



# Chapter 11 IP Trials<sup>1</sup>

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## **11.1 INTRODUCTION**

The conduct of an intellectual property (IP) or information technology (IT) trial often involves an appreciation of the peculiarities of intellectual property law, technology and how the court handles both.

As with any trial, thorough preparation is the key to success.

## **11.2 PROVING YOUR CASE AT TRIAL**

By the time a trial takes place, extensive homework will have already been done in evaluating the ability to succeed. Before trial, and in light of facts disclosed on discovery, counsel should review the case with the client to ensure that all proper parties have been included and issues raised.

The pleadings (if properly drafted) will set out the material facts necessary to prove or defend the case. As such, they provide an excellent outline for the facts that must be proven at trial and the arguments that must be led.

In general, the defendant has a different perspective on preparing its case than does the plaintiff. It must answer the plaintiff's case and present its own. Because the defendant presents its case after the plaintiff at trial, it has a responsive role. The defendant will not need to educate the judge to the same extent as did the plaintiff, but it may have to "undo" some of that education to put forward the defendant's theory of the case. The defendant may also have its own case in chief if it is counterclaiming in an IP case for the invalidation of the plaintiff's IP asset or for other remedies on an IT case.

Whatever the subject matter or dispute, victory comes only where the case has been properly prepared and presented.

### **11.2.1 Patent Cases**

In virtually all patent infringement cases, the action is bifurcated. Issues of profits or damages are left until after trial, if required. At the trial on the issues of liability, the plaintiff will have to prove, for the case in chief:

- (i) ownership of the patent;
- (ii) a license in order to prove that your client is "a person claiming under the patent";  
and
- (iii) facts establishing infringement.

Ownership of the patent can be established by the presentation at trial, as a trial exhibit, of a certified copy of the grant of the patent and the patent.<sup>2</sup>

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<sup>2</sup> *Patent Act*, R.S.C., c. P-4, ss. 13 and 14; *Canada Evidence Act*, R.S. c. E-10, s. 24.

The corporate status or identity of the plaintiffs is usually not an issue at trial, but if it is, can be proven by certified copies of documents evidencing the incorporation and continued existence of the plaintiff.

In order for a plaintiff to be a “person claiming under” the patentee and to have standing to sue for patent infringement, it must show that the right it is asserting can be traced back to the patentee.<sup>3</sup> A patent licence is usually in writing and can be made an exhibit once it is identified by a corporate representative of the licensor or licensee. Oral licences can be proven by oral evidence and a course of conduct of the licensor and licensee.<sup>4</sup>

Facts establishing infringement are usually obtained from admissions on discovery of the defendant's representative and by observations made by the plaintiff's expert witness of the allegedly infringing article or method. The expert will also educate the court to put the technology in context, assist the court in understanding how the patent would be understood by a skilled reader and explain what elements are present in the defendant's device or method that are relevant to infringement.

The defendant will have its own interpretation of the patent and claims that suggests or is consistent with its defences and theory of the case.

For a defence of non-infringement, the defendant must show that there are variations between the defendant's product and the product of the patent that are material or “essential.”

The onus is on the defendant to prove invalidity and dispel the presumption of validity provided for in section 43 of the *Patent Act*. When attacking the validity of a patent, a defendant can plead any matter under the *Patent Act* or at law that would render the patent invalid or unenforceable. Such attacks are usually based on lack of novelty, obviousness, prior public use or publication, vagueness, ambiguity, claims broader than the invention disclosed in the specification, claims broader than the invention made or insufficiency of the disclosure, lack of utility, and, in the case of a machine, failure to describe the principle of the machine and the best mode of applying it. If the defendant intends to assert more than one ground of invalidity, then it should plead them but focus on the best ones and ensure it has the elements to prove each of these. Other possible grounds of attack include abuse of patent rights under the *Competition Act*,<sup>3.1</sup> expiry of a limitation period, licence, delay, laches or acquiescence. Each ground requires a different form of evidence in its support.

In preparing a defence and counterclaim, some defendants will take a shot gun or “all but the kitchen sink” approach, alleging the patent is invalid on every possible ground and asserting different interpretations of the patent that may be inconsistent with each other and with the grounds of invalidity asserted. They may also cite a long list of patents and publications to support allegations of anticipation and obviousness. If so pleaded, that list should be severely trimmed for trial, otherwise the court may validly ask: how can a patent be obvious if so many references must be pieced together to lead a person skilled in the art to the invention claimed?

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<sup>3</sup> *Apotex Inc. v. Wellcome Foundation Ltd.* (1998), 79 C.P.R. (3d) 193 at. 300 – 301 (F.C.T.D.).

<sup>4</sup> *Kirin-Amgen Inc. v. Hoffman-La Roche Ltd.* (1999), 87 C.P.R. (3d) 1 at 28 (F.C.T.D. per Reed J.).

<sup>3.1</sup> R.S.C. 1985, c. C-34, as amended, s. 32.

Unless there are extenuating circumstances, defendants should assert a validity defence, if for no other reason than to limit the scope of the claims urged by the plaintiff. Without a validity defence, the plaintiff will urge a broad interpretation of the patent claims so as to include the defendant's product within their scope. In some cases, referred to as a "Gillette defence", the defendant can argue:

- (i) if the patent is interpreted broadly (as desired by the plaintiff), then the claims also include prior art and are invalid as being too broad; or
- (ii) if the claims are interpreted narrowly (usually to avoid prior art) then the patent is not infringed.

Either way, the defendant wins.

### 11.2.2 Trade-mark cases

In cases where infringement of a registered trade-mark is alleged, the principal issues to be determined are whether: (1) the defendant "used" a trade-mark as defined in section 4 of the *Trade-marks Act*;<sup>3.2</sup> (2) the trade-mark so used in association with wares or services similar to the plaintiff's was a "confusing" trade-mark as defined in sections 2 and 6 of the *Trade-marks Act*; and, therefore (3) the defendant infringed the rights of the owner of the trade-mark as governed by sections 19, 20 and/or 22 of the *Trade-marks Act*.

Where the plaintiff has trade-mark rights at common law and has alleged passing off, he or she must establish the three elements of passing off<sup>5</sup>:

- (i) the existence of goodwill or reputation on the part of the plaintiff;
- (ii) deception to the public due to misrepresentation; and
- (iii) actual or potential damage to the plaintiff.

Statutory passing off involves a similar test.<sup>6</sup> Evidence at trade-mark trials therefore involve establishment of the IP rights either by tendering a certified copy of the trade-mark registration or, in cases involving common law rights, tendering evidence of extensive use of the trade-mark so as to establish enforceable goodwill.

### 11.2.3 Copyright Cases

In copyright infringement cases, the following issues will need to be addressed in proving the plaintiff's case:

- (i) Does copyright subsist in the plaintiff's work?

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<sup>3.2</sup> R.S.C., c. T-10.

<sup>5</sup> *Ciba-Geigy Canada Ltd. v. Apotex Inc.* (1992), 44 C.P.R. (3d) 289 (S.C.C.).

<sup>6</sup> R.S.C., 1985, c. T-10, as amended, s. 7.

- (ii) Has the defendant infringed the copyright or moral rights of the plaintiff? In particular:
- has the defendant, without the authorization of the plaintiff copyright owner, done anything that by virtue of the *Copyright Act* only the copyright owner can do?;
  - has there been a substantial copying or reproduction of the plaintiff's work?;
  - has the defendant failed to name the author/owner or provide sufficient attribution to him or her?; and
  - has the defendant manipulated or altered the work to the prejudice of the reputation of the author?
- (iii) Does the plaintiff have direct evidence of copying? If not, can the plaintiff show that (1) the defendant had access to the plaintiff's copyrighted work, and (2) there is a substantial similarity between the defendant's allegedly infringing work and the plaintiff's copyrighted work?
- (iv) Are statutory damages or criminal penalties provided for in the *Copyright Act* to be pursued?

Copyright ownership can be established by tendering as exhibit at trial, a certified copy of the copyright registration(s) for the work(s) at issue or by leading evidence showing who was the author of the work, that person's citizenship or residency and whether they were under any contract of employment affecting the ownership of the work.

In copyright infringement cases, a defendant can respond by attacking: (1) the plaintiff's asserted copyright in the work; (2) the originality in the work; (3) the fixation of the work; and/or (4) the residency or citizenship of the work's creator. Other defences to copyright infringement include allegations that: (a) the work is an industrial design, which does not benefit from the protection of the *Copyright Act*; (b) the limitation period provided by the *Copyright Act* has expired; (c) the plaintiff is not the owner of the work; (d) the work or circumstances fall within one of the exceptions to infringement defined in the *Copyright Act*, sections 29.4 to 30; and/or (e) the fair dealing exception to infringement applies.

### **11.3 WITNESSES**

Early in the proceedings, counsel should prepare a list of facts that need to be put into evidence to establish the client's case. The pleadings provide the outline for the material facts needed to prove the case. They should be used to ensure that all witnesses collectively will tell the complete story of the case. Counsel must then determine how these facts and their related documents are going to be proven.

Assuming the facts will be proven through a witness, a summary can be prepared for each witness, setting out all the facts and documents they can introduce into evidence.

If possible, counsel should prepare and obtain witness statements from anyone interviewed who has evidence or information relating to the case and who may be useful as a witness for trial.

Witness statements can be formal statements, or a simple letter to the individual requesting confirmation of the information they gave counsel.

A plaintiff asserting an intellectual property right at trial has the obligation of proving its case in chief by putting in its entire case at once. It should not split its case by putting evidence in reply that it should have put in chief because the defendant will not have a formal opportunity to reply to it.<sup>7</sup> Where a party submitted multiple experts' affidavits (in chief and in reply) the court ordered the plaintiff to make out its case entirely in chief and allowed a defendant an opportunity to reply but to provide a written summary of the reply evidence in advance.<sup>8</sup>

### 11.3.1 Fact Witnesses

It is as important to prepare fact witnesses as it is to prepare expert witnesses. The experience of testifying can be just as unnerving for them as for an expert witness. Building comfort with the process builds confidence and predictability.

Counsel should instruct the witness on how to be a good witness (for example, by answering truthfully and directly, listening to the question, asking for clarification of a question if it is not understood and answering only the question asked, not volunteering answers, not guessing at any answers, etc.).

Counsel should create a “script” for each fact witness — a document containing the questions he or she will pose to the witness and the answers the witness is expected to give (the “script” is not a document of what the witness is supposed to say – rather it is of what the witness is expected to say based on what the witness knows). By posing the question in a proper manner, the proper answer will be elicited: both in content and in length. If an answer is too long for the witness to remember all the points, break the question into smaller parts to elicit smaller answers. There is nothing more embarrassing than having a witness ask counsel, “What is it that you want me to say?” A “script” prevents such occurrences.

Elicit only the minimum information necessary to prove the case. Excess information is unnecessary and wastes the court’s time and attention. Counsel should have each witness review their witness statements or affidavits, any documents the witness may be questioned on, and any other prior statements he or she has given in preparation for trial or at earlier hearings or trials relating to the same subject matter. If the witness was examined for discovery, he or she should also review their discovery transcripts in order to avoid the possibility of prior inconsistent statements at trial.

Fact witnesses should also be familiar with the issues in the case. In cross-examination, they may be questioned on an area outside that covered by their evidence in chief.

Counsel should also prepare the witness for cross-examination. Conducting a mock cross-examination of the witness allows the witness to practice answering questions and develop answers that more clearly answer the question posed. It is suggested that the practice cross-examination be done by someone other than the lawyer who will be leading the witness through

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<sup>7</sup> Federal Courts Rules SOR/2004-283, r. 279 and r. 281 [Federal Courts Rules].

