

Federal Court



Cour fédérale

**Date: 20080829**

**Docket: T-1856-06**

**Citation: 2008 FC 979**

[ENGLISH TRANSLATION]

**Montréal, Quebec, August 29, 2008**

**PRESENT: Richard Morneau, Esq., Prothonotary**

**BETWEEN:**

**RAYMOR INDUSTRIES INC.  
and  
INSTITUT NATIONAL DE RECHERCHE SCIENTIFIQUE**

**Plaintiffs**

**and**

**NATIONAL RESEARCH COUNCIL OF CANADA  
BENOIT SIMARD, ORSON BOURNE,  
UNIVERSITY OF SHERBROOKE  
and  
GERVAIS SOUCY**

**Defendants**

**AND BETWEEN:**

**NATIONAL RESEARCH COUNCIL OF CANADA**

**Plaintiff by counterclaim**

**and**

**INSTITUT NATIONAL DE LA RECHERCHE SCIENTIFIQUE**

**Defendant by counterclaim**

**REASONS FOR ORDER AND ORDER**

[1] The parties in this case have filed six (6) motions with the Court as part of an action for patent infringement and invalidity.

[2] Those motions are as follows:

- I. Motion by the plaintiffs seeking leave to question various people and for the production of documents;
- II. Motion by the plaintiffs to obtain an order to inspect devices;
- III. Motion by the defendants, the University of Sherbrooke and Gervais Soucy, seeking permission to amend their defence and add a counterclaim;
- IV. Motion by the defendants, the University of Sherbrooke and Gervais Soucy, under Rule 151 of the *Federal Court Rules* seeking a confidentiality order;
- V. Motion by the plaintiffs seeking determination of objections;
- VI. Motion by the defendants the National Research Council of Canada, Benoit Simard, Orson Bourne—joined by the defendants the University of Sherbrooke and Gervais Soucy—seeking determination of objections.

## **Background**

[3] These motions are brought as part of an action for infringement on Canadian patent No. 2,499,850 issued for an invention entitled “*Method And Apparatus For Producing Single-Wall Carbon Nanotubes*” (hereinafter the ‘850 patent). The ‘850 patent was issued to the plaintiff, the Institut national de recherche scientifique (hereinafter INRS), which then granted a commercial operating licence for the patented technology to the defendant Raymor Industries Inc. (hereinafter Raymor).

[4] The application for the ‘850 patent was filed on May 9, 2003, and was published on November 20, 2003. The ‘850 patent was issued on January 2006 and indicated May 9, 2002, as the priority date.

[5] In their *Statement of Claim*, the plaintiffs allege in particular that the defendants violate the ‘850 patent in their scientific research activities and hinder Raymor’s commercial activities due to the alleged efforts of the defendant, the National Research Council of Canada (hereinafter the NRC), to market a technology developed jointly by the defendant, the University of Sherbrooke (hereinafter the University), and the NRC in violation of the ‘850 patent (hereinafter the Alleged Infringing Technology).

[6] In their *Statement of Claim and Counterclaim* filed on February 26, 2007, the defendants, the NRC, Benoit Simard and Orson Bourne (collectively the NRC defendants), deny that the

Alleged Infringing Technology violates the '850 patent and allege that the patent is invalid for several reasons.

[7] In their defence filed on February 28, 2007, the defendants, the University of Sherbrooke and Gervais Soucy (collectively the University of Sherbrooke defendants), essentially only deny that the Alleged Infringing Technology used at the University for scientific research purposes violates the '850 patent.

[8] Following the filing of a certain number of preliminary motions and the service of affidavits of documents from the parties, a first round of examination for discovery of the parties' representatives took place in August and September 2007.

[9] In Motion No. IV, above, at paragraph [2], the University of Sherbrooke defendants are now seeking to amend their defence by adding a counterclaim. The purpose of the amendments proposed by the University of Sherbrooke defendants and the conclusions in their counterclaim are as follows:

- a. to allege the steps in the development of the Alleged Infringing Technology in order to explain that it cannot be the result of an illegal appropriation of scientific information developed by INRS as claimed by the defendants, and to provide context for the scientific information provided to the defendants during the first round of examination for discovery;

- b. to show that the Alleged Infringing Technology was designed and was publicly disclosed before the first application for the '850 patent was filed and that, if that patent is interpreted as being broad enough to include the Alleged Infringing Technology, it must thus be considered invalid;
- c. to allege various grounds for the invalidity of the '850 patent or certain specific claims in it, i.e.:
  - i. the lack of novelty (prior art showing the invention was identified);
  - ii. the lack of inventiveness (prior art identified shows that the solution proposed in the '850 patent for the problem identified was clear to any person familiar with art at the relevant time);
  - iii. some claims involve more than what was invented and described in the '850 patent;
  - iv. some claims involve accomplishments of the invention that cannot function.

