IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

ABBOTT LABORATORIES, an Illinois corporation, FOURNIER INDUSTRIE ET SANTE, a French corporation, and LABORATORIES FOURNIER S.A., a French corporation,	)	
Plaintiffs,	)	
v.	)	Civil Action No. 03-120-KAJ (Consolidated)
IMPAX LABORATORIES, INC., a Delaware corporation,	)	
Defendant.	)	

MEMORANDUM ORDER

I. INTRODUCTION

Presently before me is a motion by defendant Impax Laboratories, Inc. ("Impax") requesting international judicial assistance to take discovery in this case, pursuant to Federal Rule of Civil Procedure 28(b).[1] (Docket Item ["D.I."] 100; the "Motion".) Plaintiffs Abbott Laboratories ("Abbott"), Fournier Industrie et Sante, and Laboratories Fournier, S.A. (together, "Fournier") oppose the Motion. (D.I. 104.) For the following reasons, Impax's Motion will be granted.

II. BACKGROUND

This is a patent infringement case brought by Fournier, a French pharmaceutical company, and Abbott, an Illinois corporation, against Impax, a Delaware corporation.

[1]The Rule provides, in pertinent part, that "[d]epositions may be taken in a foreign country...pursuant to any applicable treaty or convention, or...pursuant to a Letter of Request.... A commission or a Letter of Request shall be issued on application and notice on terms that are just and appropriate...." Fed. R. Civ. P. 28(b) (2004).

(*See* D.I. 1.) Abbott is the exclusive licensee of Fournier's U.S. Patent Nos. 6,074,670; 6,277,405; 6,589,552; and 6,652,881 (collectively, "the patents-in-suit"). (*Id.*; D.I. 104 at 1.) Generally, the patents-in-suit claim both fenofibrate pharmaceutical compositions having high bioavailability and the methods for preparing them. (*See* D.I. 1 and exhibits attached thereto.) Abbott and Fournier allege that Impax, a generic pharmaceutical company, is infringing the patents-in-suit. (*Id.*)

During the course of discovery, Impax learned that three people - Andre Stamm, Philippe Reginault, and Maurice Tendero - have information relevant to this litigation. (D.I. 100 at 1-2.) Dr. Stamm is a named inventor for each of the four patents-in-suit.[2] (D.I. 104 at 1.) Dr. Reginault provided a declaration relating to one of the patents-in-suit and is also a named inventor for a prior art patent[3] that formed the basis for rejections of the patents-in-suit during prosecution. (*Id.* at 1-2.) Mr. Tendero was involved during prosecution of the patents-in-suit, providing guidance as to how to overcome the prior art rejections. (*Id.* at 2.)

All three men are French citizens currently residing in France. (*Id.* at 2.) Neither Dr. Stamm, nor Dr. Reginault, nor Mr. Tendero are currently employed by Fournier, though Dr. Reginault and Mr. Tendero are former employees of that company. (D.I. 104 at 2; D.I. 113 at 1.) The parties agree that Dr. Stamm, Dr. Reginault, and Mr. Tendero, as French citizens who are third party witnesses, cannot be compelled to provide

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[2]Fournier does not dispute Impax's descriptions of Dr. Stamm, Dr. Reginault, and Mr. Tendero.

[3]Curtet, et al., U.S. Patent No. 4,895,726, "Novel dosage form of fenofibrate" (issued January 23, 1990).

evidence in the absence of compliance with the Hague Evidence Convention. (D.I. 100 at 2; D.I. 104 at 2.) Fournier concedes that "these three individuals may have some limited information of relevance to the litigation" (D.I. 104 at 2), but opposes Impax's Motion for letters of request so that Impax may depose Dr. Stamm, Dr. Reginault, and Mr. Tendero in France because "Impax has not sufficiently identified the scope of discovery it seeks to take from these individuals in direct violation" of the Hague Convention. (D.I. 104 at 2.)

III. DISCUSSION

Essentially, Fournier objects to the Motion because it feels that Impax's request to depose Dr. Stamm, Dr. Reginault, and Mr. Tendero is overly broad. (*Id.* at 3.) Impax should, Fournier argues, provide it with a "detailed statement of the subject matters to be covered during the proposed oral depositions of these third party witnesses." (*Id.* at 4-5.) In support of this argument, Fournier relies upon Articles 3(d) and 3(f) of the Hague Convention. (*Id.*)

In response, Impax says that the three witnesses are likely in possession of "an abundance of relevant information." (D.I. 113 at 1.) To support this assertion, Impax has, in its reply brief, set forth detailed reasons why it is seeking the depositions of Dr. Stamm, Dr. Reginault, and Mr. Tendero, citing to information it has obtained thus far in discovery. (*See id.* at 1-3.) For example, Impax points out that, as a named inventor for the patents-in-suit, Dr. Stamm's testimony is highly relevant, as it would be in any patent infringement case. (D.I. 113 at 1-2.) As to Dr. Reginault, Impax notes that he served as Fournier's director of pharmaceutical development until late 2003 or early 2004; is a named inventor for a prior art patent cited against the patents-in-suit; submitted a

