

Federal Court



Cour fédérale

Date: 20230704

**Docket nos.: T-2276-22
T-2318-22**

Court No.: 2023 FC 943

Ottawa, Ontario, July 4, 2023

PRESENT: Case Management Judge Benoit M. Duchesne

BETWEEN:

**BOEHRINGER INGELHEIM (CANADA) LTD. and BOEHRINGER INGELHEIM
INTERNATIONAL GMBH**

Plaintiffs

and

JAMP PHARMA CORPORATION

Defendant

REASONS and ORDER

[1] The parties are involved in a proceeding commenced pursuant to subsection 6(1) of the *Patented Medicines (Notice of Compliance) Regulations*, SOR/93-133 (the “Regulations”).

[2] The Plaintiffs are seeking declaratory and other relief against the Defendant in connection with its making, constructing, using, and /or selling of orally administered empagliflozin tablets

containing 10 mg or 25 mg empagliflozin that would directly infringe or induce the infringement of various claims of Canadian patents bearing numbers 2,696,558; 2,752,435; 2,557,801; 2,606,650; 2,751,833; and 2,813,661, respectively. The Defendant has raised a number of defences including that the patents are invalid and void. None of the defences asserted are at issue on the motion before me.

[3] The Defendant has brought a motion to compel the attendance of the Plaintiffs' employee inventors (the "Inventor Employees") for discovery pursuant to Rule 237(4) of the *Federal Courts Rules*, SOR/98-106 (the "*Rules*") by way of an Order pursuant to Rule 90(2) made *in personam* against the Plaintiffs with the intent that it would be binding directly upon them and require them to produce their Inventor Employees. In essence, the Defendant seeks an Order requiring the Plaintiffs to make their Inventor Employees who are potential witnesses, but are not corporate representatives for discovery, attend to be examined for discovery pursuant to Rule 237(4), failing which the Order could be enforced against the Plaintiffs themselves.

[4] The Plaintiffs resist the motion by arguing, among others, that the *Rules* do not contemplate the type of Order sought by the Defendant. I agree with the Plaintiffs.

[5] The Defendant also seeks an Order requiring the Plaintiffs to provide more, better, or more meaningful contact information such as telephone numbers and email addresses regarding inventors identified in the patents but are no longer employed by the Plaintiffs (the "Inventor Former Employees"). The Plaintiffs argue they have complied with their obligation as set out in the *Regulations* and that ordering the Plaintiffs to provide more or better information with

respect to their Inventor Former Employees' contact information is a make-work project not contemplated by the *Rules* or the *Regulations*. I agree with the Plaintiffs.

[6] The Defendant seeks an Order compelling the Plaintiffs to permit counsel for the Defendant to have a 1-hour videoconference conversation with each of the Inventor Employees (an "Informal Discussion") for the purpose of permitting counsel for the Defendant to determine the role of each of the Inventor Employees in the conception of the inventions in dispute. The Informal Discussion would also be without prejudice to the Defendant seeking letters of request or letters rogatory in respect of each Inventor Employee to examine them for discovery. The Informal Discussion that is sought to be compelled could be attended by counsel for the Plaintiffs and the Inventor Employees would have to agree to be truthful, but the Informal Discussion would not be recorded. The Plaintiffs argue that there is no such process contemplated by the *Rules* and that the request should be dismissed. Again, I agree with the Plaintiffs.

[7] Finally, the Defendant seeks a scheduling Order and an Order regarding the manner in which examinations for discovery will be carried out if the parties cannot agree after these reasons are released to them. The parties will be directed to seek out a case management conference in the event that they cannot agree on how to proceed following the release of these reasons.

[8] The Defendant's motion is therefore dismissed for the reasons that follow.

I. Background

[9] The parties are preparing for discovery in their proceeding. The Defendant seeks to examine all of the twenty-three (23) living inventors identified in the patents referred to above. Thirteen (13) of the inventors continue to be employed by the Plaintiffs or by a company within the Plaintiffs' control, while the others are not. The inventors, whether employed by the Plaintiffs or not, reside outside of Canada, mostly in Germany, and are beyond the territorial jurisdiction of this Court.

