

BEFORE THE WASHINGTON UTILITIES AND TRANSPORTATION COMMISSION

SANDRA JUDD, et al.,

Complainants,

v.

AT&T COMMUNICATIONS OF THE
PACIFIC NORTHWEST, INC.; and
T-NETIX, INC.,

Respondents.

DOCKET NO. UT-042022

**COMPLAINANTS' SURREPLY TO
AT&T'S REPLY IN SUPPORT OF
OBJECTION TO DESIGNATION
OF EXPERT**

How Complainants Intend to Use Mr. Wilson and Topics to be Addressed by Him

1. Mr. Wilson will assist Complainants and the Commission in resolving the questions referred to it by the trial court: (1) Were AT&T and/or T-Netix operator service providers (OSPs) for Washington correctional facilities? If so, did either entity violate regulations requiring disclosure of rate information to consumers?

2. Mr. Wilson will review documents and responses to data requests from T-Netix and AT&T; help counsel prepare for depositions, review deposition transcripts; ascertain relevant facts; develop opinions based on those facts and the questions referred; serve, if appropriate, as a testifying expert; and assist counsel in preparing for any hearings.

3. Although we are at a relatively early stage of this proceeding, and Mr. Wilson has been unable to review the majority of documents produced so far, he has

identified a number of questions and specific types of information that he believes would assist the Commission in resolving this matter. Supp. Wilson Decl., ¶¶ 2-4, 12. This description, along with Mr. Wilson's factual narrative regarding his experience with AT&T and his access, or lack thereof, to relevant confidential information, should put the Commission in a good position to determine whether AT&T's interests are truly compromised here.

**The Question Before the Commission Should Be Confined
to the Issue Raised by AT&T in its Objection**

4. AT&T's initial objection to Mr. Wilson was limited to his designation "as an outside expert who may review Confidential or Highly Confidential Information." Exh. A to Complainants' Response. It has improperly sought to expand that objection by seeking to completely exclude Mr. Wilson from this proceeding.

5. The issue should be confined to the one raised by AT&T and recognized by the Protective Order. Under that Order, the question is whether Mr. Wilson's access to designated confidential information presents a risk of competitive injury to AT&T. *See* Order, ¶ 1.d.; ¶ 6.

6. To date, AT&T has not shown, in any concrete way, how it would suffer competitive harm as a result of Mr. Wilson's participation in this matter. Mr. Wilson has agreed to be bound by the terms of the Order. This case is no different, from the standpoint of competitive injury, than any other case before the Commission. If anything, it is less threatening, as no party is a competitor with AT&T. For that

reason, and because AT&T should not be permitted to improperly expand the issue it raised, AT&T's objection should be denied.

7. The remainder of this brief is relevant only if the Commission reaches the question of whether Mr. Wilson should be disqualified outright, a question neither contemplated by the Protective Order nor properly raised by AT&T.

Before Considering the Drastic Sanction of Disqualification, the Law Requires AT&T to Show That Mr. Wilson Retains Relevant AT&T Confidential Information That Will Necessarily Be Used in this Proceeding

8. Disqualification of an expert is "a drastic measure that courts should impose only hesitantly, reluctantly, and rarely." *Hewlett-Packard Co. v. EMC Corp.*, 330 F. Supp. 2d 1087, 1092 (N.D. Cal. 2004). There is no per se rule that precludes a party from retaining an expert who has either worked for or previously served as an expert for the party's opponent. Nor is there any per se rule that requires disqualification of an expert who has signed a non-disclosure agreement with the objecting party. See *Greene, Tweed of Delaware, Inc. v. Dupont Down Elastomers, LLC*, 202 F.R.D. 426, 429 (E.D. Pa. 2001). The existence of a non-disclosure agreement does not create a presumption that an expert possesses confidential information. *Chamberlain Group, Inc. v. Interlogix, Inc.*, 2002 WL 653893, *3 (N.D. Ill. 2002). And disqualification cannot be based on inferences that confidential information was transmitted to an expert when there is no direct evidence that it did. *Id.*

9. Instead, what AT&T must establish here is (a) that Mr. Wilson currently possesses AT&T confidential information; (b) that AT&T has not waived its right to maintain the confidentiality of that information; and (c) that any confidential

information in his possession bears a substantial relationship to the specific issues raised in this proceeding. *Greene*, 202 F.R.D. at 429; *Chamberlain Group, Inc. v. Interlogix, Inc.*, 2002 WL 653893, *3 (N.D. Ill. 2002).

10. The sum total of AT&T's allegations to date are that Mr. Wilson was given access to its "network and interconnections," that he "worked on AT&T's network infrastructure," and that he worked as a consultant to AT&T in two proceedings before the WUTC. AT&T's Reply re: Expert Designation, ¶¶ 8-9.

11. Mr. Wilson has, in the past, had access to AT&T information regarding provisioning intervals for special access trunks in Washington. Supp. Wilson Decl., ¶ 6. This was contained in lists of trunks involving hundreds of trunk groups. *Id.* He does not remember this information. *Id.* It is irrelevant to this matter anyway. *Id.* He has no knowledge of customer locations where AT&T has trunking. *Id.*

12. Seven years ago, Mr. Wilson served as an expert for AT&T in an arbitration cost case in Washington. *Id.*, ¶ 7. He does not remember any AT&T confidential information from that case, if indeed any was disclosed. *Id.*

13. Mr. Wilson served as an expert for AT&T in the Qwest 271 case in Washington. *Id.*, ¶ 9. He states that the amount of AT&T confidential information was minimal, and he does not recall what it was. *Id.*

14. As an expert witness for AT&T, Mr. Wilson was shielded from most confidential information, as that information is freely discoverable and not subject to the attorney-client privilege or work-product doctrine. *Id.*, ¶ 11. To the extent that AT&T continues to believe that information given to Mr. Wilson in his capacity as an

expert witness is confidential, it is mistaken. The information is not confidential precisely because it is discoverable. See *Chamberlain Group*, 2002 WL at *2-3.

15. Mr. Wilson retired from AT&T in 1998. He had no specific knowledge of AT&T's interconnection plans or implementation in Washington. *Id.*, ¶ 10. To the extent he acquired any information on AT&T's network structure, and to the extent that he could remember any of it, the information is out of date by five to ten years. *Id.*, ¶ 12.

16. AT&T's vague allegations, unsupported by any declarations or affidavits, fail to satisfy the first prong of its burden: that Mr. Wilson presently retains AT&T confidential information regarding its network structure or interconnections.

17. There are serious questions regarding whether AT&T can meet the second prong—that it has not waived confidentiality (to the extent any relevant confidential information was actually given to Mr. Wilson). As noted by Mr. Wilson, AT&T has not objected to his participation in cases involving competitors. Supp. Wilson Decl., ¶¶ 24-26; 8. When asked in the May 10 teleconference what distinguished this case from others in which Mr. Wilson has participated and AT&T did not object (and which involved direct competitors to AT&T), AT&T's counsel responded that Mr. Wilson is "adverse" in this matter. That is certainly true. But that hardly constitutes a basis for disqualifying an expert; if it was, experts who were former employees or consultants of an objecting party would be disqualified in every case.

18. Even if AT&T could establish (a) that Mr. Wilson possesses AT&T confidential information, and (b) that it has not waived the confidentiality of that information, it would still need to prove that the information bears a “substantial relationship” to any opinions that he may offer in this proceeding. *Chamberlain* at *3; *Viskase Corp. v. W.R. Grace & Co.*, 1992 WL 13679, *2 (N.D. Ill. 1992). The test is stringent. AT&T must make a detailed and explicit factual showing. See *Greene*, 202 F.R.D. at 429 (expert must have confidential information concerning the “specific technology at issue”; it is not enough that the technology is “operationally similar” or “evolved” into the technology at issue); *Hewlett-Packard*, 330 F. Supp. 2d at 1094 (“Because the burden is on the party seeking to disqualify the expert, that party should point to specific and unambiguous disclosures that if revealed would prejudice the party.”).

19. AT&T faces a particularly difficult burden here because Mr. Wilson states, in exacting detail, that he either did not acquire confidential information that would be relevant to this matter, or, if he ever did, he does not retain it now. Supp. Wilson Decl., ¶¶ 5-13, 22, 28, 30-31. To date, AT&T’s arguments are just that—arguments, unsupported by evidence. It is not enough to throw around terms like “network structure” and “interconnections” without providing real evidence that links specific AT&T confidential information that currently resides with Mr. Wilson to specific issues in this proceeding. See *Greene*, 202 F.R.D. at 429, 431 n.8 (rejecting conclusory assertions that expert possesses confidential information and will “inevitably” use it).

20. *Viskase Corp. v. W.R. Grace & Co.*, 1992 WL 13679 (N.D. Ill. 1992) illustrates why AT&T's attempt to disqualify Mr. Wilson should be rejected. (This case and two others, *Greene* and *Chamberlain*, are attached to this brief for the Commission's convenience.) *Viskase* was a patent infringement case in which the plaintiff sought to disqualify an expert because he was a former employee of the defendant's corporate predecessor for 19 years and worked in a group that was allegedly responsible for manufacturing certain resins at issue in the case. *Id.* at *1. The expert had signed a non-disclosure agreement. *Id.* at *6 n.2. The court resolved the dispute by examining the expert's affidavit to determine the extent and relevance of his knowledge to the issues in the case. It found that the objecting party could not refute the facts in the affidavit; namely, that the expert had no direct "involvement with the resins or patents directly at issue in this case." *Id.* at *2.

Essentially, then, his position is indistinct from any other expert who acquired licensing experience from some company other than plaintiff. He has general experience, but no experience specific to the products or patents in suit. Thus, the Court finds that there is not a substantial relationship between the confidential information Friedlander would have acquired while employed by Union Carbide and the matters to which he would be expected to testify in this case. Instead, he, like any other retained expert, will be required to review the confidential materials produced by plaintiff and to make an assessment based upon his knowledge and experience of the relevant market, rather than upon any knowledge of plaintiff's confidential products and processes.

Id.

21. Mr. Wilson stands in the same position as the expert in *Viskase*. He has no confidential knowledge of issues specific to this case. Supp. Wilson Decl., ¶¶ 2-5, 12.

