IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF OHIO
EASTERN DIVISION

North American Rescue Products, Inc., :

Plaintiff, :

v. : Case No. 2:08-cv-101

Bound Tree Medical, LLC, : JUDGE HOLSCHUH

Defendant. :

ORDER

This matter is before the Court to consider five pending discovery motions. They include defendant's motion to quash subpoenas (#51), plaintiff's motion in limine to exclude "expert testimony" (#53), defendant's motion to compel the production of communications with attorneys for Kimberly Norton (#57), defendant's motion to compel plaintiff to produce all notes and electronic drafts related to expert witnesses (#58) and a motion for sanctions filed by interested party Pyng Medical Corporation (#81). These motions have been fully briefed. Also before the Court is plaintiff's motion to strike the motion of Patrick J. McMahon for admission pro hac vice (#85). For the following reasons, #51, #57, and #58 will be granted, #53 and #81 will be denied, and #85 will be denied as moot.

I. Background

By way of background, this case arises out of a previous lawsuit which had been filed in the Franklin County Court of Common Pleas. In that case, Bound Tree Medical, LLC (Bound Tree) sought to enforce an employment agreement and non-competition agreement with Kimberly Norton, a former Bound Tree account manager who went to work for North American Rescue Products (NARP). In the case pending here, NARP claims that Bound Tree

misappropriated information about which NARP's president Bob Castellani testified in the state court proceeding. NARP is pursuing claims for misappropriation of trade secrets, false advertising, trademark infringement, and unfair competition and trade practices. Both NARP and Bound Tree sell military medical supplies.

II. Motion to Quash (#51)

Turning first to Bound Tree's motion to quash, this motion involves deposition subpoenas issued to Bound Tree's trial counsel David Whitcomb and a previously deposed Bound Tree employee, Bruce Forester. Although Exhibit C attached to Bound Tree's motion is a subpoena to produce documents issued to Mr. Whitcomb, the Court notes that the notice of issuance of subpoenas (#47) filed by NARP on April 30, 2009, indicates that a deposition subpoena was issued to Mr. Whitcomb. According to Bound Tree, NARP has provided no legal basis for seeking to conduct trial counsel's deposition. With respect to Mr. Forester, Bound Tree asserts that NARP has not sought leave of court to conduct a second deposition of this witness as required by Fed.R.Civ.P. 30(a)(2). Moreover, Bound Tree contends, an additional deposition of Mr. Forester would be cumulative because Mr. Forester has already provided 300 pages of testimony about his background, expertise, and every product identified in the complaint.

NARP has responded to the motion to quash with no less than three filings including a memorandum in opposition, a motion in limine, and a response to Bound Tree's objections to subpoenas directed to trial counsel. In accordance with Fed.R.Civ.P.5(d) Bound Tree had not filed its objections to the subpoenas.

The gist of these multiple filings is the following. With respect to Mr. Whitcomb, NARP claims that he has become a nonparty witness in this case and is subject to the discovery

provisions of Fed.R.Civ.P. 45. The basis for NARP's position is the fact that Mr. Whitcomb was identified by Bound Tree in a supplemental discovery response as a person having knowledge of Bound Tree's assertion in its answer that Mr. Castellani's state court testimony did not involve trade secrets. With respect to Mr. Forester, NARP asserts that the motion to quash is untimely, is procedurally improper because it was filed by a party without standing, and was filed in the wrong court. NARP also contends that Mr. Forester's recent identification as an expert necessitates his additional deposition.

In reply, Bound Tree asserts that it did not identify Mr. Whitcomb as a witness or potential witness in this case. Rather, as Bound Tree explains, NARP identified Mr. Whitcomb as such in response to Bound Tree's interrogatories. Bound Tree believed that, under NARP's standard of knowledge, NARP should have identified every attorney who appeared in the state court litigation. Consequently, when asked to supplement its discovery responses regarding individuals with knowledge, Bound Tree identified all attorneys in the Norton suit. Bound Tree asserts, however, that Mr. Whitcomb's having knowledge regarding the Norton lawsuit does not entitle NARP to take his deposition.

With respect to Mr. Forester, Bound Tree argues that NARP seeks to distract the Court's attention from the undisputed fact that NARP did not seek leave of court before seeking to depose him a second time. Bound Tree does not believe that Mr. Forester's having been identified as an expert following the deposition excuses NARP's obligation to seek leave of court before deposing him again. Bound Tree asserts that NARP is aware that Mr. Forester was designated as an expert as a result of his testimony in response to NARP's detailed questions regarding every product identified in the complaint. As for the other issues raised by NARP, Bound Tree argues that Fed.R.Civ.P.

26(c)(1) allows its challenge to the subpoena to be brought in the court where the litigation is pending. Further, Bound Tree asserts that the fact that its motion, as far as it relates to Mr. Forester, is captioned as a motion to quash rather than a motion for a protective order is not determinative.

