

THE HON'BLE SRI JUSTICE M.SATYANARAYANA MURTHY

ORIGINAL PETITION No.1 of 2017

ORDER:

This Petition is filed under Section 78 read with Order XXVI Rules 19 to 22 & Section 151 of C.P.C. to appoint a Commissioner to record the evidence of representative of MSN Laboratories and to issue a commission to compel the said entity (MSN Laboratories Pvt. Ltd) to submit the requested evidence (described in Exs.A and B) to an appropriate designated authority in India for subsequent return to the court at New Jersey as mentioned in Letter of Request, with a direction to the said commission to execute the Letter of Request in the manner set out therein, including direction to MSN Laboratories Private Limited to submit documents to the commission to summon the designated representatives of MSN Laboratories Private Limited pursuant to Paragraph 9 of the Letter of Request to appear before it, and to permit counsel for the petitioners to question the said designated representatives and to cause the oral depositions to be reduced to writing and be video-taped.

There was a dispute between the petitioners and respondents regarding a trade mark before New Jersey Court, United States of America. The petitioners and respondents are the parties in the litigation before the New Jersey Court, United States of America in Civil Action Nos.3:16-cv-1816 (PGS) (LHG), 3:16-cv-3642 (PGS) (LHG) for infringement of the patents registered under the Laws of the United States of America, instituted by United Therapeutics Corporation and Supernus Pharmaceuticals Inc., against Actavis

Laboratories FL, Inc (respondents herein) on the ground that, United Therapeutics produces and markets Orenitram®, a pharmaceutical product approved in the United States, indicated for the treatment of pulmonary arterial hypertension (“PAH”). United Therapeutics is the owner or exclusive licensee of at least eleven U.S. patents (“U.S.suit Patents”), detailed in Paragraph 7 of the Letter of Request, that cover the preparation and the specific active pharmaceutical ingredient (API) tersprostiniol diolamine, in Orenitram®. Supernus is the lawful owner of one U.S. patent detailed in Paragraph 7 of the Letter of Request and for which United Therapeutics is the exclusive licensee.

The defendant in the U.S. Suit, Actavis, has filed an Abbreviated New Drug Application (ANDA) with the U.S. Food and Drug Administration (USFDA) seeking approval to *inter alia* market and sell a generic treprostniol diolamine tablet prior to the expiration of the suit patents. Actavis has represented to the USFDA that its ANDA product contains the same API as petitioner No.1’s approved Orenitram® product.

The dispute pending before the Court is coming up for recording of evidence of representative of MSN Laboratories Pvt. Ltd., having registered office at Hyderabad and the factory at Medak for recording evidence and for production of documents, the New Jersey District Court of USA, addressed a letter of request to appoint any Court as a Advocate Commissioner to record the depositions and summon the witnesses of the respondent i.e., MSN Laboratories Pvt. Limited and be video taped with regard to

production of infringement against actavis during the course of trial before New Jersey District Court, USA.

It is the case of the petitioners that the registered office is in Industrial Estate, Sanath Nagar, Hyderabad whereas Manufacturing unit is situated at Patancheru Mandal, Medak District.

During the course of hearing, Sri S.Niranjana Reddy, learned Senior counsel representing Ms.Althaf Fatima, learned counsel for petitioners contended that as per the Hague Convention, India being a signatory to the Hague Convention has to extend its cooperation in civil litigations which permits the Courts in India to comply any direction by the foreign countries and its confirmation under Articles 12 and 13 and Article 3 (g) (i) of Hague Convention specifies procedure to be followed.

In addition to Hague Convention, Section 78 read with Order XXVI Rule 19 to 22 C.P.C, prescribes procedure to the Courts in India to appoint any Court to record evidence and for that purpose.

According to Section 78 of C.P.C, Subject to such conditions and limitations, as may be prescribed, the provisions as to the execution and return of commissions for the examination of witnesses shall apply to commissions issued by or at the instance of-

- a) Courts situate in any part of India to which the provisions of this Code do not extend; or
- b) Courts established or continued by the authority of the Central Government outside India; or
- c) Court of any State or Country outside India.

