

Federal Court of Appeal



Cour d'appel fédérale

Date: 20180925

Docket: A-109-17

Citation: 2018 FCA 172

**CORAM: PELLETIER J.A.
GAUTHIER J.A.
DE MONTIGNY J.A.**

BETWEEN:

**BOMBARDIER RECREATIONAL
PRODUCTS INC.**

Appellant

and

**ARCTIC CAT, INC. AND ARCTIC CAT
SALES, INC.**

Respondents

Heard at Montréal, Quebec, on February 12, 2018.

Judgment delivered at Ottawa (Ontario), on September 25, 2018.

REASONS FOR JUDGMENT BY:

GAUTHIER J.A.

CONCURRED IN BY:

**PELLETIER J.A.
DE MONTIGNY J.A.**

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REASONS FOR JUDGMENT

GAUTHIER J.A.

[1] Bombardier Recreational Products Inc. (BRP) appeals the decision of Roy J. of the Federal Court (2017 FC 207) dismissing its action for infringement against Arctic Cat, Inc. and Arctic Cat Sales, Inc. (collectively AC) with respect to Canadian Patents 2,293,106 (the 106

Patent), 2,485,813 (the 813 Patent), 2,411,964 (the 964 Patent) (collectively referred to as the Rider Forward Position Patents or RFP Patents). In this decision, the Federal Court concluded that BRP had established that various models of snowmobiles sold by AC infringed some claims of each of the RFP Patents, but it found that the claims were invalid. It also issued a declaration of invalidity of the asserted claims (AC's counterclaim). The sole basis relied upon by the Federal Court in that respect is that the disclosures of the RFP Patents did not meet the requirement of subsection 27(3) of the *Patent Act*, R.S.C. 1985, c. P-4 (insufficiency) (the *Act*).

[2] BRP also challenges the Federal Court's dismissal of its action with respect to Canadian Patent 2,350,264 (the 264 Patent). The Federal Court concluded that, on its interpretation of the claims at issue, the snowmobiles sold by AC did not infringe the 264 Patent because they did not include an "engine cradle" within the meaning of the claims.

[3] For the following reasons, I would allow the appeal in part.

I. CONTEXT

[4] The four patents at issue in this appeal relate to inventions made in the context of a design project by BRP referred to as the REV (Radical Evolution Vehicle). It is not necessary to refer to the prosecution history of the RFP Patents or the 264 Patent, as there is no dispute that the Federal Court used the appropriate dates to determine the relevant "common general knowledge", as well as all the other issues relevant to the present appeal.

[5] The Federal Court generally describes the inventions claimed in the RFP Patents as new configurations for a snowmobile bringing the rider in a more forward position when sitting on a snowmobile, while the 264 Patent relates to a frame assembly (particularly a frame assembly which includes a pyramidal brace assembly) to be used in the construction of snowmobiles (Federal Court reasons at para. 8). It is worth adding here that the 264 Patent mentions at page 1 that it also facilitates the construction of snowmobiles with an improved rider positioning, i.e. with the rider in a more forward position (see Exhibit P-4 at para. 0001, Appeal Book at p. 9697).

[6] AC is a competitor of BRP who admitted selling the 378 models of snowmobiles at issue in this matter in Canada between 2006 and 2014 (Federal Court reasons at para. 470).

[7] In December 2011, BRP commenced its action for infringement against AC with respect to these four patents. The forty-day trial took place between February 2 and April 16, 2015. The Federal Court issued its decision (247 pages) on February 24, 2017.

[8] In fairness to the Federal Court, I ought to explain what could otherwise appear like a very long delay in issuing the decision currently on appeal before us. I understand that the trier of fact had another long trial with the same parties following the forty-day one in the present matter.

[9] Many of the Federal Court's conclusions in respect of the RFP Patents are not in dispute. Among other things, the Federal Court concluded that the RFP Patents claims could be properly

construed and were not ambiguous, vague or confusing, as had been argued by AC (see generally Federal Court reasons at paras. 293-340). The Federal Court also found that the inventions claimed in the said RFP Patents were inventive (non-obvious) and new (not anticipated) (Federal Court reasons at paras. 521, 527). Moreover, the Federal Court stated that there was overwhelming evidence that the new configurations with a rider forward position pioneered by BRP “changed the sport and ushered in a new era of snowmobile design and thinking”. The innovative REV platform had incredible commercial success (Federal Court reasons at paras. 417-18).

[10] The Federal Court was also satisfied that BRP had established that all the AC models involved infringed some claims in each of the RFP Patents (Federal Court reasons at paras. 469-70).

[11] As mentioned, the Federal Court dismissed the action and issued a declaration of invalidity of the claims at issue solely on the basis that it was not satisfied that the RFP Patents included an “enabling disclosure”. In other words, the patents did not contain sufficient information to enable the person skilled in the art (POSITA) to whom it is addressed to practice the invention, i.e. how the snowmobile claimed is to be reconfigured and its layout redesigned (Federal Court reasons at paras. 339, 534, 560, 568, 572). Under the same heading of insufficiency, the Federal Court also accepted AC’s argument that the “bald man” metaphor (*Free World Trust v. Électro Santé Inc.*, 2000 SCC 66, [2000] 2 S.C.R. 1024 at para. 32 [*Free World Trust*]) applied to this case because the RFP Patents appear to claim the result achieved by any configuration with the rider forward position. There is no need to say anything more in this

part of my reasons, as I will review the findings of the Federal Court in that regard later on in my analysis.

[12] With respect to the 264 Patent, the Federal Court construed the term “engine cradle” in the claims at issue as being limited to a particular variety of engine cradle that is “a walled engine cradle”, as illustrated in the drawings of the 264 Patent. It also stated that such a walled engine cradle was an essential element of the claimed invention. As the engine compartments (which may have fallen within the common meaning of “engine cradle” for the POSITA) in the AC models at issue did not have walls, they could not be infringing. In light of this conclusion, the Federal Court did not deal with AC’s arguments and counterclaim and that the invention claimed in the 264 Patent was anticipated and/or obvious.

II. ISSUES

[13] Before this Court, BRP argues that the Federal Court erred:

- i. in finding that the disclosure of the RFP Patents was insufficient; and
- ii. by limiting the ordinary meaning of the term of the art “engine cradle” to the type of engine cradle described in the preferred embodiments section of the 264 Patent.

[14] Furthermore, should this Court agree that the Federal Court erred in construing the 264 Patent, AC asks this Court to either send the matter back to the Federal Court for a determination regarding its anticipation and obviousness arguments, or to determine these issues ourselves.

Finally, if the appeal is successful in respect of the RFP Patents, the Court should send the matter back to the Federal Court to deal with the remedies, considering that issues such as damages and why an injunction should not be granted were fully argued during the trial but not dealt with by

the Federal Court. There was no cross-appeal in respect of the declaration invalidating the asserted claims of the RFP Patents.

