Tennessee Law Review

Volume 81
Issue 1 *Fall 2013*

Article 3

2013

DEPOSITIONS OF OTHER LAWYERS

Douglas R. Richmond

DEPOSITIONS OF OTHER LAWYERS

DOUGLAS R. RICHMOND*

I. INTRODUCTION 47
II. THE *SHELTON* TEST FOR PERMITTING DEPOSITIONS OF OTHER LAWYERS 51
A. *The* Shelton *Decision and its Subsequent Acceptance* 51
B. Shelton's *Limits* 63
III. THE ALTERNATIVE APPROACH 68
IV. THE SPECIAL CASE OF PATENT LITIGATION 73
V. CONCLUSION 77

I. INTRODUCTION

Fact witness depositions are a fundamental aspect of civil litigation. But what of the situation where the intended deponent is a lawyer with some relationship to the case?

Assume, for example, that you are defending a sporting goods manufacturer in a patent infringement action in which the plaintiff alleges that football pads sold by your client infringe a patent on football pads the plaintiff holds. Your client is defending in part on the basis that the patent is unenforceable by virtue of the plaintiff's inequitable conduct before the United States Patent and Trademark Office (PTO). In particular, your client contends that the plaintiff's litigation counsel, who also prosecuted the patent-in-suit, deliberately failed to disclose prior art references to the PTO with the intent to deceive.[1] You therefore subpoena the plaintiff's lawyer to appear for a deposition. The plaintiff moves to quash the subpoena, arguing that the deposition would reveal attorney–client privileged information and impose an undue burden.[2] What result?[3]

---

* Managing Director, Aon Professional Services, Chicago, Illinois. J.D., University of Kansas; M.Ed., University of Nebraska; B.S., Fort Hays State University. Opinions expressed here are the author's alone.

1. The validity of a patent may be challenged on the basis that "what is claimed in the patent is not novel because it would have been obvious from the prior art at the time of the 'invention' to one of ordinary skill in the art." JAMES M. AMEND, PATENT LAW: A PRIMER FOR FEDERAL DISTRICT COURT AND MAGISTRATE JUDGES 4 (2d ed. 2006) (footnote omitted). "Prior art" describes the state of knowledge in the field of the invention at the time the invention was created and which skilled practitioners in the art are presumed to know. *Id.*

2. *See* FED. R. CIV. P. 45(c)(3)(A) (specifying when a court must quash a subpoena on a timely motion).

Alternatively, pretend for a moment that you are defending a liability insurer in an equitable garnishment case in a Missouri court. The case arises out of a consent judgment between the plaintiff and the insured in an underlying tort action. The plaintiff's lawyer in the equitable garnishment proceeding also represented the plaintiff in the tort action and conceived, negotiated, and prepared the consent judgment. You believe that the consent judgment is unreasonable in amount, as well as collusive and fraudulent, and that it is therefore unenforceable against the insurer. Under Missouri law, you bear the burden of proving these defenses at trial.[4] When other discovery efforts aimed at developing related evidence are unrevealing, you subpoena the plaintiff's lawyer to sit for a deposition to probe the circumstances surrounding the consent judgment. The plaintiff moves for a protective order preventing the deposition.[5] Again, what result?[6]

Finally, assume you are a member of a team at your law firm defending your client in major employment litigation. You have coordinated the electronic discovery aspects of the case, including crafting the client's searches for electronically-stored information (ESI), organizing the review of thousands of electronic documents collected for responsiveness, and ensuring that all arguably privileged communications found in the ESI are culled and appropriately logged before any information is produced to the plaintiffs. The plaintiffs' lawyer believes that your client is wrongfully withholding discoverable information and has, in fact, destroyed responsive documents. Knowing your role in the case, the plaintiffs' lawyer writes the partner at your firm who is leading the representation to request a date for your deposition. Will the court permit the plaintiffs to depose you?[7]

---

3. This example is based on *Ed Tobergte Associates Co. v. Russell Brands, LLC*, 259 F.R.D. 550 (D. Kan. 2009). The court denied the plaintiff's motion to quash the subpoena, thus permitting the deposition of the plaintiff's lawyer. *Id.* at 560.

4. Gulf Ins. Co. v. Noble Broad., 936 S.W.2d 810, 816 (Mo. 1997).

5. *See* MO. SUP. CT. R. 56.01(c)(1) (stating that a court may order that discovery "not be had" in order to "protect a party or person from annoyance, embarrassment, oppression, or undue burden or expense").

6. On these limited facts, the court should permit the deposition. Pamida, Inc. v. E.S. Originals, Inc., 281 F.3d 726, 729–31 (8th Cir. 2002) (differentiating between depositions of lawyers regarding their work in a prior case versus a pending case).

7. The answer likely is "no." *See* Shelton v. Am. Motors Corp., 805 F.2d 1323, 1327–30 (8th Cir. 1986) (refusing to permit the deposition of the defendant's in-house litigation counsel in a case involving paper records rather than ESI).

Rules of civil procedure permit depositions of other lawyers, including depositions of opposing counsel in litigation.[8] In cases where a lawyer's conduct is the basis of a party's claim or defense, it is often reasonable to expose the lawyer to examination much as any other fact witness.[9] Lawyers who are fact witnesses to key events are reasonably subject to deposition in many cases.[10] Yet courts generally disfavor depositions of opposing counsel.[11] Depositions of opposing counsel may prolong the litigation and increase its cost, cause delays to resolve work-product immunity and attorney–client privilege objections, distract the lawyer to be deposed from the client's representation, and discourage parties from communicating openly with their lawyers.[12] Depositions of opposing counsel may be

---

8. *See, e.g.*, FED. R. CIV. P. 30(a)(1) (providing that a party may "depose *any* person") (emphasis added); *cf.* LA. CODE CIV. PROC. ANN. art. 1452(b) (West 2005) (stating that "[n]o attorney of record representing the plaintiff or the defendant shall be deposed except under extraordinary circumstances and then only by order of the district court after contradictory hearing").

9. Cascone v. Niles Home for Children, 897 F. Supp. 1263, 1267 (W.D. Mo. 1995); Johnston Dev. Grp. v. Carpenters Local Union No. 1578, 130 F.R.D. 348, 352 (D.N.J. 1990).

10. *See, e.g.*, Younger Mfg. Co. v. Kaenon, Inc., 247 F.R.D. 586, 588–89 (C.D. Cal. 2007) (permitting the deposition of the defendant's general counsel where the general counsel was a percipient witness and his deposition was the only way the plaintiff could obtain relevant information in time to respond to the defendant's summary judgment motion).

11. *See, e.g.*, Nguyen v. Excel Corp., 197 F.3d 200, 209 (5th Cir. 1999) (stating that "depositions of opposing counsel are disfavored generally"); Harter v. CPS Sec. (USA), Inc., No. 2:12-cv-00084-MMD-PAL, 2013 WL 129418, at *8 (D. Nev. Jan. 9, 2013) (citing Tailored Lighting, Inc v. Osram Sylvania Prods., 255 F.R.D. 340, 344 (W.D.N.Y. 2009)); Hughes v. Sears, Roebuck & Co., Civ. Action No. 2:09-cv-93, 2011 WL 2671230, at *4 (N.D. W. Va. July 7, 2011) (quoting M&R Amusements Corp. v. Blair, 142 F.R.D. 304, 305 (N.D. Ill. 1992) ("Deposing an opponent's attorney is a drastic measure that is infrequently proper."); Sterne Kessler Goldstein & Fox, PLLC v. Eastman Kodak Co., 276 F.R.D. 376, 380 (D.D.C. 2011) (observing reluctance to permit depositions of opposing counsel among federal courts); Melendrez v. Superior Court, 156 Cal. Rptr. 3d 335, 342 n.12 (Cal. Ct. App. 2013) (quoting Carehouse Convalescent Hosp. v. Superior Court, 50 Cal. Rptr. 3d 129, 131 (Cal. Ct. App. 2006)); McMurry v. Eckert, 833 S.W.2d 828, 830–31 (Ky. 1992) (reasoning that while depositions of opposing lawyers are sometimes necessary, "the potential for harm to the administration of justice is too great to permit such a practice routinely"); Club Vista Fin. Servs., L.L.C. v. Eighth Judicial Dist. Court, 276 P.3d 246, 250 (Nev. 2012) (quoting Theriot v. Parrish of Jefferson, 185 F.3d 477, 491 (5th Cir. 1999)).

12. *Club Vista Fin. Servs., L.L.C.*, 276 P.3d at 249 (citing *Shelton*, 805 F.2d at 1327); *see also Sterne Kessler Goldstein & Fox, PLLC*, 276 F.R.D. at 380–81 (identifying related concerns even when depositions of opposing counsel are limited to relevant, non-privileged information).

a backdoor method of learning the opponent's litigation strategy or obtaining otherwise protected information.[13] Deposing other lawyers may be an effective means of harassing them and the parties they represent.[14] When sought for illegitimate or improper purposes, depositions of other lawyers are weapons—not discovery. For example, a deposition may be a litigation tactic intended to disqualify the opposing lawyer as trial counsel under the advocate–witness rule.[15] As one court colorfully summarized many of these worries, "a party shouldn't be able to use a deposition to sucker-punch the other side's quarterback or listen in on the other side's huddle."[16]

These widespread concerns have had no obvious chilling effect. Attempts to depose opposing counsel are more common than many lawyers might anticipate; there are scores of cases on the subject. And, despite courts' uneasiness regarding depositions of other lawyers, such discovery is periodically required.[17] Indeed, for all their expressions of concern about potential problems that accompany depositions of opposing counsel and the studied caution with which they approach such requests, courts "countenance depositions of even litigation counsel" in appropriate situations.[18]

This Article explores the ground rules for depositions of other lawyers. It begins in Part II with a discussion of the leading case on

---

13. *In re* Subpoena Issued to Dennis Friedman, 350 F.3d 65, 70 (2d Cir. 2003) (citing *Shelton*, 805 F.2d at 1327).

14. *See* Kerr v. Able Sanitary & Envtl. Servs., Inc., 684 A.2d 961, 965 (N.J. Super. Ct. App. Div. 1996) (noting that depositions of opposing counsel "frequently interfere" with litigation "by inviting delay, disruption, harassment, and perhaps even disqualification").

15. *See* MODEL RULES OF PROF'L CONDUCT R. 3.7(a) (2013) (providing that a lawyer "shall not act as an advocate at a trial in which the lawyer is likely to be a necessary witness" except in three circumstances).

