



## PRACTICE

### PRIVILEGE

Appeal from Prothonotary's order dismissing defendant Distrimed's motion seeking order that plaintiff Richards Packaging Inc. could not assert privilege over documents listed in its Updated Privilege Log submitted to counsel for defendant under confidential seal — Parties direct competitors in field of medical products — Plaintiff filing action against defendant for infringement of three of its Canadian patents — Defendant alleging that one patent invalid because reissued in 2018 specifically to target defendant's products — Application to reissue made on basis that patent agency had erred in filing initial patent application — Plaintiff, law firm exchanging documents, communications from 2015 through 2018, including documents, communications previously exchanged between plaintiff, patent agency — Prothonotary concluding that all documents listed privileged, no evidence to support loss or waiver of privilege — Setting out three limited exceptions to confidentiality of solicitor-client communications, including the one at issue in this appeal: "in situations where there are criminal communications or communications that have the purpose of furthering criminal acts or unlawful conduct" — Concluding, *inter alia*, that plaintiff not waiving privilege in redacted sections of communications provided to Patent Office — Rejecting defendant's argument that privilege not applying because documents served to facilitate reissue of patent for improper or unlawful purpose — Finally, concluding that limitation set forth in *Patent Act*, R.S.C., 1985, c. P-4, s. 16.1(6) not defeating existence of patent agent privilege in communications between plaintiff, patent agents in reissue proceedings that have remained confidential — Defendant submitting that Prothonotary made error of statutory interpretation in concluding that words "action or proceeding" in s. 16.1(6) must be read as referring to actions or proceedings that remain ongoing — Main issue whether Prothonotary erring in interpreting s. 16.1(6) — Prothonotary making no error in concluding that s. 16.1(6) extending patent agent privilege, as contemplated in s. 16.1(1), retroactively except in context of ongoing proceeding instituted before June 24, 2016 — Purpose of last sentence of s. 16.1(6) to maintain rules of disclosure applicable in proceeding that was in progress when s. 16.1 enacted — Ss. 16.1(1), (6) having to be read together — Communications between client, patent agent enjoying same protections as solicitor-client communications — Exception in the last sentence of s. 16.1(6) narrow — Excluding from retroactive protection proceedings underway at its enactment — Prothonotary not failing to properly analyze reissue proceedings, plaintiff's disclosure of certain communications with its original patent agents — Not failing to consider evidence of misconduct by plaintiff in seeking reissue of patent — Appeal dismissed.

RICHARDS PACKAGING INC. V. DISTRIMED INC. (T-1606-18, 2020 FC 1162, Walker J., reasons for order dated December 17, 2020, 28 pp.)