III. ANALYSIS

[15] The standards of review applicable to the present appeal are well-established. They are those set out in *Housen v. Nikolaisen*, 2002 SCC 33, [2002] 2 S.C.R. 235.

[16] Construction of a patent is a question of law. However, the appreciation of expert evidence as to how a POSITA would understand the claims and any specific wording, as well as what common general knowledge was available to the said POSITA at the date of publication, is a question of fact reviewable under the palpable and overriding error standard (see for example *Apotex Inc. v. Astrazeneca Canada Inc.*, 2017 FCA 9 at paras. 29-30).

[17] Adequacy of the disclosure is a mixed question of fact and law, which, in the absence of any extricable question of law, is also subject to the palpable and overriding error standard (see *Apotex Inc. v. Pfizer Canada Inc.*, 2014 FCA 250 at para. 60, leave to appeal to SCC refused, 36227 (13 April 2015); *Teva Canada Limited v. Leo Pharma Inc.*, 2017 FCA 50 at para. 44 [*Leo Pharma*]).

[18] I will first review the main issue concerning the 264 Patent.

A. *264 Patent: Engine Cradle Forward of the Tunnel*

[19] All the claims in the 264 Patent include the language “a frame including a tunnel and an engine cradle forward of the tunnel”. Thus, among many other things, the Federal Court had to determine the meaning of the term “engine cradle”. I will only reproduce the first independent claim asserted.

[20] Claim 1 reads as follows:

1. A snowmobile, comprising:

a frame including a tunnel and an engine cradle forward of the tunnel;

an engine mounted in the engine cradle;

a drive track disposed below and supported by the tunnel and connected operatively to the engine for propulsion of the snowmobile;

left and right skis disposed on the frame;

a straddle seat disposed on the tunnel above the drive track and rearward of the engine;

a pair of footrests supported by the frame;

a steering column movably connected to the frame without a headpipe and operatively connected to the two skis;

a handlebar connected to the steering column;

a pyramidal brace assembly connected to the frame, the assembly including:

left and right rear legs extending forwardly and upwardly from the tunnel, each of the left and right rear legs having a front end and a rear end, the rear ends of the rear legs being spaced further from each other than the front ends of the rear legs, and left and right front legs extending rearwardly and upwardly from the frame forward of the tunnel, each of the left and right front legs having a front end and rear end, the front ends of the front legs being spaced further from each other than the rear ends of the front legs.

(Exhibit P-4, Appeal Book, tab 65 at p. 9724)

[21] The general principles applicable to the construction of claims in a patent are well-established (*Whirlpool Corp. v. Camco Inc.*, 2000 SCC 67, [2000] 2 S.C.R 1067 [*Whirlpool*]; *Free World Trust*). The Federal Court correctly describes some of these at paragraphs 294 and 295 of its reasons. This appeal does not raise any new questions of law in this respect.

[22] That said, the application of such principles is not necessarily easy, especially when the parties put forth evidence that may lead the trial court astray, such as extrinsic evidence of the inventors' intention, for instance by: 1) asking the inventor whether he considered a particular element claimed as important; or 2) referring to another patent application to establish his intention (Federal Court reasons at para. 380). This would also include comparing the wording used in the 264 Patent with the wording used in the RFP Patents (Federal Court reasons at para. 343). Considering that, at paragraph 510 of its closing submissions before the Federal Court, AC stated that the language of the claims should be construed without resort to extrinsic evidence, such as the inventor's evidence, prior art or contemporary documents (Appeal Book, tab 272 at p. 26321), it is surprising that it would have tendered such evidence.

[23] The Supreme Court of Canada was clear that although purposive interpretation can be viewed as an attempt to determine the intention of the inventor, one does not seek to establish the subjective intention of the inventor. Rather, one must seek to determine the objective intention as it was expressed in the patent itself, and as would be understood by the person to whom it is addressed (*Free World Trust* at paras. 58-67; *Whirlpool* at para. 49).

[24] Thus, apart from the specification itself, the only evidence that should be considered to inform a court's analysis of a claim is proper evidence as to how the POSITA would understand it in light of his or her relevant common general knowledge in the context of the specification as a whole.

[25] The Federal Court defined the POSITA with respect to the 264 Patent at paragraph 283 of its reasons. It is a person who has experience in the field of snowmobile design, and mechanical engineering experience or the equivalent experience acquired through many years of experience in the design of snowmobiles.

[26] In adopting this definition of the POSITA, the Federal Court rejected the proposition of Mr. Cowley, one of AC's experts, that the POSITA does not require experience in snowmobile design, but only an understanding of the law of physics. It preferred the view of Mr. Breen (BRP's witness) and Mr. David Karpik (AC's witness) that it makes a difference whether the expertise required is general, as suggested by Mr. Cowley, or has some specificity, as suggested by these two expert witnesses.

[27] This definition is crucial, as it also impacts on who is qualified to opine on how the POSITA would understand the claims and what relevant common general knowledge would be available to the POSITA, and on what weight can be given to an expert's opinion.

[28] The following four experts reviewed some aspects of the 264 Patent. They were qualified as experts in the following fields:

For AC:

- Mr. Daniel Cowley was accepted as an expert in mechanical engineering and vehicle design, including the design of vehicle frames (Exhibit D-84, Appeal Book, tab 222 at p. 20424);
- Mr. David Karpik was accepted as an expert on snowmobiles, including the design and manufacture of snowmobiles. He also has experience racing snowmobiles (Exhibit D-100, Appeal Book, tab 232 at p. 21012);

For BRP:

- Mr. Kevin C. Breen was accepted as an expert in mechanical engineering and human factors, and analysis of recreational vehicle design and riding, including of snowmobiles (Exhibit P-38, Appeal Book, tab 97 at p. 13046); and
- Mr. Gerard Karpik was accepted as an expert in mechanical design and development of motorized recreational vehicles, with expertise in designing and building snowmobiles and snowmobile components (Exhibit P-120, Appeal Book, tab 169 at p. 18827).

[29] Before us, and in its memorandum to the Federal Court with respect to the meaning of “engine cradle”, AC focused exclusively on the evidence of the two experts, Mr. Cowley and Mr. Breen, who addressed this issue extensively in their reports and evidence. In fact, the only other expert who said anything about this subject in his report is Mr. David Karpik; his evidence consisted of a single paragraph (Exhibit D-99 at para. 104, Appeal Book, tab 231 at p. 20506). The paragraph states that the Blade snowmobile and its Delta Perimeter Frame (prior art used by AC to challenge the validity of the 264 Patent) included an engine cradle as this term would be understood by the POSITA and as claimed in the 264 Patent. Mr. Breen notably agreed with this position in his expert report in rebuttal at paragraphs 309-15 (Exhibit P-114, Appeal Book, tab 163 at pp. 18671-72). It is trite law that one cannot adopt a different construction for the purpose of determining the validity than the one applicable to infringement. Thus, Mr. Karpik’s construction in his report on validity is relevant.

