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U.S. DISTRICT COURT  
DISTRICT OF COLUMBIA

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UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF COLUMBIA

NANCY MAYER WHITTINGTON, CLERK  
U.S. DISTRICT COURT

NANCY M.  
MAYER-WHITTINGTON  
CLERK

STATIC CONTROL COMPONENTS, INC.

3010 Lee Avenue  
Post Office Box 152  
Sanford, NC 27331,

PLAINTIFF/COUNTERCLAIM  
DEFENDANT

v.

LEXMARK INTERNATIONAL, INC.,

DEFENDANT/COUNTERCLAIM  
PLAINTIFF

v.

WAZANA BROTHERS INTERNATIONAL,  
INC. d/b/a MICRO SOLUTIONS ENTERPRISES

COUNTERCLAIM DEFENDANT

v.

PENDL COMPANIES, INC.

COUNTERCLAIM DEFENDANT

v.

NER DATA PRODUCTS, INC.

COUNTERCLAIM DEFENDANT

Pending in the United States District Court  
Eastern District of Kentucky, before the  
Honorable Gregory F. Van Tatenhove,  
Civil Action 04-CV-84-GFVT

~~CIVIL~~ ACTION NO.

CASE NUMBER 1:06MS00478

JUDGE: John D. Bates

DECK TYPE: Miscellaneous

DATE STAMP: 10/30/2006

**MOTION TO QUASH SUBPOENA  
SERVED ON OPPOSING PARTY'S TRIAL COUNSEL**

Pursuant to Fed. R. Civ. P. 45(c), the law firm of Constantine Cannon, P.C. ("Constantine Cannon") moves this Court to quash the October 19, 2006 subpoena that was served on it by Lexmark International, Inc. ("Lexmark). Under the guise of a subpoena, Lexmark seeks

deposition testimony and documents from Constantine Cannon related to its work as trial counsel for Static Control Components, Inc. ("Static Control"), a party that is suing and one of four parties being sued by Lexmark in the United States District Court for the Eastern District of Kentucky. Lexmark's ruse is nothing more than an inappropriate attempt to discover trial strategy and attorney work product from *all* of its opposing parties' counsel, ostensibly based on the unfounded belief that because *one* of the defendants (*not Constantine Cannon's client*) has asserted an "advice of counsel" defense, all attorney client privilege or work product of the *other* parties have been waived. Because the information sought by Lexmark constitutes attorney-client communication and attorney work product, and the privilege has not been waived, this Court should quash the subpoena, pursuant to Fed. R. Civ. P. 45(c), and award Static Control its legal fees incurred in connection with responding to the subpoena.

### **BACKGROUND**

#### **A. Nature Of The Underlying Litigation**

Constantine Cannon brings this motion in this Court because the subpoena at issue was issued under the caption of this Court. *See* Fed. R. Civ. P. 45(c)(1). The underlying litigation is pending in the United States District Court for the Eastern District of Kentucky, before the Honorable Gregory Van Tatenhove (the "Kentucky Litigation"). It is the consolidation of two lawsuits that have been pending, respectively, since 2002 and 2004. One of the cases was the subject of the Sixth Circuit's opinion in *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 387 F.3d 522 (6th Cir. 2004) (vacating preliminary injunction and remanding for further proceedings).<sup>1</sup>

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<sup>1</sup> In an effort not to burden the Court with an exhaustive collection of exhibits, Constantine Cannon submits as general support for this summary of the nature of the case Static Control's February 24, 2004 Complaint for Declaratory Judgment (attached as Exh. 1 to the Declaration of

The cases concern certain laser printer toner cartridges manufactured by Lexmark. Lexmark makes and sells laser printers and then attempts to “license” toner cartridges for those printers by means that include affixing fine-print labels to the cartridges in an effort to declare unilaterally that anyone who opens the cartridge box or uses the cartridge is a patent licensee of Lexmark, bound by the label “license” to use the cartridge only once and then return it to Lexmark. The object of this scheme is to prevent used cartridges from falling into the hands of companies known as “remanufacturers,” which repair used cartridges and refill them with toner so that they can be used again – at a price far below that of buying a new Lexmark cartridge. There are thousands of such remanufacturers in the United States.

