
Sana Halwani
416-865-3733
shalwani@litigate.com


Andrew Moeser
416-649-1815
amoeser@litigate.com


Jim Lepore
416-865-2881
jlepore@litigate.com

January 26, 2021

Donâ€™t Sit Back During Summary Judgment: Federal Court of Appeal Weighs in on Summary Judgment for Patent Infringement Actions

The Federal Court of Appeal has historically held that summary judgment is usually not the preferred means of resolving patent infringement actions. These cases are inherently complex and technical, and usually involve expert evidence. In the Federal Court of Appeal's view, a trial judge who has had the opportunity to hear all of the evidence live is best suited to resolve these disputes (see *Suntec Environmental Inc v Trojan Technologies Inc*).

In the Federal Court, Justice Manson's decision in *Canmar Foods Ltd v TA Foods Ltd* ("Canmar"), released in late 2019, was one of the first patent infringement actions in several years to be resolved through summary judgment.

We previously commented on *Canmar* as well as two other recent decisions of the Federal Court (*Jempak* and *Bauer*). We noted that those decisions signalled that the Federal Court was willing to consider increased use of summary judgment in the right circumstances, notwithstanding the Federal Court of Appeal's historic reluctance to approve summary judgment for patent infringement actions. At the time of that comment, the Federal Court of Appeal had yet to weigh in on these decisions. However, that is no longer the case.

The Federal Court of Appeal recently released its decision in the appeal of *Canmar* (referred to in this commentary as *Canmar Appeal*). As a top line, the Federal Court of Appeal approved the use of summary procedures in *Canmar* and sent a message to parties resisting a motion for summary judgment: put your best foot forward and strongly consider leading expert evidence.

The Federal Court of Appeal's decision in *Canmar Appeal*

By way of background, the plaintiff patent owner in *Canmar* alleged that the defendant infringed its patented method of roasting oil seeds. This method involved, *inter alia*, heating the oil seed in a stream of air for less than 2 minutes, and

transferring the heated oil seed into an insulated roasting chamber. The defendant in *Canmar* brought a pre-discovery motion for summary judgment based on non-infringement.

On this motion, the defendant advanced fact evidence that its allegedly infringing roasting method did not involve a stream of air or an insulated roasting chamber (see *Canmar*, here). The plaintiff responded with its own fact evidence that questioned the defendant's evidence. Significantly, neither party proffered expert evidence, and the Federal Court found that it did not require expert assistance to understand and construe the claims at issue.

In *Canmar Appeal*, the Court confirmed that claims construction is a question of law, which did not necessarily require expert evidence. Accordingly, it was not an error for Justice Manson to construe the patent claims at issue without expert evidence (see here). However, notwithstanding that finding, the Federal Court of Appeal cautioned (here) that:

> Claims must always be construed in an informed and purposive way, and it is only in the clearest of cases that judges should feel confident enough to construe the claims of a patent as they would be understood by a skilled person, without the help of any expert evidence.

The Court in *Canmar Appeal* also confirmed that both the moving and responding parties are required to put their best foot forward on a motion for summary judgment. The Court noted that the burden on a motion for summary judgment is "no genuine issue for trial", which "should obviously translate into a heavy burden on the moving party" (see here). Should the moving party discharge this burden, "the evidentiary burden [then] falls on the responding party, who cannot rest on its pleadings and must come up with specific facts showing that there is a genuine issue for trial" (see here).

As *Canmar* was a summary judgment motion brought before the exchange of affidavits of documents and examinations for discovery, the Federal Court of Appeal confirmed that "a party responding to a motion for summary judgment cannot be faulted for the absence of evidence if that evidence is in the exclusive control of the moving party." However, in dismissing the appeal, the Federal Court of Appeal found that was not the situation in *Canmar*:

> [The defendant advanced] sufficient information to allow the appellant to marshal evidence, including expert evidence, as to the operation of the [specifically identified component of the defendant's system, which was nearly

> 25 years old] and how it could potentially be modified, to show that it fell within [the claims of the asserted patent].

Implications of *Canmar Appeal*

Patent infringement actions are not categorically different. Despite the complexity of patent infringement actions, when it comes to summary judgment, the same principles apply as in other types of cases (e.g., the burden and the obligation to put the best foot forward).

Responding parties should not sit back. Consistent with past comments, *Canmar Appeal* is yet another strong reminder that the party resisting summary judgment should take such a motion seriously. In the two recent Federal Court decisions that dismissed a patent infringement action using summary judgment—*Canmar* and *Jempak*—the Federal Court was critical of the responding plaintiffs for only attacking the moving party's evidence. *Canmar Appeal* demonstrates that the Federal Court of Appeal also expects responding parties to put their best foot forward, including (where appropriate) advancing expert evidence as to facts and inferences not led by the moving party.

Expert evidence is important. Canmar Appeal confirms that expert evidence is typically required (in all but the clearest cases) to purposefully construe a patent's claims. Parties contemplating or responding to a summary judgment motion should consider this guidance when assessing whether to advance expert evidence. This guidance likely also bears on whether a summary trial—which allows for live evidence—is a more appropriate avenue of summary adjudication (see our commentary on summary trials here).

Other implications. This commentary focuses on the Federal Court of Appeal's guidance on summary adjudication. *Canmar Appeal* also provides guidance on file wrapper estoppel and section 53.1 of the *Patent Act*, which is the focus of a separate blog (available here).