

**CITATION:** Cisco Systems Inc. v. N. Harris Computer Corporation, 2024 ONSC 3492  
**COURT FILE NO.:** CV-24-95423  
**DATE:** 2024 06 18

**SUPERIOR COURT OF JUSTICE - ONTARIO**  
**Application under s. 60 of the *Evidence Act*, RSO 1990, c. E.23 as amended**

**RE:** CISCO SYSTEMS, INC., Applicant

**AND:**

N. HARRIS COMPUTER CORPORATION, Respondent

**BEFORE:** C. MacLeod RSJ

**COUNSEL:** Nicole Boyle & Jeremy Want, for the Applicant

Timothy M. Lowman, for the Respondent

**HEARD:** June 4, 2024 in person

**DECISION AND REASONS**

**INTRODUCTION**

[1] Before this Court is an Application to enforce a Letter Rogatory or Letter of Request from the United States District Court for the Eastern District of Texas. The Request was authorized by the Honorable James Rodney Gilstrap, Chief United States District Court Judge of that District and signed and sealed by the requesting court on March 8, 2024.

[2] The U.S. Court is seized of a patent dispute between Video Solutions Pte. Ltd. (Video Solutions) as Plaintiff and Cisco Systems Inc. (Cisco) as Defendant. In support of its defences in the patent litigation, Cisco seeks production and discovery from N. Harris Computer Corporation (Harris). Harris is not a party to the U.S. litigation but may have relevant evidence. Harris is a corporation with its head office in Ontario. Harris resists the order for various reasons.

[3] Under the principle of comity, Canadian courts give deference to requests from foreign courts to assist in unearthing evidence. Canadian courts may make similar requests and it is important that such requests can be honoured.<sup>1</sup> A foreign request will be given full force and effect

---

<sup>1</sup> See Rule 34.07 (2) of the [Rules of Civil Procedure](#), RRO 1990, Reg 194, as amended which provides for the issuing of a Commission and Letter of Request in Ontario.

unless it is contrary to public policy to do so, or the request is otherwise prejudicial to the sovereignty or citizens of the jurisdiction to which the request has been directed.<sup>2</sup>

[4] Harris resists the order as burdensome and unnecessary. For the reasons that follow, I decline to make the order at this time, but this is without prejudice to the right of the Applicant to renew the Application with additional evidence.

## BACKGROUND

[5] As discussed above, the Applicant, Cisco is the Defendant in a complaint before the U.S. District Court brought by Video Solutions alleging patent infringement. Cisco is a U.S. Company headquartered in Delaware and Video Solutions is a company incorporated in Singapore. Video Solutions is the holder of certain U.S. patents related to visual collaboration and videoconferencing which it claims Cisco has breached.

[6] The patents in question were accepted and issued by the U.S. Patent and Trademark Office between 2013 and 2015. The individuals recognized as “inventors” of the processes covered by the patents were employed by Magor Communications Corporation (Magor) which was a Canadian technology company based in Ottawa. Magor was the original owner of the patent rights.

[7] In 2017, Magor was acquired by the Respondent, Harris which is a global software and services company also headquartered in Ottawa. Harris obtained ownership of the Magor patents in the 2017 purchase. Subsequently Harris assigned those patents to Video Solutions in 2022. Although Harris therefore held the patent rights between 2017 and 2022, it was not itself involved in the development of the inventions described and claimed in the patents, or in the registration of the U.S. patents. Harris does have ownership and control over any surviving records of Magor.

[8] In the pleadings in the U.S. action, Cisco denies it has infringed the patents in question but also denies the validity of the patents for failure to satisfy the conditions of patentability set forth in the *U.S. Patent Act*. (35 U.S.C). Cisco’s defences include “prior publication”, “prior art”, “prior disclosure”, “obviousness” and “lack of specificity”. Consequently, Cisco seeks information concerning these defences and whether Magor made, offered for sale or sold products embodying the asserted claims and when.

[9] The inventors named in the patent applications are Mojtaba Hosseini, Patrick White or David Brown. Those individuals are residents of Ontario and as noted above, at the time the patents were registered, these individuals were working for Magor. The Order obtained in Texas is for the production of documents and deposition of the inventors and of Harris (as the successor to Magor).

