



IP Users Committee

MINUTES
MAY 12, 2016
OTTAWA, ON

Attendance: Justice Manson (Chair), Chief Justice Crampton, Justice Phelan, Justice Hughes (by phone), Prothonotary Tabib, Prothonotary Milczynski, Prothonotary Aalto, Yuri Chumak, Carol Hitchman, Trent Horne, Patrick S. Smith, Brad White (by phone), Lise Lafrenière Henrie

Regrets: Justice O'Reilly, Justice Locke, Prothonotary Lafrenière, Jonathan Stainsby

SUBJECT	STATUS / ACTION
<p>1. Agenda – approved</p> <p>2. Minutes of November 19, 2015 meeting - approved.</p> <p>3. Issues arising from the Town Hall</p> <p><i>Records retention</i> – C. Hitchman indicated that the bar needed to give it some thought and would get back to the Court. There was a view that 15-20 years might be reasonable. For patents, the life of a patent + 6 years might be reasonable. At Gowlings, there's a project to get rid of old records. It involves the Law Society and could provide some guidance. As well, the Rules provide that where all avenues of appeal have been exhausted, the evidence on file may be retrieved by the parties or destroyed. There was also discussion that storing documents electronically may be problematic as technology is constantly evolving and it may be difficult to access in 10-20 years. There may be segments of the documents, such as authorities and evidence that can be destroyed.</p> <p><i>Costs</i> – the Rules Committee had a paper seeking views on costs. There may be an opportunity for the IP Bar to react to this when the report comes out.</p> <p><i>Mediation</i> – Prothonotary Tabib mentioned that the Court <u>would try</u> to accommodate requests for a particular judge or prothonotary for mediation only (not case management, etc.). This is not sufficiently well-known. There needs to be a way to make this known to the bar. Better to request mediation early in the process even if it is not used right away. Good to have in the back of mind.</p> <p><i>Quadrennial Commission</i> – The Bar will review the report when it comes out to determine next steps. The Bar's reaction could help the government in its response.</p> <p><i>Guidelines for Complex Litigation</i> are very favourably received. However, because interlocutory and case management decisions are not published, the Bar doesn't know how the Guidelines are being applied by others. For the Town Hall next year, it would be useful to hear from members of the court who are applying the Guidelines to see if there are any controversial issues or if they are working well.</p>	<p>Bar to consider what timeframe might be reasonable and provide feedback as soon as possible.</p> <p>Ms. Hitchman will report this to IPIC and T. Horne will report to CBA.</p> <p>Bar to monitor release of QuadComm report.</p> <p>Topic for Town Hall in 2017</p>

Other issues – It is important to keep the dialogue going. Anytime issues come up, the Bar should send their issues to the Court and we can have a conference call.

The Chief Justice asked the Bar for feedback. Reps are to take issues to their members:

- *Chess Clock* – Has been used with success in the Competition Tribunal)
- *Hot-tubbing* – Hot-tubbing typically takes place towards the end of a trial– it should be brief (20 minutes). It could also be done at pre-trial: “early hot-tubbing” but it’s not always ideal. May be better in damages cases.

How is hot-tubbing different from regular cross-examination? Justice Hughes explained that many lawyers are dabblers and are all over the map. The judge can ask counsel to focus on issues but some still can’t do it. There needs to be courses in cross-examination.

Two types of hot-tubbing – 1) get experts together before to see if they can agree; 2) get the two experts in a box (get counsel together and tell them the four questions that will be put to them); there’s no formal mechanism in place to encourage counsel to get their experts in a room; how to get more buy-in?

Markman hearing – the US lawyers are used to this wording; we shouldn’t call it Markman (too rigid) but rather “active case management”; discussion of how to carve out of an issue: bifurcation (not just for damages, can be used for construction), case management, summary trial, simplified action. Construction is the essence of every patent trial.

4. Discussion of the Notice to the Profession on Experimental Testing

No discussion

5. Guidelines for NOC Proceedings

The Guidelines have been reviewed based on comments from the Bar and the Court. They are not cast in stone but a template of what the Court would like to see. NOCs are like a patent trial in 3-4 days. They are quite challenging. The idea that there could be extensions or motions a few weeks before isn’t a good way to go forward. These GL ask for hearing dates early to avoid last minute skirmishes before the hearings.

