

Federal Court



Cour fédérale

Date: 20230830

**Docket: T-1831-22
T-1842-22**

Citation: 2023 FC 1175

Ottawa, Ontario, August 30, 2023

PRESENT: Case Management Judge Benoit M. Duchesne

Docket T-1831-22

BETWEEN:

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

**Plaintiffs/
Defendants by Counterclaim**

and

SANDOZ CANADA INC.

**Defendant/
Plaintiff by Counterclaim**

Docket T-1842-22

BETWEEN:

**BOEHRINGER INGELHEIM (CANADA) LTD. and
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**Plaintiffs/
Defendants by Counterclaim**

and

SUN PHARMA CANADA INC.

**Defendant/
Plaintiff by Counterclaim**

ORDER

[1] The Defendants have brought a motion pursuant to Rule 97 of the *Federal Courts Rules*, SOR/98-106 (the “*Rules*”) to compel answers to questions refused by the Plaintiffs’ corporate representative during his examination for discovery held on June 14, 15, 20, 21 and 22, 2023. The parties worked cooperatively prior to the hearing of the motion to substantially reduce the number of questions to be considered by the Court during the hearing of the motion. Except as set out below in the operative part of this Order with respect to objections for which the adjudication that has been deferred, the corporate representative refusals were disposed of for the oral reasons given during the hearing of the Defendants’ motion.

[2] The Defendants also sought to compel answers to questions refused during the examination for discovery of the inventors who assigned their patent rights to the Plaintiffs. These examinations for discovery occurred pursuant to Rule 237(4) of the *Rules*. The objections made during the inventor examinations were disposed of for the oral reasons given during the hearing of the Defendants’ motion. The specific relief sought by the Defendants with respect to the inventor examinations is set out in the Defendant’s notice of motion as follows:

“An Order”:

- a) [...]
- b) Requiring the Plaintiffs to provide answers to questions improperly objected to and any proper question arising therefrom:

- i. from Dr. Wolfram Eisenreich, as indicated in Part III of the attached charts;
- ii. from Dr. Matthias Eckhardt, as indicated in Part III of the attached charts;
- iii. from Dr. Leo Thomas, as indicated in Part III of the attached charts;
- iv. from Dr. Gerd Luippold, as indicated in Part III of the attached charts;
- v. from Dr. Hans-Juergen Martin, as indicated in Part III of the attached charts; (the emphasis is mine)

[3] The Court informed the Defendants during the hearing of the motion that this portion of their sought relief, specifically, an order compelling the Plaintiffs to provide answers from inventors pursuant to Rules 97 and 237(4) of the *Rules*, was ill-conceived and could not be granted in that this Court could not compel the Plaintiffs to provide answers sought from a non-party and non-corporate representative inventor for the reasons set out in *Boehringer Ingelheim (Canada) Ltd. and Boehringer Ingelheim International GmbH v Jamp Pharma Corporation*, 2023 FC 943. The Court's power to compel pursuant to Rule 97 does not extend to compel a person who has not been served personally with a direction to attend to be examined, or to compel a person who was not asked a question on discovery while under oath. Rules 97(a), (b), (c) and (e) set out this conclusion in plain language in the *Rules*. It follows that the Plaintiffs, being distinct from the inventor who has been served with a direction to attend and not having been asked the questions for which relief is sought, cannot be ordered to provide answers to questions that were refused during the inventor's Rule 237(4) examination for discovery as they cannot be compelled to answer for the inventor.

[4] The Defendants have argued strenuously that the Plaintiffs' solicitors of record acted contrary to the *Rules* by making objections on the record at the Rule 237(4) examination for discovery of the inventors. The Defendants argue that the objections made on the record by the Plaintiff's solicitors of record during the Rule 237(4) inventor examinations are problematic

because the refusals appear to have been given on behalf of the Plaintiffs, or by the Plaintiffs and the inventor, which the Plaintiffs' lawyers may or may not have been assisting during the examinations.

[5] The Defendants also argue that the questions they put to the inventors but were refused by the Plaintiffs are clearly relevant and should be answered by the inventors, particularly because the Plaintiffs refuse to produce emails, presentations, meeting minutes and internal memoranda regarding the inventors and their work. As mentioned above, this category of objections was dealt with during the hearing of the Defendants' motion and oral reasons were given from the bench with respect to each question on which the Defendants chose to proceed. Those questions and the reasons for the orders made with respect to each will not be revisited here.

