Date: 20101224

Docket: T-737-08

Citation: 2010 FC 1328

Montréal, Quebec, December 24, 2010

PRESENT: The Honourable Mr. Justice Martineau

BETWEEN:

EUROCOPTER
(société par actions simplifiée)

Plaintiff/
Defendant by
Counterclaim

and

BELL HELICOPTER TEXTRON CANADA
LIMITÉE

Defendant/
Plaintiff by
Counterclaim

REASONS FOR ORDER AND ORDER

[1] The Defendant/Plaintiff by Counterclaim (the Defendant) claims the inadmissibility of the Expert Report of Murray Wilson dated November 11, 2010 (the Wilson Report) and any *viva voce* testimony presented by Wilson during the trial, on four (4) grounds:

- Wilson's testimony regarding the patent examination process and the prosecution of the patent is irrelevant;
- Wilson's testimony regarding Canadian patent law is inadmissible expert testimony on domestic law;
- Wilson's testimony regarding the construction of Canadian Patent No. 2,207,787 (the '787 Patent) and responding substantively to the Defendant's expert reports is inadmissible as Wilson is not being offered to the Court as a person skilled in the art to whom the patent is addressed, nor does he qualify as such; and
- Wilson's testimony regarding whether a patent examiner would have rejected the claims of the '787 Patent based on the Defendant's invalidity attacks is inadmissible and irrelevant.

[2] This type of motion is most often presented as an interlocutory motion to either a prothonotary or another judge, but the parties have requested to present it to me in my capacity as trial judge. The present trial is scheduled to start in about two weeks from now, that is, on January 10, 2011.

[3] The case in question is a standard patent infringement proceeding. The principal action was instituted by the Plaintiff/Defendant by Counterclaim (the Plaintiff) on the grounds that the Defendant's helicopter landing gear is violating the '787 Patent. The Defendant denies that its helicopter landing gear infringes the claims of the '787 Patent and instituted a counterclaim against the Plaintiff seeking the invalidity of the '787 Patent.

[4] In preparation for the action, the parties have exchanged expert reports. The Plaintiff served the reports of Andrew H. Logan and E. Robert Wood on the issue of infringement and of Andrew H. Logan, E. Robert Wood, François Malburet and Murray Wilson on the issue of invalidity.

[5] Murray Wilson is a retired patent examiner with a Bachelor's Degree in mechanical engineering. He has no particular expertise or experience with helicopter landing gear. He has 37 years of experience with the patent examination process and is acknowledged by both parties as an expert in the practices of the Patent Office.

[6] The Wilson Report is comprised of 8 sections. The names and contents thereof are as follows:

1. Introduction – Mr. Wilson introduces himself and his qualifications
2. Material Instructions – Mr. Wilson sets out the mandate he has been given.
3. The Patent Examination Process – Mr. Wilson outlines the process by which a patent is approved by the Patent Office.
4. Canadian Patent 2,207,787 – Mr. Wilson reviews the examination history of Canadian Patent 2,207,787.
5. Novelty – Mr. Wilson discusses the concept of novelty as per the Patent Act and the Manual of Patent Office Practice (MOPOP) in relation to the examiner's task, and addresses the Defendant's Expert reports on novelty.

6. Utility – Mr. Wilson discusses the concept of utility as per the Patent Act and the MOPOP in relation to the examiner's task and the Defendant's Expert reports on utility. Mr. Wilson speculates on the process taken by the examiner.
7. Best Mode – Mr. Wilson discusses the best mode requirement set out in the Patent Act and evaluates the drawings submitted with the '787 Patent.
8. Sound Prediction – Mr. Wilson comments on the Patent Office's understanding of what is required for a sound prediction and applies this to the '787 Patent.

[7] 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;
d) a properly qualified expert (*R. v. Mohan*, [1994] 2 S.C.R. 9 at paragraph 17).

[8] Applying this test to the facts at hand, the Wilson Report is deemed inadmissible for the following reasons.

[9] A large amount of the Wilson Report is an exposé of the evaluation that the '787 Patent would have undergone during the examination process. While there is no question that Mr. Wilson is in a position to provide this general information to the Court, this information is not relevant, as the patent examination process is not in question.

[10] Furthermore, Mr. Wilson speculates, on several occasions, on how a patent examiner would respond to the Defendant's invalidity argument against the '787 Patent. Given the expert's role to inform the Court, such speculation is irrelevant in the case at hand. The Court must assess the Defendant's invalidity attacks from the point of view of the person skilled in the art, and not the point of view of the Patent Office.

