

EXHIBIT 1

FILED UNDER SEAL

EXHIBIT 2

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EXHIBIT 3

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EXHIBIT 4

----- Original Message -----

From: John Hendrickson <JOHN.HENDRICKSON@EEOC.GOV>

At: 7/11 11:14:55

Attached FYI regarding EEOC's effort to compel Sidley & Austin to articulate any reasons other than age which compelled the expulsion of "partners."

Working left to right through the document array below, the first (left-most) document is the Notice of Motion indicating that EEOC's Motion will be presented to the court on Thursday, the middle document is the Motion itself (this is the substantive document), and the last (right-most) document is made up of the exhibits to the Motion.

EXHIBIT 5



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Briefs and Other Related Documents

Only the Westlaw citation is currently available.

United States District Court, E.D. Pennsylvania.

Fred SMITH, Plaintiff,

v.

UNIVERSITY OF PENNSYLVANIA, Defendant.

Civil Action No. 05-525.

June 21, 2006.

H. Francis Delone, Wayne, PA, for Plaintiff.

Farah Gold, Frank A. Chernak, Ballard Spahr Andrews & Ingersoll LLP, Philadelphia, PA, for Defendant.

MEMORANDUM

EDUARDO C. ROBRENO, J.

*1 Before the Court is plaintiff's second motion for a continuance under Federal Rule of Civil Procedure 56(f) to permit further discovery (doc. no. 45).

I. BACKGROUND

Plaintiff, Fred Smith, an African American male, brings this employment discrimination action against his former employer, defendant, University of Pennsylvania, under Title VII of the Civil Rights Act of 1964, 42 U.S.C. § 2000e et seq. Plaintiff alleges (1) a claim of race discrimination, and (2) a claim of retaliation for engaging in a protected activity.

From May 30, 1995 through September 15, 2003, plaintiff, who had been employed by defendant since the early nineties, was out of work due to a work-related injury. During that time period, in July 1995 plaintiff filed an employment discrimination charge against defendant with the Equal Employment Opportunity Commission ("EEOC"). This charge was settled sometime after plaintiff brought a civil action against defendant. Also filed during the period plaintiff was out of work due to injury was a workers' compensation action against defendant, which was settled in March 2003.

On September 15, 2003, plaintiff was cleared for work by his doctor and sought to return to work. Plaintiff worked at the Faculty Club prior to sustaining a work-related injury on May 30, 1995. Defendant operated the Faculty Club until

August 13, 1999, at which time Hilton Hotels Corporation began to operate the facility as the Inn at Penn. When plaintiff attempted to return to work on September 15, 2003, defendant informed plaintiff that the Faculty Club had ceased operation in his absence and that plaintiff could re-apply for any position for which he was qualified.

On May 20, 2004, ten months after plaintiff attempted to resume employment with defendant, plaintiff filed a charge of discrimination with the EEOC alleging that he was denied reinstatement to his former position in violation of Title VII of the Civil Rights Act and the Americans with Disabilities Act. ^{FN1} The instant action followed on February 4, 2005.

^{FN1}. Plaintiff's complaint does not allege discrimination under the Americans with Disabilities Act, although that allegation was included in his EEOC charge.

II. DISCUSSION

A. The Discovery Dispute.

Plaintiff has prolonged the adjudication of defendant's motion for summary judgment by filing successive motions to compel discovery. An extensive discovery dispute underlies defendant's pending motion for summary judgment, and involves *in toto* several motions to compel discovery filed by plaintiff, one motion for a protective order filed by defendant and one motion for a continuance under Rule 56(f). In brief, the Court granted the plaintiff's first motion to compel and motion for a continuance pursuant to Rule 56(f), and denied plaintiff's remaining two motions to compel and defendant's motion for a protective order as moot. Plaintiff now has filed a second motion for a continuance under Rule 56(f) to permit further discovery. It is this motion which is now before the Court.

Plaintiff filed the instant action on February 4, 2005. On April 11, 2005, defendant filed a motion to dismiss or in the alternative for summary judgment (doc. no. 3). After a hearing on June 6, 2005, the Court denied defendant's motion to dismiss or in the alternative for summary judgment. Order of June 6, 2005 (doc. no. 10). The Court issued a scheduling order of the same date, which established a November 3,



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2005 deadline for discovery and the filing of dispositive motions (doc. no. 11).

*2 Plaintiff filed his first motion to compel on November 2, 2005 (doc. no. 13), the day before the scheduled discovery deadline. In his first motion to compel, plaintiff sought to depose a designee of the University of Pennsylvania pursuant to Rule 30(b)(6). Defendant argued that the notice of deposition was onerous, seeking, *inter alia*, oral testimony as to every discrimination lawsuit filed against defendant and the salaries of every African-American employee at the University of Pennsylvania. During the November 9, 2005 telephone conference to address plaintiff's first motion to compel, the Court agreed that the deposition of a Rule 30(b)(6) designee was burdensome under the circumstances and instead ordered that the notice of deposition be treated as interrogatories and requests for production of documents.

The Court granted in part plaintiff's first motion to compel and ordered defendant to produce the following: (1) the docket/case number and the subject matter of each employment discrimination lawsuit, EEOC complaint or Pennsylvania Human Relations Commission ("PHRC") complaint in which defendant was involved in the last five years; (2) the terms and use of any agreement between defendant and the entity that runs the Inn at Penn, 3600 Sansom Street, Philadelphia, Pennsylvania; (3) the name, race, address and telephone number of each person who worked at the Faculty Club in or around 1995 who went to work for the Inn at Penn after the Faculty Club closed; (4) the name, race, address and telephone number of each employee or former employee who received worker's compensation who requested to be rehired and was rehired upon returning from leave within the last three years prior to the decision not to rehire plaintiff; (5) information about plaintiff's prior worker's compensation lawsuit against defendant, which was settled; and (6) information about plaintiff's prior employment discrimination lawsuit in the Eastern District of Pennsylvania, docket number 96-8210, which was settled. Order of Nov. 9, 2005. ^{FN2} The information to be produced by defendant amounted to substantially the same information plaintiff had sought by way of a Rule 30(b)(6) deponent. Moreover, the Court left open the possibility of a Rule 30(b)(6) followup deposition.

^{FN2}. The Court's Order of November 9, 2005 lists the numbers to which responses were compelled. The language above appears in Exhibit A of Plaintiff's first motion to compel.

Pursuant to the Court's Scheduling Order of June 6, 2005, defendant filed a second motion for summary judgment on November 3, 2005 (doc. no. 14). The Court denied without prejudice defendant's second motion for summary judgment on November 9, 2005, following the telephone conference addressing the first motion to compel. Also on November 9, 2005, the Court issued a Second Amended Scheduling Order extending the deadline for discovery and the filing of dispositive motions to January 16, 2006 (doc. no. 18).

On January 5, 2006, defendant moved for a protective order to bar a proposed Rule 30(b)(6) deposition (doc. no. 22), arguing that plaintiff served essentially the same notice of deposition deemed burdensome pursuant to the Court's Order of November 9, 2005. Moreover, on January 17, 2006, defendant filed a third motion for summary judgment (doc. no. 23), which is currently pending before the Court.

*3 On January 20, 2006, plaintiff filed a second motion to compel discovery (doc. no. 30) seeking to depose a corporate designee on the same issues the Court had addressed in plaintiff's first motion to compel. Plaintiff also opposed defendant's motion for a protective order for its corporate designee. The Court held a hearing on January 30, 2006 to address defendant's motion for a protective order and plaintiff's second motion to compel. The Court took the matters under advisement.

Additionally, on January 30, 2006 following the hearing, plaintiff filed a third motion to compel discovery (doc. no. 33) and his first motion for a continuance under Rule 56(f) (doc. no. 32). In his third motion to compel, plaintiff sought further responses to his First Requests for Production of Documents. Consequently, plaintiff's first Rule 56(f) motion was based upon his need for the information sought in his third motion to compel. As part of his third motion to compel, plaintiff argued that defendant made "meritless" and general objections to his requests for production of documents and had failed to comply with the Court's Order of November 9, 2005. Defendant responded to plaintiff's re-



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quests for production, subject to certain objections on the basis of privilege (doc. no. 37). In support of those objections, defendant submitted a privilege log detailing what information was withheld on the basis of attorney client privilege and/or as attorney work product. Def.'s Resp. to Pl.'s Third Mot. to Compel, Ex. B. The privilege log lists counsels' notes in plaintiff's current and prior actions against defendant and correspondence between counsel and defendant.

On March 7, 2005, the Court granted plaintiff's first Rule 56(f) motion, and ordered defendant to: (1) identify the docket/case action number and the court/agency of each EEOC and PHRC complaint filed by "non-professional" employees against defendant from January 1, 2000 to the present; (2) identify the EEOC and PHRC complaints, identified in paragraph 1(a) above, that resulted in court action; and (3) produce the agreement between the Faculty Club and the Inn at Penn. See Order of Mar. 7, 2006 (doc. no. 42). In addition, all of the above information was to be subject to a confidentiality agreement between the parties. Plaintiff's second and third motions to compel and defendant's motion for a protective order were denied as moot pursuant to the Court's order granting plaintiff's first Rule 56(f) motion.

