

Federal Court



Cour fédérale

Date: 20260720

Docket: T-9-25

Toronto, Ontario, July 20, 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 second motion for an order directing the Administrator to issue letters rogatory, also known as letters of request.

[2] The first motion was dismissed. The potential witness in the United States had agreed to testify at trial, and it was therefore not demonstrated why letters rogatory were required. As for the potential witnesses in Switzerland, Sandoz did not explain its lengthy delay bringing the

motion or demonstrate that the evidence could be taken abroad in a way that would not interfere with the orderly administration of the trial.

[3] Almost immediately after the decision on the first motion, Sandoz brought this second motion for letters rogatory. The motion is granted in part. There has been a material change in circumstances with respect to the witness in the United States, who is no longer responding to Sandoz' communications. The motion as it relates to a potential witness in England is dismissed. The motion in this respect is an abuse of process by re-litigation; it seeks to obtain evidence from an employee of the same Swiss company on the same issue that was the subject of the first motion.

[4] There is no order as to costs. While I would ordinarily be inclined to award costs to the plaintiffs, allegations were made, without a proper foundation, that the defendant misled the Court. This disentitles the plaintiffs to costs.

II. Background

[5] This action is brought pursuant to the *Patented Medicines (Notice of Compliance) Regulations*, SOR/93-133 [*Regulations*]. 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.

[6] 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.

[7] 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).

[8] 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. It is readily apparent that the Smith Abstract is an important part of Sandoz' case.

III. The First Motion

[9] Sandoz' first motion sought the issuance of two letters rogatory. One was directed to judicial authorities in the United States to compel the attendance of a representative of Internet Archive, who operates the Wayback Machine. The Wayback Machine captures and stores webpages as they were publicly available on particular dates. Sandoz stated 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.

The second letters rogatory was directed to judicial authorities in Switzerland to compel the attendance of representatives of ESMO.

[10] The motion was dismissed (*Aragon Pharmaceuticals, Inc v Sandoz Canada Inc*, 2026 CanLII 54839). On the first motion, there was evidence that an employee of the Internet Archive was willing to attend the trial remotely by videoconference or to attend a local in-person examination. I was not satisfied that letters rogatory should be issued because there were no good grounds upon which to conclude that the witnesses could not or would not attend the trial (para 13). As for ESMO, a significant factor was timing. Sandoz knew as of October 2025 that Janssen would not admit the publication date of the Smith Abstract, yet waited until May 2026 to bring its motion. No explanation was offered for that delay, other than to say that the pre-trial schedule set a deadline in early July to move for letters rogatory. While Sandoz led evidence as to the process by which letters rogatory would be enforced in Switzerland, how long that process was expected to take was not explained (para 24). I concluded that 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, which was not done in this case (para 19). Further, Sandoz had not established that the ESMO witnesses would not voluntarily attend the trial (para 30).

[11] A disputed point on the first motion was the extent of Sandoz' disclosure of its communications with ESMO. Sandoz produced a single redacted email in which an employee of ESMO, Dr Rowett, stated that he was instructed not to engage further in discussions with

Sandoz' counsel. Janssen asked for further particulars of the communications, but Sandoz refused, asserting that these communications were both irrelevant and privileged.

IV. Rule 272

[12] 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.

[13] 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).

[14] 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.

[15] Sandoz notes that a subpoena could be issued to compel the attendance of a witness residing in Canada without leave. That is accurate, but there is no element of *quid pro quo* in the

issuance of a subpoena. The leave requirement for letters rogatory ensures that requests directed to foreign courts are reasonably made, just as we would expect foreign courts to fairly screen requests that would consume Canadian judicial resources. The issuance of letters rogatory may not be an extraordinary remedy as that word is used to describe orders such as an injunction or awards of solicitor-client costs, but there remains a test that must be considered and applied before this Court calls on another to effectively collect on a past kindness.

[16] 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).

