

**Ingram Yuzek Gainen Carroll & Bertolotti, LLP v  
Codon**

2012 NY Slip Op 32741(U)

October 23, 2012

Supreme Court, New York County

Docket Number: 105841/09

Judge: Paul Wooten

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SUPREME COURT OF THE STATE OF NEW YORK — NEW YORK COUNTY

PRESENT: HON. PAUL WOOTEN

Justice

PART 7

INGRAM YUZEK GAINEN CARROLL &  
BERTOLOTTI, LLP,  
Plaintiff,

- against -

WILLIAM CODEN and FIDO'S FENCES, INC.,  
Defendants.

**FILED**

INDEX NO.

105841/09

MOTION SEQ. NO.

005

OCT 26 2012

COUNTY CLERK'S OFFICE  
NEW YORK

The following papers, numbered 1 to 5, were read on this motion by defendants to disqualify plaintiff's counsel.

Notice of Motion/ Order to Show Cause — Affidavits — Exhibits ...

PAPERS NUMBERED

1

Answering Affidavits — Exhibits (Memo) \_\_\_\_\_

2, 3, 4

Reply Affidavits — Exhibits (Memo) \_\_\_\_\_

5

Cross-Motion:  Yes  No

Ingram Yuzak Gainen Carroll & Bertolotti, LLP, (plaintiff) commenced this action against William Coden (Coden) and Fido's Fences, Inc. (Fido's Fences) (collectively, defendants), by the filing of a Summons with Notice seeking, *inter alia*, legal fees and expenses in the amount of \$237,242.14, in connection with plaintiff's representation of Fido's Fences in an underlying action entitled *Fido's Fences, Inc. v The Canine Fence Co.*, Index No. 08-CV-754, United States District Court, Eastern District of New York (underlying action). Lewis Brisbois Bisgaard & Smith LLP (Lewis), is counsel to plaintiff only in connection with defendant's counterclaims for professional malpractice. Plaintiff is proceeding *pro se* on the affirmative claim.

Before the Court is a motion by defendants to disqualify Lewis on the basis that it violated CPLR §§ 3107 and 3120(b) with respect to issuance of subpoenas on nonparties and thereby improperly and covertly obtained privileged and/or confidential documents from defendant's previous counsel Marc Weingard, Esq. (Weingard) of Weinberg, Gross & Pergament, LLP in the underlying action. Defendants also move to suppress the documents

produced by Weingard. Plaintiff and Lewis are in opposition to the motion and defendants submit a reply.

#### BACKGROUND

The underlying action was originally filed in February 2008 in the Supreme Court of New York, Suffolk County, by Fido's Fences then attorney Panagiotta Betty Tufariello, Esq. (Tufariello). The underlying action was then removed to the Eastern District of New York, and Fido's Fences hired plaintiff as its counsel. Plaintiff acted as Fido's Fences attorney in the underlying action until early December of 2008. The herein action was filed on April 24, 2009, when Fido's Fences and its principal, Coden, allegedly failed and refused to pay its legal fees. Meanwhile, Fidos' Fences continued to litigate the underlying action through its successor counsel, Weingard. On January 23, 2009, Magistrate Judge Wall (M.J. Wall) So Ordered a Stipulated Confidentiality Agreement and Protective Order (Protective Order) in the underlying action which stated that material marked "Confidential" or "Attorneys' Eyes/Retained Experts Only" would be filed, if at all, only under seal and would be used for no purpose "other than to assist in the prosecution or defense of claim" in the underlying action (Defendant Affirmation in Support ¶ 7; exhibit B). Subsequently, in 2010, the underlying action was settled.

In the herein matter a Compliance Conference was held on December 22, 2010, during which Lewis maintains that the parties discussed plaintiff's need to review summary judgment motion papers in the underlying action which were under seal. The parties entered into a Compliance Conference Order which provided that defendants would provide an authorization for sealed documents in the underlying action (see Lewis Opposition, exhibit F). It is undisputed that on December 31, 2011, prior to the issuance of any subpoenas, defendants' counsel, Jennifer Coden, Esq. (J. Coden), authorized the release of pleadings in reference to the underlying action (J. Coden Authorization) (Defendant Affirmation in Support ¶ 5, exhibit A; Lewis Affirmation in Opposition at p. 4). What occurred after defendants served the J. Coden

Authorization is disputed by the parties.

