

commonly involves business records, including corporate books and records,<sup>83</sup> photographs,<sup>84</sup> drawings,<sup>85</sup> bank records,<sup>86</sup> scientific research data<sup>87</sup> and lab notebooks.<sup>88</sup> Any of these items can be relevant and, thus, producible in an infringement action if they are already in existence.<sup>89</sup>

## 2. Premise Inspections

The same relevancy, scope and timing considerations extending to both parties and nonparties that cover document discovery also apply to premise inspections.<sup>90</sup> Patent infringement litigants tend to make use of premise inspections to scrutinize – mostly by testing, videotaping and photographing – their adversaries’ processes and manufacturing facilities.<sup>91</sup> Experts and consultants often accompany the inspecting party to ensure an efficient performance of the inspection.<sup>92</sup> Usually the parties collectively plan the parameters of access and inspection.<sup>93</sup> One practitioner describes the process as follows:

It is usually the technique on such an inspection to attempt to simultaneously conduct a “walking” Rule 30(b)(6) [ ] deposition. This is consistent with [the notice requirement and may include] asking the deponent to recreate certain events on videotape. These “walking” depositions are, however, not easy to do properly and may require an initial or several days of access by the party inspecting to enable full familiarization with the plant, process, and physical constraints applied before commencing the deposition. Often a separate camera for

- 83 See e.g. *Federal Sav. & Loan Ins. Corp. v. Commonwealth Land Title Ins. Co.*, 130 F.R.D. 507, 509 (D.D.C. 1990).
- 84 See e.g. *Daniels v. AMTRAK*, 110 F.R.D. 160, 161 (S.D.N.Y. 1986).
- 85 See e.g. *Financial Bldg. Consultants, Inc. v. American Druggists Ins. Co.*, 91 F.R.D. 59, 60 (N.D. Ga. 1981).
- 86 See e.g. *Societe Internationale v. Rogers*, 357 U.S. 197, 204 – 206 (1958); *contra Duracell Inc. v. SW Consultants, Inc.* 126 F.R.D. 576, 579 (1989) (stating that discovery of research and development information, financial statements, bank accounts and records, net profits and losses, investments was especially sensitive for a company in a vulnerable competitive position and, thus, merited a protective order under Rule 26(c)(1)(G)).
- 87 See e.g. *Simon v. G.D. Searle & Co.*, 119 F.R.D. 680, 681 (D. Minn. 1987).
- 88 *Fresenius Med. Care Holding Inc., v. Baxter Int’l, Inc.*, 224 F.R.D. 644, 649 (2004); *E.I. Du Pont de Nemours v. Phillips Petroleum Co.* 24 F.R.D. 416, 424 – 425 (2006). However, in deciding whether to permit production of laboratory notebooks and record courts ask how important those records are to the case. *Id.*
- 89 7 JAMES WM. MOORE ET AL., *MOORE’S FEDERAL PRACTICE* §34.12[2] (Matthew Bender 3d ed. 2008). This means that the producing party has no obligation to create or draft new documents solely for Rule 34 discovery. E.g. *Alexander v. FBI*, 194 F.R.D. 305, 310 (D.D.C. 2000). However, a defendant in a defamation case was *ordered to create* and produce handwritten exemplars. In doing so, the judge construed Rule 34 broadly in conjunction with Rule 26(b) and referred to the common occurrence during depositions of compelling deponents to make a sketch in accident cases. *Harris v. Athol-Royalston Reg’l Sch. Dist. Comm.*, 200 F.R.D. 18, 20 (D. Mass. 2001).
- 90 See FED. R. CIV. P. 34; FED. R. CIV. P. 45.
- 91 E.g. *Micro Chem., Inc. v. Lextron, Inc.*, 193 F.R.D. 667, 670 (D. Colo. 2000); see Kenneth R. Adamo et al., *Document Discovery in Patent Litigation*, in *PATENT LITIGATION STRATEGIES HANDBOOK 2004 CUMULATIVE SUPPLEMENT supra* note 89, at 79, 104 – 105.
- 92 E.g. *Eirhart v. Libbey-Owens-Ford Co.*, 93 F.R.D. 370, 372 (N.D. Ill. 1981) (access to plant by plaintiffs, their counsel and consultants).
- 93 Kenneth R. Adamo et al., *Document Discovery in Patent Litigation*, in *PATENT LITIGATION STRATEGIES HANDBOOK 2004 CUMULATIVE SUPPLEMENT supra* note 1, at 79, 104; e.g. *National Dairy Prods. Corp. v. L.D. Schreiber & Co.*, 61 F.D.R. 581, 583 (E.D. Wisc. 1973) (performance of tests only in presence of opponent’s counsel and experts).