Lexmark’s adversaries in these cases are three specific remanufacturers – NER Data Products, Inc.; Pendl Companies, Inc. (“Pendl”); and Wazana Brothers International, Inc. (collectively, the “Remanufacturers”) – along with the industry’s largest supplier of parts to such remanufacturers, Static Control.

In broad terms, Static Control and the Remanufacturers contend that Lexmark’s “licensing” scheme entails false advertising, constitutes patent misuse and is otherwise improperly anti-competitive, while Lexmark contends that Static Control and the Remanufacturers are willfully infringing Lexmark’s patents, and/or willfully inducing the infringement of Lexmark’s patents, by enabling the re-use of toner cartridges that Lexmark alleges were licensed to consumers for only one use.

**B. Constantine Cannon’s Role As Trial Counsel To Static Control**

In January 2003, following the commencement of the first of the two litigations in December 2002, Static Control retained Seth D. Greenstein of McDermott, Will and Emery as

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Seth D. Greenstein submitted herewith (“Greenstein Decl.”)) and Lexmark’s November 8, 2004 Second Amended Answer and Counterclaims (attached as Exh. 2 to the Greenstein Decl.).

trial counsel. Greenstein Decl. ¶ 3. In January 2006, Mr. Greenstein became a member of Constantine Cannon, and Static Control consequently retained Constantine Cannon as trial counsel.<sup>2</sup> *Id.* ¶ 4. Constantine Cannon was retained solely as trial counsel and not to offer any opinions as to the validity or infringement of any patent. *Id.* ¶ 5. Constantine Cannon was not retained by any other party to the litigation. *Id.* ¶ 6.

As trial counsel for Static Control, Constantine Cannon has not provided any party to this litigation, including Static Control, with any opinion as to the validity or infringement of any patent. *Id.* ¶ 5. Nor has Constantine Cannon provided any legal services whatsoever to any party other than Static Control. *Id.* ¶ 6.

As trial counsel, Constantine Cannon has participated with counsel for all of the Remanufacturers in privileged communications concerning matters of common interest to their preparation for trial, pursuant to a common interest agreement. Greenstein Decl. ¶ 7. The common interest agreement does not contemplate the provision of, nor has it been used to provide, any party with any opinions as to the validity or infringement of any patent. *Id.* ¶ 8.

### **C. Pendl's Disclosure of An Opinion Letter**

On or about October 13, 2006, Pendl – of its own volition and without prior discussion with Constantine Cannon – disclosed to Lexmark a written opinion of counsel that it apparently procured in 1999 (“Opinion Letter”), years before any of this litigation began. Greenstein Decl. ¶ 9. The Opinion Letter presumably will be used by Pendl to assert an advice of counsel defense.<sup>3</sup>

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<sup>2</sup> McDermott, Will & Emery remains as co-trial counsel to Static Control.

<sup>3</sup> See generally, e.g., *Mahurkar v. C.R. Bard, Inc.*, 79 F.3d 1572, 1579 (Fed. Cir. 1996) (whether infringer acted willfully is a question of fact that rests on determination of infringer's state of mind; infringer's good faith reliance on competent advice of counsel constitutes defense

The Opinion Letter, dated August 26, 1999, is from Robert D. Becker, Esq. of Coudert Brothers to Mr. Randy Pendl and its subject is "Lexmark Prebate Program."<sup>4</sup> Greenstein Decl. ¶ 10. The Opinion Letter mentions: (i) the patent laws of the United States; (ii) the contract laws of the United States; (iii) Pendl's repair of Lexmark cartridges; (iv) the sale by Pendl of repaired Lexmark cartridges; (v) the exhaustion of any Lexmark patent right(s) in the cartridges; (vi) Lexmark's anti-competitive behavior; and (vii) Lexmark's pricing schemes. *Id.*

To the best of Constantine Cannon's knowledge, neither Mr. Becker nor Coudert Brothers has played any role in this litigation. Greenstein Decl. ¶ 12. Constantine Cannon has never had any communications with Mr. Becker or Coudert Brothers concerning Pendl or this litigation. *Id.* ¶ 13. Nor was Constantine Cannon even aware of the Becker/Coudert opinion letter before Pendl disclosed it on October 13, 2006. *Id.* ¶ 14.

