Federal Court  Cour fédérale

Date: 20241030

Docket: T-1624-17

Citation: 2024 FC 1729

Ottawa, Ontario, October 30, 2024

PRESENT: Mr. Justice McHaffie

BETWEEN:

MCCAIN FOODS LIMITED

Plaintiff

and

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

Defendants

ORDER AND REASONS

I. Overview

[1] The defendants [collectively, Simplot] seek an order under Rule 290 of the *Federal Courts Rules*, SOR/98-106, permitting them to use at trial parts of the examination for discovery of Dr. Adeline Goullieux, one of the inventors of the patent at issue in this action, which is owned by McCain Foods Limited. In the alternative, Simplot asks the Court to issue a letter of request to the *Tribunal judiciaire* of Compiègne, France [the French Court] asking it to assist this

Court by requiring Dr. Goullieux to give evidence in France for use at trial, pursuant to Rule 272. McCain opposes both requests.

[2] At the conclusion of the hearing of this matter, I granted Simplot's motion in part, with reasons to follow. These are those reasons.

[3] As set out in further detail below, Simplot has not satisfied me that Dr. Goullieux's evidence "cannot be obtained on commission." As this is one of the requirements of Rule 290, I conclude the Court should not grant an order pursuant to that Rule. Nor has Simplot satisfied me that "special circumstances" exist that warrant an order under Rule 55 varying or dispensing with compliance with Rule 290. The Court will therefore not grant an order permitting the use of Dr. Goullieux's examination for discovery as evidence at trial at this time.

[4] With respect to the issuance of a letter of request, McCain raises concerns about prejudice, the timing of Simplot's motion, and the parties' ability to obtain the French Court's assistance and conduct the examination in time for trial, scheduled to begin before me on December 2, 2024. Having considered the overall circumstances, I am satisfied that the relevant factors support the issuance of a letter of request to permit Simplot to obtain Dr. Goullieux's evidence for use at trial. The Court will therefore issue a letter of request to the French Court, on terms somewhat different from those initially proposed by Simplot.

[5] The motion is therefore granted in part. Given the parties' arguments regarding the relevance and significance of Dr. Goullieux's evidence, costs of the motion are reserved to trial.

II. Issues

[6] Simplot's motion raises the following two central issues:

A. Should the Court permit Simplot to use part of the examination for discovery of Dr. Goullieux as evidence at trial, either pursuant to Rule 290 or pursuant to Rule 55?

B. If not, should the Court order the issuance of a letter of request for the conduct of an examination out of Court of Dr. Goullieux in France, pursuant to Rules 271 and 272?

III. Analysis

A. *The Court will not make an order permitting Dr. Goullieux's examination for discovery to be used at trial*

(1) Factual context

[7] In this action, McCain alleges that Simplot has infringed Canadian Patent No 2,412,841 [the '841 Patent], which pertains to a process for treating vegetables and/or fruit with a high electric field before cooking to reduce their resistance to cutting. Simplot denies infringement and alleges the '841 Patent is invalid on a number of grounds, including overbreadth, insufficiency, and lack of utility.

[8] Dr. Goullieux is one of four named inventors of the '841 Patent. As an inventor, Dr. Goullieux is an assignor of her rights in the invention; McCain is an assignee. In January 2022, Simplot examined Dr. Goullieux for discovery by videoconference pursuant to Rule 237(4). That rule provides as follows:

Examination of assignee	Interrogatoire du cessionnaire
237 (4) Where an assignee is a party to an action, the assignor may also be examined for discovery.	**237 (4)** Lorsqu'un cessionnaire est partie à l'action, le cédant peut également être soumis à un interrogatoire préalable.

[9] The purpose of an examination for discovery under Rule 237(4) has been described as twofold: to allow the examining party to obtain general information and possible lines of inquiry regarding the assignment and the right assigned, and to allow them to impeach the credibility of the assignor in the event that they are called as a witness at trial: *Richter Gedeon Vegyészeti Gyar Rt v Merck & Co*, 1995 CanLII 3514, [1995] 3 FC 330 (CA) at p 339; *Faulding (Canada) Inc v Pharmacia SPA*, 1999 CanLII 7940 (FC) at para 4; *Allergan* at para 37. The evidence given by the assignor is only that of the assignor. Unlike an examination for discovery of an adverse party under Rule 235, an assignor's evidence cannot simply be read in at trial and it cannot be used to bind an adverse party unless adopted by them: *Allergan Inc v Apotex Inc*, 2020 FC 658 at para 37; *Federal Courts Rules*, Rule 288.

[10] McCain has not adopted aspects of Dr. Goullieux's evidence that Simplot would like to rely on at trial. In particular, Simplot identifies 42 questions and answers from Dr. Goullieux's examination for discovery that it seeks to use as evidence at trial. This includes Dr. Goullieux's evidence on certain experimental testing results, as well as some questions regarding what the invention covers.

