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Clerk, U.S. District Court, ILCD

IN THE UNITED STATES DISTRICT COURT
FOR THE CENTRAL DISTRICT OF ILLINOIS
ROCK ISLAND DIVISION

DURASYSTEMS BARRIERS INC., a Canadian corporation, Plaintiff, vs. VAN-PACKER CO., an Illinois corporation, and JEREMIAS, INC., a Georgia corporation, Defendants.	Consolidate Case No. 1:19-cv-01388 Chief Judge Sara Darrow Magistrate Judge Jonathan E. Hawley

REQUEST FOR INTERNATIONAL JUDICIAL ASSISTANCE (LETTER ROGATORY) TO THE CENTRAL AUTHORITY OF ONTARIO

To The Judicial Authority of the Province of Ontario, Canada:

The United States District Court for the Central District of Illinois presents its compliments to the Superior Court of Justice of Ontario and respectfully requests international judicial assistance and comity to obtain evidence to be used in the above-captioned civil proceeding before this Court. The United States District Court for the Central District of Illinois requests the assistance described herein as necessary in the interests of justice. This Court has jurisdiction over the parties and subject matter in these matters. A trial date is not yet set.

I. FACTUAL BACKGROUND

The above-captioned suit, brought by Plaintiff DuraSystems Barriers Inc. ("Plaintiff"), a Canadian Corporation, against Defendants Van-Packer Co. and Jeremias, Inc. (collectively, "Defendants") involves an allegation of infringement of U.S. Patent No. 10,024,569 (the "'569 Patent"). Mr. William B. Vass, a resident of Toronto, Ontario and formerly of the firm Bennett

Jones LLP, now of the firm Cognitive Intellectual Property Law, is a Canadian patent attorney. He is registered as both a Canadian patent agent and a United States patent agent. Mr. Vass is identified in the file history of the ’569 Patent as the primary individual involved in the prosecution of the ’569 Patent. Mr. Vass moved to his current firm while the ’569 Patent was still being prosecuted. Mr. Vass has key knowledge relating to the prosecution of the ’569 Patent. Mr. Vass and/or his law firm, Cognitive Intellectual Property Law, possess documents relating to the prosecution of the ’569 Patent. This information is highly relevant to the assertion of patent infringement by Plaintiff and cannot be obtained from any other source.

II. REQUEST FOR JUDICIAL ASSISTANCE

In view of the above facts, this Court has determined that it would further the interests of justice if, by the proper and usual process of your Court, you summon Mr. William B. Vass, a resident of Toronto, Ontario, to: (1) produce certain documents that may be in his possession or in the possession of Cognitive Intellectual Property Law, identified below, and (2) appear before a person empowered or appointed under your law to administer oaths and take testimony forthwith, to give testimony under oath or affirmation by questions and answers upon oral examination in respect of the matters and issues identified below, and permit a written transcript and video recording of such testimony. The Court has determined that the requests seek relevant evidence necessary for trial.

This request is made pursuant to Federal Rule of Civil Procedure 28(b)(1)(B); 28 U.S.C. § 1781 (permitting the transmittal of letter rogatory through the district courts and the Department of State); section 60 of the Ontario *Evidence Act*, R.S.O. 1990, C. E.23; and sections 43, 46, 47, 48, 49 and 51 of the Canada *Evidence Act*, R.S.C., 1985, c. C-5.

This request is made with the understanding that it will in no way require any person to commit any offense, or to undergo a broader form of inquiry than he or she would if the litigation

were conducted in a Canadian Court. The requesting Court is satisfied that the evidence sought to be obtained through this request is relevant, necessary, and cannot reasonably be obtained by other methods. Because this Court lacks authority to compel participation of this person and, such participation being necessary in order that justice be served in the above-captioned proceedings, this Court respectfully requests assistance from the Superior Court of Justice of Ontario.

III. RELEVANCE AND AVAILABILITY OF THE EVIDENCE TO BE OBTAINED

The testimony and production of documents requested herein are intended for use at trial, if admissible, or directly in the preparation of trial. While this Court expresses no view at this time as to the merits in the above-captioned case, it is satisfied that the evidence requested is highly relevant to the claims and defenses of the parties in this action.

IV. IDENTITY AND ADDRESS OF THE PERSON TO BE EXAMINED

The identity and business address of the person to be examined is set forth below. The address provided is based on currently available information:

Mr. William B. Vass
A resident of Toronto, Ontario, Canada

Cognitive Intellectual Property Law
1710 - 2255B Queen Street East
Toronto, Ontario, Canada M4E 1G3

V. DOCUMENTS OR EVIDENCE TO BE PRODUCED

The Requesting Judicial Authority seeks the production of the following documents from Mr. Vass and/or Cognitive Intellectual Property Law:

1. All non-privileged documents and non-privileged communications relating to the internal patent application preparation file of the application that issued as the ’569 Patent and any Related Applications, including but not limited to invention disclosures, documents describing or otherwise relating to the conception and/or actual reduction to practice of the claimed inventions,

documents relating to any disclosure or use of the subject matter described and/or claimed in the application prior to the filing of the application, patentability studies and/or opinions, prior art searches, notes of meetings or conversations with the inventors, and drafts of documents to be submitted to the U.S. Patent and Trademark Office.

2. All non-privileged documents or non-privileged communications relating to the abandonment and subsequent petition for revival of the application that issued as the ’569 Patent.

3. All non-privileged documents and non-privileged communications relating to the transfer of files relating to the prosecution of the application that issued as the ’569 Patent and any Related Applications from Bennett Jones LLP to Cognitive Intellectual Property Law.

4. All non-privileged documents and non-privileged communications relating to the transfer of files relating to the representation of Plaintiff from Bennett Jones LLP to Cognitive Intellectual Property Law.

5. All non-privileged documents referring or otherwise concerning any alleged or potential infringement of the ’569 Patent, whether by the Defendants or anyone else, including but not limited to any analysis, study or opinion concerning such alleged or potential infringement.

