

Aragon Pharmaceuticals Inc. Et Al. v. Sandoz Canada Inc., 2026 CanLII 54839 (FC)

Source: Federal Court
Date: 2026-06-08
File number: T-9-25
Citation: Aragon Pharmaceuticals Inc. Et Al. v. Sandoz Canada Inc., 2026 CanLII 54839 (FC), <<https://canlii.ca/t/klcz1>>, retrieved on 2026-06-10

Date: 20260608

Docket: T-9-25

St. John's, Newfoundland and Labrador, June 8, 2026

PRESENT: Associate Judge Trent Horne

BETWEEN:

**ARAGON PHARMACEUTICALS, INC. AND
JANSSEN INC.**

**Plaintiffs /
Defendants by Counterclaim**

and

SANDOZ CANADA INC.

**Defendant /
Plaintiff by Counterclaim**

REASONS AND ORDER

I. Overview

[1] The defendant, plaintiff by counterclaim [Sandoz], has brought a motion for an order directing the Administrator to issue letters rogatory, also known as letters of request, addressed to judicial authorities in the United States and Switzerland.

[2] The motion is dismissed. The potential witness in the United States has agreed to give evidence at trial; Sandoz has not demonstrated that there are good grounds to believe that this witness will not attend. As for the potential witnesses located in Switzerland, the orderly progression of the trial could be compromised by the lengthy delay in bringing this motion, which is prejudicial. In any event, there is no evidence that Sandoz asked the witness to voluntarily attend, which must be done before moving for letters rogatory.

II. Background

[3] This action is brought pursuant to the *Patented Medicines (Notice of Compliance) Regulations*, SOR/93-133. In their statement of claim, the plaintiffs [Janssen] seek a declaration that Sandoz will infringe certain claims of Canadian patent 2,885,415 [the 415 Patent] by making, using, and selling a pharmaceutical product called apalutamide.

[4] In addition to denying infringement, Sandoz pleads that the 415 Patent is invalid. Among other things, Sandoz asserts that the 415 Patent is anticipated and obvious in light of Smith, MR, et al, “ARN-509 in Men with High Risk Non-Metastatic Castration-Resistant Prostate Cancer”, *Annals of Oncology*, 2012 23(S9), 920P [the Smith Abstract]. The Smith Abstract was included in a schedule of prior art attached to the statement of defence and counterclaim filed on February 17, 2025.

[5] The publication date of the Smith Abstract is important to determine whether it is citable prior art or not. The priority date for the 415 Patent is September 26, 2012. Sandoz takes the position that the Smith Abstract was published by the European Society for Medical Oncology [ESMO] in a book of abstracts at least as early as September 17, 2012 (before the priority date), however the conference associated with these abstracts commenced on September 28, 2012 (after the priority

date). Janssen notes that there are about 1,700 abstracts in that book, and submits that Sandoz will need to establish the publication date of the abstract book, and that the Smith Abstract was included in it.

[6] Sandoz states that the Smith Abstract has been considered by decision-makers in other jurisdictions to be relevant prior art when considering the validity of foreign equivalents to the 415 Patent. This includes the European Opposition Division, which held that the European equivalent to the 415 Patent was not novel over the Smith Abstract.

III. Rule 272

[7] Under subrule 272(1) of the *Federal Courts Rules*, SOR/98-106 [Rules], the Court may make an order for the issuance of, in respect of evidence to be given outside of Canada, a Commission, letters rogatory, a letter of request and any other document required for the examination in the Forms prescribed by the Rules.

[8] The issuance of a commission to obtain evidence is an extraordinary procedure which should only be granted where special circumstances and the proper administration of justice requires it. The decision to set up a commission is discretionary. In adjudicating between the parties on such a discretionary matter, the Court must not only consider the rights of the parties but the effects that its decision might have on the administration of justice generally (*Sanofi-Aventis Canada Inc v Apotex Inc*, 2009 FC 294 [*Sanofi*] at para 39).

[9] I note that in *Sanofi*, the party moving for letters rogatory did so two days after the completion of the evidentiary phase of trial, and that the request related to some 3,000 pages of material. It may be that the use of the word “extraordinary” arose in the context of the timing and scope of that motion. In any event, letters rogatory involve consideration of judicial comity and respect for foreign courts. To respect the resources of foreign courts, the Federal Court should give careful consideration to any such motion.