#### **D. Lexmark's Subpoena To Constantine Cannon**

Despite knowing Constantine Cannon's role as trial counsel for Static Control, Lexmark subpoenaed Constantine Cannon on October 19, 2006 seeking documents and testimony from Constantine Cannon.<sup>5</sup> See Subpoena, attached as Exh. 3 to the Greenstein Decl. On information and belief, Lexmark has caused identical subpoenas to be served on each and every other law firm representing all of the defendants in the Kentucky Litigation "seeking discovery relating to to willfulness).

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<sup>4</sup> The Opinion Letter has been marked "Confidential-Attorney's Eyes Only" pursuant to a Protective Order entered in the Kentucky Litigation. Greenstein Decl. ¶ 11. Accordingly, and although it is attached to the subpoena as "Tab 1," Constantine Cannon is not attaching the letter as an exhibit to the subpoena or to this motion.

<sup>5</sup> The subpoena commanded production of documents on October 27, 2006 but the date was extended to October 31 through agreement of the parties during a good faith discussion to resolve the dispute created by the subpoenas.

Pendl's advice of counsel defense." Greenstein Decl. ¶ 16 and October 19, 2006 email from Michael Krashin, attached to Greenstein Decl. as Exh. 4. The subpoena broadly demands "[a]ll documents and things relating to the subject matter discussed in" the Opinion Letter. Subpoena at Request 1; *see also* Deposition Topic 1. Given the vagueness and breadth of this request and deposition topic, Lexmark is likely to interpret the "subject matter" to include all privileged communication between Constantine Cannon and Static Control, and all work product produced by Constantine Cannon during the litigation.

The subpoena goes on to demand various communications "between Constantine Cannon and Pendl" related to virtually every legal contention in the case. *See id.*, Requests 2-9 and Deposition Topics 2-9. Because Pendl is defined to include Pendl's attorneys (*see id.*, Definition 3), the subpoena also seeks all communication between Constantine Cannon and Pendl's attorneys, including Pendl's trial counsel. As mentioned above, there have been numerous common-interest-privileged communications between Constantine Cannon and all the attorneys for all the Remanufacturers in connection with the Kentucky Litigation, including Pendl. Given the breadth of topics specified by the subpoena, it thus seems designed to call for most if not all common-interest-privileged communications that have taken place among counsel for Static Control and counsel for the Remanufacturers over the course of the entire litigation.

### ARGUMENT

#### **I. The Subpoena Must Be Quashed Because It Seeks Information Protected By The Attorney-Client Privilege, Work-Product Doctrine and Joint Defense Privilege.**

Fed. Rule Civ. P. 45 provides that a Court *must* quash or modify a subpoena that requires disclosure of privileged or other protected material. *See* Fed. R. Civ. P. 45(c)(3)(A)(iii). This protection applies to subpoenas for production of documents as well as the testimony of witnesses. *Id.* A client has the right to seek this protection when its attorney is subpoenaed, and

the attorney independently has the right to seek it in favor of his client. *See Estate of Yaron Ungar v. Palestinian Auth.*, 400 F. Supp.2d 541, 554 (S.D.N.Y. 2005) (finding subpoena on counsel's documents required a court to "quash, rather than modify, the subpoena under Rule 45(c)"). Constantine Cannon is seeking that protection as to each request and deposition topic in Lexmark's subpoena.