<sup>8</sup> *Halford v. Seed Hawk Inc.* (2001) 16 C.P.R. (4th) 199 at 202, para. 5 (F.C.T.D. per Pelletier J.), aff'd 2006 FCA 275.

evidence in chief. In this way, the practice cross-examination will seem more realistic and will not harm the trust that has been built between the witness and the lawyer who has been the witness' primary contact and someone whom the witness trusts.

### **11.3.2 Expert Witnesses**

Expert witnesses can help the court understand technical evidence — be it in the area of science, engineering, accounting or marketing.

The use of expert evidence from persons qualified in the relevant discipline is key in intellectual property and information technology litigation since it educates and assists the court in understanding the relevant field or discipline. In patent or trade-secret cases, experts are often used to educate the court as to the state of the art or public knowledge at the date of the patent, how the invention works, any similarities and differences between the plaintiff's invention and the defendant's product, and other details of the art in issue. In IT cases, experts can explain the functionality (or lack thereof) of the computer or telecommunication system. In trade-mark cases, experts can advise the court about actual consumer awareness as determined by surveys.

Some potential expert witnesses are nervous about being retained as an expert witness. They fear that being an expert will hurt their reputation as they may be seen as "hired guns" who will say anything for a fee. The expert witness is not supposed to be an advocate for the party who retained him or her. It is their objective, honest opinion that is desired, the provision of which will not in any way effect their reputation. On the contrary, the provision of non-objective evidence will incur the court's wrath and may hurt the reputation of the witness.<sup>9</sup>

#### **11.3.2.1 Retain Early**

Because experts often require specific information upon which they can base their opinions, an expert should be retained early in the litigation process so that the evidence they need can be gathered in the discovery process.

In patent cases, experts can help counsel understand the technology, collect and understand prior art to impeach the patent, and assess the defences and the case as a whole. The defendant will need to review issues relating to the purposive construction of the claims, the essential versus non-essential features of the invention as claimed, the validity (or invalidity) of the plaintiff's patent claims, and the alleged infringement of the patent.

Experts can also assist by recommending other experts who may be necessary or useful for additional expertise.

#### **11.3.2.2 Limitations on the Number of Expert Witnesses**

A party may need a number of expert witnesses, who serve different purposes and are put forward to establish different things in the case.

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<sup>9</sup> *Ductmate Industries, Inc. v. Exanno Products Ltd.* (1984), 2 C.P.R. (3d) 289 (F.C.T.D.) at p. 302; *Kirin-Amgen, supra*, note 3.

The *Canada Evidence Act*<sup>10</sup> limits to five the number of expert witnesses each party can call unless leave of the court has been granted to allow more.<sup>11</sup> Similar rules exist in the *Ontario Evidence Act*<sup>12</sup>, which limit the number of experts to three, and in the *Federal Courts Rules*<sup>13</sup>, which sets a limit of five experts (for the case as a whole<sup>14</sup>), unless leave of the court is obtained. Factors to be considered whether to grant leave include the nature of the litigation, its public significance and any need to clarify the law, the number, complexity or technical nature of the issues in dispute, and the likely expense involved in calling the expert witnesses in relation to the amount in dispute in the proceeding.<sup>15</sup>

The Rule is to safeguard against the undue expansion of the number of expert witnesses. The burden imposed on the party seeking to call more than five expert witnesses is considerable, as the factors set forth under Rule 52.4 impose a high threshold. Leave under Rule 52.4 is not granted lightly.<sup>16</sup> The mere allegation that a case is complex or technical will not suffice.<sup>17</sup>

The *Federal Courts Rules* permits parties to jointly name an expert witness.<sup>18</sup>

### 11.3.2.3 Selecting the Prospective Witness

Generally, counsel should look for experts that have the relevant expertise, a good reputation, credibility, good teaching or communication skills, and a lack of bias. The best experts give evidence that is clear and persuasive.

<sup>10</sup> R.S.C. 1985, c. C-5. As amended, s. 7:

Where, in any trial or other proceeding, criminal or civil, it is intended by the prosecution or the defence, or by any party, to examine as witnesses professional or other experts entitled according to the law or practice to give opinion evidence, not more than five of such witnesses may be called on either side without the leave of the court or judge or person presiding.

<sup>11</sup> *Eli Lilly & Co. v. Novopharm Ltd.* (1997), 73 C.P.R. (3d) 371 (F.C.T.D.), aff'd (2000) 10 C.P.R. (4<sup>th</sup>) 10. Leave to appeal refused (2001) S.C.C.A. No. 100.

<sup>12</sup> R.S.O. 1990, c. E-23, s. 12.

<sup>13</sup> R. 52.4(1).

<sup>14</sup> *Eli Lilly & Co. v. Apotex Inc.*, 2007 FC 1041 (F.C. per Hughes J.) at para. 27; *Altana Pharma Inc. et al v Novopharm Ltd.*, 2007 FC 1095, [2007] FCJ No. 1421, (F.C. per Phelan J.) at para 55. Where several cases were heard concurrently in *Eli Lilly & Co. v. Novopharm Ltd.* (1997), 73 C.P.R. (3d) 371 (F.C.T.D. per Reed J.) at paras. 119 & 120, aff'd (2000) 10 C.P.R. (4<sup>th</sup>) 10 (leave to appeal refused (2001) S.C.C.A. No. 100) the court permitted 5 expert witnesses per defence counsel but referred to cases interpreting s. 7 as limiting the expert evidence to five witnesses per subject matter or factual issue in a case, rather than 5 witnesses in total.

<sup>15</sup> R. 52.4(2).

<sup>16</sup> *Apotex Inc. v. Sanofi-Aventis* 2010 FC 1282 (F.C. per Boivin J.) at para. 20.

<sup>17</sup> *Apotex Inc. v. Sanofi-Aventis* 2010 FC 1282 (F.C. per Boivin J.) at para. 24.

<sup>18</sup> R. 52.1(2).

**a) Expertise**

The first criterion for selecting an expert witness is that he or she has expertise in the relevant area.

A strong professional reputation in the scientific community is usually due to a high level of expertise, academic honesty and lack of bias — all elements that also lend credibility to an expert witness.

It is preferable to have an expert witness be employed by someone other than the party retaining him or her. A person may have greater loyalty to his or her employer than to the court. Nevertheless, an objective, honest employee can be a good expert witness. They must first overcome the court's bias and prove themselves.

The same can be said for a negative reputation with the court. Check the name of the expert witness on online search engines to see whether a court has commented unfavourably on the expertise of the witness you proposed to call (or the witness that the other side has chosen). Derogatory comments by another court as to the credibility or objectivity of your witness are valuable weapons in cross-examination.

In patent cases, the claims are interpreted as of the date of publication of the claims.<sup>19</sup> In IT cases, it is sometimes necessary to provide the court with a history or perspective of the industry. It is preferable if the witness was working in the field or was considered to be an expert in the art at the relevant time.

University professors are often unbiased, but in some fields, may lack real-life experience. In informal discussions, judges have said that they prefer to hear from someone with “dirt under their fingernails” — persons who have been actively engaged in the field at issue -- in preference to academic theoreticians.

In patent cases where validity of the patent has been attacked and the test applied by the court for obviousness of the patent is one from the perspective of the ordinary person skilled in the art, the defendant should be careful when selecting an expert. If the expert is a Nobel laureate, he or she maybe considered to be too skilled or knowledgeable to be an ordinary, unimaginative person skilled in the art without much imagination. The invention may be obvious to the expert but may not have been obvious to an ordinary worker in the art. A plaintiff, however, can call as an expert, someone who was imaginative and was working in the area of the invention but never came up with the idea. If the invention was not obvious to a superlative, imaginative worker, how could it possibly have been obvious to an ordinary skilled worker?<sup>20</sup>

**b) Good teacher**

The second criterion for an expert is that he or she should be a good teacher. The judge or jury will be the expert's students. The students will likely be ignorant (in the sense of not being

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<sup>19</sup> *Whirlpool Corp. v. Cameo Inc.*, [2000] 2 S.C.R. 1067 at 1101-1102; *Free World Trust v. Electro Sante Inc.*, [2000] 2 S.C.R. 1024 at 1055.

<sup>20</sup> See evidence of Dr. Beal in *Control Data Can., Ltd. v. Senstar Corp.* (1988), 24 C.P.R. (3d) 117 (F.C.T.D. per Cullen J.); and Dr. Uldall in *Mahurkar v. Vas-Cath of Canada Ltd.* (1988), 18 C.P.R. (3d) 417 at 436 (F.C.T.D. per Strayer J.).

educated in the relevant field) but will be attentive to a good teacher. The expert must be able to teach the necessary information to the judge or jury without being patronizing. The expert (often with the help of counsel) must be able to make something that is otherwise very complicated, very easy to understand.

**c) Experience as a witness: asset or not?**

Court experience by an expert witness can be a double-edged sword. On the favourable side, an expert who has testified often will be less nervous in a courtroom, may respond better under cross-examination and may understand better the legal implications of his or her evidence. On the other hand, a witness who has testified often for the same party in related litigation around the world, may be seen as someone who looks more like a biased employee whose income depends upon saying the right thing for his or her client.

A witness' experience also depends upon his or her area of expertise. In the scientific or engineering disciplines, it is rare for the same subject matter (and hence the need for the same expertise) to arise. A witness who appears regularly in a variety of cases can therefore be viewed with suspicion. Is this person a "professional witness"? Has the court previously commented unfavourably on the quality of his or her research?<sup>21</sup> The same is not the case for a forensic accountant. Although the opinions require the same expertise, the facts and clients in each case are different. Experience in such circumstances can enhance rather than diminish an expert's credibility.

**11.3.2.4 What Issues will the Expert Evidence Address?**

The issues of claim construction in a patent action is essentially "What do the claims mean to a skilled worker?" The question of claim construction has been described as a "question of law", which is for the court to answer, under Canadian law, absent extrinsic evidence. But how is the court supposed to construe a patent if the claims are written in language comprehensible only to a skilled worker in the field?

Expert evidence is admissible when it is relevant, necessary to assist the trier of fact, not prohibited by an exclusionary rule and when it is given by a properly qualified expert.<sup>22</sup> There was once a general rule that excluded expert evidence in respect of the ultimate issue. Although the Supreme Court held in one case that the general rule is no longer of general application<sup>23</sup>, it stated in another that it is not the function of the expert to construe the claims but rather to put the trial judge in the position of being able to do so in a knowledgeable way.<sup>24</sup>

Perhaps the *correct* approach (but not that followed by current jurisprudence) is to recognize that claim construction is a question for the court to answer after the court has determined the

<sup>21</sup> *Sanofi-Aventis Canada Inc. v. Ratiopharm Inc. et al*, 2010 FC 230 (F.C. per Phelan J.) at para. 17

<sup>22</sup> *R. v. Mohan* [1994] 2 S.C.R. 9 at p. 20.

<sup>23</sup> *R. v. Mohan* [1994] 2 S.C.R. 9 at p. 24.

<sup>24</sup> *Whirlpool v. Camco*, [2000] S.C.R. 1067 at paras. 43 and 49(a), followed in *Pfizer Canada Inc. et al v. The Minister of Health and Mayne Pharma (Canada) Inc.* (2005) 46 C.P.R. (4<sup>th</sup>) 244 (F.C. per Hughes J.) at para. 34.

question of fact: what did the words or phrases in the claim mean to a skilled reader as of the relevant date? The expert in a patent case can provide that evidence by testifying as to what it meant to him or her as of the relevant date and what it would have meant to most others in the field.