[11] Simplot examined two other inventors for discovery pursuant to Rule 237(4). McCain has undertaken to call one of them at trial. For the second, the parties agreed to an out-of-court

process for taking evidence in France for use at trial pursuant to a commission issued by the Court under Rule 272, and have recently conducted that examination. However, McCain has never indicated an intention to call Dr. Goullieux at trial.

[12] Both parties reached out to Dr. Goullieux several times over the summer of 2024 regarding testimony at trial, without response. On August 16, 2024, McCain advised Simplot that it did not consent to Simplot's request to take commission evidence from Dr. Goullieux. On September 13, 2024, McCain wrote to Simplot advising that it had heard back from Dr. Goullieux, and that she did not consent to being examined.

(2) Principles

[13] Rule 290 permits the Court to allow a person's examination for discovery to be used as evidence at trial where (a) they are unable to testify at trial, and (b) their evidence cannot be obtained on commission. Both of these requirements must be met to trigger the rule:

Unavailability of deponent	**Non-disponibilité d'un déposant**
290 The Court may permit a party to use all or part of an examination for discovery of a person, other than a person examined under rule 238, as evidence at trial if	**290** La Cour peut, à l'instruction, autoriser une partie à présenter en preuve tout ou partie d'une déposition recueillie à l'interrogatoire préalable, à l'exception de celle d'une personne interrogée aux termes de la règle 238, si les conditions suivantes sont réunies :

(a) the person is unable to testify at the trial because of his or her illness, infirmity or death or because the person cannot be compelled to attend; and	**a)** l'auteur de la déposition n'est pas en mesure de témoigner à l'instruction en raison d'une maladie, d'une infirmité ou de son décès, ou il ne peut être contraint à comparaître;
(b) his or her evidence cannot be obtained on commission.	**b)** sa déposition ne peut être recueillie par voie de commission rogatoire.

[14] The Federal Court of Appeal addressed Rule 290 briefly in a decision relating to foreign commission evidence, *Boily v Canada*, 2017 FCA 180. There, the Crown sought to obtain commission evidence in the form of written responses to questions, through the combined application of Rules 99, 271, and 272: *Boily* at paras 1, 9–13. In concluding the request should not be granted, the Court of Appeal noted the importance of the general rule that trial evidence is presented by way of *viva voce* examination and not in writing. It held that this principle should also be applied to commission evidence taken out of Court, while recognizing there may be exceptions where a party could demonstrate that an order for written evidence was proper in all the circumstances: *Boily* at paras 64–65.

[15] Justice Nadon for the Court found support for this proposition in Rule 290. After citing the text of the rule, he interpreted it in the following way:

> In other words, a party may be allowed to use all or part of its examination for discovery of a person (in that context, counsel for the person being discovered has no right to examine or re-examine the witness) […], where the person is unable to testify because, *inter alia*, of his or her medical condition and that person's evidence cannot be obtained on Commission. In my opinion, the assumption behind rule 290 is that before the Court will accept the discovery examination of a person, it must make sure that there is no real possibility of that person being able to be examined in the

> usual manner, i.e. by way of *viva voce* questions and answers subject to cross-examination. Thus, the Rules clearly support the view that trial testimony should preferably be given by way of *viva voce* questions and answers subject to cross-examination. Written examinations should only be allowed as evidence when proceeding in the usual way is not possible.
>
> [Emphasis added; *Boily* at para 69.]

[16] The foregoing passage may be considered *obiter*, since the Federal Court of Appeal was not called upon directly to interpret and apply Rule 290, but simply used the rule as argumentative support for its conclusions on other rules. Nonetheless, as an observation by the Court of Appeal directly addressing the meaning of Rule 290 and the assumption behind it, it is, at the least, highly persuasive.

[17] Justice Nadon's reasoning is also, in my view, unassailable. As he points out, the language of both Rule 290(a) and (b) is clearly designed to put narrow limits on the circumstances in which the Court will allow discovery evidence to be used in place of a witness's *viva voce* evidence. Notably, Rule 290(a) requires the witness to be "unable" to testify at trial, and to be unable to do so either due to health or because they are beyond the compellable power of the Court. Thus, as Justice Nadon describes, the purpose of the rule is not to address circumstances where it would simply be more convenient or cheaper to use the discovery evidence, but where there is "no real possibility" of having the witness testify. This "no real possibility" approach is also seen in Rule 290(b), which requires that the witness's evidence "cannot" be obtained on commission.

[18] Simplot contends that Rule 290 must be interpreted in accordance with Rule 3, which sets out the "general principle" that informs the Court's interpretation and application of the *Federal Courts Rules*:

General principle	**Principe général**
3 These Rules shall be interpreted and applied	**3** Les présentes règles sont interprétées et appliquées :
(a) so as to secure the just, most expeditious and least expensive outcome of every proceeding; and	**a)** de façon à permettre d'apporter une solution au litige qui soit juste et la plus expéditive et économique possible;
(b) with consideration being given to the principle of proportionality, including consideration of the proceeding's complexity, the importance of the issues involved and the amount in dispute.	**b)** compte tenu du principe de proportionnalité, notamment de la complexité de l'instance ainsi que de l'importance des questions et de la somme en litige.

