Federal Court Cour fédérale

Date: 20231107

Docket: T-1624-17

Citation: 2023 FC 1480

Toronto, Ontario, November 7, 2023

PRESENT: Associate Judge Trent Horne

BETWEEN:

MCCAIN FOODS LIMITED

Plaintiff /
Defendant by Counterclaim

and

J.R. SIMPLOT COMPANY AND
SIMPLOT CANADA (II) LIMITED

Defendants /
Plaintiffs by Counterclaim

ORDER AND REASONS

I. Overview

[1] Rule 52.5 requires that objections to expert reports be made as early as possible. The Rule does not require that a motion to determine the admissibility of an expert report also be brought as early as possible. While case management judges have the ability to strike expert evidence on a preliminary motion, that discretion should be exercised with great restraint. If it is debatable whether the *Mohan* test has been met, that debate should be resolved by the trial judge.

[2] I am not persuaded that the plaintiff has demonstrated that one of the expert reports served by the defendants should be struck by the case management judge on a pre-trial motion.

II. Background

[3] This is an action for patent infringement. The plaintiff ("McCain") asserts that its patent directed to a process for treating vegetables and fruit before cooking has been infringed by the defendants. The defendants ("Simplot") deny infringement, and have advanced a counterclaim seeking a declaration that the asserted claims are invalid. Trial dates, and a trial judge, have not been assigned.

[4] Discoveries are complete. The parties exchanged expert reports on June 14, 2023. Simplot served reports from two experts, Dr Eugène Vorobiev and Dr Sudhir Sastry.

[5] The two reports are rather different. Dr Sastry's report reviews the patent in issue, and the claims. This report provides an opinion on claim construction (including essential elements), anticipation, obviousness, utility, overbreadth, sufficiency and ambiguity.

[6] Dr Vorobiev's report states that he was asked to do four things:

(a) review the 841 Patent;

(b) describe the skills, education, training, and experience of the person of ordinary skill in the art of the 841 Patent (the "skilled person") as of December 27, 2001 (which I am advised is the publication date of the 841 Patent);

(c) describe the common general knowledge of the skilled person as of December 27, 2001; and

(d) comment on what a skilled person, on reading the 841 Patent, would understand the patent is teaching in terms of the technology and its use as disclosed and claimed in the 841 Patent.

[7] Dr Vorobiev summarizes his opinions as follows:

> 18. The skilled person would have a Bachelor's degree (or the European equivalent) in food process engineering and several years experience in industry. Alternatively, the skilled person would have more substantial academic experience, such as a Master's in food process engineering, or at least several years experience as an academic research technician or similar.
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> 19. The common general knowledge of the skilled person would include knowledge of biological and engineering concepts relevant to the food processing industry and their application, familiarity with the theory and operation of equipment such as pulsed electric field systems, ohmic heating systems and texturometers, and knowledge of previous work in electric field-based technologies for food processing as well as the general advancements in this field.
>
> 20. The skilled person would not read the 841 Patent and conclude that it was directed to pulsed electric field technology, and in any case, the 841 Patent specification does not contain enough information for the skilled person to perform a pulsed electric field process and obtain the results disclosed without a large amount of trial and error-type experimentation.

[8] In McCain's view, Dr Vorobiev's report primarily consists of an abstract discussion of the history of scientific research in various fields, and introductory principles related to certain electrical science topics. McCain argues that the report only has a few paragraphs related to a discussion of how the person of ordinary skill in the art would read the patent, and whether the patent would enable such a person to perform the process it contemplates.

[9] McCain argues that the Vorobiev report never connects the expert's opinions to the issues that the trial judge will be asked to decide. In particular, McCain says that Dr Vorobiev did not have any mandate that asked for his opinion on claim construction. He did not have a mandate that asked him to specifically turn his mind to the claims of the patent, does not discuss the claims at all in his report, and had no mandate regarding any ground of invalidity or other defence asserted by Simplot.

[10] McCain moves under Rules 52.5 and 279(a) of the *Federal Courts Rules*, SOR-98-106 ("Rules") to strike the Vorobiev report.