22. It is useful to compare *Viskase* with the authorities cited by AT&T in its Reply. Three of the four cases cited are not on point: they do not involve attempts to disqualify an expert witness in the action in which the expert is involved. See AT&T Reply, ¶ 9 (citing the *Solutec*, *Pepsico*, and *Uniroyal* cases). The fourth, *Wang Labs., Inc. v. CFR Assocs., Inc.*, 125 F.R.D. 10 (D. Mass. 1989), is easily distinguished.

23. In *Wang*, a patent infringement case, the plaintiff objected to defendant's use of an expert who "developed software used in the very Wang computer systems covered by the patent at issue" and who had worked under one of the inventors of the patented product. *Id.* at 11. The expert was simultaneously working for Wang's competitors, consulting on products in direct competition with Wang's. *Id.* at 11-13. On these facts, Wang had no problem demonstrating that the expert had access to confidential information that not only was directly relevant to the specific issues in the case, but also had the potential to cause it competitive harm. Even so, the court denied Wang's request to bar all contacts with the expert, and expressly permitted his designation as an expert "in a way which would not violate his employment agreement." *Id.* at 13-14.

24. AT&T has one more opportunity—its fourth, if the teleconference is included—to attempt to demonstrate that Mr. Wilson should be barred from viewing confidential documents or disqualified. So far, we have seen only conclusory assertions. Mr. Wilson, on the other hand, is very clear in stating that he does not possess AT&T confidential information that is relevant to this proceeding. One more question is worth asking. If Mr. Wilson possesses confidential information from

AT&T that is relevant to this case, it follows, *a fortiori*, that AT&T possesses that information. But AT&T has not produced a single confidential document or designated any of its responses to data requests as confidential. If AT&T's argument is correct, it would appear that it has failed to produce relevant confidential information.

Conclusion

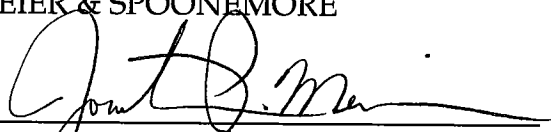
25. Ken Wilson is a very good expert. AT&T knows this. Without the services of a qualified, extremely competent expert, Complainants are at a severe disadvantage. After losing an earlier expert due to a conflict arising from a corporate merger involving T-Netix that occurred after we had retained the expert, Complainants have invested a considerable amount of time and money in retaining Mr. Wilson, who has already provided an opinion and valuable assistance in this matter. Under the law, Complainants' prerogative to choose an expert of their choice and present their case through him cannot be easily dislodged. Mr. Wilson's ability to pursue his professional calling is also deserving of protection.

26. Disqualification is an extraordinary remedy. It requires extraordinarily solid proof that confidential information will be divulged and improperly used. AT&T has not and cannot meet that burden.

27. Complaints respectfully request that the Commission deny AT&T's objection.

DATED: May 12, 2005.

SIRIANNI YOUTZ
MEIER & SPOONEMORE

A handwritten signature in black ink, appearing to read "Jonathan P. Meier", written over a horizontal line.

Jonathan P. Meier (WSBA #19991)

Attorneys for Complainants

1400 Millennium Tower

719 Second Avenue

Seattle, WA 98104

Tel.: (206) 223-0303

Fax: (206) 223-0246

C**Motions, Pleadings and Filings**

Only the Westlaw citation is currently available.

United States District Court, N.D. Illinois, Eastern
 Division.

VISKASE CORPORATION, Plaintiff,

v.

W.R. GRACE & CO.--CONN., Defendant.

No. 90 C 7515.

Jan. 24, 1992.

MEMORANDUM OPINION AND ORDER

ILANA DIAMOND ROVNER, District Judge.

I. INTRODUCTION

*1 Pending before the Court are two motions filed by plaintiff Viskase Corporation ("Viskase") relating to the Stipulated Protective Order (the "Protective Order") entered in this case on March 26, 1991. In its first motion, plaintiff seeks to prevent the disclosure to Bernard I. Friedlander ("Friedlander"), an expert designated by defendant W.R. Grace & Co. ("Grace"), of materials designated as confidential by plaintiff pursuant to that Protective Order. Plaintiff's basis for denying Friedlander access to confidential materials is that Friedlander formerly was employed by Union Carbide Corporation ("Union Carbide"), a predecessor corporation to plaintiff Viskase. As a result of that prior relationship, plaintiff essentially maintains that Friedlander should be barred from testifying as an expert on behalf of defendant in this case. In its second motion, plaintiff requests an order modifying the Protective Order to permit disclosure to Viskase personnel of the sales designations of defendant's products that are charged with infringement. Plaintiff maintains that disclosure of this information to certain of its marketing and sales personnel is essential to the preparation of its case on damages. For the reasons set forth below, the Court will deny both of plaintiff's motions.

*II. ANALYSIS**A. Disclosure of Materials to Friedlander.*

Although couched in terms of a motion to deny the disclosure of confidential materials to defendant's proposed expert, plaintiff's motion in fact is a motion to disqualify Friedlander from testifying at trial because an order denying disclosure of confidential materials essentially would require defendant to retain an alternate expert. Plaintiff seeks to disqualify Friedlander because he previously was a Union Carbide employee who held authoritative positions in that company's Patents and Licensing Department of its Chemicals & Plastics Group. It is this "group" which purportedly was responsible for manufacturing certain of the resins that are at issue in this case. Accordingly, plaintiff maintains that because Friedlander had access to Union Carbide's confidential information relevant to the instant claims of infringement, he should be barred from utilizing that information to plaintiff's detriment in this case.

Friedlander was employed by Union Carbide from 1966 through 1985. (Friedlander Aff. ¶ 2.) In 1972, Friedlander became the Licensing Manager of the Patents and Licensing Department of the Chemicals and Plastics Group. In 1977, he became the Associate Director of that department. (*Id.*) Friedlander attests that during this time, he either was "involved in or responsible for the chemicals and nonpolyethylene licensing activities of the Group." (*Id.*) After 1979, however, Friedlander held various positions with other Union Carbide divisions in which he did not "have access to or receive technical or licensing information concerning low and very low density polyethylene resins." (*Id.* at ¶¶ 3-4.)

*2 Union Carbide's Films Packaging Division is the corporate predecessor to plaintiff. Friedlander states that to the best of his knowledge, all licensing relating to the Films Packaging Division conducted between 1972 and 1983 was done by the division's licensing managers in Chicago. (*Id.* at ¶ 5.) Friedlander maintains that he "never had personal nor professional interaction with any person in the licensing department of the Films Packaging Division." (*Id.*)

Moreover, when Union Carbide initiated the manufacture of "linear low density polyethylene and linear high density polyethylene," the resins at issue in this case, it created a Polyolefins Division. (*Id.* at ¶ 6.) Friedlander describes his involvement with that division as follows:

The operating procedures of the Polyolefins Division restricted all information regarding licensing to those within the Division. I was not in the Division, and therefore had no access to information regarding the licensing or manufacture of these resins. Similarly, I had no access to information regarding the development or licensing of very low density polyethylene resins.

(*Id.*) Instead, Friedlander maintains that his "licensing and commercial responsibilities were separate from those of the Films Packaging Division and Polyolefins Division." (*Id.* at ¶ 7.) As a result, Friedlander concludes in his affidavit that "[a]ny consulting or testimony in this case will require neither the use nor disclosure of Union Carbide confidential information." (*Id.* at ¶ 8.)

Plaintiff has not refuted the fact that Friedlander had no direct involvement in the licensing of products containing the resins at issue in this lawsuit. It is undisputed that Friedlander's responsibilities with Union Carbide were separate and distinct from the Films Packaging Division (Viskase's direct corporate predecessor) and the Polyolefins Division, the group which manufactured and licensed the resins at issue here. (*Id.*) Unable to refute these statements, Viskase focuses instead on the fact that Friedlander's licensing responsibilities with Union Carbide included "upstream manufacturing processes (e.g., processes for the purification of raw material feedstocks), and downstream manufacturing processes (e.g., structural foams) which utilized polyethylene resins, as well as many other resins." (*Id.*) From this, plaintiff maintains that the potential for prejudice from the disclosure of its confidential information to Friedlander is clear because Friedlander's knowledge of the licensing of such resins is a product of his earlier employment by Union Carbide. [FN1]

This Court cannot agree with plaintiff that the potential for prejudice is so clear. Although Friedlander did acquire licensing experience while employed by Union Carbide, he had no involvement with the resins or patents directly at issue in this case. Essentially, then, his position is indistinct from any other expert who acquired licensing experience from some company other than plaintiff. He has general experience, but no experience specific to the products or patents in suit. Thus, the Court finds that there is not a substantial relationship between the confidential information Friedlander would have acquired while employed by Union Carbide and the matters to which

he would be expected to testify in this case. Instead, he, like any other retained expert, will be required to review the confidential materials produced by plaintiff and to make an assessment based upon his knowledge and experience of the relevant market, rather than upon any knowledge of plaintiff's confidential products and processes. *Cf. Brooks Shoe Manufacturing Co. v. Suave Shoe Corp.*, 716 F.2d 854, 861 n. 16 (11th Cir.1983) (affirming refusal to disqualify expert where there was no evidence that expert, in prior consultation with adverse party, had gained confidential information which could be utilized in his trial testimony); see also *Paul v. Rawlings Sporting Goods Co.*, 123 F.R.D. 271, 280 (S.D.Ohio 1988) (refusing to disqualify plaintiff's proposed expert who previously had consulted with defendant about the same lawsuit because there was no evidence that defendant had disclosed any trade secrets or confidential information to the expert); *Estate of George S. Halas, Sr. v. Commissioner of Internal Revenue*, 58 T.C.M. (CCH) 280 (T.C. Sept. 28, 1989) (refusing to disqualify expert appraiser of stock which had prior relationship to taxpayer because no confidential relationship existed between the expert and the party and because the stock to be appraised differed from that with which the expert previously had experience).

