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# Ii. Civil Procedure

cused on interstate commerce considerations.

The Fourth Circuit examined the activity of the Fairfax County Bar Association and determined that the association sought only to regulate a "general local service."[23] The court dismissed as insignificant the fact that many homeowners seeking legal services in Northern Virginia worked outside of the State. The court thus found that the practice of law regulated was wholly intrastate.[24] Noting that the alleged restraint of trade or commerce must be shown to affect interstate commerce in order to base a claim on a violation of the Sherman Act, the court held that the lack of interstate commerce in the present case was a jurisdictional defect. Thus, it reversed the district court's judgment for the plaintiff against the Fairfax County Bar Association.

Two recent developments, one judicial and one legislative, have resulted in keeping current the issues discussed in *Goldfarb*. Specifically, the United States Supreme Court granted certiorari to *Goldfarb* in October 1974.[25] In addition, state statutes, modelled after the federal anti-trust statutes, have been erected in several jurisdictions.[26] In such states the interstate commerce requirement relied on by the Fourth Circuit in its decision would be irrelevant.

S.E.L.

## II. CIVIL PROCEDURE

**A. Applicability of Work Product Doctrine in Subsequent Litigation**—*Duplan Corporation v. Moulinage et Retorderie de Chavanoz*, 487 F.2d 480 (4th Cir. 1973) and Civil No. 74-1221 (4th Cir. 1974).

The Fourth Circuit recently became the first[1] federal circuit court to decide whether the immunity from discovery afforded "work prod-

[23] *Id.* at 18.

[24] 497 F.2d at 18.

[25] Certiorari was granted on October 29, 1974. See note 1 *supra*.

[26] For example, in Virginia a state antitrust act patterned after the federal statutes was enacted effective July 1, 1974, VA. CODE ANN. §§ 55.1-9.1 to 9.18 (1974). Under this act there is no requirement that the action questioned be related to interstate commerce.

[1] *See* Note, *Discovery of an Attorney's Work Product in Subsequent Litigation*, 1974 DUKE L.J. 799 at 817 n.95 (1974). The author of that note states that *Duplan* is

uct" material[2] under Rule 26(b)(3) of the Federal Rules of Civil Procedure[3] applies to this material after the termination of the litigation for which it was prepared. In two appeals[4] arising out of an initial district court decision in *Duplan Corp. v. Deering Milliken, Inc.*,[5] the Fourth Circuit held that once material qualifies for Rule 26(b)(3) protection, it will continue to be so protected in all future proceed-

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only the second case dealing with the issue of discovery of a lawyer's work product in subsequent litigation. The other case dealing with this issue is Republic Gear Co. v. Borg-Warner Corp., 381 F.2d 551 (2d Cir. 1967). That case, however, dealt with work product materials developed in prior unterminated litigation whereas *Duplan* addressed the issue of work product materials developed in prior *terminated* litigation.

[2] In Hickman v. Taylor, 329 U.S. 495 (1947) the Supreme Court described work product as follows:

> Proper preparation of a client's case demands that he [the lawyer] assemble information, sift what he considers to be the relevant from the irrelevant facts, prepare his legal theories and plan his strategy without undue and needless interference . . . . This work is reflected, of course, in interviews, statements, memoranda, correspondence, briefs, mental impressions, personal beliefs, and countless other tangible and intangible ways—aptly though roughly termed by the Circuit Court of Appeals in this case as the "work product of the lawyer."

*Id.* at 511.

[3] FED. R. CIV. P. 26(b)(3) provides in pertinent part:

> (3) *Trial Preparation: Materials.* Subject to the provisions of subdivision (b)(4) of this rule, a party may obtain discovery of documents and tangible things otherwise discoverable under subdivision (b)(1) of this rule and prepared in anticipation of litigation or for trial by or for another party or by or for that other party's representative (including his attorney, consultant, surety, indemnitor, insurer, or agent) only upon a showing that the party seeking discovery has substantial need of the materials in the preparation of his case and that he is unable without undue hardship to obtain the substantial equivalent of the materials by other means. In ordering discovery of such materials when the required showing has been made, the court shall protect against disclosure of the mental impressions, conclusions, opinions, or legal theories of an attorney or other representative of a party concerning the litigation.

[4] In the first appeal the Fourth Circuit addressed the issue of immunity from discovery in subsequent litigation of "factual" work product materials developed in prior terminated litigation. These materials were documents and tangible things which did not contain any mental impressions, conclusions, opinions or legal theories of an attorney or other representative of a party concerning the litigation. Duplan Corp. v. Moulinage et Retorderie de Chavanoz, 487 F.2d 480 (4th Cir. 1973) [hereinafter cited as *Duplan I*]. In the second appeal the court addressed the issue of immunity from discovery in subsequent litigation of "opinion" work product materials developed in prior terminated litigation. These materials were "documents" and "tangible things" which did contain mental impressions, conclusions, opinions or legal theories. Duplan Corp. v. Moulinage et Retorderie de Chavanoz, Civil No. 74-1221 (4th Cir., Oct. 18, 1974) [hereinafter cited as *Duplan II*].

