

UNITED STATES DISTRICT COURT

EASTERN DISTRICT OF CALIFORNIA

DUHN OIL TOOL, INC.,)	1:05-cv-01411 OWW GSA
)	
Plaintiff,)	ORDER REGARDING PLAINTIFF DUHN OIL
)	TOOL, INC.'S MOTION TO COMPEL
v.)	DEFENDANT COOPER CAMERON
)	CORPORATION'S PRODUCTION OF
COOPER CAMERON CORPORATION,)	WITNESSES FOR DEPOSITIONS, AND
)	DOCUMENTS
Defendant.)	(Doc. 308)
)	
AND RELATED CROSS-CLAIMS.)	
)	

I.

INTRODUCTION

Pending before the Court is Plaintiff Duhn Oil Tool, Inc.'s ("Duhn") Motion to Compel Defendant Cooper Cameron Corporation's ("Cameron") Production of Witnesses for Depositions and Documents, filed on June 30, 2009. Generally speaking, Duhn seeks discovery pertinent to its claim that Cameron willfully infringed upon its patent. The parties filed a Joint Statement regarding the motion on August 4, 2009. (*See* Doc. 324.)

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2 **III.**

3 **JOINT INTRODUCTORY STATEMENTS¹**

4 Generally speaking, at issue here is whether Cameron can assert the attorney-client
5 privilege and work product doctrine in response to particular discovery responses propounded by
6 Duhn.

7 *Duhn's Statement*

8 Duhn argues that when Cameron asserted the defense of reliance upon an opinion of
9 counsel in response to its claim of willful infringement, Cameron waived its right to claim
10 attorney client and work product privileges for all documents and testimony related to the
11 opinion from advice counsel ("Opinion"). Duhn asserts the waiver is a broad subject matter
12 waiver and relies upon *In re Echostar Commc'n Corp.*, 448 F.3d 1294, 1301 (Fed. Cir. 2006).
13 (Doc. 324 at 1.)

14 More specifically, Duhn complains that Cameron has improperly refused to produce in
15 house counsel, Manish Vyas, and its Federal Rules of Civil Procedure rule 30(b)(6) witness for
16 purposes of deposition. Duhn also alleges Cameron has refused to produce documents and
17 discovery responses related to the advice of counsel defense, other than that prepared by Fletcher
18 Yoder. (Doc. 324 at 1.)

19 Duhn believes that further justification in support of its motion is evidenced by
20 Cameron's actions, to wit: rather than relying on the Opinion, Cameron designed and
21 manufactured two alternative frac mandrels during the pendency of this litigation. Duhn claims
22 it "know[s] that Cameron considered at least two opinions (and likely three) in changing its
23 business strategy and coming out with these attempted designarounds." (Doc. 324 at 1-2.)
24 According to Duhn, Mr. Vyas and trial counsel Rogers were conducting a separate infringement
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26 ¹The Court has done its best to decipher the pleadings in this matter, the organization of
27 them often made for a difficult read. For instance, the Court notes the use of fifty-six (56)
28 footnotes in a thirty-two (32) page joint statement, many of which were critical and therefore
should have been provided in the body of the document itself.

1 analysis and provided Cameron with advice regarding “designs that attempted to workaround
2 Duhn’s patent.” (Doc. 324 at 2.) Duhn argues that the relevant law mandates it be permitted to
3 review “the full extent of communications and the information Mr. Vyas and Cameron
4 considered, as well as any other opinions regarding the subject of infringement.” (Doc. 324 at 2.)

5 Lastly, Duhn asserts that Cameron is employing delay tactics to prejudice Duhn’s ability
6 to participate in discovery and effectively prepare for trial. (Doc. 324 at 3.)

7 *Cameron’s Statement*

8 Cameron acknowledged that in response to Duhn’s claim of willful infringement, it
9 asserted certain defenses, including reliance on a noninfringement opinion issued by opinion
10 counsel Tait Swanson and Lee Eubanks of Fletcher Yoder. (Doc. 324 at 3.)

11 Cameron asserts that it has produced, in response to Duhn’s written discovery requests,
12 documents including the Opinion, all communications and documents exchanged between
13 Cameron and its opinion counsel regarding the subject matter of the noninfringement Opinion,
14 and all documents and communications between Cameron and its opinion counsel regarding the
15 subject matter of the Opinion, “even if those documents and communications themselves were
16 not communicated from opinion counsel to Cameron . . .” (Doc. 324 at 3-4.)

17 Cameron claims it complied with the holdings set forth in *In re EchoStar Commc’ns*
18 *Corp.*, 448 F.3d 1294 and *In re Seagate Technology, LLC*, 497 F.3d 1360 (Fed. Cir. 2007). More
19 particularly, the “[d]ocuments that embody the advice-of-counsel (the traditional opinion letter
20 itself)” and “[u]ncommunicated work product that reflects a communication between opinion
21 counsel and the client regarding the subject matter of the Opinion.” (Doc. 324 at 4.) Cameron
22 did not produce communications with trial counsel, based upon the holding in *Seagate*, wherein
23 the court held that ““asserting the advice of counsel defense and disclosing opinions of opinion
24 counsel do not constitute waiver of the attorney-client privilege for communications with trial
25 counsel.”” (Doc. 324 at 4-5.)