[10] Regarding the invention more specifically referred to in the '850 patent, the NRC defendants describe it as follows at paragraphs 4 and 5 of their written submissions as part of motion number VI at paragraph [2], above:

- 4. In particular, the patent in suit allegedly teaches a method and apparatus that overcomes the problem of producing sufficient quantities of single-wall carbon nanotubes

(SWCNT) in a continuous manner for most industrial and commercial applications. In order to accomplish this, the method and apparatus taught by the patent in suit allegedly eliminates carbon deposits within a plasma torch, thereby avoiding premature extinguishment.

(...)

5. The method and apparatus of the alleged invention “involves supplying a carbon-containing substance at the plasma discharging end of the [plasma] torch. By supplying the carbon-containing substance downstream of the inert gas feed, the invention allows the formation of single-wall carbon nanotubes without significant carbon deposits within the torch. The metal catalyst may be fed at the discharge end, either separately from or together with the carbon-containing substance. Alternatively, the catalyst may be fed at the inlet of the torch, for example with the inert gas feed.”

[11] It must be noted that the Alleged Infringing Technology allows, *inter alia*, for the production of SWCNT.

[12] Regarding that Alleged Infringing Technology, it must be noted that, on March 14, 2006, the NRC defendants filed an application for an international patent entitled “*Method and Apparatus For the Continuous Production and Functionalization of Single-Walled Carbon Nanotubes Using a High Frequency Plasma Torch*” under publication number WO 2006/096964, published on September 21, 2006, and naming Benoît Simard, Christopher Thomas Kingston, Stéphane Dénomée, Gervais Soucy and Germain Cota-Sanchez as the inventors.

[13] Based on this context, we can now consider the motions mentioned above in order.

**I. Motion by the plaintiffs seeking leave to question various people and for the production of documents**

[14] This motion more specifically seeks leave to examine the following three people:

1. German Cota-Sanchez, a person not party to the litigation;
2. Christopher Thomas Kingston, a Research Officer with NRC SIMS;
3. Stéphane Dénomme, a Technical Officer with NRC-SIMS (Steacie Institute of Molecular Science).

[15] This same motion also seeks to obtain an order under Rule 225 of the *Federal Courts Rules* (the Rules) requiring that the defendants provide full disclosure of relevant documents and submit full unredacted versions of documents already provided.

[16] After examining the parties' motion records and their oral submissions, and for the following reasons, I will not allow, for the NRC defendants, any of the remedies sought here by the defendants and, for the University of Sherbrooke defendants, I will not allow the first two remedies sought here by the defendants, but will, however, allow the application to provide full unredacted documents.

[17] Regarding the people to be examined, counsel for the plaintiffs claimed during oral arguments before the Court that it must be understood from the motion record filed that the examination of Mr. Cota-Sanchez was sought under Rule 238 and that the testimonies of

Mr. Kingston and Mr. Dénommée was not sought under that rule. However, only Rule 238 is cited regarding the examination of any person as part of the motion. As well, the very text of the motion and that of the written submissions clearly indicate that the three people mentioned above are sought under Rule 238.

[18] This position expressed by counsel for the plaintiffs at the hearing surprised the Court and all the defendants. The Court and the defendants were unable to assess and react to such a change in approach. Consequently, to not delay the case and to hold the parties to what they raised in their motion records, the Court did not allow the defendants to allege and claim that the examination of Mr. Kingston and Mr. Dénommée should be allowed on a different basis, even though those individuals could provide testimony at trial regarding the Alleged Infringing Technology.

[19] Rule 238 reads as follows:

**238.** (1) A party to an action may bring a motion for leave to examine for discovery any person not a party to the action, other than an expert witness for a party, who might have information on an issue in the action.

(2) On a motion under subsection (1), the notice of motion shall be served on the other parties and personally served on the person to be examined.

**238.** (1) Une partie à une action peut, par voie de requête, demander l'autorisation de procéder à l'interrogatoire préalable d'une personne qui n'est pas une partie, autre qu'un témoin expert d'une partie, qui pourrait posséder des renseignements sur une question litigieuse soulevée dans l'action.

