



T-1875-95

**BETWEEN:**

**VISX, INCORPORATED**

**Plaintiff**

- and -

**SUMMIT TECHNOLOGY INCORPORATED,  
Dr. YAIR KARAS, Dr. MICHEL BRUNET, Dr. MARVIN KWITKO  
Dr. HOWARD GIMBEL, Dr. GERALD SCAIFE, Dr. PATRICIA TEAL,  
Dr. JOSEPH WEINSTOCK and Dr. FOUAD TAYFOUR**

**Defendants**

**REASONS FOR ORDER**

**JEROME, A.C.J.:**

This is an appeal by the plaintiff from an order of the Associate Senior Prothonotary dated September 11, 1996, granting the defendant Summit Technology Incorporated ("Summit") leave to join Summit Ireland B.V. as a plaintiff by counterclaim in this action.

The plaintiff is the owner of several patents relating to excimer lasers which are used for ophthalmic surgery. It commenced an action in this Court alleging infringement of its patents with respect to a patent owned jointly by the defendant Summit and another company, Summit Ireland B.V..

On April 22, 1996, Summit served on the plaintiff a Statement of Defence and Counterclaim including Summit Ireland B.V. as a plaintiff by counterclaim. The

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Federal Court Registry refused to accept the Statement of Defence and Counterclaim for filing as it added a new plaintiff by counterclaim.

Summit then brought a motion for leave to file the counterclaim. On September 18, 1996, the Associate Senior Prothonotary granted the defendant leave to file the Statement of Defence and Counterclaim, allowing the co-owner of the patent to be joined as plaintiff by counterclaim. His reasons for doing so are set out at pp. 2-3 of his decision as follows:

There is not a patently applicable Rule in Federal Court Rules, nor could I find a rule in the Ontario or English Rules, nor any decided cases in which a plaintiff by counterclaim had been added.

. . . because the defendant is not the sole owner of the patent it is sought to enforce by counterclaim, the plaintiff has applied to add the co-owner as a plaintiff by counterclaim. I note that had the existing plaintiff sought to enforce the patent, and his co-plaintiff had not agreed, he could have moved the Court under Rule 1719 to add the co-owner as a defendant by counterclaim. It seemed to me illogical that if the defendant could have forced his co-owner into the action as a defendant the co-owner should not be permitted to voluntarily join the action. This is particularly so, where the additional party's claim is the same as that of the original corporate defendant. I therefore concluded that in this case, a plaintiff by counterclaim could be added.

The plaintiff now appeals from that order on the grounds that the *Federal Court Rules* do not provide for adding a plaintiff by counterclaim.

Counterclaims are governed by Rules 1717 to 1722. Rule 1717 provides as follows:

1717. (1) A defendant in any action who claims that he is entitled to any relief or remedy against a plaintiff in the action in respect of any matter, whenever and however arising, may, instead of bringing a separate action, make a counterclaim or cross-demand in respect of that matter.

(2) A counterclaim or cross-demand shall be included in the same document as the defence.

It is clear, therefore, that only a defendant in an action is entitled to bring a counterclaim. Since Summit Ireland B.V. is not a defendant in the main action, it follows that it cannot be a plaintiff in the counterclaim.

For these reasons the appeal is allowed. Costs in the cause.

O T T A W A

March 18, 1997

"James A. Jerome"  
A.C.J.

FEDERAL COURT OF CANADA  
TRIAL DIVISION

NAMES OF COUNSEL AND SOLICITORS ON THE RECORD

COURT FILE NO.: T-1875-95

STYLE OF CAUSE: VISX Inc. et al.  
v. Summitt Technology et al.

PLACE OF HEARING: Toronto, Ontario

DATE OF HEARING: December 2, 1996

REASONS FOR ORDER OF THE HONOURABLE ASSOCIATE CHIEF JUSTICE JEROME

DATED: March 18, 1997

APPEARANCES:

Mr. Gregory Piasetszki

FOR THE PLAINTIFF

Mr. Dan Hitchcock  
Richard Naiberg

FOR THE DEFENDANT

SOLICITORS OF RECORD:

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FOR THE PLAINTIFF

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FOR THE DEFENDANT

49