

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF INDIANA
INDIANAPOLIS DIVISION

JOE MORROW and AMERICAN,)
INNOVATIVE MANUFACTURING)
INDUSTRIES, INC.,)
)
Plaintiffs,)
) IP-05-113-Misc.
vs.)
)
AIR RIDE TECHNOLOGIES, INC.)
)
Defendant.)

**ENTRY ON PLAINTIFFS' MOTION TO COMPEL
RESPONSE TO NON-PARTY SUBPOENA**

I. Background.

On November 12, 2004 Plaintiffs Joe Morrow and American Manufacturing Industries, Inc., filed a patent infringement suit against competitor Defendant Air Ride Technologies, Inc., in the United States District Court of Arizona. [JAMS Docket No. 2, pp. 1-2.] Through Defendant's discovery responses, Plaintiffs learned that Defendant used products from Firestone Industrial Products Company ("Firestone") in manufacturing the products at issue in the Arizona patent suit. [*Id.*, p. 2.] Firestone, too, is one of Plaintiffs' direct competitors. [JAMS Docket No. 2, p. 3.] In subsequent discovery requests to Defendant, Plaintiffs sought "all documents showing what components [Firestone] provided to Defendant" for use in the allegedly infringing products. [*Id.*]

When Defendant allegedly failed to produce any documents, Plaintiffs served Firestone, a non-party, with a subpoena duces tecum on November 10, 2005 requesting all documents

“showing or touching upon any communications between and/or business transacted between Firestone Ind. Prod. Co. and/or any affiliated entities and Air Ride Technologies and/or any affiliated entities, from January 1, 1997 to the present date.” [JAMS Docket Nos. 3, 5.]

Consistent with Fed. R. Civ. P. 45(c)(2)(B), Firestone served written objections on all parties on November 22.¹ [JAMS Docket No. 4.] Firestone objects to the subpoena on the dual bases that it subjects Firestone to undue burden and contemplates the production of privileged and other protected matter. [JAMS Docket No. 11.]

On December 9, Plaintiffs moved to compel Firestone’s response to the subpoena.² [JAMS Docket No. 1.] Plaintiffs contend that Firestone’s objections are largely unsupported “bare assertions.” [JAMS Docket No. 2, pp. 4-7.] Plaintiffs also assert that they are entitled to the requested discovery because it is relevant to establish when the alleged infringement commenced, whether and to what extent it was knowing and willful, whether Firestone engaged in contributory negligence, and to determine if any additional claims exist against Firestone.

¹ Firestone initially did not file its objections and proposed motion to quash subpoena with any court. Subsequent to Plaintiffs’ motion to compel, Firestone obtained leave from this Court to respond to Plaintiffs’ motion to compel. [JAMS Docket No. 10.] Although the response filed by Firestone is titled “Non-Party Firestone Industrial Products Company’s Motion to Quash Subpoena Duces Tecum and Response to Plaintiffs’ motion to compel”, the only matter properly before this Court is Plaintiffs’ motion to compel, and the Court treats this filing as a response.

² Plaintiffs failed to submit a separate statement certifying that Plaintiffs’ counsel made a reasonable effort to reach agreement with Firestone on this matter as required by Local Rule 37.1. While it would be well within the Court’s discretion to require strict compliance with the local rules, the Court opts instead to assess the merits of this issue rather than dispose of this matter on procedural grounds. *See Fisher v. National Railroad Passenger Corporation*, 152 F.R.D. 145, 149 (S.D. Ind. 1993) (“[W]here a previous error is the result of negligence or other nonculpable conduct...the dispute is better decided on the merits than on procedural grounds.”).

II. Discussion.

Plaintiffs move to compel responses to their non-party subpoena under Federal Rule 45(c)(2)(B), which provides that “if objection has been made, the party serving the subpoena may, upon notice to the person commanded to produce, move at any time for an order to compel the production.” Rule 45 mandates that “such an order to compel production shall protect any person who is not a party or an officer of a party from significant expense resulting from the inspection and copying commanded.” Fed. R. Civ. P. 45(c)(2)(B). A district court may limit the scope of discovery if “the discovery sought is unreasonably cumulative or duplicative, or is obtainable from some other source that is more convenient, less burdensome, or less expensive.” Fed. R. Civ. P. 26(b)(2); *see also Cook, Inc. v. Boston Scientific Corp.*, 2002 WL 406977, at *1 (N.D. Ill. 2002) (“Discovery may be limited if the court determines it is unreasonably cumulative or duplicative, or if the burden or expense of the proposed discovery outweighs its likely benefit.”) (internal quotations omitted). “It has consistently been held that ‘non-party status’ is a significant factor to be considered in determining whether the burden imposed by a subpoena is undue.” *United States v. Amerigroup Illinois, Inc.*, 2005 WL 3111972, at *4 (N.D. Ill. Oct. 21, 2005).

