Federal Court  Cour fédérale

Date: 20150618

Docket: T-396-13

Citation: 2016 FC 436

Ottawa, Ontario, June 18, 2015

PRESENT: The Honourable Mr. Justice Keith M. Boswell

BETWEEN:

HOSPIRA HEALTHCARE CORPORATION

Plaintiff

and

THE KENNEDY INSTITUTE OF RHEUMATOLOGY

Defendant

AND BETWEEN:

THE KENNEDY TRUST FOR RHEUMATOLOGY RESEARCH, JANSSEN BIOTECH, INC., JANSSEN INC. AND CILAG GMBH INTERNATIONAL

Plaintiffs by Counterclaim

and

HOSPIRA HEALTHCARE CORPORATION,
CELLTRION HEALTHCARE CO. LTD
AND CELLTRION INC.

Defendants by Counterclaim

ORDER

UPON MOTION dated the 27th day of April, 2015, on behalf of the Hospira Healthcare Corporation [Hospira] and Celltrion Healthcare Co. Ltd and Celltrion Inc. [collectively, Celltrion], pursuant to Rule 51 of the *Federal Courts Rules*, for:

1. An Order that the Order of Prothonotary Milczynski [the Prothonotary] dated April 17, 2015 (re: re-attendance, *inter alia*, of the inventors of Canadian Patent No. 2,261,630 [Patent 630] be set aside, in part;
2. An Order that Drs. Feldmann and Mani attend continued examinations for discovery for one day each and that such examinations for discovery are to be conducted in person at their own expense;
3. Costs of this motion payable to Hospira and Celltrion;
4. Costs of the motion below payable to Hospira and Celltrion; and
5. Such further and other relief as this Honourable Court may deem just.

AND UPON hearing this motion at Toronto, Ontario, on June 16, 2015, and reviewing the materials filed with the Court and hearing the arguments and submissions of the parties;

AND UPON reserving a decision with respect to this matter;

AND UPON concluding that this motion should be dismissed for the following reasons:

1. According to *R. v. Aqua-Gem Investments Ltd.*, [1993] 2 F.C. 425 (C.A.) at paragraph 67, discretionary orders of prothonotaries should not be disturbed on appeal unless (a) they are clearly wrong, in the sense that the exercise of discretion by the prothonotary was based upon a wrong principle or upon a misapprehension of the facts, or (b) in making such orders, the prothonotary improperly exercised her discretion on a question vital to the final issue of the case.

2. Compelling the re-attendance of the inventors of Patent 630 does not raise or involve any question which is vital to the final issue of the case. On the contrary, at best such re-attendance will only serve to provide historical context in respect of Patent 630's origination and development.

3. Furthermore, it cannot be said that the Prothonotary's decision in respect of the re-attendance of the inventors is clearly wrong, in the sense that the exercise of discretion by the Prothonotary was based upon a wrong principle or upon a misapprehension of the facts.

4. This Court is reluctant to interfere with decisions made by a prothonotary in the course of case managing a matter prior to trial, particularly one as complex as this one. When performing case management functions prothonotaries are appropriately given "elbow room" by appellate courts, so that they can get on with what is often a difficult job, calling for a mix of patience, flexibility, firmness, ingenuity, and an overall sense of fairness to all parties. These qualities are evident in the way in which the Prothonotary has performed her tasks to date

in the present matter (see *Sawridge Band v. Canada*, 2006 FCA 228, at paragraphs 21-24).

5. Inasmuch as the Prothonotary's decision involved an exercise of discretion, the Moving Parties here had a high hurdle to cross, and they failed to establish that the Prothonotary exercised her discretion on the basis of an erroneous view of the law or a misapprehension of the facts, or was otherwise non-judicial. Indeed, upon review of the Prothonotary's decision as to the re-attendance of the inventors in view of the procedural history of this matter to date, her Order in this regard is not only a focused decision but a reasonable one as well.

6. In my view, this motion by the Moving Parties was of questionable necessity or merit, to say the least. Not only did they not succeed but, in many respects, appealing the Prothonotary's decision in respect of the re-attendance of the inventors only served to undermine the objectives of the case management system in the *Federal Courts Rules*. Consequently, I award costs to the Responding Parties in the fixed amount of $5,000 (inclusive of any disbursements and taxes), such costs to be payable forthwith and in any event of the cause.

THIS COURT ORDERS that: the motion by the Defendants by Counterclaim is dismissed and the Defendant/Plaintiffs by Counterclaim shall have their costs in respect of this motion in the fixed amount of $5,000 (inclusive of any disbursements and taxes), such costs to be payable forthwith and in any event of the cause.

"Keith M. Boswell"

Judge