**A. The Attorney-Client Privilege.**

The attorney client privilege is one of the oldest recognized privileges meant to protect confidential communications between a client and his attorney. *United States v. Hsia*, 81 F. Supp. 2d 7, 16 (D.D.C. 2000). It assures the "frank and full" communication between attorneys and their clients in order to promote the effective rendering of legal services. *Id.* "The attorney-client privilege exists to protect confidential communications, to assure the client that any statements he makes in seeking legal advice will be kept strictly confidential between him and his attorney; in effect, to protect the attorney-client relationship." *United States v. AT&T.*, 642 F.2d 1285, 1299 (D.C. Cir. 1980); *see also Upjohn Co. v. United States*, 449 U.S. 383, 389, 66 L. Ed. 2d 584, 591, 101 S. Ct. 677, 682 (1981). The attorney-client privilege "belongs to the client, not the attorney." *In re Grand Jury Proceedings*, 73 F.R.D. 647, 652 (M.D. Fla. 1977).

**B. The Work Product Privilege.**

Work product "prepared in anticipation of litigation or for trial" is discoverable only upon a showing of substantial need of the privileged materials and inability, without undue hardship, to obtain their substantial equivalent elsewhere. Fed. R. Civ. P. 26(b)(3). Rule 26(b)(3) specifically instructs that, *even where a showing of substantial need and inability to discover the information elsewhere is made*, the Court "shall protect against disclosure of the mental impressions, conclusions, opinions, or legal theories of an attorney or other representative



of a party concerning the litigation.” *Id.* Further, while in certain circumstances the attorney-client privilege can be waived through inadvertent disclosure of the privileged information, the work-product privilege is not easily waived. As the DC Circuit announced in comparing the two privileges:

the work product privilege does not exist to protect a confidential relationship, but rather to promote the adversary system by safeguarding the fruits of an attorney's trial preparations from the discovery attempts of the opponent. The purpose of the work product doctrine is to protect information against opposing parties, rather than against all others outside a particular confidential relationship, in order to encourage effective trial preparation.

*AT&T*, 642 F.2d at 1299. Thus, only under extraordinary circumstances should a Court order that documents protected by the work product doctrine be produced. Fed. R. Civ. P. 26(b)(3); *see also Hickman v. Taylor*, 329 U.S. 495, 510-13 (1947) (“Were [an attorney’s ‘statements, memoranda, correspondence, briefs, mental impressions, personal beliefs’] open to opposing counsel on mere demand, much of what is now put down in writing would remain unwritten. An attorney’s thoughts, heretofore inviolate, would not be his own. Inefficiency, unfairness and sharp practices would inevitably develop in the giving of legal advice and in the preparation of cases for trial.”).

**C. The Joint Defense or Common Interest Privilege.**

The joint defense privilege “protects communications between two or more parties and their respective counsel if they are engaged in a joint defense effort.” *In re Sealed Case*, 29 F.3d 715, 719 n. 5 (D.C. Cir. 1994). “It permits a client to disclose information to [its] attorney in the presence of joint parties and their counsel without waiving the attorney-client privilege and is intended to preclude joint parties and their attorneys from disclosing confidential information learned as a consequence of the joint defense without permission.” *Hsia*, 81 F. Supp. 2d at 16.



The joint defense privilege applies not only to communications subject to the attorney-client privilege, but also to communications protected by the work product doctrine. *In re Grand Jury Subpoenas*, 902 F.2d 244, 249 (4<sup>th</sup> Cir. 1990). In order to establish the existence of a joint defense privilege, the party asserting the privilege must show that “(1) the communications were made in the course of a joint defense effort; (2) the statements were designed to further the effort; and (3) the privilege has not been waived.” *In re Sealed Case*, 29 F.3d at 719 n.15 (quoting *In re Bevill, Bresler & Schulman Asset Management*, 805 F.2d 120, 126 (3d Cir. 1986)). Moreover, the D.C. Circuit has instructed that disclosure of work product to others with a “common interest” does not waive the privilege, stating that “[s]o long as a transferor and transferee anticipate litigation against a common adversary on the same issue or issues, they have strong common interests in sharing the fruit of the trial preparation efforts.” *AT&T*, 642 F.2d at 1299. Such a rule against waiver “furthers the purpose of the work product privilege by protecting attorneys’ preparations for trial and encouraging the fullest preparation without fear of access by adversaries.” *Id.* at 1300.

