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## PRACTICE

### DISCOVERY

#### *Examination for Discovery*

*Related subject: Patents*

Motion by defendants pursuant to *Federal Courts Rules*, SOR/98-106, r. 97 to compel answers to questions refused by plaintiffs' corporate representative during his examination for discovery — Defendants also sought to compel answers to questions refused during examination for discovery of inventors who assigned their patent rights to plaintiffs — These examinations for discovery occurred pursuant to Rules, r. 237(4) — Court informed defendants during hearing of motion that portion of their sought relief, specifically, order compelling plaintiffs to provide answers from inventors pursuant to Rules, rr. 97, 237(4) was ill-conceived, could not be granted — Court's power to compel pursuant to r. 97 not extending to compel person who has not been served personally with direction to attend to be examined, or to compel person who was not asked question on discovery while under oath — Rules, rr. 97(a),(b),(c),(e) set out this conclusion in plain language — Parties involved in contentious litigation with respect to six patents owned by plaintiffs — Defendants obtained Order for issuance of commissions, letters of request pursuant to Rules, r. 272, proceeded to examine some of inventors identified in patents at issue in proceeding prior to examining plaintiffs' corporate representative for discovery — Plaintiffs' solicitors of record attended r. 237(4) examinations for discovery of specific inventors — Plaintiffs' solicitors of record assisted some of inventors in their preparations to be examined for discovery, whereas other inventors prepared themselves on their own — Some objections made by plaintiffs' solicitors of record during these examinations for discovery — Defendants at no time suggested during examinations that motion was required to determine whether plaintiffs' solicitors' objections could be made on record — Rather, save for brief exchange during examination for discovery, defendants' conduct suggested that they accepted that plaintiffs' solicitors of record had right to attend inventor examinations for discovery, to make objections on record — Defendants asking whether solicitors of record for one or more of parties attending examination for discovery of non-party inventor pursuant to r. 237(4) could make objections on record regardless of whether solicitors represent non-party inventor witness — Rules determined that answer to question was clearly yes — Issue herein whether to grant defendants' motion — Under r. 242, questions may be objected to during examination for discovery — Rule 240 describes that what "person being examined" must do during examination for discovery — Is clear in its designation of the "person" that person being examined, whether party or not, is to answer questions as prescribed by rule — Rules provide definition of word "person" — As found in r. 2, "person" defined as including tribunal, unincorporated association, partnership — Such definition as used in Rules clearly not exhaustive — Is equally clear that use of word "person" in Rules, depending on context, may refer to and mean "party" but not necessarily always referring to or meaning "party" — Rather, contextual interpretation of word "person" will assist in determination of which "person" is referred to in any given rule — Rules 87 to 100 apply to examinations for discovery under Rules — Several rules examined, discussed herein — Examination of relevant rules showing that it is permissible, indeed contemplated by Rules, that plaintiff's solicitor of record may attend on

examination for discovery of non-party inventor pursuant to r. 237(4), make objections on record even if solicitor at issue not acting for non-party witness being examined — Party's solicitor of record attending examination for discovery may indeed object to question on grounds set out in r. 242 — That objection may also be made on behalf of party rather than of witness — Party making objection having right to object to ensure that examination of non-party is being carried out in accordance with Rules; that proper questions asked — In this sense, parties having ability to object to questions asked of non-party witness during that non-party witness' examination for discovery as they would be entitled to object to question asked of non-party witness who is being examined in chief or cross-examined during trial — Motion for order compelling plaintiffs to provide answers to questions improperly objected to during examination of non-party inventors therefore dismissed — However, appropriate to make "best efforts" order akin to that made in *Allergan Inc. v. Apotex Inc.*, 2020 FC 658, at paragraphs 23-24 — Motion granted in part.

BOEHRINGER INGELHEIM (CANADA) LTD. V. SANDOZ CANADA INC (T-1831-22, T-1842-22, 2023 FC 1175, Duchesne C.M.J., reasons for order dated August 30, 2023, 16 pp.)