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Intellectual Property Trial

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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.

(a) 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.¹

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.² 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.³

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

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1 *Patent Act*, R.S.C. 1985, c. P-4, ss. 13 and 14; *Canada Evidence Act*, R.S.C. 1985, c. C-5, s. 24.

2 *Apotex Inc. v. Wellcome Foundation Ltd.* (1998), 79 C.P.R. (3d) 193 (F.C.) at 300-301, reversed in part 2000 CarswellNat 2643 (F.C.A.), affirmed 2002 CarswellNat 3436 (S.C.C.).

3 *Kirin-Amgen Inc. v. Hoffmann-La Roche Ltd. / Hoffmann-La Roche Ltée* (1999), 87 C.P.R. (3d) 1 (F.C.) at 28, per Reed J., affirmed 2000 CarswellNat 3187 (F.C.A.).

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(2) 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. Attacks based on a lack of sound prediction or a failure to fulfil a promise are also advanced, particularly in pharmaceutical patent cases. 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*,⁴ expiry of a limitation period, licence, delay, laches or acquiescence.⁵ Each ground requires a different form of evidence in its support.

In preparing a defence and counterclaim, some defendants will take a shotgun 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. However, this approach should be used with caution.¹ A finding in the defendant's favour of only one or two out of a multitude of invalidity allegations may have negative cost consequences.⁶ Defendants 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?

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",² 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 claims are not infringed.

Either way, the defendant wins.

(i) *Patent Medicine Notice of Compliance Trials: The Post-September 21, 2017 Regime*

Effective September 21, 2017, the Federal government enacted new Regulations⁷ amending the procedures under the *Patented Medicines (Notice of Compliance) Regulations* to fundamentally change the process from a paper-based court application to a patent infringement/validity trial, complete with documentary and oral discoveries, and live testimony at trial.

The former *PM(NOC)* regime was oddly eccentric and unpopular with all parties concerned. The Courts had only a paper record upon which to decide often complicated technical evidence, without the aid of live expert witnesses to answer a judge's questions. The burden of proof was on the Innovator (the "first person" or patent owner) to prove that the allegations of non-infringement and invalidity made by the Generic (the "second person") in the Notice of Allegation were not justified. Appeals by Innovators from unsuccessful applications were usually moot, because the Notice of Compliance had already issued before the appeal could be brought and could not be "un-issued". Unsuccessful applications were often followed by patent infringement and invalidity lawsuits, resulting

⁴ R.S.C. 1985, c. C-34, as amended, s. 32.

⁵ *Gary Gurmukh Sales Ltd. v. Quality Goods IMD Inc.*, 2014 FC 437 (F.C.) at paras. 105-106.

¹ *Grenke v. DNOW Canada ULC*, 2018 FC 564 (F.C.) at para. 197.

⁶ *E. Mishan & Sons Inc. v. Supertek Canada Inc.*, 2014 FC 326 (F.C.) at para. 162.

² *Western Oilfield Equipment Rentals Ltd. v. M-I LLC*, 2021 FCA 24 (F.C.A.) at para. 75.

⁷ SOR/93-133 (the "2017 Regulations"), available at <<http://laws-lois.justice.gc.ca/eng/regulations/SOR-93-133/index.html>>.

in the duplication of efforts by the parties and the Court.

By agreeing to the *Canada-European Union Comprehensive Economic and Trade Agreement* (“CETA”), Canada committed to providing full appeal rights under the *Regulations* that linked the approval of generic medicines to the protection of patent rights. That commitment necessitated replacing the *PM(NOC)* regime’s court application with a fast-tracked, patent infringement/validity trial.

The *2017 Regulations* put a greater burden on the parties and the Court to have the patent infringement/validity trial proceed to trial and a decision within 24 months.⁸

No longer at issue will be the question as to whether the Minister of Health should be prohibited from issuing a NOC. The burdens of proof under the new regime are consistent with those of traditional patent litigation. The second person can counterclaim that the patent asserted is invalid and unenforceable.

Wisely, the *Regulations* provide a limited number of procedural rules and otherwise leave most procedural matters to be dealt with by the Court, to evolve procedural solutions as experience with the new regime develops.

Res judicata in the sense of cause of action estoppel does not apply to preclude the commencement of an action under the *2017 Regulations* by reason of a decision made on a section 6 application under the *Former Regulations*, and is not a basis for dismissal of an action under section 6.08⁹ of the *2017 Regulations*.¹⁰ It remains open to a party to raise issue estoppel and abuse of process at trial.¹¹

The Court has also provided guidance in respect of the scope of the section 6.02 rule prohibiting any action from being joined to an action commenced under the *Regulations* during the 24-month period wherein the Minister cannot issue an NOC.¹² The *raison d’être* of the prohibition is to promote the expediency of one action, and one action only, instituted pursuant to subsection 6(1), in the context of the 24-month period within which that action is meant to be determined.¹³ The wording of the prohibition therefore captures more than just the consolidation of proceedings; it applies equally to other arrangements such as the hearing together of common issues across separate actions under the *Regulations* relating to the same patented medicine, where doing so could possibly result in the action exceeding the 24-month timeline.¹⁴

In 2020 the Federal Court issued an updated guidance document setting out the procedures to be followed for *PMNOC* actions (“*PMNOC Guidelines*”).³ As the Court continues to refine the practice for *PMNOC* trials, it would not be surprising that these practices will be adopted for non-*PMNOC* patent infringement cases.

24-Month Timeline Retained

The *2017 Regulations* continue the current practice of barring the Minister of Health from issuing a Notice of Compliance for up to 24 months from the day an action is commenced (as discussed below), plus a day.¹⁶ From the Canadian perspective, 21 months to trial and a decision within 24 months is a “fast-track” to a patent infringement/validity trial. The parties to an action under the *Regulations* must be diligent, with the help of the Court, in ensuring that the proceedings move as expeditiously as possible and must cooperate in attempting to have

⁸ As of May 2020, actions initiated under the *2017 Regulations* that have been decided include: *Amgen Inc. v. Pfizer Canada ULC*, 2020 FC 522 (F.C.); *Janssen Inc. v. Teva Canada Ltd.*, 2020 FC 593 (F.C.); and *Biogen Canada Inc. v. Taro Pharmaceuticals Inc.*, 2020 FC 621 (F.C.).

⁹ Section 6.08: An action brought under subsection 6(1) may, on the motion of a second person, be dismissed, in whole or in part, on the ground that it is redundant, scandalous, frivolous or vexatious or is otherwise an abuse of process in respect of one or more patents or certificates of supplementary protection.

¹⁰ *Pfizer Canada Inc. v. Amgen Inc.*, 2019 FCA 249 (F.C.A.) at paras. 77, 81-84 (per Nadon J.A.). See also para. 76 citing Sexton J.A. in *Apotex Inc. v. Pfizer Ireland Pharmaceuticals*, 2011 FCA 77 (F.C.A.): “. . . *Res judicata* in the sense of cause of action estoppel is inapplicable because the subject matter of an infringement or impeachment action is very different from that of an NOC [application]. The question before a judge in NOC [application] is simply whether the allegations of invalidity or non-infringement contained in a notice of allegation are justified. . . . Simply put, the issues of validity and infringement are not before the court in an NOC [applications].”

¹¹ *Pfizer Canada Inc. v. Amgen Inc.*, 2019 FCA 249 (F.C.A.) at para. 84 (per Nadon J.A.). See also *Amgen Inc. v. Pfizer Canada ULC*, 2020 FC 522 (F.C.) at paras. 154-169.

¹² *2017 Regulations*, s. 6.02: No action may be joined to a given action brought under subsection 6(1) during any period during which the Minister shall not issue a notice of compliance because of paragraph 7(1)(d) other than (a) another action brought under that subsection in relation to the submission or supplement in that given action; and (b) an action brought in relation to a certificate of supplementary protection that is added to the register after the filing of the submission or supplement in that given action, if the patent that is set out in that certificate of supplementary protection is at issue in that given action.

¹³ *Apotex Inc. v. Bayer Inc.*, 2020 FCA 86 (F.C.A.) at paras. 122 (per Nadon J.A.).

¹⁴ *Apotex Inc. v. Bayer Inc.*, 2020 FCA 86 (F.C.A.) at paras. 110, 122 and 124 (per Nadon J.A.).

³ The Federal Court of Canada, “Case and Trial Management Guidelines for Complex Proceedings and Proceedings under the *PM(NOC)* Regulations”, available at [https://www.fct-cf.gc.ca/Content/assets/pdf/base/EN_Case%20and%20Trial%20Management%20Guidelines%20for%20Complex%20Proceedings%20and%20Proceedings%20under%20the%20PM\(NOC\)%20Regulations%20-%20FINAL.pdf](https://www.fct-cf.gc.ca/Content/assets/pdf/base/EN_Case%20and%20Trial%20Management%20Guidelines%20for%20Complex%20Proceedings%20and%20Proceedings%20under%20the%20PM(NOC)%20Regulations%20-%20FINAL.pdf) (*PMNOC Guidelines*).

¹⁶ *2017 Regulations*, s. 7(1).

the action determined within the 24-month period.¹⁷ The *Regulations* do not, however, require the Federal Court to render judgment before expiry of the 24-month period.¹⁸

Commencing a PMNOC action

Consistent with the former *PMNOC* regime, the triggering event for an action under section 6(1) (a “PMNOC action”) of the *2017 Regulations* is the Innovator’s receipt of a Notice of Allegation in respect of a patent(s) listed on the Patent Register for a drug. This initiates a 45-day statutory limitation period within which the Innovator is to determine whether an action for infringement is appropriate, and if so, to commence an action.⁴ If no action is commenced within this period, the *2017 Regulations* prevent the Innovator from bringing a PMNOC action, or any other infringement action, against the Generic challenger in respect of patent(s) that were the subject of a Notice of Allegation, unless the Innovator can establish it did not have a reasonable basis for bringing a section 6(1) action within the limitation period.⁵ The 45-day period does not, however, apply to actions asserting infringement of patents other than the listed patents referenced in the Notice of Allegation.⁶

Pleadings

An action is begun by issuing a Statement of Claim. A PMNOC Statement of Claim must be accompanied by a letter to the Court identifying that the action is proceeding under the *PMNOC Regulations* and requesting that the proceeding be specially managed thereunder. The letter must also identify any other on-going proceedings involving the same patent(s) or medicinal ingredient(s), and indicate whether the plaintiff has renounced the 24-month statutory stay.⁷

The defendant must file a Notice of Intention to Respond within ten days of being served with the Statement of Claim.⁸ As with a normal patent infringement action, the defendant may file a Statement of Defence and/or a Counterclaim setting out the material facts relating to allegations of non-infringement and/or invalidity.⁹ Unlike the former *PMNOC* regime, under which the Notice of Allegation defined the issues that could be raised in a section 6(1) proceeding, the legal and factual basis for any allegation of invalidity in a PMNOC action is not limited to that detailed in the Notice of Allegation.¹⁰ The delivery of an Notice of Allegation is intended to facilitate early consideration of issues likely to arise in the litigation and does not limit the issues and arguments that may be raised, which are defined by the pleadings themselves.¹¹ A Statement of Defence may be amended to allege additional grounds of invalidity not included in the Notice of Allegation, provided doing so is consonant with the interests of justice and the principles relating to pleading amendments.¹²

Agreement Re Pre-Trial Procedures and Timeline

Following service of the Notice of Intention to Respond, the parties are expected to reasonably cooperate and agree on expediting pre-trial procedures pursuant to s. 6.09, including with respect to:

¹⁷ *Apotex Inc. v. Bayer Inc.*, 2020 FCA 86 (F.C.A.) at para. 134 (per Nadon J.A.).

¹⁸ *Apotex Inc. v. Bayer Inc.*, 2020 FCA 86 (F.C.A.) at para. 132 (per Nadon J.A.): “. . . the Regulations do not require the Federal Court to render judgment within 24 months. While it is true that the Regulations prohibit the Minister from issuing an NOC to a generic before the end of the 24-month period, they do not require the Federal Court to render judgment within that period.”

⁴ *Sunovion Pharmaceuticals Canada Inc. & Sumitomo Dainippon Pharma Co., Ltd v. Taro Pharmaceuticals Inc.*, 2021 FC 37 at paras. 13-14. See *ViiV Healthcare Company, Shionogi & Co., Ltd. and ViiV Healthcare ULC v. Sandoz Canada Inc.*, 2020 FC 1040 (F.C.) at para. 75 for the application of the *Time Limits and Other Periods Act (COVID-19)* to section 6(1).

⁵ *2017 Regulations*, s. 6.01.

⁶ *2017 Regulations*, s. 8.1; *Merck Sharp & Dohme Corp. v. Sandoz Canada Inc.*, 2020 FC 1180 at paras. 5-6, 59-6.

⁷ *PMNOC Guidelines*, item 31.

⁸ *PMNOC Guidelines*, item 32.

⁹ *Sunovion Pharmaceuticals Canada Inc. & Sumitomo Dainippon Pharma Co., Ltd. v. Taro Pharmaceuticals Inc.*, 2021 FC 37 at paras. 15, 23, aff’d 2021 FCA 113.

¹⁰ *Sunovion Pharmaceuticals Canada Inc. & Sumitomo Dainippon Pharma Co., Ltd. v. Taro Pharmaceuticals Inc.*, 2021 FC 37 at para. 13, aff’d 2021 FCA 113 at para. 5.

¹¹ *Sunovion Pharmaceuticals Canada Inc. & Sumitomo Dainippon Pharma Co., Ltd. v. Taro Pharmaceuticals Inc.*, 2021 FC 37 at para. 22, aff’d 2021 FCA 113 at para. 5.

¹² *Sunovion Pharmaceuticals Canada Inc. & Sumitomo Dainippon Pharma Co., Ltd v. Taro Pharmaceuticals Inc.*, 2021 FC 37 at para. 11, aff’d 2021 FCA 113 at paras. 5-6.

- the scheduling of the various steps leading up to trial;¹⁹ and
- the order of evidence at trial, and the presentation of evidence at trial in a manner that could streamline the hearing.²⁰

Claim Construction and Claim Charts

Consideration of claim construction at an early stage can result in a reduction of the claims being asserted at the trial, or even lead to settlement of the entire proceeding. Therefore, the parties are required to exchange claims charts in a format prescribed by the Court.²² A case management conference should be requisitioned with a view to limiting claim construction issues.²³

Case Management Conference

Within seven days of service of the defendant's Notice of Intention to Respond, the plaintiff must requisition a case management conference, and provide the Court with a letter setting out a jointly proposed timetable of all steps leading up to trial, the duration and venue and of the trial, and dates of mutual availability for trial. The requisition letter must also identify any pre-trial motions contemplated by the parties relating to protective or confidentiality orders, document production, or relief under sections 6.07 or 6.08 of the *2017 Regulations*.¹³

The initial case management conference to schedule all pre-trial steps in the action, address procedural matters at an early stage, and explore settlement prospects will be held within 28 days of issuance of the Statement of Claim.¹⁴ Thereafter the Court will convene regular case management conferences to discuss the timetable and narrow the issues for trial. The parties are expected to confer before requesting any case management conference or bringing any motion. The *PMNOC Guidelines* provide that a case management conference should be requested before any motion is brought.¹⁵

Trial Management Conference

Given the active role of the Court in case management, no pre-trial conferences shall be held in PMNOC proceedings.²⁴

A trial management conference shall be requisitioned by the parties pursuant to Rule 270 of the Rules forthwith upon the trial dates being fixed to deal with matters relating to the conduct of the trial.²⁵ All affidavits must be, following the *PMNOC Guidelines*, item 33, served and filed in accordance with the schedule fixed by the Court and, unless a prior order is made, the witness should be available for cross-examination at the trial.²⁶

If any fact evidence is to be adduced at trial by *viva voce* testimony, then an outline of the areas of testimony of any facts witnesses who are expected to appear at the trial will also need to be submitted in advance of trial in accordance with the schedule fixed by the Court, with such witnesses being made available for cross-examination at trial.²⁷ Where it is agreed by the parties that certain fact evidence may be introduced without cross-examination, parties are encouraged to adduce stipulations of such evidence to streamline the necessity for trial testimony.²⁸

Demonstrative evidence sought to be used must be exchanged by the parties at least 30 days prior to the trial.²⁹ Objections to any demonstrative evidence must be raised with the Court at least 20 days prior to the trial. No additional demonstrative evidence beyond that sought to be used and so exchanged will be allowed at the trial.³⁰

At least 30 days prior to the trial, a further trial management conference should be held to discuss, among other

¹⁹ *PMNOC Guidelines*, item 33.

²⁰ *PMNOC Guidelines*, item 41.