**D. The Subpoena Seeks Information that Is Protected By the Attorney Client Communications Privilege, the Work Product Doctrine and the Joint Defense Privilege.**

As noted above, Lexmark’s subpoena requires Constantine Cannon to disclose documents and provide testimony on all things “relating to the subject matter discussed in” the Opinion Letter—i.e. the “Lexmark Prebate Program.” Because of this broad and vague language, the subpoena can be construed to require that Constantine Cannon – in its role as trial counsel – divulge privileged communications and work product concerning all aspects of the Kentucky Litigation. Subpoena at Request 1; *see also* Deposition Topic 1. The requests are not tailored for discovery of non-privileged information; indeed they specifically seek privileged

information related to each and every claim asserted in the litigation. *See id.* at Requests 2-9 and Deposition Topics 2-9 (seeking documents and testimony that reflect, embody or discuss communications between Constantine Cannon and Pendl relating to, *inter alia*, the scope, validity, and or enforceability of Lexmark's Prebate Program, the infringement of Lexmark's patents, and the antitrust and contractual implications of the Lexmark Prebate Program).

Any document or other communication between Constantine Cannon and Static Control that is responsive to the topics in the subpoena would have been made to Static Control for the purpose of providing legal services in connection with the ongoing litigation in Kentucky (*see* Greenstein Decl. ¶ 17) and are privileged. Similarly, Constantine Cannon's communications with Static Control, its litigation preparation, and its communications with trial counsel for Pendl reflect the privileged work product of Constantine Cannon on behalf of Static Control, and such work product is also not within the proper bounds of discovery. Fed. R. Civ. P. 26(b)(3). Any document in the possession of Constantine Cannon or any other communication by Constantine Cannon that is responsive to the topics in the subpoena would have been made in preparation for the anticipated trial in Kentucky. *See* Greenstein Decl. ¶ 18. More specifically, any communication made by Constantine Cannon to Pendl's trial counsel were made in the course of the joint defense effort to defend against Lexmark's counterclaims and all such statements were designed to further the joint defense effort. *Id.*

Therefore, as all of the requests and topics in the subpoena are directed to privileged information, the subpoena *must* be quashed in its entirety. *See* Fed. R. Civ. P. 45(c)(3)(A)(iii).

## **II. Pendl's Advice of Counsel Defense Does Not Waive Static Control's Privileges Nor Permits Lexmark to Pillage The Work of Trial Counsel.**

No doubt Lexmark believes that Pendl's advice of counsel defense and disclosure of the Opinion Letter has waived Pendl's attorney client privilege with respect to any and all

communications between Pendl and any of its counsel, including trial counsel. In serving subpoenas on each and every defense counsel, Lexmark undoubtedly also believes that Pendl's waiver would extend to the other Remanufacturers or Static Control.<sup>6</sup> Lexmark would be wrong on both counts.

**A. Pendl's Advice of Counsel Defense Does Not Waive Static Control's Privileges.**

First, Lexmark is mistaken to believe that Pendl's assertion of its advice of counsel defense could waive any privileges belonging to the other Remanufacturers or Static Control because of the common interest agreement that those parties entered into exclusively for trial preparation purposes, years after Pendl received the Opinion Letter. Indeed, quite the opposite is true; the joint defense privilege prohibits one party's disclosure from waiving any other party's privilege. *See, e.g., John Morrell & Co. v. Local Union 304A of United Food and Commercial Workers, AFL-CIO*, 913 F.2d 544, 555-56 (8th Cir. 1990) (it is fundamental that the joint defense privilege cannot be waived without the consent of all parties to the defense) (citing cases); *In re Grand Jury Subpoenas, 89-3 and 89-4, John Doe 89-129*, 902 F.2d 244 (4th Cir. 1990) (one participant in common interest privilege cannot unilaterally waive privilege without consent of other participants in the privilege).