Turning to the deposition of Mr. Whitcomb, a deposition of a trial attorney, for obvious reasons, is generally discouraged and may be ordered only under limited circumstances. In the Sixth Circuit, the party seeking the deposition must establish that (1) no other means exist to obtain the information; (2) the information sought is relevant and non-privileged; and (3) the information is crucial to the preparation of the case. Nationwide Mut. Ins. Co. v. Home Ins. Co., 278 F.3d 621 (6th Cir. 2002) (citing Shelton v. Am. Motors Corp., 805 F.2d 1323, 1327 (8th Cir. 1986). NARP has not come close to meeting its burden here.

While devoting limited discussion to the first and second requirements of Nationwide, NARP has not addressed the third requirement at all. In fact, NARP's routine treatment of the issue seems to belie any understanding of the nature of a request to depose trial counsel. Absent any attempt by NARP at least to explain to the Court how information possessed by Mr. Whitcomb is crucial to the preparation of its case as contemplated by Nationwide, there is simply insufficient information to allow the Court to uphold the deposition subpoena issued to him. Consequently, the motion to quash will be granted as to the subpoena issued to Mr. Whitcomb.

With respect to Mr. Forester, generally Bound Tree would not have standing to pursue a motion to quash on his behalf. See Underwood v. Riverview of Ann Arbor, 2008 WL 5235992 (E.D. Mich. Dec. 15, 2008); Donahoo v. Ohio Dept. Of Youth Servs., 211 F.R.D. 303, 306 (N.D. Ohio 2002)("the party to whom the subpoena is

directed is the only party with standing to oppose it"). However, under the circumstances of this case, the Court will construe the motion to quash as a motion for a protective order as it relates to Mr. Forester. See generally, White Mule Co v. ATC Leasing Co. LLC, 2008 WL 2680273 (N.D. Ohio June 25, 2008).

In considering this motion, the Court agrees with Bound Tree that leave of Court was required before NARP could take Mr. Forester's deposition a second time. Rule 30(a)(2) is clear in its language and does not provide an exception for deponents who have testified as fact witnesses and are subsequently identified as expert witnesses. NARP has provided no authority persuading the Court that such an exception should be read into the language of Rule 30(a)(2). Moreover, the Court is aware of no reason to depart from the general requirement that courts are to give the federal rules their plain meaning. See, e.g., Pavelic & LeFlore v. Marvel Entertainment Group, 493 U.S. 120 (1989). Consequently, the motion to quash, construed as a motion for a protective order as it relates to Mr. Forester's subpoena, will be granted. NARP will be required to seek leave of Court before proceeding with any additional deposition of Mr. Forester.

The Court notes that Bound Tree has requested, pursuant to Rule 37(a)(5)(A), an award of its reasonable expenses in connection with this motion. Under the circumstances of this case, the Court cannot find that Bound Tree is entitled to such an award. Consequently, Bound Tree's request will be denied.

III. Motion in Limine (#53)

Turning to the motion in limine, NARP has moved to exclude the testimony of Mr. Forester as well as that of Royce Rumsey and John Janota based on Bound Tree's alleged failure to provide expert reports from these witnesses as required by the case scheduling order and Rule 26(a)(2). In response, Bound Tree asserts that it was not required to provide expert reports for

these witnesses for several reasons. First, according to Bound Tree, it has not provided these experts with any specific information for use in developing an expert opinion for trial or for use in rebutting NARP's experts. Further, Bound Tree claims that it has identified these individuals as potential expert witnesses because their personal experience and knowledge are relevant to NARP's claims, and also asserts that none of them was specially retained for purposes of testifying as an expert witness at trial.

With respect to each expert individually, Bound Tree asserts the following. Bound Tree claims that it is not within Mr. Forester's job duties to testify as an expert witness and that he has never testified for Bound Tree in any other lawsuit. With respect to Mr. Rumsey, Bound Tree asserts that he is a neutral witness employed by Pyng Medical, a distributor of two of the products at issue here. According to Bound Tree, it is not paying Mr. Rumsey to testify nor has it provided him with any information or asked him to develop any expert opinions. Bound Tree also contends that Mr. Janota is a neutral witness who has not been retained or provided any information to use in developing an expert opinion for trial.

Mr. Janota is the focus of NARP's reply brief. According to NARP, based on Mr. Janota's deposition testimony, it is clear that he has been retained because Bound Tree has provided him with information in anticipation of litigation. In the event the Court finds that Mr. Janota has not been retained as an expert, NARP requests that Mr. Janota's testimony be limited to the opinions given during his deposition because: (1) Mr. Janota has no personal knowledge of the issues; (2) he is not qualified to testify as an unretained expert; and (3) his expected testimony was not disclosed. With respect to Mr. Forester and Mr. Rumsey, NARP contends that Bound Tree has not provided previously

requested information that is necessary to determine whether these potential witnesses have been retained or specially employed. NARP argues that it has the right to depose these witnesses after it receives a complete response to its discovery requests. Finally, NARP asserts that Bound Tree should be prohibited from communicating with any of these experts outside of NARP's presence.