**a) Experts in patent cases have been permitted to testify as to the following:**

- the state of the prior art;<sup>25</sup>
- what the prior art references (including prior patents) meant or revealed to them;<sup>26</sup>
- the state of knowledge in the craft, art or science to which the specification is directed;<sup>27</sup>
- the explanation of technical terms, words and phrases;<sup>28</sup>
- What did the specifications of the patents in suit disclose to the expert?<sup>29</sup> (In other words, what would the words in the claims or specification have meant to the expert at the date when the claims are to have been construed?) In *Halford v. Seed Hawk Inc.*, Pelletier J. interpreted this to be “a different matter than evidence as to the proper construction of the patents in suit”.<sup>30</sup>
- What a person skilled in the art would have understood from reading the patent at the relevant time.<sup>31</sup>

The judge is entitled to the assistance of experts in understanding the terms used in the patent as well as the underlying science. But that is where it ends. The judge must construe the patent and until he does, there is no basis upon which an expert can offer an

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<sup>25</sup> *Xerox of Canada Ltd. v. I.B.M. Canada Ltd.* (1977) 33 C.P.R. (2d) 24 at 36 (F.C.T.D. per Collier J.).

<sup>26</sup> *Ibid.*

<sup>27</sup> *Ibid.*, at 32.

<sup>28</sup> *Ibid.*

<sup>29</sup> *Ibid.*, at 36.

<sup>30</sup> *Supra*, note 6.

<sup>31</sup> *Amfac Foods Inc. v. Irving Pulp and Paper Ltd.* (1984) 80 C.P.R. (2d) 59 at 82-83 (F.C.T.D. per Strayer J.), *aff'd* (1986) 12 C.P.R. (3d) 193; but see *Baxter Travenol Laboratories of Canada Ltd. v. Cutter (Canada) Ltd.* (1983) 68 C.P.R. (2d) 179 at 193 (F.C.A. per Thurlow C.J.) where it was said that an expert cannot provide evidence as to the meaning of a word in the patent.

opinion as to infringement since the expert cannot substitute his view of the proper construction of the patent for the judge's.<sup>32</sup>

- The main innovations of the invention at issue since it falls into the same category as an opinion on anticipation or obviousness.<sup>33</sup> (This view is probably wrong: how does the expert know what is the invention at issue unless he or she has construed the patent?)
- Whether an ordinary skilled workman in the relevant art, at a particular date, would, in trying to solve a problem, have found precisely what he needed in a particular prior publication, use, etc. (anticipation).<sup>34</sup>
- Whether in the light of the common knowledge and the “prior art” an ordinary, skilled and un inventive workperson would, in trying to re-solve a particular problem, have easily and readily arrived at the same solution found by the “inventor” of the patent in suit (obviousness).<sup>35</sup>
- The mere juxtaposition in a table of the elements of the claim at issue and certain features of the allegedly infringing device.

Paragraph 49 contains two columns, the claims of the patent in a column on the left side of the page and a listing of features of the Seed Hawk device in the right hand side of the page. The disposition of the page results in the juxtaposition of the claims and certain features of the Seed Hawk device which may have some relation-ship to the element described in the claim. In and of itself, this does not contain an opinion as to the construction of the patent though it may represent an arrangement of data upon which the court, after construing the patent, could come to a conclusion about infringement. To the extent that it suggests to the court that certain mechanical arrangements might be relevant to the question of infringement, it may be useful to the court. The bare fact of juxtaposition without comment is not objectionable.<sup>36</sup>

A more common technique is to create a table that contains in the left column, words or phrases from the claim and in the right column an explanation of what these terms would have meant to the expert, and to a skilled reader of the patent as of the relevant date. A second table is then created, which correlates certain claim terms (or their explanations) with elements of the allegedly infringing device.

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<sup>32</sup> *Halford v. Seed Hawk* (2001) 16 C.P.R. (4th) 189 at 195, para. 24 (F.C.T.D. per Pelletier J.).

<sup>33</sup> *Ibid.*, at 197, para. 31.

<sup>34</sup> *Xerox of Canada*, *supra*, note 13, at 36.

<sup>35</sup> *Ibid.*

<sup>36</sup> *Halford*, *supra*, note 20, at 196, para. 25.

- A list enumerating the essential features of the claims to decide the issue of infringement.<sup>37</sup>
- An assessment of mechanical equivalency that the allegedly infringing device operates in the same manner as the invention at issue.<sup>38</sup> (This is probably wrong: how does the expert know what is the invention at issue without being able to construe the patent?)

The answers to the following questions appear to be inadmissible:

- construction of a document;<sup>39</sup>
- the meaning of the patent as such;<sup>40</sup>
- the testimony of the inventor as to what his invention was, for the purpose of claim construction;<sup>41</sup>
- the intention of the inventor (as expressed in the patent);<sup>42</sup> or
- conclusions on the infringement of the patent at issue.<sup>43</sup>

#### **b) Trade-mark Actions: Confusion**

Courts may be cautious about accepting expert witness evidence in trade-mark infringement cases involving likelihood of confusion to the casual consumer. The casual consumer is understood to be neither particularly skilled nor knowledgeable. The Supreme Court of Canada has criticized the use of expert evidence in such cases as “it will be positively unhelpful if the expert engages in an analysis that distracts from the hypothetical question of likelihood of confusion at the centre of the analysis”.<sup>44</sup> The Supreme Court has stated that “the test to be applied is with the average person who goes into the market and not one skilled in semantics”.<sup>45</sup>

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<sup>37</sup> *Ibid.*, at 196, para. 27.

<sup>38</sup> *Ibid.*, at 197, para. 30.

<sup>39</sup> *Ibid.*, at 193, para. 17.

<sup>40</sup> *Amfac Foods*, *supra*, note 19.

<sup>41</sup> *Lovell Manufacturing Co. v. Beatty Brothers Ltd.* (1962), 41 C.P.R. 18 at 38, 23 Fox Pat. C. 112 (Ex. Ct. per Thorson P.); adopted by *Johnson Controls Inc. v. Varta Batteries Ltd.* (1984), 80 C.P.R. (2d) 1 at 27-8, 3 C.I.P.R. 1, 53 N.R. 6 (F.C.A. per Urie J.A.); *P.L.G. Research Ltd. v. Jannock Steel Fabricating Co.* (1991), 35 C.P.R. (3d) 346, 46 F.T.R. 27, 26 A.C.W.S. (3d) 1 157 (T.D.), affirmed 41 C.P.R. (3d) 492, 142 N.R. 203, 55 F.T.R. 240 (note) (C.A.); *Halford*, *supra*, note 20, at 195, para. 22-23.

<sup>42</sup> *Amfac Foods*, *supra*, note 19.

<sup>43</sup> *Halford*, *supra*, note 20, at 195, para. 25.

<sup>44</sup> *Masterpiece Inc. v. Alavida Lifestyles Inc.*, 2011 SCC 27 at para. 80.

<sup>45</sup> *Ultravite Laboratories Ltd. v. Whitehall Laboratories Ltd.*, [1965] SCR 734 at 737-38.

As such, expert “discussion of morphology, semantics, rules of grammar and conventions of expression” would not assist the court in determining the likelihood of confusion for the casual consumer.<sup>46</sup> Courts find it adequate for the judge to imagine “putting [themselves] in the position of the average person going into the market”<sup>47</sup> and “use their own common sense” to make a finding.

### **11.3.2.5 Patent Actions: Conducting Infringement Tests for Use at Trial**

In some cases, scientific analysis of or an experiment using the defendant’s product may be necessary to obtain evidence supporting allegations of infringement, invalidity or utility. Such experiments are often expensive and take a lot of time to design and conduct. Therefore, counsel should, early in the proceedings, consider whether experiments will be required, what experiments need to be conducted, which expert should be retained to conduct them as well as how and when such experiments will be conducted.

In the U.K. where a party is going to conduct experiments to be relied on at trial, it must give the other side notice in advance of what experiments it will be doing, and invite them to attend the experiments and/or consent to their admission in evidence.

No such rule exists in either the *Federal Courts Rules* or the *Ontario Rules of Civil Procedure*. Therefore, technically a party can conduct tests or experiments for trial without giving notice to the other side and without a representative of the other side present to observe them. However, the jurisprudence provides that if an experiment is conducted for the purpose of trial (and especially if the opposing party does not have the means to verify the experiment), then notice of the experiment must be given to the opposing party, together with an opportunity to view the experiment. Where such practice is not followed, the tests are generally inadmissible.<sup>48</sup> An exception occurred when neither party attended the other’s tests due to a ruling made at a pre-trial conference. Both tests were admitted into evidence to avoid prejudice.<sup>49</sup>

Perversely, if an experiment was performed for another purpose, it can still be used as evidence at trial so long as notice of it is provided during the discovery process.

To avoid the risk of conducting an experiment in the presence of the opposing party, which produces unsatisfactory results, counsel can choose to first have the experiment conducted in private by someone who will not be called to testify at trial. If the results are satisfactory, counsel can then have an expert who will be called at trial repeat the experiment in the presence of the opposing party. If the results of the first test are not satisfactory, counsel can properly decide not to disclose the fact of the experiment to the opposing party and not rely on it at trial. If the same

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<sup>46</sup> *Masterpiece Inc. v. Alavida Lifestyles Inc.*, 2011 SCC 27 at para. 81.

<sup>47</sup> *Ultravite Laboratories Ltd. v. Whitehall Laboratories Ltd.*, [1965] SCR 734 at 738.

<sup>48</sup> *Omark Industries (1960) Ltd. v. Gouger Saw Chain Co.* (1964), 45 C.P.R. 169 at 228 (Ex. Ct. per Noel J.); *Halford*, *supra*, note 20, at 195, para. 25.

<sup>49</sup> *Halford*, *supra*, note 20, at 203, para. 9.

witness conducts the “dry-run” experiment, privilege is waived for all of that witness’ knowledge.<sup>50</sup>

### **11.3.2.6 Trade-mark Actions: Surveys**

Survey evidence is often used in passing off and trade-mark infringement cases by the plaintiff to establish the elements of the reputation of the plaintiff and the confusion or likelihood of confusion of the defendant’s product, service or business with those of the plaintiff in the mind of the public. Defendants will often conduct surveys in response to prove these elements cannot be established.

In addition to surveys, marketing experts can be retained to give evidence at trial as to the state of the marketplace and likely effect of the defendant’s improper activities in the marketplace and/or on the plaintiff. Surveys “have the potential to provide empirical evidence which demonstrates consumer reactions in the marketplace — exactly the question that the trial judge is addressing in a confusion case”.<sup>51</sup>

It is rare today for passing off or infringement actions to succeed where no survey evidence has been introduced.

In deciding whether to conduct a survey, the client should consider the costs of a survey, the time required to conduct one, and the usefulness. Costs of surveys can range anywhere from \$3,000 to \$250,000 depending on the nature of the case, the form of survey to be conducted and the accuracy and representativeness of the survey desired.

Survey evidence should be introduced at trial through affidavit and oral testimony of a survey expert. Therefore parties must comply with rules with respect to expert witnesses and evidence when preparing and introducing survey evidence.

