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UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF CALIFORNIA

DUHN OIL TOOL, INC.,

Plaintiff/Counterclaim-Defendant,

vs.

COOPER CAMERON CORPORATION,
n/k/a CAMERON INTERNATIONAL
CORPORATION

Defendant/Counterclaim-Plaintiff.

Case No. 1:05-cv-01411-OWW-GSA

**ORDER GRANTING DEFENDANT
CAMERON’S REQUEST FOR
RECONSIDERATION BY THE
DISTRICT COURT OF MAGISTRATE
JUDGE’S RULING**

Hon. Oliver W. Wanger

Pending before this Court is Defendant Cooper Cameron Corporation, n/k/a Cooper Cameron Corporation, (“Cameron”)’s Request for Reconsideration by the District Court of Magistrate Judge’s Ruling. Pursuant to Local Rule 72-303(c), Defendant Cameron requests that this Court reconsider certain aspects of Magistrate Judge Austin’s October 15, 2009 Order (Docket No. 355) which granted in part Plaintiff Duhn Oil Tool, Inc. (“Duhn Oil”)’s motion to compel.

The Court finds that Defendant Cameron’s Request should be granted. The Court finds the Magistrate Judge’s Order clearly erroneous because it did not delineate correctly the scope of the subject matter waiver triggered by Cameron’s reliance on the advice of counsel defense. And that scope is a communication to or from Cameron concerning whether the patent is valid, enforceable, and infringed. And that applies both to attorney/client communications and to work product communications other than uncommunicated work product.

1 In addition to defining this scope of the subject matter waiver, there is also a
2 delineation between trial counsel and opinion counsel. As to trial counsel, any opinions
3 that have been or will be relied upon or presented in the advice of counsel defense at trial.
4 That is non-privileged information of the trial counsel. Otherwise trial counsel's legal
5 advice, work product in generally defending the case are not discoverable. But to the extent
6 that trial counsel works on the opinion, adds to it, critiques it and communicates that to the
7 client, that's part of, if you will, the good faith and part of the test of how diligent the
8 alleged infringer was in getting that advice and knowing that that advice was competent,
9 comprehensive, and that it could be relied on. If trial counsel didn't do that, there won't be
10 anything to produce. And although the trial counsel works with the opinion counsel's work
11 product and opinion, ordinarily this Court's experience is that trial counsel doesn't get
12 involved in giving that opinion or formulating it or doing anything else with it. So there
13 shouldn't be anything to disclose. But if Cameron's trial counsel has done that, then it is
14 discoverable. That is what EchoStar and Seagate say, as far as trial counsel. The privilege
15 is not absolute. There can be an exception. This Court has defined the exception and if it
16 doesn't apply, then there is nothing to produce from trial counsel. So that is the limitation.
17 Otherwise for opinion counsel, it is any documents referring to validity, enforceability, and
18 infringement of the '925 patent, which is communicated to the client Cameron.

19 Accordingly, this Court hereby reconsiders the Magistrate Judge's Order and limits
20 the grant of the motion to compel for production of documents and interrogatories as
21 follows.

22 Request for Production No. 103

23 All documents that evidence, refer or relate to any oral or written
24 advice of counsel relating to infringement of the '925 PATENT by any
25 ACCUSED DEVICE.

26 Defendant Cameron will comply with this request for production consistent with the
27 delineation between trial counsel and opinion counsel set forth above.

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Request for Production No. 104

Any and all documents evidencing communications between YOU and any and all attorneys acting on YOUR behalf regarding the validity, enforceability, and infringement of the '925 PATENT.

Defendant Cameron will comply with this request for production with the additional limitation inserted as underlined, and consistent with the delineation between trial counsel and opinion counsel set forth above.

Request for Production No. 106

Any and all documents evidencing communications between YOU and all attorneys acting on YOUR behalf regarding YOUR ACCUSED DEVICES.

Defendant Cameron’s objections to this request are sustained and it is ordered that there be no response to 106 because it is duplicative, cumulative, and even more overbroad than 104, which this Court already limited.

Request for Production No. 107

Any and all documents evidencing communications between YOU and any and all attorneys acting on YOUR behalf regarding any similarities or differences between YOUR ACCUSED DEVICES and the '925 PATENT.

