Date: 20081024

Docket: T-1524-07

Citation: 2008 FC 1195

Ottawa, Ontario, October 24, 2008

PRESENT: Madam Prothonotary Roza Aronovitch

BETWEEN:

LOTECH MEDICAL SYSTEMS LIMITED

Plaintiff

and

KINETIC CONCEPT, INC.,
KCI LICENSING, INC., and KCI MEDICAL CANADA, INC.

Defendants

REASONS FOR ORDER AND ORDER

[1] At issue in this motion is the application of the "bright line rule" to disqualify a law firm that finds itself in a position of conflict as a result of concurrently representing clients on both sides of the underlying action. The defendants, collectively "KCI", are requesting that the firm of Cassan Maclean (CM) be removed as solicitors of record for the plaintiff as they also represent, albeit in respect of unrelated matters, KCI Licensing Inc. (KCI Licensing), one of the defendants in this action.

[2] For the reasons that follow I will grant the motion. I find that the bright line rule is applicable in the present case and requires that Cassan Maclean be removed as solicitors of record.

The Facts

[3] The defendants are related companies. Their evidence on this motion is by way of the affidavit of Nadeem G. Bridi (Bridi), Associate General Counsel of the parent company, Kinetic Concepts Inc. Bridi is one of the in-house counsel responsible for this action on behalf of the defendants collectively.

[4] The plaintiff, for its part, relies on the affidavit of Bryan Weissenboeck (Weissenboeck), a junior associate at Cassan Maclean. KCI has objected to Weissenboeck's evidence as being in violation of Rule 82 of the *Federal Courts Rules* and constituting inadmissible hearsay evidence. I will deal with these objections below.

[5] I begin with the following facts that are undisputed and set the background for the motion. The plaintiff, LoTech Medical Systems Limited (LoTech) and KCI Licensing are current clients of Cassan Maclean. LoTech's relationship with the firm began in approximately 1997. KCI Licensing's relationship with Cassan Maclean is more recent, dating from 2001. Until the

commencement of the underlying litigation, Cassan Maclean has acted as patent agents for both clients.

[6] LoTech commenced this action on August 17, 2007, alleging that the defendants have infringed Canadian Patent No. 2,197,434 (‘434) that relates to a cushioning device for seats or matresses. The statement of claim was filed on behalf of the plaintiff LoTech by its solicitor, Lynn S. Cassan, of Cassan Maclean, and served on KCI on September 26, 2007.

[7] On November 21, 2007, before KCI had filed its statement of defence, the parties entered into settlement discussions in which Cassan Maclean was not involved. The parties agreed that the defendants would not file statements of defence while the settlement talk were ongoing.

[8] Bridi’s evidence is that he became aware of the fact that KCI Licensing was a client of Cassan Maclean during the settlement discussions. The discussions concluded without result, and thereafter in February 2008, Bridi instructed counsel for KCI to advise the plaintiff of the conflict. On March 4, 2008, defendants’ counsel wrote to Cassan Maclean to raise the issue of conflict and require that LoTech retain new counsel to prosecute this action.

[9] The plaintiff did not respond to the invitation. The issue was raised again during status review, which resulted in the action being continued as a specially managed proceeding with a direction to the defendants to file the present motion.

[10] In addition to a number of patents referred to in the letter of March 4, Cassan Maclean is also currently agent of record for the defendant KCI Licensing in connection with two other Canadian patent applications and were, until January 2008, agent of record on a third patent application, the ‘724. There is no dispute that Cassan Maclean’s work on the above referenced patent applications was ongoing at the time that this action was commenced and, save for the ‘724 application, remains ongoing.

[11] Bridi says that Cassan Maclean did not seek KCI Licensing’s consent to act for the plaintiff in this suit, and that, in any event, the defendant would not have consented to have the firm act against it. Notwithstanding the fact that Cassan Maclean is representing the plaintiff, the defendant maintains that it has found Cassan Maclean to be capable counsel. Having retained the firm since 2001, for intellectual property matters, and in light of the law firm’s acquaintance with its intellectual property business, KCI Licensing maintains that it should not now be put to the cost and inconvenience of retaining new counsel for its patent applications.

