
December 17, 2014 by Andrew Hunter

On November 24th, 2014, the IP Osgoode Speaks Series concluded a busy term with the visit of the Honourable Mr. Justice Marshall Rothstein of the Supreme Court of Canada, to discuss the nexus between specialist technical expertise and the generalism of judges of courts of appeal, as well as comment on the peculiar direction for the standard of review of the various administrative bodies that govern most IP matters.

Following effusive praise from Professor Giuseppina D’Agostino as ‘one of the leading architects in IP’, and an introduction from Professor David Vaver in which we were reminded that Justice Rothstein’s exposure to IP had only begun in earnest after his appointment to the Federal Court in 1992, Justice Rothstein took to the podium. More information on his background and career can be found here.

With talks from previous years taking in topics like the Copyright Pentalogy, or the art of litigating IP at the Supreme Court, the focus of the day was really on the passage of a case up the appellate ladder, and how the technical savvy of the judges filtered away to generalism as a case rose. Justice Rothstein elaborated about how trial judges at the Federal Court (where the majority of IP cases will begin) frequently come from an IP background themselves. As such, judges are not only closer to the factual record, but are also more likely to have some degree of expertise themselves. Beyond this, he explained, expediency plays less of a factor than at the appellate level, and so trial judges frequently enjoy greater access to counsel, and, with that, more time to develop an understanding of the topic.

The appellate courts are populated by a more generalist breed of judge, which is no bad thing. Citing this article from Chicago’s 7th Circuit Chief Judge Diane Wood, he noted that generalist judges can benefit from experience with a wider variety of legal issues, leaving them able to make connections between the technical subject matter and analogous areas of law to ensure that the overarching principles at hand are not ‘lost in the forest of technical detail’.

This generalism, then, is reflected in the standard of review that the Court has been setting for IP, with a high level of deference paid to most of the findings of the various administrative bodies that govern many of the issues that occur in IP. Post-Dunsmuir, we see reasonableness applied to the findings of administrative tribunals for issues of fact, mixed fact and law, and even some questions of law, with a relatively restrictive reading of when to apply correctness. However, Justice Rothstein was quick to stress that he hasn’t necessarily been seeing eye-to-eye with the Court in interpreting how to apply this standard. In Khosa, for example, he advocated unsuccessfully for a restriction of the deferential standard to cases in which there was a strong privative clause. Conversely, in Access Copyright, he suggested that the court had seemingly applied ‘reasonableness’ in name only when they found that the Copyright Board’s application of the CCH fair dealing factors was ‘unreasonable’, leading to some tension between the Copyright Board and the Court.

It seems that the Court is still trying to figure out exactly how the standard of review should be defined here, and whether the nature of the tribunal requires an application of the standard of review analysis in every case, or whether a single standard can be etched out that might apply consistently. Justice Rothstein made no bones about the fact that he is ‘no fan of the standard of review industry’, but didn’t appear to have a solid alternative to suggest either. That said, we were reminded to keep an eye on prima facie
unrelated developments in the law outside of IP, citing the recent *Sattva Capital Corp. v. Creston Moly Corp* decision as one that may shape the future of the standard of review for cases dealing with factual matters, or ones of mixed fact and law.

The main impression that I received here, was that Justice Rothstein’s idea of the need to display deference was very much connected to the difference between generalism and technical expertise. Answering a question from Professor Carys Craig, he noted that he would have dispensed with expert evidence in a trademark case regarding confusion, as the notional ‘reasonable person’ (a ‘casual consumer somewhat in a hurry’) can easily be role-played by a judge (or any lay-person, for example). On the other hand, in a case like *Apotex Inc v Sanofi-Synthelabo*, the notional ‘person having ordinary skill in the art’ is, by definition, an expert in their field relative to a generalist judge, and so expert evidence and assistance is invaluable to the Court. Perhaps this signals a desire for separate standards of review to apply to each of the various disciplines of IP, with respect for the subject matter at hand.

Although this is Justice Rothstein’s final year at the Supreme Court, he has been an invaluable voice in IP, writing many of the Court’s decisions on the area. Whichever direction the court takes after the end of his term, IP enthusiasts can look back on an era in which an unprecedented number of issues have been decided at the Court. Hopefully, Justice Rothstein will have the opportunity to address a few more before that day comes.

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