UNITED STATES DISTRICT COURT
DISTRICT OF CONNECTICUT

Tyco Healthcare Group LP and United States Surgical Corp., *Plaintiffs*, *v.* Ethicon Endo–Surgery, Inc., *Defendant*.	Civil No. 3: 10cv60(JBA) December 30, 2011

RULING ON PLAINTIFFS' MOTION TO DISQUALIFY COUNSEL FOR DEFENDANT ETHICON ENDO–SURGERY, INC.

Plaintiffs Tyco Healthcare Group and United States Surgical Corporation move to disqualify Defendant Ethicon Endo–Surgery's attorneys of record, the law firm of Akin, Gump, Strauss, Hauer & Feld LLP ("Akin Gump"). Plaintiffs argue that Akin Gump had improper access to privileged and confidential information concerning this case as a result of its hiring and use of a former TrialGraphix employee—Michael Greer—who had served as the lead trial presentation technology consultant for Plaintiffs and their counsel during the related trial of *Tyco Healthcare Group LP v. Ethicon Endo–Surgery, Inc.*, 3:04cv1702(JBA) (the "'1702 action" or "*Tyco I*") on the same patents four years ago.[1] Akin Gump trial counsel advised Plaintiffs' counsel on September 22, 2011 that Mr. Greer had been added to its trial

[1] After two weeks of bench trial, that case was dismissed when it became apparent that the patent owner was not a plaintiff. Dismissal was affirmed, *Tyco Healthcare Group LP v. Ethicon Endo–Surgery, Inc.*, 587 F.3d 1375 (Fed. Cir. 2009), but this case, alleging the same infringement of the same patents, was begun with the correct Plaintiffs and counsel have stipulated that the Court's summary judgment ruling in the earlier action applies equally to the newly accused ACE23E, ACE 36E, and ACE 45E products. (*See* Stipulation and Ord. [Doc. # 66].) The parties also stipulate that for purposes of this action, Defendant will not contest Plaintiff's position that Tyco Healthcare is the owner of the patents–in–suit by virtue of the April 1, 1999 asset–transfer agreement. (*See* Stipulation [Doc. # 43].)

team for the trial scheduled to commence October 18, 2011, and Plaintiffs moved on October 7, 2011 for Akin Gump's immediate disqualification from further representation of Defendant Ethicon Endo–Surgery in this action. For the reasons discussed below, Plaintiffs' Motion to Disqualify is granted in part.

I. Factual Background

In 2007, the law firm of Clifford Chance, counsel for Plaintiffs in the '1702 Action, hired TrialGraphix, Inc. to provide trial consulting services to assist Plaintiff's counsel prepare for and present their witnesses and exhibits in the December 2007 bench patent trial in that action. (October 7, 2011 Declaration of Mark Rueh [Doc. # 99] ¶ 4.) As a result, Mr. Greer, an employee of TrialGraphix, became the principal TrialGraphix Presentation Technology Trial Consultant for Plaintiffs and their attorneys Drew Wintringham, Mark Rueh, and Frank Ryan (now at the law firm of DLA Piper) in the '1702 Action. (*Id.* ¶ 5.)

TrialGraphix is in the business of providing trial consulting services for attorneys and specializes in graphic design, presentation technology, and litigation counseling. (*See* Declaration of James Watkins, Director of Operations, TrialGraphics New York Office [Doc. # 100] ¶ 4.) Presentation Technology Consultant/Multimedia Consultants like Mr. Greer "are expected to travel to the trial site a week or more before trial begins to immerse themselves in the facts (and documents) of the case and develop a relationship with the trial team." (*Id.* ¶ 11.)[2] Mr. Greer moved into the Plaintiffs' trial team's hotel headquarters five

[2] TrialGraphix personnel in Mr. Greer's position are "expected to and do develop a strong working knowledge of the facts and circumstances of the client's case and position" (Watkins Dec. ¶ 11), are expected "to fully understand the cases on which they work" (*id.* ¶ 5), and "are adept at identifying key concepts and translating these concepts into visual courtroom presentations and legal graphics" (*id*). TrialGraphix describes its professionals as "providing a helpful 'layperson' perspective" in learning the intricacies of their clients'

days prior to the commencement of trial and remained until the case was dismissed mid–trial. (Rueh Dec. ¶ 7.)

In his capacity as principal presentation technology consultant, Mr. Greer "interface[d] with the presentation technology for the trial team on–site." (Declaration of Michael Greer [Doc. # 108–2] ¶ 2.) Mr. Greer describes this work as "highly technical in nature, with a view to operating computer and other equipment in a courtroom smoothly, accurately, and without delay or interruption in presenting graphic material." (*Id.*) Mr. Greer describes his responsibilities while on–site with the Tyco trial team as including "presentation database maintenance and updating, courtroom presentation equipment setup and testing, war room equipment setup, testing, configuration and end–user IT support, in–court display services, and presentation system operation during witness preparation sessions." (*Id.* ¶ 4.)

During the time leading up to the '1702 trial and throughout trial, Mr. Greer worked closely with Tyco's counsel, staying with the trial team at the New Haven hotel where Tyco's counsel was preparing its case, and working "side–by–side with Tyco's Counsel in the same conference room." (Rueh Dec. ¶¶ 7–8.) Mr. Greer was "privy to and received Tyco's confidential information" as well as "numerous confidential and privileged discussions" concerning "trial tactics and strategy," and worked on mock examinations and cross examinations of Tyco's witnesses, "including preparatory work with Mr. Philip Roy (Senior Director, Tyco Global Marketing—Vessel Sealing & Dissection) and Dr. William Durfee (Tyco's technical expert in the '1702 action)." Both Mr. Roy and Dr. Durfee are expected to testify at the trial in this action. (*See* Joint Pre–Trial Memorandum, [Doc. # 89].) Mr. Greer

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cases. (*See* Ex. A [Doc. # 100–1] to Watkins Dec.)