²² *PMNOC Guidelines*, item 20.

²³ *PMNOC Guidelines*, item 39.

¹³ *PMNOC Guidelines*, item 33; *2017 Regulations*, s. 6.07(1) ("In an action brought under subsection 6(1), the Federal Court may, on the motion of the second person, declare that a patent or certificate of supplementary protection is ineligible for inclusion on the register."), s. 6.08 ("An action brought under subsection 6(1) may, on the motion of a second person, be dismissed, in whole or in part, on the ground that it is redundant, scandalous, frivolous or vexatious or is otherwise an abuse of process in respect of one or more patents or certificates of supplementary protection.").

¹⁴ *PMNOC Guidelines*, item 34.

¹⁵ *PMNOC Guidelines*, item 35.

²⁴ *PMNOC Guidelines*, item 37.

²⁵ *PMNOC Guidelines*, item 38.

²⁶ *PMNOC Guidelines*, item 41.

²⁷ *PMNOC Guidelines*, item 41.

²⁸ *PMNOC Guidelines*, item 41.

²⁹ *PMNOC Guidelines*, item 36.

³⁰ *PMNOC Guidelines*, item 36.

things, the identification of the patents and/or claims that remain in issue and any specific claim construction disputes that still exist.³¹

Trial

At the request of, and at a time specified by, the trial judge, the parties shall provide a tutorial session in a form to be agreed to by the parties or on direction of the Court.³²

The Court will expect parties to complete PMNOC trials within ten days, unless the Court determines that additional time is required.³³

For trial, the parties will be expected to adduce their evidence-in-chief³⁴ by way of affidavit, subject to variation by the case management judge or the trial judge prior to trial.³⁵

(b) Trademark Cases

In cases where infringement of a registered trademark is alleged, the principal issues to be determined are whether: (1) the defendant “used” a trademark as defined in section 4 of the *Trademarks Act*;³⁶ (2) the trademark so used in association with goods or services similar to the plaintiff’s was a “confusing” trademark as defined in sections 2 and 6 of the *Trademarks Act*; and, therefore (3) the defendant infringed the rights of the owner of the trademark as governed by sections 19, 20 and/or 22 of the *Trademarks Act*.

Where the plaintiff has trademark rights at common law and has alleged passing off, he, she, they or it must establish the three elements of passing off:³⁷

- (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.³⁸ Evidence at trademark trials therefore involves establishment of the trademark rights either by tendering a certified copy of the trademark registration or, in cases involving common law rights, tendering evidence of extensive use of the trademark so as to establish enforceable goodwill.

(c) 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?
- (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*³⁹ 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, her or them? 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 an 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

31 *PMNOC Guidelines*, item 39.

32 *PMNOC Guidelines*, item 40.

33 *PMNOC Guidelines*, item 42.

34 Interestingly, this is not limited to expert evidence and, therefore, would include fact witnesses.

35 *PMNOC Guidelines*, item 41.

36 R.S.C. 1985, c. T-13.

37 *Ciba-Geigy Canada Ltd. v. Apotex Inc.* (1992), 44 C.P.R. (3d) 289 (S.C.C.).

38 *Trademarks Act*, R.S.C. 1985, c. T-13, s. 7.

39 R.S.C. 1985, c. C-42.

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.

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.⁴⁰

(a) 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, she or they 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, she or they has given in preparation for trial or at earlier hearings or trials relating to the same subject matter. Where the witness is a representative of the corporate party, prior statements from related corporations in related litigation should also be reviewed, as the statements may be admissible.⁴¹ If the witness was examined for discovery, he, she or they 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 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.

40 *Halford v. Seed Hawk Inc.* (2001), 16 C.P.R. (4th) 199 (F.C.) at para. 5, per Pelletier J., affirmed 2006 FCA 275 (F.C.A.).

41 *Eli Lilly Canada Inc. v. Mylan Pharmaceuticals ULC*, 2015 FC 17 (F.C.) per de Montigny J., at paras. 64-69.

(b) Expert Witnesses

Expert witnesses can help the court understand technical evidence — be it, for example, 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 trademark cases, experts can advise the court about actual consumer awareness as determined by surveys.

Expert witnesses have a special duty to the court to provide fair, objective and non-partisan assistance. A proposed expert witness who is unable or unwilling to comply with this duty is not qualified to give expert opinion evidence and should not be permitted to do so.⁴² Less fundamental concerns about an expert's independence and impartiality should be taken into account in the broader, overall weighing of the costs and benefits of receiving the evidence.⁴³

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 the expert. It is their objective, honest opinion that is desired, the provision of which will not in any way affect 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.⁴⁴ The prior testimony of the expert should be reviewed to ensure he, she or they has not made any prior inconsistent statements nor has the court impugned his, her or their credibility.⁴⁵

(i) 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.

The Expert's Code of Conduct (discussed below) should be considered and, preferably, addressed at the outset of retaining an expert where it is expected that the expert may provide opinion evidence at trial.

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. Providing prior art to the expert, rather than having the expert locate it, should not diminish the credibility of the expert at trial;⁴⁶ however, the expert's opinion must sometimes be based on a broader perspective than merely the prior art supplied by counsel, otherwise the expert runs the “real risk of offering a hindsight opinion”.⁴⁷ 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.

(ii) 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.

The *Canada Evidence Act* limits to five the number of expert witnesses each party can call⁴⁸ unless leave of the

42 *White Burgess Langille Inman v. Abbott and Haliburton Co.*, 2015 SCC 23, [2015] 2 S.C.R. 18 (S.C.C.) at para. 2. See also *Ciba Specialty Chemicals Water Treatments Limited v. SNF Inc.*, 2017 FCA 225 (F.C.A.) per Pelletier J.A., Rennie & Woods JJ.A. concurring at para. 32.

43 *White Burgess Langille Inman v. Abbott and Haliburton Co.*, 2015 SCC 23, [2015] 2 S.C.R. 18 (S.C.C.) at para. 2.

44 *Ductmate Industries Inc. v. Exanno Products Ltd.* (1984), 2 C.P.R. (3d) 289 (F.C.) at 302; *Kirin-Amgen Inc. v. Hoffmann-La Roche Ltd. / Hoffmann-La Roche Ltée* (1999), 87 C.P.R. (3d) 1 (F.C.) at 28, per Reed J., affirmed 2000 CarswellNat 3187 (F.C.A.).

45 *Varco Canada Ltd. v. Pason Systems Corp.*, 2013 FC 750 (F.C.) per Phelan J., at paras. 388-390 [*Varco* 2013].

46 *Alcon Canada Inc. v. Cobalt Pharmaceuticals Co.*, 2014 FC 149 (F.C.) at paras. 30-31, additional reasons 2014 CarswellNat 1741 (F.C.).

47 *AstraZeneca Canada Inc. v. Apotex Inc.*, 2015 FC 322 (F.C.) at para. 231 [*Astrazeneca*]. For the dangers of hindsight evidence, see also *Bridgeview Manufacturing Inc. v. 931409 Alberta Ltd.*, 2010 FCA 188 (F.C.A.) at para. 50 and *Apotex Inc. v. Bayer AG*, 2007 FCA 243 (F.C.A.) at paras. 25-26.

48 *Canada Evidence Act*, R.S.C. 1985, c. C-5, 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.

court has been granted to allow more.⁴⁹ Similar rules exist in the *Ontario Evidence Act*,⁵⁰ which limit the number of experts to three, and in the *Federal Courts Rules*,⁵¹ which sets a limit of five experts (for the case as a whole rather than for every issue⁵²), unless leave of the court is obtained. No distinction should be drawn between the number of experts who may be called at trial and the number of expert reports that may be served in advance of trial (both involve preparation for cross-examination).⁵³ For a bifurcated case, five experts are permitted in total for both phases, not for each phase. A bifurcated proceeding constitutes a single “trial” or “proceeding” for the purposes of Rule 52.4 and s. 7 of the *Canada Evidence Act*.⁵⁴

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.⁵⁵ Under the *Quebec Code of Civil Procedure*,⁵⁶ the parties cannot seek more than one expert opinion, whether joint or not, per area or matter of expertise, unless the Court authorizes otherwise, given the complexity or importance of the case or the state of knowledge in the area or matter concerned.⁵⁷

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 of the *Federal Courts Rules* impose a high threshold. Leave under Rule 52.4 is not granted lightly.⁵⁸ The mere allegation that a case is complex or technical will not suffice.⁵⁹

The *Federal Courts Rules* permit parties to jointly name an expert witness.⁶⁰

(iii) *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.

It is the duty of an expert witness to provide opinion evidence that is fair, objective and non-partisan.⁶¹

(A) Expertise

The first criterion for selecting an expert witness is that he, she or they 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 the expert. A person may have greater loyalty to his, her or their 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 databases of decisions and search engines to see whether a court has commented unfavourably on the expertise of the witness you propose 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.⁶² Witnesses who testify frequently can be praised in one case and criticized in another. The hope is that the court is mainly interested

49 *Eli Lilly & Co. v. Novopharm Ltd.* (1997), 73 C.P.R. (3d) 371 (F.C.), affirmed (2000), 10 C.P.R. (4th) 10 (F.C.A.), leave to appeal refused 2001 CarswellNat 1295, [2001] S.C.C.A. No. 100 (S.C.C.) [*Eli Lilly*].

50 R.S.O. 1990, c. E-23, s. 12.

51 *Federal Courts Rules*, SOR/98-106, r. 52.4(1).

52 *Eli Lilly & Co. v. Apotex Inc.*, 2007 FC 1041 (F.C.) per Hughes J., at para. 27; *Altana Pharma Inc. v. Novopharm Ltd.*, 2007 FC 1095, [2007] F.C.J. No. 1421 (F.C.) per Phelan J., at para. 55. Where several cases were heard concurrently in *Eli Lilly*, *supra*, note 49, 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 (at paras. 119-120).

53 *Apotex v. Sanofi-Aventis*, 2010 FC 1282 at para. 31; *Airbus Helicopters v. Bell Helicopter Textron Canada Limitée*, 2016 FC 590 (F.C. per Martineau J.) at para. 31.

54 *Airbus Helicopters v. Bell Helicopter Textron Canada Limitée*, 2016 FC 590 (F.C. per Martineau J.) at paras. 45-46.

55 *Federal Courts Rules*, SOR/98-106, r. 52.4(2).

56 *Quebec Code of Civil Procedure*, Article 232

57 *Hamel c. Lames Nordik (Usinage Pro 24)*, 2018 QCCS 925 (C.S. Que.), leave to appeal allowed 2018 CarswellQue 1487 (C.A. Que.).

58 *Apotex Inc. v. Sanofi-Aventis Canada Inc.*, 2010 FC 1282 (F.C.) per Boivin J., at para. 20.

59 *Ibid.*, per Boivin J., at para. 24.

60 SOR/98-106, r. 52.1(2).

61 *Henderson v. Risi*, 2012 ONSC 3459, 111 O.R. (3d) 554 (Ont. S.C.J.) per Lederman J., at para. 19; quoted with approval in *Moore v. Getahun*, 2015 ONCA 55 (Ont. C.A.) per Sharpe J.A., at para. 52.

62 *Varco 2013*, *supra*, note 45 at para. 388 (“While a court should be cautious in being influenced by other court’s comments on an expert’s work in unrelated cases, it is telling that [the expert] has earned qualitative criticism from the Federal Court, the Ontario Superior Court of Justice and the Alberta Court of Queen’s Bench”).

in the substance of each expert's opinion and the reasoning that led to that opinion.⁶³

In patent cases, the claims are interpreted as of the date of publication of the claims.⁶⁴ 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"⁶⁵ — 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, she or they may be 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?⁶⁶

(B) Good teacher

The second criterion for an expert is that he, she or they 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 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, her or their 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, her or their client.

A witness' experience also depends upon his, her or their 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, her or their research?⁶⁷ 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.

(iv) *What Issues will the Expert Evidence Address?*

The issue of claim construction in a patent action is essentially "What do the claims mean to a skilled worker?" The question of claim construction is 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.⁶⁸ 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,⁶⁹ it stated in another that it is not the function of the expert to construe the claims,

63 *Shire Canada Inc. v. Apotex Inc.*, 2016 FC 382 (F.C.) per Locke J. at para. 48.

64 *Whirlpool Corp. v. Camco Inc.*, [2000] 2 S.C.R. 1067 (S.C.C.) at 1101-1102, reconsideration / rehearing refused 2001 CarswellNat 283 (S.C.C.) [*Whirlpool*]; *Free World Trust c. Électro Santé Inc.*, [2000] 2 S.C.R. 1024 (S.C.C.) at 1055.

65 See *Ciba Specialty Chemicals Water Treatments Limited v. SNF Inc.*, 2017 FCA 225 (F.C.A.) per Pelletier J.A., Rennie & Woods J.J.A. concurring at para. 27 where the court referred to the trial judge's preference for the evidence of the SNF experts because they had "greater field experience".

66 See evidence of Dr. Beal in *Control Data Canada Ltd. v. Senstar Corp.* (1988), 24 C.P.R. (3d) 117 (F.C.) per Cullen J.; and Dr. Uldall in *Mahurkar v. Vas-Cath of Canada Ltd.* (1988), 18 C.P.R. (3d) 417 (F.C.) at 436, per Strayer J., affirmed 1990 CarswellNat 223 (F.C.A.).

67 *Sanofi-Aventis Canada Inc. v. Ratiopharm Inc.*, 2010 FC 230 (F.C.) at para. 17, per Phelan J.

68 *R. v. Mohan*, [1994] 2 S.C.R. 9 (S.C.C.) at 20.

69 *Ibid.* at 24.

but rather to put the trial judge in the position of being able to do so in a knowledgeable way.⁷⁰

Experts should be cautious in addressing issues dealing with areas more general than their area of extensive expertise. A court may conclude that an expert's extensive knowledge in one area distorts that expert's view of what an ordinary skilled person would have in mind when reading a patent.⁷¹ Likewise, an expert should have at least the same qualifications as the POSITA: if his, her or their expertise does not include experience with the specific art to which the patent relates, then the expert cannot opine as to what was the common general knowledge of the POSITA at the relevant time and the court cannot rely on that expert's evidence.⁷²

(A) Experts in patent cases have been permitted to testify as to the following:

- the state of the prior art;⁷³
- what the prior art references (including prior patents) meant or revealed to them;⁷⁴
- the state of knowledge in the craft, art or science to which the specification is directed;⁷⁵
- the explanation of technical terms, words and phrases;⁷⁶
- what did the specifications of the patents in suit disclose to the expert?⁷⁷ (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".⁷⁸
- what a person skilled in the art would have understood from reading the patent at the relevant time.⁷⁹

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 opinion as to infringement since the expert cannot substitute his view of the proper construction of the patent for the judge's.⁸⁰

- the main innovations of the invention at issue since it falls into the same category as an opinion on anticipation or obviousness.⁸¹ (This view is probably wrong: how does the expert know what is the invention at issue unless he, she or they 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).⁸²
- whether in the light of the common knowledge and the "prior art" an ordinary, skilled and un inventive workperson would, in trying to resolve a particular problem, have easily and readily arrived at the same solution found by the "inventor" of the patent in suit (obviousness).⁸³
- 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

70 *Whirlpool*, *supra*, note 64 at paras. 43 and 49(a), followed in *Pfizer Canada Inc. v. Canada (Minister of Health)* (2005), 46 C.P.R. (4th) 244 (F.C.) at para. 34, per Hughes J., affirmed 2007 CarswellNat 6 (F.C.A.).

71 *Mediatube Corp. v. Bell Canada*, 2017 FC 6 (F.C.) per Locke J. at para. 68

72 *Eli Lilly Co. v. Apotex Inc.*, (2009), 2009 CF 991, 2009 FC 991, 2009 CarswellNat 3042, 2009 CarswellNat 6607 (F.C.) at paras. 61-73, 94, affirmed (2010), 2010 CAF 240, 2010 FCA 240, 2010 CarswellNat 5866, 2010 CarswellNat 3443 (F.C.A.), cited in *Bombardier Recreational Products Inc. v. Arctic Cat, Inc.* (2018), 2018 CAF 172, 2018 FCA 172, 2018 CarswellNat 5338, 2018 CarswellNat 5339 (F.C.A.) per Gauthier J.A., Pelletier and De Montigny JJ.A., concurring at paras. 30-32.

73 *Xerox of Canada Ltd. v. IBM Canada Ltd.* (1977), 33 C.P.R. (2d) 24 (F.C.) at 36, per Collier J. [*Xerox*].

74 *Ibid.*

75 *Ibid.* at 32.

76 *Ibid.*

77 *Ibid.* at 36.

