Federal Court  Cour fédérale

IP Users Committee

MINUTES
NOVEMBER 3, 2016
TORONTO, ON

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

Regrets: Justice O'Reilly

SUBJECT	STATUS / ACTION
1. Agenda – approved **2. Minutes of May 12, 2016 meeting - approved.** **3. Quadrennial Commission** The Chief Justice reported that Court is pleased with the Government response. The Chief Justice thanked IPIC and CBA IP Bar for their support. Prothonotary Lafrenière indicated that when advertising prothonotary positions in the future, the positions will be more attractive to prospective candidates. One remaining piece is the supernumerary status/ part-time status leading to retirement for prothonotaries. The Chief Justice will pursue discussions with the government. **4. *Hospira Healthcare Corporation* v. *Kennedy Institute of Rheumatology*** This decision is a change in direction from *Aqua-Gem*. Now, the test to appeal a prothonotary decisions is the same as for a trial judge. The threshold has been elevated so that Prothonotary decisions will be more difficult to reverse. The Rules Committee chaired by Justice Rennie are looking at proposed changes that might be of interest to the Bar. One possible change would be to seek leave to appeal a prothonotary decision. Justice Manson indicated that the Court can make more effective use of case management without all the motions, particularly appeals from prothonotary decisions to judges. Carol Hitchman indicated that the Court may want to wait to see what happens as a result of the *Hospira* decision before amending the Rules. We may see fewer appeals. In the Ontario	

Court, you need leave for certain appeals. On procedural matters, it may be appropriate to seek leave if going from FC to FCA. Justice Phelan suggested that we wait to see if SCC grants leave on the *Hospira* case. The Chief Justice questioned whether a prothonotary's decision could be appealed directly to the FCA (rather than going through FC first). The parties discussed whether it matters if the trial judge hears an appeal as opposed to a motions judge. The Bar would prefer to have the trial judge hear it. Brad White indicated that there might be issues with the Federal Court of Appeal's availability to fit scheduled timeframes. Carol indicated that the FC judge's decision typically ends interlocutory appeals. Trent Horne added that it would mean more work to go directly to the Federal Court of Appeal. Justice Manson indicated that scheduling attempts to set aside some time for case management, which would include these motions. Prothonotary Aalto mentioned that some motions can, and are, sent directly to the trial judge. Prothonotary Lafrenière would not burden the trial judge to deal with interlocutory matters if he has the jurisdiction and availability to deal with them. Conclusion: we'll wait to see how *Hospira* plays out in practice. The Court will review the issue again in a year from now.	**Bar to provide comments on possible changes to Rules re leave to appeal.** **Follow up on *Hospira* in November 2017**
5. Discussion of the Notice to the Profession on Experimental Testing (May 12, 2016) The Notice was amended based on feedback from IPIC. Justice Manson asked if there are any comments from the Bar or experience on the revised Notice issued on May 12th. He indicated that experimental testing has to be meaningful in terms of access to the other party, but also how it's carried out. There have been a number of recent decisions where there has been criticism of some of the types of ET that goes on. The Court will be critical if testing is not done within parameters that make it useful, fair and open. The Court has to consider it to be meaningful data. Carol Hitchman indicated that she had not heard any further comments from the Bar on the Notice.	
6. Guidelines for NOC Proceedings – feedback NOC guidelines were made available in May 2016, and feedback from the Bar was requested. Prothonotary Lafrenière heard a PMNOC that involved 10 related PMNOC proceedings with motions for partial re-order. There appears to be a message to the Bar that the Court is dealing with these aggressively, and in a timely fashion. Prothonotary Milczynski indicated that dates are sometimes provided before the requisition for hearing has been filed. Brad White referred to the Court's best practices and that a requisition should always be filed. To give dates, the language, the location and the time for hearing needs to be set. Justice Manson specified that consistency depends on counsel. The Chief Justice asked whether the Bar had any further comments on the proportionality guidelines. At the last meeting, the Committee had agreed: > 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. Brad White along with other members of the Bar indicated that there has	

been no trouble complying with the guidelines.

Trent Horne asked the Court if, in a broader perspective, the guidelines are well received. Justice Manson indicated that the Court has not received any negative feedback.

On behalf of IPIC, Carol Hitchman asked if there was a better response to lower the cost of litigation, such as summary trials. Grant Lynds indicated it appears that summary proceedings are used in trademark matters, not patent matters. Patrick Smith indicated that they are being used in patent cases. He gave a few recent cases as examples. However, case management may lead to the same result (for example, may get claim construction determined) – and settle the whole case. If you go by way of summary trial, you may get a quick decision, but you still need to prove your case, particularly damages.

7. Draft Compendia Guidelines

Justice Manson indicated that #6 in the Guidelines, which relates to the length of the compendia, provides for a 30 page limit, but also provides some flexibility. The thought was that this would encourage parties to be more succinct in providing compendia.

Jonathan Stainsby stated that the Bar typically does not have time to make the compendia shorter.

Prothonotary Aalto suggested that the material be provided in a more condensed fashion. He has seen files with 7 volumes the size of phone books, where counsel only referred to maybe eight pages at the hearing. He suggested that there be a compendium that directs the judge or prothonotary only to the relevant pages. Prothonotary Lafrenière recommends that compendia should not just be for trial, but for complex motions where material is voluminous. These lengthy pleadings take up a lot of preparation time. He referred to a Notice of Allegation that was 400 pages long. While the compendium provided was useful, it needed to be provided earlier.