also participated in at least one mock cross–examination of Ethicon witness Dr. Mark Tsonton, in which a Clifford Chance attorney played Tsonton's role. In addition, Mr. Greer participated in mock cross–examinations of and in the development of cross–examination strategies for Ethicon's witnesses, including Mr. Thomas Davison, Mr. Gary Whipple and Dr. Joseph Amaral. (Rueh Dec. ¶ 10.) During these sessions, "Tyco's counsel engaged in detailed discussions about the case, including refining its examination and cross–examination strategies." (*Id.* ¶ 11.) On a "daily basis," Mr. Greer participated in the "preparation of Tyco's trial demonstratives" in *Tyco I*. This involved participation in and "observance of discussions by Tyco's counsel regarding trial tactics and strategy in the course of preparing witnesses and cross examination," and "in the course of this work, Mr. Greer was privy to privileged discussions including conversations about which issues to emphasize or de–emphasize during trial." (*Id.* ¶ 12.) In all, Mr. Greer billed over 220 hours of time to the '1702 case. (Ex. K to October 7, Ryan Dec. [Doc. # 98].)

During his October 6, 2011 deposition, Mr. Greer acknowledged that he had access to Plaintiffs' attorney trial team's confidential and privileged information as a TrialGraphix consultant working on the '1702 action on behalf of Tyco. (*See* Greer Tr., Ex. A to Ryan Dec. at 82:7–15.) Mr. Greer also testified that he "most definitely was in the room for witness prep sessions," and that it was "highly likely" that he was present during trial strategy discussions. (*Id.* at 102:9–113:9.)

In his post–deposition affidavit dated October 11, 2011, Mr. Greer describes his participation during these preparatory sessions before the Tyco trial in the '1702 action as "solely for the purpose of introducing the witness to the presentation technology and to simulate the use of presentation technology as it would be in the courtroom setting." (Greer

Dec. ¶ 6.) His focus during these sessions "was to listen for exhibit numbers or deposition transcript references so that I could display the corresponding image files on a computer display for the witness and presenting attorney at the appropriate time." (*Id.*) Mr. Greer was not the TrialGraphix employee involved in the creation of Plaintiff's trial graphics, in the development of any case themes, in the analysis of any documents, or in the generation of content for any graphics for the Tyco trial team, and recalls that these responsibilities fell solely to Ryan Flynn, the TrialGraphix graphic artist on–site in New Haven for the duration of trial. (*Id.* ¶ 8.) Mr. Greer also stated that "[o]ther members of the TrialGraphix graphic design staff were likely involved in assisting the Tyco team with their graphic needs prior to Mr. Flynn and I going on–site in November of 2007," and "[t]o the best of my recollection, I was not involved and did not participate in any substantive conversations regarding the graphic design and concepts that may have occurred between Mr. Flynn and the Tyco trial team." (*Id.* ¶ 8.) Upon completion of Mr. Greer's work for the Tyco trial team, all Tyco–related information was returned either to the Tyco team or to TrialGraphix, and upon leaving TrialGraphix in April 2011, he did not take any confidential or privileged information with him, and does not now have any such information in his possession. (*Id* ¶ 10.) He was able to assist Plaintiffs' attorneys to locate a degraded file at their request in 2010. (Ex. I to Ryan Dec.)

Mr. Greer left TrialGraphix in April 2011 to join Akin Gump as a Trial Presentation Specialist. (*Id.* ¶ 11.) Mr. Greer states that his job responsibilities at Akin Gump include "all of those that I was responsible for at TrialGraphix, plus coordinating on–site logistics such as hotel arrangements, copier rental, presentation technology equipment rental . . , graphic layout design and additional technical production–related tasks." (*Id.* ¶ 11.) Mr. Greer writes

that in late August 2011, he was assigned to this case to assist the Ethicon trial team with their trial preparation. (*Id.* ¶ 12.) During his involvement with the Ethicon team, Mr. Greer worked with Attorney Ruben Munoz, paralegal Marisa Browndorf, and Joe Ficocello, Director of Trial Services and Mr. Greer's supervisor. (*Id.*) He worked on presentation database creation and production, and graphic layout tasks. (*Id.* ¶ 13.)

On September 22, about three weeks before trial, Plaintiffs' trial team received an email from Dianne Elderkin, Ethicon's lead trial counsel at Akin Gump. This email notified Plaintiffs' counsel for the first time that Akin Gump had hired Mr. Greer and intended to use him to assist at trial in this case:

> Michael Greer is an employee of Akin Gump in our trial support group. We plan to have him assist at trial next month. He was formerly employed by TrialGraphix and, in that capacity, assisted the Clifford Chance team on–site at the December 2007 trial. We obviously see no problem with using Michael, or we wouldn't be planning to do so, but we did want to make you aware of this so that you will not be surprised when you see him in the courthouse next month.

(Ex. A to Rueh Dec.) Mr. Greer was hired in early April 2011, and time records show that Mr. Greer had been assigned to the *Tyco v. Ethicon* matter by August 24, 2011, nearly a month prior to Ms. Elderkin's disclosure of his involvement. (*See* Exs. E, H to Ryan Dec.) An email from Joseph Ficocello to Mr. Greer shows that Ethicon contemplated using him on this case and advising Plaintiffs' counsel of his involvement as early as August 8, 2011. This email states:

> I spoke with the Ethicon team on Friday regarding your assistance on that case. It may be fruitful for one of [sic] lead attorneys to contact the other side to let them know you are no longer affiliated with TrialGraphix and are now working for Akin full time in–house. . . From there we can decide how best to proceed, and if there are any conflicts or objections from opposing counsel then it will be better to have that known earlier than later.

(Ex. I to Ryan Dec.) In that email, Mr. Ficocello posed several questions to Mr. Greer:

> 1. Are there any specific provisions in your employment contract with TrialGraphix which would preclude you from assisting a previously opposing party on the same matter? Are there any conflicts or dated term limits in place?
>
> 2. Were you involved in any key strategy meetings in advance of your in–court involvement at trial? Do you possess any knowledge of information which opposing counsel would determine to be an unfair or conflicting advantage to Akin or the client?
>
> 3. Did you sign, agree to, or otherwise confirm, any separate non–TrialGraphix related agreement with Tyco? (i.e. a separate confidentiality agreement or document of any kind).
>
> 4. Since the case ended in December 2007, have you had any further communication with any members of the trial team, or participated in any confidential conversations related, but not limited to, case strategy, theory development or a similar topic?