[10] The jurisprudence has enunciated a number of factors that need to be considered on motions for letters rogatory. In particular, there are four factors that are deserving of consideration: the

application must be made *bona fide*; the issue in respect of which the testimony is sought is one that is relevant to the proceedings before the Court; the witnesses sought to be examined can give evidence which is material to the issue; and finally, there are good grounds for which the witnesses cannot attend the trial (*Boily v Canada*, [2017 FCA 180](#) [*Boily*] at para 42). Consideration must also be given to potential prejudice (*Sanofi* at para 9).

IV. Analysis

A. The Internet Archive

[11] The Internet Archive operates the Wayback Machine, which captures and stores webpages as they were publicly available on particular dates. Sandoz states that, in September 2012, the Wayback Machine captured ESMO’s websites multiple times, and these captures indicate that the abstract book was published on the ESMO website on September 17, 2012.

[12] Sandoz’ evidence on the motion includes an affidavit from a law clerk employed by its counsel of record. The affiant attended a telephone call between lawyers at the firm and an employee of the Internet Archive. That employee stated that he “is willing to attend the trial remotely by videoconference or to attend a local in-person examination.” There is no qualification to this statement. There is no statement in the affidavit expressing concern that this promise may not be kept. There is nothing to indicate that the individual required further approval from management of the Internet Archive, or that his attendance at trial would be contingent on other events or decisions.

[13] Based on this evidence, I am not satisfied that letters rogatory should be issued. There are no good grounds upon which to conclude that the witnesses cannot or will not attend the trial.

I considered a similar issue in *Samsung Bioepis Co, Ltd v Janssen Biotech, Inc*, [2024 FC 1147](#) [*Samsung*] where a motion for letters rogatory directed to inventors of a patent was dismissed as premature; the defendant had agreed to make the inventors available. An order under Rule 272 is discretionary. While the Court may be able to issue letters rogatory when a witness has already

agreed to be examined, such an order should only be made when there is a demonstrated need for one (para 26).

[14] Sandoz points to a page of “frequently asked questions” published by the Internet Archive:

Can I subpoena someone to testify to the authenticity of the URLs in the Wayback Machine?

The Internet Archive would prefer if you didn't, and will most likely fight it. The Internet Archive is a small non-profit, and taking up the hours or days of a member of the team significantly affects our work. Please consider alternatives to subpoenaing someone from the Internet Archive, including using the standard affidavit or judicial notice.

[15] I am not satisfied that this general statement casts doubt on the specific promise given by the Internet Archive employee to give evidence at trial. Court resources are frequently and fairly described as scarce. Bringing a motion for a “just in case I need it” order is not an efficient use of the Court’s resources, particularly when it has not been demonstrated that there is a likelihood of non-attendance (*Samsung* at para 30). Further, it has not been demonstrated that such an order would be an efficient use of the resources of the United States District Court for the Northern District of California.

[16] Sandoz amended its notice of motion to add a request for alternative relief, namely an order that the motion as it relates to the Internet Archive be stayed pending voluntary attendance at trial by videoconference. I am not satisfied that this relief should be granted. The motion should be adjudicated on the record as it now exists. If the Internet Archive later decides to refuse to participate at trial, the evidentiary record for any subsequent motion will need to be updated.

B. The European Society for Medical Oncology

[17] During the examination for discovery of Janssen’s corporate representatives, Sandoz asked for admissions as to the publication dates of prior art documents, including the Smith Abstract. Janssen refused on the basis that the plaintiff Aragon Pharmaceuticals, Inc did not have information as to when documents became publicly available, and that the best source of that

information is the journal itself. Sandoz included that refusal in its motion to compel that was heard on October 8, 2025, but withdrew it in advance of the hearing of the motion. As of that date, Sandoz knew that it could not rely on an admission from Janssen to establish the publication date of the Smith Abstract and would have to prove that at trial by other means.

[18] The only explanation Sandoz offers for the delay between the hearing of the discovery motion in October 2025 and the hearing of this motion in June 2026 is that a scheduling order of February 10, 2026 set aside the week of July 6, 2026 for motions for letters rogatory. I hasten to emphasize that this date was selected by the parties, not imposed by the Court. One of the factors to consider on a motion for letters rogatory is prejudice, which includes whether the timing of the motion and any examinations will interfere with the orderly administration of the trial. The fact that the parties chose a range of dates for motions for commission evidence that could be, and were likely to be, practically unworkable does not relieve Sandoz of its burden to bring its motion in a timely way, and demonstrate an absence of prejudice. On reflection after the hearing, I recall that the potential risks of scheduling motions for letters rogatory so close to trial were raised with the parties during a trial management conference on January 30, 2026.