[10] The Letter of Request first came before this Court on May 15, 2024. At that time I granted Orders in relation to the inventors, Hosseini, White and Brown who did not contest the matter and

---

<sup>2</sup> See [Zingre v. The Queen et. al.](#), [1981] 2 SCR 392 (Supreme Court of Canada) @ page 401.

consented to be examined. At the request of counsel for Harris, insofar as it sought orders against the corporation, I adjourned the Application until June 4<sup>th</sup>.

[11] Harris filed responding material and resists the enforcement of the Letter of Request against the corporation. The Application therefore proceeded as a contested application in respect of Harris only.

[12] I note that neither party chose to cross-examine on the affidavits, or to examine witnesses, prior to the Application, although that step would have been available to them.<sup>3</sup>

## **EVIDENCE & ARGUMENTS**

[13] In support of the Application, Cisco filed an Affidavit of Sarah Mullins, a Senior Associate lawyer in the office of counsel for Cisco in the U.S. Action. That Affidavit sets out the basis for believing Harris has relevant information and why that information would be relevant to Cisco's defence. The Application also contains the Letter Rogatory to which is attached the pleadings in the U.S. action (Amended Complaint and Amended Answer), Protective Order, details of the proposed deponents and schedules of documents and areas of questioning in respect of each proposed deponent.

[14] As discussed above, the individual inventors did not resist the Application. Orders have been made for the three inventors to produce documents in the categories requested in the appropriate schedule in the Letter Rogatory and to submit to an oral deposition. Those depositions had been scheduled at the time this matter was argued but had not yet taken place.

[15] Schedules "A" and "B" to the Letter Rogatory are the schedules relating to Harris. In Schedule "A" there are comprehensive lists of categories of documents. Amongst other things, Harris is asked to produce "all documents" relating to the conception and reduction to practice of the "alleged inventions", documents sufficient to identify all persons who participated in the conception, reduction to practice or diligence, documents relating to the patent applications, and documents relating to income, profit margin and expenses for products using the patents. Similarly, in Schedule "B", there are 42 categories of questions to be covered during the deposition.

[16] In response to the Application, Harris has filed an Affidavit sworn by Adrienne Bouleris, its General Counsel (Utilities) based in Fairfax, Virginia. Ms. Bouleris deposes that upon the sale to Video Solutions in 2022, Harris provided Video Solutions with approximately 700 documents which Harris believes would be responsive to at least six of the categories of documents listed in Schedule "A". She further deposes that she has been advised by information from counsel for Video Solutions that 311 of those documents have been produced by Video Solutions in the U.S. action and that Video Solutions has claimed privilege over approximately 400 documents and withheld them from production. She also states that she was advised by counsel that Video

---

<sup>3</sup> See Rule 39.02 & 39.03 of the [Rules of Civil Procedure](#).

Solutions has not yet produced its privilege log in the U.S. action, but it is due by July 2 in accordance with a Docket Control Order in that action.

[17] Ms. Bouleris deposes that upon becoming aware of the Letter of Request, two senior Harris employees were tasked with searching for any other documents listed in Schedule “A” and also to determine whether anyone is still employed at Harris who could provide the evidence sought in Schedule “B”. Her Affidavit states that over 100 hours have been spent in the search of records and that no records other than the documents previously provided to Video Solutions in the categories those documents cover have been located. She provides detailed responses to other categories of documents indicating that Harris has no such documents or was not involved in the activities (such as sale of products) covered by those categories.

[18] Finally, with respect to inquiries relating to Magor records, source codes, software and other material which might be located on server archives, the affidavit states that if this material is retrievable, it would require outside third party assistance and expert involvement. There is no one still employed at Harris who could access earlier build versions of code or who could understand or interpret it. These materials are not stored anywhere that is currently accessible and would have to be restored from backups or otherwise retrieved by experts.

[19] Harris resists any order that it be required to undertake these costs or the time and burden of producing these records.

[20] On this Application, counsel for Harris also points out that the hearing in Texas was an unopposed hearing which was not made on notice to Harris. As such, she argues, there was no information before the U.S. District Court about whether the request would pose an unreasonable burden on a non-party to the litigation or what would be involved in responding to it.