[11] Simplot submits that the Vorobiev report provides evidence on technical matters that are central to the issues in the proceeding, and that the proposed evidence is relevant, would assist the trial judge, is not precluded by an exclusionary rule, and that Dr Vorobiev is a properly qualified expert. In addition to opposing the motion on the merits, Simplot submits that the motion is premature, and the matter should be decided by the trial judge.

III. Objections to Expert Evidence

[12] Rule 52.5 requires a party, as early as possible, to raise any objection to an opposing party's proposed expert witness that could disqualify the witness from testifying. Subrule 52.5(2) sets out the manner of raising an objection. While the Rule requires that a document containing the particulars of and basis for the objection be served and filed, it does not expressly require the objecting party to bring a motion for determination of the propriety of an objection, or the admissibility of the expert evidence, at the time the objection is made.

[13] The parties are divided on the interpretation and application of subrule 52.5(2). Simplot argues that Rule 52.5 only requires parties to notify each other of any objections as early as possible, but does not contemplate immediate motions to determine the merits of any objections, and the admissibility of the evidence. McCain asserts that such an approach makes no sense because there would be no reason for the Rules to expressly require parties to raise objections "as early as possible" if the parties were powerless to resolve such objections until close to trial. McCain submits that, by including an express requirement that a party raise objections "as early as possible" (a phrase that does not appear in any other Rule), the Rules were clearly intended to encourage parties to resolve issues relating to disputed expert evidence well in advance of trial, including by bringing a motion for a ruling on the admissibility of specific expert evidence.

[14] I begin with the text of Rule 52.5. While objections to expert evidence must be made as early as possible in the proceeding, the Rule does not require or encourage motions to determine the validity of any objection, only that opposite party and the Court be put on notice of the objection. Rule 52.5 also provides that an objection can be raised in accordance with subrules 262(2) or 263(c), if the objection is known prior to the pre-trial conference.

[15] Rules 262 and 263 are directed to pre-trial conferences. Rule 262 sets out a requirement for parties who did not file a requisition for a pre-trial conference to serve and file a pre-trial conference memorandum. Subrule 262(2) requires that the pre-trial conference memorandum include any known objection to the requisitioning party's proposed expert witness that could disqualify the witness from testifying, and the basis for the objection. Rule 263 states that participants in a pre-trial conference must be prepared to address, among other things, any issues

arising from affidavits or statements of expert witnesses. Rules 262 and 263 do not require motions at the pre-trial conference to determine the merits of any objections, or the admissibility of expert evidence. If the presumption is that objections to expert evidence will be discussed at the pre-trial, this does not support an interpretation of Rule 52.5 that requires such objections to be adjudicated forthwith.

[16] Reading Rules 52.5 and 258-263 together, I cannot conclude that the Rules require an early motion to determine the merits of any objections to expert evidence, or the admissibility of an expert's report. Rather, these Rules set out a notice requirement so that no party is taken by surprise, and the issue can be addressed, but not necessarily adjudicated, at the pre-trial conference.

[17] McCain relies on *Crocs Canada, Inc v Double Diamond Distribution Ltd*, 2022 FC 1443 ("*Crocs*"), a decision on the merits of an industrial design proceeding. During the trial, the defendant raised an objection to the plaintiff's expert witness. The fact that the objection was only raised at trial was criticized by Justice Fuhrer. She noted that the Court strongly discourages objections to expert evidence being made for the first time at trial, that the defendant did not raise an objection earlier, and did not bring any pre-trial motion under Rule 52.5 to disqualify the expert from testifying (paras 29-34).

[18] I do not read *Crocs* as endorsing or mandating that a timely objection to expert evidence under Rule 52.5 must be accompanied by a motion. The real issue in *Crocs* was that the defendant waited in the weeds for a year to raise its objection in any manner.

