

**UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF CONNECTICUT**

THULE, INC.,	:	
	:	
Plaintiff	:	
	:	
v.	:	CIVIL NO. 3:03CV1730 (MRK)
	:	
YAKIMA PRODUCTS INC.,	:	
	:	
Defendant.	:	

ORDER

In accordance with the Court's instructions in its Scheduling Order ("Scheduling Order") dated November 20, 2003 (¶ 3B, Note), the parties have conferred telephonically with the Court in connection with a discovery dispute. In addition, at the Court's request, the parties provided the Court with two brief memoranda, along with attachments. *See* Thule's Memorandum in Support of Claim Construction, Infringement and Validity Discovery, dated December 3, 2003 ("Thule's Brief"); Yakima's Opposition to Thule's Attempt to Obtain Premature Willful Infringement Discovery, dated December 4, 2003 ("Yakima's Brief"). Plaintiff Thule, Inc. ("Thule") also submitted a Reply in Support of Claim Instruction [sic], Infringement and Validity Discovery, dated December 5, 2003. Because of impending depositions and the tight schedule that governs discovery and filings in this case, the Court agreed to consider these submissions and rule upon this issue on an expedited basis without the need for formal motions to quash, for a protective order and/or to compel discovery.

The current dispute arises from ¶ 3B of the Scheduling Order, which states as follows:

Prior to the February 6, 2004 claim construction/summary judgment hearing the parties will refrain from conducting discovery on willful infringement or damages unless the party seeking that discovery in good faith believes that such discovery is directly relevant to or otherwise directly bears on the issues expected to be addressed at the claim construction/summary judgment hearing.

The Court included that provision in the Scheduling Order because both parties and the Court recognized that the schedule governing discovery and briefing in this case was very ambitious. In order to ensure that all work was accomplished and all issues briefed in an orderly fashion consistent with that ambitious schedule, the Court established two phases to the pretrial proceedings in this case. The first phase involved expedited discovery and briefing on *only* claim construction and summary judgment issues (infringement and invalidity). The Court agreed to hold a hearing on those issues on February 6. The second phase, which begins immediately following the February 6 hearing and does not await the Court's disposition of claim construction/summary judgment issues, relates to all other issues in the case, including willfulness and damages. Paragraph 3B was designed to implement the Court's decision to phase discovery and briefing based on the division of issues just noted, though the provision also recognized that it was conceivable that there could be some overlap on issues. Therefore, the Court's order permitted pre-February 6 discovery on willfulness and damages issues if the party seeking the discovery demonstrated that the discovery also was "directly relevant to or otherwise directly bears on" issues to be addressed at the February 6 claim construction/summary judgment hearing.

Thule has recently issued a number of Subpoenas and Notices of Deposition for various depositions commencing on December 11, 2003, copies of which Thule has provided the Court. In particular, Thule has issued subpoenas and noticed the deposition of the Kolisch Hartwell law

firm – which is serving as counsel for Defendant Yakima Products, Inc. ("Yakima") in this action and also apparently serves as general patent counsel to Yakima – and John McCormack and Owen Dukelow, both of the Kolisch Hartwell law firm. Attached to these subpoenas is a Schedule A listing various topics that Thule intends to inquire into or about which the deponents should bring documents, and those topics included advice that Kolisch Hartwell gave to Yakima regarding the '705 patent. In addition, the subpoenas and deposition notices issued to Yakima and its employees also include a list of topics to be inquired into. Those topics include a request for testimony and documents regarding advice that Kolisch Hartwell gave Yakima regarding the '705 patent and an opinion that Yakima received from McCormack in or about 1997 or 1998 (the letter itself is dated June 9, 1997 but it may not have been transmitted until 1998), a copy of which Yakima attached to its brief in opposition [doc. #20] to Thule's motion for preliminary injunction. [doc. # 1]. In his letter, McCormack opined that the Yakima product that is the subject of this action would not infringe Thule's '705 patent.¹ The issue presented to the Court is whether this discovery sought by Thule of Kolisch Hartwell and Yakima relating to the McCormack Opinion is permitted under the terms of ¶ 3B. For the reasons stated below, the Court concludes that such discovery is not permitted before February 6.

As should be apparent from the captions that each party chose to label its briefs, the parties have very different views of what issues are implicated by Thule's requested discovery. As a result, the parties' briefs are often two ships passing in the night. For example, Thule has

¹ In this Order, the Court refers to discovery regarding the "McCormack Opinion" as a short-hand to encompass all discovery regarding discussions and correspondence between Yakima and its counsel regarding the '705 patent and the Yakima product that is the subject of this action.

devoted its briefs chiefly to the issue of waiver of the attorney-client privilege (Thule contends that Yakima waived the privilege by attaching the McCormack's opinion letter to, and discussing it in, Yakima's preliminary injunction brief) and an exegesis about relevance under the discovery rules (Thule contends that discovery regarding the McCormack Opinion easily satisfies the standards governing the scope of discovery under the Federal Rules).

