

O.P. (PT) Nos.5 and 6 of 2024

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on : 20.01.2025

Pronounced on : 28.01.2025

CORAM:

THE HON'BLE MR. JUSTICE ABDUL QUDDHOSE

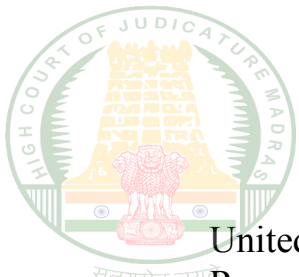
O.P. (PT) Nos.5 and 6 of 2024

1. Pfizer Inc.
235 East 42nd Street,
New York, NY 10017,
United States of America,
Represented by its Constituted Attorney,
Mr.Pankaj Pahuja

2. FoldRx Pharmaceuticals, LLC,
Corporation Trust Center,
1209 Orange St.,
Wilmington, DE 19801,
United States of America,
Represented by its Constituted Attorney,
Mr.Pankaj Pahuja

3. PF PRISM IMB B.V.,
Rivium Westlaan 142, 2909 LD,
Capelle aan den IJssel,
The Netherlands,
Represented by its Constituted Attorney,
Mr.Pankaj Pahuja

4. Wyeth LLC,
Corporation Trust Center,
1209 Orange St.,
Wilmington, DE 19801,



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United States of America,
Represented by its Constituted Attorney,
Mr. Pankaj Pahuja

.. Petitioners
In both O.Ps.

VS.

Softgel Healthcare Private Limited

.. Respondent
In both O.Ps.

COMMON PRAYER: Common Joint petition filed under Order XXVI Rule 19 to 22 and Sections 78 and 151 of C.P.C., 1908 for the following reliefs:

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, and

iii) An order setting up a Confidentiality Club consisting of the persons stated in paragraph 12 and on the lines stated as stated in paragraph 13 of the instant petitions; and

iv) An order to conduct the further proceedings before this 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 Court as well as the Commissioner to keep all the documents and records pertaining to these petitions 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 United States District Court for the District of Delaware in a sealed cover.



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For Petitioners
In both O.Ps.

:

Mr.Sathish Parasaran
Senior Counsel
for Mr.Pravin Anand,
Mr.K. Premchandrar
Tusha Malhotra
N.C. Vishal
M.S. Yeseswini
Tanvi Bhatnagar

For Respondent
In both O.Ps.

:

Mr.V. Raghavachari
Senior Counsel
for Dr.Mohan Devan
Mr.A.K. Balaji
Ms.S. Nithya

COMMON ORDER

These petitions have been filed before the Intellectual Property Division (IPD) of this Court under Order XXVI Rules 19 - 22 read with Sections 78 and 151 of C.P.C., seeking to execute the Letters Rogatory dated 13.05.2024 issued by the United States District Court under the Hague Convention, 1870, seeking judicial assistance from this Court against the respondent. Letters Rogatory are formal requests from one Court to another to obtain judicial assistance.

2. The petitioners in O.P. (PT) No.5 of 2024 claim that in the case pending before the United States District Court at Delaware, they had alleged, among other things, that the submission of Abbreviated New



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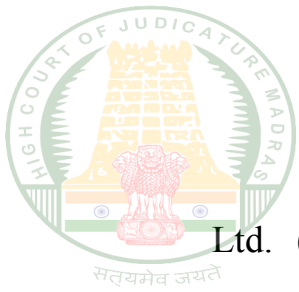
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Drug Application (ANDA) No.218409 by CIPLA, which seeks approval from the FDA to market a generic version of VYNDAMAX[®] ("CIPLA's ANDA Product") before the expiration of the petitioners' "441 Patent", constitutes an act of infringement with respect to the "441 Patent".

3. The petitioners in O.P. (PT) No.6 of 2024 claim that in the case pending before the United States District Court at Delaware, they had alleged, among other things, that the submission of Abbreviated New Drug Application (ANDA) No.218205 by Zenara (now Hikma), which seeks approval from the FDA to market a generic version of VYNDAMAX[®] ("Zenara's ANDA Product") before the expiration of the petitioners' "441 Patent", constitutes an act of infringement with respect to the "441 Patent".

4. Since the directions sought for in both the petitions are similar in nature, they are disposed of by a Common Order.

5. A patent dispute is pending adjudication before the United States District Court between the petitioners and Zenara Pharma Pvt.



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Ltd. (hereinafter referred to as 'Zenara'), CIPLA and other Indian pharmaceutical Companies viz., Aurobindo Pharma Limited and Dexcel Pharma Technologies and Limited.

6. The present petitions pertain to Zenara's ANDA Product, which according to the petitioners, infringes their "441 Patent" issued by the U.S. Patent Office for their TAFAMIDIS 61 mg capsules sold under the brand name VYNDAMAX[®], which are used for treatment of TRANSTHYRETIN AMYLOID CARDIOMYOPATHY. According to the petitioners, they believe that the respondent and its employees who are associated with Zenara possesses information and documents relating to Zenara ANDA product that are relevant for proving infringement of 441 Patent belonging to the petitioners.

7. In the Civil proceedings, pending before the United States District Court at Delaware between the petitioners and Zenara, CIPLA and other Indian pharmaceutical companies, the petitioners filed a request for international judicial assistance (Letters Rogatory) as per Hague Convention of 18.03.1970 for taking evidence abroad in Civil or



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Commercial matters to which both India and the United States are signatories and to obtain evidence for the purpose of being used in the Civil proceedings before the United States District Court for the District of Delaware.

8. The United States District Court for the District of Delaware has issued Letters Rogatory dated 13.05.2024 requesting this Court for obtaining the deposition of documents from the respondent herein. Subsequent to the issuance of Letters Rogatory, Zenara, one of the defendants in the U.S. proceedings, raised confidentiality concerns regarding certain portions of the Letters Rogatory and requested the petitioners' counsel not to divulge the Letters Rogatory unless a confidential club is formed.

