

Federal Court



Cour fédérale

**Date: 20151016**

**Docket: T-2105-13**

**Citation: 2015 FC 1176**

**Ottawa, Ontario, October 16, 2015**

**PRESENT: The Honourable Mr. Justice LeBlanc**

**BETWEEN:**

**BARD PERIPHERAL VASCULAR, INC.  
AND  
BARD CANADA INC.**

**Plaintiff/  
Defendants by counterclaim**

**and**

**W.L. GORE & ASSOCIATES, INC.  
AND  
W.L. GORE & ASSOCIATES CANADA INC.**

**Defendant/  
Plaintiffs by counterclaim**

**ORDER AND REASONS**

**I. Introduction**

[1] This is an appeal by the Defendants/Plaintiffs by counterclaim, W.L Gore & Associates Inc. [Gore US] and W.L Gore & Associates Canada Inc. [Gore Canada] [collectively referred to

as Gore], pursuant to Rule 51 of the *Federal Courts Rules*, SOR/98-106 [the Rules], of part of Prothonotary Richard Morneau's Order, dated August 24, 2015 [the Order], disposing of the request for answers to questions posed to the representative of the Plaintiffs/Defendants by counterclaim [Bard] during discovery. Gore seeks to compel answers be given by Bard's representative, Mr. Scott Randall, to a number of questions which Prothonotary Morneau held need not be given.

[1] Gore also challenges the part of Prothonotary Morneau's Order awarding costs to Bard.

[2] For the reasons that follow, Gore's appeal is dismissed.

## **II. Background**

[3] This appeal arises in the context of an action brought by Bard seeking a declaration that Gore has infringed Canadian Patent No. 1,341, 519 [the 519 Patent] as well as injunctive relief and damages, including punitive and exemplary damages. The 519 Patent, entitled *Prosthetic Vascular Graft*, contains 27 claims and relates to prosthetic devices, including artificial veins and arteries, made of expanded Teflon known as *ePTFE*. Bard alleges that 12 broad families of Gore products include all the elements of, and therefore infringe, certain claims of the said patent.

[4] Gore is denying infringement and has counterclaimed that the 519 Patent is invalid in several respects, including lack of utility, insufficient disclosure, overbreadth, and co-inventorship.

[5] As noted by Prothonotary Morneau, the parties to this case are not strangers to each other or to the technology and patent in suit as this matter has been prosecuted and litigated for more than four decades both in Canada and the United States. The 519 Patent was issued on January 2, 2007 to the named inventor, Dr. David Goldfarb, from a Canadian application filed in January 1975, which claimed priority based on a US application filed by Dr. Goldfarb on October 24, 1974. The Canadian application was put into conflict by the Canadian Patent Office in 1980 against an application filed in Canada by Gore US in order to determine the issue of inventorship. This gave rise to proceedings before this Court. In February 2001, Justice François Lemieux held that Dr. Goldfarb, instead of Peter Cooper, an employee of Gore US who had assigned his rights to Gore US, was the first inventor (*Goldfarb v W.L. Gore & Associates Inc.*, 2001 FCT 45, 200 FTR 184) [*Goldfarb*]. This judgment was affirmed on appeal (*W.L. Gore & Associates Inc. v Goldfarb*, 2002 FCA 486, 235 FTR 167). Dr. Goldfarb's US patent application was also put in an interference proceeding against an application filed by Gore US. In 2002, after years of litigation, a US patent was issued to Dr. Goldfarb.

[6] Justice Lemieux, in *Goldfarb*, above, described Dr. Goldfarb's invention as follows:

[118] The first step in the analysis to determine who, as between Dr. Goldfarb and Mr. Cooper, was the first inventor of a successful artificial small vascular human vein or artery replacement, is to define exactly what the invention is.

[119] The invention relates to an artificial vascular prosthesis made from ePTFE. The properties and method of manufacture of ePTFE are not new. They are prior art. Robert Gore was the inventor and obtained, in 1976, a patent on that invention.

