Federal Court  Cour fédérale

Date: 20190715

Docket: T-1163-18
Docket: T-1416-18
Docket: T-220-19

Citation: 2019 FC 942

Ottawa, Ontario, July 15, 2019

PRESENT: Case Management Judge Mireille Tabib

Docket: T-1163-18

BETWEEN:

BIOGEN CANADA INC.,
BIOGEN INTERNATIONAL GMBH
AND ACORDA THERAPEUTICS, INC.

Plaintiffs

and

TARO PHARMACEUTICALS INC.

Defendant

Docket: T-1416-18

AND BETWEEN:

BIOGEN CANADA INC.,
BIOGEN INTERNATIONAL GMBH
AND ACORDA THERAPEUTICS, INC.

Plaintiffs

and

APOTEX INC.

Defendant

Docket: T-220-19

AND BETWEEN:

BIOGEN CANADA INC.,
BIOGEN INTERNATIONAL GMBH
AND ACORDA THERAPEUTICS, INC.

Plaintiffs

and

PHARMASCIENCE INC.

Defendant

REASONS FOR ORDER

TABIB P.

[1] The Defendants in each of the above-mentioned actions brought a single motion to rule on objections and to compel answers to questions asked in the context of the follow-up round of their common examinations for discovery of the Plaintiffs' representatives. The Court ruled on most of the objections from the bench at the hearing, but reserved its decision in respect of two categories of questions. These questions essentially seek production of transcripts of depositions given by certain witnesses in the course of judicial and administrative proceedings in the United States.

[2] The Plaintiffs have objected to those questions on the basis that the Defendants' questions are not relevant, do not constitute proper follow-up and contravene the implied undertaking rule or protective orders issued in the US proceedings.

[3] The issues that require determination in respect of each category of questions are:

1) Whether the documents or information sought by the Defendants might constitute evidence of any unadmitted fact at issue in the actions, would contain information which may enable the Defendants to establish these facts, or would lead to such information enabling the Defendants to establish these facts.

2) Whether the questions constitute proper follow-up, that is, whether the questions arise from new information provided or documents delivered after the initial discovery, either through answers to undertakings or answers to questions initially objected to.

3) Whether production of the documents requested would breach any applicable protective order or any implied undertaking rule, such that the Court should decline to order the Plaintiffs to answer them.

I. The facts at issue in the actions

[4] These are actions for a declaration of infringement brought pursuant to section 6(1) of the *PM(NOC)Regulations*, in respect of certain claims of Canadian Patent 2,562,277 (‘277 Patent). The ‘277 Patent is owned by a Acorda Therapeutics Inc., one of the named Plaintiffs, and claims the use of certain compositions of 4-aminopyridine (referred to as fampridine) for improving walking or increasing walking speed in a subject with multiple sclerosis. In their respective

defences, the Defendants have alleged that the relevant claims of the ‘277 Patent are invalid as being anticipated or rendered obvious by, *inter alia*, the following two prior art references:

1) The “Goodman 1” poster: This is a “poster” used in a presentation which Dr. Goodman gave during a scientific conference in Baltimore in 2002. That poster presented the results of a study conducted by Dr. Andrew Goodman.

2) The Acorda S-1 document: This is a Registration Statement filed by Acorda with the US Securities and Exchange Commission in 2003 and which the Defendants allege contain information that inherently anticipates or renders obvious the relevant claims of the ‘277 Patent.

[5] Goodman 1 was put in evidence in the course of a trial before the United States District Court for the District of Delaware in respect of the validity of the corresponding US Patent to the ‘277 Patent (the “US Trial”). Information which the Defendants say is contained in Acorda S-1 was also put in evidence at the US Trial, although not the document itself. The US District Court eventually issued a judgment finding that the corresponding claims of the US Patent were obvious and that the information contained in Goodman 1 and Acorda S-1 was available to persons of ordinary skill in the art at the relevant date.

[6] Notwithstanding these findings, the Plaintiffs in these actions maintain that the two references were not publicly available at the relevant time, and put the Defendants to strict proof that they were.

