

THE HIGH COURT

[2023] IEHC 376

[2021 No.1 PAP]

**IN THE MATTER OF IRISH PATENT NUMBER EUROPEAN PATENT (IE) 1 427
415 ‘LACTAM-CONTAINING COMPOUNDS AND DERIVATIVES THEREOF AS
FACTOR XA INHIBITORS’**

– AND –

**REGISTERED IN THE NAME OF BRISTOL-MYERS SQUIBB HOLDINGS
IRELAND UNLIMITED COMPANY**

– AND –

IN THE MATTER OF THE PATENTS ACTS 1992 TO 2019

JUDGMENT of Mr Justice Max Barrett delivered on 26th June 2023.

SUMMARY

This judgment is concerned with (i) an application made under O.31, r.11 RSC, and (ii) an application concerning the form of the undertaking as to damages to be given as the ‘price’ for an injunction granted.

1. This judgment is divided into two parts. Part A deals with the application made under O.31, r.11 RSC. Part B deals with the application concerning the form of the undertaking to be given as the ‘price’ for the injunction granted.

Part A

The Order 31, r.11 RSC Application

2. By notice of motion of 1 June 2023, Teva seeks, amongst other matters, an order pursuant to O.31, r.11 RSC requiring the respondent to answer further by *viva voce* examination, Interrogatories §5.20 and §5.22, served by the petitioner on 19th May 2022. In fact, only Interrogatory §5.22 is now the focus of this application, albeit in this judgment it has been necessary to refer also to Interrogatories §5.17 and §5.20.

3. I have touched upon the facts underpinning these proceedings at some length in my judgment on whether or not to grant the injunction and do not propose to repeat those facts here, save insofar as is necessary.

4. Throughout this judgment, even when quoting from documents that refer to full company names, I have found that it aids understanding to use ‘BMS Pharma Company’ for ‘Bristol-Myers Squibb Pharma Company’ and ‘BMS Company’ for ‘Bristol Myers Squibb Company’.

5. Unusually, I will commence my Part A judgment with a statement of the applicable law as it will make my consideration of Teva’s application more comprehensible.

6. Order 31, rule 11 RSC provides as follows:

‘If any person interrogated omits to answer, or answers insufficiently, the party interrogating may apply to the Court for an order requiring him to answer, or to answer further, as the case may be; and an order may be made requiring him to answer or answer further, either by affidavit or by viva voce examination, as the Court may direct.’

7. For the rule to apply, it must be shown that the interrogated party has either failed to answer an interrogatory or has answered it insufficiently. Teva relies on the latter limb, *viz.* that the answer to Interrogatory §5.22 is insufficient.

8. In *IBB Internet Services Ltd and Ors v. Motorola Ltd* [2013] IEHC 541, Charleton J. considered an application by the defendant that the secretary of the plaintiff companies should be required to answer by means of *viva voce* examination the interrogatories delivered by the defendant. (The background to that application was that the plaintiff's original replies contained a series of errors that were likely attributable to numbering/referencing mistakes. These were rectified in the second set of replies. In the course of his judgment, Charleton J. observed as follows (at §12):

*‘Even had there been a failure to satisfactorily answer an interrogatory, it is impossible to imagine the circumstances under which a party answering should be brought to court to be examined generally. Even an examination on specific questions will be rare indeed. An examination of some kind would not be impossible, since that is provided for in the rule. Before embarking on such course, however, the court should bear in mind that the principle adopted in our system is that the unitary trial is in general the mode of disposal of the case unless a preliminary issue of law or a modular issue will genuinely help in disposal and not cause irremediable prejudice. It is also important that any examination of a party or witness prior to trial should not become the trial itself....Should discretion on this rule be exercised in favour of either requiring a party to swear an affidavit or to appear and be questioned in court, any such leave must and should be directed towards specific numbered questions. It seems outside the text of the rule to envisage circumstances where a party would be granted leave to engage in a general cross-examination in advance of the trial. Any such procedure is properly to be confined to trial. Furthermore what is at issue in the rule is whether a party has answered an interrogatory or has answered the interrogatory sufficiently. It is no part of the discretion vested in the court to make any such order on the basis that it may appear that the answer is untruthful. That is a matter for the trial. As Cotton L.J. shrewdly stated in *Lyell v. Kennedy*...[1884] 27 Ch.D. 1, ‘with regard to the form of discovery by answer to interrogatories, what the court has to consider is simply whether the answer is insufficient. It has not to go into the question of the truthfulness of the answer, but must see whether it is insufficient or not.’*

9. My attention has also been drawn by Teva to the observations of Charleton J. (at §11) as to the obligation on a party answering interrogatories to correct any error immediately. I do not see that this aspect of the judgment of Charleton J. is especially relevant to the case before me. Here, BMS considers that its answers to the interrogatories posed to it are sufficient, which implicitly involves a contention that they are also correct: I do not myself see how one could properly contend that an answer which was wrong and which was known or became known to the interrogated party to be wrong could be, or could continue to be, described properly as sufficient.

10. When it comes to Charleton J.'s observation that 'Even an examination on specific questions will be rare indeed', I asked both lead counsel at the hearing of this application 'how rare is rare?' Both counsel have long experience of practice and neither, I understand, are aware of the jurisdiction having been exercised previously, though both accepted the jurisdiction to exist. Counsel for Teva gave a more detailed answer to my question and I respectfully agree with his statement of the position at law and in the present case, as stated in the following quotation from his answer to my question:

'Counsel: It's relatively rare and there would have to be a clear basis for doing so, which we say [exists] here....I think the way you approach the rare – I mean I genuinely can't say, but all I can say, Judge, is...it doesn't happen every day. You get cross-examination on discovery more often than you get cross-examination on interrogatories. And normally people are careful in replying and giving an answer. You may not like the answer; tough luck you didn't get a good answer and sometimes people say we shouldn't have asked that question. The rareness arises...only where there is an insufficiency....You can't say, you should have told us that before. You can't say, why did you give us a different [answer]...if the answer makes sense even if it's one that is inconsistent, it doesn't matter. You can't ask, 'please explain the errors that you made previously'....I cannot recollect, in my time...seeing an answer to an interrogatory that is self-contradictory on its face...[T]hat is the rare occasion....[H]ere, as Mr. Justice O'Moore said, it is critical - is how he put it – that...[Teva] can challenge the policy because whatever way you express the policy, you rely on that to sustain priority. If priority isn't sustained, the patent fails for novelty and we never get into an examination of the

plausibility issue that is the other issue in the trial.... So, that's why I think we meet the test....[I]t's hard to think when you would do it, other than somebody refusing to answer at all. But of course you can achieve a similar outcome, I don't want to be disparaging, but you achieve a similar outcome by giving an answer that's nonsensical. And it's like the witness who gives the nonsensical answer and you pursue it and say you haven't answered the question. And that's why I think we meet it here.'

11. A key message to be taken from the just-quoted submission is that it is the very oddness of the situation that presents here, in which (a) the party interrogated has given an answer that, on its face, is inherently contradictory, and (b) the centrality to these proceedings of the interrogatory/issue in respect of which the inherent contradiction arises, that has yielded a situation in which a relief that is rarely granted can properly be ordered.

12. Charleton J. mentions the decision of the Court of Appeal in *Lyell v. Kennedy (number 3)* [1884] 27 Ch.D. 1. That case involved an appeal by the plaintiff from an order of Bacon V.C. , dismissing a summons taken out by the plaintiffs asking for a declaration that the defendant's answer to interrogatories was, having regard to the answers to certain interrogatories specified in the summons, insufficient, embarrassing and 'impertinent' – I suppose for this last term we would nowadays state 'not pertinent' or 'irrelevant' – and sought, amongst other matters, that the defendant might be ordered to file a further and better answer.

13. Among the conclusions reached by the Court of Appeal in *Lyell* (and this remains good law in Ireland today) were that the duty of the court when it comes to answers to interrogatories is limited to considering the sufficiency or insufficiency of an answer. Notable among the observations of the Court of Appeal judges, when it comes to the application now before me, is the observation of Cotton L.J., at 16, that '*I say he has not answered, because he has answered it in such a way that we cannot tell what he wished to state and what to deny*'.

14. As will be seen hereafter, this is a case in which an interrogatory has been answered in such a way that it is, on its face, inherently contradictory. The answer points in one direction; materials referenced therein point in the other direction. I do not myself see how such an answer could be described as sufficient. I am buttressed in this conclusion by the just-quoted

observation of Cotton L.J. in *Lyell*. If an interrogatory presents with the ostensible contradiction that I have just described (which ostensible contradiction presents here) it would seem generally to follow (and certainly it is the case here) that there is no sufficient answer because in answering in a manner which is ostensibly self-contradictory, the interrogated party ‘*has answered...in such a way that we cannot tell what he wished to state and what to deny*’.

15. I turn now to the substance of the present application which originates ultimately in the fact that my colleague, O’ Moore J., made an order on 20th October 2022 requiring BMS to provide responses to Interrogatories §5.20 and 5.22 which read:

§5.20 Other than the emails of 19th October 2001 and 24th October 2001, was not the said policy of BMS Company reduced to or evidenced in writing?

§5.22 Did not BMS Company have a written policy governing the manner in which the IP of BMS Pharma Company was to be held?

16. These interrogatories are important, given that O’Moore J., in observations of 13th October 2022, rightly described the question to which they relate (the existence of any written policy regarding ownership of the IP) as of ‘*critical importance*’ to the end-decision of the court in the as yet to-be-heard substantive proceedings.

17. The relief sought in the present motion is confined to Interrogatories §5.20 and §5.22 (and by the time of the hearing had netted down to Interrogatory §5.22 only). Those two net questions relate to what the parties refer to as the ‘priority ground’ which I will consider in a little more detail later below.