(*Id.*) Mr. Greer responded to the email promptly, and in his response to the second question, he wrote,

> Once on–site I was involved in numerous prep sessions with witnesses and experts. I don't remember any details regarding strategy or testimony. I do remember the Clifford Chance team members and their general presentation styles, but nothing case specific other than it was a patent case involving a surgical cutting and cauterizing device.

(*Id.*)

An August 14, 2011 Email from Mr. Ficocello to Ms. Elderkin followed up on Greer's involvement. Mr. Ficocello writes:

> I wanted to follow up on our ETHI discussion and Mike's involvement at trial. I'd asked him a few pointed questions (Q&A's below) on his experience on the case, involvement/arrangement with [Trial Graphix] and what his exposure had been beyond trial. I thought it covered our bases and the range of what

> we'd need to know, but if you think of other questions we can also ask them too. I suppose the email to Drew [Plaintiffs' Attorney] would just highlight that Mike has joined our team and we believe he's clear of any conflict, however if they wish to voice an objection to his technical assistance that they should in a timely manner. If they do object we can always pivot and Jamey and I can work together to support as needed. I've blocked it out on my calendar though so I'm planning on being there the whole time.

(August 14, 2011 Email from Joseph Ficocello to Dianne Elderkin, Ex. A to Ryan Supp. Dec. [Doc. #123].)

On September 22, 2011, Mr. Greer sent an email to Mr. Ficocello asking, "[d]o you know if anyone has mentioned to [Plaintiffs' counsel] that I now work for Akin?" (Ex. A to Ryan Supp. Dec.) Mr. Ficocello responded, "I had emailed the issue forwarding your responses but never heard back." (*Id.*) At 5:15PM that day, Mr. Greer responded to Mr. Ficocello informing him, "I emailed Ruben [Munoz]. He will [be] contacting Tyco. He is also going to bring up the other issue with the team." (*Id.*) Later that day, Ms. Elderkin notified Plaintiffs' counsel that Ethicon planned to use Mr. Greer at trial. (Ex. A to Rueh Dec.)

In spite of Defendant's counsel's knowledge at the time Akin Gump hired him that Mr. Greer had worked for Plaintiffs during trial in the '1702 action, no steps were taken to wall him off from the Ethicon matter, he was instead assigned to work on the same case and Defendant's attorneys waited nearly seven weeks, until the eve of trial, to inform Plaintiffs' trial counsel of this fact, and inaccurately described the scope of Mr. Greer's role to Plaintiffs' counsel and to the Court. Ms. Elderkin's September 22 email that Ethicon "planned" to have Mr. Greer assist at trial in October, did not disclose that Mr. Greer had already been working on the case for several weeks. (*See* Ex. A to Rueh Dec.) Further,

during the Court's telephonic pre–trial conference on September 27, 2011, Ms. Elderkin told the Court and Plaintiffs's counsel that "Mr. Greer is not experienced with the case" (Pretrial Conf. Tr. 23:11–12), that "Akin Gump planned to bring Mr. Greer to trial solely 'as a training experience'" (*id.* 23:7); and that Mr. Greer had only "prepared one or two slides based on our damages expert report and he's had some involvement in calling the hotel to make trial arrangements. That's the extent of his involvement" (*id.* 23:22–25).

Mr. Greer's subsequent deposition revealed that he understood that his role in the upcoming trial was to provide "logistics, trial preparation, graphics, potentially video or audio editing and possibly hot seat support." (Greer Tr. 71:6–8.) He was never informed that his role would be a "training exercise," nor did he expect it to be (*id.* at 72:5–24), and he did not know who made the New Haven hotel reservations, but that "I know it wasn't me" (*id.* at 72:25–72:5). Mr. Greer also testified that his access to Akin Gump's litigation database for this case was removed on September 27, 2011. (*Id.* at 142:3–1; 143:23–144:5; 145:22–23; *see also* Greer Dec. ¶ 17.)

Mr. Greer internally billed nearly 80 hours of work on this case to Ethicon, involving three separate areas: preparation of the opening PowerPoint slide presentation, the damages PowerPoint slide presentation, and the reformatting of a timeline for use in the opening PowerPoint presentation. (Greer Supp. Dec. [Doc. # 128–5] ¶ 1.) He worked on over 100 slides for a damages presentation, prepared a timeline presumably related to Ethicon's invalidity defense (*see* Ruling Denying Summary Judgment on Wilful Infringement [Doc. # 91]) for use in connection with the opening at trial,[3] and drafted "time bars" and slides

[3] In a supplemental affidavit, Mr. Greer states that during his involvement with the Ethicon matter "the placeholder text [on the timeline slides] was never updated with actual

to counter evidence offered by Plaintiffs' damages expert.[4] (Ex. C to Ryan Supp. Dec.; Greer Supp. Dec. [Doc. # 128–5] ¶¶ 1–2.) The record contains numerous emails and references to telephone calls between Mr. Greer and Attorney Munoz, Marisa Browndorf, a paralegal working on this case, and Ethicon's damages expert. (Exs. C–D of Ryan Supp. Dec.)

During Mr. Greer's deposition, Mr. Munoz, counsel of record for Ethicon and one of Mr. Greer's supervisors in this matter, defended the deposition on behalf of Mr. Greer. (Greer Tr. 4:13–19.) Although apparently Plaintiffs' counsel lodged no objection, Mr. Greer testified that Mr. Munoz had spent approximately three hours preparing him for his deposition. (*Id.* at 4:7–12.) Mr. Greer also testified that Akin Gump never suggested or pointed out to him that the interests of the firm might not be aligned with his own interests, or that he may wish to retain his own counsel. (*Id.* at 91:24–92:11.)

