

THE HON'BLE SRI JUSTICE M.S.RAMACHANDRA RAO

O.P.No.1 of 2019

JUDGMENT:

This O.P. has been filed under Order XXVI Rule 20(a) of the Civil Procedure Code, 1908 by the petitioners seeking appointment of a Commission under Rule 19 of Order XXVI by this Court for collection of evidence, documents as well as for obtaining and recording testimony from the respondent and its authorized representatives which details are mentioned in the Letters Rogatory and as per letter of request / proceedings dt.19.11.2018 in case C.A.No.17-1154/GMS CONSOLIDATED filed by the petitioners against M/s. Slayback Pharma Limited Liability Co., *et al* issued by the United States District Court for the District of Delaware.

2. In the O.P., it is contended by the petitioners that they have filed a civil action No.17-1154-CFC titled '**Cephalon Inc. et al vs. Slayback Pharma Liability Co. et al**' before the United States District Court, District of Delaware against **Apotex Inc., Canada and Apotex Corporation, USA**; that the petitioners manufacture and sell Bendeka®, an anti-cancer drug indicated for the treatment of patients with chronic lymphocytic leukemia and indolent B-Cell non-Hodgkin lymphoma with an active pharmaceutical ingredient Bendamustine; that Bendeka® is protected by various patents mentioned in para no.6 of the O.P.; that the defendants **Apotex** had submitted Abbreviated New Drug Application (ANDA) No.210601 for Bendamustine

Hydrochloride Injection, 100 mg. / 4 mL (25 mg. / mL) (ANDA Product); and this constitutes an act of Patent infringement with respect to each of the Patents-in-suit under 35 USC §271(e)(2)(A).

3. According to petitioners, among other things, the manufacture, use, offer for sale, sale, marketing, distribution, and / or importation of Apotex's ANDA Product would infringe one or more claims of each of the Patents-in-suit; and that Apotex's ANDA Product and the methods of using Apotex's ANDA Product as set forth in and / or induced by the proposed package insert / proposed labeling for Apotex's ANDA Product also infringe one or more of the asserted claims of the Patents-in-suit.

4. It is contended that in defence of the allegations of infringement, Apotex has asserted that the Patents-in-suit are not infringed, invalid, and unenforceable and also asserted counter-claims seeking declaratory judgment of non-infringement and invalidity of the Patents-in-suit.

5. It is contended that the discovery regarding Apotex's ANDA Product – including the research, development, and formulation of Apotex's ANDA Product; ingredients and impurities in Apotex's ANDA Product; and testing of Apotex's ANDA Product – is relevant for Petitioners / Plaintiffs to prove infringement and defend the validity of at least some of the asserted claims of the Patents-in-suit. It is submitted that despite repeated requests, Apotex has refused to

state whether it has possession, custody, or control over documents related to the research and development of its ANDA Product.

6. It is contended that Apotex has represented that the respondent herein, i.e., **Orbicular Pharmaceutical Technologies Pvt. Ltd.**, performed the research and development of its ANDA Product; and accordingly, the petitioners / plaintiffs believe that Orbicular and its employees possess information and documents relating to Apotex's ANDA Product that are relevant to prove infringement and defend the validity of at least some of the asserted claims in the civil case pending before the U.S. District Court.

7. It is stated that in the said proceedings pending before the U.S. District Court, petitioners had filed a request for International Judicial Assistance (Letters Rogatory) as per the Hague Convention to obtain evidence to be used in the said action; and on 19.11.2018, the U.S. District Court had issued the Letters Rogatory requesting this Court for obtaining the deposition of and documents from the respondent.

8. It is stated that a Protective Order was also issued by the U.S. District Court for the District of Delaware on 16.02.2018 which is annexed as Ex.1 to the Letters Rogatory as stipulated in Clause 13 (f) of the Letters Rogatory; by the said Protective Order, the said Court had protected the proprietary or confidential trade secrets or technical, business, financial or personal information disclosed by the petitioners

or respondent or third parties; and the petitioners would deposit the un-edited and complete version of the Letters Rogatory dt.19.11.2018 in a sealed envelope in this Court. They also sought setting up of a 'Confidentiality Club'.

