

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

PIONEER KABUSHIKI KAISHA d/b/a)
PIONEER CORPORATION,)
)
Opposer,)
)
v.)
)
HITACHI HIGH TECHNOLOGIES AMERICA,)
INC., by change of name from)
NISSEI SANGYO AMERICA, LTD.,)
)
Applicant.)

Opposition No. 125,458
Mark: SUPERSCAN ELITE
Serial No.: 76/208,230
Published: March 19, 2002

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**REPLY BRIEF OF APPLICANT ON
APPLICANT'S MOTION TO COMPEL
PRODUCTION OF SURVEY DOCUMENTS**

Applicant, Hitachi High Technologies America, Inc., has moved to compel Opposer, Pioneer Corporation, to produce documents generated by its expert in conducting a survey for use in this case. Opposer responds that it need not produce the documents because Applicant did not issue a subpoena to the expert.

Opposer is relying on an incorrect interpretation of the Federal Rules of Civil Procedure and a misreading of the case law to avoid producing the documents on which its expert relied in preparing his opinion and report. Contrary to Opposer's assertions, a Rule 45 subpoena to the expert was not required under the circumstances here. Opposer seeks to evade production of documents relating to a survey which Opposer commissioned despite the fact that Opposer agreed that it would produce such documents. To allow such a procedural sleight of hand would contravene the overarching principle stated in F.R.C.P. 1, namely, that the Federal Rules "shall be construed and administered to secure the just, speedy and inexpensive determination of every action."



08-16-2004

A Subpoena Was Not Required Because Opposer Stated It Would Produce Documents Relating to the Survey

Opposer's Response ignores a crucial factor affecting this motion: In document requests 32, 36 and 37 (quoted in full in Applicant's Motion, ¶3), Applicant requested Pioneer to produce all documents relating to any survey and all documents relied on by Pioneer's expert. In its supplemental responses to these document requests, Pioneer states that it ". . . will produce documents responsive to this request. . . ." (See Motion, ¶4).

Not one sentence in Opposer's response acknowledges this promise to produce the very documents Applicant is now seeking. Rather, it takes the position that even though it commissioned and paid for the surveys, *it* does not have possession of the documents; only its hired expert does. Allowing Opposer to renege on its commitment to produce survey documents would not promote the "just, speedy and inexpensive" determination of this action.

Opposer insists that Applicant should have issued a subpoena to the expert. Why would Applicant even consider issuing a subpoena directly to the expert when Pioneer had already agreed to produce the documents? Such a measure would surely be unnecessary and only add to the expense of the action and to the proliferation of papers in this case.

It would be a sly trick for Opposer to promise production of documents relating to a survey *it commissioned* and then avoid its obligation by taking the position that those documents are not in *its* possession but in the possession of an expert it commissioned to perform the survey. Yet that seems to be what Opposer is trying to accomplish.

The text of Rule 34 requires production of documents not only in a party's "possession," but also production of documents which are in its "control." Opposer cannot credibly argue that these documents are not in its control. Mr. Klein, the expert, is not simply an unrelated third-party with relevant information. He was specifically retained by Opposer and his firm was paid approximately \$35,000 to perform the survey on which Opposer now seeks to rely. (Klein Dep.,

p. 17). Opposer clearly has a right to copies of these documents and has access to them through its controlled expert. See *Alper v. U.S.*, 190 F.R.D. 281 (D. Mass. 2000), where the court held that Rule 34 could be applied to a party's expert ("Although Dr. Becker himself is not a party to the action, Rule 34 governs the discovery of documents in the possession or control of the parties themselves. Given the fact that Dr. Becker is Defendant's expert, the documents which Plaintiff seeks from him may be considered to be within Defendant's control"). 190 F.R.D. at 283.

Opposer's intent to evade production is illustrated by a fact disclosed in Mr. Skousen's Declaration at ¶11. Pioneer's expert testified that he had given a data print-out to Mr. Skousen (Klein Dep., p. 81). Despite the outstanding document requests cited above, Mr. Skousen did not produce the document but rather returned the document to Mr. Klein (apparently after the deposition). This clearly suggests an effort to evade production. Such actions should not be countenanced by the Board.