[7] More specifically, the Plaintiffs’ position on the facts is that the version of the poster on which the Defendants rely and which was filed in evidence in the US Trial is not a true (but reduced-size) copy of the full-size poster used by Dr. Goodman at the Baltimore Conference, as

the Defendants allege and believe. Rather, the Plaintiffs take the position that it is but an internal draft poster from Acorda that was neither presented nor available to the public. The Plaintiffs assert that they do not have the actual poster used in Baltimore in 2002, either as a full-size original, a full-size copy or a reduced-size copy. This puts at issue whether some of the information from the Goodman study that the Defendants consider anticipatory or novelty-destroying was in fact presented at the Baltimore Conference or at a subsequent Honolulu conference.

[8] With respect to Acorda S-1, the Plaintiffs do not deny that the document referred to by the Defendants was filed by Acorda's bankers or lawyers with the SEC on or about the date it is said to have been filed. However, their position is that the filing of that document with the SEC on a specific date does not mean that the document was either "publicly available" or could reasonably have been locatable by a person of skill in the art through a reasonably diligent search.

[9] Clearly, facts that may establish whether the actual poster used at the Baltimore Conference is the same, or contains the same information, as the only known version of the poster are extremely relevant, as are facts that might establish whether and how, beyond its filing with the SEC at a certain date, the Acorda S-1 document could be or was accessed by the public at or before the relevant priority date.

II. The initial discoveries

[10] The Plaintiffs' denial of the public availability of both references is contained in the pleadings, although the specific factual basis for that denial may not have been clear prior to the beginning of discoveries.

[11] The Defendants were aware of the US Trial prior to the initial discoveries. They knew that Dr. Goodman had testified as an expert for Acorda at that trial, and, if they did not then have the transcripts of the evidence led at the trial, it was available to them.

[12] The Defendants were also previously aware, or learned during the initial discoveries, that there had been *Inter Partes* Review (IPR) proceedings before the US Patent Office in respect of the corresponding US Patent, that one of the named inventors, Dr. Cohen, had been deposed for those proceedings and that the other named inventor, Dr. Blight, might have been.

[13] The Defendants examined for discovery Dr. Cohen, both as a representative of the Plaintiffs and as an inventor, as well as Dr. Blight, as an inventor. They had an opportunity to ask about Dr. Cohen's and Dr. Blight's own personal knowledge and recollections about the identification and content of the Goodman 1 poster. They had an opportunity to ask Dr. Cohen about the Plaintiffs' information, knowledge and belief of that poster. They had an opportunity to ask the Plaintiffs' information, knowledge and belief relating to the public availability of the Acorda S-1 document at the relevant time. The Defendants also had an opportunity to explore whether depositions taken in the context of the US Trial or of the IPR contained information

relevant to these facts. Indeed, the Defendants asked the Plaintiffs to undertake to make several inquiries directly to Dr. Goodman about Goodman 1; they asked the Plaintiff to undertake to make direct inquiries of Acorda's bankers and lawyers about the availability of Acorda S-1; and they asked for production of the deposition transcripts of Dr. Goodman in the context of the US Trial and of Drs. Cohen and Blight in the IPR context.

[14] The Plaintiffs objected to both requests for productions. With respect to the Goodman deposition, the Defendants sought a ruling from the Court on a motion to compel. By order rendered from the bench and signed as a formal order dated April 26, 2019, the Court upheld the Plaintiffs' objections to production on the basis that the Defendants had not established that the deposition of Dr. Goodman in fact contained relevant information. With respect to the IPR depositions, the Plaintiffs provided, despite their initial objections, an answer under reserve of objection to the effect that "the Plaintiffs' best information is that the deposition transcript[s are] subject to confidentiality terms in the United States." The Defendants did not move to compel a further or better response to that request.