16. Cascone v. Niles Home for Children, 897 F. Supp. 1263, 1267 (W.D. Mo. 1995).

17. *See, e.g.*, Kleiman *ex rel.* Kleiman v. Jay Peak, Inc., Civil Action No. 1:10-cv-83, 2012 WL 2498872, at *6 (D. Vt. June 27, 2012) (permitting deposition of lawyer concerning his acquisition of documentary evidence); Carr v. Double T Diner, 272 F.R.D. 431, 435 (D. Md. 2010) (permitting the deposition of the defendant's regular employment counsel in a sexual harassment case where the lawyer handled the defendant's employment practices training, investigated harassment complaints for it, and knew of internal controls of the defendant relevant to one of the plaintiff's claims); Sorenson v. Riffo, Civil No. 2:06-CV-749 TS, 2008 WL 2465454, at *5–6 (D. Utah June 16, 2008) (permitting deposition of lawyer regarding alleged offers to invest in client's business after client waived the attorney–client privilege).

18. EDNA S. EPSTEIN, THE ATTORNEY-CLIENT PRIVILEGE AND THE WORK-PRODUCT DOCTRINE 1335 (5th ed. 2007).

the subject, *Shelton v. American Motors Corp.*,[19] and its three-part test for permitting depositions of opposing counsel. Part II also examines related case law and the limits of the *Shelton* test. Part III discusses the alternative "flexible approach to lawyer depositions" outlined by the Second Circuit in *In re Subpoena Issued to Dennis Friedman*.[20] Finally, Part IV concentrates on the special need to depose opposing lawyers in patent litigation. Lawyers who prosecute patents-in-suit must often submit to depositions in litigation to enforce those patents in which they are trial counsel.[21]

II. THE *SHELTON* TEST FOR PERMITTING DEPOSITIONS OF OTHER LAWYERS

A. *The* Shelton *Decision and its Subsequent Acceptance*

Shelton v. American Motors Corp.[22] is the leading case on the permissibility of deposing other lawyers. *Shelton* was a product liability action.[23] Colletta Shelton was killed when her Jeep overturned on an Arkansas road.[24] American Motors Corp. (AMC) manufactured the Jeep.[25] Shelton's parents sued AMC in a case plagued by discovery disputes.[26] Following a dispute over the depositions of six corporate representatives that AMC produced pursuant to Federal Rule of Civil Procedure 30(b)(6),[27] the plaintiffs noticed the deposition of Rita Burns, an in-house lawyer at AMC who was supervising the defense of the case.[28] AMC sought a protective order and moved to quash the deposition notice.[29] The

---

19. 805 F.2d 1323 (8th Cir. 1986).

20. 350 F.3d 65, 72 (2d Cir. 2003).

21. David Hricik, *How Things Snowball: The Ethical Responsibilities and Liability Risks Arising from Representing a Single Client in Multiple Patent-Related Representations*, 18 GEO. J. LEGAL ETHICS 421, 460 (2005); *see also* Scott Tolchinsky, *Deposition of Opposing Counsel in Patent Litigation*, 19 GEO. J. LEGAL ETHICS 993, 993 (2006) (noting "the widespread acceptance by courts of the practice of deposing opposing counsel" in patent litigation).

22. 805 F.2d 1323 (8th Cir. 1986).

23. *Id.* at 1324.

24. *Id.*

25. *Id.*

26. *Id.* at 1324–35.

27. FED. R. CIV. P. 30(b)(6) (specifying a procedure by which a party may name as a deponent a corporation, partnership, association, government agency, or other entity and describe matters for examination; the deponent then designates one or more persons to testify on its behalf).

28. *Shelton*, 805 F.2d at 1325.

29. *Id.*

magistrate on the case granted AMC's protective order with respect to several Rule 30(b)(6) categories, but otherwise permitted the deposition.[30] The deposition spiraled into a dispute over attorney–client privilege and work-product issues, with Burns refusing to answer questions about her knowledge of the existence of some internal AMC documents.[31] The magistrate, who presided over Burns's deposition, overruled most of AMC's related objections.[32] Burns still refused to answer many questions.[33]

The magistrate recommended that the district court order AMC to show cause why it should not be held in contempt and have a default judgment entered against it as a sanction for its conduct at Burns's deposition.[34] The district court issued the recommended show cause order and AMC stood on the positions it took at Burns's deposition.[35] The district court granted the plaintiffs' motion for a default judgment against AMC on the issue of liability.[36] It reasoned that default was an appropriate sanction for AMC's refusal to retreat from what the court considered to be baseless attorney–client privilege and work-product doctrine objections.[37] Apparently recognizing the sensitivity of the issues, however, the court certified its order of default for immediate appeal, and AMC sought review in the Eighth Circuit.[38]

The principal issue on appeal was whether a deponent's "mere acknowledgement of the existence of corporate documents" was protected against discovery by the attorney–client privilege or work-product immunity.[39] The Eighth Circuit held that where, as in this case, "the deponent is opposing counsel and has engaged in a selective process of compiling documents from among voluminous files in preparation for litigation, the mere acknowledgement of the existence of those documents would reveal counsel's mental impressions, which are protected as work product."[40] In addition to arguing for privilege and work-product protection, however, AMC was riveted to the position that the plaintiffs' deposition of Burns

---

30. *Id.*
31. *Id.* at 1325 & n.2.
32. *Id.* at 1326.
33. *Id.* at 1325.
34. *Id.* at 1326.
35. *Id.*
36. *Id.*
37. *Id.*
38. *Id.*
39. *Id.*
40. *Id.* This has come to be known as the "selection-and-compilation" doctrine. *Ex parte* Int'l Ref. & Mfg. Co., 959 So. 2d 1084, 1089–90 (Ala. 2006).

was an improper means of discovering the existence of the documents in question.[41] It was this argument that the court first addressed.[42]

The *Shelton* court noted that the boundaries of discovery had steadily expanded in recent years and that the practice of deposing opposing counsel had become an increasingly popular discovery vehicle.[43] The Federal Rules of Civil Procedure permit such depositions.[44] Nonetheless, the court viewed depositions of opposing counsel as a negative development and as a tactic that litigants should employ "only in limited circumstances."[45] The court explained its concerns:

> Undoubtedly, counsel's task in preparing for trial would be much easier if he could dispense with interrogatories, document requests, and depositions of lay persons, and simply depose opposing counsel in an attempt to identify the information that opposing counsel has decided is relevant and important to his legal theories and strategy. The practice of forcing trial counsel to testify as a witness, however, has long been discouraged . . . and recognized as disrupting the adversarial nature of our judicial system. . . . Taking the deposition of opposing counsel not only disrupts the adversarial system and lowers the standards of the profession, but it also adds to the already burdensome time and costs of litigation. It is not hard to imagine additional pretrial delays to resolve work-product and attorney-client objections, as well as delays to resolve collateral issues raised by the attorney's testimony. Finally, the practice of deposing opposing counsel detracts from the quality of client representation. Counsel should be free to devote his or her time and efforts to preparing the client's case without fear of being interrogated by his or her opponent. Moreover, the "chilling effect" that such practice will have on the truthful communications from the client to the attorney is obvious.[46]

Despite these concerns, the Eighth Circuit declined to hold that opposing counsel were immune from being deposed.[47] The court recognized that some circumstances require depositions of opposing

---

41. *Shelton*, 805 F.2d at 1326–27.
42. *Id.* at 1327.
43. *Id.*
44. *Id.* (citing FED. R. CIV. P. 30(a)).
45. *Id.*
46. *Id.* (citations omitted).
47. *Id.*

counsel.[48] The court compromised by holding that those circumstances should be limited to cases in which the party seeking the deposition demonstrates that "(1) no other means exist to obtain the information than to depose opposing counsel; (2) the information sought is relevant and non-privileged; and (3) the information is crucial to preparation of the case."[49]

This case did not present these limited circumstances.[50] First, the plaintiffs could obtain the information sought from other sources or by other means, including depositions of other AMC personnel, interrogatories, and requests for production of documents.[51] In fact, the plaintiffs' lawyer had indicated that he was deposing Burns to determine whether AMC had fully responded to the plaintiffs' written discovery.[52] Second, as the court went on to hold, Burns's knowledge concerning the disputed documents was immune from discovery as work product.[53]

The *Shelton* test is straightforward. The party seeking the deposition must satisfy all three requirements.[54] If any one of the three fails—if there are other means of obtaining the information sought, *or* the information sought is irrelevant or is privileged or work product and those protections have not been waived, *or* the information is not crucial to preparation of the case—the court will preclude the deposition.[55] The third requirement actually frames the first question that a lawyer or party weighing the deposition of opposing counsel must answer. Simply stated, if the information sought is not *crucial* to the preparation of the case, neither its

---

48. *Id.*

49. *Id.* (citation omitted).

50. *Id.*

51. *Id.*

52. *Id.* at 1327–28.

53. *Id.* at 1328.

54. Chesher v. Allen, 122 F. App'x 184, 188 (6th Cir. 2005); Invesco Institutional (N.A.), Inc. v. Paas, 244 F.R.D. 374, 393 (W.D. Ky. 2007); Epling v. UCB Films, Inc., 204 F.R.D. 691, 695 (D. Kan. 2001).

55. *See, e.g.*, FDIC v. Fid. & Dep. Co. of Md., No. 3:11-cv-0019-RLY-WGH, 2013 WL 6181127, at *3 (S.D. Ind. Nov. 26, 2013) ("Because the *Shelton* test requires that all three factors be met, [the defendant's] failure to meet the first factor results in a failure of the test."); Malcolm D. Smithson & Christine B. Smithson Trusts v. Amerada Hess Corp., No. CIV 06-624 JB, 2007 WL 5685112, at *9 (D.N.M. Dec. 19, 2007) (citing Boughton v. Cotter Corp., 65 F.3d 823, 830 (10th Cir. 1995) (stating that because the plaintiffs could not meet one of the *Shelton* factors, the court would issue a protective order prohibiting the lawyer's deposition)); Stalling v. Union Pac. R.R. Co., No. 01 C 1056, 2004 WL 783056, at *3 (N.D. Ill. Jan. 23, 2004) ("Because [the plaintiff] has failed to satisfy the first *Shelton* factor, the Court need not address the remaining two factors.").

availability from other sources nor any attorney–client privilege or work-product protections matter because the court will prohibit the deposition on that ground alone.[56] The fact that information would benefit a party's case or would assist the party in preparing its case does not necessarily make it crucial.[57]

As for the first element, *Shelton* indicates that parties generally should exhaust other means of collecting the information sought before contemplating depositions of opposing counsel.[58] If any other means of acquiring the information exist—including interrogatories, requests for production of documents, requests for admissions, stipulations, depositions of other witnesses, or review of the requesting party's own records—the court will forbid the deposition, or at least delay a final ruling until the effectiveness of those alternative methods can be gauged.[59] In this way, the *Shelton* test

---

56. Cont'l Coal, Inc. v. Cunningham, No. 06-2122-KHV, 2008 WL 145245, at *4 (D. Kan. Jan. 14, 2008) (citing *Boughton*, 65 F.3d at 831).

