



PRACTICE

DISCOVERY

Examination for Discovery

Related subject: Patents

Motion seeking to compel attendance of plaintiffs' employee inventors (inventor employees) for discovery pursuant to *Federal Courts Rules*, SOR/98-106 (Rules), r. 237(4) by way of order pursuant to r. 90(2) made *in personam* against plaintiffs — In essence, defendant seeking order requiring plaintiffs to make their inventor employees, who are potential witnesses but not corporate representatives for discovery, attend to be examined for discovery pursuant to r. 237(4), failing which order could be enforced against plaintiffs themselves — Plaintiffs in underlying proceeding seeking declaratory relief against defendant in connection with defendant's making, constructing, using, selling of orally administered empagliflozin tablets — Defendant also seeking orders requiring plaintiffs to: provide more meaningful contact information such as telephone numbers and email addresses; permit counsel for defendant to have a one-hour videoconference conversation with each of the inventor employees — Inventors beyond territorial jurisdiction of Court — Each of the inventors assigned their patent rights to plaintiffs such that inventors are assignors of patent rights, plaintiffs are assignees of those inventors' patent rights for purposes of r. 237(4) — Scheduling order made early on in litigation ordered plaintiffs to advise defendant which inventors would be made available to attend examinations for discovery — Plaintiffs offered up six inventors across all patents at issue, suggested that their examination for discovery take place in Brussels as opposed to Germany — Stated that remaining inventor employees not available for examination — Defendant claiming refusal unjustified, contrary to its discovery rights pursuant to Rules — Defendant arguing that it seeks on this motion to have Court determine issue of which party, between patentee or challenger of patent, has authority to decide which, how many inventors are examined during discovery process in Canadian patent disputes — Real issue mechanics of compelling non-party assignor to be examined for discovery pursuant to r. 237(4) in context of litigation pursuant to *Patented Medicines (Notice of Compliance) Regulations*, SOR/93-133 when allegation of patent invalidity or voidness made by a defendant — R. 237(4) providing defendant with right to examine assignor inventor who resides outside of Canada, r. 90(2) providing mechanics of when, where, how that examination to take place — Neither rule imposing duty upon assignee party to make its assignor inventor available to be examined — Right to examine assignor inventor pursuant to r. 237(4) in context of action commenced pursuant to Regulations, s. 6, in which allegation of invalidity or voidness made triggering duty upon assignee party to provide inventor names, contact information, upon request, but not any greater duty upon assignee to take steps to facilitate assignor's attendance to be examined for discovery — Duty to provide inventor contact information only duty contemplated to be imposed directly upon assignee in connection with party right to examine non-party assignor pursuant to r. 237(4) — No specific Rules-based duty upon assignee party to make any of its assignor inventors available to be examined for discovery — Neither Rules nor Regulations providing plaintiffs with any pre-emptive right to unilaterally dictate what may or may not be proportional in defendant's intended manner of proceeding with inventor discovery — No

basis for *in personam* orders in Rules or Regulations — Order defendant seeking one that plaintiffs may not be able to comply with despite their best efforts for any one of a number of reasons, circumstances, or interests that are beyond their control and are personal to assignor to be examined — As to contact information, no basis requiring plaintiffs to do more than they have done — Also no basis for order that plaintiffs permit one-hour videoconference conversation between defendant's solicitors of record and each inventor employee — Motion dismissed.

BOEHRINGER INGELHEIM CANADA LTD. V. JAMP PHARMA CORPORATION (T-2276-22, T-2318-22, 2023 FC 943, Duchesne C.M.J., reasons for order dated July 4, 2023, 24 pp.)