26 Cameron points out that it and opinion counsel compiled and produced a detailed
27 privilege log pertaining to the documents and categories of documents withheld based upon
28 assertions of the attorney-client and work product privilege. It states it took special care to redact

1 privileged information from that which must be produced and noted the redactions in the
2 privilege log. (Doc. 324 at 5 & Ex. 10.) Cameron also took care to redact information
3 “unrelated to infringement issues, which is the subject matter of the noninfringement Opinion” in
4 reliance upon *In re EchoStar*, 448 F.3d at 1297. (*Ibid.*)

5 Cameron states that in response to Duhn’s deposition requests, it “presented its opinion
6 counsel for deposition on June 23, 2009” and filed a motion to quash the deposition of Manish
7 Vyas seeking this Court’s guidance.² (Doc. 324 at 6.) Cameron points out Duhn’s “refusal to
8 recognize [its] in-house trial counsel as ‘real trial counsel.’” (Doc. 324 at 6.)

9 IV.

10 THE DISCOVERY AT ISSUE

11 The purpose of discovery is to make trial "less a game of blind man's bluff and more a
12 fair contest with the basic issues and facts disclosed to the fullest practicable extent possible."
13 *United States v. Procter & Gamble*, 356 U.S. 677, 683 (1958). Discovery will also serve to
14 narrow and clarify the issues in dispute. *Hickman v. Taylor*, 329 U.S. 495, 501 (1947).

15 Federal Rules of Civil Procedure rule 26(b) establishes the scope of discovery and states
16 in pertinent part:

17 Parties may obtain discovery regarding any matter, not privileged, that is relevant
18 to the claim or defense of any party, including the existence, description, nature, custody,
19 condition, and location of any books, documents, or other tangible things and the identity
20 and location of persons having knowledge of any discoverable matter. For good cause,
the court may order discovery of any matter relevant to the subject matter involved in the
action. Relevant information need not be admissible at trial if the discovery appears
reasonably calculated to lead to the discovery of admissible evidence.

21 "The party who resists discovery has the burden to show that discovery should not be
22 allowed, and has the burden of clarifying, explaining, and supporting its objections." *Oakes v.*
23 *Halvorsen Marine Ltd.*, 179 F.R.D 281, 283 (C.D. Cal. 1998); *Nestle Foods Corp. v. Aetna*
24 *Casualty & Surety Co.*, 135 F.R.D. 101, 104 (D. N.J. 1990).

25 Here, Plaintiff Duhn asserts, (1) it is entitled to see all documents regarding non-
26 infringement opinions and documents relating to Defendant’s reliance upon the opinions; (2) it is
27

28 ²Cameron’s motion to quash (Doc. 309) was effectively withdrawn on August 4, 2009 (Doc. 326).

entitled to responses from Defendant regarding verbal and written assessments of the risk of infringement; (3) that Defendant lacks a valid reason for failing to produce witnesses pursuant to Federal Rules of Civil Procedure rule 30(b)(6); (4) that Duhn is entitled to take the deposition of Manish Vyas; and (5) that good cause exists to compel production of the witness for deposition and for the production of documents and information. (Doc. 308.)

A. The Eighth Set of Interrogatories - Numbers 35 & 37-40

On or about May 14, 2009, Duhn propounded its Eighth Set of Interrogatories to Cameron. (Doc. 324, Ex. 5.)

Cameron does not specifically respond to Duhn's interrogatory requests in its Joint Statement argument. Rather, Cameron stated it has "produced all documents in the Categories 1 and 3 which the Federal Circuit held in *Echostar* are subject to the waiver triggered by the advice-of-counsel defense" and that Duhn has not presented this Court with "any proof of the 'unique circumstances to extend waiver to trial counsel . . . set forth in *Seagate*.'" (Doc. 324 at 29.)

Plaintiff's interrogatories and Defendant's specific responses thereto are as follows:

INTERROGATORY NO. 35:

Identify each and every counsel that provided an opinion regarding whether or not YOUR ACCUSED DEVICES infringe the '925 patent.

RESPONSE TO INTERROGATORY NO. 35:

Defendant Cameron incorporates by reference General Objections 1 through 3 as if fully stated here. Subject to and without waiving its objections, defendant responds as follows:

Lee Eubanks
Tait R. Swanson
Fletcher Yoder
7915 FM 1960 West, Suite 330
Houston, TX 77070

INTERROGATORY NO. 37:

Set forth, with particularity, the opinion(s) prepared by any CAMERON in house or outside counsel regarding whether or not YOUR ACCUSED DEVICES infringe the '925 patent.

RESPONSE TO INTERROGATORY NO. 37:

Defendant Cameron incorporate by reference General Objections 1 through 3 as if fully stated herein. Subject to and without waiving its objections, Defendant responds as follows:

Pursuant to Rule 33(d) of the Federal Rules of Civil Procedure, Defendant Cameron refers to records produced in this action from which information responsive to this Interrogatory may be derived or ascertained. The legal Opinion provided by Lee Eubanks and Tait Swanson of the Fletcher Yoder law firm, and the

related billing records, were produced as document numbers CAM44245-44972.

INTERROGATORY NO. 38:

Identify each and every document and discussion that was used by counsel to prepare the opinions set forth in YOUR response to interrogatory number 37.

RESPONSE TO INTERROGATORY NO. 38:

Defendant Cameron incorporate by reference General Objections 1 through 3 as if fully stated herein. Subject to and without waiving its objections, Defendant responds as follows:

Pursuant to Rule 33(d) of the Federal Rules of Civil Procedure, Defendant Cameron refers to records produced in this action from which information responsive to this Interrogatory may be derived or ascertained. The legal Opinion provided by Lee Eubanks and Tait Swanson of the Fletcher Yoder law firm, and the related billing records, were produced as document numbers CAM44245-44972.