In particular, in the specific context of an advice of counsel defense, one co-defendant's decision to raise the defense does not waive the privilege rights of his fellow co-defendants who

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<sup>6</sup> Lexmark has stated that the instant subpoenas on Constantine Cannon and Static Control's other litigation counsel was predicated on Pendl's reliance on the advice of counsel defense. Ex. 4 to the Greenstein Decl. There is a separate privilege waiver dispute pending before Judge Van Tatenhove involving Static Control, whereby Lexmark contends that Static Control's dissemination in 1998 of a letter written by a law professor, who was not retained as counsel to Static Control, effected a broad privilege waiver. Lexmark has never served a subpoena on Static Control's law firms for those privileged materials, and that matter currently is under review by Judge Van Tatenhove.

share a common-interest agreement to defend themselves in a litigation. *Interfaith Hous. Delaware, Inc. v. Town of Georgetown*, 841 F. Supp. 1393, 1402 (D. Del. 1994) (“[W]hen one of two or more clients with common interests waives the attorney-client privilege in a dispute with a third party [raising an advice of counsel defense], that one individual’s waiver does not effect a waiver as to the others’ attorney-client privilege.”)

Moreover, even in the absence of a joint defense privilege attaching under a common interest agreement, a co-defendant’s advice of counsel defense cannot waive privilege as to other co-defendants. *See Ross v. City of Memphis*, 423 F.3d 596, 603 (6th Cir. 2005) (“[A] municipal official’s assertion of the advice of counsel defense does not require the City [of Memphis] to relinquish the privilege it holds.”); *AT&T Corp. v. Microsoft Corp.*, No. 02-0164 MHP (JL), 2003 U.S. Dist. LEXIS 8710 \*20 (N.D. Cal. April 18, 2003) (“this court could not locate any precedent that allows a party in [a] litigation to waive the privilege claims of a third party through the assertion of an advice of counsel defense”).

Static Control has not consented to any waiver of its privileges or of the common interest privilege that exists among itself and the Remanufacturers. Thus, even if Pendl waived its own privileges with respect to certain materials of its own, that limited waiver cannot be construed to waive any privilege that belongs to Static Control, including the common interest privilege that Static Control shares with the Remanufacturers.

**B. Pendl’s Advice of Counsel Defense Does Not Entitle Lexmark To Trial Counsel’s Work Product and Trial Strategy.**

Lexmark would be equally mistaken to believe that Pendl’s advice of counsel defense waived even *Pendl’s* own privilege over communications with its own trial counsel or work product produced by its own trial counsel sufficient to support its broad and overreaching subpoena. Many courts hold that the waiver applies only to communications and documents

created before the filing of a lawsuit; communications and documents created thereafter retain their privilege. *See Dunhall Pharms. v. Discus Dental*, 994 F.Supp. 1202, 1206 (C.D. Cal. 1998) (“Once the lawsuit is filed, the waiver of work product protection ends.”); *Motorola v. Vosi Techs.*, 2002 U.S. Dist. LEXIS 15655 at \*2 (N.D. Ill. 2002). Such a limitation “follows the enhanced interest” in protecting a party against wholesale “disclosure of trial strategy and planning.” *Dunhill*, 994 F.Supp. at 1206.

Some courts find that the waiver extends beyond the filing of the lawsuit. These courts nevertheless limit post-filing discovery to *non-litigation counsel*. They continue to protect *litigation counsel* and apply the privilege to their advice. *See Tivo v. Echostar*, Civ. No. 2:04-CV-1, 2005 U.S. Dist. LEXIS 42481, at \*\*18-19 (E.D. Tex. Sept. 26, 2005) (denying discovery into opinions by litigation counsel). Even courts, such as this one, applying the most liberal and expansive form of waiver still protect *litigation files*, limiting any production to work product materials that (1) have been communicated to the client and (2) that contain conclusions or advice that contradict or cast doubt on the earlier opinions. *See Intex Recreation Corp. v. Metalast*, Civ. No. 01-1213 (JDB), 2005 U.S. Dist. LEXIS 10149, at \*15 (D.D.C. March 2, 2005). All of these interpretations stand for the general premise that regardless of a court’s interpretation of waiver, a party cannot – under the guise of discovery pursuant to an advice of counsel defense – “pillage” its opponent’s litigation files. *In re Echostar*, 448 F.3d 1294, 78 USPQ2d 1676, at 1682 (Fed. Cir. 1996). That is precisely and transparently what Lexmark is trying to do in subpoenaing Pendl’s trial counsel and all of the trial counsels of the other defendants. The Court should therefore quash Lexmark’s subpoena to Constantine Cannon.

