

ANNOTATED PATENT DIGEST

by Robert A. Matthews, Jr.

© 2005-07 Thomson-West, All Rights Reserved

CHAPTER 41 DISCOVERY

I. GENERAL PROCEDURAL ASPECTS REGARDING DISCOVERY

- § 41:1 Purpose of Discovery
- § 41:2 District Court's Discretion in Governing Discovery
- § 41:3 Abuse of Discretion Standard Applies
- § 41:4 Timing and Scope
- § 41:5 —Timing of Discovery Related to Claim Construction
- § 41:6 Initial Disclosures Under Rule 26
- § 41:7 Discovery After Scheduling Order Cut-Off Date

II. RELEVANCY AND THE SCOPE OF DISCOVERY

A. General Aspects of Relevancy

- § 41:8 The Federal Rules Standard for Relevancy
- § 41:9 —Relevancy Before the 2000 Amendments to Rule 26
- § 41:10 Discovery Only for Use in the Specific Case and not For Aiding Other Cases
- § 41:11 Fishing Expeditions Prohibited
- § 41:12 Speculative Theory of Relevance Not Sufficient
- § 41:13 Post-Filing Documents

B. Relevance in Patent Cases

- § 41:14 Federal Circuit Law Controls Relevancy Determinations
- § 41:15 Relevancy Must Relate to Claimed Invention
- § 41:16 Claim Scope Impact on Relevancy
- § 41:17 Relevancy as to Infringement
- § 41:18 Relevancy to Validity
- § 41:18.50 Relevancy to Charges of Inequitable Conduct
- § 41:19 Relevancy of Items to Damages

- § 41:20 Relevancy of Licensing Agreements
- § 41:21 Documents Predating Issuance of Patent

III. INTERROGATORIES

A. General Aspects of Interrogatories

- § 41:22 Interrogatories Under Rule 33
- § 41:23 Limits on Numbers of Interrogatories
- § 41:24 Answers Can be Used at Trial
- § 41:25 Duties in Responding to Interrogatories
- § 41:26 Production of Business Records in Lieu of Answer

B. Case Examples Addressing Specific Patent-Related Interrogatories

- § 41:27 Identifying Date of Conception
- § 41:28 Identifying Date of First Patent Marking
- § 41:29 Identifying Requester of Reexamination
- § 41:30 Identifying Other Pending Applications
- § 41:31 Identifying Other Abandoned Applications
- § 41:32 Identifying Other Foreign Applications

C. Contention Interrogatories

- § 41:33 General Aspects of Contention Interrogatories
- § 41:34 Time for Responding to Contention Interrogatories
- § 41:35 Contention Interrogatories in Lieu of or Before Depositions

1. Case Examples Addressing Specific Patent-Related Contention Interrogatories

- § 41:36 Claim Construction Contentions and Claim Charts
- § 41:37 Infringement Contentions
- § 41:38 Mapping of Claims on to Patentee's Product
- § 41:39 Validity Contentions

IV. REQUESTS FOR PRODUCTION OF DOCUMENTS

A. General Aspects Requests for Production of Documents and Things

- § 41:40 Production Requests Under Rule 34
- § 41:41 Permissible Scope of Requested Material

- § 41:42 Responding to Production Requests
- § 41:43 Custody or Control
- § 41:44 Production of Electronic Materials

B. Production of Patentee’s Patent Applications

- § 41:45 Patentee’s Related Pending and/or Abandoned Patent Applications
- § 41:46 Heightened Standard of Relevancy to Require Production of Pending Patent Applications

1. Case Examples Addressing Specific Potential Points of Relevancy for Pending or Abandoned Patent Applications

- § 41:47 Relevancy – Admissions on Claim Scope or Prosecution History Estoppel
- § 41:48 Relevancy – Implied Admissions on Validity
- § 41:49 Relevancy – Applications Not in Family of Patent-in-Suit
- § 41:50 Relevancy – Date of Invention

2. Other Considerations in Production of Patentee’s Pending Patent Applications

- § 41:51 Opposing Counsel’s Routine Involvement in Patent Prosecution
- § 41:52 FOIA Requests for Abandoned Applications
- § 41:53 Prior Drafts of Patent Applications
- § 41:54 Foreign Applications

C. Production of Accused Infringer’s Patent Applications

- § 41:55 Implied Admissions on Claim Construction or Infringement
- § 41:56 Implied Admissions on Validity
- § 41:57 Relevance to a Claim of Willful Infringement