Historically, surveys are generally criticized by the questions they ask or to whom the questions are asked. In conducting a survey, it is important to ensure that the relevant “universe” (i.e., the population from which the target group will be selected) has been identified. For example, if a company is attempting to prove a substantial likelihood of confusion between types of lipstick, the survey “universe” should be restricted to females. In situations where the trade-mark has not yet been established in a marketplace, there are no casual or average consumers that are familiar enough with the trade-mark. “For a survey to be valid, it seems elementary that there must be some consumers who could have an imperfect recollection of the first mark.”<sup>52</sup> It would be “highly unlikely that such a survey [of people without an imperfect recollection of the first mark] would meet the requirements of reliability and validity”.<sup>53</sup>

In addition, the survey sample (i.e., the respondents interviewed) should be representative of the relevant universe and sufficiently large to ensure statistical significance and reliability of the results. As for the questions asked, they should be objective, unambiguous, free from bias (i.e.,

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<sup>50</sup> *Kirin-Amgen, supra*, note 3, at 22-23, paras. 70-71.

<sup>51</sup> *Masterpiece Inc. v. Alavida Lifestyles Inc.*, 2011 SCC 27 at para. 93.

<sup>52</sup> *Ibid.* at para. 96.

<sup>53</sup> *Ibid.* at para. 97.

not conceived to elicit conditioned responses) and relevant to the legal issues at hand. Open-ended questions, such as “what do you think when you see X” and follow-up questions with more than one prompt in which the participant is asked if he/she thinks of anything else are recommended. For a trade-mark that is not yet known in a marketplace, using preliminary questions to prime the respondents into a simulated recollection of the trade-mark would likely produce results that are both unreliable and invalid.<sup>54</sup> Therefore, the parties are advised to conduct a pre-test to ensure the right questions for the survey are asked and in the right way.

Reliable and valid surveys can be helpful tools for adjudicators presiding over trade-mark disputes.<sup>55</sup> However, the survey questions must be properly phrased to show confusion in the marketplace. If the survey is not responsive to the point at issue, it is irrelevant and should be excluded on that ground alone.<sup>56</sup>

### **11.3.2.7 Preparation of the Expert Witness for Giving Evidence**

Counsel should have each witness review articles they have written and, in cases where they have previously testified, their witness statements, affidavits and transcripts of testimony to look for any statements that may contradict their proposed opinion in the current action.

Counsel should go through the entire case with the expert so that he or she understands the content of his or her opinion and can become aware as to your overall theory of the case. The expert may be able to help you refine your arguments to make them more consistent technically. Reviewing the entire case prepares the expert for a “surprise” cross-examination on an area unrelated to his or her evidence in chief. Witnesses in cross-examination are not limited to the areas canvassed by their evidence in chief.

An expert witness should be instructed not to step outside their area of expertise when giving opinions at trial.

### **11.3.2.8 Code of Conduct**

The Federal Court of Canada has specified the role of an expert witness in a Code of Conduct that explicitly sets out the expert’s duty to the Court.<sup>57</sup> An expert has a duty to provide impartial, independent and objective opinions in their area of expertise to assist the Court. The expert’s duty to the Court overrides any duty to the party that retained them. An expert does not advocate for the party who retained the expert.

The Code of Conduct specifies the following be included in the expert’s report: issues addressed in the report, expert’s qualifications on the issues addressed, expert’s CV, facts and assumptions, summary of the expert’s opinions, areas of agreement or disagreement with the other party’s expert opinion, reasons supporting the opinions, literature relied on for the opinion,

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<sup>54</sup> *Ibid.* at para. 96.

<sup>55</sup> *Mattel Inc. v. 3894207 Canada Inc.* [2006] SCC 22.

<sup>56</sup> *Ibid.*, para. 44.

<sup>57</sup> Federal Courts Rule 52.2(1).

summary of the methodology used to arrive at the opinions, caveats, and particulars about existing relationships between the expert and parties to the proceeding.

When the Court orders experts to confer with each other, the Code of Conduct also requires the expert to assess the issues independently, impartially and objectively. The experts for the parties are also required to clarify the points on which they agree and disagree.

If an expert does not comply with the Code of Conduct, the Court may choose to exclude some of or all the expert's affidavit or statement.<sup>58</sup>

### **11.3.2.9      *Crafting the Affidavit or Statement***

Before a party can call an expert witness at trial to give evidence in chief, the expert's evidence must be set out in full in an affidavit or signed statement in writing and served on the other parties at least 60 days before the start of the trial.<sup>59</sup> If this is not done, the expert cannot testify except with leave of the court. The rationale for this rule is to avoid an "ambush" by any one party of the other.

Expert evidence in reply to another expert's affidavit or signed statement must be set out in an affidavit or signed statement and served on the other parties at least 30 days before trial.<sup>60</sup>

The purpose of an expert report is to disclose what evidence the witness will give at trial and the factual basis on which he or she proposes to give that evidence. Expert testimony on matters not mentioned in the expert's affidavit or signed statement will be ruled inadmissible at trial.

There can be no cross-examination before trial on an affidavit or signed statement of an expert witness served under Rule 279(b), except with leave of the court.<sup>61</sup>

Experts should not present argument in their affidavits or oral testimony in the guise of expert evidence. While experts can give evidence on the ultimate issue, the mixing of argument and opinion is objectionable. Experts can present evidence and an opinion with respect to an issue, but should not express a direct conclusion about its significance — this is for the court to do.<sup>62</sup>

Counsel should prepare their expert witnesses well. Upon being retained, counsel should help the expert understand the issues in the litigation and how their expertise and evidence can help the court resolve those issues.

In preparing the expert's report:

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<sup>58</sup> Federal Courts Rule 52.2(2).

<sup>59</sup> Federal Courts Rule 279(b).

<sup>60</sup> Federal Courts Rule 281.

<sup>61</sup> Federal Courts Rule 280(3).

<sup>62</sup> *Eli Lilly*, *supra*, note 11.

## (1) Start with the basics.

Set out the basics or a primer on the relevant art or field of technology. This will serve as background or the basic building blocks upon which the judge can build the evidence in the case.

## (2) Keep it simple/be clear and concise.

The objective is to help the judge understand the technology and the witness' area of expertise, not to give long, complicated, technical explanations to impress the judge. Use analogies to explain something complicated and put it into circumstances that the court will readily understand.

## (3) Avoid or minimize the use of jargon.

Use pictures and demonstrative evidence. Experts should only use accepted scientific procedures or accepted industry practices in forming their opinions/preparing their report to avoid any argument over the credibility of the evidence.

## (4) Clearly set out the facts and assumptions on which his/her opinion is based (i.e., why he or she believes his or her opinion is the correct one).

The expert's report or affidavit is typically divided into four sections:

- (1) a summary of the expert's background, education and experience that qualifies him or her as an expert to testify about the subject matter in issue;
- (2) a primer or introduction to the relevant subject matter or field of technology so the judge will understand the technical terms and evidence it will hear from the expert;
- (3) the assumptions, facts and evidence upon which the expert is basing his/her opinion;
- (4) the expert's opinion (i.e., interpretation of the facts and evidence and the conclusions he or she has drawn from them).

**a) Good science**

The expert should use accepted scientific principles or accepted accounting procedures that have become generally accepted. Both the United States Supreme Court (see *Daubert v. Merrell Dow Pharmaceuticals Inc.*, 113 S. Ct. 2786 (1993)) and the Supreme Court of Canada (see *R. v. Mohan* [1994] 2 S.C.R. 9 and *R. v. J. J.* [2000] 2 S.C.R. 600) have held that scientific expert evidence is subjected to special scrutiny to determine whether it meets a basic threshold tests of: (a) reliability (that is, whether the underlying methodology from which the evidence is derived is based on "scientific knowledge"); and (b) relevance (that is, whether it is essential to assist the trier of fact in understanding other evidence or in determining a fact in issue.). Factors which each of these courts applied in evaluating the soundness or reliability of scientific expert evidence included: (i) whether the theory or technique can be and has been tested; (ii) whether the theory or technique has been subjected to peer review and publication; (iii) the

known or potential rate of error or the existence of standards; and (iv) whether the theory or technique used has been generally accepted.

There is nothing unusual in the practice of having counsel for a party prepare the first drafts of the affidavits after consultation with the experts, as long as the evidence is that of the affiant and not the lawyer.<sup>63</sup>

#### **b) Translating the Evidence into Understandable Form**

Expert affidavits or statements should be clear, compelling and aimed at the right level for a non-expert judge. Counsel should understand every point and the technology discussed in the affidavit, and challenge the expert on it while the affidavit is being prepared to ensure it is clear and accurate.

#### **11.3.2.10 Familiarizing the Witnesses with the Courtroom**

It is important that counsel help make witnesses feel comfortable with the litigation and trial process, especially if it is the witness' first appearance in court. The entire trial process, and the rules and etiquette of the court, should be explained to the witness.

As part of the preparation of their witnesses, counsel should describe what the witnesses can expect to see in the courtroom and how matters will proceed during trial. For example, who will be present in the courtroom, where they will be, and how and when counsel and the judge will address them, why you cannot ask him or her leading questions in chief, but opposing counsel can on cross-examination, are all things that should be explained to witnesses to help them feel more at ease when they are giving evidence at trial.

#### **11.3.2.11 Assistance in Cross-Examination**

An expert can also assist counsel in preparing for and conducting the cross-examination of the other side's expert witness. He or she should review the report or affidavit of the other side's expert and provide comments on it (perhaps even prepare a reply affidavit to it), advise if there is anything in the affidavit that would hurt his or her own testimony, and help counsel develop questions for cross-examination. He or she can also review the books, articles or papers written by the other side's expert to see if they have in the past said anything inconsistent with the evidence they are giving in their report or affidavit for trial.

#### **11.3.2.12 Procedure for Expert Witnesses**

##### **a) Code of Conduct**

The Federal Court of Canada requires that expert affidavits or statements be accompanied by a signed certificate where the expert acknowledges that they will be bound by the Code of Conduct for Expert Witnesses as set out in the *Federal Courts Rules*.<sup>64</sup> Counsel must provide the Code of Conduct to the expert and must also file the signed certificate with the Court.

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<sup>63</sup> *Pharmaceutica Inc. v. Apotex Inc.* (2001), 13 C.P.R. (4<sup>th</sup>) 410 (F.C.A.) at para. 53, aff'g (2000), 5 C.P.R. (4<sup>th</sup>) 53 (F.C.T.D.).

<sup>64</sup> Federal Courts Rules 52.2(1).

**b) Objection to Expert Witness**

A party can seek to have an expert witness disqualified from testifying by serving and filing a document with the Federal Court that contains the particulars for their objection to the witness.<sup>65</sup>

**c) Expert Witness Conference**

Expert witnesses may be ordered by the Federal Court to confer with each other before the hearing in order to narrow the issues and to identify the specific points on which they have differing opinions.<sup>66</sup> Parties and their counsel have a right to be present during the conference, but may agree to be absent.<sup>67</sup> The Federal Court may in addition order that a judge or prothonotary be present during the conference.<sup>68</sup>

The expert witnesses can prepare a joint statement following the conference that would be admissible at trial.<sup>69</sup> Aside from this joint statement, any discussions during the conference or documents prepared for the purpose of the conference are confidential and will not be available to the judge or prothonotary unless the parties consent to it.<sup>70</sup>

**d) Pre-Trial Conference**

If a party raises an objection to a proposed expert witness prior to a pre-trial conference, then the objection should be included in the pre-trial conference memorandum and should also be discussed during the conference itself.<sup>71</sup>

**e) Hot-Tubbing**

Hot-tubbing involves a panel of expert witnesses giving concurrent testimony at a hearing. It may be ordered at any time during a trial.<sup>72</sup> During this procedure, the experts can present their opinions, comment on the opinions of other experts on the panel, and even pose questions to each other in a format more similar to a discussion than adversarial cross-examination by

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<sup>65</sup> Federal Courts Rules 52.5(2)(a).

