



## Alerts

### Work Product Protection Applies to Plaintiff's Testing Data in Patent Dispute

November 18, 2010

*Lawyers for the Profession® Alert*

*Kimberly Clark Worldwide, Inc. v. First Quality Baby Products, LLC*, 2010 WL 4537002 (M.D. Pa. 2010)

#### Brief Summary

A U.S. Magistrate Judge held that testing data that formed the basis for plaintiff's patent infringement suit were protected by the work product doctrine so long as plaintiff did not rely on the data as substantive evidence in support of its claims, even though plaintiff already had relied on the data for its preliminary infringement contentions.

#### Complete Summary

Defendant in this patent infringement action sought to compel production of relevant testing data that plaintiff had gathered prior to bringing suit. In support of its motion, defendant argued that the materials were not protected by either the attorney-client privilege or the work product doctrine, and that even if they were, plaintiff had waived both.

A U.S. Magistrate Judge from the Middle District of Pennsylvania held that the attorney-client privilege did not apply because plaintiff failed to demonstrate that the testing materials were confidential communications between attorney and client.

But the magistrate judge held that the materials were protected by the work product doctrine. In reaching this conclusion, the magistrate relied on a declaration from plaintiff's counsel that the materials were prepared in anticipation of litigation as well as the fact that the privilege log demonstrated that the materials were prepared when litigation was contemplated and within only eight months of the beginning of litigation.

The magistrate judge then held that plaintiff could not rely on the testing data in support of its infringement claim without waiving protection. Although plaintiff had already relied on the data in its preliminary infringement contentions, the magistrate stated that such use of the materials did not waive protection because it merely served to put defendant on notice of plaintiff's theory of the claims and was not yet being used as substantive evidence to support the claims. However, any use of the materials as evidence in support of plaintiff's claims, the magistrate held, would waive protection because defendant had

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demonstrated a substantial need for the testing data.

The judge gave plaintiff 14 days to decide whether it would rely on the testing data as evidence, and, depending on plaintiff's decision, 10 days thereafter to disclose the information to defendant.

### **Significance of Opinion**

This opinion demonstrates again that work product protection can be broader than attorney-client privilege, and that the purposes for which work product materials ultimately are used (*e.g.*, putting a defendant on notice of claims, versus providing evidence in support of a claim) may be important in determining whether protection has been waived.

*This alert has been prepared by Hinshaw & Culbertson LLP to provide information on recent legal developments of interest to our readers. It is not intended to provide legal advice for a specific situation or to create an attorney-client relationship.*