*3 Neither *Wang Laboratories, Inc. v. CFR Associates, Inc.*, 125 F.R.D. 10 (D.Mass.1989), nor *Marvin Lumber & Cedar Co. v. Norton Co.*, 113 F.R.D. 588 (D.Minn.1986), relied upon by plaintiff, require a different result. First, in *Wang*, the expert designated by the defendant had developed software for the very computer at issue in the case. He also had worked under one of the inventors of the plaintiff's patented product. 125 F.R.D. at 11. As a result, the Court concluded that the expert should be disqualified from testifying against his former employer in that case. *Id.* at 13. Of course, as the Court has discussed above, Friedlander lacks the direct involvement with the patented product or process that led to disqualification in *Wang*. Similarly, in *Marvin Lumber*, the scientific testing laboratory which the plaintiff sought to disqualify had an actual conflict of interest because it maintained a consulting relationship with the plaintiff at the same time that it had been retained by the defendant as an expert witness. 113 F.R.D. at 590. Moreover, the Court found that, in acting as the defendant's expert, the laboratory necessarily would utilize confidential information acquired through its consultations with the plaintiff. *Id.* at 591. Therefore, the laboratory would be placed "in an adversarial position against its past and present client." *Id.* at

592. In the present case, by contrast, Friedlander's relationship with Union Carbide terminated approximately seven years ago, and there is no indication that he is in possession of any confidential information relevant to the patents at issue herein. Accordingly, neither *Wang* nor *Marvin Lumber* aids plaintiff's cause.

As a final basis for disqualification, plaintiff relies on its supposition that Friedlander must have signed an employment agreement with Union Carbide requiring that he maintain the confidentiality of any of the company's technologies or trade secrets. [FN2] Viskase contends that a similar confidentiality agreement convinced the court in *Wang* to disqualify the defendant's designated expert. Contrary to the circumstances in *Wang*, there is no indication that Friedlander's consultation as an expert in this case would result in a breach of any employment agreement because plaintiff has not established that Friedlander's testimony would require the disclosure of any of Union Carbide's confidential technologies or trade secrets. Accordingly, the existence of such an employment agreement would not require the disqualification of Friedlander.

Plaintiff's motion to deny disclosure of confidential materials to Friedlander pursuant to ¶ 3(B) of the parties' Protective Order is denied.

B. Modification of the Protective Order.

The Court similarly is not persuaded that the Protective Order previously entered in this case should be modified in order to permit disclosure of the sales designations of defendant's products charged with infringement. Although plaintiff contends that such a modification and disclosure is essential to the preparation of its damages case, defendant has made a persuasive showing that this confidential material should not be disclosed to plaintiff's employees. Moreover, the Court finds that plaintiff has alternative means of preparing its damages case which will not require the disclosure of defendant's commercially sensitive information.

*4 The rather unique and troubling issue posed by plaintiff's motion-- whether counsel should be permitted to disclose to his client the identity of the products which the client itself has charged with infringement--arises for the following reasons. When plaintiff filed the instant complaint, it was unaware of defendant's specific products which were alleged to have infringed its patents. Instead, the complaint was filed on the basis of analytical data

which purportedly disclosed the existence of an infringement. In the course of discovery, counsel has been able to identify the specific products which purportedly infringe plaintiff's patents. However, because all information relating to those products has been designated as confidential pursuant to the Protective Order, the information cannot be disclosed to plaintiff or any of its employees. Under the parties' Protective Order, the only persons permitted access to materials designated as confidential are the in-house and retained counsel representing each of the parties, as well as any experts or consultants employed to assist counsel in the preparation of the case. (Protective Order ¶ ¶ 3, 11.) In the present motion, therefore, plaintiff seeks an expansion of the Protective Order to include certain of plaintiff's employees, at least with respect to the sales designations that are the subject of plaintiff's motion. [FN3]

Preliminarily, the Court always is concerned by a contested motion which seeks to modify a stipulated protective order because that order was the product of an agreement between the parties. Moreover, in this case, the circumstances which purportedly require a modification of the Protective Order should have been apparent to plaintiff at the time it entered into the Protective Order and should have been accounted for therein. When plaintiff agreed to the instant Protective Order and restricted the disclosure of confidential materials to counsel and experts, plaintiff and its counsel were aware that they could not, as yet, identify the specific products charged with infringement. They also must have been aware that those products would be identified at some point in the course of discovery in this litigation. Thus, plaintiff should have anticipated and accounted for its present problem when it agreed to the Protective Order in the first instance. Evidently, plaintiff failed to do so, and accordingly, plaintiff and its counsel stipulated to a protective order prohibiting any disclosure of confidential information to plaintiff's employees. Now, to remedy its apparent oversight, plaintiff seeks to alter and expand the terms of the Protective Order. Such a modification is not to be undertaken lightly, however. Instead, plaintiff must make a substantial showing of good cause to relieve it of the burden of the agreed Protective Order, particularly when the proposed modification relates to a matter within the parameters of reasonable foresight at the time of the parties' agreement. See *American Telephone and Telegraph Co. v. Grady*, 594 F.2d 594, 597 (7th Cir.1978), cert. denied, 440 U.S. 971, 99 S.Ct. 1533 (1979); *Richard Wolf Medical Instruments Corp. v. Dory*, 130 F.R.D. 389,

392 (N.D.Ill.1990) (Bucklo, U.S.M.). Plaintiff has made no such showing here.

*5 In opposing plaintiff's motion, Grace contends that the disclosure to Viskase personnel of the sales codes of allegedly infringing products would reveal to plaintiff the identity of the Grace products which contain Dow Attane resins. According to Phillip T. Voso, the Director of Manufacturing Operations in Grace's Cryovac Division, information relating to the resins used in a particular product is unknown even to most of Cryovac's own employees. In short, defendant considers its product formulations highly confidential. (Voso Aff. ¶¶ 6-7.) Accordingly, it contends that it would be inappropriate to permit the employees of a direct competitor such as plaintiff access to that kind of confidential information.

Viskase, of course, disputes the importance of the information that would be disclosed to its employees, as well as what could be gleaned from it. Having much less familiarity with the products and the formulations at issue here than either of the parties, it is difficult for the Court to determine the actual impact of an order requiring disclosure of the competitive information sought by plaintiff. The Court, however, cannot underestimate the resourcefulness of plaintiff's employees when handed sensitive information of a competitor in an evolving, technology-based market such as this. This Court agrees that "where confidential material is disclosed to an employee of a competitor, the risk of the competitor's obtaining an unfair business advantage may be substantially increased." Akzo N.V. v. U.S. International Trade Commission, 808 F.2d 1471, 1483 (Fed.Cir.1986), cert. denied, 482 U.S. 909, 107 S.Ct. 2490 (1987). The Court does not believe that Grace should be made to incur that risk here, particularly where it was plaintiff, the party seeking modification of the Protective Order, that failed to anticipate its current problem in negotiating the Protective Order in the first instance.

Moreover, the Court is not persuaded that disclosure of the sales code information is essential to the preparation of plaintiff's case. Alternative methods exist for formulating a damage case without simply disclosing to plaintiff's employees confidential information relating to the allegedly infringing products. For instance, defendant's counsel agreed at the January 9 hearing on plaintiff's motion that he would have no objection if Viskase were to present to certain of its marketing and sales personnel a list of defendant's products and then to make inquiry as to which of plaintiff's own products compete with those

products in the marketplace. Such a procedure presumably would not involve the disclosure of any information considered to be confidential because the list would include both products charged with infringement, as well as those that are not. Thus, there would be no need to modify the existing Protective Order. Although such a procedure may place added burdens on plaintiff and its counsel, and possibly its experts, in terms of synthesizing information and calculating any alleged damages, plaintiff cannot be heard to complain in these circumstances. This procedure, agreed to by defendant, would permit plaintiff to gather the information needed to make its damage case without compromising defendant's potentially sensitive business information. Accordingly, that is the procedure the Court will permit in this case. Plaintiff's motion for relief from the Protective Order is denied.

III. CONCLUSION

*6 For the reasons set forth above, plaintiff's motion to deny disclosure of confidential materials to Bernard I. Friedlander is denied. Plaintiff's motion to modify the parties' Stipulated Protective Order similarly is denied.

FN1. In effect, the perception of prejudice does not arise so much from the disclosure of confidential information to Friedlander as it does from the possibility that Friedlander would disclose confidential information of plaintiff in the course of his consultation in this case.

FN2. Plaintiff attaches to its supporting memorandum a copy of the standard employment agreement utilized by Union Carbide at the time of Friedlander's employment. (See Plaintiff's Mem.Ex.C.) In that standard agreement, the employee covenants "[t]o keep confidential and not disclose or use, either during or subsequent to my employment, any secret or confidential technology, information or trade secrets of the Corporation, except as required in my employment with the Corporation or as authorized in writing by the Corporation." (*Id.*) The agreement attached to plaintiff's memorandum is not executed by Friedlander, but merely is utilized as an example of Union Carbide's standard agreement. In responding to plaintiff's motion, Grace does not dispute that Friedlander signed such an agreement,

however. Therefore, the Court accepts plaintiff's representation that Friedlander is subject to such a confidentiality covenant.

FN3. Significantly, plaintiff does not challenge the confidentiality designation made with respect to the information sought to be disclosed. Accordingly, plaintiff's reliance on the decision in Procter & Gamble Co. v. Nabisco Brands, Inc., 111 F.R.D. 326 (D.Del.1986), is misplaced. In that case, the plaintiff challenged the confidential designation of a group of documents produced by the defendant. Id. at 328. Accordingly, the Court was required to analyze whether in fact the materials were properly protected pursuant to Fed.R.Civ.P. 26(c)(7). Id. at 328-29. In this case, plaintiff did not object to Grace's designation of the instant materials as confidential, as it might have pursuant to ¶ 7 of the Protective Order. (See Protective Order ¶ 7.) Thus, the Court need not consider whether the information is itself properly designated as confidential.

1992 WL 13679 (N.D.Ill.)

Motions, Pleadings and Filings ([Back to top](#))

- 1:90CV07515 (Docket)
(Dec. 28, 1990)

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H**Motions, Pleadings and Filings**

United States District Court,
E.D. Pennsylvania.
GREENE, TWEED OF DELAWARE, INC.
v.
DuPONT DOW ELASTOMERS, L.L.C.
No. Civ.A. 00-3058.

May 8, 2001.

Patent holder brought infringement suit. Defendant and non-party filed motion to preclude plaintiff from naming research scientists formerly employed by defendant as experts and from showing confidential information to them as fact witnesses. The District Court, Welsh, United States Magistrate Judge, held that: (1) disqualification of research scientist as expert witness was not warranted on ground that scientist had previously been employed by alleged infringer, absent evidence that scientist was privy to confidential information relevant to the alleged infringing products; (2) disqualification of research scientist as expert witness was not warranted on ground that scientist had previously been employed by alleged infringer, and was privy to attorney-client privileged communications; and (3) plaintiff was not precluded from questioning former employees of defendant about confidential documents they authored or received while in defendant's employ, consistent with terms of stipulation and protective order which was negotiated and agreed upon by the parties and approved by the court.