B. Plaintiff's Second Motion for a Continuance Under Rule 56(f).

Plaintiff filed a second motion for a continuance under Rule 56(f) on April 6, 2006 (doc. no. 44). It is this matter which is before the Court. In his second motion for a continuance, plaintiff makes the same arguments advanced in support of his first motion for a continuance, namely that defendant has not produced the discovery requested and ordered by the Court. Plaintiff alleges that defendant still has not appeared for a Rule 30(b)(6) deposition and has failed to provide responses to plaintiff's First Requests for Production of Documents numbers 2, 4-7 and 9-14.

**4 Under Rule 56(f),*

Should it appear from the affidavits of a party opposing the motion that the party cannot for reasons stated present by affidavit facts essential to justify the party's opposition, the court may refuse the application for judgment or may order a continuance to permit affidavits to be obtained or depositions to be taken or discovery to be had or may make such

other order as is just.

The Third Circuit determined that whether a Rule 56(f) motion should be granted "depends, in part, on 'what particular information is sought; how, if uncovered, it would preclude summary judgment; and why it has not been previously obtained.'" *San Filippo v. Bongiovanni*, 30 F.3d 424, 432 (3d Cir.1994). Although the district court has discretion to deny the motion, it "should grant a Rule 56(f) motion as a matter of course unless the information is otherwise available to the non-movant." *Id.* at 432-33. The information sought should be examined in light of the strictures of Rule 26(b) and viewed in the context of the case.

Plaintiff relies on *Simpson v. Kay Jewelers*, 142 F.3d 639, 644-45 (3d Cir.1998), to support his claim that he is entitled to further discovery. Plaintiff argues that the following language allows the broad range of discovery relating to other claims of discrimination against defendant:

To show that discrimination was more likely than not a cause for the employer's action, the plaintiff must point to evidence with sufficient probative force that a factfinder could conclude by a preponderance of the evidence that age was a motivating or determinative factor in the employment decision. *Keller v. Orix Credit Alliance, Inc.*, 130 F.3d 1101, 1111 (3d Cir.1997). For example, the plaintiff may show that the employer has previously discriminated against her, that the employer has discriminated against other persons within the plaintiff's protected class or within another protected class, or that the employer has treated more favorably similarly situated persons not within the protected class. *Fuentes*, 32 F.3d at 765.

Id. at 644-45; see also Pl.'s Mem. in Support of Rule 56(f) Mot. at 5-6.^{FN3} The Court rejected plaintiff's argument that *Simpson* compels the unlimited discovery of past acts of discrimination sought by plaintiff. Indeed, the court permitted plaintiff to discover past acts of discrimination, but only those involving non-professional employees. See Hr'g Tr. 7-13, Nov. 9, 2005. The Court found that, under the circumstances of this case and on balance, discovery of past acts of discrimination involving professional employees who were not similarly situated to plaintiff was not likely to lead to the discovery of admissible evidence.



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FN3. Plaintiff's second motion for a continuance under Rule 56(f) incorporates by reference his first motion for a continuance under Rule 56(f), his second and third motions to compel and his reply memorandum in further support of his Rule 56(f) motion. Pl's Mem. in Support of Second Mot. for a Continuance (doc. no 44).

In summary, plaintiff has received the following information: (1) plaintiff's personnel file, worker's compensation file and litigation file in defendant's possession; (2) a list, including the race, address and telephone number, of employees who worked at the Faculty Club and who now work at the Inn at Penn; (3) the identity of one employee who worked at the Faculty Club, filed a worker's compensation claim and is now employed by the Inn at Penn; (4) a list of employees who filed worker's compensation claims during the last five years; (5) a list of current employees of defendant; (6) a verification that all employees of the Faculty Club were terminated as of August 13, 1999 and that none of those employees were hired by defendant; (7) the docket/case action number of each EEOC and PHRA complaint filed by non-professional employees against defendant from January 1, 2000 to the present; (8) the identity of the EEOC and PHRC complaints that resulted in court action; (9) the agreement between the University of Pennsylvania and the Hilton Hotels Corporation, which now operates the Faculty Club; and (10) the agreement between the Faculty Club and the Inn at Penn.^{FN4}

FN4. On May 12, 2006, the Court ordered defendant to certify delivery of the materials listed in the Court's Order of March 7, 2006 granting the first Rule 56(f) motion (doc. no. 47). The defendant did so via letters to the Court dated May 25, 2006 and May 26, 2006.

*5 As part of his second Rule 56(f) motion, plaintiff is still seeking answers to numbers 2, 4-7 and 9-14 of his First Requests for Production of Documents served upon defendant. Pl.'s Mot. for Leave, Ex. D (doc. no. 40).^{FN5} Although plaintiff has not received every piece of information he would like, plaintiff is not entitled to a second continuance under Rule 56(f). The reason is twofold. One, plaintiff already has received much of the information he requests.

Two, plaintiff has not requested any new information that, if uncovered, would preclude defendant's motion for summary judgment.

FN5. Plaintiff's First Requests for Production of Documents is separate from his notice of deposition which the Court deemed interrogatories or requests for production in the Order of November 9, 2005. However, plaintiff's First Requests for Production seek much of the same information that was before the Court pursuant to plaintiff's first motion to compel. Moreover, the information sought was also the subject of plaintiff's third motion to compel.

Below is each request for production to which plaintiff seeks a further response in his second Rule 56(f) motion, and why plaintiff is not entitled to any further responses.

1. Requests number 2, 4 and 5

- Request number 2: "Any and all statements concerning this action or its subject matter previously made by plaintiff."
- Request number 4: "Any and all documents (including but not limited to letters and memoranda) that contain or relate to any correspondence between plaintiff and Defendant that took place during the time period from January 1, 1995 to the present."
- Request number 5: "Each and every document (including but not limited to letters and memoranda) created by Defendant that mentions plaintiff by name or makes any other reference to plaintiff that was created during the time period from January 1, 1995 to the present."

Plaintiff has received sufficient information in response to these requests. Defendant produced plaintiff's personnel file, the file related to plaintiff's prior lawsuit against defendant and the file related to plaintiff's worker's compensation claim against defendant. Any relevant correspondence or documents is contained within those files. No further response by defendant is needed.2. Requests number 6 and 7

- Request number 6: "Each and every complaint or charge of discrimination in which Defendant was named as a respondent that was filed with the EEOC or the Pennsylvania Human Relations Commission during the time period from January 1, 2000 to the present."



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• Request number 7: “Each and every Complaint and Answer in any civil lawsuit that any current or former employee of the Defendant brought against Defendant during the time period from January 1, 2000 to the present.”

Plaintiff has received the docket/case action number of each EEOC and PHRA complaint filed by non-professional employees against defendant from January 1, 2000 to the present and the identity of the EEOC and PHRC complaints that resulted in court action. Plaintiff is not entitled to a copy of every complaint and/or answer for each action. Defendant has no burden to do plaintiff's ministerial tasks for him. As the Court noted during the November 9, 2005 telephone conference addressing plaintiff's first motion to compel, plaintiff is entitled to the “docket or case action number” and “where it was brought,” and then plaintiff “can go and find out as much as [he] can from that basis.” Hr'g Tr. 10, Nov. 9, 2005. Plaintiff is not entitled to a further response to requests number 6 and 7 and can “do [his] own research” from the information provided. *Id.**6 3. Request number 9

• Request number 9: “Each and every document that refers or relates to any person or persons who worked at the Faculty Club in or around 1995 and who, after the Faculty Club closed, went to work for the company or other type of entity that runs the Hilton Inn at Penn.”

Plaintiff has received a list, including the race, address and telephone number of employees who worked at the Faculty Club and now work at the Inn at Penn. The balance of the information sought constitutes a veritable fishing expedition on dry land. Plaintiff is not entitled to a further response to request number 9.4. Request number 10

• Request number 10: “Each and every document that contains information about any employee or former employee of Defendant who received worker's compensation at some time during the time period from January 1, 1995 to the present, including but not limited to each and every document containing information about whether the employee or former employee received medical clearance to return to work and to [sic] each and every document containing information about whether the employee or former employee returned to work as an employee of the Defendant.”

The Court limited plaintiff to discovery of worker's com-

pensation claims filed during “the past three years prior to the decision not to rehire [plaintiff, which occurred in 2003].” Hr'g Tr. 25, Nov. 9, 2005. Plaintiff has received the names of all employees of defendant who filed worker's compensation claims during the last five years and the identity of one Faculty Club employee who filed a worker's compensation claim and is now employed by the Inn at Penn. Plaintiff is not entitled to a further response to request number 10.5. Request number 11

• Request number 11: “Any and all performance evaluations or other documents that contain information about plaintiff's performance in his job as an employee of Defendant.”

Plaintiff has received his personnel file, the contents of which include any performance evaluations. Hr'g Tr. 29, Nov. 9, 2005. Plaintiff has had this information since before the November 9, 2005 telephone conference. *Id.* Therefore, no further response to request number 11 is needed.6. Request number 12

• Request number 12: “Any and all documents received by Defendant pursuant to any third-party subpoena served in this case, including all such documents already received by Defendant as well as all such documents received by Defendant at some future date.”

Plaintiff is entitled to this information pursuant to the Rule 34 and 26(b).7. Requests number 13 and 14

• Request number 13: “Each and every document that relates or refers to the worker's compensation claim that plaintiff pursued against Defendant, including but not limited to the settlement agreement regarding that claim that was reached between plaintiff and Defendant.”