78 *Halford v. Seed Hawk Inc.* (2001), 16 C.P.R. (4th) 199 (F.C.) at para. 17, per Pelletier J., affirmed 2006 FCA 275 (F.C.A.).

79 *Amfac Foods Inc. v. Irving Pulp & Paper Ltd.* (1984), 80 C.P.R. (2d) 59 (F.C.) at 82-83, per Strayer J., affirmed (1986), 12 C.P.R. (3d) 193 (F.C.A.) [*Amfac*]; but see *Baxter Travenol Laboratories of Canada Ltd. v. Cutter (Canada) Ltd.* (1983), 68 C.P.R. (2d) 179 (F.C.A.) at 193, per Thurlow C.J., leave to appeal refused 1983 CarswellNat 825 (S.C.C.), where it was said that an expert cannot provide evidence as to the meaning of a word in the patent.

80 *Halford v. Seed Hawk Inc.* (2001), 16 C.P.R. (4th) 189 (F.C.) at para. 24, per Pelletier J.

81 *Ibid.*, at para. 31.

82 *Xerox*, *supra*, note 73 at 36.

83 *Ibid.*

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.⁸⁴

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.

- a list enumerating the essential features of the claims to decide the issue of infringement.⁸⁵
- an assessment of mechanical equivalency that the allegedly infringing device operates in the same manner as the invention at issue.⁸⁶ (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;⁸⁷
- the meaning of the patent as such;⁸⁸
- the testimony of the inventor as to what his invention was, for the purpose of claim construction;⁸⁹
- the intention of the inventor (as expressed in the patent);⁹⁰ or
- conclusions on the infringement of the patent at issue.⁹¹

(B) Trademark Actions: Confusion

Courts may be cautious about accepting expert witness evidence in trademark 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”.⁹² 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”.⁹³ 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.⁹⁴ Courts find it adequate for the judge to imagine “putting [themselves] in the position of the average person going into the market”⁹⁵ and “use their own common sense” to make a finding.

(v) 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

⁸⁴ *Halford v. Seed Hawk Inc.* (2001), 16 C.P.R. (4th) 189 (F.C.) at para. 25, per Pelletier J.

⁸⁵ *Ibid.*, at para. 27.

⁸⁶ *Ibid.*, at para. 30.

⁸⁷ *Ibid.*, at para. 17.

⁸⁸ *Amfac*, *supra*, note 79.

⁸⁹ *Lovell Manufacturing Co. v. Beatty Brothers Ltd.* (1962), 41 C.P.R. 18, 23 Fox Pat. C. 112 (Can. Ex. Ct.) at 38 [C.P.R.], per Thorson P.; adopted by *Johnson Controls Inc. v. Varta Batteries Ltd.* (1984), 80 C.P.R. (2d) 1, 3 C.I.P.R. 1, 53 N.R. 6 (F.C.A.) at 27-28 [C.P.R.], per Urie J.A., leave to appeal refused (1984), 56 N.R. 398n (S.C.C.); *P.L.G. Research Ltd. v. Jannock Steel Fabricating Co.* (1991), 46 F.T.R. 27, 35 C.P.R. (3d) 346 (F.C.), affirmed (1992), 55 F.T.R. 240 (note), 41 C.P.R. (3d) 492, 142 N.R. 203 (F.C.A.); *Halford v. Seed Hawk Inc.* (2001), 16 C.P.R. (4th) 189 (F.C.) at paras. 22-23, per Pelletier J.

⁹⁰ *Amfac*, *supra*, note 79.

⁹¹ *Halford v. Seed Hawk Inc.* (2001), 16 C.P.R. (4th) 189 (F.C.) at para. 25, per Pelletier J.

⁹² *Masterpiece Inc. v. Alavida Lifestyles Inc.*, 2011 SCC 27 (S.C.C.) at para. 80 [Masterpiece].

⁹³ *Ultravite Laboratories Ltd. v. Whitehall Laboratories Ltd.*, [1965] S.C.R. 734 (S.C.C.) at 737-738 [Ultravite].

⁹⁴ *Masterpiece*, *supra*, note 92 at para. 81.

⁹⁵ *Ultravite*, *supra*, note 93 at 738.

their admission in evidence.⁹⁶

Although no such formal rule exists in either the *Federal Courts Rules* or the *Ontario Rules of Civil Procedure*,⁹⁷ the Federal Court has issued a Notice to the Legal Profession that directs that a similar procedure be followed.⁹⁸ If a party wishes to establish a fact in issue at trial by experimental testing conducted for the purpose of litigation, it must, no later than two months before the scheduled service of expert reports in chief, advise the other party of:

- the facts to be proven by the testing;
- the nature of the experimental procedure to be performed;
- when and where the adverse parties' counsel and representative can attend to watch the experiment; and
- when and in what format the data and test results from such experiment will be shared with the adverse parties.

If this procedure is not followed, a party may not rely on the experiment at trial without leave of the court. Further, the jurisprudence prior to the issuance of the 2014 Notice provided 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.⁹⁹ Where such practice was not followed, the tests were generally inadmissible.¹⁰⁰ 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.¹⁰¹ Another exception occurred when a party was informed of the other party's intention to conduct experimental testing, but did not ask to attend. The test results were admitted.¹⁰²

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, invoking privilege, not to disclose the fact of the experiment to the opposing party and not rely on it at trial. If the same witness conducts the "dry-run" experiment, privilege is, however, waived for all of that witness' knowledge.¹⁰³

Where one party advances experimental evidence, it may be risky to simply take "pot-shots from the sidelines", rather than "challenge [the] experimental data head-on."¹⁰⁴

(vi) *Trademark Actions: Surveys*

Survey evidence may be used in passing off and trademark 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 may also conduct surveys in response to prove these elements cannot be established.

Surveys, as a form of expert evidence, must be both reliable and necessary to be admissible.¹⁰⁵ Survey evidence is now viewed with caution in trademark actions and, even if it is allowed, it may have little probative value.¹⁰⁶ Judges serve a "gatekeeper" function with respect to survey evidence, so that unnecessary, irrelevant, and potentially distracting evidence is not allowed to lengthen court proceedings.¹⁰⁷ However, survey evidence may still be useful to establish commercial goodwill in Canada,¹⁰⁸ although it may not be necessary when a judge concludes

96 UK, *Civil Procedure Rules*, Practice Direction 63, paras. 7.1-7.2, online: <<http://perma.cc/KYQ5-WKKA>>.

97 R.R.O. 1990, Reg. 194 [*Rules of Civil Procedure*].

98 Memorandum from Paul Crampton, Chief Justice of the Federal Court, to the Legal Profession (27 February 2014) re: Experimental Testing, online: <<http://perma.cc/PY33-ZJG3>>.

99 *Dow Chemical Co. v. Nova Chemicals Corp.*, 2012 FC 754 (F.C.) at paras. 51, 58.

100 *Omark Industries (1960) Ltd. v. Gouger Saw Chain Co.* (1964), 45 C.P.R. 169 (Can. Ex. Ct.) at 228, per Noel J.; *Halford v. Seed Hawk Inc.* (2001), 16 C.P.R. (4th) 189 (F.C.) at para. 25, per Pelletier J.

101 *Halford v. Seed Hawk Inc.* (2001), 16 C.P.R. (4th) 199 (F.C.) at para. 9, per Pelletier J., affirmed 2006 FCA 275 (F.C.A.).

102 *Apotex Inc. v. Pfizer Canada Inc.*, 2013 FC 493 (F.C.) at para. 40, affirmed 2014 CarswellNat 413 (F.C.A.).

103 *Kirin-Amgen Inc. v. Hoffmann-La Roche Ltd. / Hoffmann-La Roche Ltée* (1999), 87 C.P.R. (3d) 1 (F.C.) at paras. 70-71, per Reed J., affirmed 2000 CarswellNat 3187 (F.C.A.).

104 *Astrazeneca*, *supra*, note 47 at para. 298.

105 *Masterpiece*, *supra*, note 92 at para. 99.

106 *Cheah v. McDonald's Corp.*, 2013 FC 774 (F.C.) at para. 26; *SK Corp. v. Safety-Kleen Systems Inc.*, 2014 FC 140 (F.C.) at para. 45.

107 *Masterpiece*, *supra*, note 92 at para. 76.

108 *Sandhu Singh Hamdard Trust v. Navsun Holdings Ltd.*, 2014 FC 1139 (F.C.) at para. 84.

based on other evidence and his, her or their own knowledge that a mark is known in Canada.¹⁰⁹ There may be ways to adduce evidence of the public's reaction to a trademark without resorting to survey evidence.¹¹⁰

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".¹¹¹

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.

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.

If survey evidence is to be introduced at trial, then it should be 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 trademark has not yet been established in a marketplace, there are no casual or average consumers that are familiar enough with the trademark. "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."¹¹² 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".¹¹³

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., 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 trademark that is not yet known in a marketplace, using preliminary questions to prime the respondents into a simulated recollection of the trademark would likely produce results that are both unreliable and invalid.¹¹⁴ 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 trademark disputes.¹¹⁵ 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.¹¹⁶

(vii) *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, she or they understands the content of his, her or their 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, her or their 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.

(viii) *Code of Conduct*

The Federal Court has specified the role of an expert witness in a Code of Conduct that explicitly sets out the expert's duty to the Court.¹¹⁷ An expert has a duty to provide impartial, independent and objective opinions in their

109 *Empresa Cubana Del Tabaco v. Tequila Cuervo S.A. Dec. V.*, 2013 FC 1010 (F.C.) at para. 39, affirmed 2015 CarswellNat 75 (F.C.A.).

110 *Canadian Council of Professional Engineers v. Continental Teves AG & Co. oHG*, 2013 FC 801 (F.C.) at para. 31.

111 *Masterpiece*, *supra*, note 92 at para. 93.

112 *Ibid.*, at para. 96.

113 *Ibid.*, at para. 97.

114 *Ibid.*, at para. 96.

115 *Mattel U.S.A. Inc. v. 3894207 Canada Inc.*, 2006 SCC 22 (S.C.C.).

116 *Ibid.*, at para. 44.

117 *Federal Courts Rules*, SOR/98-106, Schedule.

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, 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.¹¹⁸

(ix) *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 with the party's pre-trial conference memorandum, unless otherwise scheduled.¹¹⁹ The expert's affidavit or statement must set out in full the proposed evidence of the expert.¹²⁰

Any party who is not in default may request a pre-trial conference after the close of pleadings.¹²¹ The party requesting the pre-trial conference must serve its pre-trial conference memorandum (and accompanying expert affidavits or statements) with the request;¹²² all other parties must then serve their pre-trial conference memoranda within 30 days after being served with the requisition for a pre-trial conference.¹²³

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 in accordance with the schedule ordered at the pre-trial conference.¹²⁴

The purpose of an expert report is to disclose what evidence the witness will give at trial and the factual basis on which he, she or they 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.¹²⁵

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.¹²⁶

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. However, counsel must be wary of what they discuss with the expert, as communications between a lawyer and an expert may not be protected by privilege. In some jurisdictions, the contents of the expert's file relating to the preparation of the affidavit may also be producible.¹²⁷ Counsel should advise the expert of the possibility that the expert's file will be disclosed, and should advise the expert not to destroy relevant records.¹²⁸

In preparing the expert's report:

118 *Ibid.*, r. 52.2(2). See discussion in *Saint Honore Cake Shop Limited v. Cheung's Bakery Products Ltd.*, 2015 FCA 12 at paras. 21-30 [*Saint Honore*].

119 *Ibid.*, r. 279(b), r. 258(4).

120 *Federal Courts Rule*, 55.2(1)(a).

121 *Ibid.*, r. 258(1).

122 *Ibid.*

123 *Ibid.*, r. 262(1)

124 *Ibid.*, r. 265(2). For what constitutes proper reply evidence, see *Merck-Frosst v. Canada (Minister of Health)*, 2009 FC 914 (F.C.) at paras. 22-23 and 25

125 *Ibid.*, r. 280(3).

126 *Eli Lilly*, *supra*, note 49 at 410.

127 See e.g. British Columbia, *Supreme Court Civil Rules*, r. 11-6(8). See also *Comprehensive Economic and Trade Agreement*, Canada and European Union, agreement in principle signed 18 October 2013, s. 22, art. 15.

128 The Advocates' Society, "Principles Governing Communications with Testifying Experts", Position Paper, June 2014, Principle 7, online: <<http://perma.cc/HTG5-AKGX>>.

- (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, she or they believes his, her or their opinion is the correct one).

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

- (1) a summary of the expert's background, education and experience that qualifies the witness 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, she or they has drawn from them) and a summary of it provided at the beginning of the affidavit or statement.

The Federal Courts Code of Conduct¹²⁹ sets out what should be included in the Expert's report:

- (a) a statement of the issues addressed in the report;
- (b) a description of the qualifications of the expert on the issues addressed in the report;¹³⁰
- (c) the expert's current curriculum vitae attached to the report as a schedule;
- (d) the facts and assumptions on which the opinion in the report are based; in that regard, a letter of instructions, if any, may be attached to the report as a schedule;
- (e) a summary of the opinions expressed;
- (f) in the case of a report that is provided in response to another expert's report, an indication of the points of agreement and of disagreement with the other expert's opinions;
- (g) the reasons for each opinion expressed;
- (h) any literature or other materials specifically relied on in support of the opinions;
- (i) a summary of the methodology used, including any examinations, tests or other investigations on which the report has relied, including details of the qualifications of the person who carried them out, and whether a representative of any other party was present;
- (j) any caveats or qualifications necessary to render the report complete and accurate, including those relating to any insufficiency of data or research and an indication of any matters that fall outside the expert's field of expertise; and
- (k) particulars of any aspect of the expert's relationship with a party to the proceeding or the subject matter of his, her or their proposed evidence that might affect his, her or their duty to the Court.

The expert's affidavit or statement must also be accompanied by a certificate in Form 52.2 signed by the expert acknowledging that the expert has read the Code of Conduct for Expert Witnesses set out in the schedule and agrees to be bound by it.¹³¹ This is most conveniently done by attaching it as the first exhibit to the affidavit or first appendix to a statement.

An expert's statement must be in writing, signed by the expert and accompanied by a solicitor's certificate.¹³²

129 Online: <<http://laws-lois.justice.gc.ca/eng/regulations/SOR-98-106/page-127.html?txthl=conduct+code#sched84>>, para. 3.

130 See also *Federal Courts Rule*, 55.2(1)(b).

131 *Federal Courts Rule*, 55.2(1)(c).

132 *Federal Courts Rule*, 55.2(1)(d).

(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 (U.S. Cal., 1993)) and the Supreme Court of Canada (see *R. v. Mohan*, [1994] 2 S.C.R. 9 (S.C.C.) and *R. c. J. (J.-L.)*, [2000] 2 S.C.R. 600 (S.C.C.)) have held that scientific expert evidence is subjected to special scrutiny to determine whether it meets a basic threshold test 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.

(B) Translating the Evidence into Understandable Form

Expert affidavits or statements should be clear, compelling and aimed at the “right” level. Counsel should understand every point raised, and the technology discussed, in the affidavit, and should challenge the expert on it while the affidavit is being prepared to ensure that it is clear, understandable and accurate.

(C) Assisting the Expert in the Preparation of the Report or Affidavit

In some highly technical areas such as patent law, expert witnesses “require a high level of instruction by the lawyers” which may necessitate “a high degree of consultation” involving “an iterative process through a number of drafts.”¹³³

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.¹³⁴

Likewise, there is nothing wrong with an expert reviewing the draft report with counsel.

This practice has been accepted in Ontario courts,¹³⁵ in the Federal Court,¹³⁶ and in England.¹³⁷

Although early drafts of expert reports are generally protected by litigation privilege, litigation privilege attaching to expert reports is qualified, and disclosure may be required in certain situations, e.g. where there are reasonable grounds to suspect that counsel communicated with an expert witness in a manner likely to interfere with the expert witness’s duties of independence and objectivity.¹³⁸ Production may still be required of the “foundational information” — the facts underlying the expert’s opinion — and any other material relevant to the formulation of the expressed opinion.¹³⁹

It is as important for the witness, as it is for the client’s case, that the witness not be urged to give an opinion with which he, she or they does not fully agree: “partisan expert evidence is almost always exposed as such in cross-examination, which is likely to reduce, if not eliminate, the value of the evidence to the client’s case.”¹⁴⁰

(x) 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

133 *Medimmune Ltd. v. Novartis Pharmaceuticals UK Ltd.*, [2011] EWHC 1669 (Ch. Div. Pat.) at para. 110; quoted with approval in *Moore v. Getahun*, 2015 ONCA 55 (Ont. C.A.) per Sharpe J.A., at para. 55.