[6] Finally, the Defendants argue that the Plaintiffs' interference with the Rule 237(4) inventor examinations have prevented the Defendants from obtaining a transcript on key issues such as inventor course of conduct and knowledge that could be used to impeach the credibility of the inventor if the inventor is called to testify at trial. The record before me does not show that the Plaintiffs have interfered in the Defendants' inventor discovery or that such "interference" has caused the Defendants prejudice with respect to obtaining a transcript for a potential future use at trial. Rather, the record shows that the Defendants' questions were in many cases not proper questions within the meaning of the *Rules*, were appropriately objected to, did not require an answer then, and do not require an answer now.

[7] The Plaintiffs argue that the *Rules* permit a party's solicitor of record to attend the examination for discovery of a non-party inventor and make objections on the record, regardless of whether the non-party inventor is represented on the motion by the objecting party's solicitors of record or not. I agree with the Plaintiffs.

[8] The Defendants have requested that this Court provide written reasons with respect to whether it is appropriate for a party's solicitor of record to attend the examination of a non-party inventor and to make objections on the record in order to provide the parties future guidance in this proceeding.

I. The Background

[9] A limited review of the facts relevant to these reasons and regarding Rule 237(4) examinations for discovery is appropriate. The parties are involved in contentious litigation with respect to six (6) patents owned by the Plaintiffs. The Defendants obtained an Order for the issuance of commissions and letters of request pursuant to Rule 272 of the *Rules* and proceeded to examine some of the inventors identified in the patents at issue in the proceeding prior to examining the Plaintiffs' corporate representative for discovery. The Defendants have yet to examine a few of the inventors identified in the patents although their examination for discovery of the Plaintiffs' corporate representative is now complete subject to objections determined on this motion, the Plaintiffs' delivery of answers to undertakings, and any follow-up examination on those answers and any proper questions arising therefrom.

[10] The Plaintiffs' solicitors of record attended the Rule 237(4) examinations for discovery of the inventors identified above. The Plaintiffs' solicitors of record assisted some of the inventors in their preparations to be examined for discovery, whereas other inventors prepared themselves on their own without the assistance of the Plaintiffs' solicitors of record. In one case, the Plaintiffs' solicitors of record attended an inventor's Rule 237(4) examination for discovery to assist the inventor during their examination. The record before the Court establishes the following:

- a. the inventor Dr. Eisenreich was not represented by any lawyers during his Rule 237(4) examination for discovery although he did meet three times with the Plaintiffs' solicitors of record to prepare prior to his examination for discovery (Transcript of the examination for discovery of Dr. Wolfram Eisenreich held on May 30, 2023, at page 2 and at questions 29 to 33);
- b. the inventor Dr. Eckhardt met with the Plaintiffs' lawyers, but did not retain lawyers to help him prepare or to defend him during his examination for discovery (Transcript of the Examination for Discovery of Dr. Matthias Eckhardt, held May 31, 2023, at page 2 and at questions 19 to 36);
- c. the transcript of the inventor Dr. Thomas' examination for discovery does not reflect that he was represented by any lawyers during his Rule 237(4) examination for discovery, although the Plaintiffs' counsel in attendance stated on the record during the second day of Dr. Thomas' examination at question 591, following a question by the Defendants' solicitors about the nature of the refusals given during the examination, that the refusals i) were made by the Plaintiffs' solicitors on behalf of the Plaintiffs and on behalf of Dr. Thomas, and, ii) that the Plaintiffs'

solicitors were present during the examination to assist Dr. Thomas (Transcript of the examination for discovery of Dr. Leo Thomas held on June 1, 2023, at page 2, and Transcript of the examination for discovery of Dr. Leo Thomas held on June 2, 2023, at page 2 and at question 591);

- d. the inventor Dr. Luippold was not represented by any lawyers during his Rule 237(4) examination for discovery, although he did meet three or four times with the Plaintiffs' solicitors of record to prepare prior to his examination for discovery (Transcript of the examination for discovery of Dr. Gerd Luippold held on June 5, 2023, at page 2 and at questions 48 to 50); and,
- e. the inventor Dr. Hans-Juergen Martin was not represented by any lawyers during his Rule 237(4) examination for discovery, although he did meet two or three times with the Plaintiffs' solicitors of record to prepare prior to his examination for discovery (Transcript of the examination for discovery of Dr. Hans-Juergen Martin held on June 6, 2023, at page 2 and at questions 57 to 64).