Applicant's Request for Production Was Not Untimely

Opposer attempts to portray Applicant's counsel as somehow dilatory in seeking the documents at issue, suggesting that Applicant's counsel first requested the documents "4 hours before discovery closed." Opposer argues that counsel was attempting to "circumvent the discovery cut-off." (Opposer's Mem., p. 1). This is clearly misleading, as it ignores the fact that on April 30, 2004, three weeks prior to the expert's deposition and a month prior to the discovery cut-off, counsel requested supplemental responses to production requests 32, 35, 36, 37 and 38, relating to the survey. (See Motion, Exhibit 2). Opposer had a duty under Rule 34 to supplement its document production by producing the documents referred to by Mr. Klein in his deposition. Since the documents were directly responsive to the production requests, Pioneer should have produced them irrespective of counsel's May 28 request.

Opposer's Production of Some Survey Documents Does Not Justify Withholding Other Relevant Survey Documents

Opposer attempts to excuse its refusal to produce the documents at issue by pointing out what it *did* produce as part of its expert's report. (Opposer's Mem., p. 13). This, of course, only highlights the selective nature of Pioneer's production. Pioneer produced materials generated by its expert when it deemed them useful, but withheld materials which would be necessary for Applicant to test the validity of the expert's procedures. If Opposer wants to be able to rely on *some* of the expert's survey documents, it should be required to produce *all* of the expert's survey documents.

The documents which Applicant is seeking (completed questionnaires and screening forms, data printouts, validation documents and tally sheets) are critical to Applicant's ability to investigate the validity of Mr. Klein's report. Opposer argues (Opp. Mem., p. 15) that summaries of the data are contained in the report, but that is the very reason Applicant needs the underlying data. Applicant is not required to simply take the expert's word for it; it is entitled to check and verify the expert's calculations and conclusions. It is also entitled to determine whether there were flaws in conducting the survey. Opposer should not be able to withhold the materials needed to cross-examine the expert.

Opposer's Cases Do Not Hold That A Subpoena Is the Only Basis for Production of the Documents

Opposer misstates the effect of the cases on which it relies. None of those cases holds that a Rule 45 subpoena is the exclusive method of obtaining documents relied on by an expert.

The gist of the *Expeditors* case is not that a Rule 45 subpoena is the *only* way to obtain documents relied on by an expert, but rather that it is a *permissible* way to obtain such documents. In *Expeditors*, the expert was served with a subpoena and tried to avoid production by arguing that discovery "must proceed" under Rules 26 and 34, and that the limitations in

those rules should not be circumvented by use of Rule 45. 2004 WL 406999 at *3. The court rejected that argument, stating that a Rule 45 subpoena issued to an expert is “*an appropriate* discovery mechanism against nonparties such as a party’s expert witness.” The court did not state that Rule 45 is the *only* appropriate manner to obtain documents relied on by an expert. The court concluded its discussion of this point by stating: “Accordingly, Rule 26 does not prohibit the use of a subpoena in this situation.” *Id.* at *3.

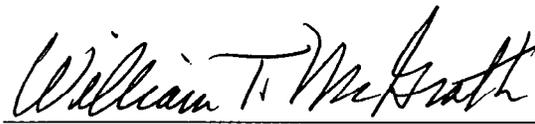
Opposer relies heavily on *Smith v. Transducer Technology, Inc.*, 2000 WL 1739217 (D.V.I. 2000). Opposer has absolutely misstated the holding of this case. *Smith v. Transducer* merely held that an expert could not be sanctioned for not producing documents at a deposition pursuant to a Rule 30(b)(5) deposition notice. It did not hold that Rule 45 was the exclusive method of obtaining documents relied on by an expert witness. In fact, a later order by the court in that case, which Pioneer did not disclose in its brief, states just the opposite. See, *Smith v. Transducer Technology, Inc.*, 2000 WL 1717332 (D.V.I. 2000) (copy attached). In this order denying a motion for reconsideration, the court rejected the characterization of its prior order as requiring that documents considered by an expert in forming his opinion must be obtained only by a subpoena. *Id.* at *1. The court made it clear that its prior order did not foreclose the availability of other avenues of discovery allowable under the Federal Rules. The court noted that its initial ruling was strictly limited to a request for documents made by way of a 30(b)(5) deposition notice to an expert. In footnote 2, the court added that “a motion pursuant to Rule 34 is not equivalent to the Rule 30(b)(5) Notice of Deposition utilized by Plaintiff.” *Id.* at *2. The court concluded by stating: “Nothing contained in the Order dated May 19, 2000 [the prior order] prohibits Plaintiff from utilizing other means of discovery (e.g., a motion to compel pursuant to Rule 37(a)(2)) to procure producable documents.” *Id.* at *2.