• Request number 14: “Each and every document that relates or refers to the employment discrimination lawsuit that plaintiff and two others pursued against Defendant in or around 1995, including but not limited to the settlement agreement regarding that suit that was reached between the plaintiffs in that lawsuit and Defendant.”

*7 Plaintiff has received full responses to requests number 13 and 14. Defendant produced the contents of plaintiff's worker's compensation and litigation files maintained by defendant, subject to the information listed in defendant's privilege log. Moreover, plaintiff's current counsel represented plaintiff's in his prior discrimination suit against defendant



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and is fully aware of the circumstances of the prior case. Plaintiff is not entitled to any further responses to requests number 13 and 14.

As demonstrated above, plaintiff has received more than adequate discovery to respond to defendant's motion for summary judgment. The Court has given due consideration to plaintiff's successive discovery motions, granting in part plaintiff's first motion to compel and his first motion for a continuance under Rule 56(f) and ordering defendant to certify delivery of certain discovery materials. Defendant's obligations under Rule 26(b)(1) have been satisfied. Plaintiff is not entitled to further responses to his First Requests for Production of Documents as a basis for a Rule 56(f) continuance.

Second, plaintiff is not entitled to a Rule 56(f) continuance because plaintiff has not demonstrated what specific additional information, if uncovered, would preclude defendant's motion for summary judgment. Fed. R. Civ. Pro. 56(f). Plaintiff is merely speculating that by chance he may uncover some information helpful to his case, or get the Rule 30(b)(6) deponent to admit wrongdoing at deposition. Therefore, plaintiff is not entitled to a further continuance under Rule 56(f).

III. CONCLUSION

For the foregoing reasons, plaintiff's second motion for a continuance under Rule 56(f) will be denied.

ORDER

AND NOW, this 21st day of **June, 2006**, it is hereby **ORDERED** that Plaintiff's Second Motion for a Continuance Under Rule 56(f) (doc. no. 45) is **DENIED**.

IT IS FURTHER ORDERED that plaintiff shall file a response to defendant's motion for summary judgment by **July 7, 2006**.

AND IT IS SO ORDERED.

E.D.Pa., 2006.
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Briefs and Other Related Documents ([Back to top](#))

- [2006 WL 1358239](#) (Trial Motion, Memorandum and Affidavit) Response of Defendant University of Pennsylvania to Plaintiff Fred Smith's Second Motion for a Continuance under FRCP 56(f) to Permit Further Discovery (Apr. 21, 2006) Original Image of this Document with Appendix (PDF)
- [2006 WL 1358240](#) (Trial Motion, Memorandum and Affidavit) Reply Brief in Further Support of the Motion for Summary Judgment of Defendant University of Pennsylvania (Apr. 21, 2006) Original Image of this Document with Appendix (PDF)
- [2006 WL 737220](#) (Trial Motion, Memorandum and Affidavit) Order (Feb. 13, 2006)
- [2006 WL 737219](#) (Trial Motion, Memorandum and Affidavit) Order (Feb. 7, 2006)
- [2005 WL 3724576](#) (Trial Motion, Memorandum and Affidavit) Motion (Nov. 8, 2005)
- [2005 WL 3724575](#) (Trial Motion, Memorandum and Affidavit) Motion (Nov. 3, 2005)
- [2005 WL 693690](#) (Trial Pleading) Complaint (Feb. 4, 2005)
- [2:05cv00525](#) (Docket) (Feb. 4, 2005)

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Not Reported in F.Supp.2d
Not Reported in F.Supp.2d, 2000 WL 116082 (N.D.Ill.)
(Cite as: Not Reported in F.Supp.2d)

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Briefs and Other Related Documents
Only the Westlaw citation is currently available.
United States District Court, N.D. Illinois, Eastern
Division.
SMITHKLINE BEECHAM CORPORATION and
BEECHAM GROUP, P.L.C., Plaintiffs,
v.
APOTEX CORP., APOTEX, INC., and
TORPHARM, INC., Defendants.
No. 98 C 3952.

Jan. 24, 2000.

MEMORANDUM OPINION

KOCORAS, District J.

*1 Before the Court are the following motions: (1) Plaintiffs' Motion to Compel Defendant Apotex, Inc. to Produce Discovery; (2) Defendants' Motion to Amend their Answer and Affirmative Defenses; and (3) Defendants' Motion to Compel Plaintiffs to Testify on Topics 2 and 15-19 of Defendants' Rule 30(b)(6) Notice. For the reasons set forth below, we rule as follows: (1) Plaintiff's Motion to Compel is granted in full; (2) Defendants' Motion to Amend their Answer and Affirmative Defenses is granted; and (3) Defendants' Motion to Compel is granted in part and denied in part.

BACKGROUND

On June 26, 1998, Plaintiffs SmithKline Beecham Corporation and Beecham Group, p.l.c. (collectively "SmithKline") filed a one-count patent infringement complaint against Defendants Apotex Corp., Apotex, Inc. and TorPharm, Inc. (collectively "Defendants"). SmithKline seeks an order barring FDA approval of the Defendants' proposed product until the expiration of SmithKline's patent, and also barring Defendants from manufacturing, using or selling their product until the expiration of SmithKline's patent.

The suit claims that pursuant to 35 U.S.C. §§ 271(b), 271(e) and 281-283, Defendants infringed Patent No. 4,721,723 ("the '723 Patent"), which the United States Patent and Trademark Office granted Beecham on January 26, 1988 for an invention called "Anti-Depressant Crystalline Paroxetine Hydrochloride Hemihydrate." Beecham eventually

assigned the patent to SmithKline, which markets the paroxetine as a pharmaceutical drug, Paxil.

Defendant Apotex, Inc. is a corporation organized under the laws of the Dominion of Canada, with its principal place of business located in Weston, Ontario, Canada. Apotex, Inc. manufactures and markets pharmaceuticals, and it contends that it conducts its testing and manufacturing work solely for prescription drugs to be sold in Canada and other markets outside of the United States.

In 1993, Apotex, Inc. established an operating division, TorPharm Inc., FN1 a Division of Apotex, Inc. ("TorPharm Division"), for the express purpose of "[d]eveloping, testing and manufacturing prescription drugs in conformance with the detailed regulatory requirements" of the United States Food and Drug Administration ("FDA"). Defendants contend that TorPharm Division operates a "stand alone" facility in Etobicoke, Ontario, Canada. Defendants claim that the TorPharm Division facility in Etobicoke is autonomous and wholly distinct from Apotex, Inc.'s Weston facility.

FN1. TorPharm, Inc. is a corporation organized under the laws of the Dominion of Canada.

The suit arose on May 18, 1998, when SmithKline received a letter from TorPharm Division, informing and notifying SmithKline that through its United States agent, Apotex Corp., TorPharm Division had previously filed an Abbreviated New Drug Application ("ANDA") No. 75-356 for "Paroxetine HCl Tablets" with the FDA. The letter purported to be a Notification of Certification of noninfringement under Section 505(j)(2)(B) of the Federal Food, Drug and Cosmetic Act, 21 U.S.C. § 355(j)(2)(B)(i) and (ii), and informed SmithKline TorPharm Division believed that because TorPharm Division's product contained paroxetine hydrochloride solely in an anhydrous state, unlike the '723 Patent which is in hemihydrate form, its "Paroxetine HCl Tablets" did not infringe upon the '723 Patent. SmithKline disputes TorPharm Division's claim, arguing paroxetine hydrochloride in an anhydrate state will convert into a hemihydrate form. Thus, SmithKline claims ANDA No. 75-356 for "Paroxetine HCl Tablets" infringes on the '723 Patent.

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*2 This is our second opinion in this case involving discovery disputes between the parties. Our first opinion concerned SmithKline's motion to compel Defendants, which we granted in part, and denied in part. *See SmithKline Beecham Corp. v. Apotex Corp.*, 1999 WL 311697 *1 (N.D.Ill. May 13, 1999). SmithKline renews a portion of its motion to compel, arguing that new information establishes the propriety of an order compelling Apotex, Inc. to produce materials about the role of Apotex, Inc. in the development of TorPharm's paroxetine hydrochloride. In addition to opposing SmithKline's motion, Defendants seek to amend their answer and affirmative defenses to assert that the '723 Patent is invalid or unenforceable. Defendants also move to compel SmithKline to designate and produce witnesses pursuant to Federal Rule of Civil Procedure 30(b)(6). We shall address each motion in turn.

DISCUSSION

I. Plaintiffs' Motion to Compel

SmithKline moves to compel Apotex, Inc. to produce all documents, samples, and things for two categories: (1) Apotex Inc.'s work and efforts to develop the formula, specifications, and process for formulating and producing paroxetine hydrochloride, which Apotex provided on April 15, 1997 to its TorPharm Division to produce a product for the United States market; and (2) Apotex Inc.'s recent work and efforts to test and tablet larger-scale batches [(PAR(108), PAR(109), and PAR (110)] of bulk paroxetine hydrochloride, produced by Brantford Chemicals, Inc. ("BCI"), allegedly the common supplier for both TorPharm Division and Apotex, Inc. SmithKline argues that these documents fall within the parameters of requests 9, 11, 23-25, 31, and 33 of SmithKline's first set of document requests.

A. Apotex's Initial Development Work

This is not our first review of this issue. Apotex, Inc. had objected to producing these documents and things when SmithKline initially propounded its production requests. SmithKline then moved to compel their production.

