

A man from State A and a woman from State B started a fashion business together in State A. After a year of working together, the man and the woman began to have different opinions on how the business should operate. The woman was also concerned that the man used dress designs from his previous employer, thereby risking a lawsuit from the former employer. They tried to figure out a solution to wind down the business without involving lawyers but failed.

The woman sued the man in federal district court, seeking \$2 million for breach of contract. During discovery, the woman served a subpoena on the man's former employer seeking copies of the employer's dress designs. The employer is worried that disclosing these designs will reveal his trade secrets.

What is the most efficient action the employer can take to prevent disclosure of his trade secrets?

- A. Claim privilege over the dress designs.
- B. File a motion to quash the subpoena.
- C. Intervene in the case.
- D. Request a temporary restraining order.

Explanation:

Quashing or modifying subpoenas

(FRCP 45(d)(3))

Required Court *must* quash or modify subpoena that:

- fails to allow reasonable time to comply
- requires person to comply beyond geographical limits
- requires disclosure of privileged or protected matter *or*
- subjects person to undue burden

Permitted Court *may* quash or modify subpoena that requires disclosing:

- unretained expert's opinion or information that (1) does not describe occurrences in dispute & (2) results from expert's study not requested by party
- trade secret or confidential research, development, or commercial information

FRCP = Federal Rule of Civil Procedure.

A **subpoena** is a written court order that compels a **person** (party or nonparty) to appear in court or at a deposition OR to **produce documents or items** in his/her possession.* Under Federal Rule of Civil Procedure 45(d), a person subjected to a subpoena may file a motion to **modify or quash** that subpoena. A court *may* grant the motion if the subpoena **requires disclosure** of:

- an unretained expert witness's opinion or information that (1) does not describe specific occurrences in dispute and (2) results from the expert's independent study instead of a party's request *or*
- trade secrets or other confidential research, development, or commercial information.

Here, the woman served a subpoena on the man's former employer (nonparty) to produce copies of his dress designs. Since the employer is concerned that disclosure will reveal his trade secrets and a motion is relatively cost-effective, the most efficient action to prevent disclosure is to file a motion to quash the subpoena.

*A person commanded to produce documents or items need not appear in person at the place of production or inspection unless also commanded to appear for a deposition, hearing, or trial.

(Choice A) In general, trade secrets are not privileged. If they were, the court would be required to modify or quash a subpoena compelling the disclosure of that privileged information.

(Choice C) A nonparty may intervene (ie, join) and fully participate in a pending suit to protect his/her interests. But here, the employer does not have an interest in the pending suit other than the subpoena, and he can efficiently protect this interest by filing a motion to quash.

(Choice D) A temporary restraining order (TRO) is a court order that preserves the status quo of the parties until there is an opportunity to hold a full hearing on an application for a preliminary injunction. But since the employer is not a party to the suit and a TRO provides only a temporary solution, it is not the most efficient action.

Educational objective:

A court may modify or quash a subpoena that requires disclosing (1) an unretained expert's opinion or information that does not describe specific occurrences in dispute and results from the expert's independent study instead of a party's request or (2) trade secrets or other confidential research, development, or commercial information.

References

- Fed. R. Civ. P. 45(d)(3) (modifying or quashing a subpoena).