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**UNITED STATES INTERNATIONAL TRADE COMMISSION**

**Washington, D.C.**

**In the Matter of**

**CERTAIN MULTI-STAGE FUEL VAPOR  
CANISTER SYSTEMS AND ACTIVATED  
CARBON COMPONENTS THEREOF**

**Inv. No. 337-TA-1140**

**ORDER NO. 20: DENYING-IN-PART RESPONDENTS' MOTION TO ENFORCE  
ORDER NO. 11 AND/OR COMPEL DISCOVERY REGARDING  
INGEVITY'S METHODS FOR AND RESULTS OF TESTING  
INCREMENTAL ADSORPTION CAPACITY**

(August 1, 2019)

On July 15, 2019, respondents MAHLE Filter Systems North America, Inc., MAHLE Filter Systems Japan Corp., MAHLE Sistemas de Filtración de México S.A. de C.V., and MAHLE Filter Systems Canada ULC, Kuraray Co., Ltd., Calgon Carbon Corporation, and Nagamine Manufacturing Co., Ltd. (collectively, "Respondents") moved (1140-012) to compel complainants Ingevity Corp. and Ingevity South Carolina, LLC ("Ingevity") to produce discovery responses and deposition testimony regarding Ingevity's testing of incremental adsorption capacity ("IAC"). Specifically, Respondents move to compel:

[D]ocuments, interrogatory responses, and deposition testimony concerning Ingevity's test methods (including test conditions and the identity of the product under test) and test results from all prior testing of the "incremental adsorption capacity" ("IAC") of any (1) canister containing an Ingevity domestic industry product (*e.g.*, any canister produced by Ingevity's customers), (2) Ingevity domestic industry product itself, (3) canister containing Respondents' accused MPAC activated carbon product, including any accused MAHLE canister, and (4) MPAC itself.

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(Mot. at 1.) Respondents add that, to the extent the motion to compel is granted, some form of monetary or non-monetary sanctions are warranted in light of Order No. 11. (*See id.* at 1-2.) On July 25, 2019, Ingevity opposed the motion. Respondents' motion (1140-012) is hereby denied-in-part.

The scope of discovery in this investigation is governed by Commission Rule 210.27(b), which provides that a party may obtain discovery of non-privileged information that is relevant to, among other things, a claim or defense of the party seeking discovery. 19 C.F.R. § 210.27(b). Even information that would be inadmissible at the hearing is discoverable if it appears reasonably calculated to lead to the discovery of admissible evidence. *Id.*

The party moving to compel has the “initial burden” to show the relevance of the information sought, and, if the moving party is successful, then the party resisting discovery has the burden of proving that the request is improper. *See Certain Wireless Consumer Electronic Devices*, 337-TA-853, Order No. 23, at 3 (Apr. 4, 2013). “Discovery should be permitted on the basis of relevance unless the resisting party demonstrates that the information sought can have no bearing on the action or is clearly irrelevant.” *Certain Computer Forensic Devices & Prod. Containing Same*, Inv. No. 337-TA-799, Order No. 44, at 2 (May 1, 2012).

Here, Respondents have shown that the discovery sought is relevant to the issues in this investigation, as testing for a particular adsorbent or canister volume’s “incremental adsorption capacity” is directly tied to the practice or non-practice of the asserted claims of asserted U.S. Patent No. RE38,844 (“the ’844 patent”). (*See, e.g.*, ’844 patent at cl. 1.) Respondents then describe how, in seeking this information, they were met with claims of privilege and work product protection allegedly “cover[ing] not just pre-suit testing, but all of Ingevity’s IAC tests

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and results.” (See Mot. Mem. at 2-5.) Respondents argue these claims are misplaced for three reasons. First, Respondents argue attorney work product protection is simply inapplicable under the basic idea that “test results are not privileged.” (Mot. Mem. at 10 (citing *inter alia For Your Ease Only, Inc. v. Calgon Carbon Corp.*, 02 C 7345, 2003 U.S. Dist. LEXIS 7131, at \*6-7 (N.D. Ill. Apr. 24, 2003)).) Respondents extend this idea, given in the context of attorney-client privilege, over to work product protection. (*Id.* at 12 (citing *ECDC Envtl., L.C. v. New York Marine & Gen. Ins. Co.*, No. 96 Civ. 6033, 1998 U.S. Dist. LEXIS 8808, at \*44 (E.D.N.Y. June 5, 1998); *In re Savitt/Adler Litig.*, 176 F.R.D. 44, 46 (N.D.N.Y. 1997)).)