6. Potential Amendments to the NOC Regulations

The Chief Justice indicated that there are amendments that would be needed to implement the Canada-Europe Free Trade Agreement and the Trans-Pacific Partnership. There may be an opportunity to address other issues.

The Court has a database of all NOC hearings that can be searched by: drug, parties, who case managed it, who was the hearing judge. It will also soon include all pending patent actions so that if it involves the same drug, we could have the same judge hearing the NOC and trial. Discussion about whether there may be a concern with having the same person hear the NOC and the trial on the same patent(s). If one loses at NOC, it may appear to be a greater hurdle to appear again before the same person. However, the Court must apply the law. In fact, the hurdle may be greater before a different judge as another judge may be uncomfortable overturning a colleague. A judge’s understanding can be more informed the 2nd time around.

Masterpiece decision – usefulness of survey evidence – is there a trend? Justice Hughes never heard evidence of a survey being done in a patent case but there has been quite a bit in trademark cases (until *Masterpiece*). A survey on confusion is not very useful but a survey on inherent/acquired distinctiveness may have some utility. At pre-hearing

Bar reps to discuss issues (Chess Clock, Hot-tubbing) with their members.

<p>conference, the judge could tell the parties what words he/she needs to hear about. Other words may have a plain meaning. The Bar suggests that it would be good to have that in a decision (the usefulness of survey evidence in Trademark cases). Justice Rothstein has qualified usefulness only when he needs help both on surveys and on claim construction.</p> <p><i>Claims chart</i> – In most cases (not all), a claim chart is helpful. This is usually discussed at case management conferences. Last year, Justice Manson distributed the U.S. District Court precedent. This led to much better claims charts. How can it be disseminated further? It would be good to have a common understanding of what we mean by claims charts. Justice Manson offered to develop a template to circulate to the Case Management group based on the U.S. model. Three types of claims charts are needed: validity; infringement; claim construction.</p> <p>7. Prothonotaries</p> <p>Awaiting the appointment of a prothonotary in Ottawa (to replace Prot. Aronovitch).</p> <p>8. Workload/scheduling</p> <p>Many NOC cases have settled. There is room to move more quickly if parties/counsel are ready for trial. The Chief Justice Crampton reminded the Bar to ask the Judicial Administrator to be added to the “ready list” (any IP case, not just the big ones).</p> <p>9. Hearing Management Conferences (HMC) for NOCs</p> <p>See page 3 of the Guidelines for NOC Proceedings. The HMC help understand expert evidence (tutorials). It can cut out a lot of uncertainty. The court would welcome tutorials. Any motions late in the day usually have to be heard by the hearing judge.</p> <p>10. Timing for release of judgments where reasons are delayed</p> <p>Where reasons in NOCs have confidential information, some parties take too much time to identify what is confidential. Certain judges have practices to deal with this, such as giving parties a timeframe (e.g. 20 days for a 95-page judgment). The judge may or may not agree with the parties as to what is confidential.</p> <p>Other matters</p> <p>Appeals from prothonotaries – A five-member bench of the Federal Court of Appeal heard an appeal in April in A-303-15. The appeal was from a decision of Mr. Justice Boswell dated June 15, 2015, dismissing an appeal from an Order issued by Prothonotary Milczynski. The Court of Appeal is being asked by both parties to overrule <i>R. v. Aqua-Gem Investments Ltd.</i>, [1993] 2 F.C. 425 (C.A.) and replace it with <i>Housen</i>.</p> <p>List of case law – Y. Chumak indicated that the list of case law circulated at the Town Hall was very useful and suggested that it be repeated every year. Justice Manson indicated that it can be done on a yearly basis but that it shouldn’t be viewed as exhaustive. It was also noted that the Law Society develops a similar list for their January programme.</p> <p>11. Next meeting</p> <p>The next meeting will take place on November 3, 2016 at 2:00 p.m. in Toronto.</p>	<p>Justice Manson to develop template for claims chart.</p> <p>Bar to remind members that they can ask to be added to the “ready list”.</p> <p>The Court may be able to identify a sliding scale for a timeframe to provide comments on confidentiality.</p> <p>The Court will prepare a list of case law for the Town Hall next year.</p>
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