6. All non-privileged documents relating to validity of the ’569 Patent, including but not limited to any analysis, study or opinion concerning validity or invalidity.

7. Any non-privileged documents or non-privileged communications with Plaintiff relating to the licensing of the ’569 Patent.

8. A privilege log pursuant to Rule 26(b)(5) of the Federal Rules of Civil Procedure identifying all privileged documents, communications, or tangible things responsive to Request Nos. 1–7 above withheld on the basis of privilege. The log shall describe the nature of the privileged documents, communications, or tangible things in a manner that, without revealing

information itself privileged or protected, will enable other parties to assess the claim.

VI. QUESTIONS TO BE PUT TO THE PERSON TO BE EXAMINED

The Requesting Judicial Authority requests that an attorney for the Defendants be permitted to examine Mr. Vass regarding the subject matter or topics set forth below:

1. Non-privileged information concerning the internal patent application preparation file of the application that issued as the ’569 Patent and any Related Applications, including but not limited to invention disclosures, documents describing or otherwise relating to the conception and/or actual reduction to practice of the claimed inventions, documents relating to any disclosure or use of the subject matter described and/or claimed in the application prior to the filing of the application, patentability studies and/or opinions, prior art searches, notes of meetings or conversations with the inventors, and drafts of documents to be submitted to the U.S. Patent and Trademark Office.

2. Non-privileged information concerning the abandonment and subsequent petition for revival of the application that issued as the ’569 Patent.

3. Non-privileged information concerning the transfer of files relating to the prosecution of the application that issued as the ’569 Patent and any Related Applications from Bennett Jones LLP to Cognitive Intellectual Property Law.

4. Non-privileged information concerning the transfer of files relating to the representation of Plaintiff from Bennett Jones LLP to Cognitive Intellectual Property Law.

5. Non-privileged information concerning any alleged or potential infringement of the ’569 Patent, whether by the Defendants or anyone else, including but not limited to any analysis, study or opinion concerning such alleged or potential infringement.

6. Non-privileged information concerning the validity of the ’569 Patent, including but not limited to any analysis, study or opinion concerning validity or invalidity.

7. Non-privileged information concerning licensing of the ’569 Patent.

VII. SPECIAL RIGHTS OF PERSON TO BE EXAMINED / PROTECTIVE ORDER

This request is made with the understanding that it will in no way require any person to commit any offense, or to undergo a broader form of inquiry than he or she would if the litigation were conducted in a Canadian Court. The requesting Court is satisfied that the evidence sought to be obtained through this request is relevant, necessary, and cannot reasonably be obtained by other methods. Because this Court lacks authority to compel participation of this person and, such participation being necessary in order that justice be served in the above-captioned proceeding, this Court respectfully requests assistance from the Superior Court of Justice of Ontario.

Further, some of the documents requested and some of the testimony sought may call for the disclosure of confidential information. This Court entered a Protective Order that governs the production of documents, testimony, and other evidence in connection with this action, including the document production or testimony of third parties. A copy of the governing Protective Order is attached as Exhibit 1 hereto. This Protective Order will serve to protect any confidential and proprietary business information produced by Mr. Vass from public disclosure.

VIII. PROCEDURES OR METHOD TO BE FOLLOWED

This Court requests that the examination be conducted pursuant to the discovery rules as provided for in the United States Federal Rules of Civil Procedure, except to the extent such procedure is incompatible with the laws of Canada. This Court further requests: (1) that the examination be conducted in Toronto, Ontario at a date and time that is mutually convenient to the witness and counsel for the Plaintiff and Defendants; (2) that the examination be conducted by remote means in light of travel restrictions due to the current pandemic; (3) that the examination and testimony be provided orally; (4) that the examination be taken before an official court reporter and videographer; (5) that the videographer be permitted to record the examination and testimony

by audiovisual means; (6) that the official court reporter be allowed to record a verbatim transcript of the examination; (7) that the examination be conducted in English; and (8) that the witness be examined for no more than seven hours, with Defendants permitted to examine the witness for 5 hours and Plaintiff permitted to examine the witness for 2 hours.

In the event that the evidence cannot be taken according to some or all of the procedures described above, this Court requests that it be taken in such manner as provided by the laws of Canada for the formal taking of testimonial evidence.

IX. REQUEST FOR NOTIFICATION

This Court respectfully requests that the following be notified of the time and place for the execution of the Request:

Honorable Sara Darrow
Chief United States District Judge
United States District Court for the Central District of Illinois
U.S. Courthouse
131 E. 4th Street
Davenport, IA 52801
United States of America

With a copy to:

(Counsel for Defendants):

James A. Shimota
Katherine L. Allor
K&L GATES LLP
70 W. Madison St., Suite 3300
Chicago, IL 60602
United States of America
Telephone: (312) 372-1121
Fax: (312) 827-8000
james.shimota@klgates.com
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(Counsel for Plaintiff):

Brian N. Platt
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WORKMAN NYDEGGER
60 East South Temple, Suite 1000
Salt Lake City, UT 84111
United States of America
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bplatt@wnlaw.com
cnydegger@wnlaw.com

X. SPECIFICATION OF DATE BY WHICH THE REQUESTING AUTHORITY REQUIRES RECEIPT OF THE RESPONSE TO THE LETTER ROGATORY

This Court respectfully requests that the examination of Mr. Vass commence on a date as soon as practicable, but no later than December 1, 2020.

XI. RECIPROCITY

The United States District Court for the Central District of Illinois is willing and authorized to provide similar assistance to the judicial authorities of Canada, should a similar Request for International Judicial Assistance be received from the courts of Ontario and Canada. *See* Federal Rule of Civil Procedure, 28(b)(1)(B) and 28 U.S.C. § 1781.

