

# EXHIBIT 33



**In re NIFEDIPINE CAPSULE PATENT LITIGATION; BAYER AG & PFIZER,  
INC., Plaintiffs, v. SIEGFRIED AG & SIEGFRIED PHARMACEUTICALS, INC.,  
Defendants**

**MDL No. 774, M21-51 (JFK), No. 88 Civ. 1374 (JFK)**

**UNITED STATES DISTRICT COURT FOR THE SOUTHERN DISTRICT OF  
NEW YORK**

**1989 U.S. Dist. LEXIS 11061; 13 U.S.P.Q.2D (BNA) 1574**

**September 19, 1989, Decided; September 20, 1989, Filed**

**OPINION BY:** [\*1] KEENAN

**OPINION**

*MEMORANDUM OPINION AND ORDER*

*JOHN F. KEENAN, UNITED STATES DISTRICT  
JUDGE*

*Background*

*The parties to this multidistrict patent litigation seek the Court's intervention in the resolution of two discovery disputes. First, defendants Siegfried AG and Siegfried Pharmaceuticals, Inc. ("Siegfried") request that plaintiff Bayer AG ("Bayer"), a German corporation, make available for deposition pursuant to the Federal Rules of Civil Procedure four inventors named on the patent that is the subject of these infringement actions. \* Second, Bayer seeks production from Siegfried of certain requested documents.*

*\* Defendant Chase Chemical Company, by letter to the Court dated September 1, 1989, indicates its desire to participate in any depositions taken of the four inventors in this action.*

*While the Court intervenes in these disputes in order to expedite discovery, it wishes to impress upon the*

*parties its unwillingness to do so in the future. It is, after all, the purpose of discovery to advance the litigation so that it may proceed in an orderly manner within reasonable time constraints. It is not the purpose of discovery to harass the adversary with subterfuge and delay. [\*2] Counsel are advised to consider long and hard before entering into any further discovery disputes.*

*Discussion*

*A. Inventors*

*The four inventors whose depositions Siegfried wishes to obtain, Drs. Frederick Bessert, Wulf Vater, Kurt Bauer and Karl Heinz Adams, are former employees of Bayer who reside in Germany. Siegfried asserts that the four were major participants in the invention of the drug whose patent is at issue in this case. (Siegfried August 21, 1989 letter to the Court, at 2). On March 27, 1989, Siegfried served on the parties a notice of deposition of these four inventors. In a letter from Bayer to Siegfried dated April 21, 1989, Bayer notified Siegfried that the four were no longer employed with Bayer, thus Bayer presumably could not exert control over them to be deposed. (Siegfried August 21, 1989 letter to the Court, Exhs. A & B). Siegfried has demonstrated its need for deposing the inventors; their testimony is logically relevant to the determination of this action. In addition to the relevance of their testimony, the four inventors entered into a written assignment with*

*Bayer which states in pertinent part, "we hereby agree, whenever requested, to . . . testify [\*3] in any legal proceedings." (Siegfried August 21, 1989 letter to the Court, Exh. J). The Court interprets this clause to mean that the four inventors have agreed to testify in any legal proceedings, not just those proceedings in which Bayer would like them to testify.*

*Bayer argues that it is powerless to compel the inventors to testify in an American-style deposition and suggests that Siegfried request Letters Rogatory pursuant to German law and the Hague Convention. The Court disagrees with Bayer's position. The contract clause is clear. It makes no mention of an expiration of the inventors' obligation to testify nor does it invoke German law as controlling. Siegfried points out correctly that "Bayer . . . has come to a U.S. court, as a U.S. plaintiff, asserting a U.S. patent" (Siegfried August 6, 1989 letter to the Court, at 2), and therefore, in the interests of justice, must proceed according to the Federal Rules of Civil Procedure. The Court directs the parties to its decision in *Compagnie Francaise D'Assurance v. Phillips Petroleum Co.*, 105 F.R.D. 16 (S.D.N.Y. 1984). In that case, two French companies brought suit in the Southern District of New York for breach of contract, [\*4] then sought protection under the Hague Convention from discovery requests pursuant to the Federal Rules of Civil Procedure. This Court held, among other things, that plaintiffs were subject to discovery pursuant to the Federal Rules. The Court stated:*

*Plaintiffs come into this court seeking the protection of United States laws that enable injured persons to recover for breach of contract. Plaintiffs cannot avail themselves of these benefits, yet neglect their accompanying responsibility to disclose all relevant facts to their adversary.*

*Compagnie Francaise*, 105 F.R.D. at 32. The Court finds this logic to be wholly applicable to plaintiff Bayer.

In addition, Bayer is under a statutory injunction pursuant to the Food and Drug Laws, specifically 21 U.S.C. § 355, which permits it to delay for 30 months Federal Drug Administration approval of Siegfried's pending application for permission to sell its product. Siegfried correctly indicates that 21 U.S.C. § 355(j)(4)(B)(iii) requires that "the parties shall reasonably cooperate in expediting the action," and empowers the court to shorten the 30 month injunctive period for failure of either party to cooperate in expediting the action. [\*5] The Court finds that Bayer's actions concerning the inventors does not constitute "reasonable cooperation." Bayer's further refusal to make the four inventors available for deposition pursuant to the Federal Rules of Civil Procedure will result in this Court exercising its aforementioned powers, thus shortening the period of injunctive relief which Bayer is presently enjoying.

For the reasons set forth above, Bayer is ordered to make the four inventors available for deposition by Siegfried pursuant to the Federal Rules of Civil Procedure.

#### *B. Document Request*

*In a letter to the Court dated August 29, 1989, Bayer alleges difficulty in obtaining requested documents from Siegfried. To the extent that Bayer is already in possession of some of the documents at issue, the Court's intervention is unnecessary. However, as to those documents which Siegfried has failed to produce and to which Siegfried has admitted their "marginal relevance" (Siegfried September 12, 1989 letter to the Court), the Court orders that they be produced to Bayer no later than October 2, 1989.*

*SO ORDERED.*

*Dated: September 19, 1989, New York, New York*