[11] It bears noting that the Defendants first raised a question regarding the Plaintiffs' solicitors' objections during the inventors' Rule 237(4) examinations for discovery on June 2, 2023, part way through the fourth (4th) day of six (6) days of inventor examinations. Even then, having raised the issue, the Defendants did not state for the record that they considered or took the position that the Plaintiffs' solicitors' conduct in making objections on the record was improper, illegitimate, open to question, or required further clarification. The inventor examinations continued on days five and six with continued objections being made on the record by the Plaintiffs' solicitors of record without any objection as to the Plaintiffs' solicitor's conduct as is now raised by the Defendants.

[12] The Defendants at no time suggested during the examinations that a motion was required to determine whether the Plaintiffs' solicitors' objections could be made on the record or at all. Rather, save and except for the brief exchange that lasted a few moments only on day 4 of 6 days of examination for discovery, the Defendants' conduct suggested that they accepted that the Plaintiffs' solicitors of record had the right to attend the inventor examinations for discovery and to make objections on the record.

[13] The Defendants now ask the question of whether the solicitors of record for one or more of the parties attending the examination for discovery of a non-party inventor pursuant to Rule 237(4) may make objections on the record regardless of whether the solicitors represent the non-party inventor witness. The *Rules* determine that the answer to his question is clearly yes.

II. Analysis

[14] Rule 240 sets out the scope of examination for discovery as follows:

Scope of examination	Étendue de l'interrogatoire
240 A person being examined for discovery shall answer, to the best of the person's knowledge, information and belief, any question that	240 La personne soumise à un interrogatoire préalable répond, au mieux de sa connaissance et de sa croyance, à toute question qui :
(a) is relevant to any unadmitted allegation of fact in a pleading filed by the party being examined or by the examining party; or	a) soit se rapporte à un fait allégué et non admis dans un acte de procédure déposé par la partie soumise à l'interrogatoire préalable ou par la partie qui interroge;
(b) concerns the name or address of any person, other	b) soit concerne le nom ou l'adresse d'une personne,

<p>than an expert witness, who might reasonably be expected to have knowledge relating to a matter in question in the action.</p>	<p>autre qu'un témoin expert, dont il est raisonnable de croire qu'elle a une connaissance d'une question en litige dans l'action.</p>
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[15] Rule 242 sets out that questions may be objected to during an examination for discovery as follows:

Objections permitted

242 (1) A person may object to a question asked in an examination for discovery on the ground that

(a) the answer is privileged;

(b) the question is not relevant to any unadmitted allegation of fact in a pleading filed by the party being examined or by the examining party;

(c) the question is unreasonable or unnecessary; or

(d) it would be unduly onerous to require the person to make the inquiries referred to in rule 241.

Objections not permitted

(2) A person other than a person examined under rule 238 may not object to a

Objection permise

242 (1) Une personne peut soulever une objection au sujet de toute question posée lors d'un interrogatoire préalable au motif que, selon le cas :

a) la réponse est protégée par un privilège de non-divulgateion;

b) la question ne se rapporte pas à un fait allégué et non admis dans un acte de procédure déposé par la partie soumise à l'interrogatoire ou par la partie qui l'interroge;

c) la question est déraisonnable ou inutile;

d) il serait trop onéreux de se renseigner auprès d'une personne visée à la règle 241.

Objection interdite

(2) À l'exception d'une personne interrogée aux termes de la règle 238, nul ne

question asked in an examination for discovery on the ground that	peut s'opposer à une question posée lors d'un interrogatoire préalable au motif que, selon le cas :
(a) the answer would be evidence or hearsay;	a) la réponse constituerait un élément de preuve ou du ouï-dire;
(b) the question constitutes cross-examination.	b) la question constitue un contre-interrogatoire.

[16] Rule 240 describes that what the “person being examined”, “*La personne soumise à un interrogatoire préalable*” must do during examination for discovery. It is clear in its designation of the “person”, “la personne”, that the person being examined, whether a party or not, is to answer questions as prescribed by the Rule.

