

MEMORANDUM

DATE: December 3, 2007
TO: Professor Richard Marcus
FROM: Andrea Thomson
CC: Judge Lee H. Rosenthal
SUBJECT: Protection of attorney-expert communications at trial

This memorandum addresses certain research questions that arose during the November 2007 Civil Rules Advisory Committee meeting with respect to potential changes to rules governing disclosure of attorneys' communications with testifying experts. The primary issue that has been the focus of my research thus far deals with the application of work product protection at trial. In particular, when discussing potential protections to attorney-expert communications, the question arose as to whether any such protection in Rule 26 could extend to trial because a protection that did not endure through the trial may not effectively deter the behaviors that such protections would be designed to avoid (*i.e.*, the retention of multiple experts and the artificial means of communicating with experts to avoid creating discoverable documents). In 1975, the Supreme Court dealt with the issue of protection of attorney work product and expert work product at trial in *United States v. Nobles*. However, as noted in your email and memorandum, a lot has happened since that case was decided, including the adoption of the Federal Rules of Evidence and the possible pertinence of Rule 612(2) of those rules. Your memo regarding the application of work product protections at trial identified outstanding questions on this issue, including: (a) whether *Nobles* has been followed, (b) whether a revision to Rule 26(b)(3) would also apply at trial (versus *Hickman v. Taylor* itself), (c) whether interactions with an expert should be regarded as protected by *Hickman* itself, and (d)

whether there are any cases involving invocation of work product protection at trial to limit questioning of an expert witness. This memo provides an overview of the results of my initial research on these issues, and a discussion of some of the case law I have found that may provide some guidance on these issues is described below.

I. Whether *Nobles* Has Been Followed

In *U.S. v. Nobles*, 422 U.S. 225 (1975), the Supreme Court recognized that work product protection extends to trial. In that case, the defense had hired an investigator who interviewed the prosecution's key witnesses. The investigator created a report, which was largely inaccessible to the government's attorneys. The defense called the investigator as a witness, and the court ordered that the report be produced to the prosecution. *Id.* at 229. The defense refused to produce the report, and the court then refused to permit testimony from the investigator regarding his interviews with the prosecution's witnesses. *Id.* Regarding the protection of work product at trial, the court stated:

Moreover, the concerns reflected in the work-product doctrine do not disappear once trial has begun. Disclosure of an attorney's efforts at trial, as surely as disclosure during pretrial discovery, could disrupt the orderly development and presentation of the case. We need not, however, undertake here to delineate the scope of the doctrine at trial, for in this instance it is clear that the defense waived such right as may have existed to invoke its protections.

Id. at 239. On the waiver issue, the court found that "[r]espondent, by electing to present the investigator as a witness, waived the privilege with respect to matters covered in his testimony."¹

¹ On this point, it has been noted that while testimonial use of privileged information may waive an evidentiary privilege, it is not proper to refer to the waiver as a waiver of work product protection. See Jeff A. Anderson et al., *The Work Product Doctrine*, 68 CORNELL L. REV. 760, 889 (1983). Anderson suggests that waiver of work product should not occur when a party discloses work product materials. *Id.*

In a case where a party makes testimonial use of work product materials, a court would still hold that the party has waived protection of the documents involved, but only as to an evidentiary privilege, not as to work product immunity. The distinction is significant. The inherent unfairness associated with 'testimonial use' of privileged materials that necessitates waiver of evidentiary privilege is not present

Id. Justice White concurred, but wrote separately to express his view that *Hickman v. Taylor* had been viewed as a limit on the ability to obtain pretrial discovery, but not as a limit on the discretion of a judge to enter evidence at trial. *Id.* at 244, 246.

While the concurrence's strong disagreement in *Nobles* with the proposition that work product protection is available at trial may be enough to give at least some pause as to the doctrine's continued applicability at trial, at least some courts have subsequently followed the majority's view that work product protection extends beyond pre-trial discovery. For example, in *Nichols v. Bell*, 440 F. Supp. 2d 730 (E.D. Tenn. 2006), the court acknowledged that *Nobles* had recognized that work product protection extends to trial, but noted that no Supreme Court cases have since determined its scope at trial. *Id.* at 815. The *Nichols* court found that requiring disclosure of the memoranda prepared by the defendant's testifying medical expert was not a violation of the attorney work-product doctrine because the expert had testified on behalf of the habeas petitioner during the sentencing phase of trial. The court found: "Applying the principles of *Nobles* to the instant case, the state court's conclusion preventing petitioner from arguing the work-product doctrine to sustain a unilateral testimonial use of work product was not contrary to, nor an unreasonable application, of federal law." *Id.* at 816. Thus, in addition to approving of *Nobles*'s holding that work product protection extends to trial, the court also seemed to approve of the *Nobles* holding that testimonial use of work product at trial will waive any protection. In this case, the "testimonial use" seemed to involve testimony at trial regarding the expert's examination of the petitioner and interviews with others. In light of this testimonial use, the court found it appropriate to require disclosure of

when disclosures are made to third parties in the course of trial preparation. Calling such a waiver of evidentiary privilege a waiver of work product immunity is a misnomer.