Motion denied.

West Headnotes

[1] Evidence  535

157k535 Most Cited Cases

Federal courts have the inherent power to disqualify expert witnesses in certain circumstances to protect the integrity of the adversary process and to promote public confidence in the legal system.

[2] Evidence  535

157k535 Most Cited Cases

Disqualification of expert witness may be appropriate

when a party retains an expert witness who previously worked for an adversary and who acquired confidential information during the course of his employment.

[3] Evidence  535

157k535 Most Cited Cases

When determining whether to disqualify an expert based on a prior relationship with the adversary, a court must undertake the following inquiry: (1) did the adversary have a confidential relationship with the expert; and (2) did the adversary disclose confidential or privileged information to the expert that is relevant to the current litigation

[4] Evidence  535

157k535 Most Cited Cases

Disqualification of an expert witness based on a prior relationship with the adversary should not occur where a confidential relationship existed but no privileged information was communicated or alternatively, where no confidential relationship existed but privileged information was nonetheless disclosed.

[5] Evidence  535

157k535 Most Cited Cases

The party who seeks disqualification of an expert based on based on a prior relationship with the adversary has the burden of showing the existence of confidentiality and its non-waiver.

[6] Evidence  535

157k535 Most Cited Cases

Disqualification of research scientist as expert witness in patent infringement suit was not warranted on ground that scientist had previously been employed by alleged infringer, absent evidence that scientist was privy to confidential information relevant to the alleged infringing products; fact that scientist's name appeared on distribution lists, along with approximately one hundred other names, did not prove that he was privy to such information.

[7] Evidence  535

157k535 Most Cited Cases

[7] Witnesses  219(3)

410k219(3) Most Cited Cases

Disqualification of research scientist as expert

witness in patent infringement suit was not warranted on ground that scientist had previously been employed by alleged infringer, and was privy to attorney-client privileged communications; by relying on an opinion of counsel concerning alleged invalidity of patent in its affirmative defenses to charge of willful infringement, alleged infringer waived its privilege with regard to the subject matter of the opinion.

[8] Patents 292.2
291k292.2 Most Cited Cases

[8] Stipulations 14(1)
363k14(1) Most Cited Cases

Patent holder bringing infringement suit was not precluded from questioning former employees of defendant about confidential documents they authored or received while in defendant's employ, consistent with terms of stipulation and protective order which was negotiated and agreed upon by the parties and approved by the court.

*427 Ronald L. Panitch, Panitch, Schwarze, Jacobs and Nadel, Philadelphia, PA, Kevin R. Hamel, Akin, Gump, Strauss, Hauer & Feld, LLP., Philadelphia, PA, David P. Callet, Michael S. Caldwell, Shari L. Fleishman, Akin Gump Strauss Hauer & Feld, Washington, DC, Lynda L. Calderone, Kristyne A. Bullock, Akin Gump Strauss Hauer & Feld, Philadelphia, PA, for Greene, Tweed of Delaware, Inc., Plaintiff.

Mark S. Stewart, Ballard, Spahr, Andrews and Ingersoll, Philadelphia, PA, Leora Ben-Ami, Gerard P. Norton, Philip E. Roux, Neer Gupta, Samuel Waxman, Clifford Chance Rogers & Wells LLP, New York City, for DuPont Dow Elastomers, L.L.C., Defendant.

MEMORANDUM AND ORDER

WELSH, United States Magistrate Judge.

Plaintiff, Greene, Tweed of Delaware, Inc. ("Green, Tweed"), brought this action alleging that certain activities relating to the manufacture and sale of various products of defendant, DuPont Dow Elastomers, L.L.C. ("DuPont Dow"), infringe United States Patent No. 5,461,107 ("the '107 patent"). [FN1] Plaintiff further contends that DuPont Dow's infringement was willful, and plaintiff therefore seeks, *inter alia*, increased damages and attorneys' fees.

FN1. The '107 patent relates to improving the chemical resistance of perfluoroelastomeric compositions and seals. At issue in this case are specially formulated O-rings that are, among other things, highly resistant to heat and chemical attack.

Presently before the Court is the Motion of Defendant, DuPont Dow, and Non-party, E.I. du Pont de Nemours and Company (hereinafter referred to as "the non-party"), [FN2] *428 to Preclude Plaintiff from Naming Charles Stewart and Anestis Logothetis as Experts and to Preclude Plaintiff from Showing Confidential Information to Them as Fact Witnesses. [FN3] Specifically, DuPont requests that the Court enter an Order (1) disqualifying former DuPont employees, Drs. Stewart and Logothetis, from serving as consultants or experts for plaintiff in this litigation, and (2) preventing these individuals from being provided confidential information of DuPont in their alternative capacities as fact witnesses. *See* DuPont's Mot. at 1.

FN2. Defendant, DuPont Dow, and non-party, E.I. du Pont de Nemours and Company, are herein referred to collectively as "DuPont."

FN3. According to the present motion, "DuPont Dow was formed on April 1, 1996 as a joint venture between E.I. du Pont de Nemours and Company and the Dow Chemical Company." *See* DuPont's Mot. at 3. Pursuant to Fed.R.Civ.P. 24(b), the non-party has requested leave to intervene in this litigation for the limited purpose of the present motion on the grounds that it alleges that its "trade secrets are threatened to be disclosed and disseminated by this litigation, and confidentiality agreements with former employees have been breached or are threatened to be breached by their engagement as experts and/or consultants for Greene, Tweed." *See* DuPont's Mot. at n. 1. The non-party does not seek to intervene as a party to this lawsuit, *id.*, and plaintiff has not indicated any opposition to the non-party's intervention for the stated limited purpose.

In support of the present motion, DuPont alleges that Drs. Stewart and Logothetis had access to confidential information during their previous employment with DuPont. *Id.* DuPont is concerned

that if plaintiff uses Stewart and Logothetis as consultants or experts, they will inevitably disclose DuPont's confidential information to plaintiff. *Id.* at 1-2. In addition, DuPont is concerned that plaintiff will disclose confidential information to Stewart and Logothetis in their capacities as fact witnesses. *Id.* at 2.

In its memorandum in opposition to DuPont's motion, plaintiff argues that "Greene, Tweed is entitled to any information bearing on its claim of infringement, confidential or not, and it is entitled to speak to any persons with knowledge thereon." See Pl.'s Mem. at 2. Plaintiff further argues that the Stipulation and Protective Order dated March 16, 2001 negotiated and agreed upon by the parties and approved by the Court sufficiently protects any legitimate interests in confidentiality of the parties. [FN4] *Id.* In addition, plaintiff argues that "[n]ot a single shred of evidence has been presented to support any of [DuPont's] sweeping factual allegations" and that "[w]ithout providing hard evidence to support their claims ..., [DuPont] should not be awarded the extraordinary relief they seek." See Pl.'s Mem. at 4.

[FN4]. In particular, the Stipulation and Protective Order in this case provides, *inter alia*, that any confidential information exchanged will be used "solely for the preparation, trial, and appeal of this lawsuit; settlement discussions and negotiations pertaining to this lawsuit; or any form of alternative dispute resolution of this lawsuit; and for no other purpose of publication whatsoever, whether directly or indirectly." See Stip. and Prot. Order dated 3/16/01, ¶ 2.

I. DISQUALIFYING EXPERT WITNESSES

[1][2] Federal courts have the inherent power to disqualify expert witnesses in certain circumstances to protect the integrity of the adversary process and to promote public confidence in the legal system. *Space Sys./Loral v. Martin Marietta Corp.*, No. 95-20122, 1995 WL 686369, at *2 (N.D.Cal.1995) (citing *Wang Labs., Inc. v. Toshiba Corp.*, 762 F.Supp. 1246, 1248 (E.D.Va.1991)). One situation where disqualification may be appropriate is when a party retains an expert witness who previously worked for an adversary and who acquired confidential information during the course of his employment. *Space Sys./Loral*, 1995 WL 686369, at *2; see *Toshiba Corp.*, 762 F.Supp. at 1248.

[3] When determining whether to disqualify an

expert based on a prior relationship with the adversary, a court must undertake the following two-step inquiry: (1) Did the adversary, in this case Dupont, have a confidential relationship with the expert?; and (2) Did the adversary disclose confidential or privileged information to the expert that is relevant to the current litigation? See *Space Sys./Loral*, 1995 WL 686369, at *2 (patent infringement suit where defendant moved to disqualify plaintiff's expert on the grounds that the expert previously worked for defendant); *In re Orthopedic Bone Screw Prods. Liab. Litig.*, No. MDL 1014, 1995 WL 925673, at *3 (E.D.Pa. May 5, 1995) (denying *429 defendant's motion to disqualify an expert despite defendant's allegations that it had retained the expert as a consultant and conveyed confidential information to him); *Toshiba Corp.*, 762 F.Supp. at 1248 (patent infringement suit where plaintiff filed motion to disqualify expert claiming to have previously retained him).

[4] If the answers to both inquiries are affirmative, a court should disqualify the expert. *In re Orthopedic Bone Screw Prods. Liab. Litig.*, 1995 WL 925673, at *3; *Toshiba Corp.*, 762 F.Supp. at 1248. However, disqualification is likely inappropriate if either inquiry yields a negative response. *Id.*; see *In re Orthopedic Bone Screw Prods. Liab. Litig.*, 1995 WL 925673, at *3. Thus, generally, disqualification "should not occur where a confidential relationship existed but no privileged information was communicated or alternatively, where no confidential relationship existed but privileged information was nonetheless disclosed." *Id.* (quoting *Mayer v. Dell*, 139 F.R.D. 1, 3 (D.D.C.1991) (citations omitted)).

[5] The party who seeks disqualification of an expert has the burden of showing the existence of confidentiality and its non-waiver. *In re Orthopedic Bone Screw Prods. Liab. Litig.*, 1995 WL 925673, at *3; *United States ex rel. Cherry Hill Convalescent Ctr., Inc. v. Healthcare Rehab Sys., Inc.*, 994 F.Supp. 244, 249 (D.N.J.1997); *English Feedlot, Inc. v. Norden Labs., Inc.*, 833 F.Supp. 1498, 1501-02 (D.Colo.1993). Furthermore, the party requesting disqualification may not meet its burden with "mere conclusory or *ipse dixit* assertions." *In re Orthopedic Bone Screw Prods. Liab. Litig.*, 1995 WL 925673, at *6 (citing *Nikkal Indus., Ltd. v. Salton, Inc.*, 689 F.Supp. 187, 191 (S.D.N.Y.1988)).