[30] Unfortunately, considering the POSITA as defined by the Federal Court, Mr. Cowley's evidence could not be given any weight. There is no evidence as to how he would have acquired the knowledge to opine on how this POSITA would understand the claims. He did not meet the characteristics of the POSITA and did not work on a team that would meet those characteristics. How could he describe the common general knowledge of the POSITA at the relevant time?

[31] This is always a risk when a party relies on a wider definition of the POSITA that fits the qualification of its expert (see for example *Eli Lilly and Company v. Apotex Inc.*, 2009 FC 991 at paras. 61-73, 94, aff'd 2010 FCA 240). For instance, the Supreme Court of Canada in *Whirlpool* confirmed that Mr. Mellinger's evidence could not be given any weight because, despite his otherwise vast experience, he lacked experience with dual action agitator washing machines, the specific art to which the patent at issue pertained. It also held that the trial judge could not rely on the evidence of Mr. Pielemeier, as this witness could not be a proper proxy for the POSITA because of the extent of his knowledge which was different than that of the POSITA (see *Whirlpool* at paras. 70-72).

[32] In the same fashion, Mr. Cowley's evidence could not be given any weight. Apart from the specific terms of the stipulation concerning his expertise, he confirmed during cross-examination that he had never worked on snowmobiles (Trial Transcript, vol. 19 at pp. 73-74, Appeal Book, tab 22 at pp. 4998-99), and that his understanding of what an "engine cradle" is (his analogy of holding a ball in one's hand, "cradling" it) was acquired early on during the 33 years he worked on tractors and large equipment in the agricultural field (Trial Transcript, vol. 18 at pp. 6, 68-69, Appeal Book, tab 21 at pp. 4716, 4778-79).

[33] As properly noted in AC's written submissions before the Federal Court, common general knowledge includes that which is "passed from person to person 'on the job'[...]. As aptly put by Justice Hughes, '[j]ust as one might learn to cook at mother's elbow, it is not all in the recipe book'" (Appeal Book, tab 272 at p. 26325, para. 522; see also *Janssen-Ortho Inc. v. Novopharm Ltd.*, 2006 FC 1234 at para. 113(3), aff'd 2007 FCA 217). Mr. Cowley may well have been provided with prior art by AC's counsel, but this could not in any way qualify him to speak to the common general knowledge of the POSITA in 2000 including the meaning of a term of the art used in the claims.

[34] On the proper evidence as to the common general knowledge of the POSITA, and how they would understand "engine cradle" as used in the claims, the Federal Court could only conclude that the term of the art would refer to any rigid structure which acts as a receptacle or compartment to receive the engine, which can also be a component of the frame. As in Mr. Breen's expert report, it "could be a structure delimited by solid walls, or alternatively an open structure" (Exhibit P-39 at para.147, Appeal Book, tab 98 at p. 13085; Federal Court reasons at para. 344).

[35] Before reaching this conclusion, I have reviewed all the portions of the transcripts where the meaning of "engine cradle" is discussed by any of the experts, as well as those of ordinary witnesses who may have been considered as proxy for POSITAs, such as Mr. Ken Fredrickson, keeping in mind any comments of the Federal Court with respect to those witnesses, such as those made at paragraphs 252 and 253 of the reasons with respect to Mr. Fredrickson.

[36] Mr. Breen’s conclusion is in line with the common general knowledge also described in his expert report (Exhibit P-39, Appeal Book, tab 98 at pp. 13065-66, 13085), which included the following, among other things:

64. [...] The engines of older snowmobiles were typically mounted on the tunnel. Tunnels were generally made of bent metal sheets or planks. At some point, well before these patents were filed, snowmobile engines were placed ahead of the tunnel in a lower position, in what has come to be known as the “engine cradles”. Engine cradles are compartments for receiving and mounting the engine forward of the tunnel down into the belly pan. [...]

65. In addition to defining a space or compartment for cradling the engine, the engine cradles were typically known to provide support for the front suspension and the skis of the snowmobile... [They] were known to have different shapes and configurations and were of course well-known. In some instances, engine cradles included components integrally formed with the tunnel while in some other instances, engine cradles were open structures attached to the tunnel.

[...]

146. An engine cradle is typically understood as a structure that holds and supports the engine assembly, which would also be considered a part of the frame of the snowmobile. The position of the engine cradle can be defined based on the other component parts of the frame assembly.

[37] The Federal Court says very little about the common general knowledge of the POSITA with respect to the engine cradle. It simply states at paragraph 286 of its reasons: “No doubt the POSITA would have known about ‘engine cradles’ and ‘tunnels’, terms that were commonly used”.

[38] The Federal Court also appears to have accepted Mr. Breen’s evidence as to how this expression would be understood by the POSITA. Still, it held at paragraph 347 of its reasons:

Mr. Breen may well have been right when he wrote at para 147 of his first report, P-39 that “(t)he cradle could be a structure delimited by solid walls, or alternatively an open structure”. The difficulty is that there cannot be found that alternative in the 264 Patent. There is simply no embodiment where walls can be

eliminated: the walls are complete and incomplete, they are solid and they may have openings. But these are walls. One does not find any signal from the Patent that the alternative is under consideration. On the evidence in this case, the engine cradle considered by the Patent is of a variety that includes walls. There is no evidence to the contrary. Every indication is to that effect.

[39] Considering the evidence discussed above and what can be properly considered when construing the claims, the Federal Court must have meant that there was no evidence to the contrary in the patent itself.

[40] Frankly, it is difficult to understand what other evidence the Federal Court was looking for. Certainly, it is not unusual for a disclosure not to include a full review of the prior art and the common general knowledge. In fact, it seldom does. This is especially true when, as in this case, the configuration of the engine cradle used in the figures describing the preferred embodiments is not significantly different from the configuration of the engine cradle (walls with openings of different sizes) shown as part of the frame assembly of a prior art BRP snowmobile, in figure 4 of the 264 Patent. How could this lead a POSITA to conclude that this configuration is of particular importance and that it was intended to limit the invention as claimed? Again, the addressee of this patent knew that the configuration found in Figure 4 (prior art) was not the only configuration used in prior art. Even Mr. David Karpik, AC's expert, came to the conclusion in his report that the "engine cradle" in the claims included the engine cradle of the Delta Perimeter Frame, which had no walls.

