Letters Rogatory in Intellectual Property Cases

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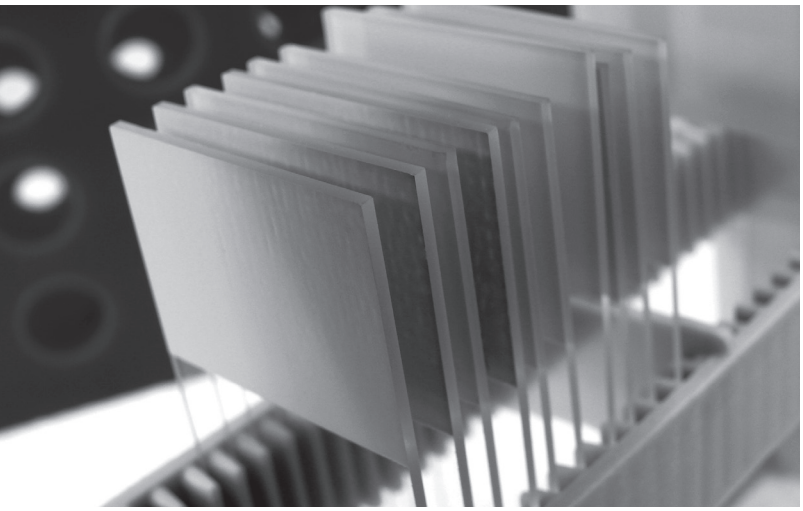

Intellectual property litigation is an increasingly international business. Compelling a foreign witness to provide discovery or trial evidence can be a key part of the proceedings.

Where a Canadian resident has documents or evidence that would be relevant to a foreign proceeding, and will not agree to voluntarily attend for an examination, that evidence can be compelled through letters rogatory, also known as letters of request.

Letters rogatory are not based on international treaties, rather enforced as a matter of judicial comity. A foreign request will be given full force and effect unless it is contrary to public policy or prejudicial to the sovereignty of Canadian citizens.

There are three basic rules for the enforcement of letters rogatory:

- The request for assistance to obtain evidence must originate from an order or other process of a foreign court.
- The witness and/or documents must be within a Canadian court's jurisdiction.
- The evidence sought must be in relation to a civil or commercial action, suit or proceeding or a criminal matter pending before the foreign court.

In this context, Canadian courts have developed specific criteria to determine whether, in any particular case, letters rogatory should be enforced:

- **The evidence sought should be relevant.** It is generally presumed that the foreign court has acted reasonably and that the Canadian court, being in a position to assist, should do so as a matter of comity. To the extent the target of the letters rogatory or the opposite party in the foreign litigation is aware of the initial request to the foreign court, that is an opportune time to narrow the scope of the order. A Canadian court may not second guess the necessity or relevance of the evidence for a foreign proceeding.
- **The evidence sought should be necessary for trial and will be adduced at trial, if admissible.** Enforcement of letters rogatory is no longer limited to evidence that will be adduced at trial. This procedure is available to obtain pre-trial discovery evidence.
- **The evidence is not otherwise obtainable.** In bringing the motion, the moving party must demonstrate that its formal and informal discovery options in the foreign jurisdiction have been exhausted.
- **The order sought is not contrary to public policy.** This defence is rarely invoked, but can be relevant where the evidence has the potential of being used in criminal or quasi-criminal proceedings.
- **The documents sought are identified with reasonable specificity.** The Court will not sanction a fishing expedition that will result in an unreasonable burden on the Canadian witness. If the potential witness will incur expenses (file retrieval, legal costs, lost compensation) the moving party may be required to offset the witnesses' costs.

- **The order sought is not unduly burdensome.** The Court will weigh what the witness would be required to do, and produce, were the action to be tried here. The Court will be sensitive to not imposing an undue burden, particularly when the witness has no direct involvement or interest in the underlying litigation.

Information disclosed in Canadian litigation under compulsion of a court order or procedural rule is protected from disclosure to non-parties. Documents and evidence obtained during the litigation may not be used for any purpose beyond the proceedings in which the information was compelled, unless and until the information is disclosed in open court. Parties to Canadian litigation are implied to have given an undertaking (hence "the implied undertaking rule") that they will not disclose or use information obtained in the discovery process of the adverse party for any reason other than the litigation in which the information was disclosed. Applicants for the enforcement of letters rogatory will be required to undertake to be bound by the implied undertaking rule. A potential witness can also ask, as a term of the order, that any documents or evidence obtained be designated as confidential under any protective or confidentiality orders in the originating litigation.

In Canada, communications between a client and a patent agent (who is not also a lawyer) are not subject to solicitor-client privilege unless they are generated for the purpose of litigation. Provided the requirements are otherwise met, letters rogatory directed to a patent agent may be enforceable.

Most Canadian intellectual property cases are litigated in the Federal Court. The Federal Court will issue letters rogatory on terms.

When considering a request to issue letters rogatory, the Federal Court will place significant weight on whether the moving party has exhausted its ability (either through informal requests and its discovery of the opposite party) to obtain the evidence. The moving party must introduce persuasive evidence as to why the witness could not or would not otherwise attend an examination or the trial. The Court will give directions on the scope of documents to be produced and questions that may be asked. In the case of a corporation, the Court may order that the individual to be examined be the same person who will testify at trial.

Our litigation team has significant experience in all aspects of intellectual property litigation, including obtaining and enforcing letters rogatory.

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