[17] On this motion, Sandoz places significant reliance on a decision of Justice McHaffie in *McCain Foods Limited v JR Simplot Company*, 2024 FC 1729 [*McCain*]. Parenthetically, I note that *McCain* was not referred to or relied on by Sandoz in the first motion. In *McCain*, the defendants sought an order permitting them to use parts of the discovery evidence of one of the inventors of the patent at trial. In the alternative, the defendants asked for letters rogatory directed to a French court to take commission evidence for trial. As with Sandoz' motions, a strongly contested point in *McCain* was timing; the motion was brought close to trial and could

have been brought much earlier. Justice McHaffie noted at paragraph 55 that it is not in the interests of justice to issue letters rogatory if the evidence indicates that doing so will be futile because it will not or cannot be executed to obtain the desired evidence for trial. While he acknowledged that the defendants delayed in bringing the motion, in consideration of all the relevant factors, he concluded that it was in the interests of justice to order the issuance of letters rogatory (para 59).

V. Analysis

A. *The Internet Archive*

[18] Since the issuance of the order on the first motion, Sandoz has made repeated attempts to communicate with the Internet Archive to arrange for the attendance of one of its employees to give evidence at trial. There has been no response to numerous email and telephone messages. This is an unforeseen change of circumstances.

[19] The Registry is directed to prepare and issue letters rogatory directed to the judicial authorities of the United States District Court for the Northern District of California. The motion is made *bona fide*. In *Hoffmann-La Roche Limited v Sandoz Canada Inc*, 2021 FC 384 at paragraphs 49-55 [*Hoffmann-La Roche*], the Court found that an affidavit of a law clerk attaching printouts from the Wayback Machine was inadmissible; this evidence must be obtained from the Internet Archive directly. The issue in respect of which the testimony is sought (publication date of the Smith Abstract) 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

the recent absence of communications from representatives of the Internet Archive constitutes good grounds to conclude that the witnesses cannot or will not attend the trial.

[20] I acknowledge that this motion was brought close to the commencement of the trial, and that it may be very difficult to complete the processes in California in the time available. I am not, however, satisfied that the attempt would be futile.

[21] Having dismissed Sandoz' first motion because the Internet Archive witness was cooperative, it would not be in the interests of justice to refuse Sandoz the ability to try to secure that evidence now that the witness has become, for whatever reason, unresponsive. I am hard pressed in the circumstances to think of what Sandoz could or should have done differently.

[22] There will be some prejudice to Janssen as a result of dealing with this issue in the weeks leading up to trial, and perhaps during the trial, but this prejudice is not so significant that the motion in this respect should be dismissed.

B. *Dr Lewis Rowett*

[23] I reach a different conclusion on the motion as it is directed to the judicial authorities in England to obtain the evidence of Dr Rowett. Sandoz' motion in this respect constitutes abuse of process by re-litigation.

[24] Abuse of process engages the inherent power of the Court to prevent the misuse of its procedure (*Toronto (City) v CUPE, Local 79*, 2003 SCC 63 [CUPE] at para 37). The doctrine is

flexible and unencumbered by specific requirements, and in this respect differs from *res judicata* and issue estoppel (*Law Society of Saskatchewan v Abrametz*, 2022 SCC 29 at para 35). Courts have applied the abuse of process doctrine to preclude re-litigation when it would be contrary to the principles of judicial economy, consistency, finality, and integrity of the administration of justice (*CUPE* at para 37).

[25] This Court has confirmed that the principles enunciated in *CUPE* must inform analysis with respect to abuse of process in the context of the *Regulations* (*Sanofi-Aventis Canada Inc v Novopharm Limited*, 2007 FCA 163 at paras 26 and 35; *Pfizer Canada Inc v Amgen Inc*, 2019 FCA 249 at para 57).