9. It was further suggested that this Court should appoint a Commissioner, preferably a senior person having good knowledge in the field of Chemistry such as a retired professor or a retired District Judge, so as not to burden this Court with the execution of the request; and some orders of the High Courts in India wherein similar petitions were allowed and local commissioners appointed to collect evidence and record testimony from parties in India passed by other High Courts in India have been placed before this Court.

10. The following prayers were made in the O.P. :

“(i) an order appointing a Local Commissioner, preferably a senior person having good knowledge in the field of Chemistry such as a retired Professor or a District Judge for collection of evidence, documents (as mentioned in Clause 11 and Schedule A to the Letters Rogatory) as well as for obtaining and recording the testimony (as mentioned in Clause 10 and Schedule B to the Letters Rogatory) from the respondent and its authorized representatives whose details are given in Clause 9 of the Letters Rogatory; and

(ii) an order conferring 'Special Powers' on the aforesaid Commissioner including the power to summon the person or persons including corporations and / or their authorized representatives to produce documents and things; the power to accept copies of the said documents and things; the power to summon person or persons including corporations and / or their authorized representatives, to administer oath to them and to record their evidence; the power to allow the Petitioners' and the Respondent's respective Indian counsel

the opportunity to examine or cross-examine the aforesaid witnesses; the power to permit the Petitioners' and the Respondent's respective foreign representatives to attend and observe the examination of said person or persons including corporations and / or their authorized representative; the power to record the testimony of the said person or persons including corporations and / or their authorized representative; the power to have the said recording transcribed verbatim; and the power to provide, both the documents and recording and the transcript to the Petitioners' and the Respondent's respective representatives, their respective Indian Counsel, as more particularly stated in Clause 13 of the Letters Rogatory; and

(iii) an order setting up a Confidentiality Club consisting of the persons stated in paragraph 14 and on the lines stated in paragraph 15 of the instant petition; and

(iv) an order to conduct the further proceedings before this Hon'ble Court as well as before the Local Commissioner in camera with only the members of the 'Confidentiality Club' being present; and

(v) an order directing the officials of the Registry of this Hon'ble Court as well as the Commissioner to keep all the documents and records pertaining to this petitioner or the matters arising therefrom including the evidence collected by the Commissioner in a sealed cover and allow access to the said documents only to the members of the aforesaid Confidentiality Club; and

(vi) an order directing the said Commissioner to send the evidence / documents collected and the testimony recorded to the Hon'ble United States District Court for the District of Delaware in a sealed cover; and

(vii) such further Order(s) as this Hon'ble Court deems fit and proper in the circumstances of the case may also be passed."

11. Notice was ordered on 14.02.2019 to the respondent and the counsel for the petitioners, Sri D. Venkat Reddy was also permitted to take out personal notice to the respondent by registered post with acknowledgment due and file proof of service in the Registry.

12. Ms.Altaf Fatima, counsel entered appearance for the respondent. Sri C.V. Mohan Reddy, Senior Counsel appeared for the respondent.

13. Sri D.Prakash Reddy, Senior Counsel appearing for Sri D.Venkat Reddy, the counsel for petitioners drew the attention of this Court to Rules 19 to 22 of Order XXVI of the Civil Procedure Code and stated that Commission may be issued for examination of a witness in India under sub-Rule (1) of Order XXVI Rule 19 on a request made by a foreign Court situated in a foreign country that it wishes to obtain evidence of a witness in any proceeding before it, which is of a civil nature, and the witness is residing within the limits of the High Court's appellate jurisdiction; under sub-Rule (2) of Order XXVI Rule 19, evidence may be given of the above matters specified in sub-Rule (1) by a letter of request issued by the foreign Court and produced before the High Court by a party to the proceeding; and under Rule 20 of Order XXVI, such Commission may be issued under Rule 19 by the High Court upon application by a party to the proceeding before the foreign Court. He also stated that under Rule 21 of Order XXVI, such Commission under Rule 19 may be issued to any Court within the local limits of whose jurisdiction the witness resides and since the witness / witnesses reside within the jurisdiction of this High Court, this present O.P. has been filed.

