

1 WO
2
3
4
5

6 IN THE UNITED STATES DISTRICT COURT
7 FOR THE DISTRICT OF ARIZONA
8

9 PCT International, Inc.,

10 Plaintiff,

11 v.

12 Holland Electronics, LLC,

13 Defendant.

No. CV-12-01797-PHX-JAT

ORDER

14 Pending before the Court is Plaintiff's Motion to Disqualify (Doc. 28). The Court
15 now rules on the Motion.

16 **I. BACKGROUND**

17 Defendant Holland Electronics is represented by two law firms in this matter:
18 Ocean Law and Snell & Wilmer, L.L.P. ("Snell & Wilmer"). Pursuant to Ethical Rules
19 1.9 and 1.10 of the Arizona Rules of Professional Conduct, Plaintiff moves to disqualify
20 Snell & Wilmer, L.L.P. from the representation of Defendant in this matter because one
21 of Snell & Wilmer's attorneys, Mr. Rogers, formerly represented Plaintiff in legal
22 matters, which Plaintiff asserts are substantially related to this lawsuit. Although Mr.
23 Rogers is not directly involved in the representation of Defendant in this matter, Plaintiff
24 asserts that Mr. Rogers has a conflict in the representation that can be imputed to the
25 attorneys at Snell & Wilmer that are representing Defendant in this matter, and, thus,
26 Snell & Wilmer must be disqualified.

27 **II. LEGAL STANDARD**

28 "The United States District Court for the District of Arizona has adopted the

1 Arizona Rules of Professional Conduct as its ethical standards. LR Civ 83.2(e) . . .
2 Accordingly, this Court applies the Arizona ethical rules when evaluating motions to
3 disqualify counsel.” *Roosevelt Irrigation. Dist. v. Salt River Project Agric. Improvement*
4 *and Power Dist.*, 810 F.Supp.2d 929, 944 (D. Ariz. 2011) (internal citations omitted).

5 Pursuant to Ethical Rule 1.9(a),

6 A lawyer who has formerly represented a client in a
7 matter shall not thereafter represent another person in the
8 same or a substantially related matter in which that person’s
9 interests are materially adverse to the interests of the former
10 client unless the former client gives informed consent,
11 confirmed in writing.

12 ER 1.9(a)

13 Further, pursuant to Ethical Rule 1.10(d),

14 (d) When a lawyer becomes associated with a firm, no lawyer
15 associated in the firm shall knowingly represent a person in a
16 matter in which that lawyer is disqualified under ER 1.9
17 unless:

18 (1) the matter does not involve a proceeding before a tribunal
19 in which the personally disqualified lawyer had a substantial
20 role;

21 (2) the personally disqualified lawyer is timely screened from
22 any participation in the matter and is apportioned no part of
23 the fee therefrom; and

24 (3) written notice is promptly given to any affected former
25 client to enable it to ascertain compliance with the provisions
26 of this Rule.

27 E.R. 1.10(d).

28 “[O]nly in extreme circumstances should a party to a lawsuit be allowed to
interfere with the attorney-client relationship of his opponent.” *Alexander v. Superior*
Court, 685 P.2d 1309, 1313 (Ariz. 1984); *see Amparano v. ASARCO, Inc.*, 208 Ariz. 370,
93 P.3d 1086, 1092 (Ariz. Ct. App. 2004) (“[T]he rules of professional responsibility are

1 for ethical enforcement and are not designed to be used as a means to disqualify counsel.
2 The courts have, of course, looked to the ethical rules for guidance on disqualification
3 issues.”) (internal citation omitted); *Optyl Eyewear Fashion Int’l Corp. v. Style Cos.,*
4 *Ltd.*, 760 F.2d 1045, 1050 (9th Cir. 1985) (“disqualification motions should be subjected
5 to ‘particularly strict judicial scrutiny’”) (internal citation omitted). “However, close or
6 doubtful cases are resolved in favor of disqualification in order to preserve the integrity
7 of the judicial system.” *Roosevelt*, 810 F.Supp.2d at 944 (internal citations omitted).
8 “[T]he burden is on the party moving to disqualify opposing counsel to show ‘sufficient
9 reason’ why the attorney should be disqualified.” *Amparano*, 93 P.3d at 1093.

10 III. ANALYSIS

11 Snell & Wilmer does not dispute that Mr. Rogers formerly represented Plaintiff or
12 that Plaintiff’s and Defendant’s interests in this case are materially adverse. Rather, the
13 entire dispute in this case concerns whether this case is substantially related to matters on
14 which Mr. Rogers previously represented Plaintiff.

15 Matters are substantially related “if they involve the same transaction or legal
16 dispute or if there otherwise is a substantial risk that confidential factual information as
17 would normally have been obtained in the prior representation would materially advance
18 the client’s position in the subsequent matter.” ER 1.9 cmt. 3 (2003). Determining the
19 scope of a “matter” requires examination of the facts of a particular situation or
20 transaction and the nature and degree of the lawyer’s involvement. ER 1.9 cmt. (2003).

