

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF PENNSYLVANIA

THE SHERWIN-WILLIAMS COMPANY,) CIVIL ACTION NO. 17-1023
)
Plaintiff/Counterclaim-defendant,)
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)
)
v.)
)
PPG INDUSTRIES, INC.,)
)
Defendant/Counterclaimant.)

MEMORANDUM OPINION

Pending in this patent infringement case are the motion to adopt and modify in part Report and Recommendation (“R&R”) of the special master (ECF No. 310), with brief in support, filed by defendant PPG Industries, Inc. (“PPG”); the response to the special master’s R&R filed by plaintiff The Sherwin-Williams Company (“Sherwin”) (ECF No. 312); Sherwin’s response in opposition to PPG’s motion to modify the R&R (ECF No. 313); and PPG’s reply (ECF No. 314).¹

Factual and Procedural Background

On July 20, 2018, PPG filed a motion to streamline the number of asserted claims (ECF No. 272), with brief in support. On August 3, 2018, Sherwin filed a response in opposition to the motion. (ECF No. 277). On August 28, 2018, the court held a hearing on the motion, at which

¹ Also pending is Sherwin’s expedited motion to exclude obviousness combinations set forth in PPG’s opening expert report (ECF No. 315), which will not be addressed in this opinion. That motion will be referred to the special master for report and recommendation.

the parties confirmed their stipulation to limit the number of claims to 25. (Tr. 2, ECF No. 297). The court denied the motion without prejudice and instructed the parties to meet and confer in an effort to resolve the issue. *Id.*

On October 1, 2018, the parties filed a joint motion, representing they had been unable to reach agreement and requesting appointment of a special master. (ECF No. 300). On October 15, 2018, the court appointed a special master and specifically referred the dispute to the special master for report and recommendation. (ECF No. 304).

The special master filed an R&R on November 14, 2018. (ECF No. 308). The special master recommended that the court limit the number of claims being asserted to 16 for expert witness review, reporting and discovery; and that within two weeks of the completion of expert discovery, the number of asserted claims be reduced to 12 for purposes of summary judgment proceedings.

PPG asks the court to adopt the R&R in all respects, except one. PPG proposes that the reduction to 12 claims be made earlier, within two weeks of completion of rebuttal expert disclosures. (ECF No. 311 at 2-3). Sherwin, despite its disagreement, asks the court to adopt the R&R without modification. (ECF No. 312 at 2). Sherwin opposes PPG's effort to modify the schedule, and offers an alternative timeline. Both parties note, for clarification, that there are 25 claims presently being asserted, rather than 60 as stated in the R&R.

Legal Analysis

When a party files objections to a report and recommendation of a special master, the district court must make a de novo determination of the findings of fact and conclusions of law in the report to which objections are made. Fed. R. Civ. P. 53(f)(3) and (4). The court may

accept, reject or modify in whole or in part the special master's findings or recommendations. Fed. R. Civ. P 53(f)(1). *See Cole's Wexford Hotel, Inc. v. UPMC & Highmark, Inc.*, No. CV 10-1609, 2016 WL 462856, at *1 (W.D. Pa. Feb. 8, 2016).

There is no dispute that the claims shall be reduced to 16 for expert witness review, reporting and discovery. The sole dispute to the R&R is the timing of the reduction to 12 claims. Under the amended scheduling order (ECF No. 307), rebuttal expert witness disclosures must be made by March 1, 2019, expert depositions must be completed by March 29, 2019, and motions for summary judgment must be filed by April 10, 2019.

PPG argues that if the reduction to 12 claims occurs two weeks after completion of expert depositions (which would be April 12, 2019), the parties will have already filed their summary judgment briefs based on 16 claims. In other words, PPG contends that the anticipated reduction to 12 claims for summary judgment proceedings would be moot. PPG proposes that the reduction to 12 claims be advanced to March 15, 2019.

Sherwin objects to PPG's proposal. Sherwin argues that if the deadline is moved prior to the completion of expert discovery, it will be unable to fully explore and test PPG's experts' non-infringement and invalidity contentions before making its decision on which 12 claims to advance. Sherwin proposes that it announce its reduction to 12 claims two days after the completion of expert discovery (on March 31, 2019), which would still allow the parties ten days to file their summary judgment briefs. (ECF No. 313 at 2).

The special master did not explain the reasons underlying his suggested timeline. PPG is correct that, under the recommended schedule, summary judgment motions would be filed before the reduction to 12 claims is made, which would moot the intended efficiency benefits of that reduction. Rather than delay the summary judgment deadline, the court agrees with

Sherwin's proposal to modify the disclosure deadline. Sherwin acknowledged it is able to identify its 12 claims within two days of the completion of expert discovery. The court believes that ten days after the reduction to 12 claims will provide the parties sufficient time to finalize their summary judgment filings.

Conclusion

The special master's R&R will be adopted as the opinion of the court with two modifications: (1) a clarification that 25 claims were previously being asserted; and (2) within two days of the completion of expert discovery (on or before March 31, 2019), the number of asserted claims shall be reduced to 12 for purposes of summary judgment.

An appropriate order follows.

December 20, 2018

By the Court,

/s/ Joy Flowers Conti
Joy Flowers Conti
Senior United States District Judge

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ORDER

AND NOW, this 20th day of December, 2018, in accordance with the memorandum opinion, it is hereby ordered that the special master’s Report and Recommendation (ECF No. 308) is adopted as the opinion of the court, as modified. The motion to adopt and modify in part Report and Recommendation of the special master (ECF No. 310) is granted in part and denied in part. The number of asserted claims shall be reduced forthwith to 16 for expert witness review, reporting and discovery. Within two days of the completion of expert discovery (on or before March 31, 2019), the number of asserted claims shall be reduced to 12 for purposes of summary judgment.

By the Court,

/s/ Joy Flowers Conti
Joy Flowers Conti
Senior United States District Judge