134 *Janssen Pharmaceutica Inc. v. Apotex Inc.* (2001), 13 C.P.R. (4th) 410 (F.C.A.) at para. 53, affirming (2000), 5 C.P.R. (4th) 53 (F.C.).

135 *Moore v. Getahun*, 2015 ONCA 55 (Ont. C.A.) per Sharpe J.A.

136 *Eli Lilly & Co. v. Apotex Inc.*, 2009 FC 991 (F.C.) at para. 62, affirmed 2010 CarswellNat 3443 (F.C.A.), leave to appeal refused 2011 CarswellNat 1368 (S.C.C.), additional reasons 2011 CarswellNat 4151 (F.C.); *Fournier Pharma Inc. v. Canada (Minister of Health)*, 2012 FC 740 (F.C.) at paras. 63-64.

137 *Medimmune Ltd. v. Novartis Pharmaceuticals UK Ltd.*, [2011] EWHC 1669 (Ch. Div. Pat.) at paras. 108-111; *Whitehouse v. Jordan* (1980), [1981] 1 W.L.R. 246 (U.K. H.L.) at 256-257.

138 *Moore v. Getahun*, 2015 ONCA 55 (Ont. C.A.) per Sharpe J.A., at paras. 70, 77.

139 *Moore v. Getahun*, 2015 ONCA 55 (Ont. C.A.) per Sharpe J.A., at para. 75.

140 *Medimmune Ltd. v. Novartis Pharmaceuticals UK Ltd.*, [2011] EWHC 1669 (Ch. Div. Pat.) at para. 111; quoted in *Moore v. Getahun*, 2015 ONCA 55 (Ont. C.A.) per Sharpe J.A., at para. 61. See also *Carmen Alfano Family Trust v. Piersanti*, 2012 ONCA 297, 291 O.A.C. 62 (Ont. C.A.) at paras. 106-120, additional reasons 2012 CarswellOnt 7923 (Ont. C.A.), leave to appeal refused 2012 CarswellOnt 13924 (S.C.C.).

they will be, and how and when counsel and the judge will address them, why you cannot ask the witness 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.

(xi) *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, she or they 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, her or their own testimony, and help counsel develop questions for cross-examination. He, she or they 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.

(xii) *Procedure for Expert Witnesses*

(A) Code of Conduct

The Federal Court 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*.¹⁴¹ Counsel must provide the Code of Conduct to the expert and must also file the signed certificate with the Court. Best practice would be to include the certificate signed by the expert as an exhibit to the expert's affidavit. Failure to attach the Certificate Concerning the Code of Conduct for Expert Witnesses to the expert affidavit or report should not be conflated with a failure to comply with the Code of Conduct for Expert Witnesses so as to render an expert affidavit inadmissible.¹⁴²

(B) Blinding

The determination as to whether an invention is obvious is supposed to be made "viewed without any knowledge of the alleged invention as claimed".¹⁴³ Theoretically then, an expert should be blinded as to what is the invention at issue when opining on what would have been obvious to a person of ordinary skill in the art at the relevant date. Likewise, a patent must not be construed with an eye on the allegedly infringing device in respect of infringement or with an eye to the prior art in respect of validity to avoid its effect.¹⁴⁴

"Blinding an expert" is the term used to describe eliciting an opinion from an independent expert witness before he, she or they knows which party has retained them¹⁴⁵ or what is the allegedly infringing product or method so his/her opinion is not end-directed. Blinding is supposed to be analogous to a double-blind test of a pharmaceutical, to determine its efficacy. In theory, by not knowing by whom the expert is retained, the expert will presumably lack a bias towards the retaining party and his, her or their evidence will be more objective than that of a witness who knows for whom they testify.¹⁴⁶

For claim construction, under *Free World*, one of the questions used to determine whether a claim element is non-essential and thus substitutable, is whether, at the date of publication of the patent, the skilled addressees would have appreciated that a particular element could be substituted without affecting the working of the invention; i.e., had the skilled worker at that time been told of both the element specified in the claim and the variant and "asked whether the variant would obviously work in the same way", the answer would be yes.¹⁴⁷ To answer such a question, the expert must be told of the "variant" found in the allegedly infringing article or method.

141 *Federal Courts Rules*, SOR/98-106, r. 52.2(1). See also *Saint Honore*, *supra*, note 118 at paras. 21-30.

142 *Saint Honore*, *supra*, note 118 at para. 24. See *Federal Courts Rule*, 52.2(2) which provides the court with the discretion to exclude some or all of the expert's affidavit or statement if an expert fails to comply with the Code of Conduct for Expert Witnesses.

143 *Sanofi-Synthelabo Canada Inc. v. Apotex Inc.*, 2008 SCC 61, [2008] 3 S.C.R. 265 (S.C.C.) at para. 67.

144 *Whirlpool Corp. v. Camco Inc.* (2000), 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at pp. 148-149, paras. 43 and 49(a), reconsideration / rehearing refused 2001 CarswellNat 283 (S.C.C.); citing *Dableh v. Ontario Hydro* (1996), 68 C.P.R. (3d) 129 (F.C.A.) per Strayer J.A., Linden and Robertson J.J.A. concurring at p. 143, leave to appeal refused 1997 CarswellNat 3240 (S.C.C.); *Rodi & Wienenberger*, [1969] R.P.C. 367 (H.L.) per Lord Upjohn at p. 391(2); *American Cyanamid Co. v. Berk Pharmaceuticals Ltd.* (1973), [1976] R.P.C. 231 (Eng. Ch. Div.) at p. 234; *Pfizer Canada Inc. v. Canada (Minister of Health)* (2005), 46 C.P.R. (4th) 244 (F.C.) per Hughes J. at para. 35, affirmed 2007 CarswellNat 6 (F.C.A.); *Pfizer Canada Inc. v. Canada (Minister of Health)*, 2007 FCA 209, 60 C.P.R. (4th) 81 (F.C.A.) per Nadon J.A., Linden and Sexton J.J.A. concurring at para. 39, leave to appeal refused 2007 CarswellNat 3850 (S.C.C.).

145 An expert who knows who the parties are would of course surmise the positions of the parties. See *Valeant Canada LP/Valeant Canada S.E.C v. Ranbaxy Pharmaceuticals Canada Inc.*, 2018 FC 847, 2018 CarswellNat 4846, 2018 CarswellNat 5255 (F.C.) (Per McVeigh J.) at para. 26.

146 See Robertson, C.T., "Blind Expertise", *NYU Law Review*, Vol. 85, No. 1, April 2010 available at <<http://www.nylawreview.org/sites/default/files/pdf/NYULawReview-85-1-Robertson.pdf>>.

147 *Free World Trust c. Electro Santé Inc.* (2000), 2000 CSC 66, 2000 SCC 66, 2000 CarswellQue 2728, 2000 CarswellQue 2731, [2000] 2 S.C.R. 1024 (S.C.C.) at para. 55.

It would be highly impractical to construe the claims without knowing what specific terms or phrases give rise to interpretive difficulties.¹⁴⁸ Arguments and evidence need to be directed to the point or points in dispute or “where the shoe pinches”.¹⁴⁹ It is acceptable for counsel to focus its expert on the terms needing construction.¹⁵⁰

To some judges, blinding is overrated.¹⁵¹ Blinding is no guarantee of reliability.¹⁵² No party would use an expert who disagreed with their theory of the case and, therefore, no party would present a blinded expert who did not so agree. Each side could hire blinded experts who agreed with both sides, but present at trial only the evidence that favoured its side. If one of those many experts provided the opinion that the party sought and all of the others concluded otherwise, the party would be able to retain the outlier and present the expert as a blinded (and therefore reliable) witness.¹⁵³ Such blinding would only render their opinions less biased than that of a non-blinded witness, but would not make either opinion, or the evidence before the court, necessarily correct.

Blinding is a question of relevance, reliability and weight, not admissibility.¹⁵⁴ Some judges have given greater weight to the evidence of blinded witnesses over that of non-blinded witnesses¹⁵⁵ commenting that the fact that the allegedly infringing substance was disclosed to one expert before they conducted their construction of the claims means their interpretation is to be afforded lesser weight.¹⁵⁶ In some situations, the fact that an expert witness was unaware of the features of an allegedly-infringing product when they formed their opinion on claim construction may be helpful in deciding the weight to be placed on that expert’s opinion. Some judges have not given greater weight to blinded witness evidence, and the favouring the evidence of experts who have been blinded has not been raised to the level of a legal principle that must be applied in all cases, and is merely persuasive.¹⁵⁷

When assessing expert testimony, the logical character of their reasoning is much more important than the fact that some of them were blinded.¹⁵⁸ It is better that the court be mainly interested in the substance of each expert’s opinion and the reasoning that led to that opinion¹⁵⁹ and, for example, which of the experts provided the most compelling evaluations of the common general knowledge held by the POSITA, the state of the art, and other factors in the obviousness analysis.¹⁶⁰

(C) 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.¹⁶¹ If a party objects to the admissibility of expert evidence, it should raise the objection when the evidence is submitted, so that all parties have an opportunity to examine the witness on the admissibility of his, her or their evidence. Raising the issue for the first

148 *Seedlings Life Science Ventures, LLC v. Pfizer Canada ULC*, 2020 FC 1, 2020 CarswellNat 6 (F.C.) (per Grammond J.) at para. 43.

149 *Shire Biochem Inc. v. Canada (Minister of Health)* (2008), 2008 FC 538, 2008 FC 538, 2008 CarswellNat 2815, 2008 CarswellNat 1240, 67 C.P.R. (4th) 94 (F.C. per Hughes J.) at para. 22, quoting Justice Floyd of the England and Wales High Court (Patent Court) in *Qualcomm Incorporated v. Nokia Corporation*, [2008] EWHC 329 (Pat) at paras. 7 to 11, who in turn quoted the late Justice Pumfrey (as he then was) in *Nokia v. Interdigital Technology Corporation*, [2007] EWHC 3077 (Pat), “it is essential to see where the shoe pinches so that one can concentrate on the important points.”

150 *Valeant Canada LP/Valeant Canada S.E.C v. Ranbaxy Pharmaceuticals Canada Inc.*, 2018 CF 847, 2018 FC 847, 2018 CarswellNat 4846, 2018 CarswellNat 5255, 158 C.P.R. (4th) 305 (F.C.) (Per McVeigh J.) at para. 22, citing *Teva Canada Innovation v. Apotex Inc.*, 2014 FC 1070, 2014 FC 1070, 2014 CarswellNat 6535, 2014 CarswellNat 8571 (F.C.) at para. 96, citing *Shire Biochem Inc. v. Canada (Minister of Health)*, 2008 CF 538, 2008 FC 538, 2008 CarswellNat 2815, 2008 CarswellNat 1240 (F.C.) at para. 22.

151 *Janssen Inc. v. Apotex Inc.*, 2019 CF 1355, 2019 FC 1355, 2019 CarswellNat 6085, 2019 CarswellNat 9812 (F.C.) (per Phelan J.) at para. 58.

152 *Shire Canada Inc. v. Apotex Inc.*, 2016 FC 382 (F.C.) per Locke J. at para. 46; *Astrazeneca Canada Inc. v. Mylan Pharmaceuticals ULC*, 2017 FC 142 (F.C.) per Diner J. at para. 77.

153 *Shire Canada Inc. v. Apotex Inc.*, 2016 FC 382 (F.C.) per Locke J. at para. 46; *Bayer Inc. v. Cobalt Pharmaceuticals Co.*, 2016 CF 1013, 2016 FC 1013, 2016 CarswellNat 4323, 2016 CarswellNat 10973 (F.C.) (per Fothergill J.) at para. 66.

154 *Gilead Sciences, Inc. v. Canada (Minister of Health)*, 2016 CF 857, 2016 FC 857, 2016 CarswellNat 4752, 2016 CarswellNat 10953 (F.C.) (per Brown J.) at paras. 56 and 59, *Pfizer Canada Inc. v. Teva Canada Limited*, 2017 CF 777, 2017 FC 777, 2017 CarswellNat 5511, 2017 CarswellNat 8117 (F.C.), affirmed 2019 FCA 15, 2019 CarswellNat 258 (F.C.A.) (Per Brown J.) at para. 244.

155 *Teva Canada Innovation v. Apotex Inc.*, 2014 FC 1070 (F.C.) per Gleason J. at paras. 94-96; *AstraZeneca Canada Inc. v. Apotex Inc.*, 2014 FC 638 (F.C.) per Rennie J. at para. 321, affirmed 2015 CarswellNat 2431 (F.C.A.), reversed 2017 CarswellNat 2988 (S.C.C.); *Takeda Canada Inc. v. Canada (Minister of Health)*, 2015 FC 570 (F.C.) per O’Reilly at para. 29; and *Allergan Inc. v. Apotex Inc.*, 2016 FC 344 (F.C.) per Zinn J. at para. 13.

156 *Teva Canada Innovation v. Apotex Inc.*, 2014 FC 1070 (F.C.) per Gleason J. at para. 95.

157 *Shire Canada Inc. v. Apotex Inc.*, 2016 FC 382 (F.C.) per Locke J. at para. 45. *Shire Canada Inc. v. Apotex Inc.*, 2016 FC 382 (F.C.) per Locke J. at para. 45.

158 *Seedlings Life Science Ventures, LLC v. Pfizer Canada ULC*, 2020 FC 1, 2020 CarswellNat 6 (F.C.) (per Grammond J.) at para. 44.

159 *Shire Canada Inc. v. Apotex Inc.*, 2016 FC 382 (F.C.) per Locke J. at para. 48.

160 *AstraZeneca Canada Inc. v. Mylan Pharmaceuticals ULC*, 2017 CF 142, 2017 FC 142, 2017 CarswellNat 248, 2017 CarswellNat 4172 (F.C.) (per Diner J.) at para. 78.

161 *Federal Courts Rules*, SOR/98-106, r. 52.5(2)(a).

time on appeal may be too late.¹⁶²

(D) 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.¹⁶³ Parties and their counsel have a right to be present during the conference, but may agree to be absent.¹⁶⁴ The Federal Court may in addition order that a judge or prothonotary be present during the conference.¹⁶⁵

The expert witnesses can prepare a joint statement following the conference that would be admissible at trial.¹⁶⁶ 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.¹⁶⁷

(E) 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.¹⁶⁸

(F) Hot-Tubbing

Hot-tubbing involves a panel of expert witnesses giving concurrent testimony at a hearing.¹⁶⁹ It may be ordered at any time during a trial.¹⁷⁰ 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 counsel.¹⁷¹ 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.¹⁷²

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

(G) Deference to the Trial Judge's Findings of Fact Based on Expert Evidence

For an appeal from a decision of the Federal Court sitting as a trial court, the appellate standard of review applies: palpable and overriding error for questions of fact¹⁷³ and questions of mixed fact and law,¹⁷⁴ except for extricable questions of law for which the standard of review is correctness.¹⁷⁵

In *Housen v. Nikolaisen*,¹⁷⁶ the Supreme Court of Canada included the following as one of the three principles forming the basis of why an appellate court should defer to the findings of fact of a trial judge:

The trial judge is better situated to make factual findings owing to his, her or their extensive exposure to the evidence, the advantage of hearing testimony *viva voce*, and the judge's familiarity with the case as a whole. Because the primary role of the trial judge is to weigh and assess voluminous quantities of evidence, the expertise and insight of the trial judge in this area should be respected.¹⁷⁷

The assessment of expert evidence is a question of fact, reviewable on the standard of palpable and overriding error.¹⁷⁸ A court will fall into palpable and overriding error when it comes to a conclusion for which there is no

162 *Apotex Inc. v. Pfizer Canada Inc.*, 2014 FCA 54 (F.C.A.) at paras. 9-11.

163 *Apotex Inc. v. Pfizer Canada Inc.*, 2014 FCA 54 (F.C.A.) at paras. 9-11.

164 *Ibid.*, r. 52.6(2).

165 *Ibid.*, r. 52.6(3).

166 *Ibid.*, r. 52.6(4).

167 *Ibid.*, r. 52.6(4).

168 *Ibid.*, r. 262(2), 263(c)(i).

169 See e.g. *Apotex Inc. v. Astrazeneca Canada Inc.*, 2012 FC 559 (F.C.) at para. 10, affirmed 2013 CarswellNat 496 (F.C.A.)

170 *Federal Courts Rules*, SOR/98-106, r. 282.1.

171 *Ibid.*, r. 282.2(1).

172 *Ibid.*, r. 282.2(2).

