

Date: 20090210

Docket: A-226-08

Citation: 2009 FCA 39

**CORAM: DESJARDINS J.A.
EVANS J.A.
TRUDEL J.A.**

BETWEEN:

**ELI LILLY AND COMPANY and
ELI LILLY CANADA INC.**

Appellants

and

**APOTEX INC. and
NOVOPHARM LIMITED**

Respondents

Heard at Toronto, Ontario, on February 10, 2009.

Judgment delivered from the Bench at Toronto, Ontario, on February 10, 2009.

REASONS FOR JUDGMENT OF THE COURT BY:

TRUDEL J.A.

Date: 20090210

Docket: A-226-08

Citation: 2009 FCA 39

**CORAM: DESJARDINS J.A.
EVANS J.A.
TRUDEL J.A.**

BETWEEN:

**ELI LILLY AND COMPANY and
ELI LILLY CANADA INC.**

Appellants

and

**APOTEX INC. and
NOVOPHARM LIMITED**

Respondents

REASONS FOR JUDGMENT OF THE COURT

(Delivered from the Bench at Toronto, Ontario, on February 10, 2009)

TRUDEL J.A.

[1] In an action for infringement involving two Canadian patents ('55 and '486) related to the medicine nizatidine, the respondents have alleged non-infringement of both patents and further have counterclaimed on the basis of invalidity.

[2] In the course of the proceedings, the appellants (Lilly) have conducted two rounds of discovery of the respondent (Novopharm), the second of which has given rise to an order by the case management Prothonotary refusing to compel Novopharm to answer certain questions.

[3] This appeal arises from the decision of the Motions Judge who dismissed Lilly's appeal of the Prothonotary's order (2008 FC 659).

[4] At issue are six questions ordered not answered, which are grouped in three categories: Novopharm's supplier's process (Items 45, 48, 51 of Schedule A to the Prothonotary's order (Schedule A)); Novopharm's allegations of Lilly's misrepresentations to the Patent Officer (items 128, 130 of Schedule A); and Novopharm's undertaking to provide the identity of the inventor of Patent '55 (item 126 of Schedule A).

[5] With respect to the first and second categories of questions, we have not been persuaded that there is any basis for the intervention of this Court.

[6] With respect to the third category, we are of the view that Lilly's appeal should have been allowed. Both the Motions Judge and the Prothonotary stated that Novopharm had not alleged that someone else was the inventor of the subject matter of Patent '55: Motions Judge's reasons, at paragraph 14; Schedule A to the Prothonotary's order, Item 132. However, at the hearing, counsel for Novopharm conceded that in view of paragraphs 73 and 74 of the amended fresh as amended

defence and counterclaim of October 16, 2006, both the Prothonotary and the Motions Judge were clearly wrong in not ordering that the question relating to the inventor of Patent '55 be answered.

[7] Therefore, the appeal will be allowed in part and Novopharm ordered to fulfill its undertaking by answering item 126 of Schedule A. As success is divided in this appeal, no costs will be allowed.

“Johanne Trudel”

J.A.

FEDERAL COURT OF APPEAL

NAMES OF COUNSEL AND SOLICITORS OF RECORD

DOCKET: A-226-08

**(APPEAL FROM THE ORDER OF MADAM JUSTICE TREMBLAY-LAMER DATED
07-MAY-2008 IN FEDERAL COURT FILE T-1697-01.)**

STYLE OF CAUSE: ELI LILLY AND COMPANY
and ELI LILLY CANADA INC.
v. APOTEX INC. and
NOVOPHARM LIMITED

PLACE OF HEARING: TORONTO, ONTARIO

DATE OF HEARING: FEBRUARY 10, 2009

**REASONS FOR JUDGMENT
OF THE COURT BY:** (DESJARDINS, EVANS &
TRUDEL J.J.A.)

DELIVERED FROM THE BENCH BY: TRUDEL J.A.

APPEARANCES:

Beverley Moore FOR THE APPELLANTS

Trent Horne FOR THE RESPONDENT –
NOVOPHARM LIMITED

SOLICITORS OF RECORD:

GOWLING LAFLEUR HENDERSON LLP FOR THE APPELLANTS
Ottawa, Ontario

BENNETT JONES LLP FOR THE RESPONDENT –
Toronto, Ontario NOVOPHARM LIMITED