[26] In *Apotex Inc v Merck & Co*, 1999 CanLII 7874 (FC), Apotex brought an action to impeach the patent in suit after it had lost an earlier patent infringement action in which it had not raised the issue of invalidity of the patent. Apotex had also lost a motion to vary the appeal judgment that declared the claims in issue valid. Merck moved to strike Apotex's statement of claim as an abuse of process. The Federal Court Trial Division (as it then was) granted the motion, on the basis that the validity of the patent implicitly underlay the finding of infringement in the previous action. At paragraph 25, the Court stated:

... [I]t is apparent that the application of the doctrine of *res judicata* does not depend on whether the parties actually raised the issue or issues in previous proceedings, but rather whether the parties could have done so. Should a party choose to drop certain issues for reasons of tactics, strategies, or otherwise, the party seals its fate with regard to those decisions. Parties must bring forward their whole case, and will not be permitted to litigate by instalments in piecemeal fashion. It is a principle of law and also of policy that there be finality to court decisions: see also *Grandview v. Doering*, 1975 Can.LII 16 (SCC), [1976] 2 S.C.R. 621 at 634 and

636. Parties to litigation must be able to rely on the finality of final judgments so that they can adjust their affairs, if necessary, and conduct themselves accordingly.

[27] Very recently, the Supreme Court of Canada considered abuse of process in *Patrick Street Holdings Ltd v 11368 NL Inc*, 2026 SCC 15. Sandoz particularly relies on the following paragraph of that decision:

[43] The doctrine of abuse of process derives from a court's inherent jurisdiction to manage its own procedures, and it applies based on a judge's appreciation of the impact of relitigation on the repute of the administration of justice. Abuse of process by relitigation is often invoked where the strict preconditions to apply one of the branches of *res judicata* are not met, but where permitting relitigation of an issue or cause of action would nonetheless constitute a misuse of a court's procedures (*Toronto (City)*, at para. 37). In this sense, while abuse of process is "unencumbered" by the technical requirements of *res judicata*, it should be applied as a last resort to protect the repute of the administration of justice (para. 37, citing *Canam Enterprises Inc. v. Coles* (2000), 2000 CanLII 8514 (ON CA), 51 O.R. (3d) 481 (C.A.), at para. 55, per Goudge J.A., dissenting). It is "only when the rules of *res judicata* run out that it is useful to turn to" the doctrine of abuse of process (A. Zuckerman, *Zuckerman on Civil Procedure: Principles of Practice* (3rd ed. 2013), at p. 1244).

[28] The abstract book for the ESMO 2012 congress, which includes the Smith Abstract, was published in the *Annals of Oncology*. The publication states that Dr Rowett was the Executive Editor.

[29] Sandoz submits that the first motion seeking relief against ESMO and the second motion seeking relief against Dr Rowett are two completely different requests, and that this is essentially a Venn diagram with no overlap in the relief sought. Sandoz argues that there was no way to get an order as against Dr Rowett in England on the first motion, and no way to get an order against

ESMO in Switzerland on the second motion. Therefore, it says, the same issue is not being revisited. I cannot agree.

[30] To the extent the witnesses and issues can be described using a Venn diagram, there is overlap. One of the affidavits filed in support of this motion states that Sandoz reached out to the current publisher of the Annals of Oncology in November 2025 and was referred to Dr Rowett. The affidavit describes him as Dr Rowett of ESMO (emphasis added). Sandoz was in contact with Dr Rowett to obtain information as to when the abstract book for the ESMO 2012 Congress was published, and ESMO's publication practices. Dr Rowett was not approached as an individual with personal information or recollection, rather as an employee of the entity that published the abstract book. In both motions, Sandoz is seeking to obtain evidence from an ESMO employee on the exact same issue.

[31] On its first motion, Sandoz put in evidence of Dr Rowett's non-cooperation as an indication that ESMO was not cooperative. Having made that connection in the first motion, I cannot see how Dr Rowett and ESMO can be argued to be distinct on the second.

[32] On the first motion, Sandoz refused to disclose further communications with Dr Rowett on the grounds of both relevance and privilege. Yet it is that very evidence that Sandoz relies on for this motion. I have significant difficulty seeing how a party can deem evidence to be irrelevant on one motion, obtain an unfavourable result, and then bring a second motion relying on that very same evidence.