### **III. The Subpoena Should Be Quashed Because It Fails To Meet Mandatory Prerequisites For Deposing Opposing Counsel.**

Depositions of opposing counsel are disfavored. *Corporation for Pub. Broadcasting v.*

*American Auto. Centennial Comm'n*, No. 1:97CV01810, 1999 WL 1815561 (D.D.C. Feb. 2, 1999). Even “a deposition of counsel limited to relevant and non-privileged information risks disrupting the attorney-client relationship and impeding the litigation.” *RESQNET.com v. Lansa, Inc.*, 01 CIV 3578 (RWS), 2004 U.S. Dist. LEXIS 13579, at \* 5 (S.D.N.Y. July 23, 2004) (citing *Alcorn Labs v. Pharmacia Corp.*, 225 F.Supp. 2d 340 (S.D.N.Y. 2002)). Taking the deposition of opposing counsel not only “lowers the standards of the profession,” but also “detracts from the quality of client representation.” *Shelton v. American Motors Corp.*, 805 F.2d 1323, 1327 (8th Cir. 1987). Counsel should instead be free to devote his or her time and efforts to preparing the client’s case “without fear of being interrogated by his or her opponent.” *Id.*

Courts in this Circuit have applied the strict test announced by the Eight Circuit in *Shelton*. See *Jennings v. Family Mgmt*, 201 F.R.D. 272, 277 (D.D.C. 2001); *Evans v. Atwood*, No. C.V.A. 96-2746 (RMU), 1999 WL 1032811 (D.D.C. Sept. 29, 1999); *Corporation for Pub. Broadcasting v. American Automobile Centennial Comm'n*, No. 1:97CV01810, 1999 WL 1815561 (D.D.C. Feb. 2, 1999). Under *Shelton*, depositions of opposing counsel are allowed only if three conditions are met: (1) the information sought is relevant and non-privileged; (2) “no other means exists to obtain the information” and (3) “the information is crucial to the preparation of the case.” *Shelton*, 805 F.2d at 1327.

Lexmark cannot meet any of these prerequisites. First, the information sought is privileged, as Static Control has not waived any privilege. See I, *supra*. Second, Lexmark cannot prove that no other means exist to discover the information. The subpoena seeks testimony as to communications between Constantine Cannon and Pendl. To the extent the topics encompass any non-privileged information, Lexmark can simply depose Pendl. Discovering the information from an alternate source is therefore not only possible, but

convenient. Third, Lexmark has not and cannot show that deposing Constantine Cannon is “crucial” to its case. Discovering opposing counsel’s trial strategy is not appropriate, much less “crucial.”

Even courts that have not followed *Shelton* acknowledge the limited circumstances under which opposing counsel may be deposed. In *U.S. v. Philip Morris Inc.*, 209 F.R.D. 13 (D.D.C. 2002), for example, Judge Kessler stated that “There is no question that *Shelton* addressed a troubling and real-world discovery problem.” *Id.* at 17. However, the Court held that the case before it was different from *Shelton* in a number of crucial ways, including the fact that the opposing in-house counsel whose depositions were sought were not trial counsel, that they had significant non-legal, non-litigation responsibilities, and that the plaintiff affirmatively represented that it was not seeking litigation strategy in the case, but only non-privileged, pre-litigation factual matters. *Id.* Because of these differences, the Court determined that the *Shelton* factors did not apply to the case. *Id.* In this case, however, Lexmark is specifically seeking privileged information from trial counsel who had no role in pre-litigation dealings.