[41] In fact, it appears that the approach taken by the Federal Court is the opposite of the approach discussed by the Supreme Court of Canada at paragraph 54 of *Whirlpool*:

The argument in this case turns on the meaning of the expression “outwardly extending substantially vertically oriented *vanes*” (emphasis added). All parties agree that the ‘803 specification, including claims, is silent on the type of vane (rigid or flexible) to be used in the lower oscillating portion of the agitator, except that the drawing of the preferred embodiment of the invention appended to the patent specification appears to show rigid vanes. “Reference to the patent drawings will sometimes clarify what is meant by a claim”: Hayhurst, *supra*, at p. 190; see also Fox, *supra*, at p. 220. The drawing is of limited help but hardly conclusive because the ‘803 disclosure makes it clear that the drawing represents a preferred embodiment but does not necessarily exhaust the invention. The issue for the trial judge, accordingly, was whether, at the date of issuance of the ‘803 patent, a person skilled in the art of clothes washing machines would have understood from a reading of the claims, together with any definitional assistance from the rest of the specification, that “vanes” must be of a particular type, and if so which type, rigid or flexible.

[My emphasis.]

[42] The Federal Court deals with the meaning to be ascribed to the term “engine cradle” in two distinct parts of its reasons: the first under the heading of “engine cradle forward of the tunnel”, at paragraphs 343-50, and the second, in the section dealing with infringement of the 264 Patent, at paragraphs 371-83.

[43] It appears to me that the Federal Court put undue weight on the figures of the 264 Patent and the comments relating thereto. These could not be conclusive; nor were they, in my view, sufficient to justify discarding the expert evidence the Federal Court had otherwise accepted. There was no definition in the disclosure limiting the ordinary meaning of this term of art. Indeed, like the ‘803 disclosure at issue in *Whirlpool*, the disclosure of the 264 Patent made clear that the preferred embodiments did not exhaust the invention claimed (Exhibit P-4 at para. 0115, Appeal Book, tab 65 at p. 9723).

[44] After noting that the disclosure of the 264 Patent did not expressly state that an engine cradle could be an open structure, i.e. without walls, the Federal Court lists at paragraph 346 of its reasons all the passages of the disclosure where a reference is made to an engine cradle wall (with openings or not) depicted in the figures. These passages are all found in the section entitled “Description of the Preferred Embodiments” (Exhibit P-4 at paras. 0055 ff., Appeal Book, tab 65 at p. 9706).

[45] The first two references found at paragraphs 0064 and 0065 (Exhibit P-4, Appeal Book, tab 65 at p. 9709) deal with the prior art example – the 2000 model year Ski-Doo® Mach™ Z depicted in Figure 4. A portion of paragraph 0064 not reproduced in the reasons explains how the large openings in the walls of this engine cradle allow heat to radiate and assist in cooling the engine. It only describes why such a configuration would be used by one such as BRP.

[46] The other paragraphs quoted by the Federal Court simply explain the figures describing the preferred embodiments. These indicate why a solid wall is used on one side of the engine cradle depicted therein, while there are openings on the other side. More particularly, the solid wall helps reflect radiant heat and assists in minimizing heat dissipation, whereas openings give easier access to the engine and enable other parts to be connected to the engine. Like the previous mention in paragraph 0064, this indicates that there may be various reasons or advantages to a particular configuration. It may be that the inventors preferred to minimise heat dissipation rather than a configuration allowing for the cooling of the engine. But this should not be understood as excluding other configurations that were commonly known, including the one depicted in Figure 4.

[47] As acknowledged in *Whirlpool* at paragraph 54, these preferences are not conclusive, as they do not exhaust the invention claimed.

[48] Finally, paragraph 00112 (Exhibit P-4, Appeal Book, tab 65 at p. 9722) explains that an advantage of the pyramidal frame assembly included in all the claims of the 264 Patent is that it adds strength and rigidity to the overall frame, so that the panels that make up the tunnel and engine cradle need not be as strong. I agree with BRP that this passage in fact can support the view that other commonly known configurations for the engine cradle, whether with lower or thinner walls, walls with very large openings or no walls at all, could also be included in the claims as worded.

[49] The only portion of the disclosure to which the Federal Court refers outside of the section describing preferred embodiments are paragraphs 0011, 0015 and 0016 located within the section entitled “Summary of the Invention” (Exhibit P-4, Appeal Book, tab 65 at pp. 9699-70).

The relevant passages read as follows:

[0011] It is, therefore, an object of the present invention to provide a frame assembly with a tunnel, an engine cradle disposed forward of the tunnel and connected hereto, and a sub-frame disposed forward of the engine cradle and connected hereto. The frame assembly further includes a forward support assembly extending upwardly from the subframe (sic), an upper column extending upwardly from the engine cradle to connect with the forward support assembly, and a rear brace assembly extending upwardly from the tunnel to connect with the forward support assembly and the upper column.

[0015] One other object of the present invention is to provide a frame assembly that also includes an engine disposed in the engine cradle and an endless track operatively connected to the engine and disposed beneath the tunnel for propulsion. In this embodiment, a pair of skis are (sic) operatively connected to a steering device for steering.

[0016] Still another object of the present invention is to provide a frame assembly with an engine disposed in the engine cradle and a rear wheel operatively

connected to the engine and disposed beneath the tunnel for propulsion. In this embodiment, two front wheels operatively connected to a steering device for steering.

[50] These statements are quite general. They can only be properly understood when one considers the undisputed expert evidence as to the relevant common general knowledge available to the POSITA. They do not support a conclusion that walls are required “in order” for an engine “to be disposed in the cradle” (see Federal Court reasons at para. 372); nor are they clear evidence that “the inventors meant for their invention to have a walled engine cradle in which the engine can be disposed (0015)” (Federal Court reasons at para. 348). The words “disposed in” are consistent with the origin of the expression “engine cradle” discussed in Mr. Breen’s expert report. Instead of being disposed or “mounted” (the actual word used in the claims) on the tunnel, the engine is disposed or mounted so that it sits lower than the tunnel in a solid structure that has become known as the engine cradle (Exhibit P-39 at paras. 64-65, Appeal Book, tab 98 at pp.13065-66). None of these passages could justify departing from the understanding of the POSITA with respect to the language of the claims.

[51] As mentioned earlier, references made by the Federal Court to extrinsic evidence, such as other patents (Federal Court reasons at para. 343), patent applications (Federal Court reasons at para. 380) or the testimony of the inventors (Federal Court reasons at para. 376), are inappropriate and cannot inform the construction of the claims.

[52] The Federal Court noted that, since walls on the engine cradle can add to the ruggedness and rigidity of the overall frame, they are essential (Federal Court reasons at para. 348). It stated that the inventors “meant for a walled, robust engine cradle to be part of a more rigid frame

which is the purpose of the Patent” (Federal Court reasons at para. 350). It added that, since all the asserted claims require an engine cradle, one can infer that it plays an important role and has a purpose in fulfilling the utility of the invention claimed (Federal Court reasons at para. 377).