Declaration in support of patentability for one of the patents-in-suit; and he met with Dr. Stamm regarding the subject matter of the patents-in-suit. (*Id.* at 2-3.) Impax also says that Mr. Tendero was the project manager responsible for "all aspects of Fournier's development of the alleged invention" and that he met with at least one of the named inventors of the patents-in-suit. (*Id.* at 3.) Impax further argues that Articles 3(d) and 3(f) of the Hague Convention do not require it to provide a specific outline of the questions it intends to pose to these witnesses at their respective depositions. (D.I. 113 at 5.)

The Hague Evidence Convention serves as an alternative or "permissive" route to the Federal Rules of Civil Procedure for the taking of evidence abroad from litigants and third parties alike. *See Societe Nationale Industrielle Aerospatiale v. United States District Court for the District of Iowa*, 482 U.S. 522, 538 (1987). As a threshold matter, I agree with the parties that application of the Hague Convention is appropriate here, as the witnesses are not parties to the lawsuit, have not voluntarily subjected themselves to discovery, are citizens of France, and are not otherwise subject to the jurisdiction of this court. *See Tulip Computers Int'l B.V. v. Dell Computer Corp.*, 254 F. Supp. 2d 469, 474 (D. Del. 2003). The United States and France are contracting states under the Hague Convention. *See* 28 U.S.C. § 1781.

A Letter of Request, or "letter rogatory", from a United States judicial authority to the competent authority in a foreign state is one of three available methods of taking evidence under the Hague Convention. *Id.* at 472 (citation omitted). Pursuant to the Hague Convention, a Letter of Request must provide the contracting state with certain information regarding the lawsuit and the information sought. *See id.* (citing Hague

Evidence Convention, 23 U.S.T. 2555, Art. 3). Specifically, Article 3(d) states that a Letter of Request shall specify "the evidence to be obtained or other judicial act to be performed." Hague Evidence Convention, 23 U.S.T. 2555, Art. 3(d) (1972). Article 3(f) provides that "[w]here appropriate, the Letter shall specify...the questions to be put to the persons to be examined or a statement of the subject matter about which they are to be examined...." *Id.*, Art. 3(f).

In this case, Impax has complied with Article 3(d) of the Hague Convention. Each of its proposed letters of request for Dr. Stamm, Dr. Reginault, and Mr. Tendero set forth a brief statement concerning the subject matter and relevance of the request and ask the appropriate authority in France to issue an order to compel these witnesses to appear at an oral deposition. (*See* D.I. 100, Exs. 2-4.) This satisfies the requirement of Article 3(d) that Impax specify the "the evidence to be obtained or other judicial act to be performed" in its Letters of Request. *See* Hague Evidence Convention, 23 U.S.T. 2555, Art. 3(d). Contrary to Fournier's assertions, Impax's discovery requests are not overly broad, rather, Impax's desire to depose these three witnesses, who were intimately involved in prosecution of the patents-in-suit is par for the course in any patent litigation.[4]

The language set forth in Article 3(f) of the Hague Convention is a conditional statement, beginning with the proviso "where appropriate," to modify the direction that questions be specified in advance in order to more clearly define what might otherwise

[4]In the event that Impax's questions exceed the proper scope of discovery in France, the French official present at the deposition will be able to stop or limit the questioning. *See Tulip Computers*, 254 F. Supp. 2d at 474-75.

be an unreasonable discovery request. *See, e.g.*, *Societe Nationale*, 482 U.S. at 545-46 and n.30 (trial court has the discretion to determine the "exact line between reasonableness and unreasonableness" of discovery requests "based on its knowledge of the case and of the claims and interests of the parties"). Fournier has not come forward with any persuasive reason why, in this case, it would be appropriate to require Impax to set forth the specific questions it intends to pose to Dr. Stamm, Dr. Reginault, and Mr. Tendero in their depositions. *See* Hague Evidence Convention, 23 U.S.T. 2555, Art. 3(f). On the contrary, it appears from Impax's Motion that these gentlemen may possess such a variety of relevant information that it is impracticable and would be counterproductive to require Impax to attempt a more detailed specification of the discovery it seeks.

IV. CONCLUSION

For these reasons, Impax's Motion (D.I. 100) is GRANTED. Impax is ORDERED to advise the court of the earliest date on which it is practicable for it to conduct its depositions of Dr. Stamm, Dr. Reginault, and Mr. Tendero and to provide the court with revised Letters of Request reflecting that date.

Kent A. Jordan
UNITED STATES DISTRICT JUDGE

Wilmington, Delaware
July 15, 2004