[33] Unlike the change in circumstances with the Internet Archive, there are no new developments with Dr Rowett or ESMO. What is now known is that Sandoz was doing two things at once before the first motion – communicating with Dr Rowett to learn about the publication date of the Smith Abstract and obtain his voluntary evidence in this respect, and bringing a motion to obtain evidence from ESMO employees in Switzerland about the same thing. On about the same day that the moving record on the first motion was due, Dr Rowett sent an email advising that he would no longer cooperate. Nothing has apparently changed since then.

[34] Even if abuse of process should be applied as a last resort, Sandoz' motion as it is directed to Dr Rowett must be dismissed. Sandoz made a strategic choice to bring its first motion against ESMO in Switzerland, and not Dr Rowett in England. It elected to support that motion with limited evidence, and refused Janssen's request to disclose anything further. No new facts or circumstances have arisen since the first motion.

[35] Sandoz' motion gives the appearance that it is using the reasons dismissing the first motion as a road map to put in different and better evidence on the second. The finding that there was no explanation for the delay between October 2025 and May 2026 is met with affidavits explaining what Sandoz was doing during that period. Concerns as to the limited time available between the motion and the start of trial are met with new evidence (an affidavit of a Solicitor of the Senior Courts of England and Wales that provides much more detail on the process and timing for enforcement of letters rogatory in England than what was included in the affidavit of a Swiss lawyer supporting the first motion) and argument based on new jurisprudence, specifically *McCain*. Concerns as to the absence of argument directed to privilege are met with submissions

on litigation privilege. Granting the motion in this respect would be contrary to the principles of judicial economy, consistency, finality, and integrity of the administration of justice.

VI. Costs

[36] The Court has complete discretionary power over the amount and allocation of costs (subrule 400(1)). Success on the motion was divided. Ordinarily, I would be inclined to award costs to Janssen because the motion as against Dr Rowett was dismissed as an abuse of process.

[37] There is no issue that Sandoz' evidence on the first motion was incomplete. Janssen goes beyond that and says that it was misleading. Janssen has not established its allegations of misconduct, so no costs are awarded.

[38] It has been observed on more than one occasion that litigation is not a tea party. The process is adversarial by design. Parties disagree, sometimes passionately. Lawyers often try to land a knockout punch by arguing that their adversary is incorrect, mistaken, has overlooked important evidence, or is focusing on the wrong part of a binding authority. Those arguments may nor may not be accepted by the member of the Court, but such submissions are consistent with fearless and resolute advocacy.

[39] An allegation that a party or their counsel has misled the Court goes beyond that. Allegations of misconduct are a serious matter, and accusations of this nature must be made with the utmost care and on a solid foundation (*Okogun v Canada (Citizenship and Immigration)*, 2026 FC 722 at para 59).

[40] A more complete evidentiary picture has been presented on this motion, but that further evidence has not demonstrated that Sandoz' initial evidence or argument was misleading. I was aware on the first motion that Dr Rowett was not cooperating with Sandoz at the time the motion was filed, and had no information that the Swiss representatives had been asked to voluntarily give evidence at trial. That remained unchanged on the second motion.

[41] Janssen supported its misconduct allegations, in part, on an argument that Sandoz was aware from its communications with Dr Rowett in December 2025 that ESMO's best information as to the publication date of the Smith Abstract is what is stated in the journal itself. This communication was not disclosed on the first motion. In Janssen's submission, Sandoz' first motion suggested that ESMO would have further or additional records speaking to the publication date, and this was misleading because it knew otherwise based on its communications with Dr Rowett. Janssen specifically referred to the affidavit of Mr Widmer, a Swiss lawyer who put in an affidavit on the first motion, and his cross-examination. It is argued that Mr Widmer speculated that ESMO must have relevant records to establish the publication date.