Therefore according to Section 78 C.P.C, the Court can appoint an advocate commissioner to record evidence based on the letter of request received from any Court of any State or Country outside India. At the same time, Order XXVI Rule 19 C.P.C enables this court to issue a commission to examine any witness, if the High Court satisfies, that a foreign Court situated in a foreign country wishes to obtain the evidence of a witness in any proceedings before it, that the proceeding is of civil nature, and that the witness is residing within the limits of the High Court's appellate jurisdiction and subject to Rule 20.

Sub clause (2) (c) speaks about letter of request issued by the foreign Court and produced before the High Court by a party to the proceeding.

As per the above provision, to issue such commissions, what is relevant for consideration is receipt or production of a letter of request by foreign Court and produced before the High Court by the authority to the proceedings.

Order XXVI Rule 20 prescribes 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.

Therefore, the power is conferred on the Court to appoint any Court or any person to whom the Court thinks fit to execute the commission. But in the present case, the witness to be examined is

the authorised representative of MSN Laboratories, whose office is located at Sanathnagar, Hyderabad and factory located at Patancheru, Medak District. The petitioners fail to disclose to whom the petitioners are proposing to examine as witness except contending that representative of MSN Laboratories is proposed to be examined.

Thus, the factory and registered offices are situated in different Districts, within the jurisdiction limits of Medak or Hyderabad District, respectively. Therefore, in the absence of any proof as to whom the petitioner is proposing to examine and who is the representative of MSN Laboratories and to whom direction is to be issued to produce documents, this Court can appoint any Court as the Commissioner to record the evidence of representatives of MSN Laboratories Private Ltd., and receive the documents. Therefore, taking into consideration of work load in City Civil Court, Hyderabad, when compared to Medak District, the Principal District Judge, Medak is appointed as Commissioner for the purpose of execution of commission as requested in the letter of request, which Court can complete and execute the warrant within short time after following the due procedure contemplated under Order XXVI Rules 19 to 22 C.P.C.

Therefore, I deem it appropriate to appoint the Principal District Judge, Medak District, as a Commissioner for the purposes mentioned in para Nos.8 to 14 of letter of request.

The letter of District Court at New Jersey requested to video tape the evidence. But such practice is not prevailing in India.

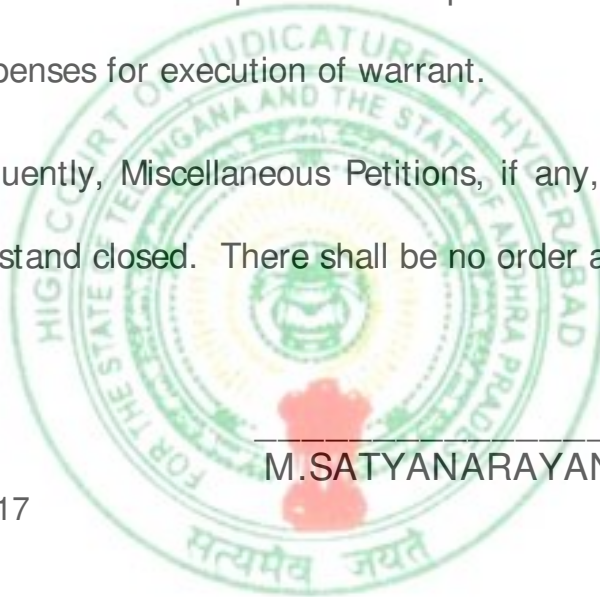
Therefore, this Court is unable to direct the Principal District Judge, Medak to video tape the entire proceedings.

In the result, the petition is allowed, appointing Principal District Judge, Medak as Commissioner and is directed to execute the Commission warrant by following Order XXVI Rules 19 to 22 and forward the entire report to the High Court along with deposition of representative of MSN Laboratories Pvt. Ltd., and documents received and mark so as to enable to transmit to the Foreign Court along with the letter of request. The petitioners shall bear the necessary expenses for execution of warrant.

Consequently, Miscellaneous Petitions, if any, pending in this petition shall stand closed. There shall be no order as to costs.

Date:20.06.2017
knl

M.SATYANARAYANA MURTHY,J



THE HON'BLE SRI JUSTICE M.SATYANARAYANA MURTHY

ORIGINAL PETITION No.1 of 2017



Date:20.06.2017

knl