Defendant Cameron will comply with this request for production consistent with the delineation between trial counsel and opinion counsel set forth above.

Request for Production No. 108

Any and all documents and things used or relied upon by any and all attorneys acting on YOUR behalf for their opinion regarding YOUR ACCUSED DEVICE and the '925 PATENT.

Request No. 108 is cumulative, repetitive, and redundant of 107 and does not need to be answered.

Request for Production No. 109

Any and all documents that evidence, refer or relate to any oral or written advice of counsel regarding the validity, enforceability, and infringement of the '925 PATENT and relating to CAMERON'S decision to stop selling its OLD STYLE FRAC MANDREL, including without

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limitation those documents relating to whether or not the OLD STYLE FRAC MANDREL infringed the '925 PATENT.

Request No. 109 is cumulative of 117 and does not need to be answered, but may be answered to satisfy the conditional sustaining of Cameron’s objections to Request Nos. 118 and 119. The Court modifies this request for production with the additional limitation inserted as underlined, and the delineation between trial counsel and opinion counsel set forth above.

Request for Production No. 110

Any and all documents that evidence, refer or relate to any oral or written advice of counsel relating to CAMERON'S decision to introduce its NEW STYLE FRAC MANDREL, including without limitation those documents relating to whether or not the NEW STYLE FRAC MANDREL infringed the '925 PATENT.

Defendant Cameron’s objections to this request are sustained and it is ordered that there be no response to 110 because it is duplicative and cumulative.

Request for Production No. 111

Any and all documents that evidence, refer or relate to any oral or written advice of counsel regarding the validity, enforceability, and infringement of the '925 PATENT and relating to CAMERON'S decision to introduce its ORIGINAL DESIGN FRAC MANDREL, including without limitation those documents relating to whether or not the ORIGINAL DESIGN FRAC MANDREL infringed the '925 PATENT.

Defendant Cameron will comply with this request for production with the additional limitation inserted as underlined, and consistent with the delineation between trial counsel and opinion counsel set forth above. The answer to this Request No. 111 could be “see answer or response to Request No. 103,” unless it’s different.

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Request for Production No. 112

Any and all mail store files for Manish Vyas, including without limitation the mail store files for mail account manish.vyas@c-a-m.com, that evidence, refer or relate to any oral or written advice of counsel that will be relied on regarding the validity, enforceability, and infringement of the '925 PATENT, or the ACCUSED DEVICES, including, without limitation, e-mail archive files, locally stored files, network stored files, Exchange files, PST files, MSF files, and mailbox files.

Defendant Cameron will comply with this request for production with the additional limitation inserted as underlined, and consistent with the delineation between trial counsel and opinion counsel set forth above.

Request for Production No. 113

Any and all mail store files for Thomas Taylor that evidence, refer or relate to any oral or written advice of counsel that will be relied on regarding the validity, enforceability, and infringement of the '925 PATENT, or the ACCUSED DEVICES, including, without limitation, e-mail archive files, locally stored files, network stored files, Exchange files, PST files, MSF files, and mailbox files.

Defendant Cameron will comply with this request for production with the additional limitation inserted as underlined, and consistent with the delineation between trial counsel and opinion counsel set forth above.

Request for Production No. 114

Any and all emails, email attachments, and instant messages to or from Charles Rogers that evidence, refer or relate to any oral or written advice of counsel relating to the '925 PATENT, including, without limitation, e-mail archives, locally stored files, network stored files, Exchange files, PST files, MSF files, mailbox files, and mail store files.