[19] Simplot therefore submits that the question of whether evidence "cannot be obtained on commission" must be interpreted through the lens of whether obtaining commission evidence would be just, expeditious, least expensive, and proportional. Simplot reinforces this submission with reference to the Supreme Court of Canada's decision in *Hryniak,* which exhorted participants in the Canadian civil justice system, including Courts, to adopt a "culture shift" to promote timely and affordable access to that system: *Hryniak v Mauldin*, 2014 SCC 7 at paras 1–2, 4, 23–33; *Sport Maska Inc v Bauer Hockey Ltd*, 2019 FCA 204 at para 32. Simplot highlights the "modern reality" described by Justice Karakatsanis, noting that in considering the balance between procedure and access, it can be an error to place too high a premium on the ideal

presented by a conventional trial in which all witnesses are called to give *viva voce* evidence: *Hryniak* at paras 2, 4.

[20] I agree with Simplot that Rule 290, as with all rules in the *Federal Courts Rules*, must be interpreted and applied in light of the general principle of Rule 3. However, Rule 290 must also be interpreted and applied based on the text, context, and purpose of the rule itself. Rule 3 is an interpretative principle and not an open invitation to rewrite the rules: see, *e.g.*, *Apotex Inc v Merck & Co*, 2003 FCA 438 at para 13. Rule 290 uses the terms "unable to testify" and "cannot be obtained." This is strong, arguably absolute, language. Even accepting that interpreting this language through the lens of Rule 3 allows for some flexibility, that flexibility is limited given the context and purpose of Rule 290. In my view, this is reflected in the "no real possibility" language used by Justice Nadon, even though he did not expressly refer to Rule 3 in his discussion in *Boily*. As discussed further below, some additional flexibility is found in the possibility of varying or dispensing with compliance with the rule under Rule 55 in the appropriate case.

[21] Justice Nadon's reading of Rule 290 is also consistent with the only other case identified by the parties addressing the rule, *Newfoundland Processing Ltd v South Angela (The)*, [1995] FCJ No 784. That case dealt with a predecessor rule to Rule 290, which included language similar to that in Rule 290(a) and (b), but added a third requirement that "special circumstances exist": *The South Angela* at para 2; *Federal Court Rules*, CRC, c 663, Rule 494(10.2). Justice Rouleau concluded that to succeed in its application under this rule, the applicant must convince the Court that "the witness is absolutely unavailable and that all

reasonable steps to arrange the witness' attendance at trial have been taken" [emphasis added]: *The South Angela* at para 3. If anything, Justice Nadon's "no real possibility" language is more permissive than the "absolutely unavailable" approach of Justice Rouleau.

[22] Simplot points to a decision of the British Columbia Supreme Court as an example of the application of the principle of proportionality in permitting discovery evidence to be used at trial even when commission evidence could be obtained: *Beazley v Suzuki Motor Corporation*, 2009 BCSC 1575 at para 34. However, the rule the Court was applying in *Beazley* is considerably more permissive than Rule 290 of the *Federal Courts Rules*, applying to any evidence taken under oath and having no equivalent to the requirement of Rule 290(b): *Beazley* at para 27; *Supreme Court Rules*, BC Reg 221/90, Rule 40(4) [now *Supreme Court Civil Rules*, BC Reg 168/2009, Rule 12-5(54)]. There were also important factual differences, including that the evidence in question was originally taken with the intent that it would be read in at trial as the discovery of an adverse party: *Beazley* at para 32. As a result, while *Beazley* provides an interesting example of the interplay between proportionality, discretion, fairness, prejudice, and trial evidence, it is of little assistance in interpreting Rule 290 and applying it to the present case.

[23] I therefore conclude that to obtain an order under Rule 290, a party must demonstrate that the witness is unable to testify at trial for one of the reasons enumerated in Rule 290(a) and that their evidence cannot be obtained on commission as required by Rule 290(b), considering each on a "no real possibility" standard. With respect to the latter, I note my agreement with McCain that if a witness's evidence "cannot" be obtained on commission entirely due to a party's own conduct, such as an unexplained delay in seeking a letter of request or letters rogatory or taking

steps to have them recognized, the requirement is unlikely to be met. At the very least, the Court may be disinclined to exercise its discretion under Rule 290 in such circumstances.

(3) Application to the current circumstances

[24] Dr. Goullieux cannot be compelled to attend at trial in Canada because she is a French citizen residing in France. I therefore conclude that the requirement under Rule 290(a) is met.

[25] McCain argues, with reference to *The South Angela*, that Simplot has not established that it took "all reasonable steps to arrange the witness' attendance at trial." It suggests that Simplot's emails did not advise Dr. Goullieux that it would be seeking to secure her testimony by commission if she declined to participate voluntarily, which might have convinced her to testify. I disagree. I cannot read Rule 290 as requiring a party to effectively threaten commission proceedings to pressure a witness into testifying voluntarily. In any case, Dr. Goullieux did not respond at all to Simplot's inquiries, and there is no evidence to support McCain's speculation that she might have agreed to testify voluntarily if the alternative were evidence taken on commission. She simply did not consent to being examined. I agree with Simplot that in the circumstances, once McCain advised it of Dr. Goullieux's position, it was not obliged to undertake further attempts to contact her.

