

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

COSMO TECHNOLOGIES LIMITED, :
VALEANT PHARMACEUTICALS :
INTERNATIONAL, and VALEANT :
PHARMACEUTICALS LUXEMBOURG :
S.A R.L., :

Plaintiffs, :

v. :

ACTAVIS LABORATORIES FL, INC., :

Defendant. :

PUBLIC VERSION RELEASED
SEPTEMBER 2, 2016

C.A. No. 15-164-LPS

COSMO TECHNOLOGIES LIMITED, :
VALEANT PHARMACEUTICALS :
INTERNATIONAL, and VALEANT :
PHARMACEUTICALS LUXEMBOURG :
S.A R.L., :

Plaintiffs, :

v. :

ALVOGEN PINE BROOK, LLC, :

Defendant. :

C.A. No. 15-193-LPS

MEMORANDUM ORDER

1. On May 5, 2016, Defendants Actavis Laboratories FL, Alvogen Pine Brook, LLC, and Par Pharmaceutical, Inc.¹ (collectively, "Defendants") brought a motion for the Issuance of a

¹Par Pharmaceutical has since settled its case with Plaintiffs. (See C.A. No. 15-116 D.I. 160)

Letter of Request for International Judicial Assistance Pursuant to the Hague Convention on Taking Evidence Abroad (“Rogatory Motion”). (D.I. 115)² Plaintiffs Cosmo Technologies Ltd., Valeant Pharmaceuticals International, and Valeant Pharmaceuticals Luxembourg S.a r.l (collectively, “Plaintiffs”) opposed the motion. (D.I. 126) Briefing was completed on June 2. (See D.I. 136)

2. Defendants’ Rogatory Motion asks the Court to seek the assistance of Italian authorities in compelling the testimony of Lorenzo Fossati, an Italian citizen residing in Italy. (D.I. 115) Mr. Fossati is a named inventor on all of the patents-in-suit in this Hatch-Waxman case. Plaintiffs disclosed Mr. Fossati in their initial Rule 26 disclosures as a person having relevant information. (See D.I. 20) Defendants wish to depose Mr. Fossati regarding his role in conceiving and reducing to practice the patented inventions, as well as in developing the Plaintiffs’ drug product, which Plaintiffs claim is a commercial embodiment of the patents-in-suit. (D.I. 115 ¶ 4)

3. “A party which seeks the application of the Hague [Evidence] Convention procedures rather than the Federal Rules [of Civil Procedure] bears the burden of persuading the trial court[] of the necessity of proceeding pursuant to the Hague Evidence Convention.” *Tulip Computers Int’l B.V. v. Dell Computer Corp.*, 254 F. Supp. 2d 469, 474 (D. Del. 2003) (internal quotation marks omitted). Judges in this District have stated that this burden is “not great” because the “Convention procedures are available whenever they will facilitate the gathering of evidence by the means authorized in the Convention.” *Id.* (citing *Societe Nationale Industrielle Aerospatiale v. U.S. Dist. Court for S. Dist. of Iowa*, 482 U.S. 522, 541 (1987)).

²All docket citations in this motion refer to C.A. No. 15-164-LPS, unless otherwise noted.

4. On June 29, 2016, after Defendants deposed the other inventors named on the patents-in-suit, Defendants filed a Motion for Leave to File a Supplemental Memorandum in Support of their Rogatory Motion (“Motion to Supplement”). (D.I. 147) Plaintiffs opposed the motion. (D.I. 157) Briefing on the Motion to Supplement was completed on July 28. Having reviewed the parties’ briefing, the Court concludes that Defendants’ Supplemental Memorandum, which presents evidence discovered after the parties’ initial briefing on the Rogatory Motion, will assist the Court in evaluating whether Mr. Fossati’s deposition will be duplicative of earlier discovery – a point put in contention by Plaintiffs’ opposition to the Rogatory Motion. *See generally St. Clair Intellectual Prop. Consultants, Inc. v. Samsung Elecs. Co.*, 291 F.R.D. 75, 80 (D. Del. 2013) (“A Court may grant leave to file a sur-reply if it responds to new evidence, facts, or arguments.”). Accordingly, **Defendants’ Motion to Supplement (D.I. 147) is GRANTED**, the Supplemental Memorandum is deemed filed, and the Court will consider the facts and arguments presented therein in its evaluation of Defendants’ Rogatory Motion.

5. Defendants argue that they need to depose Mr. Fossati because he “is likely to have exclusive, unique and important information regarding the inventions claimed in the asserted patents that would not be duplicative of information held by the Cosmo witnesses already deposed.” (D.I. 147-1 at 4) [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] Thus, although Defendants have had the opportunity to depose the other inventors on the same list of topics as they have listed in their

Letter of Request regarding Mr. Fossati, his testimony is unlikely to be duplicative of evidence Defendants obtained from the other inventors. Nor is his testimony likely to be duplicative of documentary evidence already available to Defendants. Defendants argue, and Plaintiffs do not contest, that Plaintiffs' document production includes few documents related to Mr. Fossati (other than copies of the patents-in-suit that name him as an inventor). (D.I. 136 at 10)

6. Plaintiffs argue that the Court should nevertheless deny Defendants' Rogatory Motion because it is untimely. Defendants do not deny that they filed their Rogatory Motion late in the discovery process. However, they explain that they did so because they were uncertain as to whether such a deposition would be necessary until after Plaintiffs completed their document production. (D.I. 136 at 8) Having reviewed Defendants' account of their discovery activities related to Mr. Fossati (*see* D.I. 136 at 7-9), the Court finds that Defendants acted reasonably given the circumstances (including the Court's interest in avoiding unnecessary discovery under Hague Convention procedures). Therefore, the Court finds that Defendants' Rogatory Motion is not untimely.

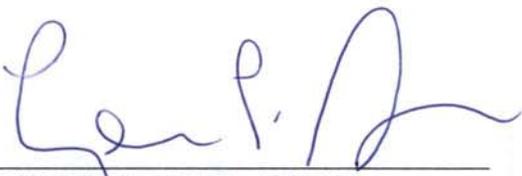
7. Plaintiffs further argue that the Court should deny Defendants' Rogatory Motion because Plaintiffs will be prejudiced by need to devote additional time and money to conducting a deposition in Italy after the close of fact discovery, as well as the need to prepare to address the deposition at trial. Though not trivial concerns, the Court finds that the prejudice to Defendants if they are denied the opportunity to take Mr. Fossati's deposition outweighs the potential prejudice of which Plaintiffs complain. Furthermore, the parties have recently agreed to extend certain dates, such that fact discovery just recently ended, expert discovery does not begin until September 15, 2016, and trial is not until May 2017. (D.I. 139 at 3; D.I. 126 at 7) Under the

circumstances, the Court is confident that the additional discovery being ordered will not prove unduly burdensome on Plaintiffs.

8. Accordingly, **Defendants' Rogatory Motion (D.I. 115) is GRANTED.**

Because this Memorandum Order has been issued under seal, the parties shall meet and confer and shall, **no later than September 1, 2016**, propose redactions to it. Thereafter, the Court will issue a publicly-available version.

August 31, 2016
Wilmington, Delaware



HON. LEONARD P. STARK
UNITED STATES DISTRICT JUDGE