In our prior opinion of May 13, 1999, we noted the Defendants had represented to the Court that the

only paroxetine products with any potential to reach the United States market were manufactured in TorPharm Division's facility in Etobicoke, Ontario. *See SmithKline*, 1999 WL 311697 at *5. The Defendants also stated that "Apotex has no intention of marketing paroxetine products in the United States." *Id.* Because SmithKline's production requests sought the production of documents and things that were solely related to Apotex Inc.'s Weston, Ontario facility, Defendants argued that the information was irrelevant. *See id.*

We found the Defendants' logic compelling and ruled that Defendants must only produce samples of paroxetine products manufactured at TorPharm Division's facility because we believed the information sought was solely related to the paroxetine products for non-U.S. Markets. *See id.* However, we explicitly noted that our decision was based on the record before us, and SmithKline was not precluded from bringing this matter before the Court if further developments warranted our attention. *See id.*

*3 SmithKline claims discovery has shown it is entitled to the documents, information and things it seeks from Apotex, Inc.'s Weston, Ontario facility. Specifically, SmithKline claims to have discovered evidence showing TorPharm Division's proposed product was developed as follows: (1) BCI, an Apotex owned entity, developed paroxetine hydrochloride, the active ingredient in the product, which it furnished to Apotex; (2) Apotex developed the specifications, formula, and process to formulate and tablet paroxetine hydrochloride, which it furnished to TorPharm Division; and (3) TorPharm Division incorporated Apotex's formula and specifications and adapted Apotex's process to meet the capabilities of TorPharm's manufacturing equipment.

SmithKline also claims BCI produced three large-scale batches of paroxetine hydrochloride [(PAR(108), PAR(109), and PAR (110)] in the early part of 1999, which it delivered to Apotex. SmithKline contends BCI and TorPharm Division are utilizing these batches with the FDA to assert their capability to increase production to their anticipated commercial-scale level for the United States. SmithKline has only been able to obtain discovery from BCI on the production of these three new batches, but has not been able to obtain

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discovery from Apotex pertaining to the testing of the batches, actual tablets produced from them, or any other information from Apotex regarding the batches or tablets. In essence, SmithKline claims Defendants are misusing our May 13, 1999 opinion by storing information or items at Apotex that it does not want to produce in discovery.

Defendants admit Apotex provided TorPharm Division with the formula and process for manufacturing paroxetine tablets, but claim this served merely as an insignificant starting point from which TorPharm Division conducted its own development work, which Defendants claim forms the basis of the ANDA submitted to the FDA by TorPharm Division. We disagree with Defendants and rule that they must provide the discovery sought by SmithKline.

In determining what matters are discoverable in this case we bear in mind "[p]arties may obtain discovery regarding any matter, not privileged, which is relevant to the subject matter involved in the pending action." Fed. R. Civ. Proc. 26(b)(1). "The information need not be admissible at the trial if the information sought appears reasonably calculated to lead to the discovery of admissible evidence." *Id.* We broadly construe relevancy at the discovery stage. *See In re Aircrash Disaster Near Roselawn, Indiana October 31, 1994*, 172 F.R.D. 295, 303 (N.D.Ill.1997).

In its briefs pertaining to SmithKline's initial motion to compel Defendants claimed Apotex, Inc.'s Weston facility had no connection whatsoever to the development of any products for marketing in the United States. *See SmithKline*, 1999 WL 311697 at *5. Despite this representation to the Court, the Defendants now claim the only connection the Weston facility has with the ANDA is providing a starting point for TorPharm's development work. This contradiction of Defendants' earlier representations to the Court indicate it is far from settled what role Apotex, Inc.'s Weston facility played, and continues to play, in the development of its TorPharm Division's paroxetine.

*4 In addition, SmithKline has presented newly obtained information to the Court that the development process of the paroxetine intended to be marketed by TorPharm Division was not as segregated as Defendants initially claimed. Instead,

SmithKline alleges Apotex Inc.'s Weston facility played a role, which it continues to play, in the development of TorPharm's paroxetine.

Defendants admit TorPharm Division based its development work upon the formula and process developed by Apotex, Inc. at its Weston facility. Indeed, Gaetan Marcoux, the former formulation development manager for TorPharm Division stated on page 99 of his deposition that the formula and process provided to TorPharm Division from Apotex, Inc. were the building blocks for TorPharm Division's process. The evidence also shows TorPharm Division received the "building blocks" for its development work no later than April 15, 1997, when Dr. Sherman, Apotex's president, faxed the formula and process package for paroxetine to Dr. Coffin-Beach, TorPharm's president.FN2 Plainly, whatever work, assumptions, calculations, and processes went into developing Apotex's formula and process is necessarily relevant to TorPharm's ANDA, because they were an essential component of the development process. This is in accord with our prior opinion permitting SmithKline to review and analyze representative samples from each stage in the development of paroxetine products at TorPharm's Division facility. *See SmithKline*, 1999 WL 311697 at *6.

FN2. Marcoux testified that he had already received the formula and process package prior to Coffin-Beach's receipt.

Defendants argue Apotex supplies product only to non-U.S. markets .FN3 Thus, permitting SmithKline discovery from Apotex's Weston facility would improperly expand the scope of discovery to include information regarding paroxetine products that will not be sold in the United States.

FN3. Defendants also argue that allowing the requested discovery will delay the litigation. Had Defendants advised the Court of the true nature of Apotex's role prior to our initial determination of this matter, we would not be facing a second motion at this late date. Also, Defendants are seeking leave to amend their answer and affirmative defenses. If granted such leave, they seek corresponding discovery responses from SmithKline. Granting Defendants their sought remedies will certainly delay the proceedings, undercutting Defendants argument.

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Defendants miss the point. SmithKline has presented the Court with compelling, uncontroverted, newly-obtained evidence that the starting point for TorPharm Division's development process of paroxetine was the product produced by Apotex to be marketed in countries other than the United States. Based on this information, compelling Apotex to produce documents and samples from its Weston facility is no longer related to their non-U.S. paroxetine products, but bears directly on Apotex's role in developing the "building blocks" for the paroxetine product produced by TorPharm Division, which TorPharm Division intends to market in the United States. Merely because that product is also sold outside of the United States is entirely irrelevant. SmithKline is entitled to discovery of each stage of the development of TorPharm's paroxetine product, *See SmithKline*, 1999 WL 311697 at *6. Apotex, Inc. must produce documents and samples reflecting Apotex Inc.'s work and efforts to develop the formula, specifications, and process for formulating and tableting paroxetine hydrochloride.

B. Apotex's Recent Large-Scale Work

SmithKline next moves to compel Defendants to produce discovery related to Apotex's efforts to test and tablet three larger scale batches of paroxetine hydrochloride recently produced by BCI. SmithKline claims BCI recently produced three batches, designated PAR(108)3-99, PAR (109)3-99, and PAR (119) 3-99. All three batches were significantly larger than any previous quantities produced by BCI for TorPharm, Division and are being stored at Apotex, Inc.'s Weston facility.

*5 SmithKline argues that the larger size of the batches, relative to the size of any batches previously produced, evidences TorPharm Division intends to rely upon them to assert to the FDA their anticipated capability of producing paroxetine hydrochloride at a commercial production level. Thus, SmithKline claims that even though the batches are stored at Apotex's Weston facility, TorPharm Division will utilize the batches to further its efforts to market the product in the United States. Consequently, SmithKline accuses TorPharm Division of improperly using this Court's prior order as a shield to prevent SmithKline from conducting appropriate discovery of any documents and things about the larger batches, even though the

batches are actually earmarked for use by TorPharm in its efforts geared towards the United States market.

Defendants claim their actions are warranted and proper. They claim BCI produces bulk paroxetine hydrochloride for both Apotex and TorPharm Division. In contrast to TorPharm Division, Apotex uses the paroxetine to produce products for non-U.S. markets. Defendants *imply* the paroxetine batches are solely for the use of Apotex. Thus, Defendants argue that their failure to produce any documentation on these batches is warranted.

The parties have framed the issue in such a way that it lends itself to easy resolution. If TorPharm is going to rely upon the batches for its application process to the USFDA, SmithKline is entitled to discovery about them. If indeed the batches are intended *exclusively* for use by Apotex in markets outside of the United States, information concerning them is irrelevant to the controversy before the Court.

Defendants argue "there is absolutely no evidence which even suggests that Apotex will use these three batches (or any batches of bulk material) to supply paroxetine to the United States, or that anyone other than TorPharm will be the supplier to the United States ." This not a flat denial of SmithKline's claim. Rather, their "denial" is couched in terms of there being no evidence.

Defendants next argue TorPharm Division will be the sole supplier to the United States market. While evidently true, SmithKline has not argued that Apotex is producing paroxetine products for the United States market. Rather, the dispute centers on whether Apotex is warehousing paroxetine to shield it from discovery by SmithKline, when TorPharm Division intends to use the paroxetine in its efforts to obtain FDA approval to market its product in the United States. Defendants make no argument on this point, much less a flat denial.

Finally, Defendants argue Apotex will not use the three batches to supply paroxetine to markets in the United States. Again, this is not the issue. SmithKline has not made this argument, but instead claims that TorPharm Division will use the three batches in its efforts to market a paroxetine product in the United States. Defendants have not argued

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this point either, and again have not made an outright denial of SmithKline's allegations.

