

# Discovery in court proceedings

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**CHAMPIONS  
OF INNOVATION.**

## Introduction

Discovery is the term used to describe the stage in a legal proceeding where each party must disclose to the other(s) all the relevant documents in its control relating to matters at issue in the proceeding.

One of the primary aims of the discovery process is to ensure that the parties are not taken by surprise at trial. Each party should be able to assess the strengths and weaknesses of the other's case at a relatively early stage by having access to all relevant documentation.

Discovery procedures are designed to prevent parties keeping their cards close to their chest. For this reason, disclosure must extend not only to any documents or materials which a party may wish to rely on to advance its case but also to any documents or materials which may be confidential or damaging to its own case / assist the case of the other party.

The obligation to disclose all relevant documents incorporates a corresponding duty not to destroy documents from the time at which litigation is in contemplation.

## Affidavit of discovery

During the first part of the discovery process each party must prepare a detailed list of all relevant documents in its control. This list will often contain hundreds of documents, each of which must be individually numbered and described.

A document is "relevant" if it relates to a matter in question in the proceedings. The term "documents" in this context covers a wide range of material. It includes not only written material, but also photographs, video and audio tapes, and material held on computers (including email messages), CD ROM or disc. "Documents" may also include product drawings, prototypes, product samples, trade and consumer price lists, trade and consumer catalogues, website pages and retail point-of-sale material.

Documents relating to the dispute in the possession of an agent such as accountants or lawyers must also be disclosed.

The discovery list is verified an appropriate person swearing an affidavit by on behalf of the party confirming that the documents listed comprise all relevant documents in that party's control. The original copy of the affidavit must be filed in Court and a copy served on the other party by a date specified by the Court.

For this reason it is important to ensure that discovery is complete. If a document is not included in the list, it may not be possible to use it as evidence if the matter proceeds to a court hearing.

## Inspection of documents

The second part of the discovery process is the inspection of documents contained in the other party's affidavit of discovery. Inspection of

these documents must be completed by the date specified in the timetable which will be set by the Court.

Documents disclosed in the discovery process may only be used by the other party for the purposes of the proceeding in question.

### **Privilege**

Disclosing the existence of a document in an affidavit of discovery does not mean that the other party is automatically entitled to inspect it.

Certain categories of documents are privileged from inspection which means that the other party is not entitled to see them. The most common categories of privileged documents are:

- correspondence between a party and its solicitor/patent attorney;
- correspondence between the solicitor, patent attorney and third parties for the purpose of conducting the litigation;
- correspondence between a party to the proceedings and third parties where the correspondence will be used by that party's solicitor/patent attorney for the purpose of conducting the litigation; and
- drafts and file notes prepared by a party's solicitors/patent attorneys.

The parties may also agree, or the Court may order, that confidential or commercially sensitive documents are excluded from inspection or limited to certain persons (such as legal counsel) only.

### **Further and better discovery**

Once the affidavits of discovery are exchanged, and the documents have been inspected, it is

not uncommon for the parties to seek further documents from each other, if it appears that these documents are missing from the original affidavit of discovery. These additional documents will usually be provided by agreement. However either party may apply for further and better discovery from the Court if it can show that further relevant documents are in the other party's control and that other party has refused to provide them.

### **Document management**

From the time litigation is in contemplation there is a duty on the parties involved to retain any relevant documents in existence at that point.

In addition, many relevant documents may be generated during the course of the dispute and subsequent proceedings.

The following can assist in managing the discovery process:

- Keep all documents, both hard copy and electronic, relating to a dispute in a separate file;
- Advise relevant employees of the need to keep relevant documents;
- Keep recipients of correspondence relating to a dispute to a minimum – only copy others on emails or other correspondence where really necessary;
- Mark any correspondence with third parties for the purposes of conducting the proceedings, or documents you prepare for your lawyers, "Privileged";

- Try to ensure that relevant documents are dated and that the author of the document is clear.

**Disclaimer**

The above is provided for general information purposes only and does not take the place of specific legal advice. For more specific advice on all aspects of intellectual property law please contact us.