[17] The *Rules* provide a definition of the word “person”. As found in Rule 2, a “person”, a “*personne*”, is defined as “includes a tribunal, an unincorporated association and a partnership”. The definition of the word “person” as used in the *Rules* is clearly not exhaustive.

[18] It is equally clear that the use of the word “person” in the *Rules*, depending on the context, may refer to and mean a “party” but is not necessarily always referring to or meaning a “party”. Rather, the contextual interpretation of the word “person” will assist in the determination of which “person” is referred to in any given Rule. Similarly, there are some Rules that specifically refer to what a “party” is required to do or may do, and those references could also include and apply to a “person” based on that person’s role and status in the proceeding. Reference to a few foundational Rules applicable to examinations demonstrates these points.

[19] Rules 87 to 100 apply to examinations for discovery under the *Rules*. Rule 95(1) provides that “A person who objects to a question that is asked in an oral examination shall briefly state the grounds for the objection for the record”. The use of the word “person” in this context necessarily refers to an individual, a corporation or other business structure, a corporate representative of a party, a party or some combination of each of these descriptors as the context may require. The same interpretation would apply with respect to the use of the word “person” in Rule 95(2). The use of the word “person” within these Rules cannot be held to exclude a “party” from its ambit, as it would lead to the absurd result that a party would have no right to object to a question asked on examination for discovery, including during their own examination for discovery.

[20] Rule 96 refers to the “person” again, but in the context of the “person being examined” and that person’s ability to adjourn an examination to bring a motion for directions in the circumstances set out in the Rule. Persons who are not parties, for example inventors who are being examined pursuant to Rule 237(4), clearly have the right to adjourn an examination to seek directions pursuant to Rule 96 because they are a “person being examined”, but so must parties who are being examined pursuant to Rules 234 and following, regardless of whether the party is an individual or a corporation because would also be the “person being examined”. Rule 96 makes no distinction between a “person” and a “party” as no distinction is necessary given that the procedural right to adjourn and to seek directions is available to both a person and a party depending the context and circumstances. Again, the word “person” must be held to include a “party” in the context of the Rule.

[21] Rule 97 follows the same contextual logic as Rule 96 in setting out that the Court can compel a “person” who fails to attend an oral examination or refuses to answer a proper question to answer a proper question. It would strain logic to interpret Rule 97 as excluding a “party” from the meaning of the word “person” as used in the Rule given that a party to a proceeding is very frequently summoned to attend an oral examination for discovery. Again, contextually, the word “person” must include a “party”.

[22] Rule 234 considered contextually also highlights that a “person” may include a “party” but does not always mean a “party”. Rule 234(1) sets out that examinations for discovery may be conducted by a party both orally and in writing with leave of the Court, but Rule 234(2) prescribes that where “two or more parties are entitled to examine a person”, the examination shall be by way of an oral examination except with leave or on consent. Rule 235 immediately follows to prescribe that a “party” may be examined only once.

[23] Given that the Rules contemplate that parties and non-parties may be examined for discovery, but that only a “party” may conduct an examination for discovery, it appears that the Rules are coherent in their description of examination rights by prescribing specific Rules that apply to parties when they are meant to apply to parties only through the use of the word “party”, and by prescribing Rules that apply more broadly to “persons” including “parties” when the word person is used and considered in its context.

[24] Returning to Rule 242 and the ability of a “person” to object to a question asked during examination for discovery, it follows that the “person” who may make an objection on the record

during an examination for discovery is not described in a limited manner by the wording used in the Rule. Rule 242 does not define the potential objector as “the person being examined for discovery”. The wording used is more expansive. The ability to object during an examination for discovery is provided to a “person” and must be interpreted contextually to include a “party” even when that party is not being examined for discovery.

III. **Conclusion**

[25] It follows from the foregoing that it is permissible and indeed contemplated by the *Rules* that a Plaintiff’s solicitor of record may attend on the examination for discovery of a non-party inventor pursuant to Rule 237(4) and make objections on the record even if the solicitor at issue does not act for the non-party witness being examined. The party’s solicitor of record attending the examination for discovery may indeed object to a question on the grounds set out in Rule 242. That objection may also be made on behalf of the party rather than of the witness.

