

**Date: 20070706**

**Docket: T-787-02**

**Citation: 2007 FC 713**

**Montréal, Quebec, July 6 2007**

**PRESENT: Richard Morneau, Esq., Prothonotary**

**BETWEEN:**

**BOMBARDIER PRODUITS RÉCRÉATIFS INC.**

**Plaintiff**

**and**

**BOSS CONTROL INC.**

**Defendant**

**and**

**BOSS CONTROL INC and  
1217537 ONTARIO LTD.**

**Plaintiffs by Counterclaim**

**and**

**BOMBARDIER INC. and  
BOMBARDIER PRODUITS RÉCRÉATIFS INC.**

**Defendants to the Counterclaim**

**REASONS FOR ORDER AND ORDER**

[1] This Court is seized with two motions.

[2] The first one is by the Plaintiff, Bombardier Produits Récréatifs Inc., and Defendants by Counterclaim, Bombardier Inc. and Bombardier Produits Récréatifs Inc. (hereinafter collectively “BRP”) for various reliefs against the Defendant, Boss Control Inc., and Plaintiffs by counterclaim, Boss Control Inc. and 1217537 Ontario Ltd, (hereinafter collectively “Boss Control”) for alleged improper termination by Boss Control of the discovery of its representative held on April 12, 2007 (the discovery of Boss Control).

[3] The second motion is by Boss Control to compel BRP’s representative to answer questions allegedly improperly objected to during the discovery of BRP’s representative.

### **Background**

[4] These two motions take place in the context of an action for a declaration of non-infringement and invalidity in respect of Canadian Patent No. 2,177,945 (the ‘945 patent) owned by Boss Control. The action was commenced by Bombardier Inc. (“Bombardier”) on May 17, 2002. Boss Control has counterclaimed for infringement against BRP. Boss Control claims that BRP personal watercrafts and snowmobiles incorporating BRP’s Digitally Encoded Security System (“D.E.S.S.”), an anti-theft system, infringe each claim of the ‘945 patent.

[5] The ‘945 patent claims are said to disclose a security power interrupt system designed to prevent the unauthorized use of an electrically operated appliance, such as a stove, while allowing for the continued operation of auxiliary electrical equipment when the appliance is still in the “interrupt” mode. The ‘945 patent claims a priority date of December 27, 1993 based on a United

States patent application that was issued as U.S. Patent No. 5,486,725 (the “U.S. 725 patent”). Both the ‘945 and U.S. ‘725 patents are entitled “Security Power Interrupt”.

[6] We shall now turn to BRP’s motion.

### **I- BRP’s motion**

[7] In June 2005, the U.S. Court of Appeal for the Federal Circuit unanimously affirmed a lower court’s decision holding that Bombardier Inc.’s products do not infringe a U.S. patent owned by Boss Control which BRP sees as virtually identical to the patent in suit (the U.S. action). In this U.S. action, a protective order was in place between Boss Control and Bombardier Inc. to apply during the U.S. action and to continue to be binding event after the conclusion of the U.S. action.

[8] At the discovery of Boss Control on April 12, 2007, Boss Control did not allow counsel for BRP to put any of the U.S. action documents to Boss Control’s representative. This clash between the parties brought, as I see in reality, a temporary halt to the discovery of Boss Control.

[9] This suspension occur - and was bound to occur - because although the parties had discussed the matter many times in the months, even years (to wit from August 2003 to December 22, 2006 and beyond) prior to the discovery of Boss Control, they did not reach a clear agreement as to whether and to what extent the parties, and especially BRP, could have access to and use the documents produced in the U.S. action. As I see it, both parties are pretty much responsible for having entered Boss Control’s discovery with this potential dilemma in place.

[10] Upon reading the motion material of the parties and upon hearing counsel, I intend to adjudicate as follows in order to bring a resumption of Boss Control's discovery with in hand, first, a better and further affidavit of documents from Boss Control.

[11] I do not intend to strike Boss Control's counterclaim.

[12] However, Boss Control will be required to serve a further and better affidavit of documents listing all relevant documents to this case even though some of these documents might otherwise fall under the protective order in the U.S. action. Inasmuch as it is necessary, Boss Control will be relieved to that extent from the implied undertaking rule.