Because the focus of NARP's motion appears to be Mr. Janota, the Court will address the issues presented by his status as an expert first. Although NARP has captioned its motion as one seeking the exclusion of Mr. Janota's testimony, NARP appears simply to want Mr. Janota to be required to prepare an expert report. Rule 26(a)(2)(B) requires the submission of a written and signed report by any "witness who is retained or specially employed to provide expert testimony in a case or whose duties as an employee of the party regularly involve giving expert testimony." The application of the Rule 26 disclosure requirements depends on the substance of the testimony rather than a witness's status as an expert. Bekaert Corporation v. City of Dyersburg, 256 F.R.D. 573 (W.D. Tenn. 2009)(citing Hawkins v. Graceland, 210 F.R.D. 210 (W.D. Tenn. 2002). Consequently, whether an expert report is required depends on whether the expert's opinion will be limited to testimony based on personal knowledge of the factual situation or whether the testimony will be based on information utilized to develop specific opinion testimony - that is, information obtained in anticipation of litigation. Id.

Here, NARP contends that Mr. Janota was retained because his deposition testimony demonstrates that his knowledge was acquired in anticipation of litigation. See Bekaert, 256 F.R.D. at 576. The Court agrees. While it may be that Mr. Janota, as an occasional client or customer of Bound Tree, has general personal

knowledge about Bound Tree and its products, his deposition testimony indicates that he does not have in-depth familiarity with respect to all of the products at issue in this action. This is enough in the Court's mind to distinguish the circumstances of this case from those in Linux One, Inc. v.Inktomi Corp., 2004 WL 5518163 (N.D. Cal. Aug. 26, 2004) relied upon by Bound Tree. In that case, a former company engineer was not required to provide an expert report because he had personal knowledge and experience with the particular product at issue in the lawsuit. Here, Mr. Janota has not worked for Bound Tree and has not been involved with the development or advertising of its products. Moreover, Mr. Janota testified that, despite having purchased products from Bound Tree, he had not used or was not familiar with all of Bound Tree's products. See Plaintiff's Reply in Support of Motion in Limine, Exhibit C. In fact, Mr. Janota required a copy of Bound Tree's catalog to review its products and this catalog was provided to him by counsel after this lawsuit began. Mr. Janota also testified that he did not have any personal knowledge of the issues presented in this case. Id. Given this testimony, the Court concludes that Mr. Janota is not relying solely on his own personal knowledge as a basis for testimony and has been provided information in anticipation of litigation. As a result, as explained by the Court in Baekert, if Bound Tree intends to call Mr. Janota to elicit opinion testimony from him, Mr. Janota has been retained for purposes of providing expert testimony in this matter. Consequently, Bound Tree will be required to provide an expert report from Mr. Janota. The Court will decline to grant the motion in limine with respect to Mr. Janota at this time. If, however, such a report is not prepared, NARP will have the opportunity to revisit the issue regarding the exclusion of his testimony.

Turning to Mr. Forester, NARP claims Bound Tree has not

provided sufficient information from which NARP can determine whether he has been retained or specially employed to give expert testimony. Alternatively, within its reply in support of its motion in limine seeking to exclude his testimony, NARP argues that it must be given an opportunity to depose Mr. Forester regarding his testimony. NARP's arguments as they relate to Mr. Forester are not persuasive. First, NARP has focused on the wrong provision of Rule 26(a)(2)(B). The provision of Rule 26(a)(2)(B) applicable to Mr. Forester as an employee of Bound Tree makes clear that a written report is only required of an employee of a party whose duties "regularly involve giving expert testimony." NARP has deposed Mr. Forester once already and elicited approximately 300 pages of testimony. NARP has provided no evidence based on this testimony to dispute Bound Tree's position that Mr. Forester is a Bound Tree employee who does not regularly testify as an expert on its behalf. Consequently, there is absolutely no support for NARP's position that Mr. Forester must provide an expert report or his testimony should be excluded.

As for NARP's claim in its reply brief that it is entitled to take Mr. Forester's deposition again, this is an argument more properly addressed in a motion for leave pursuant to Rule 30 as discussed above. The Court declines to construe this argument, buried in a reply brief, as a motion for leave and, therefore, will not consider at this time the issue of an additional deposition of Mr. Forester.

Briefly, with respect to Mr. Rumsey, NARP asserts that, because Bound Tree has failed to respond to discovery requests, NARP cannot determine whether he has been retained. Given that NARP has asserted this argument in the context of its motion in limine, the Court is not sure what relief NARP is seeking as it relates to Mr. Rumsey. While NARP is seeking to have expert

testimony excluded if retained experts have not provided a written report, NARP is contending that, given the current state of discovery as it relates to Mr. Rumsey, it cannot determine whether he is a retained expert. To the extent that NARP contends that Bound Tree has not responded to discovery requests, such an issue is more appropriately the focus of a motion to compel (assuming counsel cannot work out the issue among themselves). The Court therefore declines to consider this issue in connection with the motion in limine. Consequently, the motion in limine is denied with respect to Mr. Rumsey based on the current state of the record. NARP is free to raise the issue of the need for an expert report again if through discovery it is revealed that Mr. Rumsey is a retained expert and has not provided a written report.

Finally, NARP has offered no authority for its request that Bound Tree be prohibited from communicating with these witnesses outside of NARP's presence. Absent any meaningful discussion by NARP of this issue, the Court does not believe that NARP seriously intends to pursue this request. Consequently, the request will be denied.

