

Date: 20031008

Docket: T-754-01

Citation: 2003 FC 1174

Montréal, Quebec, October 8, 2003

Present: RICHARD MORNEAU, ESQ., PROTHONOTARY

BETWEEN:

BAUER NIKE HOCKEY INC.

**Plaintiff/
Defendant by Counterclaim**

and

PAUL REGAN

**Defendant/
Plaintiff by Counterclaim**

REASONS FOR ORDER AND ORDER

[1] The Court is faced herein with two motions, one from the Plaintiff and Defendant by Counterclaim (the Plaintiff) and the other from the Defendant and Plaintiff by Counterclaim (the Defendant), directed to outstanding questions from the examination for discovery of representatives of the parties.

Background

[2] The action herein concerns Canadian Letters Patent No. 2,219,072 owned by the Defendant. The 072 patent relates to a protective hockey turtleneck product worn by hockey players.

[3] The Plaintiff has alleged that the 072 patent is invalid on a number of grounds.

[4] The Defendant has denied that the 072 patent is invalid, and has brought a counterclaim alleging infringement of the patent in respect of three of the Plaintiff's products.

The Law on Questions on Discovery

[5] As stated by MacKay J. in *Sydney Steel Corp. v. Omisalj (The)*, (1992) 2 F.C. 193, at page 197:

(...) [T]he standard for propriety of a question asked in discovery (...) is whether the information solicited by a question may be relevant to the matters which at the discovery stage are in issue on the basis of pleadings filed by the parties.

[6] Despite this broad statement of principle, though, there are some limits on the ambit of an examination for discovery, one of which is that far-reaching questions in the nature of a fishing expedition are to be discouraged (see *Reading & Bates Construction Co. v. Baker Energy Resources Corp.* (1988), 24 C.P.R. (3d) 66 (F.C.T.D.), at page 72).

[7] With this in mind, I shall now evaluate the propriety of the questions and documents requested.

Analysis

I. Defendant's Motion

[8] I shall deal with this motion first.

[9] The only remaining question under this motion (Question 226) concerns monetary payments made by the Plaintiff Bauer to a third party, DuPont Canada Inc. (DuPont).

[10] Bauer has produced the licence between itself and DuPont for the subject matter of DuPont's patent application (a hockey undershirt type product with built in neck protection). DuPont's hockey undershirt product disclosed in its patent application contains similar features as those disclosed by Regan to Bauer. The licensing agreement between Bauer and DuPont provides that Bauer is to pay DuPont a royalty of fifty cents per unit sold. Regan would like to know whether Bauer has actually paid, to date, any royalties, and if so, what they were.

[11] Since the Plaintiff has pleaded that the invention of the patent in suit was obvious, it follows that in so doing the Plaintiff raised commercial success (see *James River Corp. of*

Virginia v. Hallmark Cards, Inc. (1997), 72 C.P.R. (3d) 157, at 163-164). Question 226 goes to commercial success and therefore it must be answered.

[12] Costs on this motion shall be in the cause.

II. Plaintiff's Motion

[13] In said motion, the questions upon which the Court needs to adjudicate have been grouped into four categories. I shall deal with each category in turn.

Category 1

[14] The sole question (Question 1177-1180) in this category asks for the names and addresses of people who played hockey with the Defendant in 1997 and 1998.

[15] The Defendant admitted on discovery that he wore a sample of his turtleneck product at one of his hockey games. However, the Defendant was unable to recall exactly when this took place.

[16] Therefore, if Mr. Regan disclosed his turtleneck protector more than one year prior to the filing of the application for the 072 patent (October 27, 1997), this may serve to invalidate the patent.

[17] Certainly, a disclosure at any time in 1997 or 1998 would not invalidate the patent in suit. However, since it appears that the Defendant's teammates over the years have remained essentially the same, it is reasonable to believe that one or more of these individuals might recall a disclosure that dates back more than one year prior to the filing of the application for the patent in suit.

[18] Consequently, Question 1177-1180 shall be answered.

Category 2

[19] The two questions in this category (Questions 884-887 and 888) pertain to the bills and cheques issued for the preparation and prosecution of the patent application and the entire patent agent file.

[20] Regardless of whether or not the above information is subject to solicitor-client privilege, I do not intend to order that the said questions be answered since I share the position expressed by the Defendant in paragraphs 16 to 19 of his written representations filed in opposition to the motion at bar.

Category 3

[21] There are eight (8) questions in this category dealing with prior art products.

[22] Each of the said questions asks Regan to examine a particular product, as shown in a series of catalogues that were included in Bauer's productions (the products are manufactured by third party competitors) and identify the "technical differences" between that product and a Bauer product that is claimed to infringe the 072 patent.

[23] It appears, however, that the Defendant has never seen any of the products shown in the catalogues.

[24] In addition, by asking the Defendant to provide the "technical differences" between two products "in the context of the language of claims 6 to 17 of the 072 Patent", he is in essence being asked to interpret the patent. However, the Defendant, although he is the inventor of the patent in suit, has not been put forward as an expert.

[25] I agree with the Defendant that a technical description of a product manufactured by a third party competitor is not a task that reverts to the Defendant.

[26] For the above reasons, the eight (8) questions in this category are inappropriate and need not be answered.

Category 4

[27] The two questions (Questions 1229 and 1230) in this category deal with some technical aspects of the Defendant's own product. These questions can be considered relevant to the issue of validity and infringement. In addition, contrary to the questions in category 3, the questions in category 4 go to technical facts that can be addressed by the Defendant since he is the inventor of the patent and someone with a number of years of experience in the hockey equipment industry. Therefore, the two questions under this category shall be answered.

[28] As success is divided on this motion, no costs are awarded.

[29] Within the next ten (10) days, the parties, on a joint basis, shall transmit to the Court a draft order that will implement a timetable addressing the various matters covered in the instant reasons for order and order as well as the deadlines found in paragraphs 9 to 12 of the order of this Court dated December 17, 2002.

Richard Morneau

Prothonotary

FEDERAL COURT

Date : 20031008

Docket : T-754-01

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BAUER NIKE HOCKEY INC.

**and
PAUL REGAN**

**Plaintiff/
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REASONS FOR ORDER AND ORDER

FEDERAL COURT

COUNSEL AND SOLICITORS OF RECORD

DOCKET: T-754-01

STYLE OF CAUSE: BAUER NIKE HOCKEY INC. Plaintiff/
Defendant by Counterclaim

and

PAUL REGAN Defendant/
Plaintiff by Counterclaim

PLACE OF HEARING: Montreal, Quebec

DATE OF HEARING: September 29, 2003

REASONS FOR ORDER OF RICHARD MORNEAU, ESQ., PROTHONOTARY

DATED: October 8, 2003

APPEARANCES:

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Mr. Gregory A. Piassetzki for the Defendant/Plaintiff by Counterclaim

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