However, the Court does not believe that either of Thule's points bear on the question presented by the current dispute over discovery. The issue before the Court is not *whether* Thule will be permitted to undertake discovery regarding the McCormack Opinion. Thule certainly will be permitted to take that discovery, though the precise scope of the discovery need not be determined today.² Rather, the question currently before this Court is *when* will that discovery take place. And the answer to the "*when*" question can be found in the terms of the Court's Scheduling Order, not in case law governing waiver of attorney-client privilege or in generalized discussions about the proper scope of discovery. Under the explicit terms of the Scheduling Order, the Court delayed *all* discovery regarding willfulness or damages until after the hearing on February 6, unless the party seeking the discovery – in this case Thule – demonstrated that the discovery was "directly relevant to or otherwise directly bears on the issues" the Court will consider on February 6.

Thule does not argue that under relevant case law the McCormack Opinion is directly relevant to claim construction or infringement. And for good reason. For under relevant case law, the views of Yakima's counsel have little, or no, relevance to either claim construction or infringement. As the Federal Circuit put it in *Hilton Davis v. Warner-Jenkinson Co.*, 62 F.3d

² Kolisch Hartwell will also need to comply with Local Rule 83.13.

1512 (Fed. Cir. 1995):

Intent is not an element of infringement. A patent owner may exclude others from practicing the claimed invention, regardless of whether infringers even know of the patent. . . Proof of bad faith by an infringer may entitle the patent owner to enhanced damages and attorneys fees for willful infringement under 35 U.S. C. § 284-285 (1988). Evidence of culpable conduct, however, is not a prerequisite nor necessary for application of the doctrine [of equivalents].

Id. at 1519.

By all appearances, therefore, any testimony regarding the McCormack Opinion would appear to relate solely to willfulness and damages and have no bearing on claim construction or infringement. Indeed, Thule has not cited a single decision in which a court relied on an opinion expressed by a party's counsel in connection with the court's construction of patent claims or determination of infringement or invalidity issues.

Nonetheless, Thule argues that Yakima has itself put the McCormack Opinion at issue on claim construction and infringement. Had Yakima done so, the Court would be sympathetic to Thule's argument.³ However, the Court does not find any basis for Thule's assertion. To support its argument, Thule relies solely on the fact that Yakima attached the McCormack Opinion to its preliminary injunction brief and discussed it in connection with Yakima's arguments against the grant of injunctive relief. That much is certainly true, but the Court does not accept Thule's assertion that Yakima sought to use the McCormack Opinion "as a 'sword' in an effort to prove non-liability (i.e., non- *infringement*)." Thule's Brief at 1.

The McCormack Opinion is invoked twice in Yakima's brief and contrary to Thule's

³ As a consequence, Yakima will be deemed to have opened the door to immediate discovery on the issues requested by Thule if Yakima seeks to rely on, or otherwise use, evidence regarding the McCormack Opinion in connection with the issues the Court will entertain on February 6.

argument, in neither instance does Yakima use it in connection with issues of claim construction or infringement. Yakima first citation to the McCormack Opinion is in the "background" section of the brief, and it is clear that Yakima is merely citing it as factual background on how the parties arrived at the dispute before the Court. The McCormack Opinion is next cited at page 30 of Yakima's brief *after* Yakima had discussed claim construction and infringement issues and in a section of the brief dealing with the public interest factors the Court would have to consider in deciding whether to grant an injunction. In that section of its brief, Yakima used the McCormack Opinion to respond to Thule's contention (in the public interest portion of its brief) that Yakima had deliberately copied Thule's design. It is clear from Yakima's brief that it sought to use the McCormack Opinion as evidence of Yakima's good faith and lack of culpable intent, both of which are relevant to willfulness but not to infringement or claim construction. Yakima did not use the McCormack Opinion to show that Yakima's construction of the '705 patent was correct or that Yakima's product did not infringe the '705 patent.

Accordingly, at this point, Thule has failed to carry its burden of demonstrating that discovery it seeks regarding the McCormack Opinion must occur before February 6 because such discovery is directly relevant to the issues the Court will consider on February 6. Thule can conduct any appropriate discovery regarding the McCormack Opinion *after* February 6.

Construing the parties' oral requests and written briefs as a motion to quash and for a protective order by Yakima and a motion to compel by Thule, the Court quashes the subpoenas issued to Kolisch Hartwell and its personnel, grants a protective order regarding the requested depositions of Yakima personnel insofar as discovery relating to the McCormack Opinion is concerned and denies Thule's motion to compel.

IT IS SO ORDERED

/s/ Mark R. Kravitz

USDJ

Dated at New Haven, Connecticut: December 8, 2003.