In the present case, DuPont clearly had a confidential relationship with both Stewart and Logothetis at the time of their previous employment, and plaintiff does not specifically deny this in its

opposition to DuPont's motion. Both individuals were employed by DuPont as research scientists, and both signed employment and termination agreements that included confidentiality clauses (copies of which are attached to DuPont's Motion as Exhibit "A"). Therefore, DuPont has satisfied the first part of the aforementioned two-prong test, and the remaining issue is whether confidential information was disclosed to these individuals "that is relevant to the current litigation" and that would warrant a disqualification of either or both of them as experts for plaintiff. See Space Sys./Loral, 1995 WL 686369, at *2; see also In re Orthopedic Bone Screw Prods. Liab. Litig., 1995 WL 925673, at *3; Toshiba Corp., 762 F.Supp. at 1248.

In Viskase Corp. v. W.R. Grace and Co.-Conn., No. 90-7515, 1992 WL 13679, at *1 (N.D.Ill. Jan. 24, 1992), a patent infringement case, the plaintiff corporation sought to disqualify the defendant's proposed expert on the grounds that the individual was previously employed by the plaintiff's predecessor corporation. As in the present case, the proposed expert had signed an employment agreement requiring confidentiality with the predecessor corporation of the party seeking disqualification. *Id.* at *6 n. 2.

The Court in Viskase found that the plaintiff had failed to demonstrate that the proposed expert had "direct involvement in the licensing of products containing the resins at issue in [the] lawsuit." *Id.* at *2. The Viskase Court further concluded that "there [was] not a *substantial relationship* between the confidential information [the proposed expert] would have acquired while employed by [the predecessor corporation] and the matters to which he would be expected to testify in this case." *Id.* (emphasis added). Accordingly, the Court in Viskase denied the motion to disqualify the proposed expert. *Id.*

In Space Systems/Loral, 1995 WL 686369, at *1, the plaintiff alleged the infringement of two of its patents covering "attitude control" technology which enabled satellites to maintain a constant orientation towards the earth. The defendant corporation sought to disqualify two individuals who had previously been employed by the defendant from being designated as experts for the plaintiff, Space Systems/Loral ("SSL"). The proposed experts had signed confidentiality agreements with the defendant corporation. *Id.* at *1, *3.

The Court granted the defendant's motion to

disqualify one of the proposed experts on the basis that the proposed expert "had significant*430 involvement in designing the attitude control systems" for the alleged infringing products in that litigation, and the witness "was privy to *substantial confidential information* from [the defendant] that [was] relevant to the issues in [the] case." *Id.* at *2-3. With regard to the second proposed expert in Space Systems/Loral, the defendant corporation alleged that the proposed expert possessed "crucial" knowledge because he was involved in the development of attitude control systems which were "operationally similar" to the infringing products and "which evolved into the system used in the [infringing products]." *Id.* However, the Court noted that this second proposed expert "possess[ed] no *confidential information* concerning ... the *specific technology at issue in this lawsuit.*" *Id.* (emphasis added). Therefore, with respect to that individual, the Court denied the motion to disqualify plaintiff's expert. *Id.*

In the present case, as explained above, DuPont has the burden of showing the existence of confidentiality and its non-waiver. In re Orthopedic Bone Screw Prods. Liab. Litig., 1995 WL 925673, at 3; United States ex rel. Cherry Hill Convalescent Ctr., Inc., 994 F.Supp. at 249; English Feedlot, Inc., 833 F.Supp. at 1501-02. However, DuPont has failed to satisfy its burden of demonstrating that Drs. Logothetis or Stewart were privy to "confidential information concerning ... the specific technology at issue in this lawsuit." See Space Sys./Loral, 1995 WL 686369, at *3; see also Viskase Corp., 1992 WL 13679, at *2; In re Orthopedic Bone Screw Prods. Liab. Litig., 1995 WL 925673, at *7 ("record is void of any evidence that confidential information was disclosed ...").

As explained by the Court in Space Systems/Loral, asserting that the proposed experts were involved in the development of technology which was "operationally similar" to the infringing products or "which evolved into the [technology] used in the [infringing products]" is not enough. See Space Sys./Loral, 1995 WL 686369, at *2-3. Nor can DuPont satisfy its burden by making conclusory assertions that the proposed experts were "privy to substantial confidential information related and unrelated to this litigation." See, e.g., DuPont's Mot. at 9. For example, DuPont's conclusory assertions that certain information is "not publicly available," without supporting evidence, is not enough to satisfy the burden of showing confidentiality and its non-waiver. See In re Orthopedic Bone Screw Prods. Liab. Litig., 1995 WL 925673, at 3; United States ex

rel. Cherry Hill Convalescent Ctr., Inc., 994 F.Supp. at 249; *English Feedlot, Inc.*, 833 F.Supp. at 1501-02. Of course, as plaintiff points out, *see* Pl.'s Letter Brief dated 4/6/01, at 2, the fact that an individual may have had access to *public* information about a product cannot be a basis to disqualify him from being an expert.

[6] With respect to Dr. Logothetis, although documents submitted by DuPont indicate that he assisted in the development of improved polymerization, the documents do not show that he was privy to *confidential* information relevant to the alleged *infringing products* in this case. *See Viskase Corp.*, 1992 WL 13679, at *2. Furthermore, as plaintiff correctly points out, *see* Pl.'s Letter Brief dated 4/6/01, at 2, the fact that Dr. Logothetis' name appears on some "Distribution" lists, along with approximately one hundred other names, also does not prove that he was privy to confidential information substantially related to the alleged *infringing products*. [FN5] *See, e.g., In re Orthopedic Bone Screw Prods. Liab. Litig.*, 1995 WL 925673, at *7 (affidavit stating that "the parties discussed confidential information at the meeting, including 'the scope of the products liability litigation pending against [the defendant], including this litigation' ... [did] not provide the court with sufficient evidence that confidential information was discussed."). DuPont has failed to present evidence demonstrating that any information to which Dr. Logothetis was privy was kept *confidential* at the time it was given or that confidentiality has since been maintained and not waived. *See id.* at *3 (party seeking disqualification of expert has burden of showing existence of confidentiality and its *431 non-waiver); *United States ex rel. Cherry Hill Convalescent Ctr., Inc.*, 994 F.Supp. at 249 (same); *English Feedlot*, 833 F.Supp. at 1501-02 (same).

[FN5]. Indeed, these "Distribution" lists (copies of which are attached to DuPont's Letter Brief dated 4/5/01) state "Anyone interested in being added to the distribution list or would like your name removed from the list, please contact Miriam DiSantis, ELAS, TRALEE PARK, via EMAIL ..." (emphasis added).

[7] With regard to Dr. Stewart, DuPont has submitted for *in camera* review Document Nos. 9 and 12 identified in DuPont Dow's Second Privilege Log [FN6] in support of the claim that Dr. Stewart was privy to attorney-client privileged communications. [FN7] *See* DuPont's Letter Brief dated 4/5/01, at 2.

In opposition to this claim of privilege, plaintiff responds that "[b]y relying on an opinion of counsel concerning [the] alleged invalidity of the '107 patent [in DuPont Dow's affirmative defenses to plaintiff's charge of willful infringement], DuPont Dow has waived its privilege with regard to the subject matter of that opinion, i.e., the invalidity of the '107 patent." *See* Pl.'s Letter Brief dated 4/6/01, at 3. Plaintiff further points out that "this very issue is argued in [plaintiff's] motion to compel documents." *Id.* at 4.

[FN6]. As explained in this Court's Memorandum and Order dated May 1, 2001, *see* Mem. and Order dated 5/1/01, at n. 1, on or about March 7, 2001, DuPont Dow produced a privilege log identifying the documents which it believed to be protected by the attorney-client privilege or work product immunity. After reconsidering whether any of the withheld documents were improperly designated as privileged, and in an attempt to, among other things, provide more detailed descriptions of the withheld documents, DuPont Dow subsequently provided a second privilege log (herein referred to as "Second Privilege Log"). *Id.*

[FN7]. DuPont produced redacted versions of these documents to plaintiff. *See* DuPont's Letter Brief dated 4/5/01, at 2.

By Memorandum and Order dated May 1, 2001, this Court granted in part and denied in part plaintiff's aforementioned Motion to Compel Documents Identified in Defendant DuPont Dow's Privilege Log, which included a request for Document Nos. 9 and 12 identified in DuPont Dow's Second Privilege Log. As explained in the May 1st Memorandum and Order, "DuPont Dow has waived the [attorney-client] privilege ... with respect to the issue of validity of the '107 patent." *See* Mem. and Order dated 5/1/01, at 7 (citing *Saint-Gobain/Norton Indus. Ceramics Corp. v. General Elec. Co.*, 884 F.Supp. 31, 34 (D.Mass.1995)); *see also Applied Telematics, Inc. v. Sprint Corp.*, No. 94-4603, 1995 WL 567436, at *3 (E.D.Pa. Sept. 21, 1995); *Mushroom Assoc. v. Monterey Mushrooms, Inc.*, No. 91-1092, 1992 WL 442892, at *3 (N.D.Cal. May 19, 1992).

According to DuPont Dow's own description of Document No. 12 in the Second Privilege Log, this document "reflects legal advice regarding [the] invalidity of [the] '107 patent based upon prior art" (emphasis added). Furthermore, Document No. 9 appears to be a memorandum provided in response to

inquiries made in Document No. 12 related to the invalidity of the '107 patent. See DuPont's Letter Brief dated 4/5/01, at 2. Moreover, in DuPont's April 5, 2001 letter brief in support of the present motion, counsel acknowledges that "[Document Nos. 9 and 12] reflect assembling information concerning invalidity for anticipation." See DuPont's Letter Brief dated 4/5/01, at 2 (emphasis added).

In any event, this Court has previously determined that DuPont Dow waived the attorney-client privilege with respect to the information reflected in Document Nos. 9 and 12, since these two documents are relevant to the issue of invalidity of the '107 patent. See Mem. and Order dated 5/1/01, at 10-11. Accordingly, DuPont has failed to demonstrate that while Dr. Stewart was employed by DuPont, he was privy to any communications which are now privileged and not waived.