57. Issaquena & Warren Cntys. Land Co. v. Warren Cnty., Miss. Bd. of Supervisors, Civil Action No. 5:07-cv-106-DCB-JMR, 2011 WL 6092450, at *5 (S.D. Miss. Dec. 7, 2011).

58. *But cf.* Alcon Labs., Inc. v. Pharmacia Corp., 225 F. Supp. 2d 340, 343 (S.D.N.Y. 2002) (stating that the party seeking the lawyer's deposition did not have to exhaust "every available avenue for the testimony" where "certain information [was] exclusively within [the lawyer's] knowledge and interrogatories [were] arguably unavailable since [the lawyer was] not a party to [the] action").

59. *See, e.g.*, Alomari v. Ohio Dep't of Pub. Safety, Civil Action No. 2:11-cv-00613, 2013 WL 5180811, at *6 (S.D. Ohio Sept. 13, 2013) (refusing to permit counsel's deposition where the information to be obtained was available from other witnesses); Ford Motor Co. v. Nat'l Indem. Co., Civil Action No. 3:12cv839, 2013 WL 3831438, at *1 (E.D. Va. July 23, 2013) (refusing lawyer's deposition where the information sought had been obtained from other deponents); Buth v. AAA Allied Grp., Inc., Civil Action No. 12-CV-1223-JWL-DJW, 2013 WL 1308543, at *4 (D. Kan. Mar. 28, 2013) (refusing to permit the defendant to depose a corporate representative of the plaintiff's law firm where the information sought potentially was available from other sources and was not crucial anyway); Harter v. CPS Sec. (USA), Inc., No. 2:12-cv-00084-MMD-PAL, 2013 WL 129418, at *8 (D. Nev. Jan. 9, 2013) (refusing lawyer's deposition because the plaintiffs did not show that they had "no other means to obtain the information" sought from the lawyer); Chao v. Aurora Loan Servs., LLC, No. C 10-3118 SBA (LB), 2012 WL 5988617, at *5 (N.D. Cal. Nov. 26, 2012) (quashing subpoena where the defendant's "own records combined with what it ha[d] from Plaintiffs already provide[d] a sufficient avenue for [the defendant] to obtain the information it need[ed]"); Riverbank Holding Co. v. N.H. Ins. Co., No. 2:11-cv-02681-WBS-GGH, 2012 WL 4748047, at *3–4 (E.D. Cal. Oct. 3, 2012) (refusing to permit lawyer's deposition when information was available from other witnesses); Memory Bowl v. N. Pointe Ins. Co., 280 F.R.D. 181, 186–87 (D.N.J. 2012) (ordering the plaintiff to try alternative means of obtaining the information sought through the proposed deposition of the lawyer and inviting the plaintiff to raise any

tracks the case law that has developed around the professional responsibility ban on lawyers who are likely to be necessary witnesses at trial also serving as trial counsel,[60] which holds that lawyer witnesses should not be disqualified as trial counsel if the same evidence can be obtained from other sources.[61] Courts and lawyers must distinguish, however, between cases in which other witnesses may be able to testify about what a lawyer said and offer their impressions of those statements, and cases in which a lawyer's thought processes are at issue (and therefore are not immune from discovery as work product). In the latter instance, the lawyer's deposition probably will be permitted.[62]

Importantly, the fact that a party establishes all three elements of the *Shelton* test does not guarantee that a court will permit it to depose an opposing lawyer. In appropriate cases, courts may exercise their discretion and prohibit depositions of opposing counsel, even when the party requesting the deposition has established all of the *Shelton* elements.[63] For example, timing issues, extraordinary expense concerns, or other case-specific considerations might counsel against ordering a lawyer's otherwise permissible deposition.

Critics of the *Shelton* test complain that the first element, i.e., the "no other means" requirement, may impose unreasonable expense or inconvenience on the party requesting the deposition.[64] The mandate that the party seeking the lawyer's deposition demonstrate that the information sought is not privileged or protected as work product is allegedly flawed because it shifts the traditional burden of proof on attorney–client privilege and work-

---

remaining concerns with the court after exhausting the other avenues of discovery). *But see* Munn v. Bristol Bay Hous. Auth., 777 P.2d 188, 195–96 (Alaska 1989) (rejecting this approach).

60. *See* MODEL RULES OF PROF'L CONDUCT R. 3.7(a) (2013) (stating that a lawyer "shall not act as an advocate at a trial in which the lawyer is likely to be a necessary witness" except in three circumstances).

61. DOUGLAS R. RICHMOND ET AL., PROFESSIONAL RESPONSIBILITY IN LITIGATION 579 (2011) (explaining that a lawyer is not likely to be a necessary witness at trial if there are other sources of the same evidence).

62. *See, e.g.*, Ricoh Co. v. OKI Data Corp., C.A. No. 09-694-SLR, 2011 WL 3563142, at *2 (D. Del. Aug. 15, 2011) (permitting lawyer's deposition while noting that proper attorney–client objections could be made during the deposition and that the lawyer could refuse to answer questions calling for privileged information).

63. Simmons Foods, Inc. v. Willis, 191 F.R.D. 625, 630 (D. Kan. 2000) (citing Boughton v. Cotter Corp., 65 F.3d 823, 829–31 (10th Cir. 1995)).

64. *See, e.g.*, Timothy Flynn, Jr., Note, *On "Borrowed Wits": A Proposed Rule for Attorney Depositions*, 93 COLUM. L. REV. 1956, 1977 (1993) (asserting that this element of the *Shelton* test "places an onerous burden on the party seeking to depose the opponent's attorney").

product issues, reallocating it from the party asserting those protections to the party seeking the lawyer's deposition.[65] In addition, it arguably "reverses the traditional practice of requiring that any objections of privilege be made and resolved during the regular course of the deposition."[66] Finally, the requirement that a lawyer's testimony be crucial to the preparation of the case is faulted for being "unclear in its content and application."[67] The criticism of this element for its lack of clarity is actually two-fold. First, no two lawyers, nor a court and a lawyer, are likely to agree on whether testimony is crucial.[68] Second, whether a lawyer's testimony is crucial can be difficult to evaluate in the early stages of litigation.[69] None of these criticisms are fatal.

With respect to the potential burden or expense that may accompany the pursuit of alternative means of discovery, the *Shelton* court inferentially concluded as a policy matter that the ills attending depositions of opposing counsel outweigh the hardships other forms of discovery may impose on the requesting party. That is a reasonable conclusion, but it is by no means unanimous among courts.[70] Indeed, some courts have modified this aspect of the *Shelton* test to require that alternative means of obtaining the information sought through a lawyer's deposition be "practical" or "practicable."[71]

Critics' claim that *Shelton* reallocates the burden of proof on attorney–client privilege and work-product objections, and flips the settled practice of requiring that such objections be made during the deposition, evidences a bit of a misunderstanding. Consider the usual order of events: the party seeking the lawyer's deposition (the defendant in the following illustration) either sends a deposition

---

65. *Id.* at 1979–80.

66. *Id.* at 1978.

67. *Id.* at 1979.

68. *Id.* at 1980.

69. *Id.*

70. *See, e.g.*, qad.inc v. ALN Assocs., Inc., 132 F.R.D. 492, 494 (N.D. Ill. 1990) (stating that the exhaustion of all other possible means of discovery before deposing a lawyer "would be less efficient, more expensive, more time consuming—in short, it would have all the vices that we tend to associate with the present pattern of overextensive discovery that is constantly (and justifiably) decried in litigation today," and thus rejecting the *Shelton* test in permitting a lawyer's deposition).

71. *See, e.g.*, W. Peninsular Title Co. v. Palm Beach Cnty., 132 F.R.D. 301, 302 (S.D. Fla. 1990) ("The party seeking a deposition must demonstrate that the deposition is the only practical means available of obtaining the information."); Carehouse Convalescent Hosp. v. Superior Court, 50 Cal. Rptr. 3d 129, 132 (Cal. Ct. App. 2006) (requiring that that there be no other "practicable means to obtain the information").

notice to its opponent (the plaintiff here) or subpoenas opposing counsel (the plaintiff's lawyer). In response, the plaintiff moves for a protective order or moves to quash the notice or subpoena on attorney–client privilege or work-product immunity grounds. In its motion papers, the plaintiff will articulate the factual and legal bases for its privilege or work-product claims. That sequence of events reflects the normal allocation of the burden of proof in attorney–client privilege and work-product immunity disputes.[72] The defendant will then argue why the information it seeks through the deposition of the plaintiff's lawyer is not privileged or does not constitute work product, or argue that those protections have somehow been waived (in addition to explaining why the other two elements of the *Shelton* test are satisfied).[73] The defendant may promise to avoid arguably protected subjects if the court permits the deposition. The plaintiff probably will file a reply. If the defendant makes a prima facie showing that the information sought is neither privileged nor work product, and the other two *Shelton* elements are satisfied, the court will permit the defendant to depose the plaintiff's lawyer with the understanding that the plaintiff should object to specific questions, which, if answered, would elicit confidential information.[74] This is logical because the court cannot rule in a vacuum.[75] If the plaintiff objects to questions on privilege or work-product grounds at the deposition, the court can then rule on those objections.[76] This is normal deposition procedure and again describes ordinary burden shifting or something close to it. In any event, any deviation from normal burden shifting is sufficiently minor to mute any related criticism of the *Shelton* test.

Regarding the vagueness of the characterization of particular evidence as crucial, the importance of a lawyer's testimony will in the first instance be determined by the trial court. Trial judges make similar calls every time they rule on the relevance of evidence, or

---

72. *See* EPSTEIN, *supra* note 18, at 810 (stating that under federal common law, parties invoking attorney–client privilege and work-product immunity bear the burden of proof).

73. *See, e.g.*, Ed Tobergte Assocs. Co. v. Russell Brands, LLC, 259 F.R.D. 550, 558–59 (D. Kan. 2009) (explaining the adequacy of the defendant's showing in seeking to depose the plaintiff's lawyer in a patent infringement action).

74. *Id.* at 559.

75. Alcon Labs., Inc. v. Pharmacia Corp., 225 F. Supp. 2d 340, 344 (S.D.N.Y. 2002) (quoting *In re* Arthur Treacher's Franchise Litig., 92 F.R.D. 429, 438 (E.D. Pa. 1981)); *see also Ed Tobergte Assocs. Co.*, 259 F.R.D. at 559 (observing that it would be "premature" to rule on objections to questions that have yet to be asked).

76. *Alcon Labs., Inc.*, 225 F. Supp. 2d at 344; *Ed Tobergte Assocs. Co.*, 259 F.R.D. at 559.

decide whether the prejudicial effect of evidence outweighs its probative value. Disagreement over the importance of particular testimony is a natural part of trial practice. With respect to timing, lawyers' depositions are rarely sought unless and until other avenues of discovery are determined to be unproductive. Although that is not uniformly true, from an overall perspective, timing is not the problem critics make it out to be.

