

Ref: **Master55**

Delivered: **11/01/08**

Judgment: approved by the Court for handing down
(subject to editorial corrections)*

IN THE HIGH COURT OF JUSTICE IN NORTHERN IRELAND

QUEENS BENCH DIVISION

**IN THE MATTER OF THE EVIDENCE (Proceedings in Other Jurisdictions) ACT 1975,
and IN THE MATTER OF CIVIL PROCEEDINGS NOW PENDING**

Between:

METSO MINERALS INC

Plaintiff;

AND

**POWERSCREEN INTERNATIONAL DISTRIBUTION LTD,
TEREX CORPORATION,
POWERSCREEN NEW YORK SYSTEMS INC and
EMERALD EQUIPMENT SYSTEMS INC**

Defendants.

Master McCorry

The Applications

[1] These applications by summonses pursuant to Order 70, rule 3 of the Rules of the Supreme Court and Section 2 of the Evidence (Proceedings in Other Jurisdictions) Act 1975, are brought by the Crown Solicitor at the request of His Honour E Thomas Boyle, United

States Magistrate Judge of the United States District Court for the Eastern District of New York. The first relates to a Letter Rogatory dated 25th June 2007, issued upon application by the defendants, requesting assistance in respect of the examination under oath of, and the production of documents by, Malachy J Rafferty of 60 Termon Road, Carrickmore, Omagh, County Tyrone. The second relates to a Letter Rogatory dated 2nd August 2007, issued upon the application by the plaintiff, requesting assistance in respect of the examination under oath of Daniel James McCusker of 11 Thornleigh Manor, Benburb, Dungannon.

[2] The business of both the plaintiff and the defendants includes the design, manufacture and distribution of mobile aggregate processing machinery for use in the construction and mining industry worldwide. The plaintiff alleges continuing patent infringement by the defendants in relation to the United States Patent No. 5,577,618 entitled “Mobile Aggregate Material Processing Plant” (“the 618 Patent”). Neither Mr Rafferty nor Mr McCusker is employed by any party to the action. The defendants deny infringement and for their part have issued proceedings in the United Kingdom, alleging patent infringement by the plaintiff, which action is presently stayed.

[3] Mr Rafferty is named as an inventor of the equipment in the 618 Patent and the defendants believe that he possesses unique knowledge and information concerning the conception, production, sale and associated publication of information concerning the subject matter of the 618 patent, and in addition in relation to the assignment or sale of the patent to the plaintiff. Mr McCusker is named as one of two inventors of the equipment in Patent GB 2351719 issued to Powerscreen in relation to the same product in the United Kingdom (the subject of the stayed proceedings), and as a former employee of Powerscreen was a primary participant in the development of the product that is alleged to infringe the 618 Patent. The plaintiff therefore believes that Mr McCusker possesses unique knowledge and information relevant to the issues in dispute between the parties.

[4] At the outset both parties agreed that it was appropriate for this court to make an order for the examination on oath of Mr McCusker, but with the precise terms of the order to be the same as in the case of Mr Rafferty, if an order for his examination is made. I therefore

postpone ruling on the precise terms of the order in respect of Mr McCusker until I have ruled in the case of Mr Rafferty.

The Statutory Context

[5] There is no power derived from the inherent jurisdiction of the High Court to make the orders sought, the sole source of the court's jurisdiction being conferred by section 2 of the Evidence (Proceedings in Other Jurisdictions) Act 1975, which gives statutory effect to the United Kingdom's obligations under the Hague Convention to afford assistance to foreign courts with regard to obtaining evidence in civil proceedings. Section 1 provides:

“ Where an application is made to the High Court of Justice in Northern Ireland for an order for evidence to be obtained in the part of the United Kingdom in which it exercises jurisdiction, and the court is satisfied-

- (a) that the application is made in pursuance of a request issued by or on behalf of a court or tribunal (“the requesting court”) exercising jurisdiction in any other part of the United Kingdom or in a country or territory outside the United Kingdom; and
- (b) that the evidence to which the application relates is to be obtained for the purposes of civil proceedings which either have been instituted before the requesting court or whose institution before that court is contemplated,

..... the High Court of Justice in Northern Ireland, as the case may be, shall have the powers conferred on it by the following provisions of this Act.