Since DuPont has failed to meet its burden of demonstrating that Dr. Logothetis or Dr. Stewart were privy to confidential information while employed at DuPont which was substantially related to the alleged infringing products in this case, DuPont's motion to preclude plaintiff from naming these gentlemen as experts is denied. [FN8] See *432 *Viskase Corp.*, 1992 WL 13679, at * 2; see also *Space Sys./Loral*, 1995 WL 686369, at *2-3. Of course, any information designated as "Confidential Information" by any party or non-party disclosing such information during discovery is subject to the March 16, 2001 Stipulation and Protective Order entered in this case which provides, *inter alia*, that any such information shall be used "solely for the preparation, trial, and appeal of this lawsuit; settlement discussions and negotiations pertaining to this lawsuit; or any form of alternative dispute resolution of this lawsuit; and for no other purpose of publication whatsoever, whether directly or indirectly." See Stip. and Prot. Order dated 3/16/01, ¶ 2.

FN8. Although DuPont also claims that trade secret law and the " 'inevitable disclosure' doctrine" also compel disqualification of Drs. Stewart and Logothetis as expert witnesses for plaintiff, see DuPont's Mot. at 12-13; DuPont's Reply at 1, DuPont fails to cite a case disqualifying an expert witness specifically on the basis of the " 'inevitable disclosure' doctrine." In *Air Products and Chemicals, Inc. v. Johnson*, 296 Pa.Super. 405, 442 A.2d 1114, 1120 (1982), which is cited by DuPont in support

of its position, see DuPont's Mot. at 12; DuPont's Reply at 7, the issue was whether the Court should enjoin the plaintiff's ex-employee from working for the plaintiff's competitor as an employee in a context other than litigation. However, as DuPont acknowledges, see *id.* at 8, 442 A.2d 1114, in the context of determining whether to disqualify an expert for litigation purposes based on a prior relationship with an adversary, the applicable standard is the aforementioned two prong inquiry. See *Space Sys./Loral*, 1995 WL 686369, at *2; *In re Orthopedic Bone Screw Prods. Liab. Litig.*, 1995 WL 925673, at *3; *Toshiba Corp.*, 762 F.Supp. at 1248. In any event, as explained above, despite DuPont's conclusory assertions to the contrary, DuPont has failed to demonstrate that the proposed experts in this case were privy to any confidential or privileged information substantially related to the specific technology at issue in this case.

II. STEWART AND LOGOTHETIS AS FACT WITNESSES

[8] DuPont "do[es] not dispute that trade secrets are relevant to this case," and it acknowledges that several former DuPont employees, including Drs. Stewart and Logothetis, "may have factual knowledge relevant to the issues in this case, and [DuPont Dow] expect[s] to call them as fact witnesses as well." See DuPont's Mot. at 14. However, although it does not seek to preclude plaintiff from calling Drs. Stewart and Logothetis as fact witnesses, DuPont is "concerned ... that [plaintiff] wishes to show documents containing [DuPont] confidential information, and to discuss such information with Stewart, Logothetis, and other ex-employees without anyone else present." See DuPont's Mot. at 14. On these bases, DuPont's motion requests the following specific relief: either (1) a representative from DuPont be present during plaintiff's discussions with Drs. Stewart and Logothetis, and be given an opportunity to object, or (2) that Drs. Stewart and Logothetis be appointed their own, independent counsel, who would not represent either party to this suit. [FN9] *Id.* at 15.

FN9. According to plaintiff, both Drs. Stewart and Logothetis have chosen plaintiff's counsel to represent them. See Pl.'s Mem. at 16 n. 8.

DuPont fails to cite any applicable caselaw where a

court granted the specific relief requested by DuPont in the present case with respect to a fact witness. Indeed, at the April 4, 2001 oral argument on the present motion, counsel for DuPont acknowledged that it knew of no such caselaw where the specific relief requested by DuPont was granted in this context.

In Wang Laboratories, Inc. v. CFR Associates, Inc., 125 F.R.D. 10 (D.Mass.1989), the plaintiff filed a motion for a protective order to prohibit the defendant in that case from contacting a proposed witness who was a former employee of the plaintiff corporation and who was also subject to a confidentiality clause in his employment contract. Although the Court in Wang Laboratories disqualified the proposed expert in that case, [FN10] the Court found that "[b]ecause of his role in the development of the software for the computer system at issue, [the witness] may be an appropriate fact witness." *Id.* at 13. The Court held that the defendant "may show [the witness] and discuss with him any documents which he authored or which the document reveals he received." *Id.* at 14.

FN10. The Court in Wang Laboratories disqualified the former employee as an expert witness because of his direct role as a developer of the patented software at issue in the litigation, a conclusion that was supported by deposition testimony of a primary distributor of the alleged infringing product. See Wang Labs., 125 F.R.D. at 11, 13-14.

Similarly, in the present case, the March 16, 2001 Stipulation and Protective Order which was negotiated and agreed upon by the parties and approved by the Court, states:

Witnesses or potential witnesses may be shown any Confidential Information that *433 that person had lawfully received prior to and apart from this lawsuit or which appears on its face or from other documents, testimony, or information to have been authored by that witness, received by that witness, or communicated to that witness.

Stip. and Prot. Order dated 3/16/01, ¶ 6(e). Furthermore, as discussed above, pursuant to the Stipulation and Protective Order, any exchange of confidential information during discovery in this litigation "shall be used by every party or non-party receiving such information ... solely for the preparation, trial, and appeal of this lawsuit; settlement discussions and negotiations pertaining to this lawsuit; or any form of alternative dispute

resolution of this lawsuit; and for no other purpose or publication whatsoever, whether directly or indirectly." *Id.* ¶ 2. Accordingly, in light of the lack of caselaw cited as authority in support of the specific relief requested by DuPont in the present motion with respect to Drs. Stewart and Logothetis as fact witnesses, and consistent with the March 16, 2001 Stipulation and Order entered in this case, plaintiff may question Drs. Stewart and Logothetis about the documents which they authored or received, and DuPont's motion is denied.

An implementing Order follows.

ORDER

AND NOW, this 8th day of May, 2001, upon consideration of the Motion of Defendant, DuPont Dow Elastomers, L.L.C. ("DuPont Dow"), and non-party, E.I. du Pont de Nemours and Company, to Preclude Plaintiff from Naming Charles Stewart and Anestis Logothetis as Experts and to Preclude Plaintiff from Showing Confidential Information to Them as Fact Witnesses, for the reasons given in the accompanying Memorandum, it is hereby ORDERED that the motion is DENIED.

202 F.R.D. 426

Motions, Pleadings and Filings (Back to top)

• 2:00CV03058 (Docket)
(Jun. 14, 2000)

END OF DOCUMENT

H**Motions, Pleadings and Filings**

Only the Westlaw citation is currently available.

United States District Court, N.D. Illinois, Eastern
 Division.

CHAMBERLAIN GROUP, INC. Plaintiff,

v.

INTERLOGIX, INC. Defendant.

No. 01 C 6157.

April 19, 2002.

MEMORANDUM OPINION AND ORDER

CONLON, District J.

*1 The Chamberlain Group, Inc. ("Chamberlain") sues Interlogix, Inc. ("Interlogix") for patent infringement under 35 U.S.C. § 271 *et seq.* Interlogix counterclaims for a declaratory judgment of non-infringement, invalidity, and unenforceability. Chamberlain moves to strike Interlogix's Rule 26(a)(2) reports. In addition, Chamberlain moves to designate Dr. V. Thomas Rhyne as a Rule 26(a)(2) witness, and disclose confidential information pursuant to the January 3, 2002 stipulated protective order. Interlogix moves to strike Dr. Rhyne's expert report.

DISCUSSION

I. Motion to Strike Interlogix's Rule 26(a)(2) Reports

Chamberlain moves to strike the expert report of Larry S. Nixon. Chamberlain argues Nixon is a patent lawyer whose report consists solely of legal conclusions disguised as expert testimony. In general, testimony from a patent lawyer, not skilled in the art, as to claim construction of the patent is not helpful and may be excluded. *Endress + Hauser, Inc. v. Hawk Meas. Sys. Pty. Ltd.*, 122 F.3d 1040, 1042 (Fed.Cir.1997); *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 983 (Fed.Cir.1995). Chamberlain asserts Nixon's entire 70- page report should be stricken and his testimony barred because it contains legal conclusions. "Excluding all the testimony of a witness--rather than of a certain subject matter--is an extraordinary measure." *Amsted Indus., Inc. v.*

Buckeye Steel Castings Co., No. 91 C 1179, 1992 WL 372989, at *3-4 (N.D.Ill.Dec. 9, 1992). Chamberlain fails to identify specific portions of Nixon's report that it contends should be stricken. The court's review of Nixon's report reveals it provides an explanation of the prosecution history of the patents at issue, and the operation of the Patent and Trademark Office ("PTO"). See *e.g.* Mot. to Strike, Ex. 1, at p. 1-17. Expert testimony on prior art, prosecution history, and PTO operations can be helpful to an understanding of the issues in a patent infringement action. See *Yawway Corp. v. Eur-Control USA, Inc.*, 775 F.2d 268, 274 (Fed.Cir.1985); *Amsted Indus.*, 1992 WL 372989, at *3-4. Further, patent lawyers are not barred from testifying as expert witnesses in a patent action. See *Markman*, 52 F.3d at 991. The use of patent lawyers as experts is discouraged only when they provide opinions on the interpretation of a claim as a matter of law. *Endress*, 122 F.3d at 1042.

Chamberlain's motion is premature. Discovery does not close until May 15, 2002. Barring expert testimony involves a determination whether the expert's opinion will be helpful to the court or the jury. See *Fed.R.Evid.* 702. This court cannot determine whether Nixon's testimony will assist the trier of fact without considering his testimony in the context of the relevant issues. Accordingly, Chamberlain's motion to strike Nixon's report and bar his testimony must be denied.