Whether because of its simplicity or because it feeds into courts' established dislike of depositions of opposing counsel, the *Shelton* test has been widely accepted and employed by federal and state courts alike.[77] The Nevada Supreme Court recently embraced the

---

77. *See, e.g.*, Nationwide Mut. Ins. Co. v. Home Ins. Co., 278 F.3d 621, 628 (6th Cir. 2002); Thiessen v. Gen. Elec. Capital Corp., 267 F.3d 1095, 1112 & n.15 (10th Cir. 2001) (noting that the Tenth Circuit adopted the *Shelton* test in Boughton v. Cotter Corp., 65 F.3d 823, 830 (10th Cir. 1995)); *Boughton*, 65 F.3d at 830; Sparton Corp. v. United States, 44 Fed. Cl. 557, 560–66 (1999); Ford Motor Co. v. Nat'l Indem. Co., Civil Action No. 3:12cv839, 2013 WL 3831438, at *2 (E.D. Va. July 23, 2013) (noting that the Fourth Circuit has not adopted the *Shelton* test but concluding that *Shelton* "supplie[d] the proper rule"); Rygg v. Hulbert, No. C11-1827JLR, 2013 WL 264762, at *2 (W.D. Wash. Jan. 23, 2013) (refusing to permit deposition because the plaintiffs had not satisfied the *Shelton* factors); Melaleuca, Inc. v. Bartholomew, No. 4:12-cv-00216-BLW, 2012 WL 3544738, at *2–3 (D. Idaho Aug. 16, 2012) (applying the *Shelton* test and noting that other district courts in the Ninth Circuit have agreed that it is sound); Issaquena & Warren Cntys. Land Co. v. Warren Cnty., Miss. Bd. of Supervisors, Civil Action No. 5:07-cv-106-DCB-JMR, 2011 WL 6092450, at *4–5 (S.D. Miss. Dec. 7, 2011) (noting, however, that the Fifth Circuit has not expressly adopted *Shelton*); Nat'l W. Life Ins. Co. v. W. Nat'l Life Ins. Co., Cause No. A-09-CA-711 LY, 2010 WL 5174366, at *2–4 (W.D. Tex. Dec. 13, 2010); Powers v. Bd. of Trs. of the Univ. of Ill., No. 08-CV-2267, 2010 WL 3834441, at *3–4 (C.D. Ill. Sept. 23, 2010) (following *Shelton* and explaining that while neither the Seventh Circuit nor the Supreme Court have adopted the *Shelton* test, numerous district courts in the Seventh Circuit have employed it); Villaflor v. Equifax Info., No. C-09-00329 MMC (EDL), 2010 WL 2891627, at *1–3 (N.D. Cal. July 22, 2010) (noting, however, that the Ninth Circuit has not adopted *Shelton*); *Ex parte* Indus. Dev. Bd. of Montgomery, 42 So. 3d 699, 712 (Ala. 2010); Spectra-Physics, Inc. v. Superior Court, 244 Cal. Rptr. 258, 263 (Cal. Ct. App. 1988); Cole v. Mousavi, 1990 WL 63945, at *2 (Del. Super. Ct. Jan. 18, 1990); *In re* Marriage of Baumgartner, 890 N.E.2d 1256, 1280 (Ill. App. Ct. 2008); Club Vista Fin. Servs., L.L.C. v. Eighth Judicial Dist.Court, 276 P.3d 246, 247, 250 (Nev. 2012); Blue Ridge Pediatric & Adolescent Med., Inc. v. First Colony Healthcare, LLC, No. 11 CVS 127, 2012 WL 3249553, at *11 (N.C. Super. Ct. Aug. 9, 2012) (noting that although *Shelton* was not binding authority, it offered guidance and its application was appropriate); Harter v. Plains Ins. Co., 579 N.W.2d 625, 631–32 (S.D. 1998) (citing Cascone v. Niles Home for Children, 897 F. Supp. 1263, 1265 (W.D. Mo. 1995)).

Shelton test in *Club Vista Financial Services, L.L.C. v. Eighth Judicial District Court.*[78]

Club Vista arose out of a failed real estate venture.[79] Club Vista and two constituents, Gary Tharaldson and Tharaldson Motels II, embarked on a real estate development project called Manhattan West with several counterparties known collectively as Scott Financial.[80] When a multi-million dollar loan funded by Scott Financial and guaranteed by Tharaldson and Tharaldson Motels II went into default, Club Vista engaged lawyers Layne Morrill and Martin Aronson "to determine whether legal action was warranted."[81] Based on their investigation, Morrill and Aronson sued Scott Financial on Club Vista's behalf, alleging that Scott Financial "had failed to ensure that certain pre-funding conditions were satisfied before advancing money on the loan.[82] In its initial disclosures, Club Vista identified Morrill "as a person who 'may have discoverable information related to dealings between Scott Financial and Tharaldson and related companies.'"[83]

Scott Financial deposed Tharaldson, who testified that he had almost no personal knowledge of the facts alleged in Club Vista's complaint, nor did he know of anyone other than Morrill and Aronson who might have such knowledge.[84] Tharaldson further testified that he and two of his employees, Ryan Kucker and Kyle Newman, were the Club Vista witnesses who would have personal knowledge of the Manhattan West project.[85] Scott Financial then deposed Kucker and Newman, who denied any personal knowledge of the facts alleged in Club Vista's complaint.[86]

Frustrated by Tharaldson's, Kucker's, and Newman's ignorance, Scott Financial informed Morrill that it intended to depose him on the factual bases for the allegations in Club Vista's complaint.[87] Morrill sought a protective order preventing the deposition.[88] A discovery master recommended that Scott Financial be allowed to depose Morrill based on Tharaldson's admission that only his

78. 276 P.3d 246 (Nev. 2012).
79. *Id.* at 247.
80. *Id.*
81. *Id.*
82. *Id.*
83. *Id.* (quoting Club Vista's initial disclosures).
84. *Id.*
85. *Id.*
86. *Id.*
87. *Id.*
88. *Id.* at 248.

lawyers were familiar with the facts underlying the complaint.[89] The trial court upheld the discovery master's recommendation, reasoning that it could resolve any attorney–client privilege or work-product disputes that surfaced at the deposition, and relying on Scott Financial's assertion that it only intended to question Morrill on factual issues.[90]

Club Vista petitioned for a writ of mandamus or prohibition in the Nevada Supreme Court.[91] While the writ was pending, Club Vista replaced Morrill as counsel.[92] During oral argument before the Nevada Supreme Court, Club Vista pledged that "it would not call Morrill as a witness at trial."[93]

The *Club Vista* court recognized that depositions of opposing counsel are vulnerable to abuse and may unduly burden targeted lawyers and parties they represent.[94] The court concluded, however, that "opposing counsel should not be absolutely immune from being deposed."[95] Rather, depositions of opposing lawyers are permissible only in "exceptionally limited circumstances."[96] In so deciding, the court adopted the *Shelton* three-factor test.[97] The court then added some enhancements of its own.

> In evaluating these three factors, the [trial] court should consider whether the attorney is a percipient witness to the facts giving rise to the complaint. . . . By establishing this heightened standard when a party is attempting to depose opposing counsel, we advise litigants to resort to alternative discovery methods and discourage endeavors to seek confidential and privileged information. When the facts and circumstances are so remarkable as to allow a party to depose an opposing party's counsel, the [trial] court should provide specific limiting instructions to ensure that the parties avoid improper disclosure of protected information.[98]

Because neither the discovery master nor the trial court employed the *Shelton* test in permitting Scott Financial to depose Morrill, the Nevada Supreme Court granted Club Vista's writ in part

---

89. *Id.*
90. *Id.*
91. *Id.*
92. *Id.*
93. *Id.*
94. *Id.* at 249–50.
95. *Id.* at 250.
96. *Id.*
97. *Id.*
98. *Id.* (footnote omitted) (citation omitted).

and remanded the case to the trial court with directions to reconsider Club Vista's motion for protective order consistent with the *Shelton* factors and its additional guidance in the opinion.[99] The *Club Vista* court further directed the trial court to consider whether Morrill had any relevant, discoverable information and whether Club Vista's withdrawal of Morrill as a trial witness affected Scott Financial's need for his deposition.[100]

Club Vista is an interesting case. At the outset, the plaintiffs invited trouble when they identified Morrill as someone with knowledge of discoverable information. Perhaps they had no choice given Tharaldson's, Kucker's, and Newman's cluelessness, but prudence dictates that lawyers not identify themselves as witnesses in matters in which they are trial counsel unless absolutely necessary.

Second, the plaintiffs' promise not to call Morrill as a witness at trial appears to have been a misjudgment. By withdrawing Morrill as a witness, they did not erase his factual knowledge and, thus, Scott Financial's alleged need to depose him; all they did was impair their ability to prove their case absent the identification of someone else to testify in his place.[101] Might not an alternative have been to designate a representative of the limited liability company (recall that Club Vista was an LLC) for deposition under Nevada Rule of Civil Procedure 30(b)(6)?[102] In federal courts, organizational representatives deposed pursuant to Federal Rule of Civil Procedure

---

99. *Id.* (noting, however, that the discovery master mentioned the *Shelton* factors).

100. *Id.* at 250–51.

101. It is no answer to say that Morrill's withdrawal as a witness was justified by the ban on lawyers acting as trial advocates in cases in which they are likely to be necessary witnesses. This is because Rule 3.7(a) of the Model Rules of Professional Conduct only disqualifies lawyers in their representational capacities—it does not prohibit their testimony as witnesses. RICHMOND ET AL., *supra* note 61, at 574. Morrill's replacement as trial counsel eliminated any potential Rule 3.7(a) problems.

102. Nevada Rule of Civil Procedure 30(b)(6) provides:

> A party may in the party's notice and in a subpoena name as the deponent a public or private corporation or a partnership or association or governmental agency and describe with reasonable particularity the matters on which examination is requested. In that event, the organization so named shall designate one or more officers, directors, or managing agents, or other persons who consent to testify on its behalf. . . . The persons so designated shall testify as to matters known or reasonably available to the organization.

NEV. R. CIV. P. 30(b)(6).

30(b)(6) need not have personal knowledge of designated subjects to testify about them on the entity's behalf.[103] If a representative does not have personal knowledge of designated subjects, the organization must prepare the designee from reasonably available sources.[104] Assuming that Nevada law tracks the federal approach, Morrill would have been able to prepare a corporate representative to testify on Club Vista's behalf and thus avoid or limit any damage to the plaintiffs' case.