IV. Motion to Compel Attorney Communications (#58)

In its motion to compel the production of communications with attorneys for Ms. Norton, Bound Tree seeks the following: (1) all communications between NARP and the attorneys for Kimberly Norton in her lawsuit against Bound Tree in the state court litigation; (2) Bob Castellani's response to deposition questions regarding conversations he had with Ms. Norton's attorneys; and (3) Ms. Norton's attorneys' compliance with subpoenas requesting production of their communications with NARP. With respect to the third category, Bound Tree directed subpoenas to attorneys Robert Noble and Kim Herlihy and has served them with a copy of its motion to compel. Neither Mr.

Noble nor Ms. Herlihy have responded to Bound Tree's motion.

In support of its motion, Bound Tree contends that the state court record demonstrates that Ms. Norton's attorneys and NARP had no attorney-client relationship. Further, Bound Tree claims that Mr. Castellani, NARP's president, testified in his deposition that he did not know whether Ms. Norton's attorneys also represented NARP. Bound Tree also argues that, to the extent any privilege applies, NARP has waived its right to assert that privilege based on its voluntary production of strategic emails between its attorneys and Ms. Norton's attorneys. Finally, Bound Tree claims that, because Mr. Noble has not challenged its subpoena, Mr. Noble must produce his communications with NARP.

In response, NARP claims that its communications with Ms. Herlihy are privileged because of a direct attorney-client relationship. Further, NARP contends that its communications with Mr. Noble are privileged under the joint defense or common interest privilege. Additionally, NARP argues that it has not waived the attorney client privilege because the emails at issue constitute only attorney work product and are protected under the work product doctrine rather than the attorney client privilege. To the extent the emails contained attorney client communications, NARP contends that they were disclosed inadvertently and such an inadvertent disclosure cannot act as a waiver. Finally, NARP asserts that Bound Tree has not demonstrated that the requested documents are relevant.

In its reply brief Bound Tree claims that NARP's failure to raise the joint defense or common interest doctrine as an objection to Bound Tree's discovery request has resulted in a waiver. Additionally, Bound Tree argues that, even if properly raised, these doctrines are inapplicable here. Finally, Bound Tree asserts that any disclosure was not inadvertent and the

information sought is relevant.

The Court will address the issues as they relate to each attorney individually but will address briefly the issue of relevance at the outset. With respect to this issue, Bound Tree argues that NARP's communications with Mr. Noble are relevant given the allegations in this case that, utilizing Mr. Castellani's testimony in the Norton litigation, Bound Tree misappropriated trade secrets. Bound Tree believes it is entitled to know what information NARP and Mr. Castellani shared with Mr. Noble in preparing for Mr. Castellani's testimony. According to Bound Tree, these discussions are probative of whether any of Mr. Castellani's testimony could be considered a protected trade secret. The Court agrees that any information relating to whether certain topics of Mr. Castellani's testimony could be considered a protected trade secret would go to the heart of Bound Tree's defense in this action. Consequently, the motion to compel as it relates to communications between NARP and Ms. Norton's attorneys will not be denied on grounds that the communications are not relevant.

Turning to the remaining issues relating to Mr. Noble, in its response NARP does not seriously contend that it had an attorney-client relationship with Mr. Noble. Consequently, the Court finds that NARP does not intend to pursue this position. Instead, NARP claims that its communications with Mr. Noble are privileged under the joint defense or common interest privilege. Bound Tree contends that this objection has been waived because NARP failed to raise it in its initial response to Bound Tree's discovery requests.

The Court agrees with Bound Tree that, "[a]s a general rule, when a party fails to object timely to interrogatories, production requests, or other discovery efforts, objections thereto are waived." Greene v. Cracker Barrel Old Country Store,

Inc., 2009 WL 1885641 (W.D. Tenn. July 1, 2009)(quoting Blackmond v. UT Medical Group, Inc., 2003 WL 22385678 (W.D. Tenn. Sept. 17, 2003)); see also Drutis v. Rand McNally & Co., 236 F.R.D. 325 (E.D. Ky. 2006). A party's waiver of objections to discovery requests may be excused upon a showing of good cause. Id. NARP has not attempted a showing of good cause here and this fact alone is enough to prevent NARP from relying on the privilege. Even if it had demonstrated good cause, however, the Court could not conclude that the joint defense or common interest privilege is applicable here.

The joint defense or common interest privilege is not an independent basis for privilege but an exception to the general rule that the attorney-client privilege is waived when privileged information is disclosed to a third party. Broessel v. Triad Guaranty Insurance Corporation, 238 F.R.D. 215 (W.D. Ky. 2006). There are generally three situations where this exception is deemed to apply. Id. The first situation, where a single attorney represents multiple clients in the same matter, is not applicable here because NARP concedes that Mr. Noble did not represent NARP. The second situation involves parties represented by different counsel sharing information to coordinate a common legal defense. This situation is also inapplicable here because NARP has not provided any evidence of an agreement with Mr. Noble to coordinate a common legal defense.