Plaintiffs’ chief contention -- that Firestone’s objections are not appropriately substantiated -- could easily be levied against Plaintiffs’ arguments as well. In this case, the request is unduly burdensome on its face and the Plaintiffs’ statements in support of their motion

actually undermine any assertion that the discovery is relevant to the instant litigation.³

To determine whether a Rule 45 subpoena is unduly burdensome, a court may weigh a number of factors including “relevance, the need of the party for the documents, the breadth of the document request, the time period covered by it, the particularity with which the documents are requested, and the burden imposed.” *The Goodyear Tire & Rubber Co. v. Kirk’s Tire & Auto Servicenter of Haverstraw, Inc.*, 211 F.R.D. 658, 662-63 (D. Kan. 2003). In this case, Plaintiffs subpoena casts a wide net encompassing any and all documents in any form concerning communication or business transactions between non-party Firestone, Defendant, and any of their respective affiliates over a seven-year period. In both of their briefs, Plaintiffs advocate that their offer to pay all reasonable costs of compliance with the subpoena nullifies any possible burden to Firestone. [JAMS Docket Nos. 2, 13.] Plaintiffs’ offer misses its legal mark because “expense is but a part of the burden.” *Amerigroup Illinois*, 2005 WL 3111972 at *4.

Plaintiffs fail to adequately explain exactly how this information is reasonably calculated to lead to discovery of admissible evidence. Plaintiffs’ statements to the Court that they seek the information to support a claim of contributory negligence and other potential amended claims against Firestone [JAMS Docket No. 2, p. 6] belie any contention that the request was designed to reap relevant evidence for use in the pending litigation as presently postured. As such,

³ Based on the paucity of information concerning the requested documents, the Court does not endeavor to assess whether this request implicates trade secrets or other confidential materials. Instead, the Court bases its decision on the undue burden to the non-party in this matter and Plaintiffs’ lack of verification that the information is unavailable through any other source. Nonetheless, it is not difficult to imagine that this request could reach trade secrets and confidential information for which Plaintiffs have not demonstrated the requisite relevance and specific need. *See Pioneer Hi-Bred International Inc., v. Holden’s Foundation Seeds, Inc.*, 105 F.R.D. 76, 82 (N.D. Ind. 1985).

Plaintiffs' request cannot stand.

Plaintiffs vastly understate the obvious burden their subpoena imposes on Firestone. For instance, Plaintiffs state, "Plaintiffs have requested documents showing Firestone's business dealings with a small, family owned company, that has one location and buys a limited number of components, going back only to the late 1990's." [JAMS Docket No. 13, p. 3.] Such statements do nothing to demonstrate the lack of burden on Firestone. If anything, these statements suggest that Plaintiffs should seek alternative means of discovery. Given its breadth and lack of specificity or relevance to any claims pending in the underlying lawsuit, this subpoena facially poses an undue burden on Firestone. *See Heidelberg Americas, Inc. v. Tokyo Kikai Seisakusho, LTD*, 333 F.3d 38, 42 (1st Cir. 2003) (subpoena requesting any and all documents relating to business between plaintiff and a non-party over a ten-year span of time was unduly burdensome).

Plaintiffs' reasoning foreshadows another basis for denying their motion. Plaintiffs seem to concede, implicitly at least, that the information they seek may be available from Defendant. While Plaintiffs represent that they served discovery requests and followed up in writing when no response was received, they do not state that they moved to compel the production of this information from the adversarial party Defendant. Absent such assurance of unavailability of this information from this less burdensome source, this Court is reluctant to allow the Plaintiffs to jettison the burden of production on a non-party, however potentially adversarial that non-party may ultimately prove to be to Plaintiffs. *See Bada Company v. Montgomery Ward & Co.*, 32 F.R.D. 208, 209-10 (S.D. Ca. 1963) (non-parties to the action "should not be burdened with the annoyance and expense of producing the documents sought unless the plaintiff is unable to

discover them from the defendant”).

III. Conclusion.

Plaintiffs’ expansive subpoena poses an undue burden on a non-party and seeks information that may be obtainable from some other source that is more convenient, less burdensome, or less expensive. Accordingly, the Court DENIES Plaintiffs’ motion to compel [JAMS Docket No. 1] Firestone’s response to Plaintiffs’ November 10, 2005, subpoena.

So ordered.

DATED this ____ day of March, 2006.

Tim A. Baker
United States Magistrate Judge
Southern District of Indiana

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