MATTHEW R. WALSH
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Plaintiff In Pro Per,

UNITED STATES DISTRICT COURT

CENTRAL DISTRICT OF CALIFORNIA

MATTHEW R. WALSH Plaintiff In Pro Per, vs. ROKOKO ELECTRONICS (AND DOES 1 THROUGH 50, INCLUSIVE) Defendant	Case No.: 2:25-CV-05340-ODW-RAO Before: Hon. Otis D. Wright II Courtroom 5D Hearing date: October 20, 2025 Hearing time: 1:30PM **REQUEST FOR JUDICIAL NOTICE ISO PLAINTIFFS MOTION FOR SANCTIONS**

REQUEST FOR JUDICIAL NOTICE ISO PLAINTIFFS MOTION FOR SANCTIONS

Pursuant to Federal Rule of Evidence 201(b), Plaintiff respectfully requests that the Court take judicial notice of the following facts, each of which is either (1) not subject to reasonable dispute because it is generally known within this Court's

jurisdiction, or (2) can be accurately and readily determined from sources whose accuracy cannot reasonably be questioned.

Plaintiff respectfully apologizes to the Court for the late submission of this Request; however, pursuant to Rule 102(d), Judicial Notice may be taken at any stage. Further, this filing pertains to Plaintiff's pending Motion for Sanctions, it is necessary to bring ongoing and newly arising issues to the Court's attention to ensure a complete and accurate record before the Court renders its decision.

Plaintiff specifically requests judicial notice of the following:

JUDICIALLY NOTICEABLE DOCKET ENTRIES

1. **Docket #77 (WHAT)** Request for Judicial Notice re: Defendant's Reliance on Fabricated Caselaw **(WHY)** Defendant repeatedly continued using this AI-fabricated caselaw in at least two additional documents despite knowing from the record, it was improper. **This RJN was never opposed and is deemed accepted.**

2. **Docket #80, attachment 2 – (WHAT)** Defendant's blanket objections to nearly every RFA, Interrogatory and RFP **(WHY)** Demonstrates Defendant's ongoing discovery obstruction and contains the Admissions should be deemed admitted by a matter of law and supports sanctions.

3. **Docket #80, attachment 4 – (WHAT)** Forensic PDF search tool results on Defendant's caselaw LEXIS PDF's **(WHY)** Demonstrates with technical precision their caselaw was AI-fabricated and their own PDF files do not reference the caselaw as they state it does, supports sanctions.

4. **Docket #82 – (WHAT)** Defendant's Motion to Quash **(WHY)** Defendant using the same AI-fabricated caselaw *again* on the record after both the unopposed RJN (Dkt #77) and (Dkt #80 attachment 4) demonstrated to Defendant that the caselaw was not valid, supports sanctions and intent.

5. **Docket #82 – (WHAT)** Defendant's Motion to Quash **(WHY)** It contains a footnote accusing Plaintiff of using AI and in that same block, the statement confused Oliver's Standing Orders instead of Otis' for **"Each of Plaintiff's filings to date".** Indicating this too was drafted and hallucinated by AI,

supports sanctions.

6. **Docket #82 – (WHAT)** Defendants Motion to Quash **(WHY)** Supports sanctions and Plaintiff's ask of striking the MTD as Defendant continues to file defective motions, this one of which was stricken as it violates **(one)** L.R. 7-3 – No meet and confer before filing any motions **(two)** L.R. 37-1 – No prefiling conference relating to discovery **(three)** L.R. 11-3.2 – Line numbering is not continuous **(four)** L.R. 11-6.1 – Table of contents is inaccurate *again* and only goes to page 18 out of a 26 page document / Page numbers do not line up 37 with content. **(six)** Court Order Dkt #71 – Footnotes must be used sparingly **(seven)** L.R. 11-6.2 - *Another* false word count / certification –says 5,659 words, however it is actually 6,620.

7. **Docket #72 – (WHAT)** MINUTE ORDER **(WHY**) Supports striking Defendant's MTD and supports sanctions as Defendant continues to repeat violations of Local Rules and Court Orders: *"Further filings that fail to comply with applicable rules or that are otherwise inappropriate will be summarily stricken, and* ***the Court will not hesitate to impose monetary sanctions in cases where the violations are*** *particularly egregious or* ***repeated****."*.

JUDICIALLY NOTICEABLE EXHIBITS (ATTACHED)

8. **EXHIBIT 1 – Attached (WHAT)** A list of 248 words and phrases which Defendant claimed were "ambiguous" and "vague", most of which are plain English and some which are alarming if the definition is truly unknown such as (Counsel, Plaintiff, Evidence, Warranty, Customer, Sell, Employee, **(WHY)** Supports sanctions and demonstrates Defendant's ongoing discovery obstruction and contains the Admissions should be deemed admitted by a matter of law.

9. **EXHIBIT 2 – Attached (WHAT)** Defendant's LEXIS PDF's sent to Plaintiff to disprove their caselaw was AI-fabricated **(WHY) –** Docket #80 attachment 4 demonstrates that the caselaw was in fact AI-fabricated and the LEXIS PDF's do nothing to absolve Defendants.

JUDICIALLY NOTICEABLE LOCAL RULES

10. **Local Rule 11-9** – *"The presentation to the Court of frivolous motions or opposition to motions (or the failure to comply fully with this rule) subjects the offender at the discretion of the Court to the sanctions of L.R. 83-7."*

11. **Local Rule 83-7 –** *"The violation of or failure to conform to any of these Local Rules may subject the offending party or counsel to: (a) (b) (c) monetary sanctions, if the Court finds that the conduct was **willful, grossly negligent, or reckless**; the imposition of costs and attorneys' fees to opposing counsel, if the Court finds that the conduct rises to the level of **bad faith** and/or a **willful disobedience of a court order**; and/or for any of the conduct specified in (a) and (b) above, such other sanctions as the Court may deem appropriate under the circumstances."*

12. **Local Rule 83-8 (WHAT)** Vexatious litigants **(WHY)** Should Plaintiff's motion be granted in all or part, Local Rule 83-8 and subparts may be applied by the Court due to Defendants conduct to deter/prevent future misconduct.

13. **Local Rule 83-8.3** –Vexatious litigants *"Any order issued under L.R. 83-8.2 shall be based on a finding that the litigant to whom the order is issued has*

abused the Court's process and is likely to continue such abuse, unless protective measures are taken."

JUDICIALLY NOTICEABLE CASES AND STATUTES

14. Plaintiff respectfully requests the Court take judicial notice of the following cases and for what purpose:

a. **The following case supports that Defendant's refusal to engage in meet and confers without recording of them is sanctionable:**

i. Wilbert v. Pyramid Healthcare, Inc., No. 3:18-cv-215 (W.D. Pa. Feb. 5, 2019) - Counsel was sanctioned because they refused to meet and confer without imposed conditions—such as insisting on recording any in-person conference—that made cooperation impossible. Precisely what Defendants have done.

b. **The following cases support that Defendant's obstruction with third-party subpoenas is improper:**

i. United States of America v AB Electrolux and General Electric Company (2015) - Highly wealthy and large companies cannot flatly declare undue burden to avoid discovery.

ii. Pegoraro v. Marrero, United States District Court, S.D. New York, February 3, 2012, 281 F.R.D. 122 - specifies when subpoenas are and are not overbroad.

iii. Meek v. Ward, No. 2:21-CV-00216-HL, 2022 WL 19977542, at *2 (D. Or. Feb. 3, 2022) – Defendants cannot claim "any and all communications" is overbroad, they can only make reasonable objections to the time periods.

iv. Pub. Serv. Co. of Okla., 2011 WL 691204, at *4. - "[e]ven if a party has standing to challenge a subpoena directed to a third party on privilege grounds, he may not challenge that subpoena on the grounds that the information imposes an undue burden on the subpoenaed party."

c. The following statutes and cases support that Defendant's boiler-plate blanket objections should be deemed admitted as a matter of law:

i. Fed. R. Civ. P. 36(a)(4) – A responding party must *"**specifically** deny the matter or state in detail **why** the answering party **cannot truthfully admit or deny it**."*

ii. Fed. R. Civ. P. 36(a)(6) – *The requesting party may move to determine the sufficiency of an answer or objection. Unless the court finds an objection justified, it must order that an answer be served.* ***On finding that an answer does not comply with this rule. It authorizes the court to deem requests admitted when the response is evasive, nonresponsive, or objection-only.***

iii. Moore v. Cox, 341 F. Supp. 2d 570, 573 (E.D. Va. 2004) – ***"A party's failure to admit or deny a matter is tantamount to an admission."***

iv. Siser N. Am., Inc. v. Herika G. Inc., 325 F.R.D. 200, 209–10 (E.D. Mich. 2018) – The court held that *"Boilerplate objections are legally meaningless and amount to a waiver of an objection."*

v. Strategic Mktg. & Research Team, Inc. v. Auto Data Sols., Inc., No. 2:15-cv-12695, 2017 WL 1196361, at *2 (E.D. Mich. Mar. 31, 2017) - *"Boilerplate or generalized objections are*

tantamount to no objection at all and will not be considered by the Court."

vi. Auburn Sales, Inc. v. Cypros Trading & Shipping, Inc., No. 14-cv-10922, 2016 WL 3418554, at *3 (E.D. Mich. June 22, 2016) – *"The filing of boilerplate objections is tantamount to filing no objections at all."*

vii. Lucky v. Detroit Prop. Exch. Co., No. 2:19-cv-11122, 2020 WL 6118495, at *1 (E.D. Mich. Oct. 16, 2020) The court condemned *"litany-style boilerplate objections" as "strongly disfavored and meaningless."*

viii. Oleson v. Kmart Corp., 175 F.R.D. 560, 565 (D. Kan. 1997) – *"The litany of overly burdensome, oppressive, and irrelevant does not alone constitute a successful objection to a discovery request."*

ix. Asea, Inc. v. S. Pac. Transp. Co., 669 F.2d 1242, 1246 (9th Cir. 1981) – The Ninth Circuit affirmed that when responses to RFAs are *"evasive or incomplete*,**" the trial court may deem the matters admitted under Rule 36(a).**

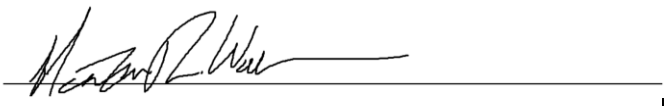
x. Marchand v. Mercy Med. Ctr., 22 F.3d 933, 936–37 (9th Cir. 1994) – The Ninth Circuit again upheld deemed admissions

where the responding party failed to timely serve proper responses, finding that admissions under Rule 36 are *"conclusively established unless withdrawn or amended by the court."*

xi. Henry v. Champlain Enters., Inc., 212 F.R.D. 73, 77 (N.D.N.Y. 2003) – *"Objections alone, without a statement that the party cannot admit or deny, are insufficient under Rule 36(a)."*

All exhibits attached hereto are true and accurate copies of documents I have received or made. I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Executed on October 18, 2025, in Santa Clarita, California.



Matthew R. Walsh

Plaintiff in pro per

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EXHIBIT 1

1. Compounded
2. Common
3. Ownership
4. (2) and (3) Compounded: **"Common ownership"**
5. Joint
6. Overlapping
7. Assets
8. Plaintiff's
9. Photograph
10. (8) and (9) compounded **"Plaintiff's photographs"**
11. Business
12. Ties
13. (11) and (12) compounded: **"Business ties"**
14. Assisted
15. Motion
16. Capture
17. Equipment

18.(15) and (16) and (17) compounded: **"Motion capture Equipment"** *(as in the very product Defendant sells)*

19. Investors

20. Witnessed

21. Animation

22. Data

23. (21) and (22) compounded: **"Animation Data"** *(as in the output from the very product Defendant sells)*

24. User

25. Content

26. (24) and (25) compounded: **"User Content"** (definable from Defendant's own website www.rokoko.com/studio-term-of-use)

27. Terms

28. Of

29. Service

30. (27) and (28) and (29) compounded: **"terms of service"**

31. Rights

32. Use

33. Resell

34. Changed

35. Anonymized (definable from Defendant's own website https://www.rokoko.com/mocap/motion-dataset)

36. Sell

37. Resell

38. Financial

39. Gain

40. (38) and (39) compounded: **"Financial Gain"**

41. CMI (definable from Defendant's own filing Dkt #42 and/or 17 USC 1202(c))

42. Considered

43. Conducted

44. AI

45. Training

46. (44) and (45) compounded: **"AI Training"**

47. User

48. Controlled

49. Opt-out

50. Mechanism

51. (47) trhough (50) compounded: **"User Controlled Opt-Out Mechanism"**

52. Data

53. Collection

54. (52) and (53) compounded: **"Data Collection"**

55. Marketing

56. Materials

57. Websites

58. (55) through (57) compounded: **"Marketing materials and websites"**

59. Live

60. Telemetry

61. (59) and (60) compounded: **"Live Telemetry"**

62. Mixed

63. Boot

64. States

65. (62) through (64) compounded **"Mixed Boot States"** (definable from Defendant's own technical logs and software – Compl. ¶ 7)

66. Parts

67. Stop

68. Working

69. (67) and (68) compounded: **"Stop Working"**

70. Used

71. Other

72. Operating

73. Software

74.(71) through (73) compounded **"Other Operating Software"**

75. Warranty

76. Warranties

77. Modified

78. Notification

79. Remove

80.(79) and (41) compounded: **"Remove CMI"**

81. Generally

82. Segments (definable from Defendant's own website: https://www.rokoko.com/mocap/motion-dataset)

83. Collect

84. Collected

85. Employee

86. In

87. California

88.(86) and (87) compounded: **"In California"**

89. Web

90. Server

91.(89) and (90) compounded: **"Web Server"**

92. Secret

93. Area

94.(92) and (93) compounded: **"Secret Area"** *(as found in Defendant's 'Rokoko Studio' source code within the namespace TeamSharingWebSocketSharp.Server within the class WebSocketServer, fourth private static readonly variable (of type string))*

95. Default

96. Realm

97.(95) and (96) compounded**: "Default Realm"** *(as found in Defendant's 'Rokoko Studio' source code within the namespace TeamSharingWebSocketSharp.Server within the class WebSocketServer, fourth private static readonly variable (of type string))*

98. Remote

99. Remotely

100. Disable

101. Functionality

102. Undocumented

103. Forces

104. Connect

105. Synchronize

106. Synchronized

107. MQTT

108. NAT

109. Hole

110. Punching

111. (108) through (110) compounded: **"NAT Hole Punching"** *(as found in Defendant's 'Rokoko Studio' source code within the namespace TeamSharingMQTTnet.Server within the sealed class MqttClientKeepAliveMonitor))*

112. Punching

113. Included

114. Inaccurate

115. Plaintiff's

116. Exhibits

117. (115) and (117) compounded: "**Plaintiff's Exhibits"**

118. Any

119. Effort

120. (118) and (119) compounded: **"Any Effort"**

121. Motion

122. To

123. Dismiss

124. (121) through (123) compounded: **"Motion to Dismiss"** (as in Docket #42)

125. Your

126. (125) and (124) compounded: **"Your Motion to Dismiss"** (Defendant should define this alone)

127. Reported

128. Law

129. Enforcement

130. Agency

131. (128) through (130) compounded: **"Law Enforcement Agency"**

132. Regulatory

133. Authority

134. (134) and (133) compounded: **"Regulatory Authority"**

135. Never

136. Reported

137. (135) and (136) compounded: "**Never Reported**"

138. Prior

139. Notice

140. (138) and (140) compounded: **"Prior Notice"**

141. Subsidiaries *(such as the term Defendant used in his facebook post in (Dkt #52, Exhibit SET1-F))*

142. Interest

143. Staffed

144. Unstaffed

145. Copenhagen

146. HQ

147. (145) and (146) combined **"Copenhagen HQ"** *(such as the term Defendant used themselves in Dkt #62, Attachment 1)*

148. Counsel

149. Calling

150. Emailing

151. Removed

152. Her

153. From

154. The

155. Docket

156. (151) and (152) and (153) and (154) and (155) compounded: **"Removed her from the docket"**. *(Such as Dkt #7, Dkt #8 - Defendant should answer this themselves using the now defined words)*

157. Mikkel Overby *(Defendant's Counsel should answer this themselves unless they are unaware of who their client is; or alternatively Defendant may, unless they are unaware of who their COO is and who is writing personal declarations in this case)*

158. Declaration

159. Earlier

160. (159) and (158) compounded: **"Earlier Declaration"**

161. Mikkel Overby's Declaration (as in Dkt #1, attachment 4)

162. Mikkel Overby's Declaration (as in Dkt #62, attachment 1)

163. Contradictions

164. Metadata

165. Accurate

166. Assist

167. Determination

168. Expert

169. Technologist

170. (168) and (169) combined: **"Expert Technologist"**

171. Customers

172. Core

173. Operational

174. Servers

175. (171) and (172) and (173) combined: **"Core Operational Servers"**

176. Many

177. Or

178. All

179. (176) and (177) and (178) combined: **"Many or All"**

180. Disclose

181. Existence

182. Continued

183. Operation

184. (182) and (183) combined: "**Continued Operation"**

185. Funding

186. Investments

187. Authored

188. Edited

189. False

190. Threatened

191. Raised

192. Their

193. Voices

194. (191) and (192) and (193) combined: **"Raised Their Voices"**

195. Laughed

196. Giggled

197. Disparaging

198. Condescending

199. Intended

200. Dissuade

201. Pursing

202. Pursuing

203. Rhetorical

204. In

205. Nature

206. (203) and (204) and (205) compounded: **"Rhetorical In Nature"**

207. Supported

208. Capabilities

209. Technical Capability

210. Interpret

211. Reproduce

212. Evidence

213. Plaintiff

214. Has

215. Placed

216. Before

217. The

218. Court

219. (213) through (218) compounded: **"Evidence Plaintiff Has Placed Before The court"**

220. Technical

221. Expertise

222. (220) and (221) combined **"Technical Expertise"**

223. Advanced

224. Forensic

225. And

226. Software

227. Evidence

228. (223) through (227) compounded: **"Forensic and Software Evidence"**

229. Conduct

230. Analyze

231. Performed

232. Analysis

233. No

234. Attorney

235. (233) and (234) compounded **"No Attorney"**

236. Initial

237. Declaration

238. (236) and (237) compounded: **"Initial Declaration"** *(As in Dkt #1, not Dkt #62, as mathematically number 1 comes before the number 62 - Defendant should answer this themselves)*

239. Second

240. Declaration

241. (239) and (240) compounded: **"Second Declaration"** *(As in Dkt #62, not Dkt #1)*

242. Statements

243. Sold

244. Licensed

245. Motion

246. Data

247. (245) and (246) compounded **"Motion Data"** (as defined from Defendants own website https://www.rokoko.com/mocap/motion-dataset)

248. Speaking

249. Publicly

250. (248) and (249) compounded: **"Speaking Publicly"**

EXHIBIT 2

Questioned
As of: July 24, 2020 8:33 PM Z

Arminak & Assocs. v. Saint-Gobain Calmar, Inc.

United States Court of Appeals for the Federal Circuit

September 12, 2007, Decided

2006-1561

Reporter
501 F.3d 1314 *; 2007 U.S. App. LEXIS 21820 **; 84 U.S.P.Q.2D (BNA) 1258 ***

ARMINAK AND ASSOCIATES, INC. and HELGA ARMINAK, Plaintiffs/Counterclaim Defendants-Appellees, and ARMIN ARMINAK, Counterclaim Defendant-Appellee, v. SAINT-GOBAIN CALMAR, INC. (now known as MeadWestvaco Calmar, Inc.), Defendant/Counterclaimant-Appellant.

Subsequent History: US Supreme Court certiorari denied by, Motion granted by *St.-Gobain Calmar, Inc. v. Arminak & Assocs., 553 U.S. 1102, 128 S. Ct. 2906, 171 L. Ed. 2d 858, 2008 U.S. LEXIS 4799 (2008)*

Partial summary judgment granted by, Stay granted by *Arminak & Assocs. v. St.-Gobain Calmar, Inc., 789 F. Supp. 2d 1201, 2011 U.S. Dist. LEXIS 62557 (C.D. Cal., June 7, 2011)*

Prior History: [**1] Appealed from: United States District Court for the Central District of California. Judge Cormac J. Carney.

Arminak & Assocs. v. St.-Gobain Calmar, Inc., 424 F. Supp. 2d 1188, 2006 U.S. Dist. LEXIS 20168 (C.D. Cal., 2006)

Disposition: AFFIRMED.

Core Terms

patented, shroud, trigger, ordinary observer, sprayer, district court, designs, purchaser, novelty, retail, DRAWING, infringement, liquid, consumer, deceived, bottle, prior art, horizontal, assembled, similarities, features, buyer, appearance, ornamental, manufacture, industrial, blocks, cap, substantially similar, appropriated

501 F.3d 1314, *1314; 2007 U.S. App. LEXIS 21820, **1; 84 U.S.P.Q.2D (BNA) 1258, ***1258

Case Summary

Procedural Posture

Appellee competitor of defendant patent owner brought an action seeking a declaration that the competitor's shroud on its trigger sprayer did not infringe the owner's patented shroud design. The owner appealed a summary judgment of noninfringement entered in the United States District Court for the Central District of California.

Overview

The owner contended that its patent claims were construed too narrowly, and that an industrial buyer rather than a retail consumer of products using a trigger sprayer was erroneously identified as the ordinary observer. The owner also argued that the similarities in the owner's shroud design and the competitor's shroud would deceive an ordinary observer, and that the points of novelty of the patented design were clearly present in the competitor's shroud. The appellate court held, however, that the finding of noninfringement was proper. The meticulous description of the patented design was not too detailed and accurately demonstrated the claimed design as a whole. Further, the ordinary observer of the shroud design was properly identified as an industrial buyer to whom both the owner and the competitor sold their products for incorporation into the buyer's products, and it was undisputed that the differences in the designs of the owner and the competitor were apparent to such an observer. Also, the owner identified points of novelty as a prominent horizontal line and a distinctive shroud shape, and it was clear that such points of novelty did not exist in the competitor's shroud.

Outcome

The summary judgment of noninfringement was affirmed.

LexisNexis® Headnotes

Civil Procedure > Appeals > Summary Judgment Review > Standards of Review

501 F.3d 1314, *1314; 2007 U.S. App. LEXIS 21820, **1; 84 U.S.P.Q.2D (BNA) 1258, ***1258

HN1 **Summary Judgment Review, Standards of Review**

An appellate court reviews a grant of summary judgment de novo, reviewing the record and drawing all reasonable inferences in the nonmovant's favor to determine whether there is a genuine issue as to any material fact.

Patent Law > Subject Matter > Design Patents > Functionality

Patent Law > Subject Matter > Design Patents > Ornamentality Requirement

HN2 **Design Patents, Functionality**

A design patent protects the nonfunctional aspects of an ornamental design as shown in the patent. The chief limitation on the patentability of designs is that they must be primarily ornamental in character. If the design is dictated by performance of the article, then it is judged to be functional and ineligible for design patent protection.

Business & Corporate Compliance > ... > Patent Law > Infringement Actions > Design Patents

HN3 **Infringement Actions, Design Patents**

See *35 U.S.C.S. § 289*.

Business & Corporate Compliance > ... > Patent Law > Infringement Actions > Design Patents

HN4 **Infringement Actions, Design Patents**

A design patent is infringed by the unauthorized manufacture, use, or sale of the article embodying the patented design or any colorable imitation thereof.

Business & Corporate Compliance > ... > Patent Law > Infringement Actions > Design Patents

HN5 **Infringement Actions, Design Patents**

Infringement of a design patent is evaluated in a two-step process. First, a court must construe the claims of the design patent to determine their meaning and scope. Design patents typically are claimed as shown in drawings. Claim construction by a court is adapted accordingly. The scope of the claim of a patented design encompasses its visual appearance as a whole, and in particular the visual impression it creates.

Business & Corporate Compliance > ... > Patent Law > Infringement Actions > Design Patents

HN6 **Infringement Actions, Design Patents**

After construction of a design patent's claims, a court compares the construed claims to an accused design. Infringement of a design patent occurs if the designs have the same general visual appearance, such that it is likely that a purchaser (or an ordinary observer) would be deceived into confusing the design of the accused article with the patented design. The patented and accused designs do not have to be identical in order for design patent infringement to be found. In determining infringement of a design patent, the court is not limited to the ornamental features of a subset of the drawings, but instead must encompass the claimed ornamental features of all figures of a design patent.

Business & Corporate Compliance > ... > Patent Law > Infringement Actions > Design Patents

HN7[] **Infringement Actions, Design Patents**

A comparison of patented and accused designs involves two separate tests, both of which must be satisfied to find infringement: the "ordinary observer" test and the "point of novelty" test. If, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other. In a separate and distinct inquiry, the point of novelty test requires proof that the accused design appropriated the novelty which distinguishes the patented design from the prior art. Both the ordinary observer test and point of novelty test are factual inquiries.

Business & Corporate Compliance > ... > Patent Law > Infringement Actions > Design Patents

Patent Law > Infringement Actions > Claim Interpretation > Construction Preferences

HN8[] **Infringement Actions, Design Patents**

Patent law does not prohibit detailed claim construction of design patent drawings. It merely disapproves claim construction that goes beyond the novel, nonfunctional ornamental features visually represented by the claimed drawings, or that fails to encompass the claimed ornamental features of the design as a whole.

Business & Corporate Compliance > ... > Patent Law > Infringement Actions > Design Patents

HN9[] **Infringement Actions, Design Patents**

A question that is central to every design patent case is the identity of the ordinary observer of the design at issue. This test requires an objective evaluation of the question of whether a hypothetical person called the ordinary observer would find substantial similarities between the patented design and the accused design, so as to be deceived into purchasing the accused design believing it is the patented design.

Business & Corporate Compliance > ... > Patent Law > Infringement Actions > Design Patents

HN10 **Infringement Actions, Design Patents**

Ordinary observers are described as people possessing ordinary acuteness, bringing to the examination of an article upon which a design has been placed that degree of observation which men of ordinary intelligence give. It is persons of this class who are the principle purchasers of the articles to which designs have given novel appearances, and if they are misled, and induced to purchase what is not the article they supposed it to be, patentees of the design are injured, and the advantage of a market which the patent was granted to secure is destroyed. To be effective, design patent protection must focus upon observations by ordinary observers, by those who buy and use the article bearing the design in question.

Business & Corporate Compliance > ... > Patent Law > Infringement Actions > Design Patents

HN11 **Infringement Actions, Design Patents**

The focus of the ordinary observer test for design patent infringement is on the actual product that is presented for purchase, and the ordinary purchaser of that product.

Business & Corporate Compliance > ... > Patent Law > Infringement Actions > Design Patents

HN12 **Infringement Actions, Design Patents**

In applying the ordinary observer test, a court compares construed patent claims to an accused design to determine whether the designs have the same general visual appearance, such that it is likely that the purchaser (or the ordinary observer) would be deceived into confusing the design of the accused article with the patented design. Specifically, the question to be addressed in applying the ordinary observer test is whether the ordinary observer would be deceived by the accused design because it is substantially similar to the patented design. The ordinary observer test requires the comparing of the accused and patented designs from all views included in the design patent, not simply those views a retail customer seeking to buy would likely see when viewing the product at the point of sale.

Business & Corporate Compliance > ... > Patent Law > Infringement Actions > Design Patents

HN13 **Infringement Actions, Design Patents**

The point of novelty test must be satisfied for an accused design to infringe a design patent. In applying the point of novelty test, a court compares the construed claims to the accused design to determine whether the accused design has appropriated the points of novelty from the patented design. Where the art in the field of a particular design is crowded, the court must construe the range of equivalents narrowly.

Business & Corporate Compliance > ... > Patent Law > Infringement Actions > Design Patents

HN14 **Infringement Actions, Design Patents**

501 F.3d 1314, *1314; 2007 U.S. App. LEXIS 21820, **1; 84 U.S.P.Q.2D (BNA) 1258, ***1258

The relevant inquiry in the point of novelty test is not to analyze the words used by a patent owner to describe a particular design feature after the issuance of a design patent, but whether the design feature, as it appears in the figures of the patent as issued, is found in an accused design.

Business & Corporate Compliance > ... > Patent Law > Infringement Actions > Design Patents

HN15[] **Infringement Actions, Design Patents**

To establish infringement in a design patent case, a district court is required to compare the patented design with the accused design.

Counsel: Daniel C. DeCarlo, Lewis Brisbois Bisgaard & Smith, of Los Angeles, California, argued for the plaintiffs/counterclaim defendants-appellees and counterclaim defendant-appellee. With him on the brief were William C. Steffin and Isamu H. Lee. Of counsel was David N. Makous.

Roger D. Taylor, Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P., of Atlanta, Georgia, argued for defendant/counterclaimant-appellant. With him on the brief were Michael J. McCabe, II and Robert C. Stanley. On the principal brief were M. Kelly Tillery, Charles S. Marion, and Keith Lee, Pepper Hamilton LLP, of Philadelphia, Pennsylvania.

Judges: Before MICHEL, Chief Judge, GAJARSA, Circuit Judge, and HOLDERMAN, * Chief District Judge.

Opinion by: James F. Holderman

Opinion

[***1260] [*1317] HOLDERMAN, *Chief District Judge*.

Appellant Saint-Gobain Calmar, Inc. ("Calmar") appeals from the district court's order granting summary judgment in favor of Arminak & Associates, Inc. ("Arminak"), finding that the design of [**2] Arminak's "AA Trigger" shroud did not [*1318] infringe Calmar's two design patents, U.S. Patents Nos. Des.

* Honorable James F. Holderman, Chief Judge, United States District Court for the Northern District of Illinois, sitting by designation.

381,581 ("the '581 patent") and Des. 377,602 ("the '602 patent"). *Arminak & Assoc., Inc. v. Saint-Gobain Calmar, Inc., 424 F. Supp. 2d 1188 (C.D. Cal. 2006)*. We affirm.

I. *Background*

Calmar and Arminak are both in the business of selling trigger sprayers to producers of liquid household products. A trigger sprayer is a device that is attached atop the cap of a bottle containing liquid, with a tube extending from the trigger sprayer device into the liquid. When the trigger of the sprayer device is manually pulled back, liquid is drawn up the tube into the sprayer device and is dispersed as a spray or mist out of the device's nozzle. The outside cover of the top portion of the sprayer device behind the nozzle and above the trigger mechanism is called the shroud, which is typically made of a molded plastic design.

In 1997, the U.S. Patent and Trademark Office ("PTO") granted Calmar two design patents--the '581 and '602 patents--on two trigger sprayer shroud designs. Calmar thereafter produced a commercial embodiment of the '581 patent called the "ERGO" shroud. No commercial embodiment of the [**3] shroud design set forth in the '602 patent has been produced.

In 2004, Arminak began selling its "AA Trigger" sprayer with the accused shroud design. In October 2004, Calmar informed one of Arminak's customers that Calmar believed the shroud design of Arminak's AA Trigger sprayer infringed Calmar's '581 and '602 design patents. On November 16, 2004, Arminak filed a declaratory judgment action against Calmar in the United States District Court for the Central District of California seeking a declaratory judgment of noninfringement. Calmar counterclaimed, alleging infringement of its '581 and '602 design patents. Arminak filed an amended complaint adding allegations of patent invalidity and certain state law claims against Calmar. After a period of pretrial discovery, Arminak moved for summary judgment on its declaratory judgment claim, asserting that Arminak's AA Trigger shroud's design does not infringe Calmar's patents. On March 20, 2006, the district court in a detailed opinion determined that the shroud of Arminak's AA Trigger does not infringe Calmar's '581 and '602 design patents. *Arminak, 424 F. Supp. 2d at 1189-90*. On May 9, 2006, the district court dismissed Calmar's patent [**4] infringement counterclaims, stayed the litigation as to Arminak's patent invalidity and state law claims, and entered judgment in Arminak's favor pursuant to *Federal Rule of Civil Procedure 54(b)*.

In granting Arminak's motion for summary judgment of noninfringement on Arminak's declaratory judgment claim and dismissing Calmar's counterclaims, the district court initially construed the claims of Calmar's '581 and '602 design patents. The district court then found that the ordinary observer of the trigger sprayer shroud designs in question was not the retail consumer or purchaser of retail products sold in containers with trigger sprayer devices, but the buyer of trigger sprayers for a contract filler or an industrial purchaser up the stream of commerce from the retail purchaser. The district court further found that the ordinary observer of trigger sprayers would not be deceived by the similarities between Arminak's AA Trigger shroud's design and Calmar's patented shroud designs. Additionally, the district court found that the similarities between Arminak's AA Trigger shroud and the design of Calmar's patented shrouds do not stem from Calmar's two asserted points of design novelty over [**5] the prior art in the sprayer shroud field.

[*1319] II. *Jurisdiction and Standard of Review*

The district court's subject matter jurisdiction over Arminak's declaratory judgment action for patent noninfringement was granted by *28 U.S.C. § 1338(a)*. We have jurisdiction over Calmar's appeal of the district court's partial summary judgment pursuant to *28 U.S.C. § 1292(c)(2)* and *§ 1295(a)(1)*.

HN1[⬆] We review a grant of summary judgment de novo, reviewing the record and drawing all reasonable inferences in the nonmovant's favor to determine whether there is a genuine issue as to any material fact. *Johns Hopkins [***1261] Univ. v. Cellpro, Inc., 152 F.3d 1342, 1353 (Fed. Cir. 1998)*.

III. *Calmar's Contentions of Error*

Calmar asserts four primary bases for its appeal: (1) the district court erred by construing the claims of Calmar's patents too narrowly; (2) the district court erred in its identification of the industrial buyer, not the retail consumer, as the ordinary observer; (3) the district court erred in holding that no reasonable jury could find that the ordinary observer would be deceived by the similarities of the trigger sprayers' shroud designs in question; (4) the district court erred in holding that no reasonable [**6] jury could find the points of novelty of the patented designs to be present in Arminak's AA Trigger shroud's design. Each of Calmar's arguments supporting its contentions of error is discussed below, after a brief overview of the law governing design patents.

IV. *Overview of Design Patent Law*

HN2[⬆] "A design patent protects the nonfunctional aspects of an ornamental design as shown in the patent." *Elmer v. ICC Fabricating, Inc., 67 F.3d 1571, 1577 (Fed. Cir. 1995)* (citing *Keystone Retaining Wall Sys., Inc. v. Westrock, Inc., 997 F.2d 1444, 1450 (Fed. Cir. 1993))*. The chief limitation on the patentability of designs is that they must be primarily ornamental in character. If the design is dictated by performance of the article, then it is judged to be functional and ineligible for design patent protection. *Best Lock Corp. v. Ilco Unican Corp., 94 F.3d 1563, 1566 (Fed. Cir. 1996)*.

The elements of design patent infringement are set forth at *35 U.S.C. § 289*:

> ***HN3***[⬆] Whoever during the term of a patent for a design, without license of the owner, (1) applies the patented design, *or any colorable imitation* thereof, to any article of manufacture for the purpose of sale, or (2) sells or exposes for sale any article [**7] of manufacture to which such design *or colorable imitation* has been applied shall be liable to the owner to the extent of his total profit, but not less than $ 250, recoverable in any United States district court having jurisdiction over the parties.

35 U.S.C. § 289 (emphases added). Accordingly, ***HN4***[⬆] a design patent is infringed by the "unauthorized manufacture, use, or sale of the article embodying the patented design or any colorable imitation thereof." *Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co., 162 F.3d 1113, 1116-17 (Fed. Cir. 1998)*.

Similar to the infringement analysis of a utility patent, ***HN5***[⬆] infringement of a design patent is evaluated in a two-step process. First, the court must construe the claims of the design patent to determine their meaning and scope. *OddzOn Prods., Inc. v. Just Toys, Inc., 122 F.3d 1396, 1404-05 (Fed. Cir. 1997)*. Design patents typically are claimed as shown in drawings. Claim construction by a court is adapted accordingly. *Goodyear, 162 F.3d at 1116*. The scope of the claim of a patented design "encompasses 'its visual appearance as a whole,' and in particular [*1320] 'the visual impression it

creates.'" *Contessa Food Prods., Inc. v. Conagra, Inc., 282 F.3d 1370, 1376 (Fed. Cir. 2002)* [**8] (quoting *Durling v. Spectrum Furniture Co., 101 F.3d 100, 104-05 (Fed. Cir. 1996)*).

Second, ***HN6***[↑] after construction of the patent's claims, the court is to compare the construed claims to the accused design. *Elmer, 67 F.3d at 1577*. Infringement of a design patent occurs if "the designs have the same general visual appearance, such that it is likely that the purchaser [(or the ordinary observer)] would be deceived into confusing the design of the accused article with the patented design." *Goodyear, 162 F.3d at 1118*. The patented and accused designs do not have to be identical in order for design patent infringement to be found. *Contessa, 282 F.3d at 1376*. In determining infringement of a design patent, the court "is not limited to the ornamental features of a subset of the drawings, but instead must encompass the claimed ornamental features of *all figures* of a design patent." *Id. at 1379* (emphasis added).

HN7[↑] The comparison of the patented and accused designs involves two separate tests, both of which must be satisfied to find infringement: the "ordinary observer" test and the "point of novelty" test. *Bernhardt, L.L.C. v. Collezione Europa USA, Inc., 386 F.3d 1371, 1383 (Fed. Cir. 2004)*. The "ordinary [**9] observer" test was first enunciated by the United States Supreme Court in *Gorham Manufacturing Co. v. White, 81 U.S. 511, 20 L. Ed. 731 (1871)*, which held that:

> [I]f, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to [***1262] purchase one supposing it to be the other, the first one patented is infringed by the other.

Id. at 528. In a separate and distinct inquiry, the "point of novelty" test requires proof that the accused design appropriated the novelty which distinguishes the patented design from the prior art. *Egyptian Goddess, Inc. v. Swisa, Inc., No. 2006-152, 498 F.3d 1354, 2007 U.S. App. LEXIS 20599, 2007 WL 2439541, at *2 (Fed. Cir. Aug. 29, 2007)* (citing *Litton Sys., Inc. v. Whirlpool Corp., 728 F.2d 1423, 1444 (Fed. Cir. 1984)*). Both the ordinary observer test and point of novelty test are factual inquiries. *Bernhardt, 386 F.3d at 1383*.

V. *Discussion of Calmar's Arguments*

A. The District Court's Detailed Claim Construction

Calmar argues that the district court erred by construing the claims of the patents-in-suit too narrowly, improperly focusing on and describing in minute detail the ornamental [**10] features of Calmar's patent rather than simply describing in words what is shown in their drawings. Based on the allegedly "too narrow" claim construction, the district court, according to Calmar, then improperly engaged in a "side-by-side, element-by-element comparison of the minute details of and differences between the patented designs and the AA Shroud." Appellant's Br. at 67.

The district court in this case performed the requisite task of claim construction by describing each of the drawings of Figures 1 through 5 in each of the two Calmar patents-in-suit. In doing so, the district court was careful to point out that the patented design did not include the nozzle, trigger, or closure cap. The district court also carefully noted that, to overcome the PTO's earlier rejection of the '581 patent application as not patentably distinct from the preceding Calmar '602 patent and to obtain the PTO's

issuance of the '581 patent on July 29, 1997, Calmar filed a terminal disclaimer under *37 C.F.R. § 1.321(b)*. Calmar's disagreement [*1321] with the district court's claim construction is essentially that it was too detailed. ***HN8***[⬆] Our case law does not prohibit detailed claim construction of design patent [**11] drawings. It merely disapproves claim construction that goes beyond the novel, nonfunctional ornamental features visually represented by the claimed drawings, *Elmer, 67 F.3d at 1577*, or that fails to encompass the claimed ornamental features of the design as a whole. *Amini Innovation Corp. v. Anthony California, Inc., 439 F.3d 1365, 1371 (Fed. Cir. 2006)*. The district court's meticulous and accurate description of Figures 1 through 5 of each of Calmar's patents-in-suit did not constitute error. The district court's claim analysis demonstrated the proper consideration of the claimed designs as a whole.

B. The District Court's Identification of the Ordinary Observer

HN9[⬆] A question that is central to this case, and every design patent case, is the identity of the "ordinary observer" of the design at issue, which in this case is the design of trigger sprayer shrouds. This test requires an objective evaluation of the question of whether a hypothetical person called the "ordinary observer" would find substantial similarities between the patented design and the accused design, so as to be deceived into purchasing the accused design believing it is the patented design. *Gorham, 81 U.S. at 528*.

Calmar [**12] argues that the appropriate "ordinary observer" in this case is the retail consumer who purchases the retail product that incorporates the sprayer shroud, such as the retail purchaser of a bottle of liquid window cleaner with a trigger sprayer device attached to the bottle's cap and a tube extending into the liquid to extract the liquid from the bottle as a spray during retail use. If the ordinary observer is found to be the retail consumer that purchases the shroud of the trigger sprayer device as it is incorporated into a retail product, then it is much more likely that the ordinary observer would find substantial similarities between the patented and accused designs sufficient to be deceived into thinking that Arminak's AA Trigger shroud is one of the patented designs.

The district court disagreed with Calmar and found that the "ordinary observer" of trigger sprayer shrouds is not the retail consumer, but the purchaser of trigger sprayer mechanisms for assembly and incorporation into the product that is sold to retail consumers. The record clearly shows that Calmar never sold any of its patented shrouds directly to retail consumers. *Arminak, 424 F. Supp. 2d at 1198*. If the ordinary [**13] observer is the contract buyer or industrial purchaser of trigger sprayers, then the undisputed material facts in the record establish that such a purchaser would not find substantial similarity between the patented and accused shrouds, and therefore would not be deceived into thinking that [***1263] Arminak's AA Trigger shroud is one of the patented designs. *Id. at 1201-02*.

The Supreme Court's *Gorham* opinion, which dealt with an accused design's infringement of a design patent on silverware handle designs, expressly excluded experts from the category of persons who are ordinary observers. Under the facts of *Gorham*, it was "the observation of a person versed in designs in the particular trade in question--of a person engaged in the manufacturer or sale of articles containing such designs--of a person accustomed to compare such designs one with another, who sees and examines the articles containing them side by side," *id. at 527*, that was explicitly rejected by the Supreme Court.

The Supreme Court in *Gorham* contrasted this group of expert examiners, whose observations it rejected, with ***HN10***[⬆] "ordinary observers," who it described as people [*1322] possessing "ordinary acuteness,

bringing to the examination [**14] of the article upon which the design has been placed that degree of observation which men of ordinary intelligence give." *Id. at 528*. The Court emphasized that "[i]t is persons of this latter class who are the principle purchasers of the articles to which designs have given novel appearances, and if they are misled, and induced to purchase what is not the article they supposed it to be . . . the patentees are injured, and that advantage of a market which the patent was granted to secure is destroyed." *Id.* To be effective, design patent protection must focus upon observations "by ordinary observers, by those who buy and use" the article bearing the design in question. *Id.*

The unanswered question remaining after *Gorham* is whether these "ordinary observers" of which the Supreme Court spoke can be commercial or industrial buyers of designed items that are used as component parts assembled into a retail product. Although we have not squarely addressed that question until now, in the *Goodyear* case (which dealt with patented tire tread designs commercially embodied on Goodyear's truck tires) we stated that ***HN11***[↑] the focus of the ordinary observer test is "on the actual product that is presented [**15] for purchase, and the ordinary purchaser of *that* product." *162 F.3d at 1117* (emphasis added). There we found that the ordinary observer of the patented tread designs was a truck driver and a truck fleet operator because the products containing the patented and accused designs were tires used on trucks, even though the design patent at issue was not limited to truck tires.

In *Keystone*, we found that the ordinary observers of patented wall blocks were "visitors to trade shows." *997 F.2d at 1451*. We made that finding even though the accused wall blocks, when stacked to form a wall, were substantially similar to a wall of patented wall blocks. We held that the visual observation of the ordinary observer should focus only on the unassembled "patented design" of the individual block, not the blocks that were stacked together as "an assembled wall." *Id. at 1451*. Accordingly, we concluded in *Keystone* that "the 'ordinary purchaser' for the purpose of the block design patent is a purchaser of the patented block," not a purchaser of an assembled wall. *Id.*

In 1933, when the regional United States Courts of Appeals still had jurisdiction over patent law issues, the Sixth Circuit noted the substantial [**16] number of prior art design patents in the field of automobile electric cigar lighters and ashtrays. Adhering to the precedent of *Gorham v. White*, the court held:

> The ordinary observer is not any observer, but one who, with less than the trained facilities of the expert, is "a purchaser of things of similar design," or "one interested in the subject" . . . one who, though not an expert, has reasonable familiarity with such objects [as an automobile ash tray and cigar lighter], and is capable of forming a reasonable judgment when confronted with a design therefor as to whether it presents to his eye distinctiveness from or similarity with those which have preceded it.

Applied Arts Corp. v. Grand Rapids Metalcraft Corp., 67 F.2d 428, 430 (6th Cir. 1933).

More recently, two district court opinions found that institutional purchasers, not end-user consumers, were the appropriate persons to be considered ordinary observers when the design-patented item is a component of the product that is sold. *E.g.* *Spotless Enters., Inc. v. A & E Prods. Group, L.P., 294 F. Supp. 2d 322, 347 (E.D.N.Y. 2003)* (design patent for lingerie hangers; "ordinary observer" was not the general public, but the commercial [**17] buyer [*1323] for garment manufacturers, who then resold garments on the hangers to retail stores); *Puritan-Bennett Corp. v. Penox Techs., Inc., No. IP02-0762-C-M/S, 2004 U.S. Dist. LEXIS 6896, 2004 W.L. 866618, at *26 (S.D. Ind. Mar. 2, 2004)* (design patent for portable liquid oxygen tanks; "ordinary observer" "must include medical equipment distributors, at the least, and possibly, hospitals [***1264] and physicians" who provide the tanks by prescription to patients), *aff'd 121 F. App'x 397 (Fed. Cir. 2005)*.

Calmar cites to our *Contessa* opinion in support of its contention that in this case the ordinary observer must be the retail consumer. In *Contessa*, we stated:

> for purposes of design patent infringement, the "ordinary observer" analysis is not limited to *those features* visible during only one phase or portion of the normal use lifetime of an accused product. Instead, the comparison must extend to *all ornamental features* visible during normal use of the product, *i.e.*, "beginning after completion of manufacture or assembly and ending with the ultimate destruction, loss, or disappearance of the article."

282 F.3d at 1380 (citations omitted) (emphases added). We disagree with Calmar that the quoted language from *Contessa* supports [**18] Calmar's contention that the retail consumer must be the ordinary observer of trigger sprayer shrouds. This quoted language does not describe who the ordinary observer is. Rather, it explains what "features" of the patented design must be included as "observed" in the ordinary observer test--or in other words, what features of the patented design the ordinary observer is to examine in determining if there is substantial similarity with an accused design.

Calmar also argues that the purchasers of the shrouds themselves (who Calmar repeatedly refers to as "the sophisticated purchaser who is well-versed in the trade") do not "use" the shrouds and therefore cannot be the ordinary observer. Appellant's Br. at 30-31. Again, we disagree with Calmar. The industrial purchaser of the trigger sprayer shrouds for manufacturing assembly does indeed "use" the shrouds--to cover trigger sprayer mechanisms that are assembled with the bottle, the bottle's cap, the liquid contained in the bottle, and the label on the bottle, all of which assembled together create the retail product. Consequently, the purchaser of the patented and accused designs in this case is the purchaser of one of a retail product's [**19] component parts that is thereafter assembled with other parts to make the retail product. To hold that such a purchaser is the appropriate hypothetical ordinary observer fits squarely with our precedent that the ordinary observer is a person who is either a purchaser of, or sufficiently interested in, the item that displays the patented designs and who has the capability of making a reasonably discerning decision when observing the accused item's design whether the accused item is substantially the same as the item claimed in the design patent.