Second, Respondents argue that even if there was protection, it has been waived through Ingevity’s reliance on “this testing as a ‘sword’ to show that the accused and/or domestic industry products meet claim elements 1[A]-[B], in both the Complaint and now in contentions . . . .” (See Mot. Mem. at 14; see also *id.* at 15 (“Ingevity’s attorneys admit that Ingevity is disclosing some MPAC testing to support its case while withholding other MPAC testing pursuant to privilege. . . . However, by selectively relying on its IAC testing in the claim charts attached to the Complaint and its contentions, Ingevity waived any attorney-client privilege or work product immunity that previously applied over any other IAC test methods or results.”).) Respondents add, “[u]nder the doctrine of implied subject matter waiver, Ingevity also waived any privilege that previously applied to any material related to, and necessary and proper to the evaluation of, the test methods and results relied upon in the Complaint or its contentions.” (*Id.* at 15 (citing *Certain Audio Processing Hardware and Software and Prods. Containing Same*, Inv. No. 337-TA-949, Telephonic Hr’g. Tr. at 17 (Sept. 1, 2015); *Certain Network Controllers and Prods. Containing Same*, Inv. No. 337-TA-531, Order No. 15 at 4 (July 19, 2005)).)

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Third, Respondents argue, even if work product protection applies, and there had been no waiver, the discovery is still appropriate because they “face a substantial need for, and undue burden in obtaining, materials related to IAC test methods and results.” (Mot. Mem. at 16.) Specifically, Respondents claim they have a substantial need “to discover how Ingevity tests for IAC of the accused and domestic industry products and the results of any such tests” because they themselves “cannot conduct their own apples-to-apples tests of the IAC of the accused and/or domestic industry products without knowing which test Ingevity used.” (*Id.* at 16-17.)

I am not persuaded to compel the requested information under any of the three grounds. As to the first, I do not understand how work product protection would cease to exist simply because the materials under consideration happen to contain facts, such as test results. If those results were created in anticipation of litigation and pursuant to instruction from counsel, then they qualify for protection unless otherwise relied upon, waived, or subject to a substantial need from an opposing party. As stated by the Supreme Court:

The [work product] doctrine is an intensely practical one, grounded in the realities of litigation in our adversary system. One of those realities is that attorneys often must rely on the assistance of investigators and other agents in the compilation of materials in preparation for trial. It is therefore necessary that the doctrine protect material prepared by agents for the attorney as well as those prepared by the attorney himself.

*U.S. v. Nobles*, 422 U.S. 225, 238-9 (1975). Under this guidance, and in practical terms, Ingevity’s testing personnel appear to have been used by counsel in a role akin to a non-testifying expert performing pre-suit investigation—a circumstance in which Federal Rule of Civil Procedure 26 expressly protects “facts known”:

(D) Expert Employed Only for Trial Preparation. Ordinarily, a party may not, by interrogatories or deposition, discover facts known or opinions held by an expert who has been retained or specially employed by another

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party in anticipation of litigation or to prepare for trial and who is not expected to be called as a witness at trial. But a party may do so only:

(i) as provided in Rule 35(b); or

(ii) on showing exceptional circumstances under which it is impracticable for the party to obtain facts or opinions on the same subject by other means.

Fed. R. Civ. P. 26(b)(4)(D).