In addition, Chamberlain contends two of Interlogix's four remaining Rule 26(a)(2) reports should be stricken because they are redundant. Chamberlain asserts Interlogix has designated two technical experts (Dr. Jeffrey Frey and Dr. Sharad Malik) and two damages experts (Dr. Gerald Hausman and Charles Kuyk). Chamberlain moves to strike one expert from each category. A court has discretion to exclude expert testimony that is cumulative, redundant or confusing. See *Fed.R.Evid.* 403; *United States v. Hall*, 165 F.3d 1095, 1104 (7th Cir.1999). Chamberlain advances this court's standing order on pretrial procedures, which states "one expert on each subject for each party will be permitted to testify absent good cause shown." Local Rule 16.1, Standing Order, at n. 7. Chamberlain's motion is premature. The parties are still conducting discovery. The standing order restricts Interlogix to one expert per subject *at trial*. *Id.* A party may

identify more than one expert on a subject under Rule 26(a)(2) and reserve its later choice as to which expert to use at trial. *Commonwealth Ins. Co. v. Stone Container Corp.*, No. 99 C 8471, 2001 WL 385559, at *6 (N.D.Ill. Mar. 12, 2002). Nor can the court determine whether the reports are redundant without considering them in the context of the issues to be addressed at trial. Chamberlain's motion is more appropriately brought as a motion *in limine*. See *Harbor Ins. Co. v. Continental Bank Corp.*, No. 85 C 7081, 1991 WL 222260, at *5 (N.D.Ill. Oct. 25, 1991) (addressing the redundancy of expert testimony in a motion *in limine*); *Nichols v. Grieshaber*, No. 90 C 0195, 1990 WL 159995, at *2 (N.D.Ill. Oct. 15, 1990) (same). Accordingly, Chamberlain's motion to strike Interlogix's Rule 26(a)(2) reports must be denied.

II. Disqualification of Dr. Rhyne as a Rule 26(a)(2) Witness

*2 Chamberlain moves to designate Dr. Rhyne as an expert and disclose confidential information under the January 3, 2002 stipulated protective order. In response, Interlogix moves to strike Dr. Rhyne's Rule 26(a)(2) report. Interlogix asserts Dr. Rhyne must be disqualified as Chamberlain's expert due to a conflict of interest. "Courts have the inherent power to disqualify expert testimony, if necessary, to protect privileges, which would be breached if an expert were to switch sides, and to preserve public confidence in the fairness and integrity of judicial proceedings." *Tucker v. Steele & Assoc.*, No. 93 C 1268, 1994 WL 127246, at *3 n. 6 (N.D.Ill. Apr. 12, 1994). Disqualification of experts is subject to a different standard than attorney disqualification. *City of Springfield v. Rexnord Corp.*, 111 F.Supp.2d 71, 74, n.2 (D.Mass.2000). "Experts are not advocates in the litigation but sources of information and opinions." *English Feedlot v. Norden Lab., Inc.*, 833 F.Supp. 1498, 1501 (D.Colo.1993). A two-prong test is applied to determine whether an expert should be disqualified: (1) whether the attorney or client acted reasonably in assuming that a confidential or fiduciary relationship developed; and (2) whether confidential information was exchanged requiring disqualification of the expert. *Tucker*, 1994 WL 127246, at *3 n.6.; see also *Great Lakes Dredge & Dock Co. v. Harnischfeger Corp.*, 734 F.Supp. 334 (N.D.Ill.1990). Disqualification is a "drastic measure which courts should hesitate to impose except when absolutely necessary." *Commonwealth Ins. Co. v. Stone Container*, 178 F.Supp.2d 938, 943 (N.D.Ill.2001) (quoting *Owen v. Wangerin*, 985 F.2d 312, 317 (7th Cir.1993).

Interlogix asserts Dr. Rhyne was exposed to confidential information when he served as an expert witness for Interactive Technologies ("Interactive"), Interlogix's predecessor, in *Interactive Tech., Inc. v. Pittway Corp.*, No. 2-95-771 (D.Minn.). Dr. Rhyne's association with Interactive concluded in 1999. Chamberlain contends Dr. Rhyne provided expert testimony on the '118 patent, the precursor to the two patents at issue (the '364 and '703 patents), and other prior art relevant to this action. Interlogix identifies three "confidential" areas that Dr. Rhyne was purportedly privy to in *Pittway*: (1) Interactive's trial and patent strategy; (2) business information; and (3) information on prior art and prosecution history.

Interlogix contends Dr. Rhyne was exposed to confidential patent information during his association with Interlogix. Rule 26 requires disclosure of materials furnished to experts, and parties cannot assert materials provided to experts are protected from disclosure by privilege or confidentiality. *Fed.R.Civ.P. 26(a)(2)*, 1993 Advisory Comm. Notes. Interlogix concedes the parties are disclosing confidential information on the relevant patents, prior art, and prosecution history under the stipulated protective order. Pursuant to *Fed.R.Civ.P. 26*, relevant information on the patents at issue that Interlogix possesses are discoverable. Thus, Dr. Rhyne's knowledge of relevant prosecution history and prior art from his association with Interlogix is immaterial. See *Palmer v. Ozbek*, 144 F.R.D. 66, 68 (D.Md.1992).

*3 An expert cannot be disqualified without evidence that privileged or confidential information was received by the expert during the relationship. *Tucker*, 1994 WL 127246, at *3 n. 6; *Paul v. Rawlings Sporting Goods Co.*, 123 F.R.D. 271 (S.D. Ohio 1988). Interlogix must demonstrate that confidential information passed from Interactive to Dr. Rhyne. See *Great Lakes*, 734 F.Supp. at 338 (recognizing there is no presumption that confidential information will pass to an expert); *Cherry Hill Convalescent Ctr., Inc. v. Healthcare Rehab Sys. Inc.*, 994 F.Supp. 244, 251 (D.N.J.1997) (refusing to disqualify expert based on inferences that confidential information must have passed from client to expert). This rule prevents attorneys from retaining an expert solely to disable the opponent's use of that same expert. *Wang Labs. Inc. v. Toshiba Corp.*, 762 F.Supp. 1246, 1248 (E.D.Va.1991).

Interlogix fails to offer evidence that Dr. Rhyne was exposed to confidential patent information that is not

subject to discovery in this action. Instead, Interlogix contends Dr. Rhyne was exposed to confidential business information when he worked as Interlogix's consultant before and after the *Pittway* litigation. However, Interlogix does not elaborate on the type of confidential business information that Dr. Rhyne received. Nor does Interlogix address the manner in which that business information is relevant to the issues in this action or Dr. Rhyne's role as Chamberlain's expert. Interlogix must establish a substantial relationship between Dr. Rhyne's purported knowledge of business information and the subject matter of Dr. Rhyne's testimony. *Vikase*, 1992 WL 13679, at *2. Interlogix offers nothing more than conclusory affidavits that state Dr. Rhyne was exposed to confidential business strategy. See Def. Resp Br., Ex. A, Durrant Aff.; Ex. B, Scahefer Aff. Interlogix cannot satisfy its burden to disqualify Dr. Rhyne based on unsupported assertions. See *Green, Tweed of Delaware, Inc. v. Dupont Down Elastomers, L.L.C.*, 202 F.R.D. 426, 429 (E.D.Pa.2001) (conclusory assertions are insufficient to disqualify an expert); *Vikase Corp. v. W.R. Grace Co.*, No. 90 C 75715, 1992 WL 13679 (N.D.Ill. Jan. 24, 1992) (where there is no evidence that expert possessed confidential information, disqualification of expert was unwarranted).

Further, Interlogix contends Dr. Rhyne was privy to trial strategies in the *Pittway* litigation. Interlogix asserts that information was disclosed in a confidential relationship. Interlogix's assertion is unpersuasive. Communications between a testifying expert and the party retaining that expert are not privileged. See *Commonwealth Ins. Co.*, 178 F.Supp.2d at 944; *Barna v. United Sates*, No. 95 C 6552, 1997 WL 417847 (N.D.Ill. Jul. 23, 1997). Indeed, disclosure of a party's legal position and contentions to a testifying expert is not protected by the attorney-client privilege. *In re Pioneer Hi-Bred Int'l, Inc.*, 238 F.3d 1370, 1376 (Fed.Cir.2001). And an attorney's mental impressions communicated to a Rule 26(a)(2) expert are not protected by the work-product doctrine. *Barna*, 1997 WL 417847, at *3.

*4 A testifying expert's role is to review materials, draw on the expertise in his discipline, and offer opinions on a particular issue relevant to the case. *Commonwealth Ins. Co.*, 178 F.Supp. at 945. An expert's purpose is to assist the parties and help the trier of fact understand the evidence. *Great Lakes*, 734 F.Supp. at 338; Fed.R.Evid. 702. In the course of the attorney-expert relationship, every expert is exposed to a degree of the retaining party's litigation strategy. However, an expert's exposure to trial

strategy in an unrelated and different action is insufficient to warrant the extreme sanction of disqualification. There is no evidence that Dr. Rhyne acted as Interlogix's litigation consultant in *Pittway*. See *Cherry Hill*, 994 F.Supp. at 251. Nor is Dr. Rhyne a patent lawyer. See Pl. Mot., Ex. 3. Chamberlain has retained Dr. Rhyne as a Rule 26(a)(2) witness, not as a consultant. Disqualification is only warranted where there is a substantial relationship between the confidential information acquired and the matters to which Dr. Rhyne would be expected to testify in this action. *Vikase*, 1992 WL 13679, at *2; *Green Tweed*, 202 F.R.D. at 431, n.8; see also *Wang Laboratories, Inc. v. CFR Assoc., Inc.*, 125 F.R.D. 10 (D.Mass.1989) (expert disqualified where he had developed software for the computer at issue). Interlogix fails to establish a substantial relationship between Dr. Rhyne's purported knowledge of Interlogix's trial strategies from *Pittway* and Dr. Rhyne's role as a Rule 26(a)(2) testifying expert. Indeed, "it would be foolish for the retaining party to use a testifying expert [to advise on strategy], as the communications would be an open book, available for the opponent to review." *Commonwealth Ins. Co.*, 178 F.Supp.2d at 945.