18. By way of the affidavit of Mr Scott Brown, sworn on 10th March 2023, BMS has provided further and better replies to Interrogatories §5.20 and §5.22. That affidavit exhibits some never before disclosed documents which are important when it comes to the priority ground but which, at least ostensibly, seem irreconcilable with the answers given by Mr Brown in the affidavit of 10th March.

19. I turn now briefly to discuss the priority ground. These proceedings are substantively concerned with the validity of Irish Patent EP (IE) 1427415 and an associated supplementary protection certificate which expires on 19th May 2026. A priority date of 21st September 2001 is claimed for the patent from US patent application US324165.

20. The compound which BMS asserts is protected by the patent is known as apixaban and BMS's apixaban product is approved in Europe for the treatment and prevention of deep vein thrombosis and pulmonary embolism. Eliquis is BMS's highest revenue producing product and one of the most profitable drugs in the world.

21. Teva maintains that the patent is invalid by reason of lack of novelty, lack of plausibility, and on the basis that the patent is not entitled to claim priority from US165 (the priority patent). It is common case between the parties that if Teva succeeds on the priority ground, the patent will fall. To understand the priority ground it is useful to provide a brief chronology, the following dates being key:

17 September 2002. Patent application filed by BMS Company claiming a priority date of 21st September 2001 based on US Patent Application 165. A critical alleged problem presenting is that US 165 was owned by BMS Pharma Company and not BMS Company on the filing date. Between the claimed priority date and 17th September 2002 there was an intervening patent application which would destroy the novelty of the patent if the claimed priority date of 21st September 2001 was not available to BMS.

April 2007 and December 2016 On Teva's view of matters BMS Pharma 'purports to' assign US patent application 165 to BMS Company. There appears to be no evidence or suggestion of an assignment of US patent application 165 (or a right to claim priority therefore) prior to the filing date.

22. Among its arguments, BMS claims that BMS Company has equitable title in all assets held by any BMS entity by reason of its ownership of those entities and its right of control by laying out the policy of IP ownership for BMS Pharma.

23. Teva raised interrogatories concerning, *inter alia*, what has become known in these proceedings as the BMS policy. By way of background, a policy concerning legal entity registration was alleged to have been set out in an email of 24th October 2001, which refers to recommendations by lawyers to maintain legal ownership in BMS Pharma (formerly DPC) (Interrogatory Answer §5.17). In full, BMS's answer to Interrogatory §5.17 reads as follows:

‘5.17 Did not BMS Company lay out the policy as to how patents were to be held as between BMS Company and BMS Pharma Company?’

Answer: More precisely it laid out the policy as to ‘legal entity registration’ of patents from the acquired DuPont pharmaceutical business which was to ‘maintain legal ownership in BMS Pharma Company’ in respect of existing rights already residing there and to put new patents and trademarks in the name of BMS Company.

Response: Insufficient Reply. If ‘it’ is intended as a reference to the email of 24th October 2001, does not that email concern a ‘recommendation’ by the tax department of BMS Company and not a decided policy of any entity?

Is it not erroneous to state that the email of 24th October 2001 contains a single policy or recommendation ‘...as to legal entity registration’ of patents from the acquired DuPont pharmaceutical business?’ Rather is it not the case that there was a recommendation for different treatment of these categories of ‘Du Pont Pharma’ patents and trademarks?

Further Answer: BMS Company controlled how the IP acquired in the Du Pont acquisition should be held and dealt with. The email of 24th October 2001 is evidence of part of that process whereby the proposed policy at that point, just after acquisition, as to how the rights were to be held was circulated and comment

invited. The implementation of the policy is the province of oral evidence to be given at trial.’

24. Interrogatories §5.20 and §5.22 essentially enquire as to whether there is any other evidence of ‘the said policy’. In reply to §5.20, Mr Brown avers as follows, in his affidavit of 10th March (at §9):

‘To the best of my knowledge, information and belief, other than the emails of 19th October 2001 and 24th October 2001, the ‘said policy’, *i.e.* the decision to maintain legal ownership in BMS Pharma Company in respect of existing rights already residing there **and to put new patents in the name of BMS Company** was evidenced in writing in the following materials which I outline in the paragraph below.’ [Emphasis added].

25. Unfortunately, the materials that follow appear, ostensibly, to show that the policy of BMS was completely different to the ‘said policy’ (which the answer to Interrogatory §5.20 seeks to address). Thus, the materials indicate that any patents filed before 1st October 2001 should be filed in the name of BMS Pharma and (this would seem ostensibly to be of significance) that **‘all subsequent filings** worldwide claiming this priority’ **should be in the name of BMS Pharma** (*i.e.* not BMS Company). [Emphasis added].¹

¹ This last statement is contained in an email dated 30th January 2002 from Mr Blair Ferguson to Ms Lori Allaire. Mr Ferguson was a senior person within BMS and is described by Mr Brown as ‘Chief Patent Counsel at BMS, having previously been head of the DuPont Pharma Patent Department’, at the relevant time. That title was previously held by Ms Marla Matthias, a witness for BMS in parallel proceedings in Sweden. The email was circulated to a large number of recipients and was then forwarded by Ms Allaire to a further 47 recipients on 1st February 2002. The statement was then replicated in a training manual directed to certain BMS employees with responsibility for filings. That manual states, among other matters, ‘You will need to change the Recordation Cover Sheet to enter BMS Pharma Company as the form defaults to BMS Company’. The manual was sent to 44 recipients by email dated 12th June 2002, Mr Ferguson among them. Mr Brown has confirmed that the manual was updated from time to time and that subsequent editions up to 6th September 2005 have been identified as including the just-quoted wording. I understand that ten iterations of the manual have been produced in discovery, with no material differences to the relevant text.

26. Thus, on the face of things (and it may be that there is good explanation, which will be found at the trial of the substantive hearing to be established) there is an ostensible contradiction between the answer to Interrogatory §5.20 and the materials that follow that answer.

27. A like ostensible contradiction presents when it comes to Interrogatory §5.22. That Interrogatory and the related Answer state as follows:

‘5.22 Did not BMS Company have a written policy governing the manner in which the IP of BMS Pharma Company was to be held?’

Answer: To the best of my knowledge, information and belief, no written policy of the manner in which the IP of BMS Pharma Company was to be held has been identified, nor am I aware of any, save to the extent that the October 2001 emails and the additional documents described herein address that.’

28. I note in passing that, if it is properly to be understood, Interrogatory §5.22 and the answer thereto must be looked at in the context of Interrogatory §5.20 and the answer thereto, and likewise if one is properly to understand §5.20, it must be looked at in the context of Interrogatory §5.17 and the answer thereto.

29. I note also that the ostensible contradiction was queried by Teva as early as a letter of 5th April 2023. (There was suggestion that Teva had delayed in raising the issue or delayed in coming to court. The chronology of events does not bear this out).

30. Teva has identified a number of difficulties that present as a result of the ostensible contradiction:

- first, it maintains (correctly) that the interrogatories posed are important to the priority ground.
- second, it notes that the importance of the question of whether there was a written policy for the holding of patents was emphasised by O’Moore J. when making the order.
- third, it contends that the latest answers to Interrogatories §5.20 and §5.22 are

inadequate, that rather than clarifying matters, they yield confusion, stating one thing in the text of the interrogatories but referring into materials that appear to embody a contradictory policy. (Again, this application is now confined to Interrogatory §5.22).

- fourth, it contends that the apparent clash is inadequately explained.
- fifth, it complains that it is BMS’s lawyers, rather than Mr Brown, that have sought to explain the ostensible contradiction.
- sixth, arising from the interrogatories affidavit evidence and materials, Teva sought in a letter of 8th May 2023 to clarify BMS’s case, only to receive a reply a week later to the effect that BMS’s case was as pleaded and that it was inappropriate to seek a similar statement in correspondence.
- seventh, Teva has emphasised that (i) it is a stranger to the facts underpinning BMS’s claim of beneficial ownership of US patent application 165 as of the filing date, (ii) the priority ground is one in respect of which BMS is the sole custodian of fact and bears the burden of proof, (iii) it (Teva) has pursued procedural mechanisms to clarify BMS’s case (interrogatories, discovery and correspondence) and that (again) rather than increasing clarity presenting, there is a worsening lack of clarity presenting concerning what are highly relevant matters.

31. Teva also complains that it has not been provided with an adequate explanation as to how the documents now being disclosed were overlooked when Mr Brown was first replying to the interrogatories. However, this aspect of matters is an argument for a later day. Teva’s motion in relation to alleged inadequacy in the discovery process has been adjourned to the substantive hearing and Teva has expressly reserved its entitlement to challenge BMS’s discovery efforts, including its failure to disclose interrogatory materials at an earlier stage. This being so, I have not treated in this judgment with any concerns/explanations as to the discovery process.

32. In summarising the issue that the ostensible contradictions present, counsel for Teva succinctly put matters as follows at the hearing:

‘Now, BMS may be able to satisfy you at trial that that contradiction doesn’t exist. I don’t think you have to determine that at the moment. What you have to say is, I

look at this answer, I read this answer, on its face it appears contradictory, it requires an explanation....[W]hat we have to have to get is the answer to the interrogatory that is an answer that is not undermined by an insufficiency....[Y]ou can't answer in a way which frustrates the identification of important evidence, critical to the case as identified by Judge O'Moore....So, it is critical and I don't want to embroil you anymore in the consequences of that. My friends seek to do so and offer some explanation but that's not appropriate. All I have to do is establish, on its face, the insufficiency.' [Emphasis added].

33. I respectfully agree with the just-quoted submission, in particular the proposition that my proper focus in approaching this application is whether the impugned answer on its face appears contradictory, requiring explanation in one of the forms mentioned in O.31, r.11 RSC.