[120] What was not known in 1970, however, was whether ePTFE tubing could have a medical use. Experimentation or search for use for it as a vascular graft in replacement for natural arteries and veins in humans began almost immediately after Mr. Gore filed his U. S. patent application in 1970.

[121] The invention, an appropriate range of fibril length in the material, is what made the ePTFE tubing useful for such purpose. The essential feature of the invention is the distance between the nodes (or the length of the fibres connecting them) which forms part of the internal structure of ePTFE tubing.

[122] An appropriate fibril length is what permits this ePTFE tubing to act as a useful artificial graft which remains patent because it allows cellular or fibroblastic movement and thus tissue ingrowth.

[7] The present action was initiated in 2013. It is casemanaged by Prothonotary Morneau as a specially managed proceeding. By Order dated November 12, 2014, the trial - on the issues of infringement and validity - is scheduled to commence in a year from now, that is on October 3, 2016. Discoveries of each party's corporate representative were held in the spring of 2015 and followed by written questions. In each case approximately 1200 questions were not answered by the other side's representative and motions were brought to compel answers to some of them. Bard sought to compel answers to 72 refused or unanswered questions whereas Gore sought the adjudication of some 940 unanswered questions. At the time of the hearing of both motions held before Prothonotary Morneau on August 12, 2015 and as a result of ongoing efforts to reduce the issues in dispute, these figures were brought down to six questions by Bard and to approximately 450 by Gore.

[8] Gore's 450 questions were broken down into some 30 categories or sub-categories. The questions at issue in this appeal are in relation to three of these categories: the Prosecution Questions, the Aneurysm Questions, and the Pore Size Questions. There were 17 questions at issue initially but this total was reduced to 13 [the Refused Questions] at the outset of the hearing of the appeal.

[9] After having set out what were, in his view, the legal principles applicable to the analysis of both parties' motions to compel answers, and pointed to the Notice to the Profession, issued by the Chief Justice of this Court on June 25, 2015 with a view of bringing increased proportionality in complex litigation before the Court [the Proportionality Guidelines], Prothonotary Morneau held that the Refused Questions need not be answered either because they were not relevant to unadmitted allegations of fact or because they sought expert opinion, legal conclusions, or expressions of opinion or state of mind.

[10] On the whole, Gore was successful on 13 of the 450 questions for which it sought answers from Bard's representative. Given this limited success and being of the view that Gore's motion to compel answers, by its magnitude, was unreasonable and excessive, Prothonotary Morneau awarded costs to Bard at the top of Column IV of the Tariff.

[11] The issue to be determined in this case is whether the Court should interfere with these findings.

### **III. Analysis**

#### **A. *The Standard of Review***

[12] Prothonotaries' decisions ordering questions to be answered or not answered on discovery are interlocutory, discretionary decisions (*Bell Helicopter Textron Canada Limitée v Eurocopter*, 2010 FCA 142 [*Bell Helicopter*], at para 17; *Apotex Inc. v Welcome Foundation Limited*, 2008 FCA 131, at para 3; *Hayden Manufacturing Co. v Canplas Industries Ltd.*, 161

FTR 57, 85 ACWS (3d) 12, at para 8 [*Hayden Manufacturing*]; *Létourneau v Clearbrook Iron Works Ltd.*, 2005 FC 475, at para 4; *AstraZeneca Canada Inc. v Apotex Inc.*, 2008 FC 1301, [2009] 4 FCR 243, at para 22 [*AstraZeneca Canada*]).

[13] As is well-settled, discretionary orders of Prothonotaries ought not to be disturbed on appeal before a judge of the Court unless they raise questions vital to the final issue of the case or they are clearly wrong in the sense that the exercise of discretion by the Prothonotary was based upon a wrong principle or upon a misapprehension of the facts. Therefore, the Court may only consider the matter *de novo* when the Prothonotary's decision falls within the scope of one of these two criteria (*R v Aqua-Gem Investments Ltd.* [1993] 2 FC 425, 61 FTR 44 [*Aqua-Gem*]; *Z.I. Pompey Industrie v ECU-Line N.V.*, 2003 SCC 27, [2003] 1 SCR 450; *Merck & Co. Inc. v Apotex Inc.*, 2003 FCA 488, 246 FTR 319; *Bell Helicopter*, above at para 18; *Apotex Inc v Sanofi-Aventis*, 2011 FC 52, 383 FTR 37, at para 13 [*Sanofi-Aventis*]; *NOV Downhole Eurasia Limited v TLL Oil Field Consulting*, 2014 FC 889, at paras 13-14 [*NOV Downhole*]).