<sup>66</sup> Federal Courts Rules 52.6(1).

<sup>67</sup> Federal Courts Rules 52.6(2).

<sup>68</sup> Federal Courts Rules 52.6(3).

<sup>69</sup> Federal Courts Rules 52.6(4).

<sup>70</sup> Federal Courts Rules 52.6(4).

<sup>71</sup> Federal Courts Rules 262(2), 263(c)(i).

<sup>72</sup> Federal Courts Rules 282.1.

counsel.<sup>73</sup> After the completion of the expert panel testimony, the Federal Court may allow the panel members to be re-examined and cross-examined by counsel.<sup>74</sup>

Judges have expressed favourable interest in having expert evidence presented this way because of its potential to streamline litigation.

## **11.4 NARROWING THE ISSUES BEFORE TRIAL**

### **11.4.1 Pre-trial Motions**

#### **11.4.1.1 Bifurcation Order**

Rule 107 of the *Federal Courts Rules* permits the court, at any time, to order a separate trial of an issue or issues, including separate discoveries. The court may make such an order either on its own initiative<sup>75</sup> or on motion by one of the parties. In such an order, the court may give directions regarding the procedures to be followed, including those applicable to documentary and oral discovery.

On a motion under Rule 107 for a bifurcation order, the court must be satisfied, on a balance of probabilities, that: (1) there is a clear distinction between the legal and evidentiary issues sought to be severed from the other matters for disposition; and (2) in light of the evidence and all of the circumstances of the case (including the nature of the claim, the conduct of the litigation, the issues and the remedies sought), severance is more likely than not to result in the just, most expeditious, and least expensive determination of the proceeding on its merits.

Generally, a party seeking to sever the trial of issues must show that there is some practical or economic reason for doing so. Factors the court will consider when deciding whether to grant a bifurcation order include the separability of issues, savings in time and costs, and whether any party will suffer prejudice as a result of bifurcation.

The importance of reducing the cost of trial and bringing matters on to trial as quickly as possible appear to be the paramount considerations in the application of Rule 107 and determination of whether the case is appropriate for the grant of an order for the severance of the trial.<sup>76</sup>

#### **11.4.1.2 Summary Judgment**

An action can be determined in whole or in part through summary judgment.<sup>77</sup>

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<sup>73</sup> *Federal Courts Rule* 282.2(1).

<sup>74</sup> *Federal Courts Rule* 282.2(2).

<sup>75</sup> *Federal Courts Rule* 47.

<sup>76</sup> *Visx Inc. v. Nidek Co.* (1998), 81 C.P.R. (3d) 572 (F.C.T.D. per Hugessen J.).

<sup>77</sup> *Federal Courts Rule* 213-219; Ontario, Rules of Civil Procedure, R.R.O. 1990 Reg. 194, r. 20 [Ontario Rule] Rule 20.

Either party may bring a motion for summary judgment relating to all or part of a statement of claim or defence.<sup>78</sup> A plaintiff can apply for summary judgment at any time after a defence has been filed or, with leave of the court, before a defence has been filed. A defendant can apply for summary judgment at any time after it has served and filed a defence. Neither party may move for summary judgment after a trial date has been fixed.<sup>79</sup>

The threshold question on motions for summary judgment is whether there is “a genuine issue” for trial. The product at issue at a summary judgment must, of course, have been pleaded.<sup>80</sup> If the court determines there is a genuine issue for trial, it may choose to determine the issue through a summary trial.<sup>81</sup>

In responding to a motion for summary judgment, a party must put its best foot forward at the time of the motion by filing such relevant evidence as is reasonably available to it demonstrating that a genuine issue for trial exists. A response cannot rest merely on allegations or denials of the pleadings, but must set out specific facts showing that there is a genuine issue for trial.<sup>82</sup>

Where the court is satisfied that there is no genuine issue for trial, it shall grant summary judgment.<sup>83</sup> Where it is satisfied that the only issue for trial is the quantum of relief or a question of law, it may order a trial of that issue or grant summary judgment.<sup>84</sup>

Where the court is satisfied that there is a genuine issue of fact or law for trial with respect to a claim or defence, it may nevertheless determine the issue by summary trial.<sup>85</sup> In this respect, the Federal Courts Rules are broader than the Ontario *Rules of Civil Procedure*.

Where the motion for summary judgment is dismissed in whole or in part, the court may order the action, or the issues in the action not disposed of by summary judgment, to proceed to trial in the usual way, or order that the action be conducted as a specially managed proceeding.<sup>86</sup>

Where summary judgment is refused or granted only in part, the court may make an order specifying which material facts are not in dispute, defining the issues to be tried, limiting the

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<sup>78</sup> *Federal Courts Rule 213.*

<sup>79</sup> *Ibid.*

<sup>80</sup> *DuPont Canada Inc. v. Glopak Inc.* (1998) 81 C.P.R. (3d) 44 (F.C.T.D. per Muldoon J.).

<sup>81</sup> *Federal Courts Rule 215(3).*

<sup>82</sup> *Federal Courts Rule 214.*

<sup>83</sup> *Federal Courts Rule 215(1).*

<sup>84</sup> *Federal Courts Rule 215(2).*

<sup>85</sup> *Federal Courts Rule 215(3).*

<sup>86</sup> *Federal Courts Rule 215(3).*

nature and scope of examinations for discovery (if not yet completed) and prescribing the use of discovery transcripts at trial.<sup>87</sup>

**a) Patent cases**

Historically, the Federal Court has been reluctant or hesitant to grant summary judgment in patent infringement actions. This is largely because patent infringement actions depend to a large extent on the assessment by the court of the expert evidence submitted by the parties and the credibility of the expert witnesses.

However, where the only real issue is the interpretation of the patent, the court may make a determination as to the interpretation of the patent claims and grant summary judgment. That is, the court tends to be more willing to grant summary judgment in a patent matter where the invention is relatively simple and understandable to persons not skilled in the art (and, therefore, where expert testimony and an assessment of an expert's credibility are not required).

**b) Trade-mark and copyright cases**

The court seems to be more willing to grant summary judgment in trade-mark and copyright cases than in patent cases, but only in the clearest of cases (e.g., where the plaintiff's trade-mark has been copied by the defendant, or where there is clear evidence of copying or no copying).

**11.4.1.3 Summary Trial**

A plaintiff can apply for summary trial at any time after a defence has been filed or, with leave of the court, before a defence has been filed. A defendant can apply for summary trial at any time after it has served and filed a defence. Neither party may move for summary trial after a trial date has been fixed.<sup>88</sup> The court will dismiss a motion for summary trial if the issues are not suitable for this type of proceeding or the requested summary trial would not assist in efficiently resolving the action.<sup>89</sup>

Supporting materials in the motion record for summary trial can include affidavits, admissions, cross-examination on affidavits, documents produced on discovery, and discovery transcripts.<sup>90</sup>

In a summary trial, the court may order a deponent or expert witness be cross-examined before the court.<sup>91</sup> The court is permitted to draw adverse inferences when parties fail to cross-examine on affidavits or to file rebuttal evidence.<sup>92</sup>

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<sup>87</sup> *Federal Courts Rule 218.*

<sup>88</sup> *Federal Courts Rule 213.*

<sup>89</sup> *Federal Courts Rule 216(5).*

<sup>90</sup> *Federal Courts Rule 216(1).*

<sup>91</sup> *Federal Courts Rule 216(3).*

<sup>92</sup> *Federal Courts Rule 216(4).*

In hearing a motion for summary judgment, the court may make findings of fact and law if the materials and evidence filed lend themselves to this and it is just to do so. A conflict in the evidence will not preclude adjudication by summary trial even if the amounts at issue are large and the issues complex.<sup>93</sup> Judges can decide issues at summary trial that require resolving conflicting evidence and, notably, assessing witness credibility.<sup>94</sup>

When the court grants a judgment by summary trial, the court can order that the quantum of damages be determined by trial, impose terms for enforcing the judgment, and award costs.<sup>95</sup> If the motion for summary trial is dismissed, the court may order the unresolved issues to be determined at trial or through a specially managed proceeding.<sup>96</sup>

#### **11.4.1.4 Settlement Discussions**

The parties in Federal Court actions are required to hold settlement discussions.<sup>97</sup> The Rule is intended to encourage early, alternative resolution of the litigation. Within 60 days after the close of pleadings, the solicitors for the parties must discuss the possibility of settling any or all of the issues in the action and of bringing a motion to refer any unsettled issue to a dispute resolution conference. There are no sanctions for a bilateral failure to hold such discussions; however such discussions (even if very brief) must take place before a solicitor can requisition a pre-trial conference.<sup>98</sup>

#### **11.4.1.5 Pre-Trial Conference**

A pre-trial conference is now mandatory in all actions proceeding to trial in the Federal Court of Canada, and in all actions that are case managed in the Ontario Superior Court of Justice. In Ontario Court actions that were commenced before July 3, 2001 and not randomly assigned to case management, a pre-trial conference may be scheduled at the request of a party or by a judge on its own initiative.

Pre-trial conferences provide the parties with an opportunity to discuss settlement, refine the issues of the case and address any other matters so as to make the trial more efficient. They are intended to address the possibility of settlement of any or all of the issues in the action, and of simplifying the issues to be resolved. They are also intended to assist the court in determining the length and complexity of the trial.

#### **a) Requisition**

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<sup>93</sup> *Federal Courts Rule 216(6).*

<sup>94</sup> *Federal Courts Rule 216(6).*

<sup>95</sup> *Federal Courts Rule 216(7).*

<sup>96</sup> *Federal Courts Rule 216(8).*

<sup>97</sup> Federal Courts Rule 257.

<sup>98</sup> Federal Courts Rule 258(2)(b).

In Federal Court actions, any party may requisition a pre-trial conference, though usually it will be the plaintiff. However, the following preconditions must be met before a party can requisition a pre-trial conference:

1. the pleadings are closed;<sup>99</sup>
2. all examinations for discovery that the party intends to conduct have been completed;<sup>100</sup>
3. the requisitioning party is not in default;<sup>101</sup>
4. the requisitioning party is ready for trial;<sup>102</sup>
5. the requisitioning party has conducted its examination for discovery;<sup>103</sup> and
6. the parties have discussed the possibility of settlement.<sup>104</sup>

The requisitioning party must serve and file:

1. a requisition for a pre-trial conference;<sup>105</sup>
2. its pre-trial conference memorandum;<sup>106</sup> and
3. a copy of the documents that may be of assistance in settling the action.<sup>107</sup>

The court may order that a pre-trial conference be held in accordance with the Rules, with such modifications as are necessary.<sup>108</sup>

Where a pre-trial conference has not been requisitioned within 360 days of the issuance of the statement of claim, the court shall fix a date and time for a status review under Federal Courts Rule 380.

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<sup>99</sup> Federal Courts Rule 258(1).

<sup>100</sup> Federal Courts Rule 258(2).

<sup>101</sup> Federal Courts Rule 258(1).

<sup>102</sup> *Ibid.*

<sup>103</sup> Federal Courts Rule 258(2)(a).

<sup>104</sup> *Ibid.*

<sup>105</sup> Federal Courts Rule 258(1) and Form 258.

<sup>106</sup> Federal Courts Rule 258(1).

<sup>107</sup> Federal Courts Rule 258(4).

<sup>108</sup> Federal Courts Rule 315.