INTERROGATORY NO. 39:

Identify each person to whom any of the opinion(s) set forth in YOUR response to interrogatory number 37 were communicated to, whether communicated in document, electronic, or oral form.

RESPONSE TO INTERROGATORY NO. 39:

Manish Vyas - written opinion communicated in document and oral form.

Thomas Taylor - opinion communicated in oral form.

INTERROGATORY NO. 40:

Identify the specific counsel(s) [*sic*] and opinion(s) that CAMERON relied upon in deciding to introduce its NEW STYLE and ORIGINAL DESIGN FRAC MANDRELS.

RESPONSE TO INTERROGATORY NO. 40:

Defendant Cameron incorporates by reference General Objections 1 through 3 as if fully stated herein. Subject to and without waiving its objections, Defendant responds that it relied in part upon the opinion of Duhn Oil's designated technical expert George Boyadjieff, who asserted in his expert report dated August 10, 2007 that the asserted claims of the '925 patent required a "dual load path," which he described as "two independent load paths" used "to absorb the axial force," and the opinion of Duhn Oil's designated technical expert, corporate representative, and named inventor on the asserted '925 patent, Rex Duhn, who testified at pages 39-40 of his September 19, 2007 deposition that "[y]ou would have to contact shoulder for the [lockscrew] to engage . . . [t]o react the force on the elongate mandrel," and even when the lockscrew is "screwed in real tight" to contact the frac mandrel there "would be insufficient friction coefficient to maintain the mandrel" because "You would have no shear point."

(Doc. 324, Ex. 5 at 6-7 & Ex. 11 at 4-5.) The general objections by Defendant Cameron include attorney-client privilege and attorney work product doctrine, an assertion that each is unreasonably burdensome and oppressive, and that the "Definitions" and "Instructions" impose burdens and obligations greater or different than those provided for in the Federal Rules of Civil Procedure, or give meanings other than their ordinary meaning. (Doc. 324, Ex. 11 at 2.)

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B. The Seventh Set of Requests for Production

On or about May 13, 2009, Duhn propounded its Seventh Set of Requests for Production of Documents to Cameron. (Doc. 324, Ex. 6.)

Plaintiff complains that Cameron responded to its seventh request for production of documents by “producing just a single document, the Fletcher Yoder Opinion.” The seventh request included thirty separate requests for production of documents. (Doc. 324 at 8, emphasis in original.)

1. Numbers 104, 106-113, 115-116, 118-119, 121-122 & 124-127

The requests provide as follows:

REQUEST FOR PRODUCTION NO. 104

Any and all documents evidencing communications between YOU and any and all attorneys acting on YOUR behalf regarding the ‘925 PATENT.

REQUEST FOR PRODUCTION NO. 106

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

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.

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 FOR PRODUCTION NO. 109

Any and all documents 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.

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.

REQUEST FOR PRODUCTION NO. 111

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 ORIGINAL STYLE FRAC MANDREL, including without limitation those documents relating to whether or not the ORIGINAL STYLE FRAC MANDREL infringed the ‘925 patent.

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 relating to the ‘925 PATENT, or

1 the ACCUSED DEVICES, including, without limitation, e-mail archive files,
2 locally stored files, network stores files, Exchange files, PST files, MSF files, and
3 mailbox files.

4 **REQUEST FOR PRODUCTION NO. 113**

5 Any and all mail store files for Thomas Taylor that evidence, refer or
6 relate to any oral or written advice of counsel relating to the '925 PATENT, or the
7 ACCUSED DEVICES, including, without limitation, e-mail archive files, locally
8 stored files, network stores files, Exchange files, PST files, MSF files, and
9 mailbox files.

10 **REQUEST FOR PRODUCTION NO. 115**

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

16 **REQUEST FOR PRODUCTION NO. 116**

17 Any and all emails, email attachments, and instant messages to or from
18 Thomas Taylor that evidence, refer or relate to any oral or written advice of
19 counsel relating to the '925 PATENT, including, without limitation, e-mail
20 archive, locally stored files, network stores files, Exchange files, PST files, MSF
21 files, mailbox files, and mail stores.

22 **REQUEST FOR PRODUCTION NO. 118**

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

28 **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.

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.

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.

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.

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.

REQUEST FOR PRODUCTION NO. 126

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

REQUEST FOR PRODUCTION NO. 127

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

(Doc. 324, Ex. 6 at 7-12.)

Cameron objected to foregoing requests on the following bases: (1) unreasonably burdensome and oppressive; (2) protected from disclosure by privilege, including the attorney-client privilege and the attorney work product doctrine; (3) documents do not exist and/or are not within Cameron's possession, custody or control; and (5) the "Definitions" and "Instructions" impose burdens and obligations on Cameron greater than those set forth in the Federal Rules of Civil Procedure. Yet, Cameron stated that "relevant non-objectionable documents responsive to this request . . . will be made available for inspection and copying . . ."

Duhn has not received responsive documents to these requests. (Docs. 324 at 8 & 325, Ex. 9.) In its motion to compel the requested documents, Duhn relies upon *In re Echostar Commc'n Corp.*, 448 F.3d at 1302-1303, in support of its position.

2. Numbers 114, 117, 120, 123, & 128-130

The requests provide as follows:

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 stores files, network stored files, Exchange files, PST files, MSF files, mailbox files, and mail store files.