III. The questions that issue

A. *Deposition of Dr. Goodman*

[15] As mentioned, the Defendants obtained undertakings from the Plaintiffs at the initial discovery to put certain specific inquiries to Dr. Goodman about the poster. His answer to all questions what that he could not remember. In follow-up, the Defendants have now asked a series of questions as to whether, in his deposition, Dr. Goodman was specifically asked about

the poster, whether or not the version produced at the trial was available or was presented at the Baltimore or the Honolulu conferences, whether that version is an internal Acorda draft, whether he "addressed" specific information found in the version at issue at the Baltimore Conference, whether anyone walked up to him to ask questions, how many people viewed the poster or attended the conference, and how long the conference was, as well as similar questions about a slide presentation he gave at a platform in Baltimore. For every such question, the Defendants then ask that, if Dr. Goodman was questioned on deposition, the relevant portions of the transcript be produced.

(1) Relevance

[16] The ultimate factual issues to which the questions relate are clearly relevant. The questions as formulated, however, do not directly ask for that information or for Dr. Goodman's current recollection of that information. They instead ask whether he was previously questioned as to these facts and if so, the production of the information he gave at that time.

[17] The record before the Court indicates that it is reasonably likely that such questions could have been asked of Dr. Goodman on deposition. For example, the US Trial transcript contains the question, "Sir, did you tell me at the deposition that you prepared this facsimile of the poster?"

[18] What Dr. Goodman was asked on deposition is not directly relevant to any issue in dispute in this litigation. However, a positive answer to that question leads to establishing that the deposition transcripts do contain information about the relevant facts. The question for the

Court is whether the production of the deposition transcripts is likely to advance the Defendants' case or damage the Plaintiffs'.

[19] There is nothing in the manner in which the questions are formulated, or on the record before the Court, that would suggest that information contained in the deposition transcripts likely includes reference to other sources of information or evidence to corroborate whatever testimony Dr. Goodman might have given at the time. It is the answers given by Dr. Goodman himself that are of interest to the Defendants.

[20] The transcripts would not be admissible as evidence in this action. To the extent the deposition transcripts contain information that supports the Defendants' case, the only way they can be used to advance the Defendants' case is for the purpose of cross-examining Dr. Goodman, if he were to come to testify at the trial of this action, as a way to perhaps jog his memory (*Apotex v Sanofi Aventis* 2011 FC 52, at para 66). Does the depositions' potential usefulness as a tool to jog Dr. Goodman's memory meet the test for relevance? The Court believes so. There are means by which the Defendants could compel Dr. Goodman's attendance at trial, and therefore, there is a reasonable likelihood that this information could be used to advance the Defendants' case.

(2) Are the questions proper follow-up?

[21] The questions could have been asked before. The Defendants knew, from the trial transcripts, that Dr. Goodman had been deposed. They made a general request for production of the transcripts. The Plaintiffs' objection to that request was upheld by the Court, because the

Defendants had failed at the time to lay the appropriate foundation to establish that the deposition transcripts likely contained relevant information.

[22] The Plaintiffs are correct in noting that utilizing a re-attendance on discovery to reformulate questions that were refused because they were initially improperly formulated does not constitute appropriate follow-up. The circumstances here are, however, different.

[23] There are good reasons why this Court has historically been reluctant to order the wholesale production of deposition transcripts of foreign proceedings. These transcripts are usually protected by confidentiality measures imposed either by protective orders or the implied undertaking rule. These confidentiality measures evolved in recognition that there is a greater public interest in restricting the use of discovery transcripts for purposes other than the litigation in which they were made. Because law, facts, parties and issues are rarely identical between proceedings in different jurisdictions, only small portions of deposition or discovery transcripts are typically relevant to other proceedings. The party being examined might be able to waive confidentiality, but only in respect of its own information. (See discussion and cases cited in *Hospira Healthcare Group v Kennedy Institute of Rheumatology* 2015 FC 1292 at paras 92 to 95).

[24] The task of going through discovery transcripts to find, identify and extract information that is both relevant and amenable to waiver, while ensuring that the deponent or the other party's confidentiality rights are not infringed, can be an onerous task to which a party should not lightly be put.

