

**UNITED STATES INTERNATIONAL TRADE COMMISSION**

**Washington, D.C.**

**In the Matter of**

**CERTAIN BULK WELDING WIRE  
CONTAINERS AND COMPONENTS  
THEREOF AND WELDING WIRE**

**Inv. No. 337-TA-686**

**ORDER NO. 26: DENYING COMPLAINANTS' MOTION TO PRECLUDE  
RESPONDENTS FROM RELYING ON PRIOR ART NOT  
PRODUCED, OR IN THE ALTERNATIVE, TO COMPEL  
PRODUCTION**

(January 4, 2010)

On December 9, 2009, complainants The Lincoln Electric Company and Lincoln Global, Inc. (collectively "Lincoln") filed a motion to preclude respondents The ESAB Group Inc. ("ESAB") and Sidergas SpA ("Sidergas") from relying on any prior art that has not been produced, or alternatively, to compel ESAB and Sidergas to produce prior art. (Motion Docket No. 686-025.) On December 16, 2009, ESAB filed a response opposing the motion. On December 22, 2009, Sidergas filed a response opposing the motion. On December 22, 2009, the Commission Investigative Staff filed a response opposing the motion to preclude and supporting the motion to compel.

Lincoln's motion relates to ESAB's and Sidergas' alleged failure to fully produce prior art. Lincoln claims that both parties have failed to timely produce all relevant documents related to the prior art that they seek to rely on in this investigation. Lincoln attaches copies of ESAB's and Sidergas' Notices of Prior Art and indicates which prior art documents have not yet been produced.

Lincoln notes that Sidergas has indicated its intention to rely on alleged prior art bulk welding wire containers currently in the possession of Sidergas in Italy. While Sidergas has made these containers available for inspection in Italy, Lincoln seeks an order compelling Sidergas to make the containers available for inspection in Washington, D.C.

Lincoln claims that ESAB refused to participate in discovery until the Commission issued its notice not to review the Initial Determination adding ESAB as a respondent. Lincoln states that it served discovery on ESAB as soon as possible, and responses were due on December 7, 2009. According to Lincoln, ESAB indicated that it would not produce documents until December 11, 2009. Lincoln argues that ESAB has chosen to strictly adhere to the Commission Rules regarding when it became a respondent in this investigation, and so ESAB should strictly adhere to the Commission Rules regarding production of documents.

Sidergas opposes the motion. Sidergas argues that it has fully produced all discovery regarding alleged prior art. Sidergas states that it “has no additional prior art to produce, insofar as it is now aware.” (Sidergas Resp. at 7-8.) Sidergas claims that it has raised objections to producing prior art patents that are publicly available to both parties at the Patent Office website. Finally, Sidergas argues that Lincoln has never discussed the subject of its motion at any Discovery Committee meeting. Sidergas thus argues that the motion should be denied as violating Ground Rule 4.1.1.

ESAB opposes the motion. ESAB claims that Lincoln’s motion to preclude is procedurally deficient because discovery sanctions can only be awarded based on the failure to comply with an order to produce discovery. ESAB argues that Lincoln’s motion to compel violates Ground Rule 4.1.1, as Lincoln had not even seen ESAB’s discovery responses when it put the parties on notice of its intent to file the current motion. ESAB claims that Lincoln failed

to raise the subject matter of the current motion during the parties' December 9, 2009 Discovery Committee call. ESAB asserts that Lincoln's motion is now moot, as ESAB produced the requested documents on December 11, 2009. Finally, ESAB disputes Lincoln's assertion that it has been prejudiced by ESAB's failure to produce documents. ESAB notes that Lincoln's expert report addressing invalidity issues is not due until January 13, 2009. ESAB argues that Lincoln will have adequate time to prepare its expert report.

Staff opposes Lincoln's motion to preclude, making the same procedural argument made by ESAB. Staff states that to the extent that Sidergas and ESAB have not yet produced the prior art upon which they intend to rely, they should be compelled to produce such information. Staff asserts that if a party intends to rely on a physical specimen, it should also be made available for inspection to the extent it has not already been made available.

Regarding Lincoln's motion to preclude, I find that the request is premature. Commission Rule 210.33(b) provides that an order compelling discovery is a prerequisite to the imposition of non-monetary sanctions. Because no order compelling ESAB or Sidergas to produce prior art discovery has issued, Lincoln's request to preclude is procedurally deficient pursuant to Commission Rule 210.33(b).

Regarding Lincoln's motion to compel, both Sidergas and ESAB claim that Lincoln failed to raise the issues in the motion at a Discovery Committee meeting. Ground Rule 4.1.1 states that "[n]o motion to compel discovery may be filed unless the subject matter of the motion has first been brought to the Discovery Committee and the Committee has reached an impasse in resolving the matter." Ground Rule 3.5 requires the parties to make intensive good faith efforts to resolve discovery disputes.

Lincoln states that it first gave notice of its intention to file its motion on December 4, 2009.<sup>1</sup> Lincoln states that during the December 9, 2009 discovery conference, Sidergas indicated that it was not sure whether its document production was complete, and ESAB indicated that Lincoln would receive ESAB's document production on December 11, 2009. Lincoln's summary of the Discovery Committee meeting lacks: (1) any mention of whether Lincoln raised the issues addressed in its motion; (2) facts demonstrating that Lincoln engaged in intensive good faith efforts to resolve the dispute; or (3) a showing that an impasse was declared in resolving the matter. In addition, Lincoln does not attach minutes from the Discovery Committee meeting.

Based on ESAB's and Sidergas' representations that Lincoln failed to address the issues contained in the motion during the Discovery Committee meeting, and Lincoln's own description of the Discovery Committee meeting, I find that Lincoln's motion to compel violates Ground Rule 4.1.1, because the issues contained in the motion were not properly raised at a Discovery Committee meeting and the parties had not reached impasse on those issues. In addition, the present facts support the assertion that Lincoln did not make intensive good faith efforts to resolve the dispute before filing its motion, as required by Ground Rule 3.5.

ORDER

Motion No. 686-025 is hereby DENIED.

**SO ORDERED.**



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Robert K. Rogers, Jr.  
Administrative Law Judge

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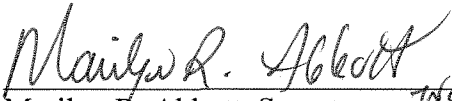
<sup>1</sup> I note that, according to Lincoln, ESAB's discovery responses were not due until December 7, 2009.

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**PUBLIC CERTIFICATE OF SERVICE**

I, Marilyn R. Abbott, hereby certify that the attached **ORDER** was served upon **Benjamin Levi, Esq.**, Commission Investigative Attorneys, and the following parties via first class mail and air mail where necessary on **JAN 05 2010**

  
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**PUBLIC CERTIFICATE OF SERVICE PAGE 2**

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**PUBLIC CERTIFICATE OF SERVICE - PAGE 3**

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