[26] However, I am not satisfied that Simplot has established that Dr. Goullieux's evidence cannot be obtained on commission, as required by Rule 290(b). On this issue, Simplot's submissions are primarily premised on its argument that Rule 290 should be read flexibly in light of Rule 3. It argues that permitting Dr. Goullieux's discovery evidence to be read in at trial

would avoid unnecessary time, effort, and expense to the parties, to the French and Canadian courts, and to Dr. Goullieux herself, and that it would not cause any prejudice to McCain. In my view, these considerations are relevant to the application of Rule 55, but they are not part of Rule 290. For the reasons set out above, Rule 290 has specific and stringent requirements, including that there be no real possibility that the witness's evidence could be obtained on commission.

[27] The parties each recognize that there may be circumstances where a witness's evidence might technically or possibly be obtained on commission, but that prohibitive cost or legal impediments might mean that there was "no real possibility" of obtaining it. This is not such a case. The witness is in France. While there will no doubt be time, cost, and travel associated with this process of obtaining the evidence, these are not of a nature that would render it effectively or practically not possible to do so.

[28] With respect to legal impediments, each party filed an affidavit from a French lawyer opining on the process for executing a letter of request or letters rogatory from Canada. Somewhat ironically, on the question of Rule 290(b), each party relied primarily on the opinion evidence filed by the other.

[29] To summarize, Simplot filed an affidavit from Me Pierre-Olivier Ally, a member of the Quebec, New York, and Paris bars, currently practising in intellectual property litigation, who has been involved in matters relating to seeking the assistance of courts in France in obtaining commission evidence. Me Ally described the process for seeking execution of letters of request in France, the rights of the individual being examined, and the process on examination. He gave

his opinion that "there is a reasonably high probability" that the French Court will enforce and issue the letter of request sought by Simplot on this motion, that the process usually takes two to six months, but that it is possible to ask the French Court to treat the letter of request expeditiously given the trial date in this matter.

[30] McCain responded with an affidavit from Me Floriane Codevelle, a member of the Paris bar whose studies included a six-month period in Quebec, and who also practises in intellectual property litigation in France. Me Codevelle opined that there was some question as to whether the *Tribunal judiciaire* of Compiègne was the right court to apply to, that execution was "unlikely" to occur before trial starts in this matter on December 2, 2024, and that there was a possibility that a French judge could annul the resulting examination. Neither lawyer was cross-examined.

[31] With respect to the question of whether Dr. Goullieux's evidence "cannot be obtained on commission," McCain underscored that Simplot's own expert evidence—and indeed its entire request for alternative relief—indicated that it could be obtained. Simplot countered by referring to McCain's expert evidence, highlighting the uncertainties that Me Codevelle had raised.

[32] On balance, and despite any uncertainties raised by Me Codevelle, it cannot be said on the evidence before me that there is no real possibility of obtaining Dr. Goullieux's evidence on commission. I therefore conclude that the requirements of Rule 290 have not been met.

[33] If it turns out that Simplot is ultimately unable, for one reason or another, to obtain commission evidence from Dr. Goullieux, then the situation may be different. Should this be the case, Simplot is at liberty to make a further motion under Rule 290, recognizing the observations above regarding the circumstances or reasons for which the evidence cannot be obtained.

(4) Varying or dispensing with compliance

[34] Simplot also asks the Court to vary or dispense with compliance with Rule 290. The Court may make such an order pursuant to Rule 55, which reads as follows:

Varying rule and dispensing with compliance	**Modification de règles et exemption d'application**
55 In special circumstances, in a proceeding, the Court may vary a rule or dispense with compliance with a rule.	**55** Dans des circonstances spéciales, la Cour peut, dans une instance, modifier une règle ou exempter une partie ou une personne de son application.

[35] As Justice Gleason for the Federal Court of Appeal observed, Rule 55 gives "textual expression to the broader principle that the Federal Court has plenary powers to manage its processes and proceedings" and "empowers the Court to give effect to the proportionality mandated by *Hryniak*": *Sport Maska* at paras 36–37. At the same time, while Rule 55 permits the Court to dispense with compliance with a rule, it is also not designed to permit a wholesale re-writing of the rules, particularly over the objections of another party, and the discretion should only be exercised where there are "special circumstances" to warrant it: *Apotex Inc v Bayer Inc*, 2020 FCA 86 at para 40; *Yearsley v Canada*, 2001 FCT 732 at para 7.