[42] This submission is not supported by the evidence. Mr Widmer was not asked to opine on what kinds of documents Swiss companies are obliged to maintain or are likely to have. His affidavit does not offer evidence or speculation as to what documents ESMO may have in respect of the publication date of the Smith Abstract. On information and belief, Mr Widmer states that he has been advised that Sandoz requires information expected to be in the possession of ESMO, but does not indicate what that information may be. On cross-examination, Mr

Widmer was asked whether he knew anything about ESMO's record retention policy. He gave an answer that mentioned legal minimum standards in Switzerland, and stated "so there's a high likelihood that the relevant questions in relation to the publication are still available." Sandoz did not refer to or rely on this general answer on the first motion, or otherwise suggest that ESMO may have more documents relating to the publication date of the Smith Abstract beyond what they knew from communications with Dr Rowett. I cannot agree with Janssen's submission that Mr Widmer was operating under a misapprehension that would have otherwise altered his evidence.

[43] Janssen submits that the first motion operated on the assumption that there was something worth getting from ESMO, that the Court should have known at that time that all ESMO had was the date on the abstract book notice, which Janssen argues "is already in the case." If "in the case" is intended to mean part of the evidentiary record for trial, that certainly does not apply to the publication date of the Smith Abstract. Janssen has not admitted the publication date of the Smith Abstract and appears to be doing everything it can to avoid doing so. Janssen submitted on the first motion that Sandoz must not only prove the publication date of the abstract book, but also that the Smith Abstract was included in the book at that time and not another date. Sandoz' experts may be basing their opinions on a September 17, 2012 publication date, but that underlying fact must be proven. I do not expect that Sandoz can prove the publication date by simply handing up a photocopy of the abstract book during trial or attaching it to a clerk's affidavit (*Hoffmann-La Roche*). The fact that ESMO may have limited evidence on the publication date of the Smith Abstract is not determinative. Sandoz did not mislead the Court by suggesting that further evidence may be available.

[44] Janssen argues that, had the information obtained from Dr Rowett been disclosed on the first motion, it would have been doomed. I do not see how the result would have been different. Janssen refuses to admit the publication date, so Sandoz has to prove it. The fact that ESMO may have limited evidence as to the publication date of the Smith Abstract does not mean that it has no evidence that could be useful to the trial judge.

[45] A finding of abuse of process by re-litigation does not mean that there has also been misleading conduct. The fact that further evidence was introduced on the second motion does not inherently make the materials on the first misleading. While Janssen has demonstrated that the second motion as it relates to Dr Rowett should be dismissed, it has not demonstrated misconduct by Sandoz.

THIS COURT ORDERS that:

1. The Administrator is directed to prepare and issue a letter of request, in substantially the form attached as Schedule “C” to the notice of motion dated June 22, 2026 addressed to the Judicial Authorities of the United States District Court for the Northern District of California, seeking the issuance of such process as is necessary to compel a representative of the Internet Archive to attend in the jurisdiction of the U.S. District Court, and to be examined for evidence at trial in this Court file for a period of no more than one hour.
2. The motion is otherwise dismissed.
3. There is no order as to costs.

“Trent Horne”

Associate Judge

FEDERAL COURT
SOLICITORS OF RECORD

DOCKET: T-9-25

STYLE OF CAUSE: ARAGON PHARMACEUTICALS, INC. ET AL. v.
SANDOZ CANADA INC.

PLACE OF HEARING: HELD BY WAY OF VIDEOCONFERENCE

DATE OF HEARING: JULY 9, 2026

REASONS AND ORDER: HORNE A.J.

DATED: JULY 20, 2026

APPEARANCES:

Andrew Skodyn
Claire Stempien

FOR THE PLAINTIFFS

Mingquan Zhang
Nathaniel Dillonsmith

FOR THE DEFENDANT

SOLICITORS OF RECORD:

Sprigings IP
Barristers & Solicitors
Toronto, Ontario

FOR THE PLAINTIFFS

Cassels Brock & Blackwell LLP
Barristers & Solicitors
Toronto, Ontario

FOR THE DEFENDANT