[11] The Wilson Report also fails the criterion of necessity. It is well-established that the Federal Court shall take judicial notice of any public or private Act of the Federal Parliament and of the Legislature of the province (Section 18, *Canada Evidence Act*, R.S.C. 1985, c. C-5). Consequently, while expert evidence may be required for international law, it is not admissible as to domestic law (*Pan American World Airways Inc. v. The Queen*, [1979] 2 F.C. 34 (T.D.) at p. 44, affirmed [1980] F.C.J. no. 1158 (F.C.A.) (QL), affirmed [1981] 2 S.C.R. 565 (S.C.C.)).

[12] The Wilson Report's discussion of the requirements of the *Patent Act*, R.S.C. 1985, c. P-4, and the patent examination process, which is governed by the *Patent Act* and the *Patent Rules*, SOR/96-423, is thus unnecessary. The Wilson Report's discussion of the file wrapper is also unnecessary, as the file wrapper is already in evidence.

[13] The third criterion is also not met, as expert evidence on domestic law is not permitted.

[14] Finally, the Wilson Report fails to meet the fourth criterion. As mentioned previously, there is no question that Mr. Wilson is an expert on the patent examination process, but he is certainly not an expert on helicopter landing gear.

[15] Part of the judge's task in a case such as the present one is the construction of claims. Expert evidence is admissible to assist the judge, but the evidence is intended only to render the judge knowledgeable in order to construct the claims, and not to interpret the claims for the judge (*Whirlpool Inc. v. Camco Inc*., [2000] 2 S.C.R. 1067 at paragraph 57). A claim must be given a purposive construction, which results from an objective determination of what a person skilled in the art would have understood the inventor to mean (*Whirlpool*, above, at paragraph 53).

[16] The natural result of the above is that, in order for an expert to assist the Court, the expert must be able to give evidence about what an appropriately skilled person would have known and understood at the time in question. Mr. Wilson is manifestly not such a person. The Plaintiff's expert, Andrew H. Logan, describes the person skilled in the art to whom the '787 Patent is addressed as follows:

> [A] team of engineers, each of whom would have at the very least a Bachelor's degree in engineering, with several years experience working as members of a helicopter landing gear design team with exposure to dynamics, structure analysis, materials, vibration analysis, certification and testing. […] Alternatively, […] a senior Engineer […] who has had many years of experience leading helicopter design teams [or] a senior academic with a Masters or Ph.D. degree in engineering in a related discipline, with specific experience in designing or consulting on the design of helicopter landing gear.

[17] The Plaintiff claims that the Wilson Report does not seek to assist the Court in its construction of the '787 patent claims but rather, merely to inform the Court of the Patent Office's practices. This claim is not supported by the text of the Wilson Report. For example, Mr. Wilson analyzes the specification to determine the utility of the invention, and whether the data provided in

the patent meets the best mode and sound prediction criteria. He also examines the prior art cited by the Defendant's experts. These passages do not qualify as informing the Court of the Patent Office's practices. Rather, they, like most of the Wilson Report, constitute argument.

[18] The Plaintiff cites numerous cases in support of its bid for the admission of the Wilson Report. However, of these cases, only two were not simply interlocutory motions (*Lundbeck Canada Inc. v. Genpharm Inc.*, (2007) T-372-07 and *Lundbeck Canada Inc. v. Genpharm Inc*., (2009) T-372-07; *Merck v. Pharmascience*, 2010 FC 510). Furthermore, the facts of those cases differ substantially from those of the case at hand.

[19] Finally, the Plaintiff argues that even if the Court accepts that the Wilson Report does not meet the Mohan test, the Court should not declare the Wilson Report inadmissible, as the Defendant would not suffer any prejudice from its admission.

[20] The Court disagrees with this statement. The Wilson Report may only be a small part of the Plaintiff's argument, but its admission requires the Defendant to dedicate time and resources to its response. This is sufficient prejudice in the eyes of the Court.

[21] With respect to costs, Counsel for the parties have agreed that a lump sum of $3,000 should be awarded to either party in function of the result of the motion.

[22] In conclusion, an order granting the motion made by the Defendant and excluding the Wilson Report and Wilson's testimony at trial is issued accordingly, with costs of $3,000 to be paid forthwith, in any event of the cause, by the Plaintiff to the Defendant.

ORDER

THIS COURT ORDERS that

1. The Expert Report of Murray Wilson dated November 11, 2010 is inadmissible.
2. The Plaintiff is barred from presenting Murray Wilson as an expert witness at trial.
3. Costs in the amount of $3,000 to be paid by the Plaintiff to the Defendant forthwith, in any event of the cause.

"Luc Martineau"
Judge

FEDERAL COURT

SOLICITORS OF RECORD

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APPEARANCES:

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