B. Shelton's *Limits*

The court in *Shelton* was primarily concerned that the plaintiffs' deposition of AMC's in-house lawyer, Burns, would reveal information that was immune from discovery as work product.[105] Accordingly, courts have declined to apply *Shelton* in cases where (1) the lawyer to be deposed was not trial or litigation counsel; and (2) the lawyer's deposition would not reveal litigation strategy in the pending case.[106] As the conjunction "and" suggests, courts have required a lawyer to be both trial or litigation counsel and a source of work product for *Shelton* to apply.[107] If either element is missing, *Shelton* does not apply, and the propriety of the lawyer's deposition is evaluated just as any other witness's deposition would be.[108] But,

---

103. QBE Ins. Corp. v. Jorda Enters., Inc., 277 F.R.D. 676, 688 (S.D. Fla. 2012).

104. Brazos River Auth. v. GE Ionics, Inc., 469 F.3d 416, 433 (5th Cir. 2006).

105. Shelton v. Am. Motors Corp., 805 F.2d 1323, 1328–29 (8th Cir. 1986).

106. *See, e.g.*, Rowe v. Liberty Mut. Grp., Inc., Civ. No. 11-cv-366-JL, 2013 WL 3762662, at *7 (D.N.H. July 16, 2013) (involving an in-house lawyer who was not involved in managing the litigation); Houston Cas. Co. v. Supreme Towing Co., Civil Action No. 10-3367, 2011 WL 5326061, at *4 (E.D. La. Nov. 4, 2011) (citing United States v. Philip Morris, Inc., 209 F.R.D. 13, 17 (D.D.C. 2002)); Gulf Coast Shippers Ltd. v. DHL Express (USA), Inc., No. 2:09CV221, 2011 WL 5102270, at *1 (D. Utah Oct. 26, 2011) (permitting lawyer's deposition); Sterne Kessler Goldstein & Fox, PLLC v. Eastman Kodak Co., 276 F.R.D. 376, 380 (D.D.C. 2011) (citing *Philip Morris, Inc.*, 209 F.R.D. at 17).

107. *See, e.g.*, Buyer's Direct Inc. v. Belk, Inc., No. 5:10-CV-65-H, 2012 WL 3278928, at *3 (E.D.N.C. Aug. 10, 2012) (stating this two-part test conjunctively before determining that *Shelton* did not apply because the lawyer to be deposed met neither requirement); Devlyne v. Lassen Mun. Util. Dist., Civ. No. S-10-0286 MCE GGH, 2011 WL 4905672, at *2 (E.D. Cal. Oct. 14, 2011) (stating that the mere fact that a lawyer was formerly a party's general counsel does not implicate *Shelton*); *Sterne Kessler Goldstein & Fox, PLLC*, 276 F.R.D. at 380 (reciting and applying this requirement).

108. *Shelton* does not apply where the lawyer to be deposed is a business advisor or other advisor or consultant to the party rather than its counsel. *See, e.g.*, Zimmerman v. State, 114 So. 3d 446, 447–48 (Fla. Dist. Ct. App. 2013) (permitting

because this approach may complicate discovery where the lawyer to be deposed possesses work-product information concerning the pending case even though she is not representing the party in it, some courts have instead applied these requirements in the alternative.[109] In other words, the *Shelton* test will apply if (a) the lawyer sought to be deposed is either trial or litigation counsel; *or* (b) the deposition might reveal the party's litigation strategy in the pending case.[110] This makes more sense because trial or litigation counsel are certain to know the litigation strategies of the parties they represent, thus making the second prong of the test redundant unless it can be applied separately.

Other courts have reached the same result by generously interpreting the "litigation counsel" qualifier, as *Newkirk v. ConAgra Foods, Inc.*[111] illustrates. The plaintiff in *Newkirk* alleged that he was injured as a result of inhaling the flavoring compound diacetyl used in microwave popcorn made by ConAgra.[112] Newkirk's lawyer subpoenaed the McGrath North law firm and one of its lawyers, Sandra Morar, seeking documents relating to the firm's work for ConAgra related to diacetyl, microwave popcorn, or lung disease.[113]

---

deposition of lawyer who was merely advising client regarding a related matter); Wright v. Life Investors Ins. Co. of Am., Civil Action No. 2:08-CV-03-P-A, 2009 WL 4347024, at *2–3 (N.D. Miss. Nov. 24, 2009) (permitting the deposition of lawyer who was performing both business and legal roles, and who did not qualify as opposing counsel); Advanced Tech. Incubator, Inc. v. Sharp Corp., 263 F.R.D. 395, 399–400 (W.D. Tex. 2009) (permitting deposition where lawyer appeared to be serving as a business advisor).

109. *See, e.g.*, Hughes v. Sears, Roebuck & Co., Civ. Action No. 2:09-cv-93, 2011 WL 2671230, at *5 (N.D. W. Va. July 7, 2011) ("The *Shelton* test is applicable in only two instances: 1) where trial or litigation counsel are being deposed *or* 2) where the subject matter of the deposition may elicit litigation strategy.") (emphasis added); Ellipsis, Inc. v. Color Works, Inc., 227 F.R.D. 496, 497 (W.D. Tenn. 2005) ("[T]he *Shelton* test should be limited to those instances where the attorney to be deposed is either trial/litigation counsel *or* the subject matter of the deposition may elicit litigation strategy.") (emphasis added).

110. *See, e.g.*, *Hughes*, 2011 WL 2671230, at *5 (interpreting these requirements disjunctively in refusing to permit depositions of litigation paralegals); Massillon Mgmt., LLC v. Americold Realty Trust, No. 5:08CV0799, 2009 WL 614831, at *3–6 (N.D. Ohio Jan. 21, 2009) (interpreting these requirements disjunctively in a case involving in-house counsel); *Ellipsis, Inc.*, 227 F.R.D. at 496 (treating these requirements disjunctively).

111. Nos. 8:10-cv-22-LSC-FG3, CV-08-00273-FVS, 2010 WL 2135263 (D. Neb. May 27, 2010).

112. *Id.* at *1.

113. *Id.*

The plaintiff learned of Morar from scientific reports produced by ConAgra in discovery that were prepared for McGrath North.[114]

McGrath North was not trial counsel for ConAgra in the case;[115] however, Morar had long advised ConAgra on microwave popcorn risks in anticipation of related litigation and had thereafter counseled the company in connection with such litigation once underway.[116] Morar had dealt with the scientists or consulting experts identified in the documents "to provide legal advice and to evaluate the technical information they provided in the course of giving legal advice."[117]

The court concluded that the *Shelton* test applied.[118] Although McGrath North and Morar were not representing ConAgra in Newkirk's case, they had been providing legal advice to ConAgra concerning the issues raised in the case for many years.[119] Applying *Shelton*, the court easily concluded that Morar's deposition was improper—she was not the only possible source of the information sought, and the information on which Newkirk sought to depose her was not crucial to the case.[120]

Newkirk was correctly decided. Other courts have similarly applied the *Shelton* test to lawyers who, while not trial counsel or litigation counsel in the sense that they have entered appearances in the litigation or are formally tasked with the party's representation in the case,[121] have advised a party on trial strategy to an extent that they qualify as members of the party's litigation team.[122] These courts reason that the major determinant should be the lawyer

---

114. *Id.* at *2.

115. *Id.*

116. *Id.* at *3.

117. *Id.*

118. *Id.* at *6.

119. *Id.*

120. *Id.*

121. Of course, lawyers may qualify as litigation counsel even if they never enter their appearances in cases. Guantanamera Cigar Co. v. Corporacion Habanos, S.A., 263 F.R.D. 1, 9 (D.D.C. 2009). In-house lawyers are a perfect example of this. *See, e.g.*, Massillon Mgmt., LLC v. Americold Realty Trust, No. 5:08CV0799, 2009 WL 614831, at *5–6 (N.D. Ohio Jan. 21, 2009) (quashing the deposition of the defendant's general counsel).

122. *See, e.g.*, Nat'l W. Life Ins. Co. v. W. Nat'l Life Ins. Co., Cause No. A-09-CA-711 LY, 2010 WL 5174366, at *3 (W.D. Tex. Dec. 13, 2010) (finding that a party's long-time lawyer's participation in a case qualified him as a member of the party's "litigation team"); *see also* Devlyne v. Lassen Mun. Util. Dist., Civ. No. S-10-0286 MCE GGH, 2011 WL 4905672, at *2 (E.D. Cal. Oct. 14, 2011) (recognizing that *Shelton* applies if a lawyer is "so intimately involved with the litigation that taking her deposition would be akin to deposing one's litigation counsel").

deponent's involvement in the litigation, however characterized.[123] Although this test is not always determinative, it is perhaps the truest test of whether *Shelton* should apply because it best protects against the disclosure of work product through lawyers' depositions.

On the other hand, a lawyer's immersion in the litigation in which her deposition is sought does not necessarily prevent the deposition from going forward.[124] *Shelton* does not apply where the lawyer's conduct preceded the litigation and never contemplated it.[125] The *Shelton* test is not intended to armor a lawyer who represented a client in a completed matter and then represents the same client in a current case in which information known only by the lawyer regarding the completed matter is crucial,[126] as the Eighth Circuit firmly established in *Pamida, Inc. v. E.S. Originals, Inc.*[127]

Pamida arose out of an indemnification action by Pamida against Dynasty Footwear.[128] Pamida sought indemnification for its costs incurred in defending and settling a patent infringement action brought by Susan Maxwell.[129] The law firm of Larkin, Hoffman, Daly & Lingren, Ltd. represented Pamida in Maxwell's case and in the indemnification action.[130] Dynasty sought to depose the five Larkin lawyers who defended the Maxwell case and who also represented Pamida in the present action.[131] The issues on which Dynasty sought to depose the lawyers were crucial to its defense; they included whether and how Pamida had attempted to notify Dynasty of Maxwell's lawsuit, and whether the attorneys' fees for which Pamida sought reimbursement were reasonably incurred in the defense of Maxwell's suit.[132] Pamida moved for a protective order preventing the depositions.[133] The district court denied the motion with respect

---

123. *Nat'l W. Life Ins. Co.*, 2010 WL 5174366, at *3 (quoting Murphy v. Adelphia Recovery Trust, No. 3-09-MC-105-B, 2009 WL 4755368, at *3 (N.D. Tex. Nov. 3, 2009)).

124. *See Devlyne*, 2011 WL 4905672, at *2 (explaining that *Shelton* does not apply where the lawyer is a percipient witness to facts relevant to the opponent's claim that are outside the pending litigation proceedings).

125. Boston Edison Co. v. United States, 75 Fed. Cl. 557, 561–63 (2007); Cascone v. Niles Home for Children, 897 F. Supp. 1263, 1267 (W.D. Mo. 1995).

126. *See, e.g.*, Srail v. Vill. of Lisle, No. 07 C 2617, 2007 WL 4441547, at *2 (N.D. Ill. Dec. 12, 2007) (stating this rule in permitting lawyer's deposition).

127. 281 F.3d 726 (8th Cir. 2002).

128. *Id.* at 728.

129. *Id.*

130. *Id.*

131. *Id.* at 728–29.

132. *Id.* at 729.

