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Inventor Examination Cannot Be Compelled by Proxy, and Other Practical Lessons

In the recently released decision *Boehringer Ingelheim Ltd v Jamp Pharma Corporation*, Jamp brought a motion seeking an order that would require Boehringer to make their employee inventors attend to be examined for discovery, failing which the order could be enforced against Boehringer themselves. Boehringer argued that the *Rules* do not contemplate such an order. Associate Judge Duchesne agreed.

Jamp sought two additional orders relating to inventor examinations:

- an order requiring Boehringer to provide “more, better or more meaningful” contact information for those inventors identified in the patents, but no longer employed by Boehringer. Boehringer argued that there was no basis for this request in the *Rules* or *Regulations*. Duchesne AJ agreed.
- an order compelling Boehringer to allow Jamp’s counsel to have an informal pre-discovery conversation by videoconference with each employee inventor. Boehringer argued that no such process was contemplated by the *Rules*. Duchesne AJ agreed.

Practical Effect

The decision demonstrates some of the difficulties of managing examinations of foreign non-party inventors within the timelines of an action under the *Patented Medicine (Notice of Compliance) Regulations*.

PM(NOC) actions must get to trial in approximately 21 months. While parties to *PM(NOC)* actions have a duty to reasonably cooperate in moving the action forward, there is no duty imposed on plaintiffs to make all employee inventors available for examination, facilitate informal pre-discovery conversations with employee inventors, or provide contact information for former employee inventors beyond name and last known address.

Background

In an action under the *PM(NOC) Regulations*, Jamp sought to

examine for discovery all 23 living inventors identified on the patents at issue. Thirteen of the inventors were still employees of Boehringer, and all 23 inventors lived outside of Canada, mostly in Germany.

A scheduling order made early in the proceeding required Boehringer to advise Jamp which inventors would be made available to attend for examinations for discovery and how. Boehringer offered to make available for examination six inventors total, but otherwise refused to make any additional employee inventors available.

No Duty to Make Employee Inventors Attend Examinations

On the issue of entitlement to examine inventors, Boehringer argued that while Jamp had a right to examine inventor employees pursuant to Rule 237(4), that right was not unlimited and is subject to principles of proportionality.

While the Court found that any right of discovery is subject to overarching principles of proportionality (set out in Rule 3), there was “no question” Jamp’s entitlement to examine the inventor employees exists and can be exercised by Jamp. Moreover, neither the *Rules* nor the *Regulations* provided Boehringer with “any pre-emptive right to unilaterally dictate what may or may not be proportional in [Jamp’s] intended manner of proceeding with inventor discovery”. The Court found that Boehringer’s conduct “in unilaterally selecting which Inventor Employees to make available for discovery pursuant to Rule 237(4)” was “contrary to the *Rules*”. The Court held that if Boehringer had a legitimate concern about the number of inventor employees Jamp intended to examine, it should have raised those concerns on a case management conference or on a motion designed to have the Court impose conditions on Jamp’s examinations pursuant to Rule 237(4).

Notwithstanding, the Court held that there is no basis in the *Rules* or *Regulations* for Jamp’s request for an order *in personam* against Boehringer requiring it to make employee inventors (who are not corporate representatives) available for examination pursuant to Rule 237(4). While the parties have a duty to reasonably cooperate in expediting the action, such cooperation “does not extend to requiring the Court” to create a “new procedural vehicle to compel a third-party assignor who is a non-resident to attend examination for discovery when normally exercisable means of proceeding, such as an agreement between the parties or letters of request and a commission have been neither attempted nor exhausted”.

No Duty to Provide Better Contact Information of Inventors

Jamp’s second request on the motion was for better contact

information for former employee inventors. Boehringer had provided the names and last known home addresses for the former employees, but no email addresses or phone numbers.

Subsections 6.04(2) and 5(3.1) of the *Regulations* impose a duty on the assignee to provide the name and contact information of inventors who might have information that is relevant to an allegation of patent invalidity. According to the Court, based on the *Regulatory Impact Analysis Statement* accompanying the 2017 amendments to the *PM(NOC) Regulations,* the duty to provide contact information is satisfied in different ways for employees versus non-employees: for an employee inventor, the duty to provide contact information is satisfied by stating that the employee inventor can be contacted through the assignee employer's counsel; for a non-employee inventor, contact information must be provided to satisfy the duty.

The Court found that Boehringer had fulfilled its duty because the purpose of the duty is to facilitate the potential examination through the disclosure of a potential address for service (*e.g*., a home address). Duchesne AJ also stated that Jamp could take steps to obtain other contact information from, for example, "non-party investigative resources."

No Duty to Facilitate "Informal" Videoconferences with Inventors

Finally, Jamp also sought an order that Boehringer facilitate informal pre-discovery discussions for the purpose of permitting Jamp to determine each employee inventor's role relating to the patents. As summarized by Duchesne AJ: "Essentially, the Defendant seeks an Order authorizing it to ask questions of an inventor to explore whether examination for discovery of that Inventor Employee would be worthwhile before investing in actually conducting examination for discovery, the whole without prejudice to its right to examine for discovery." The Court held that there was no basis in the *Rules* or on the record before it to order such informal discussions.

"Failure to Be Practical" Will Affect Costs

Boehringer sought costs of $3,000 on the motion. Despite being entirely successful on the motion, Duchesne AJ ultimately fixed costs at $1,000, noting "the parties' failure to be practical". The Court found that while Boehringer "complied with the early scheduling order", it applied its "own view of proportionality with respect to further examinations of inventors" and "ought not to be rewarded for hindering the Defendant's procedural rights to examine inventors". Moreover, "the Defendant should be made to understand by way of costs

order, albeit a modest one, that the Orders sought on this motion were simply not supported by either the jurisprudence, the *Rules*, or the *Regulation*".

The Court emphasized the real concern for the timeline in litigation under the *PM(NOC) Regulations* "that is easily derailed by one party's failure to cooperate reasonably at any given time throughout the process". The Court cautioned that the failure to "make a *bona fide* effort to agree and set realistic timetables" in discovery plans can result "in consequences, including significant costs". Furthermore, other "types of Orders such as restrictions on examination rights may be made to drive home the point that a failure to cooperate reasonably on issues of process and procedure that do not detrimentally affect a party's legitimate interests and rights in the cause, but results in running down the litigation clock, is not acceptable."