



Multi-Jurisdictional Issues in Intellectual Property: Canada/US Litigation

*Bill Manson
The Lubrizol Corporation
April 9, 2010*

© 2010, all rights reserved



National Nature of Patents

- Patents are creatures of national law – separate national patents must be obtained in each country in which protection is desired
- To understand enforcement choices we should first start with a consideration of business patent strategy

© 2010, all rights reserved



Where To File

- ✦ Patents are costly to get, maintain and enforce
- ✦ Is a patent needed in every country?
- ✦ Will purposes be served by filing on a more limited basis
 - ▣ Consider where goods are made
 - ▣ Consider distribution channels

© 2010, all rights reserved



Patent Owner's Perspective

- ① Where is the claimed infringing activity occurring or expected to occur?
- ② Which Court(s) has/have jurisdiction to address issues relating to such activity?
- ③ If two or more forums have jurisdiction to address such issues, should litigation be commenced in one or more

© 2010, all rights reserved



Patent Owner's Perspective

- Single forum or multiple forums
 - ▣ Cost
 - ▣ Extent of infringement in each forum
 - ▣ Effectiveness of remedy in one forum
 - Location(s) of manufacture
 - Will injunction in one forum stop infringement in others?
 - Will decision in one country influence others?

© 2010, all rights reserved



Patent Owner's Perspective

- Consider the Remedies
 - ▣ Availability of interlocutory/preliminary injunction
 - ▣ Nature and amount of the monetary remedies available

© 2010, all rights reserved



Nature of the process

- Nature of the procedures available –
- Specialist judge, general judge, jury
- Availability of discovery
- Time to decision

© 2010, all rights reserved



Remedies available

- Interlocutory/Preliminary injunction
- Damages – how determined?
- Availability of increased damages? Punitive Damages?
- Availability of account of infringer profits
- Recovery of costs

© 2010, all rights reserved



Discovery Issues

- The approach to discovery differs by jurisdiction
- In US, broad documentary and deposition discovery of party and witnesses, including experts
- In Canada, documentary discovery and oral discovery of party and of inventors/assignors

© 2010, all rights reserved



Role of Experts

- Experts are approached differently
- In Canada there still seems to be a greater perception of the expert as a neutral
- Canada may be considering Australian Procedure for experts

© 2010, all rights reserved



Privilege Issues

In Canada, two types of privilege:

Solicitor Client privilege – communications with solicitor for purpose of obtaining legal advice

Litigation privilege – communications relating to pending or anticipated litigation

In US these are attorney/client privilege and work product

© 2010, all rights reserved



Multiple Jurisdiction Litigation may lead to loss of privilege

Communications with foreign lawyers/client

Waiver by U.S. counsel giving evidence in Canada

Waiver by evidence

Waiver by expert evidence

Is litigation privilege lost at close of case?

© 2010, all rights reserved



Be Careful Not to Inadvertently Waive Privilege

Waiver by U.S. counsel giving evidence in Canada

United States of America v. Friedland (1996) 30 OR (3d) 568 (Ont. Ct. GD) – US counsel who gave evidence re a *Mareva* injunction motion in Ont. Ct. held to have waived privilege re all documents she reviewed

Waiver by evidence

Bourns v. Raychem [1999] FSR 665 (CA) – information from taxation of costs in UK case sought to be used to set aside US jury award

© 2010, all rights reserved



Privilege Issues

Waiver by expert evidence

Imperial Oil v. Lubrizol (2000) 6 CPR (4th) 417 (FC – Nadon J.) – motion to set aside Canadian trial judgment of patent infringement, which had been affirmed on appeal, on basis of deposition evidence of one of the expert witnesses for plaintiff in a subsequent US proceeding – motion dismissed

© 2010, all rights reserved



Concluding Thoughts

- ✦ Systems are similar
- ✦ But, variations can be significant.

© 2010, all rights reserved