34. The proposed form of examination is very limited. In fact it is intended to pose only the following four questions, subject to a possible nuancing of the questions between now and the examination:

- (1) Is the policy set out in the manual and an e-mail of Mr. Ferguson to Ms Allaire dated 30th January 2002 not different from the '*said policy*' because that is how it is described in the original answers to interrogatories.
- (2) Is the policy set out in the manual and that e-mail not the policy of BMS company in relation to assignments?
- (3) Was not the policy set out in the manual implemented?
- (4) Was not the policy set out in the manual followed in the present case?

35. As can be seen these questions are very narrow and do not stray into the type of exercise against which Charleton J. cautioned in *IBB*.

36. Counsel for BMS made the following key observations at the hearing. I will refer to these as BMS Contention/s 1, 2, 3 *etc.*

37. First, counsel for BMS contended that the focus now is on Interrogatory §5.22 and the four questions that Teva wants to put. However, these are questions that were not

asked by way of interrogatory. In short, according to counsel for BMS ‘There has been no failure to deal with an interrogatory. The interrogatory asked was answered. The answer is clear and there’s no insufficiency that would affect Teva’s ability to rely upon it when we get to trial.’

38. With respect it does not suffice that an interrogatory has been answered. The test where an answer has been provided is whether the answer is sufficient. As I mentioned above, this is a case in which an interrogatory has been answered in such a way that it is on its face inherently contradictory. The answer points in one direction; referenced materials point in the other direction. I do not myself see how such an answer could be described as sufficient. I am buttressed in this conclusion by the above-quoted observation of Cotton L.J. in *Lyell*. If the answer to an interrogatory presents with the ostensible contradiction that I have just described (which ostensible contradiction presents here) it would seem generally to follow (and certainly it is the case here) that there is no sufficient answer. This is because in answering in a manner which is ostensibly self-contradictory, the interrogated party, to borrow from Cotton L.J. ‘has answered...in such a way that we cannot tell what he wished to state and what to deny’.

39. Second, counsel for BMS contended that it does not suffice for an application of the sort now presenting that Teva wished it had asked some other question or that there was something else they would like to ask. Sufficiency or insufficiency of an answer to an interrogatory is determined by reference to whether the answer is capable of being treated as an answer to the question being asked, or whether there is so much additional, irrelevant or objectionable material that the ability to rely upon the answers given to the interrogatories asked is undermined.

40. It seems to me that this contention is met by the answer that I gave to BMS Contention 1.

41. Third, counsel for BMS contended that Teva seeks a relief that (i) is rarely granted, (ii) on questions that they could have asked and did not ask and now want to move to something that is (iii) quite exceptional and, BMS maintains, (iv) ‘significantly destructive’ to BMS’s preparation of the trial.

42. As to (i), just because a relief is rarely granted does not mean that it should not be granted

in circumstances where it is merited. In the case before me, I see the relief sought to be merited for the reasons I have stated in relation to BMS Contention 1.

43. As to (ii), I note, and respectfully agree with, the following observations made by counsel for Teva at the hearing of this application:

'The...point that he makes which I find, with respect, puzzling, is that the questions we want answered are not questions we've already asked. Of course that's the case. The questions we want answered are directed to the unsatisfactory answer. They made no sense, prior to getting that answer...[The confusion]...has arisen from the answer. We could never have asked it before.'

44. I would only add to this that if it were the case that an interrogatory no matter how unsatisfactorily answered ought to be followed by a further interrogatory, then it seems to me that no-one could ever avail of the relief available under O.31, r.11 RSC, for it would always be argued that another interrogatory could have been or ought to have been put. Yet the relief for insufficiency, though rarely granted, can be sought and, where appropriate, granted. There will be circumstances, such as those that present here, where one can cross the Rubicon, enter into the realm of rarity, and properly order relief under O.31, r.11 RSC.

45. As to (iii), exceptionality is but another way of referring to rarity and has been treated with under point (i).

46. As to (iv), I admit to some surprise at this line of contention. If anything, it is BMS by its failure to provide a non-self-contradictory answer to a straightforward interrogatory that, at this moment in time and in this particular regard, is impeding a swift and fair trial of the issues arising between the parties. Pursuant to this judgment, Teva will get to put its questions sometime in the week commencing 26th June 2023. The substantive hearing of this case will commence before me on 4th July 2023. That is a very tight timeframe for all concerned.

47. Fourth, counsel for BMS pointed to the limitations identified in the above case-law concerning the relief now sought, including the rarity of the relief sought.

48. As to whether the relief sought should be granted, please see my observations in relation to BMS Contention 1. As to whether this is a case in which a relief rarely granted should be granted, please see my observations in relation to the first contention above and also the second contention.

49. Fifth, turning to the specific questions that it is proposed now to raise in the *viva voce* examination and relating those back to the substance of the interrogatories previously raised, counsel for BMS observed as follows:

[Re Question 1] Is the policy set out in the manual Blair Ferguson e-mails not different from the said policy?

How does that arise, Judge, in respect of a question that's asking you about the existence of a written policy?

I believe it is helpful to focus on the question/test that actually arises for me to address in the within application, rather than the above-quoted question. The question/test is whether the impugned answer is sufficient or insufficient. I have concluded that it is insufficient for the reasons stated in the context of BMS Contention 1].

[Re Question 2] Is the policy set out in the manual Blair Ferguson e-mails not the policy of BMS in relation to assignments?

Again, I'd make the same observation, Judge.

I would make the same observation as is made in respect of Question 1].

[Re Questions 3 and 4] Was not the policy set out implemented?

and then

Was not the policy not followed...in the present case?

...[T]he reason there's so much care, Judge, about ordering any further interrogatory or indeed viva voce evidence...is you look at the question asked and you determine whether the answer is sufficient. You don't look at the question asked and say well, they could have asked another question. That's utterly unfair and it's certainly not fair to put somebody like Mr. Brown in a position of being examined vive voce in relation to another question that can be asked.'

I respectfully agree that the test is that of whether the answer is sufficient or insufficient. I have concluded that the impugned answer in this case is insufficient for the reasons stated in respect of BMS Contention 1. As to the text from 'That's utterly unfair...that can be asked', I respectfully consider the following flaws to present in this line of argument. First, it seems to me that it will always be the case when the relief that I am going to grant in this application is granted that some other, different question will be asked of the interrogated party. Why would an applicant seek to ask the same question? Second, the rules contemplate a *viva voce* examination as a form of relief that can be granted in this regard. So I do not see how the granting of such a relief would fall correctly to be castigated as '*utterly unfair*'. For the reasons stated in this judgment, I consider the granting of such a form of relief to be appropriate and merited here and not at all unfair.

50. Sixth, counsel for BMS submitted that the issue that was the subject of the interrogatories put is an important issue. That is why the interrogatories were raised. Then the point was put by counsel for BMS that '*...they're a fully resourced team on the other side. They deliberated on the interrogatories. They raised 115 of them. They pursued 12 and got an order in relation to Interrogatories §5.20 and §5.22 and none of those interrogatories accommodate the questions that we're now told they want to put to Mr. Brown*'.

51. With respect, it does not matter if Teva has one lawyer or 1,000 lawyers acting for it. The test to be applied in the present application is whether the answer that is given is sufficient or insufficient. When it comes to the impugned answer, I have concluded that it is insufficient for the reasons stated in the context of BMS Contention 1. As to the point that 'none of those

interrogatories...put to Mr Brown’, this is a repackaging of the ‘Why weren’t the proposed questions that it is now sought to ask of BMS asked before?’ line of contention. I have respectfully rejected this line of contention in my response to BMS Contention 3, point (ii) above.

52. Seventh, counsel for BMS contended that it would drive a coach and four through, e.g., the judgment of Charleton J., that these orders should rarely be made, if orders are made in a case where the interrogatory itself and the answer to it do not accommodate the questions asked.

53. This seems to be but a further repackaging of (a) the ‘Why weren’t the proposed questions that it is now sought to ask of BMS asked before?’ line of contention, and (b) the rarity point. As to (a), I have respectfully rejected this line of contention in my response to BMS Contention 3, point (ii) above. As to (b), I have also treated with this issue in my response to BMS Contention 3.

54. Eighth, counsel for BMS addressed the alleged discovery concerns and sought to explain away the ostensible inconsistency presenting.

55. Both issues it seems to me are extraneous to this application. The alleged frailties of the discovery process will be considered at the trial. And my focus is not on what the explanation for the ostensible contradiction may be but whether what presents is an answer to an interrogatory that is or is not sufficient.

56. On a separate note and without prejudice to his other arguments, counsel for BMS indicated that if the court was minded to grant the relief sought by Teva in this application the appropriate step would not be to require a *viva voce* examination of Mr. Brown but to direct that the proposed questions (which were first raised at the hearing of this application) be furnished to BMS, with Mr Brown to answer them by way of affidavit replying to interrogatories. Counsel for BMS described a *viva voce* examination as the ‘*nuclear option*’; however, O.31, r.11 RSC makes no such distinction between the two forms of remedy that it contemplates and clearly views each as – if I might continue with the nuclear metaphor – equally conventional.

57. For the reasons stated in this Part A of my judgment, I will grant the relief as now sought by Teva, being focused on Interrogatory §5.22. Order 31, rule 11 RSC contemplates that an order may be made requiring an interrogated party to answer further, either by affidavit or by *viva voce* examination. As I understand the contention of counsel for BMS, he considers it would be more appropriate for his client to answer by affidavit the four questions to be posed by Teva because he has not previously been offered a chance to answer those questions by affidavit. I can see a logic to that. However, it seems to me that the overriding concern is that the further answers need to be provided as promptly as possible, given that the trial is commencing next week (with the parties able properly to prepare for trial thereafter). That being so, and my own sense being that a *viva voce* examination will more quickly be done, I will order that matters proceed by way of *viva voce* examination.