[10] Each of the inventors, whether currently employees of the Plaintiffs or not, assigned their patent rights to the Plaintiffs such that the inventors are assignors of patent rights and the Plaintiffs are assignees of those inventors' patent rights for the purposes of Rule 237(4).

[11] The parties have exchanged views on the examination for discovery of the inventors without reaching agreement on a discovery plan with respect to the issue.

[12] A scheduling order was made early on in the litigation. The scheduling order ordered the Plaintiffs to advise the Defendant of which inventors would be made available to attend for examinations for discovery as well as where and how they would be made available. The Plaintiffs offered up six (6) inventors across all of the patents at issue and suggested that their examination for discovery take place in Brussels as opposed to Germany in light of alleged restrictions arising from the Convention Between His Majesty and the President of the German Reich Regarding Legal Proceedings in Civil and Commercial Matters of March 20, 1928

(the “German British Convention”; Canadian Treaty E-101557, made applicable in Canada from August 1, 1935).

[13] The Plaintiffs’ offer was based on their reasoning that they would make those Inventor Employees that they might call as witnesses at trial available for examination for discovery. The Plaintiffs also informed the Defendant that they would make other Inventor Employees who they might call as witnesses at trial available for discovery. From the Plaintiffs’ perspective, proceeding in this manner focussed the issues going forward and would result in a proportional approach to inventor examination for discovery by foregoing the examination for discovery of inventors whose evidence would be unnecessary because they would not be called upon as witnesses at trial.

[14] The Defendant inquired whether the Plaintiffs would make the remaining Inventor Employees available for examination. The Plaintiffs responded that they would not be made available for examination “...at this time”, but might be at a later date based on whether any of those inventors would be called as witnesses at trial. The Plaintiffs did not undertake to not call any other inventors as witnesses at trial.

[15] The Defendant has taken the Plaintiffs’ response as a refusal to make the Inventor Employees available for examination for discovery and that the refusal is unjustified and contrary to its discovery rights pursuant to the *Rules*.

[16] The Defendant argues that it seeks on this motion to have this Court determine the issue of which party as between the patentee or the challenger of a patent should have or has the authority to decide which and how many inventors are examined during the discovery process in Canadian patent disputes. Although the Defendant frames its motion in this manner, both Rule 237(4) and the relevant jurisprudence have established conclusively that a party, in this case the Defendant, may examine any adverse assignee-party's assignor for discovery in the context of an action subject always to any Order of the Court that may fix parameters or conditions on an examining party's examination (Rules 53, 87.1, 90(2), 96, 97, and 238 of the *Rules*; *Richter Gedeon Vegyészeti Gyar Rt v. Merck & Co.* (C.A.), 1995 CanLII 3514 (FCA), [1995] 3 FC 330; *Faulding (Canada) Inc. v. Pharmacia S.P.A.*, 1999 CanLII 7940 (FC), at para. 4).

[17] The real issue on this motion is not the right to examine an assignor for discovery, or who decides the means by which the examination for discovery of an assignee-party's assignor may be compelled. Rather, the real issue is the mechanics of compelling a non-party assignor to be examined for discovery pursuant to Rule 237(4) of the *Rules* in the context of litigation pursuant to the *Regulations* when an allegation of patent invalidity or voidness is made by a Defendant.

II. The Applicable Law

[18] The rules applicable to examinations out of court are provided for at Rules 87 to 100, and 234 to 254 of the *Rules*. Rules 87 to 100 provide the general mechanics of out of court examination under the *Rules* and apply to examinations for discovery, the taking of evidence out of court for use at trial pursuant to Rules 271 to 273, the cross-examination on affidavits, and an examination in aid of execution. Rules 237 to 254 apply more particularly with respect to examination for discovery.

[19] Rules 234(1), 235, and 236 apply with respect to examination for discovery of one party to the proceeding by another adverse party in the same proceeding. Rules 234(2), 237, 238 and 239 apply with respect to the examination for discovery of a person who is not necessarily a party to the proceeding.

[20] Rule 237 reads as follows:

Representative selected

237 (1) A corporation, partnership or unincorporated association that is to be examined for discovery shall select a representative to be examined on its behalf.