9. According to the petitioners, to maintain the confidentiality, they have filed a redacted version of the Letters Rogatory dated 13.05.2024 and the petitioners have requested this Court to grant leave for them to place on record the full un-redacted version of the said Letters Rogatory once this Court directs the formation of a



confidentiality club as prayed for in these petitions. However, as seen from the pleadings of the respondent filed before this Court, they have raised the following defences to these petitions:

a) The respondent is a third party and in the absence of any infringement claim made by the petitioner against the respondent, these petitions are not maintainable;

b) The respondent being a non-party to the original litigation pending before the United States District Court at Delaware, they cannot be compelled to provide evidence beyond the boundaries as per the Hague Convention;

c) The respondent is entitled to invoke article 11 (1) of the Hague Convention to refuse participation, if the request conflicts with domestic laws or sovereignty;

d) Article 39 of the Hague Convention explicitly safeguards confidential data, which is the core of the respondent's pharmaceutical research and development;

e) Compelling disclosure by the respondent under the current circumstances would be contrary to India's obligation under the TRIPS agreement:



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f) The Indian Patent Office has refused the petitioners' patent application for the drug VYNDAMAX under Section 3 (d) of the Patents Act, 1970, rejecting the application on the ground that it constitutes a new form of a known substance. This decision negates the petitioners' ability to enforce the patent rights within the territory of India;

g) The International Convention, such as Hague Evidence Convention, cannot be invoked to override the domestic laws of India, particularly when the petitioner is not asserting valid patent rights in India. The Indian Patents Act, 1970 governs the enforceability of patent rights within India and the Indian Patent Office's administration to reject the petitioners' application renders any claim for this right is invalid;

h) The petitioners cannot make a fishing expedition in the guise of evidence collection. The petitioners' requests are vague and violate the principles of specificity and proportionality required under Article 23 of the Hague Convention;

i) The respondent has legitimate source about the misuse of sensitive information which unfairly benefit the petitioners in circumventing the refusal of their patent application in India;

j) Forcing the respondent, a non-party to the U.S. litigation, to



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disclose sensitive research and development data, would cause disproportionate hardship to its commercial interest and those of its equitable collaborators;

k) The respondent states that any information, the petitioner is seeking regarding Zenara and CIPLA, ought to have been first addressed before the United States District Court at Delaware.

10. Heard Mr. Sathish Parasaran, learned senior counsel and assisted by Mr.Pravin Anand, learned counsel for the petitioners and Mr.V. Raghavachari, learned senior counsel appearing for Dr.Mohan Devan, learned counsel for the respondent.

11. Both the learned senior counsels reiterated the respective contentions of the respective parties as seen from their pleadings filed before this Court. Both of them have referred to the relevant documents and relevant clauses in the Hague Convention as well as the Letters Rogatory issued by the United States District Court at Delaware in support of their respective contentions.



WEB COPY 12. The learned senior counsel appearing for the petitioners in support of the petitioners' contentions drew the attention of this Court to the following authorities and submitted that in identical matters, the Andhra Pradesh High Court, Bombay High Court and Delhi High Court allowed similar reliefs for enforcement of Letters Rogatory issued by a foreign Court:

a) Aventis Pharmaceuticals Inc. Vs. Dr. Reddy's Laboratories Inc. reported in MANU/AP/0650/2008;

b) Pfizer Inc Vs. Unimark Remedies Limited reported in 2016 SCC Online Bom 8599;

c) Wooster products Inc., Vs. Magna Tek Inc. and Others reported in MANU/DEL/0102/1988;

13. The learned senior counsel for the petitioners also drew the attention of this Court to the *House of Lords* decision rendered in Norwich Pharmacal Co. and Others Vs. Customs and Excise Commissioners reported in Roskill LJ A.C. 133 and would submit that where a person, albeit innocently and without incurring any personal



liability, became involved in the tortious acts of others, he came under a duty to assist the one injured by those acts by giving him full information by way of discovery and disclosing the identity of the wrongdoers.

14. Learned senior counsel appearing for the petitioners also submitted that only in cases where

a) The execution of the Letters Rogatory does not fall within the powers of the Indian Courts; and

b) The Letters Rogatory issued will affect the sovereignty or security of India,
the question of refusing to execute the Letters Rogatory issued by the foreign Court will arise.

15. According to him, in the present case, there is no prohibition for this Court to enforce the Letters Rogatory issued by the United States District Court, Delaware against the respondent since there are no legal restrictions. According to him, the Letters Rogatory issued by the United States District Court is in complete compliance with the Hague Convention 18.03.1970 to which both India and United States are



signatories and India has also ratified it.

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16. The learned senior counsel appearing for the petitioners also submitted that the respondent's allegation in its counter statement that the documents, that are sought for from it, are already in the possession of CIPLA, is wrong. He also drew the attention of this Court to the respondent's counter statement and would submit that the respondent has admitted to the fact that it is also in possession of the documents pertaining to CIPLA's ANDA product. According to him, there became a necessity for the petitioners to seek for Letters Rogatory from the United States District Court, Delaware since CIPLA, one of the defendants in the said litigation, did not furnish all the necessary documents and they had suggested that they would obtain the same from the respondent. Since CIPLA did not produce the documents, Letters Rogatory was issued by the United States District Court.

17. On the other hand, learned senior counsel appearing for the respondent in support of the respondent's objections, relied upon the following authorities:



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a) A judgment of the Gujarat High Court in the case of Leighton International Limited and Others Vs. Gavin John Hodge and Others reported in 2014 SCC Online Guj 15738;

b) A decision of the Gujarat High Court in the case of Fenix Diamonds LLC Vs. Carneige Institute of Washington reported in 2020 SCC Online Guj 1628.

18. Relying upon the aforesaid decisions, the learned senior counsel appearing for the respondent would submit that this Court cannot compel the respondent to produce the documents as it would amount to causing serious prejudice to them as it will strip-off their protection, privilege and confidentiality. He would also submit that the aforesaid decisions have also made it clear that the production of documents pursuant to the issuance of Letters Rogatory is limited to the parties to the proceedings and a fishing expedition in the guise of evidence collection cannot be permitted through the assistance of Indian Courts.