58. Finally, BMS mentioned in argument that Teva's French lawyers in France in parallel proceedings to these proceedings have alleged before the French courts that BMS has been deceitful in these proceedings. The suggestion was made that I would consider this as a factor in deciding how to proceed in the within application. Five points might be made in this regard. First, I struggle to see how what one or more French lawyers have said in a French court as to Teva's perception of how BMS has conducted itself in Irish proceedings would be factored in by me into a determination as to the sufficiency or insufficiency of an answer given to an interrogatory in Irish proceedings or the relief to follow. Second, if BMS is upset by what has been said in the French proceedings it seems to me, with all respect, to be big enough, rich enough, and capable enough to make its views known in those proceedings. Third, it seems to me that the comity of the courts, and simple good manners, require that I should respect the French court as the master of its own proceedings (and I do) and not start taking a view on matters that are properly within the purview and subject to the oversight of the French court. Fourth, if the notion is (and this was not expressly stated) that the relief being granted is a discretionary one and I should refuse the relief because I take a dim view of what has transpired in the French proceedings, that would seem to me to be a completely inappropriate step which (a) would be disrespectful of the French court as the master of its own proceedings and as the forum where complaints as to the conduct of the French proceedings ought properly to be raised, and (b) might lead the French lawyers acting for Teva in France to feel somehow constrained in what they could say before a French court for fear of how it would be viewed in an Irish court. Fifth, even if I am wrong in the preceding points (and I do not see that I am) the conduct

complained of is so remote to these proceedings that even if I were to factor it in (and, for the reasons stated, I will not), I would not alter my view as to the correct course of action to take in these proceedings.

Part B

The Form of the Undertaking as to Damages

59. Following my judgment of 17th February and the order made pursuant thereto on 23rd March 2023, Teva is subject to the following injunction:

‘the Defendant whether by itself or its directors, officers, servants or agents be restrained from infringing Supplemental Protection Certificate No. 2011/032 (the ‘SPC’) and, in particular, by making, offering, putting on the market and/or using and/or importing or stocking for the aforesaid purposes, a generic version of the Plaintiff’s medicinal product Eliquis (active ingredient) apixaban) pending the determination of the proceedings by the High Court.’

60. Following the delivery of my judgment, the parties engaged in correspondence regarding the order that should issue and the form of the undertaking.

61. Teva’s position is that inclusion of related companies in the undertaking in damages is proportionate and necessary to ensure that all losses sustained by Teva (including losses via and through entities related to Teva) as a result of the grant of the injunction are unambiguously covered by the terms of the undertaking. Teva has identified two bases for this:

– first, it would (it claims) be unworkable for the injunction and undertaking to list every individual entity in the Teva group of companies which may be restrained in their activities by the injunction and every entity which may suffer loss arising from the injunction. Teva maintains that (a) it is unrealistic to expect that the corporate structure of an international pharmaceutical company, such as the Teva group of companies, would remain static for the period of the injunction and (b) it would not be an efficient use of court resources (and presumably, though Teva has not made this point, of *its* resources) for the parties to appear

before the court each time a company with the Teva group of companies sought to be included in the undertaking as to damages.

– second, due to the reference to ‘directors, officers, servants or agents’ in the injunction that entities other than Teva (the sole defendant to the injunction proceedings) will be subject to the injunction and that the harm caused to Teva (Teva claims) may in turn cause and/or manifest itself in damage to related companies.

62. BMS does not see that related companies should be included in its undertaking to the court as to damages. Its view is that (i) BMS issued its injunction proceedings against Teva, as that was the company that had obtained marketing authorisation and indicated an intention to launch at risk, and (ii) no rational explanation has been provided as to why damages should be extended to other entities not enjoined by the order.

63. The critical issue before me, in effect, is what form of undertaking ought to form the ‘price’ for the injunction granted to Teva.

64. The following is the form of resolution mooted by Teva:

‘I note the Plaintiff’s undertaking to the Court that if the Court later finds that this order has caused loss to the Defendant and/or its related companies as defined in the Companies Acts, and decides that the Defendant and/or its related companies should be compensated for the loss, the Plaintiff will abide by any order which this Court may make.’

65. In approaching this application, I have found it useful to keep this exact form of wording very much to the fore of my mind.

66. Counsel for Teva opened her argument with the following seven observations:

‘First...I...acknowledge...that this is not the usual form of undertaking in a plain vanilla injunction case and it is, therefore, novel in this jurisdiction. As you said yourself on the last occasion, it does raise issues which require further

exploration....

[S]econd...like all cross-undertakings, [it] is an undertaking to the Court and...not an undertaking to Teva.

[T]hird...and this is an important point...this undertaking does not require the Court to assess damages now. There are two inbuilt contingencies. The first one being that there has to be a finding that the injunction order has caused loss to the related entity, and, secondly, there has to be a finding that the Group companies should be compensated. So, this is really...just to preserve the status quo if and until those orders were made. And that would be in the context of a full inquiry hearing into damages and so on, at another day with lots of evidence and so on....

[F]ourth...there is no prejudice to BMS in the making of this order. BMS's interests are fully protected insofar as they can argue all of the points they want to make at the damages hearing where the Court will have at large jurisdiction to look into causation, quantum, all of those issues. There has never been, to the best of...knowledge [of all of Teva's counsel]...a damages module in an Irish patent case so that is new territory. But the order is just intended to preserve all of the parties' interests in such a hearing. It's not to pre-judge it in any way or to create an entitlement as of now, it's just to preserve the option, I suppose. And the preservation of that option I have to say...does have real commercial significance for my client....

[F]ifth...there is no suggestion that we're seeking enhanced damages in any way. The loss is the same....It's just where that loss is accounted for within a complex group of companies....

[S]ixth...whatever form of undertaking is ultimately ordered...whether it's my broader version or [BMS's]...narrower version, it must, we say, date back to the date of the injunction order....

[S]eventh...this application for an expanded undertaking in the form which we have gone through is...not an abuse of process....BMS's self-described primary position on this application is that this is an abuse of process. Even asking you, Judge, to consider extending the cross-undertaking to Group companies is described in terms...as a cynical abuse of process and a collateral challenge to your judgment and order....[That argument involves] a misapprehension as to the argument that is being made. It seems to be posited that Teva's seeking this undertaking in favour

of related companies and if it doesn't get it, it will look for the injunction which you granted, to be set aside, for that reason alone. That's not an argument that has ever been made by Teva.'

67. I will come back to some of these points later below.

68. After I gave my judgment in the injunction application and after the possibility of this application was mooted I asked that an affidavit would be put in by Teva to explain the rationale for what is now being sought by it. A helpful affidavit has been provided by Teva's general counsel. She avers, amongst other matters, as follows:

'While Teva Ireland will suffer the initial loss and damage because of the injunction, there are arrangements in place in respect of profit sharing within the Teva Group of Companies, which will result in indirect loss to other companies within the Teva Group of Companies. In broad terms, whilst Teva Ireland would have, but for the injunction, made and accounted for the sale of Apixaban Teva to customers in Ireland, a significant proportion of the margin (i.e. profit) would have been transferred (by transfer pricing) to another company in Teva Group of Companies. The structure of these arrangements is highly confidential and I do not believe that particularising the terms of any such arrangements at this point will assist the Court. I am informed that a damages inquiry itself may be the appropriate forum for further detail to be provided.

In addition to this, and as is clear from the case law and from my own experience, structures within multinational pharmaceutical companies change over the years and thus, the fact that Teva Ireland is now the MA holder and the company intending to commercialise the product, does not necessarily mean that it will remain so.

...

Due to the references to 'directors, officers, servants or agents' in injunction, entities other than Teva Ireland (the sole Defendant to these proceedings) would be subject to the injunction and the harm caused to the Defendant may in turn cause and/or

manifest itself in damage to related companies. If BMS has secured the benefit of an injunction extending beyond restraining Teva Ireland, then the undertaking in damages (being the quid pro quo for that injunction) should reflect this.'

69. I indicated to BMS, at the time that I asked Teva to put in an affidavit, that BMS was welcome to put in a replying affidavit. It has not done so. I make no criticism of BMS for this. It must run its case as it sees fit. I simply mention it by way of explanation as to why I am not considering any affidavit evidence from BMS.

70. I turn now to consider certain English caselaw of interest and to consider also the separate but related question as to whether I have jurisdiction to make the form of order now being urged upon me by Teva. (It is probably helpful to note at this juncture that ultimately I conclude in this judgment that (i) the Irish courts *have* identical powers and jurisdiction to make the orders that are granted in the two English cases that I now proceed to consider, and (ii) the same equitable jurisdiction falls to be applied in Ireland as in England, albeit that in Ireland that jurisdiction flows from a particular pre-Independence Act of the Westminster Parliament – the Supreme Court of Judicature Act (Ireland) 1877 – which does not apply in England).

71. The first case to be mentioned in this regard is *Actavis Group v. Boehringer Ingelheim* [2013] EWHC 2927 (Pat.). That was a set of 'clear the path' proceedings brought by Actavis. In those proceedings, Actavis agreed not to launch and Boehringer provided a cross-undertaking by agreement. So, there was not an injunction. Rather what presented was a consensual situation where there was an agreement not to launch and a cross-undertaking given voluntarily. Although peace had to some extent broken out between the parties, a dispute emerged as to the scope of the cross-undertaking that ought to be given by Boehringer. Actavis wanted the cross-undertaking to cover all Actavis companies and Actavis customers. Boehringer said it should cover Actavis UK only and possibly named entities, but not an open-ended formulation such as Actavis group companies. In the course of his judgment Birss J., as he then was, observes as follows:

'19. The other issue I have to decide relates to the cross-undertaking. Actavis has offered an undertaking not to commence marketing of the combination product. However, as I have said, an issue arises about the appropriate form

of the cross-undertaking to be offered by Boehringer Ingelheim.

20. *Paragraph 5.1A of the Practice Direction to CPR Part 25, that is PD25A states:*

'When the court makes an order for an injunction, it should consider whether to require an undertaking by the applicant to pay any damages sustained by a person other than the respondent, including another party to the proceedings or any other person who may suffer loss as a consequence of the order.'