XII. REIMBURSEMENT

This Court understands that any fees and costs incurred in the execution of this request are reimbursable. These fees and costs will be reimbursed by counsel for the Defendants up to USD $2,500. Counsel for Defendants, James Shimota, should be informed before the costs exceed this amount, and may be contacted at: K&L Gates LLP, 70 W. Madison Street, Suite 3300, Chicago, IL 60602, Telephone: (312) 372-1121, Email: james.shimota@klgates.com.

Dated: October 13, 2020

s/ Jonathan E. Hawley

Honorable Jonathen E. Hawley
United States Magistrate Judge
United States District Court for the Central District of Illinois

EXHIBIT 1

E-FILED
Monday, 04 May, 2020 08:48:14 AM
Clerk, U.S. District Court, ILCD

UNITED STATES DISTRICT COURT
FOR THE CENTRAL DISTRICT OF ILLINOIS
ROCK ISLAND DIVISION

DURASYSTEMS BARRIERS INC., a Canadian corporation, Plaintiff, vs. VAN-PACKER CO., an Illinois corporation, and JEREMIAS, INC., a Georgia corporation, Defendants.	**Case No. 1:19-cv-01388-SLD-JEH** **STIPULATED PROTECTIVE ORDER** District Judge Sara Darrow Magistrate Judge Jonathan E. Hawley

Plaintiff DuraSystems Barriers Inc. ("Plaintiff") and Defendants Van-Packer Co. and Jeremias, Inc. ("Defendants") through their counsel, hereby stipulate, subject to the approval of the Court, to enter this Stipulated Protective Order.

WHEREAS, the Parties seek a protective order limiting disclosure thereof in accordance with Federal Rule of Civil Procedure 26(c):

1. PURPOSES AND LIMITATIONS

Disclosure and discovery activity in this action are likely to involve production of confidential, proprietary, or private information for which special protection from public disclosure and from use for any purpose other than prosecuting this litigation may be

warranted. Accordingly, the parties hereby stipulate to and petition the Court to enter the following Stipulated Protective Order.

The parties acknowledge that this Order does not confer blanket protections on all disclosures or responses to discovery and that the protection it affords from public disclosure and use extends only to the limited information or items that are entitled to confidential treatment under the applicable legal principles.

The parties further acknowledge, as set forth in Section 12.3, below, that this Stipulated Protective Order does not entitle them to file confidential information under seal, and acknowledge the Standing Order in Civil Cases Referred to or Pending Before Hon. Jonathan E. Hawley, U.S. Magistrate Judge ("Standing Order") regarding procedures that must be followed and the standards that will be applied when a party seeks permission from the Court to file material under seal.

2. DEFINITIONS

2.1 Challenging Party: a Party or Non-Party that challenges the designation of information or items under this Order.

2.2 "CONFIDENTIAL BUSINESS INFORMATION" Documents, Items, or Materials: information (regardless of how it is generated, stored, or maintained) or tangible things that qualify for protection under Federal Rule of Civil Procedure 26(c) and that contain information prohibited from disclosure by statute or that should be protected from disclosure as confidential business or personal information, personnel

records, or such other sensitive commercial information that is not publicly available. Such materials shall be marked "CONFIDENTIAL BUSINESS INFORMATION — SUBJECT TO PROTECTIVE ORDER."

2.3 Counsel (without qualifier): Outside Counsel of Record (as well as their support staff).

2.4 Designating Party: a Party or Non-Party that designates information or items that it produces in disclosures or in responses to discovery as "CONFIDENTIAL BUSINESS INFORMATION — SUBJECT TO PROTECTIVE ORDER" or "HIGHLY CONFIDENTIAL ATTORNEYS' EYES ONLY – SUBJECT TO PROTECTIVE ORDER."

2.5 Disclosure or Discovery Material: all items or information, regardless of the medium or manner in which it is generated, stored, or maintained (including, among other things, testimony, transcripts, and tangible things), that are produced or generated in disclosures or responses to discovery in this matter.

2.6 Expert: a person with specialized knowledge or experience in a matter pertinent to the litigation who (1) has been retained by a Party or its counsel to serve as an expert witness or as a consultant in this action, (2) is not currently and has not in the past been affiliated with a Party and is currently not affiliated with a Party's competitor, and (3) at the time of retention, is not anticipated to become affiliated with a Party or of a Party's competitor beyond the scope of retention in this matter.

2.7 "HIGHLY CONFIDENTIAL ATTORNEYS' EYES ONLY" Documents, Items, or Materials: information (regardless of how it is generated, stored, or maintained) or tangible things that qualify for protection under Federal Rule of Civil Procedure 26(c) and that contain information prohibited from disclosure by statute or that should be protected from disclosure as trade secrets or other highly sensitive business or personal information, the disclosure of which is likely to cause significant harm to an individual or to the business or competitive position of the Designating Party including, but not limited to, financial data, customer data, sales data, highly detailed engineering or other technical documentation, business plans, and highly sensitive employee information. Such materials shall be marked "HIGHLY CONFIDENTIAL ATTORNEYS' EYES ONLY — SUBJECT TO PROTECTIVE ORDER."

2.8 This Litigation: The following related proceedings between Plaintiff and Defendants now consolidated under the above case caption: (1) *DuraSystems Barriers Inc. v. Van-Packer Co.*, CDIL-1:19-cv-01388-SLD-JEH; and (2) *DuraSystems Barriers Inc. v. Jeremias, Inc.*, CDIL-4:20-cv-04069-SLD-JEH.

2.9 Non-Party: any natural person, partnership, corporation, association, or other legal entity not named as a Party to this action.

2.10 Outside Counsel of Record: attorneys who are not employees of a party to this action but are retained to represent or advise a party to this action and have

appeared in this action on behalf of that party or are affiliated with a law firm which has appeared on behalf of that party.

2.11 Patent in Suit: U.S. Patent No. 10,024,569; and any other patent asserted in this action, as well as any related patents, patent applications, provisional patent applications, continuations, and/or divisionals.