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.

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 stop selling 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 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 stop selling its ORIGINAL STYLE FRAC MANDREL, including without limitation those documents relating to whether or not the ORIGINAL STYLE FRAC MANDREL infringed the '925 PATENT.

REQUEST FOR PRODUCTION NO. 128

Any and all documents that evidence, refer or relate to any oral or written advice of counsel relating to any checklists regarding the installation and use of YOUR ACCUSED DEVICES.

REQUEST FOR PRODUCTION NO. 129

Any and all documents that evidence, refer or relate to any oral or written advice of counsel relating to any FRAC MANDREL identification tags or placards for any ACCUSED DEVICE.

REQUEST FOR PRODUCTION NO. 130

Any and all documents that evidence, refer or relate to any oral or written advice of counsel 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.

(Doc. 324, Ex. 6 at 9-12.)

Cameron objected to the forgoing requests on the following bases: (1) unreasonably burdensome and oppressive; (2) protected from disclosure by privilege, including the attorney-client privilege and the attorney work product doctrine; (3) documents do not exist and/or are not within Cameron's possession, custody or control; and (5) the "Definitions" and "Instructions" impose burdens and obligations on Cameron greater than those set forth in the Federal Rules of Civil Procedure. (Doc. 324, Ex. 9.)

3. Numbers 101-103 & 105

These requests provide as follows:

REQUEST FOR PRODUCTION NO. 101:

All documents that evidence, refer or relate to any opinion of counsel, whether oral or written, upon which YOU intend to rely in support of an advice of counsel defense to any claims asserted by DUHN.

REQUEST FOR PRODUCTION NO. 102:

All documents that evidence, refer or relate to any opinion of counsel, whether oral or written, regarding the validity, enforceability, and/or infringement of the '925 PATENT on which YOU intend to rely as evidence that any infringement of the '925 PATENT was not willful or deliberate.

REQUEST FOR PRODUCTION NO. 103:

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

1 **REQUEST FOR PRODUCTION NO. 105:**

2 Any and all documents evidencing communications between YOU and
3 any other PERSON(S) regarding the '925 PATENT.

4 (Doc. 324, Ex. 6.)

5 **C. The Deposition of Manish Vyas**

6 On or about June 10, 2009, Duhn noticed the deposition of Manish Vyas for June 25,
7 2009, in Houston, Texas. Mr. Vyas was specifically identified as “in-house counsel for Cooper
8 Cameron Corporation.” (Doc. 324, Ex. 7.) On or about June 21, 2009, Cameron moved to quash
9 the depositions of “its in-house counsel for June 23 and 25, 2009.” (Doc. 324, Ex. 12.)

10 Cameron requests that “this Court provide guidance to the parties regarding the scope of
11 the subject matter waiver triggered by the advice-of-counsel defense” and “implement guidelines
12 for these depositions to insure that Duhn will not be allowed to inquire regarding attorney-client
13 privileged communications . . .” (Doc. 324 at 30.) Further, Cameron acknowledged

14 that all communications between Cameron (including Mr. Vyas) and its opinion
15 counsel regarding the subject matter of the noninfringement Opinion are within
16 the scope of the waiver, so Mr. Vyas is prepared to testify as to all of his
17 communications with Cameron’s opinion counsel regarding the subject matter of
18 the noninfringement opinion, but Mr. Vyas’ role as trial counsel must preclude
19 Duhn’s attempts at further inquiry into Mr. Vyas’ communications with Cameron
20 personnel regarding issues other than the Opinion itself.

21 (*Ibid.*) Additionally, Cameron asks this Court to recognize that the waiver of the attorney-client
22 privilege, following assertion of an advice-of-counsel defense, does not extend to
23 communications concerning other defenses to infringement. (*Ibid.*) Lastly, Cameron asks this
24 Court to recognize the waiver must be limited to information in or after August 2007 because
25 Duhn’s allegations are limited to Cameron’s “New Style” and “Original” design frac mandrels.
26 (*Id.*, at 31.)

27 **D. Deposition of Cooper Cameron Corporation**

28 On or about June 16, 2009, Plaintiff noticed the deposition of Cooper Cameron
Corporation, pursuant to Federal Rules of Civil Procedure, rules 26 and 30(b)(6)³, for June 23,

³Rule 30(b)(6) of the Federal Rules of Civil Procedure provides:

. . . In its notice or subpoena, a party may name as the deponent a public or private corporation, a
partnership, an association, a governmental agency, or other entity and must describe with
reasonable particularity the matters for examination. The named organization must then designate

1 2009, in Houston, Texas. (Doc. 324, Ex. 8.) On or about June 21, 2009, Cameron moved to
2 quash the deposition. (Doc. 324, Ex. 12.)

3 Cameron's position regarding this deposition mirrors that detailed above regarding the
4 deposition of Manish Vyas. *See* subheading C, *ante*.

5 V.

6 DISCUSSION AND ANALYSIS

7 In a controversy surrounding assertions of privilege in a patent case, substantive patent
8 law applies, so the law of the Federal Circuit governs, rather than the law of the regional circuit.
9 *In re EchoStar Commc'ns Corp.*, 448 F.3d 1294, 1298 (Fed. Cir. 2006).