21. *I should say that it is common ground and I agree that the fact that in this case I am not making an order for an injunction but accepting undertakings from the respondent does not make any difference. This Practice Direction plainly applies in both circumstances.*

[Court Note: One of the points made by BMS before me is that the *Actavis* case can be dismissed as irrelevant because it arose in the context of a voluntary undertaking by Actavis not to launch, whereas here Teva has been enjoined. Teva contends that when one has regard to how Birss J. proceeded this is a distinction without a difference, for Birss J. proceeded as though he were confronted with an injunction scenario. I believe myself that the truth lies between the two positions canvassed by counsel. Birss J. was presented with a consensual agreement scenario where there was a dispute as to the undertaking. So the latter issue was the sole issue before him, *i.e.* the proper form of the undertaking. I was presented with an injunction application in which, after I indicated that I would grant the injunction in proceedings to which one Teva entity was party, a dispute then arose as to the form of the undertaking, the suggestion being that it should extend to multiple Teva parties. It follows from the foregoing that the factual matrix that presented before Birss J. and that which presents before me are different. However, a precedential system of justice does not proceed on the basis that one must find an exactly similar previous case but rather on the basis that a previous case is

sufficiently similar as to give a useful and sometimes binding intimation as to how one might or ought to proceed. Here, one is dealing with non-binding case-law from a foreign jurisdiction. Nonetheless, there is sufficient similarity between the facts of this case and *Actavis* and with the form of jurisdiction exercised by the court in *Actavis* that it would be folly to proceed as though it were a completely irrelevant judgment. It is a relevant and useful precedent.]

...

[Court Note: Birss J. then moves on to consider the arguments made by Boehringer before him, which are notably similar to those made by BMS in the case before me.]

24. Boehringer....submit that, in order for the court to consider whether to extend the cross-undertaking in this way, the court needs to be told who the people to whom the order would extend are and there is no such evidence.

25. Mr. Carr, who appears for Boehringer Ingelheim, also points out that Actavis must know what other Actavis companies are involved and he refers to the letter dated 29th April 2013 in which the solicitors for Actavis made it clear that the particular company which will be making the relevant sales in the UK was Actavis (UK) Limited, the second claimant, and he submits that, if that is right, there is no reason to extend the cross-undertaking any further.

26. Mr. Carr also submits that the wording of the order in paragraph 4 referring to customers or potential customers is unclear and may lead to potential further significant disputes.

...

[Court Note: Birss J. then essentially goes on to conclude that neither party had been able to point to any decision dealing with the type of issues before

him. I understand that the same position presents as a matter of Irish case-law, though of course I am proceeding with the benefit that there is illuminating English case-law].

31. Mr. Meade submits that the orders sought are fair. He says in particular that, in relation to the Actavis Group, that is a certain class of persons who will be covered by the undertaking and setting the cross-undertaking up in this way avoids a problem which might otherwise arise with a cross-undertaking which may well last for a couple of years, for example, if there was a corporate restructuring in the Actavis Group, which leads to different companies who would otherwise have been involved in the sale or the production of the tablets to be sold in this case becoming companies which ought to be able to recover on the cross-undertaking.

[Court Note: That is the issue that is being raised by Teva here. Birss J. continues as below].

...

32. Paragraph 5.1A of the practice direction was, I believe, inserted into the practice direction following the judgment of the Court of Appeal in SmithKline Beecham v. Apotex [2006] EWCA Civ 658, in particular, I suspect, following what Jacob L.J. said in paragraph 29 of that judgment. Since then, as far as I am aware and as far as counsel and the solicitors instructing them have been able to show me, there has been no case dealing with the principles to be applied in the application of paragraph 5.1A.

33. In considering the matters which the Practice Direction requires, the court ultimately is undertaking the exercise of discretion with the aim of doing justice not just to the parties before the court, but generally.

[Court Note: This is the same jurisdiction that I am being asked to exercise].

If a class can be identified at this stage for whom justice demands a cross-undertaking should cover before an injunction is ordered or an undertaking accepted, then the court should require the cross-undertaking to be drafted accordingly. For example, in the case of freezing orders, as I understand it, it is common practice and has been for many years that the cross-undertaking in question is drafted so as to extend to cover the expenses of persons, such as banks, which they might incur in complying with the order.

34. However, it seems to me that for the court to exercise this discretion, it needs to know, in some way at least, who the relevant persons are. They do need to be identified at least in some suitable way and also the court needs to know what may be the nature of the potential loss or harm which is said may potentially arise.

35. A cross-undertaking has been called the price of an injunction and, in the end, it seems to me that the person paying that price needs to know with reasonable certainty what it is. It could be, in a given case, that the price demanded would be too high. A party seeking an interim injunction, or accepting undertakings in lieu of an interim injunction, is entitled to be wary of an indeterminate and open-ended cross-undertaking in favour of persons unknown.

[Court Note: It seems to me that the quoted text from the last ‘Court Note’ above to this point is of importance in the case before me. Does the proposed undertaking fail to provide the ‘reasonable certainty’ to which Birss J. refers? Is the proposed form of undertaking ‘indeterminate and open-ended’? When I look to *Actavis* and to the later judgment of Arnold J. in *Warner Lambert* (considered below), my assured answer to each of these two questions is ‘no’.]

37. As far as other companies in the group are concerned, I am told on instructions by Mr. Meade that the Actavis Group will be buying the API (that is to say, the raw chemical ingredients) in from third parties and will then

manufacture the tablets and sell them. It seems to me that it is unreal for the patentee (the defendant) to say that they need to know precisely which companies in the Actavis Group will be undertaking these tasks. The tasks in question are clear. I can understand, as Mr. Meade submits, that when an injunction of this kind has to last for a significant period of time, it is quite possible that a group such as the Actavis Group will undertake restructurings in such a way that it would mean that although today the Actavis Group knows who exactly is going to sell the product, in future the chain of companies which might be involved will change. It would be extremely inconvenient, and ultimately pointless, to require companies in the position of Actavis in this case to keep coming back to court every time they may or may not be involved in any kind of restructuring in order to reorganise the companies for whom the cross-undertaking of benefit. The reason I say that is because the patentee in this case knows that this cross-undertaking is a cross-undertaking in favour of the group who is going to sell the product in question. The nature of the loss that the group would rely on in any claim on the cross-undertaking is not going to change during the course of the action and the pendency of this undertaking and cross-undertaking. Accordingly, it seems to me that the concept underlying the language proposed by Actavis in this case is a fair and proper one and the language proposed achieves the desired objective. I will accept the order proposed by Mr. Meade in so far as it relates to companies in the Actavis Group. I should emphasise that it does mean, in my judgment, that the cross-undertaking is now being granted for the benefit of those companies even though they may not be identified until after judgment.'

72. The next English case worth touching upon is *Warner-Lambert v. Actavis* [2015] EWHC 485 (Pat.). In that case the patentee was Warner-Lambert. Warner-Lambert sought an injunction against Actavis. That was refused and, as a fallback, Warner-Lambert sought an injunction against the NHS to require the NHS to have particular guidance that would prevent any generic drug being used for a patented use. The upshot of this for generics in the market was similar to the circumstances that would have presented had an injunction been granted against them (in that there was an indirect restriction on their product being used for a patented use). Arising from that mandatory order, three generic companies sought a cross-undertaking from

Warner-Lambert for damages. In his judgment, Arnold J., having quoted extensively from the judgment of Birss J. in *Actavis*, observes, *inter alia*, as follows:

‘28. Counsel for Teva submitted that Teva should have the benefit of the cross-undertaking for two reasons. First, the effect of the order was intended to be, and was likely to be, that prescribers prescribed pregabalin for treating pain by reference to the brand name LYRICA rather than the generic name pregabalin. If prescribers did so, then pharmacists would be obliged to dispense LYRICA rather than generic pregabalin for treating pain. If it turned out that the Patent was invalid, however, then Teva should not have been prevented from making sales of generic pregabalin which pharmacists would otherwise have dispensed for the treatment of pain whether or not Teva would infringe the Patent if it was valid by selling the product under a skinny label.

29. Secondly, counsel for Teva submitted that, even if the Patent was valid, the possibility could not be excluded that the guidance would have the effect of LYRICA being prescribed and dispensed at the expense of generic pregabalin in circumstances which did not amount to infringement of the Patent. In my view this is improbable, but I agree that the possibility cannot be excluded.

*30. I accept that, for both these reasons, the benefit of the cross-undertaking should be extended to Teva. Counsel for Teva also submitted that, for similar reasons to those in *Actavis v Boehringer*, the benefit should extend to all companies in the Teva group....*

If the Court later finds that this Order has caused loss to the Respondent, the Department of Health, the Actavis group of companies, the Teva group of companies or the Dr. Reddy's... Laboratories (UK) Limited should be compensated for that loss, the Applicant will comply with any Order the Court may make.’

73. Teva points to this judgment and notes that the same double contingency which was built into Arnold J.’s judgment is built into its proposed order. It seems to me that if there was any doubt, by reference to *Actavis*, as to whether this is an appropriate case for the form of

undertaking canvassed for by Teva, the similarity between what was ordered in *Warner Lambert* and what is being sought here yields the inexorable conclusion that the justice of matters requires that the form of undertaking to be asked for by the court in this case ought to be that canvassed for by Teva.

74. I have now repeatedly stated that I consider that the jurisdiction that Teva contends to exist does exist in fact and in law. I should explain why I consider this is so. It is the case that in England and Wales there is that Practice Direction of which Birss J. makes mention. It is the case too that there is no equivalent provision in our Rules of the Superior Courts. However, s.28(8) of the Supreme Court of Judicature Act (Ireland) 1877 provides, *inter alia*, as follows:

‘[A]n injunction may be granted...by an interlocutory order of the Court in all cases in which it shall appear to the Court to be just or convenient that such order should be made and any such order may be made either unconditionally or upon such terms and conditions as the Court shall think just...’.