We agree, therefore, with the district court that the ordinary observer of the sprayer shroud designs at issue in this case is the industrial purchaser or contract buyer of sprayer shrouds for businesses that assemble the retail product from the component parts of the retail product bottle, the cap, the sprayer tube, the liquid, the label, and the trigger sprayer device atop the cap, so as to create a single product sold to the retail consumer. Here, the patented design is only the shroud of the sprayer device. The three physical exhibits submitted for examination on appeal are trigger sprayer devices attached to bottle caps with plastic tubes [**20] for insertion into contained liquid, not the bottles, not the liquid into which the sprayer tube is inserted during normal use, and not the label of the retail product. Accordingly, [*1324] we hold that the ordinary observer of the trigger sprayer shrouds in this case is, as the district court found, the contract or industrial buyer for companies that purchase the stand-alone trigger sprayer devices, not the retail purchasers of the finished product.

C. The District Court's Application of the Ordinary Observer Test

HN12[↑] In applying the ordinary observer test, a court is to compare the construed claims to the accused design to determine whether "the designs have the same general visual appearance, such that it is likely

that the purchaser [(or the ordinary observer)] would be deceived into confusing the design of the accused article with the patented design." *Goodyear, 162 F.3d at 1118*. Specifically, the question to be addressed in applying the ordinary observer test is whether the ordinary observer would be deceived by the accused design because it is substantially similar to the patented design. *Gorham, 81 U.S. at 528*. Under our case law, the ordinary observer test requires, as the district court [**21] recognized, the comparing of the accused and patented designs from all views included in the design patent, not simply those views a retail customer seeking to buy would likely see when viewing the product at the point of sale. *Contessa, 282 F.3d at 1379*.

The record establishes that the ordinary observer would not be deceived by the similarities between Arminak's AA Trigger shroud and Calmar's patented sprayer shroud designs. [***1265] Indeed, Calmar's own expert conceded that "[i]t would be a significant exception for a corporate buyer purchasing the Arminak trigger sprayer to confuse the Calmar ERGO Shroud and the Arminak AA shroud" and that "[t]here is essentially no question that a corporate buyer purchasing these trigger sprayers with these specific shrouds would be able to tell the difference easily." *Arminak, 424 F. Supp. 2d at 1201-02*. A former Calmar customer service manager also testified that most of Calmar's customers "wouldn't be fooled for a second." *Id. at 1201*. We agree with the district court that the undisputed material facts establish that the ordinary observer would not be deceived by the similarities between Arminak's AA Trigger shroud and Calmar's patented sprayer shroud [**22] designs.

D. The District Court's Application of the Point of Novelty Test

HN13[↑] The point of novelty test is the second test that must be satisfied for an accused design to infringe a design patent. In applying the point of novelty test, a court compares the construed claims to the accused design to determine whether the accused design has "appropriated" the points of novelty from the patented design. *See Litton, 728 F.2d at 1444*. Where the art in the field of a particular design is crowded, we must construe the range of equivalents narrowly. *Id.*

The record in this case includes a number of prior art examples of trigger sprayer shrouds' patented designs.

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Calmar presented two points of novelty to the district court that Calmar asserted distinguished its patented designs from the prior art. The district court "concur[ed] with Calmar's characterization of the [two] points of novelty in the '581 and '602 Patents":

> 1. There is a prominent horizontal line extending along each side [of the shroud], parallel to the top surface of the shroud, all the way to the sloped rear surface; and
>
> 2. The sides of the shroud first go straight downwardly, and then, as viewed from the rear, [**23] at the horizontal lines on each side, bulge outwardly in a bulbous fashion, to the bottom rear of the shroud.

Arminak, 424 F. Supp. 2d at 1204. We examine each in turn.

1. "A Prominent Horizontal Line"

With respect to Calmar's assertion as to the first point of novelty, "a prominent horizontal line" extending along the shroud's sides appears in both patented designs.

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[***1266] GET DRAWING SHEET 1 OF 1

The district court found that the prominent horizontal line of Calmar's patented designs was not appropriated by Arminak's AA Trigger shroud because "the [horizontal] line on the AA Trigger is intersected by a slanted line defining a raised surface," *id. at 1204-05*, beneath the horizontal line and above the trigger mechanism.

[*1326] [SEE DIAGRAM IN ORIGINAL]

We agree with the district court. Although the top edge of Arminak's AA Trigger shroud's raised surface is beneath a horizontal line that extends along the shroud's side to the back of the shroud, the rear edge of the raised surface is defined by a downwardly slanted line that intersects Arminak's AA Trigger shroud's horizontal line near the middle of the shroud's side. The raised surface and intersecting slanted line below Arminak's AA Trigger shroud's [**24] horizontal line results in a different overall design appearance than Calmar's asserted first point of novelty of its patented designs.

2. "Bulge Outwardly in a Bulbous Fashion"

With respect to Calmar's asserted second point of novelty, the sides of the shroud that "bulge outwardly in a bulbous fashion, to the rear of the shroud," the district court found that Arminak's AA Trigger shroud did not appropriate this point of novelty because, similar to several prior art patents, Arminak's AA Trigger shroud's sides "instead flare out in straight lines before converging slightly inward toward the bottom of the shroud." *Id. at 1204*. The district court cited to the '222 patent's drawings in support of its finding

> that the AA Trigger does not contain the "bulbous sides" point of novelty Calmar claims. The AA Trigger's flared appearance, when viewed from the back, is similar to the back view disclosed in the '222 Patent. . . . Indeed, any similarity that might appear between the back portion of the AA Trigger and the back drawings of the patented designs is no greater than the similarity between the back views claimed in the patented designs and the back view shown in the '222 Patent.

Id. at 1204 n.14.

The [**25] similarities and differences between the back of the patented designs, the prior art, and Arminak's AA Trigger shroud are illustrated below:

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Arguably, the "bulbous" "bulge" of the sides of the patented designs are "novel" when compared to the prior art. We agree with the district court that based on [*1327] the "bulbous" sides as depicted in the back views of Calmar's patents' drawings, no reasonable jury could find that the back of Arminak's AA Trigger shroud, which is almost identical to the '198 and '222 prior art patents, appropriates Calmar's second point of novelty.

Our conclusion is that Arminak's AA Trigger shroud does not appropriate the two points [***1267] of novelty from the prior art as Calmar contends. We agree with the district court that no reasonable jury could find that Calmar's points of novelty exist in Arminak's AA Trigger shroud.

Calmar contends that the district court in its analysis improperly merged the point of novelty test with the ordinary observer test, which we have held is "legal error." *Contessa, 282 F.3d at 1377*. We disagree with Calmar's contention. The district court's opinion is clear that its point of novelty analysis was confined to determining [**26] Calmar's points of novelty and whether Arminak's AA Trigger shroud appropriated Calmar's points of novelty. Calmar implies that the district court should have limited its discussion of the points of novelty comparison to only the exact words Calmar used to describe its two points of novelty and that the district court should not have looked at Calmar's patents' Figures. ***HN14***[↑] The relevant inquiry is not to analyze the words used by the patent owner to describe a particular design feature after the issuance of the patent, but whether the design feature, as it appears in the Figures of the patent as issued, is found in the accused design.

Calmar also implies that it was improper for the district court to do a detailed side-by-side comparison between the patented design and the accused design. Calmar cites no authority for this contention because there is none. ***HN15***[↑] To establish infringement in a design patent case, the district court is required to compare the patented design with the accused design. *See Elmer, 67 F.3d at 1577*. Without comparing the patented design with the accused design, there was no way for the district court to determine whether an ordinary observer would find the accused design [**27] deceptively similar and whether the accused design appropriated points of novelty. Therefore, based on our de novo review, we find that the district court applied both judicially articulated design patent infringement tests in the proper manner. Neither test is satisfied in this case.

VI. *Conclusion*

For the foregoing reasons, the district court's judgment is affirmed.

AFFIRMED.

No costs.

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Bradley v. Val-Mejias

United States District Court for the District of Kansas

October 9, 2001, Decided ; October 9, 2001, Filed; October 10, 2001, Entered on Docket

CIVIL ACTION No: 00-2395-GTV

Reporter
2001 U.S. Dist. LEXIS 25278 *; 2001 WL 1249339

RICK L. BRADLEY, Plaintiff, v. J. E. VAL-MEJIAS, M.D., et al., Defendants.

Subsequent History: Dismissed by, in part, Sanctions disallowed by, Motion denied by, Summary judgment granted, in part, summary judgment denied, in part by *Bradley v. Val-Mejias, 238 F. Supp. 2d 1242, 2002 U.S. Dist. LEXIS 21952 (D. Kan., 2002)*

Prior History: *Bradley v. Val-Mejias, 2001 U.S. Dist. LEXIS 16209 (D. Kan., Apr. 18, 2001)*

Disposition: Motions ruled upon.

Core Terms

interrogatory, filing date, deposition, disability, discovery, waive, take place, reply, business record, medical record, physician-patient, burdensome, patient, unduly, no privilege, disclosure, lawsuit, pertain, reasonable expenses, request information, overly broad, subpoena, motion to compel discovery, attorney's fees, principal fact

Case Summary

Procedural Posture
Defendants, doctor and medical group, filed a motion to compel discovery, a motion for protective order, and a motion to quash the deposition of the doctor pursuant to claims by plaintiff patient alleging medical malpractice and fraudulent concealment.

Overview

The district count found that the fact that the patient might later supplement his interrogatory response with an expert report did not permit him to initially refuse to respond with whatever discoverable information he held at the time. The district court also overruled the patient's objection that an interrogatory which asked him to identify those facts upon which he might rely to prove his case, noting that the interrogatory did not ask for what facts the patient intended to rely upon at trial, but merely sought the patient's explanation of how the occurrence complained of in the complaint took place, to identify his damages, and to state the prognosis for his medical condition. In addition the district court determined that information concerning all convictions in the patient's criminal record was discoverable so that the medical group and the doctor could decide for themselves whether the crime involves dishonesty or false statement, under *Fed. R. Evid. 609(a)*. Finally, the district court awarded the medical group and the doctor a portion of the costs and expenses that they had incurred with respect to their motion to compel.

Outcome
The patient's objection to producing any of the patient's statements was sustained, however, the doctor and medical group's motion to compel was granted as to all other requests for production and their motion for a protective order and to quash the deposition of the doctor was granted.

Counsel: **[*1]** For Rick L Bradley, Plaintiff: James E Puga, Leventhal & Brown, P.C., Denver, CO, LEAD ATTORNEY. Jeffrey D. Zimmerman, Shawnee, KS, LEAD ATTORNEY. Jim Leventhal, Leventhal & Brown, P.C., Denver, CO, LEAD ATTORNEY. Natalie Brown, Leventhal & Brown, P.C., Denver, CO, LEAD ATTORNEY.

For JE Val-Mejias, Galichia Medical Group, P.A., The, Defendants: Amy S. Lemley, Foulston Siefkin LLP, Wichita, KS, LEAD ATTORNEY. Jack Focht, Foulston Siefkin LLP, Wichita, KS, LEAD ATTORNEY. Jay F. Fowler, Foulston Siefkin LLP, Wichita, KS, LEAD ATTORNEY. Shannon D. Wead, Foulston Siefkin LLP, Wichita, KS, LEAD ATTORNEY.

For Demosthenis Klonis, Defendant: Timothy M. Aylward, Horn, Aylward & Bandy LLC, Kansas City, MO, LEAD ATTORNEY.

Judges: David J. Waxse, United States Magistrate Judge.

Opinion by: David J. Waxse

Opinion

MEMORANDUM AND ORDER

This matter is before the Court on the following motions: (1) Motion to Compel Discovery, filed by Defendants J.E. Val-Majias, M.D., and The Galichia Medical Group, P.A. (doc. 60); (2) Motion for Protective Order and Motion to Quash the Deposition of J.E. Val-Mejias, M.D., filed by J.E. Val-Mejias, M.D. (doc. 58); and (3) request to strike Plaintiff's Reply to **[*2]** Defendants' Response to Plaintiff's Motion for Extension of Time to Designate Expert Witnesses and to Strike Plaintiff's Certificate of Compelling Circumstances for Fax Filing, filed by Defendants J.E. Val-Mejias, M.D., and The Galichia Medical Group, P.A. (doc. 94)

I. Factual Background

This is a medical malpractice action in which Plaintiff asserts that Defendants J.E. Val-Mejias, M.D., and The Galichia Medical Group, P.A., were negligent with regard to the care and treatment they provided him during the time period March 5, 1997 to June 16, 1997. Plaintiff also asserts a claim for fraudulent concealment against Dr. Val-Mejias for concealing from Plaintiff that his pacemaker was allegedly negligently inserted in 1993. Plaintiff claims that he has suffered disabling, permanent injuries, emotional distress, and pain and suffering. He also claims that he has suffered a loss of earnings and future earning capacity.

II. Defendants' Motion to Compel Discovery (doc. 60)

Defendants move to compel Plaintiff to respond to various interrogatories and requests for production propounded by Dr. J.E. Val-Mejias and The Galichia Medical Group, P.A. They also move to compel **[*3]** Plaintiff to sign releases for his Social Security, medical, employment, insurance, and workers' compensation records. In addition, Defendants request that Plaintiff be required to respond to Defendants' written discovery before any party's deposition may be taken. They also request monthly case management conferences. Finally, they seek to recover the attorney fees and expenses they have incurred in connection with the filing of their Motion to Compel.

A. Defendants' First Set of Interrogatories

1. Interrogatory No. 4

This interrogatory asks Plaintiff to provide the following information:

> Please state in detail your factual version of how the occurrence complained of in your Complaint took place, and identify the precise nature and extend [sic] of your alleged injuries and damages, and your prognosis regarding same.

Plaintiff objects to this interrogatory on the basis that it seeks to discover his counsel's mental impressions, opinions, and "outline and analysis" of the case. Plaintiff also objects to this interrogatory on the basis that its requests medical expert opinion, and states that such information will be provided to Defendants "in accordance with **[*4]** the Federal Rules of Civil Procedure." Finally, Plaintiff objects on the basis that the interrogatory seeks to discover facts upon which Plaintiff and Plaintiff's counsel will rely in prosecuting the case.

The Court will overrule these objections. A defendant is entitled to know the factual basis of a plaintiff's allegations. *Towner v. Med James, Inc., 1995 U.S. Dist. LEXIS 11669, 1995 WL 477700, *3 (Aug. 9, 1995)*; *Continental Ill. Nat'l Bank & Trust Co. v. Caton, 136 F.R.D. 682, 684 (D. Kan. 1991)*. Furthermore, requests for opinions or contentions that call for the application of law to fact are proper, *Towner, 1995 U.S. Dist. LEXIS 11669, 1995 WL 477700 at *3-4* (citing *Fed. R. Civ. P. 33(c)*), and an interrogatory may properly inquire into a party's contentions in the case, *Bohannon v. Honda Motor Co., 127 F.R.D. 536, 538 (D. Kan. 1989)*. These types of interrogatories, known as "contention interrogatories" may be used to narrow and define the issues for trial, and they enable the propounding party to determine the proof required to rebut the responding party's position. *Steil v. Humana Kansas City, Inc., 197 F.R.D. 445, 446 (D. Kan. 2000).* **[*5]**

Moreover, Defendants are entitled to "a specific and substantive answer [as to] the dollar amount of plaintiff's claimed damages and a definitive description of other non-pecuniary relief, if any, plaintiff seeks." *Caton, 136 F.R.D. at 687*. It is not sufficient for Plaintiff to respond by stating that his expert will provide the requested damages information in accordance with the expert disclosure deadlines. *See id.* (overruling objection to interrogatory asking plaintiff to state the precise amount of damages he sustained as a result of the acts alleged in the complaint). The fact that a plaintiff may later supplement his interrogatory response with an expert report does not permit him to initially refuse to respond with whatever discoverable information he presently holds. *Bohannon, 127 F.R.D. at 538*. The Court therefore overrules Plaintiff's objections that the interrogatory seeks his counsel's mental impressions, opinions, and outline and analysis of the case.

The Court will also overrule Plaintiff's objection that the interrogatory asks Plaintiff to identify those facts upon which he may rely to prove his case. Plaintiff has mischaracterized **[*6]** the interrogatory. Rather than asking what facts Plaintiff intends to rely upon at trial, it merely asks him to explain "how the occurrence complained of in [the] Complaint took place," to identify his damages, and to state the prognosis for his medical condition. Such a request is proper.

Accordingly, the Court will grant Defendants' Motion to Compel as to Interrogatory No. 4.

2. Interrogatory No. 7

This interrogatory seeks information about Plaintiff's previous hospitalizations. Plaintiff does not object to this interrogatory but states that the requested information "can be derived from the medical records of the Plaintiff that have been or are being obtained by the Defendants pursuant to deposition subpoenas."

The Court agrees with Defendants that this is an insufficient response. While *Fed. R. Civ. P. 33(d)* allows a party to answer an interrogatory by producing business records in certain circumstances, that rule applies only to the business records "of the party upon whom the interrogatory has been served." *Fed. R. Civ. P. 33(d)*. The business records option does not apply here, because the medical records are the business records of various non-party hospitals and not **[*7]** those of Plaintiff. Furthermore, Defendants should not be required to subpoena this information from third parties. Plaintiff, as the responding party, cannot shift the expense and burden to Defendants to obtain this information from Plaintiff's medical providers. The Motion to Compel will therefore be granted as to this interrogatory.

3. Interrogatory No. 8

This interrogatory asks Plaintiff to provide the total dollar amounts of any claims he is making for lost earnings or for the impairment of future earning capacity. It also asks Plaintiff to identify any accountant or other person with whom he has consulted or upon whom he has relied in calculating the amount of claimed earnings losses and to provide "the financial assumptions" that he or his representatives have made in performing the calculations.

Plaintiff states in his response that the amount of his economic damages is being computed by an economist expert and that the requested information will be provided when his expert's report is due. He also sates that under *Rule 33(d)*, "the past medical expenses can be derived from medicals [sic] obtained by Defendants pursuant to deposition subpoenas."

The Court finds this **[*8]** response to be insufficient in several respects. First, directing Defendants to Plaintiff's medical records and/or providing information about Plaintiff's medical expenses is non-responsive to this request for lost earnings information. Second, even if the medical records were responsive, they are not business records of Plaintiff and the *Rule 33(d)* option to produce business records is inapplicable. Finally, as stated in the discussion of Interrogatory No. 4, Plaintiff is required to provide Defendants with what damages information he presently possesses. The fact that Plaintiff may later supplement his interrogatory response with an expert report does not permit him to refuse to respond at the present time with whatever discoverable information he presently holds. *See Bohannon, 127 F.R.D. at 538* (party has duty to answer interrogatory with whatever information he has; *Fed. R. Civ. P. 26(e)* provides procedure for supplementing response).

The Motion to Compel will therefore be granted as to this interrogatory. [1]

[*9] *4. Interrogatory No. 9*

This interrogatory asks Plaintiff to provide various information about all claims or suits for injury or disability, "except for the present lawsuit." Plaintiff responded by stating: "I have never filed any previous lawsuits or any other type of claim *other than my claim for disability related to the matters at issue in this action*." (Emphasis added.) Plaintiff did not provide any of the requested information as to that claim for disability. Plaintiff states in his opposition to the Motion to Compel that his response fully answers the interrogatory.

The Court reads Plaintiff's response to mean that he has filed a claim for disability and that the claim is related to the matters raised in this lawsuit. Plaintiff apparently believes that because his disability claim relates to the instant lawsuit, it falls within the interrogatory's "present lawsuit" exception and he is not required to provide the requested information as to the claim. The Court disagrees, and finds that any disability claim which Plaintiff has filed does not fall within the exception. Plaintiff is therefore required to provide the requested information.

Defendants state in their reply **[*10]** brief that they have reason to believe that more than one disability claim has been filed by Plaintiff, but they do not explain the basis for that belief. At most, the Court can instruct plaintiff to fully answer this interrogatory as to *all claims* for disability. The Motion to Compel will be granted as to this interrogatory.

5. Interrogatory No. 13

This interrogatory states:

> Please state with specificity each and every alleged departure from standard, approved medical practice you or your representative are alleging against J.E. Val-Mejias, M.D. in this case.

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[1] The Court notes that a party is not required to identify a non-testifying, consulting expert and that discovery is generally not allowed regarding the facts known or opinions held by such an expert. *See* ***Fed. R. Civ. P. 26(b)(4)(B)***. Plaintiff, however, did not object to this interrogatory on that basis, and, thus, the Court makes no ruling as to whether the interrogatory is objectionable as requesting discovery regarding a non-testifying, consulting expert.

Plaintiff objects to this interrogatory on the basis that it seeks to discover his counsel's mental impressions and opinions and counsel's "outline and analysis" of the case. Plaintiff also objects to this interrogatory on the grounds that it requests medical expert opinion, and he states that such information will be provided to Defendants "in accordance with the Federal Rules of Civil Procedure." The Court will overrule these objections for the same reasons discussed above in connection with Interrogatory No. 4.

The Court notes that Plaintiff has asserted an additional objection to this interrogatory **[*11]** in his opposition to the Motion to Compel, which was not asserted in his initial response to the interrogatory. In his opposition brief, Plaintiff asserts that the interrogatory is objectionable on the basis that it asks Plaintiff to provide *each and every* fact in support of his allegation that Dr. Val-Mejias departed from the standard of care.

The Court would have been inclined to overrule this objection, finding that Plaintiff waived it by failing to assert it in his initial objections. *See* *Starlight Int'l, Inc. v. Herlihy, 181 F.R.D. 494, 496 (D. Kan. 1998)* (quoting *Fed. R. Civ. P. 33(b)(4)* ("untimely objections are 'waived unless the party's failure to object is excused by the court for good cause shown.'"). Defendants, however, have not argued waiver. Instead, Defendants concede in their reply brief that contention interrogatories are improper if they ask the responding party to provide *each and every fact* supporting the identified allegations. Defendants properly recognize that contention interrogatories should instead ask only for the *material or principal* facts supporting Plaintiff's contentions. *See* *IBP, Inc., v. Mercantile Bank of Topeka, 179 F.R.D. 316, 321 (D. Kan. 1998).* **[*12]** In their reply brief, Defendants thus urge the Court to compel Plaintiff to respond to this interrogatory by providing the "material or principal facts" requested.

The Court will decline to heed Defendants' request, inasmuch as this particular interrogatory does not ask Plaintiff to provide "each and every fact" in support of certain allegations. Rather, it merely asks Plaintiff to identify each alleged departure from standard, approved medical practice made by Dr. J.E. Val-Mejias. To compel Plaintiff to provide the principal or material facts supporting his allegation that Dr. Val-Mejias departed from the standard of care, as Defendants request, would have the effect of rewriting this interrogatory. The Court does not find the interrogatory to be objectionable as written. The Court will therefore compel Plaintiff to answer Interrogatory No. 13 as written.

6. Interrogatory No. 14

This interrogatory asks Plaintiff to state whether he has been convicted of any felony or misdemeanor, and, if so, to state the nature, date, and place of the conviction. Plaintiff objects on the basis that the interrogatory seeks information that is neither relevant nor calculated to lead to the discovery **[*13]** of relevant evidence. He also objects on grounds that "it is annoying, harassing, and unduly burdensome." Plaintiff then states that, subject to and without waiving those objections, he has not been convicted of a felony. In his opposition to the Motion to Compel, Plaintiff adds that "upon information and belief," he has never been convicted of any crime involving dishonesty or false statement.

Defendants contend that Plaintiff should be required to provide information about *all* convictions so that Defendants can decide for themselves whether the crime involves dishonesty or false statement, the terminology used in *Fed. R. Evid. 609(a)*. [2] The Court agrees that the information is discoverable. Defendants should be provided with the requested information so that they may make their own determination as to whether the conviction falls within *Fed. R. Evid. 609(a)(2)* and so that they may raise whatever arguments they deem necessary at trial regarding the conviction's admissibility. The Court will grant the Motion to Compel as to this interrogatory.

[*14] *7. Interrogatory Nos. 15-17*

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[2] *Fed. R. Evid. 609(a)(2)* provides that evidence that a witness committed a crime is admissible if it involved dishonesty or false statement. Otherwise, it is admissible only if the crime was punishable by death or imprisonment in excess of one year. *Fed. R. Evid. 609(a)(2)*.

Each of these three interrogatories asks Plaintiff to "state each and every basis for your allegation, including each and every fact supporting your allegation" contained in various paragraphs of the Complaint. Plaintiff asserts the same objections that he asserted in response to Interrogatory No.4. The Court will overrule the objections for the same reasons discussed above in connection with Interrogatory No. 4.

In his opposition to the Motion to Compel, Plaintiff also objects, for the very first time, that these interrogatories ask for "each and every fact" supporting the identified allegations. In their reply brief, Defendants fail to argue waiver and once again state that Plaintiff need not provide "each and every fact" but only "the material or principal facts" supporting the identified allegations.

Because these interrogatories do ask for "each and every fact" and because Defendants have conceded that Plaintiff need only provide the material or principal facts supporting the specified allegations, the Court will order Plaintiff to respond by providing only the material or principal facts that he contends support the specified allegations.

[*15] *8. Interrogatory Nos. 18-20*

These interrogatories ask Plaintiff to provide various information about a number of Plaintiff's claims and allegations. Plaintiff asserts the same objections that he made in response to Interrogatory No. 4. The Court will overrule those objections for the same reasons set forth above in connection with Interrogatory No. 4.

As in the case of Interrogatory Nos. 13 and 15-17, Plaintiff also objects for the very first time in his opposition to the Motion to Compel that these interrogatories ask him to provide "each and every fact" supporting these allegations. Defendants once again fail to argue waiver and state hat Plaintiff need only provide the principal or material facts. As with Interrogatory Nos. 13 and 15-17, Defendants ask the Court to compel Plaintiff to answer these interrogatories with the material or principal facts supporting Plaintiff's allegations.

The Court will, once again, decline to heed Defendants' request. These particular interrogatories do not ask Plaintiff to provide "each and every fact" in support of his various allegations. [3] Rather, they merely ask Plaintiff to provide certain, specified information about his allegations. **[*16]** Interrogatory No. 18 asks Plaintiff to identify each statement or act by Dr. Val-Mejias that allegedly fraudulently concealed, or attempted to fraudulently conceal, the claimed negligent insertion of Plaintiff's pacemaker. Interrogatory No. 19 asks Plaintiff to state "how your pacemaker was negligently installed" as pled in paragraphs 23 and 24 of the Complaint. Interrogatory No. 20 asks Plaintiff to identify all information that Dr. Val-Mejias allegedly failed to provide Plaintiff and to explain how Plaintiff's decisions regarding his medical care would have differed had he received the information allegedly not provided.

To compel Plaintiff to provide the principal or material facts supporting these claims and allegations, as Defendants now request, would have the effect of completely rewriting these interrogatories. The Court does not find the interrogatories to be objectionable **[*17]** as written. They are only asking Plaintiff to provide certain, specific information about his claims and allegations, information that Defendants are entitled to receive. The Court will therefore compel Plaintiff to answer Interrogatory Nos. 18-20 as written.

B. Defendants' First Request for Production of Documents

1. Request No. 1

This request is as follows:

> All documents either in the possession or subject to the possession of plaintiff, any insurance company or adjusting company acting in plaintiff's behalf, or in the possession or plaintiff's attorney, pertaining to the claim

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[3] It appears to the Court that Defendants' reply brief mistakenly lumped these interrogatories together with Interrogatory Nos. 15-17.

> herein. Documents which are claimed to be privileged as a result of attorney/client privilege or attorney work product may be excluded, but it is requested that they be identified, together with this specific privilege claimed[.]

Plaintiff objects on the grounds that the request "is harassing, annoying, unduly burdensome and seeks to impose an obligation on Plaintiff not imposed by the Rules of Civil Procedure." Plaintiff also states in his response to the request that he does not have the burden to obtain records from third parties as requested. He then states that subject to and **[*18]** without waiving the foregoing objections, "all responsive documents are available for inspection."

The Court agrees with Plaintiff that this request is unduly burdensome. The use of the term "pertaining to," often makes a discovery request overly broad and unduly burdensome on its face. *See* Mackey v. IBP, Inc., 167 F.R.D. 186, 197 (D. Kan. 1996). [4] Such a phrase often requires the answering party "to engage in mental gymnastics to determine what information may or may not be remotely responsive." Id. This is the case here, where the request seeks all documents "pertaining to the claim herein" and not to a single or discrete event or fact. The request is so broad and open-ended that Plaintiff could not possibly fully answer without undue burden. See id. (finding interrogatory seeking the identity of all documents "'pertaining to' comparisons or rankings of the plants of [defendant] for 'any reason'" to be so open-ended and overly broad on its face that defendant could not fully answer without undue burden).

[*19] Despite having a valid objection to a request, a party, generally speaking, is still required to answer the request to extent it is not objectionable. Id. at 198 (citing Fed. R. Civ. P. 33(b)(1)). An answer will not be required, however, when the request is overly broad and unduly burdensome on its face unless adequate guidance exists as to what extent the interrogatory is not objectionable. Id. (citing Nelson v. Telecable of Overland Park, 1996 U.S. Dist. LEXIS 2764, 1996 WL 111250, at *2 (D. Kan. Feb. 29, 1996)).

Here, the parties here have provided insufficient guidance for the Court to determine the extent that the request is not objectionable, and, thus, no answer should be required. The Court notes, however, that Plaintiff has stated that, subject to his objections, "all responsive documents are available for inspection." To the extent Plaintiff has not already provided copies of those documents to Defendants, he shall do so. Said documents shall be produced to Defendants within **fourteen (14) days** of the date of filing of this Order.

2. Request No. 2

This request seeks "all statements or records of parties and witnesses taken by anyone **[*20]** before the date of the filing of the lawsuit herein." Plaintiff objects on the grounds that it seeks information protected by the attorney-client privilege and the attorney work product doctrine. He states that his attorney has taken some statements from Plaintiff. He further states that he is unaware of any statements or recordings given by Defendants or any witnesses and that he knows of no documents responsive to this request other than his own statements. Defendants do not discuss Request No. 2 in either their initial or reply brief, other than to state generally that they are seeking to compel answers to all four of their requests for production.

Plaintiff's objection to producing any of Plaintiff's statements will be sustained. Plaintiff has responded that he is unaware of any other documents responsive to this request. The Court cannot compel the production of documents that do not exist. The Motion to Compel will therefore be denied as to this request.

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[4] This Court usually requires a party asserting undue burden to supply some type of evidentiary support for its objection. *See* Kutilek v. Gannon, 132 F.R.D. 296, 300 (D. Kan. 1990) (party objecting to discovery as unduly burdensome "cannot rely on some generalized objections, but must show specifically how each interrogatory or request is burdensome and/or overly broad by submitting affidavits or some detailed explanation as to the nature of the claimed burden."). Such support will not be required here, however, since the request is overbroad and unduly burdensome on its face. *See* Mackey, 167 F.R.D. at 197 ("A party resisting facially overbroad or unduly burdensome discovery need not provide specific, detailed support.").

3. Request No. 3

This requests seeks the following:

> All memoranda, writings, records, tape recordings . . . or documents of any nature concerning any claim for benefits/damages made by or on behalf of the plaintiff[. **[*21]**]

Plaintiff responded as follows:

> Plaintiff objects to Requests for Production No. 3 on the grounds that it is overly broad, annoying, harassing and unduly burdensome. Plaintiff further objects on the grounds that it seeks information protected by the attorney-client privilege and the attorney work product doctrine. Plaintiff has produced all documents in his possession, not otherwise privileged, pursuant to Initial Disclosures. Plaintiff has available family photographs for review at the offices of Plaintiff's counsel. Subject to, and without waiving the foregoing objections, Plaintiff states that all responsive documents have been produced.

In their Motion to Compel, Defendants state that Plaintiff's representation that he has produced all non-privileged documents "pursuant to Initial Disclosures" is false and that no documents whatsoever were produced with Plaintiff's initial disclosures and that no documents have been produced since the initial disclosures.

Rather than responding directly to this rather serious allegation, Plaintiff merely states in his opposition to the Motion to Compel that "Plaintiff stands by this response" and that "all responsive documents **[*22]** have been produced." Doc. 78 at 7. He also states in his opposition that the request "is in violation of *Fed. R. Civ. P. 26(b)(1)*" to the extent it seeks information about unrelated claims. *Id.* The Court interprets this to be a relevance objection.

Defendants counter that because Plaintiff is claiming physical impairment in this case, any past claims of disability are relevant. They argue that this is particulary true with respect to a claim for Social Security benefits that Plaintiff apparently filed in March 1997. [5] The Court agrees that any past disability claims are relevant, and will grant the Motion to Compel as to this request.

4. Request No. 4

This request seeks "all tax returns of plaintiff from 1990 through 2000." Plaintiff stated **[*23]** in his initial response that he would "provide those upon receipt." He also stated that he would sign an appropriate release to the Internal Revenue Service (IRS) if defense counsel would provide one.

As best as the Court can determine, no tax returns have been produced. If the tax returns have been received by Plaintiff or are otherwise in his possession but he has not yet produced them, Plaintiff shall produce them to Defendants within **five (5) days** of the date of filing of this Order. If Plaintiff has not received the returns or they are otherwise not in his possession, he shall sign an appropriate release so that Defendants may obtain the returns. The release shall be signed and returned to Defendants' counsel within **five (5) days** of the date of filing of this Order.

C. Social Security Records Release

Defendants move for an order compelling Plaintiff to sign a release so that Defendants may obtain his Social Security records. As noted above, it appears that Plaintiff may have filed a claim for Social Security disability benefits in March 1997. Defendants served a subpoena on the Social Security Administration (SSA) but were informed that the SSA will **[*24]** not provide the records unless Plaintiff signs a release or Defendants obtain a

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[5] According to Defendants, a medical record they obtained through a subpoena indicates that Plaintiff filed a claim for Social Security disability benefits "around March of 1997." Doc. 61 at 14. Plaintiff does not confirm or deny whether he filed such a claim.

court order. Plaintiff has refused to sign a release. He argues generally that "he cannot be forced to turn over any medical or other records that do not pertain to the injuries being addressed in this case." Doc. 78 at 7.

The Court is not persuaded by Plaintiff's argument. If Plaintiff did indeed file a claim for Social Security disability benefits in March 1997 (which Plaintiff has yet to confirm or deny), that claim would be relevant to his claim in this action that he has suffered permanently disabling injuries as a result of the Defendants' claimed negligence, which purportedly occurred in March through June 1997. Plaintiff has failed to show why this information would not be relevant to this action. The Court will therefore order Plaintiff to sign a release for his Social Security records. *See Rodriguez v. IBP, Inc., 243 F.3d 1221, 1230 (10th Cir. 2001)* (district court has authority to order plaintiff to provide consent for release of Social Security records). Plaintiff shall sign the release and return to Defendants' counsel within **five (5) days** of the date of filing of **[*25]** this Order.

D. Medical Records Releases

Defendants also move for an order compelling Plaintiff to sign a release so that Defendants may obtain his medical records. Defendants state that Plaintiff has refused to sign any medical records releases. The requested release is a general release directed to hospitals, medical institutions, and various health care providers and is not limited to any particular time period, injury, or medical condition. *See* Consent to Release Information, Defendants' Exhibit J to doc. 61. Given Plaintiff's refused to sign any medical records release, Defendants have served subpoenas on Plaintiff's health care providers, but have received very few records in response.

Plaintiff argues that he should not be forced to turn over any medical records "that do not pertain to the injuries being addressed in this case" because he has waived the physician-patient privilege only as to the specific injuries being addressed in this case and not to any other injuries or medical conditions. Doc. 78 at 7. Defendants argue, on the other hand, that Plaintiff completely waived the physician-patient privilege by bringing this lawsuit.

The Court agrees with Defendants. **[*26]** The Kansas statute governing the physician-patient privilege is found at *K.S.A. 60-427. Subsection (d)* sets forth the circumstances under which the privilege is waived. It provides as follows:

> There is no privilege under this section in an action in which the condition of the patient is an element or factor of the claim or defense of the patient or of any party claiming through or under the patient or claiming as a beneficiary of the patient through a contract to which the patient is or was a party.

K.S.A. 60-427(d).

This Court has repeatedly rejected the concept of a limited waiver under *K.S.A. 60-427(d)*. *See, e.g., Lake v. Steeves, 161 F.R.D. 441 (D. Kan. 1994)*; *Evertson v. Dalkon Shield Claimants Trust, 1993 U.S. Dist. LEXIS 9670, 1993 WL 245972 (D. Kan. 1993)*; *Bryant v. Hilst, 136 F.R.D. 487 (D. Kan. 1991)*. The *Bryant* case is most instructive here. In *Bryant*, Judge Saffels affirmed a decision of Magistrate Judge Newman which expressly rejected a plaintiff's argument that the privilege is waived only as to the medical condition at issue. Judge Saffels stated:

> In *State v. Campbell, 210 Kan. 265, 281, 500 P.2d 21 (1972),* **[*27]** the Kansas Supreme Court specifically stated that "there is no privilege under *K.S.A. 1971 Supp. 60-427(d)* (physician-patient privilege) in an action in which the condition of the patient is an element or factor of the claim or defense of the patient." The court in *Campbell* followed the clear language of *K.S.A. 60-427*. There is no privilege in an action in which the condition of the patient is in issue. While a privilege is generally afforded under *K.S.A. 60-427(b)*, it is removed under *K.S.A. 60-427(d)*. It simply does not exist. Since there is no common law physician-patient privilege, there is no privilege available to plaintiff herein. *Plaintiff's argument that there is a privilege as to conditions other than the condition in issue, is without merit*. The statutory language, as well as that of the court, is without qualification. The issue is not waiver or partial waiver, there is simply no privilege available to the plaintiff.

Bryant, 136 F.R.D. at 491 (emphasis added).

In light of the above, the Court finds no merit to Plaintiff's argument that he has not waived the physician-patient privilege as to any conditions other than the specific injuries **[*28]** at issue in this case.

Plaintiff has asserted no other objections to signing the medical release. The Court will therefore order Plaintiff to sign the medical release, which is attached as Exhibit J to Defendants' Memorandum in Support of Defendants' Motion to Compel (doc. 61). Plaintiff shall sign and return the release to Defendants' counsel within **five (5) days** of the date of filing of this Order.

E. Employment, Insurance, and Workers' Compensation Records Releases

Defendants also request that Plaintiff be ordered to sign releases for Plaintiff's employment, insurance, and workers' compensation records. *See* Exhibits J, K, and L, attached to Defendants' Memorandum (doc. 61). Plaintiff does not address these releases in his opposition brief. The Court will therefore grant the Motion to Compel as to these records releases. Within **five (5) days** of the date of filing of this Order, Plaintiff shall sign and return to Defendants' counsel the above-mentioned releases.

F. Request That Plaintiff Be Required to Respond to Defendants' Written Discovery Prior to the Taking of Any Party's Deposition

Defendants argue that they need Plaintiff's responses **[*29]** to their written discovery before they can prepare to take Plaintiff's deposition and before they can prepare to defend Dr. Val-Mejias' deposition. Plaintiff failed to address this issue in his opposition to the Motion to Compel. The Court will grant this request. No deposition of any party shall take place sooner than **eleven (11) days** after Plaintiff has answered Defendants' First Set of Interrogatories and First Requests for Production and produced documents responsive to the First Requests for Production, as provided for herein. [6]

G. Request for Monthly Case Management Conferences

Defendants also ask the Court to schedule monthly case management conferences in this case. The Court finds no pressing need at the present time for regularly scheduled conferences, and, thus, this request will be denied. **[*30]** The Court is, however, available, if discovery issues should arise, and any party may request a telephone conference with the Court.

H. Summary of Ruling on Defendants' Motion to Compel

For the reasons set forth above, the Court will grant in part and deny in part Defendant's Motion to Compel Discovery. Any supplemental written responses to Defendants' written discovery required to be served by this Order shall be served within **fourteen (14) days** of the date of filing of this Order. In addition, all responsive documents ordered to be produced pursuant to this Order shall be produced to Defendants within **fourteen (14) days** of the date of filing of this Order. Said production shall take place at the office of Defendants' counsel or at any other location agreed upon by the parties. In addition, within **five (5) days** of the date of filing of this Order, Plaintiff shall sign the appropriate records releases and return them to Defendants' counsel, as directed herein.

I. Sanctions

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[6] The Court notes that this ruling dovetails with its ruling on Defendant Dr. J.E. Val-Mejias' Motion for Protective Order and to Quash (doc. 58), which is addressed in Part III of this Order.

Defendants request that they be awarded the attorney fees and costs they have incurred in connection with their Motion to Compel. *Federal Rule of Civil Procedure 37(a)(4)(C)* **[*31]** allows a court to impose sanctions where, as here, a motion to compel discovery is granted in part and denied in part. Under that rule, the court may "apportion the reasonable expenses incurred in relation to the motion among the parties and persons in a just manner." *Fed. R. Civ. P. 37(a)(4)(C)*.

The Court deems it appropriate to award Defendant a portion of the costs and expenses that they have incurred with respect to this Motion to Compel. [7] To aid the Court in determining the proper amount of sanctions, Defendants' counsel shall, within **twenty (20) days** of the date of filing of this Order, file an affidavit itemizing the expenses, including attorney fees, that Defendants have incurred in connection with their Motion to Compel. Plaintiff shall have **eleven (11) days** thereafter to file a response to the affidavit, and Defendants shall have **eleven (11) days** thereafter to file a reply brief, if they so choose. After reviewing the briefs, the Court will issue an order specifying the amount and time of payment.

[*32] Having determined that Defendants are entitled to recover a portion of their reasonable expenses and fees, the Court must next determine whether it is Plaintiff's counsel or Plaintiff himself who should pay the sanctions. To the extent possible, sanctions should be imposed only upon the person or entity responsible for the sanctionable conduct. *White v. General Motors Corp. Inc., 908 F.2d 675, 685-86 (10th Cir. 1990)* (imposing *Rule 11* sanctions); *McCoo v. Denny's, Inc., 192 F.R.D. 675, 697 (D. Kan. 2000)* (imposing *Rule 11, 26(g)(3), and 37(a)(4)* sanctions); *Starlight Int'l, Inc. v. Herlihy, 190 F.R.D. 587, 593 (D. Kan. 1999)* (imposing *Rule 26(g)and 37(b)and (d)* sanctions). The sanctioning of a *party*, as opposed to the party's *counsel*, "requires specific findings that the party was aware of the wrongdoing." *McCoo, 192 F.R.D. at 697* (citing *White, 908 F.2d at 685-86*).

In the absence of any evidence that Plaintiff himself was responsible for the objections asserted to Defendants' discovery requests or for the arguments made in response to the Motion to Compel, the Court finds it appropriate **[*33]** to hold the law firms of Plaintiff's counsel [8] solely responsible for paying the monetary sanctions.

III. Defendant's Motion for Protective Order and to Quash the Deposition of J.E. Val-Mejias, M.D. (doc. 58)

A. Merits of the Motion

For good cause shown, the Court will grant Defendant J.E. Val-Mejias, M.D.'s Motion for Protective Order and to Quash. [9] Dr. Val-Mejias shall be deposed at the offices of his attorney in Wichita, Kansas. The deposition shall take place at a date and time that is mutually agreeable to Dr. Mejias and all counsel and shall take place no sooner

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[7] The Court recognizes that before *Rule 37(a)(4)* sanctions may be imposed, it must afford the parties an "opportunity to be heard." *See id.* The Advisory Committee Notes to the 1993 Amendments to *Fed. R. Civ. P. 37(a)(4)* make it clear that a court may consider the issue of sanctions "on written submissions." Here, Defendants specifically requested sanctions in their Memorandum in Support of the Motion to Compel, and Plaintiff had the opportunity to respond to that request. The Court therefore finds that the parties have had sufficient "opportunity to be heard" within the meaning of *Fed. R. Civ. P. 37*.

[8] Pursuant to Kansas Rule of Professional Conduct 5.1 and the comment thereto, the partners or shareholders in a law firm are responsible for making reasonable efforts to assure that all lawyers in the firm conform to the rules of professional conduct. The Court therefore holds that the law firms representing Plaintiff rather than the individual attorneys shall be responsible for payment of the expenses.

[9] The Court notes that no response was filed by Plaintiff to the Motion for Protective Order and to Quash. The Court therefore could have granted the Motion as uncontested. *See* D. Kan. Rule 7.4. Plaintiff did, however, address many of the issues raised in the Motion for Protective Order and to Quash in his brief in support of his Motion for Extension of Time to Designate Expert Witnesses (doc. 73). The Court will therefore decline to treat the Motion for Protective Order and to Quash as uncontested. The Court, however, instructs Plaintiff's counsel to comply with D. Kan. Rule 7.1 when opposing any other motions filed in this case.

than **eleven (11)** **[*34]** **days** after Plaintiff has answered Defendants' First Set of Interrogatories and First Requests for Production and provided the documents responsive to the requests for production and signed and returned the releases, as provided for herein.

B. Sanctions

Although Defendants have not requested sanctions, the Court must nevertheless address the issue. *Rule 26(c)* incorporates **[*35]** the sanctions provisions of *Rule 37(a)(4)*.

Rule 37(a)(4)(A) governs the imposition of sanctions here. It provides as follows:

> If the motion is granted . . ., the court shall, after affording an opportunity to be heard, require the party . . . whose conduct necessitated the motion or the party or attorney advising such conduct or both of them to pay to the moving party the reasonable expenses incurred in making the motion, including attorney's fees, unless the court finds that the motion was filed without the movant's first making a good faith effort to obtain the disclosure or discovery, without court action, or that the opposing party's nondisclosure, response, or objection was substantially justified, or that other circumstances make an award of expenses unjust.

Fed. R. Civ. P.37(a)(4)(A).

Based on the present record, it appears that the imposition of sanctions against Plaintiff's counsel may be appropriate here. *Rule 37(a)(4)(A)*, however, requires the Court to afford the parties the "opportunity to be heard" before imposing sanctions. A hearing is not necessary, and the Court may consider the issue of sanctions "on written submissions." *See* Advisory Committee **[*36]** Notes to the 1993 Amendments to *Rule 37(a)(4)*.

Because Defendants did not request sanctions in their Motion for Protective Order, there has been no briefing on this issue, and, thus, no "opportunity to be heard" as required by the Rule. The Court will therefore order Plaintiff and his counsel, to show cause, in writing, **within twenty (20) days of the filing of this Order,** why the Court should not require the law firms of Plaintiff's counsel to pay the reasonable expenses and fees that Defendants have incurred in making this Motion for Protective Order. Defendants shall have **eleven (11) days** thereafter to file a response thereto, if they so choose. In the event the Court determines that sanctions should be imposed, the Court will issue an order setting forth a schedule for the filing of an affidavit reflecting the amount of fees and expenses that Defendants have incurred, and for the filing of any related briefs.

IV. Defendants' Request to Strike (doc. 94)

Defendants seeks to strike the following pleadings: (1) Plaintiff's Reply to Defendants' Response to Plaintiff's Motion for Extension of Time to Designate Expert Witnesses; and (2) Plaintiff's Certificate **[*37]** of Compelling Circumstances for Fax Filing. The Court will deny the request.