[53] As the Federal Court will have to determine the validity of the 264 Patent, I need to be careful not to address the inventiveness or novelty of the claimed combination of parts that are essential to have a functional machine which includes the invention (snowmobile). It is sufficient to note that it is one thing to say that an engine cradle is essential, and quite another to say that a walled engine cradle is an essential element of the claims. No inference can be made from the claims that a walled engine cradle was essential.

[54] Even if the inventors preferred the more robust embodiment of their invention depicted in the figures, one cannot simply exclude less sturdy configurations to define the actual ambit of the claims as written. This is especially so considering that the disclosure expressly mentions that, with the pyramidal frame assembly, the engine cradle does not need to be as strong (Exhibit P-4 at para. 0112, Appeal Book, tab 65 at p. 9722). Again, the Federal Court’s comments (at paragraphs 350 and 377) appear to ignore the basic principle that the description of the preferred embodiments is not meant to include all the possible embodiments of the invention claimed.

[55] The section describing the preferred embodiments is included to meet the requirement of subsection 27(3), particularly paragraph 27(3)(c), of the *Act*. This is why what may be regarded as boilerplate statements at the end of the disclosure (here paragraph 00115) are commonly included by patent agents:

[00115] While the invention has been described by way of example embodiments, it is understood that the words which have been used herein are words of description, rather than words of limitation... Although the invention has been described herein with reference to particular structures, materials, and embodiments, it is understood that the invention is not limited to the particulars disclosed.

(Exhibit P-4, Appeal Book, tab 65 at p. 9723)

The fact that these statements are commonly included does not mean that they can simply be ignored.

[56] Before concluding, I ought to mention that AC insisted that there was nothing wrong with limiting the language of a claim even when a wider expression is used. It submits that this is exactly what was done in *Whirlpool*. While I agree with this general statement, I note that, as expressly stated at paragraph 42 of AC's Memorandum of Fact and Law (AC's Memorandum), the conclusion that the word "vanes" in the claims would be understood as rigid vanes in *Whirlpool* was based on the trial judge's conclusion that rigid vanes were the only ones known to the POSITA at the relevant time. This is simply not so in the present case.

[57] My careful review of the claims, read in the context of the disclosure, informed by the evidence as to the common general knowledge of the POSITA leads me to conclude that the Federal Court erred in construing the expression "engine cradle" restrictively. In doing so, the Court rewrote the claims as if they read "a walled engine cradle forward of the tunnel". Thus, on a correct interpretation of the claims at issue, the engine cradle is not limited to a variety that included walls. I therefore propose to quash the conclusion of the Federal Court to the effect that AC did not infringe the 264 Patent. Given that both the issues of validity and remedies were fully

argued before the Federal Court (less so before this Court), it is best to return the file to the Federal Court so that it may deal with those issues. Obviously, depending on the ultimate result, the issue of costs will need to be readdressed.

B. *The RFP Patents*

(1) Preliminary issue: was the argument on insufficiency before the Federal Court?

[58] First, a preliminary issue. At the hearing before us, BRP said that the basis on which the Federal Court declared the claims at issue invalid (insufficiency) had not been really argued before it. This submission is difficult to reconcile with the arguments made at paragraph 77 of BRP's Memorandum of Fact and Law (BRP's Memorandum). However, in light of the seriousness of this argument, which involves procedural fairness, I have carefully reviewed the material before the Federal Court. I conclude that this allegation is baseless.

[59] Paragraph 100 of AC's Amended Statement of Defence and Counterclaim dated January 9, 2015, which was discussed at the hearing before us, laid out AC's initial arguments relating to insufficiency. Next, BRP denied that the RFP Patents were invalid for insufficient disclosure at paragraph 22 of its own Amended Reply to Statement of Defence & Defence to Counterclaim dated January 16, 2015. The argument that the disclosure did not contain "a sufficient description of the invention and an explanation as to how to put it into practice" was then included in AC's Opening Statement (see for example Appeal Book, tab 268 at p. 62). In fact, the argument was supported by several statements in Mr. Warner's expert report, and AC reasserted it not only in

its Statement of Issues (Appeal Book, tab 270 at p. 25901), but at length in its final written submissions before the Federal Court (Appeal Book, tab 273 at pp. 26587 ff., at paras. 910 ff.).

[60] BRP also addressed this issue in its final written submissions at paragraphs 803 and 806 to 811, which constitute seven paragraphs out of the total 1,100 in these submissions (Appeal Book at pp. 26111-13). BRP had the opportunity to point to what it considered the most relevant evidence to support a conclusion that the POSITA would be in a position to practice the claimed inventions, reading the disclosures armed with its common general knowledge, and in fact did so. It even acknowledged during oral submissions before the Federal Court that this was a particularly difficult issue. As mentioned by the Federal Court, BRP emphasized the fact that AC did practice the invention in the paragraphs 807 and 809 mentioned above.

(2) Alleged errors regarding Federal Court's finding of invalidity

[61] I now turn to the main issues. I have considered the evidence above, together with the BRP's oral submissions before the Federal Court, the evidence included in each party's Compendium, as well as references to it in their memoranda. I have also reviewed, among other things, all of Mr. Breen and Mr. Warner's reports, in addition to the transcripts of their cross-examinations and re-examinations, before reaching my conclusion on the part of the appeal dealing with the RFP Patents. Even so, this extensive exercise cannot put me in the same position as the trier of fact, who not only reviewed the reports in depth, but heard all of the evidence firsthand.

[62] Before us, BRP argues that:

- i. The Federal Court erred by intermingling the concepts of sufficiency, ambiguity of the claims and overbroad claims (claiming a result);
- ii. The Federal Court applied the wrong test for sufficiency in asserting that the POSITA had to be able to practice the invention solely on the basis of the disclosure. It thus failed to consider that such disclosure is to be read as it would be understood and applied by the POSITA using his or her common general knowledge. It also misconstrued the teachings of the Supreme Court of Canada in *Teva Canada Ltd. v. Pfizer Canada Inc.*, 2012 SCC 60, [2012] 3 S.C.R. 625 [*Pfizer*] in applying too stringent a test which did not allow for routine trial and error tests that do not involve any inventive steps;
- iii. The Federal Court erred by failing to consider the sufficiency of the disclosure of each RFP patent individually. This led to its conclusion that a major research project would be required to put the three inventions in practice;
- iv. The Federal Court erred by requiring that the inventor explain more precisely the difference between the old and the new design layout or configurations;
- v. The Federal Court erred by considering the efforts of the inventors in conceiving and practicing all the inventions including the one claimed in the 264 Patent (Federal Court reasons at paras. 129, 139, 146, 161, 558, 568);
- vi. The Federal Court made a palpable and overriding error by ignoring the evidence of Mr. Breen. Having accepted the evidence of this expert to dismiss Mr. Warner's suggestions that the language in the claims of the RFP Patents was ambiguous, the Federal Court could not then accept the position of Mr. Warner that a POSITA would require months if not years to go through all the possible permutations he identified to practice the inventions claimed;
- vii. The Federal Court also made palpable and overriding error by ignoring the considerable evidence put forward by BRP to establish that all the uncertainties raised by Mr. Warner were superficial and would have no impact on the POSITA's ability to make and use the invention armed with the knowledge referred to at paragraphs 63 to 65 of the BRP's Memorandum. Were it not so, the Federal Court could not state that BRP had essentially ignored this aspect of the case.