Id.

memoranda prepared by the expert in connection with the litigation. The issue in the *Nichols* case was whether the memoranda prepared by the expert were discoverable when the expert was to take the stand, so that court did not delve into the question of how far questioning could extend at trial with respect to the expert's communications with the retaining attorney or what other documents created by the expert, if any, might still be covered by work product protection.

In addition to finding no violation of work product protection by the disclosure of the memoranda, the *Nichols* court also approved of the state court's requirement that the petitioner turn over memoranda prepared by the testifying expert regarding his interviews with witnesses on the basis that the expert had failed to prepare a report and that the petitioner had failed to notify the prosecution that he intended to call a psychologist until after trial had begun. *Id.* at 816–17. The court found that the prosecutor had a substantial need for the material because he was prevented from rebutting the expert's testimony by retaining his own expert and that the state court had authority to impose a sanction. *Id.* at 817.

Other courts have likewise appeared to follow the *Nobles* holding that work product extends through trial, although some have done so simply by recognizing that testimony would waive any work product protection, rather than by explicitly stating that work product extends through trial. For example, in *Holder v. Gold Fields Mining Corp.*, 239 F.R.D. 652 (N.D. Okla. 2005), the defendant's consulting expert was listed as a potential testifying *fact* witness, and the opposing party sought to discover any documents related to the expert's proposed testimony. The defendants claimed that the requested documents were protected by the work product doctrine and that they would not know if and how the expert would testify at trial until after the plaintiffs had completed their case-in-chief. *Id.* at 657. The court held that the documents were not *yet* discoverable because

there would be no waiver *until the witness took the stand*. *See id.* at 659. The court concluded, however, that once the witness testified, documents he relied on in forming his opinion would become discoverable. The court stated that “clearly a witness cannot offer testimony based on documents that he simultaneously claims are protected work-product.” *Id.* (citing *Nobles*, 422 U.S. at 239–40). The court held that “[i]f a witness testifies in reliance on work-product documents, a waiver of work product will be found.” *Id.* However, the court concluded that simply listing the expert as a witness was not sufficient to find waiver, seeming to rely on the fact that until there was testimony, there was no disclosure of the work product such that it placed at issue all documents relating to the same subject matter. *Id.* at 659–60. The court seemed to imply that the result might have been different if the consultant had been listed as a proposed testifying expert witness (rather than a testifying fact witness) because under Rule 26(a)(2) all documents he considered in forming his opinion would be discoverable. *See Holder*, 239 F.R.D. at 660. The court concluded that if there was any doubt as to whether the witness was acting as a consultant or expert when he considered particular documents, it would be resolved in favor of discovery. *Id.* Thus, the court seemed to recognize that work product protection extended to trial, but that there could be a waiver through testimonial use of work product. The court seemed to believe that with respect to testifying expert witnesses, that waiver would extend to anything considered in forming the opinion,² but with respect to fact witnesses, the waiver might extend to documents related to the subject matter of the testimony.

In another analogous case, the court distinguished *Nobles* on the grounds that the expert in the case at bar did not testify at trial. *See John Doe Co. v. United States*, 350 F.3d 299 (2d Cir.

² Because the court relied on Rule 26(a)(2) in reaching this conclusion, it is not clear that the result would be the same in the absence of the language in that rule providing for broad discovery of testifying expert witnesses.

2003). In that case, the government filed a motion to compel the production of notes taken by the attorneys for the company being investigated by the grand jury during meetings with officials from the Bureau of Alcohol, Tobacco, and Firearms (“ATF”). *See id.* at 300. After the investigation began, the company’s attorneys submitted a letter to the U.S. Attorney’s Office, arguing that the company had proceeded in good faith and that it had relied on statements made by ATF officials. *Id.* at 301. The government argued that this letter constituted a waiver of any privilege attaching to attorney notes made in connection with meetings with ATF officials. *Id.* The court held that there was no unfairness in preventing discovery because unlike in the scenario where the witness is providing testimony that needs to be rebutted, the government was not prejudiced when the company submitted its letter to the U.S. Attorney’s office. *Id.* at 304. The court distinguished *Nobles* because the company had not offered testimony *as part of its defense at trial*, and held that telling the U.S. Attorney of its position was not sufficient to waive any privilege. *Id.* at 304–05. Although the *John Doe Co.* case did not address waiver of work product with respect to a testifying expert, its holding that there was no waiver of the attorney’s work product here because there was no testimony at trial regarding the work product seems to reinforce the *Nobles* holding that work product protection does in fact extend through trial absent waiver (which can be accomplished by testimonial use of the work product, among other things).

In sum, it would appear that several courts have followed the holding in *Nobles* that work product protection extends past discovery and into trial, although the scope of the protection at trial remains unclear. The courts that recognize that work product protection extends to trial also seem to acknowledge that “testimonial use” of work product will waive the protection. However, it is not entirely clear exactly what “testimonial use” entails and how broad the waiver will be when there

is “testimonial use.” For example, it may be that there is no waiver until the expert actually testifies (as opposed to when he is identified as a potential witness). As another example, it is not clear if putting an expert witness on the stand will open cross-examination up to anything and everything that the expert knows or whether it is simply with respect to material “regarding the same subject matter” as the testimony, or otherwise limited to facts and data considered by the expert.