[19] It is up to the party moving for letters rogatory to obtain trial evidence to show that the evidence can be obtained in a manner that does not disrupt the orderly progression of the trial. I have no indication as to why this motion was, or could not have been, brought months ago. Delay may not be a stand-alone reason to dismiss a motion for letters rogatory, but an absence of due diligence in bringing the motion can weigh heavily against the moving party (*Sanofi* at para 29).

[20] Sandoz' motion includes an affidavit of Peter Widmer, a senior Swiss intellectual property attorney. Mr Widmer was cross-examined on his affidavit. Based on the affidavit and cross-examination, letters rogatory from the Federal Court should be directed to The Swiss Federal Office of Justice [FOJ]. The FOJ is the central authority in relation to letters of request for international judicial assistance, and will give effect to the letters. Compliance with the Swiss Federal Act on Private International Law [PILA] is required; this includes supplying a certified German or French translation of the letters rogatory.

[21] If the letters rogatory are deemed compliant, the FOJ will direct it to the competent court. Based on the nature of the evidence sought, this could be either the Swiss Federal Patent Court [FPC] in St Gall, or the regional high court of the Canton of Tessin. Mr Widmer recommends that a request be made that the FOJ direct any request to the FPC. On cross-examination, Mr Widmer stated an expectation that the FOJ would send the letters to both courts, and they would discuss as between them who would take the matter.

[22] The court seized of the matter will then send a summons to ESMO. Swiss courts typically prefer a specific individual to be named and/or require the organization to disclose a person with direct knowledge of the issue or access to relevant corporate records. A summons will oblige ESMO to determine who has relevant knowledge of the matter. The date of the actual examination will depend on the availability of the court, the parties, and the witnesses.

[23] How long these steps are expected to take is not addressed in the Widmer affidavit. Some of these details emerged on cross-examination.

[24] There is a measure of uncertainty as to overall timing because the relevant article of PILA was substantially revised in January 2026. It is Mr Widmer's expectation that the FOJ would process the initial request within days. It is not apparent how long it typically takes for the FPC and the regional high court of the Canton of Tessin to decide among themselves as to which one of them will take the matter, and then issue the summons. Once issued, a response to the summons is due within 10 business days. As for how long it is expected to take to conduct the examination after a response to the summons has been provided, that is unknown.

[25] Sandoz points out that Janssen did not introduce evidence from a witness with experience in the Swiss legal system, specifically on the issue of timing. Janssen was not required to do so. As the moving party, Sandoz bears the burden of meeting the test for issuance of letters rogatory. Ordinary principles of litigation put the burden of proof on the party making the assertion (*WIC Radio Ltd v Simpson*, 2008 SCC 40 at para 30). The burden is always on the party asserting a

proposition or fact that is not self-evident (*Voltage Holdings, LLC v Doe #1*, 2023 FCA 194 at para 40). It is for Sandoz to demonstrate that any examination of ESMO can be completed without prejudice to the trial schedule, and introduce evidence to that effect.

[26] Mr Widmer states that it is possible for the letters rogatory to highlight a deadline in the Canadian litigation, and that the Federal Court can ask the Swiss authorities to complete the process before the deadline.

[27] Letters rogatory were considered by the Supreme Court in *Zingre v R* (1981), 1981 CanLII 32 (SCC), 127 DLR (3d) 223 (SCC). In that judgment, the Supreme Court set out the justification for honouring the request of a foreign court. Dickson J (as he then was) stated at page 230:

As that great jurist, Chief Justice Marshall, observed in *Schooner Exchange v. McFadden et al.* (1812), 7 Cranch's Reports 116 at pp. 136-7, the jurisdiction of a nation within its own territory is necessarily exclusive and absolute, susceptible of no limitation not imposed by itself, but common interest impels Sovereigns to mutual intercourse and an interchange of good offices with each other.

It is upon this comity of nations that international legal assistance rests. Thus the Courts of one jurisdiction will give effect to the laws and judicial decisions of another jurisdiction, not as a matter of obligation but out of mutual deference and respect. A foreign request is given full force and effect unless it be contrary to the public policy of the jurisdiction to which the request is directed (see *Gulf Oil Corp. v. Gulf Canada Ltd.* (1980), 1980 CanLII 192 (SCC), 111 D.L.R. (3d) 74, 51 C.P.R. (2d) 1, [1980] 2 S.C.R. 39) or otherwise prejudicial to the sovereignty or the citizens of the latter jurisdiction.