In Ontario Court actions that are case managed, the Registrar will, on at least 45 days' notice to the parties, schedule a pre-trial conference.<sup>109</sup> All examinations, production of documents and motions arising out of the examinations for discovery and production of documents must be completed before the pre-trial conference date.<sup>110</sup>

At least 10 days before the pre-trial conference, the plaintiff must deliver a settlement conference brief containing all material the plaintiff considers necessary for the conference.<sup>111</sup> Every other party must deliver its settlement conference brief at least five days before the conference.<sup>112</sup> Under Rule 77.14(6), all parties' briefs must contain:

1. a concise summary of the facts, including the agreed upon facts and admissions;
2. where necessary, a concise summary of the issues and the law to be relied upon by each party;
3. a list of witnesses and a summary of each witnesses' evidence;
4. the relevant portions only of transcripts, experts' reports and other evidence that may be adduced at trial;
5. the party's pleadings, including any demand or order for particulars of a pleading and the particulars delivered in response.

**b) Pre-trial conference memoranda**

The requisitioning party must serve and file a pre-trial conference memorandum with its requisition for a pre-trial conference (see above). All parties other than the requisitioning party must serve and file a pre-trial conference memorandum at least seven days before the date fixed for the conference.<sup>113</sup>

The pre-trial conference memoranda should be prepared with a view to matters to be discussed at the pre-trial conference as listed in Rule 263. Although not required, a party may wish to consider preparing and serving notices to admit facts or documents before the pre-trial conference in order to demonstrate readiness for trial.

The parties and their solicitors are expected to come to the pre-trial conference ready to discuss the possibility of settlement and alternative dispute resolution. The memorandum is meant to facilitate the discussion of these subjects.

**c) At the pre-trial conference**

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<sup>109</sup> Ontario Rule 77.14(1).

<sup>110</sup> Ontario Rule 77.14(2).

<sup>111</sup> Ontario Rule 77.14(4).

<sup>112</sup> Ontario Rule 77.14(5).

<sup>113</sup> Federal Courts Rule 262.

The Rules<sup>114</sup> provide that the parties must be prepared to address the following issues at the pre-trial conference:

1. the possibility of settlement of any or all of the issues in the action and of referring any unsettled issues to a dispute resolution conference;
2. simplification of the issues;
3. definition of any issues requiring the evidence of expert witnesses;
4. the possibility of obtaining admissions that may facilitate the trial;
5. the issue of liability;
6. the amount of damages, where damages are claimed;
7. the estimated duration of the trial;
8. the advisability of having the court appoint an expert to give testimony at trial;
9. the advisability of directing a reference;
10. suitable dates for trial;
11. the necessity for interpreters or simultaneous interpretation at the trial;
12. the content of the trial record; and
13. any other matter that may promote the just, most expeditious and least expensive disposition of the action.

Pre-trial conferences maybe conducted by a judge or officer (e.g., prothonotary in the Federal Court) of the court.

In Ontario Court proceedings, the judge who conducts a pre-trial conference cannot preside at the trial of the action.<sup>115</sup> This does not prevent a judge who has been assigned to hear the trial from holding a conference before or during the trial to consider any matter that may assist in the just, most expeditious and least expensive disposition of the proceeding without disqualifying himself or herself from presiding at the trial.<sup>116</sup> In Federal Court actions, the judge who conducts a pre-trial conference cannot preside at the trial of the action unless all parties consent.<sup>117</sup>

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<sup>114</sup> Federal Courts Rule 263; Ontario Rule 50.01.

<sup>115</sup> Ontario Rule 50.04; 77.14(10).

<sup>116</sup> Ontario Rule 50.07.

<sup>117</sup> Federal Courts Rule 266.

In the Federal Court, a trial date is obtained at a pre-trial conference.<sup>118</sup> The judge or prothonotary conducting the pre-trial conference shall, at that conference, fix the date and place for trial.<sup>119</sup> In Ontario Court actions that are case managed, the pre-trial conference judge assigns a trial date or refers the parties to the judge responsible for the assignment of a trial date.<sup>120</sup>

Unless the court directs otherwise, it is mandatory for the solicitors of record for the parties and the parties, or their authorized representatives, to attend at the pre-trial conference in the Federal Court.<sup>121</sup> In the Ontario Court such attendance is not mandatory, but if the action is case managed, a case management judge or master may direct the parties, or a representative of a party responsible for making decisions in the proceeding and instructing the solicitor, to attend all or part of the pre-trial conference personally with their counsel.<sup>122</sup>

The statements made at a pre-trial conference are not to be communicated to the judge presiding at trial except as disclosed in an order made at the conclusion of the pre-trial conference or as consented to by the parties.<sup>123</sup> Ontario Rule 50.03 also provides an exception for statements disclosed in a pre-trial memorandum.

#### **11.4.1.6 Trial Management Conference**

Trial management conferences were introduced with the *Federal Courts Rules* in 1998. Federal Court Rule 270 expressly states the scope of a trial management conference. Trial management conferences recognize the practice of the assigned trial judge convening counsel to discuss the efficient conduct of the trial. This concept is consistent with the general principle of securing the just, most efficient and least expensive determination of every proceeding.<sup>124</sup> Federal Court Rule 270 was introduced at the same time that the broader case management and dispute resolution services were implemented in the *Federal Court Rules*.<sup>125</sup> This approach is aligned with the inherent power of the Court to determine its own process. Trial management conferences are not the same as a pre-trial conference under Rules 258-267. The judge who presides at the pre-trial conference is disqualified from serving as trial judge unless all parties consent.<sup>126</sup>

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<sup>118</sup> Federal Courts Rule 264.

<sup>119</sup> *ibid.*

<sup>120</sup> Ontario Rule 77.14(7).

<sup>121</sup> Federal Courts Rule 260.

<sup>122</sup> Ontario Rule 77.14(3).

<sup>123</sup> Ontario Rule 50.03; Federal Courts Rule 267.

<sup>124</sup> Federal Court Rule 3.

<sup>125</sup> Federal Court Rules, Part 9.

<sup>126</sup> Federal Courts Rule 266.

A trial management conference may be conducted by the assigned trial judge after the pre-trial conference and the fixing of a trial date.

In Ontario Court actions, a trial management conference may be held on or following the setting of a trial date at the request of one of the parties or on the initiative of the trial judge, case management judge or case management master.<sup>127</sup> The party requesting the conference must file a trial management conference form<sup>128</sup> at least 14 days before trial or 4 days before the conference, whichever is earlier.<sup>129</sup>

The Rules with respect to pre-trial conferences do not prevent a judge who has been assigned to hear the trial from holding a conference before or during the trial to consider any matter that may assist in the just, most expeditious and least expensive disposition of the proceeding without disqualifying himself or herself from presiding at the trial.<sup>130</sup>

Ontario Rule 77.15(3) provides that, at a trial management conference, the judge or case management master may:

- a) canvass with the parties the names of the witnesses intended to be called and the substance of their testimony;
- b) explore whether admissions can be made that will facilitate proof of non-contentious matters;
- c) explore alternative methods of presentation of evidence, such as the filing of affidavits or reports;
- d) explore with counsel expeditious means for the presentation of evidence; and
- e) give directions that will facilitate the orderly and expeditious conduct of the trial.

## **11.4.2 Notices to Admit**

### **11.4.2.1 Facts**

At any time after the close of pleadings, a party may request in writing that another party admit facts, or the authenticity of any document. A party receiving such a request is deemed to admit the facts or authenticity of the documents unless he or she responds to the request within 20 days of service by denying the admission and providing the grounds for the denial.

The Federal Courts Rules introduced in 1998 effected two changes with respect to Notices to Admit: (1) a party is now deemed to admit the facts or authenticity of the documents if no response is served within the prescribed time; and (2) the response to the request to admit must now set out the grounds for denying the admission.

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<sup>127</sup> Ontario Rule 77.15(1).

<sup>128</sup> Ontario Rule 77.15 and Form 77D.

<sup>129</sup> *ibid.*

<sup>130</sup> Ontario Rule 50.07.

Typically, the parties will exchange requests to admit facts and documents after discovery when counsel are preparing for trial.

In most cases, counsel will avoid admitting all facts in a notice to admit except for the most obvious ones. Although the court has a discretion to award costs against any party that refuses to admit any facts in response to a notice to admit that should have been admitted,<sup>131</sup> this discretion is rarely exercised. Notices to admit therefore rarely result in the resolution or narrowing of facts and issues to be proved at trial.

An admission may be withdrawn only with the express permission of the court.<sup>132</sup>

The reply to a notice to admit facts, as well as the notice itself, should be filed as proof of a fact admitted or as proof of refusal to admit. A document that has been admitted can be submitted at trial and its authenticity need not be proven by a witness.

Objections to the relevance or admissibility of admitted facts or documents should be made when they are tendered at trial.

A party may move for judgment on an admission of facts or documents made in response to a request to admit including a deemed admission.<sup>133</sup>

#### **11.4.2.2 Documents**

Admissions are made to the authenticity of the documents, and not to the truth of the contents of the document.

A party should try to have the other side admit that that party's documents (especially prior art documents in patent cases) are what they purport to be and were published on the dates indicated. Admissions on the authenticity of documents are likely to be given.

A document that is not disclosed at discovery may not be used at trial.<sup>134</sup>

#### **11.4.3 Agreed Statements of Facts and/or Issues**

Rather than exchange and file requests to admit facts and responses, parties can prepare an agreed statement of facts and/or issues for submission at trial. Such facts need not be proven or established by witnesses at trial.

Agreed statements of fact and/or issues are helpful to the court and can save the parties extra time and costs at trial.

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<sup>131</sup> Federal Courts Rule 400(3)(j) See also Ontario Rule 51.04.

<sup>132</sup> *Canderel Ltd. v. Canada* [1994] 1 F.C. 3 (C.A.).

<sup>133</sup> Ontario Court Rule 51.06.

<sup>134</sup> Federal Courts Rule 232.

In patent cases, parties should try to obtain admissions from the other side with respect to the prior art and publications. They can also try to obtain reciprocal admissions with opposing counsel.

## **11.5 PAPER**

### **11.5.1 Preparing Trial Briefs**

#### **11.5.1.1 Trial Record**

The trial record in Federal Court of Canada actions is not prepared until after the trial date has been set, and the trial record need not be certified.

The content of the record is prescribed by Rule 269, and is a subject to be discussed at the pre-trial conference.<sup>135</sup>

Ontario Rules 48 and 77.14(8) set out the procedures for setting of an action down for trial, including service and filing of a trial record.

At any time after the close of pleadings, any party who is ready for trial and who is not in default under the Rules or an order of the court, may set an action down for trial by serving and filing a trial record.<sup>136</sup>

In actions that are case managed, a trial record must be served and filed in accordance with Rule 48.02 at least seven days before the trial date.

The trial record must contain a copy of the items listed in Ontario Rule 48.03. These items include copies of all pleadings, demands and orders for particulars of a pleading and the particulars delivered in response, any jury notice, any orders respecting trial, and a certificate in the form set out in Rule 48.03(h) signed by the solicitor setting the action down for trial.

Any party who has set an action down for trial by serving and filing a trial record, and any party who has consented to the action being placed on a trial list, may not initiate or continue any motion or form of discovery without leave of the court. However, such a party must still comply with its undertakings on discovery or any obligations set out in Ontario Rule 48.04(2)(b), nor preclude it from delivering a request to admit facts or documents. Undefended actions are placed on a trial list on the filing of a trial record.<sup>137</sup> Defended actions are placed on the trial list by the registrar 60 days after the trial record is filed, or earlier on written consent of the parties.<sup>138</sup>

#### **11.5.1.2 Counsel's Trial Book**

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<sup>135</sup> Federal Courts Rule 263(m).