[21] Counsel also argues that under Ontario law, as a non party to the litigation with no stake in the outcome, a production or discovery order under the *Rules of Civil Procedure* would be premature. Production from non parties under *Rule 30.10* or discovery of non parties under *Rule 31.10* are available only where the evidence is critical, it would be unfair to proceed without it and when it cannot reasonably be obtained through one of the parties to the litigation. Discovery in Ontario is also subject to considerations of proportionality and reasonableness including application of the *Sedona Canada Principles* in relation to electronic documents.<sup>4</sup>

## **ANALYSIS & DISCUSSION**

[22] Sovereignty and comity are important features of international law and in particular of the North American legal landscape. On the one hand courts of different states must protect their citizens from inappropriate intrusion by foreign courts but on the other international commerce and the international legal order could not function without some mechanism to obtain evidence

---

<sup>4</sup> [The Sedona Canada Principles](#), 3d Edition, 2022 CanLiiDocs 1167 I am aware that there are similar considerations under the U.S. Federal Rules but this point was not argued.

from other jurisdictions. The mechanism for this is a Letter Rogatory or Letter of Request where a court in one jurisdiction requests the assistance of another court to enforce a discovery or production order.

[23] In Ontario, in civil proceedings, Letters of Request from foreign courts are enforceable pursuant to s. 60 of the *Ontario Evidence Act*.<sup>5</sup> There is a virtually identical provision in s. 46 of the *Canada Evidence Act*.<sup>6</sup> Regardless of whether federal or provincial jurisdiction is engaged, the statutory test is the same and the jurisprudence is equally applicable.

[24] While comity is important and deference is due to the requesting court, this does not mean that Letters Rogatory will be blindly enforced. The Ontario Court of Appeal has listed six factors that must be considered as follows:

- (1) the evidence sought is relevant;
- (2) the evidence sought is necessary for trial and will be adduced at trial, if admissible;
- (3) the evidence is not otherwise obtainable;
- (4) the order sought is not contrary to public policy;
- (5) the documents sought are identified with reasonable specificity;
- (6) the order sought is not unduly burdensome, having in mind what the relevant witnesses would be required to do, and produce, were the action to be tried here.<sup>7</sup>

[25] Factors (1) and (2) are easily addressed. The U.S. District Court has already determined that the anticipated evidence meets the test of relevance and is required for the trial in Texas. Since Cisco's defence is in part dependent on attacking the validity of the patents, the requested categories of documents appear both important and relevant to those defences. That would be equally true in Ontario.

[26] Nor can it be said under factor (4) that it is contrary to public policy to order discovery and production from a non-party. While there are significant differences between the discovery regimes under the *Ontario Rules of Civil Procedure* or under the U.S. Federal rules, both production and discovery of non-parties are available under our rules in appropriate circumstances.<sup>8</sup> As mentioned earlier, Ontario Courts can issue Commissions and Letters of Request in similar circumstances. It is not necessary that discovery regimes be completely aligned.

---

<sup>5</sup> [Evidence Act](#), RSO 1990, c. E.23, as amended

<sup>6</sup> [Canada Evidence Act](#), RSC, 1985, c. C.5 as amended

<sup>7</sup> [Presbyterian Church of Sudan v. Rybiak](#), 2006 CanLII 32746 (ON CA) @ para. 20

<sup>8</sup> See the discussion in [Aker Biomarine AS et al. v. KGK Synergize Inc.](#) 2013 ONSC 4897 @ para. 26 - 32

[27] Factors (3) and (6) are engaged. Under Ontario practice, an order is appropriate against a non-party to the litigation only if the evidence cannot be obtained from one of the parties. In this case, Video Solutions was in a contractual relationship with Harris. Under Ontario practice, Video Solutions would be required to request evidence from Harris and only if Harris refused to provide it would the Court likely make an order for production or discovery directly against Harris.

[28] It is Harris' evidence that a large number of potentially relevant documents were provided to Video Solutions when the patents were assigned. Harris does not believe it has any other documents in those categories that were not provided to Video Solutions. If that is correct, then the documents should be produced by Video Solutions in the U.S. litigation, and it would not be necessary to obtain copies of the same documents from Harris.

[29] There is a second problem with ordering Harris to turn over documents it says were provided to Video Solutions. That is the conundrum that may arise if this Court orders Harris to produce documents to Cisco over which Video Solutions claims privilege. Video Solutions was not a party to the Application and therefore did not have counsel present to speak to the matter. If this situation was anticipated, and if (as Harris contends) Video Solutions will be claiming privilege over more than half of the documents delivered to it by Harris, it is odd that Video Solutions chose not to oppose the Order made in Texas. It seems to me that the assertion made by Harris should be addressed in Texas and the question of privilege resolved before such an order is made here.