Section 2 provides:

- (1) Subject to the provisions of this section, the High Court of Justice in Northern Ireland shall have power, on any such application as is mentioned in section 1 above, by order to make such provision for obtaining evidence in the part of the United Kingdom in which it exercises jurisdiction as may appear to the court to be appropriate for the purpose of giving effect to the request in pursuance of which the application is made; and any such order may require a person specified therein to take such steps as the court may consider appropriate for that purpose.

(2) Without prejudice to the generality of subsection (1) above but subject to the provisions of this section, an order under this section may, in particular, make provision –

- (a) for the examination of witnesses, either orally or in writing;
- (b) for the production of documents;

(3) An order under this section shall not require any particular steps to be taken unless they are steps which can be required to be taken by way of obtaining evidence for the purposes of civil proceedings in the court making the order (whether or not proceedings of the same description as those to which the application for the order relates); but this subsection shall not preclude the making of an order requiring a person to give testimony (either orally or in writing) otherwise than on oath where this is asked for by the requesting court.

(4) An order under this section shall not require a person-

- (a) to state what documents relevant to the proceedings to which the application for the order relates are or have been in his possession, custody or power; or
- (b) to produce any documents other than particular documents specified in the order as being documents appearing to the court making the order to be, or to be likely to be, in his possession, custody or power.

Section 3 provides:

(1) A person shall not be compelled by virtue of an order under section 2 above to give any evidence which he could not be compelled to give –

- (a) in civil proceedings in the part of the United Kingdom in which the court that made the order exercises jurisdiction; or
- (b) subject to subsection (2) below, in civil proceedings in the country or territory in which the requesting court exercises jurisdiction.

(2) Subsection (1)(b) above shall not apply unless the claim of the person in question to be exempt from giving the evidence is either-

(a) supported by a statement contained in the request (whether it is so supported unconditionally or subject to conditions that are fulfilled); or

(b) conceded by the applicant for the order;

and where such a claim made by any person is not supported or conceded as aforesaid he may (subject to the other provisions of this section) be required to give the evidence to which the claim relates but that evidence shall not be transmitted to the requesting court if that court, on the matter being referred to it, upholds the claim”.

[6] It is clear in Section 2 (4) that as far as requests for the obtaining of documents is concerned the court will not allow requests for classes of documents. Particular documents sought must be individually described. The meaning of ‘particular document’ in this context is clarified by the Court of Appeal at paragraph 35 of Genira Trade and Finance Inc et al v Refco Capital Markets Ltd et al (unrep. 21 November 2001), wherein Waller L.J., refused a Request for documents because: “it is not identification of particular documents which are known to exist and should be produced. To put it another way, it is not a request for the agreements, it is a request for “any” or “all”.”

[7] Section 2 (4) is a statutory reflection of the United Kingdom’s opt out under Article 23 of the Convention, which enables a signatory state to revoke its consent to the Treaty’s procedures for pre-trial discovery, pursuant to which the United Kingdom has declared that it will not execute Letters of Request for the purpose of obtaining pre-trial discovery of documents. In the past this has given rise to dispute in requests from courts in the United States, where the pre-trial discovery practice differs significantly from disclosure procedures in this jurisdiction.

The Procedural Framework

[8] Order 70 of the Rules of the Supreme Court (Northern Ireland) 1980, as amended, sets the procedural framework for applications such as this. Rule 6 deals specifically with the issue of privilege in the following terms:

“6.-(1) The provisions of this rule shall have effect where a claim by a witness to be exempt from giving any evidence on the ground specified in section 3(1)(b) of the Act of 1975 is not supported or conceded as mentioned in sub-section (2) of that section.

(2) The examiner may, if he thinks fit, require the witness to give the evidence to which the claim relates and, if the examiner does not do so the Court may do so, on the ex parte application of the person who obtained the order under section 2.

