

**IN THE UNITED STATES DISTRICT COURT FOR THE
NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION**

RTC INDUSTRIES, INC.,)	
)	Case No. 17 C 3595
Plaintiff,)	
)	District Judge Pacold
v.)	
)	Magistrate Judge Schenkier
)	
FASTENERS FOR RETAIL, INC.,)	
)	
Defendant.)	

ORDER

Under the protective order governing this litigation, a party can “claw back” a document that it produced but later claims to be privileged (doc. # 201: Modified Protective Order, ¶ 5(b)). On October 28, 2019, RTC clawed back 14 documents (hereafter the “clawback documents”) on the basis that the “documents contain, or reflect, privileged communications and/or attorney work product and were inadvertently produced” (doc. # 342, at 16-17: RTC’s Clawback Ltr., at 1). RTC then re-produced the clawback documents; in these reproduced documents, RTC redacted those portions it claimed to be privileged (*see* doc. # 342-1, at 2-3: RTC’s Rule 37.2 Resp., at 2).

FFR asserts that RTC’s October 28 clawback was improper, and it has moved to compel RTC to produce unredacted copies of the clawback documents or, in the alternative, to provide these documents for our *in camera* inspection (doc. # 341: FFR’s Mot.; doc. # 342, at 2-6: FFR’s Rule 37.2 Ltr., at 1-2). Pursuant to our January 8, 2020 order, RTC has provided for our *in camera* review “unredacted copies of the 14 documents in issue, along with an identification of: (1) any redactions that were made to the documents as originally produced to [FFR], and (2) any redactions that were made to any of the clawed back documents that were re-produced to [FFR]” (doc. # 374: 1/8/20 Order). We have reviewed the documents, and, for the following reasons, we grant FFR’s motion to compel in part.¹

I.

Although RTC’s October 28 letter characterized the clawback documents as “privileged communications *and/or attorney work product*” (RTC’s Clawback Ltr. at 1) (emphasis added), the documents’ corresponding privilege log entries identify attorney-client privilege as the only basis for redaction (doc. # 342-1, at 5-1547: RTC’s 7th Suppl. Priv. Log, at 1, 191, 236, 317, 333, 1196,

¹ As we have done with prior orders and opinions issued in this case, if we must refer to a sealed document, we attempt to do so without revealing any information that could be reasonably deemed confidential. To the extent we discuss confidential information, however, we have done so because it is necessary to explain the path of our reasoning. *See In re Specht*, 622 F.3d 697, 701 (7th Cir. 2010); *Union Oil Co. of Cal. v. Leavell*, 220 F.3d 562, 568 (7th Cir. 2000).

1208, 1537, 1538). We therefore only consider whether RTC properly redacted the clawback documents on attorney-client privilege grounds.

The attorney-client privilege protects from disclosure “[c]onfidential communications between a client and her lawyer for the purpose of receiving legal advice.” *United States v. Bey*, 772 F.3d 1099, 1101 (7th Cir. 2014); *see also United States v. Leonard-Allen*, 739 F.3d 948, 953 (7th Cir. 2013) (stating that the attorney-client privilege “covers only those communications which reflect the lawyer’s thinking or are made for the purpose of eliciting the lawyer’s professional advice or other legal assistance”) (internal alteration and quotations omitted).² The attorney-client privilege, however, “is in derogation of the search for the truth,” so “it is construed narrowly.” *United States v. Evans*, 113 F.3d 1457, 1461 (7th Cir. 1997). The proponent of the privilege bears the burden of showing that the attorney-client privilege is applicable to each document withheld or redacted on that basis. *See United States v. BDO Seidman*, 337 F.3d 802, 811 (7th Cir. 2003) (“The mere assertion of a privilege is not enough; instead, a party that seeks to invoke the attorney-client privilege has the burden of establishing all of its essential elements”); *Evans v. City of Chicago*, 231 F.R.D. 302, 311 (N.D. Ill. 2005) (“The party asserting the attorney-client privilege has the burden of establishing each of [the privilege’s] elements on a document-by-document basis”).

II.

With the foregoing principles in mind, we now address the 14 clawback documents: (1) RTC0087327, (2) RTC0088018, (3) RTC0147190, (4) RTC0148333, (5) RTC0148342, (6) RTC0180031, (7) RTC0180037, (8) RTC0182615, (9) RTC0184447, (10) RTC0185091, (11) RTC0186614, (12) RTC0186806, (13) RTC0186851, and (14) RTC0190832.

(1) RTC0087327 and (2) RTC0088018: In these two documents, RTC redacted the same portion of an internal RTC email sent by Gideon Schlessinger, a non-attorney, to Richard Nathan, another non-attorney.³ RTC must remove the redaction from the last sentence of the redacted passage (“Joel is going . . . mentioned above”), as it does not reflect or disclose any legal advice or analysis. But RTC can maintain the remainder of the redaction; this portion of the passage reflects the substance of an attorney’s investigation into, and his advice to RTC regarding, existing intellectual property. This portion of the passage is properly redacted under the attorney-client privilege.