[63] I do not intend to address all of these above-mentioned issues to the same extent of detail.

As will be explained, whatever error the Federal Court may have made, I am satisfied that this portion of the appeal can be determined on the basis of whether or not the disclosures of the RFP Patents were sufficient to enable the POSITA to practice the invention covered in the claims at issue.

(a) *Intermingling of concepts in regards to invalidity*

[64] With respect to the BRP's first submission that the Federal Court intermingled various concepts in respect to invalidity, I will only strike a cautionary note regarding the statement found at paragraph 556 of the Federal Court's reasons. Here, relying on a statement by Phelan J., the Federal Court says that "such issues are always intertwined" (see *Sanofi-Aventis Canada Inc. v. Ratiopharm Inc.*, 2010 FC 230 at paras. 51-52). Patent law concepts are already notoriously difficult to apply correctly, especially when one does not have an intimate knowledge of how each concept evolved and why. Although it may be appropriate in certain cases to borrow from one concept to explain another or to treat them together, this must be done with extreme caution, and only with a deep appreciation of the distinctions. Otherwise, it will result in more uncertainty in the law and, often, in an error of law. This is so even for masters in the field. For example, in *Synthon BV v. Smith-Kline Beechan plc*, [2005] UKHL 59 [*Synthon*], Lord Hoffman reaffirmed the need to keep concepts involved in one's analysis (here, disclosure of the invention versus enablement) distinct even when they are closely related. The learned judge also found that the otherwise very knowledgeable Aldous L.J. had confused two such concepts in his reasons (*Synthon* at para. 54).

[65] I need not say much about the Federal Court's finding that the "bald man" analogy used in *Free World Trust* applied to the inventions described in the disclosures of the RFP Patents. I always understood this analogy to illustrate the concept of the "overbroad claim". This is a good example of the danger of intermingling the issues. In this particular case, the analogy made it

more difficult to understand the Federal Court's reasoning in respect of the issue that is determinative here.

(b) *Evidence of the inventors*

[66] As to BRP's statement with respect to the evidence of inventors when considering enablement, I do not agree with BRP that it is entirely irrelevant (BRP's Memorandum at para. 54). In fact, in its final oral submissions before the Federal Court, BRP itself referred to the fact that the inventors were appropriate proxy for POSITAs (even if they also had a scintilla of inventiveness that the standard POSITA does not have); that they were able to design a snowmobile around the three reference points set out in the disclosures (Trial Transcript, vol. 40 at p. 250, Appeal Book at p. 8821). BRP suggested that the Federal Court should infer from this that a POSITA could do so as well. I agree that, in specific cases, this type of evidence may establish that no inventive step was required to put the invention in practice once the invention was conceived, or that it would be easy to do so with the common general knowledge available to a POSITA. I understand that, having considered the evidence of the inventors as suggested by BRP, the Federal Court did not agree that it should make such an inference because the evidence taken as a whole, including the extracts of the examination for discovery filed as exhibits, did not warrant it (see for example Exhibit D-120, Appeal Book, tab 248 at pp. 22235-36).

[67] The problem in the present case is that the course of events described by Messrs. Girouard and Fecteau, two named inventors, did not relate only to the conception and development of the new design layout of a snowmobile with a driver forward position as claimed in the 106 or 813 Patents. It also related to what the inventors considered a distinct invention, as

claimed in the 264 Patent – the pyramidal frame assembly. This was also the case when Mr. Boisjoli testified as to the problems that had to be resolved in the development stage. For example, it appears that difficulties encountered, such as the particular design of the fuel tank on the prototypes built by the inventors or the issue with “louvoisement” [tacking or swaying] (see Federal Court’s reasons at para. 129), appear to relate to the use of the pyramidal frame assembly.

[68] Therefore, on the one hand, one could not simply assume that all of those difficulties encountered would have to be dealt with by a POSITA to practice the inventions claimed in the RFP Patents (Trial Transcript, vol. 2 at pp. 325-35, Appeal Book, tab 5 at pp. 771-81, 1607-12). On the other hand, the evidence also established that the inventors had identified what could be interpreted as a major problem in positioning the engine to achieve the desired center of gravity when one places the steering device in the more forward position, as described in the disclosures of these patents. The most efficient way they found to configure an embodiment of the invention using the 3-points approach proposed by BRP involved the conception of the pyramidal frame assembly. Thus, although Mr. Girouard alluded to the fact that this could have been done differently, there is no evidence as to what design layout and actual structure (i.e. physical configuration as opposed to purely conceptual points) would be required to practice the invention without the pyramidal frame ultimately claimed in the 264 Patent. One thing is clear: even the first prototype built by the inventors included some form of pyramidal frame assembly which, according to them, was not purely the result of routine iterations. Mr. Fecteau even mentioned that “sheer luck” was involved (Exhibit D-120, Appeal Book, tab 248 at p. 22243). Thus considered in its proper context, I cannot agree that the Federal Court made a palpable and

overriding error by referring to the evidence of the inventors in its reasons at paragraphs 558 and 568; it was responding directly to the argument put forth by BRP. Nevertheless, even if I were to assume that the Federal Court made a palpable error – as it is indeed not clear that it only considered difficulties related to the invention claimed in the RFP Patents –, it would not, in my view, constitute an overriding error. This is so in light of the Federal Court’s other factual findings regarding other difficulties the POSITA would encounter in trying to practice the inventions claimed in each of the RFP Patents when it considered the sufficiency of the disclosures.

(c) *Common general knowledge available to the POSITA*

[69] I also cannot agree that, when one reads all the relevant portions of the Federal Court’s reasons holistically and with an open mind, one must conclude that it failed to take into account the common general knowledge available to the POSITA.

[70] It is trite law that an enabling disclosure is one that gives enough information to the POSITA armed with his or her common general knowledge to practice the invention. In my view, the Federal Court in this case relied on various authorities that made quite clear that enablement is to be assessed from the point of view of the POSITA armed with such knowledge. On this point, see for example paragraph 543 of the Federal Court’s reasons, particularly where it cites paragraph 33 of *Pfizer*.

[71] Both experts, who were fully qualified to opine on these matters, took into account such knowledge in their reports. They simply did not agree on whether the information provided in

each disclosure was sufficient for the POSITA armed with such knowledge to practice the invention described in the RFP Patents.