133. *Id.*

to testimony and documents concerning Maxwell's lawsuit but granted it with respect to testimony and documents related to the indemnification action.[134] As a result, Dynasty could depose the lawyers regarding their conduct in Maxwell's case. Pamida appealed to the Eighth Circuit.[135]

Pamida contended that *Shelton* barred the lawyers' depositions.[136] "Yes and no," said the court. It answered "yes" insofar as *Shelton* prohibited the lawyers' depositions regarding their actions and decisions in the pending indemnification case, but "no" as to their conduct in Maxwell's concluded patent infringement action.[137] As the court explained:

> The *Shelton* test was intend [sic] to protect against the ills of deposing opposing counsel in a pending case which could potentially lead to the disclosure of the attorney's litigation strategy. . . . *Shelton* was not intended to provide heightened protection to attorneys who represented a client in a completed case and then also happened to represent that same client in a pending case where the information known only by the attorneys regarding the prior concluded case was crucial.[138]

In short, the concerns raised in *Shelton* were not implicated to the extent Dynasty sought relevant information from or about the completed Maxwell suit.[139] After addressing additional issues related to the scope of the district court's ruling, the *Pamida* court affirmed the district court's decision.[140]

Finally, lawyers for organizations sometimes fill non-legal roles in addition to having legal responsibilities.[141] For example, a lawyer might serve as a company's vice president of administration, human resource director, or lobbyist in addition to functioning as its general counsel. In such instances, *Shelton* generally does not prevent the

---

134. *Id.*
135. *Id.* at 728.
136. *Id.* at 729.
137. *Id.* at 730.
138. *Id.* (citation omitted).
139. *Id.* at 731.
140. *Id.* at 733.
141. On the right facts, this combination of roles or responsibilities has the potential to complicate or confuse attorney–client privilege issues. *See generally* Todd Presnell, *A Higher Standard: Claiming Attorney–Client Privilege is Tougher for In-House Counsel*, BUS. L. TODAY, May/June 2005, at 19 (using as an example a lawyer employed by a company who holds the title "vice president & general counsel").

lawyer's deposition in her business capacity concerning non-privileged matters.[142]

III. THE ALTERNATIVE APPROACH

Although the *Shelton* test is widely recognized, not all courts apply it.[143] On the theory that the *Shelton* test is too rigid or lacks support in the Federal Rules of Civil Procedure, some courts employ a more flexible approach that considers all of the relevant facts and circumstances of the case in determining whether the intended deposition would impose an inappropriate burden or cause undue hardship.[144] *In re Subpoena Issued to Dennis Friedman*[145] leads this line of authority.

Friedman arose out of litigation over the unhappy merger of two home improvement companies, Hechinger and Builders Square.[146]

---

142. *See* Bledsoe v. Remington Arms Co., No. 1:09-CV-69 (WLS), 2010 WL 147052, at *2 (M.D. Ga. Jan. 11, 2010) (permitting the deposition of a lawyer holding the dual roles of "General Counsel and Vice President, Vice President of Marketing").

143. *See, e.g.*, Axiom Worldwide, Inc. v. HTRD Grp. Hong Kong Ltd., No. 8:11-cv-1468-T-33TBM, 2013 WL 230241, at *3–4 (M.D. Fla. Jan. 22, 2013) (adopting the *Shelton* test but then adding as a fourth factor the requirement that movant's need for the deposition outweigh the dangers of deposing the attorney); Covington v. Walgreen Co., No. 1:11-CV-22900, 2012 WL 2120776, at *3 (S.D. Fla. June 11, 2012) (reciting a four-factor test that requires the party seeking the deposition to show that (1) the deposition is the only practical means of obtaining the information; (2) the information sought will not invade the attorney–client privilege or work-product immunity; (3) the information sought is relevant and crucial to the case; and (4) the movant's needs outweigh the dangers of deposing the lawyer); Wilson v. O'Brien, No. 07 C 3994, 2010 WL 1418401, at *2 (N.D. Ill. Apr. 6, 2010) (employing an alternative approach of "flexibility and consideration of all the circumstances presented in [the] particular case"); Thomas v. Cate, No. 1:05-cv-01198-LJO-JMD-HC, 2010 WL 1343789, at *3 (E.D. Cal. Apr. 5, 2010) (finding that the *Shelton* test did not provide the "appropriate framework" for evaluating the propriety of the requested depositions "given the context of this action"); Phillips v. Indianapolis Life Ins. Co., No. 1:06-cv-1544-WTL-JMS, 2009 WL 1564384, at *3 (S.D. Ind. June 3, 2009) (rejecting *Shelton* because its "heightened burden-of-proof rule finds no support in the plain text of the Federal Rules of Civil Procedure"); United States v. Philip Morris, Inc., 209 F.R.D. 13, 19 (D.D.C. 2002) (relying on the text of Rules 26 and 30 in permitting depositions of in-house lawyers on non-privileged, pre-litigation matters).

144. *See, e.g.*, *In re* Subpoena Issued to Dennis Friedman, 350 F.3d 65, 72 (2d Cir. 2003) (articulating this approach); OCI Chem. Corp. v. Aon Corp., No. CV054003935S, 2007 WL 3087958, at *2 (Conn. Super. Ct. Oct. 3, 2007) (adopting the soon to be described *Friedman* approach).

145. 350 F.3d 65 (2d Cir. 2003).

146. *Id.* at 67.

The plaintiffs alleged that Hechinger's former directors breached their fiduciary duties in approving the merger.[147] The directors' defense pivoted on the business judgment rule and advice provided by Dennis Friedman, who was then a partner with a respected New York law firm.[148] Friedman had advised the directors on their fiduciary duties and the business judgment rule in connection with the merger.[149] His representation of the directors ended with the merger, and he later relocated his practice to Gibson Dunn & Crutcher, which was defending the directors in the litigation.[150] Friedman was not a trial lawyer and had no role in the litigation.[151]

One of the issues in the case was whether the directors had considered the interests of Hechinger's creditors when evaluating the merits of the merger.[152] The plaintiffs deposed all of the former directors, who either had forgotten whether Friedman had advised them on that issue or gave conflicting accounts.[153] The plaintiffs then subpoenaed Friedman for a deposition.[154] The district court quashed the subpoena under *Shelton*.[155] The plaintiffs appealed to the Second Circuit.[156] Friedman subsequently agreed to be deposed, which mooted the appeal.[157] But before dismissing the appeal as moot, the court volunteered a new approach to attorney depositions that departed from the *Shelton* test.[158]

After surveying the "deposition-discovery regime" established by the Federal Rules of Civil Procedure, including district courts' broad discretion to manage the discovery process, the *Friedman* court distanced itself from *Shelton* by explaining that it had never adopted the *Shelton* test and had long held that "the disfavor with which the practice of seeking discovery from adversary counsel is regarded is not a talisman for the resolution of all controversies of this nature."[159] Contrary to the formulaic *Shelton* test, the court

---

147. *Id.*
148. *Id.*
149. *Id.*
150. *Id.*
151. *Id.*
152. *Id.*
153. *Id.*
154. *Id.*
155. *Id.* at 68.
156. *Id.* at 65.
157. *Id.* at 67.
158. *See id.* at 72–73 (Wesley, J., concurring in result only) (questioning the court's issuance of a decision in a case properly dismissed as moot).
159. *Id.* at 69–71 (citing Gould Inc. v. Mitsui Mining & Smelting Co., 825 F.2d 676, 680 n.2 (2d Cir. 1987)).

reasoned, Rule 26 required "a flexible approach" to lawyer depositions, under which the trial court would consider "all of the relevant facts and circumstances to determine whether the proposed deposition would entail an inappropriate burden or hardship."[160] Those facts and circumstances may include the need to depose the lawyer, the lawyer's role in the matter to be discussed, the lawyer's role in the current litigation, the risk of triggering attorney–client privilege and work-product issues, and the state of discovery at the time the deposition is sought.[161] Consideration of these factors may cause a court to decide that a lawyer's deposition might be avoided by the use of interrogatories, or that interrogatories should be tried before ordering the lawyer to appear for a deposition.[162] Regardless, under this flexible approach, a lawyer's status as such does not insulate her from being deposed, nor does it automatically require prior resort to alternative forms of discovery.[163]

Had it considered the plaintiffs' appeal on the merits, the *Friedman* court would have ruled that the district court abused its discretion by applying the *Shelton* test.[164] Because the appeal was moot, however, the Second Circuit did not need to "rule definitively" on the district court's decision.[165]

Friedman is a curious case. It is tempting to dismiss the entire opinion as dicta.[166] Friedman's consent to his deposition after the appeal was filed rendered the case moot, thus depriving the Second Circuit of jurisdiction.[167] Federal courts are not empowered to issue advisory opinions,[168] a characterization that perfectly describes *Friedman*.[169] Nevertheless, the case is treated as controlling

---

160. *Id.* at 72.

161. *Id.*

162. *Id.*

163. *Id.*

164. *See id.* (explaining the flaw in the district court's ruling).

165. *Id.*

166. *See* Sea Tow Int'l, Inc. v. Pontin, 246 F.R.D. 421, 424 & n.2 (E.D.N.Y. 2007) (stating that "[i]n determining whether a deposition of opposing counsel is appropriate . . . district courts in New York are generally guided by *dicta* contained in the Second Circuit's opinion in *In re Friedman*," and explaining the dicta characterization in a footnote) (footnote omitted).

167. Ringo v. Lombardi, 677 F.3d 793, 796 (8th Cir. 2012) (quoting Neighborhood Transp. Network, Inc. v. Pena, 42 F.3d 1169, 1172 (8th Cir. 1994)); Fla. Wildlife Fed'n, Inc. v. S. Fla. Water Mgmt. Dist., 647 F.3d 1296, 1302 (11th Cir. 2011).

168. North Carolina v. Rice, 404 U.S. 244, 246 (1971); United States v. Combe, 437 F. App'x 644, 646 (10th Cir. 2011).

169. *See* Shenandoah Valley Network v. Capka, 669 F.3d 194, 201 (4th Cir. 2012) (explaining that an opinion constitutes an advisory opinion when there is no actual dispute between adverse parties).

authority in the Second Circuit, and *Friedman* potentially furnishes persuasive authority elsewhere.