19. The learned senior counsel for the respondent reiterated the contentions of the respondent as pleaded by them before this Court and



would submit as follows:

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a) Since the respondent is not a party before the United States District Court, the present petitions are not maintainable;

b) The Hague Convention does not enable this Court to grant the relief as sought for in these petitions against a third party;

c) The Hague Convention cannot be invoked to override the domestic laws of India. Since the patent application filed by the petitioners pertaining to a similar invention as claimed before the United States District Court has been refused to be granted by the Indian patent office, no relief can be granted by this Court as sought for by the petitioners in these petitions.

20. According to the learned senior counsel for the respondent, if these petitions are allowed, it would amount to overriding the Indian domestic laws, governing the issuance of patent. The petitioners ought to have exhausted all remedies before the United States District Court before seeking international judicial assistance. Having not done so, they cannot file these petitions before this Court and therefore, they are not maintainable.



WEB COPY 21. Learned senior counsel for the respondent further contended that the petitioners cannot make a fishing expedition in the guise of evidence collection. The respondent has legitimate source about the misuse of sensitive information, which could unfairly benefit the petitioners in circumventing the rejection of the patent application of the petitioners by the Indian Patent Office. By forcing the respondent, a non-party to the US litigation, to disclose sensitive Research and Development data would cause disproportionate harm to its commercial interests and those of its global collaborators.

Discussion:

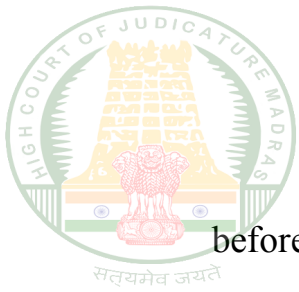
22. To pursue discovery from foreign entities, litigants often request Letters Rogatory (or Letters of request for Judicial assistance) from a foreign Court. In the instant case, the petitioners had sought assistance for the issuance of Letters Rogatory against the respondent from the United States District Court, Delaware and the same was also granted. The petitioners claim that the documents sought for from the



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respondent before this Court are relevant for the purpose of proving the petitioners' patent infringement claim before the United States District Court in respect of Zenara ANDA product and CIPLA ANDA product which according to the petitioners has violated the petitioner's "441 Patent".

23. The petitioners have also categorically confirmed through their pleadings that they do not have any claim against the respondent and that they have filed these petitions only for the purpose of assisting them in proving their patent claim against Zenara and CIPLA, which are pending adjudication before the United States District Court, Delaware. Letters Rogatory dates back to early American Law, when courts of one state would formally request the taking of evidence from any other state but now Letters Rogatory are used to request judicial assistance in taking evidence abroad. According to the petitioners, in respect of the pharmaceutical drug, which is the subject matter of the patent litigation before the United States District Court at Delaware, the respondent is having information of the same, which will aid in proving the petitioners' patent claim against Zenara ANDA product and CIPLA ANDA product



before the United States District Court at Delaware.

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24. It is not in dispute that in so far as India is concerned, the respondent is having contractual relationship with Zenara and CIPLA, pertaining to manufacture and sale of the special drug manufactured and sold by Zenara and CIPLA. Zenara and CIPLA are the defendants in the suit filed by the petitioners before the United States District Court at Delaware.

25. The Hague Evidence Convention relied upon by the petitioners, to which India is a signatory, facilitates access to evidence in foreign jurisdiction, if certain jurisdiction based conditions are met. Letters Rogatory is often the first step in the discovery of documents from foreign jurisdiction.

26. Chapter I of the Hague Evidence Convention, 1970 deals with Letter of Request. Article 3 states that a Letter of Request shall specify the evidence sought for. Clause (d) of Article 3 states that Letter of Request shall specify the evidence to be obtained or other judicial Act to



be performed. Clause (g) of Article 3 states that a Letter of Request, where appropriate, shall specify the documents or other property, real or personal to be inspected.

27. Article 9 of the Hague Evidence Convention permits a judicial authority that executes a Letter of Request to apply its own municipal laws. In India the enabling power to execute the Letter of Request issued by a foreign Court is under Order XXVI Rule 19 - 22 read with Section 78 of the C.P.C., 1908.

28. Order XXVI Rule 19 - 22 of C.P.C. as well as Section 78 of the C.P.C. are extracted hereunder:

"19. Cases in which High Court may issue commission to examine witness.—(1) If a High Court is satisfied.—

(a) that a foreign court situated in a foreign country wishes to obtain the evidence of a witness in any proceeding before it,

(b) that the proceeding is of a civil nature, and

(c) that the witness is residing within the limits of the High Court's appellate jurisdiction, it may, subject to the provisions of rule 20, issue a



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commission for the examination of such witness.

(2) Evidence may be given of the matters specified in clause (a), (b) and (c) of sub-rule (1)—

(a) by a certificate signed by the consular officer of the foreign country of the highest rank in India and transmitted to the High Court through the Central Government, or

(b) by a letter of request issued by the foreign Court and transmitted to the High Court through the Central Government, or

(c) by a letter of request issued by the foreign court and produced before the High Court by a party to the proceeding.

20. Application for issue of commission.—*The High Court may issue a commission under rule 19—*

(a) upon application by a party to the proceeding before the foreign court, or

(b) upon an application by a law officer of the State Government acting under instructions from the State Government.

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 the witness resides within the*



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local limits of [the ordinary original civil jurisdiction of the High Court], to any person whom the Court thinks fit to execute the commission.

22. Issue, execution and return of commissions, land transmission of evidence to foreign Court.—

The provisions of rules 6, 15, [sub-rule (1) of rule 16A, 17, 18 and 18B] of this Order in so far as they are applicable shall apply to the issue, execution and return of such commissions, and when any such commission has, been duly executed it shall be returned, together with the evidence taken under it, to the High Court, which shall forward it to the Government General in Council along with the letter of request for transmission to the foreign court.] "

"78. Commissions issued by foreign Courts.—

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



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of the Central Government outside India; or
(c) Courts of any State or country outside India."