The final situation arises when two or more clients share a common legal or commercial interest and share legal advice with respect to that common interest. See Broessel. In this situation, the parties must have a common legal, as opposed to commercial, interest. Id. Here, NARP has not provided any evidence that persuades this Court that NARP and Ms. Norton shared a common legal interest. At best, NARP may have suggested that NARP had an interest in Ms. Norton's continued employment

with NARP, but this suggestion, without more, is insufficient to meet its burden here. Consequently, the Court finds that any communications between Mr. Noble and NARP are not subject to protection under the joint defense and common interest privilege.

In summary, as NARP has conceded, any communications between NARP and Mr. Noble are not protected by the attorney-client privilege. Further, to the extent the joint defense or common interest was not waived, these communications are not protected under the doctrine. Finally, Bound Tree has demonstrated that the information it seeks is relevant to its defense in this case. Accordingly, the motion to compel will be granted and NARP will be required to respond to Bound Tree's discovery requests relating to any communications between NARP and Mr. Noble. For these same reasons, as well as the fact that Mr. Noble did not timely object or move to quash the subpoena, Mr. Noble must respond to Bound Tree's discovery requests regarding his communications with NARP.

With respect to Ms. Herlihy, NARP asserts that Ms. Herlihy had a direct attorney-client relationship with NARP. Bound Tree claims that whether Ms. Herlihy represented both Ms. Norton and NARP is not clear. Assuming, for purposes of this motion, that a direct attorney-client relationship existed, Bound Tree argues that any privilege was waived through NARP's voluntary production of emails with Ms. Norton's attorneys.

NARP responds with two arguments. First, it asserts that the documents at issue are not protected by the attorney client privilege and any waiver was of work product protection which would not necessarily waive the attorney-client privilege. Second, it claims that any disclosure was inadvertent and therefore cannot constitute a waiver of the attorney-client privilege. For the following reasons, the Court finds that NARP has waived the attorney-client privilege.

First, contrary to NARP's position, there is no question that several of the documents produced by NARP would be subject to protection under the attorney-client privilege. Lawyer and client communications are privileged when they relate to legal advice or strategy. Several of the documents at issue here, as outlined by Bound Tree, contain strategic communications of the nature the privilege is designed to protect.

Further, there is no question that the voluntary disclosure of information protected by the privilege waives the privilege. In re Grand Jury Proceedings October 12, 1995, 78 F.3d 251 (6th Cir. 1996); United States v. Dakota, 197 F.3d 821 (6th Cir. 1999). Here, despite NARP's assertion that any disclosure was inadvertent, its disclosure was voluntary and therefore constitutes a waiver. The disclosure was clearly voluntary. There is no question that NARP knew it was producing these particular documents to Bound Tree, and NARP does not challenge this fact. Rather, NARP claims that it was waiving only the work product privilege through the disclosure. However, "[p]oorly judged disclosure is not the same as inadvertent disclosure." Williams v. Sprint/United Management Co., 2007 WL 38397 (D. Kan. January 5, 2007)(quoting Transonic Systems, Inc v. Non-Invasive Medical Technologies Corp., 192 F.R.D. 710, 712 (D. Utah 2000).

The circumstances of the disclosure demonstrate that it was not unintentional, accidental or unknowing. Rather, the documents were purposefully produced because, as NARP explained, they were reviewed. There is a distinction between an inadvertent disclosure and a disclosure that is intended but the person making the disclosure was mistaken or unaware of the consequences of producing the document. See Maday v. Public Libraries of Saginaw, 480 F.3d 815, 821 (6th Cir. 2007)("A party waives the attorney-client privilege notwithstanding an error of judgment where the person knows that privileged information is

being released but concludes that the privilege will nevertheless survive").

Moreover, even assuming that NARP's disclosure would be properly characterized as inadvertent, NARP would not prevail. Fed. R. Evid. 502 governs the effect of inadvertent disclosures of attorney-client privileged information. American Coal Sales Co. v. Nova Scotia Power, Inc., Case No. 2:09-cv-94 (S.D. Ohio February 23, 2009). Under Rule 502, an inadvertent disclosure does not operate as a waiver if the holder of the privilege took reasonable steps to prevent disclosure or took reasonable steps to rectify the error. NARP cannot be found to have taken any reasonable steps either to prevent disclosure or to rectify the error. As the record in this case indicates, the documents were produced in November 2008 and NARP did not raise the issue of inadvertent disclosure until after Bound Tree filed its motion to compel the remaining documents.

Briefly, with respect to the issue of work product privilege, NARP, by its own admission, has waived it. Further, this waiver covers all documents relating to the same subject matter, i.e. Ms. Norton's state court litigation. While disclosure to a third party does not automatically result in subject matter waiver of the work product privilege, the Court finds that NARP's conduct with respect the privilege has been inconsistent with its assertion of the privilege. See The Navajo Nation v. Peabody Holding Co., Inc., 255 F.R.D. 37 (D.D.C. 2009). Further, "subject matter waiver of work product will occur even if the party did not intend to waive the privilege through disclosure." Id. at 49 (citing Daniels v. Hadley Mem.'l Hosp., 68 F.R.D. 583, 587 (D.D.C. 1975)).