II. Discussion

The authority of federal courts to disqualify attorneys derives from their inherent power to "preserve the integrity of the adversary process."*Hempstead Video, Inc. v. Incorporated Village of Valley Stream*, 409 F.3d 127, 132 (2d Cir. 2005) (citing *Bd. of Educ. v. Nyquist*, 590 F.2d 1241, 1246 (2d Cir.1979)). In exercising this power, the Court must attempt to balance "a client's right freely to choose his counsel" against "the need to maintain the highest standards of the profession." *Gov't of India v. Cook Indus., Inc.*, 569

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testimony text." (Greer Supp. Dec. ¶ 2.)

[4] The majority of the slides that Mr. Greer worked on for Ethicon that were turned over to Plaintiffs during disqualification discovery were redacted for attorney work product privilege. (*See* Ex. C to Ryan Supp. Dec.)

F.2d 737, 739 (2d Cir.1978); *see also Emle Indus., Inc. v. Patentex, Inc.*, 478 F.2d 562, 564-65 (2d Cir.1973).

Disqualification is disfavored in the Second Circuit, and is only warranted in the rare circumstance where an attorney's conduct "poses a significant risk of trial taint." *Arista Records LLC v. Lime Group LLC*, 2011 WL 672254 (S.D.N.Y. Feb. 22, 2011); *see also Gleuck v. Jonathan Logan, Inc.*, 653 F.2d 746, 748 (2d Cir. 1981) ("Recognizing the serious impact of attorney disqualification on the client's right to select counsel of his choice, we have indicated that such relief should ordinarily be granted only when a violation . . . poses a significant risk of trial taint."). Consequently, the moving party's burden of proof is a high one, *see Evans v. Artek Sys. Corp.*, 715 F.2d 788, 791–92 (2d Cir. 1983), though the Second Circuit has admonished that "in the disqualification situation, any doubt should be resolved in favor of disqualification." *Hull v. Celanese Corp.*, 513 F.2d 568, 571 (2d Cir. 1975).

The Second Circuit appears to have been presented with only two types of situations in which an attorney's misconduct will taint the trial sufficiently to require disqualification. *Nyquist*, 590 F.2d at 1246. The first is where a law firm concurrently represents parties with adverse interests and is inapplicable here. The second type—that of "successive representation"—arises where the attorney places him or herself in a position where that attorney could use in litigation against a former client relevant, privileged information obtained during the prior representation. *Id.* Under these circumstances, disqualification is appropriate if

> (1) the moving party is a former client of the adverse party's counsel; (2) there is a substantial relationship between the subject matter of the counsel's prior representation of the moving party and the issues in the present lawsuit; and (3) the attorney whose disqualification is sought had

> access to, or was likely to have had access to, relevant privileged information in the course of his prior representation of the client.

Evans, 715 F.2d at 791. Outside of these situations, courts "have shown considerable reluctance to disqualify attorneys despite misgivings about the attorney's conduct." *Nyquist*, 590 F.2d at 1246. That the representation may create an appearance of impropriety generally is insufficient on its own to merit disqualification. "[T]he appearance of impropriety is simply too slender a reed on which to rest a disqualification order except in the rarest cases." *Id.* at 1247. In a successive representation situation, "conflicts are ordinarily imputed to [the] firm based on the presumption that 'associated' attorneys share client confidences." *Hempstead*, 409 F.3d at 135. The presumption of confidence sharing within a firm can be rebutted, and according to the Second Circuit there is "no categorical rule against considering practices and structures that protect client confidences within a firm in determining whether an attorney or firm should be disqualified." *Id.* at 137.

If the elements of the three–part *Evans* analysis are demonstrated, a court must balance three competing interests: (1) the client's interest in freely selecting counsel of its choice, (2) the adversary's interest in the trial free from the risk of even inadvertent disclosures of confidential information, and (3) the public's interest in the scrupulous administration of justice. *Hull v. Celanese Corp.*, 513 F.2d 568, 570 (2d Cir.1975).

A. Former Client

This case involves a non–lawyer[5] exposed to attorney confidences and trial strategies of one side switching sides, thus satisfying the first prong of *Evans*, that the movant be the former client. *See Evans*, 715 F.2d at 791. The situation here is analogous to that of a contract attorney, brought in to work on a specific aspect of trial, and switching sides during the pendency of the litigation. Mr. Greer was deployed by TrialGraphix in 2007 during *Tyco I*, on contract with Plaintiffs who were the "clients" that used Mr. Greer's services for trial preparation and presentation. (*See* Watkins Dec. ¶ 11 (describing the work of a TrialGraphix trial consultant and referring to the relationship as one with a "client"); Greer Dec. ¶ 4.) Therefore, prong one of the *Evans* test is satisfied.

B. Substantial Relationship

Next, there must be a "'substantial relationship' between the subject matter of the prior representation and the issues involved in the current action." *Cablevision Lightpath*,

[5] Non–lawyers who have acquired confidential information also are held to the same conflict of interest provisions as applicable to attorneys. *See MMR/Wallace*, 764 F.Supp. 712, 725 n.19 (D. Conn. 1991) ("The fact that [the conflicted employee] was not an attorney is irrelevant to the court's consideration of his ability to assist Plaintiff's counsel in the preparation for litigation" and "it cannot be seriously disputed that [he] possessed confidential and privileged information"); *cf. In re Tevis*, 347 B.R. 679, 693 (9th Cir. 2006) ("A communication with a nonlawyer employee of a law firm can also give rise to a disqualifying conflict of interest, especially where confidential information is disclosed."); *Lamb v. Pralex Corp.*, 333 F.Supp. 2d 361, 361 (D.V.I. 2004) ("a trial court has the authority, in a litigation context, to disqualify counsel based on the conduct of a nonlawyer assistant that is incompatible with a lawyer's ethical obligations," and "such disqualification may be imputed to the entire law firm"); *Rodriguez v. Montalvo*, 337 F. Supp. 2d 212, 218 (D. Mass. 2004) ("if a non–lawyer paralegal established a confidential relationship with a client, that relationship may be imputed to the attorney supervisor and consequently to the firm as a whole."); *Richards v. Jain*, 168 F.Supp. 2d 1195, 1202 (W.D. Wa. 2001) (conduct and knowledge of nonlawyer is imputed to firm).