the deposition videotape is advisable with a primary camera focused on taking the inspection/testing videotape.<sup>94</sup>

To alleviate burdensomeness and disruption and create mutually agreeable circumstances,<sup>95</sup> parties commonly collaborate in specifying the location, time and manner of the inspection.<sup>96</sup> However, courts do intervene. For example, when production sought under Rule 34(a) is so voluminous that it would impose oppressive copying and transportation costs on the producing party, courts may order inspection of the records at the producing party's convenience and place of business, rather than hard-copy-production.<sup>97</sup>

### 3. *Custody, Possession, Control*

Rule 34 authorizes inspection of things and premises if they are within *either* the “possession, custody, or control”<sup>98</sup> of a party or proper nonparty.<sup>99</sup> Accordingly, courts do not require the *preparation* of nonexistent writings producible for inspection.<sup>100</sup> Still, the concept of “custody, possession or control” is far-reaching, because only one of the three need apply and “control” is broadly construed under Rule 34;<sup>101</sup> it may include having a legal right to obtain a document, even if no copy is presently possessed.<sup>102</sup> At least one commentator argues and several courts have held that the concept of control should extend to circumstances when a “*practical ability* to obtain materials in possession of another” exists, even absent a legally enforceable right to obtain the documents.<sup>103</sup>

In patent infringement actions, issues of control surface when nonparty agents, such as attorneys, corporate officers and corporate parents and their subsidiaries possess,

- 94 Kenneth R. Adamo et al., *Document Discovery in Patent Litigation*, in PATENT LITIGATION STRATEGIES HANDBOOK 2004 CUMULATIVE SUPPLEMENT *supra* note 1, at 79, 105 (footnotes omitted).
- 95 See *Harris v. Sunset Oil Co.*, 2 F.R.D. 93, 93 (W.D. Wash. 1941) (ordering production's location and time or, alternatively, allowing parties to agree on a *mutually agreeable* time and place).
- 96 See 7 MOORE ET AL., *supra* note 89, at §34.14[3].
- 97 See *id.*; e.g. *Baine v. General Motors Corp.*, 141 F.R.D. 328, 331 – 32 (M.D. Ala. 1991) (inspection of accident reports at their usual storage location to reduce time and expense).
- 98 FED. R. CIV. P. 45(a) (emphasis added). The disjunctive listing implies that only a single requirement must apply.
- 99 Nonparties must be subject to jurisdiction under Federal Rule 45.
- 100 7 MOORE ET AL., *supra* note 89, at §34.14[2][a]. Nevertheless, creation of a computer tape which did not previously exist was proper under Rule 34. In re Air Crash Disaster at Detroit Metro. Airport, 130 F.R.D. 641, 646 (E.D. Mich. 1989).
- 101 7 MOORE ET AL., *supra* note 89, at §34.14[1]. See also *Societe Internationale v. Rogers*, 357 U.S. at 204 – 206, *supra* notes 61 – 63 (holding that *Roger's* factual and legal background mandated Rule 34 to be construed in accordance with the Trading with the Enemy Act's policies and that so read a ruling that the documents were in the plaintiff's “control” sufficient to require Rule 34 production was justified).
- 102 *Scott v. Arex, Inc.*, 124 F.R.D. 39, 41 (D. Conn. 1989) (control means the right, authority or ability to obtain document on demand); *contra Chaveriat v. Williams Pipe Line Co.*, 11 F.3d 1420, 1426 – 1427 (7th Cir. 1993) (fact that party could theoretically and only with great efforts obtain a document does not mean it has control).
- 103 See 7 MOORE ET AL., *supra* note 89, at §34.14[2][b]; e.g. *Riddell Sports Inc. v. Brooks*, 158 F.R.D. 555, 558 – 559 (S.D.N.Y. 1994) (emphasis added) (ordering corporation to produce tapes made by its officer and in possession of his attorney, because control exists if the party has the practical ability to obtain the tapes).