[28] The paragraphs reproduced above are in the context of enforcing letters rogatory issued by a foreign jurisdiction, but highlight the foundation of judicial comity, and mutual deference and respect, which must also apply to the issuance of letters rogatory.

[29] Canadian judicial resources are scarce. I have no understanding of the workload of Swiss courts, but cannot assume that judges there have excess capacity. Simply put, Sandoz has not explained why it waited so long to bring this motion. Even if the process in Switzerland is efficient, it has not been demonstrated that the examination would be completed before the start of

the trial on August 17, 2026, particularly since the summer holiday season is already underway. Absent some evidence demonstrating that an examination of an ESMO representative could be completed without interfering with the presentation of evidence at trial, I cannot conclude that there is an absence of prejudice. I am also not satisfied that it is deferential to or respectful of the Swiss courts to ask them to expedite a process in their country, which may delay and de-prioritize their own domestic matters, without good reason.

[30] Even if an examination of an ESMO representative could be completed in a timely way, the motion would be dismissed because Sandoz has not established that a witness will not voluntarily attend at trial.

[31] Sandoz delivered motion materials to Janssen that included a first law clerk's affidavit. That affidavit principally attached a series of documents without commenting on them. The final paragraph of the affidavit stated "I have been informed by Ms. Lauren Daly, associate lawyer at Sprigings IP and counsel for Sandoz Canada Inc., and verily believe to be true, that we have not received agreement from the Internet Archive or the European Society for Medical Oncology (ESMO) to attend the trial in this proceeding." The affidavit did not attach any documents in this respect.

[32] Shortly after receipt of this affidavit, Janssen sent an email to Sandoz stating that there were shortcomings in the evidence. It was noted that no documents were included to substantiate the lack of agreement, and that there was no evidence of communications between Sandoz' counsel and ESMO.

[33] Sandoz responded, and produced a redacted email from Dr Rowett at ESMO dated May 11, 2026. The brief email states, in part, that the author has been instructed not to engage further in discussions with Sandoz' counsel. The second clerk's affidavit attaching the email states: "earlier correspondence in that email chain is not relevant to the motion for letters of request, and/or remains litigation privileged and so has been redacted." The second clerk's affidavit does not

explain why the redactions were made or provide a general description of what was redacted. The written representations on the motion do not address the propriety of the redactions or any claim for litigation privilege.

[34] I have significant difficulty with this partial disclosure.

[35] In the context of documentary discovery, redactions based on relevance should be exceptional, sparingly applied, and clearly explained (*Boehringer Ingelheim (Canada) Ltd v Pharmascience Inc*, 2023 FC 584 at para 11). The same principles apply here. If there was a communication with ESMO about attendance at trial, I have difficulty seeing how only part of that discussion would be relevant.

[36] As for litigation privilege, again, there is no evidence or argument supporting the redactions in this respect. Perhaps it could be concluded that Sandoz has waived privilege over this communication by disclosing part of it. When litigation privilege is contested, there can be a “fairness and consistency” analysis to determine whether the partial disclosure of privileged information can result in unfairness to the other side. Where unfairness can be shown to result from the partial disclosure, the disclosing party may be considered to have waived the privilege altogether even where it had no intention of doing so (*Merck & Co Inc v Apotex Inc*, 2009 FCA 27 at para 13).

[37] I need not resolve this. Unlike the motion as it relates to the Internet Archive, I do not have evidence that Sandoz ever asked a representative of ESMO to testify at trial. At a minimum, it is expected that a party asking the Federal Court to direct letters rogatory to judicial officers in another jurisdiction to compel the examination of a witness will begin by asking whether a witness will attend voluntarily (*Boily* at para 55). I expect that a party moving for letters rogatory would disclose or describe in some detail the communication to the potential witness asking whether trial evidence will be voluntarily given, and any response.

V. Costs

[38] The parties are encouraged to reach an agreement on costs. If agreement cannot be reached, a schedule is set for the exchange of submissions.

THIS COURT ORDERS that:

1. The defendant's motion is dismissed.
2. The parties are encouraged to reach agreement on costs. If an agreement cannot be reached, the plaintiffs shall serve and file costs submissions, not to exceed five pages, within 7 days of the date of this order. The defendant shall serve and file costs submissions, not to exceed five pages, within 14 days of the date of this order.

blank

blank

"Trent Horne"
Associate Judge