Similarly, in *Sadowski v. Gudmundson*, 206 F.R.D. 25 (D.D.C. 2002), Magistrate Judge Facciola allowed a limited deposition of opposing counsel who had participated in a telephone conversation with an officer of the Copyright Office pertaining to the copyright at issue in the lawsuit. Because the trial counsel was also involved in the underlying events supporting the lawsuit, and he had “unique or superior knowledge of key facts” of the case, his deposition was allowed for the limited purpose of obtaining factual information related to the telephone conference and the copyright application. *Id.* at 26-27. Unlike the attorney in *Sadowski*, Constantine Cannon had no involvement in the underlying events giving rise to the case nor does it have any unique or superior knowledge of any “key facts” to the case. Under any standard,



Lexmark's subpoena to Constantine Cannon represents a "textbook example" of the abuses of the discovery rules and an attempt to obtain a preview of the defendants' litigation strategies in this case and should not be condoned. *Phillip Morris*, 209 F.R.D. at 18.

**IV. The Subpoena Should Be Quashed Because It Does Not Provide A Sufficient Response Time, Is Overly Broad And Unduly Burdensome, And Seeks Duplicative Documents.**

The subpoena should further be quashed because of numerous other deficiencies. First, it allowed only eight (and now by agreement twelve) days for what would be tremendously burdensome document production. Subpocna at 2. Under Rule 45(c), this does not constitute a reasonable time for compliance. *See* Fed. R. Civ. P. 45(c)(3)(i) (requiring reasonable time for compliance).

Second, the subpoena is overly broad and unduly burdensome. For instance, it requests all documents and testimony "relating to" the "subject matter" of a letter from August 1999. Not only is this request vague, but it could be read to include all statutes and case law, as well as every document ever written on patent infringement. As such, the subpoena is overly burdensome and should be quashed. *See* Fed. R. Civ. P. 45(c)(3)(A)(iv) (quashing subpoena for undue burden).

Finally, the subpoena seeks duplicative documents already sought from the appropriate party – Pendl. Allowing an opposing litigant to serve discovery on a party and then subpoena its opposing counsel for the same documents is wasteful. Indeed, it is taxing not only the Eastern District of Kentucky's resources where the suit is ongoing, but now this Court's time (and several other Courts' time) as well. For all these reasons enumerated under Rule 45(c), the subpoena should be quashed.

**V. Static Control Should Be Awarded Attorney Fees.**

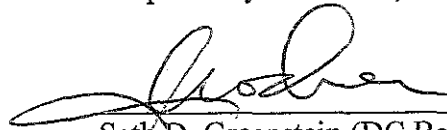
Rule 45(c) provides that a party and its attorney issuing and serving a subpoena “shall take reasonable steps to avoid imposing undue burden or expense on a person subject to that subpoena.” Moreover, the “court on behalf of which the subpoena was issued shall enforce this duty and impose upon the party or attorney in breach of this duty an appropriate sanction which may include, but is not limited to, lost earnings and a reasonable attorney’s fee.” *Id.*

Even a cursory review of the attorney-client privilege would have put Lexmark on notice that its document requests and deposition topics were impermissible. *See I and II, infra.* Furthermore, any serious consideration of the requirements for deposing litigation counsel would have put Lexmark on notice of the impropriety of its subpoena. *See III, infra.* Finally, regardless of whether Lexmark argues it has appropriate grounds based on the advice of counsel defense asserted by one defendant in this case, it is undeniable that it has sought documents and testimony far exceeding that topic and from parties that have not waived their privilege. Based on these actions, Static Control should be awarded its attorney’s fees incurred in connection with this motion.

**CONCLUSION**

For all of the foregoing reasons, this Court should quash Lexmark's subpoena to Constantine Cannon. Seeking all privileged material on all claims related to a litigation is not only contrary to law, but also detrimental to the litigation process. Static Control should be awarded its reasonable attorney's fees for Constantine Cannon's response to the subpoena.

Respectfully submitted,



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*For itself and as attorneys for  
Plaintiff/Counterclaim Defendant  
STATIC CONTROL COMPONENTS, INC.*

Dated: October 30, 2006

**CERTIFICATE OF SERVICE**

I hereby certify that true and correct copies of CONSTANTINE CANNON'S MOTION TO QUASH SUBPOENA SERVED ON OPPOSING PARTY'S TRIAL COUNSEL, DECLARATION OF SETH D. GREENSTEIN, ESQ. and PROPOSED ORDER GRANTING MOTION TO QUASH were served this 30th day of October 2006 by first class mail, to the following:

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