

ilege and work product doctrine are the most commonly used mechanisms in attempting to protect sensitive communications from document discovery.<sup>124</sup>

The attorney-client privilege applies to communications between lawyers and their clients when lawyers act in counseling or litigating roles.<sup>125</sup> In the patent context, the Court of Appeals for the Federal Circuit has held that the attorney-client privilege protects invention records prepared and submitted to counsel<sup>126</sup> primarily for obtaining legal advice concerning patent applications or assistance in a legal proceeding, even if this invention record contains technical and not strictly juridical information.<sup>127</sup> The work-product doctrine protects documents prepared in anticipation of litigation or trial from disclosure.<sup>128</sup> Because they likely contain crucial analyses and strategies of the litigation, these communications threaten to be damaging in the adversaries' hands.<sup>129</sup>

## 2. Protective Orders

Protective orders aim to ensure that discovery proceeds efficiently and fairly by injecting judicial supervision into especially sensitive matters where cooperation among the parties' has failed.<sup>130</sup> While Rule 26(c)(1) lists eight ways of achieving this, its non-exhaustive nature allows much judicial discretion in fashioning protective orders.<sup>131</sup> However, motions for protective orders should be used sparingly, because courts generally dislike extensive involvement in discovery disputes.<sup>132</sup> For example,

- research, development or commercial information.” FED. R. CIV. P. 26(c)(1)(G); *see also* Coca-Cola Bottling Co. of Shreveport, Inc. v. Coca-Cola Co., 110 F.R.D. 363, 366 (D.Del. 1986) (when Coca-Cola Co. refused to comply with the court's request to disclose its recipe for making Cola, which was held essential to the determining the dispute, all inferences related to the recipe were drawn in favor of the opposing party); *see* 2 CHARLES ALAN WRIGHT ET AL., FEDERAL PRACTICE AND PROCEDURE § 5422 (2d ed. 2008) (discussing policies underlying privileges and Federal Rule of Evidence 501).
- 124 *See* KIMBERLY A. MOORE, PAUL R. MICHEL & RAPHAEL V. LUPO, PATENT LITIGATION AND STRATEGY 145, 164 – 165 (2nd ed. 2003); *see* FED. R. CIV. P. 26(b)(3)-(4). Other privileges such as the priest-penitent, physician-patient and governmental privileges are virtually irrelevant to patent actions and, thus, beyond the scope of this paper. *See e.g.* 6 MOORE ET AL., *supra* note 13, at §26.48 – 52.
- 125 U.S. v. Chen, 99 F.3d 1495 (9th Cir. 1996).
- 126 That case concerned corporate in-house counsel for Spalding and, more specifically, its “patent committee” consisting presumptively of both lawyers and patent agents. *See* In re Spalding Sports Worldwide, 203 F.3d 800, 805 (Fed. Cir. 2000).
- 127 In re Spalding Sports Worldwide, 203 F.3d at 805 – 806 (justifying that “an attorney cannot evaluate patentability or prepare a competent patent application without knowing the prior art and obtaining relevant technical information from the inventors.”), *quoting* Sperry v. Florida, 373 U.S. 379, 383 (1963) (“[T]he preparation and prosecution of patent application of others constitutes the practice of law.”)
- 128 The work product doctrine and attorney-client privilege constitute independent concepts. While the former protects the adversarial system by assuring that an attorney's files normally remain private and protected from interferences and parasitism by the opposing party, the latter is designed to encourage frank and complete communication between attorneys and their clients. *See* Christina M. Tchen et al., *The Attorney-Client Privilege and Work-Product Doctrine in Internal Investigations: Protecting the Privilege: What Is It, Who Has It, and What Happens If You Waive It Good-Bye?* 778 PLI/LIT 33 (2008); Alvin K. Hellerstein, *A Comparative Survey of the Attorney-Client Privilege and Work-Product Doctrine*, 540 PLI/LIT 589 (1996); *see also* 6 MOORE ET AL., *supra* note 13, at §26.70[8] (distinguishing work product doctrine and attorney-client privilege).
- 129 MOORE, MICHEL & LUPO, *supra* note 124, at 145.
- 130 *Id.* at 162.
- 131 FED. R. CIV. P. 26(c)(1) (including an order different from what the parties sought)
- 132 Raphael V. Lupo, *Protective Orders*, in PATENT LITIGATION STRATEGIES HANDBOOK 125, 133 (Barry L. Grossman & Gary M. Hoffman eds., BNA Books 2002).

a movant's obligation to first attempt to settle the dispute amicably and show "good cause" eliminates the availability of protective orders for purely tactical purposes.<sup>133</sup>

### 3. *Motions to Compel and Sanctions*

A party who has made a Rule 34 request and, in response, received an objection or no answer at all may seek an order compelling compliance under Federal Rule 37(a).<sup>134</sup> Once the court enters such an order, Rule 37(b) provides various sanctions if the order is violated.<sup>135</sup> There are two main reasons for issuing sanctions involving Rule 34; noncompliance with a proper request and improper destruction of documents.<sup>136</sup> Overproduction or dumping of documents falls under the former and constitutes a common problem concerning Rule 34 discovery.<sup>137</sup> For example, in *Levene v. City of New York*, the court sanctioned the plaintiff by dismissing his claims entirely for "dumping" more than 10,000 pages on the defendants, in addition to other failures to comply with discovery orders.<sup>138</sup> Courts exercise much discretion regarding what type of sanction to issue and do so on a fact-specific basis.<sup>139</sup>

133 See FED. R. CIV. P. 26(c)(1)(G); see also *Nestle Foods Corp. v. Aetna Casualty & Surety Co.*, 129 F.R.D. 483, 486 (D.N.J. 1990) (non-patent case denying protection order because movants failed to attempt to negotiate or move for protective order in a timely fashion).

134 7 MOORE ET AL., *supra* note 89, at §34.16[2].

135 See FED. R. CIV. P. 37(b).

136 See 7 MOORE ET AL., *supra* note 89, at §34.16[3],[4]. Sanctions for destruction of documents may be imposed pursuant to Rule 37(b) only if the destruction happened *after* being served with a Rule 34 request. A court may exercise its "inherent power" to sanction abusive acts involving pre-request destruction, if the destructing party was reasonably aware that the items it was destroying constituted evidence. *Id.*; e.g. *Alliance of End Repression v. Rochford*, 75 F.R.D. 438, 440 (N.D. Ill. 1976) (sanctions imposed when documents required to answer interrogatories were destroyed after defendants learned that plaintiffs were about to sue).

137 97 Civ. 7985, 1999 U.S. Dist. LEXIS 9031 (S.D.N.Y. June 11, 1999).

138 *Id.* at \*9.

139 See 7 MOORE ET AL., *supra* note 89, at §34.16[3]-[4].