[26] The party making the objection has the right to object to ensure that the examination of the non-party is being carried out in accordance with *Rules* and that proper questions are asked. In this sense, considered more broadly but on this relatively narrow point of procedure and taking into account the difference between examinations for discovery and trials, the parties have the ability to object to questions asked of a non-party witness during that non-party witness’ examination for discovery as they would be entitled to object to a question asked of a non-party witness who is being examined in chief or cross-examined during a trial.

[27] The Defendants' motion for an Order compelling the Plaintiffs to provide answers to questions improperly objected to during the examination of the non-party inventors is therefore dismissed.

[28] That does not completely dispose of the matter however. Considering that the inventors at issue are all located outside this Court's territorial jurisdiction and have already, for the most part, met with the Plaintiffs' solicitors of record to prepare for their examination for discovery, and that the Plaintiffs' solicitors of record confirmed during the hearing of this motion that they could try to or could in fact contact the inventors and attempt to prevail upon them to answer the questions which the Court has determined were proper questions that should be answered by them, it is appropriate to make an Order akin to the "best efforts" Order contemplated by the Court at paragraphs 23 and 24 of *Allergan Inc. v. Apotex Inc.*, 2020 FC 658 (CanLII).

THIS COURT ORDERS that:

1. The Defendants' motion is granted in part, as follows:
 - a) for the reasons given orally during the hearing of the Defendants' motion, the questions found at item numbers 9, 10, 11, 125, 186, 192 of the Defendants' moving chart are proper questions and are to be answered by the Plaintiffs within 15 days of this Order, or within such other extended time as the parties may agree in writing, acting reasonably and cooperatively;
 - b) for the reasons given orally during the hearing of the Defendants' motion, the questions found at item numbers 289, 290, 291, 310, and 317 of the

Defendants' moving chart are proper questions, and the Plaintiffs are requested to use reasonable efforts to contact the inventors at issue and to prevail upon them to answer the question asked within 21 days of the date this Order, or within such other extended time as the party may agree in writing, acting reasonably and cooperatively;

- c) for the reasons given orally during the hearing of the Defendants' motion, the questions found at item numbers 1, 2, 4, 5, 17, 19, 22, 23 24, 39, 40 to 48, 51 to 54, 55 to 58, 61, 63, 68, 126, 133, 135, 151, 155, 157, 161 to 165, 193, 244, 248, 252, 253, 259, 260, 261 to 266, 267 to 278, 292, 293, 294, 295, 296 to 308, 309, 310 to 316, 318 to 351 of the Defendants' moving chart are not proper questions and the objections made during the examinations for discovery are upheld. These questions do not need to be answered; and,
- d) for the reasons given orally during the hearing of the Defendants' motion, the questions found at item numbers 12, 145, 187, and 206 of the Defendants' moving chart are deferred to be considered upon a request from the Defendants' for the Court's consideration of these questions following the completion of the Defendants' Rule 237(4) examinations for discovery.

- 2. This Court notes that the Defendants have withdrawn those questions found at item numbers 3, 6, 7, 8, 13, 14, 15, 18, 21, 21, 59, 60, 62, 64 to 67, 69, 95, 134 to 142, 178, and 182 to 184 of the Defendants' moving chart.

3. The Defendants may continue their examination for discovery on the answers ordered to be answered through this Order, as well as any proper question arising therefrom. The parties are to confer and act cooperatively to schedule these limited follow up-examinations. If the parties cannot agree on a schedule for the follow-up examinations, then they can seek a timetable Order from the Court through a request for a virtual case management conference.
4. Following the agreement of the parties, there are no costs awarded for this motion.

“Benoit M. Duchesne”

Case Management Judge

FEDERAL COURT
SOLICITORS OF RECORD

DOCKET: T-1831-22 AND T-1842-22

STYLE OF CAUSE: BOEHRINGER INNGELHEIM (CANADA) LTD. and
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GMBH (Plaintiffs/Defendants by Counterclaim) v
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Counterclaim)

PLACE OF HEARING: OTTAWA, ONTARIO (VIEDOCONFERENCE)

DATE OF HEARING: AUGUST 18 AND 21,2023

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

DATED: AUGUST 30, 2023

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