173 *Housen v. Nikolaisen*, 2002 SCC 33, [2002] 2 S.C.R. 235 (S.C.C.) at para. 10; *Stein v. "Kathy K" (The)* (1975), [1976] 2 S.C.R. 802 (S.C.C.) at p. 808; *Ingles v. Tutkaluk Construction Ltd.*, [2000] 1 S.C.R. 298, 2000 SCC 12 (S.C.C.) at para. 42; *Ryan v. Victoria (City)*, [1999] 1 S.C.R. 201 (S.C.C.) at para. 57; *Consolboard Inc. v. MacMillan Bloedel (Saskatchewan) Ltd.*, [1981] 1 S.C.R. 504 (S.C.C.) at p. 537.

174 *Ibid.*, *Housen* at para. 28.

175 *Ibid.*, at para. 8.

176 2002 SCC 33, [2002] 2 S.C.R. 235 (S.C.C.).

177 *Ibid.*, at para. 18.

178 *Ciba Specialty Chemicals Water Treatments Limited v. SNF Inc.*, 2017 FCA 225 (F.C.A.) per Pelletier J.A., Rennie & Woods JJ.A.

factual basis, or when its reasoning is illogical or unrelated to the evidence.¹⁷⁹

It is difficult for an appellate court to acquire the familiarity with the evidence which a trial judge has developed over the course of the trial. As a result, it is unwise for an appellate court to interfere with a trial judge's conclusions of fact on the basis of isolated elements of the evidence brought to its attention by counsel, absent palpable and overriding error. These debates seldom occur in a context in which there is no evidence on a given point. They almost always occur where there is conflicting evidence. It is not the appellate court's function, absent exceptional circumstances, to resolve conflicts in the evidence. That is the role of a trial judge and, so long as there is evidence to support the conclusion and the reasoning is sound and anchored in the evidence, the appellate court should not intervene.¹⁸⁰

11.4 NARROWING THE ISSUES BEFORE TRIAL

Where a proceeding is case managed in the Federal Court, a party may request that a trial date be assigned at any point.¹⁸¹ Where a party requests a trial date early in the action, the Court will endeavour, where possible, to have the action tried within two years of its commencement.¹⁸² Otherwise, where a proceeding is not case managed, a trial date is set at the pre-trial conference, discussed below.

(a) Pre-trial Motions

(i) 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 initiative¹⁸³ 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.¹⁸⁴

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.¹⁸⁵

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.¹⁸⁶ Once a bifurcation order has been granted, especially by a case management judge or other person intimately familiar with the action, it will only be interfered with in the clearest of cases.¹⁸⁷

(ii) Summary Judgment

An action can be determined in whole or in part through summary judgment.¹⁸⁸ The Supreme Court of Canada has indicated that summary judgment motions are one way to implement a "culture shift" in order to "create an

concurring at para. 27, citing *Eurocopter c. Bell Helicopter Textron Canada Ltée*, 2013 FCA 219, 120 C.P.R. (4th) 394 (F.C.A.) at para. 74, reconsideration / rehearing refused 2013 CarswellNat 4333 (F.C.A.), *Halford v. Seed Hawk Inc.*, 2006 FCA 275, 54 C.P.R. (4th) 130 (F.C.A.) at para. 11.

179 *Ciba Specialty Chemicals Water Treatments Limited v. SNF Inc.*, 2017 FCA 225 (F.C.A.) per Pelletier J.A., Rennie & Woods J.J.A. concurring at para. 27, citing *Mahjoub v. Canada (Citizenship and Immigration)*, 2017 FCA 157, [2017] F.C.J. No. 726 (F.C.A.) at para. 62, leave to appeal refused *Mohamed Zeki Mahjoub v. Minister of Citizenship and Immigration, et al.*, 2018 CarswellNat 2296 (S.C.C.).

180 *Ciba Specialty Chemicals Water Treatments Limited v. SNF Inc.*, 2017 FCA 225 (F.C.A.) per Pelletier J.A., Rennie & Woods J.J.A. concurring at para. 41.

181 Notice to the Profession, "Streamlining Complex Litigation"; Federal Court, May 1, 2009, p. 2, found at <[http://cas-cdc-www02.cas-satj.gc.ca/ct-cf/pdf/Notice%20-%20streamlining%20complex%20litigation%2001-05-2009%20\(ENG\).pdf](http://cas-cdc-www02.cas-satj.gc.ca/ct-cf/pdf/Notice%20-%20streamlining%20complex%20litigation%2001-05-2009%20(ENG).pdf)>.

182 *Ibid.*

183 *Ibid.*, r. 47.

184 *Merck & Co. v. Brantford Chemicals Inc.*, 2004 FC 1400 (F.C.) at para. 4, affirmed 2005 CarswellNat 1239 (F.C.A.).

185 See also *Apotex Inc. v. Pfizer Canada Inc.*, 2014 FC 159 (F.C.) at paras. 45-70.

186 *Vixx Inc. v. Nidek Co.* (1998), 81 C.P.R. (3d) 572 (F.C.) per Hugessen J.

187 *AbbVie Corp. v. Janssen Inc.*, 2014 FC 178 (F.C.) at para. 7.

188 *Federal Courts Rules*, SOR/98-106, r. 213-219; *Rules of Civil Procedure*, *supra*, note 97, r. 20.

environment promoting timely and affordable access to the civil justice system.”¹⁸⁹ Although the case dealt specifically with the Ontario *Rules of Civil Procedure*, the court indicated that the principles underlying the Ontario rule are of general application.¹⁹⁰ The court held that a summary judgment motion should be viewed as “a legitimate alternative means for adjudicating and resolving legal disputes.”¹⁹¹

Either party may bring a motion for summary judgment relating to all or part of a statement of claim or defence.¹⁹² 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.¹⁹³

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.¹⁹⁴ The moving party bears the onus of establishing that there is no genuine issue for trial.¹⁹⁵ The test is whether the case is so doubtful that it does not deserve consideration by the trier of fact at a future trial.¹⁹⁶ There is no genuine issue for trial if the record (i) allows the judge to make the necessary findings of fact; (ii) allows the judge to apply the law to the facts; and (iii) summary judgment is a proportionate, expeditious and a less expensive way to proceed.¹⁹⁷ Issues of credibility ought not to be decided on motions for summary judgment.¹⁹⁸ The mere existence of apparent conflict in the evidence does not preclude summary judgment; rather, judges should take a hard look at the merits of the case.¹⁹⁹ If the court determines there is a genuine issue for trial, it may choose to determine the issue through a summary trial.²⁰⁰

On a motion for summary judgment, both parties are required to put their best foot forward. A moving party bears the legal onus of establishing all the facts necessary to obtain summary judgment.²⁰¹ 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.²⁰²

This requirement has been described as necessitating that the responding party “lead trump or risk losing”.²⁰³

Where the court is satisfied that there is no genuine issue for trial, it shall grant summary judgment.²⁰⁴ Where it is satisfied that the only issue for trial is the quantum of relief, it may order a trial of that issue or grant summary judgment with a reference under Rule 153 to determine the amount.²⁰⁵ Where it is satisfied that the only issue for trial is a question of law, it may determine the question and grant summary judgment accordingly.²⁰⁶

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.²⁰⁷ In this respect, the *Federal Courts Rules* are broader than the Ontario *Rules of Civil Procedure*. However, in Ontario, unlike in the Federal Court, a judge hearing a summary judgment motion has the power to weigh evidence, evaluate the credibility of a deponent, and draw any reasonable inference from the evidence.²⁰⁸

Where the motion for summary judgment is dismissed in whole or in part, the court may order the action, or

189 *Hryniak v. Mauldin*, 2014 SCC 7 (S.C.C.) at paras. 2-3 [*Hryniak*].

190 *Ibid.*, at para. 35.

191 *Ibid.*, at para. 36. See also *Baghbanbashi v. Hassle Free Clinic*, 2014 ONSC 5934 (Ont. S.C.J.) at para. 20 [*Baghbanbashi*] (“There is no right to a trial in civil litigation in Ontario”). But see *Society of Composers, Authors & Music Publishers of Canada v. Maple Leaf Sports & Entertainment Ltd.*, 2010 FC 731 (F.C.) at para. 15 [*SOCAN*] (“...summary procedures have their limits. Trials are the ways by which true disputes are resolved. People have a right to their day in court to deal with legitimate claims.”) Note that *SOCAN* was released prior to *Hryniak*, whereas *Baghbanbashi* was released after *Hryniak*.

192 *Federal Courts Rules*, SOR/98-106, r. 213(1); *Rules of Civil Procedure*, *supra*, note 97, r. 20.01(1), (3).

193 *Federal Courts Rules*, SOR/98-106, r. 213(1).

194 *DuPont Canada Inc. v. Glopak Inc.* (1998), 81 C.P.R. (3d) 44 (F.C.) per Muldoon J.

195 *Hinton v. Jempak Corporation*, 2020 FC 644 (F.C.) at para. 21.

196 *Hinton v. Jempak Corporation*, 2020 FC 644 (F.C.) at para. 20; *Milano Pizza Ltd. v. 6034799 Canada Inc.*, 2018 FC 1112 (F.C.) at paras. 33 to 40; *Canmar Foods Ltd. and TA Foods Ltd., Re*, 2019 FC 1233 (F.C.) at para. 48; *Garford Pty Ltd. v. Dywidag Systems International Canada Ltd.*, 2010 FC 996 (F.C.) at para. 2, affirmed 2012 FCA 48 (F.C.A.).

197 *Hinton v. Jempak Corporation*, 2020 FC 644 (F.C.) at para. 21.

198 *Hinton v. Jempak Corporation*, 2020 FC 644 (F.C.) at para. 22.

199 *Hinton v. Jempak Corporation*, 2020 FC 644 (F.C.) at para. 22.

200 *Federal Courts Rules*, SOR/98-106, r. 215(3)(a).

201 *Hinton v. Jempak Corporation*, 2020 FC 644 (F.C.) at para. 133.

202 *Ibid.*, r. 214; *Apotex Inc. v. Pfizer Ireland Pharmaceuticals*, 2014 FCA 13 (F.C.A.) at para. 21.

203 *Hinton v. Jempak Corporation*, 2020 FC 644 (F.C.) at para. 23.

204 *Federal Courts Rules*, SOR/98-106, r. 215(1).

205 *Ibid.*, r. 215(2)(a).

206 *Ibid.*, r. 215(2)(b).

207 *Ibid.*, r. 215(3)(a).

208 *Rules of Civil Procedure*, *supra*, note 97, Rule 20.04(2.1).

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.²⁰⁹

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 nature and scope of examinations for discovery (if not yet completed) and prescribing the use of discovery transcripts at trial.²¹⁰

(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. Where a higher court, such as the Supreme Court of Canada, has ruled on the construction of a patent, that ruling is binding on a lower court, which may grant summary judgment on that basis.²¹¹ The court also 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).

In *Canmar Foods Ltd. and TA Foods Ltd., Re*,²¹² for example, the Federal Court granted, on motion by the defendant TA Foods, summary judgment of non-infringement of a patent directed to methods for roasting flax seeds. The patent claim included the steps of “(a) heating the oil seed in a stream of air for less than 2 minutes ...” and “(b) transferring the heated oil seed into an insulated or partially insulated roasting chamber or tower; (c) maintaining the heated oil seed in said roasting chamber or tower without addition of further heat until the roasting process is complete, ...” In support of its motion, TA Foods argued its roasting method did not involve heating flax seeds in a “stream of air” or maintaining the seeds in an “insulated roasting chamber or tower,” features it alleged were essential to the asserted method claims. The Court was satisfied that based on the asserted claims, the disclosure, and the prosecution history, expert evidence was not required to purposively construe the two elements of the claim at issue.²¹³ The Court stated that while there is no determinative test for summary judgment,²¹⁴ in light of the Supreme Court of Canada's decision in *Hryniak v. Mauldin*,²¹⁵ the summary judgment provisions ought to be liberally construed.²¹⁶ The Court further noted that the *Hryniak* decision “resulted in a culture shift and opened the door for a more reasoned approach to the use of summary judgment motions ... summary judgment rules must be interpreted broadly, favouring proportionality and fair access to the affordable, timely and just adjudication of claims.”²¹⁷

Summary judgment of non-infringement was also granted in *Hinton v. Jempak Corporation*,²¹⁸ an action concerning the alleged infringement of patented dishwasher detergent pods. The Court noted as a factor in support of the appropriateness of granting summary judgment the fact that there was no substantial conflict of opinion evidence on the issue of claim construction, the plaintiff having opted not to have its experts opine on the common general knowledge or a proposed construction of the claims.²¹⁹ Rather, the plaintiff took the position that the defendant had not met its burden of establishing non-infringement, and relied on its experts to contradict expert evidence put forward by the defendant regarding the composition of its detergent pods.²²⁰ In this regard, the Court was critical of the plaintiff for electing not to perform tests that would have gone to the heart of the infringement issue despite having samples, methods and expertise available to do so,²²¹ ultimately finding that the plaintiff did not demonstrate the existence of a genuine issue for trial.²²²

(B) Trademark and copyright cases

The court seems to be more willing to grant summary judgment in trademark and copyright cases than in

209 *Federal Courts Rules*, SOR/98-106, r. 215(3)(b).

210 *Ibid.*, r. 218.

211 *Apotex Inc. v. Pfizer Ireland Pharmaceuticals*, 2012 FC 1339 (F.C.) at paras. 30-33, affirmed 2014 FCA 13 (F.C.A.).

212 *Canmar Foods Ltd. and TA Foods Ltd., Re*, 2019 FC 1233 (F.C.) [*Canmar Foods and TA Foods*].

213 *Canmar Foods Ltd. and TA Foods Ltd., Re*, 2019 FC 1233 (F.C.) at para. 81.

214 *Canmar Foods Ltd. and TA Foods Ltd., Re*, 2019 FC 1233 (F.C.) at para. 48.

215 *Hryniak v. Mauldin*, 2014 SCC 7 (S.C.C.).

216 *Hryniak v. Mauldin*, 2014 SCC 7 (S.C.C.) at para. 49.

217 *Hryniak v. Mauldin*, 2014 SCC 7 (S.C.C.) at para. 46.

218 *Hinton v. Jempak Corporation*, 2020 FC 644 (F.C.).

219 *Hinton v. Jempak Corporation*, 2020 FC 644 (F.C.) at paras. 4-5, 134.

220 *Hinton v. Jempak Corporation*, 2020 FC 644 (F.C.) at para. 134.

221 *Hinton v. Jempak Corporation*, 2020 FC 644 (F.C.) at paras. 5, 133-134.

222 *Hinton v. Jempak Corporation*, 2020 FC 644 (F.C.) at para. 135.

patent cases, but only in the clearest of cases (e.g., where the plaintiff's trademark has been copied by the defendant, or where there is clear evidence of copying or no copying).

(iii) *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.²²³ 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.²²⁴

The burden to establish that summary trial is appropriate is on the moving party.²²⁵

There is little jurisprudence under Rule 216(5) of the *Federal Courts Rules* on the timing of when a court may hear argument on the appropriateness of summary trial and decide whether or not a motion for summary trial should proceed. The Federal Court has recognized that the summary trial procedure is to be interpreted with guidance from Rule 9-7 (formerly Rule 18A) of the *British Columbia Supreme Court Civil Rules*,²²⁶ upon which the *Federal Courts Rules* summary trial procedure was modelled.²²⁷ The British Columbia summary trial procedure allows a court to adjourn or dismiss a summary trial on an application heard before or at the same time as the hearing of a summary trial.²²⁸

In *Wenzel*,²²⁹ the Court allowed the plaintiff in a patent infringement action to bring a motion on the appropriateness of summary judgment in advance of the Court hearing the defendants' motion for summary judgment itself,²³⁰ finding that neither summary judgment nor summary trial were appropriate mechanisms to decide the particular issues in dispute.²³¹ In *Mishan*,²³² the Court adjourned *sine die* the plaintiffs' motion for summary trial on the issue of patent infringement and set aside the date scheduled for the summary trial hearing, scheduling instead a conventional trial on patent infringement and validity.²³³ A different approach was taken, however, in *Collins*,²³⁴ wherein the Court stated that where a case is found to be suitable for summary trial, the Court should hear the case on the merits in the same motion,²³⁵ and in *Viiv*,²³⁶ in which the Court held that the right to a summary trial crystallized on the day that the motion was brought, and that the determination of whether a motion for summary trial is appropriate should be made at the summary trial itself rather than in advance.²³⁷

On appeal of the *Viiv* decision, the Federal Court of Appeal observed that the methodology that should be followed when a summary trial motion is brought was "rather unclear".¹⁶ Reversing *Viiv* on whether the right to a summary trial is crystallized with the filing of a motion,¹⁷ the Federal Court of Appeal found that motions to quash or adjourn, although the circumstances would be rare, can be brought,¹⁸ and that the Court can also act on its own

²²³ *Federal Courts Rules*, SOR/98-106, r. 213(1).