10 "The attorney-client privilege and the work-product doctrine, though related, are two
11 distinct concepts and waiver of one does not necessarily waive the other." *Carter v. Gibbs*, 909
12 F.2d 140, 1451 (Fed. Cir. 1990) (en banc), superceded in non-relevant part, Pub.L. No. 104-424,
13 § 9(c), 108 Stat. 4361 (1994), as recognized in *Mudge v. United States*, 308 F.3d 1220, 1223
14 (Fed. Cir. 2002). A client can waive the attorney-client privilege by asserting the defense of
15 advice-of-counsel. *In re EchoStar Commc'ns Corp.*, 448 F.3d at 1299; *Carter*, 909 F.2d at 1451.
16 The attorney-client privilege is waived as to communications regarding the same subject matter.
17 *In re EchoStar Commc'ns Corp.*, at 1301. Work product doctrine waiver is not a broad waiver of
18 all work product related to the same subject matter like the attorney-client privilege.

19 In *In re EchoStar Commc'ns Corp.*, TiVo brought suit for infringement against EchoStar,
20 pertaining to its United States Patent No. 6,233,389 ("the '389 patent"). EchoStar asserted the
21 defense of reliance on advice of counsel. TiVo sought production of certain documents in
22 possession of Merchant & Gould, from whom EchoStar obtained advice, but upon whom's
23 advice EchoStar chose not to rely. The district court ruled that EchoStar had waived its attorney-
24 client privilege and attorney work-product immunity relating to advice of any counsel regarding
25 infringement, including Merchant & Gould. It held the waiver included communications that

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27 one or more officers, directors, or managing agents, or designate other persons who consent to
28 testify on its behalf; and it may set out the matters on which each person designated will testify. A
subpoena must advise a nonparty organization of its duty to make this designation. The persons
designated must testify about information known or reasonably available to the organization . . .

1 occurred before or after the filing of the complaint and any work product, whether or not it was
2 communicated to EchoStar. EchoStar could redact only information related to trial preparation
3 or information unrelated to the alleged infringement. EchoStar produced communications,
4 including two infringement opinions prepared by Merchant & Gould, but did not produce work
5 product related to the Merchant & Gould opinions. *In re EchoStar Commc'ns Corp.*, 448 F.3d at
6 1297.

7 In response to the district court's ruling, the parties sought clarification. TiVo argued that
8 the court should order EchoStar to produce all Merchant & Gould documents relating to the
9 advice of counsel defense, including documents not in its possession because the information
10 was not communicated to EchoStar. EchoStar, on the other hand, asserted it should be required
11 to produce only those documents it was provided by Merchant & Gould. *In re EchoStar*
12 *Commc'ns Corp.*, 448 F.3d at 1297.

13 In its order clarifying the previous order, the district court found the waiver of immunity
14 extended to all work product of Merchant & Gould even where it had not been communicated to
15 EchoStar. The district court reasoned that the documents could be relevant or lead to the
16 discovery of admissible evidence. EchoStar petitioned for a writ of mandamus to the Federal
17 Circuit. *In re EchoStar Commc'ns Corp.*, 448 F.3d at 1297.

18 The Federal Circuit reaffirmed that “[o]nce a party announces that it will rely on advice of
19 counsel, for example, in response to an assertion of willful infringement, the attorney-client
20 privilege is waived.” *In re EchoStar Commc'ns Corp.*, 448 F.3d at 1299. In response to
21 EchoStar's argument that it intended to rely on in-house counsel and in-house investigation, as
22 distinguished from advice counsel, the Federal Circuit found

23 when EchoStar chose to rely on the advice of in-house counsel, it waived the
24 attorney-client privilege with regard to any attorney-client communications
25 relating to the same subject matter, including communications with counsel other
than in-house counsel, which would include communications with Merchant &
Gould.

26 *Ibid.*

1 With regard to EchoStar's argument that the district court erred by ordering that it
2 produce communications never communicated from Merchant & Gould to EchoStar, the Federal
3 Circuit agreed:

4 In contrast to the attorney-client privilege, the work-product doctrine, or
5 work-product immunity as it is called, can protect "documents and tangible
6 things" prepared in anticipation of litigation that are both non-privileged and
7 relevant. Unlike the attorney-client privilege, which protects all communication
8 whether written or oral, work-product immunity protects documents and tangible
9 things, such as memorandums, letters, and e-mails. We recognize work-product
immunity because it promotes a fair and efficient adversarial system by protecting
the attorney's thought processes and legal recommendations from the prying eyes
of his or her opponent. Essentially, the work-product doctrine encourages
attorneys to write down their thoughts and opinions with the knowledge that their
opponents will not rob them of the fruits of their labor. . . .

10 Like the attorney-client privilege, however, the work-product doctrine is
11 not absolute. First, a party may discover certain types of work product if they
12 have substantial need . . . and the party is unable without undue hardship to obtain
13 [the material] by other means. . . . [¶] Second, a party may discover work product
if the party waives its immunity. However, work product waiver is not a broad
waiver of all work product related to the same subject matter like the attorney-
client privilege. Instead, work-product waiver only extends to factual or non-
opinion work product concerning the same subject matter as the disclosed work
product.

14 We recognize that the line between factual work product and opinion work
15 product is not always distinct When faced with the distinction between where
that line lies, however, a district court should balance the policies to prevent
sword-and-shield litigation tactics with the policy to protect work product.