29. Article 23 provides that a contracting State may at the time of signature, ratification or accession, declare that it will not execute a Letter of Request issued for the purpose of obtaining pre-trial discovery of documents as known in Common Law Countries. India in its declaration has stated that "The Republic of India will not execute Letter of Request issued in pursuance of Article 23 of the Convention for the purpose of obtaining pre-trial discovery of documents, which requires a person to produce any documents other than particular documents specified in the Letter of Request, which are likely to be in his possession, custody or power".

30. When evidence of a witness residing in India has to be taken in a civil proceeding pending before a foreign court, a commission is issued by the High Court to obtain evidence of a witness under Order XXVI Rule 19 read with Section 78 of the Code of civil procedure, 1908. If the ingredients of the said Rule 19 are fulfilled, the High Court will issue a commission for the purpose of obtaining evidence/testimony of



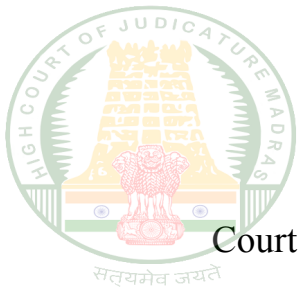
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witnesses in accordance with the Letter of Request issued by the Foreign

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31. The High Court will issue a commission under Order XXVI Rule 19 of C.P.C. upon an application preferred by a party to the proceedings before the Foreign Court. Under Rule 19, if the High Court on perusal of the application finds that a foreign Court situated in a foreign country wishes to obtain the evidence of a witness in any proceeding before it, that the proceeding is of civil nature and the witness is residing within the High Court's local jurisdiction, it must issue a commission in furtherance of and to execute the Letter of Request. The High Court will not go into the propriety of the Letter of Request or the questions of relevance or admissibility of evidence, which is an exclusive prerogative of the Foreign Court which has issued the Letter of Request.

32. After considering the relevant provisions of Code of Civil Procedure, 1908 and the definition of 'Evidence' in the Indian Evidence Act, 1872, it can be construed that the commission appointed by a High



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Court on request of a Foreign Court on the basis of a Letter of Request

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19 read with Section 78 of the Code of Civil Procedure, 1908 would be for obtaining both oral as well as documentary evidence.

33. The word evidence cannot be narrowly construed in isolation, ignoring the meaning and definition of the term 'evidence' under the Indian Evidence Act. Any other Interpretation that limits the evidence to be obtained under Order XXVI Rule 19 is arbitrary and contrary to Order XXVI Rule 19 of the Code of Civil Procedure, 1908. Such a narrow construction of the term 'evidence' used in order XXVI Rule 19 of the Code of Civil Procedure, 1908 defeats the very purpose of obtaining evidence if the same cannot be backed by documentary evidence. There is no provision in the Code of Civil Procedure, 1908 that would limit or not permit documentary evidence to be obtained at the behest and request of a Foreign Court under Order XXVI Rule 19 read with Section 78 of the Code of Civil Procedure, 1908.



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34. There is an inherent contradiction within Order XXVI Rule 19 of the Code of Civil Procedure, 1908, which widens the scope of evidence that can be obtained under the above-mentioned Rule. Rule 19 uses the phrase 'High Court may issue to examine witnesses' and 'wishes to obtain evidence of a witness...'. When two interpretations are possible, the more liberal interpretation which is in consonance with the Hague Evidence Convention needs to be followed. Therefore, Rule 19, has to be liberally construed and a High Court may issue a commission to obtain both oral as well as documentary evidence.

35. The Andhra Pradesh High Court, the Bombay High Court and the Delhi High Court have rightly allowed similar reliefs for enforcement of Letters Rogatory issued by a foreign Court. However, with due respect to the Gujarat High Court, this Court is of the considered view that the view taken by the Gujarat High Court in the case of Leighton International Limited and Others Vs. Gavin John Hodge and Others reported in 2014 SCC Online Guj 15738 and in the case of Fenix

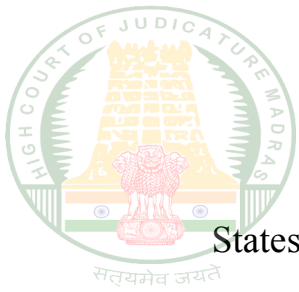


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Diamonds LLC Vs. Carnegie Institute of Washington reported in 2020

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SCC Online Guj 1628 that only oral evidence is permissible, is not a correct view. Both oral and documentary evidence can be procured from the Indian party, provided the evidence sought for is not in violation of the Hague Evidence Convention. The only objection raised by India as a signatory to the Hague Evidence Convention under Article 23 of the said convention is that they will not execute Letter of Request issued in pursuance of Article 23 of the Convention for the purpose of obtaining pre-trial discovery of documents, only in cases where the documents are not specified. In the case on hand, documents have been specified in the Letters Rogatory issued by the United States District Court at Delaware, though the respondent may contend that they are vague. Whether the documents disclosed are specific and procurable or not, can be ascertained only after a Commissioner is appointed by this Court who is empowered to seek for clarification from both the parties if the need arises for the purpose of ascertaining the specificity of the documents. Such an objection with regard to vagueness cannot be raised by the respondent at this premature stage that too when documents have been disclosed in these petitions, which were also considered by the United



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States District Court at Delaware before granting Letters Rogatory as per

the Hague Evidence Convention as requested by the petitioners.

36. The U.S. Supreme Court in its decision rendered in *Aerospatiale* case (*Societe Nationale Industrielle Aerospatiale Vs. United States District Court for the Southern District of Iowa*) reported in 482 U.S. 522 (1987), also relied upon by the learned senior counsel for the respondent has made it clear that the foreign Courts should scrutinize request for issuance of Letters Rogatory on a case to case basis to determine whether they satisfy international comity (i.e., there is no violation of courtesy to the foreign valuation).