*6 Given that Defendants have not stated that TorPharm Division will not use the three larger batches that are currently located at Apotex's Weston facility in its efforts to obtain FDA approval allowing it to produce paroxetine products to be sold in the United States market, we believe that the batches may be used by TorPharm and thus are relevant to this action. SmithKline is entitled to the discovery they seek regarding the paroxetine hydrochloride contained in batches PAR(108)3-99, PAR (109)3-99, and PAR (119) 3-99 and its motion to compel is granted.

II. Defendants' Motion to Amend Their Answer and Affirmative Defenses

Next, Defendants move to amend their answer and affirmative defenses to assert that the '723 patent is invalid or unenforceable. Federal Rule of Civil Procedure 15(a) provides that a party must obtain leave of court or written consent of the opposing party to amend a pleading. *See Garner v. Kinnear Mfg. Co.*, 37 F.3d 263, 269 (7th Cir.1994) (citing *Perrian v. O'Grady*, 958 F.2d 192, 194 (7th Cir.1992)). Under Rule 15(a) of the Federal Rules of Civil Procedure, district courts may grant leave to amend pleadings and such leave "shall be freely given when justice so requires," so long as there is no harm to the other party. Leave to amend is "inappropriate where there is undue delay, bad faith, dilatory motive on the part of the movant, repeated failure to cure deficiencies by amendments previously allowed, undue prejudice to the opposing party by virtue of allowance of the amendment or futility of the amendment." *Perrian*, 958 F.2d at 194; *see also General Electric Capital Corp. v. Lease Resolution Corp.*, 128 F.3d 1074, 1085 (7th Cir.1997) (citing *inter alia Foman v. Davis*, 371 U.S. 178, 182, 83 S.Ct. 227 (1962)); *Orix Credit Alliance, Inc. v. Taylor Mach. Works, Inc.*, 125 F.3d 468, 480 (7th Cir.1997) (citing *Ferguson v. Roberts*, 11 F.3d 696, 706 (7th Cir.1993)). Delay is an insufficient justification by itself for denying a motion to amend, unless the delay causes undue prejudice to the opposing party. *See Tragarz v. Keene Corp.*, 980 F.2d 411, 432 (7th Cir.1992).

SmithKline argues Defendants have unduly delayed seeking to amend for improper reasons, prejudicing

SmithKline's ability to swiftly prosecute their case. Defendants dispute Plaintiffs characterization of the delay as undue. They contend they could not previously plead the '723 patent was invalid or unenforceable because they did not have a good faith basis for doing so. Defendants claim SmithKline delayed producing their discovery responses, and turned over a prodigious amount of documents (in excess of 375,000 pages). As a result, Defendants only recently were able to determine a good faith basis existed for pleading that the '723 patent is invalid or unenforceable. Defendants further contend SmithKline will not be prejudiced if the Court permits them to amend their answers and affirmative defenses. We conclude Defendants may amend their affirmative defenses and answer because Defendants did not unduly delay seeking to file their amendments.FN4

FN4. Because we find that no undue delay exists we need not examine whether SmithKline is prejudiced by the delay. As for SmithKline's prejudice argument regarding the Philadelphia case concerning the '723 patent, we note that SmithKline is the Plaintiff in both cases and opposed their consolidation. The resolution of any prejudice to SmithKline arising from duplicative depositions is within their control and it may not claim prejudice on this basis.

*7 This case has been in litigation since June 26, 1998. Defendants filed their original answer and affirmative defenses on August 31, 1998, and moved to amend their answer and counterclaim on December 22, 1999, nearly sixteen months later. Contrary to SmithKline's implication, however, the record does not show Defendants were inactive during this period. Defendants promptly served their first requests for production of documents on SmithKline in September of 1998. They followed these initial requests with a second set of production requests on March 10, 1999. SmithKline admits it did not fully comply with these production requests until September 21, 1999, and the last batch of documents concerned Ferrosan, a company with whom SmithKline has a licensing deal.

Defendants claim the '723 patent is invalid and unenforceable based upon Ferrosan's role in the development of the paroxetine hydrochloride marketed by SmithKline. Specifically, Defendants claim they recently obtained evidence indicating in

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the early 1980's SmithKline received paroxetine hydrochloride material and specifications from Ferrosan. Because SmithKline did not list any Ferrosan employees as named inventors in the '723 patent, Defendants argue the '723 patent is invalid under 35 U.S.C. § 102(f). Based on this recently discovered information, Defendants seek to amend their answer and affirmative defenses to plead the '723 patent is invalid and unenforceable.

SmithKline challenges this version of events, pointing to Defendants' own statement that SmithKline has been producing Ferrosan documents for over one year. SmithKline also claims Defendants are actually the party slowing the progress of discovery to better align this action with a similar case in Pennsylvania.

We find SmithKline's arguments unpersuasive. Contrary to SmithKline's assertion, the pertinent factor is when they completed their document production. Only then could Defendants fully synthesize the documents and compose their theory of the case. Defendants received the final documents from SmithKline in September 1999. They subsequently filed Rule 30(b)(6) deposition notices seeking information relevant to the invalidity and unenforceability issues. After SmithKline balked at designating witnesses, claiming irrelevance to the issues before the Court, Defendants moved to amend their answers and affirmative defenses. We do not believe this qualifies as foot-dragging by Defendants.

Moreover, the record shows SmithKline's production tardiness was not an insignificant factor in the timing of Defendants seeking to assert the invalidity and unenforceability defenses. SmithKline contributed to any delay by taking over six months to finish producing the documents sought by Defendants in March of 1999, and taking one year to fully comply with Defendants' September 1998 requests. Allowing SmithKline to assert delay as a basis for prohibiting Defendants from amending their answer and affirmative defenses would be inequitable inasmuch as SmithKline has been less than diligent in fulfilling its production obligations. Based on the relatively brief period between the completion of production and Defendants seeking leave to amend in tandem with SmithKline's contributing role, we conclude Defendants did not unduly delay seeking to amend their answer and

affirmative defenses.

*8 SmithKline next argues Defendants are barred from raising these issues because they failed to assert them in their notice letter to SmithKline, thus precluding Defendants from raising them in any subsequent litigation. SmithKline essentially analogizes this situation to cases barring a discrimination complainant from raising any basis for discrimination in her complaint that she did not plead with EEOC. In support of this original proposition, SmithKline cites *Bristol-Myers Squibb Co. v. Royce Labs, Inc.*, 69 F.3d 1130 (Fed.Cir.1995), wherein the court stated that in an infringement action, "depending upon the nature of the certification that has been filed, the district court determines the validity of the patent at issue and/or whether the drug sought to be marketed infringes the claims of the patent." *Bristol-Myers Squibb*, 69 F.3d at 1135.

Bristol-Myers does not support SmithKline's argument. The cited language merely discusses what the court should look to in its determination of the validity of the patent. *Bristol-Myers* does not say notification letters to patent-holders must assert all potential basis for noninfringement, at risk of being precluded from asserting them in a subsequent suit. Because SmithKline does not assert any other authority for barring Defendants from asserting in litigation a theory not presented in its notice letter, we conclude Defendants may amend their answer and affirmative defenses.

III. Defendants' Motions to Compel

The final matter before the Court is Defendants' motion to compel SmithKline to testify on Topics 2,3 and 15-19 of Apotex's Rule 30(b)(6) notice. Rule 30(b)(6) authorizes litigants to name a business entity as a deponent. *See Fed. R. Civ. Proc. 30(b)(6)*. Doing so triggers a duty upon the business to designate an individual to testify on its behalf, while setting forth the matter upon which the individual will testify. *See id.* The designated witness "must testify as to matters known or reasonably available to the organization." *Id.*

Defendants originally filed a motion to compel SmithKline to testify on topics 1-20 of defendants' Rule 30(b)(6) notice. Following receipt of the motion, SmithKline forwarded Defendants a letter

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naming individuals to testify on topics 1, 4-14, and 20. SmithKline declined to designate witnesses for topics 2, and 15-19. SmithKline promised to shortly name a witness for topic 3, but as of this writing, has failed to do so. We will examine the propriety of a Rule 30(b)(6) deposition for each these topics in sequence.

A. Rule 30(b)(6)

Rule 30(b)(6) is a vehicle for streamlining the discovery process. *See Resolution Trust Corp. v. Southern Union Co., Inc.*, 985 F.2d 196, 197 (5th Cir.1993). The effect of the rule is to place upon the business entity the burden of identifying witnesses who have knowledge responsive to subjects requested in the Rule 30(b)(6) requests of its opponent. *See id.* Rule 30(b)(6) is also designed to prevent business entities from "bandying," the practice of presenting employees for their deposition who disclaim knowledge of facts known by other individuals within the entity. *See Alexander v. F.B.I.*, 186 F.R.D. 148, 152 (D.D.C.1999). Consequently, Rule 30(b)(6) imposes a duty upon the named business entity to prepare its selected deponent to adequately testify not only on matters known by the deponent, but also on subjects that the entity should reasonably know. *See Alexander*, 186 F.R.D. at 152; *United States v. Taylor*, 166 F.R.D. 356, 361 (M.D.N.C.1996); *Media Svcs. Group, Inc. v. Lesso, Inc.*, 45 F.Supp.2d 1237, 1253 (D.Kan.1999). If a deponent is unable to testify about certain relevant areas of inquiry the business entity must designate additional parties to satisfy a Rule 30(b)(6) notice. *See Alexander*, 186 F.R.D. at 152; *Taylor*, 166 F.R.D. at 360; *Starlight Intl. Inc. v. Herlihy*, 186 F.R.D. 626, 639 (D.Kan.1999); *Dravo Corp. v. Liberty Mut. Ins. Co.*, 164 F.R.D. 70, 75 (D.Neb.1995)(corporation must provide a substitute for a deponent with insufficient knowledge). Failure to adequately prepare the deponent may subject the entity to sanctions. *See Bank of New York v. Meridien Biao Bank Tanzania Ltd.*, 171 F.R.D. 135, 151 (S.D.N.Y.1997); *Taylor*, 166 F.R.D. at 363; *Starlight*, 186 F.R.D. at 640.