[36] What constitutes “special circumstances” will necessarily depend on a variety of factors and the particular circumstances of the case. This will include the rule that a party is seeking to vary or dispense with, and the extent of the requested variance. The more significant the requested departure from the usual rules, and the greater the impact on the process and the interests of another party, the more a party will be expected to justify that departure based on the circumstances of the case. In some cases, the existence of significant savings in cost or time resulting from the requested variance or dispensation may be particularly relevant, as may other contextual factors such as the degree of cooperation the parties have demonstrated in the proceeding and the timeliness of the Rule 55 motion: *Hoffman-La Roche Limited v Pfizer Canada Inc*, 2018 FC 932 at paras 5–6. Importantly, it is implicit in considering the “special circumstances” under Rule 55 that justice be done and that there be no prejudice to any party: *Yearsley* at para 7, citing *Chow v Canada*, 1998 CanLII 8853 (FC); *Hoffman-La Roche* at para 4. This is entirely consistent with the general principle in Rule 3, which requires the Court to secure not only the most expeditious and least expensive outcome but, importantly, the just one.

[37] It is relevant in this case that Simplot seeks dispensation from compliance with a rule that establishes a specific and narrow test to obtain the relief it seeks, namely to file discovery evidence at trial. To show that it ought to be permitted to avoid the application of Rule 290, Simplot must show there are special circumstances that justify allowing it to get the benefit of filing the discovery evidence without meeting the test in Rule 290. For the following reasons, I am not satisfied that it has done so.

[38] As special circumstances, Simplot points to the relevance and reliability of Dr. Goullieux's discovery evidence; the time, effort, and expense to the parties of obtaining commission evidence simply to obtain the same evidence that Dr. Goullieux already provided; the imposition on this Court and the French Court; the avoidance of uncertainties associated with commission evidence; the burden on Dr. Goullieux herself of having to attend for a further examination; and the absence of prejudice to McCain.

[39] Despite McCain's contrary arguments, I am satisfied that Dr. Goullieux's evidence is at least relevant to some of Simplot's invalidity arguments, notably those of overbreadth and inutility. However, the relevance of the evidence seems to me to be a *sine qua non*: if it were not relevant, there would be no basis to accept it at trial in any case. This therefore does not seem to be a special circumstance justifying dispensation from Rule 290. The reliability of the evidence is relevant, as is the context in which it was given under oath, although this is tempered by the nature of the Rule 237(4) examination, discussed further below.

[40] Similarly, many of Simplot's other arguments could be raised in respect of any commission evidence from a witness who has been examined for discovery. It would almost invariably be less costly and time consuming, for the parties, the courts, and the witness, to simply read in their discovery evidence instead of obtaining their evidence for trial on commission. Yet Rule 290 nonetheless requires that commission evidence be unobtainable before discovery evidence can simply be read in. In my view, for these factors to constitute "special circumstances," justifying a dispensation under Rule 55, the Court must be satisfied that

these costs and inconveniences are unusually disproportionate given the nature of the proceeding, its complexity and importance, and the amount in dispute.

[41] In the present case, which is bifurcated, there is no evidence before me regarding the amount in dispute. Nor is there evidence of the estimated cost of taking steps in France to recognize a letter of request and take Dr. Goullieux's evidence on commission. However, the litigation as a whole is clearly important enough for both parties for them to have dedicated significant resources to it over the course of a number of years, and the invalidity issues raised by Simplot are both central to the litigation and of above-average complexity. In my view, the evidence does not establish that the cost and inconvenience of obtaining Dr. Goullieux's evidence by commission through execution of a letter of request in France justifies dispensing with the requirements of Rule 290, either alone or in combination with the other factors and circumstances.

[42] I note in this regard my disagreement with Simplot's assertion that taking Dr. Goullieux's trial evidence on commission would necessarily involve simply obtaining the same evidence she already provided. The entire context of the rules governing discovery evidence and trial evidence recognizes that a witness's evidence at trial may not be exactly the same as their evidence on discovery. Both the scope and content of a witness's evidence may be different, in ways either subtle or more substantial. Were it otherwise, the *Federal Courts Rules* would simply provide for discovery evidence to stand in for a witness's evidence at trial as a general matter.

[43] This brings us to the question of prejudice to McCain. The parties' primary arguments on this question relate to McCain's ability to examine Dr. Goullieux. Simplot argues that Dr. Goullieux is aligned in interest with McCain and cooperated with McCain in preparation for her examination for discovery, and that McCain's counsel met with her in advance of that examination and "defended" her at the examination. It contends that McCain had the opportunity to assist Dr. Goullieux in clarifying her evidence before the examination, and could have re-examined her to clarify any answers, but chose not to. It therefore argues there would be no prejudice to McCain in having the discovery evidence read in without an opportunity to examine Dr. Goullieux. It also notes that McCain's positions on Dr. Goullieux's evidence, as well as any clarifying read-ins, can be read into the record along with the discovery excerpts it seeks to read in.