IT IS THEREFORE ORDERED that the Motion to Compel Discovery (doc. 60) filed by Defendants J.E. Val-Mejias, M.D., and The Galichia Medical Group, P.A., is granted in part and denied in part, as set forth herein. Any supplemental written responses to Defendants' written discovery required to be served by this Order shall be served within **fourteen (14) days** of the date of filing of this Order. In addition, all responsive documents ordered to be produced pursuant to this Order shall be produced to Defendants within **fourteen (14) days** of the date of filing of this Order, except for the requested tax returns. Said production shall take place at the office of Defendants' counsel or at any other location agreed upon by the parties. If Plaintiff has received copies of his tax returns or they are otherwise in his possession but he has not yet produced them, Plaintiff shall produce them to Defendants within **five (5) days** of the date of filing of this Order. If Plaintiff has not received the returns or they are otherwise not in his possession, he shall sign an appropriate release so **[*38]** that Defendants may obtain the returns. The release shall be signed and returned to Defendants' counsel within **five (5) days** of the date of filing of this Order. In addition, within **five (5) days** of the date of filing of this Order, Plaintiff shall sign and return to Defendants' counsel

the releases for his Social Security, medical, employment, insurance, and workers' compensation records, which are attached as Exhibits H, J, K and L, to doc. 61.

IT IS FURTHER ORDERED that no deposition of any party shall take place sooner than **eleven (11) days** after Plaintiff has answered Defendants' First Set of Interrogatories and First Requests for Production and produced documents responsive to the First Requests for Production, as provided for herein.

IT IS FURTHER ORDERED that Defendants' request for monthly case management conferences (doc. 60) is denied.

IT IS FURTHER ORDERED that Defendants' request for sanctions relating to Defendants' filing of their Motion to Compel (doc. 60) is granted in part. Within **twenty (20) days** of the date of filing of this Order, Defendants' counsel shall file an affidavit itemizing the expenses, including **[*39]** attorney fees, that Defendants have incurred in connection with their Motion to Compel. Plaintiff shall have **eleven (11) days** thereafter to file a response to the affidavit, and Defendants shall have **eleven (11) days** thereafter to file a reply brief, if they so choose.

IT IS FURTHER ORDERED that the Motion for Protective Order and to Quash the Deposition of J.E. Val-Mejias, M.D., (doc. 58) is granted. Dr. Val-Mejias shall be deposed at the offices of his attorney in Wichita, Kansas. The deposition shall take place at a date and time that is mutually agreeable to Dr. Mejias and all counsel and shall take place no sooner than **eleven (11) days** after Plaintiff has answered Defendants' First Set of Interrogatories and First Request for Production and produced documents responsive to the First Request for Production, as provided for herein.

IT IS FURTHER ORDERED that Plaintiff and his counsel shall, within **twenty (20) days** of the date of filing of this Order, show cause, in writing, why the Court should not require the law firms of Plaintiff's counsel to pay the reasonable expenses and fees incurred by Defendants in making the Motion **[*40]** for Protective Order and to Quash the Deposition of J.E. Val-Mejias, M.D. (doc. 58). Defendants shall have **eleven (11) days** thereafter to file a response thereto, if they so choose.

IT IS FURTHER ORDERED that Defendants' Request to Strike Plaintiff's Reply to Defendants' Response to Plaintiff's Motion for Extension of Time to Designate Expert Witnesses and to Strike Plaintiff's Certificate of Compelling Circumstances for Fax Filing (doc. 94) is denied.

IT IS SO ORDERED.

Dated in Kansas City, Kansas on this 9th day of October 2001.

David J. Waxse

United States Magistrate Judge

End of Document

Contessa Food Prods. v. Lockpur Fish Processing Co.

United States Court of Appeals for the Ninth Circuit

November 1, 2004, Argued and Submitted, Pasadena, California ; January 3, 2005, Filed

No. 03-55415, No. 03-55469, No. 03-55502, No. 03-55581

Reporter
123 Fed. Appx. 747 *; 2005 U.S. App. LEXIS 28 **; Copy. L. Rep. (CCH) P29,014

CONTESSA FOOD PRODUCTS INC., fka ZB Industries Inc., a California Corporation, Plaintiff - Appellant, v. LOCKPUR FISH PROCESSING CO. LTD., Defendant, and, BERDEX SEAFOOD INC.; THE MAZZETTA COMPANY, an Illinois Corporation; SLADE GORTON & CO., INC., a Massachusetts Corporation; HANWA AMERICAN CORP., a New York Corporation; FISHERY PRODUCTS INTERNATIONAL INC., a Massachusetts Corporation; COAST TO COAST SEAFOOD, INC.; SEA PORT PRODUCTS CORPORATION, a Washington Corporation; ADMIRALTY ISLAND FISHERIES INC., a Corporation dba Aqua Star, Defendants - Appellees. CONTESSA FOOD PRODUCTS INC., fka ZB Industries Inc., a California Corporation, Plaintiff - Appellee, v. LOCKPUR FISH PROCESSING CO. LTD., Defendant, and, THE MAZZETTA COMPANY, an Illinois Corporation, Defendant - Appellant. CONTESSA FOOD PRODUCTS INC., fka ZB Industries Inc., a California Corporation, Plaintiff - Appellee, v. LOCKPUR FISH PROCESSING CO. LTD., Defendant, and, SLADE GORTON & CO., INC., a Massachusetts Corporation, Defendant - Appellant. CONTESSA FOOD PRODUCTS INC., fka ZB Industries Inc., a California Corporation, Plaintiff - Appellee, v. LOCKPUR FISH PROCESSING CO. LTD., Defendant, and, HANWA AMERICAN CORP., a New York Corporation, Defendant - Appellant.

Notice: [**1] RULES OF THE NINTH CIRCUIT COURT OF APPEALS MAY LIMIT CITATION TO UNPUBLISHED OPINIONS. PLEASE REFER TO THE RULES OF THE UNITED STATES COURT OF APPEALS FOR THIS CIRCUIT.

Subsequent History: US Supreme Court certiorari denied by, Motion granted by *Contessa Premium Foods, Inc. v. Berdex Seafood, Inc., 2005 U.S. LEXIS 7628 (U.S., Oct. 11, 2005)*

Prior History: Appeal from the United States District Court for the Central District of California. D.C. No. CV-98-08218-NMM. Nora M. Manella, District Judge, Presiding.

Contessa Food Prods. v. Lockpur Fish Processing Co., 2001 U.S. Dist. LEXIS 25994 (C.D. Cal., Nov. 26, 2001)
Contessa Food Prods. v. Lockpur Fish Processing Co., 2001 U.S. Dist. LEXIS 25996 (C.D. Cal., Nov. 26, 2001)
Contessa Food Prods. v. Lockpur Fish Processing Co., 2001 U.S. Dist. LEXIS 25998 (C.D. Cal., Nov. 26, 2001)

Disposition: AFFIRMED IN PART, REVERSED IN PART, AND REMANDED.

Core Terms

infringement, attorney's fees, district court, packaging, contributory, trademark, copyright infringement, reasonable inference, Copyright Act, injunctive relief, court's decision, summary judgment, disgorgement, employees, cartons, profits, shrimp, genuine issue of material fact, Lanham Act, distribute, defending, permanent, speculate, appeals, inner, ship

Case Summary

Procedural Posture
Appellant alleged copyright and trademark holder sought judicial review of the decisions by the United States District Court for the Central District of California granting summary judgment in favor of appellee alleged infringers on its infringement claims and granting summary judgment against the holder on its claim for disgorgement of profits. Three alleged infringers cross-appealed the denial of the request for attorneys' fees.

Overview
Even if the alleged holder had a protectable copyright of the Boiling Shrimp Image (Image), its assertion that the alleged infringers were liable for contributory copyright infringement failed. The alleged holder failed to establish a genuine issue of material fact that any of the alleged infringers knew or had reason to know of a non-appearing defendant's infringement. Since there was no admissible evidence that three alleged infringers ever possessed, let alone distributed, the allegedly infringing packaging, the district court abused its discretion in denying their request for attorneys' fees. The district court did not err in dismissing the alleged holder's trademark claims against the alleged infringers. There was no evidence supporting a reasonable inference that five of the eight alleged infringers ever used the Image in

commerce. Regarding the remaining three alleged infringers, there was no evidence that they willfully infringed the alleged trademark. Since there was not a reasonable likelihood that any allegedly infringing behavior would recur, the alleged holder was not entitled to injunctive relief.

Outcome

The decision of the district court denying the request for attorneys' fees was reversed and remanded. The district's court's dismissal of the alleged holder's claim for disgorgement of profits was affirmed as was the district court's decision denying the alleged holder injunctive relief. Costs were taxed against the alleged holder.

LexisNexis® Headnotes

Copyright Law > Copyright Infringement Actions > Civil Infringement Actions > Burdens of Proof

Torts > ... > Multiple Defendants > Contribution > General Overview

Copyright Law > Copyright Infringement Actions > Civil Infringement Actions > General Overview

Copyright Law > ... > Civil Infringement Actions > Secondary Liability > General Overview

Copyright Law > ... > Civil Infringement Actions > Secondary Liability > Contributory Infringement Actions

HN1[⬇] **Civil Infringement Actions, Burdens of Proof**

The three elements required to establish contributory copyright liability are: (1) direct infringement by a primary infringer, (2) knowledge of the infringement, and (3) material contribution to the infringement. Contributory liability is based in tort law and stems from the notion that one who directly contributes to another's infringement should be held accountable.

Civil Procedure > ... > Summary Judgment > Opposing Materials > General Overview

Civil Procedure > ... > Summary Judgment > Entitlement as Matter of Law > General Overview

Civil Procedure > ... > Summary Judgment > Entitlement as Matter of Law > Genuine Disputes

Civil Procedure > ... > Summary Judgment > Entitlement as Matter of Law > Materiality of Facts

HN2[] **Summary Judgment, Opposing Materials**

Mere speculation is not sufficient to create a genuine issue of material fact sufficient to defeat summary judgment.

Civil Procedure > Remedies > Injunctions > Permanent Injunctions

Trademark Law > ... > Equitable Relief > Injunctions > Permanent Injunctions

Trademark Law > ... > Remedies > Equitable Relief > General Overview

HN3[] **Injunctions, Permanent Injunctions**

The party moving for a permanent injunction must demonstrate that there is some cognizable danger of recurrent a trademark violation that is more than a mere possibility.

Counsel: For CONTESSA FOOD PRODUCTS INC., fka ZB Industries Inc., a California Corporation, Plaintiff - Appellant (03-55415): Gary Dukarich, Theodore A. Pianko, Esq., CHRISTIE, PARKER & HALL, LLP, Newport Beach, CA.

LOCKPUR FISH PROCESSING CO. LTD., Defendant (03-55415, 03-55469, 03-55502, 03-55581): No appearance.

For BERDEX SEAFOOD INC., COAST TO COAST SEAFOOD, INC., Defendants - Appellees (03-55415): Mitchell C. Tilner, Esq., Nina E. Scholtz, Esq., HORVITZ & LEVY, Encino, CA; Robert Helfing, Esq., SEDGWICK DETERT MORAN & ARNOLD, Los Angeles, CA.

For THE MAZZETTA COMPANY, an Illinois Corporation, Defendant - Appellee (03-55415): Richard R. Mainland, Esq., FULBRIGHT & JAWORSKI, LLP, Los Angeles, CA; Monica L. Thompson, PIPER MARBURY RUDNICK & WOLFE, Chicago, IL.

For SLADE GORTON & CO., INC., a [**2] Massachusetts Corporation, Defendant - Appellee (03-55415): Keith E. Walden, Aaron L. Turner, Darren M. Harris, Esq., SPRAY, GOULD & BOWERS, Irvine, CA.

For HANWA AMERICAN CORP., a New York Corporation, Defendant - Appellee (03-55415): David Lieberworth, Esq., GARVEY SCHUBERT & BARER, Seattle, WA.

For FISHERY PRODUCTS INTERNATIONAL INC., a Massachusetts Corporation, Defendant - Appellee (03-55415): Jeffry A. Miller, Esq., LEWIS DAMATO BRISBOIS & BISGAARD, San Diego, CA; David N. Makous, Esq., LEWIS BRISBOIS BISGAARD & SMITH, LLP, Los Angeles, CA.

For SEA PORT PRODUCTS CORPORATION, a Washington Corporation, Defendant - Appellee (03-55415): Russell F. Rowen, LERNER & VEIT, San Francisco, CA.

For ADMIRALTY ISLAND FISHERIES INC., a Corporationa dba Aqua Star, Defendant - Appellee (03-55415): David L. Prince, Esq., LAW OFFICES OF DAVID L. PRINCE, Los Angeles, CA.

For CONTESSA FOOD PRODUCTS INC., fka ZB Industries Inc., a California Corporation, Plaintiff - Appellee (03-55469, 03-55502, 03-55581): Gary Dukarich, CHRISTIE, PARKER & HALL, LLP, Newport Beach, CA.

For THE MAZZETTA COMPANY, an Illinois Corporation, Defendant - Appellant (03-55469): Richard R. Mainland, [**3] Esq., Joshua D. Lichtman, Esq., FULBRIGHT & JAWORSKI, LLP, Los Angeles, CA; Monica L. Thompson, PIPER MARBURY RUDNICK & WOLFE, Chicago, IL.

For SLADE GORTON & CO., INC., a Massachusetts Corporation, Defendant - Appellant (03-55502): Keith E. Walden, Aaron L. Turner, SPRAY, GOULD & BOWERS, Irvine, CA.

For HANWA AMERICAN CORP., a New York Corporation, Defendant - Appellant (03-55581): David Lieberworth, Esq., GARVEY SCHUBERT & BARER, Seattle, WA.

Judges: Before: SCHROEDER, Chief Judge, GOODWIN and CLIFTON, Circuit Judges.

Opinion

[*749] MEMORANDUM [*]

Contessa Food Products, Inc. appeals dismissal on summary judgment of its copyright infringement claims against defendants Berdex Seafood Inc., Coast to Coast Seafood, Inc., Mazzetta Company LLC, Slade Gorton & Company, Inc., and Hanwa America Corporation. Contessa also appeals dismissal on summary judgment of its [**4] *Lanham Act* claims for disgorgement of profits and injunctive relief against the aforementioned defendants, as well as against defendants Fishery Products International, Sea

[*] This disposition is not appropriate for publication and may not be cited to or by the courts of this circuit except as provided by *Ninth Circuit Rule 36-3*.

Port Products Corporation, and Admiralty Island Fisheries, Inc. (collectively "Defendants"). Defendants Mazzetta, Hanwa America, and Slade Gorton cross-appeal the district court's decision denying their request for attorneys' fees under the *Copyright Act*. We affirm the dismissal of Contessa's copyright and trademark claims. We reverse the decision to deny Mazzetta, Hanwa America, and Slade Gorton attorneys' fees under the Copyright Act and remand to the district court for a determination of the reasonable attorneys' fees each incurred defending against Contessa's copyright claims.

Contessa acknowledges that these Defendants did not themselves copy its Boiling Shrimp Image, claiming instead that they are liable for contributory copyright infringement. See *Sony Corp. of America v. Universal City Studios, Inc., 464 U.S. 417, 435, 78 L. Ed. 2d 574, 104 S. Ct. 774 (1984)* (explicitly recognizing contributory copyright infringement as a viable theory of liability under the Copyright Act). ***HN1***[⬆] The three elements required to establish contributory [**5] [*750] copyright liability are: (1) direct infringement by a primary infringer, (2) knowledge of the infringement, and (3) material contribution to the infringement. *MGM Studios, Inc. v. Grokster Ltd., 380 F.3d 1154, 1160 (9th Cir. 2004)*; *Fonovisa, Inc. v. Cherry Auction, Inc., 76 F.3d 259, 264 (9th Cir. 1996)* (noting that contributory liability is based in tort law and "stems from the notion that one who directly contributes to another's infringement should be held accountable").

Assuming, *arguendo*, that Contessa does have a protectable copyright in the Image, [1] [**6] the element of direct infringement is easily established given that it is undisputed that Lockpur Fish Processing Co., Inc. copied the Image with only *de minimis* modifications and placed it on some of the packaging it used to ship frozen block shrimp from Bangladesh to the United States. However, Contessa cannot succeed on a theory of contributory liability against any of these Defendants because it has failed to establish a genuine issue of material fact that any of the Defendants knew or had reason to know of Lockpur's infringement. [2]

Even assuming that some employees of at least some Defendants were aware that Contessa used the Image to market its product, there is no basis in the record for making the leap that they knew that Lockpur was using the Image on some of the inner packaging contained within the master cartons of shrimp it sold to Defendants when Defendants [**7] subsequently resold the shrimp without opening the master cartons. Furthermore, Lockpur only used the Image on some of its inner packaging. Therefore, even if some employees of Defendants did occasionally break open the master shipping cartons for sampling, quality control or partial sales, Contessa can only speculate that these employees saw the infringing packaging.

HN2[⬆] Mere speculation is not sufficient to create a genuine issue of material fact sufficient to defeat summary judgment. *Matsushita Elec. Indus. Co. v. Zenith Radio Corp., 475 U.S. 574, 586-587, 89 L. Ed. 2d 538, 106 S. Ct. 1348 (1986)*. Therefore, the district court did not err in dismissing Contessa's copyright claims against all Defendants.

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[1] For the reasons discussed herein, we do not need to, and therefore we do not reach the issue of whether Contessa has a protectable copyright in the Boiling Shrimp Image.

[2] Alternatively, Contessa could have pursued its claims on the basis of vicarious copyright infringement. See *Ellison v. Robertson, 357 F.3d 1072, 1076 (9th Cir. 2004)*. However, Contessa would not have fared any better under this theory. In addition to proving direct infringement by Lockpur, Contessa would also have to establish that Defendants received a direct financial benefit from the infringement and that Defendants had the right and ability to supervise Lockpur. See *MGM Studios v. Grokster Ltd., 380 F.3d at 1164*. Not only did Defendants not have the requisite control over Lockpur, there is no evidence in the record that Defendants received any benefits whatsoever from Lockpur's sporadic use of the Image on its inner packaging.

In addition, we reverse the district court's decision denying Mazzetta, Slade Gorton, and Hanwa America attorneys' fees under the Copyright Act. *17 U.S.C. § 505*. It does not further the aims of the Copyright Act to force a party to defend itself against a charge of copyright infringement when the proponent of the copyright can produce no evidence from which a reasonable inference can be drawn that the party engaged in any infringing activity. *Fogerty v. Fantasy, Inc., 510 U.S. 517, 526-27, 534 n. 19, 127 L. Ed. 2d 455, 114 S. Ct. 1023 (1994).* [**8] Because there is no admissible evidence in the record that Slade Gorton, Hanwa America or Mazzetta [*751] ever possessed, let alone distributed, the allegedly infringing packaging, the district court abused its discretion in denying their request for attorneys' fees. Accordingly, we remand to the district court for an individualized determination of the total amount of reasonable attorney's fees each incurred in defending against Contessa's copyright claims.

Furthermore, without reaching the issue of whether Contessa has a valid trademark in the Image, we conclude that the district court did not err in dismissing Contessa's trademark claims against Defendants. As an initial matter, Contessa has not introduced any evidence supporting a reasonable inference that five of the eight Defendants ever used the Image in commerce. *15 U.S.C. § 1125*. Therefore, as a matter of law, defendants Mazzetta, Slade Gorton, Hanwa America, Sea Port Products, and Admiralty Island Fisheries cannot be held liable for trademark. infringement, and thus as to these defendants Contessa is not entitled to any remedy under the Lanham Act. [3]

[**9] Although Contessa has introduced evidence supporting a reasonable inference that defendants Fishery Products, Berdex and Coast to Coast did distribute product in packaging containing the Image, we deny Contessa's request for disgorgement of profits because of an absence of any evidence supporting a reasonable inference that any of the Defendants willfully infringed its alleged trademark. *Lindy Pen Co. v. Bic Pen Corp., 982 F.2d 1400, 1406 (9th Cir. 1993)*. Likewise, we deny Contessa's request for injunctive relief because the district court did not abuse its discretion in concluding, *inter alia*, that where Defendants had permanently terminated business relations with Lockpur and had neither commercial interest nor motivation to use the allegedly infringing Image, there was not a reasonable likelihood that any allegedly infringing behavior would recur. *Friends of the Earth, Inc. v. Laidlaw Envtl. Servs., Inc., 528 U.S. 167, 189, 145 L. Ed. 2d 610, 120 S. Ct. 693 (2000)*; *Cummings v. Connell, 316 F.3d 886, 897 (9th Cir. 2003)* (noting that ***HN3***[⬆] the party moving for a permanent injunction must demonstrate that there is "some cognizable danger of recurrent violation" that [**10] is more than a "mere possibility") (internal citations omitted).

Therefore, as to all Defendants, we affirm the district court's dismissal of Contessa's request for disgorgement of profits under the Lanham Act, as well the district court's decision denying Contessa injunctive relief.

Costs are taxed against appellant Contessa.

AFFIRMED IN PART, REVERSED IN PART, AND REMANDED.

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[3] Contessa did not allege any theory of third party liability, nor would any of the Defendants be liable in trademark under any such theory. Third party trademark liability is even more narrowly circumscribed than third party copyright liability. *Sony Corp. of America v. Universal City Studios, Inc., 464 U.S. at 439*. Because there is no evidence that any of the Defendants were engaged in an apparent or actual partnership with Lockpur or induced Lockpur to infringe Contessa's mark, none of the Defendants could be found liable for either vicarious or contributory trademark infringement. See *Inwood Labs. v. Ives Labs., 456 U.S. 844, 854, 72 L. Ed. 2d 606, 102 S. Ct. 2182 (1982)*; *Fonovisa, Inc. v. Cherry Auction, Inc., 76 F.3d at 265*; *Hard Rock Cafe Licensing Corp. v. Concession Services, Inc., 955 F.2d 1143, 1150 (7th Cir. 1992)*.

End of Document

Ekene v. Office L. Fowler

United States District Court for the Central District of California

April 13, 2023, Decided; April 13, 2023, Filed

2:19-cv-06995-DDP (JDE)

Reporter
2023 U.S. Dist. LEXIS 187409 *; 2023 WL 6812672

Linus Ekene v. Office L. Fowler, et al.

Prior History: *Ekene v. Galapon, 2020 U.S. Dist. LEXIS 129472, 2020 WL 4032669 (C.D. Cal., May 12, 2020)*

Core Terms

deposition, subpoena, questions, Prison, notice, parties, housed, written question, deponent, depose, cell

Counsel: [*1] Linus Ekene, Plaintiff, Pro se, Soledad, CA.

For L. Fowler, Correctional Officer, individual, J. Galapon, Correctional Officer, individual, Defendants: Kandice Heejung Jung, CAAG - California Department of Justice, Los Angeles, CA.

Judges: John D. Early, United States Magistrate Judge.

Opinion by: John D. Early

Opinion

CIVIL MINUTES - GENERAL

Proceedings: (In Chambers) Order Granting, in Part, Plaintiff's Request for Clerk's Office to Issue Subpoena and Directing Further Proceedings (Dkt. 59)

On December 28, 2022, Defendants L. Fowler and J. Galapon ("Defendants") filed their Answer (Dkt. 53) to the Civil Rights Complaint (Dkt. 1) filed by Plaintiff Linus Ekene ("Plaintiff"), a California state prison inmate proceeding pro se and granted leave to proceed in forma paupers (Dkt. 8). Plaintiff alleges Defendants, correctional officers at California State Prison Los Angeles County ("the Prison"), violated his civil rights when he was an inmate at the Prison by, among other things, causing him to be housed for 153 days in a cell without heat, hot water, and/or electricity and was subject to sewar gas fumes, all to prevent him from and/or retaliate against him for filing and helping others file lawsuits against Prison employees. **[*2]** On January 3, 2023, the Court issued a Scheduling Order that set, among other things, a discovery cutoff date of July 6, 2023, and directed the parties to proceed expeditiously with discovery. Dkt. 54 ("Scheduling Order") at 2.

On April 11, 2023, the Court received from Plaintiff a Request for Issuance of a Subpoena under *Rule 45 of the Federal Rules of Civil Procedure* ("*Rule 45*") directed to Dr. H. Aly, a Psychologist who treated Plaintiff at the time of the events described in the Complaint who, according to Plaintiff, "was a witness to the incidents stated on this complaint" and "informed Defendants numerous times about the unconstitutional conditions of my cell." Dkt. 59 ("Request") at 2. Plaintiff requests the Subpoena compel the production of all communications between Dr. H. Aly and Plaintiff or Defendants regarding the conditions of the two cells in which Plaintiff was housed at the Prison from November 3, 2016 until May 2017. Id. at 4-5 (CM/ECF pagination). Plaintiff also requests that the Subpoena compel

Dr. H. Aly to appear at the prison at which Plaintiff is currently housed, that is, Salinas Valley State Prison, located in Soledad, California. Id. at 6 (CM/ECF pagination). Further, attached to the Request is a list of nine **[*3]** questions that Plaintiff asks that Dr. Aly either admit or deny. Id. at 7-10 (CM/ECF pagination).

Under *Rule 45*, only a clerk of the issuing court or an attorney for a party may issue a subpoena in a federal civil case. *Rule 45(a)(3)*. Thus, Plaintiff, proceeding pro se, may only serve a subpoena issued by the Clerk of this Court. *Rule 45* limits the timing, location, and scope of third party subpoenas, imposes requirements regarding the tendering of witness fees, and imposes obligations on the party responsible for issuing and serving the subpoena as well as the Court to take reasonable steps to avoid undue burdens on persons subject to a subpoena. See *Rule 45 (a)*, *(b)*, *(c)*, *(d)*. For a deposition subpoena by which testimony is sought, the procedures relating to depositions under *Rule 30 of the Federal Rules of Civil Procedure* ("*Rule 30*") apply, including requirements regarding the method of recording, with the noticing party responsible for recording costs and arranging for an officer to person to administer the oath. See *Rule 30 (a)*, *(b)*. The parties may stipulate, or the court may on motion order, that the deposition take place by telephone or other remote means. See *Rule 30(b)(4)*.

Separately, *Rule 31 of the Federal Rules of Civil Procedure* ("*Rule 31*") provide a procedure by which party may depose "any person, including a party," by written questions. *Rule 31* provides, **[*4]** in full:

(a) When a Deposition May Be Taken.

(1) *Without Leave*. A party may, by written questions, depose any person, including a party, without leave of court except as provided in *Rule 31(a)(2)*. The deponent's attendance may be compelled by subpoena under *Rule 45*.

(2) *With Leave*. A party must obtain leave of court, and the court must grant leave to the extent consistent with Rule 26(b)(1) and (2):

(A) if the parties have not stipulated to the deposition and:

(i) the deposition would result in more than 10 depositions being taken under this rule or *Rule 30* by the plaintiffs, or by the defendants, or by the third-party defendants;
(ii) the deponent has already been deposed in the case; or
(iii) the party seeks to take a deposition before the time specified in Rule 26(d); or

(B) if the deponent is confined in prison.

(3) *Service; Required Notice*. A party who wants to depose a person by written questions must serve them on every other party, with a notice stating, if known, the deponent's name and address. If the name is unknown, the notice must provide a general description sufficient to identify the person or the particular class or group to which the person belongs. The notice must also state the name or descriptive title and the address of **[*5]** the officer before whom the deposition will be taken.

(4) *Questions Directed to an Organization*. A public or private corporation, a partnership, an association, or a governmental agency may be deposed by written questions in accordance with *Rule 30(b)(6)*.

(5) *Questions from Other Parties*. Any questions to the deponent from other parties must be served on all parties as follows: cross-questions, within 14 days after being served with the notice and direct questions; redirect questions, within 7 days after being served with cross-questions; and recross-questions, within 7 days after being served with redirect questions. The court may, for good cause, extend or shorten these times.

(b) Delivery to the Officer; Officer's Duties. The party who noticed the deposition must deliver to the officer a copy of all the questions served and of the notice. The officer must promptly proceed in the manner provided in *Rule 30(c)*, *(e)*, and *(f)* to:

(1) take the deponent's testimony in response to the questions;
(2) prepare and certify the deposition; and
(3) send it to the party, attaching a copy of the questions and of the notice.

(c) Notice of Completion or Filing.

(1) *Completion*. The party who noticed the deposition must notify all other **[*6]** parties when it is completed.

(2) *Filing*. A party who files the deposition must promptly notify all other parties of the filing.

Here, as noted, Plaintiff has requested the Clerk of Court issue a subpoena to Dr. H. Aly, alleged to be a percipient witness, to appear for a deposition and produce all communications between Dr. H. Aly and Plaintiff or Defendants regarding the conductions of the cell in which Plaintiff was housed at the Prison from November 3, 2016 until May 2017. The Court finds, as a threshold matter, that Plaintiff has made a sufficient showing of relevance for the issuance of the requested subpoena for documents; the finding is without prejudice to the ability of Dr. H. Aly or Defendants to object or to move to quash or modify the subpoena on any lawful basis.

As to the portion of the Request that seeks to have the subpoena compel Dr. H. Aly to personally appear to answer questions at the prison in which Plaintiff is currently housed, such relief creates several potential procedural and logistical difficulties. For example, Plaintiff is currently housed at Salinas Valley State Prison, located in Soledad, California, located in Monterey County, which is not within Central **[*7]** District of California. See *28 U.S.C. § 84 (a)*. As the Court does not know where Dr. H. Aly currently resides, is employed, or regularly conducts business, it is unclear if the location for the deposition complies with *Rule 45(c)*'s geographic limitations. Second, demanding attendance inside a prison without coordination with the prison raises legitimate security concerns. Third, as noted, Plaintiff is responsible for arranging for the recording of any in-person deposition and is also responsible for obtaining the appearance of a deposition officer to, among other things, administer the oath. Lastly, it is not apparent that personal appearance is needed here. As noted, Plaintiff attaches nine questions that he wants Dr. Aly to answer. Although Plaintiff states the answers must be either "admit" or "deny," nonparties are not subject to being compelled to answer Requests for Admissions under *Rule 36 of the Federal Rules of Civil Procedure* and it would be inappropriate, in advance, to compel a third party to only answer "admit" or "deny" to questions, as qualifications and/or explanations may fairly be required. Nonetheless, if those are the questions Plaintiff seeks to have answered, a *Rule 31* deposition by written questions, combined with a document subpoena, appear **[*8]** to be appropriate vehicles by which Plaintiff can obtain the information he seeks and, at the same time, limits the burden upon Dr. Aly, a burden that the Court must consider and, as needed, limit under *Rule 45*. In that regard, the Court grants leave to so proceed under *Rule 31(a)(2)(B)*.

As a result, the Request (Dkt. 59) is GRANTED, in part, as follows:

1. The Clerk is directed to issue, place on the docket, and mail to Plaintiff, a *Rule 45* Subpoena for documents directed to Dr. H. Aly to produce to Plaintiff by May 30, 2023, by mail, at Plaintiff's current address, that is, Linus Ekene, CDC F-84633, Salinas Valley State Prison, PO Box 1050, Soledad, California 93960, the following documents: all communications, in any form, between Dr. H. Aly and Plaintiff or L. Fowler or J. Galapon regarding the conditions of the two cells in which Plaintiff was housed at the California State Prison - Los Angeles County, from November 3, 2016 until May 2017.
2. Counsel for Defendants are ordered to inquire and thereafter file, by April 27, 2023, a statement whether counsel is authorized to and does accept service of such subpoena and the nine written questions on behalf of Dr. H. Aly.

3. If service is accepted on behalf of Dr. H. **[*9]** Aly, Defendants may propound and serve cross-questions upon Dr. H. Aly; those cross-questions must be included in the statement regarding acceptance of service if service is accepted. No further questions shall be permitted absent a showing of good cause. Thereafter, Dr. H. Aly shall answer the nine questions, under penalty of perjury, in writing, without a need for a deposition officer, recording, or further oath, and such answers shall be admissible in this proceeding as if they were provided in accordance with the procedures of *Rule 31*.
4. If the statement filed by April 27, 2023 by counsel for Defendants indicates counsel does not have authority to accept service of the subpoena and list of questions on behalf of Dr. H. Aly, further steps will be required to serve Dr. H. Aly, including possibly service by the United States Marshal, and the Court will conduct further

proceedings, if and as warranted, to coordinate a possible in-person deposition of Dr. H. Aly, with Plaintiff's participation at the facility in which Plaintiff is currently housed.

IT IS SO ORDERED.

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In re 5-Hour Energy Mktg. & Sales Practices Litig.

United States District Court for the Central District of California

June 7, 2017, Decided; June 7, 2017, Filed

ML 13-2438 PSG (PLAx)

Reporter
2017 U.S. Dist. LEXIS 220969 *; 2017 WL 2559615

In re 5-Hour Energy Marketing and Sales Practices Litigation

Subsequent History: Appeal denied by *5-Hour Energy Mktg. & Sales Practices Litig. v. Innovation Ventures LLC, 2017 U.S. App. LEXIS 26749 (9th Cir. Cal., Dec. 22, 2017)*

Prior History: *In re 5-Hour Energy Mktg. & Sales Practices Litig., 949 F. Supp. 2d 1357, 2013 U.S. Dist. LEXIS 81695 (J.P.M.L., June 5, 2013)*

Counsel: **[*1]** Attorneys Present for Plaintiff(s): Not Present.

Attorneys Present for Defendant(s): Not Present.

Judges: Philip S. Gutierrez, United States District Judge.

Opinion by: Philip S. Gutierrez

Opinion

CIVIL MINUTES - GENERAL

Proceedings (In Chambers): Order DENYING Plaintiffs' Motion for Class Certification and GRANTING IN PART and DENYING IN PART Defendants' Motions to Exclude Plaintiffs' Experts

Before the Court is Plaintiffs Marc Adler, Michael Casey, David Ellis, William Forrest, Ilya Podobedov, Cody Soto, and Donna Thompson's motion for class certification, **Dkt. # 159**, and Defendants Innovation Ventures, LLC; Living Essentials, LLC; Manoj Bhargava; and Bio Clinical Development, Inc.'s motions to exclude experts Patrick T. Ronaldson and Colin B. Weir, Dkts. **# 206, 209, 217, 219**. The Court finds the matter appropriate for decision without oral argument. *Fed. R. Civ. P. 78*; *Local R. 7-15*. After thoroughly considering the arguments in the papers, the Court DENIES Plaintiffs' motion for class certification, and GRANTS IN PART and DENIES IN PART Defendants' motions to exclude Plaintiffs' experts.

I. Background

A. Procedural Background

On August 4, 2011, Plaintiffs Ilya Podobedov, Jordan Moussouros, and Richard N. James filed this putative class action against **[*2]** Defendants Innovation Ventures, LLC; Living Essentials, LLC; Manoj Bhargava; and Bio Clinical Development, Inc. in the Central District of California. *See Complaint, Podobedov v. Living Essentials, LLC*, CV 11-6408 PSG (PLAx) (C.D. Cal.), Dkt. # 1. In June 2013, the Judicial Panel on Multidistrict Litigation centralized a number of cases related to the marketing and sale of 5-hour ENERGY ("5HE") and assigned the matter to this Court for consolidated pretrial proceedings. *See* Dkt. # 1. On January 24, 2017, the Court issued an order granting in part and denying in part Defendants' motion for summary judgment. Dkt. # 191. Plaintiffs now move for class certification on some of the remaining claims,[1] and

[1] Some of the surviving causes of action contained claims

Defendants have moved to exclude Plaintiffs' experts, Colin B. Weir and Patrick T. Ronaldson. *See* Dkts. # 159, 206, 209, 217, 219.

B. Factual Background

Plaintiffs are consumers in six states who purchased 5-hour ENERGY ("5HE") products, including 5-hour ENERGY and 5-hour ENERGY Extra Strength,[2] between March 1, 2008 and their entry into this case. *See Plaintiff's Notice of Motion* 1:4-24. They allege that Defendants deceptively and **[*3]** misleadingly marketed 5HE as "five hour energy" or providing "hours of energy" when 5HE provides only a few minutes of energy at most. *See Order Granting in Part and Denying in Part Summary Judgment* 2. Throughout the class period, every label of 5HE displayed the name of the product, "5-hour ENERGY," and a claim that the product provides "hours of energy." *Motion for Class Certification* 1:4-5.

Plaintiffs propose certification of six separate statewide classes:

> All persons who purchased 5HE products, including 5HE and 5HE Extra Strength, on or after March 1, 2008 in California. This class is represented by Plaintiffs Ilya Podobedov[3] and Cody Soto who first filed their Complaint in the Central District of California.
>
> All persons who purchased 5HE products, including 5HE and 5HE Extra Strength, on or after March 1, 2008 in Missouri. This class is represented by Plaintiff William Forrest who first filed in the Eastern District of Missouri.
>
> All persons who purchased 5HE products, including 5HE and 5HE Extra Strength, on or after March 1, 2008 in New Mexico. This class is represented by Plaintiff David Ellis who originally filed in the District of New Mexico.
>
> All persons who purchased 5HE products, **[*4]** including 5HE and 5HE Extra Strength, on or after March 1, 2008 in New Jersey. This class is represented by Plaintiff Marc A. Adler who originally filed in the District of New Jersey.
>
> All persons who purchased 5HE products, including 5HE and 5HE Extra Strength, on or after March 1, 2008 in New York. This class is represented by Plaintiff Podobedov who originally filed the New York claims in the Central District of California.
>
> All persons who purchased 5HE products, including 5HE and 5HE Extra Strength, on or after March 1, 2008 in Pennsylvania. This class is represented by Plaintiffs Donna A. Thompson and Michael R. Casey who originally filed in the Western District of Pennsylvania.

Plaintiffs allege claims for violations of state consumer protection laws, breach of express warranty, breach of the implied warranty of merchantability, and intentional misrepresentation and concealment of fact. Specifically, they plead the following claims:

> 1. **California**: (1) violation of the *Consumer Legal Remedies Act ("CLRA"), Cal. Civ. Code §§ 1750 et seq.*; (2) violation of the Unfair Competition Law ("UCL"), *Cal. Bus. & Prof. Code §§ 17200 et seq.*; (3) violation of the False Advertising Law ("FAL"), *Cal. Bus. & Prof. Code §§ 17500 et seq.*; (4) breach of express **[*5]** warranty; (5) breach of implied warranty of merchantability; and (6) intentional misrepresentation and concealment of fact.
>
> 2. **Missouri**: (1) violation of the *Missouri Merchandising Practices Act ("MMPA"), Mo. Ann. Stat. §§ 407.020 et seq.*, and (2) intentional misrepresentation and concealment of fact.

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based on off-label representations and claims that 5HE did not result in a crash. An example of an off-label representation is a claim in a television commercial that 5HE provides, "A powerful blend of B Vitamins for energy," "5-hour ENERGY's blend of vitamins and amino acids gives you hours of smooth energy," and "5-hour ENERGY doesn't jack you up with sugar, caffeine, and herbal stimulants. Instead, it's packed with stuff that's good for you—B-vitamins, amino acids, and enzymes." *See Consolidated First Amended Class Action Complaint* ¶¶ 47-50, 53-55. Plaintiffs' motion for class certification makes no mention of these statements or Plaintiffs' claim under the federal *Magnuson-Moss Warranty Act*, and Defendants point out the apparent abandonment of these claims in their Opposition. *See Opp*. 5 n.5. Although the Court does not dismiss these claims, as Defendants' urge, the Court does not consider the statements as part of Plaintiffs' class certification order because they are not argued in Plaintiffs' motion.

[2] Plaintiffs have not had an opportunity to revise their motion for class certification since the Court granted in part and denied in part Defendants' motion for summary judgment. Although Plaintiffs' motion for class certification asks the Court to certify a class based on decaffeinated 5HE, the Court dismissed all decaffeinated-related claims in its summary judgment order. *See* Dkt. # 191, at 19. The Court therefore does not address any claims based on decaffeinated 5HE.

[3] Plaintiff Podobedov is the lead Plaintiff for both the California and New York classes. Podobedov purchased 5HE in California, Nevada, and New York. *See Podobedov et al. v. Innovation Ventures et al.*, CV 11-6408 PSG (PLAx).

3. **New Jersey**: (1) violation of the New Jersey Fraud in Sales or Advertising of Merchandise Law (the "New Jersey Fraud Statute"), N.J. Stat. Ann. §§ 56:8-1 et seq.; (2) violation of the New Jersey Truth-in-Consumer Contract, Warranty and Notice Act (the "New Jersey Warranty Act"), N.J. Stat. Ann. §§ 56:12-14 et seq.; (3) breach of express warranty; (4) breach of implied warranty of merchantability; (5) intentional misrepresentation and concealment of fact.

4. **New Mexico**: (1) violation of the New Mexico Unfair Practices Act ("UPA"), N.M. Stat. Ann. §§ 57-12-2 et seq.; (2) breach of implied warranty of merchantability; and (3) intentional misrepresentation and concealment of fact.

5. **New York**: (1) violation of the New York Deceptive Trade Practices Act ("DTPA"), N.Y. Gen. Bus. Law §§ 349 et seq., and (2) intentional misrepresentation and concealment of fact.

6. **Pennsylvania**: (1) violation of the Pennsylvania Unfair Trade Practices and Consumer Protection Law ("UTPCPL"), 73 Pa. Cons. Stat. §§ 201-2 *et seq.*; and (2) intentional misrepresentation and concealment of fact.

II. Discussion

A. Evidentiary **[*6]** Objections to Plaintiffs' Experts

Before addressing the merits of the certification motion, the Court must consider Defendants' evidentiary objections to Plaintiffs' experts, Patrick T. Ronaldson and Colin B. Weir. The Ninth Circuit has approved of a rigorous application of Daubert v. Merrill Dow Pharmaceuticals, Inc., 509 U.S. 579, 591, 113 S. Ct. 2786, 125 L. Ed. 2d 469 (1993), in evaluating class certification motions. *See* Ellis v. Costco Wholesale Corp., 657 F.3d 970, 982 (9th Cir. 2001).

Under Federal Rule of Evidence 702 and Daubert:

> If scientific, technical, or other specialized knowledge will assist the trier of fact to understand the evidence or to determine a fact in issue, a witness qualified as an expert by knowledge, skill, experience, training, or education, may testify thereto in the form of an opinion or otherwise, if (1) the testimony is based upon sufficient facts or data, (2) the testimony is the product of reliable principles and methods, and (3) the witness had applied the principles and methods reliably to the facts of the case.

Fed. R. Evid. 702; *see also* United States v. Finley, 301 F.3d 1000, 1007 (9th Cir. 2002). Before admitting expert testimony, the trial court must make "a preliminary assessment of whether the reasoning or methodology underlying the testimony is scientifically valid and of whether that reasoning or methodology properly can be applied to the facts in issue." Daubert, 509 U.S. at 592-93. In conducting this preliminary assessment, the trial **[*7]** court is vested with broad discretion. *See, e.g.,* General Elec. Co. v. Joiner, 522 U.S. 136, 142, 118 S. Ct. 512, 139 L. Ed. 2d 508 (1997).

"The party offering the expert bears the burden of establishing that Rule 702 is satisfied." Sundance Image Tech., Inc. v. Cone Editions Press, Ltd., No. CV 02-2258 JM (AJBx), 2007 U.S. Dist. LEXIS 16356, 2007 WL 935703, at *3 (S.D. Cal. Mar. 7, 2007) (citing Allison v. McGhan Med. Corp., 184 F.3d 1300, 1306 (11th Cir. 1999)). "In determining whether expert testimony is admissible under Rule 702, the district court must keep in mind [the rule's] broad parameters of reliability, relevancy, and assistance to the trier of fact." Sementilli v. Trinidad Corp., 155 F.3d 1130, 1134 (9th Cir. 1998). On a motion for class certification, it is not necessary that expert testimony resolve factual disputes going to the merits of plaintiffs' claims; instead, the testimony must be relevant in assessing "whether there was a common pattern and practice that could affect the class as a whole." Ellis, 657 F.3d at 983.

i. Patrick T. Ronaldson

Patrick T. Ronaldson is Plaintiffs' expert on the physiological effects of 5HE. Ronaldson is currently an assistant professor in the Department of Pharmacology at the University of Arizona College of Medicine. *Smith Decl.*, Ex. 19 (Ronaldson Decl.), Att. A. Ronaldson holds a BS in pharmacology from the University of Toronto, and a Ph.D. in pharmaceutical sciences from the Leslie Dan Faculty of Pharmacy at the University of Toronto. *Ronaldson Decl.*, ¶¶ 4-5. His expertise is **[*8]** in the areas of neuropharmacology, drug delivery, drug transporter biology, pharmacokinetics, drug-drug interactions, and the effect of disease mechanisms on drug efficacy and toxicity. *Id.* ¶ 13.

Ronaldson opines that 5HE does not (1) provide five hours of energy, which Ronaldson defines as "caloric" energy, (2) 5HE's B-vitamins and amino acids are not

the basis of the increased energy and alertness that consumers feel after consuming 5HE, and (3) 5HE results in the same "crash" typically attributed to other caffeine products. *Id.* ¶ 70. Based on information about the number of calories in 5HE and the demographic characteristics of the average 5HE consumer, Ronaldson estimates that 5HE provides no more than 3.4 minutes of caloric energy to the average male consumer and 3.7 minutes of caloric energy to the average female consumer. *Id.* ¶ 27.

Defendants argue that Ronaldson's declaration is unreliable to the extent that Ronaldson claims expertise in how the ordinary consumer would use the term "energy." *Defendants' Motion to Exclude the Expert Opinion Testimony of Patrick T. Ronaldson* 1:11-22 ("Dr. Ronaldson's opinion is what the word 'energy' means *to him* judged 'from the perspective of **[*9]** a pharmacologist.' Dr. Ronaldson does not opine (nor is he qualified to opine) as to how the word 'energy' as used on the Product label is interpreted by the ordinary consumer, either alone or taking the entire label into consideration."); *see also Vazquez Decl.*, Ex. L (Riley Report), at 1, Ex. X (Kennedy Deposition, 51:6-10) (opining that defining energy in terms of caloric value is inconsistent with consumer expectations).

Although the Court finds Ronaldson qualified to testify as an expert on the physiological effect of 5HE, the Court agrees with Defendants that Ronaldson's declaration cannot be used as evidence that there is only one meaning of the term "energy." "Energy" is a commonly understood term, and the trier of fact does not need assistance defining "energy" because it is not a matter that is beyond ordinary competence and experience. *See* United States v. Seschillie, 310 F.3d 1208, 1212 (9th Cir. 2012) ("A district court does not abuse its discretion when it refuses expert testimony where the subject does not need expert 'illumination' and the proponent is otherwise able to elicit testimony about the subject." (quoting United States v. Ortland, 109 F.3d 539, 545 (9th Cir. 1997)). The Court is therefore skeptical of the claim that a fact finder needs help defining the term.

Accordingly, the Court **[*10]** STRIKES those portions of Ronaldson's declaration that discuss the meaning of the term "energy" according to a pharmacologist. However, the Court ADMITS Ronaldson's declaration to the extent that Ronaldson opines on the physiological effects of a bottle of 5HE on the average 5HE consumer.

ii. Colin B. Weir

Colin Weir is Plaintiffs' damages expert. Weir is Vice President of Economics and Technology, Inc. ("ETI"), a research and consulting firm specializing in economics, statistics, regulation, and public policy, where he has worked for ten years. *Corrected Smith Decl.*, Dkt. # 180, Ex. 21 (Weir Decl.), Att. A (Statement of Qualifications), at 1. Weir holds an MBA from Northeastern University, and a BA in Business Economics from the College of Wooster. *Id.* Weir has consulted and submitted testimony in a variety of consumer and wholesale products cases, calculating damages related to household appliances, herbal remedies, food products, electronics, and computers. *Id.* at 3-8.