37. As seen from the Hague Evidence Convention, good cause for denying the request of the Courts in the Country where the main litigation is being pursued may exist where the disruption to international comity outweighs the value of the requested information in furthering justice. But, it has been made clear in the aforesaid decision of the US Supreme Court which has followed Hague Evidence Convention that where requests for international discovery properly balances

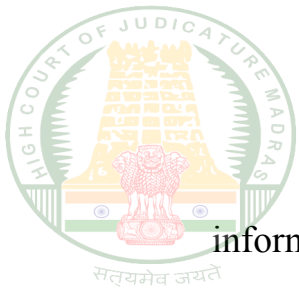


consideration of comity, Letters Rogatory is a valuable tool for seeking collection of evidence.

38. Analysing international comity requires Courts to weigh the relevant Costs and benefits that pursuing discovery will bestow on each party.

39. The U.S. Supreme Court in *Aerospatiale* case referred to supra, presented five factors that Courts can consider to weigh the international comity considerations:

- a) The importance to the litigation of the documents or other information requested;
- b) The degree of specificity of the request;
- c) Whether the information originated in the United States;
- d) The availability of alternative means of securing the information; and
- e) The extent to which non-compliance with the request would undermine important interests of the United States, or compliance with the request would undermine important interests of the State where the



information is located.

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40. In the case on hand, a categorical plea has been taken by the petitioners that the respondent is having all the information pertaining to the documents sought for through the Letters Rogatory issued by the United States District Court at Delaware. Admittedly, Zenara and CIPLA, the defendants in the patent litigation pending before the United States District Court at Delaware are Indian entities. A categorical assertion has also been made by the petitioners that the documents disclosed in the Letters Rogatory issued by the United States District Court at Delaware are available only with the respondent. The learned senior counsel for the respondent during the course of the submissions made a submission that the documents listed out in the Letters Rogatory are vague and unless there is specificity, the question of allowing these petitions does not arise. On the other hand, the learned senior counsel for the petitioners would submit that there is no vagueness in the listed documents and if at all a clarification is required, once a Court Commissioner is appointed by this Court, he can seek for clarification. Therefore, at this stage, the objections raised by the respondent in respect



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of their claim, that there is no specificity in the documents disclosed in the Letters Rogatory is not maintainable. The petitioners have also taken a categorical plea that the only source for them to inspect the documents disclosed in the Letters Rogatory is only through the respondent. The said statement has also not been disproved by the respondent through any documentary evidence to prove their contention that there are other sources available to the petitioner through whom the documents listed out in the Letters Rogatory can be accessed.

41. No iota of evidence has also been placed by the respondent to prove that the petitioners can source the documents in the United States itself and that there is no necessity to seek for production of documents by the respondent which is an Indian entity with the assistance of Indian Courts.

42. The petitioners have also categorically pleaded that the Indian National Security interest will not be undermined if the prayer sought for in these petitions are granted. The respondent has also not submitted any iota of evidence that the production of documents by the respondent will



be detrimental to the national security interest of India.

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43. The petitioners have also categorically pleaded that they do not have any claim against the respondent and the only limited relief they are seeking before this Court is to seek for the evidence sought for in these petitions, which according to the petitioners, are available only with the respondent.

44. Article 12 of the Hague Convention, which has been relied upon by both the senior counsels provides for limited grounds when execution of Letters Rogatory issued by a foreign Court can be refused by the state of execution and the state of execution in the present case is India and they are

a) In the state of execution, the execution of the Letter of request does not fall within the functions of the judiciary or;

b) The state addressed considers that its sovereignty or security would be prejudiced thereby.

45. The request of the petitioners does not fall under any of the



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above mentioned categories stipulated under Article 12 of the Hague Evidence Convention. Hence, there is no prohibition for this Court to allow these petitions filed under Order XXVI Rule 16 to 22 read with Sections 75 to 78 and 151 of C.P.C.. The Letters Rogatory issued by the United States District Court at Delaware in favour of the petitioners are also in complete compliance with the Hague Convention dated 18.03.1970, to which both India and United States are signatories and India has also ratified it in the year 2007 itself.

46. The petitioners' patent litigation before the United States District Court at Delaware involves entities in India with whom the respondent is having a contractual relationship. The petitioners categorically claim that they have been unable to access the sought for documents in United States of America and only due to the same, they are constrained to seek for international judicial assistance through the issuance of Letters Rogatory by the United States District Court at Delaware. The aid rendered by one nation to judicial or quasi-judicial proceeding in another Country's Tribunal / Courts is called international judicial assistance.



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47. The issuance of Letters Rogatory are designed to remedy the problems faced to procure testimony from an absent or a non-resident witness and the said testimony is essential for proving the case of the party seeking for issuance of Letters Rogatory. The Letters Rogatory are the medium in effect, whereby one Country can through it's own Courts and the methods of Court proceedings peculiar thereto and entirely within the latter's control to assist the administration of justice in the former Country: such request being made and usually granted by reasons of comity existing between nations in ordinary peaceful time. India and United States of America, being signatories to the Hague Convention, 1970, which provides for international judicial assistance and there being no prohibition as per the said convention for this Court to accede to the Letters Rogatory issued by the United States District Court at Delaware in favour of the petitioners, necessarily this Court will have to allow these petitions as prayed for by the petitioners.

48. The International Comity of Courts, which has strengthened



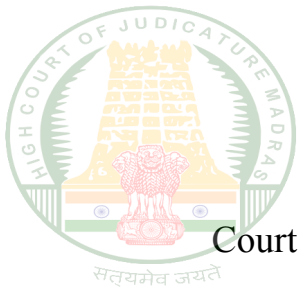
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through the Hague Convention, 1970, mandates this Court to allow these petitions as prayed for by the petitioners.