[13] In the hope to avoid any further motion regarding, *inter alia*, the completeness of said supplemental affidavit of documents, said affidavit shall include:

- documents related to Boss control's efforts to commercialize its alleged invention since said documents might served as indicia of obviousness;
- documents related to the prosecution histories of the U.S. patents raised by BRP since the patent in suit claims a priority filing date based on one of the U.S. patents and since the U.S. patents are continuation and divisional applications from the U.S. application from which the Canadian application claims priority;
- Documents related to the structure of the D.E.S.S., the alleged infringing product, since this factual aspect has already been the subject of some exchanges between the parties.

[14] As to the pursuit of Boss Control's discovery, it will be ordered that it shall be pursued and completed under a new deadline, under the same conditions in terms of venue and expenses as on April 12, 2007.

[15] BRP's motion will otherwise be dismissed, with costs however to BRP since it is largely successful.

### **ORDER**

Therefore, with respect to BRP's motion, the Court hereby orders as follows:

Boss Control is required to serve a further and better affidavit of documents listing all relevant documents to this case even though some of these documents might otherwise fall under the protective order in the U.S. action. Inasmuch as it is necessary, Boss Control is relieved to that extent from the implied undertaking rule.

In the hope to avoid any further motion regarding, *inter alia*, the completeness of said supplemental affidavit of documents, said affidavit shall include:

- documents related to Boss Control's efforts to commercialize its alleged invention since said documents might served as indicia of obviousness;
- documents related to the prosecution histories of the U.S. patents raised by BRP since the patent in suit claims a priority filing date based on one of the U.S. patents and since the U.S. patents are continuation and divisional applications from the U.S. application from which the Canadian application claims priority;

- Documents related to the structure of the D.E.S.S., the alleged infringing product, since this factual aspect has already been the subject of some exchanges between the parties.

As to the pursuit of Boss Control's discovery, it shall be pursued and completed under the same conditions in terms of venue and expenses as on April 12, 2007.

BRP's motion is otherwise dismissed, with costs however to BRP since it is largely successful.

## **II- Boss Control's motion to compel**

[16] At the end of the discovery of BRP's representative, 39 questions were still outstanding. These questions have been grouped by Boss Control into 4 categories under a Schedule A. This categorisation will be retained herein but the Court shall also use the itemisation performed by BRP in its motion record in response.

[17] In its motion record in response, BRP has provided what it considers sufficient answers to about 31 questions out of the 39 questions outstanding. In addition, a document dated July 3, 2007 and provided by Boss Control limits even more the debate. Therefore, I shall deal only here with the few questions still outstanding between the parties.

### Category 2

[18] It deals with the validity of the '945 patent.

[19] I agree with BRP that items 25 to 29, as framed, ask BRP's representative to essentially describe how an allegation of invalidity will be made. These are questions of law to be addressed by the Court with the help of experts. They need not be answered.

[20] Item 30 seeks to determine the facts in support of a fraud allegation. It shall be answered.

**ORDER**

Therefore with respect to Boss Control's motion to compel, the Court hereby orders as follows:

- The representative of BRP shall re-attend at his own expense for a further examination for discovery to answer item 30 ordered to be answered in the Reasons for order and all proper follow-up questions arising from the answers provided so far by BRP and from the questions ordered to be answered herein.
  
- Costs on this motion are in the cause.
  
- Boss Control's motion is otherwise dismissed.

As discussed at the July 4, 2007 hearing, counsel for the parties shall jointly submit to the Court within fifteen (15) days a draft order which shall contain a tight fresh schedule to implement the steps ordered herein under the two motions, the further amendments to be brought by BRP to its Statement of claim, and the essential remaining steps contained in the order of this Court dated January 19, 2007.

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"Richard Morneau"  
Prothonotary



**FEDERAL COURT**  
**SOLICITORS OF RECORD**

**DOCKET:** T-787-02

**STYLE OF CAUSE:** BOMBARDIER PRODUITS RÉCRÉATIFS INC. Plaintiff  
and  
BOSS CONTROL INC. Defendant

**PLACE OF HEARING:** Montréal, Quebec

**DATE OF HEARING:** July 4, 2007

**REASONS FOR ORDER:** MORNEAU P.

**DATED:** July 6, 2007

**APPEARANCES:**

Mr. Steven Mason FOR THE PLAINTIFF

Mr. Joseph Etigson FOR THE DEFENDANT

**SOLICITORS OF RECORD:**

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