



[2022] 1 F.C.R. D-6

PATENTS

INFRINGEMENT

Action against defendant alleging infringement of four patents owned by plaintiff — Patents at issue relating generally to “interactive television program guide” (IPG) technology — IPG consisting of software that generates for display television program listings, recorded content in electronic form that a user can navigate by electronic means — In IPGs, information on available programming content downloaded or sent to user’s television equipment, typically set-top box (STB) — Plaintiff pursuing four sets of claims (asserted claims) — Defendant denying allegations of infringement — Counterclaiming that claims of patents are invalid — Submitting that asserted claims of patents directed to straightforward, routine design choices for user interfaces, system access methods for STBs, IPGs, that no technological problem identified for which claimed subject matter provides solution, nothing novel or inventive in patents — Main issues whether defendant infringed asserted claims; whether asserted claims valid; whether plaintiff entitled to accounting of defendant’s profits — Asserted claims of patents invalid for anticipation, obviousness — Although plaintiff’s action dismissed, issue of remedies addressed for sake of completeness — *Patent Act*, R.S.C., 1985, c. P-4 setting out two alternatives for remedies in action where patent found to be infringed: damages in form of royalty or lost profits (s. 55); accounting of profits (s. 57(1)(b)) — First issue in terms of remedies whether appropriate to award damages or profits on facts of this case — Various factors to consider in deciding whether to award accounting of profits include: (i) whether undue delay in commencing or prosecuting litigation; (ii) patentee’s conduct; (iii) infringer’s conduct; (iv) whether patentee practiced invention of patent in Canada; (v) complexity of calculating accounting of profits — No delay by plaintiff in commencing present action — Plaintiff having reputation of using hard-ball legal tactics to pressure third parties to license its patent portfolio — During its licence negotiations with defendant, plaintiff would not reveal complete list of its patents that it thought defendant had infringed, or even what it referred to as its “best patents” — Plaintiff’s questionable business weighing heavily against it — Defendant’s conduct not inappropriate — Defendant not willfully infringing plaintiff’s patents — Defendant’s motives to refuse to renew licence agreement with plaintiff well founded — Unreliability, complexity of calculating accounting of profits weighing against award of accounting of profits in this case — Plaintiff’s experts relied on novel theories, assumptions — Using any methods proposed by plaintiff’s expert to calculate profits, which would be fraught with insufficient, speculative, contradicted evidence not allowing for reliable, appropriate amount reflecting defendant’s profits — Given that factors weighing against granting accounting of profits, appropriate remedy reasonable royalty — Had Videotron’s system feature infringed valid claim in patents, appropriate remedy would have been \$150,000 per feature — Plaintiff’s action dismissed; defendant’s counterclaim allowed.

ROVI GUIDES, INC. V. VIDEOTRON LTD. (T-921-17, 2022 FC 874, Lafrenière J., public reasons for judgment dated June 23, 2022, 190 pp.)