

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

3M COMPANY, *et al.*

Plaintiffs,

ORDER

v.

07-C-87-C

KERR CORPORATION,

Defendant.

The instant lawsuit spins off 3M's '948 patent counterclaims from Kerr's '251 and '733 patent lawsuit (06-C-423-C, which has settled and awaits dismissal). Discovery in the initial lawsuit proceeded fitfully, *see* 12/1/06 and 1/2/07 orders in that case, dkt. 37 & 45. Severance of the instant lawsuit has not improved the situation.

Before the court is defendant Kerr's motion to compel discovery and to shift costs. *See* dkt. 6-8. Kerr seeks production of any information regarding plaintiffs' testing of Kerr's challenged products and production of a 30(b)(6) witness adequately prepared to respond to topics 1, 2, 5-7 and 19 of the deposition notice. Kerr asserts that 3M refused to provide a 30(b)(6) witness on Topics 5-7, did not prepare its witness on Topics 1, 2 and 19, and refused to provide evidence regarding testing done with the MacBeth transmission densitometer. 3M vigorously disagrees with Kerr's contentions, arguing that Kerr has highlighted and mischaracterized a small portion of a much bigger discovery picture. *See* dkt. 9.

Having determined that no discovery breakdown has occurred requiring court action, with one exception I am denying Kerr's motion.

I have read all of the documents and affidavits submitted by both sides in support of their positions.¹ I will not provide a background narrative in this order because the parties don't need one. The bottom line is that we are in a situation much like that addressed in the January 2, 2007 discovery order cited above: given the *gestalt* of the parties' exchange of discovery, there really isn't much that this court could order that would make a substantive difference. Previous orders in the first case didn't really order the parties to do anything that they weren't already doing or planning to do, but twice I have roweled Kerr for not maintaining track speed. So, perhaps it is understandable that Kerr would welcome an opportunity to accuse 3M of not living up to its discovery obligations in a timely fashion. 3M takes this thought a step further by suggesting that a good offense is the best defense: Kerr filed its motion prophylactically, anticipating objections from 3M to Kerr's latest responses to 3M's discovery demands.

It's hard to tell if discovery in this particular patent lawsuit is any more dysfunctional than in other patent lawsuits, but the parties certainly are not shy about bringing their problems to the court's attention. This often is useful and sometimes it is critical, but other times it's neither. Given the parties' history with this court in these two cases, I decline to conclude that Kerr filed its motion with no basis to do so; that said, I still am denying Kerr's motion in all substantive parts.

3M's 30(b)(6) witness, Dr. Bradley Craig, apparently thought that he was prepared to talk about virtually every topic on which 3M did not invoke privilege. His failure to provide enough satisfactory information to Kerr on Topics 1, 2 and 19 may be laid at 3M's feet, but this

¹ I remind the parties that it is improper to file confidential documents electronically.

failure was not intentional and Kerr did not object to it at the time. Certainly Kerr was and is entitled to appropriate follow-up, but Kerr was and is receiving it, at least according to 3M. Kerr did not need and does not need a court order to obtain this information.

So too with 3M's provision of documents Craig had reviewed to prepare for his deposition: 3M should have provided all of these documents upon Kerr's demand at the deposition, but there is no evidence that Craig or 3M intentionally withheld these materials or that Kerr was deprived of an opportunity to ask genuinely material questions of Craig. If Kerr actually has some substantive follow-up in mind as a result of having reviewed these additional documents, then 3M must provide that follow-up, but claiming to have been denied an opportunity to ask questions about foundational documents, without more, is not a basis for this court to sanction 3M.

Kerr's objections to 3M's claims of privilege have slightly more traction, but I will not order 3M to produce information about scientific testing performed at the request of 3M's counsel that 3M (and its experts) will not be relying upon to provide infringement. Such testing qualifies as work product to which no exceptions (waiver or substantial need) apply. Given 3M's claim that it produced its expert report on opacity testing over a month early, Kerr is not entitled to further relief on this topic from the court.

3M also has invoked the attorney-client privilege to protect Craig's communications with 3M's Office of Intellectual Property Counsel. It may be that this invocation is appropriate, but the Seventh Circuit is chary of such claims and it is not enough for 3M simply to invoke Federal Circuit precedent as a shield of invulnerability. Not later than March 16, 2007 3M must

produce for *in camera* inspection all communications on this topic that it is withholding on the basis of attorney-client privilege.

It is ORDERED that defendant's motion to compel discovery is GRANTED IN PART and DENIED IN PART for the reasons and in the manner stated above.

Each side will bear its own costs on this motion.

Entered this 12th day of March, 2007.

BY THE COURT:

/s/

STEPHEN L. CROCKER
Magistrate Judge