(3) If such evidence is taken –

- (a) it must be contained in a document separate from the remainder of the deposition of the witness;
- (b) the examiner shall send to the Master with the deposition a statement signed by the examiner setting out the claim and ground on which it was made;
- (c) on receipt of the statement the Master shall, notwithstanding anything in rule 5, retain the document containing the part of the witness’s evidence to which the claim relates and shall send the statement and a request to determine the claim to the foreign court or tribunal with the documents mentioned in rule 5;
- (d) if the claim is rejected by the foreign court or tribunal, the Master shall send to that court or tribunal the document containing that part of the witness’s evidence to which the claim relates, but if the claim is upheld he shall send the document to the witness, and shall in either case notify the witness and the person who obtained the order under section 2 of the court or tribunal’s determination”.

[9] The manner in which an examination for the taking of evidence by deposition is conducted is governed by Order 39, rule 8 of the Rules of the Supreme Court, which provides:

“(1) Subject to any direction contained in the order for examination-

- (a) any person ordered to be examined before the examiner may be cross examined and re-examined, and
- (b) the examination, cross examination and re-examination of persons before the examiner shall be conducted in like manner as at the trial of a cause or matter.

(2) The examiner may put any question to any person examined before him as to the meaning of any answer made by that person or as to any matter arising in the course of the examination.

(3) The examiner may, if necessary, adjourn the examination from time to time.”

[10] Order 39, rule 10 deals with objections to questions:-

“(1) If any person being examined before the examiner objects to answer any questions put to him, or if objection is taken to any such questions, that question, the ground for the objection, and the answer to any such question to which objection is taken must be set out in the deposition of that person or in a statement annexed thereto.

(2) The validity of the ground for objecting to answer any such question or for objecting to any such question shall be decided by the Court and not by the examiner, but the examiner must state to the parties his opinion thereon, and the statement of his opinion must be set out in the deposition or in a statement annexed thereto.

(3) If the court decided against the person taking the objection it may order him to pay the costs occasioned by his objection.”

The Authorities

[11] The principles governing the court’s exercise of its jurisdiction were helpfully summarised by Smith J at paragraph 30 of his judgment in Daric Smith v Philip Morris Companies Inc et al [2006] EWHC 916 (Q.B.). These principles provide sufficient clear guidance as to merit setting out in full:-

“There was little difference between the parties about the general principles which govern the approach of the English courts to applications of this kind. The following is established by the authorities:

(i) The jurisdiction of this Court to respond to a Letter of Request is statutory, and accordingly the Court has jurisdiction to make an order only in accordance with the provisions of the 1975 Act.

(ii) However, section 2(3) of the Act restricts what orders the court may make to (so far as is relevant) steps that can be

required to be taken by way of obtaining evidence for the purposes of civil proceedings in the English Court, and so 'prohibits the making of an order for the examination of a witness not party to the action for the purpose of seeking information which, though inadmissible at trial, appears to be reasonably calculated to lead to the discovery of admissible evidence': see In re: Westinghouse Uranium Contract, [1978] AC 547 at p. 634G per Lord Diplock. That would be an impermissible investigatory exercise.

(iii) Subject to this limitation, the approach of the English Court is to seek to assist the foreign court whenever it is appropriate to do so: see the Westinghouse case (cit sup) at p.560H per Lord Denning MR

(iv) Accordingly, if the Court receives a Letter of Request that is defective in that it does not comply with the provisions of the 1975, the Court will be prepared to make an order subject to limitations or conditions if it can properly do so and thereby remedy the defect: see for example Golden Eagle Refinery v Associated International Insurance, (unrep) 19 February 1998.

(v) The Court has jurisdiction to make an order, it has discretion whether or not to do so.

(vi) The Court will generally not exercise its discretion to make an order for the examination of a witness if it is satisfied that the letter of request is mainly of an investigatory character even though it is satisfied that the witness may be able to give some relevant and admissible evidence: United States of America v Philip Morris Inc., (unrep) 10 December 2003 at para 76 per Moore-Bick J.

(vii) Otherwise, the Court is generally disposed to exercise its discretion in favour of granting requests unless it would be unfairly oppressive upon the witness to do so or there is other powerful reason not to do so.

(viii) In order to accede to the request of the foreign court, this Court will again in a proper case be prepared to grant the order subject to conditions or limitations designed to afford the witness adequate protection.