[12] The defendants deny the statements made by the plaintiff in its submissions on status review to the effect that the defendants have made a "calculated effort" to create a conflict of interest in order to serve their advantage in this case by "tying up" the field of experienced patent firms.

[13] Bridi explains that due to the innovative nature of its businesses, KCI is the owner, or applicant of approximately forty Canadian trademarks and forty five Canadian patents. At various points since 1987, KCI has employed twelve law firms in Canada in respect of its intellectual property matters.

[14] KCI points out that LoTech itself has used four firms for the prosecution and maintenance of the '434 patent, and that Stephen Gates (Gates), LoTech's principal, has previously used different counsel in litigation against KCI involving the very patent at issue in this proceeding. According to the defendants, Gates has once before "chosen" to be represented by counsel also representing KCI. Gates had retained Ridout & Maybee LLP, who also act for KCI, and had voluntarily removed themselves from the record when the conflict was brought to their attention.

[15] For the plaintiff, the Weissenboeck affidavit includes, as an attachment, a letter from Gates, dated June 18, 2008, addressed to Lynn Cassan. In essence, the letter expresses LoTech's objections to having Cassan Maclean removed from the file. There are three paragraphs in Weissenboeck's affidavit that essentially relate the contents of the Gates letter. They go to Gates'

longstanding relationship with Cassan Maclean, refer to Gates' complaint that KCI is tying up most of Ottawa's firms that do patent litigations thereby limiting his ability to have competent patent counsel, and express Gates' appreciation for being represented by Cassan Maclean, whom he is said to find efficient and reasonable in its fees compared with larger firms.

[16] In addition, Weissenboeck attests to searches that he conducted that indicate that the three defendants together have a total of fifty three published Canadian applications or patents. He names the eleven different firms that are retained by the defendants as agents of record for the fifty three published applications.

[17] Having reviewed the files, Weissenboeck describes the precise work performed by CM for KCI Licensing on its outstanding patent applications. He makes the point that the work done by his firm for KCI Licensing has been "overstated" by the defendants, and that, in any event, the work to date has been in respect of technologies unrelated to LoTech's patent at issue in this proceeding. He further states that he has found no document or correspondence from Kinetic Concepts, or its related companies, that include confidential information that could be relevant to the plaintiff's action against KCI.

[18] Finally, Weissenboeck recounts that, pursuant to the instructions of the defendants' in-house patent department, one of KCI Licensing's patents was transferred from CM to the firm of Borden

Ladner Gervais LLP (BLG) on 25 January 2008. Weissenboeck says that Cassan Maclean assumed that KCI Licensing's three other related divisional applications would also be transferred to BLG. Based on his experience, and the information he obtained while working in the area of patent law, Weissenboeck believes that it would be more prudent from a prosecution standpoint for the four related files to be handled together since they contain closely related subject matter. He notes however that KCI did not transfer the work to BLG, as expected.

Admissibility and Weight to be Given to Weissenboeck Affidavit

[19] The defendants challenge the plaintiff's evidence as improper and in violation of Rule 82 of the *Federal Courts Rules*. The Rule provides that, without leave of the Court, a solicitor[1] may not depose to an affidavit and at the same time present argument to the Court based on that affidavit.

[20] KCI contends that the entire affidavit should be disregarded and given no weight. In the alternative, the Court is requested to disregard as inadmissible hearsay evidence, those paragraphs that make reference to the Gates letter, as well as Weissenboeck's considered opinion as to what is current or common practice in the area of patent prosecutions.

[21] The plaintiff, for its part, makes the following points. The evidence proffered by the junior associate is not contentious and does not go to the heart of the motion. In substance, the evidence

goes to show that the work done by Cassan Maclean for KCI Licensing is in respect of unrelated patent applications. Weissenboeck's evidence is proper and necessary in that regard, as only counsel at the firm is able to review and provide a first hand account of the work performed by the firm in the various files.

[22] Ms. Cassan, on behalf of the plaintiff, accepts that it would have been preferable for Gates to swear an affidavit and make himself available for cross-examination in Canada. She argues however, that the Court ought to take into consideration that, in so doing, LoTech would have had to incur significant costs and that such costs are material for a "small entity" such as the plaintiff.