Weir opines that it is possible to determine damages in this case on a class-wide basis by determining the amount of "underfill" in each bottle of 5HE. *Id.* ¶¶ 8, 11-13. Using Ronaldson's calculation that 5HE provides only 3.7 **[*11]** minutes of caloric energy, Weir calculates that the bottles are "underfilled" by approximately 296.3 minutes of caloric energy (300 minutes in five hours minus 3.7 minutes). *Id.* ¶ 12. Defendants attack the reliability of Weir's declaration on multiple grounds, but their principal objection appears to be that Weir's damages model does not comport with Plaintiffs' theory of liability in this case, and so violates the principles set forth in Comcast v. Behrend, 569 U.S. 27, 133 S. Ct. 1426, 1433, 185 L. Ed. 2d 515 (2013).

Because the issue of whether Weir has put forward a workable model to assess damages on a class-wide basis is closely intertwined with the *Rule 23(b)* predominance analysis, the Court declines to address the reliability of Weir's methodologies in a *Daubert* motion, and instead accepts Weir's expert report and testimony for the limited purpose of deciding the predominance issue. *See* In re ConAgra Foods, Inc., 90 F. Supp. 3d 919, 946 (C.D. Cal. 2015) ("As respects Ugone's criticism that the methodology does not satisfy the requirement articulated in *Comcast*—i.e., that damages may be capable of measurement on a classwide basis—this does not affect the *admissibility* of Weir's opinions." (internal citations omitted)); *accord* Forth Worth Employees' Retirement Fund v. J.P. Morgan Chase & Co., 301 F.R.D. 116, 130 (S.D.N.Y. 2014) (whether damages can be assessed "on a class[-]wide basis [is a] question that is properly considered as **[*12]** part of the *Rule 23(b)* issue of whether questions common to the class predominate over individual issues, not to the validity of [the expert's] methods as a matter of admissibility of his expert

testimony under the Federal Rules of Evidence.").

Accordingly, the Court DENIES Defendants' motion to exclude the Weir declaration, and admits Weir's declaration for the narrow purpose of determining whether Plaintiffs have met their class certification burden under *Rule 23*.

B. Class Certification

"The class action is an 'exception to the usual rule that litigation is conducted by and on behalf of the individual named parties only.'" *Wal-Mart Stores, Inc. v. Dukes et al., 564 U.S. 338, 348-49, 131 S. Ct. 2541, 180 L. Ed. 2d 374 (2011)* (citing *Califano v. Yamasaki, 442 U.S. 682, 700-01, 99 S. Ct. 2545, 61 L. Ed. 2d 176 (1979)*). "In order to justify a departure from that rule, 'a class representative must be part of the class and "possess the same interest and suffer the same injury" as the class members.'" *Id.* (citing *East Tex. Motor Freight Sys., Inc. v. Rodriguez, 431 U.S. 395, 403, 97 S. Ct. 1891, 52 L. Ed. 2d 453 (1977)*).

In a motion for class certification, the burden is on plaintiffs to make a prima facie showing that class certification is appropriate, *see In re Northern Dist. of Cal. Dalkon Shield IUD Liab. Litig., 693 F.2d 847, 854 (9th Cir. 1982)*, and the Court must conduct a "rigorous analysis" to determine the merit of plaintiffs' arguments, *see Gen. Tel. Co. of Sw. v. Falcon, 457 U.S. 147, 161, 102 S. Ct. 2364, 72 L. Ed. 2d 740 (1982)*. Plaintiffs must be prepared to "prove" that there are "*in fact*" sufficiently numerous parties or that common questions exist, and frequently **[*13]** this will require some "overlap with the merits of the plaintiff's underlying claim." *See Dukes, 564 U.S. at 350*. *Rule 23* does not, however, grant the court license to "engage in free-ranging merits inquiries at the certification stage." *Amgen Inc. v. Connecticut Ret. Plans & Tr. Funds, 568 U.S. 455, 133 S. Ct. 1184, 1194- 95, 185 L. Ed. 2d 308 (2013)*. "Merits questions may be considered to the extent—but only to the extent—that they are relevant to determining whether the *Rule 23* prerequisites for class certification are satisfied." *See id.* (citing *Dukes, 564 U.S. at 351 n.6*).

Federal Rule of Civil Procedure 23 governs the structure of class certification motions in federal court. *Rule 23(a)* ensures that the named plaintiffs are "appropriate representatives of the class whose claims they wish to litigate." *See Dukes, 564 U.S. at 349*. Plaintiffs must satisfy all of *Rule 23(a)*'s four requirements—numerosity, commonality, typicality, and adequacy—and at least one of the requirements of *Rule 23(b)*. *See Ellis v. Costco Wholesale Corp., 657 F.3d 970, 979-80 (9th Cir. 2011)* (describing *Rule 23(b)* requirements).

In this motion, Plaintiffs move for certification under *Rule 23(b)(3)*. *Rule 23(b)(3)* requires the Court to find that (1) "questions of law or fact common to class members predominate over any questions affecting only individual class members" and (2) "that a class action is superior to other available methods for fairly and efficiently adjudicating the controversy." *See Fed. R. Civ. P. 23(b)(3)*. The dual requirements of *Rule 23(b)(3)* are commonly known as "predominance" and "superiority." **[*14]**

Because Plaintiffs' bid for class certification fails conclusively at the predominance inquiry, the Court focuses its class certification analysis on predominance alone. Predominance "tests whether proposed classes are sufficiently cohesive to warrant adjudication by representation." *Amchem Prods. v. Windsor, 521 U.S. 591, 623, 117 S. Ct. 2231, 138 L. Ed. 2d 689 (1997)*. "Predominance is a qualitative rather than a quantitative concept. It is not determined simply by counting noses: that is, determining whether there are more common issues or more individual issues, regardless of relative importance." *See Parko v. Shell Oil Co., 739 F.3d 1083, 1085 (7th Cir. 2014)* (Posner, J.). It is "far more demanding" than the commonality requirement of *Rule 23(a)*. *See Amchem, 521 U.S. at 623-24*.

Here, the predominance element is not satisfied because individual questions predominate over common questions. Two issues in particular concern the Court. First, Plaintiffs have not carried their burden of showing that reliance and causation are subject to common proof. Plaintiffs offer little evidence of the materiality of the alleged misstatements on the 5HE label, and no evidence that consumers understand the term "energy" in uniformly the same way. Second, Plaintiffs' proposed damages model does not comport with Plaintiffs' theory of liability in this case and so violates predominance **[*15]** under *Comcast*. The Court first discusses reliance and causation, and then turns to the proposed damages model.

i. Reliance and Causation

Reliance and causation are critical components of establishing liability under all of Plaintiffs' causes of action.[4] Thus, to establish predominance under *Rule*

[4] In its Order granting in part and denying in part Defendants'

23(b)(3), courts typically require that plaintiffs demonstrate that reliance and causation are subject to common proof. *See* *In re ConAgra Foods, Inc., 302 F.R.D. at 576*.

In the causes of action at issue in this case, reliance and causation are susceptible to common proof only if the state law at issue follows a "reasonable person" standard for assessing the materiality of the misstatement. In such states, a misstatement is material if it is "likely to mislead a reasonable consumer acting reasonably under the circumstances." *See* *In re Scotts EZ Seed Litig., 304 F.R.D. 397, 409-10 (S.D.N.Y. 2015)*; *see also* *Shein v. Canon U.S.A., Inc., No. CV 08-7323 CAS (Ex), 2010 U.S. Dist. LEXIS 91160, 2010 WL 3170788, at *7 (C.D. Cal. Aug. 10, 2010)*. If a statute uses a reasonable person standard, it is more likely to be subject to common proof because the inquiry into materiality is objective. *See* *In re Scotts EZ Seed Litig., 304 F.R.D. at 409-10*; *see also* *Tait v. BSH Home Appliances Corp., 289 F.R.D. 466, 490 (C.D. Cal. 2012)* (recognizing that the reasonable consumer test is "ideal for class certification because [it] will not require the court to investigate class members' individual interaction with the product"). "Reasonable consumer" **[*16]** statutes entitle plaintiffs to a class-wide inference of causation if the plaintiffs can show that the manufacturer's representations were material. *See* *In re ConAgra Foods, Inc., 302 F.R.D. at 571*. Similarly, such reasonable consumer laws entitle plaintiffs to a class-wide inference of reliance if plaintiffs show (1) that uniform misrepresentations were made to the class, and (2) that the misrepresentations were material. *Shein, 2010 U.S. Dist. LEXIS 91160, 2010 WL 3170788, at *7*; *see also* *Wiener v. Dannon Co., Inc., 255 F.R.D. 658, 669 (C.D. Cal. 2009)*.

Plaintiffs have shown, and Defendants do not dispute, that the state consumer laws remaining in this case follow a reasonable consumer standard and so a class-wide inference of reliance and causation is available to Plaintiffs. *See, e.g.,* *Cole v. Asurion Corp., 267 F.R.D. 322, 328 (C.D. Cal. 2010)* ("Class relief is available on [UCL, FAL, and CLRA] claims 'without individualized proof of deception, reliance, and injury.'"); *Falk v. Gen. Motors Corp., 496 F. Supp. 2d 1088, 1095 (N.D. Cal. 2007)*; *Allen v. Hyland's Inc., 300 F.R.D. 643, 669 (C.D. Cal. 2014)* (California express warranty claim); *In re First All. Mortg. Co., 471 F.3d 977, 991 (9th Cir. 2006)* (California common law fraud); *Glen v. Fairway Indep. Mortg. Corp., 265 F.R.D. 474, 480-81 (E.D. Mo. 2010)* (MMPA); *Boswell v. Panera Bread Co., 311 F.R.D. 515, 531 (E.D. Mo. 2015)* (Missouri common law fraud); *Elias v. Ungar's Food Prods., Inc., 252 F.R.D. 233, 239, 251 (D.N.J. 2008)* (New Jersey Fraud Statute and Breach of Express Warranty); *In re Prudential Ins. Co. of Am. Sales Practices Litig., 962 F. Supp. 450, 513 (D.N.J. 1997)* (New Jersey common law fraud); *Guidance Endodontics, LLC v. Dentsply Int'l Inc., 749 F. Supp. 2d 1235, 1258 (D.N.M. 2010)* (New Mexico UPA); *Daye, 313 F.R.D. at 169 n.12* (New Mexico common law fraud); *AIG Aviation Ins. v. Avco Corp., 709 F. Supp. 2d 1124, 1132 (D.N.M. 2010)* (New Mexico breach of express warranty); *Ackerman v. Coca-Cola Co., No. CV 09-0395 JG (RMLx), 2010 U.S. Dist. LEXIS 73156, 2010 WL 2925955, at *15 (E.D.N.Y. July 21, 2010)* (New York DTPA); *In re Scotts EZ Seed Litig., 304 F.R.D. 397, 409-10 (S.D.N.Y. 2015)* ("Materiality under Section 349 of the GBL is an objective inquiry; a deceptive act is defined as one likely to mislead a reasonable consumer **[*17]** acting reasonably under the circumstances."); *Moore v. PaineWebber, Inc., 306 F.3d 1247, 1253 (2d Cir. 2002)* (New York common law fraud); *Oslan v. Collection Bureau of Hudson Valley, 206 F.R.D. 109, 112 (E.D. Pa. 2002)* (Pennsylvania UTPCPL).

Nonetheless, although Plaintiffs have shown that a class-wide presumption of reliance and causation is *available* for all their claims, they have not shown that they are *entitled* to the presumptions because they have not made a sufficient showing that the statements on the 5HE label were material to the class. *See* *Jones v. ConAgra Foods, Inc., No. C 12-1633 CRB, 2014 U.S. Dist. LEXIS 81292, 2014 WL 2702726, at *15-16 (N.D. Cal. June 13, 2014)*; *see also* *In re ConAgra Foods, Inc., 302 F.R.D. at 567-68*. A misrepresentation is material "if a reasonable man would attach importance to its existence or nonexistence in determining his choice of action in the transaction in question." *In re Steroid Hormone Prod. Cases, 181 Cal. App. 4th at 157*. As the Ninth Circuit concluded in *Stearns v. Ticketmaster*, "[i]f the misrepresentation or omission is not material as to all class members, the issue of reliance [and causation] 'would vary from consumer to consumer' and the class should not be certified." *Jones,*

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motion for summary judgment, the Court recognized that some states impose a less rigorous standard for proving the element of reliance. *See* Dkt. # 91, at 13-16 (recognizing that some states had adopted a more liberal "exposure" standard). This finding in no way changes the outcome here. In the summary judgment order, the Court was primarily concerned with whether Plaintiffs had presented proof of reliance; here, the Court's only concern is whether reliance is amenable to common proof.

*2014 U.S. Dist. LEXIS 81292, 2014 WL 2702726, at *15-16* (citing *Stearns v. Ticketmaster Corp., 655 F.3d 1013, 1022-23 (9th Cir. 2011)*); *see also In re Steroid Hormone Prod. Cases, 181 Cal. App. 4th at 156-57*.

The evidence of materiality of the "five hour energy" statement on the 5HE bottle in this case is limited. Plaintiffs rely heavily on the opinion of 5HE's former marketing director, Carl Sperber, who testified at his deposition that 5HE was named so that it would "educate" consumers in a "few words" about "what the **[*18]** product was" and "what they could expect from it." *Smith Decl.*, Ex. 14 (Sperber Depo.). Sperber's deposition does not convince the Court that materiality is subject to common proof because the deposition addresses only how 5HE perceived its own branding techniques, and not how consumers reacted to the product name or the alleged misstatements on the 5HE label. Although Sperber generally asserts that "front labels" are important to consumers, Sperber provides no information to suggest that the representations on the 5HE label are material to consumers or that the representations factored into the consumers' decision to purchase the product. *Id.* Moreover, although some named Plaintiffs stated that they purchased 5HE because they believed it would provide them with five hours of caloric energy, *see Mot*. 5:1-18, *Reply* 8, Plaintiffs do not provide any consumer surveys that suggest that this belief is common across the class.

In contrast, Defendants' evidence suggests that the representations are not material to most or even a substantial portion of the class. Defendants' expert, Michael J. Riley, conducted a consumer online survey of 5HE consumers. *Vazquez Decl.*, Ex. L (U.S. Consumer Online **[*19]** Survey Report, attached as exhibit to report of Michael Riley). The survey found that only 2.2 percent of 5HE consumers attributed their initial purchase decision to 5HE's "marketing efforts." *Vazquez Decl.*, Ex. L, at 2. Riley also concluded that "marketing efforts" had little effect on subsequent purchases, which were primarily driven by consumer satisfaction or dissatisfaction with the product. *Id.* Moreover, in the survey, consumers listed numerous reasons for making their initial purchase of 5HE, including staying awake or focused; because it was recommended; out of curiosity; as an alternative to energy drinks or coffee; because of its location on the checkout counter; small size and convenience, price, promotions, discounts, free sampling and flavor; because it is sugar free, has zero carbohydrates and four calories; and because of its vitamins and nutrients. *Vazquez Decl.*, Ex. L (Riley Report) at 32 (listing 5HE Consumer Online Survey Report results).

Courts have refused to certify a consumer protection class where plaintiffs make such a limited showing of class-wide materiality. In *Jones*, for example, Judge Breyer declined to certify a class of consumers who had purchased Pam **[*20]** cooking spray products, Hunt's tomato products, and Swiss Miss hot cocoa products, and who alleged that they were deceived by the products' "All Natural" label. *2014 U.S. Dist. LEXIS 81292, 2014 WL 2702726, at *1*. The court reasoned that evidence of materiality was lacking because plaintiffs provided only the conclusory declaration of an expert who stated that "reasonable consumers would rely on [the] label to identify products that are natural." *See 2014 U.S. Dist. LEXIS 81292, 2014 WL 2702726, at *15* ("[The expert] did not explain *how* the challenged statements, together or alone, were a factor in any consumer's purchasing decisions. She did not survey any customers to assess whether the challenged statements were in fact material to their purchases, as opposed to, or in addition to, price, promotions, retail positioning, taste, texture, or brand recognition."). Similarly, in *In re ConAgra Foods*, Judge Morrow declined to certify a class when the evidence of materiality was "in conflict." *302 F.R.D. at 576-77*. Judge Morrow faulted plaintiffs for failing to adduce any survey evidence of consumer reactions to the "100% Natural" label or any evidence that consumers understood the "100% Natural" label to indicate that the product would be GMO-free. *Id.*

The same faults permeate the evidence here. Absent a consumer **[*21]** survey or other market research to indicate how consumers reacted to the "five hour energy," or "hours of energy" statements, and how they valued these statements compared to other attributes of the product and the energy supplement market generally, Plaintiffs have not offered sufficient evidence of materiality across the class. *See Pierce-Nunes v. Toshiba Am. Information Sys., Inc., No. CV 14-7242 DMG (KSx), 2016 U.S. Dist. LEXIS 149847, 2016 WL 5920345, at *9 (C.D. Cal. June 23, 2016)* (finding no common proof of materiality where defendants introduced evidence that consumers purchased TVs for a variety of factors, including their own research, the influence of sales people, comparison shopping, or recommendations from family, friends, or co-workers).

Predominance also fails for lack of a common definition for the term "energy." Where plaintiffs fail to establish a controlling definition for a key term in an alleged misstatement, courts have found that materiality is not

susceptible to common proof. *See* Pierce-Nunes, 2016 U.S. Dist. LEXIS 149847, 2016 WL 5920345, at *7 (finding predominance not satisfied where plaintiffs could not establish a common meaning for the term "LED TV"); Pelayo v. Nestle USA, Inc., 989 F. Supp. 2d 973, 2013 WL 5764644, at *4-5 (C.D. Cal. 2013) (discussing lack of common understanding of the term "all natural" that is shared by reasonable consumers); Jones, 2014 U.S. Dist. LEXIS 81292, 2014 WL 2702726, at *15 ("[E]ven if the **[*22]** challenged statements were facially uniform, consumers' *understanding* of those representations would not be."); Astiana v. Kashi Co., 291 F.R.D. 493, 508 (S.D. Cal. 2013) (denying class certification where plaintiffs failed to show that "all natural" had any kind of uniform definition among the class). In these cases, some plaintiffs have even shown a specific rate of acceptance of the proposed definition of a disputed term in the consumer marketplace. *See* In re NJOY, Inc. Consumer Class Action Litig., 120 F. Supp. 3d 1050, 1112-13 (C.D. Cal. 2015) (presuming materiality where "37.1 percent and 41.5 percent of respondents who viewed the advertisement believed it conveyed an overall safety message"); Oshana v. Coca-Cola Co., 2005 U.S. Dist. LEXIS 14184, 2005 WL 1661999, at *9 (N.D. Ill. July 13, 2005) (presumption of materiality applied where 24 percent of consumers "would behave differently" without the misrepresentation).

Here, the meaning of the term "energy" is disputed, and Plaintiffs have offered no evidence of a common definition of "energy" among a substantial number of consumers. Plaintiffs argue that "energy" means "caloric energy," and they offer the declaration of their expert, a leading pharmacologist, who attests that energy is scientifically understood to mean caloric energy. *See Smith Decl.*, Ex. 19 (Ronaldson Decl.), ¶ 19. Plaintiffs also point out that the U.S. Food and Drug Administration defines "energy" as caloric **[*23]** energy for dietary supplements. *See Reply* 8. Even with these proffered definitions, however, Plaintiffs still offer no evidence that the majority of consumers, or even a substantial group of consumers, define "energy" as caloric energy or believe that "energy" means only one thing. *See Vazquez Decl.*, Ex. Y.

In response, Defendants argue that consumers define "energy" more broadly to encompass subjective feelings of energy and an increased ability to perform tasks. *Vazquez Decl.*, Ex. O (Kennedy Report, at 6-13). Defendants point to the definition of energy in a "psychological sense," which includes "alertness, arousal, or fatigue," and energy as in "mental energy" or "the ability and motivation to perform mental tasks," such as vigilance and sustained attention. *Id.*, Ex. ¶ (Kennedy Report, at 8-9). Defendants point out that people do not typically associate the term "energy" with the feeling you get after a high-calorie meal, *Opp.* 4:14-16, and they argue that Plaintiffs' definition of energy is excessively narrow, given that each bottle of 5HE explicitly stated that it contained only four calories and it would thus be unreasonable for a consumer to believe that "energy" meant only "caloric **[*24]** energy."

At this point, the Court need not resolve the dispute among the parties about the appropriate definition of the term "energy." It is enough to say that Plaintiffs have offered no evidence that any one definition of energy prevails among all consumers. Without a common definition or common understanding of the term, the Court cannot conclude that materiality is susceptible to common proof.

In sum, the Court concludes that individual issues predominate over common issues. The element of predominance is not satisfied because Plaintiffs have not shown that they are entitled to a class-wide presumption of materiality, and thus, cannot establish reliance or causation with common proof. Without a market survey documenting consumer preferences, Plaintiffs have not shown that the "five hour energy" representation is material to consumers as compared to other factors, including the positioning of the product at the retail location, the product's value as an alternative to coffee, and the relatively small size of the bottle. Plaintiffs also have not shown that there is a prevalent definition of "energy" in the market. Without such evidence, Plaintiffs cannot show an entitlement to a class-wide **[*25]** presumption of materiality.

Although Plaintiffs' motion to certify a class under *Rule 23(b)(3)* fails on these grounds alone, there are additional predominance problems with Plaintiffs' proposed damages model that the Court turns to now.

ii. Damages

To satisfy *Rule 23(b)(3)*, plaintiffs must show that "damages are capable of measurement on a classwide basis." Comcast, 133 S. Ct. at 1433. Under *Comcast*, Plaintiffs must additionally show that their proposed damages models match their theory of liability in the case. *Id.* ("[A] model purporting to serve as evidence of damages in this class action must measure only those damages attributable to that theory. If the model does

not even attempt to do that, it cannot possibly establish that damages are susceptible of measurement across the entire class for purposes of *Rule 23(b)(3)*."). The Ninth Circuit rule that damage calculations do not defeat certification does not relieve Plaintiffs of the requirement of putting forth a damages model that ties the theory of liability to damages. *See* *Lindell v. Synthes USA, No. 11-2053, 2014 U.S. Dist. LEXIS 27706, 2014 WL 841738, at *14 (E.D. Cal. Mar. 4, 2014)* ("So long as the damages can be determined and attributed to a plaintiff's theory of liability, damage calculations for individual class members do not defeat class certification.").

Plaintiffs offer two methods for calculating **[*26]** damages. First, Plaintiffs propose a statutory damages model for the New York and Pennsylvania classes based on the statutory amounts available under New York and Pennsylvania's consumer protection laws. *See Reply* 10:3-15 & 10 n.9; *Weir Decl.*, ¶ 28. Defendants do not take issue with this statutory damages model, and for this reason, it is not discussed further here. *See id.* The second damages model proposes to calculate damages in California, Missouri, New Jersey, and New Mexico based on Colin Weir's theory that 5HE is "underfilled" with caloric energy. Because this second damages model is divorced from Plaintiffs' theory of liability, the Court concludes that this second damages model does not satisfy *Comcast* and is further reason why Plaintiffs' motion to certify the California, Missouri, New Jersey, and New Mexico classes fail predominance.

Weir's underfilled theory calculates damages in two steps. First, Plaintiffs' expert, Ronaldson, estimates the amount of caloric energy in 5HE and concludes that 5HE's four calories provide as much as 3.7 minutes of caloric energy. *See Weir Decl.*, ¶¶ 8, 11. With this estimate, Weir divides the 3.7 minute estimate of actual caloric energy by the **[*27]** five hours of allegedly promised caloric energy. *Id.* ¶ 12. From these calculations, Plaintiffs estimate that each bottle of 5HE is only 1.3 percent filled (3.7 minutes divided by 300 minutes) or 98.7 percent underfilled. *Id.* To account for the "value" received from the other ingredients in 5HE, such as caffeine, folic acid, B6, and sucralose, Weir adjusts the "underfilled" amount by the cost of these other ingredients. *Id.* ¶ 29. Weir, for example, estimates that the cost of 200 mgs of caffeine in each bottle of 5HE is $0.00269. *Weir Decl.*, Tbl. 2. Based on these calculations, Weir estimates that damages in this case will total $1.436 billion. *Id.* ¶ 27.

The proper measure of damages in a consumer class action case is typically restitution. *See, e.g., Colgan v. Leatherman Tool Grp., Inc., 135 Cal. App. 4th 663, 694, 38 Cal. Rptr. 3d 36 (2006)*. Restitutionary relief is an equitable remedy, and its purpose is "to restore the status quo by returning to the plaintiff funds in which he or she has an ownership interest." *Korea Supply Co. v. Lockheed Martin Corp., 29 Cal. 4th 1134, 1149, 131 Cal. Rptr. 2d 29, 63 P.3d 937 (2003)*; *see also Cortez v. Purolator Air Filtration Prods. Co., 23 Cal. 4th 163, 177, 96 Cal. Rptr. 2d 518, 999 P.2d 706 (2000)*. "The proper measure of restitution in a mislabeling case is the amount necessary to compensate the purchaser for the difference between a product as labeled and the product as received." *Colgan, 135 Cal. App. 4th at 700*. Restitution is "determined by taking the difference between the **[*28]** market price actually paid by consumers and the true market price that reflects the impact of the unlawful, unfair, or fraudulent business practices." *Brazil v. Dole Packaged Foods, LLC, No. CV 12-1831, 2014 U.S. Dist. LEXIS 74234, 2014 WL 2466559, at *15 (N.D. Cal. May 13, 2014)*; *see also* *In re NJOY, Inc. Consumer Class Action Litig., 120 F. Supp. 3d at 1118* ("The proper measure of restitution in a mislabeling case is the amount necessary to compensate the purchaser for the difference between a product as labeled and the product as received." (citing *Werdebaugh v. Blue Diamond Growers, 2014 U.S. Dist. LEXIS 71575, 2014 WL 2191901, at *2 (N.D. Cal. May 23, 2014)* (calculating damages as the price paid less the value received), class decertified, *2014 U.S. Dist. LEXIS 173789, 2014 WL 7148923 (N.D. Cal. Dec. 15, 2014)))*. This measure typically requires some understanding of the value of the goods as received by the consumer. *See* *In re ConAgra Foods, 302 F.R.D. at 578-79*.

In this case, Plaintiffs' "underfilled" model is not an adequate measure of restitution because the model does not accurately account for the value that consumers receive from 5HE, even excluding the limited value of the "caloric energy." *See Opp*. 13:26-14:5. As Defendants point out in their papers, 5HE's caffeine content alone may be sufficient to justify much of the price of 5HE, given that consumers typically pay several dollars for a cup of coffee with similar caffeine content. *Defendants' Mot. to Exclude Weir* 2:27-3:4. Yet, Plaintiffs do not account for the value of the caffeine, **[*29]** vitamins, and minerals in 5HE, or even the relative convenience of the small 5HE bottle compared to other energy supplements. Plaintiffs only account for the cost of 5HE's ingredients to the manufacturer. Defendants are correct that the "cost" of

the ingredients is not the same as the value of the ingredients to the consumer, and so this measure is not an adequate proxy consumer value or restitution. *See* Hughes v. The Ester C Co., 317 F.R.D. 333, 355-56 (E.D.N.Y. 2016).

Plaintiffs also fail to distinguish the Ninth Circuit cases that have struck down damages models in similar circumstances for failing to account for other factors that may drive consumer preferences. *See, e.g.,* Brazil, 2014 U.S. Dist. LEXIS 74234, 2014 WL 2466559, at *15-16 (finding damages model insufficient under *Comcast* because it "does not take into account 'any factors that may cause consumers to prefer [the product] . . . such as brand loyalty or quality differences'"); Algarin, 300 F.R.D. at 460 (finding damages model insufficient for failure to account for price differences attributable to "higher quality ingredients," "selection of 'flavors,'" and research and development costs). Plaintiffs' argument that they do not need to provide a "complex pricepremium damages model" is neither here nor there because, regardless of whether Plaintiffs' provide a price-premium **[*30]** model or not, they still must be able to account for consumer preferences and the relative value that consumers ascribe to different aspects of the product. *See Reply* 11:16-23.

The showing that Plaintiffs must make is well illustrated in Judge Morrow's companion opinions in *In re ConAgra Foods. See* 302 F.R.D. 537 (2014); 90 F. Supp. 3d 919 (2015). There, the court did not approve of plaintiffs' damages model until plaintiffs proved that they could isolate the specific "price premium" for the term "100% Natural," as plaintiffs defined it to mean "non-GMOs." *See* 90 F. Supp. 3d at 1023. To prevail, plaintiffs had to show that consumers paid a "price premium" for an oil that was free of non-GMOs versus an oil that had GMOs. *Id.* The court ultimately approved a damages model that combined hedonic regression and conjoint analysis, and was informed by consumer surveys that established the "relative value" of certain of the product features. Id. at 1025. Plaintiffs' damages model here falls short of that approved in ConAgra Foods. Even if Plaintiffs' are correct that caloric energy is the dominant definition of "energy," Plaintiffs must account for the value of other features of 5HE if they are to isolate the specific premium paid for five hours of **[*31]** caloric energy. Without consumer surveys ascribing a relative value to each of 5HE's features, it is hard to see how Plaintiffs will do this here.

Judge Walter's recent approval of the underfilled theory in *Martin v. Monsanto Co.*, EDCV 16-2168 JFW (SPx), Dkt. # 51, does not convince the Court that such a theory is appropriate here, given *Martin*'s distinguishable facts and theory of liability. In *Martin*, plaintiffs alleged that Monsanto sold RoundUp Concentrates that did not make the number of gallons of solution promised when following the instructions on the back label. *Id.* at 10. There, the underfilled theory was appropriate because plaintiffs alleged that Monsanto sold them less RoundUp than they promised. *See id.* at 9-11. Here, Plaintiffs' theory is distinguishable because Plaintiffs do not allege that they received less 5HE than expected; rather, they allege that 5HE did not perform as expected, or that the ingredients were deficient. When the performance of a product is at issue, the calculation of value is not as simple as when the product is underfilled because, with a performance issue, the plaintiff must account not only for how the product actually performed but also whether the consumer valued **[*32]** other aspects of the product. In contrast, when the issue is only how much of the product the consumer received, few would contest that the consumer received no value from the product that they did not get. In this way, Plaintiffs' attempt to analogize to *Martin* is overly simplistic and ultimately unconvincing.

In sum, the Court is not convinced that the damages model proposed in this case adequately matches Plaintiffs' theory of liability. The Court finds the deficit in Plaintiffs' damages model an additional ground for denying class certification, at least as it applies to the proposed classes in California, Missouri, New Jersey, and New Mexico, where statutory damages are not available.

III. Conclusion

Plaintiffs have failed to demonstrate that common issues predominate over individual inquiries, and so class certification is not appropriate under *Rule 23(b)(3)*.

IT IS SO ORDERED.

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In re Subpoenas to Global Music Rights

United States District Court for the Central District of California

January 18, 2019, Decided; January 18, 2019, Filed

MC 18-0170 TJH (ASx)

Reporter
2019 U.S. Dist. LEXIS 235809 *

In re Subpoenas to Global Music Rights, et al.

Core Terms

subpoena, licenses, documents, Radio, court proceedings, protective order, motion to quash, iHeart, provisionally, repertory, contends

Counsel: **[*1]** Attorneys for Plaintiff: David Marroso.

Attorneys for Third Party: Andrew Michael Gass.

Judges: Alka Sagar, United States Magistrate Judge.

Opinion by: Alka Sagar

Opinion

CIVIL MINUTES — GENERAL

Proceedings (In Chambers): Order GRANTING-IN-PART Plaintiffs' Motion to Quash (Docket Entry Nos. 1, 2, 23, 24)

On December 10, 2018, the parties filed a joint stipulation ("Joint Stip.") regarding Plaintiffs Global Music Rights, LLC ("GMR"), Azoff Music Management, LLC, and Azoff MSG Entertainment, LLC's Motion to Quash ("Motion"). (Dkt. Nos. 1, 2). On December 21, 2018, Plaintiffs filed a supplemental memorandum in support of their Motion (Dkt. No. 23), and Respondent Radio Music License Committee ("RMLC") filed a supplemental memorandum in support of its opposition to the Motion. (Dkt. No. 24). On January 8, 2019, the Court held a hearing on the Motion. (Dkt. Nos. 26, 30).

A. Background

The Motion seeks to quash nonparty subpoenas issued on November 1, 2018, in connection with RMLC's rate court proceeding against Broadcast Music Inc. ("BMI") pending in the Southern District of New York, Radio Music License Comm., Inc. v. Broad. Music, Inc., No. 18-4420 ("Rate Court Proceeding").[1] (Dkt. No. 2-2 (Marroso Decl.) at ¶ 11 & Exs. 1-3 **[*2]** ("Subpoenas"). GMR is a "boutique" performing rights organization ("PRO") with fewer than

[1] Because the Subpoenas seek compliance in this district, the Motion is properly before this Court. *Fed. R. Civ. P. 45(d)(3)(A)*. Finding no "exceptional circumstances," the Court declines RMLC's request to transfer the Motion to the Southern District of New York pursuant to *Rule 45(f)*. (See Joint Stip. at 32-38).

100 members and a repertory of approximately 30,000 compositions.[2] (Joint Stip. at 1). RMLC represents approximately 8,000 member radio stations. (Joint Stip. at 7).[3]

In the Rate Court Proceeding, RMLC has petitioned the court to determine a reasonable fee for a license between BMI and RMLC's member radio stations. (Joint Stip. at 7 n.4). In response to a subpoena from BMI, GMR provisionally agreed to produce four documents: GMR's licenses with two RMLC members, iHeart Radio and Townsquare Media, who have entered long-term agreements with GMR, a communication between GMR and iHeart Radio, and a list of the compositions in the GMR repertory as of November 2016. (Joint Stip. at 8; Marroso Decl. Ex. 4; Dkt. No. 30 ("Hr'g Tr.") at 27). The instant Subpoenas request these documents, along with other information that RMLC contends is necessary to "effectively litigate its dispute with BMI." (Id. at 3).

In separate lawsuits, RMLC filed an antitrust case against GMR in the Eastern District of Pennsylvania, Radio Music License Comm., Inc. v. Global Music Rights, LLC, No. 16-6076, and GMR sued RMLC in **[*3]** the Central District of California for fixing license fees below competitive levels and for orchestrating a boycott of GMR licenses, Global Music Rights, LLC v. Radio Music License Comm., Inc., No. 16-9051. In the Pennsylvania matter, a motion to dismiss is pending and discovery has not commenced. (Joint Stip. at 6-7). In the California matter, the action is stayed pending the Pennsylvania court's ruling on the motion to dismiss. (Id. at 7). The same law firm represents RMLC in all three cases. (Marroso Decl. ¶ 6).

B. Motion to Quash

GMR contends that the Subpoenas seek highly confidential and competitively sensitive material and subject it to an undue burden. (Joint Stip. at 9-29). While GMR has provisionally agreed to produce four documents to both BMI and RMLC, it contends that the existing protective order is not sufficient to protect it from harm. (Id. at 26-27).

Rule 45(d)(3) sets forth the bases for a court to quash or modify a nonparty subpoena. In particular, as applies here, the court "must quash or modify a subpoena that . . . subjects a person to undue burden." *Fed. R. Civ. P. 45(d)(3)(A)(iii)* (emphasis added). "An evaluation of undue burden requires the court to weigh the burden to the subpoenaed party against the value of the information **[*4]** to the serving party." *Travelers Indem. Co. v. Metro. Life Ins. Co., 228 F.R.D. 111, 113 (D. Conn. 2005)*. "Although irrelevance is not among the litany of enumerated reasons for quashing a subpoena found in *Rule 45*, courts have incorporated relevance as a factor when determining motions to quash a subpoena." *Moon v. SCP Pool Corp., 232 F.R.D. 633, 637 (C.D. Cal. 2005)*. Whether a subpoena imposes an "undue burden" depends upon "such factors as relevance, the need of the party for the documents, the breadth of the document request, the time period covered by it, the particularity with which the documents are described and the burden imposed." *United States v. Int'l Bus. Machines Corp., 83 F.R.D. 97, 104 (S.D.N.Y. 1979)*.

In the Rate Court Proceeding, BMI bears the burden to demonstrate that the two license agreements between RMLC members and GMR are reasonable benchmarks. *United States v. Broad. Music, Inc., 316 F.3d 189, 194 (2d Cir. 2003)* ("The consent decree itself stipulates that in any rate proceeding, BMI shall have the burden of proof to establish the reasonableness of the fee requested by it.") (citation and alterations omitted). Thus, because RMLC

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[2] In contrast, BMI, which is also a PRO, has 800,000 affiliates and a repertory of 13 million compositions. (Joint Stip. at 6).

[3] Given their substantial size, the two largest PROs, BMI and the American Society of Composers, Authors, and Publishers ("ASCAP"), have for decades been subject to a consent decree with the Department of Justice. See *United States v. Broad. Music, Inc., 426 F.3d 91, 93 (2d Cir. 2005)*. Among other provisions, the consent decrees provide a procedure whereby ASCAP, BMI, or their prospective licensees may petition a designated "rate court" in the Southern District of New York for the determination of a reasonable license fee. See id. "A rate court's determination of the fair market value of the music is often facilitated by the use of benchmarks—agreements reached after arms' length negotiation between other similar parties in the industry." *Id. at 94*.

does not have the burden of proof, any information outside the ambit of the documents that GMR has agreed to produced to BMI would have limited relevance in the Rate Court Proceeding.

RMLC contends that it needs additional information to rebut BMI's contention that GMR's license agreements with iHeart Radio and Townsquare **[*5]** Media are reasonable "benchmarks" for determining a reasonable fee between BMI and RMLC's members. (Joint Stip. at 3-4). RMLC, however, does not explain why it cannot get much of this information from its own members, especially iHeart Radio and Townsquare Media. (See generally Hr'g Tr. 8-11). "There is simply no reason to burden nonparties when the documents sought are in possession of the party [plaintiff]." *Nidec Corp. v. Victor Co. of Japan, 249 F.R.D. 575, 577 (N.D. Cal. 2007)*; see *Moon, 232 F.R.D. at 637-38* (documents pertaining to defendant could more easily and inexpensively be obtained from defendant than nonparty); *Khosroabadi v. Mazgani Soc. Servs., Inc., No. 17 CV 0644, 2018 U.S. Dist. LEXIS 237433, 2018 WL 1858153, at *8 (C.D. Cal. Mar. 1, 2018)* ("information that can be obtained from a party should not be sought from third parties"). At the January 8, 2019 hearing, RMLC asserted that it critically needs two categories of evidence: the universe of songs GMR has in its repertory, which GMR has agreed to produce to BMI, and "how GMR . . . extrapolates from the number of songs that it licenses and the particular songs it licenses to some concept of spin share or market share." (Hr'g Tr. 14). Given GMR's intent to produce a list of the songs in its repertory, which is also available on GMR's website, RMLC can employ its own expert economic analyses to determine spin rates and market share.

A court is also **[*6]** permitted to quash or modify a *Rule 45* subpoena if the subpoena requires "disclosing a trade secret or other confidential research, development, or commercial information." *Fed. R. Civ. P. 45(d)(3)(B)(i)*. However, if the serving party "shows a substantial need for the . . . material that cannot be otherwise met without undue hardship," the court may order production of the confidential material "under specified conditions." *Fed. R. Civ. P. 45(d)(3)(C)(i)*. The Court finds that GMR has made a credible showing that much of the information requested in the Subpoenas involves confidential and competitively sensitive material. (Joint Stip. at 9-12). Further, RMLC has not demonstrated a "substantial need" for the requested information. As discussed above, other than the documents that GMR has provisionally agreed to produce, the requested information is of limited relevance and RMLC has not demonstrated that the information is unavailable elsewhere.

C. Protective Order

While GMR has provisionally agreed to produce four documents, as described above, it contends that the protective order entered in the Rate Court Proceeding will not protect it from "undue prejudice" in the Pennsylvania and California antitrust cases. (Joint Stip. at 26-27). Specifically, GMR **[*7]** is concerned that any information produced in the instant case will be shared with RMLC attorneys in the antitrust cases. (Id. at 27). After discussing the issue at the January 8, 2019 hearing, the parties agreed to the Court's proposed "tweaks" to the existing protective order that would satisfy GMR's concerns. (Hr'g Tr. 27-29). The parties shall make a good faith effort to revise promptly the protective order in line with the procedures agreed to at the hearing.

D. Conclusion

The Motion to Quash is **DENIED** as to the four documents that GMR provisionally agreed to produce to BMI: GMR's licenses with iHeart Radio and Townsquare Media, a communication between GMR and iHeart Radio, and a list of the compositions in the GMR repertory as of November 2016. GMR shall produce these four documents within seven days of the revised protective order being entered into effect. As to all other information requested in the Subpoenas, the Motion to Quash is **GRANTED** without prejudice to RMLC seeking an order to compel if (1) subsequent orders in the Rate Court Proceeding demonstrate their relevance, and (2) RMLC demonstrates that the information cannot be discovered from a party or a party's expert.

IT IS SO ORDERED. **[*8]**

End of Document

In re Subpoena to Kingswood Cap. Mgmt., L.P.

United States District Court for the Central District of California

December 16, 2024, Decided; December 16, 2024, Filed

2:24-mc-0102-JLS-PVC

Reporter
2024 U.S. Dist. LEXIS 240253 *; 2024 LX 129675; 2024 WL 5423804

In re Subpoena to Kingswood Capital Management, L.P.

Core Terms

discovery, subpoena, nonparty, undue burden

Counsel: **[*1]** For Kingswood Capital Management L.P., Movant: Jason David Strabo, McDermott Will and Emery LLP, Los Angeles, CA; Preny Sarkissian, McDermott Will and Emery, Los Angeles, CA.

For R.L. Mlazgar Associates Inc., Plaintiff: Devin E Murtaugh, Murtaugh Treglia Stern and Deily LLP, Irvine, CA; Samuel A. Meshbesher, PRO HAC VICE, DroeLPLLC, Minneapolis, MN; Houston M. Droel, PRO HAC VICE, Droel PC, Minneapolis, MN.

For Progress Lighting Inc., Defendant: Ryan E. Cosgrove, Nelson Mullins Riley and Scarborough LLP, Torrance, CA.

Judges: Pedro V. Castillo, United States Magistrate Judge.

Opinion by: Pedro V. Castillo

Opinion

CIVIL MINUTES — GENERAL

PROCEEDINGS: [IN CHAMBERS] ORDER DENYING PLAINTIFF'S MOTION TO COMPEL (Dkt. No. 16)

In the underlying dispute in the District of South Carolina, R. L. Mlazgar Associates, Inc. (Plaintiff) sued HLI Solutions, Inc., Litecontrol Corporation, and Progress Lighting, Inc. (Defendants) for breach of sales representation agreements, trade secret appropriation, and tortious interference. *See R L Mlazgar Associates Inc v. HLI Solutions Inc et al*, No. 6:22-cv-4729-JDA (D.S.C. filed Dec. 30, 2022) (*Mlazgar*). Two years after the lawsuit was filed, Kingswood Capital Management, L.P. (Movant) acquired Progress. Discovery closes on February 24, 2025, but "[t]he parties may, with the consent of all counsel, **[*2]** conduct discovery up to the time of trial, provided the deadlines in [the Scheduling] Order are not affected." (*Mlazgar* Dkt. No. 91).

The current dispute centers around a *Rule 45* subpoena issued by Mlazgar to Kingswood. ("Subpoena," Dkt. 1-2 at 9-11). The Subpoena seeks information related to risk assessments, escrow agreements, and other communications regarding the impact of the *Mlazgar* litigation on Progress's valuation. In August 2024, Kingswood filed a Motion to Quash (Dkt. No. 1) and Progress filed a Motion for Protective Order (Dkt. No. 2), both arguing that the information sought by the Subpoena is irrelevant, burdensome, and confidential. At the parties' request, the Court conducted an informal telephonic discovery conference on October 25, 2024, regarding Kingswood's compliance with the *Rule 45* Subpoena. (Dkt. No. 14). On November 15, 2024, after the parties failed to resolve

their disputes, Mlazgar filed a Motion to Compel (Dkt. No. 16), along with a Joint Stipulation describing the parties' arguments (Dkt. No. 17). On November 26, the parties filed supplemental memoranda in support of their positions. (Dkt. Nos. 18, 19).

On December 10, the Court held an in-person hearing on the Motion. **[*3]** For the reasons given below and at the hearing, Plaintiff's Motion to Compel is **DENIED**.

Federal Rule of Civil Procedure 26(b)(1), as amended on December 1, 2015, provides:

> Parties may obtain discovery regarding any nonprivileged matter that is relevant to any party's claim or defense and proportional to the needs of the case, considering the importance of the issues at stake in the action, the amount in controversy, the parties' relative access to relevant information, the parties' resources, the importance of the discovery in resolving the issues, and whether the burden or expense of the proposed discovery outweighs its likely benefit. Information within this scope of discovery need not be admissible in evidence to be discoverable.

Fed. R. Civ. P. 26(b)(1).

Evidence is relevant if "it has any tendency to make a fact more or less probable than it would be without the evidence, and the fact is of consequence in determining the action." *Fed. R. Evid. 401*. "The relevance standard is commonly recognized as one that is necessarily broad in scope in order to encompass any matter that bears on, or that reasonably could lead to other matter that could bear on, any issue that is or may be in the case." *Raya v. Barka, 2022 U.S. Dist. LEXIS 41230, 2022 WL 686460, at *4 (S.D. Cal. Mar. 8, 2022)* (citation omitted); *see Sci. Games Corp. v. AGS LLC, 2017 U.S. Dist. LEXIS 109488, 2017 WL 3013251, at *2 (D. Nev. July 13, 2017)* ("Even after the 2015 amendments, courts continue **[*4]** to recognize that discovery relevance remains 'broad' in scope."). "The proportionality inquiry [in *Rule 26(b)(1)*] focuses, at bottom, on analyzing the marginal utility of the discovery being sought." *V5 Techs. v. Switch, Ltd., 334 F.R.D. 306, 314 (D. Nev. 2019)* (citation omitted). Where a nonparty possesses potentially relevant information, the party seeking discovery may obtain a subpoena for the evidence pursuant to *Rule 45*. "Generally, the scope of material obtainable by a *Rule 45* subpoena is as broad as permitted under the discovery rules, and a motion to quash a subpoena is reviewed in light of the standards of *Rule 26(b)*." *Phase II Chin, LLC v. F. Shops*, LLC, 2010 WL 11636215, at *2 (D. Nev. Feb. 5, 2010)) (citing *Gonzales v. Google, Inc., 234 F.R.D. 674, 679 (N.D. Cal. 2006)*).

While the scope of permissible discovery may be broad, because discovery must be both relevant and proportional to the needs of the case, the right to discovery, even plainly relevant discovery, is not limitless. The 2015 amendments to *Rule 26* "were designed to protect against over-discovery and to emphasize judicial management of the discovery process, especially for those cases in which the parties do not themselves effectively manage discovery." *Noble Roman's, Inc. v. Hattenhauer Distrib. Co., 314 F.R.D. 304, 308 (S.D. Ind. 2016)*; *see Davita HealthCare Partners, Inc. v. United States, 125 Fed. Cl. 394, 398 n.3 (2016)* (the 2015 amendments to the Federal Rules "contribute to the overall goal of regulating the time and expense of litigation"). "Upon a motion to compel discovery, the movant has the initial burden **[*5]** of demonstrating relevance. In turn, the party opposing discovery has the burden of showing that discovery should not be allowed, and also has the burden of clarifying, explaining and supporting its objections with competent evidence." *United States v. McGraw-Hill Cos., 2014 U.S. Dist. LEXIS 59425, 2014 WL 1647385, at *8 (C.D. Cal. Apr. 15, 2014)* (citations omitted); *see DIRECTV, Inc. v. Trone, 209 F.R.D. 455, 458 (C.D. Cal. 2002)* ("The party who resists discovery has the burden to show that discovery should not be allowed, and has the burden of clarifying, explaining, and supporting its objections.").