75. Counsel for Teva helpfully referred me to a decision of the neighbouring jurisdiction, *AIB v. Ashford Hotels* [1997] 3 All E.R. 309 (CA), in which rather than looking to the court rules, the English court looked to the applicable legislation (the United Kingdom’s Supreme Court Act 1981) as a basis for exercising a jurisdiction akin to that referred to in s.28 of the Act of 1877. In truth it seems to me to be so obvious from the terms of the Act of 1877 that I do have the type of jurisdiction contended for by Teva in this case that there is no need for me to consider *AIB v. Ashford Hotels*, save to note that it buttresses me in my conclusion that I have the jurisdiction contended for (though, again, this is so clear from the Act of 1877 that I do not require any buttressing of my view). I would only add in passing that rules of the superior courts cannot extend or limit a jurisdiction granted by law; they can only give directions as to how existing jurisdiction is to be exercised (see in this regard, *e.g.*, the speech of Herschell L.C. in *British South Africa Co. v Cia de Mozambique* [1893] AC 602, 628).

76. Counsel for Teva also referred me to the judgment of the (Irish) High Court in *Teva Pharmaceutical Industries Ltd v. Mylan Teo. t/a Mylan Institutional* [2018] IEHC 324 because that judgment invokes *AIB v. Ashford*, follows that line of authority, and agrees with the principle of looking at loss, not just at the defendant in an infringement action but also a group

of companies. I do not see that there is need to consider *Mylan* in any detail when I accept the point made by Teva by reference to *AIB v. Ashford* and accept also the existence of the jurisdiction that I have stated to arise under the Act of 1877 and for which Teva has contended. However, it is obviously reassuring that the judgment in *Mylan* and this judgment are adopting the same type of approach.

77. I turn now to the Enforcement Directive, *i.e.* Directive 2004/48/EC of the European Parliament and of the Council of 29th April 2004 on the enforcement of intellectual property rights ([2007] O.J. 157, 45). BMS contends that the form of undertaking now sought by Teva is inconsistent with that directive. The Enforcement Directive requires member states to provide for provisional measures to be available to rights holders to protect their intellectual property. Article 9(7) of the directive states as follows:

‘Where the provisional measures are revoked or where they lapse due to any act or omission by the applicant, or where it is subsequently found that there has been no infringement or threat of infringement of an intellectual property right, the judicial authorities shall have the authority to order the applicant, upon request of the defendant, to provide the defendant appropriate compensation for any injury caused by those measures.’

78. In effect, that provision has the effect that, in the context of Irish proceedings, a court must have the power to require a cross-undertaking in favour of a defendant to an infringement action. However, it does not preclude the giving of a cross-undertaking in favour of third parties.

79. BMS has referred me to the judgment of the CJEU in Case C-688/17 *Bayer Pharma AG v. Richter Gedeon* (ECLI:EU:C:2019:722). There, the question for the CJEU was, essentially, whether a court/State needed to provide for provisional measures to be given every time an injunction was set aside. (So, if an injunction was granted and then set aside was there an automatic right to the appropriate compensation, which in the case before me would be the enforcement of the undertaking, or where there were other things to be taken into account, such as a failure to mitigate damage?) Treating with the issue of what constitutes ‘appropriate compensation’ for the purposes of Art.9(7) of the Enforcement Directive, the CJEU observed, amongst other matters, as follows:

⁴⁹ *In the light of the foregoing considerations, the concept of ‘appropriate compensation’ must be regarded as an autonomous concept of EU law which must be given a uniform interpretation throughout the territory of the European Union....*

⁵¹ *Consequently, it is for those national courts to assess, in the exercise of the powers conferred on them, the specific circumstances of the case before them in order to decide whether it is appropriate to order the applicant to pay to the defendant compensation which must be ‘appropriate’, that is to say, justified in the light of those circumstances.’*

80. It seems to me that in this wording the Court of Justice is not far from using wording of the sort that appears in the Act of 1877 (which empowers me to impose whatever conditions are just). In other words there seems to me to be no discrepancy between my jurisdiction under the Act of 1877 and what is required by the Enforcement Directive.

81. Counsel for BMS made a number of arguments which I seek to deal with below in the order in which they occurred.

82. First, counsel for BMS expressed concern by reference to the affidavit of Ms Reynolds that the type of damage/s to be covered by the proposed undertaking is ‘absolutely undefined’.

83. I do not myself see that this can rightly be stated when one has regard to the actual text of the undertaking proposed by Teva. I should perhaps add that that proposed text seems to me to be more properly the subject of focus when it comes to what is being sought than whatever Ms Reynolds averred.

84. Second, counsel for BMS contended that what is being sought is ‘a very large undertaking’ that would cover direct and indirect losses.

85. With respect, when one looks to the actual text of the proposed undertaking I do not see that this is so. It does not refer to indirect loss. It refers to loss simpliciter and the normal rules of causation will apply at a damages inquiry in the normal way, and Teva will still have to prove

its loss.

86. Third, counsel for BMS contended that the concept of indirect damages, potential restructurings within the Teva group, and the potential for transfer pricing to be caught by the undertaking, meant that what Teva is in effect seeking is to enhance the damages available under the proposed undertaking.

87. Again, I do not, with respect, see that this concern is borne out when one has regard to the actual text of the proposed undertaking and also to the third, fourth and fifth of the opening comments made by counsel for Teva which I have quoted previously above. The proposed undertaking is clear and it does not refer to indirect loss. It refers to loss simpliciter and the normal rules of causation will apply at a damages inquiry in the normal way and Teva will still have to prove its loss.

88. Fourth, counsel for BMS noted that Teva has been the manufacturing and producing entity that has been operating in Ireland since at least 2016 and queried what restructuring is in the offing that requires to be covered by the undertaking.

89. Two points, it seems to me, might be made in this regard. First, it is the loss that might be engendered by the injunction that is properly the subject of focus of this application. Second, regardless of what the answer to counsel's point may be today, it may be that BMS's governing board could decide today, next week, next month, whenever, to engage in some level of restructuring for whatever reason, which reason may not even exist today. It is this natural commercial uncertainty that Teva wishes to see covered by the undertaking. What one is at in the proposed undertaking is to regulate what is to happen in a future that (being in the future) cannot be fully known by reference to presently known and/or even anticipated facts.

90. Fifth, counsel for BMS noted that it is typical in an injunction to injunct a person, whether they are acting by themselves or through their servants or agents, then continued 'Now, this is being turned into some sort of 'oh, well you're doing things to other people and therefore the undertaking has to be larger'.

91. With respect, when I look to the proposed form of undertaking, I do not see that this is

what is at play. Teva has merely proposed a form of undertaking that will enable it as a group to recover the damages that it may suffer by reference to the injunction that has been granted. I do not see that it is the ‘doing things to other people’ that is Teva’s concern; it is ‘causing damages by your injunction that would not be recoverable in the event that Teva prevails at the main trial and the injunction should never have been granted’ that is its concern. That is a perfectly rational and legitimate concern.

92. Sixth, counsel for BMS maintained that the scope and extent of the liability that BMS may incur under the proposed undertaking ‘cannot be understood. It can’t be identified....[T]hat goes completely against all of the authorities’.

93. Respectfully, I do not see that this is so. Of course, as I have already touched upon, future damage to some (or even a great) extent cannot be identified now. The future is the future and one cannot be certain what it will bring. All that Teva is saying is that if damage is caused to the Teva group by the injunction, and if Teva prevails in its action then BMS should undertake to pay for provable damage caused by the granting of the injunction. The proposed undertaking is clear and it does not refer to indirect loss. It refers to loss simpliciter and the normal rules of causation will apply at a damages inquiry in the normal way and Teva will still have to prove its loss. I do not, with respect, see that the concern to which counsel refers is borne out when one has regard to the actual text of the proposed undertaking and also to the third, fourth and fifth of the opening comments made by counsel for Teva which I have quoted above and do not propose to repeat here. I discuss in this judgment the authorities to which I have been referred and I respectfully do not agree that what is proposed ‘*goes completely against all of the authorities*’. On the contrary, what is proposed seems to me to be consistent with those authorities (most notably *Actavis* and *Warner Lambert*).

94. Seventh, counsel for BMS in the course of her submissions indicated that she did not take issue with counsel for Teva:

‘saying that there’s a general equitable jurisdiction in this Court. And whatever source you look to for that, whether it is the...Judicature Act, whether it’s the Court rules, whether it’s the Enforcement Directive, what’s required of the Court is to exercise its jurisdiction in a just way. And in my respectful submission,

Judge, the justice must go both ways. That's clear.'

95. I have explained previously above why I consider that I do have the jurisdiction for which Teva contends, which jurisdiction has existed for the courts of Ireland since at least the time of the enactment of the Act of 1877. As to justice cutting both ways, of course it must. But that with respect is precisely the case that Teva is making. It is stating in effect that 'You, BMS, have got your injunction but if in the grand scheme of things it turns out that we, Teva, prevail at the main trial, you should have to pay for damage that has been caused to the Teva group by virtue of the undertaking'. Offhand I cannot think of a better example of justice cutting both ways. BMS urged on me that Teva should not be allowed to enhance its damages (which is correct and not what I perceive Teva to be seeking to do), but if justice is to cut both ways, then neither should BMS be allowed to diminish the damage caused by its having obtained the injunction if Teva prevails at the main trial.