[14] As Justice Yves de Montigny stated in *Sanofi-Aventis*, above, it will be a rare occurrence when it can be shown that the denial of further discovery will be vital to the outcome of a case (*Sanofi-Aventis*, at para 14). Here, Gore has not attempted to show that the part of Prothonotary Morneau's Order under appeal is vital to the final issue of the case.

[15] Therefore, the issue is whether Prothonotary Morneau, in finding that Bard's representative need not answer the questions at issue in this appeal, exercised his discretion based upon a wrong principle or upon a misapprehension of the facts. If he did not, then his

decision attracts considerable deference and should only be interfered with “in the clearest case of misuse of judicial discretion” (*NOV Downhole*, above at para 14; *L’Hirondelle v Canada*, 2001 FCA 338, (*sub nom Sawridge Band v R*) [2002] 2 FC 346, at para 11). This is particularly the case where, as here, the impugned decision was rendered in the context of case management. In such context, it is generally recognized that the burden of a party seeking to overturn an interlocutory order by a case-manager is a heavy one as a casemanager is normally intimately familiar with the history, details, and complexities of the casemanaged matter (*Sanofi-Aventis*, above at para 15).

[16] In other words, I should not substitute my discretion for that of Prothonotary Morneau, even if I may have arrived at different results had I been hearing the matter at first instance, unless he made a fundamental error of principle or misapprehended the evidence or the pleadings (*Merck & Co. Inc. v Apotex Inc.*, 2005 FC 582, 273 FTR 160, at para 59; *Hayden Manufacturing*, above at para 12).

#### **B. Oral Discovery: Relevant Principles**

[17] As reaffirmed by the Federal Court of Appeal in *Canada v Lehigh Cement Limited*, 2011 FCA 120, at paragraph 30 [*Lehigh Cement*], the general purpose of discovery “is to render the trial fairer and more efficient by allowing each party to inform itself fully prior to trial of the precise nature of all other parties’ positions so as to define fully the issues between them.” This calls for a liberal approach to the scope of questioning on discovery (*Lehigh Cement*, at para 30; *Sanofi-Aventis*, above at para 19).

[18] Examinations on discovery in proceedings before this Court are governed by Rules 234 to 248. Rules 240 and 242(1) are of particular relevance to the present case. Rule 240 provides for the scope of the examination for discovery. It states that a person examined for discovery is required to answer, *inter alia*, any questions relevant to any unadmitted allegation of fact disclosed in the pleadings. In *Lehigh Cement*, above, the Federal Court of Appeal reiterated that a question is relevant “when there is a reasonable likelihood that it might elicit information which may directly or indirectly enable the party seeking the answer to advance its case or to damage the case of its adversary, or which fairly might lead to a train of inquiry that may either advance the questioning party’s case or damage the case of its adversary” (*Lehigh Cement*, at para 34).

[19] For its part, Rule 242(1) establishes permissible objections during an examination for discovery. It provides that a person may object to a question when, for example, the answer is not relevant, is unreasonable, is unnecessary, or would be unduly onerous to answer. The following types of questions have generally been found not to be proper subject matters for discovery : (i) questions seeking expert opinion, (ii) questions seeking the witness to testify as to questions of law, (iii) questions seeking law or argument, as opposed to facts, and (iv) questions where the witness is being asked: “upon what facts do you rely for paragraph x of your pleading” (*Apotex Inc. v Pharmascience Inc.*, 2004 FC 1198, 260 FTR 254, at para 19; *AstraZeneca Canada*, above at para 14).