Inc. v. Verizon NY Inc., No. 11–CV–2457(CBA)(JMA), 2011 WL 3845504, * 3 (E.D.N.Y. Aug. 30, 2011). This element is satisfied only "upon a showing that the relationship between issues in the prior and present cases is 'patently clear' . . . or when the issues involved have been 'identical' or 'essentially the same.'" *Id.* (citing *Gov't of India v. Cook Industries*, 569 F.2d at 739–40.)

Here, the trial at issue is not merely substantially related, but is in fact a continuation four years later, with updating, of the same claims. Plaintiffs maintain that this identity requires disqualification under *Hull v. Celanese Corp.*, 513 F.2d 568 (1975) ("[h]ere, the matter at issue is not merely 'substantially related' to the previous representation, rather, it is exactly the same litigation. . . . [t]his is, in short one of those cases in which disqualification is a necessary and desirable remedy . . . to enforce the lawyer's duty of absolute fidelity and to guard against the danger of inadvertent use of confidential information.") (internal citations omitted). In *Hull*, the firm's attestations that "they never had direct access to any confidences" and that they "carefully cautioned [the conflicted person] not to reveal any information received in confidence as an attorney for Celanese," were not deemed dispositive: "*Emle* makes it clear that the court need not inquire whether the lawyer did, *in fact*, receive confidential information" *id.* at 572 (citing *Emle Industries, Inc.*, 478 F.2d at 571), and affirmed the district court's decision to disqualify plaintiff's counsel:

> The Rabinowitz firm had notice that Delulio had worked on the defense of the *Hull* case and should have declined representation when approached. Had Delulio joined the firm as an assistant counsel in the *Hull* case, they would have been disqualified. Here she joined them, as it were, as a client. The relation is no less damaging and the presumption in *Emle* should apply.

Id. at 572.[6]

Given the identity of trial issues in the 2007 trial involving Mr. Greer and the forthcoming trial, with Mr. Greer now on the Defendant's side, the second *Evans* prong is satisfied.

C. Likelihood of Access to Relevant Privileged Information

The final prong requires that "during the former representation, the attorney sought to be disqualified had, or likely had, access to relevant privileged information." *Cablevision Lightpath*, 2011 WL 3845504, at *4. Given the nature and substance of Mr. Greer's work in his prior trial presentation services and work, and the similar type of in–house work on the issues to be tried in this case, Plaintiffs are entitled to a rebuttable presumption that this element has been met. *Id.* (citing *Cook Indus.*, 569 F.2d at 741). Mr. Greer testified that during his time working for Plaintiffs on *Tyco I*, he was privy to confidential and privileged information (*see* Greer Tr., Ex. A to Ryan Dec. at 82:7–15), and Defendant does not dispute that Plaintiff had access to relevant privileged information and for the purposes of this motion does not dispute the applicability of this presumption.

What remains, therefore, is determining whether Defendant has rebutted the presumption of shared confidences that are imputed to members of a firm once the three prongs of *Evans* are satisfied. *See Hempstead*, 409 F.3d at 135. The parties muster a panoply of cases to support their respective arguments: Defendants assert that their uncontroverted affidavits are sufficient to rebut the presumption, while Plaintiffs argue that the obvious

[6] The Second Circuit cautioned that "the novel factual situation presented here dictates a narrow reading of this opinion" and that "the scope of this opinion must, of necessity, be confined to the facts presented and not read as a broad–brush approach to disqualification." *Id.* at 572.

opportunity for disclosure of confidential information, even inadvertently or subconsciously, creates the significant risk of taint and warrants disqualification.

1. Whether Uncontroverted Affidavits Are Sufficient to Rebut the Presumption

In determining whether a party has provided sufficient evidence to rebut the presumption of shared confidences, courts require clear, competent, and effective evidence. *See, e.g.*, *Freeman v. Chicago Musical Instrument Co.*, 689 F.2d 715, 723 (7th Cir. 1982) ("Accordingly, if an attorney can clearly and effectively show that he had no knowledge of the confidences and secrets of the client, disqualification is unnecessary "); *Hamilton v. Dowson Holding co.*, Civ. No. 2008/02, 2009 WL 2026327, *4 (D.V.I. Jul. 2, 2009)("[W]here a nonlawyer employee has learned the confidences of an adversary, a rebuttable presumption arises that the nonlawyer employee will disclose the confidential information to the new employer. . . . [o]nce the presumption arises, it must be rebutted by competent evidence that the nonlawyer employee has not shared any confidential evidence with the new firm."). In addition, an absolute finding of no possible inadvertent sharing is not required to successfully rebut the presumption. Applying Seventh Circuit law, the Federal Circuit has stated that "[a]n *absolute* finding of no *possible* inadvertent sharing of confidences is not required to establish an effective rebuttal. The proof of a negative renders certainty virtually impossible." *Panduit Corp. v. All States Plastic Mfg. Co., Inc.*, 744 F.2d 1564, 1580 (Fed. Cir. 1984) (emphasis in original). *Panduit* also notes that "nowhere in Seventh Circuit opinions has proof of *formal screening* been delineated as the *sine qua non* of establishing the nonexistence of the presumed fact that confidences have been shared." *Id.*

Under some circumstances, significant weight may be given to uncontroverted affidavits that "unequivocally state that [the conflicted employee] did not provide the affiants with any confidential information" concerning the prior matter. *Reilly v. Computer Associates Long–Term Disability Plan*, 423 F. Supp. 2d 5, 11 (E.D.N.Y. 2006). However, even in those cases, the courts have looked to more than just the affidavits, including the context in which the affidavits are offered, and the manner in which the information has been corroborated, to determine whether or not the presumption has been sufficiently rebutted. In *1210 Colvin Ave., Inc. v. Tops Markets, L.L.C.* No. 03CV0425E, 2006 WL 3827429, *9 (W.D.N.Y. Dec. 28, 2006), while the court concluded that the presumption was sufficiently rebutted where affidavits from the attorneys at issue had been provided, denying any improper disclosure such that the law firm disqualification was denied, the court granted the defendant's motion to disqualify the plaintiff's trial consultants, Bridgepoint Partners, LLC, because certain employees of Bridgepoint had been former employees of Defendant:

> [N]o one would seriously contend that a court should permit a consultant to serve as one party's expert where it is undisputed that the consultant was previously retained as an expert by the adverse party in the same litigation and received confidential information from the adverse party pursuant to the earlier retention.