2.12 Party: any party to this action, including all of its officers, directors, employees, consultants, retained experts, and Counsel.

2.13 Producing Party: a Party or Non-Party that produces Disclosure or Discovery Material in this action.

2.14 Professional Vendors: persons or entities that provide litigation support services (e.g., photocopying, videotaping, translating, preparing exhibits or demonstrations, and organizing, storing, or retrieving data in any form or medium) and their employees and subcontractors.

2.15 Protected Material: any Disclosure or Discovery Material that is designated as "CONFIDENTIAL BUSINESS INFORMATION — SUBJECT TO PROTECTIVE ORDER" or "HIGHLY CONFIDENTIAL ATTORNEYS' EYES ONLY — SUBJECT TO PROTECTIVE ORDER."

2.16 Receiving Party: a Party that receives Disclosure or Discovery Material from a Producing Party.

3. SCOPE

The protections conferred by this Stipulation and Order cover not only Protected Material (as defined above), but also (1) any information copied or extracted from Protected Material; (2) all copies, excerpts, summaries, or compilations of Protected Material; and (3) any testimony, conversations, or presentations by Parties or their Counsel that might reveal Protected Material. However, the protections conferred by this Stipulation and Order do not cover the following information: (a) any information that is in the public domain at the time of disclosure to a Receiving Party or becomes part of the public domain after its disclosure to a Receiving Party as a result of publication not involving a violation of this Order, including becoming part of the public record through trial or otherwise; and (b) any information known to the Receiving Party prior to the disclosure or obtained by the Receiving Party after the disclosure from a source who obtained the information lawfully and under no obligation of confidentiality to the Designating Party. Any use of Protected Material at trial shall be governed by a separate agreement or order. This Order is without prejudice to the right of any Party to seek further or additional protection of any Discovery Material or to modify this Order in any way, including, without limitation, an order that certain matter not be produced at all.

4. DURATION

Even after final disposition of this litigation, the confidentiality obligations imposed by this Order shall remain in effect until a Designating Party agrees otherwise in

writing or a court order otherwise directs. Final disposition shall be deemed to be the later of (1) dismissal of all claims and defenses in this action, with or without prejudice; and (2) final judgment herein after the completion and exhaustion of all appeals, rehearings, remands, trials, or reviews of this action, including the time limits for filing any motions or applications for extension of time pursuant to applicable law.

5. DESIGNATING PROTECTED MATERIAL

5.1 Exercise of Restraint and Care in Designating Material for Protection. Each Party or Non-Party that designates information or items for protection under this Order must take care to limit any such designation to specific material that qualifies under the appropriate standards. To the extent it is practical to do so, the Designating Party must designate for protection only those parts of material, documents, items, or oral or written communications that qualify – so that other portions of the material, documents, items, or communications for which protection is not warranted are not swept unjustifiably within the ambit of this Order.

Mass, indiscriminate, or routinized designations are prohibited. Designations that are shown to be clearly unjustified or shown to have been made for an improper purpose (e.g., to unnecessarily encumber or retard the case development process or to impose unnecessary expenses and burdens on other parties) may expose the Designating Party to sanctions. If it comes to a Designating Party's attention that information or items that it designated for protection do not qualify for protection at all or do not qualify for the level

of protection initially asserted, that Designating Party must promptly notify all other parties that it is withdrawing the mistaken designation.

5.2 Manner and Timing of Designations. Except as otherwise provided in this Order (see, e.g., section 5.2(a) below), or as otherwise stipulated or ordered, Disclosure or Discovery Material that qualifies for protection under this Order must be clearly so designated before or at the same time the material is disclosed or produced. Designation in conformity with this Order requires:

(a) for information in documentary form (e.g., paper or electronic documents, but excluding transcripts of depositions or other pretrial or trial proceedings), that the Designating Party affix the legend "CONFIDENTIAL BUSINESS INFORMATION — SUBJECT TO PROTECTIVE ORDER" or "HIGHLY CONFIDENTIAL ATTORNEYS' EYES ONLY — SUBJECT TO PROTECTIVE ORDER" to each page that contains Protected Material. If only a portion or portions of the material on a page qualifies for protection and where practicable, the Designating Party also must clearly identify the protected portion(s) (e.g., by making appropriate markings in the margins) and must specify, for each portion, the level of protection being asserted. A Party or Non-Party that makes original documents or materials available for inspection need not designate them for protection until after the inspecting Party has indicated which material it would like copied and produced. During the inspection and before the designation, all of the material made available for inspection shall be deemed "HIGHLY CONFIDENTIAL

ATTORNEYS' EYES ONLY — SUBJECT TO PROTECTIVE ORDER." After the inspecting Party has identified the documents it wants copied and produced, the Designating Party must determine which documents, or portions thereof, qualify for protection under this Order. Then, before producing the specified documents, the Producing Party must affix the appropriate legend ("CONFIDENTIAL BUSINESS INFORMATION — SUBJECT TO PROTECTIVE ORDER" or "HIGHLY CONFIDENTIAL ATTORNEYS' EYES ONLY — SUBJECT TO PROTECTIVE ORDER") to each page that contains Protected Material. If only a portion or portions of the material on a page qualifies for protection and where practicable, the Designating Party also must clearly identify the protected portion(s) (e.g., by making appropriate markings in the margins) and must specify, for each portion, the level of protection being asserted.

(b) for testimony given in deposition or in other pretrial or trial proceedings, that the Designating Party identify on the record, before the close of the deposition, hearing, or other proceeding, all protected testimony and specify the level of protection being asserted. When it is impractical to identify separately each portion of testimony that is entitled to protection and it appears that substantial portions of the testimony may qualify for protection, the Designating Party may invoke on the record (before the deposition, hearing, or other proceeding is concluded) a right to have up to 21 days to identify the specific portions of the testimony as to which protection is sought and to specify the level

of protection being asserted. Only those portions of the testimony that are appropriately designated for protection within the 21 days shall be covered by the provisions of this Stipulated Protective Order. Alternatively, a Designating Party may specify, at the deposition or up to 21 days afterwards if that period is properly invoked, that the entire transcript shall be treated as "CONFIDENTIAL BUSINESS INFORMATION — SUBJECT TO PROTECTIVE ORDER" or "HIGHLY CONFIDENTIAL ATTORNEYS' EYES ONLY — SUBJECT TO PROTECTIVE ORDER."