[19] The parties referred to *Biogen Canada Inc v Pharmascience Inc*, 2022 FCA 143 ("*Biogen*"), which I find to be of limited assistance. *Biogen* did not involve a pre-trial motion heard by a case management judge, rather the treatment of expert evidence at trial. In *Biogen*, the trial judge expressly directed that all preliminary motions be brought to his attention by a fixed date. No motion was brought to exclude expert evidence, and no request was made in this respect until an expert report had been accepted into the record, and the witness was in the stand being cross-examined (paras 49-53). Like *Crocs*, *Biogen* does not invite case management judges to make rulings on the admissibility of expert evidence, rather reinforces the Court's dislike of unsuspected objections to expert evidence made for the first time at trial.

[20] McCain submits that it should not be caught in a "catch-22", where an immediate motion to challenge the Vorobiev report would be dismissed as premature, but then, as in *Crocs*, it would face an objection that a motion should be dismissed because it was not brought at the first opportunity. I am not satisfied that McCain faces such a risk. Unlike the facts in *Crocs*, McCain has articulated a detailed objection promptly. Having resisted this motion in the basis that it is premature, I do not see how Simplot could credibly submit to the trial judge that the motion should have been brought and determined earlier.

[21] McCain also relies on Rule 279, and argues that this Rule reflects the default position that expert evidence is not admissible. It is phrased in the negative: no expert witness's evidence is admissible unless the issue to which the evidence relates has been defined in the pleadings. McCain argues that Rule 279 thus contemplates that a preliminary assessment early in a proceeding may be required to determine if expert evidence is admissible. I cannot agree.

[22] I note in particular where Rule 279 is placed in the context of Part 4 of the Rules. Part 4 (Rules 169-299) applies to actions. The sequence of the Rules in Part 4 generally follow the flow of an action: pleadings; summary judgment; documentary discovery; examinations for discovery; a pre-trial conference; and a trial. The Rules relating to the trial itself start at Rule 274 (order of presentation). Rule 279 falls within the Rules relating to trials, and does not support a conclusion that there should be a preliminary assessment of the admissibility of expert evidence by members of the Court who are not the trial judge. The placement of this Rule suggests that the trial judge should determine what expert evidence is admissible and what is not.

[23] McCain has not moved under subrule 220(1)(b), which permits a party to bring a motion before trial to request that the Court determine a question of admissibility of "any document, exhibit or other evidence", however the jurisprudence interpreting subrule 220(1)(b) does not favour early determination of the admissibility of expert evidence by the case management judge as a matter of routine.

[24] The Federal Court has consistently determined that the discretion to authorize the preliminary determination of a question of admissibility should be used with great restraint. Such orders should be confined to general questions of admissibility, rather than the admissibility of evidence where the context of the evidence is required to be assessed. In addition, such orders ought only to be made when the Court is satisfied that this exceptional step is necessary to ensure the just, least expensive and most expeditious determination of the issues (*Canada (Citizenship and Immigration) v Jozepovic*, 2021 FC 536 at para 7, citing *Cantwell v Canada (Minister of the*

Environment), 1990 CarswellNat 1316, 2 WDCP (2d) 44 and *Kirkbi AG v Ritvik Holdings Inc / Gestions Ritvik Inc*, [1998] FCJ No 254).

[25] Admission of expert evidence depends on the application of the following criteria: (a) relevance; (b) necessity in assisting the trier of fact; (c) the absence of any exclusionary rule; and (d) a properly qualified expert (*R v Mohan*, [1994] 2 SCR 9 ("*Mohan*") at 20). McCain is correct that there is no Rule or jurisprudence stating that objections to expert evidence must be determined by the trial judge, however the convention is that the trial judge makes these determinations.

[26] The parties are not aware of a decision where an associate judge of the Federal Court (whether acting as a case management judge or otherwise) made an order striking an expert report that was intended to be presented at a trial. There are reported decisions where associate judges were asked to make orders relating to the admissibility of expert evidence in the context of the former *Patented Medicines (Notice of Compliance) Regulations*, SOR/93-133 (eg *Shire Canada Inc v Cobalt Pharmaceuticals Company*, 2015 FC 458). At that time, PM(NOC) proceedings were heard by way of application (as opposed to an action), and expert reports were filed as part of the record before the hearing. In actions such as this, expert reports are not filed until trial. In current PM(NOC) actions, motions relating to the admissibility of reply expert evidence are determined by the trial judge as a matter of course.