[72] The Federal Court may have felt a particular need to insist that all the information should be in the disclosure because BRP relied heavily on AC having been able to practice the invention to argue that the disclosure was sufficient. The Federal Court found that AC had had the benefit of a BRP snowmobile – an embodiment of the inventions claimed in the RFP Patents, if, as argued by BRP, the infringing AC models at issue were copies of this BRP’s snowmobile – which it disassembled (Federal Court reasons at para. 562). Use of such reverse engineering is not something that can be considered to determine if a disclosure is sufficient, even when this is done as a matter of course in the particular industry.

[73] Therefore, I am not prepared to infer that the Federal Court made a blatant error of law as suggested by BRP simply because it used words such as “solely” or “alone” in various passages of its reasons.

[74] Nor am I prepared to infer that the Federal Court ignored the evidence of Mr. Breen in respect of the common general knowledge and how it would supplement the information contained in the disclosures. The Federal Court referred to Mr. Breen’s evidence throughout its reasons; it also expressly refers to his rebuttal report (Exhibit P-114, Appeal Book, tab 163 at pp. 18589 ff.). The Federal Court is presumed to have considered all this evidence. In light of the length of the reasons, as well as that of the parties’ written submissions at trial and expert reports, it is not surprising that the Federal Court did not expressly refer to all the relevant

evidence. In my view, what BRP is really arguing is that the trier of fact failed to ascribe the weight that it itself attributes to this evidence but instead preferred the evidence of Mr. Warner.

[75] The Federal Court did accept the opinion of Mr. Breen that the language of the claims could be construed and would be understood by the POSITA. However, it does not follow that it could not consider any of Mr. Warner's evidence as to the adequacy and sufficiency of the information (particularly various measurements discussed in the disclosure) in relation to the ability of the POSITA to practice the invention. In fact, the Federal Court was quite alive to this. It even noted at paragraph 339 of its reasons that, although it accepted that the POSITA would understand the meaning to be given to "seat position and seating position" in the claims when supplemented by the disclosure, "[t]he real question may be rather how the invention can be practiced with the sole assistance of these measurements". I also note that, in its final oral submissions before the Federal Court, AC pointed to various difficulties with the disclosure addressed by Mr. Warner that were not the same as those raised with respect to the language of the claims.

(d) *Enablement and sufficiency of the disclosures*

[76] Turning to the issue which actually is, in my view, determinative, I will now consider the conclusion of the Federal Court that these disclosures were insufficient to enable the POSITA to practice the inventions.

[77] I will start by mentioning that the Federal Court expressly states at paragraph 559 of its reasons that it must examine the disclosure of each of the RPF Patents individually, as "each of

the three Patents stands on its own”. The 106 and 813 Patents (a divisional application from the original application that became the 106 Patent) have a common disclosure, and during oral arguments, the Federal Court did mention that it may have been easier to follow BRP’s position on sufficiency if it had been permissible to also consider the information contained in the 964 Patent (published later in 2003). This persuades me that it properly understood the approach to be taken, considered each disclosure, and assessed the evidence before it accordingly.

[78] Enablement (how to practice the invention) is a concept completely distinct from the disclosure of the invention itself, the latter of which was at issue in *Pfizer*. In *Leo Pharma*, our Court held that the teachings of the Supreme Court of Canada in *Pfizer* did not change the law as it had been applied to enablement (as opposed to the disclosure of the invention) not only in Canada, but also in the UK (*Synthon* at paragraph 27 being an example) and continental Europe. The fact that some non-inventive trial and error experiments may be required to practice a properly disclosed invention will not *per se* invalidate a patent on the basis that it fails to meet the requirements of subsection 27(3) of the *Act* (see *Leo Pharma* at paras. 55-59). Unfortunately, this decision was issued a few months after the decision of the Federal Court in the present matter. Thus, it was incorrect for the Federal Court to say that the strict test applicable to the description of the invention applied to the question of whether the disclosure was sufficient to teach the POSITA how to practice the invention. A disclosure will still be enabling if it does not require undue efforts.

[79] However, the Federal Court also took into account the less stringent approach described by Prof. Vaver (David Vaver, *Intellectual Property Law*, 2nd Ed., Toronto: Irwin Law, 2011 at p.

342). At paragraph 550 of its reasons, the Federal Court underlines the following sentence from the author: “If a person skilled in the art can arrive at the same results only through chance or further long experiments, the disclosure is insufficient and the patent is void”.

[80] This statement is more in line with the view expressed in *Leo Pharma*. It would have been more complete to add that even short experiments will be objectionable if they involve an inventive step, since the nature of the efforts required is also important. The acceptable extent of the efforts that may be required from the POSITA will depend on the nature of the invention and the field to which it pertains.

[81] Normally, it should be relatively easy for an expert to opine on whether particular experiments or efforts involve an inventive step, or whether its result is left to chance. It may be more difficult for the trier of fact to determine how much effort is too much in order to conclude that the patentee kept his side of the bargain or *quid pro quo* on which the granting of a patent is based. The extent of the effort required in any given case is a pure question of fact. I understand that, despite its error in interpreting *Pfizer*, the Federal Court went on to make the findings of fact that were necessary to apply the less stringent test described by Prof. Vaver. It held that, on its assessment of the evidence before it, the POSITA would have to undertake a major research project to practice the invention on the basis of the information disclosed in each of the RFP Patents (Federal Court Reasons at para. 568). Therefore, despite the error in interpreting *Pfizer*, this Court cannot simply substitute its own assessment of the evidence in that respect.

[82] Paragraphs 553-73 of the Federal Court's reasons could have been clearer and better structured. Nonetheless, I understand that the Federal Court's finding that, as a matter of fact, practicing each invention would require a major research project was not solely based on the statement of Mr. Warner who said that, if it was possible at all, it would take a very long time to figure out all that would be required to practice the invention. This statement was made while discussing his opinion on the 106 Patent. The Federal Court also considered that the method chosen to describe how to design the layout and configure an embodiment of the invention (therefore practice the invention claimed in each of the FDP Patents) was unduly complicated. Indeed, it found that the reference to the measurements used left too much to be done without proper guidance.

[83] Additionally, the Federal Court's other findings were based on its own observations (the evidentiary record included many illustrations drawn by the experts during trial, while others were included in the expert reports) and the evidence of Mr. Warner. For instance, it concluded that "it would be very difficult for the skilled person to appreciate the measurements and, more importantly, how they translate into the rider's position on the snowmobile" of the invention (Federal Court reasons at para. 571). It did not accept BRP's proposition (and this has to include the evidence of Mr. Breen) that the 3 points (steering, seat and footrest positions), as they are described in the disclosure, constituted sufficient information to effectively configure a snowmobile of the invention.