[20] There is more to it. The simple fact that a question is “relevant” does not mean that it must inevitably be answered and cannot, as a result, be objected to. In *AstraZeneca Canada*, above, the Court held that relevance is always subject to the overriding discretion of a Prothonotary to control abuses of the discovery process:

[16] “Relevance” alone is not the test as to whether a question put on discovery must be answered. Of course, if a question is irrelevant, it need not be answered. However, if a question is relevant to some degree or another, then, if an objection is raised, the Court must consider factors such as the degree of relevance, how burdensome is it to obtain an answer, is the question fair, is it abusive and so forth. Strayer JA. when he was in the Federal Court of Appeal wrote in *Merck & Co. v. Apotex Inc.* 2003 FCA 438, 28 C.P.R. (4<sup>th</sup>) 491 at paragraph 13:

A person who is a party to a civil action is entitled to ask any question on discovery that is relevant to the issue: that is a matter of justice to him, subject of course to the discretionary power of the prothonotary or a judge to disallow the question where it is abusive for one of the reasons mentioned above.

[17] The Federal Court of Appeal again considered the scope of “relevance” in the context of oral discovery in *Apotex Inc. v. Bristol-Myers Squibb Co.*, 2007 FCA 379. In that decision Shallow JA. for the Court, considered “relevance” as including not only that which will go to proving or disproving the case of one or other party, and considered the “train of inquiry” test which she stated was subject always to the “... overriding discretion of a prothonotary or judge to control abuses of the discovery process”. At paragraphs 30, 31 and 35, Shallow JA. wrote:

**30** In determining the propriety of a particular question posed in the examination for discovery of Dr. Ryan, the test is whether it is reasonable to conclude that the answer to that question might lead Apotex to a train of enquiry that may either advance its case or damage the case of BMS: *Apotex v. Canada*, [2005] F.C.J. No. 1021, 2005 FCA 217. For example, Apotex is entitled to ask any question that could elicit an admission by BMS as to a relevant fact, or that could elicit information about the existence of documents that have not been

disclosed but that meet the test of relevance for the purposes of pre-trial discovery, as set out in the Further and Better Order, subject always to the overriding discretion of a prothonotary or judge to control abuses of the discovery process.

**31** In determining whether the test of relevance is met in a particular case, it is necessary to consider the allegation that the questioning party is attempting to establish or refute. In this case, Apotex is attempting to advance its allegation of inutility (based on its interpretation of the promise of the 436 patent as explained above), or to damage the position of BMS that denies the allegation of inutility.

[...]

**35** The task of distinguishing proper questions from improper ones requires consideration of the factual and procedural context of the case, informed by an appreciation of the applicable legal principles. The determination made by the judge or prothonotary at first instance will stand if it is reasonable, unless it is based on an error of law.

[21] Relevance must therefore be weighed against matters such as the degree of relevance, how onerous it is to provide an answer, or if the answer requires fact or opinion or law. This is how the Court protects against abuses so as to secure, as required by Rule 3, the just, most expeditious and least expensive resolution of every proceeding on its merits. As the Court reiterated in *AstraZeneca Canada*, above at paragraph 7, Rule 3 - the Rules' "procedural foundation" - is to be followed in all matters before the Court, including discovery.

[22] As indicated previously, Prothonotary Morneau, in his Order dated August 24, 2015, spent quite some time setting forth the principles he relied on to reach his conclusions. He first reproduced the six principles regarding relevancy set out by Justice John McNair in *Reading &*

*Bates Construction Co. v Baker Energy Resources Corp.*, 25 FTR 226, (1988), 24 CPR (3d) 66, [Reading & Bates], pointing out that the first three define the parameters that determine whether a question is relevant whereas the last three set out a non-exhaustive series of circumstances or exceptions in which a question need not be answered. He then quoted extensively from *Merck & Co. Inc. v Apotex*, 2004 FC 1166 [Merck & Co], a decision where he insisted, in reference to the fifth principle set out by Justice McNair in *Reading & Bates*, above, on the need to maintain a balance between the broadest possible examinations for discovery and the tendency of parties, particularly in the field of intellectual property, to engage in fishing expeditions which should not be encouraged by the Court. The *Reading & Bates* fifth principle reads as follows at paragraph 10 of the decision:

[10] Before compelling an answer to any question on an examination for discovery, the court must weigh the probability of the usefulness of the answer to the party seeking the information, with the time, trouble, expense and difficulty involved in obtaining it. Where on the one hand both the probative value and the usefulness of the answer to the examining party would appear to be, at the most, minimal and where, on the other hand, obtaining the answer would involve great difficulty and a considerable expenditure of time and effort to the party being examined, the court should not compel an answer. One must look at what is reasonable and fair under the circumstances: *Smith, Kline & French Ltd. v. A.-G. Can.*, per Addy J. at p. 109.

[23] Still quoting from his decision in *Merck & Co.*, above, Prothonotary Morneau had this to say, on the basis of this Court's Judgment in *Westinghouse Electric Corp. v Babcock & Wilcox Industries Ltd.*, 15 FTR 154, (1987), 15 CPR (3d) 447, about the need for such balancing in patent infringement cases where the defendant is attacking the validity of the patent it allegedly infringed:

[15] This passage therefore testifies more particularly that in a patent infringement action in which the defendant is attacking the validity of the patent, the Court has little inclination to force the plaintiff to engage in disproportionate research to support the allegations of invalidity raised by the defendant when, inter alia, the conclusions sought by this defending party pertain primarily to the interpretation that the Court will give to the patent claims in light of its reading of the patent, the state of the applicable law and any expert evidence adduced by the parties, and not in terms of what the plaintiff may have thought or argued in the past as to the validity of the patent.

[16] Similarly, Mr. Justice Hugessen, in *Eli Lilly and Co. v Apotex Inc.* (2000), 8 C.P.R. (4th) 413 (upheld on appeal, at 12 C.P.R. (4th) 127), stated the following at pages 414-15 concerning the relevance of the inventor's knowledge about the obviousness of an invention:

I am not prepared to order the plaintiffs to produce documents relating to the state of knowledge of prior art on the part of the inventors or of the patentees at the time of the issue of the patents in suit. Such knowledge can only be relevant to the pleaded issue of obviousness. The test for obviousness is, in my view, and there is ample authority to this effect, an objective test. The touchstone is the person skilled in the art, whether or not the invention would have been obvious to that person. The actual knowledge of the inventor or inventors is irrelevant.

[Emphasis added]

[24] Further quoting from *Merck & Co* at paragraph 19 of the Order, Prothonotary Morneau relied on *Philips Export B.V. v Windmere Consumer Products Inc.*, 1 FTR 300, (1986) 8 CPR (3d) 505, to state that “a party may not be required, on an examination for discovery, to answer a question that forces it to express an opinion, whether it is an expert opinion, its interpretation of a patent or its beliefs.”

[25] Finally, he referred to Justice Roger Hughes's comments in *AstraZeneca Canada*, above, regarding the tendency of parties and counsel in patent infringement cases to use the discovery process to uncover as much as possible from the other side however marginally relevant so as to defeat the real purpose of discovery, which is directed to what a party truly requires for trial, and found them to be "forcefully" applicable to the present case (*AstraZeneca Canada*, at paras 6 and 19).

[26] It is "with that in mind, including the relevant jurisprudential principles, which comprehend those cited earlier as well as those raised by the parties" that Prothonotary Morneau disposed of Gore's motion to compel answers to the Refused Questions.

[27] So far, I do not see any failure in Prothonotary Morneau's approach and identification of the relevant applicable principles.

### **C. *The Refused Questions***

#### **(1) The Prosecution Questions**

[28] Gore claims that Prothonotary Morneau erred in law when he declined to compel Bard to answer a total of six questions pertaining to how the claimed numeric ranges within the 519 Patent were arrived at, on the basis that they were not relevant. More particularly, these questions essentially pertain to alleged discrepancies between what Dr. Goldfarb told his US Patent Agent, Mr. Sam Sutton, about these ranges and what Mr. Sutton put in the patent application.