(2) L'avis de la requête visée au paragraphe (1) est signifié aux autres parties et, par voie de signification à personne, à la personne que la partie se propose d'interroger.



(3) The Court may, on a motion under subsection (1), grant leave to examine a person and determine the time and manner of conducting the examination, if it is satisfied that

(a) the person may have information on an issue in the action;

(b) the party has been unable to obtain the information informally from the person or from another source by any other reasonable means;

(c) it would be unfair not to allow the party an opportunity to question the person before trial; and

(d) the questioning will not cause undue delay, inconvenience or expense to the person or to the other parties.

[Emphasis added.]

(3) Par suite de la requête visée au paragraphe (1), la Cour peut autoriser la partie à interroger une personne et fixer la date et l'heure de l'interrogatoire et la façon de procéder, si elle est convaincue, à la fois :

a) que la personne peut posséder des renseignements sur une question litigieuse soulevée dans l'action;

b) que la partie n'a pu obtenir ces renseignements de la personne de façon informelle ou d'une autre source par des moyens raisonnables;

c) qu'il serait injuste de ne pas permettre à la partie d'interroger la personne avant l'instruction;

d) que l'interrogatoire n'occasionnera pas de retards, d'inconvénients ou de frais déraisonnables à la personne ou aux autres parties.

[Je souligne.]

[20] It must be noted that Mr. Kingston and Mr. Dénomée are not persons who are not party to the litigation, but are employees of the NRC defendants.

[21] Consequently, Mr. Kingston and Mr. Dénomée are not respectively a "person not party to the action" under Rule 238(1).

[22] Moreover, and as noted above, although these two individuals may have relevant information on an issue in the action (Rule 238(3)(a)), I am not satisfied that the various criteria set out in Rules 238(3)(b) and (c) have been met here. This latter comment is also true for Mr. Sanchez.

[23] Although the plaintiffs note that the witnesses questioned to date are not the ones who conducted the experimental portions of the Alleged Infringing Technology and that those witnesses could not answer certain essential questions, the plaintiffs have not truly submitted any evidence in an affidavit that clearly establishes these points and the essential questions to which the plaintiffs may wish to refer.

[24] Mr. Sanchez, Mr. Kingston and Mr. Dénommée could certainly be seen by the plaintiffs as very likely witnesses at trial. However, that is not a situation that authorizes the plaintiffs to seek examination under Rule 238. As seen in the summary of *Nfld. Processing Ltd. v. "South Angela" (The)* (1988), 24 F.T.R. 116, at page 621 of the *Federal Court Practice, 2008*:

A party cannot attempt to examine witnesses outside of trial by means of discovery. An examination for discovery is not meant to be a fishing expedition where different witnesses are examined as to the events. It is meant to allow a party to examine someone who is knowledgeable about the allegations in the pleadings and who has the authority to bind the party for whom he is answering.

[25] Under the circumstances, we must consider that relevant information in this case, including on the basis of documents recently provided in April 2008 following the amended

confidentiality order, must be sought from representatives of the defendants who have at this time been examined for discovery.

[26] Regarding the plaintiffs' application to obtain fuller disclosure of documents by the defendants, the plaintiffs simply identified certain broad groups of documents in their written submissions, but without suggesting any persuasive evidence that certain specific documents are available and were not provided (see *Havana House Cigar & Tobacco Merchants Ltd. v. Naeni*, (1998) 80 C.P.R. (3d) 132, 147 F.T.R. 189; affirmed in (1998) 80 C.P.R. (3d) 563, 145 F.T.R. 197). Moreover, certain questions to be considered in the plaintiff's motion to decide on the objections are related to obtaining documents.

[27] Moreover, the documents that have been partially provided to date correspond to the documents referred to by Gauthier J. of this Court in his order on April 18, 2008. Although the affidavit by Gervais Soucy on August 6, 2008, filed by the University of Sherbrooke defendants against this part of the motion being considered alleges that the removed or redacted portions of the documents are related to aspects not relevant to this litigation, the fact remains, based on my analysis and assessment, that the text if not the spirit of the order by Gauthier J. on April 18, 2008 requires the full, unredacted disclosure of those documents to Mr. Laurent Debrun as "Restricted Access Documents" covered by the order by Gauthier J. on April 18, 2008, and to be treated from an access and confidentiality standpoint in accordance with the relevant paragraphs of that order on April 18, 2008.

[28] This motion by the plaintiffs against the NRC defendants will therefore be dismissed entirely with costs to the defendants under column III of Tariff B.