Parties shall give the other parties notice if they reasonably expect a deposition, hearing or other proceeding to include Protected Material so that the other parties can ensure that only authorized individuals who have signed the "Acknowledgment and Agreement to Be Bound" (Exhibit A) are present at those proceedings. The use of a document as an exhibit at a deposition shall not in any way affect its designation as "CONFIDENTIAL BUSINESS INFORMATION — SUBJECT TO PROTECTIVE ORDER" or "HIGHLY CONFIDENTIAL ATTORNEYS' EYES ONLY — SUBJECT TO PROTECTIVE ORDER."

Transcripts containing Protected Material shall have an obvious legend on the title page that the transcript contains Protected Material, and the title page shall be followed by a list of all pages (including line numbers as appropriate) that have been designated as Protected Material and the level of protection being asserted by the Designating Party. The Designating Party shall inform the Court reporter of these requirements. Any

transcript that is prepared before the expiration of a 21-day period for designation shall be treated during that period as if it had been designated "HIGHLY CONFIDENTIAL ATTORNEYS' EYES ONLY — SUBJECT TO PROTECTIVE ORDER" in its entirety unless otherwise agreed. After the expiration of that period, the transcript shall be treated only as actually designated.

Copies of documents or other materials that have been designated "HIGHLY CONFIDENTIAL ATTORNEYS' EYES ONLY — SUBJECT TO PROTECTIVE ORDER " that are marked as deposition exhibits shall not be provided to the Court reporter or attached to deposition transcripts; rather, the deposition record will identify the exhibit by its production numbers.

(c) for information produced in some form other than documentary and for any other tangible items, that the Designating Party affix in a prominent place on the exterior of the container or containers in which the information or item is stored the legend "CONFIDENTIAL BUSINESS INFORMATION — SUBJECT TO PROTECTIVE ORDER" or "HIGHLY CONFIDENTIAL ATTORNEYS' EYES ONLY — SUBJECT TO PROTECTIVE ORDER." If only a portion or portions of the information or item warrant protection and where practicable, the Designating Party, to the extent practicable, shall identify the protected portion(s) and specify the level of protection being asserted.

5.3 Inadvertent Failures to Designate. An inadvertent failure to designate qualified information or items does not, standing alone, waive the Designating Party's

right to secure protection under this Order for such material. Upon correction of a designation, the Receiving Party must make reasonable efforts to assure that the material is treated in accordance with the provisions of this Order.

5.4 Native Files: Where electronic files and documents are produced in native electronic format, such electronic files and documents shall be designated for protection under this Order by appending to the file names or designators information indicating whether the file contains "CONFIDENTIAL BUSINESS INFORMATION — SUBJECT TO PROTECTIVE ORDER" or "HIGHLY CONFIDENTIAL ATTORNEYS' EYES ONLY — SUBJECT TO PROTECTIVE ORDER" material, or shall use any other reasonable method for so designating Protected Materials produced in electronic format. When electronic files or documents are printed for use at deposition, in a court proceeding, or for an expert or consultant pre-approved pursuant to sections 7 and 9, the party printing the electronic files or documents shall affix a legend to the printed document corresponding to the designation of the Designating Party and including the production number and designation associated with the native file. No one shall seek to use in this litigation a .tiff, .pdf, or other image format version of a document produced in native file format without first (1) providing a copy of the image format version to the Producing Party so that the Producing Party can review the image to ensure that no information has been altered, and (2) obtaining the consent of the Producing Party, which consent shall not be unreasonably withheld.

6. CHALLENGING CONFIDENTIALITY DESIGNATIONS

6.1 Timing of Challenges. Any Party or Non-Party may challenge a designation of confidentiality at any time. Unless a prompt challenge to a Designating Party's confidentiality designation is necessary to avoid foreseeable, substantial unfairness, unnecessary economic burdens, or a significant disruption or delay of the litigation, a Party does not waive its right to challenge a confidentiality designation by electing not to mount a challenge promptly after the original designation is disclosed.

6.2 Meet and Confer. The Challenging Party shall initiate the dispute resolution process by providing written notice of each designation it is challenging and describing the basis for each challenge. To avoid ambiguity as to whether a challenge has been made, the written notice must recite that the challenge to confidentiality is being made in accordance with this specific paragraph of the Protective Order. The parties shall attempt to resolve each challenge in good faith and must begin the process by conferring directly (in voice to voice dialogue; other forms of communication are not sufficient) within 14 days of the date of service of notice. In conferring, the Challenging Party must explain the basis for its belief that the confidentiality designation was not proper and must give the Designating Party an opportunity to review the designated material, to reconsider the circumstances, and, if no change in designation is offered, to explain the basis for the chosen designation. A Challenging Party may proceed to the next stage of the challenge process only if it has engaged in this meet and confer process first or

establishes that the Designating Party is unwilling to participate in the meet and confer process in a timely manner.

6.3 Judicial Intervention. If the Parties cannot resolve a challenge without Court intervention, the Challenging Party may seek appropriate relief at any time within the discovery period established by the Court. Each such motion must be accompanied by a competent declaration affirming that the movant has complied with the meet and confer requirements imposed in the preceding paragraph. The burden of persuasion in any such challenge proceeding shall be on the Designating Party. Frivolous challenges and those made for an improper purpose (e.g., to harass or impose unnecessary expenses and burdens on other parties) may expose the Challenging Party to sanctions. Unless the Designating Party has waived the confidentiality designation by failing to oppose a motion challenging a confidentiality designation filed by the Challenging Party as described above, all parties shall continue to afford the material in question the level of protection to which it is entitled under the Designating Party's designation until the Court rules on the challenge.