"In addition to the discovery standards under *Rule 26* that are incorporated by *Rule 45*, *Rule 45* itself provides that 'on timely motion, the court for the district where compliance is required must quash or modify a subpoena that ... subjects a person to undue burden.'" *In re Subpoena of DJO, LLC, 295 F.R.D. 494, 497 (S.D. Cal. 2014)* (quoting *Fed. R. Civ. P. 45(d)(3)(A)(iv)*). In determining whether a subpoena poses an undue burden, courts "weigh the value of the information to the propounding party against the burden imposed on the recipient." *Mi Familia Vota v. Hobbs, 343 F.R.D. 71, 96 n.22 (D. Ariz. 2022)*. "[C]oncern for the unwanted burden thrust upon non-parties is a factor entitled to special weight in evaluating the balance of competing needs" in a *Rule 45* inquiry. *Cusumano v.*

Microsoft Corp., 162 F.3d 708, 717 (1st Cir. 1998); *see also* Dart Industries Co., Inc. v. Westwood Chemical Co., 649 F.2d 646, 649 (9th Cir. 1980) ("While discovery is a valuable right and should not be unnecessarily restricted, the 'necessary' restriction may be broader when a non-party is the target of **[*6]** discovery.") (citation omitted). Of course, "if the sought-after documents are not relevant[,] ... then any burden whatsoever imposed would be by definition 'undue.'" Compaq Computer Corp. v. Packard Bell Elec., Inc., 163 F.R.D. 329, 335-36 (N.D. Cal. 1995); *see also* Soc. Ranger, LLC v. Facebook, Inc., 2016 U.S. Dist. LEXIS 203547, 2016 WL 11741634, at *2 (N.D. Cal. Nov. 4, 2016) ("[W]hen a subpoena seeks information that is not relevant, or otherwise not properly discoverable, then the burden it imposes, however slight, is necessarily undue: why require a party to produce information the requesting party has no right to obtain?") (citation omitted).

Here, the Court finds that the information sought by the Subpoena is not relevant to the claims asserted in the underlying *Mlazgar* lawsuit. Mlazgar argues that it needs the information to "demonstat[e] its damages." (Dkt. No. 17 at 9; *see id.* at 10-13). At the hearing, Mlazgar asserted that the information would be of assistance to its expert in calculating Plaintiff's damages. But Kingswood's risk assessment of the pending *Mlazgar* lawsuit when it acquired Progress—more than two years after the conduct giving rise to the lawsuit—would not be helpful to a damages expert. Instead, the expert needs information directly obtainable from Defendants in order to credibly opine on Plaintiff's damages. The expert cannot shortcut its own analysis **[*7]** by relying on a nonparty's risk assessment.

Moreover, even if the information sought by the Subpoena was relevant—which the Court explicitly finds it is not—it would subject the nonparty Movant to undue burden. Request Nos. 1, 2, 4, 5, and 8 seek information that was either provided by one of the Defendants to Kingswood or exchanged between Kingswood and the Defendants. (Subpoena at 3). In determining whether the Subpoena should be enforced, the Court is guided not only by Rule 45, which requires the issuing party to "take reasonable steps to avoid imposing undue burden or expense" on a nonparty, Fed. R. Civ. P. 45(d)(1), but also *Rule 26*, which provides that a court may limit discovery if "the discovery sought ... can be obtained from some other source that is more convenient, less burdensome, or less expensive" or if "the burden or expense of the proposed discovery outweighs its likely benefit," *Fed. R. Civ. P. 26(b)(1), (b)(2)(C)(i)*. Thus, "[t]here is simply no reason to burden nonparties when the documents sought are in possession of the party defendant." Nidec Corp. v. Victor Co. of Japan, 249 F.R.D. 575, 577 (N.D. Cal. 2007). Neither in its briefs nor at the hearings has Mlazgar satisfactorily explained why it has not—or could not—obtain this information from the Defendants. Indeed, since Mlazgar has acknowledged that it **[*8]** has not attempted to obtain this information from Defendants, there is no reason to burden Kingswood at this time. *See* Moon v. SCP Pool Corp., 232 F.R.D. 633, 638 (C.D. Cal. 2005) ("Since plaintiffs have not shown they have attempted to obtain these documents from defendant, the Court finds that, at this time, requiring nonparty KSA to produce these documents is an undue burden on nonparty KSA."). Request Nos. 6 and 7 are overly broad and disproportionate to the needs of the case.

For these reasons, as well as those stated at the hearing, Mlazgar's Motion to Compel (Dkt. No. 16) is **DENIED**.[1] Kingswood's Motion to Quash the Subpoena (Dkt. No. 1) and Progress's Motion for Protective Order (Dkt. No. 2) are **GRANTED**.

IT IS SO ORDERED.

End of Document

[1] As the Motion to Compel is DENIED, the request by Plaintiff for attorneys' fees related to the Motion is also DENIED.

Lombana v. Green Tree Servicing, LLC

United States District Court for the Central District of California

January 12, 2016, Decided; January 12, 2016, Filed

LA CV 14-8330 JCG

Reporter
2016 U.S. Dist. LEXIS 187611 *

Fanny Lucia Lombana v. Green Tree Servicing, LLC

Prior History: *Lombana v. Green Tree Servicing, LLC, 2015 U.S. Dist. LEXIS 192732 (C.D. Cal., Feb. 18, 2015)*

Core Terms

discovery, Sanctions, parties, represents, responses, VACATES, Reply, court order, practitioner, conferred, deadline, reminds, solo

Counsel: **[*1]** For Fanny Lucia Lombana, Plaintiff: Janet A Lawson, Janet A Lawson Law Offices, Ventura, CA.

For Green Tree Servicing, LLC, Defendant: Matthew J Esposito, Severson & Werson, Irvine, CA.

Judges: Jay C. Gandhi, United States Magistrate Judge.

Opinion by: Jay C. Gandhi

Opinion

CIVIL MINUTES - GENERAL

Proceedings: (IN CHAMBERS) ORDER DENYING DEFENDANT'S MOTION TO COMPEL AND REQUEST FOR SANCTIONS, AND VACATING HEARING

On December 8, 2015, defendant Green Tree Servicing, LLC ("Defendant") filed a motion to compel discovery responses ("Compel Motion") from plaintiff Fanny Lucia Lombana ("Plaintiff"). [Dkt. No. 35.] Therein. Defendant represents that it served interrogatories and requests for production (collectively, "Discovery Requests") on Plaintiff in September 2015, and that, as of the Motion's filing date. Plaintiff had failed to provide any substantive response. (Mot. at 2.) Accordingly, Defendant sought an order compelling Plaintiff to respond to the Discovery Requests. (*Id.* at 4.) Defendant also seeks sanctions in the amount of $1,575.00 ("Sanctions Request"). (*Id.*)

On January 4, 2016, the Court received Plaintiff's "Response to Motion to Compel — Declaration of Janet A. Lawson" ("Declaration"). [Dkt. No. 37.] Therein. **[*2]** Plaintiff's counsel, Ms. Janet Lawson, represents that she is a "solo practitioner" who became "overwhelmed with [her] work load" in late 2015, and who "was working as hard as [she] could to catch up on all of [her] files." (Decl. at 1-2.) Ms. Lawson further represents that she had "completed the discovery responses" and "produc[ed] electronically the documents requested." (*Id.* at 2.)

On January 6, 2016. Defendant filed a reply in further support of its Motion ("Reply"). [Dkt. No. 38.] Therein, Defendant represented that, in light of Plaintiff's January production and "[a]s a show of good faith," Defendant was

"willing to withdraw its request that the Court order Plaintiff to provide responses."[1] (Reply at 2.) However, Defendant "vehemently reaffirm[ed]" its Sanctions Request. (*Id.* at 3.)

As a general matter, a solo practitioner's "busy practice" does not excuse her from abiding by case deadlines. *Cf., e.g.*, *Everest Nat'l Ins. v. Valley Flooring Specialities, 2009 U.S. Dist. LEXIS 44442, 2009 WL 1530169, at *3 (E.D. Cal. May 27, 2009)*. And, notably, Ms. Lawson missed an earlier deadline in this case, when her staff purportedly miscalendared a hearing date. [*See* Dkt. No. 21 at 2.]

However, as a rule, discovery does not commence until the parties have met and conferred pursuant to *Rule 26(f) of the Federal Rules of Civil Procedure* ("Federal Rules"), unless discovery is "authorized by [the **[*3]** Federal Rules], by stipulation, or by court order." *Fed. R. Civ. P. 26(d)(1)*. Here, the record does not reflect that the parties met and conferred concerning a discovery plan before Defendant served its Discovery Requests, thus rendering the Discovery Requests premature.[2] *See id.* Under these circumstances, the Court, in its discretion, finds that an award of sanctions would be unjust. *See* *Fed. R. Civ. P. 37(a)(5)(A)(iii)*.

As such. Defendant's Sanctions Request, [Dkt. No. 35 at 4], is **DENIED**. *See id.*

Accordingly, the Court **VACATES** the hearing set for January 14, 2016. *See C.D. Cal. L.R. 7-15*.

The Scheduling Conference remains on calendar for **January 28, 2016 at 2:00 p.m.** [Dkt. No. 34.] The Court reminds both parties that "[t]he lead trial attorney for each party shall attend the Scheduling Conference unless such counsel is engaged in trial, on vacation, or excused for good cause following a written request addressed to the Clerk in advance of the Scheduling Conference." [*Id.* at 6.] The Court further reminds the parties that a Joint *Rule 26* Report "shall be filed not later than **one week before** the Scheduling Conference." [*Id.* at 2 (emphasis added).]

IT IS SO ORDERED.

End of Document

[1] As such. Defendant's Compel Motion is **DENIED AS MOOT**. (*See* Reply at 2.)

[2] While this action was pending before District Judge Olguin, the parties entered a preliminary Joint ***Rule 26*** Report. [Dkt. No. 13.] At that time, however, the parties agreed that discovery deadlines "should not be set until the case is at issue." [*Id.* at 7-8.]

McGee v. Cnty. of Riverside

United States District Court for the Central District of California

October 21, 2022, Decided; October 21, 2022, Filed

5:21-cv-01821-JVS-KES

Reporter
2022 U.S. Dist. LEXIS 193707 *

MARLO MCGEE v. COUNTY OF RIVERSIDE, et al.

Prior History: *McGee v. Cnty. of Riverside, 2022 U.S. Dist. LEXIS 54449 (C.D. Cal., Jan. 4, 2022)*

Core Terms

defense counsel, discovery, service of process, case management, status report, deadlines, custody, mailing

Counsel: **[*1]** For Whiting, Deputy, Trujillo, Deputy, Rosa, Deputy, Perry, Deputy, Martinez Larson, Lopez, Deputy, County of Riverside, Chad Bianco, Sheriff, Defendant: Bruce Emery Disenhouse, LEAD ATTORNEY, Disenhouse Law APC, Riverside, CA.

Marlo McGee, Plaintiff, Pro se, Riverside, CA.

Judges: KAREN E. SCOTT, UNITED STATES MAGISTRATE JUDGE.

Opinion by: KAREN E. SCOTT

Opinion

CIVIL MINUTES — GENERAL

PROCEEDINGS (IN CHAMBERS): Order re New Defendants Named in First Amended Complaint

Marlo McGee ("Plaintiff") is a pre-trial detainee in the custody of the Riverside County Sheriff's Office who alleges that her civil rights were violated while she was housed at the Robert Presley Detention Center.[1] The Court recently granted Plaintiff leave to file a First Amended Complaint ("FAC" at Dkt. 40), which added three new Defendants: J. Price, S. Martinez, and D. Torres. (Dkt. 39.)

Defense counsel filed a declaration stating that he is authorized to accept service of process on behalf of Defendants Price and Martinez but not Torres. (Dkt. 41, 44.) Because the FAC has been served on defense counsel electronically (Dkt. 40), Defendants Price and Martinez are hereby deemed served as of the date of this order.

As for Defendant Torres, Plaintiff is **[*2]** entitled to have service of process completed by the United States Marshal's Service, since she has been granted in forma pauperis status. (Dkt. 4); *Fed. R. Civ. P. 4(c)(3)*. District courts in this circuit generally allow plaintiffs to conduct early discovery to locate and serve defendants. See, e.g., *Picozzi v. Clark Cty. Det. Ctr., No. 15-cv-00816, 2016 U.S. Dist. LEXIS 152607 at *5-6, 2016 WL 6562941 at *2 (D.*

[1] She was recently moved to the Cois M. Byrd Detention Center. (Dkt. 42 [notice of change of address].)

Nev. Nov. 2, 2016). However, such discovery can be time consuming and complex, especially if Defendant Torres no longer works for the Riverside County Sheriff's Office and/or no longer resides in California. If a pro se plaintiff needs to seek information from non-parties, this must be done through a subpoena issued by the Clerk and approved by the Court. See generally Fed. R. Civ. P. 45(a)(3); Lynch v. Burnett, No. 18-cv-01677, 2020 U.S. Dist. LEXIS 167740 at *3, 2020 WL 5517577 at *1 (S.D. Cal. Sept. 14, 2020). Defendants have a "duty to avoid unnecessary expenses of serving the summons." Fed. R. Civ. P. 4(d)(1).

To expedite discovery related to service on Defendant Torres, defense counsel shall file a status report: (a) giving Defendant Torres's full name, and (b) providing any mailing address for Defendant Torres that is in the possession, custody, or control of the Riverside County Sheriff's Office.[2]

Additionally, Plaintiff has filed a motion (Dkt. 43) to extend the deadlines in the Case Management and Scheduling Order (Dkt. 28) by three months. It is not clear whether Defendants oppose **[*3]** the motion. In the Court's experience, it may take the United States Marshal's Office at least that long to serve Defendant Torres with process, particularly if defense counsel is unable to provide a current mailing address for him.

IT IS HEREBY ORDERED THAT:

1. **Within fourteen (14) days** of the date of this order, defense counsel shall file: (a) the status report regarding service on Defendant Torres, and (b) a stipulation or opposition to Plaintiff's motion to extend the case management deadlines (Dkt. 43).

2. **Within twenty-one (21) days** of the date of this order, Defendants Price and Martinez shall file a response to the FAC.

End of Document

[2] The Court understands that, when a plaintiff is incarcerated and a defendant is a current or former correctional employee, providing the plaintiff with the defendant's home address may give rise to security concerns. Any residential service addresses in the status report may therefore be redacted in the copy filed publicly with the Court. Defense counsel may lodge an unredacted copy with the Court by emailing it to KES_Chambers@cacd.uscourts.gov. The Court will ensure that any service address(es) are provided to the United States Marshal's Service.

Monster Energy Co. v. Vital Pharm., Inc.

United States District Court for the Central District of California

March 10, 2020, Decided; March 10, 2020, Filed

Case No. 5:18-cv-01882-JGB (SHKx)

Reporter
2020 U.S. Dist. LEXIS 87320 *

Monster Energy Co. v. Vital Pharm., Inc.

Prior History: *Monster Energy Co. v. Vital Pharms., Inc., 2018 U.S. Dist. LEXIS 223734, 2018 WL 6431870 (C.D. Cal., Nov. 30, 2018)*

Core Terms

Subpoenaed, Non-Parties, Monster, discovery, communications, documents, deposition, opposing counsel, law firm, requests, media, paralegals, employees, courts, attorney-client, parties, depose, overly broad, analyzing, firms, burdensome, motivation, privileged, harassing, products, motion to quash, defenses, discovery request, non-privileged, defendants'

Counsel: **[*1]** For Monster Energy Company, a Delaware corporation, Plaintiff: Christina Von der Ahe Rayburn, Jennifer Bunn Hayden, LEAD ATTORNEYS, Hueston Hennigan LLP, Newport Beach, CA; John C Hueston, Joseph Alan Reiter, Michael Hayes Todisco, Moez M Kaba, Steven N Feldman, Varun Behl, LEAD ATTORNEYS, Amber Elizabeth Munoz, Lauren M Johnson, Hueston Hennigan LLP, Los Angeles, CA; Sourabh Mishra, LEAD ATTORNEY, Hueston Hennigann LLP, Los Angeles, CA.

For Vital Pharmaceuticals, Inc., a Florida corporation, doing business as, VPX Sports, John H. Owoc, also known as, Jack Owoc, Defendants: Marc J Kesten, LEAD ATTORNEY, Parkland, FL; Michael D Scully, LEAD ATTORNEY, Gordon Rees Scully and Mansukhani LLP, San Diego, CA; Timothy K Branson, LEAD ATTORNEY, Gordon and Rees LLP, Los Angeles, CA; Erica W Stump, PRO HAC VICE, Erica W Stump PA, Ft Lauderdale, FL; Francis Massabki, PRO HAC VICE, Vital Pharmaceuticals Inc, Weston, FL; Holly L K Heffner, Gordon and Rees Scully Mansukhani, San Diego, CA; Justin D Lewis, Gordon Reese Scully Mansukhani LLP, San Diego, CA; Michael D Kanach, Gordon Rees Scully Mansukhani LLP, San Francisco, CA; Peter G Siachos, PRO HAC VICE, Gordon Rees Scully Mansukhani, Florham Park, **[*2]** NJ; Sean P Flynn, Gordon Rees Scully Mansukhani LLP, Irvine, CA.

Judges: Honorable Shashi H. Kewalramani, United States Magistrate Judge.

Opinion by: Shashi H. Kewalramani

Opinion

CIVIL MINUTES—GENERAL

Proceedings: ORDER GRANTING PLAINTIFF'S MOTION TO QUASH DEFENDANT'S SUBPOENA [ECF NO. 165]

The background of this case and the claims alleged in Plaintiff Monster Energy Company's ("Monster" or "Plaintiff") operative, First Amended Complaint ("FAC") are set forth in detail and incorporated into this Order from the previously issued Order (1) Denying Defendant John H. Owoc's Motion to Dismiss for Lack of Personal Jurisdiction;

(2) Granting in Part and Denying in Part Defendants' Motion to Dismiss for Failure to State Claim; and (3) Denying Defendants' Motion to Strike ("Order re: Mot. to Dismiss"). Electronic Case Filing Number ("ECF No.") 95, Order re: Mot. to Dismiss.

On or around November 8, 2019, Defendant Vital Pharmaceuticals, Inc. ("VPX" or "Defendant") served subpoenas ("Counsel Subpoenas") on Monster's former lead counsel in this case, Marc Miles ("Miles"), and his law firm, Shook, Hardy & Bacon ("Firm") (collectively, "Subpoenaed Non-Parties"). ECF No. 165-5, Rothrock Declaration ("Rothrock Decl.") at ¶ 2; ECF **[*3]** No. 165-6, Counsel Subpoenas. November 22, 2019, Subpoenaed Non-Parties served timely objections ("Joint Objections") to the Counsel Subpoenas. ECF No. 165-5, Rothrock Decl. at ¶ 3; ECF No. 165-8, Joint Objections.

On January 22, 2020, Monster filed a Motion to Quash the Counsel Subpoenas ("Motion" or "Mot."). ECF No. 165, Mot. On February 4, 2020, VPX filed a response opposing the Motion ("Opposition"), and, on February 11, 2020, Monster filed is Reply brief ("Reply"). ECF No. 168, Opposition; ECF No. 169, Reply. After reviewing the record and the parties' letters and briefs, the Court **GRANTS** Monster's Motion.

I. BACKGROUND

A. Factual And Procedural History

Monster commenced this action in September 2018 against VPX and VPX's CEO John H. Owoc (collectively "Defendants"). ECF No. 1, Compl. On April 3, 2019, Monster filed its FAC against VPX and several other defendants alleging the following claims: (1) a violation of the Lanham Act; (2) unfair competition; (3) false advertising; (4) trade libel; (5) intentional interference with contractual relations; (6) intentional interference with prospective economic advantage; (7) conversion; (8) larceny; (9) false patent marking; (10) a violation **[*4]** of the California Uniform Trade Secrets Act; (11) a violation of the Defend Trade Secrets Act; and (12) a violation of the Computer Fraud and Abuse Act. ECF No. 61, FAC. On May 20, 2019, the Court denied in part Defendants' Motion to Dismiss and concluded Monster sufficiently pleaded, among other claims, the Lanham Act, unfair competition, and false advertising claims. ECF No. 95, Order re: Mot. to Dismiss.

On November 8, 2019, VPX propounded Counsel Subpoenas on Subpoenaed Non-Parties. ECF No. 165-8, Joint Objections. The Subpoenas seek communication between Subpoenaed Non-Parties and counsel representing plaintiffs in other litigation against Defendants, including in connection with class action lawsuits filed against VPX. ECF No. 165-5, Rothrock Decl. at ¶ 5; ECF No. 165-8, Joint Objections. On November 22, 2019, pursuant to *Federal Rule of Civil Procedure ("Rule") 45(d)(2)(B)*, Subpoenaed Non-Parties filed joint objections to the Subpoenas. ECF No. 165-8, Joint Objections.

Following counsels' discussions and failure to resolve the discovery dispute, the Court held a hearing on January 13, 2020, to address the Counsel Subpoenas. ECF No. 162, Hearing Transcript ("Tr."). During the hearing, Monster and Subpoenaed Non-Parties indicated **[*5]** they would be moving to quash the Subpoenas, and the Court ordered further briefing on the issue. Id. On January 22, 2020, Monster filed the instant Motion to Quash. ECF No. 165, Mot. On February 4, 2020, VPX filed its opposition to the Motion, ECF No. 168, Opposition, and on February 11, 2020, Monster filed its Reply. ECF No. 169, Reply. The matter is ready for decision.

B. Disputed Discovery

Below are the Requests for Production ("RFP") at issue[1] in the Counsel Subpoenas and the initial responses provided by Monster:

RFP No. 2:
All Documents and Communications between You and the U.S. Food & Drug Administration related to Monster Products, regardless of date.

Response to RFP No. 2:
Non-parties object to this Request as harassing, vague, ambiguous, overly broad, assuming facts not in evidence, unreasonably cumulative and duplicative, and unlimited in time and scope. The subject matter of this request is not relevant or proportional to what the Non-parties understand are the needs of this litigation. The Non-parties also object to this Request to the extent it requests information protected by attorney-client privilege and/or attorney work product doctrine.

RFP No. 3:

All Communications between **[*6]** You and the Bursor & Fisher law firm (including any attorneys, paralegals, employees, agents or representatives) related to VPX, Owoc, or Bang®, regardless of date.

Response to RFP No. 3:
Non-parties object to this Request as harassing, vague, ambiguous, overly broad, unreasonably cumulative and duplicative, and unlimited in time and scope. The subject matter of this request is not relevant or proportional to what the Non parties understand are the needs of this litigation. Non-parties also object to this Request on the basis that the term "related to" is vague and ambiguous and, as defined, overly broad. Non-parties also object to this Request to the extent it requests information protected by attorney-client privilege, attorney work product doctrine, and/or the common interest privilege.

RFP No. 4:
All Communications between You and the Nathan & Associates law firm (including any attorneys, paralegals, employees, agents or representatives) related to VPX, Owoc, or Bang®, regardless of date.

Response to RFP No. 4:
[Identical Response as Response to RFP No. 3]

RFP No. 5:

All Communications between You and the Barbat, Mansour & Suciu law firm (including any attorneys, paralegals, employees, **[*7]** agents or representatives) related to VPX, Owoc, or Bang®, regardless of date.

Response to RFP No. 5:
[Identical Response as Response to RFP No. 3]

RFP No. 6:

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[1] RFP No. 1 sought "[a]ll Communications between You and the U.S. Food & Drug Administration related to VPX, Owoc, or Bang(R), regardless of date." ECF No. 165-8, Joint Objections at 3-11. Monster and Subpoenaed Non-Parties contend RFP No. 1 is no longer at issue. ECF No. 165 Mot. at 3 n.1. Following the in-person hearing, counsel for Subpoenaed Non-Parties confirmed that following a reasonably diligent search, no responsive documents had been located. ECF No. 165 Mot. at 3 n.1 (citing ECF No. 162, Tr. at 15:14-19; ECF No. 165-5, Rothrock Decl. ¶ 4. VPX did not directly address the contents of the individual RFPs in its Opposition but did not rebut or reject Monster and

Subpoenaed Non-Parties' conclusion about RFP No. 1. See ECF No. 168, Opposition. Accordingly, the Court will not address RFP No. 1 in the present Order. Subpoenaed Non-Parties only mention RFP No. 16 to say that it is facially overbroad and do not include any additional arguments. ECF No. 165, Mot. at 3 n.1. The objections to RFP No. 16 are included in this Order.

All Communications between You and the Kohn, Swift & Graf law firm (including any attorneys, paralegals, employees, agents or representatives) related to VPX, Owoc, or Bang®, regardless of date.

Response to RFP No. 6:
[Identical Response as Response to RFP No. 3]

RFP No. 7:
All Communications between You and the Greg Coleman law firm (including any attorneys, paralegals, employees, agents or representatives) related to VPX, Owoc, or Bang®, regardless of date.

Response to RFP No. 7:
[Identical Response as Response to RFP No. 3]

RFP No. 8:
All Communications between You and the Kercsmar & Feltus law firm (including any attorneys, paralegals, employees, agents or representatives) related to VPX, Owoc, or Bang®, regardless of date.

Response to RFP No. 8:
[Identical Response as Response to RFP No. 3]

RFP No. 9:
All Communications between You and the Alderman Law Firm (including any attorneys, paralegals, employees, agents or representatives) related to VPX, Owoc, or Bang®, regardless of date.

Response to RFP No. 9:

[Identical Response as Response to **[*8]** RFP No. 3]

RFP No. 10:
All Communications between You and the Levin Fishbein Sedran & Berman or Levin Sedran & Berman law firm (including any attorneys, paralegals, employees, agents or representatives) related to VPX, Owoc, or Bang®, regardless of date.

Response to RFP No. 10:
[Identical Response as Response to RFP No. 3]

RFP No. 11:
All Communications between You and Harke Law LLP (including any attorneys, paralegals, employees, agents or representatives) related to VPX, Owoc, or Bang®, regardless of date.

Response to RFP No. 11:
[Identical Response as Response to RFP No. 3]

RFP No. 12:
All Communications between You and the Barnow & Associates law firm (including any attorneys, paralegals, employees, agents or representatives) related to VPX, Owoc, or Bang®, regardless of date.

Response to RFP No. 12:
[Identical Response as Response to RFP No. 3]

RFP No. 13:
All Communications between You and the Lite DePalma Greenberg law firm (including any attorneys, paralegals, employees, agents or representatives) related to VPX, Owoc, or Bang®, regardless of date.

Response to RFP No. 13:

[Identical Response as Response to RFP No. 3]

RFP No. 14:

All Communications between You and any other law firm (including **[*9]** any attorneys, paralegals, employees, agents or representatives) in the United States related to VPX, Owoc, or Bang®, regardless of date. (This request excludes any firms or attorneys representing or retained by Monster.)

Response to RFP No. 14:
[Identical Response as Response to RFP No. 3]

RFP No. 15:
All Documents and Communications related to media press releases, media statements, and media interviews related to VPX, Owoc, or Bang®, regardless of date. (This request excludes Your internal firm communications, communications with Monster, and communications with other firms or attorneys representing or retained by Monster.)

Response to RFP No. 15:

Non-parties object to this Request as harassing, vague, ambiguous, overly broad, unreasonably cumulative and duplicative, and unlimited in time and scope. The subject matter of this request is not relevant or proportional to what the Non-parties understand are the needs of this litigation. Non-parties also object to this Request on the basis that the terms "media press releases," "media statements,["] "media interviews," and "related to" are vague and ambiguous and, as defined, overly broad. Non-parties also object to this Request to the extent **[*10]** it requests information protected by attorney-client privilege, attorney work product doctrine, and/or the common interest privilege.

RFP No. 16:
All Documents and Communications related to VPX, Owoc, or Bang®, regardless of date. (This request excludes Your internal firm communications, communications with Monster, and communications with other firms or attorneys representing or retained by Monster.)

Response to RFP No. 16:
Non-parties object to this Request as harassing, vague, ambiguous, overly broad, assumes facts not in evidence, unreasonably cumulative and duplicative, and unlimited in time and scope. The subject matter of this request is not relevant or proportional to what the Non-parties understand are the needs of this litigation. Non-parties also object to this Request to the extent it requests information protected by attorney-client privilege, attorney work product doctrine, and/or the common interest privilege.

ECF No. 165-8, Joint Objections at 3-11; ECF No. 165-6, Counsel Subpoenas.

II. LEGAL STANDARD

A. Requirements And Scope Of Discovery Under *Rule 26*

In *Dale Evans Parkway 2012, LLV. v. Nat'l Fire and Marine Ins. Co., ED CV 15-979-JGB (SPx), 2016 U.S. Dist. LEXIS 187094, 2016 WL 7486606, at *3-4 (C.D. Cal. Oct. 27, 2016)*, this Court provided the following applicable general scope for discovery **[*11]** under *Rule 26*:

> *Fed. R. Civ. P. 26(b)* permits "discovery regarding any nonprivileged matter that is relevant to any party's claim or defense." *Fed. R. Civ. P. 26(b)(1)*. To be relevant, the information sought "need not be admissible in evidence"; however, it must be "proportional to the needs of the case." Id. In determining the needs of the case, the court "consider[s] the importance of the issues at stake in the action, the amount in controversy, the

parties' relative access to relevant information, the parties' resources, the importance of the discovery in resolving the issues, and whether the burden or expense of the proposed discovery outweighs its likely benefit." Id. A "relevant matter" under *Rule 26(b)(1)* is any matter that "bears on, or that reasonably could lead to other matters that could bear on, any issue that is or may be in the case." *Oppenheimer Fund, Inc. v. Sanders, 437 U.S. 340, 351, 98 S. Ct. 2380, 57 L.Ed. 2d 253 (1978)*. Relevancy should be "construed 'liberally and with common sense' and discovery should be allowed unless the information sought has no conceivable bearing on the case." *Soto v. City of Concord, 162 F.R.D. 603, 610 (N.D. Cal. 1995)* (quoting *Miller v. Pancucci, 141 F.R.D. 292, 296 (C.D. Cal. 1992)*).

See also *Nguyen v. Lotus by Johnny Dung Inc., No. 8:17-cv-01317-JVS-JDE, 2019 U.S. Dist. LEXIS 122787, 2019 WL 3064479, at *1 (C.D. Cal. June 5, 2019)* (relevancy, for purposes of discovery, "has been construed broadly to encompass any matter that bears on, or that reasonably could lead to other matter that could **[*12]** bear on, any issue that is or may be in the case.") (internal citations and quotation marks omitted).

The amendments to the Federal Rules of Civil Procedure, effective December 1, 2015, emphasize that "[t]he parties and the court have a collective responsibility to consider the proportionality of all discovery and consider it in resolving discovery disputes." *Fed. R. Civ. P. 26* advisory committee note to 2015 amendment; see *Salazar v. McDonald's Corp., No. 14-CV-02096-RS (MEJ), 2016 WL 736213, at *2 (N.D. Cal. Feb. 25, 2016)* (noting there is "a shared responsibility on all the parties to consider the factors bearing on proportionality before propounding discovery requests, issuing responses and objections, or raising discovery disputes before the courts[.]"). Moreover, "*Rule 1* is amended to emphasize that just as the court should construe and administer these rules to secure the just, speedy, and inexpensive determination of every action, so the parties share the responsibility to employ the rules in the same way." *Fed. R. Civ. P. 1* advisory committee note to 2015 amendment.

Because discovery must be both relevant and proportional, the right to discovery, even plainly relevant discovery, is not limitless. See *Fed. R. Civ. P. 26(b)(1)*; *Nguyen, No. 8:17-cv-01317-JVS-JDE, 2019 U.S. Dist. LEXIS 122787, 2019 WL 3064479, at *1*. Discovery may be denied or limited where: "(i) the discovery sought is unreasonably cumulative **[*13]** or duplicative, or can be obtained from some other source that is more convenient, less burdensome, or less expensive; (ii) the party seeking discovery has had ample opportunity to obtain the information by discovery in the action; or (iii) the proposed discovery is outside the scope permitted by *Rule 26(b)(1)*." *Fed. R. Civ. P. 26(b)(2)(C)*.

"The district court enjoys broad discretion when resolving discovery disputes, which should be exercised by determining the relevance of discovery requests, assessing oppressiveness, and weighing these factors in deciding whether discovery should be compelled." *United States ex rel. Brown v. Celgene Corp., No. CV 10-3165 GHK (SS), 2015 U.S. Dist. LEXIS 189371, 2015 WL 12731923, at *2 (C.D. Cal. July 24, 2015)* (internal citations and quotation marks omitted).

B. Non-Party Discovery

1. Mechanism For Discovery: *Rule 45*

"The Federal Rules of Civil Procedure distinguish between parties and non-parties in establishing available discovery devices." *Jules Jordan Video, Inc. v. 144942 Canada, Inc., 617 F.3d 1146, 1158 (9th Cir. 2010)*.

"*Federal Rule of Civil Procedure 45* ('*Rule 45*') provides the exclusive method of discovery on non-parties." Golden v. Am. Pro Energy, EDCV 16-891-MWF (KKx), 2018 WL 1426341, at *2 (C.D. Cal. Feb. 15, 2018); *Thompson v. Gonzales, No. 1:15-CV-301-LJO-EPG, 2016 U.S. Dist. LEXIS 132673, 2016 WL 5404436, at *4 (E.D. Cal. Sept. 27, 2016)*. "[B]ecause *Rule 45* is the only discovery-related Rule that pertains to non-parties, numerous courts have held explicitly that a *Rule 45* subpoena is required to obtain discovery from a non-party." **[*14]** *Thompson, No. 1:15-CV-301-LJO-EPG, 2016 U.S. Dist. LEXIS 132673, 2016 WL 5404436, at *4*; see *Hickman v. Taylor, 329 U.S.*

495, 502-04, 67 S. Ct. 385, 91 L. Ed. 451, (1947) (holding requests for documents under party's attorney's exclusive control could only be compelled via Rule 45 subpoena); Jules Jordan, 617 F.3d at 1158 (noting non-party can only be deposed by subpoena). A non-party is subject to, and required to comply with, a valid, properly served Rule 45 subpoena. Golden, EDCV 16-891-MWF (KKx), 2018 WL 1426341, at *2 (citing Thompson, No. 1:15-CV-301-LJO-EPG, 2016 U.S. Dist. LEXIS 132673, 2016 WL 5404436, at *8 n.11).

Rule 45(d)(1) requires parties issuing a subpoena to "take reasonable steps to avoid imposing an undue burden or expense on a person subject to the subpoena." Fed. R. Civ. P. 45(d)(1); see also Fed. R. Civ. P. 45(d)(2)(B)(ii) (requiring an order on a motion to compel or for protective order to "protect a person who is neither a party nor a party's officer from significant expense resulting from compliance."). A court must quash subpoenas in a number of instances, including if the subpoena seeks disclosure of privileged or protected information. Fed. R. Civ. P. 45(d)(3)(A)(iii). A court must also quash or modify a subpoena if it "subjects a [non-party] to undue burden." Fed. R. Civ. P. 45(d)(3)(A)(iv); In re Allergan, Inc. Sec. Litig. ("Allergan"), No. 14-cv-02004-DOC (KES), 2016 U.S. Dist. LEXIS 186537, 2016 WL 5922717, at *3 (C.D. Cal. Sept. 14, 2016).

"To determine whether a subpoena imposes undue burden on the recipient, the Court must balance the relevance of information sought, the requesting party's need for the information, and the extent of the burden imposed." **[*15]** Ret. Bd. of Policemen's Annuity & Ben. Fund of City of Chicago v. Bank of N.Y. Mellon, No. 2:13-cv-04392-ODW(CWx), 2013 U.S. Dist. LEXIS 198748, 2013 WL 12139833, at *3 (C.D. Cal. Aug. 7, 2013); Allergan, No. 14-cv-02004-DOC (KES), 2016 U.S. Dist. LEXIS 186537, 2016 WL 5922717, at *3.

2. Non-Party Discovery Considerations

Although the general scope of discovery for parties and non-parties is the same, Ret. Bd. of Policemen's Annuity & Ben. Fund of City of Chicago, No. 2:13-cv-04392-ODW(CWx), 2013 U.S. Dist. LEXIS 1198748, 2013 WL 12139833, at *2, courts may consider non-party status when determining whether discovery restrictions are necessary. Dart Indus. Co. v. Westwood Chem. Co., 649 F.2d 646, 649 (9th Cir. 1980) ("'[t]here appear to be quite strong considerations indicating that discovery would be more limited to protect [non-]parties from harassment, inconvenience, or disclosure of confidential documents.'"); see also Schaaf v. SmithKline Beecham Corp., 233 F.R.D. 451, 453 (E.D. N.C. 2005) ("a court will give extra considerations to the objections of a non-party, non-fact witness in weighing burdensomeness versus relevance.") (internal quotation marks and citation omitted). Similarly, the First Circuit held that:

> Although discovery is by definition invasive, parties to a lawsuit must accept its travails as a natural concomitant of modern civil litigation. Non-parties have a different set of expectations. Accordingly, concern for the unwanted burden thrust upon non-parties is a factor entitled to special weight in evaluating the balance of competing needs. **[*16]**

Cusumano v. Microsoft Corp., 162 F.3d 708, 717 (1st Cir. 1998) (citing, inter alia, Dart Indus. Co., 649 F.2d at 649); In re Pioneer Corp., No. CV 18-4524 JAK (SSx), 2019 U.S. Dist. LEXIS 197102, 2019 WL 5401015, at *5 (C.D. Cal. Jan. 9, 2019) (quoting Cusumano).

A non-party has the right to object on relevance grounds to avoid production and courts have routinely held that "it is a generally accepted rule that standards for non[-]party discovery . . . require a stronger showing of relevance than for simple party discovery." See, e.g., Laxalt v. McClatchy, 116 F.R.D. 455, 458 (D. Nev. 1986). Finally, counsel for a party is considered a non-party for purposes of discovery. See Hickman, 329 U.S. at 504-05, (1947).

C. Compelling Discovery Involving Trial Counsel

Counsel are not automatically exempt from being subjected to a subpoena to produce documents or to testify. United Phosphorus, Ltd. v. Midland Fumigant, Inc., 164 F.R.D. 245, 247-48 (D. Kan. 1995); see also Littlefield v. Nutribullet, LLC, No. CV 16-6894 MWF (SSx), 2017 U.S. Dist. LEXIS 229420, 2017 WL 10438897, at *4 (C.D. Cal.

Nov. 7, 2017); Shelton v. Am Motors Corp., 805 F.2d 1323, 1327 (8th Cir. 1986); In re Subpoena Issued to Dennis Friedman ("Friedman"), 350 F.3d 65 (2d Cir. 2003). In fact, the federal rules explicitly contemplate that discovery of attorney material is permissible in certain circumstances. See *Fed. R. Civ. P. 26(b)(3)*; Fed. R. Civ. P. 30; see also Nat.-Immunogenics Corp. v. Newport Trial Group, No. 15 CV-02034-JVS (JCGx), 2017 U.S. Dist. LEXIS 223871, 2017 WL 10574097, at *6 (C.D. Cal. Apr. 25, 2017) ("Rule 30(b)(3) allows a 'party to depose a person by oral questions' . . . [p]erson is not defined in the Rules to exclude counsel for a party.").

"Attorneys with discoverable facts, not protected by attorney-client privilege or work product, are not exempt from being a source for discovery **[*17]** by virtue of their license to practice law or their employment by a party to represent them in litigation." United Phosphorus, Ltd., 164 F.R.D. at 248 (analyzing defendant's motion for a protective order limiting the scope of the deposition of defendant's counsel); Rainbow Investors Grp., Inc. v. Fuji Trucolor, Missouri, Inc., 168 F.R.D. 34, 36 (W.D. La. 1996) ("The deposition of an attorney may be both necessary and appropriate where the attorney may be a fact witness, such as an actor or viewer[.]") (internal quotation marks and citations omitted).

However, courts generally disfavor subjecting opposing trial counsel to discovery and recognize its potential disruptive effect on the attorney-client relationship and the adversarial process. E.g., Allergan, No. 14-cv-02004-DOC (KES), 2016 U.S. Dist. LEXIS 186537, 2016 WL 5922717, at *4; Littlefield, No. CV 16-6894 MWF (SSx), 2017 U.S. Dist. LEXIS 229420, 2017 WL 10438897, at *3; Am. Fed. Of State, Cty. & Mun. Employees (AFSCME) Council 79 v. Scott, 277 F.R.D. 474, 479 (S.D. Fla. 2011) ("Both the attorney-client privilege and the work-product doctrine are implicated when an attorney deposes his or her adversary." A client's fear that counsel may be deposed could chill a client's candor with counsel. Similarly, attorneys who fear they might eventually be deposed about their knowledge of documents or facts connected with a case "may lead attorneys to shield themselves from relevant facts, thereby resulting in less effective representation.").

1. Shelton Test v. Friedman Test For Compelling Depositions of Opposing **[*18]** Counsel

Though the subpoenas do not seek deposition testimony from opposing counsel, the reasoning is helpful in analyzing the propriety of seeking discovery from the former counsel of the opposing party.

The seminal Eighth Circuit case, Shelton v. Am Motors Corp. ("Shelton"), set out the standard for a party seeking to depose the opposing party's counsel. 805 F.2d 1323, 1327 (8th Cir. 1986). Shelton stated that the party seeking to depose opposing counsel must show that: "(1) no other means exist to obtain the information than to depose opposing counsel; (2) the information sought is relevant and nonprivileged; and (3) the information is crucial to the preparation of the case." Id.; Littlefield, No. CV 16-6894 MWF (SSx), 2017 WL 10438897, at *4.

The Friedman test considers "'all of the relevant facts and circumstances,'" including "'the need to depose the lawyer, the lawyer's role in connection with the matter on which discovery is sought and in relation to the pending litigation, the risk of encountering privilege and work-product issues, and the extent of discovery already conducted.'" Littlefield, No. CV 16-6894 MWF (SSx), 2017 U.S. Dist. LEXIS 229420, 2017 WL 10438897, at *4 (quoting Friedman, 350 F.3d at 72). "'Under this approach, the fact that a deponent is a lawyer does not automatically insulate him or her from a deposition nor automatically **[*19]** require resort to alternative discovery devices, but it is a circumstance to be considered.'" Id. (quoting Friedman, 350 F.3d at 72).

Some courts in the Central District have adopted and applied the Shelton analysis in the context of subpoenas for depositions of opposing counsel. See, e.g., LA Printex Indus., Inc. v. VF Corp., No. CV 13-0949 PSG (SSx), 2014 U.S. Dist. LEXIS 196168, 2014 WL 12587037, at *3 (C.D. Cal. Jan. 24, 2014) (applying Shelton analysis to subpoena for deposition of opposing counsel); La Asociación de Trabajadores de Lake Forest v. City of Lake Forest, No. SACV 07-250 DOC (ANx), 2008 U.S. Dist. LEXIS 139465, 2008 WL 11411715, at *6 (C.D. Cal. Feb. 28, 2008) (acknowledging Shelton as the "'leading case on attorney depositions'").

Other courts in the Central District "have either expressly or implicitly favored the Second Circuit's approach in Friedman over the stricter Shelton test" in the context of subpoenaing opposing counsel for a deposition. Littlefield,

No. CV 16-6894 MWF (SSx), 2017 U.S. Dist. LEXIS 229420, 2017 WL 10438897, at *4-5 (acknowledging the various standards courts apply but declining to decide whether Shelton or Friedman "provide the appropriate standard for attorney depositions"); see, e.g., Nat.-Immunogenics Corp. v., No. 15 CV-02034-JVS (JCGx), 2017 U.S. Dist. LEXIS 223871, 2017 WL 10574097, at *4-5, *8-9 (approving of the approach in Friedman but ultimately declining to apply either Shelton or Friedman and instead analyzing motions to quash subpoenas for deposition of opposing counsel and seeking **[*20]** a protective order under *Rule 26*); Sec'y of Labor v. Nuzon Corp, No. 8:16-cv 00363-CJC-KESx, 2018 U.S. Dist. LEXIS 131143, 2018 WL 3655396, at *1-2 (C.D. Cal. Jul. 30, 2018) (analyzing counsel depositions in the context of a motion to compel); Younger Mfg. Co. v. Kaenon, Inc., 247 F.R.D. 586, 588 (C.D. Cal. 2007) (concluding the reasoning in Friedman reasoning was more persuasive than in Shelton and denying party's motion for a protective order to prevent counsel depositions); see also Boeing Co. v. KB Yuzhnoye, No. 13-cv-00730-ABA-JWx, 2015 U.S. Dist. LEXIS 187296, 2015 WL 12803452, at *9-10 (C.D. Cal. Nov. 3, 2015) (granting defendants' motion in limine to preclude plaintiffs from presenting testimony or communications from defendants' counsel).

Others still have analyzed requests for deposition of opposing counsel under both Shelton and Friedman. See Soukhaphonh v. Hot Topic, Inc., No. CV 16-5124-DMG (AGRx), 2017 U.S. Dist. LEXIS 222685, 2017 WL 10378493, *6 (C.D. Cal. Sept. 14, 2017) (analyzing motion to compel counsel depositions and concluding party seeking deposition failed to satisfy either the Shelton or the Friedman standard); see also Villaflor v. Equifax Info., No. C-09-00329 MMC (EDL), 2010 U.S. Dist. LEXIS 83314, 2010 WL 2891627, at *2-3 (N.D. Cal. Jul. 22, 2010).

Practically speaking, the two approaches are only "slightly different." Littlefield, No. CV 16-6894 MWF (SSx), 2017 U.S. Dist. LEXIS 229420, 2017 WL 10438897, at *4, and both approaches create a "presumption against such discovery[.]" ResQNet.com, Inc. v. Lansa, Inc., No. 01 Civ.3578(RWS), 2004 U.S. Dist. LEXIS 13579, 2004 WL 1627170 at *2 (S.D.N.Y. July 21, 2004) (emphasis in original); LA Printex Indus., Inc. v., No. CV 13-0949 PSG (SSx), 2014 U.S. Dist. LEXIS 196168, 2014 WL 12587037, at *3.

2. Non-Deposition Discovery Involving Opposing Counsel

The Court could only locate a few cases analyzing non-deposition **[*21]** discovery sought from non-party opposing counsel. See, e.g., Patsy's Italian Rest., Inc. v. Banas, No. 06-cv-00729 (DLI) (RER), 2007 U.S. Dist. LEXIS 4114, 2007 WL 174131, at *2-4 (E.D.N.Y. Jan. 19, 2007) (quashing defendants' request for documents and deposition testimony relating to, among other things, "any legal matters past and pending against defendants in this action" requests because defendants failed establish the relevance of the documents and it appeared the "information may be obtained through less burdensome means"); Rygg v. Hulbert, No. C11-1827 JLR, 2008 U.S. Dist. LEXIS 139465, 2013 WL 264762, at *1 (W.D. Wash. Jan. 23, 2013) (applying Shelton test to subpoenas for opposing counsel depositions and extending the rationale to subpoenas duces tecum requesting documents from non-party opposing counsel, reasoning "[t]he document requests are the substantial equivalent of depositions for these purposes and are just as problematic as the deposition requests, and for the same reasons."); Kirzhner v. Silverstein, No. 09-cv-02828-CMA-BNB, 2011 U.S. Dist. LEXIS 40467, 2011 WL 1321750, at *1 3 (D. Colo. Apr. 5, 2011) (applying Shelton test and quashing subpoena seeking deposition and document production from non-party opposing counsel), objections to order sustained in part and overruled in part by Kirzhner v. Silverstein, 870 F. Supp. 2d 1145, 1150-51 (D. Colo. Jan. 12, 2012).