96. Eighth, returning again to the judgment of the CJEU in *Bayer*, counsel for BMS has referred me to paras. 64 and 65 of that judgment, which in effect point to the fact that I must exercise the equitable jurisdiction, including in terms of the 'price' that falls to be paid for an injunction, in a way that does not operate as a deterrent to applying for the injunction in the first place.²

97. If I might continue with that reference to 'price', I also do not read *Bayer* as requiring me to provide 'cut-price' injunctions whereby the damages that might be sought under an

² In paras.64 and 65 of its judgment in *Bayer*, the Court of Justice states as follows:

⁶⁴ *As regards the fact that the provisional measures at issue in the main proceedings have been repealed, although that may, as stated in paragraph 52 of the present judgment, constitute one of the conditions necessary for the exercise of the authority laid down in Article 9(7) of Directive 2004/48, by contrast, it cannot be regarded in itself as a decisive factor in proving the unjustified nature of the application which gave rise to the provisional measures which have been set aside.*

⁶⁵ *A different conclusion could have the effect, in circumstances such as those of the main proceedings, of discouraging the holder of the patent in question from availing himself of the measures referred to in Article 9 of Directive 2004/48 and would thus run counter to the directive's objective of ensuring a high level of protection of intellectual property.'*

undertaking would almost certainly not be reflective of the true damage caused if it turns out that the subject of the injunction triumphs at the main trial. Again, the proposed undertaking is clear. It refers to loss simpliciter and the normal rules of causation will apply at a damages inquiry in the normal way and Teva will still have to prove its loss.

98. Ninth, counsel for BMS contended that the injunction and the undertaking are two sides of an equation and that there has to be balance, and that the form of undertaking by Teva ‘imbalance the injunction’.

99. With respect, I struggle to see how this is so. Teva has contended, in effect, that ‘You, BMS, have got your injunction but if in the grand scheme of things it turns out that we, Teva, prevail at the main trial, you should have to pay for the damage caused to the Teva group and established to the satisfaction of the court as a damage suffered by virtue of the undertaking’. If I might pose a rhetorical question, where is the imbalance in that? The proposed undertaking is clear and it does not refer to indirect loss. It refers to loss simpliciter and the normal rules of causation will apply at a damages inquiry in the normal way and Teva will still have to prove its loss.

100. Tenth, counsel for BMS contends that, when it comes to *Actavis*, ‘there are words in there that show that ...Mr. Justice Birss...thought that the scope of the undertaking given...there [was] comprehensible....that everybody knew what they [were] talking about.’

101. As I have indicated above, I believe one of the critical paragraphs, perhaps *the* critical paragraph in *Actavis* to be Birss J.’s observation, at para.35 that:

‘A cross-undertaking has been called the price of an injunction and, in the end, it seems to me that the person paying that price needs to know with reasonable certainty what it is. It could be, in a given case, that the price demanded would be too high. A party seeking an interim injunction, or accepting undertakings in lieu of an interim injunction, is entitled to be wary of an indeterminate and open-ended cross-undertaking in favour of persons unknown.’

102. Again, does the proposed undertaking in this case fail to provide the ‘reasonable certainty’ to which Birss J. refers? Is the proposed form of undertaking ‘indeterminate and open-ended’? When I look to the judgments in *Actavis* and *Warner Lambert*, my answer to each of these two questions is ‘no’. The proposed undertaking is clear and it does not refer to indirect loss. It refers to loss simpliciter and the normal rules of causation will apply at a damages inquiry in the normal way and Teva will still have to prove its loss.

103. Eleventh, counsel for BMS noted that in *Actavis* there is no discussion of indirect effects, transfer pricing or company restructuring.

104. Three points, it seems to me, might be made in this regard. First, is the point I made immediately above as regards the tenth point made by counsel for BMS. Second, just because Birss J. did not deal with points that appear not to have been made before him does not mean that his observations in *Actavis* cease to be of relevance in a case in which points not made before him are now raised before me. Third, it seems to me that the point being made by counsel for BMS in this regard is but a variant of the second contention of counsel for BMS (considered previously above) and therefore meets with the same answer that I have given as regards that second contention.

105. Twelfth, counsel for BMS referred me to the identification of the legal principles reached by the High Court in *Nolan & ors v. Dildar Ltd & ors* [2020] IEHC 243.

106. Those principles seem perfectly sensible and I do not see that any of them is not being accorded with here. But the key point being made by counsel for BMS in this regard was (again) that ‘[W]e have this central concept in every jurisdiction of the price. You look for an injunction and you have to pay a price and there is a relation between those two things’. It seems to me, with respect, that this is but a repetition of the eighth and ninth contentions which I have already considered above.

107. Counsel did draw my especial attention to the third principle iterated in *Nolan* whereby an undertaking in damages is not intended to be a complete indemnity. When I look to the form of undertaking that Teva has proposed and when I have regard to the points made by counsel for Teva, especially her opening points which I have quoted above, it seems to me to be clearly the

case that Teva has not come seeking a complete indemnity. The proposed undertaking is clear and it does not refer to indirect loss. It refers to loss simpliciter and the normal rules of causation will apply at a damages inquiry in the normal way and Teva will still have to prove its loss.

108. Thirteenth, counsel for BMS suggested that Teva hits a difficulty as regards timing in this case. Thus, she observed:

‘The price, being the undertaking has to be essentially agreed before the injunction can be given. The injunction applied for here was applied for on the basis of the usual undertaking as to damages. There was no demur from Teva in relation to that. And the Court decided to grant it, not only that but Teva insisted then the order be made. So, the order actually has been made, Judge. And now there's a question about, oh, well, the price should be different. The price should be something that we now can argue about. But in fact the price is something that my client has to agree to. So, the Court can't direct me to do that. All the Court could actually do, if some reason my client said that undertaking is far too formless, if that was the position what then happens to the injunction that has already been ordered? So that is a fundamental timing, procedural – but it goes beyond procedural because it actually goes to the heart of this, which is that you apply for an injunction and the price is part and parcel and everything gets decided at the same time.’

109. There are a number of points in these submissions:

- (i)** *‘the undertaking has to be essentially agreed before the injunction can be given’*

With respect, this is just not so. I understand from the submissions before me that in the United Kingdom it is standard practice to discuss the form of the undertaking once a decision has been made to grant an injunction. That seems an eminently sensible approach. It also chimes with my experience here. In many instances I have myself given oral judgments in which, if an injunction is to be granted, I generally conclude with words along the lines of ‘So for

that reason I will grant the injunction sought, conditional on an undertaking for damages being provided'. Invariably the question from counsel for the applicant in such cases is along the lines of 'Will that be in the usual form, Judge?' And typically it is. This case is different in that a non-typical form of undertaking is being sought, which has required argument as to the form of undertaking. Why we would potentially waste everyone's time discussing the exact form of an undertaking at the hearing of the application for an injunction when there is every possibility that an injunction might not be granted is beyond me and would be completely inefficient.

- (ii) *'[t]he injunction applied for here was applied for on the basis of the usual undertaking as to damages. There was no demur from Teva in relation to that'*

The first sentence may describe how BMS approached matters. I have not been pointed to a single piece of evidence in which BMS said to Teva 'We are approaching this application on the basis that if we win you will give the standard form of undertaking; would you be satisfied with that?' Nor have I been pointed to a single piece of evidence in which Teva stated that 'If you win the injunction application we will offer the typical form of undertaking'. Since at least the time of the Act of 1877, almost 150 years ago, it has been open to the Irish courts to formulate a different form of undertaking.

- (iii) *'the Court decided to grant [the injunction and]...Teva insisted then the order be made. So, the order...has been made'*

This, with respect, is not an accurate reflection of how matters transpired. I issued my judgment electronically and indicated that I would grant the injunction. On the first available opportunity, Teva attended physically in court and said it would appeal my judgment (as it is entitled to do). It also made clear that it would have issues as regards the form of undertaking to be given. To appeal against my judgment it needed an order to be made. So the injunction was ordered but on the understanding that Teva would come back

at a future time to address the form of the undertaking to be given. This was so clearly the intended course of action that I requested that among the documents to be provided to me at the undertaking hearing would be an affidavit from Teva swearing to its position (which has since kindly been provided). Matters have, therefore, proceeded exactly as contemplated. So I admit to being surprised by the contention that – in a context where everyone knew what was being done, ordered, and how it was being sequenced, and why – BMS, which has been at pains in this case to argue how important it is that I do justice – would seek to rely on a procedural point that simply does not bear up when one has regard to the actual facts that brought all of us to the application and hearing which have prompted the issuance of this judgment. I was so surprised by this line of contention that the following exchange occurred during the hearing of this application:

Judge: Was that order not just made to get to the Court of Appeal so that there was an order to appeal against?

Counsel for BMS: Pardon, Judge?

Judge: Was the order not just made to get you [in fact, Teva] to the Court of Appeal so there was an order you [in fact, Teva] could appeal against?

Counsel for BMS: Yes, Judge. But actually before that, the Court had already decided to grant the injunction on the basis of the arguments that had been made by the parties. If Teva was going to say that that injunction you were asking for, well, you know, that's going to cause X, Y and Z so we need an undertaking in this form.

[Emphasis added].

The ‘Yes, Judge’ answer indicates that the order was made precisely on the basis that I have described above. The underlined text, with respect, is wrong from a historical perspective. What is meant by ‘If Teva was going to say...we need an undertaking in this form’? Counsel for Teva made perfectly clear on the first mention of this matter before me after my judgment issued

that her client wanted to appeal against my decision to grant the injunction sought by BMS and also wanted to make the present application concerning the form of the undertaking. In fact, at the time counsel for Teva said all this to me I indicated that I would bring on the further application for an early hearing and follow that up with a speedy judgment so that the Court of Appeal could consider my injunction judgment and also simultaneously hear any (if any) appeal against whatever judgment I reached on the form of the undertaking. Circumstances got in the way of the early hearing but even that stated intention points to the correctness of what I am now stating as to why things were done and ordered and sequenced as they were.

(iv) *‘now there's a question about whether the price should be different’.*

Again, this, with respect, is not an accurate reflection of how matters transpired historically. Please see my observations regarding point (iii).