(ix) However, there will come a point when the imposition of such conditions or limitations will amount to re-writing the request or mean that the order is 'going too far away from the original Letter of Request' (per The State of Minnesota v Philip Morris Inc., [1998] 1 L Pr 170 at para 69 per Peter Gibson LJ) for this to be an appropriate exercise for the Court to undertake:

see to The State of Minnesota v Phillip Morris Inc., (loc cit) at para 72 per Otton LJ.”

[12] In The State of Minnesota v Philip Morris Inc., (loc cit) at para 13 Lord Woolf MR highlighted particular difficulties which can arise in cases of requests for assistance from United States courts, which arose in that case and, it appears to me, also arises in the present case, namely the practice of oral discovery and the extent of non-party discovery. He said:

“The difficulty in the present case, as in previous cases, arises because of the difference in approach to discovery, in this country and the United States. Their discovery procedures are not necessarily the same in all States. But in general in the United States there is a tradition of oral discovery which has never been developed in this country. Rightly or wrongly, we regard oral discovery as a form of discovery which generates unnecessary costs and complexity. There is another difference between the approach to discovery in this country and that in the United States. Generally, there it is possible to get much wider ‘non-party’ discovery. That is discovery against those who are not parties to the proceedings’.

Lord Woolf cited Lord Diplock in In re Westinghouse Uranium Contract, (loc cit) at p.635A about section 2(3) of the 1975 Act:

“The difficulty involved in the application of subsection (3) to proceedings in the United States lies in the fact that the examination of witnesses who are not parties to the action serves a dual purpose; the ordinary purpose of discovery with the wide line of inquiry which that permits and also the purpose of obtaining in the form of a deposition evidence from the witness that will be admissible at the trial in the event of the witness not being called in person.”.

[13] In this jurisdiction there is no tradition of oral discovery for the reasons set out by Lord Wolff, and the extent of non party discovery is closely circumscribed by well established rules of practice. This means that requests for testimony which amount to oral discovery or exceed the boundaries of what is permissible by way of non party discovery in this jurisdiction, may fall foul of section 2 (3) of the 1975 Act, which provides that “An order under this section shall not require any particular steps to be taken unless they are steps which can be required to be taken by way of obtaining evidence for the purposes of civil proceedings in the court making the order.”

[14] In the same judgment Lord Woolf at page 4 of 13, dealing with the situation where a court has to choose between either giving effect to the letter of request, or refusing to do so, or if appropriate to give amended effect to the letter of request, reiterates that:

“fishing still cannot be permitted as part of a Request. Furthermore, because of the need to hold the balance between the requesting court and the witnesses who are to be examined, if the Request is given effect, the court will not allow uncertain, vague or other objectionable Requests to be implemented. A witness is entitled to know within reasonable limits the matters about which he or she is to be examined. Although there is the possibility, to which I have already referred, of matters coming back to the court for further rulings, in general the court has to take into account that once it makes an order it ceases to have any control of the examination”

[15] Peter Gibson LJ at page 11 of 13 in the same case, provides useful insight to the court’s approach to these issues in practice. Commenting on the letter of request he stated:

“However, there is a fatal defect in the Letter of Request in its failure to specify with sufficient particularity the matters upon which the witnesses are to be examined. As was held in *re Norway’s Application* [1987] 1 QB 433, where the matters, examination on which is requested by the Letter of Request to proceed, are too widely drawn, it will lead to the inference that the Letter of Request was designed to elicit information which might lead to the obtaining of evidence rather than establish allegations of fact, and that would amount to an impermissible fishing expedition.”

I will revert to this in due course when considering the actual questions upon which the Honourable Magistrate Judge requests that Mr Rafferty be examined in the present case.

[16] Golden Eagle Refinery Co. Ltd n/k/a/ Lasmo Oil and Gas Inc v Associated International Insurance Co et al, Court of Appeal per Buxton L.J. (unrep. 19.2.98) is opened to me as an example of a United Kingdom court declining to refuse entirely a poorly drafted Letter of Request, instead imposing

conditions as to the conduct of the examination, and allowing the request. The appellants had argued that the order of the lower court was too vague, too wide and as such would present serious difficulties to the examiner. They contended that the list of topics on which the witnesses were to be examined was very extensive whilst the issues in the trial were not identified with anything like the necessary precision. Buxton L.J. noted that the requesting party had simply made a request in the foreign form to the foreign court, in effect inviting the English Court to make of it what it could. He was highly critical of that approach and was tempted to quash the Order pursuant to Section 2(3) and require that a letter of request in radically different and much more limited form be obtained from the United States Court. However, he was persuaded that subject to the imposition of safeguards as to the conduct of the examination an order was possible. Whilst this decision is an example of how the court may exercise its discretion in applications such as this, there is no attempt to set down any guiding principles and the application was decided purely on the basis of its own facts.