7. ACCESS TO AND USE OF PROTECTED MATERIAL

7.1 Basic Principles. A Receiving Party may use Protected Material that is disclosed or produced by another Party or by a Non-Party in connection with this case only for prosecuting, defending, or attempting to settle this litigation. A Receiving Party may only use Protected Material in related proceedings involving a Patent-in-Suit and the

Disclosing Party, such as *inter partes* review, post-grant review, reexamination, or reissue proceedings, and where the tribunal has previously entered a protective order with provisions at least as stringent as the Order in this case. Protected Material shall not be used for any other purpose whatsoever, including without limitation other litigation, patent prosecution, acquisition, or any other business or competitive purpose or function, except as provided in section 8 of this Order (PROSECUTION BAR). Such Protected Material may be disclosed only to the categories of persons and under the conditions described in this Order. When the litigation has been terminated, a Receiving Party must comply with the provisions of section 13 below (FINAL DISPOSITION).

Protected Material must be stored and maintained by a Receiving Party at a location and in a secure manner, as described below, that ensures that access is limited to the persons authorized under this Order.

7.2 Disclosure of "CONFIDENTIAL BUSINESS INFORMATION" Information, Documents, or Items. Unless otherwise ordered by the Court or permitted in writing by the Designating Party, a Receiving Party may disclose any information or item designated "CONFIDENTIAL BUSINESS INFORMATION — SUBJECT TO PROTECTIVE ORDER" only to:

(a) the Receiving Party's Outside Counsel of Record in this action, as well as employees of said Outside Counsel of Record, to whom it is reasonably necessary to disclose the information for this litigation;

(b) Up to two employees of a Receiving Party designated to receive CONFIDENTIAL BUSINESS INFORMATION, provided that Outside Counsel of Record determines in good faith that the employee's review is reasonably necessary to assist counsel in the conduct of this action, but only after such persons have signed the "Acknowledgment and Agreement to Be Bound" (Exhibit A) and the signed "Acknowledgment and Agreement to Be Bound" has been provided to Outside Counsel of Record for all other Parties;

(c) Experts (as defined in this Order) of the Receiving Party to whom disclosure is reasonably necessary for this litigation and who have signed the "Acknowledgment and Agreement to Be Bound" (Exhibit A);

(d) during their depositions, witnesses in the action to whom disclosure is reasonably necessary and who have signed the "Acknowledgment and Agreement to Be Bound" (Exhibit A), unless otherwise agreed by the Designating Party or ordered by the Court. Pages of transcribed deposition testimony or exhibits to depositions that reveal Protected Material must be separately bound by the Court reporter and may not be disclosed to anyone except as permitted under this Stipulated Protective Order;

(e) the author or recipient of a document containing the information or a custodian or other person who otherwise possessed or knew the information;

(f) the Court and its personnel;

(g) Court reporters engaged for depositions and who have signed the "Acknowledgment and Agreement to Be Bound" (Exhibit A);

(h) Other persons only by written consent of the Designating Party or upon order of the Court and on such conditions as may be agreed or ordered. All such persons shall execute the "Acknowledgment and Agreement to Be Bound" (Exhibit A).

7.3 Disclosure of "HIGHLY CONFIDENTIAL ATTORNEYS' EYES ONLY" Documents, Items, or Materials. Unless otherwise ordered by the Court or permitted in writing by the Designating Party, a Receiving Party may disclose any documents, items, or materials designated "HIGHLY CONFIDENTIAL ATTORNEYS' EYES ONLY — SUBJECT TO PROTECTIVE ORDER" (or information derived therefrom) only to:

(a) the Receiving Party's Outside Counsel of Record in this action, as well as employees of said Outside Counsel of Record to whom it is reasonably necessary to disclose the information for this litigation;

(b) Experts (as defined in this Order) of the Receiving Party to whom disclosure is reasonably necessary for this litigation and who have signed the "Acknowledgment and Agreement to Be Bound" (Exhibit A);

(c) during their depositions, witnesses in the action to whom disclosure is reasonably necessary and who have signed the "Acknowledgment and Agreement to Be Bound" (Exhibit A), unless otherwise agreed by the Designating Party or ordered by the

Court. Pages of transcribed deposition testimony or exhibits to depositions that reveal Protected Material must be separately bound by the Court reporter and may not be disclosed to anyone except as permitted under this Stipulated Protective Order.

(d) the author or recipient of a document containing the information or a custodian or other person who otherwise possessed or knew the information;

(e) the Court and its personnel;

(f) Court reporters engaged for depositions and who have signed the "Acknowledgment and Agreement to Be Bound" (Exhibit A);

(g) Other persons only by written consent of the Designating Party or upon order of the Court and on such conditions as may be agreed or ordered. All such persons shall execute the "Acknowledgment and Agreement to Be Bound" (Exhibit A).

7.4 Procedures for Approving or Objecting to Disclosure of "HIGHLY CONFIDENTIAL ATTORNEYS' EYES ONLY" Documents, Items, or Materials to Designated Experts.

(a) Unless otherwise ordered by the Court or agreed to in writing by the Designating Party, a Party that seeks to disclose to an Expert (as defined in this Order) any document, item, or material that has been designated "HIGHLY CONFIDENTIAL ATTORNEYS' EYES ONLY — SUBJECT TO PROTECTIVE ORDER" pursuant to section 7 (or information derived therefrom) first must make a written request to the Designating Party that (1) sets forth the full name of the Expert and the city and state of

his or her primary residence, (2) attaches a copy of the Expert's current resume or curriculum vitae, (3) identifies the Expert's current employer(s), and (4) identifies (by name and number of the case, filing date, and location of court) any litigation in connection with which the Expert has offered expert testimony, including through a declaration, report, or testimony at a deposition or trial, during the preceding five years.