[27] The Court's Case and Trial Management Guidelines for Complex Proceedings and Proceedings under the PM(NOC) Regulations, most recently amended on October 18, 2023 ("Guidelines"), address disputes relating to expert evidence:

15. **Experts: early engagement and qualifications**. Counsel are expected to make a *bona fide* effort to consult and engage experts early in the pre-trial stage to properly assess their case's merit. Where an expert is intended to be called at trial, counsel should also provide opposing counsel with early notice of their experts' views regarding issues in dispute.	15. **Experts : engagement précoce et compétences.** Les procureurs devront faire des efforts véritables et de bonne foi pour consulter et retenir des experts tôt dans la période précédant le procès afin d'évaluer correctement le bien-fondé du dossier. Lorsqu'il est prévu de faire appel à un expert lors du procès, l'avocat doit également informer rapidement l'avocat de la partie opposée de l'opinion de ses experts sur les questions en litige.
Any objections to expert reports or expert qualifications, including those contemplated by Rules 52.5 and 262(2), should be made to the case management judge within 30 days of service of the reports and no later than 30 days prior to trial.	Les objections à la production de rapports d'experts ou à l'habileté à témoigner d'un expert, y compris les objections prévues à l'article 52.5 et au paragraphe 262(2) des *Règles*, doivent être présentées au juge chargé de la gestion de l'instance dans les 30 jours suivant la signification des rapports et au plus tard 30 jours avant le procès.
The trial judge has the sole discretion as to whether to hear any such objections prior to or during the trial, if raised by the parties before the 30-day pre-trial period. The parties shall exchange short statements of each expert's proposed expertise and reach agreement when possible. Costs consequences may follow any unsuccessful challenge to expert qualifications.	Il est à l'entière discrétion du juge du procès de décider s'il entendra de telles objections avant ou pendant le procès, si elles sont soulevées par les parties avant la période de 30 jours préalable au procès. Les parties doivent échanger de brèves déclarations relatives à l'expertise proposée par chacun des experts et s'entendre lorsque possible. Toute contestation infructueuse des qualifications d'un expert peut entraîner des conséquences en matière de dépens.

[28] The Guidelines do not prohibit case management judges from making pre-trial orders in respect of expert evidence, but do not direct that such motions be brought to the case management judge. If anything, the Guidelines contemplate that objections will be heard and determined by the trial judge.

[29] If early motions to determine the admissibility of expert evidence at trial were regularly adjudicated by associate judges (whether acting as case management judges or not), it would introduce the possibility of a Rule 51 appeal and the associated delay, delay which would not be incurred if the trial judge heard such motions.

[30] While the Rules and jurisprudence discussed above point away from the desirability of early determination of objections to expert evidence by case management judges, there is a notable exception relied on by McCain: *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 ("*Masterpiece*").

[31] *Masterpiece* rebuffed the routine practice of introducing survey evidence in trademark proceedings. The Supreme Court stated in particular:

> [98] I do not know the exact circumstances in which the expert evidence was introduced in this case or what was requested of the trial judge, and there is no suggestion that the trial judge erred in admitting it. Nonetheless, I think it is apparent, particularly with respect to the survey, that the evidence was of little assistance to the trial judge and indeed distracted from the required confusion analysis.
>
> [99] Where parties propose to introduce expert evidence, a trial judge should question the necessity and relevance of the evidence having regard to the *Mohan* criteria before admitting it. As I have already pointed out, if a trial judge concludes that the expert evidence is unnecessary or will distract from the issues to be

> decided, he or she should disallow such evidence from being introduced.
>
> [100] I would further suggest that it would be salutary to have a case management judge assess the admissibility and usefulness of proposed expert and survey evidence at an early stage so as to avoid large expenditures of resources on evidence of little utility.