The Subject Matter of the Request

[17] On 23.11.07, a short time before the hearing of these applications on 27.11.07, the solicitors for the defendants served on solicitors for the plaintiff an affidavit sworn on 21.11.07 by Richard Byrne of Omagh, County Tyrone, to which was exhibited the transcript of a deposition which he had given in New York on 11.09.07. Anticipating an objection as to its admissibility I did not read the affidavit or the exhibit in advance of the hearing. Counsel for the plaintiff objected to the affidavit's admission primarily on grounds of delay. I ruled that delay was not a sufficient ground to refuse to admit the affidavit, which I read along with those parts of the deposition relevant to the proceedings before this court. Plaintiff's counsel suggested, and defendant's counsel in terms conceded, that the purpose of the affidavit was to provide particularity in respect of the documents described at exhibit B of the Letter of Request, it being apparent from the plaintiff's skeleton argument that objection

was taken to the documents sought on grounds that the request was an impermissible fishing expedition.

[18] In his affidavit Mr Byrne states that at the time the product which is the subject matter of the 618 Patent was developed he was employed as a senior design engineer by a company called Masterskreen which was owned by Messrs Malachy and Kevin Rafferty. He said that in fact he had prepared the design drawings for the machinery concerned. He was able to provide evidence in respect of 4 classes of documents, namely(a) the design drawings, (b) logbooks containing detailed design calculations, both of which he gave to Mr Malachy Rafferty for safe keeping, (c) parts manuals and (d) sales literature.

[19] Exhibit B to the Letter of Request in respect of Mr Rafferty is headed “Requested Documents” and consists of a list of 11 broad categories each beginning “All documents” or “All letters”, and I have to say it is difficult to imagine a request for documents with greater potential to fall foul of Section 2(4), and Waller L.J.’s comments on the meaning of particular documents in Genira Trade and Finance Inc v Refco Capital Markets Limited (paragraph 6 above). Plaintiff’s counsel objected to the entirety of Exhibit B, whereas defence counsel argued that it was possible to give effect to the Request for Documents by applying the “blue pencil” so as to order production of such of the documents as were capable of being described with particularity on the basis of Mr Byrne’s affidavit. He invited the court to “apply the blue pencil” and in effect amend the categories of documents sought in exhibit B on the basis that the 4 classes of documents described by Mr Byrne: namely design drawings, logbooks, sales literature and parts manuals: could be shown to exist, or have existed, and to be, or have been in, the possession of Mr Rafferty.

[20] The defendants, relying upon the deposition on oath of Mr Byrne, are able to show that certain classes of documents clearly relevant to the issues in the main action were in the custody possession and power of Mr Rafferty, and if this was an application pursuant to Order 24, rule 7 for inter partes discovery

of particular documents, it is likely that the order sought would be granted. Likewise, it seems to me that if the classes of documents requested in Exhibit B broadly reflected the 4 categories now particularised, an Order could be made under the 1975 Act. However, a line must be drawn between applying the blue pencil in order to give effect to the United States Court's request and a complete re-writing of that request. I think that Exhibit B falls far on the wrong side of that line, and it is not for this court to re-write it. Having said that, and mindful of the obligation of this court to give assistance to the requesting court, I do not think that it is necessary to reject the application entirely so far as the request for documents is concerned, but rather to refer the matter back to the Honourable Magistrate Judge for his re-consideration. I give no direction as to how this is to be done, leaving it to the parties to use such procedures as are applicable before the United States Court concerned. I will adjourn this aspect of the application generally pending a revised request.