16 That being said, we recognize at least three categories of work product that
17 are potentially relevant to the advice-of-counsel defense here. They include: (1)
18 documents that embody a communication between the attorney and client
concerning the subject matter of the case, such as a traditional opinion letter; (2)
19 documents analyzing the law, facts, trial strategy, and so forth that reflect the
attorney's mental impressions but were not given to the client; and (3) documents
that discuss a communication between attorney and client concerning the subject
matter of the case but are not themselves communications to or from the client.
20 . . . [W]e conclude that waiver extends to the third category but does not extend so
far as the second.

21
22 *In re EchoStar Commc'ns Corp.*, 448 F.3d at 1301-1303, internal citations & quotation marks
23 omitted. The Federal Circuit held that work product never communicated to the client is not
24 discoverable. That type of work-product deserves the greatest protection from disclosure. *Id.*, at
25 1303. Counsel's mental impressions and legal opinions not communicated do not become
26 evidence of non-privileged, relevant facts, and thus are not within the scope of the waiver. *Id.*, at
27 1303-1304. Uncommunicated legal opinion and mental impressions "provide little if any
28 assistance to the court in determining whether the accused knew it was infringing, and any

1 relative value is outweighed by the policies supporting the work-product doctrine.” *Id.*, at 1304.

2 In sum, the Federal Circuit concluded that

3 when an alleged infringer asserts its advice-of-counsel defense regarding willful
4 infringement of a particular patent, it waives its immunity for any document or
5 opinion that embodies or discusses a communication to or from it concerning
6 whether that patent is valid, enforceable, and infringed by the accused. This
7 waiver of both the attorney-client privilege and the work-product immunity
8 includes not only any letters, memorandum, conversation, or the like between the
9 attorney and his or her client, but also includes, when appropriate, any documents
10 referencing a communication between attorney and client.

11 *Ibid.*

12 In *In re Seagate Technology, LLC*, 497 F.3d 1360 (Fed. Cir. 2007), Convolv, Inc. and
13 MIT sued Seagate for patent infringement. Prior to the lawsuit, Seagate retained attorney George
14 Sekimura to provide opinions regarding Convolv’s patents. Opinion counsel operated
15 separately from Seagate’s trial counsel at all times. Seagate notified Convolv that it intended to
16 rely on Sekimura’s three opinion letters in defense of Convolv’s willful infringement allegation.
17 It disclosed Sekimura’s work product and made him available for deposition. Convolv moved
18 to compel discovery of communications and work product of Seagate’s other counsel, including
19 trial counsel. The district court concluded that Seagate waived the attorney-client privilege for
20 all communications between it and any counsel concerning the subject matter of Sekimura’s
21 opinions, that the waiver commenced with Seagate’s knowledge of the patents and would
22 continue until the alleged infringement ceased, or ordered production of any requested
23 documents and testimony concerning the subject matter of Sekimura’s three opinions. Seagate
24 petitioned for a writ of mandamus. *In re Seagate Technology, LLC*, 497 F.3d at 1366-1367.

25 In *Seagate*, the Federal Circuit was to confront the willfulness scheme and its functional
26 relationship compared to the attorney-client privilege and work product protection, and whether
27 waiver resulting from advice of counsel and work product defenses extend to trial counsel, a
28 question not answered in its previous *EchoStar* holding. *In re Seagate Technology, LLC*, 497
F.3d at 1370. In relevant part, the Federal Circuit stated

district courts have reached varying results with respect to trial counsel. Some
decisions have extended waiver to trial counsel, whereas others have declined to
do so. Still others have taken a middle ground and extended waiver to trial

1 counsel only for communications contradicting or casting doubt on the opinions
2 asserted.

3 Recognizing the value of a common approach . . . we conclude that the
4 significantly different functions of trial counsel and opinion counsel advise
5 against extending waiver to trial counsel. Whereas opinion counsel serves to
6 provide an objective assessment for making informed business decisions, trial
7 counsel focuses on litigation strategy and evaluates the most successful manner of
8 presenting a case to a judicial decision maker. And trial counsel is engaged in an
9 adversarial process. We previously recognized . . . that defenses prepared [by
litigation counsel] for a trial are not equivalent to the competent legal opinion of
non-infringement or invalidity which qualify as due care before undertaking any
potentially infringing activity. Because of the fundamental difference between
these types of legal advice, this situation does not present the classic sword and
shield concerns typically mandating broad subject matter waiver. Therefore,
fairness counsels against disclosing trial counsel's communications on an entire
subject matter in response to an accused infringer's reliance on an opinion
counsel's opinion to refute a willfulness allegation.

10 *Id.*, at 1372-1373.

11 "Further outweighing any benefit of extending waiver to trial counsel is the realization
12 that in ordinary circumstances, willfulness will depend on an infringer's prelitigation conduct."

13 *Id.*, at 1374. And,

14 communications of trial counsel have little, if any, relevance warranting their
15 disclosure, and this further supports generally shielding trial counsel from the
16 waiver stemming from an advice of counsel defense to willfulness. Here, the
opinions of Seagate's opinion counsel, received after suit was commenced, appear
to be of similarly marginal value. . . .

17 In sum, we hold, as a general proposition, that asserting the advice of
18 counsel defense and disclosing opinions of opinion counsel do not constitute
19 waiver of the attorney-client privilege for communications with trial counsel. We
do not purport to set out an absolute rule. Instead, trial courts remain free to
exercise their discretion in unique circumstances to extend waiver to trial counsel,
such as if a party or counsel engages in chicanery. . . .

20 *Id.*, at 1374-1375.