*9 A Rule 30(b)(6) deponent's testimony does not represent the knowledge or opinions of the deponent, but that of the business entity. *See Taylor*, 166 F.R.D. at 361. In effect, the deponent is "speaking for the corporation," giving the

corporation's position on the topic. *See id.* The deponent must testify to both the facts within the knowledge of the business entity and the entity's opinions and subjective beliefs. *See id.* This includes the entity's interpretation of events and documents. *See id.*

B. Topic 2

On October 22, 1999, Defendants served their Notice of Deposition Pursuant to Rule 30(b)(6) ("the Rule 30(b)(6)") upon SmithKline. Topic 2 of the Rule 30(b)(6) requested SmithKline designate a witness to testify regarding "SmithKline's responses to Defendants' Interrogatories and requests for production, along with the subjects identified therein." SmithKline objected to this Interrogatory, claiming that complying with it would be unduly burdensome because it would require having a witness study the vast amount of discovery pertaining to the case.

While the liberal discovery allowances of the Federal Rules do not permit a recipient of discovery requests to fulfill its discovery obligations by failing to conduct a search for answers and then stating it does not know the answer, *See In re Independent Svc. Org. Antitrust Litig.*, 168 F.R.D. 651, 653-54 (D.Kan.1996), the Rules also preclude proponents of discovery from wielding the discovery process as a club by propounding requests compelling the recipient to assume an excessive burden. *See United States v. District Council of New York City*, 1992 WL 208284 at *15 (S.D.N.Y. Aug. 19, 1992). Consequently, the recipient of a Rule 30(b)(6) request is not required to have its counsel muster all of its factual evidence to prepare a witness to be able to testify regarding a defense or claim. *See In re Independent Svc. Org. Antitrust Litig.*, 168 F.R.D. at 654. This rule holds especially true when the information sought is likely discoverable from other sources. *See E.E.O.C. v. HBE Corp.*, 157 F.R.D. 465, 466-67 (E.D.Mo.1994).

Defendants assert that compelling SmithKline to prepare such a witness would not be an undue burden, but would serve to narrow and focus the issues of the case. As Defendants are aware, answering requests for production and interrogatories customarily is performed with the assistance of counsel. Thus, the proposed area of inquiry improperly trespasses into areas of work

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product and attorney-client privilege. See *In re Independent Svc. Org. Antitrust Litig.*, 168 F.R.D. at 654. In such cases, courts will not permit discovery implicating privilege concerns absent a showing that the information sought is not discoverable by other means. See *HBE Corp.*, 157 F.R.D. at 466-67.

Defendants could readily have obtained the same information in a more efficient manner by propounding "standard" interrogatories upon its opponent. By doing so, Defendants could obtain the same information with infinitely less intrusion upon privilege concerns, in a more workable form, and from the individuals who have actual knowledge of the matters at issue.

*10 In its present form, we find Defendants' Rule 30(b)(6) deposition notice overbroad, unduly burdensome, and an inefficient means through which to obtain otherwise discoverable information. Defendants have also failed to convince us that the factual information they seek has not already been produced, or that it cannot be discovered through a less invasive method. Accordingly, we deny Defendants' motion to compel on Topic 2.

C. Topic 3

Topic 3 of the Rule 30(b)(6) requests SmithKline designate a witness to testify on the content of SmithKline's patent. While SmithKline has not explicitly objected to this Topic, it also has failed to designate a testifying witness. Because SmithKline also has not tendered to the Court any basis for not designating and producing a witness knowledgeable on Topic 3, we hold that it must do so without delay.

D. Topics 15-17

In Topics 15-17, Defendants requested SmithKline designate and produce a Rule 30(b)(6) witness who will testify on prior art bearing on the validity and enforceability of the '723 patent. SmithKline argues topics 15-17 are irrelevant to the interpretation of the patent claim and whether Apotex's proposed drug will infringe any claims of the patent. The determination of this issue hinges on the outcome of Defendants' motion to amend their answer and affirmative defenses, which would make the information sought quite relevant. Because we

granted Defendants' motion to amend *supra*, topics 15-17 are relevant to the case and SmithKline must designate witnesses to testify on these matters.

E. Topic 18

In Topic 18, Defendants seek information on the factual basis of SmithKline's claim that Defendants infringed the '723 patent. The issue here is duplication. SmithKline argues it need not designate a 30(b)(6) witness because Defendants have also served Interrogatory Number 12 upon SmithKline seeking the same information. SmithKline is currently preparing its answer to this interrogatory, and argues it should not have to prepare a representative witness to testify to matters it is already providing to Defendants.

We agree. As with Topic 2, Topic 18 improperly infringes upon matters of attorney-client privilege, work product, imposes an undue burden, and is needlessly duplicative because Defendants will already be receiving the information. See *HBE Corp.*, 157 F.R.D. at 466-67; *In Re Independent Svc. Org. Antitrust Litig.*, 168 F.R.D. at 654. Inasmuch as complying with producing a witness to testify on Topic 18 would require SmithKline to brief its designee on SmithKline's response to Interrogatory Number 12, compelling SmithKline to undergo this duplicate process is unnecessary and overly burdensome. See *Dist. Council of New York City*, 1992 WL 208284 at * 15. Consequently, we deny Defendants' motion to compel on Topic 18.

F. Topic 19

Along a similar vein, Topic 19 is better suited to alternative means of discovery than a Rule 30(b)(6) deposition. Topic 19 concerns SmithKline's investigation and testing activities which led to the conclusion that Defendants were infringing the '723 patent. Similar to Topic 2, we believe a Rule 30(b)(6) deposition is an inefficient means of ascertaining the information sought. Instead, standard interrogatories would be a better method of discovering the particulars of SmithKline's investigation because SmithKline could synthesize the information from all of the necessary sources, which would then be presented to Defendants in a comprehensible manner. In addition, SmithKline claims any testing was conducted by individuals who are knowledgeable in the field, who it will tender as

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expert witnesses. Again, this is an area better suited for an alternate means of discovery; in this case interrogatories identifying all individuals involved in testing, expert interrogatories and depositions. Consequently, we deny Defendants' motion to compel SmithKline to designate a witness to answer Topic 19.

CONCLUSION

*11 For the foregoing reasons, (1) Plaintiffs' Motion to Compel is granted in full; (2) Defendants' Motion to Amend their Answer and Affirmative Defenses is granted; and (3) Defendants' Motion to Compel is granted in part and denied in part. The parties have fourteen (14) days to comply with this Order.

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END OF DOCUMENT



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HBriefs and Other Related Documents

United States District Court, N.D. Illinois, Eastern Division.

In re SULFURIC ACID ANTITRUST LITIGATION.

No. 03 C 4576.

MDL No. 1536.

Aug. 19, 2005.

Mary Jane Edelstein Fait, Adam J. Levitt, Wolf, Haldenstein, Adler, Freeman & Herz LLC, Chicago, IL, for Plaintiffs.

Edward M. Ordonez, Hugo Chaviano, Sanchez & Daniels, David C. Gustman, Jill Christine Anderson, Jeffery Moore Cross, Freeborn & Peters, Michael H. Cramer, Adam R. Chiss, Michael David Richman, Sachnoff & Weaver, Ltd., R. Mark McCareins, Andrew David Shapiro, Edward L. Foote, Todd Jay Ehlman, William Charles O'Neil, Winston & Strawn, Matthew Patrick Connelly, Cory D. Anderson, William Edward Snyder, Connelly, Roberts & McGivney, Joel Gerald Chefitz, Howrey Simon Arnold & White, LLP, Todd Lawrence McLawhorn, Howrey Simon Arnold & White, LLP, John Reid Malkinson, Malkinson & Halpern, P.C., Michael Gerard Bruton, Ross, Dixon & Bell, L.L.P., Chicago, IL, K. Scott Hamilton, Dickinson Wright PLLC, Detroit, MI, Dylan Smith, Verrill Dana LLP, Portland, ME, Susan G. Kupfer, Glancy & Binkow LLP, San Francisco, CA, for Defendants.

MEMORANDUM OPINION AND ORDER

COLE, Magistrate Judge.

INTRODUCTION

*1 Defendants, E.I. Du Pont de Nemours and Company, Noranda, Inc., Falconbridge Limited, and Norfalco LLC ("defendants"), have moved to compel a second round of Rule 30(b)(6) depositions of all named plaintiffs. The plaintiffs have objected on various grounds, including the defendants' failure to have obtained leave of court prior to the issuance of the 30(b)(6) notices. The relevant facts are these.