(v) *‘the price is something that my client has to agree to... [T]he court can’t direct me to do that’.*

Of course I cannot direct that someone agree to something. However, if BMS declines to agree to the form of undertaking that I consider to be appropriate, *i.e.* to pay the ‘price’ that I consider appropriate for that injunction (to use a metaphor employed by BMS at the hearing) then a fairly predictable sequence of events seems likely to occur thereafter.

(vi) *‘[a]ll the Court could actually do, if some reason my client said that undertaking is far too formless, if that was the position what then happens to the injunction that has already been ordered?’*

This sequence of events has not occurred, thus far at least, so I respectfully decline to comment on it.

(vii) *‘[when] you apply for an injunction, the price is part and parcel and*

everything gets decided at the same time'

This is essentially a repeat of point (i) and I would refer the parties to that point (i).

110. Fourteenth, counsel for BMS stated that '[M]y second position, Judge, is...Teva has not discharged the onus that it has in terms of asserting that the ordinary undertaking, the normal undertaking is not satisfactory and there's specific authority on that, Judge.' She touched again on this point at a later stage, referring me to *Dunne -v- Dun Laoghaire County Council* [2003] IESC 15 case and stating:

'[I]t was spelled out that there was an onus on the person who was asserting that the ordinary injunction wasn't sufficient to say why and also to justify the scope of the undertaking that was being required. That has not been done here. Not only that, but it is entirely unclear what the scope of that undertaking is, Judge.'

111. With respect, Teva has taken the trouble to provide affidavit evidence buttressed by extensive submissions as to why the proposed form of undertaking is required, all of which I have treated with in this judgment, reaching the various conclusions that I have reached. The notion that the scope of the undertaking is 'entirely unclear' has now been treated with me ad nauseam in this judgment. It is not unclear. It is clear. Rather than repeat myself in this regard, I would refer the parties, *e.g.*, to the observations that I have made as regards the first, second and third observations of counsel for BMS.

112. Fifteenth, counsel for BMS referred to the decision of the Supreme Court in *Dunne v. Dun Laoghaire Rathdown County Council*, and in particular to the observations of the late Hardiman J. concerning how the defendant's averments in that case had not pointed to the alleged potential losses with 'sufficient precision'.

113. Hardiman J. was perfectly entitled to the view that the alleged potential losses on the facts of the case before him had not been pointed to with 'sufficient precision'. I am perfectly free to conclude (as I do) that (i) the type of damage which may present in this case requires a different form of undertaking as to damages to the typical form of undertaking, and (ii) that the form of

undertaking proposed by Teva adequately meets (for the reasons that I have now stated at some length) the circumstances presenting in this case and is consistent with the need for me to do what is ‘just’ (to echo s.28(8) of the Act of 1877). Again, it may be useful to note that the proposed undertaking is clear and it does not refer to indirect loss. It refers to loss simpliciter and the normal rules of causation will apply at a damages inquiry in the normal way and Teva will still have to prove its loss.

114. Sixteenth, counsel for BMS brought me to *SmithKline Beecham v. Apotex* [2006] EWCA Civ. 658 and to an *obiter* observation of Jacob L.J. therein to the effect that if a plaintiff in seeking an injunction has sought to minimise an exposure on an undertaking by targeting one person in the chain, a court could later pre-empt that attempted manipulation of the injunctive process by requiring an undertaking in favour of the non-targeted companies.

115. That judgment is not binding on this Court. However, as an observation, the just-mentioned observation seems to me to be, if I might respectfully observe of a rightly respected judge, a customarily sensible observation. I just do not see that it has any relevance to the facts of the case now before me. BMS has not sought to be ‘too clever by half’ in bringing its injunction application solely against Teva. But that does not mean it gets a free pass on recompensing for the types of damage contemplated by the proposed undertaking in the event that Teva prevails at the main hearing. And the proposed undertaking is clear (and it does not refer to indirect loss); it refers to loss simpliciter and the normal rules of causation will apply at a damages inquiry in the normal way and Teva will still have to prove its loss.

116. Seventeenth, counsel for BMS, in the course of considering *SmithKline Beecham v. Apotex* (a decision that is not binding on me) again urged on me that I must exercise the equitable jurisdiction, including in terms of the ‘price’ that falls to be paid for an injunction, in a way that does not operate as a deterrent to applying for the injunction in the first place.

117. This, in truth, brings one back to the judgment of the CJEU in *Bayer* (a decision that is binding on me). I have already treated with this aspect of *Bayer* in the eighth contention raised by counsel for BMS.

118. Eighteenth, counsel for BMS, in her consideration of *Actavis* and by reference to the affidavit of Ms Woods (when the true focus is and ought to be the form of the proposed undertaking) contended as follows:

‘[T]he answer that...this will all be thrashed out in a damages inquiry at the end of the day, that’s not sufficient, Judge, because it is opening the door to this liability....Now, I’m not saying that this cannot be argued at the stage of an assessment of damages [Court Note: In point of fact it can], but it is opening the door, and crucially, it means that the price for the injunction, even if we assume the injunction hasn’t already been given, the price for the injunction is absolutely at large. Not only that, but Teva Ireland seems to wish to be free to play around with the value of that. And possibly to turn the injunction into essentially an asset via the undertaking.’

119. This, with respect, is the ‘breadth of the undertaking’ and the ‘enhanced damages’ points repackaged. Those points were already raised in (and addressed by me in the context of) counsel’s first, second, and third contentions (as treated with above).

120. Nineteenth, by way of one final authority, counsel for BMS referred me to *R. v. Medicines Control Agency* [1999] R.P.C. 705 (Ch.D.).

121. This is the judgment in which Jacob J. first considered extending undertakings to third parties like departments of health. What was at issue there was a parallel import licence that had been set aside in judicial review proceedings, with the result that the parallel importer could no longer sell. An undertaking as to damages had been given. The undertaking was given to the parallel importer and at that point the company that actually traded (which had a close connection with the parallel importer) was not party to the proceedings or the undertaking. What Jacob J., as he then was, was being asked to do was to bring the losses incurred by that person within the scope of the undertaking. Among the observations made by Jacob J. in his judgment were that:

‘Of course if, once he knows of the injunction, the injunctee does not spell out to

the injunctor any special circumstances causing direct but, to the injunctor, unforeseeable damage, he may not be allowed to recover for that damage. Equity would be apt to blame an injunctee who stood by, letting the injunctor build up a liability on the cross-undertaking of which he had no knowledge.'

122. That, counsel for BMS submitted, is precisely what Teva seeks to do here. With respect it seems to me that in bringing the within application and having open and transparent argument over the proposed form and intended effect of the proposed undertaking, Teva is doing all that can humanly be done to be entirely clear about what will be covered and what will not be covered by the proposed undertaking. I also cannot but note that UK case-law has now evolved to the position reached in *Actavis* and *Warner Lambert*, so it is not entirely clear to me why I would have especial regard to a non-binding case that came at a much earlier stage in the evolutionary process that brought the courts of England and Wales to the position that has been arrived at in the non-binding cases of *Actavis* and *Warner Lambert*.

123. Counsel for BMS also pointed to Jacob J's views on transfer pricing, essentially repeating the argument contended for in her third contention, which I have already treated with above.

124. It will be clear from the foregoing that I consider the form of undertaking proposed by Teva to be an appropriate form of undertaking to be provided in return for the injunction that I have granted. I have reached the various conclusions that I have reached above. However, I note in particular that in arriving at my view as to the appropriateness of the undertaking, I have had especial regard to the fact that:

- (i) the proposed undertaking (a) does not refer to indirect loss, (b) refers to loss simpliciter, and (c) the normal rules of causation will apply at a damages inquiry in the normal way, and (d) Teva will still have to prove its loss,
- (ii) BMS's interests are fully protected insofar as they can argue all of the points they want to make at the damages hearing where the court will have at large jurisdiction to look into causation, quantum, *etc.*,
- (iii) the order is intended merely to preserve all of the parties' interests in a damages

hearing,

- (iv) in proposing the proposed form of undertaking Teva is not seeking (and will not seek) enhanced damages in any way.

125. If BMS wishes for the just-mentioned four points to be reflected, *e.g.*, as recitals to the undertaking or propositions upon which it rests, offhand I cannot myself see how Teva would object to my so ordering, since these points merely reflect what was expressly submitted to me at the hearing.

126. I do not understand it to be disputed by BMS that the undertaking must state itself to take effect as of the date of the injunction order, and clearly it must. Any other arrangement would be illogical.

127. Though it was not touched upon at the hearing, I should perhaps note for the avoidance of doubt that (i) I do not see the application for the proposed undertaking to involve a collateral judgment to my judgment, and (ii) I do not see any abuse of process to present in the bringing of this application, the background to the bringing of which I have detailed previously above.

128. It became the practice during the Covid lockdowns for the court to give an indication as to where it considers that costs ought to lie. There are two applications before me. Teva has completely succeeded in both applications. Thus it seems to me that, ostensibly, an order for costs in respect of each application ought now to be made in favour of Teva. If either side wishes to make argument in this regard, I would be grateful if I could be advised of this before the end of the main hearing and I will schedule a brief costs hearing to be heard on some future date.

129. Finally, two minor points. First, because of the need for the *viva voce* examination to be done as soon as possible, this reserved judgment is being given five days after the hearing. As a result of the speed at which it was prepared it may be that some typographical errors have occurred that will require correction. I will make any (if any) such corrections before uploading this judgment to *www.courts.ie*. Second, as with my judgment in the injunction application, I will give the parties time to read this judgment to ensure that they are satisfied that no

commercially sensitive information requires to be redacted before the judgment is made available to the public. I do not myself see that there is; however, if the parties could let me know before the end of the main hearing whether they have any comments in this regard, I will thereafter make any such redactions as seem necessary to me prior to making the judgment publicly available.