²²⁴ *Ibid.*, r. 216(5).

²²⁵ *Teva Canada Ltd. v. Wyeth LLC*, 2011 FC 1169 (F.C.) at para. 35, reversed on other grounds 2012 FCA 141 (F.C.A.), leave to appeal refused 2012 CarswellNat 4650 (S.C.C.); *0871768 B.C. Ltd. v. "Aestival" (The)*, 2014 FC 1047 (F.C.) at para. 59; *Viiv Healthcare Company v. Gilead Sciences Canada, Inc.*, 2020 FC 486 (F.C.) at para. 19.

²²⁶ *Louis Vuitton Malletier S.A. v. Singga Enterprises (Canada) Inc.*, 2011 FC 776 (F.C.) at para. 94; *Wenzel Downhole Tools Ltd. v. National-Oilwell Canada Ltd.*, 2010 FC 966 (F.C.) at para. 34 (per Snider J.); *Driving Alternative Inc. v. Keyz Thankz Inc.*, 2014 FC 559 (F.C.) at para. 36.

²²⁷ See *Louis Vuitton Malletier S.A. v. Singga Enterprises (Canada) Inc.*, 2011 FC 776 (F.C.) at para. 94: "The Regulatory Impact Analysis Statement (which can be used in interpreting the purpose and intended application of regulatory amendments) that accompanied the amendments to current Rules 213 and 216, confirms that the summary trial rules were modelled after Rule 18A of the *British Columbia Rules of Court*. [...] Hence, the British Columbia jurisprudence with respect to Rule 18A is instructive and may be persuasive in consideration of a motion for summary trial under Rule 216 of the *Federal Courts Rules*..."; *Regulatory Impact Analysis Statement*, Canada Gazette Part II, Vol 143, No 6 at 2603; *Supreme Court Rules*, B.C. Reg. 221/90, r. 18A.

²²⁸ *British Columbia Supreme Court Civil Rules*, B.C. Reg. 168/2009, r. 9-7(11).

²²⁹ *Wenzel Downhole Tools Ltd. v. National-Oilwell Canada Ltd.*, 2010 FC 966 (F.C.) [*Wenzel*].

²³⁰ *Wenzel Downhole Tools Ltd. v. National-Oilwell Canada Ltd.*, 2010 FC 966 (F.C.) at paras. 4, 7.

²³¹ *Wenzel Downhole Tools Ltd. v. National-Oilwell Canada Ltd.*, 2010 FC 966 (F.C.) at paras. 32, 38-39.

²³² *E. Mishan Sons, Inc. v. Supertek Canada Inc.*, 2014 FC 326 (F.C.), affirmed 2015 CarswellNat 2881 (F.C.A.) [*Mishan*].

²³³ *E. Mishan Sons Inc. v. Home Depot of Canada Inc et al.*, Doc. T-1112-13, Orders of the Honourable Mr. Justice Hughes dated November 12, 2013 (unpublished) and November 19, 2013 (unpublished).

²³⁴ *Collins v. R.*, 2014 FC 307 (F.C.), affirmed 2015 CarswellNat 6660 (F.C.A.) [*Collins*].

²³⁵ *Collins v. R.*, 2014 FC 307 (F.C.) at para. 41, affirmed 2015 CarswellNat 6660 (F.C.A.).

²³⁶ *Viiv Healthcare Company v. Gilead Sciences Canada, Inc.*, 2020 FC 11 (F.C.) [*Viiv*].

²³⁷ *Viiv Healthcare Company v. Gilead Sciences Canada, Inc.*, 2020 FC 11 (F.C.) at paras. 20 and 26.

¹⁶ *Viiv Healthcare Company v. Gilead Sciences Canada, Inc.*, 2021 FCA 122 (F.C.A.) at para. 12. [*Viiv Appeal*]

¹⁷ *Viiv Appeal*, para. 47.

¹⁸ *Viiv Appeal*, at para. 20.

initiative where the time and expense of a summary trial would be disproportionate to its potential benefit.¹⁹

The Federal Court of Appeal observed that the words “issues ... not suitable for a summary trial” and “assist in the efficient resolution of the action” set out in Rule 216(5) are to be interpreted and applied consistently with the objectives of Rule 3, and pointed to “useful factors” to do so identified in the *Wenzel*,²⁰ *Bosa*²¹ and *Tremblay*²² decisions, as well as the summary provided in the *Milano Pizza*²³ decision.

In *Wenzel*, the Court drew guidance on the factors a court ought to consider from jurisprudence under Rule 9-7 of the *British Columbia Supreme Court Civil Rules*,²³⁸ summarizing the factors as follows:

- the amount involved;
- the complexity of the matter;
- its urgency;
- any prejudice likely to arise by reason of delay;
- the cost of taking the case forward to a conventional trial in relation to the amount involved;
- the course of the proceedings;
- whether the litigation is extensive and the summary trial will take considerable time;
- whether credibility is a critical factor in determining the dispute;
- whether the summary trial may create an unnecessary complexity in resolving the dispute;
- whether the application would result in litigating in slices; and
- any other matters that arise for consideration on this important question.²⁴¹

The inherently complex and technical nature of patent infringement trials and issues has been recognized by the Federal Court as a factor weighing against the appropriateness of summary trial;²⁴² however, summary trial may also be an effective procedure in a patent infringement proceeding in appropriate cases.²⁴³

The summary judgment requirement that parties put their best foot forward at the time of the motion applies equally in the context of summary trial, and an adverse inference may be drawn against a responding party that fails to file responding or rebuttal evidence.²⁴⁴ Supporting materials in the motion record for summary trial can include affidavits, admissions, cross-examination on affidavits, documents produced on discovery, and discovery transcripts.²⁴⁵

In a summary trial, the court may order a deponent or expert witness be cross-examined before the court.²⁴⁶ The court is permitted to draw adverse inferences when parties fail to cross-examine on affidavits or to file rebuttal evidence.²⁴⁷

In hearing a summary trial, 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

¹⁹ *ViiV Appeal*, at paras. 21-25.

²⁰ *Wenzel Downhole Tools Ltd. v. National-Oilwell Canada Ltd.*, 2010 FC 966 (F.C.) at para. 38. [*Wenzel*]

²¹ *Bosa Estate v. Canada (Attorney General)*, 2013 FC 793 (F.C.) at para. 22.

²² *Tremblay v. Orio Canada Inc.*, 2013 FC 109 (F.C.) at para. 24.

²³ *Milano Pizza Ltd. v. 6034799 Canada Inc.*, 2018 FC 1112 at paras. 24-40.

²³⁸ B.C. Reg. 168/2009. *Gichuru v. Pallai*, 2013 BCCA 60 (B.C. C.A.) at para. 30, citing *Inspiration Management Ltd. v. McDermid St. Lawrence Ltd.* (1989), 36 B.C.L.R. (2d) 202 (B.C. C.A.) at para. 47. *Wenzel* at para. 34.

²⁴¹ *Gichuru v. Pallai*, 2013 BCCA 60 (B.C. C.A.) at paras. 30-31, citing *Inspiration Management Ltd. v. McDermid St. Lawrence Ltd.* (1989), 36 B.C.L.R. (2d) 202 (B.C. C.A.) at para. 48 and *Dahl v. Royal Bank*, 2005 BCSC 1263 (B.C. S.C.) at para. 12, affirmed 2006 BCCA 369 (B.C. C.A.); *Wenzel Downhole Tools Ltd. v. National-Oilwell Canada Ltd.*, 2010 FC 966 (F.C.) at paras. 36-37; *ViiV Healthcare Company v. Gilead Sciences Canada, Inc.*, 2020 FC 486 (F.C.) at para. 11.

²⁴² *Wenzel Downhole Tools Ltd. v. National-Oilwell Canada Ltd.*, 2010 FC 966 (F.C.) at para. 38.

²⁴³ *Wenzel Downhole Tools Ltd. v. National-Oilwell Canada Ltd.*, 2010 FC 966 (F.C.) at para. 39. See also *Cascade Corp. v. Kinshofer GmbH*, 2016 FC 1117 (F.C.), in which a patent infringement action proceeded by way of summary trial on consent of the parties, and *ViiV Healthcare Company v. Gilead Sciences Canada, Inc.*, 2020 FC 486 (F.C.), which is believed to be the first contested summary trial of issues of claim construction and patent infringement.

²⁴⁴ *0871768 B.C. Ltd. v. “Aestival” (The)*, 2014 FC 1047 (F.C.) at para. 62.

²⁴⁵ *Ibid.*, r. 216(1).

²⁴⁶ *Ibid.*, r. 216(3).

²⁴⁷ *Ibid.*, r. 216(4).

even if the amounts at issue are large and the issues complex.²⁴⁸ Where there is a “genuine issue of fact or law for trial with respect to a claim or defence”, a Court may “nevertheless determine that issue by way of summary trial”.²⁴ Judges can decide issues at summary trial that require resolving conflicting evidence²⁴⁹ and, notably, assessing witness credibility.²⁵

If the court is satisfied that there is sufficient evidence for adjudication, regardless of the amounts involved, the complexities of the issues and the existence of conflicting evidence, the court may grant judgment, either generally or on an issue, unless it would be unjust to do so.²⁵⁰

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.²⁵¹ 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.²⁵²

(A) Patent cases

In *Wenzel*, as noted above, the Court recognized several factors that weigh against directing parties towards a summary trial on claim construction and patent infringement, including, in particular, the inherently complex and technical nature of patent litigation, noting that such complexity is a factor to be considered in determining whether a summary trial should proceed.²⁵⁴ The Court further noted that issues such as claim construction typically require review by expert witnesses to assist the Court in arriving at a construction, and contradictory evidence is often presented on that subject.²⁵⁵

Summary trial may, however, be an effective procedure for determining issues of claim construction and patent infringement in appropriate cases.²⁵⁶ In *Cascade Corp. v. Kinshofer GmbH*,²⁵⁷ for example, a patent infringement action concerning the alleged infringement of patented “quick hitch” couplers, the parties mutually sought determination of construction and infringement issues by way of summary trial.²⁵⁸ The Court agreed that the particular construction issues in dispute were suitable for adjudication by summary trial, noting that it was assisted by expert evidence in reaching its conclusion on the appropriate construction of the asserted claims,²⁵⁹ which resulted in a finding of non-infringement.

In *Viiv*,²⁶⁰ the defendant in a pharmaceutical patent infringement (and, by counterclaim, invalidity) action brought a motion for summary trial on the construction of a feature of the asserted claims, and sought a declaration of non-infringement.

The Court found that it was appropriate to determine these issues on a summary trial, noting that summary trial need not be reserved for cases where summary trial will result in a determination of every issue, and that the Court may grant judgment, either generally or on an issue, if it is satisfied there is sufficient evidence for adjudication, regardless of the amounts involved, the complexities of the issues and the existence of conflicting evidence, unless it would be unjust to do so.²⁶¹ The Court further found that it had all the necessary expert evidence to construe the claim feature at issue and determine infringement, noting that collectively the parties put forward five expert witnesses who were all cross-examined on their reports during the summary trial,²⁶² and that summary trial may be dispositive of the action and would result in efficiencies in any event at a trial of the remaining construction and validity issues.²⁶³ In the result, the Court granted judgment of non-infringement in favour of the defendant and

248 *Ibid.*, r. 216(6).

24 *ViiV Appeal*, para. 34.

249 *Ibid.*

25 *Ark Innovation Technology Inc. v. Matidor Technologies Inc.*, 2021 FC 1336 (F.C.) at para. 19.

250 *Federal Courts Rules*, SOR-98/106, r. 216(6).

251 *Ibid.*, r. 216(7).

252 *Ibid.*, r. 216(8).

254 *Wenzel Downhole Tools Ltd. v. National-Oilwell Canada Ltd.*, 2010 FC 966 (F.C.) at para. 38.

255 *Wenzel Downhole Tools Ltd. v. National-Oilwell Canada Ltd.*, 2010 FC 966 (F.C.) at para. 38.

256 *Wenzel Downhole Tools Ltd. v. National-Oilwell Canada Ltd.*, 2010 FC 966 (F.C.) at para. 39. See also *Cascade Corp. v. Kinshofer GmbH*, 2016 FC 1117 (F.C.), in which a patent infringement action proceeded by way of summary trial on consent of the parties, and *Viiv Healthcare Company v. Gilead Sciences Canada, Inc.*, 2020 FC 486 (F.C.), which is believed to be the first contested summary trial of issues of claim construction and patent infringement (the decision is currently under appeal).

257 *Cascade Corp. v. Kinshofer GmbH*, 2016 FC 1117 (F.C.)

258 *Cascade Corp. v. Kinshofer GmbH*, 2016 FC 1117 (F.C.) at para. 3.

259 *Cascade Corp. v. Kinshofer GmbH*, 2016 FC 1117 (F.C.) at paras. 4-5.

260 2020 FC 486 (F.C.).

261 *Viiv Healthcare Company v. Gilead Sciences Canada, Inc.*, 2020 FC 486 (F.C.) at paras. 12-13.

262 *Viiv Healthcare Company v. Gilead Sciences Canada, Inc.*, 2020 FC 486 (F.C.) at para. 14.

263 *Viiv Healthcare Company v. Gilead Sciences Canada, Inc.*, 2020 FC 486 (F.C.) at para. 17.

dismissed the plaintiffs' action.²⁶⁴ In the *ViiV Appeal*, although the Federal Court of Appeal found the Federal Court "incorrect" on the question of whether motions to quash or adjourn are available,²⁶ the Court did not see ViiV's submissions on the application of the three summary trial principles the Federal Court of Appeal had discussed – the *Federal Courts Rules* and the Court's plenary power, that litigation before the Federal Court is party-run, and the centrality of Rule 3²⁷ – as identifying an extricable legal question on which the Federal Court had erred.²⁸ The Federal Court of Appeal did not reverse the Federal Court on the application of the principles.

(B) Trademark and copyright cases

As noted above in relation to summary judgment, the court seems to be more willing to decide issues summarily in trademark and copyright cases than in patent cases, provided that issues are not overly complex and proceeding by summary trial would result in the expeditious resolution of the action.

(iv) *Settlement Discussions*

The parties in Federal Court actions are required to hold settlement discussions.²⁶⁵ 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.²⁶⁶

(v) *Pre-Trial Conference*

A pre-trial conference is mandatory in all actions proceeding to trial in the Federal Court, and in all actions that are case managed in the Ontario Superior Court of Justice. In Ontario Court actions that are not 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

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;²⁶⁷
2. all examinations for discovery that the party intends to conduct have been completed;²⁶⁸
3. the requisitioning party is not in default;²⁶⁹
4. the requisitioning party is ready for trial;²⁷⁰ and
5. the parties have discussed the possibility of settlement.²⁷¹

The requisitioning party must serve and file:

1. a requisition for a pre-trial conference;²⁷²
2. its pre-trial conference memorandum;²⁷³ and
3. a copy of the documents that may be of assistance in settling the action, including all affidavits or statements of expert witnesses.²⁷⁴

²⁶⁴ The decision in *Viiv Healthcare Company v. Gilead Sciences Canada, Inc.*, 2020 FC 486 (F.C.) is currently under appeal.

²⁶ *ViiV Appeal*, para. 47.

²⁷ *ViiV Appeal*, paras. 16-18.

²⁸ *ViiV Appeal*, para. 45.

²⁶⁵ *Ibid.*, r. 257.

²⁶⁶ *Ibid.*, r. 258(2)(b).

²⁶⁷ *Ibid.*, r. 258(1).

²⁶⁸ *Ibid.*, r. 258(2)(a).

²⁶⁹ *Ibid.*, r. 258(1).

²⁷⁰ *Ibid.*

²⁷¹ *Ibid.*, r. 258(2)(b).

²⁷² *Ibid.*, r. 258(1) and Form 258.

²⁷³ *Ibid.*, r. 258(1).

²⁷⁴ *Ibid.*, r. 258(4).

The court may order that a pre-trial conference be held in accordance with the Rules, with such modifications as are necessary.²⁷⁵

Where a pre-trial conference has not been requisitioned within 360 days of the issuance of the statement of claim, the court shall order that the action continue as a specially managed proceeding under Rule 380 of the *Federal Courts Rules*.

In Ontario Court actions, unless the court orders otherwise, the parties must schedule a pre-trial conference within 180 days after the action is set down for trial.²⁷⁶ If they do not, the Registrar will schedule a pre-trial conference.²⁷⁷

At least 5 days before the pre-trial conference, each party must deliver a pre-trial conference brief.²⁷⁸ Each party's brief must contain concise statements, without argument, regarding:

1. the nature of the proceedings;
2. the issues raised and the party's position;
3. in the case of an action, the names of the witnesses that the party is likely to call at the trial and the length of time that the evidence of each of those witnesses is estimated to take;
4. the steps that need to be completed before the action is ready for trial or the application is ready to be heard, and the length of time that it is estimated that the completion of those steps will take.