(b) A Party that makes a request and provides the information specified in the preceding respective paragraphs may disclose the subject Protected Material to the identified Expert unless, within 10 days of delivering the request, the Party receives a written objection from the Designating Party. Any such objection must set forth in detail the grounds on which it is based.

(c) A Party that receives a timely written objection must meet and confer with the Designating Party (through direct voice to voice dialogue) to try to resolve the matter by agreement within seven days of the written objection. If no agreement is reached, the Party seeking to make the disclosure to the Expert may file a motion seeking permission from the Court to do so. In any such proceeding, the Party opposing disclosure to the Expert shall bear the burden of proving that the risk of harm that the disclosure would entail (under the safeguards proposed) outweighs the Receiving Party's need to disclose the Protected Material to its Expert.

8. PROTECTED MATERIAL SUBPOENAED OR ORDERED PRODUCED IN OTHER LITIGATION

If a Party is served with a subpoena or a court order issued in other litigation that compels disclosure of any documents, items, or materials designated in this action as "CONFIDENTIAL BUSINESS INFORMATION — SUBJECT TO PROTECTIVE ORDER" or "HIGHLY CONFIDENTIAL ATTORNEYS' EYES ONLY — SUBJECT TO PROTECTIVE ORDER" or information derived therefrom that Party must:

(a) promptly notify in writing the Designating Party. Such notification shall include a copy of the subpoena or court order;

(b) promptly notify in writing the party who caused the subpoena or order to issue in the other litigation that some or all of the material covered by the subpoena or order is subject to this Protective Order. Such notification shall include a copy of this Stipulated Protective Order; and

(c) cooperate with respect to all reasonable procedures sought to be pursued by the Designating Party whose Protected Material may be affected.[1]

If the Designating Party timely seeks a protective order, the Party served with the subpoena or court order shall not produce any documents, items, or materials designated in this action as "CONFIDENTIAL BUSINESS INFORMATION — SUBJECT TO PROTECTIVE ORDER" or "HIGHLY CONFIDENTIAL ATTORNEYS' EYES ONLY

[1] The purpose of imposing these duties is to alert the interested parties to the existence of this Protective Order and to afford the Designating Party in this case an opportunity to try to protect its confidentiality interests in the Court from which the subpoena or order issued.

— SUBJECT TO PROTECTIVE ORDER" or information derived therefrom before a determination by the Court from which the subpoena or order issued, unless the Party has obtained the Designating Party's permission. The Designating Party shall bear the burden and expense of seeking protection in that court of its confidential material – and nothing in these provisions should be construed as authorizing or encouraging a Receiving Party in this action to disobey a lawful directive from another court.

9. A NON-PARTY'S PROTECTED MATERIAL SOUGHT TO BE PRODUCED IN THIS LITIGATION

(a) The terms of this Order are applicable to information produced by a Non-Party in this action and designated as "CONFIDENTIAL BUSINESS INFORMATION — SUBJECT TO PROTECTIVE ORDER" or "HIGHLY CONFIDENTIAL ATTORNEYS' EYES ONLY — SUBJECT TO PROTECTIVE ORDER." Such information produced by Non-Parties in connection with this litigation is protected by the remedies and relief provided by this Order. Nothing in these provisions should be construed as prohibiting a Non-Party from seeking additional protections.

(b) In the event that a Party is required, by a valid discovery request, to produce a Non-Party's confidential information in its possession, and the Party is subject to an agreement with the Non-Party not to produce the Non-Party's confidential information, then the Party shall:

1. promptly notify in writing the Requesting Party and the Non-Party that some or all of the information requested is subject to a confidentiality agreement with a Non-Party;

2. promptly provide the Non-Party with a copy of the Stipulated Protective Order in this litigation, the relevant discovery request(s), and a reasonably specific description of the information requested; and

3. make the information requested available for inspection by the Non-Party.

(c) If the Non-Party fails to object or seek a protective order from this court within 15 business days of receiving the notice and accompanying information, the Receiving Party may produce the Non-Party's confidential information responsive to the discovery request. If the Non-Party timely seeks a protective order, the Receiving Party shall not produce any information in its possession or control that is subject to the confidentiality agreement with the Non-Party before a determination by the Court.[2] The 15 business day period may be extended by an additional 15 business days if notice is to be sent to a company outside the United States. Absent a court order to the contrary, the Non-Party shall bear the burden and expense of seeking protection in this court of its Protected Material.

[2] The purpose of this provision is to alert the interested parties to the existence of confidentiality rights of a Non-Party and to afford the Non-Party an opportunity to protect its confidentiality interests in this Court.

10. UNAUTHORIZED DISCLOSURE OF PROTECTED MATERIAL

If a Receiving Party learns that, by inadvertence or otherwise, it has disclosed Protected Material to any person or in any circumstance not authorized under this Stipulated Protective Order, the Receiving Party must immediately (a) notify in writing the Designating Party of the unauthorized disclosures, (b) use its best efforts to retrieve all unauthorized copies of the Protected Material, (c) inform the person or persons to whom unauthorized disclosures were made of all the terms of this Order, and (d) request such person or persons to execute the "Acknowledgment and Agreement to Be Bound" that is attached hereto as Exhibit A.

11. INADVERTENT PRODUCTION OF PRIVILEGED OR OTHERWISE PROTECTED MATERIAL

When a Producing Party gives notice to Receiving Parties that certain inadvertently produced material is subject to a claim of privilege or other protection, the obligations of the Receiving Parties are those set forth in Federal Rule of Civil Procedure 26(b)(5)(B). This provision is not intended to modify whatever procedure may be established in an e-discovery order that provides for production without prior privilege review. Pursuant to Federal Rule of Evidence 502(d) and (e), insofar as the parties reach an agreement on the effect of disclosure of a communication or information covered by the attorney-client privilege or work product protection, the parties may incorporate their agreement in the stipulated protective order submitted to the Court.