To the extent the *Friedman* approach differs from the *Shelton* test, it first does so by potentially applying in more cases. That is, while courts tend to confine *Shelton*'s reach to cases in which the lawyer to be deposed qualifies as a member of an adversary's litigation team,[170] there appear to be no such limits on the *Friedman* approach. After all, Friedman was by no stretch of the imagination a member of the former Hechinger directors' defense team, nor was he even a litigator.[171] Thus, *Friedman* seems to be intended to guide courts' analyses of the propriety of lawyers' depositions under Federal Rule of Civil Procedure 26(b)(2)(C) in all cases that require such inquiry.[172]

Second, the *Friedman* approach seems to diverge from the *Shelton* test in the initial assignment of responsibility for avoiding attorney–client privilege and work-product doctrine traps. Under *Friedman*, the party opposing the deposition bears the burden of establishing the applicability of the attorney–client privilege or work-product doctrine, consistent with the allocation of that burden in other contexts,[173] while *Shelton* requires the party pursuing the deposition to make a prima facie showing that the information it seeks is not privileged or immune from discovery.[174] As explained previously, however, *Shelton*'s assignment of responsibility is of no great consequence in practice.[175] Furthermore, some courts applying *Shelton* have required the party whose lawyer is targeted for deposition to prove the applicability of the attorney–client privilege or work-product doctrine if it intends to resist the deposition on those grounds.[176] Thus, while the difference in burden allocation between the *Friedman* approach and the *Shelton* test is interesting, it is not a game changer.

---

170. *See supra* notes 105–09 and accompanying text.

171. *In re* Subpoena Issued to Dennis Friedman, 350 F.3d 65, 67 (2d Cir. 2003).

172. *See* FED. R. CIV. P. 26(b)(2)(C) (establishing circumstances in which a "court must limit the frequency or extent" of otherwise permissible discovery).

173. *See, e.g.*, Weinstein v. Univ. of Conn., Civ. No. 3:11CV1906 (WWE), 2013 WL 2244310, at *5 (D. Conn. May 21, 2013) (concluding that the plaintiff was not entitled to depose a lawyer employed by the defendant where "the risk of encountering privilege and work product issues ha[d] been established by [the] defendant").

174. Shelton v. Am. Motors Corp., 805 F.2d 1323, 1327 (8th Cir. 1986).

175. *See supra* notes 73–76 and accompanying text.

176. *See, e.g.*, Memory Bowl v. N. Pointe Ins. Co., 280 F.R.D. 181, 185 (D.N.J. 2012); Roeben v. BG Excelsior Ltd. P'ship, No. 4:06CV01643 JLH, 2007 WL 2990427, at *3 (E.D. Ark. Oct. 10, 2007).

Overall, while the *Friedman* approach seemingly applies in more cases and is more flexible than the *Shelton* test, the two regimes are not all that far apart. The *Friedman* factors include the requesting party's need to depose the lawyer, the lawyer's role in the matter to be discussed, and the risk of triggering privilege and work-product issues; these loosely parallel the *Shelton* requirements that "no other means exist to obtain the information," the information be crucial to the requesting party's case, and the information sought be relevant and non-privileged.[177] It is perhaps not surprising, then, that courts considering whether to permit lawyers' depositions often conclude that their decisions would be the same under either standard.[178]

The *Friedman* approach potentially offers an advantage over the *Shelton* test from the standpoint of a party seeking an opposing lawyer's deposition in that it either eliminates or substantially relaxes the strict *Shelton* requirement that the party establish that there is no other way to obtain the information sought in the deposition. As noted previously, *Shelton*'s critics speculate that in some cases this requirement may impose unreasonable expense or brutal inconvenience on the party seeking the deposition by, say, forcing the party to travel to Timbuktu to depose another witness rather than deposing the lawyer.[179] The possibility of unreasonable inconvenience or expense should be a low-level concern, however, because the hypothesized scenario is extremely rare. Alternative discovery methods may be less appealing than taking an opposing lawyer's deposition, but they are seldom anything more than dislikable. In the unusual case where the alternative discovery truly presents an unreasonable burden, the party seeking the lawyer's deposition is free to argue that to the court in an effort to obtain some accommodation. Furthermore, and again as noted earlier, some

---

177. *Compare In re* Subpoena Issued to Dennis Friedman, 350 F.3d 65, 72 (2d Cir. 2003) (describing the flexible approach), *with Shelton*, 805 F.2d at 1327 (listing factors).

178. *See, e.g.*, WMH Tool Grp., Inc. v. Woodstock Int'l, Inc., No. 07-CV-3885, 2009 WL 89935, at *3 (N.D. Ill. Jan. 14, 2009) ("Thus, regardless of the standard applied, there is no basis to conclude that [the lawyer's] deposition must go forward at this point in the litigation."); Argo Sys. FZE v. Liberty Ins. Pte. Ltd., No. Civ.A. 04-00321-CGB, 2005 WL 1355060, at *3 (S.D. Ala. June 7, 2005) (concluding that "regardless of whether the *Shelton* test or the flexible approach detailed in *Friedman* is utilized, [p]laintiff has established a genuine need for the deposition of [d]efendant's counsel . . ."); Carey v. Textron, Inc., 224 F.R.D. 530, 531 (D. Mass. 2004) (noting the competing *Shelton* and *Friedman* approaches and the lack of First Circuit precedent, and then stating that "on the facts of the case, a limited deposition is warranted under any reasonable standard").

179. *See supra* note 64 and accompanying text.

courts that adhere to the *Shelton* test have slightly relaxed this prong to require that a party seeking a lawyer's deposition show that alternative means of obtaining the information sought would be impractical or impracticable.[180] Nonetheless, the *Friedman* approach avoids these concerns altogether.

Finally, while the *Friedman* approach is more flexible than the *Shelton* test, no one should confuse "flexible" with "liberal." Courts that follow *Friedman* still conservatively analyze attempts to depose opposing lawyers.[181] In *Tucker v. American International Group, Inc.*,[182] for example, the court denied the defendants' request to interrogate the plaintiff's lawyer about an underlying settlement when two other witnesses had been deposed on the subject, defense counsel acknowledged that there were less-intrusive means of obtaining the desired information, and related written discovery had been completed.[183]

IV. THE SPECIAL CASE OF PATENT LITIGATION

As common as attempts to depose opposing counsel are in all types of cases, they are particularly frequent in patent litigation. By way of background, inventors and their licensees obtain patents through the process of prosecution in the PTO.[184] Patent prosecution can be an expensive exercise; a patent lawyer may have to spend substantial time studying the client's technology and any pertinent prior art.[185] If a party has paid a lawyer to prosecute a patent and then later needs to enforce that patent, it is understandable that the party may want to capitalize on the prosecuting lawyer's knowledge of its technology and business.[186] By hiring the lawyer who prosecuted a patent to enforce that patent in litigation, a party

180. *See supra* note 71 and accompanying text.

181. *See, e.g.*, Lee v. Kucker & Bruh, LLP, No. 12 Civ. 4662 (BSJ) (JCF), 2013 WL 680929, at *2 (S.D.N.Y. Feb. 25, 2013) (refusing to permit the defendants to depose the plaintiff's lawyer where the lawyer had "no first-hand knowledge of any issue in the case"); Tucker v. Am. Int'l Grp., Inc., No. 3:09-CV-1499 (CSH), 2012 WL 314866, at *13–14 (D. Conn. Jan. 31, 2012) (stating that the court was leery of permitting the deposition of the plaintiff's lawyer and employing the *Friedman* approach in denying the deposition); Tailored Lighting, Inc. v. Osram Sylvania Prods., Inc., 255 F.R.D. 340, 344 (W.D.N.Y. 2009) (following *Friedman*, but first observing that depositions of opposing counsel are disfavored even though they are permitted).

182. No. 3:09-CV-1499 (CSG), 2012 WL 314866 (D. Conn. Jan. 31, 2012).

183. *Id.* at *13–14.

184. Tolchinsky, *supra* note 21, at 994.

185. Hricik, *supra* note 21, at 422.

186. *Id.* at 423.

largely avoids the cost of educating multiple lawyers on the relevant issues.[187]

There is no requirement that a lawyer who prosecutes a patent and then later attempts to enforce that patent in litigation be a witness in the infringement action.[188] Controversies arise, however, where the plaintiff's litigation counsel in the infringement action prosecuted the patent-in-suit, and the allegedly infringing defendant pleads inequitable conduct as an affirmative defense.[189] In a nutshell, a determination of inequitable conduct requires (1) that a person associated with the filing and prosecution of a patent application affirmatively misrepresented a material fact, submitted false material information, or failed to disclose material information to the PTO; and (2) did so with the intent to deceive the PTO.[190] The accused infringer bears the burden of proving both the materiality of the subject information and the patentee's specific intent to deceive by clear and convincing evidence.[191] If proven, inequitable conduct bars enforcement of a patent[192] and may also render patents issued on different but related applications unenforceable, even if those patents are otherwise valid.[193] The patent holder may further be required to pay the accused infringer's attorneys' fees.[194] Importantly for our purposes, when establishing inequitable conduct, the actions and knowledge of the attorney who prosecuted the patent-in-suit are imputed to the patent applicant.[195]

Courts regularly permit depositions of opposing counsel in patent infringement cases in which the lawyer also prosecuted the patent-

---

187. *Id.*

188. *Id.* at 458.

189. For a discussion of the development and evolution of the inequitable conduct defense and its consequences, *see Therasense, Inc. v. Beckton, Dickinson & Co.*, 649 F.3d 1276, 1285–90 (Fed. Cir. 2011).

190. Outside the Box Innovations, LLC v. Travel Caddy, Inc., 695 F.3d 1285, 1290 (Fed. Cir. 2012); *Therasense, Inc.*, 649 F.3d at 1287.

191. *In re* Rosuvastatin Calcium Patent Litig., 703 F.3d 511, 519 (Fed. Cir. 2012); *Therasense, Inc.*, 649 F.3d at 1290–91.

192. Aventis Pharma S.A. v. Hospira, Inc., 675 F.3d 1324, 1334 (Fed. Cir. 2012); *Therasense, Inc.*, 649 F.3d at 1285.

193. DAVID HRICIK, PATENT ETHICS 216–17 (2010).

194. *Id.* at 217.

195. Elk Corp. of Dall. v. GAF Bldg. Materials Corp., 168 F.3d 28, 30 (Fed. Cir. 1999); Sandvik Intellectual Prop. AB v. Kennametal, Inc., No. 2:10-cv-00654, 2012 WL 2288554, at *2 (W.D. Pa. June 18, 2012) (citing 37 C.F.R. § 1.56; Novo Nordisk Pharm. Inc. v. Bio-Tech. Gen. Corp., 424 F.3d 1347, 1361 (Fed. Cir. 2005)); Exmark Mfg. Co. v. Briggs & Stratton Power Prods. Grp., LLC, No. 8:10CV187, 2011 WL 1467435, at *3 (D. Neb. Apr. 18, 2011) (citing *Novo Nordisk Pharm. Inc.*, 424 F.3d at 1361; 37 C.F.R. § 1.56).

in-suit and the alleged inequitable conduct involves the lawyer.[196] Because the deposition does not concern the lawyer's conduct in, or theory of, the pending infringement action, the concerns that animated the Eighth Circuit in formulating the *Shelton* test are generally thought to be absent.[197] Nevertheless, the alleged infringer's need for the lawyer's deposition in an ordinary case of this type can be nicely illustrated by applying *Shelton*'s three factors.