[32] For matters before the Federal Court, there appears to be some tension between the decisions interpreting Rule 220 (“great restraint” and “exceptional circumstances”) and paragraph 100 of *Masterpiece*, which describes early intervention as a salutary practice by case management judges.

[33] According to CanLII, paragraph 100 of *Masterpiece* has been cited in five subsequent decisions. In two of those cases (*CMC Engineering and Management Limited v Pinnacle Renewable Energy Inc*, 2018 BCSC 2457 and *Sidhu v Hiebert*, 2020 BCSC 418), motions relating to expert evidence were adjudicated, but by the trial judge. The remaining three decisions (*Cheah v McDonald's Corporation*, 2013 FC 774, *Gemological Institute of America v Gemology Headquarters International*, 2014 FC 1153, and *Bodum USA, Inc v Meyer Housewares Canada Inc*, 2012 FC 1450) dealt with survey evidence, not preliminary motions to consider the admissibility of expert evidence.

[34] In *Harrop v Harrop*, 2010 ONCA 390, the Court of Appeal for Ontario considered the determination of admissibility of expert evidence by motions judges, concluding:

> [2] In our view, the policy considerations relevant to this issue all point to the trial judge determining this question. It avoids the risk of a multiplicity of proceedings in any given case. It ensures a full context in which the decision can be made. It avoids the risk of preliminary steps being taken for purely tactical reasons. And it avoids creating different appeal rights depending on whether the

> decision is made by a motion judge as an interlocutory order or the trial judge.
>
> [3] Thus, even if a motion judge has such jurisdiction, it should be exercised only in the rarest of cases. Nothing has been shown to us to put this case in that category.

[35] I am only aware of one instance where an expert report was struck by a case management judge on a preliminary motion: *Condominium Corporation No 0321365 v Prairie Communities Corp*, 2017 ABQB 359. Unlike the Rules, subrule 4.14(1)(g) of the *Alberta Rules of Court*, Alta Reg 124/2010, specifically authorizes a case management judge to exercise the powers that a trial judge has by adjudicating any issues that can be decided before commencement of the trial, including those related to admissibility of evidence and expert witnesses. Justice Hall opined that the rule should be used cautiously (para 5), but that on the facts, the disputed report was inadmissible because it assumed a fact-finding role, and was replete with opinions that certain defendants were in breach of their contractual or statutory obligations (paras 10 and 13). Leave was granted to serve a new report by the proposed expert that was consistent with the order (para 17). The issue and analysis is similar to *Association of Chartered Certified Accountants v The Canadian Institute of Chartered Accountants*, 2016 FC 1076. There, Justice Diner (the trial judge) made a pre-trial order that certain expert evidence was inadmissible. One of the issues to be determined at trial was whether the defendants were "public authorities" as that term is used in the *Trademarks Act*, RSC, 1985, c T-13. The plaintiffs intended to introduce expert evidence that reviewed the facts applicable to each defendant, then applied the jurisprudence relating to public authority status to those facts. While the expert reports may have been helpful to the extent that they provided an overview of the parties' governing instruments, funding information, and assessment of other publicly available

information, that did not mean they were necessary (para 22). Further the reports drew conclusions on domestic law, which is for the Court to determine, not an expert (para 43).

[36] Ultimately, to the extent *Masterpiece* extended an invitation for case management judges to play an early and active role in determining the admissibility of expert evidence, it has not been accepted.

[37] As an aside, *Masterpiece* did not signal the demise of survey evidence in trademark cases. In *Diageo Canada Inc v Heaven Hill Distilleries, Inc*, 2017 FC 571 ("*Diageo*") at para 92, the trial judge referred to an unsuccessful pre-trial motion to exclude survey evidence, determining that the test in *Mohan* had been satisfied. What is necessary to assist the trier of fact has a subjective element. This suggests that triers of fact are in a better position to determine what they view as necessary or unnecessary.