One difficulty lies in the fact that courts tend to protect the right to cross-examine an expert witness to determine how he arrived at his opinion, and such cross-examination would not necessarily be limited to the facts and data considered. For example, a cross-examiner might inquire into the extent of the retaining attorney’s involvement in developing the expert’s opinion or suggestions made by the retaining attorney, arguing that these issues are relevant to bias and/or the credibility and validity of the expert’s opinion. It seems unlikely that all courts would limit this type of cross-examination on an objection based on work product, because most courts are likely to find that any work product protection that extended to trial was waived by putting the expert on the stand, at least with respect to any inquiries into the credibility/validity of the opinion. Given the freedom that courts grant counsel in cross-examination of an expert witness, it seems unlikely that a court will allow the party presenting the witness much latitude in claiming work product when the witness is on the stand if the testimony has any relation to the work product. Even if a court were to limit cross-examination to questions regarding the facts and data considered by the expert, such a line of questioning might impinge on the expert’s communications with counsel, and it is difficult to estimate where a court might draw the line in a particular case. For example, in a scenario discussed during the November 21, 2007 call, in which the attorney directs the expert to conduct tests to be used in cross-examining the other side’s expert, the permissible cross-examination of the expert

conducting the tests might include inquiry into the tests directed by the attorney, even though they were not part of the expert's opinion for his testimony. It may be difficult to draw the line regarding what information was considered for the testimony and what was considered for other consulting purposes.

Yet another difficulty arises in that it is complicated to determine the impact of the 1993 amendments to Federal Rule of Civil Procedure 26 with respect to discovery of expert materials/communications. Given the report requirement in the rule and the statement that opposing parties are entitled to "data or other information considered by the witness in forming the opinions," it is unclear if decisions in the last 14 years permit broad discovery of testifying experts because of the language in the amended rule alone or if the same result would occur based on the common law regarding work product and waiver. As a result, it is useful to examine cases decided before the 1993 amendments to determine whether courts permitted discovery of attorney-expert communications or expert work papers prior to the addition of the report requirement. A circuit opinion addressing this issue prior to 1993 that contains useful analysis is *Bogosian v. Gulf Oil Corp.*, 738 F.2d 587 (3d Cir. 1984). In that case, the Third Circuit held that core work product is not discoverable simply because an attorney shows it to a testifying expert. The court held that the possibility of discovering in cross-examination that the expert's opinion originated with an attorney's thoughts was not sufficient to justify ordering disclosure of documents containing core attorney work product. *See id.* at 595 ("Even if examination into the lawyer's role is permissible, an issue not before us, the marginal value in the revelation on cross-examination that the expert's view may have originated with an attorney's opinion or theory does not warrant overriding the strong policy against disclosure of documents consisting of core attorney's work product."). The

court did find that if the documents contained facts and data, a party could not avoid production simply by co-mingling the facts and data with an attorney's core work product. *See id.* In such a situation, the party would be required to redact any core work product and produce the remainder of the document revealing facts or data considered. *Id.* Judge Becker dissented, disagreeing with the majority's position that discovering whether the expert's view originated with an attorney is only of "marginal" value. *Id.* at 598. Judge Becker thought that even the majority's view would permit cross-examination regarding the attorney's role in shaping the expert's opinion, but that the issue was whether extrinsic evidence could be used to impeach the expert who denies that his opinion was shaped by an attorney. *Id.* Judge Becker felt that the majority's almost exclusive ban on extrinsic evidence containing core work product that was considered by the expert was contrary to other authority and to FED. R. EVID. 612. *Bogosian*, 738 F.2d at 599. Specifically, Judge Becker pointed to the opinion in *Berkey Photo, Inc. v. Eastman Kodak Co.*, 74 F.R.D. 613 (S.D.N.Y. 1977), where it was held that core work product shown by counsel to a witness waived the work product protection. *Id.*

The Northern District of California took a view similar to that of Judge Becker's in *Bogosian* in *Intermedics, Inc. v. Ventritex, Inc.*, 139 F.R.D. 384 (N.D. Cal. 1991). In that case, the court held that communications between an attorney and a testifying expert were discoverable. The case involved a deposition of the expert (rather than testimony at trial), and the opposing party had sought to compel answers and documents related to the expert's communications with counsel. *Id.* at 385. The court found that after weighing the potential increased efficiency produced by precluding disclosure against reducing the risk of compromising the independence of experts, the choice was easily in favor of disclosure of such communications, even if disclosure would reveal work product.

See id. at 394. The court determined that there was much to be gained by finding out if the attorney shaped the expert's opinion, *see id.* at 396, a holding that would likely permit cross-examination regarding more than "facts or data considered" by the expert.