In addition to the two-prong test for expert disqualification, courts balance competing policy objectives to determine expert disqualification. *Cordy v. Sherwin-Williams Co.*, 156 F.R.D. 575, 580 (D.N.J.1994). The court has an interest in preventing conflicts of interest and maintaining judicial integrity. *Cherry Hill*, 994 F.Supp. at 251. However, experts should be allowed to pursue their trade, and parties should be permitted to select their own experts. See *Stencel v. The Fairchild Corp.*, 174 F.Supp.2d 1082, 1803 (C.D.Cal.2001). There is no indication that Chamberlain's choice of Dr. Rhyne is in bad faith because he has served as Chamberlain's expert in six other proceedings. Pl. Mot. Disclose, Rhyne Aff., at ¶ 1; see *Stencel*, 174 F.Supp.2d at 1082, n. 4 (absence of evidence of bad faith weighs against disqualification). To the extent Dr. Rhyne contradicts his prior opinions that are favorable to Interlogix, Interlogix has the opportunity to discover those inconsistencies at his deposition and may use the prior opinions as impeachment evidence. See *Great Lakes*, 734 F.Supp. at 339 (noting the party seeking disqualification can cross-examine expert witnesses at trial to reveal possible biases).

*5 Courts that have disqualified experts on conflict of interest grounds do so when the expert "switches sides" in the same litigation. See e.g. *Marvin Lumber & Cedar Co. v. Norton Co.*, 113 F.R.D. 588

(D.Minn.1986) (allowing disqualification where the expert maintained a consulting relationship with the plaintiff and served as the defendant's expert at the same time); *see also Cordy*, 156 F.R.D. at 580; *Conforti & Eisele, Inc. v. Div. of Building and Constr., et al.*, 170 N.J.Super. 64, 405 A.2d 487 (1979). Under those circumstances, the risk of disclosure of confidential information is high and the public's trust in the integrity of the judicial system is at stake. Those concerns are not present here. Dr. Rhyne was previously associated with Interlogix's predecessor in a patent action that did not involve Chamberlain and concerned only prior art of the patents at issue. Consequently, Interlogix fails to satisfy its burden that Dr. Rhyne must be disqualified as a Rule 26(a)(2) witness.

In the alternative, Interlogix contends Chamberlain's designation of Dr. Rhyne as a Rule 26(a)(2) witness and submission of his report are untimely. Chamberlain was required to disclose Rule 26(a)(2) witnesses with supporting reports to Interlogix by February 4, 2002. Chamberlain identified Dr. Rhyne as a Rule 26(a)(2) witness in correspondence to Interlogix on March 8, 2002. Pl. Mot. to Disclose, Ex. 3. Chamberlain did not serve Interlogix with Dr. Rhyne's Rule 26(a)(2) report until April 3, 2002. A party's failure to comply with Rule 26(a) results in an "automatic and mandatory" exclusion of expert testimony "unless the party to be sanctioned can show that its violation of Rule 26(a) was either justified or harmless." *Finley v. Marathon Oil Co.*, 75 F.3d 1225, 1230 (7th Cir.1996). Chamberlain's only explanation for its late disclosure of Dr. Rhyne is that it changed counsel in March 2002. Chamberlain's assertion is without merit. Chamberlain timely submitted David McGavock and Dr. Bruce Eisenstein's Rule 26(a)(2) reports. Chamberlain now seeks to designate Dr. Rhyne as a new expert one month after Interlogix responded with its own expert reports and two months after its Rule 26(a)(2) deadline. Although Chamberlain's new counsel may prefer Dr. Rhyne as an expert, that rationale is insufficient to justify an untimely disclosure. Interlogix would be prejudiced if Chamberlain is permitted to designate a new expert shortly before discovery closes. The issues are complex. Interlogix has responded to Chamberlain's Rule 26(a)(2) reports, and it would now be forced to prepare a rebuttal report. In turn, Chamberlain will not be prejudiced because it has designated two Rule 26(a)(2) witnesses, including Dr. Eisenstein as its designated patent expert.

Chamberlain's disclosure of Dr. Rhyne is untimely

only to the extent he would provide non-rebuttal expert testimony. Although the court did not specify a date for submission of rebuttal reports, this court's standing order requires submission of rebuttal reports to opposing counsel no later than 10 days before discovery closes. Chamberlain submitted Dr. Rhyne's report on April 3, 2002, more than 10 days before discovery closes on May 15, 2002. Chamberlain does not assert Dr. Rhyne's report is a rebuttal report. Instead, Chamberlain asserts Dr. Rhyne may offer new and rebuttal opinions. Chamberlain is granted leave to designate Dr. Rhyne as a rebuttal expert and submit a rebuttal report in accordance with this court's standing order. Because Chamberlain may designate Dr. Rhyne as a Rule 26(a)(2) witness, Chamberlain may disclose confidential information to him under the stipulated protective order. *See* Pl. Mot, Ex. 1, Stipulated Protective Order, at ¶ 3(d).

CONCLUSION

*6 Chamberlain's motion to strike Interlogix's expert reports and exclude expert testimony is denied without prejudice. Chamberlain's motion to designate Dr. V. Thomas Rhyne as a Rule 26(a)(2) witness and disclose confidential information is granted. Interlogix's motion to strike Dr. Rhyne's Rule 26(a)(2) report and exclude expert testimony is granted in part. Dr. Rhyne's April 3, 2002 report is stricken as untimely under this court's October 3, 2001 order. Interlogix is granted leave to provide Dr. Rhyne's Rule 26(a)(2) rebuttal report by May 3, 2002.

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- [2002 WL 32510010](#) (Trial Motion, Memorandum and Affidavit) Agreed Motion to Modify Protective Order to Allow Three People, Charles Durant, Bob Sloane and Karl A. Vick, to Review "Trial Counsel's Eyes Only" Documents Regarding Chamberlain Settlement (Aug. 22, 2002)
- [2002 WL 32510032](#) (Trial Motion, Memorandum and Affidavit) Reply Memorandum Support of Chamberlain's Motion to Vacate the Court's May 31, 2002 Order Granting Interlogix's Motion for Partial Summary Judgment of Invalidity of U.S. Patent No. Re. 36,703 (Aug. 22, 2002)

- [2002 WL 32677327](#) (Trial Motion, Memorandum and Affidavit) Reply Memorandum in Support of Chamberlain's Motion to Vacate the Court's May 31, 2002 Order Granting Interlogix's Motion for Partial Summary Judgment of Invalidity of U.S. Patent No. Re. 36,703 (Aug. 22, 2002)
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- [2002 WL 32509995](#) (Trial Motion, Memorandum and Affidavit) Memorandum in Support of Chamberlain's Motion Pursuant to Rule 59(e) to Vacate Final Judgment (Aug. 14, 2002)
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- [2002 WL 32509976](#) (Trial Motion, Memorandum and Affidavit) Chamberlain's Motion to Vacate the Court's May 31, 2002 Order Granting Interlogix's Motion for Partial Summary Judgment of Invalidity of U.S. Patent No. Re. 36,703 (Jul. 31, 2002)
- [2002 WL 32677310](#) (Trial Motion, Memorandum and Affidavit) Interlogix's Surreply in Opposition to Chamberlain's Third Motion to Compel Discovery of Information and Documents Withheld Under Claim of Privilege (Jul. 25, 2002)
- [2002 WL 32677306](#) (Trial Motion, Memorandum and Affidavit) Interlogix's Reply in Support of its Motion to Compel Answers to Questions by the Deponent, John Flannery (Jul. 23, 2002)
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- [2002 WL 32677214](#) (Trial Motion, Memorandum and Affidavit) Chamberlain's Memorandum in Opposition to Interlogix's Motion for Partial Summary Judgment Based on Invalidity of The '703 Patent (May. 14, 2002)

- [2002 WL 32509811](#) (Trial Motion, Memorandum and Affidavit) Chamberlain's Memorandum in Opposition to Motion to Compel Production of Documents and Information (May. 13, 2002)

- [2002 WL 32677208](#) (Trial Motion, Memorandum and Affidavit) Chamberlain's Memorandum in Opposition to Motion to Compel Production of Documents and Information (May. 13, 2002)

- [2002 WL 32677202](#) (Trial Motion, Memorandum and Affidavit) Chamberlain's Response to Interlogix, Inc.'s Motion to Modify Protective Order (May. 08, 2002)

- [2002 WL 32509799](#) (Trial Motion, Memorandum and Affidavit) Agreed Motion to Modify Protective Order to Allow One Additional Person, Thomas P. Lafrance, to Review "Trial Counsel's Eyes Only" Documents Regarding Chamberlain Settlements (May. 06, 2002)

- [2002 WL 32509791](#) (Trial Motion, Memorandum and Affidavit) Interlogix, Inc.'s Motion to Compel Production of Documents and Information (May. 03, 2002)

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- [2002 WL 32509776](#) (Trial Motion, Memorandum and Affidavit) Chamberlain's Motion for Reconsideration of the Court's April 18, 2002 Order Granting Interlogix's Motion to Strike the Expert Report of Dr. V. Thomas Rhyne (Apr. 29, 2002)

- [2002 WL 32509745](#) (Trial Motion, Memorandum and Affidavit) Defendant Interlogix's Preliminary Motion for Partial Summary Judgment Based on Invalidity of the '703 Patent for Failure to Comply With 35 U.S.C. § 251 and 37 C.F.R. § 1.175 (Apr. 19, 2002)

- [2002 WL 32509750](#) (Trial Motion, Memorandum and Affidavit) Defendant Interlogix's Memorandum in Support of Preliminary Motion for Partial Summary Judgment Based on Invalidity of the '703 Patent for Failure to Comply With 35 U.S.C. § 251 and 37 C.F.R. § 1.175 (Apr. 19, 2002)

- [2002 WL 32677198](#) (Trial Motion, Memorandum and Affidavit) Defendant Interlogix's Memorandum in Support of Preliminary Motion for Partial Summary Judgment Based on Invalidity of the '703 Patent for Failure to Comply with 35 U.S.C. § 251 and 37 C.F.R. § 1,175 (Apr. 19, 2002)

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- [2002 WL 32677187](#) (Trial Motion, Memorandum and Affidavit) Defendant/Counterclaim-Plaintiff Interlogix's Response to Chamberlain's Objections to the Magistrate Judge's February 21, 2002 Memorandum Opinion and Order (Mar. 22, 2002)

- 2002 WL 32509706 (Trial Motion, Memorandum and Affidavit) Chamberlain's Motion to Disclose Dr. V. Thomas Rhyne As An Expert and to Disclose Confidential Information to V. Thomas Rhyne (Mar. 18, 2002)
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- 2002 WL 32509661 (Trial Motion, Memorandum and Affidavit) Interlogix's Motion to Quash Plaintiff's Notice of Rule 30(B)(6) Deposition and for Protective Order (Feb. 20, 2002)
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- 2001 WL 34666544 (Trial Pleading) Complaint (Aug. 10, 2001)
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