21 Plaintiff first argues that the matters are substantially related because Mr. Rogers
22 obtained information regarding Plaintiff’s approach to and tolerance of potential patent
23 litigation, strategic approaches to this type of litigation, and is familiar with Plaintiff’s
24 strategies for patenting inventions relating to coaxial cable connectors. The Court finds
25 that Plaintiff has not carried its burden of showing that Mr. Rogers’ former representation
26 of Plaintiff in patent-related matters generally requires disqualification in this case.

27 “[A] lawyer who recurrently handled a type of problem for a former client is not
28 precluded from later representing another client in a wholly distinct problem of that type

1 even though the subsequent representation involves a position adverse to the prior client.”
2 ER 1.9 cmt 2 (2003). Moreover, “general knowledge of the client’s policies and
3 practices ordinarily will not preclude a subsequent representation.” ER 1.9 cmt. 3 (2003).
4 “The underlying question is whether the lawyer was so involved in the matter that the
5 subsequent representation can be justly regarded as changing sides in the matter in
6 question.” ER 1.9 cmt 2.

7 In this case, Plaintiff alleges that it is the owner of United States Patent No.
8 6,042,422 (the “422 Patent”) entitled “Coaxial cable and connector crimped by axial
9 compression.” (*See* Doc. 1) Plaintiff alleges that Defendant has infringed and continues
10 to infringe the 422 Patent. (*Id.*) The 422 Patent issued in the year 2000. Mr. Rogers
11 worked on patent and trademark matters for Plaintiff between 2008 and 2010. Mr.
12 Rogers did not work on the preparation or prosecution of the 422 Patent and there is no
13 allegation that he ever reviewed, analyzed, or advised Plaintiff about the 422 patent.
14 Although Mr. Rogers advised Plaintiff about other coaxial cable connector patents and
15 worked with the inventor of the 422 patent, Plaintiff has failed to demonstrate that Mr.
16 Rogers’ gained anything more than a general knowledge of Plaintiff’s policies and
17 practices during his two-year representation of Plaintiff on certain patent-related matters.
18 As such, Plaintiff has not shown that Mr. Rogers’ gained such specific facts about how
19 Plaintiff generally handles patent litigation and how it patents products that he could be
20 seen as changing sides on the subject matter of this litigation.

21 Plaintiff next argues that Mr. Rogers provided it with specific advice regarding
22 United States Patent Nos. 5,525,076 and 5,466,173 (the “Down Patents”). Plaintiff
23 argues that Mr. Rogers’ involvement in the Down Patents is substantially related to the
24 litigation of the 422 Patent because Defendant asserted prosecution history estoppel as a
25 defense in its Answer and discussed alleged representations made by Plaintiff regarding
26 the Down Patents to the Patent Office in 1999 in order to obtain the 422 Patent.

27 Defendant argues that the only references to the Down Patents in the Answer came
28 solely from the public record of the Patent Office from 1999 and there is no allegation

1 that Mr. Rogers ever advised Plaintiff concerning any aspect of the prosecution history of
2 the 422 Patent, involving the Down Patents or otherwise.

3 In light of these facts, Plaintiff has not met its burden of demonstrating that Mr.
4 Rogers' former representation of Plaintiff is substantially related to the issues in this case.
5 There is no suggestion that Mr. Rogers worked on the 422 Patent, which is the main issue
6 in this litigation. Although Mr. Rogers advised Plaintiff on some aspects of the Down
7 Patents, Plaintiff has not demonstrated that such advice was related in any way to the 422
8 Patent or would somehow be related to the affirmative defense relating to the Down
9 Patents. Specifically, the only information Plaintiff relies on in its Answer relating to the
10 Down Patents is from the public record of the Patent office, which was created over eight
11 years before Mr. Rogers undertook any representation of Plaintiff. "[I]nformation that
12 has been disclosed to the public ordinarily will not be disqualifying." ER 1.9 cmt. 3.
13 Such public information cannot be the basis for a conflict and does not demonstrate that
14 any advice Mr. Rogers gave regarding the Down Patents is substantially related to this
15 litigation.

16 Because disqualification should only be used in extreme circumstances and
17 Plaintiff has not carried its burden of showing that Mr. Rogers represented Plaintiff in a
18 matter substantially related to this case, the Motion to Disqualify is denied.


19 **IV. CONCLUSION**

20 Based on the foregoing,

21 **IT IS ORDERED** that Plaintiff's Motion to Disqualify (Doc. 28) is denied.

22 Dated this 7th day of March, 2013.

23
24
25
26
27
28



James A. Teilborg
Senior United States District Judge