In light of the foregoing, NARP will be required to respond to Bound Tree's discovery requests relating to all communications between NARP and Ms. Herlihy. Further, Ms. Herlihy will be

required to comply with the subpoena relating to her communications with NARP. Finally, to the extent that Mr. Castellani has withheld any responses to deposition questions on grounds of privilege, he will be required to provide any testimony previously withheld on such grounds.

V. Motion to Compel Notes Relating to Expert Witnesses (#58)

Bound Tree has also filed a motion to compel relating to the expert reports of Dr. Jeffrey Cain and Dr. William Bearden. According to Bound Tree, Dr. Cain admitted in his deposition that he personally did not prepare his report. With respect to Dr. Bearden, Bound Tree claims, based on his deposition testimony that, although it appears that Dr. Bearden prepared his own report, he destroyed his notes of any discussions with NARP's counsel and he has no recollection of these discussions. Bound Tree asserts that, without additional information, it has no way of knowing how either expert report was developed. Consequently, through its motion to compel, Bound Tree seeks three distinct sets of information: all hard copy and electronic drafts of the expert reports and declarations in the possession of NARP's lawyers and the experts, including metadata; exchanges between NARP's lawyers regarding the preparation of these reports and the declarations; and any email attachments, including the PowerPoint presentation sent to the individuals who signed declarations.

In its response, NARP does not dispute that it has a duty to produce many of the requested documents and claims that it has been in the process of locating them and will provide them to the extent they exist. Consequently, the Court concludes that NARP is not challenging the motion to compel with respect to the majority of the documents sought. NARP will be required to produce immediately those documents to which it has not objected, if it has not already done so.

Accordingly, for purposes of the Court's consideration of the motion to compel, NARP's objections to production seem to be limited to two very narrow categories of information: (1) the revisions and other comments about Dr. Cain's report that were exchanged among NARP's lawyers and (2) any notes created by NARP's attorneys regarding meeting or conversations with Dr. Bearden concerning the preparation of his report. With respect to revisions and other comments about Dr. Cain's report that were exchanged among NARP's lawyers, NARP argues that Rule 26 requires disclosure of only communications between an attorney and a testifying expert. Further, NARP contends that any such documents would be entitled to protection as attorney work product. With respect to Dr. Bearden, NARP argues that Bound Tree is not entitled to any notes created by NARP's attorneys regarding meetings or conversations with Dr. Bearden concerning the preparation of his report. According to NARP, it is under no obligation to provide any such information simply because Dr. Bearden admittedly destroyed his own notes of the discussions.

The focus of Bound Tree's reply is that it is entitled to know what role NARP's attorneys played in drafting these expert reports because an expert who simply has adopted an attorney's opinion has less credibility before a jury. Bound Tree also asserts that it has a substantial need for the information it seeks. The issues presented with respect to these experts are somewhat distinct and the Court will address each one in turn.

Turning first to Dr. Cain's report, Bound Tree argues that because his report was drafted by NARP's counsel, Bound Tree is entitled to revisions and other comments exchanged between those counsel which apparently were never directly communicated to Dr. Cain but presumably may have been incorporated into the final version he signed. NARP's response to this argument is that its attorneys did not "draft" but merely "transcribed" the report and

that any attorney notes are protected work product. Bound Tree asserts that if, as NARP contends, its attorneys were merely acting as transcriptionists for Dr. Cain, the work product doctrine does not even apply in the first instance. For the sake of clarity, the Court notes that NARP's objection to production does not seem to extend to the notes taken by Mr. Perkins - the attorney primarily responsible for "drafting" or "transcribing" the report - but rather to any notes taken by any other NARP counsel.

The primary basis for Bound Tree's position is the reasoning set forth by the court in Reliance Ins. Co v. Keybank, U.S.A., 2006 WL 543129 (N.D. Ohio March 3, 2006) which, Bound Tree contends, presented the same scenario as is presented here. In Reliance, the Court granted a motion to compel seeking attorney notes where it found that (1) testimony indicating that counsel acted as nothing more than a conduit for the preparation of the report precludes application of the work product doctrine and (2) assuming the work product doctrine applied, the notes were fact work product to which the moving party was entitled in order to effectively cross-examine the expert.

As explained by the Reliance court, where the attorney was acting merely as a conduit, the recording of the expert's opinions by the attorneys constituted an initial draft of the report. On the other hand, if the work product doctrine applied, because testimony indicated that counsel may have assisted the expert well beyond what is contemplated under Rule 26, the moving party had established a substantial need for the notes.

The Court believes that similar concerns exist here and finds the reasoning of the Reliance court persuasive. Here, regardless of whether NARP's counsel was a mere "conduit" there is no question based on Dr. Cain's testimony, the relevant portions of which have been filed under seal, that counsel's

notes constituted the initial draft of the report. Further, there is even less of a question in the Court's mind here over the extent of counsel's assistance in its preparation based on this same testimony. Consequently, for the reasons expressed in Reliance, the Court will grant the motion to compel as it relates to notes of NARP's counsel other than Mr. Perkins. As noted above, the Court's ruling assumes that this is the essence of the objection raised by NARP and that, based on the representations in its filings, NARP will voluntarily produce Mr. Perkins' notes.