[29] Regarding the University of Sherbrooke defendants, this motion by the plaintiffs will be dismissed in terms of the remedy related to the examination of individuals and the fuller production of documents, but will be allowed in terms of the production of unredacted documents by the University of Sherbrooke defendants. Those documents shall be submitted to Laurent Debrun within thirty (30) days of this order, as “Restricted Access Documents” covered by the order by Gauthier J. on April 18, 2008, and to be treated from an access and confidentiality standpoint in accordance with the relevant paragraphs of that order on April 18, 2008.

[30] Regarding costs on this motion for the University of Sherbrooke defendants, although the plaintiffs are partly right on one of the three aspects of this motion, given that this motion in fact included three different components, the University of Sherbrooke defendants are nonetheless granted their costs on this motion, but for only one series of costs under column III of Tariff B.

[31] I must now consider Motion II above, a motion by the plaintiffs to obtain an order under Rule 249 to inspect devices at the defendants’ premises that purportedly constitute the Alleged Infringing Technology.

## **II Motion by the applications seeking an order authorizing the inspection of devices**

[32] If the Court understands correctly, these devices purportedly constitute the Alleged Infringing Technology, one at the premises of the NRC in Ottawa and two other devices at the University.

[33] Under Rule 249, on motion, where the Court is satisfied that it is necessary or expedient for the purpose of obtaining information or evidence in full, the Court may order, in respect of any property that is the subject-matter of an action or as to which a question may arise therein, that:

- a. a sample be taken of the property;
- b. an inspection be made of the property; or
- c. an experiment be tried on or with the property.

[34] Moreover, under Rule 249(2), if an order is issued in this regard, the Court may, for the order to be carried out, authorize a person to enter any land or building where the property in question is located.

[35] More specifically, Rule 249 reads as follows:

**249.** (1) On motion, where the Court is satisfied that it is necessary or expedient for the purpose of obtaining information

**249.** (1) La Cour peut, sur requête, si elle l'estime nécessaire ou opportun pour obtenir des renseignements

or evidence in full, the Court may order, in respect of any property that is the subject-matter of an action or as to which a question may arise therein, that

- (a) a sample be taken of the property;
- (b) an inspection be made of the property; or
- (c) an experiment be tried on or with the property.

(2) An order made under subsection (1) may authorize a person to enter any land or building where the property is located for the purpose of enabling the order to be carried out.

(3) Where a motion is brought under subsection (1) for an order in respect of property that is in the possession of a person who is not a party to the action, that person shall be personally served with notice of the motion.

[Emphasis added.]

complets ou une preuve complète, ordonner à l'égard des biens qui font l'objet de l'action ou au sujet desquels une question peut y être soulevée :

- a) que des échantillons de ces biens soient prélevés;
- b) que l'examen de ces biens soit effectué;
- c) que des expériences soient effectuées sur ces biens ou à l'aide de ceux-ci.

(2) Dans l'ordonnance rendue en vertu du paragraphe (1), la Cour peut, pour en permettre l'exécution, autoriser une personne à entrer sur le terrain ou dans le bâtiment où se trouvent les biens.

(3) Lorsqu'une requête présentée en vue de l'obtention d'une ordonnance aux termes du paragraphe (1) vise des biens qui sont en la possession d'une personne qui n'est pas une partie à l'action, l'avis de requête est signifié à personne à cette dernière.

[Je souligne.]

[36] As for the device located at the NRC, and in addition to the aspects that the NRC considers to be irrelevant and confidential, as argued by Benoît Simard in his affidavit dated August 7, 2008, the NRC has submitted several hundred documents to date in this case. The value of those documents for the purposes of this dispute compared to an examination of the device in question is, in my opinion, reasonable under paragraphs 8 and 9 of that affidavit, which state:

8. (...) As noted above, the documents include detailed schematics of the internal components of the NRC apparatus including the plasma torch and downstream apparatus. The documents produced by NRC show far more detail of the torch and downstream apparatus than would be revealed by visual inspection. This is because a visual inspection cannot reveal the inner structure of the torch and downstream apparatus which is at issue in this proceeding. However, the schematics produced by NRC do show such inner structure.

9. Furthermore, it is not possible to ascertain NRC's method for production of SWCNTs vis-à-vis the plasma torch through an onsite inspection or demonstration. As noted above, an onsite inspection would not allow one to see the inner workings of the plasma torch or the manner in which it is operating which are at issue in this proceeding. (...)