With respect to the second ground, waiver, I agree that Ingevity has waived protection as to the testing results and methods relied on to support its claims of infringement and technical prong domestic industry. To the extent Ingevity possesses but has not produced responsive information as to the methods and results of the tests so relied on, they must do so. (*Compare* Mot. Mem. at 16 (“Ingevity refuses to disclose how it allegedly determined the IAC of the accused and domestic industry products”) *with* Opp. at 5-6 (“In response to [Order No. 11], Ingevity produced additional information in the form of documents and supplemental interrogatory responses . . . [including] pre-suit testing results (from Dr. Ritter) upon which Ingevity relied in filing its Complaint . . . and for purposes of its initial infringement contentions. . . . Ingevity has not relied upon any other IAC testing data in its responses to contentions regrading infringement or the technical prong of the domestic industry requirement.”).)

I do not, however, agree that Ingevity’s waiver extends “to all test methods . . . and test results . . . regarding any IAC testing of any accused product or domestic industry product” as Respondents would like. (Mot. Mem. at 15.) The Supreme Court has endorsed an approach to work product waiver such that its scope is commensurate with the use of the material that would have otherwise been protected. *See Nobles*, 422 U.S. at 240-1. Respondents’ request goes beyond this. Indeed, if all attorney-instructed testing methods and results of a nature similar to

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those relied on in support of a claim needed to be produced, there would be little left for Federal Rules of Civil Procedure 26(b)(3) and (4) to protect.

With respect to Respondents' third ground, substantial need, I disagree that disclosure of all testing methods and results of any accused product or domestic industry product is necessary to provide the "apples-to-apples" comparison Respondents desire. (Mot. Mem at 16-17.) The "apples-to-apples" comparison referred to means that the testing Ingevity performs to show infringement be the same as the testing Respondents perform to show non-infringement. This can be accomplished once the testing methods Ingevity employed for its claims are known; and, as mentioned above, to the extent Ingevity still possesses but has not produced this information, it must do so. Nothing more is needed. I further disagree that Respondents "have a substantial need to discover *any* IAC test results that fall outside the parameters of the asserted claims." (Mot. Mem. at 17 (emphasis added).) Rather, Respondents have a substantial need to discover *if* their accused products' IAC falls outside the parameters of the asserted claims and, again, once the methods Ingevity employed in support of its claims are known, Respondents are in an equally good position to answer this question.

Accordingly, Respondents' motion (1140-012) is hereby denied-in-part. For the avoidance of any doubt in connection with this order, Respondents' request for sanctions is denied.

Within seven days of the date of this document, the parties shall submit to the Office of the Administrative Law Judges a joint statement as to whether or not they seek to have any portion of this document deleted from the public version. If the parties do seek to have portions of this document deleted from the public version, they must submit to this office a copy of this

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document with red brackets indicating the portion or portions asserted to contain confidential business information. The submission may be made by email and/or hard copy by the aforementioned date and need not be filed with the Commission Secretary.

**SO ORDERED.**

A handwritten signature in black ink, appearing to read "C. Elliot", written over a horizontal line.

Cameron Elliot  
Administrative Law Judge

**CERTAIN MULTI-STAGE FUEL VAPOR CANISTER  
SYSTEMS AND ACTIVATED CARBON COMPONENTS  
THEREOF**

INV. NO. 337-TA-1140

**PUBLIC CERTIFICATE OF SERVICE**

I, Lisa R. Barton, hereby certify that the attached **Order No. 20** has been served upon the following parties as indicated, on **AUG 13 2019**.



Lisa R. Barton, Secretary  
U.S. International Trade Commission  
500 E Street SW, Room 112A  
Washington, DC 20436

<b>FOR COMPLAINANTS INGEVITY CORP. &amp; INGEVITY SOUTH CAROLINA, LLC</b>	
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<b>FOR RESPONDENTS MAHLE FILTER SYSTEMS NORTH AMERICA, INC., MAHLE FILTER SYSTEMS JAPAN CORP., MAHLE SISTEMAS DE FILTRACION DE MEXICO S.A. DE C.V., and MAHLE FILTER SYSTEMS CANADA, ULC</b>	
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