[23] In *Cross-Canada Auto Body Supply (Windsor) Ltd. v. Hyundai Auto Canada*, 2006 FCA 133, (*Hyundai*) Justice Sexton of the Federal Court of the Appeal, in construing Rule 82 observed at paragraph 4:

> There can be no hard and fast rule, but it does seem to us that it is not good practice for a law firm to cause its employees to act as investigators for the purpose of having them later give opinion evidence on the most crucial issues in the case. This is especially true where, as in this case, there is no evidence from any non-employee of the firm on these crucial issues…..

[24] The admonition of the Federal Court of Appeal that affidavits by solicitors are "not good practice," in my view, takes on heightened significance in the context of a motion to remove

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[1] Interpreted to include the solicitor's law firm: See *Cross-Canada Auto Body Supply (Windsor) Limited v. Hyundai Auto Canada*, 2005 FCA 1254 at para. 13 (per von Finkenstein J.); *Bojangles' International, LLC v. Bojangles Café Ltd.*, 2005 FC 272 at para. 10

counsel on account of conflict. The fact that only a lawyer of the firm that is sought to be removed would have personal knowledge of the work done by the firm on behalf of a client is among the reasons that such motions are ordinarily, and I would suggest appropriately, argued by independent counsel.

[25] Weissenboeck's evidence that purports to convey Gates' views as expressed in his letter to Ms. Cassan, is clearly hearsay evidence. There is no evidence or proper explanation as to why the best evidence, that of Gates himself, was not available. Weissenboeck's evidence is prejudicial as no meaningful cross-examination can be had on it. It is therefore inadmissible, and will be given no weight in support of the plaintiff's submissions.

[26] As to Weissenboeck's opinion regarding the conduct of patent prosecutions, he has admitted on cross-examination to having limited experience in the field, and to having based his views regarding the transfer of patent applications on information provided to him as to what is common practice. This evidence, as well, is entitled to no weight.

[27] There are other elements of Weissenboeck's evidence that are not controversial and do not go to the heart of the dispute. I see no reason, therefore, to reject the entire affidavit. Other facts, such as the number of firms retained by the defendants, the nature of work done by the firm on

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(per Hargrave, Proth.).

behalf of KCI, or that it is in respect of unrelated matters, are either not disputed or, in my view, inconsequential.

The Position of the Parties

[28] It is uncontested that Cassan Maclean, at all relevant times, has represented both the plaintiff and the defendant KCI Licensing, and continues to do so. It is also common ground between the parties that this case does not involve or raise any concern regarding the possession or use of confidential information.

[29] These facts take the matter outside the factual context considered by the Court in *MacDonald Estate v. Martin*, [1990] 3 S.C.R. 1235 (*MacDonald Estate*) and bring it squarely within the principles enunciated in the more recent decision of the Supreme Court in *R. v. Neil*, 2002 SCC 70, [2002] 3 S.C.R. 631 (*Neil*). Indeed it is the defendants' position that this case falls to be decided wholly by the application of the "bright line" test enunciated by Justice Binnie in *Neil*. They rely as well on Rule 2.054 of the *Ontario Rules of Professional Conduct* to say that Cassan Maclean must be removed.

[30] LoTech, for its part, sees this motion as strategic on the part of the defendants, and as essentially having to do with litigation funding in cases, such as the present instance, where parties are of unequal means. LoTech argues that the facts do not disclose a conflict of interest

per se, that the work of CM on the unrelated pending patent application does not give rise to a "full meaningful relationship," and that the "bright line" rule being asserted by the defendants does not contemplate patent agency work.

[31] The latter contention, in essence, is that a large company such as KCI may have dozens or more patent applications that may be handled by numerous firms that do patent agency and patent law. If the Court were to strictly apply the bright line rule in such cases it would open the door for large companies to retain a multiplicity of patent firms over the course of the years, essentially tying up the field to the detriment of small entities that would thereby see their choice of counsel severely restricted.