[37] Moreover, and fundamentally, as noted by Mr. Simard in paragraph 12 of the same affidavit, the plaintiffs did not submit evidence to justify why the documents, schematics, photographs and questions answered thus far do not meet the relevant knowledge needed regarding the NRC device. Paragraph 12 reads as follows:

12. The plaintiffs have not described what relevant components of NRC's facility or process have not been already fully disclosed in documents, schematics, photographs or answers to discovery questions. The plaintiffs have not explained why or how the hundreds of documents produced by NRC are insufficient. The plaintiffs have not identified why it is necessary to view NRC's facility. It is not necessary to carry out an experiment to show the plaintiffs that NRC produces SWCNT because NRC has from the beginning stated that it does produce SWCNT.

[38] Therefore, in that it seeks authorization to inspect the NRC device and other remedies, such as the collection of a sample, the plaintiffs' motion is dismissed, with costs.

[39] Moreover, regarding the devices located at the University, the Court applies the same approach as was applied for the NRC device. As such, the Court adopts here the views expressed by the University of Sherbrooke defendants in paragraphs 11 and 12 of their written submissions, which read:

[TRANSLATION]

11. Given the information now available to them, the plaintiffs had to justify their inspection request based on concrete and relatively precise facts that establish their actual need for such an inspection and their actual inability to obtain certain relevant information by another means. Their broad allegations, not supported by the evidence submitted, that the defendants are trying to conceal the equipment in question and their allegations regarding the inability to “administer the best evidence possible” is not a sufficient demonstration in that regard.

12. To the contrary, the plaintiffs themselves establish that they have in their possession technical documents that give a detailed description of the device in question, which should fully allow them to demonstrate an infringement as required for the court.

[40] Therefore, in that it seeks authorization to inspect the University of Sherbrooke devices and other remedies, such as the collection of a sample, the plaintiffs’ motion is dismissed, with costs.

[41] We must now consider the University of Sherbrooke defendants’ motion seeking permission to amend their defence and add a counterclaim.



**III Motion by the University of Sherbrooke defendants seeking permission to amend their defence and add a counterclaim**

[42] This motion was not challenged on August 27, 2008; the Court allowed the motion in a separate order. That order sets forth the terms agreed to by the parties regarding the leave to amend.

[43] It is now time to briefly discuss motion IV, mentioned in paragraph [2] above, i.e. a motion by the University of Sherbrooke applications under Rule 151.

**IV. Motion by the University of Sherbrooke defendants under Rule 151 seeking a confidentiality order**

[44] This motion was finally filed with the consent of all parties and was allowed by an order in that regard, issued separately on August 26, 2008.

[45] We can now look at motions V and VI mentioned in paragraph [2] above, i.e. the respective motions by the parties seeking determination of objections.

[46] Before doing so, however, we must touch on the general principles applicable to the questions to be answered and the documents to be filed during examination for discovery.

## **Questions to be answered and documents to be filed during examination for discovery**

### **Applicable principles**

[47] In *Reading & Bates Construction Co. and al v. Baker Energy Resources Corp. and al* (1988), 24 C.P.R. (3d) 66, in a general six-point reminder, McNair J. first defined in points 1 to 3 the parameters that make a question or a document relevant and then, in points 4 to 6, listed a series of circumstances or exceptions that, in the end, in any case, are such that a question need not be answered or a document need not be filed.

[48] The Court states the following at pages 70 to 72:

1. The test as to what documents are required to be produced is simply relevance. The test of relevance is not a matter for the exercise of the discretion. What documents parties are entitled to is a matter of law, not a matter of discretion. The principle for determining what document properly relates to the matters in issue is that it must be one which might reasonably be supposed to contain information which may directly or indirectly enable the party requiring production to advance his own case or to damage the case of his adversary, or which might fairly lead him to a train of inquiry that could have either of these consequences: *Trigg v. MI Movers Int'l Transport Services Ltd.* (1986), 13 C.P.C. (2d) 150 (Ont. H.C.); *Canex Placer Ltd. v. A.-G. B.C.* (1975), 63 D.L.R. (3d) 282, [1976] 1 W.W.R. 644 (B.C.S.C.); and *Compagnie Financiere et Commerciale du Pacifique v. Peruvian Guano Co.* (1882), 11 Q.B.D. 55 (C.A.).

2. On an examination for discovery prior to the commencement of a reference that has been directed, the party being examined need only answer questions directed to the actual issues raised by the reference. Conversely, questions relating to information which has already been produced and questions which are too general or ask for an opinion or are outside the scope of the reference need

not be answered by a witness: *Algonquin Mercantile Corp. v. Dart Industries Canada Ltd.* (1984), 82 C.P.R. (2d) 36 (F.C.T.D.); affirmed 1 C.P.R. (3d) 242 (F.C.A.).