Examination of Crown

(2) Where the Crown is to be examined for discovery, the Attorney General of Canada

Interrogatoire d'une personne morale

237 (1) La personne morale, la société de personnes ou l'association sans personnalité morale qui est soumise à un interrogatoire préalable désigne un représentant pour répondre en son nom.

Interrogatoire de la Couronne

(2) Lorsque la Couronne est soumise à un interrogatoire préalable, le procureur

shall select a representative to be examined on its behalf.

général du Canada désigne un représentant pour répondre en son nom.

Order for substitution

(3) The Court may, on the motion of a party entitled to examine a person selected under subsection (1) or (2), order that some other person be examined.

Substitution ordonnée

(3) La Cour peut, sur requête d'une partie ayant le droit d'interroger une personne désignée conformément aux paragraphes (1) ou (2), ordonner qu'une autre personne soit interrogée à sa place.

Examination of assignee

(4) Where an assignee is a party to an action, the assignor may also be examined for discovery.

Interrogatoire du cessionnaire

(4) Lorsqu'un cessionnaire est partie à l'action, le cédant peut également être soumis à un interrogatoire préalable.

Examination of trustee in bankruptcy

(5) Where a trustee in bankruptcy is a party to an action, the bankrupt may also be examined for discovery.

Interrogatoire du syndic

(5) Lorsqu'un syndic de faillite est partie à l'action, le failli peut aussi être soumis à un interrogatoire préalable.

Examination of party under legal disability

(6) If a party intends to examine for discovery a person who is appointed under paragraph 115(1)(b) to represent a person under a legal disability, the party may, with leave of the Court, also examine the person under a legal disability.

Interrogatoire d'une personne sans capacité d'ester en justice

(6) La partie qui entend soumettre à un interrogatoire préalable la personne désignée, en vertu de l'alinéa 115(1)b), pour représenter une personne n'ayant pas la capacité d'ester en justice peut, avec l'autorisation de la Cour, interroger aussi cette dernière.

Examination of nominal party

(7) Where a party intends to examine for discovery a person bringing or defending an action on behalf of another person who is not a party, with leave of the Court, the party may also examine that other person.

Interrogatoire d'une personne qui n'est pas une partie

(7) Si une partie entend soumettre à un interrogatoire préalable une partie qui introduit ou conteste l'action pour le compte d'une personne qui n'est pas une partie, elle peut aussi, avec l'autorisation de la Cour, soumettre cette personne à un interrogatoire préalable.

[21] Rule 237(1) provides how a corporation, a legal person but not a sentient one, may be examined: through a representative of the corporation who has been selected by the corporation for that purpose. That representative may or may not be party to the proceeding depending on how the action is pleaded. Similarly, the corporation may or may not be party to the proceeding. The important point is that the Rule requires the corporation to select a representative to be examined on its behalf. The representative's discovery answers would bind the corporation.

[22] Rule 237(2) is to the same effect, but applies where the Crown is to be examined for discovery. The Crown, like a corporation, is required to select a representative to be examined on its behalf. The representative's discovery answers would bind the Crown.

[23] Rule 237(3) applies when an examining party seeks to have a representative other than the representative selected by the corporation or the Crown to be examined for discovery.

[24] Rule 237(4) specifically contemplates that an assignor of rights may be examined for discovery when the party to whom the assignor assigned his/her/their/its rights is a party to an action. Unlike the corporation or the Crown as contemplated by Rules 237(1) and (2) who may or may not be a party to the action, Rule 237(4) implies that the assignor is not a party to the action, despite that its assignee is a party to the action. The Rule contemplates that the assignor – the inventor for the purposes of this motion – is not the representative of the assignee party in connection with the Rule 237(4) examination for discovery.

[25] Rules 237(5), (6) and (7) are similar to Rule 237(4) in object and effect in that they set out the right to examine a person who is not a party to the proceeding, albeit that the exercise of the right to examine for discovery pursuant to Rules 237(6) and (7) are exercisable only with leave of the Court.

[26] Rules 88 to 100 apply to examinations for discovery. These rules set out the mechanics – the how, the when and the means - of the exercise of the right to examine a party or a person for discovery. Rules 89(3) and 90(2) apply to an oral examination of a party or of a person that takes place in a jurisdiction outside of Canada, or where the person to be examined resides outside of Canada. These Rules read as follows:

Oral examination

89 (1) A party requesting an oral examination shall pay the fees and disbursements related to recording the examination in accordance with Tariff A.