[21] I turn then to the request for examination of Mr Rafferty under Exhibit A - Subject Matter of Examination. This consists of 22 categories, in relation to No.s 1-9 inclusive and No.s 14 and 15 of which, no objection is raised. I do not think it is necessary for me to deal in detail individually with each of the 11 remaining disputed categories, because generally the same broad points can be made in relation to most of them. No.10 stands out in that the first limb "The alleged involvement of Richard Byrne in the invention of the subject matter claimed in the '618 Patent' "appears to be a permissible and obvious area for questioning, whereas the remainder "including but not limited to all drawings and calculations created by Richard Byrne pertaining to the subject matter claimed in the '618' patent'", is too broad and consequently on its face at least looks very much like an attempt at discovery. I will allow the first limb but not the second.

[22] No 11, ("All prior art searches conducted concerning all and any of the subject matter disclosed in the 618 Patent and/or subject matter of any patent application or draft patent application that relates to or is related to the 618 Patent") is objected to as being too broad. Having regard to the observations of

Lord Woolf and Peter Gibson L.J. in The State of Minnesota v Philip Morris (paragraphs 14 and 15 above) and the general principles that (a) the court will not allow uncertain, vague or other objectionable requests to be implemented; and (b) a witness is entitled to know within reasonable limits the matters about which he or she is to be examined, it appears to me that No.11 is indeed too broad and to allow it would be oppressive and unfair to the witness. Furthermore, insofar as No.11 refers to “art searches”, suggesting a search for and consideration of documents, it may be that this is once again an attempt to obtain discovery which in any event is too broad and would fall foul of section 2(4).

[23] Requests No.s 12 and 13 concern “document retention practices” of Mr Rafferty and Masterskreen, and refers to “all documents” previously in their possession. No.s 16 through to 21 inclusive all relate to “Communications” between Mr Rafferty and others. These can not be construed other than as attempts to obtain discovery, which are so wide as to clearly offend against section 2(4). No 21 (Disclosures of any of the subject matter claimed in the 618 Patent is so vague and wide as to be unclear as to meaning and as such not only offends against the United Kingdom courts approach to discovery, but is oppressive and unfair to the witness, and is impermissible under section 2(3).

[24] Dealing with Requests No.s 12 and 13 and 16 to 21, defendants’ counsel’s basic argument is that this court ought not to apply the same test to questions put in oral examination as in a request for disclosure of documents. With respect that does not take account of section 2(3) and the approach of courts here to discovery generally but in particular non party discovery, and to permit questions of the nature proposed in my view amounts to an impermissible investigatory exercise which this court should not allow.

[25] Defendant’s counsel also contends that the possibility that a question, or line of questioning, may be oppressive or give rise to privilege issues, should not concern this court because as long as it is ordered that the examination be conducted according to the rules and practices applicable in

this jurisdiction these are matters which can be dealt with by the examiner. He refers to the procedure for dealing with objections set out at Order 39, rule 10 (which I have set out at paragraph 10 above). That rule provides for the noting of the question to which objection is taken, the ground of the objection, and any answer given, by the examiner on the deposition or on an attached statement. However, whilst the examiner must state and note down his opinion on the validity of the objection, the issue is decided by the court and not the examiner, and the court may reflect its views by an order for costs. In the context of an application for assistance by a foreign court, the Order 39, rule 10 procedure affords no real protection to the witness, for the simple reason that it was not devised with that process in mind. The primary purpose of Order 39 is to set down the procedure to be followed in the taking of evidence by deposition for use before a domestic court, where a domestic court will consider the validity of the objection having regard to the practice and procedure in this jurisdiction. In the present case there is no procedure whereby objections can be referred back to this court but instead they would be considered by the United States Court which clearly will apply its own rules in terms of admissibility, possibly allowing questions, or lines of questions, which would not be permitted in this jurisdiction, and would offend against section 2(3).

