



[2023] 1 F.C.R. D-2

PRACTICE

Related subject: Patents

Motion under *Federal Courts Rules*, SOR/98-106 (Rules), rr. 52.5, 279(a) to strike expert's report in action for patent infringement — Plaintiff/defendant by counterclaim (plaintiff) asserted that its patent directed to process for treating vegetables, fruit before cooking was infringed by defendants — Defendants/plaintiff by counterclaim (defendants) denied infringement, advanced counterclaim seeking declaration that asserted claims were invalid — Trial dates, trial judge, not yet assigned — Discoveries were complete — Parties exchanged expert reports — Defendants served reports from two experts — Two reports rather different — First report reviewed patent in issue, claims; provided opinion on claim construction (including essential elements), anticipation, obviousness, utility, overbreadth, sufficiency, ambiguity — Second report reviewed '841 Patent; described skills, education, etc. of person of ordinary skill in art of '841 Patent — Plaintiff argued that second report primarily consisted of abstract discussion of history of scientific research in various fields, introductory principles related to certain electrical science topics — Also submitted that report never connected expert's opinions to issues that trial judge would be asked to decide — Defendant claimed that second report provided evidence on technical matters that were central to issues in proceeding, that proposed evidence was relevant, would assist trial judge — Defendant opposed motion on merits, submitted that motion was premature, that matter would be decided by trial judge — Whether plaintiff's motion should be granted — Rules, r. 52.5 requires that objections to expert reports be made as early as possible — Rule not requiring that motion to determine admissibility of expert report also be brought as early as possible — While case management judges have ability to strike expert evidence on preliminary motion, discretion should be exercised with great restraint — Parties divided on interpretation, application of subsection 52.5(2) of the Rules — Rule 52.5 not requiring or encouraging motions to determine validity of any objection, only that opposite party, Court be put on notice of objection — Rule 52.5 also providing that objection can be raised in accordance with subsection 262(2) or paragraph 263(c) of the Rules, if objection is known prior to pre-trial conference — Reading Rules, rr. 52.5, 258-263 together, it could not be concluded that Rules require early motion to determine merits of any objections to expert evidence or admissibility of expert's report — Rather, these rules set out notice requirement so that no party is taken by surprise, issue can be addressed, but not necessarily adjudicated, at pre-trial conference — While second report unusual, plaintiff raised number of valid criticisms, could not be concluded that motion had to be struck — Neither Rules nor Court's practice directions set out detailed template or style guide for format of expert reports — Second report speaks to skilled person, common general knowledge but not considering claims — Expert witness' function is "to provide the judge and jury with a ready-made inference which the judge and jury, due to the technical nature of the facts, are unable to formulate" (*R. v. Abbey*, [1982] 2 S.C.R. 24) — Key point of disagreement was whether expert must give opinion on entire issue (e.g. claim construction) or may opine on some, but not all, of factors that are part of analysis — Although there did not seem to be an instance where expert in patent case expressed opinion on skilled person, common general knowledge in isolation without considering claims, that did not mean such approach was prohibited — Court not bound to choose between opinions on claim construction offered by expert witnesses, may construe claims in manner between interpretations offered by experts — With respect to validity, first report squarely

considering, providing opinion on obviousness, utility, claim overbreadth, sufficiency, ambiguity — By contrast, second report not stating which pleaded ground of invalidity report relating to, not mentioning claims — Given possibility that trial judge could determine that evidence of second report was relevant, necessary when construing claims, to grounds of validity, etc., second report not struck — Was for trial judge to determine ultimate admissibility of second report, what weight, if any, should be given to it — Motion dismissed.

MCCAIN FOODS LIMITED V. J.R. SIMPLOT COMPANY (T-1624-17, 2023 FC 1480, Horne A.J. reasons for order dated November 7, 2023, 21pp.)