[38] Having regard to all of the above, I conclude that preliminary motions to exclude expert evidence may be determined by case management judges, but that case management judges should exercise great restraint in granting such an order. To borrow a phrase from motions to strike, a moving party must land a "knockout punch". If it is debatable whether the *Mohan* test has been met, that debate should be resolved by the trial judge.

IV. Analysis

[39] While the Vorobiev report is unusual, and McCain raises a number of valid criticisms, I cannot conclude that it must be struck.

[40] Neither the Rules nor the Court's practice directions set out a detailed template or style guide for the format of expert reports. Many reports generally follow the structure of the Sastry report: qualifications; the technology; the skilled person; the common general knowledge; claim construction; and validity. Since claims are construed through the eyes of the skilled reader, as of the date of publication, having regard to the common general knowledge (Free World Trust v Électro Santé Inc, 2000 SCC 66 at paras 44-54 ("*Free World Trust*")), an expert will typically assert that they are a skilled person, aware of the common general knowledge, and then provide an opinion on the construction of the claims.

[41] The Vorobiev report speaks to the skilled person and the common general knowledge, but does not consider the claims. At all. While he describes his mandate in at least three places as providing his opinion on what is described *and claimed* in the 841 Patent, there is no consideration or analysis of the claims whatsoever.

[42] An 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 SCR 24 at 42, cited in *Mohan* at 23). A key point of disagreement is whether an expert must give an opinion on an entire issue (eg claim construction) or may opine on some, but not all, of the factors that are part of the analysis. At the risk of simplification, McCain says that, by only speaking to the skilled person and common general knowledge, the Vorobiev report does not provide a "ready made inference" on claim construction, and is fundamentally deficient. Simplot argues that an expert may provide opinion evidence on a portion of the claim

construction analysis, like a building block, which will assist the trial judge in reaching an ultimate conclusion.

[43] I am not aware of an instance where an expert in a patent case expressed an opinion on the skilled person and the common general knowledge in isolation, without considering the claims. But that does not mean such an approach is prohibited. The Court regularly receives expert evidence on the skilled person and the common general knowledge. The Court is not bound to choose between the opinions on claim construction offered by the expert witnesses, and may construe the claims in a manner between the interpretations offered by the experts (*Canamould Extrusions Ltd v Driangle Inc*, 2003 FCT 244 at para 46, aff'd 2004 FCA 63). I cannot eliminate the possibility that the trial judge could determine that the evidence of Dr Vorobiev is relevant and necessary when construing the claims. I am therefore unable to conclude that the report should be struck on that basis.

[44] As to Dr Vorobiev's opinions on validity, McCain's arguments in this respect are well made. Dr Sastry squarely considers and provides his opinion on obviousness, utility, claim overbreadth, sufficiency, and ambiguity. As one would expect, the claims are specifically considered. By contrast, Dr Vorobiev does not state which pleaded ground of invalidity his report relates to, and does not mention the claims. McCain submits the Vorobiev report is in the form of a Trojan horse, which will lead to ambush and surprise at trial when the relevant ground(s) of invalidity are first revealed. In written and oral argument on the motion, Simplot submits that the Vorobiev report is related to overbreadth and sufficiency.

[45] The subject matter of a claim will be overbroad if it exceeds the invention that was made or if it exceeds the invention disclosed in the specification (*Pfizer Canada Inc v Canada (Minister of Health*), 2008 FC 11 at paras 45-46; *Eli Lilly Canada Inc v Apotex Inc*, 2018 FC 736 at para 131).

[46] At a very general level, the patent in issue is directed to a process that can be used for the processing of potatoes in the production of French fries. The process uses electricity to treat the potatoes before cooking to reduce resistance to cutting. There are a number of ways to use electricity in food processing. This includes ohmic heating, which uses electricity to produce heat, and high electric field treatments, which seek to minimize the amount of heat produced. A subset of high electric field treatment is pulsed electric field, or "PEF", which uses relatively strong electric fields and a series of shorter pulses to control the energy delivered to the food product.

