Federal Court  Cour fédérale

Date: 20100407

Docket: T-811-08

Citation: 2010 FC 368

Ottawa, Ontario, April 7, 2010

PRESENT: The Honourable Mr. Justice Barnes

BETWEEN:

NOVOPHARM LIMITED

Plaintiff

and

ELI LILLY AND COMPANY

Defendant

REASONS FOR ORDER AND ORDER

[1] Eli Lilly and Company (Eli Lilly) brings two appeals from interlocutory decisions made by the Case Management Prothonotary, Kevin Aalto (Prothonotary). The first appeal concerns a decision allowing Novopharm Limited (Novopharm) a late amendment to its Statement of Claim. The second appeal concerns a decision made without reasons refusing to order the production of a prior art search conducted by one of Novopharm's expert witnesses.

[2] Whether or not my authority is *de novo*, I can identify no error in the Prothonotary's approach to Novopharm's motion to amend and, indeed, I would endorse the reasons he gave in allowing the amendment to the Statement of Claim.

[3] I do not agree with Eli Lilly's submission that the amendment raises issues that can be characterized as purely vague and speculative. As the Prothonotary noted in his reasons, the Massachusetts General Hospital Pilot Study (Pilot Study) that underpins Novopharm's fresh allegation of anticipation has been known to the parties for some time. Apparently that Pilot Study is the basis of Eli Lilly's assertion of utility.

[4] As a result of fairly recent document disclosure by the Massachusetts General Hospital, Novopharm believes that it can establish anticipation on the strength of disclosures made in connection with the Pilot Study that pre-date the priority date of the '735 Patent. The Prothonotary noted the potential significance of these new documents and he found that they were sufficient to support the amendment. I agree with his assessment of that evidence.

[5] Eli Lilly also contends that this amendment puts it in a position of marked disadvantage and will deprive it of a fair trial because it fails to contain sufficient information to allow it to mount a defence. In particular, it says that Novopharm should have pleaded the names of the Pilot Study patients (even though that information is not known to either Eli Lilly or Novopharm) thereby opening up the possibility for pre-trial interviews and the issuance of trial subpoenas.

[6] Here, too, I agree with the Prothonotary when he characterized this argument as a problem of proof for trial and not an impediment to a pleading amendment. The difficulties noted by Eli Lilly would have existed regardless of when this amendment was made and they are, at this stage, largely hypothetical. Indeed, given the nature of Novopharm's anticipation argument, it is difficult to see how evidence from Pilot Study patients would be useful to Eli Lilly in its defence to this allegation.

[7] For the reasons given by the Prothonotary and as expressed above, this appeal is dismissed with costs payable by Eli Lilly.

[8] With respect to Eli Lilly's second appeal, I am similarly not prepared to interfere with the Prothonotary's exercise of discretion. In my view what Eli Lilly is attempting is a form of discovery of an expert which is not permitted under our Rules: see *Canadian Council of Professional Engineers et al. v. Memorial University of Newfoundland* (1999), 159 F.T.R. 55, 84 A.C.W.S. (3d) 653 (F.C.T.D.). A case for disclosure may be made at trial and some inconvenience may be the result but that is not a sufficient basis for overturning a case-management decision like this one. I would add that I subscribe to the views expressed by Justice Roger Hughes in *AstraZeneca Canada Inc. v. Apotex Inc.*, 2008 FC 1301, [2009] 4 F.C.R. 243 where he discussed the problems of unfettered discovery in this type of litigation and concluded as follows:

> [19] Prothonotaries of this Court are burdened, to a large extent, with motions seeking to compel answers to questions put on discovery. Often hundreds of questions must be considered. Hours and often days are spent on such motions. It appears that in many cases the parties and counsel have lost sight of the real purpose of discovery, which is directed to what a party truly requires for trial.

> They should not slip into the "autopsy" form of discovery nor consider discovery to be an end in itself.
>
> [20] A determination made by a prothonotary following this arduous process ought not to be disturbed unless a clear error as to law or as to the facts has been made, or the matter is vital to an issue for trial. Where there has been an exercise of discretion, such as weighing relevance against onerousness, that discretion should not be disturbed. The process is not endless. The parties should move expeditiously to trial.

[9] In the result, these appeals are dismissed with costs payable by Eli Lilly.

ORDER

THIS COURT ORDERS that Eli Lilly's appeals are dismissed with costs payable to Novopharm.

" R. L. Barnes "
Judge

FEDERAL COURT

SOLICITORS OF RECORD

DOCKET:	T-811-08
STYLE OF CAUSE:	NOVOPHARM LIMITED v. ELI LILLY AND COMPANY
PLACE OF HEARING:	Ottawa, ON
DATE OF HEARING:	March 18, 2010
REASONS FOR ORDER AND ORDER BY:	Mr. Justice Barnes
DATED:	April 7, 2010

APPEARANCES:

Andrew Skodyn 416-360-6336	FOR THE PLAINTIFF
Richard Dearden 613-786-0135	FOR THE DEFENDANT
Patrick Smith 613-786-0135	

SOLICITORS OF RECORD:

Heenan Blaikie LLP Barristers and Solicitors Toronto, ON	FOR THE PLAINTIFF
Gowling Lafleur Henderson LLP Barristers and Solicitors Ottawa, ON	FOR THE DEFENDANT