[44] McCain, for its part, alleges that Dr. Goullieux is not aligned in interest with McCain, that counsel acted for McCain and not Dr. Goullieux both prior to and at the examination, and that the limited possibility of re-examination at a discovery cannot replace the important opportunity to examine or cross-examine Dr. Goullieux as part of her trial evidence. It also argues, more broadly, that trial fairness favours *viva voce* evidence from Dr. Goullieux, particularly to the extent that her evidence may differ from that of one or both of the two other inventors whose evidence is anticipated at trial.

[45] I accept Simplot's submission that Dr. Goullieux, as inventor of the patent that McCain owns and is seeking to uphold and enforce, is generally aligned in interest with McCain. This is so despite the expiry of the '841 Patent in 2021, prior to Dr. Goullieux's examination for

discovery. There is no evidence to support McCain's contention that as a result of this expiry, Dr. Goullieux has no interest, personal or professional, in whether the '841 Patent is upheld. There is no evidence to suggest that Dr. Goullieux's interests are any different than those of the typical inventor. The fact that some of Dr. Goullieux's evidence might potentially assist Simplot or hurt McCain's case (the subtext to the parties' dispute on this motion) also does not affect the alignment. A party does not become adverse or not aligned in interest simply because some of their evidence may be unhelpful.

[46] Nonetheless, I agree with McCain that it will suffer at least some prejudice if Simplot is permitted to read in Dr. Goullieux's discovery evidence without McCain having had the opportunity to examine her. This prejudice appears to be recognized in Rule 290 itself. As Justice Nadon noted in *Boily*, counsel for a person being discovered has no general right to examine or re-examine the witness, a fact that underlies the stringent test in Rule 290: *Boily* at para 69. This is all the more so where counsel attending the examination is not counsel for the witness. Dr. Goullieux's willingness to meet with McCain's counsel before the examination, and any limited ability counsel had to ask clarifying questions, are relevant. But they are no substitute for the examination of a witness for purposes of trial. Simplot seeks to put forward Dr. Goullieux's evidence as relevant to a central question in the litigation: the validity of the '841 Patent. McCain's inability to itself examine such a witness creates some inherent prejudice.

[47] Considering all of the circumstances, including the efficiencies and benefits identified by Simplot and the prejudice identified by McCain, and with consideration of Rule 3, I am not satisfied Simplot has established special circumstances that justify an order under Rule 55

varying or dispensing with compliance with Rule 290 and permitting it to read in Dr. Goullieux's discovery evidence at trial.

B. *The Court will issue a letter of request for the taking of commission evidence*

(1) Principles

[48] Rule 271 of the *Federal Courts Rules* permits the Court on motion to make an order for the examination for trial of a person out of Court, considering factors such as the expected absence of the person at the time of trial, the distance they reside from the place of trial, and the expense of having them attend at trial. Where such an examination is to be undertaken outside Canada, the Court can order the issuance of a letter of request or similar document pursuant to Rule 272:

Commission for examination outside Canada	**Commission rogatoire**
272 (1) Where an examination under rule 271 is to be made outside Canada, the Court may order the issuance of a commission under the seal of the Court, letters rogatory, a letter of request or any other document necessary for the examination in Form 272A, 272B or 272C, as the case may be.	**272 (1)** Lorsque l'interrogatoire visé à la règle 271 doit se faire à l'étranger, la Cour peut ordonner à cette fin, selon les formules 272A, 272B ou 272C, la délivrance d'une commission rogatoire sous son sceau, de lettres rogatoires, d'une lettre de demande ou de tout autre document nécessaire.

Examination outside Canada	**Interrogatoire à l'étranger**
(2) A person authorized under subsection (1) to take the examination of a witness in a jurisdiction outside Canada shall, unless the parties agree otherwise or the Court orders otherwise, take the examination in a manner that is binding on the witness under the law of that jurisdiction.	**(2)** À moins que les parties n'en conviennent autrement ou que la Cour n'en ordonne autrement, la personne autorisée en vertu du paragraphe (1) à interroger un témoin dans un pays autre que le Canada procède à cet interrogatoire d'une manière qui lie le témoin selon le droit de ce pays.

[49] The decision to order the issuance of a letter of request to allow the taking of commission evidence is discretionary. The Federal Court of Appeal in *Boily* noted that all relevant circumstances are to be considered in making such an order, while enumerating four non-exhaustive factors that are deserving of consideration: (i) the application must be *bona fide*; (ii) the issue in respect of which the testimony is sought must be relevant to the proceedings; (iii) the witnesses must be able to give material evidence on the issue; and (iv) there must be good grounds for which the witnesses cannot attend trial: *Boily* at para 42.

[50] Where the Court orders the issuance of a letter of request for taking commission evidence outside Canada for use at trial pursuant to Rules 271 and 272, the conduct of the examination will necessarily be influenced by the law and practice in the jurisdiction of the examination: *Federal Courts Rules*, Rule 272(2). This is inherent in the request being sent to a foreign judicial authority for assistance in the conduct of an examination. However, the evidence is ultimately being gathered for its use at a trial in Canada, such that the request may reasonably indicate how such an examination would be conducted in Canada and the terms of such an examination, and

request that consideration be given to such an approach in the foreign jurisdiction: *Federal Courts Rules*, Rules 53, 90(2), 271(3), 272(2), Forms 272A, 272B, 272C.