Lewis maintains that after receiving the J. Coden Authorization, and before issuing any subpoenas, it contacted Weingard on January 3, 2011 via telephone to discuss obtaining documents pursuant to the J. Coden Authorization and to inquire about the costs and timing of production (see Lewis Opposition ¶¶14). According to Lewis, Weingard said he would be contacting Patrick McHugh (McHugh), counsel for The Canine Fence, Co. in the underlying action to advise that he had been asked to release documents which were under seal. On or about January 13, 2011 McHugh sent an email to Ronald Alensten, Esq. (Alensten), a member of plaintiff, regarding the document production issues relating to the J. Coden Authorization, in which Lewis maintains he mistakenly objects to the production of the documents pursuant to a subpoena as it would violate the Protective Order (Lewis Opposition ¶¶ 16, 17). Lewis maintains that contrary to McHugh's assumption, and also defendants' assumption in its motion papers, as of January 13, 2011, Lewis had not issued any subpoenas, especially without notifying defendants, and the documents that are the subject of McHugh's email were in response to the J. Coden Authorization. Lewis maintains that it was later communicated by McHugh that it was Weingard's decision to determine which of the documents filed under seal in the underlying action would be disclosed.

Subsequently, on February 8, 2011, Lewis served subpoenas *duces tecum* and/or *ad testificandum* upon Weingard, Tufariello and another attorney who acted for Fido's Fences, Mitchell Birzon, seeking disclosure of litigation files maintained by these counsel for Fido's Fences in the underlying action (Lewis Affirmation in Opposition ¶¶ 8, 11; exhibit D). After Lewis served the subpoenas, Tufariello moved for an order of protection and to quash the subpoena served upon her.

The instant motion arises out of Weingard's production of responsive documents which defendants aver contained confidential material under seal pursuant to the Protective Order in

the underlying action, and was allegedly done without their knowledge.

Defendants maintain that Lewis served the subject subpoenas on January 13, 2011 and failed to notify defendants until February 3, 2011, thereby violating CPLR §§ 3107 and 3120(b), which require notice to all adverse parties when such discovery devices are served on nonparties (Notice of Motion, Coden Affirmation ¶¶ 11, 12). The subpoenas requested Weingard's entire file which was to be provided to Lewis on February 28, 2011, and the subpoena scheduled Weingard's deposition for March 28, 2011 at 10:00 a.m. (*id.* at 13, 14). On February 9, 2011, J. Coden advised Lewis by letter that Fido's Fences and Coden was not willing to waive the attorney client privilege with respect to the subpoenaed attorneys, and they also object to production of any documentation containing such privileged information (*see* Notice of Motion, exhibit D). Defendants contend that no communication of any kind occurred between it and Lewis regarding the subpoenas after February 9, 2011, and that the document production date and deposition dated passed without any documents or information from either Weingard or Lewis. It was J. Coden's alleged understanding that Tufariello's motion to quash the Lewis subpoena stayed discovery against all nonparties.

Defendants maintain that they did not have knowledge that Lewis was going to view the Weingard file until April 11, 2011 at 12:19 p.m., when J. Coden received an email from Weingard that Lewis would be inspecting the documents in his office that same day (Coden Affirmation ¶24, exhibit E). In his email Weingard states that he would not be producing for inspection any confidential documents (Coden Affirmation, exhibit E). J. Coden avers in her Affirmation, pursuant to email correspondence between Lewis and Weingard, which is annexed to the motion papers, that the new document production date was set on March 30, 2011, more than two weeks before she was notified (*see* Coden Affirmation, exhibit F). Despite his assurances that no confidential documents would be produced at the inspection, Weingard advised both Lewis and Coden via email on April 13, 2011 that he had failed to remove several

documents that were marked confidential or that were filed under seal in the underlying action (Codan Affirmation, exhibit F). Despite these confidential documents being reviewed by Lewis and tagged for copying, Weingard also stated in the email that he would not be providing copies of same because of the protective order (*see id.*). Despite demanding copies of all of the documents reviewed by Lewis on April 11, 2011, including those marked confidential, defendants maintain that Lewis refused. Defendants maintain they have been severely prejudiced as they were not properly or timely notified by Lewis of the new document inspection date as well as on the basis that Weingard allowed unspecified confidential documents to be reviewed by Lewis. Additionally, it is defendants contention that during the document inspection Lewis was left largely unsupervised, and defendants do not know if confidential documents were photographed, removed or whether copious notes were taken on same (Codan Affirmation ¶ 39).

Alensten submits an Affidavit in Opposition to defendants motion and maintains that defendants' allegations do not establish any misconduct, nor do they establish any misconduct that has harmed or prejudiced defendants. Lewis also submits an Affirmation in Opposition to defendants' motion, wherein it argues that defendants' motion is predicated on misstatements of fact, speculation and conjecture as notice and copies of the subpoenas were given to J. Codan on February 3, 2011, even before they were served on February 8, 2011 (*see* Lewis Affirmation in Opposition, ¶ 27; Notice of Motion, exhibit C), and attaches correspondence with J. Codan as well as affidavits of service of the subpoenas (Lewis Opposition exhibit L, M; Codan Affidavit, exhibit C). Lewis also contends that defendants waived privilege to the material in various discovery orders, particularly, the Court's order dated August 10, 2010. Further, Lewis maintains that defendants do not specifically identify privileged material which was inadvertently disclosed to plaintiff. Defendants are also not prejudiced by the disclosure of their own proprietary information to plaintiff, so far as plaintiff was already privy to this

information as counsel to defendants in the underlying action and defendants have been producing such information during discovery.