[84] I pause here to mention that it is in this context that the Federal Court refers to the absence of "numerical comparison" between the position of the rider on a snowmobile of the

invention and its position on a prior art snowmobile. This absence of “numerical comparison” was sufficiently important to require a stronger response from BRP: see the Federal Court’s reasons at paragraph 563 and paragraph 62(v) above. I agree that, as a matter of law, an inventor does not have to describe the differences between an embodiment of the invention and those of the prior art. However, this does not mean that a trier of fact could not find it important to do so when the inventors choose not to include a detailed and reasonably accurate example of a configuration of the invention (an actual example of a reconfigured snowmobile). The purpose of such a description would thus be to include simpler information that is available to the inventors in order to ensure that the POSITA can practice the invention. Obviously, here, this was not the only problem with the disclosures.

[85] Usually, one would have expected to find one clear example of the full configuration of the main components of a snowmobile of the invention, or at least of those that the inventors knew raised particular issues. I do not mean instructions regarding the nuts and bolts as suggested by BRP. One clear example of the full configuration would have sufficed to enable a POSITA to practice the invention. This would not necessarily mean that the patentee could not claim other configurations if the invention properly applied to more than this configuration. But it is often an important component used to meet the patentee’s part of the bargain of providing the POSITA with everything required to practice an invention (usually one clear way of using the invention).

[86] In this case, none of the RFP Patents included such an example. There was also no evidence that anyone was ever able to make a configuration of the invention on the sole basis of

the information contained in the disclosures without the pyramidal frame assembly claimed in the 264 Patent. It is in this context that the Federal Court gave weight to the fact that the disclosures say nothing about issues or problems that the inventors had to deal with in order to effectively configure a snowmobile of the invention.

[87] Also, as mentioned by the Federal Court, there is nothing at all in the disclosures about what happens to important parts of the design layout of a reconfigured snowmobile, particularly the front one that includes the engine with the more forward and steeper steering. In its final oral submissions before the Federal Court, AC did underline the fact that Mr. Fecteau testified during discovery that moving the rider forward entailed that “the steering column ended up being right in the middle of the engine”, meaning that “[s]ome solution had to be found for that to work out properly” (Trial Transcript, vol. 40 at p. 92, Appeal Book at p. 8663). The only solution, according to Mr. Fecteau, was the pyramidal frame assembly claimed in the 264 Patent, which was apparently the result of luck.

[88] Adopting the expression used by BRP in its closing submissions after the trial, my understanding of the reasons is that the Federal Court did not accept that the disclosures were proper “instruction sheets”. As such, it clearly understood the methodology described in the RFP Patents (see for example Federal Court reasons at paras. 430, 438). We may not be dealing with the configuration of a sophisticated jet, as BRP put it, but the Federal Court did find that what was required of the POSITA was complex enough to require more guidance. What constitutes a major research project varies according to the field at issue and the qualifications of the POSITA.

As mentioned, this conclusion is supported by ample evidence on the record, and not only that provided by Mr. Warner.

[89] The evidence of Mr. Breen reproduced at paragraph 572 of the Federal Court's reasons is telling. Although Mr. Breen states that, "conceptually", the information contained in the 106 Patent might be sufficient if one used an iterative process that is common in the industry (though when modifications were based on the implementation of a third party's concept, reverse engineering was also most common), he could not say what the result would be for "something like that".

[90] One could reasonably construe this to mean that Mr. Breen, who had obviously done a lot of thinking and work relating to these patents before his testimony, including about their validity, could not confirm that the required measurements and permutations were actually sufficient to practice the invention – that is, to at least enable one workable design of a complete layout of a reconfigured snowmobile of the invention disclosed in the 106 Patent.

[91] In my experience, experts do not often have to do this themselves because they can rely on what the inventors or patentee will have already done (tests results or a detailed example of an embodiment of the invention in the patent). But here, despite Mr. Breen having examined many BRP and AC models which embodied configurations of the inventions, none appear to have been configured and built by simply using the information disclosed in the Patents and putting into practice what this expert considered the POSITA's common general knowledge. In effect, the configurations all feature a pyramidal frame assembly covered by the 264 Patent.

[92] The only examples from which the trier of fact could infer that the methodology described in the disclosures was actually sufficient for a POSITA were those BRP expressly referred to in their closing submissions: those of the original inventors and AC. As mentioned, the Federal Court did not agree that it could make such an inference.

[93] I believe that, generally, the above applied to the disclosure of the 813 Patent, as its disclosure was essentially the same as that of the original application (the 106 Patent). The same reasoning also applied to the 964 Patent, which was filed on November 15, 2002, after the publication of the 264 Patent (Exhibit P-3, Appeal Book, tab 64 at p. 9663). Again, the Federal Court preferred Mr. Warner's evidence regarding this patent. Indeed, the Federal Court had sufficient evidence from Mr. Warner to infer that the answer of Mr. Breen referred to in paragraph 89 above would also apply to the 964 Patent. Thus, the effort required to practice the invention would also result in what the Federal Court described "as a major research project".

[94] Before us, BRP presented a reasoning which it claimed applied to all three patents and that should have been adopted by the Federal Court on the basis of evidence referred to in paragraph 65 of its Memorandum. However, this is not how their case on insufficiency was presented to the Federal Court and, as a result, one could not expect to find in the reasons an express mention of why this particular reasoning was not accepted. One should put its best case on such issues before the trier of fact – not on appeal.

[95] I am satisfied that the factual conclusions reached by the Federal Court were open to it on the evidentiary record. I have not been persuaded that the Federal Court made a palpable and

overriding error in concluding that, to practice the invention claimed in each of the RFP Patents, the POSITA would have to undertake a major research project (i.e. undue efforts) because of the lack of sufficient instructions in the disclosures of the RFP Patents.

[96] On a proper application of the test as to what constitutes an enabling disclosure to the relevant factual findings of the Federal Court, I conclude that there is no ground to allow the appeal in respect of the RFP patents.

IV. CONCLUSION

[97] I would allow the appeal in part only, and quash the Federal Court's declaration that AC does not infringe the asserted claims of the 264 Patent and its dismissal of the action in respect of the 264 Patent. I would send this matter back to the Federal Court so that it may determine if the said patent is valid and deal with the remedies and costs, if necessary.

[98] Considering that the success of this appeal is evenly divided, I propose that each party assume its own costs.

"Johanne Gauthier"

J.A.

"I agree.
J.D. Denis Pelletier J.A."

"I agree.
Yves de Montigny J.A."

FEDERAL COURT OF APPEAL

NAMES OF COUNSEL AND SOLICITORS OF RECORD

**APPEAL FROM A JUDGMENT OF THE HONOURABLE JUSTICE ROY DATED
FEBRUARY 24, 2017, NO. T-2025-11**

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INC.

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GAUTHIER J.A.

CONCURRED IN BY:

PELLETIER J.A.
DE MONTIGNY J.A.

DATED:

SEPTEMBER 25, 2018

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