Plaintiffs filed their Consolidated Amended Class Action Complaint on September 5, 2003, alleging that the defend-

ants engaged in a conspiracy to raise, fix, maintain or stabilize the price of sulfuric acid in the United States in violation of Section 1 of the Sherman Act, 15 U.S.C. § 1. On October 14, 2003, the defendants issued deposition notices pursuant to Rule 30(b)(6), Federal Rules of Civil Procedure, to all plaintiffs. The notices initially listed fifteen topics that were to be covered in the depositions. Ultimately, the number was reduced to seven. The named plaintiffs were deposed between November 14, 2003, and December 11, 2003. A Second Amended Class Action Complaint was filed on May 24, 2004, and a year later leave was sought leave to file a Third Amended Class Action Complaint. That motion is pending before Judge Coar.

On June 3, 2005, DuPont issued a second Rule 30(b)(6) notice of deposition to all named plaintiffs and attached a list of seven topics to be covered. ^{FN1} The additional depositions were necessitated, DuPont said, by the filing of the Second Amended Class Action Complaint in late May 2004. On June 16th, counsel for the plaintiffs wrote to Mr. Sitarchuk objecting to the notices of deposition and informing him that "we will not be producing witnesses on the dates you have noticed." (Defendants Motion to Compel, Ex. E). ^{FN2} One of the sixteen "General Objections" raised by the plaintiffs was that the defendants had not obtained leave of court to take a second set of Rule 30(b)(6) depositions, as required by Rule 30(a)(2)(B). (Defendants Motion to Compel, Ex. E at ¶ 9). ^{FN3}

^{FN1}. The currently noticed topics have been categorized by the defendants as follows: three topics address competition in the market during the period Noranda DuPont LLC was in operation; one addresses competition during the period that the Norfalco LLC (the successor to the Noranda DuPont LLC) has been in operation; one is directed at plaintiffs' allegations concerning certain so-called "zone contracts" between Falconbridge Limited and its distributors and resellers that existed in 1996-97; and the remaining two relate to plaintiffs' investigations of and bases for their allegations of antitrust violations.

^{FN2}. Attached to the letter were plaintiffs' formal objections. They are in essence an iteration of Rule



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26(b)(2). Among them were: the deposition topics are unreasonably cumulative and duplicative of those in the October 14, 2003 notices of deposition; the topics are improper under Rule 30(b)(6) in that they seek to elicit their contentions and legal theories; they seek information that is either not known and/or not reasonably available to the designated plaintiffs; they require the plaintiffs to marshal all of their factual proof in support of their claims and in opposition to defendants' defenses; the discovery sought is obtainable from other sources or discovery devices that are more convenient, more efficient, less burdensome and less expensive. The sixteen General Objections were incorporated by number in the seven paragraphs of "Specific Objections."

FN3. In addition, plaintiffs objected that the topics were duplicative of those addressed at the earlier deposition and that they involved legal theories and the activities of their counsel in the case.

ANALYSIS

A

Of course, where pleadings change, the theory of the case can also change-often quite drastically-necessitating further additional discovery, including additional depositions of previously deposed witnesses. McCann v. Frank B. Hall & Co., 109 F.R.D. 363, 368 (N.D.Ill.1986)(Nordberg, J.).^{FN4} But a party's right to conduct such discovery is neither absolute, automatic, nor self-determinable. Rather, it is governed by Rule 30(a)(2)(B), which provides that a party may take the testimony of any person without leave of court unless "the person to be examined has already been deposed in the case."

FN4. In McCann, the belated attempt to add additional claims converted a simple \$300,000 breach of contract action into a high-stakes tort action, with punitive damages of \$2 million. Judge Nordberg, understandably, concluded that it was "too late in the litigation to change the entire orientation of the case..." *Id.* at 367.

The defendants contend that they had no obligation to obtain leave of court to conduct a second set of Rule 30(b)(6) depositions. In their view, Rule 30(a)(2)(B) does not apply to Rule 30(b)(6) depositions, especially where the second deposition relates to different topics than the first. The argument ignores the text, history, and purpose of the 1993 Amendment to Rule 30.

*2 The Federal Rules of Civil Procedure, which have the force of statutes, Zapata Hermanos Sucesores, S.A. v. Hearthside Baking Co., Inc., 313 F.3d 385, 392 (7th Cir.2002), *cert. denied*, 540 U.S. 1068 (2003), are to be accorded "their plain meaning ... and generally with them, as with a statute, '[w]hen we find the terms ... unambiguous, judicial inquiry is complete....' " Pavelic & LeFlore v. Marvel Entertainment Group, 493 U.S. 120, 123 (1989). The language of Rule 30(a)(2)(B) is neither vague nor fluid. Indeed, it could not be plainer: a party "must obtain leave of court" to take a second deposition "if... the person to be examined already has been deposed in the case ". (Emphasis supplied). What Justice Holmes said long ago is an appropriate guide for decision: "the words of the statute are peremptory and must be obeyed. We do not apprehend any serious consequences, in view of the date of the change. But, whatever the consequences, we must accept the plain meaning of plain words." United States v. Brown, 206 U.S. 240, 244 (1907).

Of course, the Rule directs that leave to take a successive deposition "shall" be granted, but only if the court-not an inevitably self-interested party-determines that the requested discovery is "consistent with the principles stated in Rule 26(b)(2)"-that is, whether it is unreasonably cumulative or duplicative, is obtainable from an alternative more convenient or less burdensome source, whether the party "seeking discovery" had ample opportunity by discovery to obtain the information sought or whether the burden of proposed discovery outweighs its likely benefit.

It is no answer to say that where there has been an amendment to a complaint, discovery is often allowed. "General propositions do not decide concrete cases," Lochner v. New York, 198 U.S. 45, 76 (1905)(Holmes, J., dissenting),^{FN5} and the fact that a party may ultimately be able to persuade a judge to allow successive depositions has absolutely noth-



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ing to do with the obligation to seek in the first instance a court's permission to take a deposition of a "person" who has once been deposed.

FN5. See also *Daubert v. Merrell Dow*, 509 U.S. 579, 598 (1993)(Rehnquist, C.J., concurring in part and dissenting in part) (" 'general observations' " suffer from the common flaw that they are not applied to the specific matter and "therefore they tend to be not only general, but vague and abstract.").

The defendants here issued their second Rule 30(b)(6) subpoenas without leave of the court, despite the unambiguous requirement of Rule 30(a)(2)(B). The notices and subpoenas are thus invalid. See *Ameristar Jet Charter, Inc. v. Signal Composites, Inc.*, 244 F.3d 189, 192 (1st Cir.2001); see also *Innomed Labs, LLC v. Alza Corp.*, 211 F.R.D. 237, 240 (S.D.N.Y.2002) (denying motion seeking leave to re-depose a party for failure to comply with Rule 30(a)(2)(B)).

B

Nothing in Judge Nordberg's opinion in *McCann v. Frank B. Hall & Co., Inc.*, 109 F.R.D. 363 (N.D.Ill.1986) suggests, let alone compels, a contrary result. The issues implicated by Rule 30(a)(2)(B) were not involved in that case. Rather, the issue was whether the defendant would be prejudiced if the court allowed the plaintiff to file an amended complaint on the eve of the close of discovery that would convert the suit from a simple breach of contract case into a substantial "tort action with high stakes..." *Id.* at 368. It was in this context that Judge Nordberg said that where an amendment significantly changes the complaint, depositions which have already been taken "may" have to be repeated to pursue these additional claims." *Id.* Judge Nordberg did not address the question of whether leave of court is necessary to take a second 30(b)(6) deposition.^{FN6}

FN6. If the third amended complaint substantially changes the case, *McCann* would appear to counsel against Judge Coar's allowing the amendment. If it does not, the argument for additional discovery would tend to lose much of its force.

*3 Nor do the other cases defendants cite excuse their fail-

ure to comply with Rule 30(a)(2)(B). In *Cohn v. Taco Bell Corp.*, No. 92 C 5852, 1993 WL 451463 (N.D.Ill. Nov. 1, 1993), there was no issue raised under that Rule, and thus the case is not controlling.^{FN7} The question, which was considered under Rules 45(c)(3)(A)(iv) and 26(b)(2)(ii), was whether a non-party witness could be redeposed following the post-deposition disclosure of the witness's secret taping of the plaintiff, which led to an amendment to the complaint. The court concluded that he could and that the defendant's motion to quash should be denied. The court did at least mention the Rule in *Collins v. International Dairy Queen*, 189 F.R.D. 496 (M.D.Ga.1999), but that was because the defendants properly requested supplemental depositions before a special master. *Id.* at 496-98.

FN7. Prior cases have precedential value only when there has been a deliberative consideration of the issue at hand. See *City of Kenosha v. Bruno*, 412 U.S. 507, 512-13 (1973)("But in none of the three opinions in *Holmes* was the issue of whether or not a municipality is a person within the meaning of § 1983 discussed."); *Kramer v. Scientific Control Corp.*, 534 F.2d 1085, 1090 (3d Cir.1976) ("The challenge raised in this appeal was not presented to the court in those cases. Thus, it cannot be said that we have considered, adjudicated and set forth a holding regarding the duality problem."); *United States v. Bohle*, 445 F.2d 54, 65 (7th Cir.1971) ("However, there was apparently no challenge to the admission of this evidence ... We think it clear that Becker was not intended to, and did not, resolve the question of the admissibility of records of mental diagnoses. Thus, we must approach it as an issue of first impression in this court.").