21 With regard to the work product protection, the *Seagate* court held

22 as a general proposition, relying on opinion counsel's work product does not
23 waive work product immunity with respect to trial counsel. Again, we leave open
24 the possibility that situations may arise in which waiver may be extended to trial
25 counsel, such as if a party or his counsel engages in chicanery. And, of course,
the general principles of work product protection remain in force, so that a party
may obtain discovery of work product absent waiver upon a sufficient showing of
need and hardship, bearing in mind that a higher burden must be met to obtain that
pertaining to mental processes. *See* Fed. R. Civ. Pro. 26(b)(3).

26 Finally, the work product doctrine was partially codified in Rule 26(b)(3)
27 of the Federal Rules of Civil Procedure, which applies work product protection to
28 "documents and tangible things." Courts continue to apply *Hickman v. Taylor*,
329 U.S. 495 [], to "nontangible" work product. *See, e.g., In re Cendant Corp.*
Sec. Litig., 343 F.3d 658, 662-63 (3d Cir. 2003); *United States v. One Tract of*

1 *Real Property*, 95 F.3d 442, 428 n. 10 (6th Cir. 1996). This is relevant here
2 because Convolv sought to depose Seagate’s trial counsel. We agree that work
3 product protection remains available to “nontangible” work product under
 Hickman. Otherwise, attorneys’ files would be protected from discovery, but
 attorneys themselves would have no work product objection to depositions.

4 *In re Seagate Technology, LLC*, 497 F.3d at 1376.

5 ***Application***

6 Cameron waived its “attorney-client privilege with regard to any attorney-client
7 communications relating to the same subject matter, including communications with counsel
8 other than in-house counsel.” *EchoStar*, at 1299. Cameron, in asserting the defense of advice of
9 counsel in response to an assertion of willful infringement, may not rely upon the attorney-client
10 privilege. Thus, Cameron must respond to any interrogatories, and produce any documents,
11 relating to this subject, including any communications with counsel other than in-house counsel.

12 Three categories were identified by the *EchoStar* court as potentially relevant to an advice
13 of counsel defense: documents that embody a communication between the attorney and client
14 concerning the subject matter of the case, such as a traditional opinion letter; documents
15 analyzing law, facts, trial strategy, and so forth that reflect the attorney’s mental impressions that
16 were not given to the client; and, documents that discuss a communication between attorney and
17 client concerning the subject matter of the case but are not themselves communications to or
18 from the client. The second category identified - documents analyzing law, facts, trial strategy,
19 and so forth that reflect the attorney’s mental impressions but were not given to the client -
20 remain protected by the work- product doctrine, and thus, Cameron need not produce them.
21 *EchoStar*, at 1301-1303.

22 Here however, the issue is more complex because Mr. Vyas has been identified as both
23 in-house counsel for Cameron *and* trial counsel, along with Charles Rogers. Duhn argues that
24 Mr. Vyas is in-house counsel only, and in the Joint Statement pointed out that Mr. Vyas was not
25 licensed to practice law in California, nor had he applied for *pro hac vice* status in this matter.
26 The Joint Statement was filed on August 4, 2009. (Doc. 324.) The day prior however, on
27 August 3, 2009, a *pro hac vice* application was submitted to this Court, accompanied by the
28 necessary fee, on behalf of Manish B. Vyas. (See Doc. 321.) On August 3, 2009, District Judge

1 Oliver W. Wanger signed an Order approving the application, and the Order was docketed on
2 August 5, 2009. (Doc. 327.)⁴

3 Even prior to the submission of the *pro hac vice* application, Duhn asserted that
4 Cameron’s characterization of Mr. Vyas as trial counsel was inappropriate and was in fact
5 evidence of Cameron employing the “sword-and-shield litigation tactics” that *EchoStar* warned
6 against. (Doc. 324.)

7 Cameron responds that this Court should “recognize Cameron’s in-house trial counsel
8 Manish Vyas as Cameron’s ‘real trial counsel,’ along with Cameron’s other trial counsel Charles
9 J. Rogers.” This is so, argues Cameron, because various excerpts from the transcripts of “the ten
10 hearings held so far in this action show [that] Mr. Vyas and Mr. Rogers have both been actively
11 serving as Cameron’s trial counsel since the outset of this action.” (Doc. 324 at 29.)

12 Interestingly, the Court notes that Mr. Vyas had not been previously identified as “in
13 house *trial* counsel” by Cameron. While Mr. Vyas certainly appeared along with Mr. Rogers for
14 a number of appearances, he was identified only as “in house counsel” or “Managing Attorney,
15 Patent Services” for Cameron in the majority of those occasions. (*See* Doc. 324, Ex. 19 at 4 & 6
16 [“here today also our in-house counsel at the Cooper Cameron Corporation, Manish Vyas”], 54
17 [“and I have with me our in-house counsel, Mr. Manish Vyas”], 62-63 [in-house counsel], 72
18 [“Manish Vyas, in-house counsel for Cameron International”], 97 [“I have with me Mr. Manish
19 Vyas and Peter Belinski, in-house counsel at Cameron”].) Otherwise, Mr. Vyas remained
20 unidentified as to his status as counsel in the remaining appearances. (*See cf.* Doc. 324, Ex. 19 at
21 38, 42, 45, 157).⁵ Notably too, while Mr. Vyas has certainly participated in a number of hearings
22 before the Court, the Court notes that he was not present for the initial scheduling conference, or
23 scheduling conferences that did not otherwise follow a more substantive hearing. (*See, e.g.*
24 Docs. 14 & 162.)