D. Other Topics of Patent Related Production Requests

- § 41:58 Production of Non-party’s Patent Applications
- § 41:59 Production of R & D Records
- § 41:60 Production of Patentee’s Licensing Documents

V. REQUESTS FOR ADMISSIONS

- § 41:61 In General
- § 41:62 Admissions Limited to Pending Action Only
- § 41:63 Admissions Construed Narrowly

LATIMER, MAYBERRY & MATTHEWS

Intellectual Property Law, LLP

ROBERT A. MATTHEWS, JR.
Direct Dial: 434-525-1141
e-mail: robert.matthews@latimerIP.com

- § 41:64 Amendment of Response to Prior Admission Request
- § 41:65 —Withdrawal of an Admission
- § 41:66 —Withdrawal of a Denial
- § 41:67 Motions to Compel Under Rule 36(a)
- § 41:68 Objections to Requests to Admit
- § 41:69 Legal Conclusions
- § 41:70 Infringement Contentions on Incomplete Information
- § 41:71 Corresponding Interrogatories

VI. PARTY DEPOSITIONS

A. General Aspects of Depositions

- § 41:72 Depositions Under Rule 30
- § 41:73 Limitations on Number and Length of Depositions
- § 41:74 “Reasonable Notice” of Scheduling Deposition
- § 41:75 —Cases Finding Days of Notice Reasonable
- § 41:76 —Cases Finding Days of Notice Not Reasonable
- § 41:77 —Attorney’s Duty to Make Scheduling Accommodations
- § 41:78 Filing of Motion for a Protective Order Does Not Stop Deposition
- § 41:79 Cases Compelling Attendance at Deposition
- § 41:80 Objections and Instructions to Deponent During Deposition
- § 41:81 —Counsel Conferring with Deponent During Breaks
- § 41:82 Corresponding Document Request to Deposition Notice
- § 41:83 30(b)(6) Deposition of Corporation
- § 41:84 Personal Deposition of Corporate Officers
- § 41:85 Changing Testimony by Errata – Rule 30(e)
- § 41:86 Using Depositions at Trial
- § 41:87 Paying Deponents

B. Redeposing Witnesses

- § 41:88 General Prohibition on Redeposing Witness
- § 41:89 Failure to First Seek Leave
- § 41:90 Discovery or Production of New Information
- § 41:91 Attorney Fees as a Sanction
- § 41:92 Cases Granting Leave to Redepose
- § 41:93 Cases Denying Leave to Redepose

LATIMER, MAYBERRY & MATTHEWS

Intellectual Property Law, LLP

ROBERT A. MATTHEWS, JR.
Direct Dial: 434-525-1141
e-mail: robert.matthews@latimerIP.com

C. Deposing Trial Counsel

- § 41:94 Standards for Deposing Trial Counsel
- § 41:95 Cases Denying Right to Depose Trial Counsel
- § 41:96 Cases Permitting Depositions of Trial Counsel
- § 41:97 Deposing Attorney From Concluded Case

D. Patent-Specific Aspects to Depositions

- § 41:98 Patentee's Contention on Claim Construction and Infringement
- § 41:99 Inventor Depositions
- § 41:99.50 Compelling Foreign Inventor to Participate in U.S. Deposition
- § 41:100 Deposing Prosecution-Patent Attorney
- § 41:101 Deposing Patent Examiners

VII. OBJECTIONS TO DISCOVERY REQUESTS

E. General Aspects of Objections

- § 41:102 Objections Must be Specific
- § 41:103 Untimely Objections are Waived
- § 41:104 Requesting Party's Burden to Move to Compel

B. Specific Types of Objections

1. Undue Burden, Oppressive, Vague, Ambiguous, Not Relevant

- § 41:105 Request Seeks "All" Documents or Information
- § 41:106 Request is Not Bounded in Time
- § 41:107 Request is Vague/Ambiguous
- § 41:108 Requests is Overbroad
- § 41:109 Information Sought is Not Relevant

2. Request Seeks Privileged Material

- § 41:110 Submitting Material to *In Camera* Inspection
- § 41:111 Specificity in Claiming Privilege
- § 41:112 Privilege Logs Under Rule 26(b)(5)
- § 41:113 Claiming Privilege Does Not Excuse Identification

VIII. PROTECTIVE ORDERS

A. General Aspects of Protective Orders

- § 41:114 Protective Orders Permitted Under Rule 26(c)
- § 41:115 Only a Proper Motion for a Protective Order Stays Discovery
- § 41:116 Trial Court's Discretion in Issuing a Protective Order
- § 41:117 Protective Orders to Restrict Responding to Discovery Request
- § 41:118 Protective Order to Stay Discovery
- § 41:119 Absent a Protective Order Discovery Materials may be Freely Disseminated and Used in Other Litigation
- § 41:120 Contempt Sanctions for Violating Protective Order