In another pre-1993 case, the Western District of Missouri found that a testifying expert's communications with counsel were discoverable. *See William Penn Life Assurance Co. of Am. v. Brown Transfer and Storage Co.*, 141 F.R.D. 142 (W.D. Mo. 1990). In that case, third-party defendants sought to compel the plaintiff's expert to answer deposition questions regarding the content of the expert's communications with plaintiff or plaintiff's counsel regarding the expert's opinion of the conduct of one of the third-party defendants. *Id.* at 142. The court agreed with the dissent in *Bogosian* and found that the third-party defendants were entitled to "explore the effect those communications [between plaintiff's counsel and the expert] had on the expert's formation of his opinion." *Id.* at 143.

Similarly, in *Inspiration Consol. Copper Co. v. Lumbermens Mut. Cas. Co.*, 60 F.R.D. 205 (S.D.N.Y. 1973), the court permitted discovery of documents created by the expert with respect to claims on which it had been indicated that he might be called to testify. In that case, an accountant wore three different hats in the litigation: (1) as a longtime auditor; (2) as an expert employed specifically for the litigation and who would not testify with respect to certain claims; and (3) as an expert who might testify at trial regarding claims that might be made in the alternative. *Id.* at 208–09. The court held that "for purposes of Rule 26(b)(4)(B) an independent accountant may wear two hats, that of a general auditor subject to normal discovery, and that of an expert specially retained for litigation, in which case discovery respecting preparation of the claim is limited by Rule 26(b)(4)(B) if he is *not* to be a witness at trial." *Id.* at 210 (emphasis in original). The court

concluded that discovery was prohibited with respect to documents or opinions prepared in connection with the claim on which the expert would not testify. *Id.* However, the court stated that its holding was “not to be construed . . . as an anticipatory ruling on the scope of cross examination of Mr. Smith or of any other Price Waterhouse person who appears as a witness.” *Id.* With respect to the alternative claim on which the expert might be called to testify, the court permitted discovery, but again emphasized that it was not ruling on admissibility or the scope of cross examination at trial. *Id.* at 211.

In addition, another pre-1993 case in the Northern District of California permitted discovery of all documents that were given to a testifying expert. *See Mushroom Assocs. v. Monterey Mushrooms, Inc.*, 1992 WL 442898 (N.D. Cal. 1992). In that patent suit, one of the co-inventors was designated as a testifying expert, and the defendants sought to discover all documents to which he had access, regardless of whether they were used in formulating his expert opinion. *Id.* The court ordered disclosure of all documents that the expert considered, whether they were rejected or relied upon, and noted that “considered” meant that the expert had reviewed the documents in preparation for his expert testimony. *Id.* The court declined to grant access to all documents he saw during the life of the patent (*i.e.*, in his role as co-inventor rather than his role as testifying expert) that he did not consider in forming his expert opinion. *Id.*

Finally, yet another pre-1993 district court case determined that an expert’s documents were not protected under the work product doctrine. *See United States v. Real Property Known and Numbered as 2847 Chartiers Ave., Pittsburgh, PA*, 142 F.R.D. 431 (W.D. Pa. 1992). In that case, the government retained an expert to examine alleged gambling machines, and the expert prepared a report that contained facts known and opinions held by the expert in connection with his

examination of the machines. *Id.* at 432. The government contended that the report was not discoverable because it was work product prepared in connection with litigation and was thus protected under *Hickman*, as codified in Rule 26(b)(3). *Id.* at 433. The court held that *Nobles*'s holding that attorney work product extends to material prepared by agents for the attorney did not mean that an expert's knowledge and opinions become attorney work product simply because the expert is retained by an attorney in anticipation of litigation. *Id.* The court ruled that expert discovery was governed by Rule 26(b)(4) rather than 26(b)(3) and that most authority recognized that 26(b)(3) "work-product privilege" does not apply to discovery of experts' material. *Id.* at 434. The court also noted that materials prepared by an expert in anticipation of litigation were not protected even prior to the 1970 amendment adopting sub-section 26(b)(4). *Id.* (citations omitted).

Overall, it appears that the majority of pre-1993 cases permit discovery of expert communications with counsel and expert-created documents once the expert testifies at trial. This may mean that the 1993 amendments to Rule 26 regarding expert disclosures are not the sole reason for courts' unwillingness to shield attorney-expert communications or other documents shared with experts from discovery. It appears that the trend before 1993 was to allow access to these materials and communications, so it may be that the 1993 amendments codified the common law practice of allowing access to these documents. The relevance of investigating the effect of the 1993 amendments is that if the practice prior to those amendments was to shield certain expert materials or communications, and the effect of the 1993 amendments was to remove that shield, then the authority to replace the shield is more apparent. That is, if common law regarding work product applied to protect expert materials prior to the 1993 amendments, then the Committee should be able to codify that common law. If the Rules Committee had the authority in 1993 to create a rule that in effect removed certain protections for expert documents and communications, then the Committee

ought to have the authority to undo the effect of that amendment and return practice regarding experts to its pre-1993 state. However, an initial review of some of the pre-1993 case law on this topic reveals that it is not clear that removing the effect of the 1993 amendments would be to deny access to expert materials and communications.