<sup>136</sup> Ontario Rules 48.01 and 48.02.

<sup>137</sup> Ontario Rule 48.05.

<sup>138</sup> Ontario Rule 48.06.

Counsel should start preparing his or her trial brief at the start of the case. This is counsel's guide or road map for the trial and should contain the key documents expected to be used at trial — e.g., the current pleadings, the affidavits of documents, summaries of discoveries, written answers, important interlocutory orders, the relevant patent, trade-mark registration, licence or other asserted right in issue, witness statements, expert reports, a chronology of the relevant events and any other documents that may need to be referred to frequently and accessed quickly during the course of the litigation.

Closer to trial, other documents can be added to the brief, such as your outlines for examination in chief and cross-examination of witnesses, closing argument notes, notes on arguments anticipated from the other side and memoranda of law.

### **11.5.1.3      *Compendium of Evidence and Primers***

Thousands of documents may have been produced during the course of the litigation. By trial, you may have determined that many of these are less important, and will be relying on only the most relevant ones during the course of the trial.

Courts have found it very useful to receive a compendium from each party of the relevant documents and portions of documents, transcripts, read-ins and other evidence that each will be referring to at trial.

In patent cases, where the technology is complicated, it may be useful to prepare a primer explaining the technology and containing a glossary of terms, relevant background and excerpts from articles or textbooks on the subject or field of technology and explanations of some of the technical concepts and procedures in the evidence to be presented at trial.

### **11.5.1.4      *Discovery Excerpts to be “Read-In”***

If there are admissions made by the other side's representative on discovery, or other oral evidence that supports your case and/or hurts the other side's case, it would be more effective to put them to that witness at trial rather than just read them in as part of your case. However, portions of examinations for discovery can be read-in at trial.

Examinations for discovery may be used at trial in three situations:

1. a party may read in the discovery of an adverse party as its own evidence, whether or not the adverse party has testified yet.<sup>139</sup>

The court may order that party to read into evidence any other part of the discovery that it considers so related that it ought not to be omitted.<sup>140</sup> The purpose of this latter rule is to ensure that evidence read-in at trial is in the proper

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<sup>139</sup> Federal Courts Rule 288.

<sup>140</sup> Federal Courts Rule 289.

context so as to avoid any prejudice that might arise if only a portion were read-in, and to ensure a fair understanding of the evidence;<sup>141</sup>

2. a party can use the discovery of a person as evidence where that person is unavailable for trial.<sup>142</sup>

This use of examination for discovery evidence in place of oral evidence is exceptional and permitted only where the party can convince the court that the witness is absolutely unavailable and all reasonable steps have been taken to try to arrange the witness' attendance at trial. Although the Rule permits this use, we are not aware of any instance where it has been used; and

3. a party can use the discovery of a person as a prior inconsistent statement in order to impeach the person's credibility.<sup>143</sup>

A booklet of all the read-in portions of a discovery transcript and relevant exhibits, should be prepared and submitted to the court and the other side ahead of time (i.e., before the portions are read-in during the trial).

The testimony of a person (non-party) examined with leave of the court under Rule 238 shall not be used as evidence at trial but, if the person is a witness at trial, it may be used in cross-examination in the same manner as any witness statement of a witness.<sup>144</sup>

Information objected to on discovery cannot be used at trial by the objecting party.<sup>145</sup>

#### **11.5.1.5 Preparation of the Trial Memorandum**

Federal Courts Rule 70 governs the form and content of trial memoranda.

The trial memorandum should set out the facts, issues and argument in a truthful, non-misleading way yet with a slant that supports your case. It should be complete (with supporting evidence summarized or cited) and written in such a way that the judge can cut and paste from your memorandum into his or her reasons if he or she decides in your favour.

Much of a party's Memorandum of Argument can be prepared before trial and be supplemented and revised during trial. Where issues are known to be raised at trial, create headings or paragraphs for these in the memo in advance. Evidence from expert's affidavits and factual evidence you intend to lead can also be incorporated into the trial memo before trial, and be supplemented and revised as the trial proceeds.

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<sup>141</sup> *Footo v. Royal Columbian Hospital* (1982), 29 C.P.C. 94 at 98 (B.C.S.C. per McEachern C.J.) followed in *Almecon Industries Limited v. Anchartek Ltd.* 2001 FCT 1404, 17 C.P.R. (4th) 74 (F.C.T.D. per Gibson J.).

<sup>142</sup> Federal Courts Rule 290.

<sup>143</sup> Federal Courts Rule 291.

<sup>144</sup> Federal Courts Rule 239(6).

<sup>145</sup> Federal Courts Rule 248.

Daily transcripts of the trial proceedings can be requested, and the transcripts of each witness' testimony can be summarized and the relevant portions or oral evidence incorporated into the trial memorandum on a daily basis. Documents or information can be incorporated into the trial memorandum and the argument modified each day of trial, as necessary.

Judges will usually want the trial memorandum to be provided to them the day oral argument begins. Therefore, a memorandum should be ready for delivery to the court and the other side and use by a party during oral argument or closing submissions on the last day(s) of trial.

#### **11.5.1.6 Book of Authorities**

An initial volume of the Book of Authorities with the leading case(s) on the legal "tests" you are required to meet to prove your case, can be delivered to the court and the other side before your opening statement.

The balance of volumes of the Book of Authorities containing all of the statutes, regulations and cases cited in a party's trial memorandum and/or to be relied on during oral argument, should be prepared and delivered to the court and the other side with the trial memorandum at the time for oral argument.

The Book of Authorities should not include every case available on a given issue or point; it is more effective to include only the leading one or two cases that best support your point or issue. All volumes should be tabbed and indexed, with the cases arranged in order of the legal issues to be addressed. Depending on what the judge prefers, it may be helpful to highlight the specific passages in each case that you intend to refer to during your argument.

#### **11.5.1.7 Co-ordinating Matters with the Registrar**

Occasionally, a party may have to set up special equipment in the court-room in advance of trial (projectors, monitors, electronic whiteboards, translators, etc.). All this should be arranged in good time before trial to avoid any last minute problems.

In the Federal Court of Canada, examination rooms can sometimes be made available for counsel to use as a "war room" in the courthouse during trial. There is no charge for this service, however access is limited to the court's normal business hours so it is best used for meetings or for witness preparation during trial.

#### **11.5.1.8 Copies**

If you use computer or electronic tools or billboards at trial, make sure you have back-up hard copies you can tender to the court (both for the judge's use later and for appeal purposes).

Ensure you provide the court with enough copies:

- two official unmarked copies for the court file (in Ottawa and the local office)
- one copy for the judge
- one copy for the judge's law clerk
- one copy for the Court Reporter (so he or she can transcribe the proceedings properly)

- one copy for each counsel on the other side
- one copy for each counsel on your team
- one clean, spare copy

A safe rule of thumb is to have 10 copies of everything.

## **11.6 THE CONDUCT OF THE TRIAL**

### **11.6.1 Opening Statement**

Each party is entitled to make an opening statement before presenting its case. The opening statement is an opportunity to outline the theory of your case. It is an opportunity to get the judge to see the case through you, and should therefore not be wasted.

The plaintiff's counsel will use the opportunity to outline the plaintiff's case. The defendant's counsel will use it to raise doubts about the plaintiff's case and to assert its theory of the case. It will be up to the judge and counsel to decide whether the defendant's counsel should give opening immediately after that of the plaintiff or wait until the defendant's case in chief is to begin.

At the start of the case, the judge is willing and eager to learn, but does not know anything about the case and particularly the technology or industry involved. The opening statement is counsel's chance to give the judge the big picture and some sense of the important issues of the case. This is particularly important when technology is involved.

Remember that you and your client have lived with this case for perhaps several years and are intimately aware of the smallest of details. The judge knows very little about the case, so begin by explaining the case on a very high level adding only such detail as is absolutely required. Explain the technology's place in the universe before descending to identify what particular aspect of it is in issue.

The technology should be introduced without the use of technical jargon (it has not yet been explained to the judge so he or she will not understand it). As analogized by Judge James Warren of the San Francisco Superior Court: "explain it as if you were speaking to one of your neighbours over a beer at your kitchen table."

The opening statement should identify:

1. the key issues, factual and legal;
2. the evidence to be relied upon; and
3. the witnesses and what each will say.

A useful device for opening argument is a written outline of the issues in the case, correlated to the pleadings and defences. A general outline could be only one page, listing the key points at issue. A more detailed outline could constitute a small booklet with different pages giving more detail as to the issue and the evidence that will be lead to deal with it. Under each issue, is an outline of the evidence that will be tendered in respect of each issue. The references could include a summary of the discovery to be read-in on each point footnoted to the page of the

discovery; likewise for the expert's or experts' affidavit(s). The summarized discovery explains the story told by the transcript in a concise easily understood format. The outline provides a frame of reference for the opening and the evidence and can be used as the basis for final written sub-missions at the end of trial.

Set out below is an example of a page from a Summary of the Evidence used in the opening of a patent trial<sup>146</sup> dealing with the unadmitted allegation of the identity of one of the plaintiffs.

### Example

#### Issue: I(1)(b) Janssen-Ortho Inc.

Amended Statement of Claim	Amended Statement of Defence and Counterclaim	Issue
2. The plaintiff JANSSEN-ORTHO INC. (hereinafter "JANSSEN-ORTHO") is a corporation existing under the laws of the Province of Ontario, Canada, with a principal place of business located at 19 Green Belt Drive, North York, Ontario, M3C 1L9.	2. The defendant ROCHE has no knowledge as to the allegations made in paragraphs 1 and 2 of the Amended Statement of Claim, and, therefore, denies them.	What is the corporate status and address of JANSSEN-ORTHO?

1. The plaintiff JANSSEN-ORTHO INC. (hereinafter "JANSSEN-ORTHO") is a corporation existing under the laws of the Province of Ontario, with a principal place of business located at 19 Green Belt Drive, North York, Ontario, M3C 1L9.\*

\* Evidence of Mrs. Ann Humphreys; Copy of Corporate Profile Report from the Ministry of Consumer and Commercial Relations.

The opening should also differentiate between major and minor issues so the court can understand what you consider to be the "real" issues in the case.

Demonstrative evidence can be particularly useful in a technology case, for the reasons discussed. Use of demonstrative evidence in the opening statement can provide an engaging preview. The things or charts used in opening may never become exhibits at trial but care should be taken to avoid prejudicial surprise that may result in the court not wanting to see your material.

Legendary patent counsel Donald F. Sim, Q.C. always marked a certified copy of the patent-in-suit as Exhibit 1. The same would be good form for a trade-mark registration, industrial design registration or copyright registration. Because they are certified, they can be made exhibits

<sup>146</sup> *Kirin-Amgen, supra*, note 3.

without further proof<sup>147</sup> and be referred to throughout the trial since they will be easy to locate as the first exhibit.

In a patent or industrial design case, take the court to the patent or design registration itself. Explain with the aid of the diagrams, the technology and the claim elements at issue. In a copyright or trade-mark case, use the registration as a vehicle to introduce the owner of the right and relevant dates.

Opening statements should be kept to one hour or less, otherwise you risk losing the attention of your audience.

Sometimes, the judge will ask the defendant if it wants to make an opening statement immediately after the plaintiff. If counsel takes this opportunity, he or she should be brief and use it to plant questions or doubt about the plaintiff's case early on so the judge will have it in the back of his or her mind while hearing the plaintiff present its case.