Monster and Subpoenaed Non-parties urge the Court to adopt the standard set out **[*22]** in Flotsam of Cal. Inc. v. Huntington Beach Conf. & Visitors Bureau ("Flotsam"), No. C 06-7028 MMC (MEJ), 2007 U.S. Dist. LEXIS 89269, 2007 WL 4171136, at *1 (N.D. Cal., Nov. 26, 2007). In Flotsam, a party served a subpoena on opposing party's counsel and sought "documents relating to press conferences, press releases, and other extrajudicial activities concerning th[e] litigation" that subpoenaing party claimed was "orchestrated" by counsel. Id. The court applied the three-part test from Shelton and granted the subpoenaed party's motion to quash the requests for production, holding that the party seeking production "ha[d] not demonstrate[d] that no other means exist[ed] to obtain the discovery, nor ha[d] it demonstrated its own efforts to obtain the information from other sources." Id.

In Allergan, the court appointed, discovery special master analyzed non-deposition discovery involving opposing counsel and declined to apply the Shelton or Flotsam analysis. See *Allergan, No. 14-cv-02004-DOC (KES), 2016 U.S. Dist. LEXIS 186537, 2016 WL 5922717, at *3*. In Allergan, defendants sought to compel compliance with subpoena requests issued against a non-party law firm seeking information regarding a prior, related class action lawsuit. *2016 U.S. Dist. LEXIS 186537, [WL] at *2-3*. Though encouraged by plaintiffs to apply the Shelton analysis, the special master declined, reasoning that is was "not **[*23]** at all clear that Shelton extends to other forms of discovery [such as requests for production.]" *2016 U.S. Dist. LEXIS 186537, [WL] at *3*. While acknowledging the Flotsam decision, the court noted that "other courts applying Shelton have actually encouraged the use of written discovery as a viable alternative for deposing opposing counsel" because such methods "do not involve the same dangers as an oral deposition of opposing counsel[.]" Id. (emphasis in original) (citations omitted). Finally, the special master reasoned that due to the Eighth circuit decision limiting Shelton to discovery sought "from opposing counsel regarding the case that is being actively litigated" and because the information sought involved a prior case, the Shelton framework was inapplicable. *2016 U.S. Dist. LEXIS 186537, [WL] at *4* (citing *Pamida, Inc. v. E.S. Originals, Inc., 281 F.3d 726, 730-31 (8th Cir. 2002)*). The court analyzed defendants' subpoenas under *Rule 26* and concluded that although defendants met the threshold demonstration of relevancy, the subpoenas were overly broad and granted defendant's motion to quash. *2016 U.S. Dist. LEXIS 186537, [WL] at *4-5, *9*.

The Court agrees with Monster and Subpoenaed Non-Parties that the heightened standard from *Shelton* is appropriate in this case. Depositions differ from other forms of discovery, including requests for production, but because there because there **[*24]** is present, on-going litigation, because discovery sought from opposing counsel is universally disfavored, and because the consensus among courts is to apply the heightened standard from Shelton, the Court will do so here.

III. DISCUSSION

A. Counsel Subpoenas

The Counsel Subpoenas seek communication between Subpoenaed Non-Parties and the federal government and other law firms in connection with class action lawsuits filed against VPX. ECF No. 165-5, Rothrock Decl. at ¶ 5 (listing other lawsuits against VPX). Additionally, the Counsel Subpoenas seek any information in Subpoenaed Non-Parties' possession relating to VPX or any VPX product, including news or media articles about VPX. Id.; ECF No. 165-8, Joint Objections at 3-11.

B. Arguments

1. Monster And Subpoenaed Non-Parties

Monster and Subpoenaed Non-Parties argue VPX's Counsel Subpoenas are "designed to fish for evidence supporting VPX's unsubstantiated and baseless theory that Monster's counsel conspired with class-action lawyers across the county[.]" ECF No. 165, Mot. at 2; ECF No. 169, Reply. Monster and Subpoenaed Non-Parties argue the Counsel Subpoenas seek irrelevant information, harass prior counsel, threatens the attorney-client relationship, and are **[*25]** improper under federal case law. ECF No. 165, Mot. at 2; ECF No. 165-11, Ex. 6 at 12.

Monster and Subpoenaed Non-Parties argue that that Court should apply the heightened standard from Shelton to analyze whether VPX's Subpoenas are appropriate. ECF No. 165, Mot. at 2-3; ECF No. 169, Reply at 2. Monster and Subpoenaed Non-Parties further argue that the three-part test from Shelton applies to document requests, that courts recognize that "'attempt[s] to obtain opposing counsel's documents and files [are] equally improper and may be more burdensome than merely attempting to obtain testimony,'" and have applied the three-part test to quash document requests. ECF No. 169, Reply at 3 (quoting *Kirzhner, No. 09-cv-02828-CMA-BNB, 2011 U.S. Dist. LEXIS*

*40467, 2011 WL 1321750, at *3)*. Because VPX has failed to meet this standard, Monster and Subpoenaed Non-Parties argue the Court should grant the Motion to Quash. ECF No. 165, Mot. at 3-6; ECF No. 169, Reply at 3.

Under the first *Shelton* Factor, Monster and Subpoenaed Non-Parties argue VPX carries the burden of showing that no other means exist to obtain the requested information. Thus, VPX must seek the requested discovery elsewhere before subpoenaing it from counsel. ECF No. 165, Mot. at 4. Monster and **[*26]** Subpoenaed Non-Parties argue the documents VPX seeks are in possession of others. For example, RFP No. 2 asks for documents from "the U.S. Food and Drug Administration related to Monster Products"; if these documents exist, they could be sought through a Freedom of Information Act ("FOIA") Request to the FDA. Id. (citing *5 U.S.C. § 552*). In fact, there's reason to believe VPX has already done so. Id. (citing ECF No. 165-1, Todisco Decl., Ex. 1 (VPX's CEO, defendant Jack Owoc, has repeatedly posted on social media that he possesses a "FOIA Report" produced by the United States Government about Monster Energy Drink).

Monster and Subpoenaed Non-Parties point out that RFPs 3-14 seek information from third-party law firms. At the in-court hearing, counsel for VPX admitted that VPX has already served these law firms with subpoenas in a related case, asking for the documents it seeks here. ECF No. 165, Mot. at 4 (citing ECF No. 162, Tr. at 36:15-17). Monster and Subpoenaed Non-Parties argue VPX's attempt to get documents from Monster's former counsel must therefore be rejected. ECF No. 169, Reply at 3. Finally, RFP No. 15 seeks information from media sources that should be acquired directly from those sources, **[*27]** not from Subpoenaed Non-Parties. ECF No. 165, Mot. at 5.

Under the second *Shelton* Factor, Monster and Subpoenaed Non-Parties argue that VPX cannot show that the information sought is relevant and nonprivileged. RFP No. 2 is overly broad and not limited to the time during which Monster competed with Bang and is plainly irrelevant. ECF No. 165, Mot. at 5. Further, at the in-court hearing Monster points out VPX's only justification for this request was to pursue an "unclean hands" defense, which the Court previously addressed and rejected. Id. (citing ECF No. 162, Tr. at 15:25-16:9).

Further, Monster and Subpoenaed Non-Parties contend that the information sought in RFP Nos. 3-14 is based on a faulty assumption that Subpoenaed Non-Parties had a strategic arrangement with counsel representing plaintiffs in other suits against Defendants. Id. at 6. Subpoenaed Non-Parties already responded that they have no documents that pre-date the filing of those firms' complaints. Id. (citing ECF No. 165-5, Rothrock Decl. ¶ 6). Additionally, none of the requests relate to a claim or defense and even if Subpoenaed Non-Parties were in possession of such documents, the documents would be privileged under the common **[*28]** interest doctrine. Id.; ECF No. 165-11, Ex. 6 at 3 (Subpoenaed Non-Parties stated that they conducted searches based on VPX's request, had not located relevant documents of any significance and "subject to their various objections [] believe any responsive document they have located are privileged."). Finally, the RFPs, including RFP No. 15, seek statements not tethered to any claim or defense, and VPX fails to show how the motivations of counsel are relevant to determining a party's motive for filing a case and is therefore not relevant. Id.; ECF No. 169, Reply at 3.

Under the third *Shelton* Factor, Monster and Subpoenaed Non-Parties argue that VPX cannot meet the lower threshold standard of relevancy and can certainly not show the information is crucial to the preparation of the case. ECF No. 165, Mot. at 6.

In correspondence, Monster and Subpoenaed Non-Parties indicated they would not conduct further searches or provide a privilege log until the Court address the merits of the Motion to Quash. ECF No. 165-11, Ex. 6 at 3, 8.

2. VPX's Arguments

VPX responds that the standard from Shelton and Flotsam only applies in the context of requests for depositions of opposing counsel, not in the **[*29]** context of simply requesting documents. ECF No. 168, VPX Response at 2. VPX points out that "where attorney depositions are requested, courts are concerned about the impact the potential deposition could have on the overall case and the attorney-client relationship, including the time spent on 'collateral issued raised by the attorney's testimony,' the potential for the deposition to 'detract[] from the quality of client representation,' and the 'chilling effect' that such practice will have on the truthful communications from the client to the attorney.'" ECF No. 168, VPX Response at 4. (quoting *Shelton, 805 F.2d at 1327*). The concerns underlying this

prong of the test are "inapplicable where, as here, the subpoena seeks documents, rather than deposition testimony." Id.

Secondly, VPX argues that even if the Court applies the heightened standard from Shelton and Flotsam, the subpoenas seek non-privileged, relevant information. VPX argues the information sought is relevant to VPX's defenses and that VPX has a right to discover Subpoenaed Non-Parties' communications with third parties about VPX, Bang products, and Monster's claims in this case. ECF No. 168, VPX Response at 4-5 (citing *Fed. R. Civ. P. 26(b)*). Specifically, VPX argues **[*30]** the information is relevant to VPX's exceptional case claim under *Section 35(a)* of the Lanham Act, which provides that in exceptional cases, a court may award reasonable attorney fees to the prevailing party, and for such an award of fees the court must consider the motivation of the party against whom fees are sought. Id. at 5 (internal quotation marks and citations omitted). VPX "challenges the merits of Monster's claims and the motives behind the filing of this action—issues that VPX has consistently raised since the lawsuit was filed" and VPX has maintained "both in its affirmative defenses and elsewhere, that Monster has failed to state a claim . . . [and] commence the action for the sole purpose of harassing VPX." ECF No. 168, VPX Response at 4 (citing ECF No. 123, Defs. Answer to FAC at 23, 26).

VPX also argues that Monster and Subpoenaed Non-Parties argue cannot hide behind a claim of privilege in their Motion to Quash because "the proper remedy for a claim of privilege when relevant documents are at issue is not an order quashing the requests outright, but rather, a routine privilege log" Id. at 5. That is, the Subpoenaed Non-Parties cannot shield non-privileged, relevant documents from production merely **[*31]** because some responsive documents may be privileged. Id.

Finally, VPX claims that the information is crucial to case preparation. Id. Documents evidencing Monster's and Monster's counsel's motivations for filing this action are "necessary for the survival" of VPX's exceptional case claim and unfair competition affirmative defense. ECF No. 168, VPX Response at 5 (citing *Hanover Ins. Co. v. Terra S. Corp., No. 2:18-cv-00675-KJD-EJY, 2019 U.S. Dist. LEXIS 196807, at *25 (D. Nev. Nov. 12, 2019)* (citing *Mid-Century Ins. Co. v. Wells, No. 2:12-cv-02041-GMN-VCF, 2013 U.S. Dist. LEXIS 203669, 2013 WL 12321555, at *3 (D. Nev. June 17, 2013)*). Thus, VPX argues that even if the Court applies the test from Shelton, VPX is entitled to the documents it seeks.

C. Analysis

Although Subpoenaed Non-Parties no longer represent Monster, they previously represented Monster and established a privileged, attorney-client relationship. Accordingly, for purposes of the discovery analysis, the Court does not distinguish Subpoenaed Non-Parties from current counsel, unless such distinction is necessary to the analysis. See *Villaflor, No. C-09-00329 MMC (EDL), 2010 U.S. Dist. LEXIS 83314, 2010 WL 2891627, at *2-3* (analyzing request for discovery under Shelton and Friedman standards even though non-party subpoenas sought to depose attorneys in a firm were not acting as counsel of record but who the court determined worked closely with the **[*32]** counsel of record, "are very frequently contributing to the strategy, legal research and work product in this case" and have an attorney-client relationship between plaintiffs and non-party such that the same concerns are raised as in Shelton and Friedman—granting plaintiffs' motion for a protective order).

The Court finds the conclusion of the Littlefield Court persuasive, that the two heightened standards from Shelton and Friedman, are practically identical. See *Littlefield, No. CV 16-6894 MWF (SSx), 2017 U.S. Dist. LEXIS 229420, 2017 WL 10438897, at *4*. However, as previously stated, the Court will apply the *Shelton* test to analyze whether VPX's discovery requests are appropriate or whether Subpoenaed Non-Parties' Motion to Quash should be granted. The backdrop for this analysis remains the Court's obligation to proportionally balance the relevance of discovery sought and the burden on the producing party. See *Fed. R. Civ. P. 26*; *Fed. R. Civ. P. 45*.

1. No Other Means

With regard to RFP No. 2, which seeks documents from "the U.S. Food and Drug Administration related to Monster Products," any such documents would be available through a FOIA Request to the FDA. See *5 U.S.C. § 552*. Further, as Monster and Subpoenaed Non-Parties point out, it appears Defendants have already successfully sought information **[*33]** via this mechanism. See ECF No. 165-1, Todisco Decl., Ex. 1.

As to RFP Nos. 3-14, which seek communications between Subpoenaed Non-Parties and other law firms, it is likely VPX already has in its possession most of the information sought namely information about various lawsuits against it—even absent documents showing specific coordination between legal teams. However, as to specific inter-firm communications, Monster and Subpoenaed Non-Parties' argument that VPX must first seek to obtain this information from third parties, namely the other law firms, is somewhat confusing considering that those firms would likely raise the same objections as Subpoenaed Non-Parties. Additionally, it appears, based on the hearing transcript, that VPX did seek or is seeking similar or identical information from other law firm third parties. ECF No. 162, Tr. 34:6-21, 36:15-21. Thus, VPX established its (apparently unsuccessful) attempts to obtain these communications from others and its need to subpoena these communications from Subpoenaed Non-Parties.

RFP No. 15 seeks documents and communications involving media press releases, media statements, and interviews related to VPX, Owoc, or Bang—excluding **[*34]** internal firm communications, communications with Monster, and communications with other firms or attorneys representing or retained by monster. The majority of such information is likely readily available to VPX and obtainable from a third party via web searches or media outlets or through a public records request. However, because the Court recognizes the difficulty of tracking this information down from various, known and unknown, sources would be burdensome, the Court will treat this request as relatively incapable of being obtained other than from Monster's former law firm.

Accordingly, VPX fails to demonstrate it has exhausted other means of obtaining information sought in RFP No. 2. However, as to RFP Nos. 3-14, it appears to the Court that VPX would likely encounter the same resistance from the other firms if communications between Subpoenaed Non-Parties and those firms were sought directly from the firms listed in RFP Nos. 3-14 and the information sought in RFP No. 15 is relatively difficult to obtain.

2. Relevant And Not Privileged

VPX has failed to demonstrate how its RFPs seek relevant and non-privileged information from Monster's former counsel. See ECF No. 61, FAC at 1, ¶¶ 121-28, **[*35]** 138-47; ECF No. 95, Order re: Mot. to Dismiss at 14-16; *Flotsam, No. C 06-7028 MMC (MEJ), 2007 U.S. Dist. LEXIS 89269, 2007 WL 4171136, at *1*; *Shelton, 805 F.2d at 1327*.

With regard to RFP No. 2, Monster's communications with the FDA about Monster's products, there is no demonstrated relevance to VPX's affirmative defenses or defense generally. VPX claims that such communications (along with the rest of the information sought via the Counsel Subpoenas) are relevant because VPX challenges the motives behind the filing of this action, which VPX claims are "solely for purposes of harassment and unfair competition." ECF No. 168, Opposition at 4. However, the claims in this case center on Monster's allegations that VPX engaged in unfair competition and false advertising, among other claims, as it relates to VPX's use of the term "Super Creatine." See ECF No. 95, Order re: Mot. to Dismiss. Monster's products are not at issue in this litigation, and Monster's communication with the government about Monster's products do not bear on any of the claims or defenses, including the defense of unclean hands.

Further, at the in-court hearing, VPX's only justification for this request was to pursue an "unclean hands" defense, and to which the current requested information appears to have no relation. See ECF No. 162, Tr. **[*36]** at 15:25-16:9. VPX fails to establish the requisite level of relevancy for this request. See also *Dale Evans Parkway 2012, LLV, ED CV 15-979-JGB (SPx), 2016 U.S. Dist. LEXIS 187094, 2016 WL 7486606, at *3-4*; *Fed. R. Civ. P. 26(b)*; see also *Innovation Ventures, LLC v. N2G Distrib., Inc. 763 F.3d 524, 538-39 (6th Cir. 2014)* (affirming a district court denial of a competitors' reciprocal discovery request for the formula for seller's products where none of competitors' defenses or counter claims made seller's formula relevant to their case). Although FDA

communications with Monster about Monster's products are likely public information and not privileged, VPX has still failed to demonstrate relevance.

RFP Nos. 3-14 seek communications between Subpoenaed Non-Parties and other law firms engaged in litigation with VPX. Although, in limited circumstances, opposing counsel's motivation for bringing suit may be relevant, it does not appear to be relevant in this case when weighed against the burden that this discovery request imposes on Monster. See *Hill v. MacMillan/McGraw-Hill Sch. Co., 164 F.3d 630 (9th Cir. 1998)* (concluding a plaintiff's "motivation for bringing the suit [was] irrelevant" and affirming the district court's decision to exclude evidence of press coverage at trial because "the merits of [plaintiff's] claims stand independent from her reasons for asserting them"); see also **[*37]** *Collins v. Del Taco, Inc., No. EDCV 03-128-SGL, 2005 U.S. Dist. LEXIS 40838, 2005 WL 3789357, at *3 (C.D. Cal. Feb. 24, 2005)* (stating that a plaintiff's motivations in bringing ADA suit were not relevant to the issues of the case); *Scott, 277 F.R.D. at 478-79* ("Neither does the [non-party's] knowledge or belief have any bearing on the [d]efendant's affirmative defenses. . . . Further, the document requests, which have no time limitation, are exceedingly broad and burdensome on their face. . . . The universe of information covered by these requests appears to be boundless and untethered to the claims or defenses actually at issue in the case, contrary to *Rule 26*").

In addition to being unconvinced that potential information or evidence that Monster's former counsel possibly engaged in a litigation scheme to harass VPX is relevant to VPX's defenses in this case, VPX fails to overcome the hurdle protecting privileged communications between attorneys and clients, firms coordinating under the common interest privilege, and the attorney work-product doctrine. See *La Asociación de Trabajadores de Lake Forest, No. SACV 07-250 DOC (ANx), 2008 U.S. Dist. LEXIS 139465, 2008 WL 11411715, at *6*. Though normally the burden falls on the party asserting the privilege to justify non-production, because VPX seeks communication from Monster's former counsel, VPX bears the burden to showing **[*38]** communications sought in RFP Nos. 3-14 are not privileged, and it has failed to do so here. See *Shelton, 805 F.2d at 1327*.

Finally, RFP No. 15 also does not seem tailored to seek or obtain relevant information. VPX does not offer evidence to show why or how all of Monster's former counsel's communications with the press are tied to a defense and is overbroad. See *Patsy's Italian Rest., Inc., No. 06-cv-00729 (DLI) (RER), 2007 U.S. Dist. LEXIS 4114, 2007 WL 174131, at *3-4*; *Flotsam, No. C 06-7028 MMC (MEJ), 2007 U.S. Dist. LEXIS 89269, 2007 WL 4171136, at *1*. Monster and Subpoenaed Non-Parties do acknowledge the existence of inter-firm documents relating to the media communications but assert that any internal communications involving communication to the press or law articles would qualify as attorney work product. ECF No. 162, Tr. At 39:3-16, 41:2-7. However, such information would likely be privileged as it could contain litigation strategies.

In sum, the Court is not convinced the information sought in the RFPs is relevant to VPX's defense or non-privileged such that it is discoverable. See also *United States ex rel. Brown, No. CV 10-3165 GHK (SS), 2015 U.S. Dist. LEXIS 189371, 2015 WL 12731923, at *2* ("The district court enjoys broad discretion when resolving discovery disputes[.]").

3. Crucial To Case Preparation

This factor also favors granting Monster's motion because though this information may be useful, if it exits, **[*39]** Defendants have not shown that any of this information is crucial to case preparation.

4. Undue Burden To Subpoenaed Non-Parties By Production And Proportionality

Finally, though not a step in the Flotsam/Shelton analysis, burden and proportionally are always relevant to any analysis of discovery requests, especially non-party requests. See *Fed. R. Civ. P. 26*; see also *Fed. R. Civ. P. 45*. The Court has already determined that VPX fails to meet the standard set forth in *Shelton* to justify production of documents requested in RFP Nos. 2-15. The Court turns to RFP No. 16.

RFP No. 16 seeks "[a]ll Documents and Communications related to VPX, Owoc, or Bang, regardless of date"—excluding internal firm communications, communicants with Monster, and communications with other firms or attorneys representing or retained by Monster. ECF No. 165-8, Joint Objections at 10-11; ECF No. 165-6, Counsel Subpoenas at 15.

In addition to failing to make the required showing under *Shelton*, VPX's request is overly broad and unduly burdensome. VPX suggests Subpoenaed Non-Parties should prepare a privilege log justifying its redaction or refusal to produce potentially privileged documents from Subpoenaed Non-Parties' files. Such an undertaking unreasonably burdensome and **[*40]** would unnecessarily expand the scope and cost of the litigation. See *Kirzhner, No. 09-cv-02828-CMA-BNB, 2011 U.S. Dist. LEXIS 40467, 2011 WL 1321750, at *3*. Accordingly, RFP No. 16 should be quashed. See *Fed. R. Civ. P. 45(d)(3)(A)(iv)*.

D. Conclusion

VPX has failed to show that the information sought through VPX's RFP Nos. 2-15 is relevant to this case. Further, given the focus of the Complaint on VPX's conduct, there has been no showing that the information is crucial to the preparation of this case. Additionally, RFP No. 16 is overly broad and unduly burdensome. Accordingly, Monster's Motion to Quash the Counsel Subpoenas is **GRANTED**.

IV. CONCLUSION

Monster and Subpoenaed Non-Parties' Motion is **GRANTED** and VPX's *Rule 45* Requests for Production 2-16 are **QUASHED**.

IT IS SO ORDERED

End of Document

Moon v. SCP Pool Corp.

United States District Court for the Central District of California

December 7, 2005, Decided ; December 7, 2005, Filed

Case No. CV 05-7729-NM(RCx)

Reporter
232 F.R.D. 633 *; 2005 U.S. Dist. LEXIS 39100 **; 63 Fed. R. Serv. 3d (Callaghan) 823

Joon S. Moon, et al. v. SCP Pool Corporation, et al.

Prior History: *Moon v. Scp Pool Corp., 2005 U.S. Dist. LEXIS 57460 (E.D. Mich., May 27, 2005)*

Core Terms

subpoena, nonparty, pool, moon, winter, discovery, motion to quash, subpoena duces tecum, quashing a subpoena, non-party, undue burden, laboratory, overbroad, modify, region, nos

Case Summary

Procedural Posture

Plaintiff companies had litigation pending against defendant companies in a district court in Michigan alleging breach of contract and other related claims. Plaintiffs filed a subpoena duces tecum with the court, pursuant to *Fed. R. Civ. P. 45*, to require a non-party witness located within the district to produce seven categories of documents. Defendants filed a motion to quash the subpoena.

Overview
The litigation between the parties related to an agreement that defendants had with plaintiffs for the purchase of pool covers imported from Asia and the purchase of liquid pool products for a three-year period. Plaintiffs alleged that while they had the exclusive agreements with defendants, defendants breached the agreements by purchasing products from other sources. Plaintiffs sought information from the non-party witness, one of defendants' other vendors, and requested seven categories of information from the non-party witness, including agreements, evidence of sales, and communications for a 10-year period. The court initially acknowledged that as a general rule when the non-party witness did not object to the subpoena the objections were considered to be waived. However, the court found unusual circumstances and good cause for quashing the subpoena in this matter. The subpoena was overbroad and unduly burdensome to the non-party witness and the value of the information that would be obtained was questionable. Additionally, much of the material requested could be obtained from defendants.

Outcome
The court granted defendants' request to quash the subpoena served by plaintiffs to the non-party witness.

Counsel: [1]** For John S Moon, an individual, Patterson Laboratories Inc, a Michigan corporation, Plaintiffs: Glenn R Matecun, Glenn Matecun Law Offices, Howell, MI; Marian Nicholas Nita, Consumer Legal Services, Los Angeles, CA; Michael S Thomas, Kirk and Huth, Clinton Township, MI.

For SCP Pool Corporation, Defendant: James O Miller, Jeffrey S Behar, Ford Walker Haggerty & Behar, Long Beach, CA; Larry E Powe, Stuart M Schwartz, Keller Thoma, Detroit, MI.

FOR DEFENDANTS: Tina Ivankovic Mangarpan

Judges: HON. ROSALYN M. CHAPMAN, UNITED STATES MAGISTRATE JUDGE.

Opinion by: ROSALYN M. CHAPMAN

Opinion

[*634] CIVIL MINUTES -- GENERAL

PROCEEDINGS: ORDER GRANTING DEFENDANTS' MOTION TO QUASH SUBPOENA TO KWANG SUNG AMERICA, INC.

On October 28, 2005, defendants SCP Pool Corporation and South Central Pool Supply, Inc. (collectively "defendant") filed a motion to quash the subpoena issued by plaintiffs Joon S. Moon and Patterson Laboratories, Inc. ("plaintiffs") to nonparty Kwang Sung America, Inc., and a supporting memorandum of points and authorities, and on November 2, 2005, defendant filed a notice of errata re: Exhibit A. On November 23, 2005, plaintiffs filed their response to defendant's motion **[**2]** to quash, and on November 30, 2005, defendant filed its reply.

Oral argument was held before Magistrate Judge Rosalyn M. Chapman on December 7, 2005. Michael S. Thomas, attorney-at-law with the law firm Kirth & Huth, appeared on behalf of plaintiffs and Tina Ivankovic Mangarpan, attorney-at-law with the law firm Ford, Walker, Haggerty & Behar, appeared on behalf of defendant.

BACKGROUND

I

On January 6, 2005, plaintiffs filed an action in the Circuit Court for Wayne County, State of Michigan, setting forth six causes of action: (1) breach of contract re Moon; (2) breach of contract re Patterson Laboratories; (3) action for accounting; (4) promissory estoppel re Moon; (5) promissory estoppel re Patterson Laboratories; and (6) unjust enrichment or quantum meruit re Moon. In their complaint, plaintiffs allege that on January 8, 1999, Moon and defendant, the world's largest wholesale distributor of swimming pool supplies and related equipment, entered into an Import Broker Agreement making Moon defendant's "exclusive" broker of winter swimming pool covers within the "Far East Region" for a three year period, and requiring defendant to pay Moon a 5% commission on the net **[**3]** purchases of such covers; however, defendant has failed to account for and pay Moon his commissions. Complaint, PP 5, 10-16. Specifically, paragraph 1 of the Import Broker Agreement provides:

> The Company [defendant SCP Pool Corporation] grants the Import Broker [plaintiff Moon] the exclusive right to purchase winter covers within the Far East Region only, provided that the pricing, quantity, quality, and other terms of any purchase by the Import Broker must be approved by the Company in writing before such purchase is binding on the Company.

[*635] Motion to Quash, Exh. A. Plaintiffs further allege that at the same time it entered into the Import Broker Agreement with plaintiff Moon, defendant agreed to continue to purchase liquid swimming pool products from plaintiff Patterson Laboratories; however, defendant has failed and refused to do so, and instead purchases such products from other sources. Complaint, PP 17-20. Plaintiffs seek a declaration that defendant breached its agreements with Moon and Patterson Laboratories, awards of commissions and lost profits, an accounting, attorney's fees and other relief. Complaint at 10.

On January 24, 2005, defendant removed the **[**4]** complaint from the Michigan court to the United States District Court for the Eastern District of Michigan, where it is pending. *Moon, et al. v. SCP Pool Corp., et al.*, case no. CV

05-70228-DPH-DAS. On June 13, 2005, defendant filed its answer and several affirmative defenses to the complaint. [1]

II

On or about October 13, 2005, plaintiffs served a subpoena under *Fed. R. Civ. P. 45* on Kwang Sung America, Inc. ("KSA"), [2] a nonparty located in this district, seeking the production on October 28, 2005, of the following seven categories of documents:

[5]** (1) any and all agreements between KSA and defendant "relating to the purchase, sale and/or brokerage of pool winter covers";

(2) any and all documents relating to KSA's "sale of pool winter covers to [defendant] from 1995 through the present";

(3) any and all documents "relating to [KSA's] business relationship with [defendant]";

(4) any and all documents relating to KSA's "sale of pool winter covers "to and/or through Cantar/Polyair Corporation or any of its affiliated entities from 1995 to the present";

(5) any and all documents relating to "communications" between KSA and defendant having "as their subject matter, in whole or in part, the sale/purchase of pool winter covers or Joon Moon";

(6) any and all documents relating to "communications" between KSA and "Cantar/Polyair Corporation or any of its affiliated entities and hav[ing] as their subject matter . . . the sale/purchase of pool winter covers or Joon Moon"; and

(7) any and all documents relating to "communications" between defendant "and Cantar/Polyair Corporation and hav[ing] as their subject matter . . . the sale/purchase of pool winter covers or Joon Moon." Motion to Quash, Exh. F.

On October 26, 2005, defendant **[**6]** provided plaintiffs with objections to the subpoena served on KSA, generally objecting to all requests on relevancy grounds. Motion to Quash, Exh. G. In its motion to quash, defendant argues all document requests seek irrelevant information, citing paragraph 5 of the Import Broker Agreement for the proposition that defendant could purchase from KSA winter pool covers, regardless of their origin -- even under the Import Broker Agreement with plaintiff Moon. Paragraph 5 of the Import Broker Agreement provides:

> The Company [defendant SCP Pool Corporation] shall have the right to purchase winter [pool] covers (imported or domestically produced) from any company that is based in the United States or Europe, such as but not limited to, Cookson/Pacific, Swimline, Cantar, Century Products.

Motion to Quash, Exh. A. Further, defendant argues request **[*636]** nos. 1-7 seek irrelevant information covering years the Import Broker Agreement with Moon was not in effect; request nos. 4, 6 and 7 seek irrelevant information relating to defendant's business relationship with Cantar/Polyair Corporation, and the Import Broker Agreement expressly exempts Cantar from its coverage; and request **[**7]** nos. 1-7 seek irrelevant information unrelated to the "Far East Region." Motion to Quash, Exh. G.

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[1] The discovery cut-off date is March 6, 2006; the motion cut-off date is May 20, 2006; a pretrial conference is set for May 22, 2006; and a jury trial is scheduled to commence June 20, 2006.

[2] Plaintiffs assert that KSA "provides sales and marketing directions, and coordinates shipping logistics throughout the U.S., Canada, and Mexico[,]" Response, Exhibit 3, on behalf of Kwang Sung Company, Ltd., a Korean manufacturer. *Id.*, Exhibit 4.

DISCUSSION

Rule 26(b)(1) permits discovery in civil actions of "any matter, not privileged, that is relevant to the claim or defense of any party. . . ." Generally, the purpose of discovery is to remove surprise from trial preparation so the parties can obtain evidence necessary to evaluate and resolve their dispute. *Oakes v. Halvorsen Marine Ltd., 179 F.R.D. 281, 283 (C.D. Cal. 1998)*. Toward this end, *Rule 26(b)* is liberally interpreted to permit wide-ranging discovery of information even though the information may not be admissible at the trial. *Jones v. Commander, Kansas Army Ammunitions Plant, 147 F.R.D. 248, 250 (D. Kan. 1993)*. All discovery, and federal litigation generally, is subject to *Rule 1*, which directs that the rules "shall be construed and administered to secure the just, speedy, and inexpensive determination of every action."

Federal Rule of Civil Procedure 45 governs subpoenas duces tecum for the production of documents with or without the taking of a deposition. [3] One of the purposes of **[**8]** *Rule 45* is "to facilitate access outside the deposition procedure provided by *Rule 30* to documents and other information in the possession of persons who are not parties. . . ." Advisory Committee Notes to 1991 Amendment. "The non-party witness is subject to the same scope of discovery under this rule as that person would be as a party to whom a request is addressed pursuant to *Rule 34*." *Id.*

Under *Rule 45*, the nonparty served with the subpoena duces tecum may make objections to the subpoena duces tecum within 14 days after service or before the time for compliance, if less than 14 days. *Fed. R. Civ. P. 45(c)(2)(B)*. On timely motion, the court may quash or modify the subpoena. *Rule 45(c)(3)(A)*. A **[**9]** party cannot object to a subpoena duces tecum served on a nonparty, but rather, must seek a protective order or make a motion to quash. Schwarzer, Tashima & Wagstaffe, *California Practice Guide: Federal Civil Procedure Before Trial*, P 11:2291 (2005 rev.) (emphasis in original); *see also Pennwalt Corp. v. Durand-Wayland, Inc., 708 F.2d 492, 494 n.5 (9th Cir. 1983)* ("Once the person subpoenaed objects to the subpoena . . . the provisions of *Rule 45[c]* come into play.").

Here, defendant, rather than nonparty KSA, made timely objections to the *Rule 45* subpoena duces tecum. A nonparty's failure to timely make objections to a *Rule 45* subpoena duces tecum generally requires the court to find that any objections have been waived. *In re DG Acquisition Corp., 151 F.3d 75, 81 (2d Cir. 1998)*; *Creative Gifts, Inc. v. UFO, 183 F.R.D. 568, 570 (D. N.M. 1998)*; Schwarzer, Tashima & Wagstaffe, *California Practice Guide: Federal Civil Procedure Before Trial*, § 11:2293 (2005 rev.). Nonetheless, "[i]n unusual circumstances and for good cause, . . . the failure to act timely will not bar consideration of objections [to a *Rule 45* subpoena]. **[**10]** " *McCoy v. Southwest Airlines Co., Inc., 211 F.R.D. 381, 385 (C.D. Cal. 2002)* (citations and internal quotation marks omitted); *American Elec. Power Co. v. United States, 191 F.R.D. 132, 136 (S.D. Oh. 1999)*; *In re Motorsports Merchandise Antitrust Litigation, 186 F.R.D. 344, 349 (W.D. Va. 1999)*; *Alexander v. Federal Bureau of Investigation, 186 F.R.D. 21, 34 (D. D.C. 1998)*; *Concord Boat Corp. v. Brunswick Corp., 169 F.R.D. 44, 48 (S.D. N.Y. 1996))*. Courts have found unusual circumstances where, for instance, the subpoena is overbroad on its face and exceeds the bounds of fair discovery and the subpoenaed witness is a non-party acting in good faith. *McCoy, 211 F.R.D at 385*; *American Electric Power Co., 191 F.R.D. at 136-37*; *Alexander, 186 F.R.D. at 34*; *Concord Boat Corp., 169 F.R.D. at 48*. In light of the overbroad nature of the subpoena served by plaintiffs on nonparty KSA, the Court finds defendant's objections to the subpoena have not been waived.

[*637] *Rule 45(c)(3)(A)* sets forth the bases for a court to quash or modify a subpoena. In **[**11]** particular, it provides:

> [o]n timely motion, the court by which a subpoena was issued shall quash or modify the subpoena if it
>
> (i) fails to allow reasonable time for compliance;

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[3] *Rule 34*, pertaining to the production of documents, provides that "[a] person not a party to the action may be compelled to produce documents and things or to submit to an inspection as provided in *Rule 45*." *Fed. R. Civ. P. 34(c)*.

> (ii) requires a person who is not a party . . . to travel to a place more than 100 miles from the place where that person resides, is employed or regularly transacts business . . ., or
> (iii) requires disclosure of privileged or other protected matter and no exception or waiver applies', or
> (iv) subjects a person to undue burden.

Fed. R. Civ. P. 45(c)(3)(A). Additionally, in the event the subpoena "requires disclosure of a trade secret or other confidential research, development, or commercial information, . . . the court may . . . quash . . . the subpoena. . . ." Fed. R. Civ. P. 45(c) (3) (B).

As an initial matter, the party who moves to quash a subpoena has the "burden of persuasion" under Rule 45(c)(3). Travelers Indem. Co. v. Metropolitan Life Insur. Co., 228 F.R.D. 111, 113 (D. Conn. 2005); Concord Boat Corp., 169 F.R.D. at 48; United States v. IBM, 83 F.R.D. 97, 104 (S.D. N.Y. 1979). **[**12]** Here, defendant seeks to quash or, in the alternative, to modify the Rule 45 subpoena on relevancy grounds, contending that the information sought is irrelevant in light of paragraph 5 of the Import Broker Agreement, and the subpoena is generally overly broad since it requests information for a ten year period of time, whereas the Import Broker Agreement covers only three years, and seeks information about KSA's commercial business with other nonparties.

Although irrelevance is not among the litany of enumerated reasons for quashing a subpoena found in Rule 45, courts have incorporated relevance as a factor when determining motions to quash a subpoena. Goodyear Tire & Rubber Co. v. Kirk's Tire & Auto Servicenter, 211 F.R.D. 658, 662 (D. Kan. 2003). Specifically, under Rule 45(c)(3)(A), "[a]n evaluation of undue burden requires the court to weigh the burden to the subpoenaed party against the value of the information to the serving party[,]" Travelers Indem. Co., 228 F.R.D. at 113, and, in particular, requires the court to consider:

> 'such factors as relevance, the need of the party for the documents, the breadth of the document request, **[**13]** the time period covered by it, the particularity with which the documents are described and the burden imposed.'

Id. (quoting IBM, 83 F.R.D. at 104).

Here, plaintiffs explain the requested documents are relevant "to show that [defendant's] purchasing patterns changed to effectively divert Far East winter cover purchases through other suppliers (including Cantar), at a time when [plaintiff] Moon was to be the exclusive broker of winter covers from the Far East." Response at 5. Accordingly, plaintiffs argue, "documents outside the years covered by the Import Broker Agreement are relevant, because those documents will show [defendant's] purchasing patterns related to winter covers imported from the Far East Region." Response at 5-6. On the other hand, defendant argues the documents plaintiffs seek are irrelevant under paragraph 5 of the Import Broker Agreement, which specifically permits defendant to purchase pool winter covers from any company based in the United States, such as nonparty KSA -- even if the covers are imported from the Far East.

Weighing the burden to nonparty KSA against the value of the information to plaintiffs, the Court finds **[**14]** the subpoena imposes an "undue burden" on nonparty KSA. Travelers Indem. Co., 228 F.R.D. at 113. Here, request nos. 1, 2, 3 and 5 broadly seek any and all documents over a ten year or greater [4] period relating to defendant and nonparty KSA regarding pool winter covers. These requests are "overbroad on [their] face and exceed[] the bounds of fair discovery" in that they seek (a) information over a ten year or greater period and (b) seek information regarding **[*638]** ***all*** pool winter covers, not only those "within the Far East Region." Moreover, these requests all pertain to defendant, who is a party, and, thus, plaintiffs can more easily and inexpensively obtain the documents from defendant, rather than from nonparty KSA. *See* Dart Indus. Co., Inc. v. Westwood Chem. Co., Inc., 649 F.2d 646, 649 (9th Cir. 1980) (discovery restrictions may be even broader where target is nonparty); Haworth, Inc. v. Herman Miller, Inc., 998 F.2d 975, 978 (D.C. Cir. 1993) (affirming order requiring party to first attempt to obtain

[4] Only request no. 2 is "limited" to a ten year period; request nos. 1, 3 and 5 contain no temporal limitation.

documents from opposing party rather than nonparty). Since plaintiffs have not shown they have attempted to obtain these **[**15]** documents from defendant, the Court finds that, at this time, requiring nonparty KSA to produce these documents is an undue burden on nonparty KSA.

Similarly, the remaining requests, request nos. 4, 6 and 7, [5] also are "overbroad on [their] face and exceed[] the bounds of fair discovery" since they seek documents covering over a ten year or greater period [6] regarding ***all*** pool winter covers. Moreover, a specific ground to quash a subpoena is that it seeks "commercial information," *see* *Fed. R. Civ. P. 45(c)(3)(B)*, which these requests clearly seek since they seek documents related to nonparty KSA's business relationship with other nonparties, such as Cantar, rather than nonparty KSA's relationship with defendant. Finally, plaintiffs' rely solely on a hearsay conversation between plaintiff Moon and a representative of nonparty KSA to explain **[**16]** the relevancy of these requests, *see* Response at 5-6, Exh. 5, and plaintiffs' reliance on such incompetent evidence is not well taken.

For all these reasons, defendants' request to quash the *Rule 45* subpoena served by plaintiffs on nonparty Kwang Sung America, Inc. **IS GRANTED**.

End of Document

[5] Request no. 7 inexplicably seeks information from nonparty KSA about communications between defendant and nonparty Cantar, without any showing that nonparty KSA would, in the normal course of business, have such documents.

[6] Only request no. 4 is "limited" to a ten year period; request nos. 6 and 7 contain no temporal limitation.

New Prime, Inc. v. Prime Grp. Holdings LLC

United States District Court for the Central District of California

March 28, 2024, Decided; March 28, 2024, Filed

CV 2:23-cv-00103-DSF-KS

Reporter
2024 U.S. Dist. LEXIS 58322 *

New Prime, Inc. D/B/A/ Prime Inc. v. Prime Group Holdings LLC et al.

Subsequent History: Motion granted by *New Prime, Inc. v. Prime Grp. Holdings LLC, 2024 U.S. Dist. LEXIS 88273 (C.D. Cal., Apr. 1, 2024)*

Core Terms

Transport, responses, Supplemental, documents, logistics, trucking, Marks, discovery, Incorporating, freight, forwarding, proportional, inspection, non-privileged, global, Interrogatory, aviation, air cargo, airports, shipping, bonded, infringement, proportionate, commerce, requests, trademark, request for production, discovery request, rail car, subsidiary

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For Prime Group Holdings LLC, Prime Group Logistics Holding LLC, Defendants: Christopher D Bright, Deborah Ann Gubernick, Snell and Wilmer LLP, Costa Mesa, CA; Morgan R. Povinelli, PRO HAC VICE, Snell and Wilmer LLP, Washington, DC.

For Prime Logistics Group LLC, Defendant: Christopher D Bright, Snell and Wilmer LLP, Costa Mesa, CA; Morgan R. Povinelli, PRO HAC VICE, Snell and Wilmer LLP, Washington, DC.

Judges: Karen L. Stevenson, Chief United States Magistrate Judge.

Opinion by: Karen L. Stevenson

Opinion

CIVIL MINUTES — GENERAL

Proceedings: (IN CHAMBERS) ORDER GRANTING IN PART AND DENYING IN PART PLAINTIFF'S MOTION TO COMPEL [DKT. NO. 63]

Pending before the Court is Plaintiff's Motion to Compel, filed on January 10, 2024 (the "Motion"), along with the Declaration of Eric D. Sidler ("Sidler Decl."), and related exhibits in support of the Motion. (Dkt. No. 63)[1] Defendants

[1] The Court granted Plaintiff's request to file Exhibits G and M to the Sidler Declaration under seal pursuant to the Stipulated Protective Order. (*See* Dkt. Nos. 67 (Sealing Order) and 59 (Protective Order).)

filed an Opposition to the Motion on January 24, 2024 ("Opp'n") **[*2]** with a Declaration of Christopher D. Bright ("Bright Decl.") and related exhibits. (Dkt. No. 70.) Plaintiff filed a Reply on January 31, 2024. (Dkt. No. 79.) On February 14, 2024, the Court held oral argument on the Motion and took the matter under submission. (Dkt. No. 94.)

For the reasons discussed below, the Motion is GRANTED in part and DENIED in part.

RELEVANT BACKGROUND

Plaintiff New Prime Inc. commenced this trademark infringement action against Defendants Prime Group Holdings LLC, Prime Group Logistics Holdings LLC, and Prime Logistics Group LLC (together, "Defendants"), on January 6, 2023. (Dkt. No. **I.)** On January 23, 2023, Plaintiff filed a First Amended Complaint. (Dkt. No. 16.) Defendants filed their Answer to the FAC on June 23, 2023. (Dkt. No. 36.) On July 27, 2023, Plaintiff filed the operative Second Amended Complaint for Trademark Infringement, Unfair competition, Dilution, and Cancellation ("SAC"). (Dkt. No. 41.)

The SAC alleges that Plaintiff owns a common law standard character word mark, "PRIME INC." and a stylized "PRIME INC." mark that "have become well known and famous through Prime Inc.'s continuous use and promotion of the marks in commerce throughout the United **[*3]** States for more than forty years in connection with transportation, trucking, and shipping services[.]" (SAC at ¶ 2.) Plaintiff also owns a common law standard character mark, "PRIME LOGISTICS," that Plaintiff has "continuously used in commerce throughout the United States and in the state of California for nearly forty years in connection with its transportation and logistics services." (SAC at ¶ 3.)

The SAC also alleges that Defendants "have used and continue to use confusingly similar marks (the 'Accused Marks' []) in connection with transportation, shipping and logistics services in violation of [Plaintiff's] exclusive rights in the PRIME INC. Marks and the PRIME LOGISTICS Mark . . . for the same or related services." (SAC at ¶ 4.) Plaintiff further asserts that it has used the PRIME INC. Mark continuously since at least 1980 in connection with its transportation, trucking, and shipping services[,]" and has continuously used the PRIME INC. Marks in commerce throughout all 48 contiguous U.S.A. states." (SAC at ¶ 18-19.) The SAC states that since at least January 21, 2020, Plaintiff has used the POWERONLY Mark, which "incorporates the PRIME INC. Marks in their entirety" "to designate **[*4]** and promote its Power Only Advanced Fleet Program in which individual owner/operators and small fleet owners can use their own trucks to haul freight in Prime's trailers." (SAC at ¶¶ 38-40.)

The SAC further alleges that the POWERONLY Mark is the subject of the U.S. Trademark Application Serial No. 90498637 for "administering group purchasing programs, namely, negotiating contracts with providers of fuel, trailers, tires, trucking equipment, and transportation services [inter alia] to enable participant members of freight and trucking networks to obtain benefits and discounts on the purchase of their goods or services[.]" (SAC at ¶ 41.) Collectively, Plaintiff's Word Mark, Stylized Mark, and POWERONLY mark, comprise the "Asserted Marks." (SAC at ¶ 4.)

Plaintiff alleges that Defendants offer transportation, shipping, and logistics services to customers in the United States, using the standard character marks: PRIME GROUP HOLDINGS, PRIME GROUP LOGISTICS HOLDING, PRIMEAIR, PRIME AIR & OCEAN CARGO, PRIME FRESH HANDLING, and PRIME FRESH PRODUCTS" (collectively, the "Accused Marks"). (SAC at ¶ 46.) Plaintiff asserts that the "Accused Marks are confusingly similar in appearance, sound, meaning **[*5]** and commercial impression when compared to the Asserted Marks." (SAC ¶ 50.)