II. Whether Rule 26(b)(3) or *Hickman* Would Apply to Work Product Protection at Trial

Another issue relevant to the analysis of potential amendments to rules governing expert discovery is, assuming work product protection does in fact extend through trial, whether a revised version of Rule 26(b)(3) could provide that protection at trial or whether *Hickman* itself would apply. A protection found solely in Rule 26 would appear to apply to discovery matters, not trial, particularly given the current title of that rule: “General Provisions Governing Discovery; Duty of Disclosure.” Thus, absent further explanation, a protection for expert communications placed in Rule 26 would not necessarily apply through trial based solely on the text of the rule. On the other hand, to the extent that *Hickman* provides work product protection through trial, it is possible that Rule 26 could be read to include that same protection, given some courts’ language stating that Rule 26 incorporates *Hickman*. See *Seal v. Univ. of Pittsburgh*, 135 F.R.D. 113, 114 (W.D. Pa. 1990) (“[T]he protection of work product arising from the case of *Hickman v. Taylor* . . . has been supplanted by Rule 26(b)(3) of the Federal Rules of Civil Procedure” (emphasis added)); *Airheart v. Chicago and N.W. Transport. Co.*, 128 F.R.D. 669, 671 (D.S.D. 1989) (“The work product doctrine had its genesis in *Hickman v. Taylor* and is now fully expressed in Rule 26(b)(3) of the Federal Rules of Civil Procedure” (emphasis added)); but see Gregory P. Joseph, *Emerging Expert Issues Under the 1993 Disclosure Amendments to the Federal Rules of Civil Procedure*, 164 F.R.D. 97, 106 n.18 (1996) (“Rule 26(b)(3) does not fully codify the work-product protection recognized in *Hickman*.” (citing MOORE’S FEDERAL PRACTICE ¶ 26.15 at 26-292, 26-293

(1995))). However, if it is really true that *Hickman* has been fully codified in Rule 26, it might be argued that there is no protection for work product at trial because Rule 26 may govern only discovery and its replacement of *Hickman* may leave no protection remaining for work product at trial. Nonetheless, given that many courts appear to have approved of the *Nobles* holding that work product protection applies at trial, it is likely that some protection remains through trial.

At least one court has recognized that while Rule 26(b)(3) only protects work product in discovery, *Hickman* applies to protect work product at trial. See *Stansberry v. Schaad Prop.*, 1991 WL 11015266 (W.D. Va. 1991). In that case, the court confronted the question of whether an expert who was consulted by the plaintiffs but not ultimately retained could be called at trial by the defendants without violating the work product doctrine. *Id.* at *1. The court found that allowing the defendants to call the expert at trial would not be a *per se* violation of the work product doctrine, but held that the court would prevent against disclosure of work product at trial. *Id.* The court recognized that *Hickman* was “codified, in part, for pretrial discovery of documents and tangible objects by Federal Rule of Civil Procedure 26(b)(3)” *Id.* at *2. The court then cited *Nobles* for the proposition that work product protection exists at trial. *Id.* (citing *Nobles*, 422 U.S. at 239). The court concluded: “Thus, although Rule 26 is generally inapplicable at trial, the work-product doctrine as developed at common law controls.” *Id.* This 1991 holding shows that, at least prior to the 1993 amendments, work product protection was recognized at trial for communications with experts under the common law. Even if the 1993 amendments have been interpreted to remove much of the protection for the attorney-expert communications, both before and during trial, if the common law protected those communications before the amendments, then presumably additional

amendments to the rules could recapture that protection both during discovery and at trial.³ However, it also appears that the rule may not be able to do all the heavy lifting itself because it may only apply to pre-trial discovery. As discussed in the November 21, 2007 conference call, the amended rule could potentially provide discovery protection for attorney-expert communications, and encourage (via committee note) the courts to follow suit with respect to protecting those communications at trial as well.

Another reason that Rule 26(b) may not be able to officially protect work product at trial on its own is that an exclusion of relevant testimony at trial would appear to be an evidentiary exclusion rather than a limit on discovery. The relevant statutory scheme provides: “Any . . . rule creating, abolishing, or modifying an evidentiary privilege shall have no force or effect unless approved by Act of Congress.” 28 U.S.C. § 2074(b). While it is not clear exactly what constitutes an “evidentiary privilege,” a rule directed to the exclusion of otherwise relevant evidence at trial is likely to fall into the category of modifying an evidentiary privilege. *See* 23 CHARLES ALAN WRIGHT & KENNETH W. GRAHAM, JR., FEDERAL PRACTICE AND PROCEDURE § 5423 (1980).

[T]he so-called “work product rule” was originally considered to be an immunity from discovery in civil cases rather than a true privilege. In this aspect, the doctrine falls within Civil Rule 26(b)(3). However, recently the Supreme Court has applied the doctrine to exclude trial preparation materials when offered in a criminal trial, a decision which has gone some way toward turning the immunity into a privilege. As such, the “work product” doctrine is within Rule 501.