49. The petitioners have been unable to procure the evidence as sought for in these petitions from the defendants in the litigation pending before the United States District Court at Delaware. A categorical assertion has also been made to that effect in the pleadings of the petitioners. No contra evidence has also been produced by the respondent to prove that the petitioners can source the evidence in United States of America itself. Admittedly, the respondent is also having a contractual relationship in India with Zenara in respect of Zenara's ANDA Product. Therefore, issuance of Letters Rogatory is virtually the only effective procedure available to the petitioners for procuring the evidence as sought for in these petitions.

50. The petitioners have satisfied, through its pleadings and supporting documents, the following:

a) The importance of the documents / evidence sought for from the respondent to the litigation pending before the United States District



Court at Delaware;

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b) The details of the documents which have been sought for by the petitioners are disclosed, though the respondent claims that they are vague. However, this Court is of the considered view that specificity can be ascertained only when a Commissioner is appointed by this Court and if the need arises, he / she seeks for a clarification with regard to the specificity;

c) Both India and Unites States of America are signatories to the Hague Convention, 1970 and they are bound by the said convention. Unless and until the request does not fall within the powers of this Court or the Indian state considers that its sovereignty or security would be prejudiced if the Letters Rogatory issued by the United States District Court at Delaware is acceded to, the question of not granting the reliefs prayed for in these petitions does not arise. Admittedly, the request of the petitioners does not fall under any of the aforementioned prohibitions;

d) Admittedly, as seen from the pleadings and the evidence placed on record, it is also confirmed from the Letters Rogatory issued by the United States District Court at Delaware that there is no availability of alternative means of securing the information as sought for in these



petitions by the petitioners except to approach this Court.

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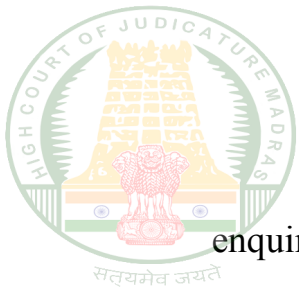
51. Eventhough the respondent alleges that the documents sought for by the petitioners are already in possession of CIPLA, the said statement is not supported by any evidence. In paragraph No.8 of the counter statement filed by the respondent before this Court, they have stated that they are in possession of the documents pertaining to CIPLA ANDA product, which is the subject matter of patent litigation before the United States District Court at Delaware. The fact that no evidence has been placed on record to prove that the documents sought for by the petitioners are already in possession of CIPLA and the fact that in paragraph No.8 of the counter statement filed by the respondent before this Court, the respondent has stated that they are in possession of the documents pertaining to CIPLA ANDA product, which is the subject matter of patent litigation before the United States District Court at Delaware makes this Court to infer that the documents sought for by the petitioners through the Letters Rogatory issued by the United States District Court at Delaware are only in the possession of the respondent, which is an Indian entity.



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52. The confidentiality of the information sought for by the petitioners from the respondent is fully protected since the United States District Court, Delaware, in the Letters Rogatory order dated 13.05.2024 has made it clear that each party is bound by the terms of the stipulated protective order. The protective order has categorically stated that any confidential information produced by the respondent will be used for the purpose of the U.S. litigation only and will not be publicly disclosed. To ensure confidentiality of documents / testimonies, the petitioners in their petitions have themselves sought for the formation of a confidentiality club. Therefore, once the confidentiality club is formed, all the members of the said club will be required to sign an undertaking, which forms part of the protective order passed by the United States District Court, Delaware along with the Letters Rogatory order dated 13.05.2024.

53. Article 39 of the TRIPS agreement does not prohibit disclosure of confidential information, if it is sought for by a Court of law. The Courts in India would not go behind the letter of request upon an



enquiry, as the jurisdiction for the issuance of letter of request has to be accepted and executed owing to reciprocity between two sovereign countries.

54. The International Comity of Courts is a principle that requires Courts to consider the interest of other jurisdictions when making legal decisions. It involves balancing the competing interest of the public and private and take into account any conflicts between the public policies of the domestic and foreign countries. Since the Letters Rogatory issued by the United States District Court, Delaware is not in conflict with the municipal law of India and the implementation of the Letters Rogatory aids in adherence to international treaties, which in the instant case is the Hague Evidence Convention to which India is a signatory, necessarily the relief sought for in these petitions has to be granted by this Court in the interest of International Comity of Courts. Though the respondent may contend that the petitions lack specificity with regard to the particulars of the documents, the question of raising such an objection at this stage is too premature and if at all such an objection can be raised, it can be raised only after a Court commissioner is appointed as sought for



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by the petitioners in these petitions. The Court commissioner on his/her appointment can seek for clarification from the petitioners or through any other source with regard to the specificity of the documents in case there is no clarity and the respondent can also assist the Court commissioner to decide as to whether the particulars of the documents sought for by the petitioners are procurable or not.

55. In the decisions of the Gujarat High Court, relied upon by the learned senior counsel for the respondent, referred to supra, they were decisions when the Court Commissioners were already appointed by the Gujarat High Court pursuant to a Letters Rogatory issued by a foreign Court. In the case on hand, the Court Commissioner is yet to be appointed and in these petitions, the petitioners seek for appointment of a Court Commissioner to execute the Letters Rogatory issued by the United States District Court, Delaware. Therefore, the Gujarat High Court's decision has no bearing to the facts of the instant case.

56. The decisions of the Delhi High Court, Andhra Pradesh High Court and Bombay High Court relied upon by the learned senior counsel



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for the petitioners have elaborately discussed the powers of an Indian Court with regard to the execution of Letters Rogatory issued by a foreign Court and they have consistently held that unless the Letters Rogatory violates the Indian domestic law, the question of refusing to grant an order for execution of the Letters Rogatory by the Indian Courts does not arise. In the case on hand, as observed earlier, there is no violation of the Indian Laws if these petitions are allowed as prayed for.

57. The confidentiality of the documents to be produced by the respondent is also fully protected by the formation of a confidentiality club as agreed to by the petitioners before the United States District Court, Delaware, which has also been incorporated in the Letters Rogatory order dated 13.05.2024.