(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 within thirty days after being served with the requisition.²⁷⁹

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

The Rules²⁸⁰ 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 may be 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

²⁷⁵ *Ibid.*, r. 315.

²⁷⁶ *Rules of Civil Procedure*, *supra*, note 97, r. 50.02(1).

²⁷⁷ *Ibid.*, r. 50.02(2).

²⁷⁸ *Ibid.*, r. 50.04.

²⁷⁹ *Federal Courts Rules*, SOR/98-106, r. 262(1).

²⁸⁰ *Ibid.*, r. 263; *Rules of Civil Procedure*, *supra*, note 97, r. 50.06.

action.²⁸¹ 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.²⁸² In Federal Court actions, the judge who conducts a pre-trial conference cannot preside at the trial of the action unless all parties consent.²⁸³

In the Federal Court, a trial date, if not already ordered, is obtained at a pre-trial conference.²⁸⁴ The judge or prothonotary conducting the pre-trial conference shall, at that conference, fix the date and place for trial.²⁸⁵ In Ontario Court actions, the presiding judge or case management master at the pre-trial conference may fix a date for the trial, subject to the direction of the regional senior judge or a judge designated by the regional senior judge.²⁸⁶

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.²⁸⁷ In the Ontario Court, the lawyers for the parties must appear at the pre-trial conference, and unless the presiding judge or case management master orders otherwise, the parties must participate by personal attendance or by telephone or video conference.²⁸⁸

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 or report made at the conclusion of the pre-trial conference or as consented to by the parties.²⁸⁹

(vi) *Trial Management Conference*

Trial management conferences were introduced with the *Federal Courts Rules* in 1998. 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 Rule 3 general principle of securing the just, most efficient and least expensive determination of every proceeding.²⁹⁰ Rule 270 was introduced at the same time that the broader case management and dispute resolution services were implemented in the *Federal Courts Rules*.²⁹¹ 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.²⁹²

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

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.²⁹³

(b) Requests to Admit

(i) *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.²⁹⁴ A party receiving such a request is deemed to admit the facts or authenticity of the documents unless he, she, they or it 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 Requests to Admit: (1) a party is 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 set out the grounds for denying the admission.²⁹⁵

281 *Ibid.*, r. 50.10(1).

282 *Ibid.*, r. 50.10(2).

283 *Federal Courts Rules*, SOR/98-106, r. 266.

284 *Ibid.*, r. 264.

285 *Ibid.*

286 *Rules of Civil Procedure*, *supra*, note 97, r. 50.07(1).

287 *Federal Courts Rules*, SOR/98-106, r. 260.

288 *Rules of Civil Procedure*, *supra*, note 97, r. 50.05(1).

289 *Ibid.*, r. 50.09; *Federal Courts Rules*, SOR/98-106, r. 267.

290 *Ibid.*, r. 3.

291 *Ibid.*, Part 9.

292 *Ibid.*, r. 266.

293 *Rules of Civil Procedure*, *supra*, note 97, r. 50.10(2).

294 *Federal Courts Rules*, SOR/98-106, r. 255.

295 *Federal Courts Rules*, SOR/98-106, r. 256.

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 Request to Admit except for the most obvious ones. Although the court has the discretion to award costs against any party that refuses to admit any facts in response to a Request to Admit that should have been admitted,²⁹⁶ this discretion seems to be rarely exercised.²⁹⁷ Requests 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.²⁹⁸

The reply to a request to admit facts, as well as the request 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.²⁹⁹

(ii) 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.³⁰⁰

(c) 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.

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.

2017 Notice to the Parties and the Profession: Trial Management Guidelines

In April 2017, the Chief Justice of the Federal Court of Canada released a Notice to the Parties and the Profession regarding Trial Management Guidelines for actions scheduled for trials of five days or longer.³⁰¹ The Notice contains guidelines as to when certain steps should be completed before trial. It is meant to be a template that can be modified to suit the particular circumstances of each case. The Notice is summarized in the table below with respect to when a particular step should be completed before trial (e.g., T [for Trial] minus 3 weeks, means the step is to be completed before three weeks before trial).

Deadline	Event	Guideline #
Earlier in proceeding	Exchange expert report(s) in chief and expert qualifications (Plaintiff as to construction and infringement; Defendant as to construction and validity)	
Earlier of: within 30 days of service or T-30 days	Objections to expert reports or expert qualifications, pursuant to Rules 52 and 262(2), must be made to case management judge within 30 days of service of the reports	4
Earlier in proceeding	Exchange expert rebuttal report(s) and expert qualifications	
Earlier of: within	Objections to expert reports or expert qualifications, pursuant to Rules 52 and	4

296 *Federal Courts Rules*, SOR/98-106, r. 400(3)(j). See also *Rules of Civil Procedure*, *supra*, note 97, r. 51.04.

297 But see *Dimplex North America Ltd. v. CFM Corp.*, 2006 FC 1403 (F.C.) at para. 27.

298 *Canderel Ltd. v. R.* (1993), [1994] 1 F.C. 3 (F.C.A.).

299 *Rules of Civil Procedure*, *supra*, note 97, r. 51.06.

300 *Federal Courts Rules*, SOR/98-106, r. 232.

301 <[http://cas-cdc-www02.cas-satj.gc.ca/fct-cf/pdf/Trial_management_guideline-s_270417_eng\(with COA\).pdf](http://cas-cdc-www02.cas-satj.gc.ca/fct-cf/pdf/Trial_management_guideline-s_270417_eng(with COA).pdf)>.

30 days of service or T-30 days	262(2), must be made to case management judge within 30 days of service of the reports	
Earlier in proceeding	Requisition Trial Management Conference <ul style="list-style-type: none"> • Include proposed agenda for trial management conference • Identify and propose timing of any motions that need to be brought before the case management judge or trial judge 	2
Prior to trial mgmt. conference	Advise the Registry at the time of filing whether the trial judge may have access to their pre-trial conference memorandum, or portions thereof	10
T-2 months	Trial Management Conference <ul style="list-style-type: none"> • Establish hours of sitting during trial day, breaks, holidays, etc. • Canvass timing of closing arguments • Consider any special equipment or facilities needed for trial 	2 2 19 17
T-2 months or ASAP	Parties to bring motions for commission evidence, if any	3
T-60 days	Motions brought after this date require leave of the case management judge or the trial judge	1
T-3 weeks	Requisition any equipment or facilities needed for trial, if not raised in pre-trial conference	17
T-2 weeks	Exchange:	15
	<ul style="list-style-type: none"> • Proposed witness lists • Description of proposed areas of testimony of fact witnesses • Proposed discovery read-ins 	15 14
T-2 weeks	Submit to Court (subject to trial judge's discretion otherwise): <ul style="list-style-type: none"> • Expert reports to be relied upon • Joint Statement of Issues • List of issues that remain in dispute • For issues upon which agreement cannot be reached, parties are to submit their own statements • Proposed schedule for trial proceedings, including: <ul style="list-style-type: none"> o Opening statements o Order and estimated duration of witness testimony 	5 8 5 8 11
T-1 week	Submit to Court: <ul style="list-style-type: none"> • Joint Book of Documents • Agreed Statements of Facts • Admissions on Authenticity 	9
Set by trial judge	Deliver joint primer on pertinent technology, if deemed necessary by trial judge	18
Before trial	Identify any evidence in expert report or of a fact witness that is considered confidential and not to be admitted on the public record, so that such evidence can be admitted accordingly	12
T-0	Trial (5 or more days) in Federal Court	

11.5 MATERIALS FOR TRIAL

(a) Preparing Trial Briefs

(i) 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 of the *Federal Courts Rules*, and is a subject to be discussed at the pre-trial conference.³⁰²

Rule 48 of the *Rules of Civil Procedure* sets 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.³⁰³

The trial record must contain a copy of the items listed in 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 Rule 48.04(2)(b), and may deliver a request to admit facts or documents. Undefended actions are placed on a trial list on the filing of a trial record.³⁰⁴ 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.³⁰⁵

(ii) Counsel's Trial Book

Counsel should start preparing his, her or their 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, trademark 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.

(iii) 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.

(iv) 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:

³⁰² *Ibid.*, r. 263(m).

³⁰³ *Rules of Civil Procedure*, *supra*, note 97, r. 48.01 and r. 48.02.

³⁰⁴ *Ibid.*, r. 48.05.

³⁰⁵ *Ibid.*, r. 48.06.

1. party may read in the discovery of an adverse party as its own evidence, whether or not the adverse party has testified yet.³⁰⁶

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 omitted³⁰⁷ to ensure that the answers to questions fairly reflect the true response given; whether the additional material showed either that the witness did not understand the particular question or that the portion being read in was misleading in the sense of suggesting that the witness, at that point, was saying one thing when in fact he/she was saying another.³⁰⁸ Qualifying read-ins were permitted: (i) where the witness misunderstood something in the question put to him; (ii) where the passage read-in by the plaintiffs misrepresented what the witness was saying; or (iii) where the passage read-in by the plaintiffs lacked necessary context or subject matter.³⁰⁹ The purpose of this latter rule is to ensure that evidence read-in at trial is in the proper 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.³¹⁰

A party has a right to correct its discovery answers. That must include the right to supercede its original answers. To omit the corrections would misrepresent what the party actually answered in the end.³¹¹

Answers that were hearsay and that were not required for context were excluded from read-ins.³¹²

The party requesting additions to read-ins has the option of calling the witness to explain, clarify or amplify the read-ins.³¹³

2. a party can use the discovery of a person as evidence where that person is unavailable for trial.³¹⁴

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.³¹⁵

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.³¹⁶

Information objected to on discovery cannot be used at trial by the objecting party.³¹⁷

(v) *Preparation of the Trial Memorandum*

Rule 70 of the *Federal Courts Rules* 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, her or their reasons if he, she or they 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

306 *Federal Courts Rules*, SOR/98-106, r. 288.

307 *Ibid.*, r. 289.

308 *Weatherford Artificial Lift Systems Canada Ltd. v. Corlac Inc.*, 2009 FC 449 (F.C.) per Phelan J. at paras. 2-3 citing *Canada (Minister of Citizenship & Immigration) v. Fast*, 2002 FCT 542 (F.C.) per Pelletier J.

309 *Mediatube Corp. v. Bell Canada*, 2016 FC 1066 (F.C.) per Locke J. at para. 8.

310 *Foote v. Royal Columbian Hospital* (1982), 29 C.P.C. 94 (B.C. S.C.) at 98, per McEachern C.J., followed in *Almecon Industries Ltd. v. Anchortek Ltd.*, 2001 FCT 1404, 17 C.P.R. (4th) 74 (F.C.) per Gibson J., affirmed 2003 CarswellNat 975 (F.C.A.).

311 *Mediatube Corp. v. Bell Canada*, 2016 FC 1066 (F.C.) per Locke J. at para. 12.

312 *Excalibre Oil Tools Ltd. v. Advantage Products Inc.*, 2016 FC 1130 (F.C.) per Manson J. at para. 9(iii).

313 *Weatherford Artificial Lift Systems Canada Ltd. v. Corlac Inc.*, 2009 FC 449 (F.C.) per Phelan J. at para. 5.

314 *Federal Courts Rules*, SOR/98-106, r. 290.

315 *Ibid.*, r. 291.

316 *Ibid.*, r. 239(6).

317 *Ibid.*, r. 248.

advance. Evidence from expert's affidavits and factual evidence you intend to lead can also be incorporated into the trial memorandum before trial, and be supplemented and revised as the trial proceeds.

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 working 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, if not earlier. Therefore, a trial memorandum should be worked on throughout the trial to be ready for delivery to the court and the other side when required by the judge.

(vi) *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. Increasingly, judges are favouring the filing of electronic copies of authorities, with pinpoints to the specific passages relied upon.

The Federal Court has made available online a list of cases commonly cited in patent and trademark litigation. Authorities included in this list are deemed to be included in the book of authorities prepared by a party pursuant to Rule 70 of the *Federal Courts Rules*.³¹⁸ For proceedings in the Federal Court, a party is not required to include these authorities in the party's book of authorities. However, if a party intends to refer to one of these authorities, the passage to be relied upon should be included. Furthermore, when citing these authorities within Court documents, parties should provide a citation to the Common List (e.g., CLA Vol.1, Part A, Tab 7). The Common List is updated regularly and further volumes may be added to the List.³¹⁹

(vii) *Co-ordinating Matters with the Registrar*

Occasionally, a party may have to set up special equipment in the courtroom 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.

The Federal Court has set out a Strategic Plan that envisions technology-enabled courtrooms, including cabling and network connectivity for computer equipment, videoconferencing, evidence display, digital audio recording and internet access.³²⁰ These services, as well as an e-trial software system, discussed below, are available in some courtrooms on a case-by-case basis upon request. The e-trial software system is a helpful addition to in-courtroom document management, including exhibit marking; parties should train and become familiar with the system in their pre-trial preparation.

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 trial team meetings at scheduled breaks or for witness preparation during trial.

(viii) *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

318 Amended Notice to the Parties and the Profession re Common List of Authorities dated October 15, 2015 available at <[http://cas-cdc-ww02.cas-satj.gc.ca/fct-cf/pdf/Notice to Parties re Common List of Authorities October \(amended Oct 2015-2015\).pdf](http://cas-cdc-ww02.cas-satj.gc.ca/fct-cf/pdf/Notice%20to%20Parties%20re%20Common%20List%20of%20Authorities%20October%20(amended%20Oct%202015-2015).pdf)>.

319 *Ibid.*

320 Federal Court, "Strategic Plan (2014-2019)", online: <<http://perma.cc/FVH4-NB7M>>.

- one copy for the judge's law clerk
- one copy for the Court Reporter (so he, she or they 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

(a) 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, she or they 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 neighbors 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 led 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 and 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 submissions 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 trial³²¹ 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	2. The defendant ROCHE has no knowledge as to the allegations made in paragraphs 1 and 2 of the Amended	What is the corporate status and address of JANSSEN-ORTHO?

321 *Kirin-Amgen Inc. v. Hoffmann-La Roche Ltd. / Hoffmann-La Roche Ltée* (1999), 87 C.P.R. (3d) 1 (F.C.) per Reed J., affirmed 2000 CarswellNat 3187 (F.C.A.).

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.	Statement of Claim, and, therefore, denies them.	
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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. 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 trademark registration, industrial design registration or copyright registration. Because they are certified, they can be made exhibits without further proof³²² 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 trademark 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, she or they 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, her or their mind while hearing the plaintiff present its case.

(b) Late-Produced Evidence/Amendment to Pleadings

Relevant documents are supposed to be produced in a timely fashion and be referred to in an updated affidavit of documents.³²³ The purpose of this rule is to record their disclosure to the other side.³²⁴ Documents that have not been disclosed in another party’s affidavit of documents cannot be entered into evidence unless otherwise ordered by the court.³²⁵

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.³²⁶ 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.³²⁷

Amending pleadings to reference new prior art in a patent case may be allowed, even on the eve of trial.³²⁸ A court will consider the timeliness of the motion to amend, the extent to which the proposed amendments would delay a trial, and the extent to which a position taken by the party seeking the amendment would require the other party to change its position.³²⁹ A party seeking to amend must also show that any injustice to the other party is capable of being compensated by costs, and that the interests of justice would be served.³³⁰ No single factor is determinative.³³¹

To determine whether to allow leave to present further evidence after evidence at trial is closed, but before

322 *Copyright Act*, *supra*, note 39, s. 53; *Canada Evidence Act*, *supra*, note 1, s. 24.

323 *Federal Courts Rules*, SOR/98-106, r. 226(1).

324 *Halford v. Seed Hawk Inc.* (2001), 16 C.P.R. (4th) 204 (F.C.) at para. 4, per Pelletier J.

325 *Federal Courts Rules*, SOR/98-106, r. 232(1).

326 *Halford v. Seed Hawk Inc.* (2001), 16 C.P.R. (4th) 204 (F.C.) at para. 6, per Pelletier J.

327 *Ibid.*, at para. 12.

328 *AbbVie Corp. v. Janssen Inc.*, 2014 FCA 242 (F.C.A.) [Janssen].

329 *Ibid.*, at para. 3, citing *Continental Bank Leasing Corp. v. R.*, 1993 CarswellNat 882, [1993] T.C.J. No. 18 (T.C.C.).

330 *Janssen*, *supra*, note 328 at para. 9, citing *Sanofi-Aventis Canada Inc. v. Teva Canada Ltd.*, 2014 FCA 65 (F.C.A.) at para. 15.