B. Protective Orders to Limit Disclosure

- § 41:121 Protective Orders Limiting Disclosure Under Rule 26(c)
- § 41:122 "Good Cause" Must be Demonstrated for Stipulated Orders
- § 41:123 Standard and Proof to Demonstrate "Good Cause"
- § 41:123.50 Improper Designation of Materials Subject to Protective Order

C. Protective Orders Addressing Trade Secrets and Confidential Information

- § 41:124 General Aspects of Protecting Trade Secrets and Other Confidential Information
- § 41:125 Rule 26(c)(7) Authorization of Protection for Trade Secrets
- § 41:126 Must Show Information is a Trade Secret
- § 41:127 "Good Cause" for Protection of Trade Secrets
- § 41:128 Showing of Harm if Disclosure Permitted
- § 41:129 Use of *In Camera* Inspections
- § 41:130 Shifting Burden to Party Seeking Disclosure
- § 41:131 Balancing Harm from Disclosure with the Need for Discovery
- § 41:132 Competitor Status may Further Justify Protective Order
- § 41:133 Modification of Stipulated Protective Order
- § 41:134 Applying Protective Order to Third-Party Documents and Confidential Settlements
- § 41:135 ITC Protective Orders
- § 41:136 Simultaneous Disclosure of Invention Dates

**D. Protective Orders to Exclude Specific Types
of Individuals From Viewing Produced Material**

- § 41:137 Exclusion of Persons from Receiving Disclosure
- § 41:138 In-house Counsel
- § 41:139 Prosecuting Patent Counsel
- § 41:140 Current Officers, Employees and In-house Experts
- § 41:141 Former Employees
- § 41:142 Inventors
- § 41:143 Outside Experts/Consultants

IX. SUPPLEMENTATION AND CORRECTION OF RESPONSES

A. General Aspects of the Duty to Supplement

- § 41:144 Duty to Supplement and Correct Responses Under Rule 26(e)
- § 41:145 Duty to Supplement After Close of Discovery
- § 41:146 Duty to Supplement Expert Reports and Depositions
- § 41:147 Excluding Evidence or Theories for Failing to Supplement

B. Cases Examples Excluding Theories or Information for Late Supplementation

- § 41:148 Excluding Patentee's Infringement Theories
- § 41:149 Excluding Accused Infringer's Noninfringement Theories
- § 41:150 Excluding Invalidity Theories
- § 41:151 Allowing New Theories in Absence of Supplementation

C. Limits on Voluntary Supplementations Injecting New Theories

- § 41:152 Voluntary Supplementing After Close of Discovery
- § 41:153 Cases Excluding New Theories Relating to Infringement for Voluntary Late Supplementation
- § 41:154 Cases Excluding Validity Theories for Late Supplementation
- § 41:155 Other Cases Striking Late Supplementations
- § 41:156 Cases Permitting New Theories Despite Late Supplementation

X. EXPERT DISCOVERY

A. Testifying Experts 26(b)(4)(A)

- § 41:157 Initial Disclosures Under Rule 26(a)(2) and the Expert Report
- § 41:158 Timeliness in Identifying Expert

LATIMER, MAYBERRY & MATTHEWS

Intellectual Property Law, LLP

ROBERT A. MATTHEWS, JR.
Direct Dial: 434-525-1141
e-mail: robert.matthews@latimerIP.com

- § 41:158.50 Reports from Employees
- § 41:159 Who Must Actually Prepare the Expert Report – Extent of Attorney Ghost Writing
- § 41:160 Opinions Not in Report
- § 41:161 Deposing the Expert.
- § 41:162 Paying the Expert
- § 41:163 Late Disclosure of Expert’s Opinions or Reports and/or Failure to Timely Supplement
- § 41:164 Opportunity to Depose Expert Before any Hearing
- § 41:165 Discovery of Drafts of Reports, Affidavits or Other Materials Used or Prepared by Expert
- § 41:165.50 Discovery of Expert’s Working Notes
- § 41:165:75 Substituting Experts

B. Discovery Relating to Other Experts Used by an Adversary

- § 41:166 Discovery From Non-Testifying Experts – “Exceptional Circumstances”
- § 41:167 In-house Technical Employees Acting as Experts
- § 41:168 —Cases Finding Employees Must Submit Rule 26(b) Report
- § 41:169 —Cases Finding Employee Could Provide Testimony Without Submitting a Rule 26(b) Report

