

UNITED STATES DISTRICT COURT
DISTRICT OF CONNECTICUT

E.I. DU PONT DE NEMOURS AND	:
COMPANY,	:
Plaintiff,	:
	:
-vs-	: Misc. No. 3:03mc249(PCD)
	:
MACDERMID, INC. and	:
MACDERMID GRAPHIC	:
ARTS, INC.,	:
Defendants.	:

RULING ON MOTION TO QUASH SUBPOENA DUCES TECUM

Defendant MacDermid, Inc. (“MacDermid”) moves to quash a subpoena duces tecum¹ served on it by E.I. Du Pont De Nemours and Co. (“DuPont”). The subpoena is related to two cases pending in the District Court for the District of Delaware, *E.I. DuPont De Nemours and Company v. Macdermid, Inc. and MacDermid Graphic Arts, Inc.*, C.A. No. 02-303(KAJ), and *E.I. DuPont De Nemours and Company v. Macdermid, Inc. and MacDermid Graphic Arts, Inc.*, C.A. No. 03-456(KAJ) (“the Delaware actions”).

The Delaware actions involve claims of patent infringement by MacDermid on two of DuPont’s patents involving digitally imaged flexographic printing elements. MacDermid alleges that it is not in the business of manufacturing or selling flexographic printing elements, and that the only defendant in such business is MacDermid Graphic Arts, Inc., a separate and distinct corporate entity. A motion to dismiss pursuant to Rule 12(b)(1), (2) and (6) is pending before

¹ In the text of its memorandum in opposition, DuPont states that it cross-moves for an order compelling production. The opposition is entitled “DuPont’s Memorandum in Opposition to MacDermid Inc.’s Motion to Quash Subpoena Duces Tecum.” Only two sentences in the opposition refer to a motion to compel. There is little in the memorandum to alert MacDermid to a motion, and not surprisingly MacDermid provides no response to a motion to compel in its reply brief. As such, the motion to compel is not properly before this Court, and the memorandum is construed only as a memorandum in opposition to MacDermid’s motion.

the Delaware District Court to this effect.

MacDermid argues that various discovery request have been served on it in Delaware, that it has objected to discovery requests in the Delaware action in addition to diligently searching for documents responsive to the requests, and that it has produced approximately 39, 574 documents in the Delaware action. MacDermid further argues that the subpoena should be quashed because it requests privileged or protected information not subject to any exception, it requests documents already in DuPont's possession, it constitutes an overly broad and unduly burdensome request, and it is duplicative of requests propounded in the Delaware action. DuPont responds that the objections are without merit.

An order quashing a subpoena may issue if such subpoena "requires disclosure of privileged or other protected matter and no exception or waiver applies, or . . . subjects a person to undue burden." FED. R. CIV. P. 45(c)(iii),(iv). The burden in establishing an entitlement to an order quashing a subpoena is on the movant. *Goodman v. United States*, 369 F.2d 166, 169 (9th Cir. 1966); *see also* 9A CHARLES ALAN WRIGHT & ARTHUR R. MILLER, FEDERAL PRACTICE AND PROCEDURE § 2459 (2d ed. 1995) (discussing motion to quash subpoena). "[T]here is a particularly heavy burden upon a deponent to make a substantial showing in support of a motion to quash as contrasted to some more limited protection." *Horizons Titanium Corp. v. Norton Co.*, 290 F.2d 421, 425 (1st Cir. 1961).

The import of MacDermid's repeated reference to the motion to dismiss pending before the Delaware District Court is not apparent. MacDermid does not allege that discovery in the Delaware actions was stayed pending resolution of its motion to dismiss. Although a stay of discovery pending resolution of a motion to dismiss is not unheard of, *see Transunion Corp.*

v. Pepsi Co., Inc., 811 F.2d 127, 130 (2d Cir. 1987), such a stay is neither required nor implied by the filing of a motion to dismiss, *see Daniel J. Hartwig Assocs. v. Kanner*, 913 F.2d 1213, 1223 (7th Cir. 1990). As MacDermid provides no evidence that the Delaware District Court has ordered discovery stayed, it may not refuse requests for production based on the mere filing of a motion to dismiss.

In support of its motion, MacDermid provides only a copy of the subpoena and requests for production. As such, if not for the inclusion of the complaint from the Delaware actions by DuPont in its opposition memorandum, this Court would be left entirely in the dark as to the substance of the Delaware actions. MacDermid neither provides a list of documents produced, *see Horizons Titanium Corp. v. Norton Co.*, 290 F.2d at 425, nor does it provide requests for production served in the Delaware action. Finally, MacDermid alleges in conclusory fashion that the documents sought are privileged or otherwise protected. “It is axiomatic that the burden is on a party claiming the protection of a privilege to establish those facts that are the essential elements of the privileged relationship, . . . a burden not discharged by mere conclusory or ipse dixit assertions.” *In re Grand Jury Subpoena*, 750 F.2d 223, 224 (2d Cir. 1984)) (internal quotation marks and citations omitted). Based on the foregoing, MacDermid has failed to satisfy its “particularly heavy burden” for issuance of an order quashing a subpoena.

Should the parties wish to revisit discovery issues as to the pending Delaware actions, it is strongly suggested that they do so in Delaware. Although this Court is obliged to hear discovery motions related to actions in other courts pursuant to FED. R. CIV. P. 45(c)(1), the procedure is highly inefficient. As evidenced by the above standards, in order to prove an

entitlement to discovery orders, parties must familiarize a this Court with all that has transpired in another court. The present motion could be resolved with relative ease by the Delaware District Court through a motion for protective order, particularly so in this case as both the movant and non-movant are parties in the Delaware actions, not non-parties over which the Delaware District Court may lack jurisdiction.

The motion to quash (Doc. No. 1) is **denied**. The Clerk shall close the file.

SO ORDERED.

Dated at New Haven, Connecticut, August ____, 2003.

Peter C. Dorsey
United States District Judge