Id. (citing *Nobles*, 422 U.S. 225). Thus, if the revised rule does not specify that it applies at trial, it is not clear that it would automatically apply at trial, and if the rule does specify that it applies at trial, then it might be subject to criticism for avoiding the procedure required by section 2074(b) for

³ As noted earlier in this memo, this appears to be a protection that is waivable by calling the expert as a testifying expert at trial, although the extent of waiver remains unclear.

creating or modifying a privilege. See Gregory P. Joseph, *Emerging Expert Issues Under the 1993 Disclosure Amendments to the Federal Rules of Civil Procedure*, 164 F.R.D. 97, 106 (1996) (Under some interpretations, “Rule 26(a)(2)(B), alone or in conjunction with Rules 26(b)(3)-(4), makes waiver of core work-product an unavoidable cost of putting an expert forward to testify. If core work-product is an ‘evidentiary privilege,’ and if mandating the waiver of this ‘evidentiary privilege’ constitutes ‘abolishing or modifying’ it, § 2074(b) has to that extent been contravened and Rule 26(a)(2)(B) is to that extent invalid. Because § 2074(b) has not been construed, the meaning of these operative phrases is not settled.”).

III. Whether Interaction With Experts Should Be Regarded as Protected by *Hickman* Itself

The question has also been raised as to whether interaction with experts should be regarded as protected by *Hickman*. If so, then it may be easier to overcome challenges to a proposed amendment because the amendment would essentially be a codification of an already existing doctrine. The committee notes to the 1970 amendments to Rule 26, which substantially codified *Hickman*, indicate that *Hickman* left open the issue of whether the work product doctrine extends to the preparatory work only of lawyers. FED. R. CIV. P. 26 advisory committee’s note (1970 Amendment). The post-1970 case law does not clarify this issue because once Rule 26 substantially codified *Hickman*, courts largely relied on the rule itself to determine the scope of expert discovery, not on *Hickman*, making it difficult to determine if *Hickman* itself provides protection for these communications and interactions. See, e.g., *United States v. Real Property Known and Numbered as 2847 Chartiers Ave., Pittsburgh, PA*, 142 F.R.D. 431 (W.D. Pa. 1992) (“*Chartiers*”) (noting that the *Hickman* principles have been codified in Rule 26(b)(3) and that expert discovery is governed by Rule 26(b)(4) rather than 26(b)(3)). In *Chartiers*, the court noted that the advisory committee note to Rule 26 “expressly states that the committee ‘reject[ed] as ill-considered the decisions which

have sought to bring expert information within the work product doctrine.” *Id.* at 433 (citing FED. R. CIV. P., West’s 1991 Revised Edition at 87). There is other language in the committee note that indicates that there were very few decisions before the 1970 amendments that protected expert information from discovery. *See* FED. R. CIV. P. 26 advisory committee notes (1970 Amendments) (“These new provisions of subdivision (b)(4) repudiate the few decisions that have held an expert’s information privileged simply because of his status as an expert.”) (citing *Am. Oil Co. v. Penn. Petroleum Prods. Co.*, 23 F.R.D. 680, 685–86 (D.R.I. 1959)). The fact that *Hickman* was largely codified in Rule 26, coupled with the fact that the committee notes disapproved of strong discovery protections for expert materials, make it difficult to assess whether *Hickman* actually provided that protection and the amended rule then reduced it,⁴ or if strong protection for expert materials never truly existed.

IV. Case Law Involving Invocation of Work Product At Trial to Limit Questioning of an Expert Witness

I have not encountered any cases directly involving invocation of the work product doctrine at trial to limit questioning of an expert witness. Most of the relevant case law focuses on obtaining testifying experts’ documents and draft reports, which seem to be generally discoverable under the current version of the rule. Of the cases I have seen thus far, the one most relevant to this issue is *New Mex. Tech. Research Found. v. Ciba-Geigy Corp.*, 1997 WL 576389 (D.R.I. 1997), which involved inquiry into work product during the deposition of a testifying expert. In *Ciba-Geigy*, the plaintiff’s testifying expert was deposed and opposing counsel inquired into whether the plaintiff’s

⁴ Clearly, some protection of certain expert materials did survive the amendments. *See, e.g., Krisa v. Equitable Life Assurance Soc.*, 196 F.R.D. 254, 259 (M.D. Pa. 2000) (“The policy reasons supporting the ‘bright-line’ rule in favor of disclosure of materials disclosed to an expert are not compelling and ignore the policy considerations that compel protection of core work product.”).