[29] Gore says these questions - the Prosecution Questions (numbered 781 to 786 in Gore's Confidential Chart) - are relevant to its allegation that the disclosure of the 519 Patent is insufficient within the meaning of subsection 34(1) of the *Patent Act*, RSC, 195, c P-4 (the Act) because it is broader than what was contemplated by Dr. Goldfarb, as well as to its allegation that the 519 Patent is invalid pursuant to section 53 of the Act on the ground that the statements in said patent about the ranges of certain claimed features are incorrect and were wilfully made for the purpose of being misleading.

[30] Bard contends that Gore failed to direct the Court to specific legal principles which would have been wrongly considered or applied by Prothonotary Morneau and that what Gore is ultimately asking the Court to do is to substitute its own assessment of the same facts considered and arrive at conclusions different from those reached by the Prothonotary. This is indeed, in my view, what Gore's argument amounts to. As I indicated previously, this is not a permissible approach when one is appealing a Prothonotary's interlocutory, discretionary decision rendered in the context of case management. The burden on the appealing party is a heavy one and requires that it be shown that the impugned decision results from a clear misuse of judicial discretion. Overall, I am not satisfied that this demonstration has been made.

[31] Gore insists that relevance is a matter of law and that no deference is therefore owed to Prothonotary Morneau's decision regarding the Prosecution Questions. This, again, is not entirely correct. As Justice Hughes stated in *AstraZeneca Canada*, above, at paragraph 23, "law establishes if a question is relevant, discretion may be applied as to whether, nonetheless, it is appropriate to Order, or not to Order, that an answer be given." This, in my view, quite

appropriately sums up this Court's case law regarding relevancy and the nature of the decisions rendered in this respect by the Court's Prothonotaries.

[32] Here, it is clear from the reasons for Prothonotary Morneau's decision that he was not only concerned with the relevance of the Prosecution Questions, from a strict legal technical standpoint, but also with the need to balance the usefulness of the information sought with the trouble and inconvenience involved in obtaining it, the Court's little inclination to force a plaintiff to engage in disproportionate research to support the allegations of patent invalidity often raised by the defendant in an action for patent infringement, and the tendency, observed by Justice Hughes in *AstraZeneca Canada*, above, by parties and counsel in patent infringement cases to lose sight of the real purpose of discovery by attempting to uncover as much as possible from the other side however marginally relevant.

[33] As Bard points out, Gore is asking Bard, through the Prosecution Questions, to answer questions pertaining to private discussions between Dr. Goldfarb and his then US Patent agent, Mr. Sutton, neither of whom are parties to the present proceedings or within the control of Bard, in an effort to arrive at what Dr. Goldfarb contemplated the 519 Patent to be.

[34] In my view, it was open to Prothonotary Morneau, based on the considerations outlined in his Order, to find that the Prosecution Questions need not be answered. These considerations were all valid and supported by this Court's jurisprudence. I also agree with Bard that the case of *Ratiopharm Inc. v Pfizer Limited*, 2009 FC 711, 350 FTR 250 [*Ratiopharm*], relied on by Gore to argue that what was contemplated by Dr. Goldfarb is relevant to Gore's patent invalidity

counterclaim, is distinguishable from the present case as evidence regarding what was contemplated by the inventors in that case was provided to the Court by the inventors themselves “live in the witness box” at trial and was so provided in a context where the Court will normally look at the patent itself in order to determine its sufficiency within the meaning of subsection 34(1) of the Act (*Ratiopharm*, above at paras 188 to 190). As Bard points out, *Ratiopharm* was brought to the attention of Prothonotary Morneau and I agree that it was within his discretion to distinguish it from the present scenario.

[35] Bard claims that in any event, answers to the Prosecution Questions cannot be compelled on discovery as these questions relate to privileged communications between Dr. Goldfarb and his then US patent attorney, Mr. Sutton. This argument was not considered by Prothonotary Morneau as it was submitted on the eve of the hearing of the parties’ motions to compel answers. This issue was discussed at some length by the parties at the hearing of Gore’s appeal. However, given my conclusion that there is no basis to interfere with Prothonotary Moneau’s finding regarding the Prosecutions Questions, there is no need to determine Bard’s privilege assertion in this appeal.