[32] Ms. Cassan says that she does not advocate that Cassan Maclean should be able to act for both clients. However, to secure a just outcome, she urges that the Court ought not to apply the bright line rule rigidly, without first engaging in a balancing of the parties' interests. She places on one side of the balance the fact that the plaintiff, the party who can least afford it, stands to be denied his choice of counsel that he has relied upon for the past 10 years with the attendant costs and hardship of finding new counsel, and on the other side, the defendants who, with ease and minimal cost, can transfer their work to one of their other counsel, as they have already done in January of this year.

The Applicable Law

[33] It is settled law that the Courts play an important supervisory function in ensuring that lawyers avoid conflicts of interest. In *MacDonald Estate*, Justice Sopkina confirmed the inherent jurisdiction of the Courts to remove solicitors who have such a conflict from the record. Their jurisdiction stems from the fact that lawyers are officers of the Court and their conduct which may affect the administration of justice is subject to this supervisory jurisdiction.[2] The Court pointed out in the same case that while not bound by ethical rules set by the provincial bar associations, Courts may look to such sources for guidance in determining the proper standards of conduct for lawyers.[3]

[34] Rule 2.04 of the Ontario *Rules of Professional Conduct* (*Rules of Conduct*) under the heading "Avoidance of Conflicts of Interest", states in relevant part that:

> …
>
> (2) A lawyer shall not advise or represent more than one side of a dispute.
>
> (3) A lawyer shall not act or continue to act in a matter when there is or is likely to be a conflicting interest unless, after disclosure adequate to make an informed decision, the client or prospective client consents.

[35] Rule 2.09(7) of the *Rules of Conduct* provides that a lawyer must withdraw if it becomes clear that the lawyer's continued employment will lead to a breach of the *Rules of Conduct*.

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[2] *MacDonald Estate*, at 1245-46.
[3] *Ibid.*

[36] The scope of a solicitor's obligations in the present circumstances, that is, to an existing client, is fully canvassed in *Neil*. The duty of loyalty to a current client is said to comprise dedication to the client's case, avoidance of conflict, candour and good faith. It is described as essential to maintaining the litigant's as well as the public's confidence in the integrity of the administration of justice. The litigant must be assured of his lawyer's "undivided loyalty" leaving "no room for doubt" as to counsel's full dedication to the client's case.[4]

[37] In most cases of conflict, Courts are asked to intervene on behalf of a *former* client, where the possession and use of confidential information is at issue. This case concerns mandates from current clients. The duty of loyalty to a *current* client is more comprehensive and "includes a much broader principle of avoidance of conflict of interest, in which confidential information may or may not play a role."[5]

[38] Lord Millet, quoted with approbation in *Neil*, points out that the disqualification of counsel serving current clients that are adverse in interest is due solely to the conflict inherent in the situation, having nothing to do with confidential information:

> …a fiduciary cannot act at the same time for and against the same client and the firm is in no better position. A man cannot without the consent of both clients act for one client while his partner is acting for another in the opposite interest. His disqualification has nothing to do with the

[4] *Neil*, at para 12.
[5] *Ibid.* at para. 17.

> confidentiality of client information. It is based on the inescapable conflict of interest which is inherent in the situation. [6]

[39] *Neil* recognizes that such a broad and "general" prohibition is undoubtedly a major inconvenience, especially for large, national firms with proliferating offices. However, Justice Binnie concludes that the bright line is nevertheless required, even when, as in this case, the mandates of the two clients are unrelated:

> The bright line is provided by the general rule that a lawyer may not represent one client whose interests are directly adverse to the immediate interests of another current client -- *even if the two mandates are unrelated* -- unless both clients consent after receiving full disclosure (and preferably independent legal advice), and the lawyer reasonably believes that he or she is able to represent each client without adversely affecting the other.[7] (emphasis original)

[40] Subsequent applications of *Neil* have found that the nature or level of the work performed by a solicitor for a client does not mitigate the bright line rule. In *First Property Holdings Inc. v. Beatty* (2003), 66 O.R. (3d) 97 (*First Property*), a law firm was acting for the plaintiff in an action, at the same time that it was performing filing work with the Ontario Securities Commission on behalf of a defendant in the same action. In granting an order to remove counsel, the Court noted at paragraph 12:

> Should there be different classes of clients, with differing obligations and duties dependent upon the nature of the tasks performed, and advice given? I think not. A current client of a law firm, even a client for whom mechanical tasks are performed is entitled to a duty of loyalty…

The Court went on to hold at paragraph 17:

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[6] *Bolkiah v. KPMG*, [1999] 2 A.C. 222 at 234-35, cited in *Neil*, at para. 27.
[7] *Neil*, at para. 29.