counsel had expressed to him their views on the case and on infringement of the patent-in-suit, and whether they had discussed their interpretation of relevant claim terms used in the patent. *Id.* at *1. The questions called for only a “yes” or “no” answer, but the plaintiff’s counsel objected on the basis of work product. *Id.* The parties agreed that follow-up questions would have gotten into work product, but apparently disagreed regarding the initial questions. *See id.* In addition to objecting to questioning, the plaintiff’s counsel withheld several documents, including: (1) several authored by the expert having notes made by the expert during conversations about the case with plaintiff’s counsel; (2) a document authored by the expert and the plaintiff’s counsel, described as a “draft supplemental expert report reflecting mental impressions of counsel; and (3) a document authored by the plaintiff’s counsel with a copy sent to the expert described as “notes reflecting mental impressions of counsel.” *Id.* at *2. The defendants took the position, relying on *Intermedics, Inc. v. Ventritex, Inc.*, 139 F.R.D. 384 (N.D. Cal. 1991), that any communications, written or oral, given by counsel to a testifying witness, are discoverable, even if they would ordinarily be protected by the work product doctrine. *See Ciba-Geigy*, 1997 WL 576389, at *3. The court rejected this approach, finding more compelling the reasoning in *Haworth, Inc. v. Herman Miller, Inc.*, 162 F.R.D. 289 (W.D. Mich. 1995), which would protect an attorney’s core work product. *Ciba-Geigy*, 1997 WL 576389, at *5. However, the court noted that even the *Haworth* analysis “does not eliminate discovery of the bases for the expert’s opinions or the source of the facts on which the expert relies,” and that “the expert is not insulated from all discovery.” *Id.* The court quoted *Haworth* regarding how to determine whether a question posed to an expert is proper:

“Whether a question is improper depends upon the question. If the question regards mechanical advice on the preparation of the expert report, the question is not objectionable. If the question tests whether certain facts had not been provided the expert for his consideration, the question would be proper as well. Opposing counsel may test

whether the witness's report accurately reflects all the facts actually considered. Opinion work product protection is not triggered unless 'disclosure creates a real, nonspeculative danger of revealing the lawyer's mental impressions' and the attorney had 'a justifiable expectation that the mental impressions revealed by the materials will remain private.'"

Id. (quoting *Haworth*, 162 F.R.D. at 296 (quoting *In re San Juan Dupont Plaza Hotel Fire Litigation*, 859 F.2d 1007, 1015–16 (1st Cir. 1988))). The court held that the questions posed at the deposition would require revealing counsel's opinions about the case, whether there had been infringement of the patent, and counsel's interpretation of terms in the patent, and that they were therefore objectionable. *Id.* at *6. The court likewise denied access to the documents. *Id.*

It may also be possible to analogize cases regarding the discoverability of documents provided to testifying experts to the scenario where the expert is questioned on the stand regarding information claimed to be subject to work product immunity. Presumably, if courts will limit discovery of certain categories of work product even after it is shown to a testifying expert, then it seems likely that courts would also limit questioning at trial regarding the same categories. And the converse is likely true as well—if the court will permit pre-trial discovery of work product shown to an expert, surely it would permit inquiry into work product at trial. As to this line of cases, there appears to be a split of authority as to whether to protect core work product once it is shown to a testifying expert.

Those cases holding that core work product is discoverable if given to a testifying expert seem to focus on the theory that if the attorney is going to shape the expert's view, then the opponent is entitled to inquire into the attorney's participation, and on the fact that the attorney has control over the amount of work product given to an expert, if any. These cases hold that if the attorney is concerned about discoverability, the attorney can simply be careful about giving core work product

to the expert.⁵ For example, in *Elm Grove Coal Co. v. Director, Office of Workers' Comp. Programs*, 480 F.3d 278 (4th Cir. 2007), the court heard an administrative law action governed by administrative law rules of procedure containing a provision that matched federal Rule 26(b)(3), with the exception of the 1993 amendment regarding expert disclosures. *See id.* at 300. The court determined that the expert could not be properly and fully cross-examined in the absence of draft reports and attorney-expert communications. *Id.* at 301. The court found that “other courts, under both pre- and post-amendment Rule 26, have mandated the production of similar draft reports and attorney-expert communications with respect to testifying experts,” *id.* at 301, but noted a split of authority: “We recognize that certain courts, both before and after the 1993 amendments to Rule 26, have determined that draft reports provided to testifying experts and attorney-expert communications are entitled to varying degrees of work product protection,” *id.* at 302 n.24 (citing *Bogosian*, 738 F.2d 387; *Nexus Prods. Co. v. CVS N.Y., Inc.*, 188 F.R.D. 7, 10–11 (D. Mass. 1999)). The court continued: “We are unpersuaded by this line of decisions [protecting draft reports shown to testifying experts and attorney-expert communications as work product] and, as discussed herein, believe that the vastly superior view is, consistent with the 1993 amendments to Rule 26, that such attorney-expert communications are not entitled to protection under the work product doctrine.” *Elm Grove Coal*, 480 F.3d at 302 n.24. The court concluded: “In sum, draft expert reports prepared by counsel and provided to testifying experts, and attorney-expert communications that explain the lawyer’s concept of the underlying facts, or his view of the opinions expected from such experts, are not entitled to protection under the work product doctrine.” *Id.* at 303.