#### STANDARD

Disqualification of counsel is a matter that rests within the sound discretion of the trial court (see *Harris v Sculco*, 86 AD3d 481 [2011]). "When considering a motion to disqualify counsel, a trial court must consider the totality of the circumstances and carefully balance the right of a party to be represented by counsel of his or her choosing against the other party's right to be free from possible prejudice due to the questioned representation" (*Ferolito v Vultaggio*, 949 NYS2d 356, 363 [1st Dept 2012], quoting *Abselet v Satra Realty, LLC*, 85 AD3d 1406, 1407 [2011]).

In such cases where attorneys are proceeding against a former client, "disqualification has been directed on a showing of 'reasonable probability of disclosure' of confidential information obtained in the prior representation" (*Saftler v Government Empls. Ins. Co.*, 95 AD2d 54, 57 [1st Dept 1983], citing *Greene v Greene*, 47 NY2d 477, 453 [1979]). Generally, in such cases, an attorney will be disqualified where the party seeking that relief meets his burden by establishing a substantial relationship between the issues in the litigation and the subject matter of the prior representation, or where counsel had access to confidential material substantially related to the litigation (see *Saftler*, 95 AD2d at 57; see also *District Counsel 37 v Kiok*, 71 AD2d 587 [1st Dept 1979]). However, disqualification will not be granted "where there is no substantial relationship or where the party seeking disqualification fails to identify any specific confidential information imparted to the attorney" (*Saftler*, 95 AD2d at 57).

CPLR 3120, provides that:

"After commencement of an action, any party may serve on any other party a notice or on any other person a subpoena duces tecum:

[2] The notice or subpoena duces tecum shall specify the time, which shall not be less than twenty days after service of the notice or subpoena, and the place and manner of making the

inspection. . . ;

[3] The party issuing a subpoena duces tecum as provided hereinabove shall at the time same time serve a copy of the subpoena upon all other parties and, within five days of compliance therewith, in whole or in part, give to each party notice that the items produced in response thereto are available for inspection or copying, specifying the time and place thereof"

#### DISCUSSION

Defendants' motion to disqualify Lewis as plaintiff's counsel is denied. Defendants meet their burden of establishing that a substantial relationship exists between the issues in this litigation and the subject matter of the prior representation, as defendants herein assert a counterclaim of legal malpractice against plaintiff relating to plaintiff's representation of defendants in the underlying action. Moreover it is undisputed that Lewis had access to confidential material during its inspection of documents provided by Weingard. However, defendants have failed to identify any specific confidential material imparted to Lewis (*see Saftler*, 95 AD2d at 57) and how defendants are prejudiced by the production (*see Ferolito*, 949 NYS2d at 363). Additionally, defendants' belief that all nonparty discovery was stayed when Tufariello filed her motion to quash is not supported in the record by any Court order or stipulation.

Furthermore, the Court finds that Lewis satisfied the requirements of CPLR 3120, which requires notice to the adverse party of compliance by the subpoenaed party within five days after a party has received the documents in hand, by providing defendants notice of the subpoenas on February 3, 2011, as well as producing to defendants a copy of the Weingard documents on May 2, 2011, within three days of Weingard's production.

#### CONCLUSION

Accordingly it is hereby,

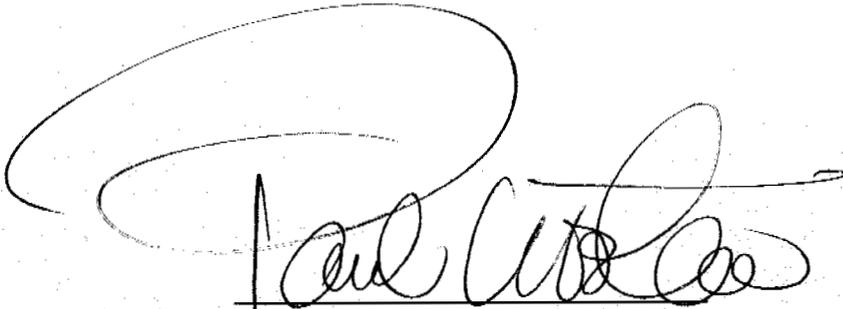
ORDERED that defendants' motion to disqualify Lewis as plaintiff's counsel and for preclusion, pursuant to CPLR 3126, is denied; and it is further,

ORDERED that Lewis, within 30 days of entry, is directed to serve a copy of this Order, with Notice of Entry, upon all parties; and it is further,

ORDERED that the parties are directed to appear for a Status Conference on December 19, 2012 at 11:00 a.m. at 60 Centre Street, Room 341, Part 7.

This constitutes the Decision and Order of the Court.

Dated: 10-23-12

  
PAUL WOOTEN J.S.C.

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Check if appropriate:  DO NOT POST

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