25
26
27 ⁴Mr. Rogers’ *pro hac vice* application, by comparison, was submitted on February 13, 2006 (Doc. 8) and
28 granted on February 16, 2006 (Doc. 11).

⁵A number of the pages to Exhibit 19 do not reflect Mr. Vyas appearance at all, rather, only Mr. Rogers’
appearance is reflected in the transcript excerpts provided to the Court. *See* Doc. 324, Ex. 19 at 48-50, 67-68

1 This Court is not persuaded by Cameron’s recent assertion that Mr. Vyas is trial counsel
2 in this matter. Between the numerous appearances wherein Mr. Vyas is expressly identified as in
3 house counsel, the filing of Mr. Vyas’s *pro hac vice* application just *one* day prior to the filing of
4 the instant joint statement (particularly where this litigation commenced in 2005), as well as
5 Cameron’s own August 2009 pleading wherein it moved to quash the deposition of “in house
6 counsel,” the record clearly belies this assertion. Moreover, this Court is free to exercise its
7 discretion in “unique circumstances to extend waiver to trial counsel” and finds this case presents
8 unique circumstances justifying its finding.⁶ *Seagate*, 497 F.3d at 1375.

9 Further, as the *Seagate* court acknowledged, district courts retain the ability to find a
10 waiver of the work product doctrine where “situations may arise in which waiver may be
11 extended to trial counsel . . .” *In re Seagate Technology, LLC*, 497 F.3d at 1376. For the
12 reasons given above, this Court is concerned with the sword-and-shield litigation tactics
13 employed in this matter. Thus, the Court believes its finding represents a fair balance between
14 the policy to prevent sword-and-shield litigation tactics with the policy to protect work product.

15 ***The Interrogatories***

16 Duhn’s motion to compel responses to the identified interrogatories is GRANTED. For
17 the reasons stated above, Cameron shall respond to Interrogatory Numbers 35, 37, 38, 39 and 40.
18 Cameron’s objections thereto are overruled.

19 ***The Requests for Production***

20 Duhn’s motion to compel responses to the identified request for production is
21 GRANTED IN PART for the reasons outlined above. Cameron shall respond to Request for
22 Production numbers 103 through 104, 106 through 113, 115 through 116, 118 through 119, 121
23
24

25 ⁶Compare *Celerity, Inc. v. Ultra Clean Holding, Inc.*, 476 F.Supp.2d 1159, 1167 (N.D.
26 Cal. 2007), where trial counsel and opinion counsel hailed from the same law firm:

27 The Court doesn’t presume to mandate who a litigant hires as trial counsel and
28 opinion counsel, nor to forbid the hiring of the same firm as both trial counsel and
opinion counsel, but it does seem risky, and a litigant shouldn’t presume the
privilege of shielding all opinion-related work product and communications to
which trial counsel is privy.

1 through 122, and 124 through 130. For the reasons provided herein, Cameron's objections
2 thereto are otherwise overruled.

3 However, with regard to Requests for Production numbers 114, 117, 120, and 123,
4 Duhn's motion is DENIED because the requests seek information from trial counsel Charles
5 Rogers.

6 ***The Depositions***

7 *Manish Vyas*

8 Duhn's motion to compel the deposition of attorney Manish Vyas is GRANTED. In light
9 of this Court's finding that Mr. Vyas is more properly considered in house counsel for Cameron,
10 rather than trial counsel, his deposition will proceed.

11 With regard to the scope of Mr. Vyas's deposition, and in light of this Court's finding that
12 Mr. Vyas has been consistently identified as "in house counsel" rather than trial counsel, Mr.
13 Vyas will testify at his deposition consistent with his obligation as in house counsel, up to and
14 including August 3, 2009, wherein Mr. Vyas submitted a *pro hac vice* application with this
15 Court. In other words, Mr. Vyas's status as trial counsel, if in fact he intends to participate
16 alongside Mr. Rogers, commences as of August 3, 2009, but not before that date.

17 Any objection asserted by Cameron is overruled.

18 *Cooper Cameron Corporation*

19 Duhn's motion to compel the deposition of Cooper Cameron Corporation is GRANTED.
20 Any objection asserted by Cameron is overruled.

21 **CONCLUSION AND ORDER**

22 The Court finds that Cameron has waived attorney-client privilege and the work product
23 doctrine for all attorney-client communications on the same subject matter as the opinion relied
24 on, for all work product which references such communications, and for all work product on the
25 same subject matter which was communicated to the client.

26 For the reasons discussed above, this Court hereby ORDERS as follows:
27
28

1. Cameron shall provide supplemental responses to Interrogatory numbers 35, 37, 38, 39, and 40 of Duhn's Eighth Set of Interrogatories within fourteen (14) days of the date of this Order;
2. Cameron shall provide supplemental responses to Request for Production numbers 103 through 104, 106 through 113, 115 through 116, 118 through 119, 121 through 122, and 124 through 130 of Duhn's Seventh Request for Production of Documents within fourteen (14) days of the date of this Order;
3. Cameron's in house counsel, Manish Vyas, shall submit to a deposition, in accordance with this Order, within thirty (30) days of the date of this Order;
4. Pursuant to Rule 30(b)(6) of the Federal Rules of Civil Procedure, Cameron shall identify a designee who shall submit to a deposition, in accordance with this Order, within thirty (30) days of the date of this Order.

IT IS SO ORDERED.

Dated: October 15, 2009

/s/ Gary S. Austin
UNITED STATES MAGISTRATE JUDGE