331 *Janssen*, *supra*, note 328 at para. 18.

argument, the Federal Court has considered the following factors: relevance, necessity, reliability, due diligence and prejudice.³³²

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 and cautiously) to re-open the trial to hear the new evidence.³³³ 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?³³⁴
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.³³⁵ 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.³³⁶

For example, a request to amend a “non-infringing alternative” defence in a patent case to allege that Apomeprazole itself was a non-infringing alternative, after the evidence was completed at trial, but before the argument began, was refused. When evidence has been shaped and strategic choices made in response to a pleaded defence, the Court was not prepared to assume that the raising of a new and distinct issue at the very end of a lengthy trial would be effectively benign. The Court held that to permit this amendment would renew the fight on an entirely different front.³³⁷

The correction of a palpable error is not a recognized reason to re-open a matter.³³⁸

(c) Examination in Chief and Cross-Examination

(i) 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 the witness in chief, from badgering or excessive behaviour by opposing counsel, although a properly prepared witness should be allowed considerable leeway to defend themselves.

(ii) 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, she or they has the various qualifications, honors and awards referred to in his, her or their resume. Counsel should then ask the judge to rule that the expert is qualified to give expert opinion evidence in this case on the particular issues (it is usually helpful to have prepared in advance a specific statement of qualification to be provided to the judge if requested). The judge will then give opposing counsel the opportunity to admit that the witness is an expert or to cross-examine the witness 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 the witness read the affidavit or statement into evidence and explaining what has been read.³³⁹ 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.³⁴⁰

Deeming the expert witness’ affidavit into evidence does not give that evidence any more weight than it would

332 *Sanofi-Aventis Canada Inc. v. Apotex Inc.*, 2009 FC 294 (F.C.) at para. 8.

333 *Varco Canada Ltd. v. Pason Systems Corp.*, 2011 FC 467 (F.C.) at para. 15, per Phelan J. [*Varco 2011*].

334 *Ibid.*, at paras. 16 & 17, citing *671122 Ontario Ltd. v. Sagaz Industries Canada Inc.*, 2001 SCC 59, [2001] 2 S.C.R. 983 (S.C.C.), reconsideration / rehearing refused 2001 CarswellOnt 4155 (S.C.C.).

335 *Varco 2011*, *supra*, note 333 at para. 20.

336 *Ibid.*, at para. 22.

337 *Astrazeneca Canada Inc. v. Apotex Inc.*, 2017 FC 378 (F.C.) per Barnes J. at paras. 14, 18 and 19.

338 *Canadian Assn. of Film Distributors and Exporters v. Society for Reproduction Rights of Authors, Composers and Publishers in Canada (SODRAC) Inc.*, 2014 FCA 235 (F.C.A.) at para. 69.

339 *Federal Courts Rules*, SOR/98-106, r. 280(1).

340 *Ibid.*, r. 280(2).

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 must be approached with preparation and caution.

The credibility of a witness can be damaged if he, she or they 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 the opinions of both side's experts will inevitably diverge, 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, she or they is bound by the laws of physics, chemistry, biology and the like. The scientific laws can be used to direct and constrain the position of the expert because it is, in his, her or their 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 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 in the court as the only valid answer (in which case, counsel wins because the witness has shown that he, she or they 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, her or their 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, she or they 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.

(d) Evidence and Hearsay

Before a court can rely on the evidence put before it, it first must determine its admissibility.³⁴¹ The trend towards flexibility in the admission of evidence has not undermined the need for a rigorous approach to admissibility.³⁴² The starting point is relevance — does the evidence logically tend to prove a point in issue.³⁴³

Hearsay evidence is, however, an exception to the general principle that relevant evidence is to be admitted. Oral or written evidence is hearsay when it is being tendered for the purposes of establishing the truth of a statement made or uttered by another. Hearsay evidence is presumptively inadmissible.³⁴⁴

For hearsay to be admissible under the principled exception to the hearsay rule (the principled approach), the party putting forward the hearsay — the proponent — must establish that the evidence is both necessary and

³⁴¹ *Pfizer Canada Inc. v. Teva Canada Limited*, 2016 FCA 161 (F.C.A.) at para. 84.

³⁴² *R. v. Khelawon*, 2006 SCC 57 (S.C.C.) at para. 59.

³⁴³ *Pfizer Canada Inc. v. Teva Canada Limited*, 2016 FCA 161 (F.C.A.) at para. 85.

³⁴⁴ *Pfizer Canada Inc. v. Teva Canada Limited*, 2016 FCA 161 (F.C.A.) at para. 87.

reliable.³⁴⁵

(e) Demonstrative Evidence

Under Rule 287 of the *Federal Courts Rules*, 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 the judge 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 trademark 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/their 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 rules under the *Rules of Civil Procedure* 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 documents³⁴⁶ and require expert reports to be filed before trial (90 days before the pre-trial conference in the Ontario Superior Court of Justice).³⁴⁷ However, unlike the *Federal Courts Rules*, there is no specific provision in the *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 may 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.

(f) Written Communications with the Canadian Patent Office

Before 2018, and following the Supreme Court of Canada's decision in *Free World Trust v. Électro Santé Inc.*, the use of extrinsic evidence as to statements or admissions made in the course of patent prosecution — e.g., the patent prosecution file history — was considered inadmissible.³⁴⁸

In 2018, the *Patent Act* was amended to allow for the use of certain extrinsic evidence in the construction of a patent. Section 53.1 permits the admission of a written communication, or any part thereof, of a Canadian³⁴⁹ patent application prosecution file history to rebut any patentee representation as to the construction of a patent claim if:

- the communication was prepared in respect of the application prosecution, a patent disclaimer or a patent re-examination request; and

345 *R. v. Khelawon*, 2006 SCC 57 (S.C.C.) at paras. 2, 93; *Pfizer Canada Inc. v. Teva Canada Limited*, 2016 FCA 161 (F.C.A.) at para. 118.

346 *Rules of Civil Procedure*, *supra*, note 97, r. 30.01(1)(a).

347 *Ibid.*, r. 53.03(1).

348 *Free World Trust c. Électro Santé Inc.*, [2000] 2 S.C.R. 1024 (S.C.C.), at para. 66. *Hinton v. Jempak Corporation*, 2020 FC 644 (F.C.), at para. 81. *Canmar Foods Ltd. v. and TA Foods Ltd., Re*, 2019 FC 1233 (F.C.) at paras. 58 and 59.

349 In *Hinton v. Jempak Corporation*, 2020 FC 644 (F.C.), the Court found at paras. 82 to 86 that s. 53.1 does not change the existing *Free World Trust* rule that a foreign prosecution file history is inadmissible. In *Canmar Foods Ltd. and TA Foods Ltd., Re*, 2019 FC 1233 (F.C.), the Court found at para. 77 that in the extraordinary circumstance that prosecution of a foreign application is made a part of the Canadian prosecution file history, that foreign prosecution file history, where relevant to limitations made to the Canadian claims, should be admissible.

- the communication was between the applicant or patentee and the Commissioner, an officer or employee of the Patent Office, or a reexamination board member.³⁵⁰

The admission of the communications under section 53.1 is subject to these enumerated conditions and is for the limited purpose of rebutting a representation made by the patentee as to the construction of a claim in that patent.³⁵¹

(g) Final Argument

The memorandum of fact and law for trial, as described above, should enable the trial judge to have all the resources he, she or they 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. 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 you, you may want to make such comments in an appendix to your memorandum of fact and law, orally referring the court to the appendix for greater detail.

(h) Relief Sought

Finally, ask for the relief you are requesting.

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.

(i) Confidentiality

Proceedings in Court are supposed to be accessible to the public and open to public scrutiny: “Justice must not only be done, but appear to be done.” Likewise, court files are supposed to be open to the public. Testimony and evidence at trial, and the resulting court record created from them, should be public unless there is some principle that temporarily overrides the principle of “open justice” enshrined in s. 2(b) of the *Charter of Rights and Freedoms*:

The principle of open courts is inextricably tied to the rights guaranteed by s. 2(b). Openness permits public access to information about the courts, which in turn permits the public to discuss and put forward opinions and criticisms of court practices and proceedings. While the freedom to express ideas and opinions about the operation of the courts is clearly within the ambit of the freedom guaranteed by s. 2(b), so too is the right of members of the public to obtain information about the courts in the first place.³⁵²

The Supreme Court of Canada described the open court principle as “the very soul of justice”, guaranteeing that justice is administered in a non-arbitrary manner.³⁵³

(i) Protective Orders

Protective Orders provide a mechanism to expand the scope of the implied undertaking rule to protect the confidentiality of information exchanged between the parties as part of, for example, the discovery process, to include third parties such as consultants, potential expert witnesses, document service providers and transcribers. Protective Orders provide “structure and enforceability in ways the implied undertaking”, or private agreements, for

³⁵⁰ *Patent Act*, s. 53.1(1). *Hinton v. Jempak Corporation*, 2020 FC 644 (F.C.) at paras. 81 to 86.

³⁵¹ *Canmar Foods Ltd. and TA Foods Ltd., Re*, 2019 FC 1233 (F.C.) at para. 63.

³⁵² *Canadian Broadcasting Corp. v. New Brunswick (Attorney General)*, [1996] 3 S.C.R. 480 (S.C.C.) per La Forest J. at para. 23.

³⁵³ *Ibid.*, at para. 22.

that matter, cannot, but they are also consistent with “modern, efficient, effective and proportional litigation”.³⁵⁴ They further add support to the Federal Court’s efforts over the past decades to streamline complex intellectual property litigation and ensure that the system remains efficient.³⁵⁵

The Federal Court’s authority to issue protective orders is derived from Rules 3, 4 and 385(1)(a) with respect to specially managed proceedings, as well as the Federal Court’s inherent jurisdiction.³⁵⁶ Such orders are typically granted on consent. If contested, the Protective Order must meet the test in *AB Hassle*³⁵⁷ and be in accordance with the Court’s Model Protective Order.³⁵⁸

The Federal Court provides a Model Protective Order.³⁵⁹

(ii) Confidentiality Orders

Confidentiality orders protect the confidentiality of information filed or tendered with the court from public inspection or viewing. The Federal Court of Canada provides a Model Confidentiality Order³⁶⁰ and a Model Interim Sealing Order³⁶¹ for temporarily sealing documents on the Court file.

In *Sierra Club*, the Supreme Court of Canada held that:

A confidentiality order under [Federal Court] Rule 151 should only be granted when:

- (a) such an order is necessary in order to prevent a serious risk to an important interest, including a commercial interest, in the context of litigation because reasonably alternative measures will not prevent the risk; and
- (b) the salutary effects of the confidentiality order, including the effects on the right of civil litigants to a fair trial, outweigh its deleterious effects, including the effects on the right to free expression, which in this context includes the public interest in open and accessible court proceedings.³⁶²

Federal Courts Rule 151 provides that, on motion, the Court may order that material to be filed shall be treated as confidential,³⁶³ but only after the Court is satisfied that the material should be treated as confidential, notwithstanding the public interest in open and accessible court proceedings.³⁶⁴ The onus is a heavy one. It is not satisfied by consent or by bald assertions. The moving party must necessarily establish that the information is actually confidential.³⁶⁵

Where the Court orders that material be treated confidentially, the party who files the material must separate and clearly mark it as confidential, identifying the Court order under which it is required to be treated as confidential.³⁶⁶ The practice is for the party to also file an expurgated copy (a public version) of the documents, with the confidential portions blacked out.

(j) Electronic Trials

Technology has finally arrived in our courts in the form of electronic trials (“e-trials”). Paper is used minimally, as most documents and exhibits are stored on servers and displayed on monitors. This eliminates much of the time otherwise spent at trial shuffling paper.

354 *Canadian National Railway Company v. BNSF Railway Company*, 2020 FCA 45 (F.C.A.) at para. 32, citing *Paid Search Engine Tools, LLC v. Google Canada Corporation*, 2019 FC 559 (F.C.) at paras. 53 and 58 (Phelan J.) and *dTechs EPM Ltd. v. British Columbia Hydro Power Authority*, 2019 FC 539 (F.C.) at paras. 47-49 and 53-60 (Lafrenière J.).

355 *Canadian National Railway Company v. BNSF Railway Company*, 2020 FCA 45 (F.C.A.) at para. 31.

356 *Canadian National Railway Company v. BNSF Railway Company*, 2020 FCA 45 (F.C.A.) at para. 31.

357 The Court must be satisfied that “the moving party believes that its proprietary, commercial and scientific interests would be seriously harmed by producing information upon which those interests are based” [*AB Hassle v. Canada (Minister of National Health Welfare)* (1998), 161 F.T.R. 15, 83 C.P.R. (3d) 428 (F.C.) at paras. 15, 20-30, affirmed [2000] 3 F.C. 360, 5 C.P.R. (4th) 149 (F.C.A.)]. In determining whether information is confidential, the Court must be satisfied that it “has been treated by the party at all relevant times as confidential,” and that “on a balance of probabilities, [the disclosing party’s] proprietary, commercial and scientific interests could reasonably be harmed by the disclosure of information”, *Canadian National Railway Company v. BNSF Railway Company*, 2020 FCA 45 (F.C.A.) at para. 31.

358 *Canadian National Railway Company v. BNSF Railway Company*, 2020 FCA 45 (F.C.A.) at para. 31.

359 Online: https://www.fct-cf.gc.ca/content/assets/docs/base/Model_Protective_Order-ENG.docx.

360 Online: <https://www.fct-cf.gc.ca/content/assets/docs/base/Draft%20Model%20Confidentiality%20Order.docx>.

361 Online: <https://www.fct-cf.gc.ca/content/assets/docs/base/Draft%20Model%20Interim%20Sealing%20Order.docx>.

362 *Sierra Club of Canada v. Canada (Minister of Finance)*, 2002 SCC 41 (S.C.C.) at para. 45, citing *R. v. Mentuck*, [2001] 3 S.C.R. 442, 2001 SCC 76 (S.C.C.), and its companion case *R. v. E. (O.N.)*, [2001] 3 S.C.R. 478, 2001 SCC 77 (S.C.C.).

363 *Federal Courts Rules*, SOR/98-106, r. 151(1).

364 *Federal Courts Rules*, SOR/98-106, r. 151(2).

365 *Bah c. Canada (Ministre de la Citoyenneté et de l’immigration)*, 2014 FC 693 (F.C.); *Canada (Attorney General) v. Amalki*, 2010 FC 733 (F.C.) cited in *Teva Canada Ltd. v. Janssen Inc.*, 2017 FC 437 (F.C.) per Tabib, Proth. at paras. 5 & 6.

366 *Federal Courts Rules*, SOR/98-106, r. 152(1).

The Federal Court uses a system based on the FileMaker Pro relational database program. Currently, documents are uploaded to a Canadian file server accessible via the Internet. Password-protected access is provided to the court staff (judge, law clerk, registrar), service providers (court reporter) and counsel for each party.

Instead of a joint book of (paper) documents, the parties decide what productions, discovery exhibits and transcripts are uploaded to the server and which, if any, of those documents are accessible to the Court before or during the trial. Each party can have documents uploaded that are only accessible to them until they decide to make them available to others (for example, documents used for cross-examination). As documents are presented to the Court, the registrar can label them in the database as Trial Exhibits and they are given a sequential trial exhibit number.

The e-trial system uses computer monitors placed throughout the courtroom (for the judge, a law clerk, the registrar, the court reporter, the witness, each counsel table and the public audience). When one set of counsel is asking a witness questions, or presenting something to the court, they are given control of the monitors and can use their own computer to choose what to display. Each front counsel table has two monitors: a private screen to use to access the database and call up documents to be displayed (a “staging area”), and a public screen where documents called up can be dragged to display to everyone in the courtroom. A monitor is also provided at the podium for counsel in the middle of the courtroom. The registrar manages the system and controls which counsel temporarily controls the public screens. The witness box can be provided with an overhead camera to see what the witness might be drawing on a paper document. Paper documents such as drawings may be digitally photographed and the photo is uploaded to the database and can be marked as a trial exhibit. Documents can be added to the database each evening.

Daily transcripts can be uploaded to the server to be available to all having access to the FileMaker database.

It is suggested that paper copies of experts’ reports (and other key documents such as the patent in issue) be available to experts when they testify so they can move to different pages more easily than can be done electronically.

Using the e-trial system typically saves about 20-25 percent of time usually spent at trial. It also saves the parties money in reduced photocopying costs of expert reports, etc. It further allowed, during the COVID-19 outbreak in the spring of 2020, for trials to continue by videoconference, under very specific directions.³⁶⁷

367 *Rovi Guides, Inc. v. Videotron Ltd.*, 2020 FC 637 (F.C.) per Lafrenière J.