[5] 61 F.R.D. 127 (D.S.C. 1973).

ings. The court concluded that work product material must be accorded the same protection in subsequent and unrelated litigation as it received in the prior terminated litigation for which it was prepared.

The basis for both appeals was a suit in which plaintiff Duplan Corporation charged the defendant with patent and antitrust violations.[6] In preparation of its case, Duplan sought discovery of work product materials prepared by the defendant's attorneys in connection with a prior suit which had resulted in settlement agreements between the defendant and third parties. Duplan also sought discovery of documents evidencing the defendant's knowledge of the state of the prior art involved in its patented process with respect to this previous agreement.[7] The district court[8] ruled that the work product materials prepared in connection with prior terminated litigation were discoverable in the present litigation and ordered production of the requested materials.[9] The court concluded that upon final termination of litigation, either by decision or settlement, the immunity afforded the work product prepared for the litigation also ceased. The district court certified its order for interlocutory consideration pursuant to 28 U.S.C. § 1292(b)[10] and the Fourth Circuit permitted an appeal from the order.

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[6] *See* Note, *Discovery of an Attorney's Work Product in Subsequent Litigation,* 1974 DUKE L.J. 799 at 816 n.88 (1974).

[7] *See* 487 F.2d at 481 n.2 where the court noted:

> [t]he documents claimed by [Chavanoz] to be work product were generated incident to (1) a series of lawsuits in the early 1960s in which Leesona Corporation claimed that United States patents owned by it were infringed by the sale and operation of machines manufactured by a licensee of Chavanoz, or (2) a series of proceedings in foreign countries relative to the validity and infringement of foreign counterparts to the Chavanoz patents here in issue. It is further conceded that each of these litigations was terminated prior to the commencement of the present case.

*See also* Civil No. 74-1221 at 4-5 nn. 2 & 3.

[8] Duplan Corp. v. Deering Milliken, Inc., 61 F.R.D. 127 (D.S.C. 1973).

[9] *Id.* at 135.

[10] 28 U.S.C. § 1292(b) (1970) reads in pertinent part:

> When a district judge, in making in a civil action an order not otherwise appealable under this section, shall be of the opinion that such order involves a controlling question of law as to which there is substantial ground for difference of opinion and that an immediate appeal from the order may materially advance the ultimate termination of the litigation, he shall so state in writing in such order. The Court of Appeals may thereupon, in its discretion, permit an appeal to be taken from such order, if application is made to it within ten days after the entry of the order . . . .

In *Duplan I*[11] the Fourth Circuit reversed the district court's decision and held that the *qualified* immunity from discovery afforded work product materials continued beyond the litigation for which the materials were prepared, and applied in any subsequent case or litigation.[12] This immunity was described as "qualified" because the materials sought to be discovered were not claimed to be "opinion" work product.[13] Therefore, these "factual" materials[14] were discoverable on a showing of substantial need for the materials and undue hardship in obtaining equivalent materials.[15] The Fourth Circuit concluded that absent a showing of both these conditions, "factual" work product materials prepared in connection with prior terminated litigation were immune from discovery in subsequent and unrelated litigation.

Since neither the text of Rule 26(b)(3) nor the accompanying Advisory Committee Note[16] addresses the question of immunity for product materials in subsequent litigation, the Fourth Circuit relied upon the Supreme Court decision from which Rule 26(b)(3) was derived, *Hickman v. Taylor*.[17] In *Hickman* the Court considered whether materials gathered in preparation for trial by an attorney were freely discoverable by the opposing party. The Court noted the conflicting interests of protecting an attorney's files and records from unwarranted searches and the public policy that encouraged reasonable and necessary inquiries in preparation for litigation.[18] The Court also recognized that the orderly work of the adversary system was dependent upon the privacy afforded an attorney's efforts.[19] After weighing these factors, the Supreme Court held that materials prepared in anticipation of litigation by an attorney were discoverable only upon a showing of "necessity or justification."[20]

The Fourth Circuit interpreted *Hickman* as standing "for the principle that the integrity of the adversary process must be safeguarded in spite of the desirability of the free interchange of informa-

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[11] 487 F.2d 480 (4th Cir. 1973).

[12] The court stated: "On balance we think the legal profession and the interests of the public are better served by recognizing the qualified immunity of work product materials in a subsequent case as well as that in which they were prepared . . . ." 487 F.2d at 484.

[13] Civil No. 74-1221 at 7.

[14] *See* note 4 *supra* for definition of "factual" work product.