## **(2) The Aneurysm Questions and the Pore Size Question**

[36] There are six Aneurysm Questions and one Pore Size Question at issue (numbered 1224, 1225, 1237, 1238, 1239, 1246 and 1073 in Gore’s Confidential Chart). With respect to Question 1224, Gore claims that Prothonotary Morneau erred in law by declining to order Bard to provide an answer on the basis that this question is not relevant. Question 1224 sought Bard’s knowledge, information, and belief about the alleged failure of certain early Gore products with a



wall thickness between 0.2 and 0.8 mm. Bard contends that Gore's submissions shed no light as to how knowledge of the specification of Gore's product is relevant and that in any case, to the extent that this question concerns Gore's own products, there are other means for Gore to obtain the information sought.

[37] Again, relevance alone does not determine whether an answer is to be given as there are other matters to be considered. As we have seen, deference is owed to a Prothonotary's decision regarding his or her consideration of those other matters and the burden on the party seeking to set aside such a decision is a heavy one, the test being not whether I might have arrived at a different result had I been hearing the matter in first instance but whether the decision amounts to a clear case of misuse of judicial discretion. Having read the context in which Question 1224 was put to Bard's representative, I will not interfere with Prothonotary Morneau's exercise of discretion in ordering that this question need not be answered even if I might have arrived at a different result had I been hearing the matter at first instance.

[38] As for the remaining Aneurysm Questions and the Pore Size Question, Gore claims that Prothonotary Morneau erred in law in declining to order Bard to answer these questions on the ground that they required an opinion. More particularly, Gore contends that Prothonotary Morneau erred in principle by adopting Bard's blanket statement that questions seeking to elicit an opinion are not permitted. It says that this goes against the teachings of the Federal Court of Appeal's decision in *Bell Helicopter*, above, which stresses the fact that although the general principles set out in the case law regarding questions requiring an expression of opinion are

useful, these principles do not provide a magic formula applicable to all situations and require, therefore, a case-by-case, or question-by-question, analysis (*Bell Helicopter*, above at para 13).

[39] Bard submits that each of these questions do elicit its representative's opinion on the functioning of early Gore products and the alleged occurrence of certain graft failures as well as his interpretation as to the beliefs of others concerning the technical issues and conclusions discussed in the referred-to scientific publication. More particularly, Bard argues that nothing suggests that Prothonotary Morneau accepted its submission in this regard without proper consideration of the application of the law to the facts of the case or that he went against the directives of the Federal Court of Appeal in *Bell Helicopter*, above.

[40] Bard claims that Gore has therefore failed to establish that Prothonotary Morneau's analysis of the remaining Aneurysm Questions and of the Pore Size Question was based upon a wrong legal principle or a misapprehension of the facts of the case and that as a result, Gore has not established that a *de novo* examination is required to decide where these questions need to be answered. I agree. There is indeed nothing to suggest that Prothonotary Morneau did not proceed on a question-by-question basis. As Bard points out, this Court has held on many occasions that it is virtually impossible for the Court's Prothonotaries to give detailed reasons for each order issued by them given the number of motions they have to decide, including burdensome motions seeking to compel answers to questions put on discovery where hundreds of question must often be considered, as was the case here, and where the only practical way to dispose of answerability issues is to state reasons cryptically (*Foseco Trading AG v Canadian Ferro Hot Metal Specialties Ltd*, 46 FTR 81, 36 CPR (3d) 35, at para 5; *AstraZeneca Canada*,

above at paras 19 and 25). As the Court further held in this regard, this is no reason to set aside Prothonotaries' decisions or to determine them *de novo* (*AstraZeneca Canada*, above at para 25; *Anchor Brewing Co. v The Sleeman Brewing & Malting Co.*, 2001 FCT 1066, 15 CPR (4th) 63, at para 31).