3. The propriety of any question on discovery must be determined on the basis of its relevance to the facts pleaded in the statement of claim as constituting the cause of action (...)

4. The court should not compel answers to questions which, although they might be considered relevant, are not at all likely to advance in any way the questioning party's legal position: *Canex Placer Ltd. v. A.-G. B.C.*, supra; and *Smith, Kline & French Laboratories Ltd. v. A.-G. Can.* (1982), 67 C.P.R. (2d) 103 at p. 108, 29 C.P.C. 117 (F.C.T.D.).

5. 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.

6. The ambit of questions on discovery must be restricted to unadmitted allegations of fact in the pleadings, and fishing expeditions by way of a vague, far-reaching or an irrelevant line of questioning are to be discouraged: *Carnation Foods Co. Ltd. v. Amfac Foods Inc.* (1982), 63 C.P.R. (2d) 203 (F.C.A.); and *Beloit Canada Ltee/Ltd. v. Valmet Oy* (1981), 60 C.P.R. (2d) 145 (F.C.T.D.).

[Emphasis added]

[49] Moreover, the list of exceptions in points 2 and 4 to 6 of *Reading & Bates* is not, in my opinion, strictly comprehensive.

[50] In many situations, the balance referred to by the Court in point 5 in *Reading & Bates* is needed.

[51] In fact, as indicated in *Faulding Canada Inc. v. Pharmacie S.p.A.* (1999), 3 C.P.R. (4th) 126, at page 128:

[...] the general tendency of the courts to grant broad discovery must be balanced against the tendency, particularly in industrial property cases, of parties to attempt to engage in fishing expeditions which should not be encouraged.

[52] Rule 242 contains a warning in this regard. Indeed Rules 242(1)(b) to (d) state:

**242.** (1) A person may object to a question asked in an examination for discovery on the ground that

(...)

(b) the question is not relevant to any unadmitted allegation of fact in a pleading filed by the party being examined or by the examining party;

(c) the question is unreasonable or unnecessary; or

(d) it would be unduly onerous to

**242.** (1) Une personne peut soulever une objection au sujet de toute question posée lors d'un interrogatoire préalable au motif que, selon le cas :

(...)

b) la question ne se rapporte pas à un fait allégué et non admis dans un acte de procédure déposé par la partie soumise à l'interrogatoire ou par la partie qui l'interroge;

c) la question est déraisonnable ou inutile;

d) il serait trop onéreux de se

require the person to make the inquiries referred to in rule 241.

renseigner auprès d'une personne visée à la règle 241.

[53] Moreover, a party cannot be required to answer a question in examination for discovery that forces that party to give an opinion, whether an expert opinion, their interpretation of a patent or their beliefs. *Philips Export B.V.v. Windmere Consumer Products Inc.* (1986) 8 C.P.R. (3d) 505, states the following at page 508:

Question 467, which must be read with Q. 466, asks for the belief of the plaintiff. In both the *Smith, Kline & French* case and in *Sperry Corp. v. John Deere Ltd. et al.* (1986) 8 C.P.R. (2d) 1, it is stated that opinion cannot be asked, as a rule, of a person being examined who is not an expert and that a party cannot be asked to express its position in terms of mental attitudes.

[Emphasis added.]

(See also *Rivtow Straits Ltd. v. B.C. Marine Shipbuilders Ltd.*, [1997 1 F.C. 735, at page 736.)

[54] Armed with these principles, we must consider Motion V, i.e. the plaintiffs' motion seeking determination of objections.

**V. Motion by the plaintiffs seeking determination of objections**

[55] Here, the plaintiff's motion record also includes tables seeking determination of a certain number of objections raised during the examination of the defendants' representatives during the

examination of the affidavits sworn in February 2008 that they had filed in support of their motion to amend the confidentiality order on May 23, 2007, which motion led to the order on February 29, 2008.

[56] It is surprising, and likely surprising for the defendants as well, to now be seeking determination of these objections. It is clear from the terms of paragraph 1(a) of the timetable order from this Court on June 23, 2008, that the plaintiffs' motion could only be related to the objections raised during the examination for discovery in the fall of 2007, not the affidavits sworn in February 2008 as part of a motion that has now been ruled on by a prothonotary and a Judge of this Court.