Interrogatoire oral

89 (1) La partie qui demande un interrogatoire oral paie le montant relatif à l'enregistrement déterminé selon le tarif A.

Examination in Canada

Interrogatoire au Canada

(2) An oral examination that takes place in Canada shall be recorded by a person authorized to record examinations for discovery under the practice and procedure of a superior court in Canada.

Examination outside Canada

(3) An oral examination that takes place in a jurisdiction outside Canada shall be recorded by a person authorized to record:

(a) court proceedings in that jurisdiction; or

(b) examinations for discovery under the practice and procedure of a superior court in Canada, if the parties consent.

Examination to be recorded

(4) A person who records an oral examination shall record it word for word, including any comment made by a solicitor, other than statements that the attending parties agree to exclude from the record.

Place of oral examination

90 (1) Where a person to be examined on an oral examination resides in Canada and the person and the parties cannot agree on

(2) L'interrogatoire oral qui a lieu au Canada est enregistré par une personne autorisée à enregistrer des interrogatoires préalables selon la pratique et la procédure d'une cour supérieure au Canada.

Interrogatoire à l'étranger

(3) L'interrogatoire oral qui a lieu à l'étranger est enregistré par une personne autorisée :

a) soit à y enregistrer des procédures judiciaires;

b) soit à enregistrer des interrogatoires préalables selon la pratique et la procédure d'une cour supérieure au Canada, si les parties y consentent.

Enregistrement intégral

(4) La personne chargée d'enregistrer un interrogatoire oral l'enregistre intégralement, y compris les commentaires des avocats, en excluant toutefois les énoncés que les parties présentes consentent à exclure du dossier.

Endroit de l'interrogatoire

90 (1) Lorsque la personne devant subir un interrogatoire oral réside au Canada et n'arrive pas à s'entendre avec les parties sur l'endroit où se

where to conduct the oral examination, it shall be conducted in the place closest to the person's residence where a superior court sits.

Person residing outside Canada

(2) Where a person to be examined on an oral examination resides outside Canada, the time, place, manner and expenses of the oral examination shall be as agreed on by the person and the parties or, on motion, as ordered by the Court.

Travel expenses

(3) No person is required to attend an oral examination unless reasonable travel expenses have been paid or tendered to the person.

déroulera l'interrogatoire, celui-ci est tenu à l'endroit où siège une cour supérieure qui est le plus proche de la résidence de la personne.

Personne résidant à l'étranger

(2) Lorsque la personne devant subir un interrogatoire oral réside à l'étranger, l'interrogatoire est tenu aux date, heure et lieu, de la manière et pour les montants au titre des indemnités et dépenses dont conviennent la personne et les parties ou qu'ordonne la Cour sur requête.

Frais de déplacement

(3) Nul ne peut être contraint à comparaître aux termes d'une assignation à comparaître pour subir un interrogatoire oral que si des frais de déplacement raisonnables lui ont été payés ou offerts.

[27] Read together, Rule 237(4) provides the Defendant with the right to examine an assignor inventor who resides outside of Canada and Rule 90(2) provides the mechanics of when, where and how that examination is to take place.

[28] What is apparent from these Rules is that neither Rule imposes a duty upon the assignee party to make its assignor inventor available to be examined. Rule 237(4) is declarative of the

right to examine the assignor inventor, but is silent about any steps, if any, to be taken by the assignee party in connection with the right of the opposite party to examine its assignor inventor.

[29] Subsections 6.04(2) and 5(3.1) of the *Regulations* impose a duty on the assignee to provide the name and contact information for any inventor who might have information relevant to an allegation of patent invalidity or voidness, but the *Regulations* do not require that the assignor inventor be made available by the assignee to be examined. It follows that the right to examine an assignor inventor pursuant to Rule 237(4) in the context of an action commenced pursuant to section 6 of the *Regulations* in which an allegation of invalidity or voidness is made triggers a duty upon the assignee party to provide inventor names and contact information, as well as whether the assignor is an employee of the assignee party, upon request, but not any greater duty upon the assignee to take steps to facilitate the assignor's attendance to be examined for discovery.