The *All West* case is inapplicable for the same reason. Like *Smith v. Transducer*, the *All West* court simply held that an expert was not compelled to produce documents where the request was made during a deposition rather than pursuant to a request for production. In *All West* the court specifically noted that the defendants had not made a request for production under Rule 34.

It would be manifestly unfair if, on the basis of some procedural technicality, Pioneer were able to withhold documents generated by its expert in conducting the survey which Pioneer commissioned and on which it intends to rely. If the Board feels that a Rule 45 subpoena is the only way to obtain a survey expert's underlying documents, it can ameliorate the situation by allowing Applicant a limited time to serve such a subpoena on Mr. Klein.

For all the foregoing reasons, Applicant respectfully requests that its Motion to Compel be granted.

Respectfully submitted,

By: 
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Only the Westlaw citation is currently available.

District Court of the Virgin Islands, Division of St. Croix.

Paul K. **SMITH**, Plaintiff,

v.

TRANSDUCER TECHNOLOGY, INC. ENDEVCO CORPORATION and MEGGITT-USA, INC.
Defendants

No. CIV.1995/28.

July 3, 2000.

ORDER DENYING PLAINTIFF'S MOTION FOR RECONSIDERATION (ORDER DATED 5/19/00)

RESNICK, Magistrate J.

*1 THIS MATTER came for consideration on Plaintiff's Motion for Reconsideration of the Order dated May 19, 2000. Defendants filed opposition to the motion. Plaintiff did not reply to such opposition.

The May 19, 2000 Order concerned the failure of Defendants' expert witness to bring documents to his deposition. The documents were requested by Plaintiff's First Amended Notice of Expert Deposition [Fed.R.Civ.P. 30(b)(5)]. In the Order, the Court held that such Notice of Deposition did not compel production of documents without an accompanying subpoena *duces tecum* in accordance with Rule 45(a)(1)(c).

Plaintiff's Motion for Reconsideration misconstrues the May 19, 2000 Order. Plaintiff states:

The essence of this Court's holding in its Order...is that Marsh [FN1] requires that documents 'considered' by an expert in forming his opinion must be obtained by use of subpoena *duces tecum* in conjunction with the expert's deposition... (emphasis added).

FN1. Marsh v. Jackson, 141 F.R.D. 431 (W.D.Va.1992).

Plaintiff suggests that such order forecloses other avenues of discovery that are mandated or allowable under the Federal Rules of Civil Procedure.

Fed.R.Civ.P. 26(a)(2)(B) provides for required disclosure of expert witness reports and what must be contained therein. Rule 26(b)(4)(A) provides for taking depositions of an opponent's expert witness and that the deposition shall not be conducted until the expert's report is provided. LRCi 26.3(a) provides that the opposing party is entitled to the expert's report at least thirty (30) days before the expert deposition.

If a party wishes to depose an opponent's expert and considers the expert's report to be deficient, the party may file a motion to compel as provided in Fed.R.Civ.P. 37(a)(2):

If party fails to make a disclosure required by Rule 26(a) any other party may move to compel disclosure and for appropriate sanctions.

A Rule 30(b)(5) Notice of Deposition to a non-party deponent will not compel such

production.