(2) Application to the current circumstances

[51] Simplot's alternative request for a letter of request to seek to examine Dr. Goullieux in France is clearly *bona fide*. McCain does not argue otherwise. Simplot seeks to obtain the evidence for trial of an inventor of the patent at issue in the case.

[52] With respect to the issues of relevance and materiality, I have concluded above that the evidence of Dr. Goullieux is relevant to at least some of the invalidity arguments raised by Simplot. Whether these arguments, or Dr. Goullieux's evidence on them, are accepted or determinative of course remains to be seen at trial. However, I am satisfied based on Simplot's arguments and its reference to Dr. Goullieux's examination for discovery that she has material factual evidence to give that is relevant to certain of the invalidity issues, including overbreadth and inutility in particular.

[53] McCain's argument that the timing of Dr. Goullieux's involvement in the work leading to the '841 Patent renders her evidence less relevant is unpersuasive. While argument regarding the value of the evidence can, and no doubt will, be presented at trial, I am satisfied that the evidence has relevance to justify issuing a letter of request. McCain's argument that Dr. Goullieux's evidence is unnecessary because evidence regarding the invention can be obtained from the other two inventors (whose evidence McCain appears to prefer) is specious. Indeed, I agree with Simplot that McCain's position that Dr. Goullieux's evidence is unnecessary and of limited

relevance is at least somewhat at odds with its strenuous position that reading in her discovery evidence, or allowing her to testify without the opportunity for McCain to examine, would be significantly prejudicial.

[54] I am also satisfied there are good grounds that Dr. Goullieux cannot attend the trial, namely her non-compellability and her stated desire not to be examined: *Federal Courts Rules*, Rule 271(2)(a). Again, McCain does not argue otherwise.

[55] McCain argues that Simplot has not shown that the examination will occur before trial, and that a letter of request should not be granted on that basis. While not one of the enumerated factors in *Boily*, I agree that this is a relevant factor. It is not in the interests of justice to issue a letter of request if the evidence indicates that doing so will be futile because it will not or cannot be executed to obtain the desired evidence for trial.

[56] On this issue, the parties rely on their own expert evidence. Simplot relies on Me Ally's opinion that the French judicial authorities will "very likely" enforce the letter of request. McCain relies on the concerns raised by Me Codevelle, particularly as to timing, jurisdiction, and potential nullity of the examination. Having reviewed this evidence, I am not satisfied that the various potential reasons that a letter of request may not result in a timely taking of Dr. Goullieux's evidence speak materially against issuance of such a letter. The parties, and particularly Simplot, will no doubt have to act quickly to obtain the evidence, and will have to persuade the French Court to process the matter expeditiously. However, they should be permitted the opportunity to do so.

[57] I reach this conclusion despite McCain's fairly persuasive argument that the urgency is at least in part of Simplot's own doing. Trial of this matter was set down on March 27, 2024, to commence on December 2, 2024. Simplot knew the inventors resided in France. If it considered their evidence material for trial, it should have addressed the issue at the earliest opportunity to determine whether commission evidence and a letter of request would be necessary and to make arrangements to seek one.

[58] In July of this year, the parties submitted a joint schedule for pre-trial steps that included a time for motions for letters rogatory and commission evidence to be filed in "July-August 2024 (subject to the availability of the Court)." This schedule was incorporated into Case Management Judge Horne's order of July 11, 2024. Nevertheless, Simplot does not appear to have reached out to Dr. Goullieux itself until August 2024, did not raise the potential for a motion with the Court until mid-August, and did not request motion dates until mid-September, resulting in the motion itself being filed in late September and heard in late October. The process of inquiry, discussion with opposing counsel, disagreement, and identifying the need for a motion could have, and should have, been undertaken earlier. The overall timing of Simplot's efforts to obtain evidence from Dr. Goullieux and ultimately of this motion is a factor speaking against the granting of a letter of request.

[59] That said, I am of the view that considering all of the relevant factors, including the nature of the evidence, the issues to which it speaks, and the importance of permitting Simplot the opportunity to obtain that evidence, it is in the interests of justice to order the issuance of a letter of request.

[60] The other arguments made by McCain in opposition to Simplot's request go primarily to the form of the examination requested. In my view, they can be addressed through the terms of the order.

[61] The draft order requested by Simplot specifies, among other things, that the examination be conducted such that Dr. Goullieux first be cross-examined by Simplot's counsel, and that she then be re-examined by McCain's counsel. McCain does not contest Simplot's right to cross-examine, but argues that Simplot's proposal prejudicially removes its own right to cross-examine Dr. Goullieux. It contends that since Simplot is effectively proposing to call Dr. Goullieux as its own witness, it should be permitted to cross-examine Dr. Goullieux. It relies on the value of cross-examination in getting to the truth, and on Justice Nadon's observation that when evidence is taken out of Court, "the Court should ensure to the extent possible that such evidence will be taken by way of *viva voce* questions and answers subject to cross-examination": *Boily* at para 64.