[26] Order 70, rule 6 (set out at paragraph 8 above) differs from Order 39, rule 10 in that it is designed to deal with issues of privilege specifically in the context of applications for assistance from foreign courts, in the very specific context covered by section 3(1)(b). Once this court makes an order allowing examination of a witness in this jurisdiction, the only basis on which the conduct of the examination can be referred back to it is on the issue of privilege under Order 70, rule 6, and even then the issue is determined by the foreign court. That procedure aside, an order having been made, there is limited if any scope for the domestic court to control the conduct of the examination. This means that the domestic court must be careful when considering the “leave it to the examiner” approach advocated by defendant’s

counsel and despite the cited examples of Courts in England and Wales adopting an arguably wider approach, at the end of the day this court must have regard to the clear basis for the exercise of its statutory powers, and its discretion thereunder, and the limitations thereon set out at Section 2 of the 1975 Act, and must not make an order the effect of which is to allow an impermissible investigatory exercise. A further point arises. This court is bound to have regard to, for example, issues of privacy which might arise pursuant to article 8 of the Human Rights Act 1998, and must reflect this in any order which it makes. For the reasons set out in the foregoing I do not allow questions 12 and 13, and 16 to 22.

[27] In the case of the request for documents at Exhibit B of the Letter of Request, rather than disallow the request outright I referred the matter back to the United States Court, which with the benefit of the information available from the deposition of Richard Byrne will be in a position to reformulate the request in a manner which is consistent with the practice in this jurisdiction. However, it does not follow that this court should adopt the same approach with regard to the disallowed questions for oral examination in Exhibit A for the reasons stated. Those reasons are based on fundamental objections which cannot be rectified by application of the blue pencil where it is not for this court to rewrite the questions, or by referral back.

[28] I turn then to the precise terms of the order for oral examination on oath of Mr Rafferty (the permitted questions under Exhibit A to the letter of Request, and Mr McCusker (the questions under Exhibit E of the letter of Request), the terms of which should be broadly the same in each case. The terms are:

1. That Malachy J Rafferty attend at a venue on a date and time to be notified for the purpose of examination on behalf of the applicant.
2. That the purpose of the examination shall be for the eliciting and the recording of testimony appropriate to be given at trial on such of the subjects identified by Magistrate Judge Boyle in exhibit A of the

Letter of Request dated 25 June 2007 as are set out at No.s 1 to 9, that part of No. 10 limited to “The alleged involvement of Richard Byrne in the invention of the subject matter claimed in the 618 Patent”, and No.s 14 and 15.

3. That no question may be asked of the witness that in the opinion of the examiner is not a question of the nature that could properly be asked by counsel examining a witness in chief at a trial held before the High Court of Justice in Northern Ireland.”

And

1. That Daniel James McCusker attend at a venue on a date and time to be notified for the purpose of examination on behalf of the applicant.

2. That the purpose of the examination shall be for the eliciting and the recording of testimony appropriate to be given at trial on such of the subjects identified by Magistrate Judge Boyle in exhibit E of the Letter of Request dated 2nd August 2007.

3. That no question may be asked of the witness that in the opinion of the examiner is not a question of the nature that could properly be asked by counsel examining a witness in chief at a trial held before the High Court of Justice in Northern Ireland.

[29] All counsel have agreed that the examinations of Mr Rafferty and Mr McCusker ought to be carried out by the attorneys with carriage of the main action in the United States. The reasons given for this are that those lawyers are familiar with the intricacies of the main action and are specialists in the field of Patent Law. I had some concerns that this might infringe our practice with respect to rights of audience. However, on reflection I am satisfied that once this court has ruled on the applications before it, what happens at the examinations does not constitute court proceedings in this jurisdiction, but are simply a taking of evidence for use in proceedings before the Court in the United States. If that is correct then I do not think that the issue of audience

rights arises, and I will therefore add to the orders set out above a 4th term, namely:

4. The examination shall be conducted by the attorneys engaged by the parties in the action before the United States District Court for the Eastern District of New York.

[30] It occurs to me that these attorneys may not be familiar with the rules as to examination of witnesses in this jurisdiction, and whilst I do not make it a specific term of the order, it seems to me that the examinations would be expedited if the United States Attorneys were accompanied during the examination by advocates from this jurisdiction who could give them practical advice and guidance as to what is permissible and as to admissibility generally in this jurisdiction. Likewise, while I do not make it a specific term of the orders, it would seem reasonable that every effort be made to arrange for the examinations of Mr Rafferty and Mr McCusker to take place on the same, or if appropriate, successive days, to facilitate travel by the United States attorneys to and from this jurisdiction.