> The bright line test discourages nuances when a conflict of interest is in issue between an existing client of the firm and another client. Once there is a finding that there is a current solicitor-client relationship, the "bright line test" applies to avoid uncertainty and shades of grey.

Analysis and Conclusion

[41] The plaintiff relies on *MacDonald Estate* and *Riberio v. Vancouver (City)* 2002 BCCA 678, (2002) B.C.L.R. (4th) 207 (*Riberio*) to support the argument that there can be a balancing of interests in the application if the “bright line” test that would allow Cassan Maclean to remain as counsel for the plaintiff.

[42] As relates to the balancing of interests, the distinction between the Supreme Court’s approach in *MacDonald Estate* and *Neil* was addressed by Justice Binnie in *Strother v. 3464920 Canada Inc.*, 2007 SCC 24, [2007] 2 S.C.R. 177 (*Strother*) at paragraph 51:

> This is not to say that in *Neil* the Court advocated the resolution of conflict issues on a case-by-case basis through a general balancing of interests, the outcome of which would be difficult to predict in advance. Once arrived at, however, the *MacDonald Estate v. Martin* rule protecting against disclosure of confidential information is applied as a "bright line" rule. The client's right to confidentiality trumps the lawyer's desire for mobility. So it is with *Neil*. **The "bright line" rule is the product of the balancing of interests not the gateway to further internal balancing.** (emphasis mine)

[43] To similar effect, in *First Property*, following its examination of the principles enunciated in *Neil*, and the *Rules of Conduct*, the Court concluded that the bright line applies in

the case of existing, or current clients, and that the balancing approach applies in the case of former clients.[8]

[44] The British Columbia Court of Appeal, in *Ribiero* does apply *MacDonald Estates* and engages in a balancing of interests in a case that, at one point, concerns concurrent retainers from adverse clients. The Court acknowledges in that case that *Neil* was only brought to its attention following the hearing. The case was distinguished on its facts and the principals in *Neil* were accordingly found to have no application. In the present circumstances, it is *Ribiero* that must be distinguished.

[45] There are a number of bases for so doing. At issue in that case were the *British Columbia Rules of Conduct* that allow concurrent mandates from opposing clients where the service provided to the clients is in respect of unrelated matters. Unlike the present circumstances, it would appear that the possession and use of confidential information was at issue in that case. Moreover, the facts in *Ribiero* may well come within an exception identified by Justice Binnie in *Neil*:

> In exceptional cases, consent of the client may be inferred. For example, governments generally accept that private practitioners who do their civil or criminal work will act against them in unrelated matters…[9]

[8] *First Property* at para. 36.
[9] *Neil* at para. 37.

[46] In this case, I find no reason to derogate from the strict application of the bright line rule to disqualify Cassan Maclean from acting for the plaintiff. Indeed, the plaintiff's own construal of the question to be determined by this Court underscores the necessity for the unequivocal application of the bright line in the circumstances. The issue for the plaintiff is as to how to apply the bright line prohibition given that in the result, one of the clients "has to go". LoTech maintains that it would be just and would present no difficulty or real cost to the defendants for this Court "to require" the defendants to complete or transfer or all of their patent applications to their other firms.

[47] It is not for the Court to direct, or choose among its clients, in order to enable Cassan Maclean to avoid its duty of loyalty or the consequences of its breach of that duty. The Court is in no better position than the firm, in that regard, as the firm's duty of loyalty is owed to both clients (see *Toddglen Construction Ltd. v. Concord Adex Developments Corp.* (2004), 34 C.L.R. (3d) 111).

[48] Cassan Maclean can also not invoke in its favour the prejudice that may have been caused to its plaintiff client. The firm has the responsibility to take the required measures to identify and avoid conflicts. The costs and inconvenience of recommencing the litigation with new counsel could have been avoided had counsel taken the minimally necessary step of conducting a conflict search before accepting the plaintiff's mandate to commence the litigation. The evidence is clear that it did not do so. This is not a case that calls for the balancing of interests. There is a clear prohibition to advising or representing both sides of a dispute.