[41] Whether a question elicits opinion or fact is often not clear. It requires a contextualized measure of judgment. As the Court has stated on a number of occasions, Prothonotaries, in their case-management capacity in particular, are in the best position to direct and control the discovery process due to their intimate knowledge of the history and details of casemanaged matters (*Galerie au chocolat Inc. v Orient Overseas Container Line Ltd*, 2010 FC 327, at para 10). In such matters, the office of a Prothonotary is not a mere "preliminary "rest-stop" along the procedural route to a motion judge" (*Aqua-Gem*, above at para 70).

[42] On examining the remaining Aneurysm Questions and the Pore Size Question in context and considering the submissions of Gore's counsel, I am not satisfied that Prothonotary Morneau was wrong in ordering that these questions need not be answered. Again, this is not an instance of clear misuse of judicial discretion.

[43] On the whole, I see no reason to interfere with Prothonotary Morneau's finding that the Refused Questions need not be answered.

**D. *Prothonotary Morneau's Determination on Costs***

[44] Gore claims that Prothonotary Morneau erred by awarding costs to Bard at the top of Column IV of Tariff B of the Rules. It contends that Prothonotary Morneau failed to give sufficient weight to paragraph 400(3)(k) of the Rules by not considering whether any step in the proceeding was improper, vexatious or unnecessary. In particular, Gore says that Prothonotary Morneau misapprehended the facts by not considering that the magnitude of its motion to compel answers was the result of Bard's excessive use of "under advisements" and improper refusals at the examination for discovery and by not considering Bard's decision to answer more than 300 questions after Gore's motion was brought.

[45] Bard responds that Gore's position proceeds from an erroneous understanding of Prothonotary Morneau's determination on costs. Bard claims that what prompted Prothonotary Morneau's determination is not Gore's initial motion seeking answers to some 940 questions but its motion, as it stood at the time of the hearing before Prothonotary Morneau, which still sought adjudication of over 450 questions in clear disregard of the purpose of discovery, jurisprudence related thereto, and the recommendations set out in the Proportionality Guidelines, all of which were properly taken into account by Prothonotary Morneau. Coupled with the fact that Bard was not ordered to pay costs to Gore because it "managed to reduce considerably the number of questions to be adjudicated" (to six), Bard submits that Prothonotary Morneau exercised his discretion within the appropriate framework and that there is therefore no basis to interfere with his costs determination.

[46] I agree with Bard. Rule 400 of the Rules provides the Court with “full discretionary power over the amount and allocation of costs and the determination of by whom they are to be paid.” In other words, costs awards are highly discretionary and I have not been convinced by Gore that Prothonotary Morneau’s determination as to costs resulted from an improper exercise of discretion.

[47] As for this appeal, each party is claiming costs. Since it is the successful party to this appeal, costs, to be assessed in accordance with Column III of the table to Tariff B, are awarded to Bard in any event of the cause.

**ORDER**

**THIS COURT ORDERS that:**

1. The motion on appeal of Prothonotary Morneau's Order dated August 24, 2015, is dismissed; and
2. Costs shall be assessed in accordance with Column III of the table to Tariff B, payable in any event of the cause to the Plaintiffs/Defendants by counterclaim.

"René LeBlanc"

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Judge

**FEDERAL COURT**  
**SOLICITORS OF RECORD**

**DOCKET:** T-2105-13

**STYLE OF CAUSE:** BARD PERIPHERAL VASCULAR, INC. AND BARD CANADA INC. v W.L. GORE & ASSOCIATES, INC. AND W.L. GORE & ASSOCIATES CANADA INC.

**PLACE OF HEARING:** TORONTO, ONTARIO

**DATE OF HEARING:** SEPTEMBER 29, 2015

**ORDER AND REASONS:** LEBLANC J.

**DATED:** OCTOBER 16, 2015

**APPEARANCES:**

Ms. Joanne Chriqui  
Mr. Eric Bellemare

FOR THE PLAINTIFF

Mr. Jonathan Giraldi  
Mr. Sean Jackson

FOR THE DEFENDANT

**SOLICITORS OF RECORD:**

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FOR THE PLAINTIFF

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