

Federal Court  
of Appeal



CANADA

Cour d'appel  
fédérale

**Date: 20100521**

**Docket: A-454-09**

**Citation: 2010 FCA 130**

**Present: SHARLOW J.A.**

**BETWEEN:**

**ELI LILLY CANADA INC.,  
ELI LILLY AND COMPANY,  
ELI LILLY AND COMPANY LIMITED and  
ELI LILLY SA**

**Appellants**

**and**

**NOVOPHARM LIMITED**

**Respondent**

Dealt with in writing without appearance of parties.

Order delivered at Ottawa, Ontario, on May 21, 2010.

**REASONS FOR ORDER BY:**

Federal Court  
of Appeal



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**REASONS FOR ORDER**

**SHARLOW J.A.**

[1] This appeal is scheduled for hearing on June 21, 2010. The appellants (collectively “Lilly”) are seeking to reverse a judgment of the Federal Court (2009 FC 1018) which, among other things, declared Canadian Patent No. 2,041,113 invalid and dismissed Lilly’s claim against the respondent (“Novopharm”) for damages and other relief for infringement of the patent.

[2] Before me is a request by Novopharm to order the return of certain material filed by Lilly on May 12, 2010, namely 13 volumes of material containing excerpts from the appeal book and one volume (“Volume 5”) of authorities. Novopharm argues that this material is improperly filed.

[3] I note at the outset that Novopharm's request has not been properly made. It was made by letter. It should have been made by means of a notice of motion, served and filed in a motion record and supported by a properly sworn affidavit. However, as time is short, and as Lilly did not object to the form of the request but courteously acceded to my request to make a speedy response by letter, I have disregarded the irregularity.

[4] This matter arises from an order dated January 8, 2010 in which Justice Sexton granted Lilly leave to file the volumes of the appeal book containing the trial exhibits and trial transcripts electronically in PDF format only, and required each party to serve and file, by a specified deadline, a compendium containing the material to which the party intended to refer in argument. This order was sought as a means of managing a voluminous trial record, estimated at the time to consist of 10 boxes of documents (double sided).

[5] A compendium normally is understood to be a relatively small document (usually a single volume) containing only documents or portions of documents from the appeal book that a party anticipates will be referred to in oral argument. Alternatively, a compendium may consist of one or more volumes of material containing all or nearly all of the documents referred to in a party's memorandum of fact and law, often with tabs corresponding to the paragraphs in the memorandum. In this case Lilly has filed 4 volumes comprising a compendium of the latter kind. Novopharm has no objection to the form or content of those four volumes.

[6] However, Lilly has also filed 13 additional volumes containing documents from the appeal book that are now in the Court file in electronic form (PDF) only, as well as an additional volume of authorities (Volume 5).

[7] Novopharm has objected to the filing of the 13 volumes of documents because they are not a compendium, in that they do not track the paragraphs in Lilly's memorandum of fact and law, they run for thousands of pages, and they contain only sporadic side-barring. Lilly has explained that of the 13 volumes in issue, some contain evidence relating to the work done to justify the grant of the patent in issue (reflecting a dispute on a key point raised in the appeal). The remaining volumes contain documents from the appeal book that Lilly anticipates may be referred to in argument to address a number of factual points raised in Novopharm's memorandum of fact and law.

[8] Lilly points out, correctly, that the filing of a compendium cannot deprive a litigant of the right to refer at the hearing to any document in the appeal book. I note also that the courtroom in which this matter is to be heard is not at present equipped with the means for reading documents in electronic form, which could present a practical difficulty to counsel who may wish, properly, to refer to a document in the appeal book that is not available in hard copy. I have not been made aware of any special arrangements that might have been made to deal with this technological deficit in the courtroom. In these circumstances, I will not accede to Novopharm's request to require the 13 volumes of documents to be returned to Lilly.

[9] Novopharm objects to the filing of Volume 5 because it contains cases, many of which are not highlighted or sidebarred, that are not part of the joint book of authorities to which the parties had previously agreed, and because it includes two patents that are not part of the record on appeal. Lilly says that the majority of the cases are sidelined, and that a patent is an “enactment” as defined in the *Interpretation Act* and may properly be included in a book of authorities.

[10] Normally, the Court will not accede to an objection that restricts the right of litigants to bring to the Court’s attention any relevant jurisprudence, even if it is presented for the first time at the hearing itself (although where such a late submission occurs the Court normally will permit any party taken by surprise to make supplementary submissions). While it would have been preferable if Lilly had identified the Volume 5 cases when consideration was being given to the preparation of the joint book of authorities, I am unable to see how Novopharm could possibly be prejudiced by the filing of Volume 5 at this time. The question of whether or not a patent is properly included in a book of authorities is a point that may be raised in argument at the hearing, if anything turns on it.

[11] For these reasons, Novopharm’s request to return to Lilly the 13 volumes of documents and Volume 5 of the authorities will be denied. Costs of this motion are costs in the cause.

“K. Sharlow”

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J.A.