12. MISCELLANEOUS

12.1 Right to Further Relief. Nothing in this Order abridges the right of any person to seek its modification by the Court in the future.

12.2 Right to Assert Other Objections. By stipulating to the entry of this Protective Order, no Party waives any right it otherwise would have to object to disclosing or producing any information or item. Similarly, no Party waives any right to object on any ground to use in evidence of any of the material covered by this Protective Order. This Order shall not constitute a waiver of the right of any Party to claim in this action or otherwise that any Discovery Material, or any portion thereof, is privileged or otherwise non-discoverable, or is not admissible in evidence in this action or any other proceeding.

12.3 Filing Protected Material. Without written permission from the Designating Party or a court order secured after appropriate notice to all interested persons, a Party may not file in the public record in this action any Protected Material. A Party that seeks to file under seal any Protected Material must comply with the Local Rules and the Standing Order entered in this case. **Protected Material may only be filed under seal pursuant to a court order authorizing the sealing of the specific Protected Material at issue.**

12.4 Termination of Matter and Retention of Jurisdiction. The Parties agree that the terms of this Protective Order shall survive and remain in effect after the

Final Determination of the above-captioned matter. The Court shall retain jurisdiction after Final Determination of this matter to hear and resolve any disputes arising out of this Protective Order.

12.5 Successors. This Order shall be binding upon the Parties hereto, their attorneys, and their successors, executors, personal representatives, administrators, heirs, legal representatives, assigns, subsidiaries, divisions, employees, agents, retained consultants and experts, and any persons or organizations over which they have direct control.

12.6 Burdens of Proof. Notwithstanding anything to the contrary above, nothing in this Protective Order shall be construed to change the burdens of proof or legal standards applicable in disputes regarding whether particular Discovery Material is confidential, which level of confidentiality is appropriate, whether disclosure should be restricted, and if so, what restrictions should apply.

12.7 Modification by Court. This Order is subject to further court order based upon public policy or other considerations, and the Court may modify this Order *sua sponte* in the interests of justice. The United States District Court for the Central District of Illinois is responsible for the interpretation and enforcement of this Order. All disputes concerning Protected Material, however designated, produced under the protection of this Order shall be resolved by the United States District Court for the Central District of Illinois.

12.8 Discovery Rules Remain Unchanged. Nothing herein shall alter or change in any way the discovery provisions of the Federal Rules of Civil Procedure, the Local Rules for the United States District Court for the Central District of Illinois, or this Court's own orders. Identification of any individual pursuant to this Protective Order does not make that individual available for deposition or any other form of discovery outside of the restrictions and procedures of the Federal Rules of Civil Procedure, the Local Rules for the United States District Court for the Central District of Illinois, or the Court's own orders.

13. FINAL DISPOSITION

Within 60 days after the final disposition of this action, as defined in section 4, each Receiving Party must return all Protected Material to the Producing Party or destroy such material. As used in this subdivision, "all Protected Material" includes all copies, abstracts, compilations, summaries, and any other format reproducing or capturing any of the Protected Material. Whether the Protected Material is returned or destroyed, the Receiving Party must submit a written certification to the Producing Party (and, if not the same person or entity, to the Designating Party) by the 60-day deadline that (1) identifies (by bates-range or category, where appropriate) all the Protected Material that was returned or destroyed and (2) affirms that the Receiving Party has not retained any copies, abstracts, compilations, summaries or any other format reproducing or capturing any of the Protected Material. Notwithstanding this provision, Outside Counsel of Record

are entitled to retain an archival copy of all pleadings, motion papers, trial, deposition, and hearing transcripts, legal memoranda, correspondence, deposition and trial exhibits, expert reports, attorney work product, and consultant and expert work product, including exhibits to any of the foregoing, even if such materials contain Protected Material. Any such archival copies that contain or constitute Protected Material remain subject to this Protective Order as set forth in section 4.

14. COMPUTATION OF TIME

The computation of any period of time prescribed or allowed by this Order shall be governed by the provisions for computing time set forth in Federal Rule of Civil Procedure 6.

IT IS SO STIPULATED, THROUGH COUNSEL OF RECORD.

DATED this 1st day of May, 2020.

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Attorney for Defendants

**affixed by filing attorney with permission*

Entered: May 4, 2020

s/ Jonathan E. Hawley
JONATHAN E. HAWLEY
U.S. MAGISTRATE JUDGE

UNITED STATES DISTRICT COURT
FOR THE CENTRAL DISTRICT OF ILLINOIS
ROCK ISLAND DIVISION

DURASYSTEMS BARRIERS INC., a Canadian corporation, Plaintiff, vs. VAN-PACKER CO., an Illinois corporation, and JEREMIAS, INC., a Georgia corporation, Defendants.	**Case No. 1:19-cv-01388-SLD-JEH** **EXHIBIT A: UNDERTAKING EXPERTS OR CONSULTANTS REGARDING PROTECTIVE ORDER** District Judge Sara Darrow Magistrate Judge Jonathan E. Hawley

I, _____, acknowledge and declare that I have received a copy of the Protective Order ("Order") in *DuraSystems Barriers Inc. v. Van-Packer Co*. et al, CDIL-1:19-cv-01388-SLD-JEH. Having read and understood the terms of the Order, I agree to be bound by the terms of the Order and consent to the jurisdiction of said Court for the purpose of any proceeding to enforce the terms of the Order. I understand and acknowledge that failure to comply with the terms of the Order could expose me to sanctions and punishment in the nature of contempt, and I promise that I will not disclose in any manner any information or item that is subject to this Stipulated Protective Order to any person or entity except in strict compliance with the provisions of this Order.

Name of individual: _____

Present occupation/job description: _____

_____

_____

Name of Company or Firm: _____

Address: _____

I hereby submit to the jurisdiction of this Court for the purpose of enforcement of the Protective Order in this action.

I declare under penalty of perjury that the foregoing is true and correct.

Signature _____

Date _____