[30] The *Regulatory Impact Analysis Statement* (Canada Gazette, Part I, Vol. 151, no. 28, at page 1227) (the "RIAS") regarding the 2017 amendments to the *Regulations*, is helpful in discerning whether the *Regulations* were intended to impose a greater duty upon an assignee than is set out in Rule 237(4) (*Bristol-Myers Squibb Co. v. Canada (Attorney General)*, 2005 SCC 26, [2005] 1 S.C.R. 533, at paragraph 157). The RIAS, at page 1236, contemplates only that an assignee is to provide contact information for any inventor who might have information relevant to the invalidity or voidness allegation. The requirement to provide contact information is intended to facilitate and expedite access to relevant evidence regardless of whether the inventor is an employee of the assignee or not. The difference in how to proceed when concerned with an

employee or non employee assignor lies only in the manner by which the duty to provide contact information is satisfied. When the assignor inventor continues to be an employee of the assignee employer, then the duty to provide contact information is satisfied by stating that the inventor can be contacted through counsel to the assignee employer. When the assignor inventor is no longer an employee, then contact information must be provided. Neither case, however, contemplates any duty upon the assignee employer to make any assignor inventor, employee or not, available for examination for discovery. Rather, both the RIAS (at page 1230) and the *Regulations* contemplate only that contact information be provided and that the Court's *Rules* would otherwise apply with respect to examinations and access to potential evidence.

[31] It follows that the duty to provide inventor contact information was the only duty contemplated to be imposed directly upon the assignee in connection with a party right to examine a non-party assignor pursuant to Rule 237(4). With that contact information, a party seeking to examine an assignor inventor may take the procedural steps available to it to compel the non-party assignor inventor to make themselves available for examination for discovery. It is also equally clear that, subject to the duty imposed on the parties pursuant to section 6.09 of the *Regulations* to reasonably cooperate in expediting any action brought under subsection 6(1) of the *Regulations*, a duty thoughtfully considered and explained by the Court in *Allergan Inc. v. Apotex Inc.*, 2020 FC 658 (CanLII) at para. 18, there is no specific *Rules* based duty upon the assignee party to make any of its assignor inventors available to be examined for discovery.

[32] The usual course for the examination of a non-party in Canada would lead to the party seeking to examine an assignor inventor serving a direction to attend in accordance with Rules

91(1) and 91(3)(b) that contemplate that the direction to attend shall be served on the person to be examined. Although it may seem obvious, the non-party to be examined must be served with the direction to attend because an order to compel them to attend pursuant to Rule 97 can only follow that person's non-attendance despite being requested to attend.

[33] The Defendant suggests that this requirement for service of a direction to attend upon an assignor inventor to compel attendance can be substituted by a direction to attend being either served upon the assignee to produce someone who is not its representative for examination for discovery when the assignor inventor resides outside of Canada, or imposed by an Order of this Court pursuant to Rule 90(2), with the result that the Court's Rule 97 power can be used against the assignee if the assignor inventor does not attend to be examined for discovery. This suggestion is flawed as it conflates the examination of a representative and the examination of a third party witness who is not a representative of the assignee selected by the assignee for examination for discovery. The obligation to attend to be examined for discovery is an obligation that is personal upon the person served with the direction to attend in accordance with the *Rules*. The Defendant's argument incorrectly suggests that this personal obligation can be imposed indirectly by serving someone other than the person to be examined. The argument ignores that the Court's power to compel pursuant to Rule 97 is predicated upon the failure of the person to attend to be examined after having been served with a direction to attend. It does not extend to compel a person who has not been served personally with a direction to attend.