The SAC asserts federal claims for unfair competition (*15 U.S.C. § 1125(a)*) (Count I); common law trademark infringement (Count II); common law unfair competition (Count III); federal trademark dilution (*15 U.S.C. § 1125(c)*) (Count IV); California trademark dilution (*Cal. Bus. & Prof. C. § 14330*) (Count V); cancellation of U.S. Registration No. 5523357 (*15 U.S.C. § 1119*) (Count VI); and federal trademark infringement (15 U.S.C. § VII).

THE DISPUTED DISCOVERY REQUESTS

In the Motion, Plaintiff seeks an order compelling Defendants to respond more fully to certain requests for production of documents and interrogatories that seek information concerning Prime Group Logistics Holdings, LLC's ("PGLH") "aviation logistics" services, "aviation freight brokerage," and "General Sales & Service Agent ('GSSA')" services. (Motion at 1.)

On August 24, 2023, Plaintiff served a First Set of Requests for Production and a First Set of Interrogatories. (Sidler Decl., ¶¶ 3, 6.) On September 7, 2023, Plaintiff served its Second Set of Interrogatories and Second Set of Requests for Production. (Sidler Decl., ¶¶ 7-8.) Defendants timely filed objections and responses to Plaintiff's requests, and subsequently provided supplemental **[*6]** responses to Plaintiff's First and Second Set of RFPs. (*See* Sidler Decl., Exs. I, R.) Defendants agreed only to provide responsive information and documents concerning "land-services" and object to providing information regarding its aviation and/or GSSA-related services.

Plaintiff seeks an order compelling Defendants to further supplement its responses to Plaintiff's Interrogatories Nos. 4-10, 12, and 14, as well as responses and production of documents for Request for Production Nos. 1-18, 22-25, 52-53, and 55-58.

The Court summarizes the Requests and Defendants' responses below[2] :

A. Interrogatories

Interrogatory No. 4: Identify by month and year when You first began offering the services identified in response to Interrogatory No. 3 in commerce, and, if applicable, the month and year in which You ceased offering any such service in commence.

> Defendant's Supplemental Response:[3] [Incorporating previous objections and responses] Defendant, incorporating its response to Interrogatory No.1, responds that PrimeAir (owned by PGLH) does not offer trucking or use of truck to transport goods, but offers "underwing services" at airports and aircraft chartering services.

(Sidler Decl., Ex. G at p.68-69 **[*7]** (filed under seal).)

> Defendants' Second Supplemental Response: [Incorporating previous objections and responses] Defendant responded regarding its "bonded transportation services" from a primary airport to a secondary airport and provided an estimate of percentage of PrimeAir's contract that involve such bonded transportation.

(*Id.* at 69.)

Interrogatory No. 5: Identify the classes, types, characteristics, and geographic location of customers to whom You have offered or sold Ground Transport Services.

> Defendants' Supplemental Responses: [Incorporating previous objections and responses] Pursuant to *Fed. R. Civ. P. 33(d)*, Defendant identified by Bates number documents PrimeGroup produced in response to this request.

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[2] Due to the voluminous nature of the discovery requests and Defendant's objections and responses, the Court does not recite the full text of the requests here.

[3] Defendants designated the Third Supplemental Responses to Plaintiff's First Set of Interrogatories, dated January 10, 2024, as "Highly Confidential-Attorneys' Eyes Only" under the Protective Order. (Sidler Decl., ¶ 9, Ex. G.) Accordingly, the Court gives a paraphrased summary of Defendants' responses rather than a verbatim recitation.

(*Id.* at 70-71.)

Interrogatory No. 6: Identify the unit and dollar amounts of Your annual sales of Ground Transport Services.

> Defendants' Supplemental Responses: [Incorporating previous objections and responses] Pursuant to *Fed. R. Civ. P. 33(d)*, Defendant agreed to produce for inspection responsive documents to the extent they include land services only. Defendants provided a Second and Third Supplemental Response to Interrogatory No. 6 identifying such documents.

(*Id.* at 72-73.)

Interrogatory No. 7: Identify and describe **[*8]** Your competitors with respect to Ground Transport Services.

> Defendants' Supplemental Responses: [Incorporating previous objections and responses] Defendants objected to the term "Ground Transport Services" as vague and ambiguous and clarified that Prime Group provides global freight forwarding services. Defendants also provided a response regarding "competitors", including identifying by name "known freight forwarding services competitors."

(*Id.* at 73-74.)

Interrogatory No. 8: Identify and describe the advertising channels You have used to promote Your Ground Transport Services.

> Defendants' Supplemental, Second Supplemental and Third Supplemental Responses: [Incorporating previous objections and responses]. In addition to a narrative response pursuant to *Fed. R. Civ. P. 33(d)*, Defendant identified by Bates number documents PrimeGroup produced in response to this request.

(*Id.* at 75-76.)

Interrogatory No. 9: Identify and describe all plans You have to expand Your Ground Transport Services.

> Defendants' Supplemental, and Second Supplemental Responses: [Incorporating previous objections and responses]. Defendants provided a substantive response to this request and, in a Second Supplemental Response, PGLH incorporated **[*9]** its response to Interrogatory No. 3.

(*Id.* at 77.)

Interrogatory No. 10: Identify by name and title the Persons(s) most knowledgeable about Your past, current, and planned future Ground Transport Services and Your past, current, and planned future uses of the Accused Marks in connection with Ground Transport Services.

> Defendants' Supplemental and Second Supplemental Responses: [Incorporating previous objections and responses]. Defendant identified individuals knowledgeable regarding "global freight forwarding services," and incorporated its response to Interrogatory Nos. 1, 2, and 3.

(*Id.* at 78.)

Interrogatory No. 12: Describe the facts and circumstances concerning Your first awareness of Prime and the Asserted Marks, including when and how You first became aware of Prime and the Asserted Marks and any investigation by You that resulted in such awareness.

> Defendants' Supplemental and Second Supplemental Responses: [Incorporating previous objections and responses]. Defendants provided a substantive response regarding when and how it became aware of Prime and/or the Asserted Marks. PGLH incorporated its response to Interrogatory Nos. 2-3.

(*Id.* at 79-81.)

Interrogatory No. 14: Identify the principal **[*10]** and material factual and legal bases for your contention that Prime's claims in this action are barred, in whole or in part, by the Morehouse defense, as alleged in Your Seventeenth Affirmative Defense.

> Defendants' Supplemental Responses: [Incorporating previous objections and responses]. Defendants provided a substantive response in its initial and supplemental response to this request.

(*Id.* at 84-85.)

B. Requests for Production

As an initial matter, Defendants' First Supplemental Responses to Plaintiff's Request for Production, Set One, state a General Objection to Plaintiff's definition of "Ground Transport Service(s)" as vague and ambiguous because "Defendants do not offer Ground Transport Services as they understand that phrase and Plaintiff's definition." (Sidler Decl., Ex. I at p. 97.) Defendants also state a General Objection to "Plaintiff's Definitions, Instructions, and Requests to the extent they seek information from Defendant [PGLS] concerning aviation logistics, which includes aviation freight brokerage and aviation GSSA services, as not relevant, not proportionate to the needs of this case, and not likely to lead to the discovery of admissible information, as these services **[*11]** are not accused by Plaintiff." (*Id.* at 98.)

The RFPs at issue in the Motion seek, in relevant part, documents "sufficient to show":

RFP No. 1: "facts and circumstances concerning the adoption of the Accused Marks, including but not limited to, the date of such adoption, the reasons the Accused Marks were chosen, and any other marks that were considered but not adopted."

> Supplemental Response to RFP No. 1: [Incorporating prior objections and responses.] "Prime Group will produce or make available for inspection responsive, non-privileged, proportional documents, to the extent they exist, regarding Prime Group's global freight forwarding services, to the extent they include any land services."

(Sidler Decl., Ex. I.)

RFP No. 2: "the name and title of all Persons who were responsible for or participated in the conception, creation, selection, or adoption of the Accused Marks, and the nature of each such Person's responsibility for or participation in the same."

> Supplemental Response to RFP No. 2: [Incorporating prior objections and responses.] "Prime Group will produce or make available for inspection responsive, non-privileged, proportional documents, to the extent they exist, regarding Prime **[*12]** Group's global freight forwarding services, to the extent they include any land services."

(*Id.* at 100.)

RFP No. 3: "all searches, investigations, studies, or analyses conducted by YOU or on YOUR behalf to determine whether other Persons have used or registered any mark or trade name similar to the Accused Marks, or whether the use or registration of the Accused Marks, along or in combination with any other terms or designs, would infringe or conflict with the rights of any other Person, including all written reports concerning the results of any such search, investigation, study, or analysis."

> Supplemental Response to RFP No. 3: [Incorporating prior objections and responses.] "Prime Group will produce or make available for inspection responsive, non-privileged, proportional documents, to the extent they exist, regarding Prime Group's global freight forwarding services, to the extent they include any land services."

(*Id.* at 101.)

RFP No. 4: "all Ground Transport Services offered at any time in commerce under the Accused Marks."

> Supplemental Response to RFP No. 4: [Incorporating prior objections and responses.] "Prime Group will produce or make available for inspection responsive, non-privileged, **[*13]** proportional documents, to the extent they exist, regarding Prime Group's global freight forwarding services, to the extent they include any land services."

(*Id.* at 102.)

RFP No. 5: "the period(s) of time in which You have offered or sold Ground Transport Services in commerce, including when You began offering Ground Transport Services in commerce and, if applicable, when You ceased offering any such service."

> Supplemental Response to RFP No. 5: [Incorporating prior objections and responses.] "Prime Group will produce or make available for inspection responsive, non-privileged, proportional documents, to the extent they exist, regarding Prime Group's global freight forwarding services, to the extent they include any land services."

(*Id.*)

RFP No. 6: "the prices at which You have offered or sold Ground Transport Services in commerce."

> Supplemental Response to RFP No. 6: [Incorporating prior objections and responses.] "Prime Group will produce or make available for inspection responsive, non-privileged, proportional documents, to the extent they exist, regarding Prime Group's global freight forwarding services, to the extent they include any land services."

(*Id.* at 103.)

RFP No. 7: "the names, **[*14]** geographic locations, classes, types, and characteristics of all customers to whom You have offered or sold Ground Transport Services in commerce."

> Supplemental Response to RFP No. 7: [Incorporating prior objections and responses.] "Prime Group will produce or make available for inspection responsive, non-privileged, proportional documents, to the extent they exist, regarding Prime Group's global freight forwarding services, to the extent they include any land services."

(*Id.* at 104.)

RFP No. 8: "the unit and dollar amounts of Your annual sales, revenue, profit, and/or loss with respect to Ground Transport Services.

> Supplemental Response to RFP No. 8: [Incorporating prior objections and responses.] "Prime Group will produce or make available for inspection responsive, non-privileged, proportional documents, to the extent they exist, regarding Prime Group's global freight forwarding services, to the extent they include any land services."

(*Id.* at 105.)

RFP No. 9: "Your competitors with respect to Ground Transport Services."

> Supplemental Response to RFP No. 9: [Incorporating prior objections and responses.] "Prime Group will produce or make available for inspection responsive, non-privileged, **[*15]** proportional documents, to the extent they exist, regarding Prime Group's global freight forwarding services, to the extent they include any land services."

(*Id.*)

RFP No. 10: "the advertising channels You have used to promote Your Ground Transport services."

> Supplemental Response to RFP No. 10: [Incorporating prior objections and responses.] "Prime Group will produce or make available for inspection responsive, non-privileged, proportional documents, to the extent they exist, regarding Prime Group's global freight forwarding services, to the extent they include any land services."

(*Id.* at 106.)

RFP No. 11: "representative samples of all advertisements or marketing or promotional materials for Your Ground Transport Services, including but not limited to, brochures, press releases, catalogs, circulars, leaflets, signs, billboards or commercials."

> Supplemental Response to RFP No. 11: [Incorporating prior objections and responses.] "Prime Group will produce or make available for inspection responsive, non-privileged, proportional documents, to the extent they exist, regarding Prime Group's global freight forwarding services, to the extent they include any land services."

(*Id.* at 107.)

RFP No. **[*16]** 12: "the annual dollar amounts of advertising, marketing, and promotional expenditures for Your Ground Transport Services."

> Supplemental Response to RFP No. 12: [Incorporating prior objections and responses.] "Prime Group will produce or make available for inspection responsive, non-privileged, proportional documents, to the extent they exist, regarding Prime Group's global freight forwarding services, to the extent they include any land services."

(*Id.* at 108.)

RFP No. 13: "all marketing and business plans for Your Ground Transport Services."

> Supplemental Response to RFP No. 13: [Incorporating prior objections and responses.] "Prime Group will produce or make available for inspection responsive, non-privileged, proportional documents, to the extent they exist, regarding Prime Group's global freight forwarding services, to the extent they include any land services."

(*Id.* at 108-09.)

RFP No. 14: "all plans You have to expand Your Ground Transport Services."

> Supplemental Response to RFP No. 14: [Incorporating prior objections and responses.] "Prime Group will produce or make available for inspection responsive, non-privileged, proportional documents, to the extent they exist, regarding Prime **[*17]** Group's global freight forwarding services, to the extent they include any land services."

(*Id.* at 109.)

RFP No. 15: "the manner in which You have used or displayed the Accused Marks in connection with Ground Transport Services."

> Supplemental Response to RFP No. 15: [Incorporating prior objections and responses.] "Prime Group will produce or make available for inspection responsive, non-privileged, proportional documents, to the extent they exist, regarding Prime Group's global freight forwarding services, to the extent they include any land services."

(*Id.* at 110.)

RFP No. 16: "Your intended or planned future uses of the Accused Marks in connection with Ground Transport Services, including, but not limited to, written proposals and strategy documents."

> Supplemental Response to RFP No. 16: [Incorporating prior objections and responses.] "Prime Group will produce or make available for inspection responsive, non-privileged, proportional documents, to the extent they exist, regarding Prime Group's global freight forwarding services, to the extent they include any land services."

(*Id.* at 111.)

RFP No. 17: "the Persons(s) most knowledgeable about Your past, current, and planned future Ground Transport **[*18]** Services and Your past, current, and planned future uses of the Accused Marks in connection with Ground Transport Services, including, but not limited to, organizational charts reflecting the name(s) and title(s) of such Person(s)."

> Supplemental Response to RFP No. 17: [Incorporating prior objections and responses.] Prime Group will produce or make available for inspection responsive, non-privileged, proportional documents, to the extent they exist, regarding Prime Group's global freight forwarding services, to the extent they include any land services.

(*Id.* at 112.)

RFP No. 18: "the nature of all services other than Ground Transport Services offered at any time in commerce under the Accused Marks."

> Supplemental Response to RFP No. 18: [Incorporating prior objections and responses.] "Prime Group will produce or make available for inspection responsive, non-privileged, proportional documents, to the extent they exist, regarding Prime Group's global freight forwarding services, to the extent they include any land services."

(*Id.* at 113.)

RFP No. 22: "All documents and communications relating to or referencing Prime or the Asserted Marks."

> Supplemental Response to RFP No. 22: [Incorporating **[*19]** prior objections and responses.] "Prime Group will produce or make available for inspection responsive, non-privileged, proportional documents, to the extent they exists, regarding Plaintiff's use of the Asserted Marks."

(*Id.* at 115.)

RFP No. 23: "All communications between YOU and Prime."

> Response to RFP No. 23: Defendants object to the extent this Request "seeks information protected by attorney client privilege and attorney work product doctrine. Defendants object to this Request as vague and ambiguous to the extent the term, 'Prime,' is not defined in this context."

(*Id.*)

RFP No. 24: "All communications between You and third parties relating to or referencing Prime, the Asserted Marks, the Lawsuit, or the Cancellation Proceeding."

> Supplemental Response to RFP No. 24: [Incorporating prior objections and responses.] "Prime Group will produce or make available for inspection responsive, non-privileged, proportional documents, to the extent they exist, regarding Plaintiff's use of the Asserted Marks."

(*Id.* at 116-117.)

RFP No. 25: "the facts and circumstances concerning Your knowledge and awareness of Prime, the Asserted Marks, and Prime's use and applications for registration of the Asserted **[*20]** Marks, including when and how You first became aware of Prime, the Asserted Marks, and Prime's use and applications for registration of the Asserted Marks and any investigation by You that resulted in such awareness."

> Supplemental Response to RFP No. 25: [Incorporating prior objections and responses.] "Prime Group will produce or make available for inspection responsive, non-privileged, proportional documents, to the extent they exist, regarding Plaintiff's use of the Asserted Marks."

(*Id.* at 118.)

RFP No. 52: "all trade or industry shows, conferences, or events where You have advertised, marketed, or promoted Your Ground Transport Services, including, but not limited to, the date and location of each show, conference, or event."

> Supplemental Response to RFP No. 52: [Incorporating prior objections and responses.] "Prime Group will produce or make available for inspection responsive, non-privileged, proportional documents, to the extent they exist regarding Prime Group's global freight forwarding services, to the extent they include any land services."

(*Id.* at 166.)

RFP No. 53: "all complaints, negative reviews, or negative customer feedback regarding Your Ground Transport Services."

> Supplemental **[*21]** Response to RFP No. 53: [Incorporating prior objections and responses.] "Prime Group will produce or make available for inspection responsive, non-privileged, proportional documents, to the extent they exist regarding Prime Group's global freight forwarding services, to the extent they include any land services."

(*Id.* at 167.)

RFP No. 55: "all projections concerning Your sales, revenue, profit, and/or loss with respect to Ground Transport Services."

> Supplemental Response to RFP No. 55: [Incorporating prior objections and responses.] "Prime Group will produce or make available for inspection responsive, non-privileged, proportional documents, to the extent they exist regarding Prime Group's global freight forwarding services, to the extent they include any land services."

(*Id.* at 168.)

RFP No. 56: "your organizational structure, including any parent, subsidiary, or other related companies."

> Supplemental Response to RFP No. 56: [Incorporating prior objections and responses.] "Prime Group will produce or make available for inspection responsive, non-privileged, proportional documents, to the extent they exist regarding Prime Group's global freight forwarding services, to the extent they include **[*22]** any land services."

(*Id.* at 169.)

RFP No. 57: "All corporate organization charts, including charts identifying individuals and their position within Defendants or any parent, subsidiary, or other related companies, and their titles and responsibilities."

> Supplemental Response to RFP No. 57: [Incorporating prior objections and responses.] "Prime Group will produce or make available for inspection responsive, non-privileged, proportional documents, to the extent they exist regarding Prime Group's global freight forwarding services, to the extent they include any land services."

(*Id.* at 170.)

RFP No. 58: "all current and former owners of Defendants or any parent, subsidiary, or other related companies, including their percentage of ownership and the time period of their ownership."

> Supplemental Response to RFP No. 58: Defendants object to this request to the extent it seeks attorney client privileged information and information protected by the work product doctrine. Defendants object to this Request as "seeking confidential, proprietary and trade secret business information and confidential information regarding third parties who are not a party to this dispute and enjoy privacy protections. **[*23]** Defendants further object on the basis that this Request is overbroad in time and scope purporting to seek information that spans the inception of Defendants' business to present."

(*Id.* at 170.)

THE MOTION

A. Plaintiff's Contentions

The Motion seeks an order compelling Defendants to produce documents and further interrogatory responses concerning Defendants' PrimeAir aviation logistics services. Plaintiff describes itself as a "leading transportation company founded in 1970 that provides transportation, trucking and shipping services, as well as related freight logistics and brokerage services," in the United States and throughout North America. (Motion at 1.) Defendants object to producing documents and interrogatory responses concerning PrimeAir's ground-based aviation logistics business as being wholly unrelated services to Plaintiff's trucking services.

Plaintiff asserts that Defendants "are a family of transportation, shipping and logistics companies in the United States operating under the umbrella name 'Prime Group.'" (*Id.* at 4.) Plaintiff alleges that Defendants use "various Prime-formative marks", including the Accused Marks, to promote Defendants' services. (*Id.*) Plaintiff maintains **[*24]** that the discovery it seeks is relevant and proportional to the needs of this case because, among other reasons, in connection with Plaintiff's application to register the POWERONLY Mark, the [USPTO] examining attorney found that Prime's transportation logistics services' were 'identical' to the services described in the PGLH Registration." (*Id.* at 5.) In this lawsuit, Plaintiff seeks to "cancel the PGLH Registration based on a likelihood of confusion and false suggestion of connection." (*Id.*) Plaintiff emphasizes that it has "commenced a parallel cancellation proceeding against the PGLH Registration in the Trademark Trial and Appeal Board." (*Id.*)

According to Plaintiff, its First and Second Sets of Interrogatories and document requests seek "basic information about the nature and extent of Defendants' services" under the Asserted Marks and directed its requests to Defendants'"Ground Transport Services." (*Id.* at 6.) In the requests, Plaintiff defined "Ground Transport Services" to include:

> Any service offered in commerce under any Accused Mark that: (a) involves the transportation or distribution of goods by truck or rail within the United States, including, but not limited to, **any shipping, [*25] logistics, brokerage, or freight forwarding service** involving such transportation or distribution; or (b) is implemented by means of trucks, truck trailers, rail cars, trucks on rail cars, truck trailers on rail cars or intermodal truck, rail, or sea containers.

(*Id.* at 6 (emphasis in original).) Defendants object to Plaintiff's definition of "Ground Transport Services," insisting that Defendants do not offer Ground Transport Services as defined by Plaintiff. (*Id.*) Defendants also objected that the discovery requests, insofar as they seek information regarding "aviation logistics, which includes aviation freight brokerage and aviation GSSA services," are neither relevant nor proportionate to the needs of the case because such services were not accused by Plaintiff. (*Id.*)

Plaintiff argues, however, that Defendants cannot refuse to provide discovery based on Defendants' own view of the merits of the case, i.e. that Defendants' aviation logistics and GSSA services do not compete with Plaintiff's trucking and cargo transport/logistics services. (*Id.* at 1.) Indeed, Plaintiff emphasizes that its "case is directed at all of Defendants' transportation, shipping and logistics services." (*Id.* **[*26]** at 6, n. 3.)

On that basis, Plaintiff seeks an order compelling Defendant "to supplement their responses to Prime's first and second sets of interrogatories and requests for production to provide responsive information and documents about Defendants' aviation logistics/GSSA services." (*Id.* at 2.)

B. Defendant's Contentions

Defendants emphasize that PGLH "is a holding company that owns it subsidiary PrimeAir, which provides air cargo services and is not a party in this case." (Opp'n at 1-2.) This discovery dispute, Defendants note, only concerns PGLH, and not the other two Defendants Prime Group Holdings, LLC and Prime Logistics Group, LLC, "which are producing documents that describe their global freight forwarding services to the extent they include land services." (*Id.*, n.1.)

Defendants object that Plaintiff, by contrast, is exclusively a trucking company and the SAC does not mention aviation or GSSA services at all, and describe Plaintiff's efforts to obtain broader, aviation-related discovery as "overreach." (*Id.*) Defendants emphasize that Plaintiff has not alleged that air cargo services are a "natural zone of expansion" for Plaintiff and has no plans to provide air cargo services. **[*27]** (*Id.*) Indeed, Defendants emphasize that "Plaintiff provides trucking services and nothing more by any other mode of transportation." (*Id.*) Additionally, Defendants maintain that Plaintiff has presented no evidence of confusion with Defendants' services. (*Id.* at 6.) Defendants emphasize that the only trucking-related services PGLH provides is a specialized service through third parties. (*Id.* at 2.)

As to its aviation-related activities, according to Defendants, the PGLH subsidiary that provides aviation-related logistics and/or GSSA services only provides limited "underwing" services that are wholly unrelated, and not comparable to the trucking transport services that Plaintiff provides. (*Id.* at 8-9.) They argue that any aviation logistics and/or GSSA services that PGLH's subsidiary PrimeAir provides are neither related to, nor competitive with, any trucking or cargo transport services offered by Plaintiff and therefore cannot infringe the Accused Marks. (*Id.* at 9.) Defendants also argue that "[n]owhere does Plaintiff's complaint allege that PGLH's air cargo services, including GSA services, infringe the Plaintiff's trademarks." (*Id.* at 10-11.)

Defendants posit that "Plaintiff's failure **[*28]** to plead the natural zone of expansion doctrine is fatal to Plaintiff's effort to obtain discovery on goods or services outside the scope of Plaintiff's actual business[.]" (*Id.* at 16 (*citing* *Beaulieu Grp., LLC v. Mohawk Carpet Distrib., Inc., Case No. 4:15-CV-01214-HLM, 2016 U.S. Dist. LEXIS 203692, 2016 WL 11745981, at *6 (N.D. Ga. Aug. 3, 2016)*.) Defendants insist that to support the discovery at issue here, Plaintiff "should have provided admissible evidence and trademark-specific law to do so." (*Id.* at 17.) Defendants maintain that the cases Plaintiff relies upon in the Motion "stand for general principles of discovery and no cases that support the production of air cargo related documents and things when the services of Plaintiff are trucking and ground transportation." (*Id.* at 18.)

Defendants reject the notion that Plaintiff's claim for cancellation of PGLH's PRIME GROUP LOGISTICS HOLDING mark is sufficient grounds to permit expansive discovery of PrimeAir's air cargo-related activity. (*Id.* at 19-20.) Defendants insist that "Plaintiff does not provide any legal authority for its argument that Plaintiff is entitled to air cargo services discovery due to the description of PGLH's registration for the PRIME GROUP LOGISTICS HOLDING mark because "[n]owhere do those registrations specifically recite air cargo services." (*Id.*)

Finally, Defendants **[*29]** insist that the USPTO Examiner's finding that there was a conflict between Prime's and Plaintiff's marks is neither conclusive nor sufficient to warrant the expansive discovery that Plaintiff seeks here because the USPTO decision was made "at the lowest administrative level," without evidence of market conditions. (*Id.* at 20 (citing *Carter-Wallace, Inc. v. Procter & Gamble Co., 434 F.2d 794, 802 (9th Cir. 1970)*.) Thus, Defendant argues, "the Examiner's finding of a conflict between marks is not only inconclusive but exaggerated in this context." (Opp'n at 20.)

Defendants maintain that Plaintiff's requests for discovery concerning aviation cargo services are not proportionate because Plaintiff's definition of "Ground Transport Services" effectively limits its discovery requests to information concerning shipping and transport services "implemented by means of trucks, truck trailers, rail cars, trucks on rail cars, truck trailers on rail cars or intermodal truck, rail, or sea containers," and that definition does not mention air cargo services. (Opp'n at 20-21.) Defendants explain that PrimeAir provides limited bonded transportation between airports but does not provide trucking services outside of airports. (*Id.* at 21.)

Therefore, Defendants argue, "to the extent **[*30]** any discovery is ordered by the Court, with respect to the proportionality requirement, any such discovery should be limited to such 'bonded transportation[.]" (*Id.* at 22.) Defendants note that they have offered the deposition of the President of the entity that is the majority owner of Prime Group Logistics Holding LLC. (*Id.* at 22; *and see* Sidler Decl., Ex. M.)

Defendants insist that any discovery regarding PrimeAir's services beyond the scope of the "bonded transportation" outlined above is wholly irrelevant to the claims and defenses at issue in this infringement action and not proportionate to the needs of the case. (*Id.* at 22-23.) Defendants contend that discovery regarding PGLH's air cargo services offered through PrimeAir is not entirely irrelevant due to "Plaintiff's failure to accuse air cargo services in its complaint." (*Id.* at 23.)

Defendants seeks an order denying the Motion entirely. Alternatively, Defendants ask that if the Court is inclined to grant the Motion that any further discovery be limited to Plaintiff's ground-based "'bonded trucking' transportation services" between airports. (*Id.* at 24.)

C. Plaintiff's Reply

In the Reply, Plaintiff largely reiterates the central **[*31]** thesis of the Motion, i.e., that "Defendants are seeking to have the ultimate merits of this case decided via motion to compel." (Reply at 1.) Plaintiff urges that Defendants have improperly "cabined" the "parties services into 'trucking' and 'not trucking' based on [Defendants'] self-serving view of the merits of this lawsuit." (*Id.* at 2.) Plaintiff emphasizes that the relatedness of the goods or services — or lack thereof — is one of the *Sleekcraft* [4] factors used to determine likelihood of confusion, and the outcome of that determination "cannot be proclaimed unilaterally by Defendants." (*Id.*)

Plaintiff rejects Defendants' contention that "transportation, shipping, and logistics" services as targeted in the SAC do not include Defendants' aviation logistics/GSSA services." (*Id.* at 3.) Plaintiff maintains that "in the context of Prime's allegations," the term "logistics" "clearly refers to transportation logistics services" and, therefore, "does not exclude aviation logistics/GSSA services from this case." (*Id.* at 3.) Plaintiff points out the allegations of the SAC target "transportation, shipping, and logistics," and Defendants cannot erase that fact by changing the description of its **[*32]** services from "aviation logistics" services (as stated in Defendants' Response to Interrogatory No. 1) to "air cargo services." (*Id.* at 4.)

Plaintiff also pushes back on Defendants' assertion that Plaintiff has failed to adequately support the Motion with admissible evidence, noting that evidence need not be admissible to be discoverable. (*Id.* at 5.) Plaintiff insists that the case law Defendants rely upon, particularly the unpublished decision in *Beaulieu Group, LLC v. Mohawk Carpet Distribution, Inc., 2016 U.S. Dist. LEXIS 203692, 2016 WL 11745951 (N.D. Ga. Aug. 3, 2016)*, does not support denying the discovery sought here because, in that case, the plaintiff sought discovery about products *other than* the products identified as infringing in the complaint. (*Id.*) Plaintiff rejects Defendants' reliance on the Pfeil Declaration because, according to Plaintiff, "that declaration is nothing more than a recitation of Defendants' ultimate positions in this case." (*Id.* at 6.)

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[4] *AMF Inc. v. Sleekcraft Boats, 599 F.2d 341 (9th Cir. 1979)* (outlining eight nonexhaustive factors relevant to determining likelihood of confusion).

Plaintiff points out that in the Opposition, Defendants concede that their companies provide "trucking services" by asserting "'bonded transportation' between airports are 'the only trucking services connected to PrimeAir's air cargo services.'" (*Id.*) Plaintiff maintains "there is no reason to treat bonded transportation any differently from the **[*33]** rest of aviation logistics/GSSA services in discovery. (*Id.* at 9.) Finally, Plaintiff notes that Defendants have made no showing of undue burden, or any burden at all, that warrants denying the Motion. (*Id.* at 10.)

In sum, Plaintiff rejects Defendants' contention that the discovery sought here concerning Defendants'"aviation logistics" and/or GSSA services is irrelevant and disproportionate.

LEGAL STANDARD

Under *Rule 26 of the Federal Rules of Civil Procedure*, a party may obtain discovery concerning any nonprivileged matter that is relevant to any party's claim or defense and proportional to the needs of the case. *FED. R. CIV. P. 26(b)(1)*. *Rule 26(b)(1)* identifies six factors Courts should consider when determining if the proportionality requirement has been met, namely, the importance of the issues at stake in the action, the amount in controversy, the parties' relative access to the relevant information, the parties' resources, the importance of the discovery in resolving the issues and whether the burden or expense of the proposed discovery outweighs its likely benefit. *Id.* Relevant information need not be admissible to be discoverable. *Id.*

Rule 37 provides that "[a] party seeking discovery may move for an order compelling an answer, designation, production, or inspection." **[*34]** FED. R. CIV. P. 37(a)(3). The party seeking to compel production of documents under Rule 34 has the "burden of informing the court why the opposing party's objections are not justified or why the opposing party's responses are deficient." Best Lockers, LLC v. Am. Locker Group, Inc., Case. No. SACV 12-00403 CJC (ANx), 2013 U.S. Dist. LEXIS 209101, 2013 WL 12131586, at *4 (C.D. Cal. Mar. 27, 2013).

District courts have broad discretion in controlling discovery. *See Hallett v. Morgan, 296 F.3d 732, 751 (9th Cir. 2002)*. When considering a motion to compel, the Court has similarly broad discretion in determining relevancy for discovery purposes. Surfvivor Media, Inc. v. Survivor Productions, 406 F.3d 625, 635 (9th Cir. 2005) (citing *Hallett, 296 F.3d at 751*).

DISCUSSION

After a thorough review of the parties' briefs and related declarations, Plaintiff's First Set of RFPs, and Defendants' Supplemental Objections and Responses to the RFPs and Plaintiff's Interrogatories and Defendants' Responses, Supplemental Responses, and Objections to the Interrogatories, the Court finds that much of the discovery requests at issue seek relevant information that is proportionate to the claims and defenses at issue in this trademark infringement action.

A. Relevance

"The party seeking to compel discovery has the burden to establish that its requests satisfy the relevancy requirements of *Rule 26(b)(1)*." Bryant v. Ochoa, 2009 U.S. Dist. LEXIS 42339, 2009 WL 1390794 at *1 (S.D. Cal. May 14, 2009). Any analysis of "relevance" in the context of discovery must be squarely grounded in the specific claims and defenses at issue in the case. *Fed. R. Civ. P. 26(b)(1)*; *and see* Nguyen v. Lotus by Johnny Dung Inc., Case No. 8:17-cv-01317-JVS-JDE, 2019 U.S. Dist. LEXIS 122787, 2019 WL 3064479, *1 (C.D. Cal. June 5, 2019) (noting **[*35]** relevance "has been construed broadly to encompass any matter that bears on, or that reasonably could lead to other matter that could bear on, any issue that is or may be in the case." (internal citations and quotation marks omitted).) The party opposing discovery has "the burden of showing that the discovery should be prohibited, and the burden of clarifying, explaining or supporting its objections." Bryant v. Ochoa, 2009 U.S. Dist. LEXIS 42339, 2009 WL 1390794 at *1.

As an initial matter, the Court notes that, in its responses, Defendants objected to certain requests because the information sought was "not likely to lead to the discovery of admissible information." (*See, e.g.*, Defendants' 3d Supp. Responses to Plaintiff's Interrogatories, Set One (Sidler Decl., Ex. G at 60).) But that standard for relevance is now obsolete. The current test for relevance is whether the information sought is "relevant to any party's claim or defense." *See FED. R. CIV. P. 26(b)(1)* (Advisory Committee Note 2015 Amendment).

Thus, in assessing relevance concerning the discovery at issue here, the Court has closely examined the allegations of the SAC as well as Plaintiff's defined terms in the discovery requests. Specifically, Plaintiff defined "Ground Transport Service(s)" as:

> any service offered **[*36]** in commerce under any Accused Mark that: (a) involves the transportation or distribution of goods by truck or rail within the United States, including, but not limited to, any shipping, logistics, brokerage, or freight forwarding service involving such transportation or distribution; or (b) is implemented by means of trucks, truck trailers, rail cars, trucks on rail cars, truck trailers on rail cars, or intermodal truck, rail, or sea containers.

(Plaintiff's First Set of Requests for Production to Defendants (Sidler Decl., Ex. A at 5).) This definition does not mention or reference aviation-related services or GSSA services. Nevertheless, the allegations in the SAC focus on use of the Asserted and Accused Marks in connection with "transportation, shipping, and logistics services." (*See, e.g.*, SAC at ¶ 46.) Moreover, Defendants acknowledge that PGLH's subsidiary PrimeAir provides limited logistics-related services between airports by truck. According to Defendants, PGLH provides bonded trucking services as a specialized service through third parties. (*See* Opp'n at 2.)

As noted above, Plaintiff defines its commercial activity for purposes of its claims to the Asserted Marks as "Ground **[*37]** Transport Services(s)" involving "transportation, shipping and logistics." (*See* Motion at 6.) Defendants argue, however, that they do not offer "Ground Transport Services," but instead provide "global freight forwarding services." (*See e.g.*, Defendants 3d Supp. Responses to Plaintiff's Interrogatory No. 3 (Sidler Decl., Ex. G at 9).) Defendants argue that Plaintiff's services exclusively pertain to trucking and, on that basis, provided responses to the disputed discovery requests only as to "any land services." But Defendants have put the nature and scope of its ground-based aviation logistics services at issue by acknowledging that PrimeAir provides "limited bonded transportation between airports," but does not provide trucking services outside of airports. (Opp'n at 21.) Therefore, the Court concludes that discovery regarding the nature and scope of those services, even if limited in nature, is relevant both to alleged claims of likelihood of confusion and defenses to such claims.

The Court also agrees with Plaintiff that to the extent Defendants' Opposition asserts legal conclusions about the ultimate merits of the case, e.g., that Defendant's PrimeAir services "do not compete" with **[*38]** Plaintiff's trucking services or ground transportation services, or that the discovery should not be allowed because the air cargo services represent only a very small fraction of PGLH's business activity, these objections are overruled. Defendants' objections are not a proper basis on which to deny otherwise relevant discovery. Indeed, whether the parties' services are competitors in any given sector is a merits issues to be resolved in the litigation.

B. Proportionality

Defendants further object that Plaintiff's discovery requests are disproportionate insofar as they seek information about services beyond land-based transport activities. This assertion is largely based on Defendants' contention that PrimeAir's air cargo logistics services are not similar to, or in competition with, any trucking transportation/logistics services that Plaintiff provides. (Opp'n at 2.) But here, too, the Court is unpersuaded. As Plaintiff points out, Defendants' arguments go to the merits of the infringement claims. (Reply at 2.) Plaintiff does not have to take Defendants' word for it. Plaintiff is entitled to discovery to test those assertions.

Defendants also argue that it would be unduly burdensome **[*39]** to respond to Plaintiff's discovery requests regarding services other than its land-based services. Plaintiff responds that Defendant has made no showing of

undue burden or any burden at all. (Reply at 10.) The Court agrees with Plaintiff here. Defendants have not presented any facts that establish any undue burden — whether in cost or time — that supports a finding that Plaintiffs' discovery requests are disproportionate within the meaning of *Rule 26(b)(1)*.

Consequently, considering the importance of the issues at stake in the action, the amount in controversy, Defendants' relative access to the relevant information Plaintiff seeks, the importance of the discovery in resolving the infringement claims, and the absence of any demonstrated burden or expense, the Court finds that proportionality factors under *Rule 26(b)(1)* are satisfied as to Plaintiff's discovery requests.

Thus, the Court concludes, as outlined below, that some, but not all, of the disputed discovery requests warrant further responses.

C. Requests for Production: Granted in Part, Denied in Part

The Court overrules Defendants' unilateral limit to providing information pertaining only to "any land services." If, as Defendants contend, PrimeAir's cargo/GSSA **[*40]** services are performed on the ground, even on a limited basis, whether at or between airports, that information is relevant and proportionate to the determination of the alleged infringement claims at issue in this lawsuit. Further, as noted above, relevant information need not be admissible.

Therefore, the Motion is GRANTED as to RFP Nos: 1-18, 52, 53, 55, 56, and 57, and responses must be supplemented, where applicable and, if necessary, subject to the Stipulated Protective Order, to include information concerning PrimeAir's bonded ground transportation and movement of goods between airports. (*See* Opp'n at 24.)

The Motion is DENIED with respect to RFP Nos. 22, 24, and 25. Defendants responded stating they will "produce or make available for inspection responsive, non-privileged proportional documents, to the extent they exist, regarding Plaintiff's use of the Asserted Marks." No further responses are required.

The Court sustains Defendants' objection to RFP No. 23 (seeking "[a]ll communications between You and Prime.") that in the context of the RFP, the term "Prime" is vague and ambiguous. No further response is required.

Finally, the Court sustains Defendants' objection to RFP No. **[*41]** 58 (seeking "all current and former owners of Defendants or any parent, subsidiary or other related companies . . ."). The Court agrees with Defendants that this request is facially overbroad in time and scope insofar as it purports to require a search for and production of documents from the inception of the company.

D. Interrogatories: Granted in Part and Denied in Part

Defendants interposed a general objection to Plaintiff's interrogatories "to the extent they seek information from Defendant Prime Group Logistics Services ['PGLS'], concerning aviation logistics, which includes aviation freight brokerage and aviation GSSA services" on the ground that such information was neither relevant nor proportionate to the needs of the case, "as these services are not accused by Plaintiff." (Sidler, Decl. Ex. G at p. 61.) For the reasons outlined above with respect to the RFPs, the Court finds that responsive information concerning bonded ground transportation services between airports, as provided by PGHL's wholly owned subsidiary PrimeAir, is both relevant and proportionate.

Accordingly, the Motion is GRANTED as to Interrogatory Nos. 4, 5, 6, 7, 8, 9, 10, and 12 only to the extent Defendants' **[*42]** supplemental responses did not previously provide responsive information concerning PrimeAir's bonded ground-based transportation services between airports.

The Motion is DENIED as to Interrogatory No. 14.

CONCLUSION

For the reasons outlined above, the Motion is GRANTED in part and DENIED in part as follows:

(1) Within twenty-one (21) days of the date of this Order, Defendant shall serve full and complete supplemental responses to RFP Nos: 1-18, 52, 53, 55, 56, and 57 including, where applicable, responses concerning PrimeAir's air cargo logistics/GSSA services. Consistent with *Rule 34(a)*, the responses must plainly indicate whether documents are being withheld based on any assertions of privilege and/or work product doctrine. Any documents withheld based on privilege or work product protection must be identified on a privilege log.
(2) Within twenty-one (21) days of the date of this Order, Defendant shall serve full and complete supplemental responses to Interrogatory Nos. 4, 5, 6, 7, 8, 9, 10, and 12 including, where applicable, responses concerning PrimeAir's bonded ground-based transportation services between airports.
(3) The Motion is DENIED in all other respects.

Each party to bear its own costs. **[*43]**

IT IS SO ORDERED.

End of Document

Pate v. Pac. Harbor Line, Inc.

United States District Court for the Central District of California

February 6, 2023, Decided; February 6, 2023, Filed

5:21-cv-01300-JWH-SHK

Reporter
2023 U.S. Dist. LEXIS 52632 *; 2023 WL 2629867

Lonnie Pate v. Pacific Harbor Line, Inc., et al.

Subsequent History: Later proceeding at *Pate v. Pac. Harbor Line, Inc., 2023 U.S. Dist. LEXIS 128016, 2023 WL 4680784 (C.D. Cal., May 30, 2023)*

Later proceeding at *Pate v. Pac. Harbor Line, Inc., 2023 U.S. Dist. LEXIS 158880 (C.D. Cal., Sept. 6, 2023)*

Request denied by *Pate v. Pac. Harbor Line, Inc., 2023 U.S. Dist. LEXIS 168769 (C.D. Cal., Sept. 21, 2023)*

Objection overruled by *Pate v. Pac. Harbor Line, Inc., 2024 U.S. Dist. LEXIS 113152 (C.D. Cal., Feb. 6, 2024)*

Core Terms

medical record, discovery, Subpoenas, protective order, motion to quash, records, visited, emotional distress damages, medical provider, burdensome, privacy interest, parties, argues, termination, disclosure, non-party, requests, Defendants', objects, medical information, documents, quotation, damages, marks, right to privacy, undue burden, privacy, oppressive, withdraw, grounds

Counsel: **[*1]** For Lonnie Pate, Plaintiff: Tanya Sukhija-Cohen, Hadsell Stormer Renick and Dai LLP, Pasadena, CA.

Judges: Shashi H. Kewalramani, United States Magistrate Judge.

Opinion by: Shashi H. Kewalramani

Opinion

CIVIL MINUTES—GENERAL

Proceedings (IN CHAMBERS): ORDER GRANTING PLAINTIFF'S MOTION TO QUASH SUBPOENAS FOR PLAINTIFF'S MEDICAL RECORDS AND FOR PROTECTIVE ORDER [ECF NO. 56]

On January 13, 2023, Lonnie Pate ("Plaintiff") filed a Notice of Motion and Motion to Quash Defendants' Subpoenas and for Protective Order ("Motion to Quash" or "MTQ"). Electronic Case Filing Number ("ECF No.") 56. On January 23, 2023, Pacific Harbor Line, Inc. ("PHL"), Anacostia Rail Holdings Company ("Anacostia"), and Does 1-10 (collectively, "Defendants") filed an Opposition to Plaintiff's Motion to Quash ("Opposition" or "Opp'n"). ECF No. 65. And on January 30, 2023, Plaintiff filed a Reply in Support of the Motion to Quash ("Reply"). ECF No. 68.

After reviewing the parties' arguments, for the reasons set forth in this Order, the Court **GRANTS** Plaintiff's Motion to Quash.

I. BACKGROUND

A. Procedural History

On August 2, 2021, Plaintiff filed a Complaint alleging various claims arising from his employment and dismissal by Defendants. ECF No. 1. On **[*2]** September 29, 2021, the Court granted the parties a Joint Stipulation for Order Allowing Plaintiff to file a First Amended Complaint, ECF No. 17, and on October 4, 2021, Plaintiff filed a First Amended Complaint ("FAC"). ECF No. 18. On October 18, 2021, Defendants filed an Answer to the FAC, ECF No. 19, and a Corrected Answer to the FAC ("Corrected Answer"), ECF No. 21.

On December 28, 2021, the Court entered an Order referring the case to private mediation to be completed by November 25, 2022. ECF No. 36. On August 31, 2022, the parties filed a Joint Stipulation for an Order, inter alia, Granting the Parties Entry into Agreed Upon Limited Pre-Mediation Discovery. ECF No. 43, "Joint Discovery Stipulation." On September 1, 2022, the Court entered an Order Granting in Part and Denying in Part the Joint Discovery Stipulation, continuing the case schedule by approximately two months. ECF No. 44. On November 9, 2022, the parties filed a Joint Stipulation to Further Continue Trial, Pretrial Discovery, and Motion Deadlines, ECF No. 45, which the Court granted on November 22, 2022, ECF No. 46.

On December 6 and 13, 2022, at the request of the parties, the Court held informal discovery dispute **[*3]** conferences. See ECF Nos. 48-49. On December 16, 2022, Plaintiff filed a Stipulation for Protective Order, ECF No. 50, which the Court granted on December 22, 2022, ECF No. 51. On January 3 and 4, 2023, the Court held continued informal discovery dispute conferences and ordered the parties to "further meet and confer regarding the scope of the discovery that is being sought by Defendants related to physicians identified by Plaintiff," ECF No. 53, Minutes re Continued Informal Discovery Dispute at 1, and to "propose a briefing schedule with respect to the subpoenas and [Requests for Production] at issue that pertain to the medical providers and medical records," ECF No. 54, Minutes re Continued Informal Discovery Dispute at 1.

On January 13, 2023, Plaintiff filed the instant Motion to Quash. ECF No. 56. The same day, Plaintiff filed an Application to file document exhibits 1-3 to the Declaration of Bryan Olney in Support of Plaintiff's Motion to Quash under seal, ECF No. 57, which the Court denied on January 20, 2023, ECF No. 64. On January 23, 2023, Defendants filed the Opposition to the Motion to Quash. ECF No. 65. On January 27, 2023, the Court held an additional informal discovery **[*4]** dispute conference. See ECF No. 67. And on January 30, 2023, Plaintiff filed the Reply in Support of the Motion to Quash. ECF No. 68.

B. The Disputed Discovery

At issue are subpoenas duces tecum (the "Subpoenas") making requests "regardless of date" for the following types of records:

> any and all medical records, documents, medical reports, including doctors' entries, nurses' charts, progress reports, physical therapy records, pathology reports, x-ray reports, lab reports, case history, emergency room records, admitting sheets, special tests, inpatient and outpatient records, and any sign-in sheets pertaining to the care and treatment, diagnosis, prognosis, condition, discharge, insurance records, all billings, statement of charges, statements of accounts, writings, and documents reflecting the following: any and all payments made or received in reference to [Plaintiff], any and all credits, adjustments, write-offs, reconciliations, contract price payments or reduction, payments by any health insurance entity, personal payments by or to said patient from any source, HMO, PPO, Medi-Cal, Medicare or contract payments by any entity concerning said patient, billing ledgers, reports and/or **[*5]** statements of charges rendered and any insurance records, . . . this request for records includes any and all evidence of any payments from any source regarding the account of this patient to

> or from any person and/or entity, . . . including all patient orders and patient results and specifically for any discharge orders, all detailed screen shots within any computer system affecting or relating to [Plaintiff],

that were noticed to each of the following medical providers:

> Dr. Ronald Kvitne; Dr. Harvey Brown; Dr. William H. Dillin; Dr. Veronica Valadez-Salcido; Dr. Gary Baker; Atlantis Eye Care (a.k.a. Azul Vision); Dr. John Greenfield; Onsyte Imaging MRI; Dr. Johnathan Frank; Dr. Nitesh Patel; Dr. Jos Santz; Sheridan Chiropractic; Dr. Edward Stokes; Dr. Lyman Wood; Dr. Thomas A. Curtis; and Paul Araullo, NP.