Jonathan Stainsby specified that motions and records are often prepared on an urgent basis and there is no time to narrow the material, creating the lengthy materials.

Justice Manson indicated that judges want counsel to cut to the chase; they just want the relevant pages; not superfluous information. The Court wants only the pages that you will rely on.

Brad White mentioned that it would be more practical to provide compendia at the hearing and inquired what would occur if documents were missing at the hearing.

Carol Hitchman specified that there are sometimes issues with the context and that further documents might be needed.

Justice Manson asked counsel to only focus on the relevant material, while Justice Locke indicated that when travelling, the Court cannot carry all the material to prepare for a file.

Brad White stated that the parties could prepare hyperlinks on a USB key for the judges to carry and if the material is submitted in advance, amended compendia might be needed. The Court agreed that this would be useful, but that the Court would need to receive them at least two days ahead to be cleared by IT.

Justice Manson concluded that the filing of compendia is best practice and that it should be filed with the Court in advance, in order to crystalize the issues before the Court ahead of the hearing. Justice Manson asks that the message be shared with their colleagues from the Bar, maybe at the next IP town hall meeting.

When scheduling matters, the CJ asked the Bar if it would be useful to take a break before final arguments.

Jonathan Stainsby indicated that preparation time for final arguments would be appreciated, and would result in better, more succinct written submissions.

The CJ proposed a week delay before final arguments for trials that are more than three weeks.

The Bar indicated that it might be possible to hyperlink all the documents, arguments and testimonials for final disposition of matters.

The CJ referred to a "chess-clock" and the fact that it is up to the parties to calibrate the time between evidence and arguments. The Court does not give more time and the parties usually end up splitting their time appropriately. Justice Manson reminded the Bar that it is up to the Court to manage the Court's schedule, not the parties.

While joint books of documents are preferred, it was recognized that it is not always possible to get agreement. In trying to reduce the amount of material before the Court, it needs to be understood that parties should not be penalized for missing documents that may need to be added.

The parties discussed that, with respect to #1 of the guidelines, it would help to indicate that complex cases are over 500 pages.

8. Format for Claims Charts

Justice Manson took feedback from Bar and provided a claim chart template. He mentioned that he's seeing much better quality claim charts in recent trials. In Pharma cases, they are typically very good, but it would be good to get consistency across the board.

Yuri Chumak –would like to see the chart as an appendix in the decision. Justice Manson indicated that it is up to the Court to decide on whether to include claim charts or not – each case is fact dependent.

Justice Locke suggested that the main value of claim chart is to make the parties' respective arguments more efficient.

There was general agreement that claim charts are useful and will be expected by the Court – earlier than later in the trial process.

9. New Prothonotary appointment in Ottawa

Prothonotary Mandy Aylen was appointed in June 2016. The Chief Justice encouraged the Bar to get to know her.

10. Records retention – feedback

Lise Lafrenière Henrie indicated that a proposal document on the subject was sent prior to this meeting, in which a two-year retention is proposed for matters that are settled, discontinued or withdrawn.

CJ provided that it concerns mainly immigration matters, but that the Court is still looking for comments.

Lise Lafrenière Henrie asked that comments be sent to her attention after the meeting.

Trent Horne asked if destroyed means *fully* destroyed. The Chief Justice indicated that it does.

Jonathan Stainsby indicated that a two-year retention period is not very long as it might be an issue for parties looking to recuperate material on specific files. Jonathan Stainsby and Carol Hitchman mention that they would need to consult the Bar on this matter. Jonathan Stainsby added that it should be limited to proceedings that do not have substantive evidence on file.

CJ asks the Bar to come back with comments before the end of the month.

Bar to provide comments on Retention Schedule by end of November 2016

11. Chess-clock/ Hot-tubbing

Justice Manson indicated that hot-tubbing is done in Australia, the UK, the US, but not in Canada; some judges agree with it, some don't. The Court and the parties need to find a way to limit issues between the experts and possibly look for joint expert agreements.

Justice Barnes would like to see a process where a final report gets written by the experts wherein the experts would have to be given a mandate to draft a common, written report that would streamline the issues in dispute. A rebuttal report would list the points on which the experts agree or disagree.

The Chief Justice agreed that it would help if counsel could have the experts indicate what they agree and don't agree upon. Having opposing experts together before the Court usually results in more reasonable approaches – often many issues are resolved before the hearing. This has been the experience at the Competition Tribunal. However, a problem may be that you might get someone with a strong personality who might intimidate the other expert. As such, it may not be able to be done in every case. Justice Hughes had a video on hot-tubbing when the new rules were introduced, but it seems that nothing has evolved since then.

Justice Manson asked counsel on how to get the parties to state clearly

whether they agree or not. Justice Barnes suggested that it's already in the Rules, or in the Code of Conduct. Justice Manson asked the Bar to look into this. Jonathan Stainsby indicated that the Rules refer to the Code of Conduct for expert witnesses (Rule 52(2)).

12. Workload/scheduling

The CJ reported that the Court is scheduling trials of 1-2 weeks in the late Spring 2018, and lengthy ones in Fall 2018. There is availability for short matters before Anglophone judges for February. There is limited availability for bilingual judges. NOCs are still being scheduled at least 2 months prior to the statutory stay expiry.

To date, there has been limited use of the ready list to obtain earlier trial dates (maybe only one case).

13. Next meeting on May 11, 2017 in Ottawa.