[34] The usual course for the examination of a non-party who does not reside in Canada would be to recognize the limits of this Court's territorial and personal jurisdictional limits over

non-parties and consider the means available to attempt to compel a non-party who is not resident in Canada to make themselves available for examination. Rule 90(2) provides that the examination of a person residing outside of Canada shall be as agreed upon by the person and the parties or ordered by the Court. Considering that the most effective manner of compelling a non-resident to attend to be examined is to have that person's local authorities exercise some form of compulsion power akin to our Rule 97 to have them attend to be examined, it becomes clear that this Court would seek the cooperation of the non-resident's local authorities to seek to compel the non-resident's attendance to be examined for discovery. Such cooperation is routinely sought through an Order for letters of request and a commission consistent with section 53(1) of the *Federal Courts Act* and Rules 271 and 272, and Form 272, adapted as necessary for examination for discovery. The Court has very broad jurisdiction to set the terms and the manner of examination of a non-party who is not resident in Canada (*Visx Inc. v. Nidek Co.*, 1998 CanLII 8031 (FC), at para. 9; see also *Allergan Inc. v. Apotex Inc.*, 2020 FC 658 (CanLII), at para. 17); this broad power would include letters of request and a commission if the inventor resides outside of Canada. It is the most effective manner by which to proceed absent an agreement between the parties.

III. Analysis

A) The Right to Examine Inventor Employees

[35] The Defendant argues that it has the right and an entitlement to examine the Plaintiffs' Inventor Employees pursuant to Rule 237(4). It further argues that its desire to examine each employee inventor for discovery is proportional and would not unduly lengthen the proceedings.

Finally, the Defendant argues that proportionality concerns should not override its substantive rights to proceed to the examination for discovery of the Inventor Employees.

[36] The Plaintiffs argue that they agree that the Defendant has a right to examine Inventor Employees pursuant to Rule 237(4), but that that right is not unlimited and is subject to principles of proportionality. The difficulty with the Plaintiffs' argument, however, is that how they apply the principles of proportionality in this case suggests that it is appropriate for the assignee party to pre-emptively determine what is proportional in the Defendant's examination for discovery of the inventors. It is not.

[37] Finally, the Plaintiffs argue that the manner in which the Defendant seeks to proceed with respect to non-resident Inventor Employees – by way of an order compelling the Plaintiffs and enforceable against the Plaintiffs to make identified non-resident Inventor Employees available for examination for discovery – is not contemplated by the *Rules* and that the proper manner in which the Defendant should proceed is by way of letters of request and a commission.

[38] As mentioned above, there is no question that the Defendant's entitlement to examine the Plaintiffs' Inventor Employees exists and can be exercised by the Defendant (*Richter Gedeon Vegyészeti Gyar Rt v. Merck & Co. (C.A.)*, 1995 CanLII 3514 (FCA), [1995] 3 FC 330, *Faulding (Canada) Inc. v. Pharmacia S.P.A.*, 1999 CanLII 7940 (FC), at para. 4).

[39] It is also without question that any right of discovery, including examination for discovery, is subject to the overarching principle of proportionality set out in Rule 3 of the *Rules*.

Applying the principle in the context of oral discoveries means that the Court must consider, at least, whether the information sought is necessary for the requesting party to make its case, or whether the examination is solely to ensure that it not be taken by surprise at trial (*Apotex Inc. v. H. Lundbeck A/S*, 2012 FC 414 (CanLII), at para. 48).

[40] The Defendant's desire to examine the other seven (7) of the Plaintiffs' thirteen (13) Inventor Employees has not been shown on this motion to be disproportionate given the importance of the issues in dispute. The Defendant's right to examine all 13 of the Plaintiffs' Inventor Employees pursuant to Rule 237(4) should not be hindered by the Plaintiffs as has been the case here. Although the Plaintiff may eventually be found to have correctly determined that only those Inventor Employees it proposes to make available for examination for discovery need to be examined for the purposes of the proceeding, neither the *Rules* nor the *Regulations* provide the Plaintiffs with any pre-emptive right to unilaterally dictate what may or may not be proportional in the Defendant's intended manner of proceeding with inventor discovery. Even if there was such a right, given the requirement for the parties to reasonably cooperate in expediting the action, the exercise of that right could not be based solely on what the Plaintiffs consider proportional based on their assessment of their own case and their own view of the use that can be made of an inventor's examination for discovery at trial. It follows that the Plaintiffs' conduct in unilaterally selecting which Inventor Employees to make available for discovery pursuant to Rule 237(4) and holding fast to its decision in the face of the Defendant's request in this case to examine all of the Inventor Employees is contrary to the *Rules*.

[41] If the Plaintiffs have a legitimate concern about the number of Inventor Employees the Defendant intends to examine for discovery, then they should bring up those concerns either during a case management conference in a discussion about a discovery plan or on a motion designed to have the Court impose conditions on the Defendant's examinations pursuant to Rule 237(4) of the *Rules*.