[15] FED. R. CIV. P. 26(b)(3), note 3 *supra*.

[16] *See* 28 U.S.C. FED. R. CIV. P. 26 at 7777-82 (1970).

[17] 329 U.S. 495 (1947).

[18] *Id.*

[19] *Id.* at 512.

[20] *Id.* at 510.

tion before trial."[21] The court then decided that a policy of unrestricted discovery in a *Duplan I* situation would subject the adversary process to the same dangers which the *Hickman* procedure attempted to eliminate or minimize.[22] Therefore, the Fourth Circuit concluded that the holding of *Hickman* should apply to "factual" work product materials in subsequent litigation even though the materials emanated from prior terminated litigation.

Upon remand, the district court directed the defendant, Chavanoz, to produce some one hundred documents.[23] In response to this order, Chavanoz produced fifty-eight documents, withholding the remaining forty-seven on the ground that Rule 26(b)(3) absolutely protected them from discovery. Chavanoz contended that the withheld materials contained mental impressions, conclusions, opinions and legal theories which were prepared in anticipation of litigation or for trial by the defendant's attorneys and other representatives.[24] The defendant claimed that the last sentence of Rule 26(b)(3)[25] afforded these "opinion" work product materials absolute immunity from discovery. This claim notwithstanding, the district court ordered the defendant to produce twenty-two or the remaining documents.

In so ruling, the district court held that materials which included mental impressions, conclusions, opinions or legal theories relating to the litigation for which they were developed need not always remain characterized as such. The court noted that following the termination of the initial proceedings, these "opinion" materials may constitute "operative facts"[26] in subsequent litigation. The district court decided that if such a change were to occur, then the court need not

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[21] 487 F.2d at 482-83.

[22] *Id.* at 483.

[23] Civil No. 74-1221 at 8.

[24] *Id.*

[25] *See* note 3 *supra.*

[26] *See* Civil No. 74-1221 at 12 n.7 where the court stated:

> Because it was contended here that the 1964 settlement agreements between Leesona Corporation and the patent owner, Chavanoz, were in fact an antitrust conspiracy, the district court ordered production of certain opinion work product materials since "the mental impressions, opinions, conclusions and legal theories of the attorney in the prior litigation are now operative facts as to the motive and intent of the parties at the time of the settlement." . . . As to the contentions that fraud was practiced on the U.S. Patent Office, the court ordered production of similar materials since "the mental impressions, opinions, conclusions, and legal theories of the attorneys prosecuting the patent applications for Chavanoz are now operative facts as to the motive and intent of the patent owner . . . ."

afford the documents absolute immunity from discovery.[27] Consequently, the court in ordering the defendant to produce some of the controverted documents held that if the party seeking discovery demonstrated the requisite "substantial need" and "undue hardship," the court in its discretion could order the production of this type of document.

On appeal, the Fourth Circuit considered the work product materials of *Duplan* for a second time.[28] The court held that "opinion" work product materials, as distinguished from materials not containing mental impressions, conclusions, opinions or legal theories, were absolutely immune from discovery even though the litigation for which they were prepared had been concluded.[29] "[N]o showing of relevance, substantial need or undue hardship would justify compelled disclosure of an attorney's mental impressions, conclusions, opinions or legal theories."[30]

The Fourth Circuit again based its holding on the language contained in Rule 26(b)(3) and the policies underlying the *Hickman* decision, explaining that the last sentence of Rule 26(b)(3) commanded the courts to afford "opinion" work product materials absolute immunity from discovery.[31] The *Hickman* holding established that the thought processes of lawyers must be protected from public examination in order to allow them to perform their duties effectively. The court concluded that allowance of discovery in *Duplan II* would jeopardize the very activities that *Hickman* sought to protect. Therefore, the court held that the policies of *Hickman* which were implemented by Rule 26(b)(3) should be extended to a *Duplan II* situation.[32]

Noteworthy, however, is the fact that the court's holding did not absolutely preclude discovery of documents containing mental impressions, conclusions, opinions or legal theories. The court held that such documents were discoverable after the examining court excised all mental impressions, conclusions, opinions or legal theories.[33] Thus, in subsequent litigation, "factual" work product material pre-

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[27] *See* note 25 *supra*.

[28] Duplan Corp. v. Moulinage et Retorderie de Chavanoz, Civil No. 74-1221 (4th Cir., Oct. 18, 1974).

[29] *Id.* at 3.

[30] *Id.* at 11-12.

[31] The court noted the use of the word "shall" rather than "may" in the second sentence of Rule 26(b)(3), note 3 *supra,* to support this proposition. *Id.* at 11-12.

[32] *Id.* at 19.

[33] *Id.* at 21. *See* 8 WRIGHT and MILLER, FEDERAL PRACTICE AND PROCEDURE § 2024 at 202 (1970).