58. These petitions have been filed only for the limited extent of executing the Letters Rogatory issued by the United States District Court at Delaware. The rejection of patent applications of the petitioners by the Indian Patent Office has no relevance for adjudicating these petitions. These petitions are not in contravention to Indian Laws and they are



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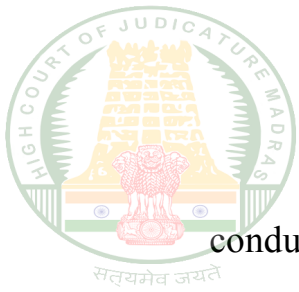
being entertained by this Court only in accordance with the Hague Evidence Convention and by adhering to the International Comity of Courts.

59. For the foregoing reasons, it is just and necessary for this Court to issue the following directions:

a) A 'confidentiality club' as prayed for in these petitions will have to be set up by this Court on the following lines:

(i) An agreement signed between the parties to the proceedings as well as the party from whom evidence and testimony is sought to be collected to the effect that the (a) pleadings, (b) the Letters Rogatory along with all annexures and (c) the information, documents, evidence, samples, etc. that may be collected pursuant to executing the Letters Rogatory be only seen by a limited number of people on each side. All of these people are bound by confidentiality undertakings in relation to the information/documents stipulated hereinabove.

(ii) The hearings in the instant matter before this Hon'ble Court as well as before the Local Commissioner who may be appointed are



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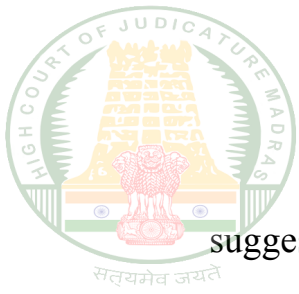
conducted in camera only with the members of the Confidentiality Club

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(iii) Directing the Learned Registrar General of this Court as well as the Local Commissioner to keep the original Letters Rogatory, all other documents, transcripts of deposition etc. pertaining to the instant case in sealed covers and allow access to the confidential documents only to the members of the Confidentiality Club identified above.

(iv) That the Registrar General of this Court as well as the Local Commissioner be empowered to de-seal the documents for inspection by members of the Confidentiality Club in his presence, on a formal request being made by either party to the Registrar General or Local Commissioner with simultaneous intimation to the other members of the Confidentiality Club who have the option to remain present for such inspection. The documents shall be resealed thereafter by the Registrar General or the Local Commissioner as the case may be."

60. The learned counsel for the Petitioners on instructions



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suggested the following names to be part of the Confidentiality Club:

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A. Petitioners' representatives:

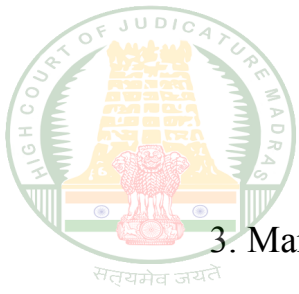
1. Michele Winneker
2. Jeffrey Rennecker

B. Petitioners' foreign counsels:

1. Thomas H.L. Selby
2. Stanley E. Fisher
3. Seth R. Bowers
4. Andrew L. Hoffman
5. Rhochelle Krawetz
6. Max C. Accardi
7. Megan E. Dellinger
8. Ayelet Evrony

C. Petitioners' foreign experts:

1. Adam Matzger
2. Shellie Rigby-Singleton



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3. Martyn Davies

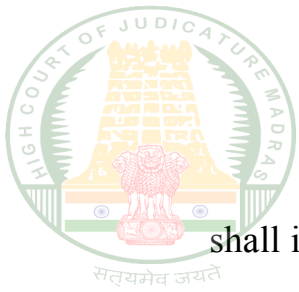
D. Petitioners' local counsels:

1. Mr. Pravin Anand
2. Ms. Tusha Malhotra
3. Mr. K. Prem Chandar
4. Mr. N.C. Vishal
5. Ms. Tanvi Bhatnagar

E. Respondent's foreign counsels:

1. Neal C. Belgam
2. Daniel A. Taylor
3. Louis H. Weinstein
4. Frank Rodriguez
5. Amlan Ray
6. Joshua I. Miller

F. Respondent's local counsels: Names to be provided by the respondent to the local Commissioner appointed by this Court and on furnishing the names, the local Commissioner appointed by this Court



shall include them also as members of the Confidentiality Club.

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If the parties wish to nominate more members to the confidentiality club, the same may either be done by mutual consent or by way of an application to either this Court or the appointed Local Commissioner.

61. Once the confidentiality club is in place, the Petitioners can place the original in a sealed cover before this Court and also share a copy of the complete version of the Letters Rogatory dated May 13, 2024 with all the members of the Confidentiality Club.

62. The Petitioners made the following prayers in paragraph 24 of the respective petitions:

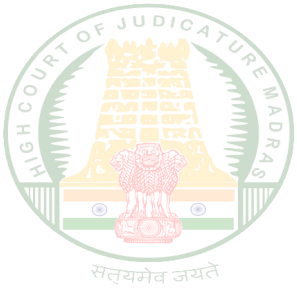
(i) an order appointing a Local Commissioner, preferably a senior person having good knowledge in the field of Chemistry such as a retired Professor or a District Judge for collection of evidence, documents (as mentioned in Clause 11 and Schedule A to the Letters Rogatory) as well as for obtaining and 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

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(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, and



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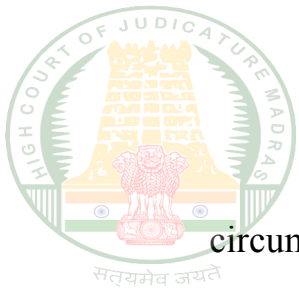
WEB COPY (iii) an order setting up a Confidentiality Club on the lines stated in paragraph 13 of the petitions; and

(iv) an order to conduct the further proceedings before this 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 Court as well as the Commissioner to keep all the documents and records pertaining to this petition 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 United States District Court for the District of Delaware in a sealed cover; and

(vii) such further Order(s) as this Court deems fit and proper in the



circumstances of the case may also be passed."