[30] Accordingly, in respect of the documents Harris deposes it provided to Video Solutions, it is premature to order Harris to produce copies of those documents to Cisco in Ontario. Counsel should seek further clarification from the U.S. District Court once the privilege logs have been delivered.

[31] With respect to other evidence in other categories, this Court has already made an Order for disclosure and discovery against the individual inventors. It is possible that the inventors will have records or will provide answers which provide the information that Cisco is seeking. Alternatively, the inventors may provide evidence that will demonstrate how critical the Magor records are.

[32] I would certainly not order Harris who, as discussed earlier, is not a party to the litigation and has no obvious stake in the outcome, to incur the cost necessary to retain a third-party expert to access legacy records of Magor. Should that be necessary, I would require Cisco to underwrite the cost of retaining an expert with the appropriate technical skills or technological tools needed to extract that data.

[33] It is not obvious to me on the material before me that computer source code originally held by Magor is relevant or probative. This is not, for example, a computer program copyright case in which it is alleged a competitor made use of a sub-routine by copying source code. These patents are patents of protocols, processes, and methods reflected in descriptions such as "adjustment of bit rate output" using the "datagram congestion control protocol" or a "method of managing the flow of time sensitive data over packet networks", "low latency high resolution video

encoding” or “videoconferencing providing virtual physical contact”. In Ontario, before the Court would make an order requiring a non party to submit to expert analysis and extraction of legacy data not currently accessible, the Court would require specific evidence from an expert as to why the data is essential, what would be involved in extracting it, what safeguards would be in place, and the cost.

[34] The sixth of the *Sedona Canada Principles* reads as follows: “A party should not be required, absent agreement or a court order based on demonstrated need and relevance, to search for or collect deleted or residual electronically stored information that has been deleted in the ordinary course of business or within the framework of a reasonable information governance structure.”<sup>9</sup> When dealing with legacy records of a non-party, not only will “need” and “relevance” have to be addressed but also proportionality and cost.

[35] In my view, given the various factors discussed above and the evidence provided by Harris in response to the Application, it is premature to make the requested order at this time. I am of the view that at least the following steps should be undertaken before considering an order that may intrude upon and disrupt a bystander to the U.S. litigation.

- a. Cisco should obtain production from Video Solutions in the U.S. and determine whether the documents it seeks from Harris are in the possession of Video Solutions.
- b. If Video Solutions is claiming privilege over documents it received from Harris, that issue should also be resolved before Harris is asked to produce privileged documents in Ontario.
- c. Examination of the “inventors” should be completed to determine what evidence they may provide and whether they have access to any of the requested documents.
- d. To the extent that it is still necessary to seek production of Magor legacy documents, records, computer code or other documents in the possession or control of Harris, it will be necessary for Cisco to propose an independent expert and to determine the cost of the inquiry, amongst other factors.

## CONCLUSION

[36] In light of the evidence produced by Harris in response to this Application and of the factors discussed above, I decline to make an order to enforce the Letter Rogatory against Harris at this time.

[37] I will order Harris to preserve the Magor legacy records. Further, should it be necessary for Cisco to renew the Application, Harris will be directed to provide any necessary information

---

<sup>9</sup> See note 4 above

to a consultant or expert in order for the expert to determine the scope and cost of accessing or restoring those records.

[38] Although there will not be an order for enforcement at this time, this decision is without prejudice to Cisco returning the Application at a later date with supplementary evidence.

### **COSTS**

[39] I invite counsel to agree on the costs of the Application.

[40] If they are unable to reach agreement, and either party seeks costs, they may make arrangements within the next 30 days to speak to the matter.

---

Justice C. MacLeod

**Date:** June 18, 2024



**CITATION:** *Cisco Systems Inc. v. N. Harris Computer Corporation*, 2024 ONSC 3492

**COURT FILE NO.:** CV-24-95423

**DATE:** 2024 06 18

**ONTARIO**

**SUPERIOR COURT OF JUSTICE**

**Application under s. 60 of the *Evidence Act*, RSO 1990, c. E.23 as amended**

**RE:** CISCO SYSTEMS, INC.

Applicant

**-and-**

N. HARRIS COMPUTER CORPORATION,

Respondent

**BEFORE:** Regional Senior Justice Calum MacLeod

**COUNSEL:** Nicole Boyle & Jeremy Want,  
for the Applicant

Timothy M. Lowman, for the Respondent

---

**DECISION AND REASONS**

---

Regional Senior Justice C. MacLeod

**Released: June 18, 2024**