XI. DISCOVERY FROM THIRD PARTIES

- § 41:170 Rules Permit Some Discovery from Third Parties
- § 41:171 Subpoenas
- § 41:172 Discovery Outside of Local District
- § 41:173 Seek From Party Opponent Before Seeking From NonParty
- § 41:174 Motions to Quash Subpoena
- § 41:175 —Proof Burdens
- § 41:176 —Undue Burden
- § 41:177 —Irrelevant
- § 41:178 —Involuntary Expert
- § 41:179 Appealing Discovery Orders Regarding Nonparties
- § 41:180 Discovery of Settlement Agreements From Third Parties
- § 41:181 —Cases Compelling Discovery of Settlement Agreements
- § 41:182 —Cases Denying Discovery of Settlement Agreements

LATIMER, MAYBERRY & MATTHEWS

Intellectual Property Law, LLP

ROBERT A. MATTHEWS, JR.
Direct Dial: 434-525-1141
e-mail: robert.matthews@latimerIP.com

XII. MOTIONS TO COMPEL UNDER RULE 37(A)

- § 41:183 Challenging Sufficiency of Discovery Response Under Rule 37(a)
- § 41:184 Evasive, Incomplete or Untimely Answers
- § 41:185 Orders Compelling Discovery are Generally Unreviewable
- § 41:186 Lack of Diligence in Pursuing Motion to Compel

XIII. DISCOVERY SANCTIONS

A. Local Control

- § 41:187 Regional Circuit Law Controls
- § 41:188 Trial Court's Discretion

B. Sanctions Under Rule

- § 41:189 Rule 26(g) – Violation of Certification Requirements
- § 41:190 Rule 37(b) – Violation of a Rule 37(a) Discovery Order
- § 41:191 Dismissal of Action or Striking of Defenses Under Rule 37
- § 41:192 —Under Inherent Authority
- § 41:193 Facts Taken as Established
- § 41:194 Refusing to Permit Proof or Support
- § 41:195 Exclude Expert Testimony or Strike Expert Report
- § 41:196 Rule 37(c)(1) Restrict Theories or Evidence for Late Disclosure
- § 41:197 Rule 37(c)(2) Post-Trial Sanctions For Requests to Admit
- § 41:198 Rule 37(d) Total Failure to Respond, Serve Answer, or Attend Deposition
- § 41:199 —Prior Discovery Order Not Necessary
- § 41:200 —Partial Response Avoids Sanctions
- § 41:201 —Applied to Interrogatory Answers
- § 41:202 —Applied to Production or Inspection Requests
- § 41:203 —Applied to Depositions

C. Other Factors Related to Discovery Sanctions

- § 41:204 35 U.S.C. § 282 Does Not Excuse Late Disclosure of Prior Art
- § 41:205 Counsel's Conduct is Imputed to Party
- § 41:206 Factors Militating Against Imposition of Sanctions
- § 41:207 —Good Faith Impossibility of Compliance

LATIMER, MAYBERRY & MATTHEWS

Intellectual Property Law, LLP

ROBERT A. MATTHEWS, JR.
Direct Dial: 434-525-1141
e-mail: robert.matthews@latimerIP.com

D. Attorney Fees

- § 41:208 Rule 16(f) – Scheduling Orders
- § 41:209 Rule 37(a)(4) – Initial Motion to Compel
- § 41:210 Rules 37(b)(2) and 37(d) – Violation of Discovery Order
- § 41:211 Rule 26(g) – Improper Certification of Discovery Request, Response or Objection
- § 41:212 Under 35 U.S.C. § 285
- § 41:213 Vexatious Litigation – 28 U.S.C. § 1927

XIV. DESTRUCTION, FABRICATION, OR FALSIFICATION OF EVIDENCE

A. Fabricating Evidence

- § 41:214 Fabrication of Evidence/False Testimony
- § 41:215 Sanctions for Fabricating Evidence or Giving False Testimony
- § 41:216 Evidentiary Hearing
- § 41:217 Attorney Fees
- § 41:218 Adverse Inferences

B. Spoliation of Evidence

- § 41:219 Duty to Preserve Evidence

XV. MISCELLANEOUS ITEMS

- § 41:220 Discovery From Patent Examiners
- § 41:221 Discovery Proceedings Ancillary to Interference
- § 41:222 Unsworn Declarations
- § 41:223 Discovery for Use In Foreign Litigation – 28 U.S.C. § 1782
- § 41:224 Foreign Plaintiffs Bringing Suit in the United States