That leaves *Quality Aero Technology, Inc. v. Telemetrie Elektronik GmbH*, 212 F.R.D. 313 (E.D.N.C.2002). There, following an initial 30(b)(6) deposition of the defendant, the plaintiff, without leave of court, served a second Rule 30(b)(6) notice. When the defendant failed to appear, the plaintiff moved to compel the second deposition. In granting the motion, the court concluded that prior judicial approval for a second deposition was not necessary in a Rule 30(b)(6)



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context, since “Rule 30(b)(6) depositions are different from depositions of individuals.” *Id.* at 319. The sole support for this conclusion was the Advisory Committee Notes to the 1993 Amendment to Rule 30 in which the Committee noted that “[a] deposition under Rule 30(b)(6) should, for purposes of [calculating the ten deposition limitation of Rule 30(a)(2)(A)], be treated as a single deposition even though more than one person may be designated to testify.” (Emphasis supplied). But it hardly follows from this that 30(b)(6) depositions should, “for [other] purposes,” also be treated “different[ly] from depositions of individuals.”

The Advisory Committee's explanation of why Rule 30(b)(6) depositions were to be treated differently from individual depositions for “purposes of” the ten deposition rule, is readily apparent. As the instant case demonstrates, Rule 30(b)(6) deposition notices routinely specify a number of topics of inquiry, which often necessitate the designation of multiple witnesses. The more complex the case, the greater the number of topics to be explored during the deposition and the greater number of witnesses. If each witness were counted separately, a party could easily exhaust the number of allowable depositions in one or two Rule 30(b)(6) depositions. The Advisory Committee Notes make clear that the drafters intended to avoid that problem by counting a 30(b)(6) deposition as a single deposition, regardless of how many individuals were required to be designated to comply with a 30(b)(6) notice.

There is nothing in the text, history, or purpose of Rule 30 that supports the conclusion that “for purposes of” the prior judicial approval requirement for successive depositions, Rule 30(b)(6) depositions should be treated differently from depositions of individuals. The dissimilar treatment approved by *Quality Aero Technology* is inconsistent with Rule 30's overall treatment of corporations and individuals. For example, the general requirements for noticing of depositions apply equally to individual and corporate deponents. Each is entitled to the same reasonable advance notice under Rule 30(b)(1); each is entitled to advance notice if the deposition is to be videotaped (Rule 30(b)(2)); and production of documents may be sought in the deposition notices in each case. Not surprisingly, one of the leading treatises on federal practice has concluded that “[t]he rule requiring

leave of court to take a second deposition applies to an entity that is deposed pursuant to Rule 30(b)(6). Even though a party may be deposing a different corporate representative, it is still seeking a ‘second’ deposition of the entity.” 7 Moore's Federal Practice, § 30.05[1][c] at 30-30.3 (3d ed.2005).^{FN8}

^{FN8}. In this case, the same individuals will be testifying on behalf of the corporate plaintiffs who testified previously.

*4 Apart from the absence of any textual support in Rule 30 for treating successive depositions of corporations differently from those of previously deposed individuals, dissimilar treatment is inconsistent with the goals subserved by the 1993 Amendment to Rule 30, with its “strong interventionist approach to discovery regulation.” Under the traditional non-interventionist approach, judicial intervention into the discovery process was relatively limited; under the 1993 Amendment, in contrast, the court is invested with substantial authority to control the formal discovery process from the outset, and to do so “on the basis of broadly phrased directives. More significantly, the inertia of the process has been largely altered: the court must affirmatively allow discovery beyond specified limits before it can take place.” 7 Moore's Federal Practice, § 30 App.102[3] at 30 App.-36 (2004). These considerations are as applicable in the context of successive 30(b)(6) depositions as they are in the context of successive depositions of individuals.

Construction, no doubt, is not a mechanical process and there may inevitably be “some retrospective infusion so that the line between interpretation and substitution is sometimes thin. But there is a difference between reading what is and rewriting it.” *Shapiro v. United States*, 335 U.S. 1, 43 (1948) (Frankfurter, J., dissenting). As Justice Cardozo said, “we are not at liberty to revise while professing to construe.” *Sun Printing & Publishing Association v. Remington Paper & Power Co.*, 235 N.Y. 338, 346 (1923). But that is what *Quality Aero Technology* has done. Under its construction, Rule 30(a)(2)(B) in essence, reads: “A party must obtain leave of court to take a second or successive deposition of any previously deposed individual. This Rule does not apply to successive Rule 30(b)(6) depositions, which do not require leave of court.” If the drafters of Rule 30 wanted it



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to exclude Rule 30(b)(6) deponents from the ambit of Rule 30(a)(2)(B), they would have said so. At a minimum, there would have been some indication in the Advisory Committee Notes that that was their intent. There is none.

Finally, *Quality Aero Technology's* construction of Rule 30 leads to anomalous results-which, as Judge Posner has said, is a reason for rejecting a particular statutory construction. See *Zapata Hermanos Sucesores*, 313 F.3d at 388.

Rule 30(a) provides:

(a) When Depositions May Be Taken; When Leave Required

(1) A party may take the testimony of *any person*, including a party, by deposition upon oral examination without leave of court except as provided in paragraph (2)....

(2) A party must obtain leave of court, which shall be granted to the extent consistent with the principles stated in Rule 26(b)(2), ... if, without the written stipulation of the parties,

* * *

(B) the *person* to be examined already has been deposed in the case....

*5 (Emphasis supplied).

As used in 30(a)(1), "person" necessarily includes corporations and individuals. Any other reading would be nonsensical, for it would mean that a corporation could not be deposed even once without court approval, while an individual could. This would not only give a greater measure of protection to corporations than to individuals, but in addition, would require the very judicial involvement in the first instance that *Quality Aero Technology* held was unnecessary after the first deposition. Since, *Quality Aero Technology* held that court approval is not required for successive 30(b)(6) depositions, it necessarily follows that the word "person," as used in 30(a)(1), has a different meaning than in 30(a)(2)(B): the former includes both individuals and corporations, while the latter includes only individuals-at least that is the inevitable result of acceptance of *Quality Aero Technology's* reading of the Rule.

However, there is no basis to attribute to the drafters of the Rule an intent to use the same word in the same Rule, with-

in a few lines of each other, to mean different things. Such a reading would be at odds with the "presumption that a given term is used to mean the same thing throughout a statute"-a presumption that is "surely at its most vigorous when a term is repeated within a given sentence." *Brown v. Gardner*, 513 U.S. 115, 118 (1994). See also *Inyo County, California v. Paiute-Shoshone Indians of the Bishop Community*, 538 U.S. 701, 710 (2003).^{FN9} "To give the same words a different meaning for each category would be to invent a statute rather than interpret one." *Pasquantino v. United States*, --- U.S. ---, 125 S.Ct. 1766, 1773 (2005). Such a reading would also be at odds with the almost undeviating definition in statutes of "person" as "include[ing] corporations, companies, associations, firms, partnerships, societies, and joint stock companies, as well as individuals." 1 U.S.C. § 1. Just as Congress legislates with knowledge of the basic rules of statutory construction, *Rowland v. California*, 506 U.S. 194, 201 (1993), so too do the drafters of the Federal Rules of Evidence.

^{FN9} *Quality Aero Technology* did not address this question or the policy question of what purpose is to be served by allowing a succession of Rule 30(b)(6) depositions.

D

The First Circuit's decision in *Ameristar Jet Charter, Inc. v. Signal Composites, Inc.*, 244 F.3d 189 (1st Cir.2001) makes clear that prior judicial approval is required for multiple depositions, whether they be of corporations or individuals. There, one of the defendants was deposed through two witnesses pursuant to Rule 30(b)(6) deposition notices. A year later, the plaintiff served a second Rule 30(b)(6) subpoena to that defendant. The district court held that the issuance of the second subpoena without leave of court was improper and granted a motion for protective order. The First Circuit affirmed, holding that "[b]ecause this second Rule 30(b)(6) subpoena was issued to [defendant] GEAE without leave of the court, it was invalid." *Id.* at 192.

Quality Aero Technology attempted to distinguish *Ameristar Jet* on the basis that it was "a predictable result of the standard of review" that precludes reversal unless the district court's decision was "plainly wrong." 181 F.R.D. at 319. If



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Quality Aero Technology is right that leave of court is not required for successive 30(b)(6) depositions, then the district court in *Ameristar Jet Charter* was “plainly wrong,” and the First Circuit would have been required to reverse. But that is not what happened. Thus, I cannot agree either with *Quality Aero Technology's* conclusion that prior judicial approval is only required for successive individual depositions, or with its conclusion that, “properly read,” *Ameristar Jet Charter* applies “only to the specific facts before the Massachusetts court.” 181 F.R.D. at 319.

*6 The Federal Rules of Civil Procedure are to be construed and administered to secure the just, speedy, and inexpensive determination of every action. *See* Rule 1. They are not, however, to be ignored. Conformity with the Rules is especially important in a complex, multi-district anti-trust case like this, involving, as it does, six plaintiffs and ten defendants, represented by some two dozen attorneys.

For the foregoing reasons, the defendants' motion to compel Rule 30(b)(6) depositions of all named plaintiffs [# 155] is DENIED.

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