Similarly, in *Energy Capital Corp. v. United States*, 45 Fed. Cl. 481 (Ct. Fed. Cl. 2000), the

⁵ This theory runs into the very problem that an amendment to the rule would be aimed at solving – the use of two sets of experts so that the attorney has one set that she can discuss theories with and another set that will testify.

case was governed by the rules of procedure for the Court of Federal Claims, which contained a rule governing expert discovery that matched federal Rule 26 before the 1993 amendments. 45 Fed. Cl. at 493. The court stated, “All cases of which this court is aware have required that the production of factual information given by an attorney to an expert must be produced. In addition, courts also require the production of the information and opinion provided by an expert to the attorney.” *Id.* at 493–94 (internal citations omitted). However, on the issue of whether the party must produce documents that reveal opinion work product, the court found that other courts had reached varying results. *Id.* at 494. The court concluded:

[T]his Court finds that the policy arguments favor the production of all materials given to experts. Complete disclosure promotes the discovery of the true source of the expert’s opinions and the detection of any influence by the attorney in forming the opinion of the expert. In addition, the attorneys can minimize how much the other side learns of their opinion work product by monitoring what information is provided to the expert. . . . Lastly, a clear line is easier to administer and a predictable result helps litigants plan their strategy.

Id.

In yet another case, the Eastern District of New York found all documents “considered” by the expert to be discoverable, but focused its reasoning on the 1993 amendments to the federal rules. *See Weil v. Long Island Sav. Bank FSB*, 206 F.R.D. 38, 39–40 (E.D.N.Y. 2001) (collecting cases that have held that the 1993 amendments require that anything disclosed to a testifying expert must be produced to opposing counsel, whether or not the expert relies on the disclosed material). The court noted a split of authority on the issue of the protection of core work product given to an expert. *Id.* at 40. The court concluded that even core work product is discoverable if given to a testifying expert because such discovery would lead to more effective cross-examination and would reveal counsel’s involvement in forming the expert’s opinion. *Id.* at 41. The court also focused on the

attorney's ability to decide whether to provide the expert with work product material. *Id.* at 42.

In contrast to those cases permitting discovery of core work product, those courts finding that core work product is not discoverable after disclosure to a testifying expert have focused on the fact that Rule 26(b)(3) is subject to Rule 26(b)(4), which grants broad discovery of expert witnesses, but that nothing in either section suggests that core work product is discoverable under (b)(4). For example, in *Krisa v. Equitable Life Assurance Soc.*, 196 F.R.D. 254 (M.D. Pa. 2000), the court rejected a bright-line rule that materials given to a testifying expert are automatically discoverable, and exempted core work product from discovery. The *Krisa* court determined that a bright-line rule in favor of requiring production of attorney work product shown to a testifying expert would “abridge[] the attorney work product privilege without specific authority to do so.” 196 F.R.D. at 260. A pre-1993 example of a case finding that core work product is not discoverable after showing it to an expert is *Bogosian v. Gulf Oil Corp.*, 738 F.2d 587, 594 (3d Cir. 1984) (finding that the proviso in the first sentence of Rule 26(b)(3) beginning “[s]ubject to the provisions of subdivision (b)(4) . . .,” does not limit the second sentence of Rule 26(b)(3), which restricts disclosure of work product revealing “mental impressions” and “legal theories”).

In sum, my research so far has not uncovered case law involving the situation where an expert took the stand at trial and there was an objection based on inquiry into work product. As noted, however, this may be the result of the broad expert discovery permitted by the 1993 amendments and the corresponding committee notes. While it may be possible to analogize cases regarding the discoverability of materials given to an expert or attorney-expert communications to the situation of questioning an expert witness on the stand, even that analogy does not add much clarity because it appears that there has been a split of authority, both before and after the 1993

amendments, as to whether core work product will be shielded from discovery when shared with a testifying expert.

V. Conclusion

Overall, it appears that the majority of authority holds that work product protection does in fact extend through the trial. Thus, the concern that a rule amendment would not actually deter parties from retaining a second set of experts if the protection would simply disappear at trial may be somewhat alleviated by the general acceptance of the proposition that work product protection extends through trial. However, under the current regime, it also appears that there is a strong risk of waiver of work product protection when an expert who has been exposed to work product is put on the stand. The extent of the waiver is unclear, and it is difficult to remove the impact of the 1993 amendments to determine whether the common law would provide protection for work product shared with testifying experts absent the contrary implication of the 1993 amendments. Even prior to the 1993 amendments, the case law was unclear as to the extent of protection for work product shared with a testifying expert. Thus, although work product immunity may extend through trial as a general proposition, the interest in permitting effective cross-examination may remove that protection, at least to some extent, for testifying experts. Because the extent of work product waiver that may be found with respect to a testifying expert is unclear, and because it may be difficult for Rule 26 to officially provide protection through trial without modifying a privilege, it may be difficult to fully prevent the cautious party with sufficient resources from hiring two sets of experts and avoiding written communications with testifying experts. Nonetheless, as discussed in the November 21, 2007 conference call, it may be that a limit on discovery of expert materials in Rule 26, coupled with an advisory committee note encouraging courts to maintain the protection through

trial, will go a substantial distance in preventing the undesired behaviors.