B) The Manner of Compelling the Examination of Inventor Employees

[42] The Defendant seeks an Order *in personam* against the Plaintiffs requiring them to make their Inventor Employees who are not corporate representatives but are potential witnesses available to be examined for discovery pursuant to Rule 237(4), failing which the Order could be enforced against the Plaintiffs themselves. As explored above, there is no basis for such an Order in the *Rules* or in the *Regulations*. Giving effect to the duty incumbent upon the parties to reasonably cooperate in expediting this proceeding pursuant to section 6.09 of the *Regulations* does not extend to requiring the Court to create of a new procedural vehicle to compel a third party assignor who is a non-resident to attend examination for discovery when normally exercisable means of proceeding such an agreement between the parties or letters of request and a commission have been neither attempted nor exhausted.

[43] The Defendant relies on Justice Phelan's decision in *Offshore Interiors Inc., v. Worldspan Marine Inc.*, 2017 FC 479, in support of its argument that there is precedent for an Order compelling a non-resident corporate representative to travel from outside of Canada to Canada in order to be examined for discovery. *Offshore Interiors* does not apply to the issue at hand in this proceeding. *Offshore Interiors* was concerned with whether representatives who had sworn and delivered affidavits in a proceeding in Canada could be compelled to travel to

Vancouver from the United States to be cross-examined on their affidavits when there was no issue of any physical or psychological needs that would preclude their travel to Vancouver. The Court was concerned with the cross-examination of deponents who were representatives of the intervener, not non-party assignor witnesses. The case did not concern Rule 237(4) at all as it was concerned with deponents and cross-examination (*Offshore Interiors Inc., v. Worldspan Marine Inc.*, 2017 FC 479, at para. 11), which is not the case here.

[44] The Defendant also argues that *Allergan Inc. v. Apotex Inc.*, 2020 FC 658 (CanLII) is a clear example of Rule 237(4) and the right to examine an inventor being enforced against the assignee party. I disagree. *Allergan* involved a very specific set of circumstances and events that resulted in the Court making an Order pursuant to Rule 3 and section 6.09 of the *Regulations* that the assignee use its best efforts to obtain the participation of a non-party non-resident inventor to be examined. The assignee was not compelled to produce the inventor to be examined for discovery as the Defendant seeks here.

[45] Beyond the absence of a legal basis for the Order sought, there are sound common sense reasons to resist the Defendant's request. The Order the Defendant seeks is one that the Plaintiffs may not be able to comply with despite their best efforts for any one of a number of reasons, circumstances, or interests that are beyond their control and are personal to the assignor to be examined.

[46] The Plaintiffs indicated in their written representations and again at the hearing of this motion that they would be open to considering and possibly not opposing a motion for an Order

granting and issuing letters of request and commissions for the examination for discovery of the non-resident Inventor Employees should such a motion be brought. The Defendant may wish to explore the Plaintiffs' suggestion regarding the manner of proceeding.

C) Providing Better Inventor Former Employee Contact Information

[47] The Defendant seeks an Order directing the Plaintiffs to provide their most current contact information, including any email address and any phone number, for individuals who are reportedly no longer employed by the Plaintiffs and are named inventors on one or more of the patents in the proceeding. The Plaintiffs have provided the Defendant with the names and last known home addresses for its Inventor Former Employees. The Defendant seeks “meaningful contact information”, such as telephone numbers or email addresses.

[48] As discussed above, the *Regulations* require at section subsection 6.04(2) and subsection 5(3.1) that the Plaintiffs provide the name and contact information for any inventor who might have information relevant to an allegation of patent invalidity or voidness. The evidence before me is that they have done so. Although one might appreciate that the Defendant may not be satisfied with the nature, quality, or currency of the contact information provided by the Plaintiffs, there is no basis on the record before me to require the Plaintiffs to do more than they have done.

[49] The Plaintiffs' obligation is to provide the inventors' name and contact information. Although it is not explicit from the *Regulations*, the RIAS makes it clear that the provision of contact information is to facilitate and expedite access to relevant evidence and, by extrapolation, to facilitate the potential examination for discovery of a non-party witness through the disclosure

of a potential address for service. The Defendant can take the steps it considers appropriate to obtain more or different contact information if it is dissatisfied with the information provided to it by the Plaintiffs, including from non-party investigative resources.