[57] This ground, in addition to the grounds argued by the NRC defendants and the University of Sherbrooke defendants, are such that this Court cannot rule here on these objections. The plaintiffs are now barred from seeking a resolution to those objections.

[58] That said, we must now consider the plaintiffs' motion for determination of the objections raised during the examination for discovery of the defendants.

[59] Regarding this motion, as with the corresponding motion by the NRC defendants, the parties filed two documents in Court on August 27 and 28, 2008, reproducing an agreement regarding the questions that require adjudication by me (hereinafter collectively the Agreement on August 27, 2008). The questions not listed for adjudication in that Agreement will therefore not be discussed here and must be subsequently dealt with as agreed by the parties.

[60] However, that leaves close to seventy (70) questions to determine under this motion by the plaintiffs. Particularly as, in the similar motion by the NRC defendants, most of the grounds in favour of or against any issues to be adjudicated are found in six (6) annexes (A to F, excluding B – See Agreement on August 27, 2008), with each annex corresponding to an examination for discovery of an individual defendant or a representative of a corporate defendant.

[61] As required by this Court, a table was filed with the Court containing this exercise by the plaintiffs and including the position of the NRC and University of Sherbrooke defendants.

[62] The Court thus took that joint table, including annexes A to F (excluding B – See Agreement on August 27, 2008) (the plaintiff’s Motion Table) and, keeping in mind the relevant principles from jurisprudence, including those cited above and those raised by the parties, the Court noted by means of a double line (“||”) in the margin of all or any reasons by a party for each question to be adjudicated following the Agreement on August 27, 2008 whether or not, in the end, that question needed to be answered. The line in the margin is thus in one of the last two columns of each annex of the Table.

[63] Thus, under that motion by the plaintiffs, the appropriate defendants must answer the questions listed in numbers 1 to 5 below. Questions not listed here regarding any of the annexes are therefore dismissed:

1 – Questions that must be answered in Annex A of the plaintiff’s Motion Table  
(reference is to the number in the far-left column):

12, 13.

2 – Questions that must be answered in Annex C of the plaintiff’s Motion Table  
(reference is to the number in the far-left column):

14, 24, 25.

3 – Questions that must be answered in Annex D of the plaintiff’s Motion Table  
(reference is to the number in the far-left column):

None.

4 – Questions that must be answered in Annex E of the plaintiff’s Motion Table  
(reference is to the number in the far-left column):

1, 2.

5 – Questions that must be answered in Annex F (Gervais Soucy) of the plaintiff’s  
Motion Table:



U-64, Q.37 (September 18), Q.38 (September 18), Q.39 (September 18),  
Q.298 (September 18), Q.199 (September 18)

[64] Given that success is shared on this motion, no costs are awarded here.

[65] Given the length of the plaintiff's Motion Table, and as it very likely contains varying levels of confidential information, the Table and thus its five (5) relevant annexes is designated as Annex I of the order, is deemed to be part of the order, and shall be forwarded to counsel for the parties under confidential seal.

**VI Motion by the NRC defendants seeking determination of objections**

[66] Nearly one hundred twenty (120) questions remain in this motion.

[67] What was indicated by the Court at paragraphs [59] to [62] and [65] above applies here *mutatis mutandis*. The NRC defendants' Motion Table, which includes two (2) annexes, is designated as Annex II of the order, is deemed to be part of the order, and shall be forwarded to counsel for the parties under confidential seal.

[68] Thus, under that motion by the NRC defendants, the plaintiffs must answer the questions listed in numbers 1 and 2 below. Questions not listed here regarding any of the annexes are therefore dismissed:

1 – Questions that must be answered in Annex A of the NRC defendants’ Motion

Table (reference is to the number in the far-left column):

35, 36, 37, 54, 55, 56, 61, 62, 63, 64, 65,  
66, 67, 68, 70, 71, 79, 80, 81, 83, 86, 87,  
88, 90, 91, 92, 95, 96, 97, 98, 99, 100, 104,  
106, 107.

2 – Questions that must be answered in Annex B of the NRC defendants’ Motion

Table (reference is to the number in the far-left column):

1, 2, 7, 11, 12, 13, 15, 24, 29, 39, 53,  
54, 56, 57, 67, 68, 69, 84, 85, 86, 87, 90,  
91, 104, 106.

- (i) The Court also considers that question 33 was sufficiently answered in Annex B and that no further answers will be required.

[69] Given that success is shared on this motion, no costs are awarded here.