With respect to Dr. Bearden, the issue appears to revolve solely around the work product doctrine. Bound Tree does not appear to contest that the information it seeks with respect to Dr. Bearden is attorney work product. Rather, its argument is simply that it has demonstrated a substantial need for the information. NARP has not directly addressed the issue of substantial need but has devoted a lengthy discussion to an argument that Dr. Bearden's destruction of his notes was not improper.

Rule 26 requires a testifying expert to disclose "the data or other information considered by the witness in forming [the opinions]." Fed.R.Civ.P. 26 (a)(2)(B)(ii). As the 1993 Advisory Committee Notes make clear, materials furnished to experts whether or not relied upon by the expert are to be disclosed. Moreover, the Sixth Circuit has established a "bright-line" rule requiring the disclosure of all documents and information, including attorney opinion work product, provided to testifying experts. Regional Airport Authority of Louisville v. LFG, LLC, 460 F.3d 697 (6th Cir. 2006). Further, there is no question that "fact" work product may be obtained pursuant to Rule 26(b)(3) upon a showing of substantial need and the inability to otherwise obtain the information without material hardship. Reliance, at *1.

Certainly, if Dr. Bearden's notes regarding information discussed with counsel in the process of drafting his report were still in existence, Bound Tree would be entitled to those notes in order to understand the role of NARP's attorneys in the drafting of his report. The reasons justifying the disclosure of Dr. Bearden's notes, including the ability to effectively cross-examine a witness, do not become less compelling simply because Dr. Bearden destroyed them. Further, based on his deposition testimony, Dr. Bearden has demonstrated that he does not remember specific details of his discussions with NARP's attorneys. In light of these circumstances, the Court finds that Bound Tree has demonstrated a substantial need for the notes at issue. For the same time reasons, Bound Tree has clearly established that it is unable to otherwise obtain the information. Consequently, the motion to compel will be granted as to this category of documents.

VI. Motion for Sanctions of Pyng Medical Corporation (#81)

Pyng Medical Corporation, the manufacturer of two of the products at issue here and a non-party to this case, filed a motion for sanctions and award of fees and costs. Through this motion, Pyng seeks reimbursement for $24,930.08 in charges related to the conversion of Pyng's native files to a reviewable format in response to a subpoena to produce documents issued by NARP. Pyng further seeks $52,782.50 in attorneys' fees incurred through June 22, 2009, in connection with the subpoena response. Additionally, Pyng is requesting any additional fees it may incur in connection with the subpoena including those for reviewing the 5,218 documents still to be examined and those costs associated with the filing of this motion.

In support of its motion, Pyng has submitted affidavits from two of its attorneys, Lauren E. Dodge and Patrick J. McMahon with attached exhibits. According to Mr. McMahon's affidavit, NARP's

subpoena requested fourteen categories of documents with no limitation as to time or scope. Pyng's counsel and its corporate officials determined that a majority of Pyng's documents were likely responsive to the subpoena. McMahon ¶4. Pyng's documents are stored electronically and had to be converted to a reviewable format. Id. at ¶5. This conversion required the services of an outside electronic discovery provider. Id. Pyng sought two bids from outside providers and the lower bid was $20,000. Id. at ¶5 and ¶9. By letter dated May 12, 2009, Pyng informed NARP that the discovery burden was significant and objected to bearing the cost. McMahon Affidavit at ¶13, Exhibit C-1 . According to Mr. McMahon, counsel for NARP failed to respond to this letter and various other communications regarding Pyng's objection to bearing the cost of discovery and its objection to producing any privileged documents. On June 12, 2009, Pyng advised NARP that the fees and costs incurred exceeded $50,000.

In its motion, Pyng asserts that NARP violated its duty to avoid imposing an undue burden or expense on a non-party under Fed.R.Civ.P. 45(c)(1). While disputing the reasonableness of the subpoena, Pyng claims that its compliance with the subpoena was proper because it did not dispute the relevancy of the documents requested.

In response, NARP argues that, by Pyng's own admission, the subpoena sought relevant information and was therefore reasonable. Consequently, NARP claims, the issuance of the subpoena cannot subject NARP to sanctions under Fed.R.Civ.P. 45(c)(1). NARP also asserts that it cannot be found responsible under Fed.R.Civ.P. 45(c)(2)(B) for the reimbursement Pyng is demanding. According to NARP, Pyng did not follow the proper procedure for objecting to a subpoena because Pyng did not specifically note an objection in a timely manner. Additionally, NARP argues that Pyng did not move to quash the subpoena.

Further, NARP argues that there was no voluntary agreement between the parties addressing the issues of costs or attorneys' fees. Finally, NARP claims that Pyng's motion was improperly filed and should be stricken because Pyng's counsel were not admitted to practice in this Court at the time the motion was filed. In support of its response, NARP has submitted the declaration of its counsel, Garth Cox, and various other exhibits.

In reply, Pyng asserts that sanctions under Rule 45(c)(1) are appropriate because NARP should have known its subpoena was so broad as to be burdensome. With respect to the issue of reimbursement under Fed.R.Civ.P. 45(c)(2)(B), Pyng contends that it put NARP on notice of its objections in its letter of May 12, 2009. Pyng claims that case law establishes that objections made beyond the fourteen-day period set forth in Rule 45 will be considered in unusual circumstances. Pyng has submitted an additional affidavit from Mr. McMahon in support of its reply.