First, other witnesses cannot attest to the lawyer's knowledge and mental impressions.[198] Propounding interrogatories to the lawyer in lieu of taking her deposition is no solution because interrogatories may be directed only to parties,[199] and the lawyer is not a party to the litigation.[200] Second, the lawyer's knowledge and mental impressions are relevant,[201] and the lawyer's testimony is unlikely to breach the attorney–client privilege or violate the work-product doctrine. The lawyer's testimony will be factual in nature, and the attorney–client privilege does not bar discovery of facts.[202] As some courts have similarly observed, "[c]ommunications of

---

196. *See, e.g.*, *Sandvik Intellectual Prop. AB*, 2012 WL 2288554, at *2; *Exmark Mfg. Co.*, 2011 WL 1467435, at *3–6; Ed Tobergte Assocs. Co. v. Russell Brands, LLC, 259 F.R.D. 550, 555–60 (D. Kan. 2009); V. Mane Fils, S.A. v. Int'l Flavors & Fragrances, Inc., Civil Action No. 06-2304 (FLW), 2008 WL 3887621, at *3–4 (D.N.J. Aug. 20, 2008); Plymouth Indus., LLC v. Sioux Steel Co., No. 8:05CV196, 8:05CV469, 2006 WL 695458, at *4–5 (D. Neb. Mar. 17, 2006); Genal Strap, Inc. v. Dar, No. CV2004-1691 (SJ) (MDG), 2006 WL 525794, at *2–3 (E.D.N.Y. Mar. 3, 2006); aaiPharma, Inc. v. Kremers Urban Dev. Co., 361 F. Supp. 2d 770, 775–79 (N.D. Ill. 2005); Alcon Labs., Inc. v. Pharmacia Corp., 225 F. Supp. 2d 340, 343–45 (S.D.N.Y. 2002).

197. WMH Tool Grp., Inc. v. Woodstock Int'l, Inc., No. 07-CV-3885, 2009 WL 89935, at *2 (N.D. Ill. Jan. 14, 2009) (citing Srail v. Vill. of Lisle, No. 07 C 2617, 2007 WL 4441547, at *2 (N.D. Ill. Dec. 12, 2007)); *Plymouth Indus., LLC*, 2006 WL 695458, at *2–3 (quoting Pamida, Inc. v. E.S. Originals, Inc., 281 F.3d 726, 730 (8th Cir. 2002)).

198. *Ed Tobergte Assocs. Co.*, 259 F.R.D. at 555; *see, e.g.*, *Genal Strap, Inc.*, 2006 WL 525794, at *2 ("Although plaintiff has already deposed defendant Irit Dar, the alleged inventor of the patents-in-suit, Raskin, as prosecution counsel, is the only source of information concerning his knowledge of other inventors and his mental impressions concerning the inventorship of the patents.").

199. *See* FED. R. CIV. P. 33 (governing "Interrogatories to Parties").

200. *Plymouth Indus., LLC*, 2006 WL 695458, at *5; *Genal Strap, Inc.*, 2006 WL 525794, at *2; *Alcon Labs., Inc.*, 225 F. Supp. 2d at 343.

201. *Exmark Mfg. Co.*, 2011 WL 1467435, at *4; *Ed Tobergte Assocs. Co.*, 259 F.R.D. at 559; *aaiPharma, Inc.*, 361 F. Supp. 2d at 774 n.3; *Alcon Labs., Inc.*, 225 F. Supp. 2d at 344.

202. *Exmark Mfg. Co.*, 2011 WL 1467435, at *4–5.

'technical information' between [a] client and [an] attorney for the purpose of submission to the Patent Office are not privileged."[203] The work-product doctrine generally does not apply because the lawyer did not prosecute the patent-in-suit in anticipation of litigation.[204] Third, because of the lawyer's "direct and instrumental role" in prosecuting the patent-in-suit,[205] her testimony is crucial to the defendant's preparation of its inequitable conduct defense.[206]

There is also a fairness aspect to the deposition of prosecuting lawyers who double as trial counsel in patent infringement actions in which the accused infringer pleads inequitable conduct as an affirmative defense. As an Illinois federal court observed in a case involving the plaintiff's alleged failure to disclose prior art, "it would be unfair to accused patent infringers if patentees could shield potentially harmful discovery related to their knowledge of prior art merely by using their prosecution counsel . . . as trial counsel."[207] For obvious reasons, any fairness-based argument is more likely to influence a court in a jurisdiction that employs the flexible *Friedman* approach, rather than one that adheres to the *Shelton* test.

On the other hand, while courts frequently permit depositions of plaintiffs' lawyers in patent infringement actions involving inequitable conduct allegations, they are not obligated to do so, nor should they necessarily abandon the caution they show in other categories of cases where parties seek lawyers' depositions.[208] For

---

203. *Genal Strap, Inc.*, 2006 WL 525794, at *3; *see also Plymouth Indus., LLC*, 2006 WL 695458, at *4 (concurring with the court's assessment in *Genal Strap, Inc.*, 2006 WL 525794).

204. *Plymouth Indus., LLC*, 2006 WL 695458, at *4 (quoting *Genal Strap, Inc.*, 2006 WL 525794, at *3); *Genal Strap, Inc.*, 2006 WL 525794, at *3 (quoting Amicus Commc'ns, L.P. v. Hewlett-Packard Co., No. 99-0284, 1999 WL 33117227, at *2 (D.D.C. Dec. 3, 1999)).

205. *Ed Tobergte Assocs. Co.*, 259 F.R.D. at 559.

206. *Exmark Mfg. Co.*, 2011 WL 1467435, at *5; *Ed Tobergte Assocs. Co.*, 259 F.R.D. at 559; *Alcon Labs., Inc.*, 225 F. Supp. 2d at 344 (stating that "the prosecuting attorney's mental impressions are crucial to any claim of inequitable conduct in a patent infringement action").

207. aaiPharma, Inc. v. Kremers Urban Dev. Co., 361 F. Supp. 2d 770, 775 (N.D. Ill. 2005).

208. *See, e.g.*, Games2U, Inc. v. Game Truck Licensing, LLC, No. MC-13-00053-PHX-GMS, 2013 WL 4046655, at *8–9 (D. Ariz. Aug. 9, 2013) (declining to permit lawyer's deposition where questions posed would repeatedly implicate the attorney–client privilege and it was not apparent that the deposition would lead to relevant information that was not available from other sources); Sterne Kessler Goldstein & Fox, PLLC v. Eastman Kodak Co., 276 F.R.D. 376, 383–85 (D.D.C. 2011) (noting that inequitable conduct was not yet alleged in the case, but even if the defendant had pled it, the lawyer's deposition was inappropriate because of the danger that

example, if the defendant has stated that it intends to assert inequitable conduct as an affirmative defense, but has not formally or properly done so at the time it seeks the opposing lawyer's deposition, the court may refuse the deposition on the basis that the lawyer's testimony is not yet crucial to the case.[209] If the lawyer to be deposed did not prosecute the patent-in-suit or provide a related patentability opinion, there is little reason to think the lawyer's deposition will be required.[210] A court may deem a request to depose a lawyer premature if the requesting party has not deposed other key witnesses at the time it seeks the lawyer's deposition.[211] Although it is generally true that other witnesses will be unable to address all, or perhaps any, of the issues to which the lawyer can speak, in some cases it can be difficult for the court to evaluate the need for the lawyer's testimony until the record is more fully developed.

V. CONCLUSION

Courts generally disfavor depositions of opposing counsel even though rules of civil procedure permit them. Depositions of opposing counsel may extend litigation and increase its cost, cause delays to resolve work-product and attorney–client privilege objections, distract the lawyer to be deposed from the client's representation, discourage parties from communicating openly with their lawyers, function as a backdoor method of learning the opponent's litigation strategy, or be an effective means of harassing opposing counsel and their clients. At the same time, in cases in which a lawyer's conduct is the basis of a party's claim or defense, it is often reasonable to

---

privileged communications or work product would be revealed, and there were alternative sources of information that made the lawyer's deposition unnecessary).

209. *Sterne Kessler Goldstein & Fox, PLLC*, 276 F.R.D. at 383 (refusing lawyer's deposition where defendant had not yet been granted leave to amend its pleadings to assert an inequitable conduct defense) (citing ResQNet.com, Inc. v. Lansa, Inc., No. 01 Civ. 3578 (RWS), 2004 WL 1627170, at *5 (S.D.N.Y July 21, 2004)); *ResQNet.com, Inc.*, 2004 WL 1627170, at *3–5 (rejecting lawyer's deposition where defendant had not properly pled inequitable conduct and it had not sought leave to amend its answer to assert the defense).

210. *See aaiPharma, Inc.*, 361 F. Supp. 2d at 775 & n.4 (noting that when it comes to deposing opposing counsel, a party's use of trial counsel who previously furnished a patentability opinion potentially raises many of the same issues that the lawyer's prosecution of the patent-in-suit raises).

211. *See, e.g.*, WMH Tool Grp., Inc. v. Woodstock Int'l, No. 07-CV-3885, 2009 WL 89935, at *3 (N.D. Ill. Jan. 14, 2009) (refusing lawyer's deposition for the time being); Miyano Mach. USA, Inc. v. Miyanohitec Mach., Inc., 257 F.R.D. 456, 465 (N.D. Ill. 2008) (entering protective order preventing lawyer's deposition).

subject the lawyer to examination much as other witnesses. Lawyers who are fact witnesses to key events are reasonably required to submit to depositions in many cases. Patent infringement actions in which the lawyer who prosecuted the patent-in-suit represents the patentee and the alleged infringer pleads inequitable conduct as an affirmative defense exemplify this point.

Lawyers should carefully consider the tactical risks of litigation before filing suit or putting particular matters at issue in a case. Lawyers who litigate their own work should anticipate efforts to depose them. When possible, the lawyer should communicate the likelihood of her deposition up front so that the client can decide whether to risk the attendant expense, complications, and distractions, or to substitute counsel. Various factors may influence this decision, including the importance of the lawyer's testimony to the preparation of the case, alternative means of discovering the information the lawyer might be expected to provide, and the chance that the lawyer's deposition will breach the attorney–client privilege or implicate the work-product doctrine.

For lawyers who are contemplating the deposition of an adversary's lawyer, these same factors come into play. Most fundamentally, a lawyer who intends to pursue the deposition of another lawyer must be prepared to demonstrate that the evidence sought is crucial to the case. It is also wise to exhaust alternative means of discovering the same information before seeking the lawyer's deposition—at least insofar as it is practical to do so. In jurisdictions that adhere to the *Shelton* test, such diligence is necessary.

At the end of the day, depositions of other lawyers, while disfavored by courts and even by most lawyers, are surprisingly common. Whether a lawyer's deposition should be permitted in a particular case is a fact-intensive inquiry that tests thoughtful courts and lawyers alike.