(3) RTC0147190, (6) RTC180031, and (7) RTC0180037: RTC redacted the same two portions of an internal RTC email sent by Barry Robbins to Mr. Nathan in these three documents. The passages disclose that an unidentified lawyer approved certain actions. While neither passage goes into detail about legal advice or analysis upon which the lawyer’s approval might have been based, we conclude that the disclosure could—when coupled with other documents and

² In patent cases, Federal Circuit law applies for those privilege disputes that relate to an issue of substantive patent law; otherwise, Seventh Circuit law applies. *Regeneron Pharms., Inc. v. Merus N.V.*, 864 F.3d 1343, 1363 n.6 (Fed. Cir. 2017); *In re Spalding Sports Worldwide, Inc.*, 203 F.3d 800, 803-04 (Fed. Cir. 2000). The disputes here do not appear to implicate substantive patent law, and neither party cited to or relied upon Federal Circuit law in their meet-and-confer correspondence. Thus, we apply Seventh Circuit law to the privilege issues raised in FFR’s motion.

³ Unless we note otherwise, none of the 14 clawback documents were authored or received by an attorney.

information—reveal that advice and analysis. RTC may retain its redactions to RTC0147190, RTC180031, and RTC0180037.

(4) RTC0148333 and (5) RTC0148342: In these two documents, RTC redacted the same three portions of an internal RTC email sent by John Ward to Nicholas Vielbig and Andy Cremer. The first redacted portion (“The potential . . . next week”) is not privileged. It refers to “additional info from the attorneys,” but it does not disclose what the information is or whether that information constitutes some sort of legal advice or analysis. RTC must unredact this portion. The second redacted portion is privileged; it discloses what Mr. Ward intends to ask the attorneys when obtaining legal advice. RTC may keep this redaction. The first sentence of the third redacted portion is privileged for the same reason—the sentence discloses a question Mr. Ward intends to ask the attorneys in the context of obtaining legal advice. RTC may keep this redaction as well. RTC, however, must remove the redaction from the remaining three sentences of the third redacted portion (“For now . . . back from them”), as these sentences do not reflect or suggest the substance of any legal analysis or advice.

(8) RTC0182615, (11) RTC0186614, and (14) RTC0190832: RTC0182615 and RTC0186614 reflect an email sent on June 27, 2014 by John Ward to “kellylward@comcast.net” with a “cc” to Mr. Ward’s RTC email address. RTC0190832 is an email sent on June 29, 2014 from “kellylward@comcast.net” to Mr. Schlessinger with a “cc” to Mr. Ward’s RTC email address. RTC contends that kellylward@comcast.net is the email account of Mr. Ward’s wife, and that by sending an email to this address, Mr. Ward was “sending an email to himself at home, via his wife’s email account” (RTC’s Rule 37.2 Resp. at 2; *see also* doc. # 342-2: 12/20/19 Meet and Confer Tr., at 43:14-17). RTC does not explain who sent the June 29 email *from* the kellylward account (RTC0190832), but based on our review of the email—which appears to be a more recent version of the list of updates contained in the June 27 email sent by Mr. Ward to the kellylward account—we presume that Mr. Ward also sent this email.

A threshold question is whether any attorney-client privilege that might have applied has been waived because the emails were sent to or from the email account of Mr. Ward’s wife. *See, e.g., Beneficial Franchise Co. v. Bank One, N.A.*, 205 F.R.D. 212, 215 (N.D. Ill. 2001) (“Perhaps the most common instance of waiver is where an otherwise privileged communication is disclosed to a third party outside the scope of the privilege”). FFR insists this is the case, and it contends that this situation is no different than sharing a document with Olympus Partners (*e.g.*, FFR’s Rule 37.2 Ltr. at 2; 12/20/19 Meet and Confer Tr. at 40:21-41:10, 44:14-20, 45:21-46:14), which we previously found constituted a waiver of the attorney-client privilege in certain circumstances (doc. # 254: 10/8/19 Op. and Order, at 11-14) (holding that FFR must “produce any withheld documents or information that was disclosed to or by employees of Olympus Partners who are not also board members or officers of FFR”).