Fed.R.Civ.P. 45(c)(1) provides that a party issuing a subpoena has a duty to "take reasonable steps to avoid imposing undue burden or expense on a person subject to the subpoena," and that "the issuing court must enforce this duty and impose an appropriate sanction - which may include lost earnings and reasonable attorney's fees - on a party or attorney who fails to comply." Whether an undue burden has been imposed is a factual inquiry made on a case by case basis and courts have generally required blatant abuse of the subpoena power before awarding sanctions. See, e.g., Alberts v. HCA, Inc., 405 B.R. 498 (D.D.C. 2009). A disputed subpoena on its own, even if ultimately found unwarranted, typically does not support an imposition of sanctions. Id. Rather an element of bad faith is usually required. Id.

Here, Pyng does not point to any behavior by NARP rising to

a sanctionable level. In fact, Pyng readily admits that the subpoena sought relevant documents. Further, Pyng does not claim that it was required to produce any documents in a highly compressed timeframe. Rather, Pyng acknowledges that NARP granted its requests for extensions of time. Pyng has provided absolutely no evidence that NARP abused the subpoena process or demonstrated any bad faith. Consequently, the motion for sanctions will be denied.

While Pyng styled its motion as one for sanctions under Rule 45(c)(1), NARP raised the issue of Fed.R.Civ.P.45(c)(2)(B) in its response and Pyng addressed this issue in its reply. Rule 45(c)(2)(B) sets forth a procedure by which a non-party is protected from costly compliance with a subpoena. As is relevant here, that provision allows a non-party to serve a written objection within 14 days after service of the subpoena. The objection forces the subpoenaing party to seek an order compelling document production. If the court compels production, it must protect a non-party from significant production expenses.

Pyng claims that it objected to the subpoena in a letter dated May 12, 2009. NARP disputes that this letter constitutes an objection. Much of the parties' briefing and affidavits of counsel address the series of events that occurred in response to the subpoena. In the Court's view, however, whether the May 12th communication constituted an objection is not the determinative factor because Pyng then voluntarily complied with the subpoena without conditioning its compliance on reimbursement. Because Pyng did not wait for a court order prior to beginning the production process, it does not have the right to seek reimbursement under Rule 45 for the costs it is seeking to recover through its current motion. See Angell v. Kelly, 234 F.R.D. 135 (M.D.N.C. 2006).

A non-party's failure to follow Rule 45, however, does not

mean that reimbursement is foreclosed under all circumstances. Courts have recognized that, where a non-party voluntarily complies with a subpoena without strictly adhering to Rule 45, it is reasonable to consider whether the non-party and party have reached some voluntary agreement regarding reimbursement. Angell, 234 F.R.D. at 139 (citing Angell v. Shawmut Bank Connecticut Nat. Ass'n, 153 F.R.D. 585 (M.D.N.C. 1994)). Here, however, Pyng has presented no evidence indicating that an agreement existed with NARP addressed to the issue of reimbursement. Consequently, even were the Court to consider Pyng's motion for sanctions as one seeking reimbursement under Rule 45 (c)(2)(B), Pyng would not prevail.

VII. The Motion to Strike #85

NARP filed a motion to strike the motion for leave to appear pro hac vice filed by Patrick J. McMahon on grounds that it failed to comply with this Court's local rules. By order dated July 21, 2009, the Court granted the motion for leave to appear pro hac vice. Consequently, the motion to strike is moot and will be denied.

IX. Disposition

Based on the foregoing, the following motions are granted as set forth above: #51, #57, and #58. The following motions are denied: #53 and #81. Further, #85 is denied as moot. Bound Tree shall provide an expert report from John Janota within 30 days. With respect to all discovery responses addressed in this order, NARP shall provide these responses within 15 days. With respect to any responses which have not yet been provided by NARP but are not the subject of this order because NARP has raised no objection to them, NARP shall immediately respond to the extent it has not already done so. Attorneys Robert Noble and Kim Herlihy shall comply with the subpoenas directed to them within 15 days. Robert Castellani shall provide any deposition

testimony previously withheld on grounds of privilege at a deposition to be held at a time and place mutually agreed upon by the parties.

Any party may, within ten (10) days after this Order is filed, file and serve on the opposing party a motion for reconsideration by a District Judge. 28 U.S.C. §636(b)(1)(A), Rule 72(a), Fed. R. Civ. P.; Eastern Division Order No. 91-3, pt. I., F., 5. The motion must specifically designate the order or part in question and the basis for any objection. Responses to objections are due ten days after objections are filed and replies by the objecting party are due seven days thereafter. The District Judge, upon consideration of the motion, shall set aside any part of this Order found to be clearly erroneous or contrary to law.

This order is in full force and effect, notwithstanding the filing of any objections, unless stayed by the Magistrate Judge or District Judge. S.D. Ohio L.R. 72.4.

/s/ Terence P. Kemp
United States Magistrate Judge