D) An Informal Discussion with Inventor Employees

[50] The Defendant has sought an Order that the Plaintiffs permit the solicitors of record for Defendant to have a 1-hour videoconference conversation with each of the Inventor Employee (an “Informal Discussion”) for the purpose of permitting counsel for the Defendant to determine the role of each of the Inventor Employee in the conception of the purported inventions in dispute. The Informal Discussion is to be ordered as being without prejudice to the Defendant seeking letters of request or letters rogatory in respect of each Inventor Employee. The solicitors of record for the Plaintiffs would be permitted to attend each information discussion and the Inventor Employees would be required to answer questions truthfully. Essentially, the Defendant seeks an Order authorizing it to ask questions of an inventor to explore whether examination for discovery of that Inventor Employee would be worthwhile before investing in actually conducting examination for discovery, the whole without prejudice to its right to examine for discovery.

[51] Although there may be some worthy practical reasons for the parties agreeing to such an informal discussion in an appropriate proceeding as a means to expedite the action and attempt to control costs by limiting the number of inventors to be examined for discovery, there is no basis whatsoever for the Court to make the Order sought on the record before me or in the *Rules*.

IV. Conclusion and Costs

[52] For the reasons provided above, the Defendant's motion is dismissed.

[53] The Plaintiffs stated at the hearing of this motion that they are seeking costs in the amount of \$3,000, should they be successful. The Plaintiffs were wholly successful on this motion. The Defendant shall pay the Plaintiffs their costs of this motion which I hereby fix in the lump sum amount of \$1,000, all inclusive, within 90 days of the date of this Order.

[54] I have exercised my discretion to award a low amount of costs because of the parties' failure to be practical that is reflected in the record that is before me. The Plaintiffs complied with the early scheduling order and then applied their own view of proportionality with respect to further examinations of inventors. The Plaintiffs ought not to be rewarded for hindering the Defendant's procedural rights to examine inventors, and the Defendant should be made to understand by way of costs order, albeit a modest one, that the Orders sought on this motion were simply not supported by either the jurisprudence, the *Rules*, or the *Regulation*.

[55] The RIAS and the industry/regulatory compromises given effect through the *Regulations* reflect a real concern that litigation pursuant to the *Regulations* must proceed from service of the Statement of Claim to a trial decision in a very short time frame that is easily derailed by one party's failures to cooperate reasonably at any given time throughout the process. Section 6.09 of the *Regulation* recognizes that the parties are to reasonably cooperate to expedite any action. This Court's *Case and Trial Management Guidelines for Complex Proceedings and Proceedings under the PM(NOC) Regulation* contain a direction that parties are to make a *bona fide* effort to

agree and set realistic timetables in their discovery plans. A failure to do so can result in consequences, including significant costs. Other types of Orders such as restrictions on examination rights may be made to drive home the point that a failure to cooperate reasonably on issues of process and procedure that do not detrimentally affect a party's legitimate interests and rights in the cause but results in running down the litigation clock is not acceptable.

[56] The parties are encouraged to have meaningful discussions to schedule the examination for discovery of inventors. The parties may request a case management conference for the Court's assistance in scheduling and carrying out those examinations for discovery should they not be able to agree.

THIS COURT ORDERS that:

1. The Defendant's motion is dismissed.
2. The Defendant shall pay the Plaintiffs their costs of this motion in the amount of \$1,000, all inclusive, within 90 days of the date of this Order.

"Benoit M. Duchesne"
Case Management Judge

FEDERAL COURT
SOLICITORS OF RECORD

DOCKET: T-2276-22 & T-2318-22

STYLE OF CAUSE: BOEHRINGER INGELHEIM (CANADA) LTD. and
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GMBH v. JAMP PHARMA CORPORATION

PLACE OF HEARING: TORONTO, ONTARIO

DATE OF HEARING: MAY 24, 2023

**REASONS FOR JUDGMENT
AND JUDGMENT:** DUCHESNE AJ.

DATED: JULY 4, 2023

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