

## PRACTICE

Motion for protective order by defendant — Underlying issue patent infringement action against defendant — Parties agreeing on terms for protective order in anticipation of discovery process — Both parties arguing same side of debate — No one arguing against motion — Issue whether motion should be granted — Legal test for issuance of protective order found in *Sierra Club of Canada v. Canada (Minister of Finance)*, 2002 SCC 41, [2002] 2 S.C.R. 522 — Supreme Court of Canada at paragraph 53 therein stating that confidentiality order granted (1) to prevent serious risk to important interest, (2) when salutary effects of confidentiality order outweighing its deleterious effects — Request for protective order should be considered using same criteria as set out in paragraph 53 and following of *Sierra Club* for confidentiality order — Whether requested order necessary because reasonably alternative measures not preventing risk to parties' interest in confidential information — Whether parties' interests in their confidential information adequately protected by express undertaking to Court supplementing implied undertaking — Parties raising number of concerns with reliance on protective agreement as alternative to protective order — No reason for concern that Court could not enforce agreement between parties regarding control of its own process — Breach of express undertaking to Court not less enforceable by contempt proceedings than breach of implied undertaking which it supplements — Third parties subject to implied undertaking rule — Protective agreement protecting parties' confidential information as adequately as protective order — Gaps in implied undertaking rule can be filled by terms of protective agreement — Amending protective agreement no more difficult than amending protective order — Implied undertaking rule, as supplemented by protective agreement, providing protection for parties' confidential information equal to that provided by protective order — Court expressing concern that continued routine issuance of protective orders in circumstances similar to present case risking perpetuation of some parties' misunderstanding of their obligations in respect of discovery material — Test provided by Supreme Court in *Sierra Club* applicable, binding on Court — Test not met herein — Law relating to implied undertaking rule has evolved over time such that earlier uncertainty no longer a concern — Reasonable alternative measure of protective agreement protecting parties' confidential information as well as requested protective order — Not necessary to consider second part of *Sierra Club* test — Motion dismissed.

CANADIAN NATIONAL RAILWAY COMPANY V. BNSF RAILWAY COMPANY (T-913-17, 2019 FC 281, Locke J., order dated March 7, 2019, 19 pp.)