The Court finds that there should be a modification of this Request. The strategic matter in which an advice of counsel defense is presented at trial, a lawyer tactic, is not necessarily discoverable, but if trial counsel is given the noninfringement opinion issued by the Opinion counsel, and trial counsel then communicates back to the client about the opinion and adds further analysis or, in effect, requests that the opinion be modified or

1 changed, and that is for the purpose of disclosure, then this Court finds that that kind of
2 attorney/client communication, where it directly involves the reliance on and the disclosure
3 of the opinion to be presented at trial as advice of counsel, is waived and/or if it is work
4 product it is not immune. So this Court finds that the correct limitation on this request
5 should be is that it is limited to documents that refer or relate to any communication relating
6 to the advice of counsel defense to be asserted at trial with reference to the '925 patent.
7 Otherwise trial counsel's opinions and work product and communications are privileged.
8 Defendant Cameron will comply with this request for production with this additional
9 limitation, which is consistent with the delineation between trial counsel and opinion
10 counsel set forth above.
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13 Request for Production No. 115

14 Any and all emails, email attachments, and instant messages to or
15 from Manish Vyas that evidence, refer or relate to any oral or written advice
16 of counsel relating to the '925 PATENT, including, without limitation, e-mail
17 archives, locally stored files, network stored files, Exchange files, PST files,
18 MSF files, mailbox files, and mail store files.

19 Defendant Cameron's objections to this request are sustained and it is ordered that
20 there be no response to 115 because it is duplicative of 112.

21 Request for Production No. 116

22 Any and all emails, email attachments, and instant messages to or
23 from Thomas Taylor that evidence, refer or relate to any oral or written
24 advice of counsel relating to the '925 PATENT, including, without limitation,
25 e-mail archives, locally stored files, network stored files, Exchange files, PST
26 files, MSF files, mailbox files, and mail store files.

27 Defendant Cameron's objections to this request are sustained and it is ordered that
28 there be no response to 116 because it is duplicative of 113.

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Request for Production No. 117

Any and all emails, email attachments, and instant messages to or from Charles Rogers that evidence, refer or relate to any oral or written advice of counsel relating to CAMERON'S decision to stop selling its OLD STYLE FRAC MANDREL, including without limitation those documents relating to whether or not the OLD STYLE FRAC MANDREL infringed the '925 PATENT.

Defendant Cameron's objections to this request are sustained. The subject of this request is not advice of counsel, unless Cameron is going to tender Mr. Rogers' advice as the advice of counsel to stop selling or to change. And that is not what this Court understands Mr. Rogers' role was. So this request does not have to be answered unless Cameron is going to rely on Mr. Rogers.

Request for Production No. 118

Any and all emails, email attachments, and instant messages to or from Manish Vyas that evidence, refer or relate to any oral or written advice of counsel relating to CAMERON'S decision to stop selling its OLD STYLE FRAC MANDREL, including without limitation those documents relating to whether or not the OLD STYLE FRAC MANDREL infringed the '925 PATENT.

Defendant Cameron's objections to this request are sustained on the condition that any documents responsive to this request will be subsumed within request number 109.

Request for Production No. 119

Any and all emails, email attachments, and instant messages to or from Thomas Taylor that evidence, refer or relate to any oral or written advice of counsel relating to CAMERON'S decision to stop selling its OLD STYLE FRAC MANDREL, including without limitation those documents relating to whether or not the OLD STYLE FRAC MANDREL infringed the '925 PATENT.

Defendant Cameron's objections to this request are sustained on the condition that any documents responsive to this request will be subsumed within request number 109.

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Request for Production No. 120

Any and all emails, email attachments, and instant messages to or from Charles Rogers that evidence, refer or relate to any oral or written advice of counsel relating to CAMERON'S decision to introduce its NEW STYLE FRAC MANDREL, including without limitation those documents relating to whether or not the NEW STYLE FRAC MANDREL infringed the '925 PATENT.

Request No. 120 is cumulative of 117 and does not need to be answered.

Request for Production No. 121

Any and all emails, email attachments, and instant messages to or from Manish Vyas that evidence, refer or relate to any oral or written advice of counsel relating to CAMERON'S decision to introduce its NEW STYLE FRAC MANDREL, including without limitation those documents relating to whether or not the NEW STYLE FRAC MANDREL infringed the '925 PATENT.

Defendant Cameron's objections to this request are sustained and it is ordered that there be no response to 121 because it is duplicative of 110 and cumulative of 103.

Request for Production No. 122

Any and all emails, email attachments, and instant messages to or from Thomas Taylor that evidence, refer or relate to any oral or written advice of counsel relating to CAMERON'S decision to introduce its NEW STYLE FRAC MANDREL, including without limitation those documents relating to whether or not the NEW STYLE FRAC MANDREL infringed the '925 PATENT.