Id. at *5. In addition, the law firm at issue in *1210 Colvin Ave.* had addressed the potential conflict immediately with Bridgepoint Partners, ensuring that no confidential information would be transferred or discussed. Here, in contrast, Mr. Greer was neither screened off nor advised by his employer to not share any information pertaining to *Tyco I*; rather, he was specifically assigned to the Ethicon matter.

More recently, Judge Wood found that disqualification of a law firm was not warranted because there was "no real risk that the trial will be tainted." *Arista Records*, 2011

WL 672254, *5–6. There, Wilkie Farragher, the law firm whose disqualification was sought, submitted "a declaration from [the conflicted attorney] attesting to the fact that he has never disclosed Plaintiffs' confidential information to anyone" and "declarations from every member of Wilkie's LimeWire team who has billed 50 hours or more to the LimeWire matter attesting to the fact that [he] has not disclosed confidential information to them." *Id.* at *6. Significantly, the conflicted attorney in *Arista Records* had never been assigned to the LimeWire matter, and the court noted several other factors that led to its decision to deny disqualification: "Defendants are not relying solely on attorney affidavits, but are also relying on electronic audits showing that Korn has never accessed any Limewire documents. . . Wilkie is a large law firm, with more than 600 lawyers worldwide. . . [which] makes the risk of inadvertent disclosure of confidences less likely. . . . [and] Finally, approximately 32 months has elapsed.")[7]

In *Panduit*, a patent case which Defendant relies on as support for its argument that "the presumption of sharing between partners of a firm can be overcome by testimonial evidence, despite the absence of screening," Mr. Conte, the conflicted employee, had worked at a firm that had filed approximately 170 patent applications on behalf of Panduit, the plaintiff, and then in 1976, Mr. Conte left that firm to start his own firm, which ended up on the opposite side of Panduit's litigation. *Id.* at 1568–69. While with his former employer, Mr. Conte had never been assigned to or worked on any Panduit matters, and was never "consulted informally on any Panduit matter." *Id.* In reversing the District

[7] Judge Wood cited a number of factors which contributed to her denial of disqualification, but emphasized that "Korn's statement that he has not shared confidences" was one of the "most significant[]." *Arista Records*, 2011 WL 672254, *7.

Court's disqualification ruling, the Federal Circuit reasoned that the conflicted employee at issue was "not shown to have any confidences," and that "his taint [was] vicarious." 744 F. 2d at 1580.

Thus, even in the instances where courts conclude that affidavits attesting to the absence of shared confidences were credible, more was required. *See, e.g., Simons v. Freeport Mem. Hosp.*, No. 06CV50134, 2008 WL 5111157, *7 (N.D. Ill. 2008) (plaintiff's attorney who spoke with opposing counsel's expert twice before realizing she had been retained by opposing counsel, who promptly ceased all communication with the expert and provided two uncontradicted affidavits, was found to have sufficiently rebutted the presumption) (quoting *Cromley v. Bd. of Educ. Of Lockport Twp. High Sch. Dist. 205*, 17 F.3d 1059, 1065 (7th Cir. 1994)); *MMR/Wallace*, 764 F. Supp. at 726 ("[i]n support of its claim that no confidential information was ever disclosed by Willett or received by Forstadt, Thames relies solely upon Willett's deposition testimony and affidavits submitted by attorney Forstadt and a Thames technical consultant . . . self–serving protestations [which] fail to clearly and effectively rebut the presumption that confidential information was exchanged").

2. Whether Opportunity of Disclosure is Sufficient to Establish a Risk of Trial Taint

Because "[e]ven the most rigorous self-discipline might not prevent a lawyer from unconsciously using or manipulating a confidence acquired in an earlier representation and transforming it into a telling advantage in the subsequent litigation," *Emle*, 478 F.2d at 571, "[w]here it can reasonably be said that . . . the attorney *might* have acquired information related to the subject matter of his subsequent representation . . . it is the court's duty to

order the attorney disqualified." *Id.*, 478 F.2d at 571. In *MMR/Wallace*, the court concluded "[e]ven if, as defendant maintains, no confidential information was actually disclosed, Forstadt's alliance with Willett creates a "nagging suspicion" that Thames' preparation and presentation has already been unfairly benefitted. At the very least, Forstadt's contact with Willett has likely stripped MMR of a valuable litigation resource whose services to the plaintiff are not likely to be easily replaced." 764 F. Supp. at 727. Though Attorney Forstadt contended that he was unaware at the time of the interview that [the conflicted employee, Willett] had performed any work for plaintiff's attorneys or was important to the preparation of their case in any way, *id.* at 715 n.4, Judge Burns found that "Forstadt's continued representation of Thames Associates threatens to taint the integrity of this case." *Id.* at 727.

In *Williams v. Trans World Airlines*, 588 F. Supp. 1037, in which a non–lawyer had worked for one party and then communicated with the other party's counsel, the court granted the motion for disqualification, and emphasizing the "potential for unfair discovery":

> [T]he potential for unfair discovery of information through private consultation rather than through normal discovery procedures threatens the integrity of the trial process. The Linde, Thomson firm has direct access to confidential information because of its representation of [the conflicted employee, Campell Schanck]. No effort has been made to prevent the Linde, Thomson attorneys representing Williams and Boeding from having access to Campbell Schanck and any information she may furnish to her Linde, Thomson attorney.