**ORDER**

**THE COURT ORDERS that:**

**1 - Motion by the plaintiffs seeking leave to question various people and for production of documents**

This motion by the plaintiffs against the NRC defendants is dismissed entirely with costs to the defendants under column III of Tariff B.

Regarding the University of Sherbrooke defendants, this motion by the plaintiffs is dismissed in terms of the remedy related to questioning individuals and producing more documents, but is allowed for the production by the University of Sherbrooke defendants of unredacted documents. Those documents shall be provided to Laurent Debrun within thirty (30) days of this order, as “Restricted Access Documents” covered by the order by Gauthier J. on April 18, 2008, and to be treated from an access and confidentiality standpoint in accordance with the relevant paragraphs of that order on April 18, 2008.

As for costs for this motion for the University of Sherbrooke defendants, although the plaintiffs were successful in one of the three aspects of this motion, given that this motion did in fact include three different components, the University of Sherbrooke defendants are nonetheless awarded their costs on this motion, but for only one set of costs under column III of Tariff B.

**2 - Motion by the plaintiffs seeking an order authorizing the inspection of devices**

- In that it seeks authorization to inspect the NRC device, the plaintiffs' motion is dismissed, with costs.

- In that it seeks authorization to inspect the University of Sherbrooke device and other remedies, such as the collection of a sample, the plaintiffs' motion is dismissed, with costs.

**3 - Motion by the plaintiffs seeking determination of objections**

Under this motion by the plaintiffs, the appropriate defendants must answer the questions listed in numbers 1 to 5 below. Questions not listed here regarding any of the annexes are therefore dismissed:

1 – Questions that must be answered in Annex A of the plaintiff's Motion Table  
(reference is to the number in the far-left column):

12, 13.

2 – Questions that must be answered in Annex C of the plaintiff's Motion Table  
(reference is to the number in the far-left column):

14, 24, 25.

3 – Questions that must be answered in Annex D of the plaintiff's Motion Table  
(reference is to the number in the far-left column):

None.

4 – Questions that must be answered in Annex E of the plaintiff's Motion Table  
(reference is to the number in the far-left column):

1, 2.

5 – Questions that must be answered in Annex F (Gervais Soucy) of the plaintiff's  
Motion Table:

U-64, Q.37 (September 18), Q.38 (September 18), Q.39 (September 18),  
Q.298 (September 18), Q.199 (September 18)

- Given that success is shared on this motion, no costs are awarded here.

**4 - Motion by the NRC defendants seeking determination of objections**

Under this motion by the NRC defendants, the plaintiffs must answer the questions listed in numbers 1 and 2 below. Questions not listed here regarding any of the annexes are therefore dismissed:

- 1 – Questions that must be answered in Annex A of the plaintiff’s Motion Table  
(reference is to the number in the far-left column):

35, 36, 37, 54, 55, 56, 61, 62, 63, 64, 65,  
66, 67, 68, 70, 71, 79, 80, 81, 83, 86, 87,  
88, 90, 91, 92, 95, 96, 97, 98, 99, 100, 104,  
106, 107.

- 2 – Questions that must be answered in Annex B of the NRC defendants’ Motion  
Table (reference is to the number in the far-left column):

1, 2, 7, 11, 12, 13, 15, 24, 29, 39, 53,  
54, 56, 57, 67, 68, 69, 84, 85, 86, 87, 90,  
91, 104, 106.

- (i) The Court also considers that question 33 was sufficiently answered in  
Annex B and that no further answers will be required.

- Given that success is shared on this motion, no costs are awarded here.

“Richard Morneau”  
\_\_\_\_\_  
Prothonotary

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

**DOCKET:** T-1856-06

**STYLE OF CAUSE:** RAYMOR INDUSTRIES INC.  
and  
INSTITUT NATIONAL DE RECHERCHE  
SCIENTIFIQUE  
Plaintiffs

and

NATIONAL RESEARCH COUNCIL OF CANADA  
BENOIT SIMARD, ORSON BOURNE,  
UNIVERSITY OF SHERBROOKE  
and  
GERVAIS SOUCY  
Defendants

AND BETWEEN:

NATIONAL RESEARCH COUNCIL OF CANADA  
Plaintiff by counterclaim  
and  
INSTITUT NATIONAL DE LA RECHERCHE  
SCIENTIFIQUE  
Defendant by counterclaim

**PLACE OF HEARING:** Montréal, Quebec

**DATE OF HEARING:** August 26 and 27, 2008

**REASONS FOR ORDER:** PROTHONOTARY MORNEAU

**DATED:** August 29, 2008

**APPEARANCES:**

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