Defendant Cameron's objections to this request are sustained and it is ordered that there be no response to 122 because it is duplicative of 110 and cumulative of 103.

Request for Production No. 123

Any and all emails, email attachments, and instant messages to or from Charles Rogers that evidence, refer or relate to any oral or written advice of counsel relating to CAMERON'S decision to introduce its ORIGINAL DESIGN FRAC MANDREL, including without limitation those documents relating to whether or not the ORIGINAL DESIGN FRAC MANDREL infringed the '925 PATENT.

Defendant Cameron's objections to this request are sustained and it is ordered that there be no response to 123 because it is duplicative of 111.

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Request for Production No. 124

Any and all emails, email attachments, and instant messages to or from Manish Vyas that evidence, refer or relate to any oral or written advice of counsel relating to CAMERON'S decision to introduce its ORIGINAL DESIGN FRAC MANDREL, including without limitation those documents relating to whether or not the ORIGINAL DESIGN FRAC MANDREL infringed the '925 PATENT.

Defendant Cameron's objections to this request are sustained and it is ordered that there be no response to 124 because it is duplicative of 111.

Request for Production No. 125

Any and all emails, email attachments, and instant messages to or from Thomas Taylor that evidence, refer or relate to any oral or written advice of counsel relating to CAMERON'S decision to introduce its ORIGINAL DESIGN FRAC MANDREL, including without limitation those documents relating to whether or not the ORIGINAL DESIGN FRAC MANDREL infringed the '925 PATENT.

Defendant Cameron's objections to this request are sustained and it is ordered that there be no response to 125 because it is duplicative of 111.

Request for Production No. 126

Any and all documents that evidence, refer or relate to any oral or written advice of counsel regarding the validity, enforceability, and infringement of the '925 PATENT and relating to any videos taken to support this litigation regarding YOUR ACCUSED DEVICES.

Defendant Cameron will comply with this request for production with the additional limitation inserted as underlined, and consistent with the delineation between trial counsel and opinion counsel set forth above.

Request for Production No. 127

Any and all documents that evidence, refer or relate to any oral or written advice of counsel regarding the validity, enforceability, and infringement of the '925 PATENT and relating to any INDENTATIONS made by the lower lockscrews on YOUR ACCUSED DEVICES.

Defendant Cameron will comply with this request for production with the additional limitation inserted as underlined, and consistent with the delineation between trial counsel and opinion counsel set forth above.

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Request for Production No. 128

Any and all documents that evidence, refer or relate to any oral or written advice of counsel on validity, enforceability, and infringement of the '925 PATENT that include any checklists regarding the installation and use of YOUR ACCUSED DEVICES.

Defendant Cameron will comply with this request for production with the additional limitation inserted as underlined, and consistent with the delineation between trial counsel and opinion counsel set forth above.

Request for Production No. 129

Any and all documents that evidence, refer or relate to any oral or written advice of counsel related to validity, enforceability, and/or infringement of the '925 PATENT concerning any FRAC MANDREL identification tags or placards for any ACCUSED DEVICE.

Defendant Cameron will comply with this request for production with the additional limitation inserted as underlined, and consistent with the delineation between trial counsel and opinion counsel set forth above.

Request for Production No. 130

Any and all documents that evidence, refer or relate to any oral or written advice of counsel regarding the validity, enforceability, and infringement of the '925 PATENT and relating to CAMERON'S response to the Court Order entered April 2, 2009 regarding DUHN'S Motion for Preliminary Injunction and CAMERON'S business practices regarding the installation and use of its FRAC assembly.

Defendant Cameron will comply with this request for production with the additional limitation inserted as underlined, and consistent with the delineation between trial counsel and opinion counsel set forth above.

As to the interrogatories, Cameron shall Cameron shall respond to Interrogatory Numbers 35, 37, 38, 39, and 40 consistent with the limitations set forth in this Order.

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IT IS SO ORDERED.

Dated: December 30, 2009

/s/ OLIVER W. WANGER
UNITED STATES SENIOR DISTRICT JUDGE