### **11.6.2 Late-Produced Evidence**

Relevant documents are supposed to be produced in a timely fashion and be referred to in an updated affidavit of documents;<sup>148</sup> The purpose of this rule is to record their disclosure to the other side.<sup>149</sup> Documents that have not been disclosed in another party's affidavit of documents cannot be entered into evidence unless otherwise ordered by the court.<sup>150</sup>

Where a document has been disclosed but not added to the affidavit of documents, to ignore that disclosure by reason of the absence of an entry in an affidavit of documents would be to prefer form over substance.<sup>151</sup> The remedy for lack of timeliness of disclosure is an adjournment to pursue other remedies; it is not to exclude evidence that is otherwise admissible.<sup>152</sup>

To determine whether to allow leave to present further evidence after evidence at trial is closed, but before argument, the Federal Court has considered the following factors: relevance, necessity, reliability, due diligence and prejudice.<sup>153</sup>

Where evidence comes to light after a trial has been concluded but before the trial judge has rendered a decision, the trial judge has broad discretion (which should be exercised sparingly

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<sup>147</sup> *Copyright Act*, R.S.C., c. C-30, s. 53; *Canada Evidence Act*, R.S. c. E-10, s. 24.

<sup>148</sup> Federal Courts Rule 226.

<sup>149</sup> *Halford v. Seed Hawk* (2001) 16 C.P.R. (4th) 204 at 205, para. 4. (F.C.T.D. per Pelletier J.).

<sup>150</sup> Federal Courts Rule 226.

<sup>151</sup> *Halford*, *supra*, note 102.

<sup>152</sup> *Ibid.*, at 207, para. 12.

<sup>153</sup> *Sanofi-Aventis Canada Inc. v Apotex Inc.*, 2009 FC 294 at para. 8

and cautiously) to re-open the trial to hear the new evidence.<sup>154</sup> The factors to be considered include:

1. Could the evidence, if it had been presented, have had any influence on the result?
2. Could the evidence have been obtained before trial by the exercise of reasonable diligence?<sup>155</sup>
3. Are there exceptional circumstances that would justify setting aside the “due diligence” test or at least reducing its overall importance in the exercise of discretion. The danger that a court would be misled is an aspect of the “exceptional” circumstances consideration.<sup>156</sup> The importance of the integrity of the trial process – the search for the truth through evidence – is an overarching consideration. To some extent that consideration is addressed in the issue of whether a court would be misled.<sup>157</sup>

## **11.6.3 Examination in Chief and Cross-Examination**

### **11.6.3.1 Fact Witnesses**

The examination in chief of a fact witness should follow the question and answer “script” described above.

The cross-examination of a fact witness usually requires documentary evidence that can be used to contradict the fact witness’ testimony.

Fact witnesses should be “defended” by the counsel that called him or her in chief, from badgering or excessive behaviour by opposing counsel, although a properly prepared witness should be allowed considerable leeway to defend him or herself.

### **11.6.3.2 Expert Witnesses**

#### **a) Examination in Chief**

An expert witness must first be qualified by the court as an expert. Counsel should go through the qualifications section of the expert’s affidavit asking the expert to humbly admit that he has the various qualifications, honors and awards referred to in his or her resume Counsel should then ask the judge to rule that the expert is qualified to give expert opinion evidence in this case

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<sup>154</sup> *Varco Canada Limited et al v. Pason Systems Corp.*, 2011 FC 467 (F.C. per Phelan J.) at para. 15.

<sup>155</sup> *Varco Canada Limited et al v. Pason Systems Corp.*, 2011 FC 467 (F.C. per Phelan J.) at paras. 16 & 17 citing *671122 Ontario Ltd. v Sagaz Industries Canada Inc.*, 2001 SCC 59, [2001] 2 SCR 983 5.

<sup>156</sup> *Varco Canada Limited et al v. Pason Systems Corp.*, 2011 FC 467 (F.C. per Phelan J.) at para. 20.

<sup>157</sup> *Varco Canada Limited et al v. Pason Systems Corp.*, 2011 FC 467 (F.C. per Phelan J.) at para. 22.

on the particular issues. The judge will then give opposing counsel the opportunity to admit that the witness is an expert or to cross-examine him or her to challenge expertise on the affidavit as a whole or only on parts of it. The court will then rule as to the witness' expertise.

The expert's evidence can be submitted at trial by having him or her read the affidavit or statement into evidence and explaining what has been read.<sup>158</sup> Other testimony of the witness can be read in only with leave of the court.<sup>159</sup> With leave of the court and the consent of the other parties, the affidavit may be deemed to be or taken as read into evidence.<sup>160</sup> Before an expert can go beyond simply explaining what is in the affidavit, leave of the court must be obtained.<sup>161</sup>

Deeming the expert witness' affidavit into evidence does not give that evidence any more weight than it would have been given had it been presented orally. In either case, the witness' evidence is evaluated by the usual standards.

Counsel must determine from the court the extent to which counsel should review the expert's affidavit or statement in detail. Sometimes the court will say that it has already read the affidavit, in which case counsel should, of course, not read every sentence into the record. Even when the court thinks that it understands the witness' statement, counsel should review the most important points in the affidavit in detail.

#### **b) Cross-examination**

Cross-examination of an expert witness much be approached with preparation and caution.

The credibility of a witness can be damaged if he or she is shown to have been technically incorrect or technically dishonest with the court in rendering an opinion.

Two questions must be answered by counsel: what do I want to get the other side's expert to admit? and; what can I get the other side's expert to admit? In a perfect world, the other side's expert would agree with everything said by your side's expert. But there will be diversions in opinion between both side's experts, usually caused by differences in the underlying assumptions and the scientific or engineering theories applied to those facts and assumptions.

The most reassuring part of cross-examining a technical witness is that he or she is bound by the laws of physics, chemistry or biology. The scientific laws can be used to direct and constrain the position of the expert because it is, in his or her perspective, the highest authority.

Knowing how an expert must answer a question, one can sometimes use what is referred to here as a "logic funnel". Just as a funnel forces all material through it, so does this cross-examination technique. In planning it, counsel must begin with the final conclusion and work backwards through a series of questions that counsel knows the witness will agree to and from which there can be no backtracking. When asked in sequence, the questions must flow only to

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<sup>158</sup> Federal Courts Rule 280(1).

<sup>159</sup> Federal Courts Rule 280(1)(c).

<sup>160</sup> Federal Courts Rule 280(2).

<sup>161</sup> Federal Courts Rule 280(3).

the next question so the expert cannot move away from the conclusion. This can be extremely difficult to prepare. Once drawn to the final question, the expert has the option of agreeing with counsel (in which case counsel wins the admission) or obstreperously trying to avoid what is recognized by all the court as the only valid answer (in which case, counsel wins because the witness has shown that he or she lacks objectivity). The latter point can only be made however so long as the judge understands what is the correct answer.

In some cases, one must start with the scientific basis of the expert's opinion and attack its weaknesses. If some of the witness' opinion is based upon incorrect facts or facts that are not established at trial, then the foundation of his or her opinion is removed. If enough of the foundation is removed, the opinion, like a structure, becomes unstable and unsustainable. If however, the unsustainable material does not result in a change in the witness' opinion, your cross-examination does not weaken the expert's testimony but rather leaves the impression of strengthening it.

Sometimes counsel can show that the expert's opinion in this case contradicts an opinion he or she has given in another case or in an article or publication. Such a cross-examination, if successful, proves the contrary point and hurts the witness' credibility on other points. Your own expert witness can help you find contradictory statements in previous articles written by the other side's expert. Care must be taken so that the other side's expert cannot differentiate the circumstances or context of the comment from the previous article or testimony. If the other side's expert has said the same thing in contradiction in many articles, no amount of differentiating will assist the other side's expert.

#### **11.6.4 Demonstrative Evidence**

Under Federal Courts Rule 287, a party must give all other parties in an action 30 days' notice of the use in chief of demonstrative evidence (which includes plans, photographs, models, video presentations, computer demonstrations and other technological forms of evidence). This rule only applies to such evidence "prepared or obtained for use at trial"; it does not apply to evidence that existed before commencement of the litigation and that would have been subject to the discovery process. This rule does not apply where the demonstrative evidence is used in the course of cross-examination at trial.

Therefore, if your expert witness intends to refer to a plan, map, graph, table, drawing, flow chart, photograph, model, video, audio recording, computer simulation or other demonstrative form of evidence on his/her examination-in-chief, notice thereof and an opportunity to inspect should be given to the appropriate parties at least 30 days before trial. If possible, try to obtain agreement with the other side as to its admissibility in advance.

Demonstrative evidence can be very useful in intellectual property cases, especially patent cases where the subject matter may be very technical and a picture may be worth a thousand words, in engaging the attention of the trial judge and assisting him or her in understanding the case (i.e., in illustrating complex scientific and factual issues).

Demonstrative evidence should not be confused with three-dimensional real evidence. For example, brochures and TV ads in trade-mark cases and samples of the allegedly infringing product in patent cases are real evidence, which have to be introduced as any other kind of evidence through witnesses.

Demonstrative evidence illustrates or explains other documents, oral testimony or real evidence, and is usually something that is specifically prepared for trial by counsel, on counsel's instructions or by a witness to help explain his/her testimony.

Where demonstrative evidence is introduced by means of an expert witness, the rules relating to expert witnesses and the tendering of their evidence must also be followed.

The Ontario Court Rules for the admissibility of demonstrative evidence are similar to the Federal Courts Rules. Both define the form of "documents" that can be included in the affidavit of documents<sup>162</sup> and require expert reports to be filed before trial (90 days before trial in the Ontario Superior Court of Justice). However, unlike the *Federal Courts Rules*, there is no specific provision in the Ontario *Rules of Civil Procedure* relating to demonstrative evidence. Despite this, it would probably be best to still give notice of any intent to introduce demonstrative evidence.

Use of high-tech tools, 3-D models, and photographs in the courtroom may be helpful. Transcript searching/summarizing software, etc. may also be useful for the court. Anything that can help you teach, simplify and persuade the judge (who will likely know little about patents/IP) should be considered.

Where such tools or models are used, ensure they are marked as exhibits, and have photos or hard copies of them also filed as exhibits so that they are available to the court in a more accessible form.

### **11.6.5 Final Argument**

The memorandum of fact and law for trial, as described above, should enable the trial judge to have all the resources he or she will require to write a decision in your favour. It will likely contain more information than will be put into the final reasons for judgment, but having that information available will better enable the court to render the proper decision based on the evidence at trial.

Therefore, deal with the highlights of your written material rather than read the written argument to the court. Take the court to the most important extracts of the evidence or the case law being relied upon, but do not feel obliged to deal with every point in detail.

When presenting oral argument, focus on the major issues and let the written material deal with the minor issues. As was the case in presenting the case, do not split your case; deliver the appropriate argument at the appropriate time.

If you have comments to make about the credibility of any of your witnesses, but you are not certain whether the court holds the same position as do you, you may want to make such comments in an appendix to your memorandum of fact and law and deliver a milder castigation orally referring the court to the appendix for greater detail.

### **11.6.6 Relief Sought**

Finally, ask for the relief you are requesting.

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<sup>162</sup> Ontario Rule 30.01.

Circumstances arising during the course of the litigation may result in equitable remedies no longer being available, in which case be sure to deny their availability in final argument.

If you are a defendant, different circumstances may apply to different product lines or time periods. Be sure to ask the court to differentiate in the Reasons for Judgment.

In the case of costs, it is becoming increasingly common in the Federal Court of Canada to ask that the matter of costs be deferred until after the trial decision has been rendered and the question of liability has been determined. In that way, assuming the successful party receives its costs, it can ask for the appropriate scale (and deal with the effects of any offers to settle) after liability has been determined.