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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION

In re Application of AIS GMBH AACHEN
INNOVATIVE SOLUTIONS & ABIOMED
EUROPE GMBH, Petitioners, for an Order
Pursuant to 28 U.S.C. § 1782 to Take
Discovery for Use in Foreign Proceedings,
Pursuant to the Federal Rules of Civil
Procedure, of Respondent Thoratec LLC

Case No. [5:16-mc-80094-HRL](#)

**ORDER DEEMING MOOT
THORATEC, LLC'S MOTION TO
DISQUALIFY COUNSEL**

Re: Dkt. No. 19

This is a miscellaneous action ancillary to patent litigation in Germany. The German action was filed by AIS GmbH Aachen Innovative Solutions (AIS) and Abiomed Europe (Abiomed) against Thoratec, LLC (Thoratec). AIS and Abiomed are represented in Germany by the Bird & Bird law firm. Pursuant to 28 U.S.C. § 1782, the present miscellaneous action was filed here by the Ropes & Gray law firm to obtain discovery from Thoratec in aid of the German litigation.

Thoratec moved for an order from this court disqualifying Ropes & Gray, as well as a motion to stay discovery in this miscellaneous proceeding pending resolution of the disqualification issue. In sum, Thoratec says that Bird & Bird has a conflict of interest because that firm previously represented Thoratec with respect to patents that are at issue in Germany.¹

¹ Details concerning Bird & Bird's prior representation have been sealed and need not be discussed here.

1 Ropes & Gray was not involved in Bird & Bird's prior representation of Thoratec. Nor has it
2 entered an appearance in the German lawsuit. Nevertheless, Thoratec contends that, by working
3 with Bird & Bird in the present proceeding before this court, Ropes & Gray has been tainted by
4 Bird & Bird's alleged conflict of interest. Bird & Bird is not before this court; and, according to
5 Thoratec, there is no disqualification procedure in Germany---or at least not one that Thoratec
6 finds practicable.

7 In response, and while it disputed that there was any basis for disqualification, Ropes &
8 Gray advised that it was willing to bow out from this miscellaneous action. To that end, the firm
9 filed a notice of its withdrawal from this case and substitution of new counsel, the LeClairRyan
10 law firm. LeClairRyan apparently represented that it has not received any information or had
11 conversations with Ropes & Gray or Bird & Bird about the subject matter of this action; has not
12 received any work product from Ropes & Gray or Bird & Bird; and will not discuss the subject
13 matter of this action with Ropes & Gray or Bird & Bird.

14 Based on LeClairRyan's representations, Thoratec withdrew its motion for a discovery
15 stay. Nevertheless, it is dissatisfied with Ropes & Gray's withdrawal from this matter because it
16 doesn't feel that the withdrawal goes far enough. Thoratec requests that this court issue an order
17 prohibiting Ropes & Gray from communicating with Bird & Bird about three patents (two
18 European patents and one U.S. patent) that Thoratec says give rise to Bird & Bird's conflict of
19 interest.

20 Ropes & Gray contends that Thoratec's motion to disqualify is moot. It says that what
21 Thoratec actually seeks is a global injunction prohibiting European counsel from communicating
22 with one another in patent litigation pending there. Ropes & Gray advises that its lawyers in
23 London are representing AIS and Abiomed in patent litigation against Thoratec in the United
24 Kingdom (UK). This court is told that the UK suit involves two of the three patents that Thoratec
25 does not want Ropes & Gray to discuss with Bird & Bird. Bird & Bird is not involved in the UK
26 suit; and, as discussed above, Ropes & Gray is not involved in the German action. But Ropes &
27 Gray says that its European lawyers do talk with Bird & Bird in Europe about the patent suits
28 pending in the UK and Germany. Nonetheless, Ropes & Gray says that it has determined that it

1 has no conflict of interest under UK rules in proceeding in the UK litigation and that Bird & Bird
2 has determined that it has no conflict of interest under German rules with respect to the German
3 suit. As such, Ropes & Gray argues that there is no basis for this court to issue an injunction
4 against the lawyers in Europe.

5 Thoratec denies that it seeks a global injunction as to the European counsel in either the
6 UK or the German action. But, if this court issues an order granting the requested relief and that
7 order happens to affect the UK case being litigated by Ropes & Gray, then Thoratec says that is
8 simply a consequence to Ropes & Gray of having an international practice.

9 Pointing out that none of the cited cases limits disqualification geographically, Thoratec
10 says that under California's vicarious presumption rule, one attorney's conflict generally is
11 imputed to the entire firm. However, none of the cases cited by the parties addresses the specific
12 situation presented here where the scope of relief requested impacts the conduct of litigation
13 abroad, where different rules concerning potential or actual conflicts of interest may apply.
14 Thoratec maintains that this court has authority to grant the requested relief because this
15 miscellaneous action is ancillary to the German proceeding. But, the fact remains that Bird & Bird
16 is not before this court, and Ropes & Gray (the actual target of Thoratec's disqualification motion)
17 is not involved in the German action. And, while Ropes & Gray disputes that it has been "tainted"
18 by anything Bird & Bird may have done, it has voluntarily withdrawn from any further
19 involvement in this ancillary proceeding. This court therefore concludes that Ropes & Gray has
20 the better argument. To the extent Thoratec seeks an order enjoining or otherwise regulating the
21 conduct of counsel in other actions not before this court, it must seek relief from the adjudicators
22 in those actions. See *Thomas Kinkaide Co. v. Hazlewood*, No. C06-7034 MHP, 2007 WL
23 1655846, at *5-6 (N.D. Cal., June 6, 2007) (This court almost certainly lacks jurisdiction to
24 preclude plaintiffs' counsel from appearing in actions not before this court. Attempts to disqualify
25 plaintiffs' counsel from other proceedings are properly directed toward the adjudicators in those
26 actions.").

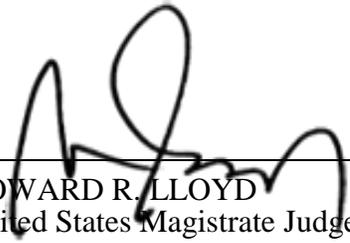
27 For the foregoing reasons, Thoratec's motion to disqualify Ropes & Gray is deemed moot.
28 Any additional relief Thoratec seeks beyond Ropes & Gray's voluntary withdrawal from this case

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is denied.

SO ORDERED.

Dated: April 5, 2017



HOWARD R. LLOYD
United States Magistrate Judge

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5:16-mc-80094-HRL Notice has been electronically mailed to:

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