The cases cited by Plaintiff in his motion do not hold otherwise. Karn v. Ingersoll-Rand Co., 168 F.R.D. 633, 638 (N.D.Ind.1996) notes that the expert witness disclosure is mandatory; Hasbro Inc. v. Serafino, 168 F.R.D. 99, concerned a deposition subpoena served on a plaintiff pursuant to Fed.R.Civ.P. 45 rather than seeking such documents pursuant to Rule 34; Hartford Fire Insurance Co. v. Pure Air on the Lake Limited Partnership, 154 F.R.D. 202 related to a subpoena served on a consulting expert not expected to testify and that the Rule 45 subpoena is subject to the limitations of Rule 26(b)(4)(B) [need to show exceptional circumstances for such discovery].

Alper v. U.S.A., 190 F.R.D. 281 (D.Mass.2000) does contain language contrary to Marsh as cited by the court in the May 19, 2000 Order. In Alper the court quashed plaintiff's subpoena to produce documents issued to defendant's expert witness, as being beyond the discovery schedule. The court then stated that although Dr. Becker (the expert witness):

*2 [h]imself is not a party to the action, Rule 34 'governs the discovery of documents in the possession or control of the parties themselves.' Given fact that Dr. Becker is Defendant's expert, the documents which Plaintiff seeks from him may be considered to be within defendant's control. Hence Rule 34, not Rule 45 would appear to apply. [FN2] Id at 283.

FN2. In any event, a motion pursuant to Rule 34 is not equivalent to the Rule 30(b)(5) Notice of Deposition utilized by Plaintiff in the case at issue.

Alper cites no precedent for such proposition and later equivocates:

[E]ven were the court to assume that Rule 45 applies to Becker... Id.

Alper has likewise has not been cited by other cases during its brief term in print whereas Marsh has been so acknowledged. See e.g. Perry v. U.S.A. 1997 WL 53136 *1 (N.D.Tex.); Ambrose v. Southworth Products Corp., 1997 WL 470359 *1 (W.D.Va.); [noting that Rule 26(b)(4) does not permit the use of a bare subpoena *duces tecum*]; Greer v. Anglemeyer D.O., 1996 WL 56557 *2 (N.D.Ind.); Hartford Fire Ins. Co. v. Pure Air on the Lake, Ltd., 154 F.R.D. 202, 208 (N.D.Ind.1993); Quale v. Carol Cable Co., Inc., 1992 WL 277981 *2 (E.D.Pa.) [A Rule 45 subpoena with respect to experts expected to testify at trial is limited by Rule 26).

Plaintiff has provided no convincing argument for reconsideration of the May 19, 2000 Order. The Court reiterates that a Notice of Deposition to the opposing party is not a proper vehicle to compel production of documents from an expert witness at such expert's deposition. A Rule 45 subpoena *duces tecum* in conjunction with a properly noticed deposition may do so (subject however to any Rule 26 limitations). Nothing contained in the Order dated May 19, 2000 prohibits Plaintiff from utilizing other means of discovery [e.g. a motion to compel pursuant to Rule 37(a)(2)] to procure producible documents.

Accordingly, it is hereby;

ORDERED that Plaintiff's motion is DENIED.

2000 WL 1717332 (D.Virgin Islands)

END OF DOCUMENT

Opposition No. 125,458

Mark: SUPERSCAN ELITE

Serial No.: 76/208,230

CERTIFICATE OF MAILING

I hereby certify that the foregoing REPLY BRIEF OF APPLICANT ON APPLICANT'S MOTION TO COMPEL PRODUCTION OF SURVEY DOCUMENTS is being deposited with the United States Postal Service, Express Mail postage prepaid, in an envelope addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202, BOX TTAB, on **August 16, 2004**.



William T. McGrath

CERTIFICATE OF SERVICE

I hereby certify that the foregoing REPLY BRIEF OF APPLICANT ON APPLICANT'S MOTION TO COMPEL PRODUCTION OF SURVEY DOCUMENTS is being transmitted by facsimile to 310-782-9579, and is being deposited with the United States Postal Service, first class postage prepaid, in an envelope addressed to Mr. Robert J. Skousen, SKOUSEN & SKOUSEN, P.C., 12400 Wilshire Boulevard, Suite 900, Los Angeles, California, 90025-1060, on **August 16, 2004**.



William T. McGrath