[25] Given that the Plaintiffs were in a position to obtain Dr. Goodman's current – and more relevant – recollections as to the facts at issue here, the Court might well have refused production of the deposition transcript on the grounds of proportionality, even if production had been asked in an appropriate manner in the context of the initial discovery. The Court is satisfied that, given the failure of the Defendants' attempt to elicit the information from Dr. Goodman's current recollections, it is appropriate and proportionate follow-up for the Defendants to seek the information from what may be contained in the deposition transcript.

(3) The incidence of protective orders or implied undertaking rules

[26] As a matter of judicial comity, the Court should avoid making orders that would require a party to breach an order of a foreign court or an undertaking of confidentiality given to a foreign court. That said, the burden of establishing the existence of such constraints to a party's ability to comply with a production order rests with the party invoking these restrictions. The Plaintiffs have led no evidence to show that such constraints exist, or that, if they do, they do not contain a provision whereby the party whose expert was deposed or who designated information as confidential cannot waive confidentiality. After all, Dr. Goodman was deposed in the US proceedings as an expert for Acorda, the requested portions of the transcript relate to information that appears to either be Acorda's own or to facts that are inherently public. Even assuming that the existence of a protective order is likely, the existence of a provision enabling Acorda to waive confidentiality is equally likely.

[27] That said, the Court does not wish to put the Plaintiffs in the position where, simply because they failed to bring the appropriate evidence before the Court, they would be forced to

choose between breaching a production order of this Court and breaching a protective order issued by or an undertaking given to a foreign court. The Plaintiffs may therefore be relieved of complying with this order if, believing that they are bound by a protective order, implied undertaking or other measure governed by the US District Court, and having taken appropriate steps to be relieved, by the US District Court, of these strictures, and that the US District Court declines to provide the relief.

B. *Depositions from the IPR*

[28] As mentioned, the Defendants requested, in the course of the initial discovery, production of any depositions given by Dr. Cohen and Dr. Blight in the context of the IPR. After initially objecting, the Plaintiffs provided, under reserve of objection, information to the effect that to the best of their knowledge, these transcripts were the subject of confidentiality terms. The Defendants did not move, in the context of a first refusals motion, for a further and better answer to that question.

[29] On follow-up discovery, having obtained a copy of the protective order issued in the IPR proceedings, the Defendants first asked whether that order prevents Acorda from disclosing its own confidential information, and then proceeded to ask a series of questions similar to those asked in respect of the Goodman deposition, directed to whether Dr. Cohen or Dr. Blythe were questioned, during the IPR depositions, about the identity or availability of the Goodman 1 poster during the Baltimore Conference, and about the “public” availability of Acorda S-1, and if so, to produce to relevant excerpts of the transcripts.

(1) Relevance

[30] The question as to whether the protective order prevents disclosure of Acorda's own information is not directly relevant to any disputed issue in the actions. Answer to that question would only lead to information that would permit the Defendants to contest what amounts to an objection to an initial discovery request. That is not a relevant discovery question. It is an issue that can and should be raised in the context of a motion to compel answers to a discovery question that has been refused on the grounds that it would breach a protective order.

[31] With respect the questions seeking information as to the content of the IPR depositions and the production of any relevant portions, there is no evidence on the record before the Court on this motion to show that it is likely that Dr. Cohen and Dr. Blythe were questioned in respect of these matters. There is no evidence to suggest that the public availability of Goodman 1 and of Acorda S-1 was at issue in the IPR proceedings. Indeed, unlike Dr. Goodman who was personally present and involved in the Baltimore Conference, there is very little on the record before the Court to suggest that Drs. Cohen and Blight might even have had personal knowledge of facts in respect of Goodman 1 or Acorda S-1. The Defendants appear to be much more looking for evidence of "admissions" they might have made as to the public availability of the reference than for relevant personal knowledge they might have. In that respect, these questions seem far more like a fishing expedition than those relating to the Goodman deposition, and are far less relevant.

