

Date: 20090211

**Dockets: A-354-08
A-356-08**

Citation: 2009 FCA 42

**CORAM: DESJARDINS J.A.
EVANS J.A.
RYER J.A.**

Docket: A-354-08

BETWEEN:

j2 GLOBAL COMMUNICATIONS, INC.

Appellant (Plaintiff)

and

PROTUS IP SOLUTIONS INC.

Respondent (Defendant)

AND BETWEEN:

PROTUS IP SOLUTIONS INC.

**Respondent
(Plaintiff by Counterclaim)**

and

**j2 GLOBAL COMMUNICATIONS, INC.
and CATCH CURVE INC.**

**Appellants
(Defendants by Counterclaim)**

Docket: A-356-08

BETWEEN:

CATCH CURVE INC.

Appellant (Plaintiff)

and

PROTUS IP SOLUTIONS INC.

Respondent (Defendant)

AND BETWEEN:

PROTUS IP SOLUTIONS INC.

**Respondent
(Plaintiff by Counterclaim)**

and

**CATCH CURVE INC. and
j2 GLOBAL COMMUNICATIONS, INC.**

**Appellants
(Defendants by Counterclaim)**

Heard at Toronto, Ontario, on February 10, 2009.

Judgment delivered at Toronto, Ontario, on February 11, 2009.

REASONS FOR JUDGMENT BY:

EVANS J.A.

CONCURRED IN BY:

**DESJARDINS J.A.
RYER J.A.**

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Appellant (Plaintiff)

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Respondent (Defendant)

AND BETWEEN:

PROTUS IP SOLUTIONS INC.

**Respondent
(Plaintiff by Counterclaim)**

and

**CATCH CURVE INC. and
j2 GLOBAL COMMUNICATIONS, INC.**

**Appellants
(Defendants by Counterclaim)**

REASONS FOR JUDGMENT

EVANS J.A.

[1] j2 Global Communications Inc. and Catch Curve Inc. (“appellants”) have appealed an order of the Federal Court (2008 FC 760), in which Justice Russell allowed in part a motion by Protus IP Solutions Inc. (“Protus”) appealing an order of Prothonotary Tabib relating to a requirement to answer further questions on discovery. Justice Russell held that the Prothonotary was clearly wrong in refusing to require that certain questions be answered, on the ground that they were relevant to Protus’s statements of defence and counterclaim.

[2] This Court heard the appeals together, and these reasons apply to both. A copy of these reasons will be inserted in each Court file.

[3] Underlying these interlocutory proceedings are actions by the appellants against Protus alleging infringement of their Canadian patents relating to internet-based facsimile services. In its statements of defence and counterclaim, Protus attacks the validity of the appellants' patents and alleges breaches by the appellants of the *Trade-marks Act* and the *Competition Act*. The questions in dispute relate to these latter issues.

[4] No doubt, from the appellants' perspective, Protus's statements of defence and counterclaim have broadened the scope of their infringement actions in a most unwelcome manner. However, such is the nature of litigation in this contentious area of the law.

[5] In considering the issues raised by the appellants in these appeals, I have borne in mind the following considerations: (i) the discretionary nature of most of the decisions made by the Motions Judge; (ii) the fact that the Motions Judge is significantly closer than this Court to the litigation; (iii) that, with one exception, it is not alleged that the questions in dispute are vital to the final issue in the case; and (iv) that the principle of proportionality in the conduct of litigation means that the time and resources, both public and private, devoted to the issues in dispute must be proportionate to their importance.

[6] Hence, the appellants have a heavy duty to discharge in order to persuade the Court that the Motions Judge had no basis for interfering with the Prothonotary's order and that his decision was clearly wrong.

[7] Having examined the parties' written materials and the judgments below, and having heard oral submissions, I am not persuaded that the Motions Judge made any error that would warrant the intervention of this Court.

[8] Accordingly, I would dismiss the appeals with costs.

“John M. Evans”

J.A.

“I agree
Alice Desjardins J.A.”

“I agree
C. Michael Ryer J.A.”

FEDERAL COURT OF APPEAL

NAMES OF COUNSEL AND SOLICITORS OF RECORD

DOCKETS:

A-354-08 & A-356-08

For A-354-08: (APPEAL FROM THE JUDGMENT OF MR. JUSTICE RUSSELL DATED 18-JUN-2008, ALLOWING IN PART, THE RESPONDENT'S APPEAL OF THE ORDER OF PROTHONOTARY TABIB DATED 04-JUL-2007 IN FEDERAL COURT FILE T-139-06.)

For A-356-08: (APPEAL FROM THE JUDGMENT OF MR. JUSTICE RUSSELL DATED 18-JUN-2008, ALLOWING IN PART, THE RESPONDENT'S APPEAL OF THE ORDER OF PROTHONOTARY TABIB DATED 04-JUL-2007 IN FEDERAL COURT FILE T-140-06.)

STYLES OF CAUSE:

A-354-08

j2 GLOBAL COMMUNICATIONS,
INC. v. PROTUS IP SOLUTIONS INC.

AND BETWEEN:

PROTUS IP SOLUTIONS INC. v. j2
GLOBAL COMMUNICATIONS, INC.
and CATCH CURVE INC.

A-356-08

BETWEEN:

CATCH CURVE INC. v. PROTUS IP
SOLUTIONS INC.

AND BETWEEN:

PROTUS IP SOLUTIONS INC. v.
CATCH CURVE INC. and j2 GLOBAL
COMMUNICATIONS, INC.

PLACE OF HEARING:

TORONTO, ONTARIO

DATE OF HEARING:

FEBRUARY 10, 2009

REASONS FOR JUDGMENT BY:

EVANS J.A.

CONCURRED IN BY:

DESJARDINS J.A.
RYER J.A.

DATED:

FEBRUARY 11, 2009

APPEARANCES:

Paul V. Lomic

FOR THE APPELLANT

Kenneth D. Hanna

Steven B. Garland
Kevin K. Graham

FOR THE RESPONDENT

SOLICITORS OF RECORD:

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FOR THE RESPONDENT