588 F. Supp. at1045 (internal citations omitted).

In contrast, other cases conclude that the "appearance of impropriety" standard, or a "nagging suspicion," are not sufficient to demonstrate taint. *See 1210 Colvin Ave.*, 2006 WL 3827429, *9 (where the only "threat of taint" is a "lingering nagging suspicion" that one side has been unfairly disadvantaged, and the court has already disqualified the conflicted trial consultants, disqualification of counsel is unwarranted); *Panduit*, 744 F.2d at 1581 (where confidential information may have been received "at some remote time in the past," the "probability that any such revival of memory would materially assist the opposing party is "very small").

As rebuttal evidence, Defendant has provided the affidavits of Mr. Greer himself, Ms. Dianne Elderkin, Trial Counsel for Ethicon and partner at Akin Gump, Mr. Ruben Munoz, an associate, Ms. Marisa Browndorf, a paralegal, and Mr. Joseph Ficocello, Director of Trial Services at Akin Gump. Each affiant states that Mr. Greer did not share any confidential information with him or her. In addition, Defendant asserts that as soon as Plaintiffs objected to Mr. Greer's work on the Ethicon matter, Mr. Greer was then immediately walled off and instructed to stop working on the case. (*See* Ficocello Dec. ¶ 29; Greer Dec. ¶ 18.) At oral argument on November 15, 2011 Counsel for Defendant represented that Mr. Greer was both removed from the case and that all of the files that he had worked on or created in the Ethicon matter were going to be destroyed.

After careful consideration of these affidavits and attestations, the Court concludes that the presumption of sharing has not been sufficiently rebutted here. Though the affidavits of Mr. Munoz, Ms. Browndorf, and Mr. Ficocello are technically uncontroverted, they are nonetheless "self–serving protestations" that, viewed with the rest of the evidence of record in the context of Mr. Greer's 80 hours working on this case with counsel, staff,

and experts, do not "clearly and effectively rebut the presumption that information was exchanged" at some level. *MMR/Wallace*, 764 F. Supp. at 726. Akin Gump's handling of Mr. Greer's employment in April, assignment to the Ethicon matter and delay in notifying Plaintiffs' counsel reflect a rather astonishing tone deafness, compounded by Akin Gump's resistance to allowing Mr. Greer to be deposed. (*See* Pretrial Tr. at 24:1–4 ("So, the idea that counsel wants to now take a deposition and get into all our work product in this case I think is entirely overblown and we think the matter should be put to rest.").) When the deposition did eventually take place pursuant to this Court's order, Mr. Greer was represented by Mr. Munoz. That Mr. Greer, as a new Akin Gump employee, was deposed on the issue of the scope of his involvement in *Tyco I* and subsequent involvement with Ethicon on the same case, with his new employer in the room, creates cause for concern that the information forthcoming in his deposition may have been less than fulsome. Further, it is hard to see what weight should be given to Ms. Elderkin's affidavit, given her unsubstantiated minimization of the role that Mr. Greer had had, stating, "it was and is still my understanding that Mr. Greer had no substantive involvement in the case, before being removed." (Elderkin Dec. ¶ 16.) The record clearly shows that Mr. Greer had substantive involvement, working on slide creation and layout on at least three different presentation areas in preparation for trial, had "review session[s]" with damages expert Jeffrey Press and telephone conferences with Mr. Munoz, the substance of which the record is silent on, and expended nearly 80 hours on this work over nearly four weeks.

During the course of his work on Ethicon, Mr. Greer's billing records and his affidavit show that he worked on three distinct areas of Ethicon's trial presentation: he assisted with slides for the opening statement, worked on a timeline for the "section 102(g)

defense," and worked on the damages section. In particular, the Court finds that his work on the timeline and the damages segment are both causes for concern. Ethicon's timeline presentation is directed to one of Ethicon's affirmative defenses—that of non–infringement by prior invention—as well as its rebuttal to Tyco's claim of willfulness.

His work on the damages portion of Ethicon's presentation involved working with both Attorney Munoz and Ethicon's damages expert. During *Tyco I*, even if Mr. Greer had not himself prepared slides pertinent to Tyco's damages presentation, he was present when they were preparing their damages expert, Dr. Phillip Beutel, to testify. Thus, Mr. Greer has had the opportunity to work on both sides of the damages issue, which, unlike some other, more complicated aspects of this patent infringement case, is not as technical.

Further, that Ethicon knowingly placed Mr. Greer on the very same matter that he had worked on four years ago creates more than a nagging suspicion of taint. The record shows that TrialGraphix had a strict conflicts–checking policy: According to James Watkins, the Director of Operations at TrialGraphix, should TrialGraphix provide services for multiple parties to any proceeding, TrialGraphix "will implement internal screening processes to address the confidentiality concerns of all parties involved and would not staff a Presentation Technology/Multimedia Consultant on a matter if there were any concerns." (Watkins Dec. ¶ 13.) TrialGraphix, as an outside vendor, would never have staffed Mr. Greer on the opposite side of the same litigation. The record shows that Mr. Greer himself seemed uncomfortable with being placed on the same matter, as he wrote a follow up email to Mr. Ficocello asking if Tyco had been notified of his assignment. (*See* Sept. 22, 2011 Email from Michael Greer to Joseph Ficocello, Ex. I to Ryan Dec.) In spite of this, Akin incomprehensibly insisted on staffing him on their trial team and delayed disclosure to

opposing counsel. In fact, it was only at oral argument that Defendant's counsel finally acknowledged the obvious, that "We made a mistake." From this alone, the Court finds, at minimum, a negative inference of taint.