[47] Dr Vorobiev's report reviews the disclosure and concludes that the patent is not directed to a PEF process, does not describe an embodiment that involves the use of PEF, nor does it teach the skilled person any PEF parameters that could be used to accomplish the aims of the invention. If McCain proposes a construction that the claims are directed to a PEF process, Simplot may attempt to rely on Dr Vorobiev's evidence as part of an argument that what is claimed is broader than what is disclosed. While it may be unusual for an expert to provide evidence relevant to overbreadth without considering the claims, the invention disclosed is a part of that analysis. I cannot eliminate the possibility that the trial judge could determine that the evidence of Dr Vorobiev is relevant and necessary to overbreadth.

[48] As for sufficiency, the skilled person must be able to produce the invention using only the instructions contained within the disclosure and the skilled person's common general knowledge. A disclosure is insufficient if it necessitates the working out of a problem. The disclosure must teach the skilled person how to put all embodiments of the invention into practice, without the need for exercising inventive ingenuity or undue experimentation, although some non-inventive trial and error experimentation may be required (*Merck Sharp & Dohme Corp v Pharmascience Inc*, 2022 FC 417 at para 252).

[49] Dr Vorobiev's opinion is that the specification does not contain enough information for the skilled person to perform a PEF process and obtain the results disclosed without a large amount of trial and error type experimentation. Again, I cannot eliminate the possibility that the trial judge could determine that the evidence of Dr Vorobiev is relevant and necessary to sufficiency.

[50] McCain may have a valid criticism that the instructions given to Dr Vorobiev were scant. I do not view this as disqualifying, rather what weight may be assigned to the evidence.

[51] To the extent McCain will be prejudiced by the dismissal of its motion, that prejudice is compensable in costs. If McCain is confident that the Vorobiev report will be of no use to the trial judge, it need not serve a responding report. It is expected that McCain will be serving a responding report that addresses the skilled person, common general knowledge, claim construction, state of the art, overbreadth, and sufficiency of disclosure in any event, particularly in response to Dr Sastry. If McCain elects to retain a different expert and serve a report that only

responds to Dr Vorobiev, it may ask for recovery of all costs associated with that report in the event Dr Vorobiev's evidence is excluded or assigned no weight.

[52] McCain has a valid complaint that it was not apparent what validity grounds the Vorobiev report was intended to address. My impression on reading the materials, which proved to be incorrect, was that it was directed to utility. Simplot, in its written and oral submissions, limited the applicability of the Vorobiev report to the skilled person, common general knowledge, claim construction, state of the art, overbreadth, and sufficiency of disclosure. Other than claim construction, which is antecedent to validity and infringement (*Free World Trust* at para 19), it is therefore expected that the Vorobiev report will not be relied on at trial for anticipation, obviousness, utility or ambiguity.

[53] The ruling on this motion is only that the Vorobiev report will not be struck on a preliminary basis. It is for the trial judge to determine the ultimate admissibility of the Vorobiev report, and what weight, if any, should be given to it.

V. Costs

[54] The Court has full discretionary power over the amount and allocation of costs (subrule 400(1)).

[55] At the conclusion of the hearing the parties agreed that costs should be fixed at $5,000.00, payable to the successful party in any event of the cause.

[56] This amount is above what could be awarded at the high end of Column V of the Tariff ($3,470.00). In the context of this long-running dispute between sophisticated parties, I am satisfied that a departure from the Tariff is warranted, and that the amount proposed by the parties is reasonable.

ORDER in T-1624-17

THIS COURT ORDERS that:

1. The plaintiff's motion is dismissed.

2. The parties shall serve any responding expert reports by no later than December 8, 2023, including any responding expert report(s) by the plaintiff responding on claim construction and validity and any responding expert report(s) by the defendants responding on claim construction and infringement.

3. The plaintiff shall serve and file a requisition for pre-trial conference, and pre-trial conference memorandum, by no later than December 22, 2023.

4. Costs are payable by the plaintiff to the defendants, fixed at $5,000.00, payable in any event of the cause.

"Trent Horne"
Associate Judge

FEDERAL COURT

SOLICITORS OF RECORD

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