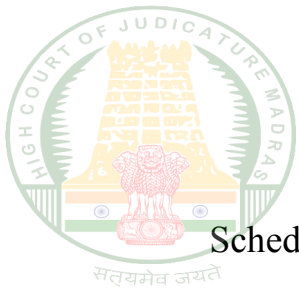
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63. As the present matter may require a certain level of technical expertise in the Commissioner himself, the Petitioners have sought for appointment of a person well versed in the field to be appointed as the local commissioner.

64. For the foregoing reasons, these petitions are allowed and the following directions are issued by this Court:

a) Within a period of 2 weeks from the date of receipt of a copy of this order, the Respondent is directed to designate the person(s) who shall depose and give testimony regarding the subjects identified in Schedule B to the Request for International Judicial Assistance (Letters Rogatory) dated May 13, 2024;

b) Ms.Vindhya S.Mani, having wide experience in the subject matter, and having office at No.6, 5th floor, M/s.Lakshmi Kumaran and Sridharan Attorneys, Chennai House, Esplanade Road, Chennai - 108, Mobile No.83769 51693 is appointed as a local Commissioner for collecting evidence, including documentary evidence as mentioned in



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Schedule A to the Letters Rogatory, and also for obtaining and recording the testimony and depositions from the person(s) designated by the Respondent as mentioned in Schedule B to the Letters Rogatory. Ms.Vindhya S.Mani is required to adhere to the terms of the protective order dated December 15, 2023;

c) Ms.Vindhya S.Mani, the appointed Commissioner is conferred with "Special Powers' including the power to -

i. Summon a person to produce documents and things as per Schedule A to the Letters Rogatory, which shall be done as per the schedule set by the appointed Commissioner and should be at least three weeks prior to the commencement of the testimony;

ii. Accept copies of the said documents and things, and provide the same to the members of the confidentiality club from the Petitioner's side;

iii. Set the schedule for the collection of the testimony of the Respondent's witness on a day-to-day basis;

iv. Decide to collect evidence based on the digitized files of the court record and as collected from the Court;



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v. Summon a person, to administer oath to her/him and to record his/her evidence.

vi. Allow the Petitioners' and Respondent's respective Indian counsel the opportunity to examine or cross-examine the aforesaid person;

vii. To record the objections, if any, of the parties and conclude, without delay, the testimony of the witness nominated by the Respondent. To not stall the testimony of the witness, once started, for technical grounds and reasons. It is clarified, that the questions, as asked should be recorded along with the answers given;

viii. Permit the Petitioners' and Respondent's respective foreign representatives to attend and observe the examination of the said person;

ix. Video record the testimony of the said person;

x. Have the said recording transcribed verbatim;

xi. Provide both the documents and recording and the transcript to the Petitioners and Respondents respective representatives and their Indian Counsels;

d) A 'Confidentiality Club' is set-up by this Court consisting of the



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persons stated in Paragraph 60 above and on the terms set out in paragraph 13 of the petition; and

e) All proceedings before Ms.Vindhya S.Mani will be in camera with only the members of the 'Confidentiality Club' being present; and

f) The Registrar (Original Side), Madras High Court, is directed to keep all documents and records pertaining to these petitions or the matters arising therefrom, including the evidence collected by Ms.Vindhya S.Mani under seal. They shall allow access to those documents only to the members of the Confidentiality Club.

g) The venue of collecting evidence and recording testimony of the respondent shall be at the Arbitration Centre, Madras High Court and the Cost of Arbitration Centre as well as the secretarial expenses shall be borne by the petitioners;

h) Ms.Vindhya S.Mani, to conduct proceedings as per the above terms and send the evidence/ documents collected and the testimony



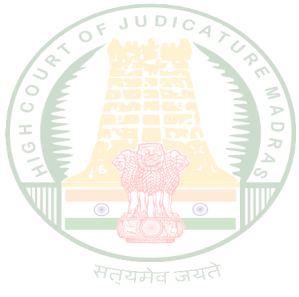
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recorded to the Registrar General of this Court who would then forward
it to the United States District Court for the District of Delaware in a
sealed cover.

i) Ms.Vindhya S.Mani shall be paid an initial remuneration of
Rs.2,00,000/- and the same shall be paid by the petitioners within a
period of one week from the date of receipt of a copy of this order. The
Commissioner is also permitted to seek additional remuneration once the
work is completed.

28.01.2025

Index: Yes/ No
Speaking order / Non speaking order
Neutral citation : Yes
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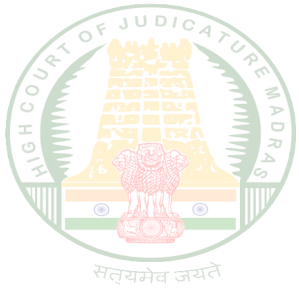
ABDUL QUDDHOSE, J.

WEB COPY After pronouncement of the order at 10.30 a.m., a mention was made by the learned counsel for the respondent at 12.30 p.m. informing this Court that the local commissioner appointed by this Court has appeared for one of the parties in a connected matter and therefore, the name of the local commissioner will have to be changed. This Court suggested the name of Mr.Adarsh Ramanujam as local commissioner in the place of Ms.Vindhya S.Mani, which was agreeable to both the counsels. Accordingly, Mr.Adarsh Ramanujam, having office at No.6, Ground Floor, Ram's Flat, 2nd Main Road, Gandhi Nagar, Adyar, Chennai - 600 020, Mobile No.99999 84703, is appointed as local Commissioner. The replaced commissioner shall adhere to the same directions given by this Court in the preceding paragraphs.

28.01.2025

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Note: Office is directed to issue order copy by today itself.



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ABDUL QUDDHOSE, J.
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pre-delivery order in O.P. (PT) Nos.5 and 6 of 2024

28.01.2025