We disagree. The situation presented here is different from the Olympus Partners scenario that we previously addressed. The Olympus Partners employees who sent emails to FFR employees or were sent emails by FFR employees were not the FFR employees’ spouses or in otherwise close familial relationships with the FFR employees. They were truly third parties. In contrast, the “third party” here is Mr. Ward’s wife. Married couples share all types of things, and we imagine that many married couples share email accounts (or at least allow one spouse to access

the other spouse's account). There is no reason to conclude that Mr. Ward sent the work-related emails at issue to or from his wife's email account so that she could look at them, or that she actually did look at these emails. In these circumstances, we do not find that Mr. Ward's use of his wife's email account constitutes a waiver. *See Eagle Forum v. Phyllis Schlafly's Am. Eagles*, No. 3:16-cv-946-DRH-RJD, 2018 WL 6249688, at *4 (S.D. Ill. Nov. 29, 2018) (finding that a husband's shared use of an email account with his wife did not waive attorney-client privilege); *see also Hiskett v. Wal-Mart Stores, Inc.*, 180 F.R.D. 403, 406 (D. Kan. 1998) (the plaintiff did not waive attorney-client privilege over a document by showing the document to her husband).

With this question decided, we now address whether the redacted information in the emails at issue is privileged. RTC0190832 has a single redaction. This redaction redacts the same information as the redaction in RTC0087327 and RTC0088018. For the same reasons set forth with respect to those documents, RTC must remove the redaction from the last sentence of the redacted passage ("Joel is going . . . mentioned above"), but it may maintain the remainder of the redaction. RTC0182615 and RTC0186614 have two redactions. The passage redacted by the first redaction is identical to the passage redacted in RTC0087327, RTC0088018, and RTC0190832; RTC must similarly remove the redaction from the last sentence of this redacted passage. As for the second redacted passage found in RTC0182615 and RTC0186614, it discloses that an RTC employee will contact Banner Witcoff attorneys. The context of the passage reflects that the contact will be for the purpose of legal advice. We therefore conclude that RTC may retain this redaction as well.

(9) RTC0184447 and (10) RTC0185091: These two documents are multi-column spreadsheets that each span numerous pages. In RTC0184447, RTC has redacted 47 cell entries in the "Description" and "Working Title" columns of the spreadsheet. In RTC0185091, RTC has redacted 274 cell entries in the "Title" column of the spreadsheet.

As an initial matter, the context surrounding the spreadsheets is unclear. RTC identifies Medine Krupin, an RTC executive assistant who is not an attorney, as the "author" of the documents (RTC's 7th Suppl. Priv. Log, at 333 (log entry 4877), 1538 (log entry 16282)). Moreover, merely saying, as RTC does, that these documents "are charts reflecting various information, including requests for legal advice" (RTC's Rule 37.2 Resp. at 2), is not very helpful. In any event, RTC asserts that each redacted line from these two spreadsheets "reflects a separate privileged communication from RTC to its attorneys requesting legal advice on topics such as infringement investigations, freedom to operate opinions, and other counseling or enforcement matters" (*Id.*).

RTC's privilege assertion is entirely unfounded. After reviewing each of the more than 300 redacted spreadsheet entries, we did not find a single entry that reflected the substance of a communication seeking legal advice. Indeed, several redacted cells simply identify a company, person, or product; other redacted cells merely indicate that there was a dispute, litigation, or negotiations with a certain company. And while other cells contain legal buzz words, such as patentability, infringement, investigation, and analysis, the mere use of such words does not disclose the substance of, for instance, the infringement analysis, nor does the use of such words indicate a request for such an analysis or advice. The use of these words reveals nothing more about legal advice than would the entries of a properly prepared privilege log, which would require

disclosure of “the subject matter in sufficient detail to determine if legal advice was sought or revealed.” See M.J. Schenkier’s Case Procedures, Privilege Logs, <https://www.ilnd.uscourts.gov/judge-info.aspx?EBclBxz8ceU=> (citing *RBS Citizens, N.A. v. Husain*, 291 F.R.D. 209, 217-19 (N.D. Ill. 2013)). RTC must produce RTC0184447 and RTC0185091 in their entirety without redaction.

(12) RTC0186806 and (13) RTC0186851: These production numbers represent two iterations of an internal RTC document authored or sent by Max Syvuk. Both documents contain two redacted portions.

In the first redacted portion, which is identical in both documents, the first two sentences reflect legal advice from RTC’s attorney about patent marking, so these sentences are properly redacted as privileged. The last sentence of the first redacted portion appears to us to pertain to attorney approval for certain actions, and this also is properly redacted.

As for the second redacted portion in RTC0186806 and RTC0186851, under the heading “Gen 2,” the first three sentences are similar to the sentences discussed immediately above, and they may remain redacted for the same reasons. RTC may also maintain the redaction to the sentences in red in RTC0186806 (which do not appear in RTC0186851), as these sentences suggest the substance of other privileged information in the redacted portion at issue.

CONCLUSION

For the foregoing reasons, we grant in part FFR’s motion to compel (doc. # 341). RTC shall produce documents in accordance with this order within 14 days.

ENTER:



SIDNEY J. SCHENKIER
United States Magistrate Judge

DATE: February 26, 2020