14. The counsel for the respondent pointed out that the request of the petitioners to have the evidence recorded / documents collected by

a Commissioner, preferably a senior person having good knowledge in the field of Chemistry such as a retired professor or a retired District Judge, cannot be granted. The counsel relied on the language in Order XXVI Rule 21 and contended that a 'person' can be appointed as a Commissioner only if this Court had ordinary original civil jurisdiction, but not otherwise.

15. Order XXVI Rule 21 states :

“21. To whom commission may be issued : A commission under Rule 19 may be issued to any Court within the local limits of whose jurisdiction the witness resides, or, where the witness resides within the local limits of the ordinary original civil jurisdiction of the High Court, to any person whom the Court thinks fit to execute the commission.”

16. A reading of the above provision indicates that a 'person' can be appointed as a Commissioner only if this Court had ordinary original civil jurisdiction, but not otherwise. Since this Court does not have ordinary original civil jurisdiction, Commission under Rule 19 of Order XXVI can only be issued to a 'Court' within the local limits of whose jurisdiction the witness resides. It cannot be issued to a person having knowledge in the field of Chemistry such as a retired professor or a retired District Judge as is being sought by the petitioners.

17. Therefore I reject the request of the petitioners to issue the Commission to a person having knowledge in the field of Chemistry such as a retired professor or a retired District Judge.

18. After hearing counsel on both sides, I am satisfied that the United States District Court for the District of Delaware is a foreign court situated in a foreign country, that it wishes to obtain evidence in a proceeding of a civil nature pending before it, and witnesses are residing within the limits of this High Court's appellate jurisdiction; and that evidence may directed to be recorded by a Court as per the Letter of Request issued by the said Court.

19. I therefore, in exercise of the power conferred on me under Rule 20 of Order XXVI, direct the Court of the Principal District Judge, Ranga Reddy, within whose jurisdiction the respondent resides to collect the evidence, documents (as mentioned in Clause 11 and Schedule A to the Letters Rogatory) as well as obtain and record the testimony (as mentioned in Clause 10 and Schedule B to the Letters Rogatory) from the respondent and its authorized representatives whose details are given in Clause 9 of the Letters Rogatory.

20. As per Clause 5 of the Protective Order dt.16.02.2018 issued by the U.S. District Court for the District of Delaware, 'Confidential Information' is to be made available only to the persons mentioned in Clauses 5(a)(i) to (xi); and material produced and marked as 'Highly Confidential Information' is to be disclosed only to individuals identified in paragraphs no.5(a)(ii) – (xi), and to any other persons as counsel for the Producing Party agrees in advance or as otherwise ordered by the Court. The Principal District Judge, Ranga Reddy Court shall bear in mind the above clauses.

21. The Principal District Judge, Ranga Reddy shall be supplied by the Counsel for the petitioners the following documents :

(i) the Full Letters Rogatory including Schedules A and B thereto;

(ii) Order dt.19.11.2018 / Request for International Judicial Assistance passed by the United States District Court for the District of Delaware in C.A.Nos.17-1154 – GMS consolidated; and

(iii) the Protective Order dt.16.02.2018 passed by the said Court.

22. While recording the testimony or receiving documents, the Principal District Judge, Ranga Reddy shall adhere to the terms of the above documents.

23. All objections during the recording of testimony of the witnesses or receiving documentary evidence shall be recorded and decided by the Principal District Judge, Ranga Reddy only.

24. The Principal District Judge, Ranga Reddy shall conduct the proceedings for recording of the said evidence / testimony in camera; and send the evidence / documents collected and the testimony recorded to the United States District Court for the District of Delaware in a sealed cover.

25. This exercise shall be completed as expeditiously as possible preferably within four (04) weeks from the date of receipt of copy of this order.

26. The O.P. is disposed of accordingly. No order as to costs.

27. As a sequel, miscellaneous petitions pending if any, shall stand closed.

JUSTICE M.S.RAMACHANDRA RAO

Date: 12.03.2019.

Ndr/*