[62] Importantly, however, Justice Nadon was addressing what I consider the usual situation in which a party is seeking to obtain commission evidence from a witness who is aligned in interest. In the ordinary course, a party calling a witness conducts an examination-in-chief (without leading questions), and opposing parties can conduct cross-examination. However, where a party seeks to call evidence from a witness who is adverse in interest, the Court may permit the party to cross-examine the witness, to be followed by a re-examination by parties not adverse in interest: *Tepper v Canada (Attorney General)*, 2020 FC 1046 at para 21, by analogy to Rule 53.07 of the *Rules of Civil Procedure*, RRO 1990, Reg 194, governing examination of adverse parties.

[63] As noted, McCain contends that Dr. Goullieux is not aligned in interest with McCain, a contention I have rejected. There is certainly no evidence that Dr. Goullieux is adverse in interest to McCain. I do not therefore consider that McCain has a presumptive right to cross-examine Dr. Goullieux simply because Simplot is seeking to tender her evidence. The situation of an adverse inventor may of course arise, such as in the context of an inventorship or ownership dispute. However, McCain was unable to point to, and the Court is unaware of, any case in which a patentee was permitted to cross-examine an inventor of its own patent simply because they were not employed by the patentee and/or the patent had expired.

[64] That said, I agree with McCain that it should be entitled to examine Dr. Goullieux, and that describing that examination as a "re-examination" may be taken to unduly restrict the examination to clarification of issues addressed in Simplot's cross-examination. I will therefore order that after Simplot's cross-examination, McCain will be allowed to "examine" Dr. Goullieux (rather than re-examine or cross-examine). In my view, this reasonably addresses McCain's concerns about procedural prejudice, without going too far by permitting McCain to cross-examine an inventor of the very patent on which it brings this action.

[65] The other procedural issue raised by McCain is the treatment of its confidential information in the context of an examination conducted in France pursuant to a letter of request. It raised a concern, supported by Me Codevelle's opinion, that Simplot's draft order, commission, and letter of request did not adequately ensure the protection of confidential information. At the hearing of this motion, Simplot expressed its willingness to revise its draft to better ensure protection. Counsel agreed that they should be able to find revised language that

would address this concern and proposed to submit a revised draft. The letter of request this Court will issue will reflect the parties' revised draft addressing this issue.

IV. Conclusion

[66] For the foregoing reasons, I will grant Simplot's motion in part, and will order that the Court issue a letter of request to the French Court for the taking of commission evidence of Dr. Goullieux in accordance with the foregoing reasons. For clarity, the use of such evidence at trial will necessarily be subject to the Court's rulings on the admissibility of the particular evidence elicited and on the objections of the parties to that evidence.

[67] As the parties presented and argued this motion in English, I have prepared this Order and Reasons in that language. However, given the location of the proposed examination, the draft order, commission, and letter of request prepared by Simplot were appropriately prepared in French. As noted above, counsel indicated at the hearing that they would discuss revisions to the draft order. At the time of issuance of this Order and Reasons, the Court had not received that revised draft. My order below will therefore simply indicate that a separate order will issue requiring the Administrator to issue a commission and letter of request, and that Simplot is to submit a revised draft order, approved by McCain, that will reflect the reasons herein.

[68] Each party sought its costs of this motion, suggesting that an appropriate award of costs would be in the range of $3,000 to $5,000. In the circumstances, given the parties' arguments regarding the importance of the evidence and concerns that it may not be taken, I consider it appropriate to defer the question of costs of this motion to the trial of the matter.

ORDER IN T-1624-17

THIS COURT ORDERS that

1. The motion is granted in part.
2. The Court will issue an order in accordance with these reasons, ordering the Administrator to prepare a commission and letter of request for the taking of commission evidence of Dr. Goullieux. The defendants are to submit a revised draft order, commission, and letter of request, approved by the plaintiff, reflecting these reasons.
3. Costs of this motion are reserved for determination at trial.

"Nicholas McHaffie"
Judge

FEDERAL COURT

SOLICITORS OF RECORD

DOCKET:	T-1624-17
STYLE OF CAUSE:	MCCAIN FOODS LIMITED v JR SIMPLOT COMPANY AND SIMPLOT CANADA (II) LIMITED
PLACE OF HEARING:	HELD BY VIDEOCONFERENCE
DATE OF HEARING:	OCTOBER 28, 2024
ORDER AND REASONS:	MCHAFFIE J.
DATED:	OCTOBER 30, 2024

APPEARANCES:

Mark Davis Kassandra Shortt Eleanor Wilson	FOR THE PLAINTIFF
Daniel Davies Emily Miller	FOR THE DEFENDANTS

SOLICITORS OF RECORD:

CASSELS BROCK & BLACKWELL LLP Toronto, Ontario	FOR THE PLAINTIFF
SMART & BIGGAR LLP Ottawa, Ontario	FOR THE DEFENDANTS