Cassan Maclean simply could not accept a mandate from one client to sue another, existing client without adequate disclosure and consent. Having done nothing to avoid the conflict, and later having failed to recuse itself when the conflict was brought to its attention, Cassan Maclean's conduct calls to be sanctioned by the strict application of the bright line.

[49] I would add that if it were appropriate in the circumstances to consider the balance of interests, I would, in any case, have no basis to assert the interests of one client over the other, as neither wishes to be denied its choice of Cassan Maclean as counsel.

Use of the motion as a Tactical Ploy/Delay

[50] The plaintiff argues that the defendants' practice in retaining counsel is for tactical advantage, and has suggested that the defendants' delay in raising the conflict should bar any relief to the defendants. I say suggest, because the defendants' delay in raising the conflict, though raised in the Weissenboeck affidavit, and in the plaintiff's submissions on status review, was not pursued at the hearing of the motion.

[51] The Supreme Court in both *Neil*, and *Strother* cautioned against the use of motions to disqualify counsel for tactical purposes or advantage:

> These competing interests are really aspects of protecting the integrity of the legal system. If a litigant could achieve an undeserved tactical advantage over the opposing party by bringing a disqualification motion or seeking other "ethical" relief using "the integrity of the administration of justice" merely as a flag of convenience, fairness of the process would be undermined.[10]

[52] In the circumstances, there is nothing nefarious in the defendants' hiring of multiple intellectual property firms to represent them, and no basis to find that it is done for an improper purpose. There is equally no reason to accept the defendants' view that the plaintiff is wilfully choosing firms to represent it that are in conflict. Both the plaintiff and the defendants have utilized a variety of counsel in pursuing their intellectual property interests. Moreover, Weissenboeck admits on cross-examination that LoTech continues to have a number of intellectual property firms to choose from. There are no other grounds to suggest that the defendants are using conflict as a ploy. The plaintiff's charge that defendants are raising conflict to delay the prosecution of this proceeding, can equally be levelled at CM for not taking the appropriate measurers to prevent the conflict, or to resolve it.

[53] I turn to the defendants' delay in raising the conflict to the attention of Cassan Maclean or in bringing the motion to disqualify the firm from acting for the plaintiff in this action. The defendants were served with the statement of claim in the underlying action in September 2007, discovered the conflict during the course of settlement talks that were pursued between November 2007 and February 2008, but waited to raise the conflict until March 2008. I accept the explanation of the

defendants that the matter was raised at the earliest possible stage of the litigation, that is, before further steps had to be taken but in a manner to allow the settlement discussion to conclude.

[54] While delay in raising the issue of conflict cannot be condoned and may, in certain cases, amount to an implied consent, or to a waiver of a party's rights in respect of the conflict,[11] nothing of the sort is alleged by the plaintiff. Here, the length of the delay was not inordinate and was satisfactorily explained. More importantly, there is no assertion of mischief or prejudice to the plaintiff as a result.

ORDER

THIS COURT ORDERS that

1. Cassan Maclean LLP is disqualified from acting as counsel for the plaintiff, LoTech and is hereby removed as counsel of record.

2. Costs of this motion shall be payable by the plaintiff to the defendants.

3. The plaintiff shall appoint new counsel of record on or before **December 12, 2008**.

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[10] *Neil* at para 14. See also *Strother* at para. 36.

4. New counsel acting for the plaintiff shall file a timetable for further steps in this proceeding, on consent, if any, by **December 21, 2008**.

"R. Aronovitch"
Prothonotary

[11] See *Dobbin v. Acrohelipro Global Services Inc.*, 2005 NLCA 22, (2005), 246 Nfld. & P.E.I.R. 177; *Saskatchewan River Bungalows Ltd. v. Maritime Life Assurance Co.*, [1994] 2 S.C.R. 490

FEDERAL COURT

SOLICITORS OF RECORD

DOCKET:	T-1524-07
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DATED:	

APPEARANCES:

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Peter Wilcox	FOR THE DEFENDANT

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