In addition, although Mr. Greer states that he cannot remember anything of substance pertaining to his time with Tyco, there are several indications that his memory is not completely blank. He remembers the names of the Plaintiffs' trial attorneys that he worked with in 2007, he accurately remembers that the case involved "a cutting and cauterizing device," and he recalls that he was involved in "numerous prep sessions with witnesses and experts." While Mr. Greer appears to be sensitive to the need to protect confidences, his answers to Mr. Ficocello's four questions do not contain the type of detail to make a credible determination of the existence of conflict, i.e., to determine "any unfair or conflicting advantage" (*see* August 8, 2011 Email from Michael Greer to Joseph Ficocello, Ex. I to Ryan Dec.). Moreover, Ms. Elderkin was satisfied to have two non–attorneys review this critical question and delved no deeper. As the court stated in *Williams*,

> the fact that [the conflicted employee] is not an attorney does not make it less likely that she would reveal confidential information . . . . In fact, a persuasive argument can be made that a non–lawyer would be more likely to reveal confidential information. . . . A non–lawyer might not be as sensitive to the need to safeguard the confidences of his or her previous employer gained while working with an attorney.

588 F. Supp. 1037, 1043.

D. Prejudice to Parties

Finally, the Court must balance (1) the client's interest in freely selecting counsel of her choice, (2) the adversary's interest in the trial free from the risk of even inadvertent disclosures of confidential information, and (3) the public's interest in the scrupulous

administration of justice in making its determination on disqualification. See *Vincent v. Essent Healthcare of Connecticut*, 465 F.Supp. 2d 142, 145.

The Court recognizes that here, the prejudice to Ethicon in being deprived of Akin Gump, the counsel of its choice, is substantial. As counsel for Ethicon argued, "[t]he loss to Ethicon would be devastating. This trial team has been the trial team for Ethicon for over seven years. . . . To try to resurrect that, to try to get somebody up to speed in this case would be—would take years to do because theoretically these lawyers at Akin Gump couldn't even help the new counsel." *Cf. Panduit*, 744 F.2d at 1581. ("the prejudice to All States is catastrophic. Its long standing counsel, a relationship established before this case began, is no longer available and could not even consult on transfer of the case to another firm.") The Court notes that at least some of the prejudice is reduced by the fact that half of the case was previously tried and the record incorporated by agreement of counsel.

However, the Court also recognizes Tyco's interest in a trial free from the risk of even inadvertent disclosures. As Plaintiffs' counsel stated at oral argument, this is a high stakes case, "with market share at issue and much more." If Tyco prevails on all of its infringement claims, including its claim of willful infringement, Tyco believes it could be awarded upward of $600 million in damages.

It is worth remembering that both parties here are sophisticated and large corporations. In fact, counsel for Tyco described them as the "Coke and Pepsi of the medical device market," or the "Hattfields and the McCoys," at oral argument. Whatever prejudice these parties face, these are corporate clients with large litigation budgets, as compared to the party in *Reilly v. Computer Associates Long-Term Disability Plan,* 423 F.Supp.2d at 13 (E.D.N.Y. 2006), a case in which disqualification was denied, which

Defendants have cited to extensively in their briefing, where the court emphasized that "Plaintiff here is not a large corporate client with a litigation budget; rather she is an unemployed individual attempting to recover long–term disability insurance payments. . . . The lost time and money associated with this transition is of particular importance here."

The Court must also consider the public's interest in a trial free from taint and the scrupulous administration of justice, as well as the Court's role in enforcing "the lawyer's duty of absolute fidelity . . . to guard against the danger of inadvertent use of confidential information," *Hull*, 513 F.3d at 571, pertaining to an adversary's trial preparation and tactics. The Court concludes that, given the important, heightened role that Trial Presentation specialists play as the use of Courtroom technology has become more and more widespread, *see, e.g.*, "Effective Use of Courtroom Technology," Federal Judicial Center (2001), having such technology specialists properly screened and checked for conflicts is of the great importance. While the Court acknowledges that Ethicon will be prejudiced even by the partial disqualification of certain members of its trial team which the Court will order, "the loss of services of knowledgeable counsel is the type of prejudice implicated in any disqualification motion and is not the type of extreme prejudice contemplated by the courts in denying a motion on those grounds." *Actel Corp. v. Quicklogic Corp.*, 1996 U.S. Dist. LEXIS 11815, *28 (N.D. Ca. April 23, 1996). Further, though the Court is aware that disqualification motions are often brought for tactical reasons, "[e]ven if tactical advantages attend the motion for disqualification, that alone does not justify denying an otherwise meritorious motion." *Id.*

E. Order of Disqualification

Having thoroughly reviewed the record, briefing and arguments presented on the issue of whether Akin Gump should be disqualified from further representation of Ethicon in this case, Plaintiffs' motion to disqualify will be granted in part. Taking guidance from the medical devices at issue in this case, the Court finds that a minimally invasive surgical approach is appropriate to reduce Plaintiffs' pain at the prospect of disclosure of its trial strategies and tactics, lower the risk of Ethicon's hemorrhaging from total loss of its seven–year litigation relationship with the trial partners, and lessen the recovery time for the established trial schedule.

Specifically, all members of the Ethicon trial team that worked directly with Mr. Greer, i.e., Ms. Browndorf, Mr. Munoz, and the damages expert team are disqualified from any further work on this case and from any contact regarding this case with the Akin Gump trial partners Dianne Elderkin, Barbara Mullin and Steven Maslowsky, or any other attorneys working on their trial team.

By this laparoscopic approach to excising risk of transmittal of tainted information, the interests of the parties, public and the Court are put in tolerable balance. With respect to the additional fees and costs which will be incurred by Plaintiffs in relation to a deposition of Ethicon's new damages expert, Ethicon will be responsible for such reasonable costs and fees. With respect to plaintiff's request for fees and costs related to its motion preparation and deposition of Mr. Greer, they are invited to file their application, after which defendant will have 21 days for opposition to any fee award or to aspects of what plaintiffs seek.

III. Conclusion

For the reasons discussed above, Plaintiffs' Motion to Disqualify [Doc. # 97] is GRANTED in part. Marisa Browndorf, Ruben Munoz, and Ethicon's Damages Expert Team are disqualified immediately from this matter.

IT IS SO ORDERED.

____/s/_____

Janet Bond Arterton, U.S.D.J.

Dated at New Haven, Connecticut this 30th day of December, 2011.