[32] The analysis as to the relevance of any portion of the transcripts that might pertain to relevant facts is otherwise roughly similar to the analysis conducted in respect of the Goodman deposition. The only usefulness of the deposition transcripts would be for the purpose of cross-examination. As there is no material on the record before the Court to establish that Drs. Cohen and Blythe did not recollect or gave conflicting answers in respect of the facts at issue, the usefulness of the transcripts, assuming they contain relevant information, is tenuous.

[33] The task of reviewing the deposition transcripts and extracting any possibly relevant information is disproportionate to its potential relevance.

(2) Are the questions proper follow-up?

[34] Even assuming that the Court's earlier determination was wrong and that Acorda's ability to waive the application of the protective order is a relevant discovery question, the Court finds that it is not a proper follow-up question in the circumstances. As mentioned, the existence and applicability of restrictions to a party's ability to provide information that is otherwise relevant is a matter that should be raised and determined in the context of motions to rule on objections or to compel answers. The Defendants had an opportunity, in the context of a first motion to compel, to contest the Plaintiffs' assertion of restrictions due to a protective order, and to put the Plaintiffs to proof of the existence and applicability of such an order. They chose not to do so and have waived their right to seek that determination. They may not revive it under the guise of a follow-up question.

[35] As regards the Defendants' questions regarding the subject matter and the production of the depositions, it is clear that the Defendants could have asked, during the initial examinations for discovery, all of the questions they now wish to ask. Unlike the case of Dr. Goodman, where the Defendants could not know whether Dr. Goodman had sufficient contemporary recollection of events until answers to undertakings were provided, the Defendants had the opportunity to directly ask Dr. Cohen and Dr. Blythe for their knowledge and recollections on the issue of the Goodman poster and the Acorda S-1 document. To the extent Dr. Cohen and Dr. Blythe were unable to recall the relevant facts, the Defendants would have been in a position to immediately ask whether the subject matter was covered in IPR depositions.

[36] The need, propriety, and proportionality of a request for deposition transcripts in the case of Dr. Cohen and Dr. Blythe does not arise from information that was provided by the Plaintiffs after the conclusion of the initial discoveries and is accordingly not an appropriate subject for follow-up.

(3) The incidence of the protective order

[37] A copy of the protective order applicable to the IPR proceedings was provided to the Court in the context of this motion. That document indicates that the right to designate testimony in the proceedings as confidential is conferred on any person providing the testimony, in this case, Drs. Cohen and Blight themselves. The protective order does not include a provision entitling any party to waive confidentiality in respect of testimony once the person who has provided it has designated it as confidential. The Defendants have not brought the Court's attention to any provision of the protective order that could be argued to give Acorda the right to

waive such a designation. Even if the requests for production of the deposition transcripts had been proportionate or constituted appropriate follow-up, the Court would have declined to order the Plaintiffs to produce them given that there is no evidence the protective order by which they are asserted to be covered can be waived by the parties in the circumstances.

IV. Conclusion and Costs

[38] The Plaintiffs will be required to provide answers to those questions which the parties have identified as belonging to Category 1A of the refusals chart prepared for the motion, subject to the conditions set out in paragraph 27 of these reasons. They will not be required to answer the questions from Category 3 of that chart.

[39] The parties shall prepare for the Court's endorsement a draft order to implement these conclusions as well as the determinations made from the bench at the hearing, approved as to form and content by all parties.

[40] Success being divided, the parties have agreed that there should be no costs on these motions.

"Mireille Tabib"
Case Management Judge

Ottawa, Ontario
July 15, 2019

FEDERAL COURT

SOLICITORS OF RECORD

DOCKET:	T-1163-18 T-1416-18 T-220-19
STYLE OF CAUSE:	BIOGEN CANADA INC ET AL v. TARO PHARMACEUTICALS INC BIOGEN CANADA INC. and OTHERS v. APOTEX INC. BIOGEN CANADA INC. et al. v. PHARMASCIENCE INC.
PLACE OF HEARING:	OTTAWA, ONTARIO
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