Also at issue are the following Requests for Production (the "RFPs") served by Defendants and initial responses provided by Plaintiff:

> **RFP No. 60**:
> All medical records from medical providers that YOU visited from January 1, 2016 to present.
>
> **Response to RFP No. 60**:
>
> Plaintiff hereby . . . objects to this Document Request as irrelevant, burdensome, oppressive and not calculated to lead to **[*6]** the discovery of admissible evidence, particularly in light of his withdrawal of emotional distress damages in connection with his claims. Subject to and without waiving these objections, Plaintiff responds as follows: Plaintiff has withdrawn his request for emotional distress damages in connection with his claims.
>
> **RFP No. 74**:
> All medical records from Atlantis Eye Care that YOU visited from January 1, 2001 to the present.
>
> **Response to RFP No. 74**:
> Plaintiff hereby . . . objects to this Document Request on the grounds that it seeks information that is overbroad and burdensome to the extent this Document Request seeks "all documents." Plaintiff further objects that Plaintiff's discovery and investigation is ongoing and not yet complete. Plaintiff reserves the right to supplement and/or amend this Document Request when further discovery is completed. Plaintiff further objects to this Document Request on the grounds that it seeks information that is overbroad as to time and thus burdensome and harassing.
>
> Plaintiff objects that this Document Request seeks information protected privacy rights of Plaintiff and third parties under the California and U.S. Constitutions and HIPAA. Plaintiff objects **[*7]** to this Document Request as irrelevant, burdensome, oppressive and not calculated to lead to the discovery of admissible evidence as there no basis to believe that Plaintiff saw this provider in connection with any allegations in the complaint. Plaintiff further objects to this Document Request as irrelevant, burdensome, oppressive and not calculated to lead to the discovery of admissible evidence in light of his withdrawal of emotional distress damages in connection with his claims.
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> **RFP No. 75**:
> All medical records from Dr. Paul Araullo - ROADS Community Care Clinic that YOU visited from January 1, 2001 to the present.
>
> **Response to RFP No. 75**:
>
> Plaintiff hereby . . . objects to this Document Request on the grounds that it seeks information that is overbroad and burdensome to the extent this Document Request seeks "all documents." Plaintiff further objects that Plaintiff's discovery and investigation is ongoing and not yet complete. Plaintiff reserves the right to supplement and/or amend this Document Request when further discovery is completed. Plaintiff further objects to this Document Request on the grounds that it seeks information that is overbroad as to time and thus burdensome and **[*8]** harassing. Plaintiff objects that this Document Request seeks information protected privacy rights of Plaintiff and third parties under the California and U.S. Constitutions and HIPAA. Plaintiff objects to this

Document Request as irrelevant, burdensome, oppressive and not calculated to lead to the discovery of admissible evidence in light of his withdrawal of emotional distress damages in connection with his claims.

RFP No. 76:
All medical records from Dr. Gary Baker - Advanced Pain Specialists of Southern California that YOU visited from January 1, 2001 to the present.

Response to RFP No. 76:
[Identical to Response to RFP No. 74]

RFP No. 77:
All medical records from Dr. Harvey Brown that YOU visited from January 1, 2001 to the present.

Response to RFP No. 77:
[Identical to Response to RFP No. 74]

RFP No. 78:
All medical records from Dr. Thomas A. Curtis that YOU visited from January 1, 2001 to the present.

Response to RFP No. 78:
[Identical to Response to RFP No. 75]

RFP No. 79:
All medical records from Dr. William H. Dillin that YOU visited from January 1, 2001 to the present.

Response to RFP No. 79:
[Identical to Response to RFP No. 74]

RFP No. 80:

All medical records from Dr. Jonathan M. Frank **[*9]** that YOU visited from January 1, 2001 to the present.

Response to RFP No. 80:
[Identical to Response to RFP No. 74]

RFP No. 81:
All medical records from Dr. John Greenfield that YOU visited from January 1, 2001 to the present.

Response to RFP No. 81:
[Identical to Response to RFP No. 74]

RFP No. 82:
All medical records from Dr. Ronald Kvitne and LA Regional Surgical Center that YOU visited from January 1, 2001 to the present.

Response to RFP No. 82:
[Identical to Response to RFP No. 74]

RFP No. 83:
All medical records from Dr. Ronald Kvitne that YOU visited from January 1, 2001 to the present.

Response to RFP No. 83:
[Identical to Response to RFP No. 74]

RFP No. 84:
All medical records from Onsyte Imaging MRI that YOU visited from January 1, 2001 to the present.

Response to RFP No. 84:
[Identical to Response to RFP No. 74]

RFP No. 85:
All medical records from Dr. Nitesh C. Patel, M.D. - California Back & Pain Specialists that YOU visited from January 1, 2001 to the present.

Response to RFP No. 85:
[Identical to Response to RFP No. 74]

RFP No. 86:
All medical records from Dr. Jos Santz - Precision Medical Group that YOU visited from January 1, 2001 to the present.

Response to RFP No. 86:

[Identical to Response **[*10]** to RFP No. 74]

RFP No. 87:
All medical records from Sheridan Chiropractic that YOU visited from January 1, 2001 to the present.

Response to RFP No. 87:
[Identical to Response to RFP No. 74]

RFP No. 88:
All medical records from Dr. Edward G. Stokes - Eaton and Stokes Medical Group that YOU visited from January 1, 2001 to the present.

Response to RFP No. 88:
[Identical to Response to RFP No. 74]

RFP No. 89:
All medical records from Dr. Veronica Valadez-Salcido - Hess Rehabilitation Centers that YOU visited from January 1, 2001 to the present.

Response to RFP No. 89:
[Identical to Response to RFP No. 74]

RFP No. 90:
All medical records from Dr. David Lyman Wood that YOU visited from January 1, 2001 to the present.

Response to RFP No. 90:
[Identical to Response to RFP No. 74]

C. The Parties' Arguments

1. Plaintiff's Motion to Quash

In the Motion to Quash, Plaintiff argues the Court should quash the Subpoenas "in their entirety and issue a protective order relieving [Plaintiff] and his medical providers of any obligation to respond to PHL's document demands" because: (1) Plaintiff's medical records are not relevant; (2) the Subpoenas are overbroad and unduly burdensome; and (3) Plaintiff's medical records **[*11]** are protected by his right to privacy. ECF No. 56, MTQ at 8-9.

(a) Background

Plaintiff states that he is a black 62-year-old man who worked for Defendant PHL from 2002-2016. Id. at 9. During his employment with PHL, Plaintiff was subjected to racist abuse. Id. at 10. On October 29, 2016, Plaintiff was working as the engineer on a locomotive that was involved in a collision with another train car (the "blind shove"). Id. On November 1, 2016, PHL issued a notice of fact-finding alleging that Plaintiff was responsible for the accident; on November 8, 2016, PHL held a hearing on the matter; and on November 21, 2016, PHL sent Plaintiff a notice of termination. Id. Neither the notice of fact-finding, the hearing transcript, nor the notice of termination referenced Plaintiff's vision, pain medication, or health status. Id.

Plaintiff filed the operative FAC on October 4, 2021, claiming race discrimination, harassment, hostile work environment, and retaliation. Id. at 10-11. On July 18, 2022, PHL served its first set of RFPs, which included broad requests for Plaintiff's medical records, but the parties reached an agreement to engage in more limited discovery, pursuant to which Plaintiff produced **[*12]** a list of medical providers and 173 pages of medical records for his mental healthcare providers, Drs. Araullo and Curtis, "redacting information of treatment that was not for injuries" related to Defendants' actions. Id. at 11. On November 21, 2022, PHL served its second set of RFPs, seeking "[a]ll medical records" from January 1, 2001 to the present for each of the medical providers Plaintiff disclosed. Id. On December 21, 2022, Plaintiff notified Defendants that he was "no longer seeking to recover emotional distress damages and the unredacted records from his therapists were therefore irrelevant and privileged and would not be produced." Id. at 12. The same day, Defendant noticed the Subpoenas on Plaintiff's medical providers. Id. On December 29, 2022, Plaintiff served objections to RFP Nos. 60 and 74-90. Id.

On January 15, 2023, Plaintiff served second amended responses to certain of Defendants' interrogatories, "clarifying that he is not seeking any emotional distress damages." Id. at 12-13. On January 11, 2023, PHL informed Plaintiff that it would withdraw its Subpoenas without prejudice, except as to (1) doctors for whom Plaintiff sought treatment for mental health or psychiatry; **[*13]** (2) doctors who treated Plaintiff around the time of the blind shove; and (3) doctors who treated Plaintiff for the eye issues that he disclosed during his deposition in this case. Id. at 13. PHL has not indicated whether it will also withdraw the RFPs seeking the same documents as the withdrawn Subpoenas and has not yet taken demonstrable steps to withdraw the Subpoenas. Id.

(b) Arguments

First, Plaintiff argues that the Court has broad authority under *Federal Rule of Civil Procedure ("Rule") 45(d)(3)(A)* to quash subpoenas that would require "disclosure of privileged or other protected matter" or "subject[] a person to undue burden." Id. at 16. A party has standing to move to quash subpoenas served on third parties where they seek information for which the objecting party claims a personal right or privilege. Id. (citation omitted). In the third-party context, courts often demand a stronger-than-usual showing of relevance. Id. (citations and internal quotation marks omitted). Ninth Circuit courts have repeatedly quashed subpoenas for non-parties' records on grounds of relevance, burden, and overbreadth. Id. at 16-17 (collecting cases). This Court should likewise quash the Subpoenas on grounds of privacy, relevance, burden, and overbreadth. **[*14]** Id. at 17.

Second, Plaintiff argues that the Court has authority under *Rule 26* to issue a protective order relieving Plaintiff and his medical providers of any obligation to comply with the Subpoenas and RFPs. Id. Under *Rule 26(b)*, the scope of permissible discovery is limited to "nonprivileged matter that is relevant to any party's claim or defense and proportional to the needs of the case," and a court must limit the "extent of discovery otherwise allowed" if it determines "the proposed discovery is outside the scope permitted by *Rule 26(b)(1)*." Id. at 17-18 (citations omitted). Further, under *Rule 26(c)(1)*, a court may "issue an order to protect a party or person from annoyance, embarrassment, oppression, or undue burden or expense" by, among other things, forbidding "disclosure or discovery." Id. at 18. And a party can move for a protective order regarding a subpoena served on a non-party that seeks irrelevant information. Id. (citations omitted). Plaintiff "challenges Defendant's subpoenas and RFPs on each of the above-mentioned grounds." Id.

Third, Plaintiff argues his medical records are not relevant to this case. Courts have repeatedly found "that mental health and medical records are not relevant or discoverable where **[*15]** the plaintiff has not placed their medical condition at issue,"[1] and even "a claim for emotional distress damages does not render the plaintiff's medical records relevant where the plaintiff seeks only 'garden variety' damages."[2] Id. at 19. Plaintiff argues that like the medical records in Bofl and Kalter, Plaintiff has not placed any medical or mental health condition or treatment at issue—none of Plaintiff's claims relate to a physical injury or disability and Plaintiff is no longer seeking even "garden variety" emotional distress damages, rendering his medical records irrelevant. Id. at 20.

Plaintiff next argues that the Subpoenas are overbroad and unduly burdensome and that because Defendant served RFPs seeking all the subpoenaed records from Plaintiff, the Subpoenas are unduly harassing, duplicative, and unnecessary. Id. at 20-21.

Finally, Plaintiff argues that even if his medical records were relevant, they are protected from disclosure by his constitutional right to privacy. Id. at 21. The Ninth Circuit has repeatedly recognized a constitutionally protected interest in avoiding disclosure of medical information. Id. (collecting cases). To resolve a privacy objection, a court must **[*16]** balance the need for the information sought against the implicated privacy right, and "[e]ntry of a protective order does not obviate the need for the court to conduct a balancing analysis." Id. at 21-22 (citations and internal quotation marks omitted). A plaintiff's right to medical privacy can protect disclosure of their medical information even where the plaintiff claims severe emotional distress.[3] Id. at 22. Plaintiff argues his privacy interests are particularly strong because he "makes no claim for emotional distress damages" and "has not placed his medical condition at issue" by, for example, alleging a claim based on disability. Id. at 23.

2. Defendants' Opposition to the Motion to Quash

Defendants argue that the Court should deny the Motion to Quash because Plaintiff's medical records are relevant, their relevance outweighs Plaintiff's privacy interests, and Defendants are willing to narrow their Subpoenas, and that Plaintiff has not shown good cause for the issuance of a protective order. ECF No. 65, Opp'n at 5-7.

(a) Background

Defendants state that Plaintiff was terminated from PHL in 2016 for "an admitted safety violation" where Plaintiff's actions "resulted in a collision," **[*17]** he "failed to timely report the accident," and he "left the premises without authority." Id. at 5. Further, "a neutral arbitrator found the termination was proper. Id. Plaintiff later filed this action, claiming that his termination was improper and that while he worked for PHL, he was subjected to racial discrimination, a hostile work environment, and retaliation. Id.

(b) Arguments

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[1] Plaintiff cites *Bofl Fed. Bank v. Erhart, No. 15-cv-2353 BAS (NLS), 2016 U.S. Dist. LEXIS 103576, at *13-14 (S.D. Cal. Aug. 5, 2016)*, where the court denied the portion of a motion to compel production that related to the defendant's medical documents and communications, finding that the documents were irrelevant because the defendant had no claim for emotional distress damages and had not placed his medical condition at issue.

[2] Plaintiff cites *Kalter v. Keyfactor, Inc., No. 21-cv-1707-L-DDL, 2022 U.S. Dist. LEXIS 208353, at *1-2 (S.D. Cal. Nov. 16, 2022)*, where the court denied a motion to compel discovery regarding the plaintiff's medical records, finding that such records were not relevant because the parties had stipulated that the plaintiff would limit her claims for emotional distress damages to those an "ordinary person would likely experience in similar circumstances."

[3] Plaintiff cites *Fritsch v. City of Chula Vista, 187 F.R.D. 614, 615-17 (S.D. Cal. 1999)*, where the court quashed subpoenas seeking plaintiff's psychological and medical records, finding the plaintiff's privacy interest in such records outweighed their potential relevance.

Defendants argue that the movant bears the burden of persuasion in a motion to quash a subpoena, and if that burden is met, the issuing party must demonstrate that the "information sought is relevant and material to the allegations and claims at issue." Id. at 8 (citations omitted). Beyond their relevance to claims for emotional distress damages, courts in this district have found that medical records can be relevant to assess a plaintiff's underlying facts, id. at 9 (citing *Carter-Mixon v. City of Tacoma, No. C21-05692-LK, 2022 U.S. Dist. LEXIS 170752, 2022 WL 4366184 (W.D. Wash. Sept. 20, 2022)*, and to assess a plaintiff's credibility, id. (citing *Doe v. City of Chula Vista, 196 F.R.D. 562, 567 (S.D. Cal. 1999)*).

First, Defendants argue Plaintiff's medical records are relevant as they reflect facts relating to the underlying action. Id. As an example, Defendants cite Carter-Mixon, an excessive force case in which the court granted a motion to compel production of medical records so defendants **[*18]** could evaluate the underlying facts of the incident, including plaintiff's cause of death, projected lifespan, likely future earnings, and emotional response to past altercations with police. Id. (citing *2022 U.S. Dist. LEXIS 170752, 2022 WL 4366184, at *3-4*). Here Plaintiff's medical records are similarly relevant to the underlying claims. Id. at 10. Plaintiff has identified his therapists as fact witnesses with knowledge and information that support, inter alia, his discrimination claim. Id. Defendants believe these records will also shed light on the "circumstances which gave rise to Plaintiff's termination." Id. Further, in a separate state court action (the "Shields Action"), Plaintiff "testified that his depression, stress, anxiety, and loss of self-esteem" were attributable to his unhabitable living conditions caused by a housing corporation and occurring around the time of the blind shove that led to Plaintiff's termination from PHL; therefore, the medical records are "after-acquired evidence of Plaintiff's likely compromised mental and physical health at the time." Id. Lastly, Plaintiff's medical records are relevant to his claim for lost wages and his ability to mitigate damages because they will reflect Plaintiff's "ability **[*19]** . . . to generate income following his employment with PHL." Id.

Second, Defendants argue Plaintiff's medical records are relevant because Plaintiff has put his credibility and medical history at issue. Id. Defendants cite to City of Chula Vista, where the court found that plaintiff's medical records were relevant for defendants "to test the truth of Doe's contention that she is emotionally upset because of the defendants' conduct.'" Id. at 11 (quoting *196 F.R.D. at 567*). Here, Plaintiff has placed his credibility and his medical history at issue because: (1) Plaintiff testified in the Shields Action that a different entity caused the damages he avers PHL caused; and (2) Plaintiff testified in this action that he has been suffering from an eye condition that caused him to take a "long period of time" to review exhibits at his deposition, but Plaintiff has identified only one medical provider that is an eye specialist and he only saw this provider "for less than a year before March 2015"; thus, the medical records will allow Defendants to test the "veracity of this testimony." Id. at 11-12.

Third, Defendants state they do not oppose narrowing the Subpoenas or RFPs. Id. at 13. Defendants could not do so **[*20]** sooner because before the Motion to Quash, Plaintiff had "refused to give additional information about his medical providers," so Defendants had been unable to determine what medical records might be relevant. Id. at 13-14. But now, based on Plaintiff's representations, Defendants will limit their Subpoenas and RFPs to:

> records which specifically name PHL and for Dr. Veronica Valadez-Salcido (RFP Nos. 60, 89); Dr. Gary Baker (RFP Nos. 60, 76); Atlantis Eye Care (a.k.a. Azul Vision) (RFP No. 74); Dr. John Greenfield (RFP No. 81); Onsyte Imaging MRI (RFP No. 84); Dr. Thomas A. Curtis (RFP No. 78); and Paul Araullo, NP (RFP Nos. 60, 75).

Id. at 14. Defendants will withdraw the remaining RFPs and subpoenas that are the subject of the instant Motion without prejudice. Id.

Finally, Defendants argue the relevance of Plaintiff's medical records outweighs his privacy interests. Id. The right to medical privacy is not absolute and must be balanced against the need for the information sought. Id. (citation omitted). Here, "Plaintiff does not [specifically] explain how the requested information violates his right to privacy." Id. at 15. Moreover, Plaintiff's privacy interests are protected by the **[*21]** stipulated Protective Order entered in this matter, a point Plaintiff admitted during the December 13, 2022 conference call with the Court. Id. Comparatively, Defendants have offered numerous reasons for why certain of Plaintiff's medical records are relevant and necessary. Id.

Defendants argue the Court should also deny Plaintiff's Motion for a Protective Order because Plaintiff has not shown good cause for the issuance of such an order as required by *Rule 26(c)*. Id. at 15. The party seeking a protective order bears the burden "'for each particular document it seeks to protect, of showing that specific prejudice or harm will result if no protective order is granted.'" Id. at 16 (quoting *Contratto v. Ethicon, Inc., 227 F.R.D. 304, 307 (N.D. Cal. 2005)*). "'Broad allegations of harm, unsubstantiated by specific examples or articulated reasoning do not satisfy the *Rule 26(c)* test.'" Id. (quoting *Contratto, 227 F.R.D. at 307*). Here, Plaintiff has "failed to articulate any harm that might result, except for some generalized invasion of his right to privacy," whereas Defendants have "shown that the records are critical and relevant." Id.

3. Plaintiff's Reply in Support of the Motion to Quash

In his Reply, Plaintiff argues Defendants have failed to demonstrate they are entitled to the discovery sought **[*22]** by their Subpoenas. ECF No. 68, Reply at 2. First, Plaintiff argues Defendants are "not entitled to Plaintiff's medical records to impeach his credibility where he has no emotional distress claims." Id. Plaintiff's testimony in the Shields Action is not relevant because Plaintiff is no longer seeking emotional distress damages and private medical records are not "discoverable for impeachment purposes on purely collateral matters." Id. Similarly, the cases Defendants rely on to argue that Plaintiff's medical records are relevant are "easily distinguishable because in each, the plaintiff sought emotional distress damages." Id. at 2-3.

Second, Plaintiff argues Defendants advanced new arguments in the Opposition for their entitlement to Plaintiff's records but are "grasping at straws." Id. at 4. Contrary to Defendants' characterization, Plaintiff's mental health providers are not "fact witnesses." Id. Plaintiff listed his therapists in response to Defendants' interrogatories as witnesses only "to the extent they could testify about [Plaintiff's] emotional distress" and only prior to dismissing his emotional distress claims. Id. And "[w]here a claim . . . has been withdrawn, it is no longer **[*23]** relevant to the case." Id. at 5 (citation omitted). Further, Defendants misrepresented the "after-acquired evidence" doctrine, under which an "employer can limit damages 'by coming forward with after-acquired evidence of an employee's misconduct, but only if it can prove . . . it would have fired the employee for that misconduct.'" Id. (quoting *Rivera v. NIBCO, Inc., 364 F.3d 1057, 1071 (9th Cir. 2004)*). Employers are not permitted "to use 'the discovery process to engage in wholesale searches for evidence that might serve to limit its damages for its wrongful conduct.'" Id. (citing *Rivera, 364 F.3d at 1072*).

Finally, Plaintiff avers that Defendants made several misrepresentations to the Court. Id. at 6. Namely: (1) "Defendants' claim that they could not narrow their [S]ubpoenas until Plaintiff filed his [Motion to Quash] misrepresents the record"; and (2) Defendants misrepresent the record by claiming that Plaintiff was unable to review exhibits during his deposition. Id.

II. DISCUSSION

A. General Legal Standards Regarding Discovery

Rule 26(b)(1) governs the scope of permissible discovery and provides:

> Unless otherwise limited by court order, the scope of discovery is as follows: Parties may obtain discovery regarding any nonprivileged matter that is relevant to any party's claim **[*24]** or defense and proportional to the needs of the case, considering the importance of the issues at stake in the action, the amount in controversy, the parties' relative access to relevant information, the parties' resources, the importance of the discovery in resolving the issues, and whether the burden or expense of the proposed discovery outweighs its likely benefit. Information within this scope of discovery need not be admissible in evidence to be discoverable.

Relevancy, for discovery purposes, "has been construed broadly to encompass any matter that bears on, or that reasonably could lead to other matters that could bear on, any issue that is or may be in the case." *Nguyen v. Lotus by Johnny Dung Inc., No. 8:17-cv-01317-JVS-JDE, 2019 U.S. Dist. LEXIS 122787, 2019 WL 3064479, at *1 (C.D. Cal. June 5, 2019)* (internal citations and quotation marks omitted). "Generally, the purpose of discovery is to remove surprise from trial preparation so the parties can obtain evidence necessary to evaluate and resolve their dispute." *Duran v. Cisco Sys., Inc., 258 F.R.D. 375, 378 (C.D. Cal. 2009)* (internal citations and quotation marks omitted).

Because discovery must be both relevant and proportional, the right to discovery, even plainly relevant discovery, is not limitless. See *Fed. R. Civ. P. 26(b)(1)*; *Nguyen, 2019 U.S. Dist. LEXIS 122787, 2019 WL 3064479, at *1*. Discovery may be denied where: "(i) the discovery sought is unreasonably cumulative or duplicative, or can be obtained **[*25]** from some other source that is more convenient, less burdensome, or less expensive; (ii) the party seeking discovery has had ample opportunity to obtain the information by discovery in the action; or (iii) the proposed discovery is outside the scope permitted by *Rule 26(b)(1)*." *Fed. R. Civ. P. 26(b)(2)(C)*.

"The party seeking to compel discovery has the burden of establishing that its request satisfies the relevancy requirements of *Rule 26(b)(1)*. The party opposing discovery then has the burden of showing that the discovery should be prohibited, and the burden of clarifying, explaining or supporting its objections." *Bryant v. Ochoa, No. 07cv200 JM (PCL), 2009 U.S. Dist. LEXIS 42339, 2009 WL 1390794, at * 1 (S.D. Cal. May 14, 2009)*. "The party opposing discovery is 'required to carry a heavy burden of showing' why discovery should be denied." *Reece v. Basi, No. 2:11-CV-2712 TLN (AC), 2014 U.S. Dist. LEXIS 78307, 2014 WL 2565986, at *2 (E.D. Cal. June 6, 2014)*, aff'd, *704 F. App'x 685 (9th Cir. 2017)* (quoting *Blankenship v. Hearst Corp., 519 F.2d 418, 429 (9th Cir. 1975)*).

Finally, "[t]he district court enjoys broad discretion when resolving discovery disputes, which should be exercised by determining the relevance of discovery requests, assessing oppressiveness, and weighing these factors in deciding whether discovery should be compelled." *United States ex rel. Brown v. Celgene Corp., No. CV 10-3165 GHK (SS), 2015 U.S. Dist. LEXIS 189371, 2015 WL 12731923, at *2 (C.D. Cal. July 24, 2015)* (internal citations and quotation marks omitted).

B. Legal Standards Regarding Motions to Quash Subpoenas

A party may obtain discovery by serving a subpoena pursuant to *Rule 45*. The "scope of discovery permitted by subpoena under *Rule 45* **[*26]** is the same as that permitted under *Rule 26*," that is, "a party may obtain discovery of any matter that is relevant to a claim or defense and that is 'proportional to the needs of the case, considering the importance of the issues at stake in the action, the amount in controversy, the parties' relative access to relevant information, the parties' resources, the importance of the discovery in resolving the issues, and whether the burden or expense of the proposed discovery outweighs its likely benefit.'" *In re Perez by Allen, No. 20-mc-80191-VKD, 2020 U.S. Dist. LEXIS 226180, 2020 WL 7056024, at *2 (N.D. Cal. Dec. 2, 2020)* (citing *Rules 45* and *26(b)(1)*).

Under *Rule 45*, a court "must quash or modify a subpoena" that, inter alia, "requires disclosure of privileged or other protected matter, if no exception or waiver applies," or "subjects a person to undue burden." *Fed. R. Civ. P. 45(d)(3)(A)(iii)-(iv)*. "To determine whether a subpoena imposes undue burden on the recipient, the Court must balance the relevance of information sought, the requesting party's need for the information, and the extent of the burden imposed." *In re Allergan, Inc. Sec. Litig., No. 14-cv-02004-DOC (KES), 2016 U.S. Dist. LEXIS 186537, 2016 WL 5922717, at *3 (C.D. Cal. Sept. 14, 2016)*; see also *Gonzales v. Google, Inc., 234 F.R.D. 674, 680 (N.D. Cal. 2006)* ("Thus, a court determining the propriety of a subpoena balances the relevance of the discovery sought, the requesting party's need, and the potential hardship to the party subject to the subpoena.") (citation omitted).

"In a motion to quash a subpoena issued in civil litigation, . . . the burden of persuasion is borne by the movant." *IPCom GMBH & Co. KG v. Apple Inc., 61 F. Supp. 3d 919, 922 (N.D. Cal. 2014)*. The objecting party must state specifically why a subpoena is overbroad, unduly burdensome, or oppressive, see *Thomas v. Hickman, No. 1:06-*

*cv-00215-AWI-SMS, 2007 U.S. Dist. LEXIS 95796, 2007 WL 4302974, at *6 (E.D. Cal. Dec. 6, 2007)*, and objections that are overly general will be waived, see *Ramirez v. Cnty. of Los Angeles, 231 F.R.D. 407, 409 (C.D. Cal. 2005)*. If the moving party meets its burden, the issuing party must then demonstrate "that the information sought is relevant and material to the allegations and claims at issue in the proceedings." *Green v. Baca, 226 F.R.D. 624, 654 (C.D. Cal. 2005)* (citation and internal **[*27]** quotation marks omitted).

Third and non-parties "are subject to the same discovery obligations . . . under [Rule] 45" as parties to the case, "including the obligation to respond to subpoenas for documents and testimony." *United States v. Acad. Mortg. Corp., 968 F.3d 996, 1006 (9th Cir. 2020)* (citing *Exxon Shipping Co. v. U.S. Dep't of Interior, 34 F.3d 774, 779 (9th Cir. 1994)*). But when third or non-party "discovery obligations become onerous, *Rule 45* allows the subject of a subpoena to file a motion to quash." Id. A party may also have standing to seek to quash a subpoena issued to a non-party where "'the objecting party claims some personal right or privilege with regard to the documents sought.'" *Crispin v. Christian Audigier, Inc., 717 F. Supp. 2d 965, 973-74 (C.D. Cal. 2010)* (quoting 9A Charles Wright & Arthur Miller, Fed. Prac. & Proc. § 2459 (3d ed. 2008)); see also *Moon v. SCP Pool Corp., 232 F.R.D. 633, 636 (C.D. Cal. 2005)* ("A party cannot object to a subpoena duces tecum served on a nonparty, but rather, must seek a protective order or make a motion to quash.").

Although the general scope of discovery for parties and non-parties is the same, courts may consider non-party status when determining whether discovery restrictions are necessary. See *Dart Indus. Co. v. Westwood Chem. Co., 649 F.2d 646, 649 (9th Cir. 1980)* ("[T]here appear to be quite strong considerations indicating that discovery would be more limited to protect [non-]parties from harassment, inconvenience, or disclosure of confidential documents.") (citation and internal quotation **[*28]** marks omitted). Indeed, in "the third-party subpoena context, . . . courts have often demanded a stronger-than-usual showing of relevance, requiring the requesting party to demonstrate that its need for discovery outweighs the nonparty's interest in nondisclosure." *Briggs v. Cnty. of Maricopa, No. CV-18-02684-PHX-EJM, 2021 U.S. Dist. LEXIS 61386, 2021 WL 1192819, at *3 (D. Ariz. Mar. 20, 2021)* (citation and internal quotation marks omitted).

C. Legal Standards Regarding Motions for Protective Orders

Under *Rule 26*, a "party or any person from whom discovery is sought may move for a protective order" and "the court may, for good cause, issue an order to protect a party or person from annoyance, embarrassment, oppression, or undue burden or expense," by, among other things, "forbidding the disclosure or discovery," "prescribing a discovery method other than the one selected by the party seeking discovery," and "forbidding inquiry into certain matters, or limiting the scope of disclosure or discovery to certain matters" *Fed. R. Civ. P. 26(c)(1)(A)-(D)*.

The "party seeking a protective order bears the burden of showing good cause for the order by demonstrating harm or prejudice that will result from the discovery." *Apple Inc. v. Samsung Elecs. Co., Ltd., 282 F.R.D. 259, 262-63 (N.D. Cal. 2012)* (citing *Rivera v. NIBCO, Inc., 364 F.3d 1057, 1063 (9th Cir. 2004)*). When deciding whether to issue a protective order preventing or limiting discovery, a court may consider factors such as the relevance **[*29]** of the requested materials, breadth of the requests, potential harm of disclosure to the movant, and the movant's reasonable privacy interests in the materials. See *Rivera, 364 F.3d at 1064*; *Prado v. Equifax Info. Servs. LLC, 331 F.R.D. 134, 139 (N.D. Cal 2019)*. Generally, *Rule 26(c)* "confers broad discretion on the . . . court to decide when a protective order is appropriate and what degree of protection is required." *Al Otro Lado, Inc. v. Nielsen, 328 F.R.D. 408, 415 (S.D. Cal. 2018)* (citation and internal quotation marks omitted).

D. Analysis

As an initial matter, the Court finds that Plaintiff has standing to seek to quash the Subpoenas issued to his non-party medical providers, as Plaintiff claims a personal right of privacy in the medical documents and information sought via the Subpoenas. See *Crispin, 717 F. Supp. 2d at 973-74*; *Moon, 232 F.R.D. at 636*.

And, cognizant of the subpoenaed medical providers' non-party status, see *Dart Indus. Co, 649 F.2d at 649*, the Court finds that the Subpoenas seek protected materials and that responding to the requests would subject Plaintiff's medical providers to undue burden. Similarly, the Court finds that the RFPs broadly seek personal medical information that is no longer particularly relevant to this action, but in which Plaintiff has a strong privacy interest.

Thus, after careful review of the parties' moving papers and the relevant law, the Motion to Quash the Subpoenas will be granted pursuant **[*30]** to *Rule 45(d)(3)(A)* and the Motion for a Protective Order from any obligation to further respond to the RFPs will be granted pursuant to *Rule 26(c)(1)*.

1. The Subpoenas and RFPs are Overly Broad and Unduly Burdensome

Under *Rule 45*, the Court "must quash or modify a subpoena" if it "subjects a person to undue burden." *Fed. R. Civ. P. 45(d)(3)(A)(iv)*. To determine whether a subpoena imposes an undue burden, the Court "must balance the relevance of information sought, the requesting party's need for the information, and the extent of the burden imposed." *In re Allergan, 2016 U.S. Dist. LEXIS 186537, 2016 WL 5922717, at *3*. And under *Rule 26(c)(1)*, the Court may issue a protective order preventing discovery that would subject a person to an undue burden, considering factors such as the relevance of the requested materials, breadth of the requests, and the movant's reasonable privacy interests. See *Rivera, 364 F.3d at 1063-64*.

In this case, the Subpoenas and RFPs seek a broad range of materials. The Subpoenas, for example, seek "any and all medical records, documents, medical reports," and a wealth of other medical and financial information regarding Plaintiff's treatment "regardless of date." See ECF No. 56-2, MTQ Exh. 11 (emphasis added). The RFPs are similarly broad, most requesting that Plaintiff produce "[a]ll medical records" from each of the medical providers **[*31]** "from January 1, 2001 to the present," a 22-year period. See Id., MTQ Exh. 12. Even the more limited Subpoenas and RFPs Defendants propose would be overly broad and unduly burdensome. Defendants offer to narrow their Subpoenas to requests for "records which specifically name PHL" and records from Drs. Valadez-Salcido, Baker, Greenfield, and Curtis, NP Araullo, Atlantis Eye Care, and Onsyte Imaging MRI, and to limit their RFPs to Nos. 60, 74, 75, 76, 78, 81, 84, 89. ECF No. 65, Opp'n at 14. These requests would still capture a huge range of sensitive medical information. Defendants have not, for example, narrowed the requests only to records related to Plaintiff's former work functions at PHL, limited the time period covered by the Subpoenas, or narrowed the Subpoenas to remove requested billing, financial, and insurance-related materials, the relevance of which seems even more tenuous than Plaintiff's actual medical treatments. The Court is particularly sensitive to the time and resources that would be required of the non-party medical providers to locate and produce the materials sought by the Subpoenas. See *Gonzales, 234 F.R.D. at 683* ("This Court is particularly concerned anytime enforcement of a subpoena **[*32]** imposes an economic burden on a non-party."). In sum, the Court finds that the Subpoenas and RFPs are broad and would impose an extensive burden on Plaintiff and his medical providers, which favors granting the Motion to Quash. See *Rivera, 364 F.3d at 1064*; *In re Allergan, 2016 U.S. Dist. LEXIS 186537, 2016 WL 5922717, at *3*.

Moreover, it does not appear that Defendants have any great need for the medical information sought by the Subpoenas and RFPs. See *Gonzales, 234 F.R.D. at 680*. Defendants argue that the medical information sought by the Subpoenas and RFPs is necessary to shed light on the "circumstances which gave rise to Plaintiff's termination," show that Plaintiff's mental and physical health were likely compromised at the time of his termination, and assess the findings of Plaintiff's mental health providers since Plaintiff intends to use them as "fact witnesses." ECF No. 65, Opp'n at 10. These arguments are unpersuasive for several reasons. One, Plaintiff does not intend to rely on his mental health providers as fact witnesses in this case. Rather, Plaintiff states that: (1) his therapists were

only "witnesses" to the extent they could have testified regarding his emotional distress, but that Plaintiff has withdrawn his emotional distress claims; (2) the only knowledge Plaintiff's therapists **[*33]** have of this case "comes from Plaintiff's hearsay statements"; and (3) Plaintiff identified his mental health clinicians in response to an interrogatory that sought "facts, witnesses" not "fact witnesses" as Defendants now represent. ECF No. 68, Reply at 4. The Court finds all of these arguments highly persuasive.

Further, Defendants do not have a strong need to use Plaintiff's medical records to determine Plaintiff's condition during, and the general circumstances around, his termination because Plaintiff does not dispute that he was involved in the blind shove that purportedly caused his termination, he merely argues that non-black employees had been punished less severely for similar infractions. See ECF No. 56, MTQ at 10. In short, the Court finds that Plaintiff's medical records are not particularly necessary to Defendants' case, especially given that Plaintiff has withdrawn his claims for emotional distress damages, which further weighs in favor of granting the Motion to Quash.

The limited relevance of the materials requested by the Subpoenas and RFPs and Plaintiff's strong privacy interests in his medical records, both of which favor granting Plaintiff's Motion to Quash—see *Rivera, 364 F.3d at 1063-64*; **[*34]** *In re Allergan, 2016 U.S. Dist. LEXIS 186537, 2016 WL 5922717, at *5*—are discussed in more detail subsequently in this Order.

Overall, the Court finds that both the Subpoenas and the RFPs are overly broad and unduly burdensome, which supports granting Plaintiff relief under *Rules 26* and *45*.

2. The Subpoenas and RFPs Do Not Seek Relevant Information

Generally, under *Rules 26* and *45*, a party may obtain discovery of any matter that is relevant to a claim or defense, meaning any matter that "bears on, or that reasonably could lead to other matters that could bear on, any issue that is or may be in the case." *Nguyen, 2019 U.S. Dist. LEXIS 122787, 2019 WL 3064479, at *1*.

While relevancy is broadly construed, here, the Court finds that the RFPs and Subpoenas seek medical information unrelated to any condition put in issue by Plaintiff; thus, such information is irrelevant and not discoverable. See *Doe v. Presiding Bishop of the Church of Jesus Christ of Latter-Day Saints, 837 F. Supp. 2d 1145, 1157 (D. Idaho 2011)* ("Medical records unrelated to the conditions put in issue by a plaintiff are not relevant and are thus not discoverable[.]").

Plaintiff argues that Ninth Circuit courts frequently find that mental health and medical records are not relevant where the plaintiff has not placed a medical condition at issue, and that even a claim for emotional distress damages does not necessarily render a plaintiff's medical records relevant if the plaintiff is only **[*35]** seeking "garden variety" damages. ECF No. 56, MTQ at 19. Here, Plaintiff argues his medical records are not relevant because, inter alia, none of his claims relate to any physical injury or disability and he is not seeking emotional distress damages. Id. at 19-20. Defendants argue that Plaintiff's medical records are relevant to "evaluating the underlying facts of this matter" and because Plaintiff has placed his medical history and credibility at issue. ECF No. 65, Opp'n at 9-12.

The Court finds Plaintiff's arguments persuasive and agrees that Plaintiff's medical records are not relevant because Plaintiff has not placed any medical or psychological condition at issue in this case. See *Redon v. Ruiz, No. 13cv1765-WQH (KSC), 2015 U.S. Dist. LEXIS 163801, 2015 WL 13229500, at *6 (S.D. Cal. Dec. 4, 2015)* (finding that a plaintiff's medical records are not relevant unless they are related to a condition that plaintiff puts in issue in the case); *Baptiste v. Lids, No. C 12-05209 PJH (MEJ), 2013 U.S. Dist. LEXIS 150413, 2013 WL 5708201, at *2 (N.D. Cal. Oct. 18, 2013)* (finding that information regarding a party's medical diagnosis and treatment is generally not discoverable unless "the patient's specific medical condition is placed into issue"). The cases Defendants cite in opposition are distinguishable, as in each the plaintiffs sought emotional distress damages—see, e.g., *Carter-Mixon, 2022 U.S. Dist. LEXIS 170752, 2022 WL 4366184, at *4* ("Plaintiffs have placed Mr. Ellis's

mental health **[*36]** history at issue by asserting damages for lost enjoyment of life, loss of consortium, and more than 'garden variety' emotional distress as a result of Defendants' actions."); *City of Chula Vista, 196 F.R.D. at 563* ("She alleges that these violations have directly and proximately caused her to suffer damages in the form of severe emotional distress.")—unlike Plaintiff here, who has withdrawn his claims for emotional distress damages. The Court agrees with Plaintiff that by withdrawing these claims, Plaintiff has greatly decreased, if not altogether eliminated, the relevance of records concerning his psychiatric or psychological treatment.

The Court further finds that medical records regarding Plaintiff's eye condition are not relevant to this action because: (1) Plaintiff is not bringing any claim or seeking any damages that relate to his eye condition, rather, this case centers on allegations that Plaintiff was discriminated against based on his race, subjected to a hostile work environment, and wrongfully terminated for conduct for which non-black employees had been punished less severely, see ECF No. 56, MTQ at 9-10; (2) Defendants have never suggested that Plaintiff was, or would have been, terminated from PHL because **[*37]** of issues with his eyesight and are not permitted to "use[] the discovery process to engage in . . . 'fishing expeditions'" on the chance they find a post facto justification to limit their damages,[4] see *Rollins v. Traylor Bros., No. C14-1414-JCC, 2017 U.S. Dist. LEXIS 69211, 2017 WL 1756576, at *2 (W.D. Wash. May 5, 2017)* (quoting *Rivera, 364 F.3d at 1072*); and (3) Plaintiff did not place his eyesight at issue in this case, so as to justify discovery of private medical records related to his eye condition, merely by "struggl[ing] to read exhibits at deposition," ECF No. 65, Opp'n at 11, and Defendants have offered little support for their allegation that Plaintiff has "repeatedly provid[ed] knowingly false testimony" on this matter, id. at 12.

Thus, the Court finds that the medical information sought by the Subpoenas and RFPs is not relevant to any claim or defense in this action, which favors granting Plaintiff relief under *Rules 26* and *45*.

3. The Information Sought is Not Sufficiently Material to Overcome Plaintiff's Privacy Interests

Finally, the Motion to Quash and for a Protective Order will grant because Defendants have not overcome Plaintiff's privacy interest in his personal medical records.

The Court agrees with Plaintiff that he has a strong privacy interest in his medical records that militates against these materials being discoverable. **[*38]** See *Tucson Woman's Clinic v. Eden, 379 F.3d 531, 551 (9th Cir. 2004)* ("Individuals have a constitutionally protected interest in avoiding disclosure of personal matters, including medical information.") (citation and internal quotation marks omitted), abrogated on other grounds by *Dobbs v. Jackson Women's Health Org., 142 S. Ct. 2228, 213 L. Ed. 2d 545 (2022)*; *Norman-Bloodsaw v. Lawrence Berkeley Lab'y, 135 F.3d 1260, 1269 (9th Cir. 1998)* ("The constitutionally protected privacy interest in avoiding disclosure of personal matters clearly encompasses medical information and its confidentiality."); *Doe v. Beard, 63 F. Supp. 3d 1159, 1164 (C.D. Cal. 2014)* ("The right to medical privacy [is] recognized by the Ninth Circuit as a constitutionally protected right[.]"); *Miesegaes v. Allenby, No. CV 15-01574 CJC (RAO), 2020 U.S. Dist. LEXIS 89806, 2020 WL 2542064, at *4 (C.D. Cal. Mar. 13, 2020)* (In the discovery context, "[t]he Court recognizes the significant privacy interest in medical records."); see also *Artis v. Deere & Co., 276 F.R.D. 348, 353 (N.D. Cal. 2011)* ("[T]he privacy interests at stake in the names, addresses, and phone numbers must be distinguished from those more intimate privacy interests such as compelled disclosure of medical records[.]").

To resolve a privacy objection during discovery, the Court must balance the need for the information sought against the privacy right asserted. See *Keith H. v. Long Beach Unified Sch. Dist., 228 F.R.D. 652, 657 (C.D. Cal. 2005)*;

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[4] To the extent Defendants seek Plaintiff's medical records related to issues other than his mental health and eyesight, the Court considers such information similarly irrelevant because: (1) Plaintiff's physical health is unrelated to his claims and he has not placed any medical conditions at issue; (2) Defendants do not suggest Plaintiff was terminated because of health issues and the Court will limit a wholesale review of Plaintiff's medical history on this basis; and (3) Plaintiff does not dispute that he was involved in the blind shove, so to whatever extent Defendants seek information to suggest that Plaintiff's physical health contributed to the blind shove, it is not sufficiently material to overcome Plaintiff's privacy interest in his medical records.

Soto v. City of Concord, 162 F.R.D. 603, 619 (N.D. Cal. 1995). And, as discussed, Defendants do not appear to have a strong need for Plaintiff's medical records in this case, see supra at section II.D.1, whereas Plaintiff has a strong privacy interest in his medical records, see *Tucson Woman's Clinic, 379 F.3d at 551*, especially considering **[*39]** that Defendants seek a broad range of Plaintiff's physical and mental health information dating back twenty years, see ECF No. 56-2, MTQ Exhs. 11-12. Thus, Plaintiff's privacy rights outweigh the need for the information Defendants seek via the Subpoenas and RFPs, which favors granting Plaintiff's Motion to Quash.

In sum, Plaintiff has demonstrated that the Subpoenas and RFPs are overly broad and unduly burdensome and that his privacy interests in his medical records override their limited potential materiality to this action. As such, Plaintiff's Motion to Quash Defendants' Subpoenas and for Protective Order is **GRANTED**.

III. CONCLUSION

For the reasons set forth above, Plaintiff's Motions to Quash and for a Protective Order are **GRANTED**, Defendants' Subpoenas are **QUASHED**, and a protective order shall be **ISSUED** relieving Plaintiff and his medical providers of the obligation to comply with, or provide any further responses to, RFP Nos. 60 and 74-90.

IT IS SO ORDERED.

End of Document

Pearson v. Cincinnati Ins. Co.

United States District Court for the Central District of California

April 14, 2025, Decided; April 14, 2025, Filed

2:24-cv-3370-SB-PDx

Reporter
2025 U.S. Dist. LEXIS 92488 *; 2025 LX 17385; 2025 WL 1386821

Eric Pearson v. The Cincinnati Insurance Co., et al.

Prior History: *Pearson v. Cincinnati Ins. Co., 2025 U.S. Dist. LEXIS 92669 (C.D. Cal., Apr. 10, 2025)*

Core Terms

Subpoena, DOCUMENTS, discovery, records, repair, motion to quash, costs, storm, invoices, projects, pertain, quashing a subpoena, non-party

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Judges: Patricia Donahue, United States Magistrate Judge.

Opinion by: Patricia Donahue

Opinion

CIVIL MINUTES — GENERAL

Proceedings (In Chambers): Order Granting in Part and Denying In Part Counter-Defendants' Motion to Quash Subpoena to Third Party Bank of America [Dkt. No. 56]

Counter-Defendants Mathew Simmons and Solutions by Simmons (collectively "Simmons") filed a motion to quash the subpoena issued by Defendant and Counterclaimant The Cincinnati Insurance Company ("Cincinnati") to third party Bank of America ("B of A") for documents in an account at B of A that belongs to Simmons (the "Subpoena"). The Court has considered the pertinent pleadings [Dkt. Nos. 56, 58, 60] and the arguments of counsel.

For the reasons set **[*3]** forth below, the motion is granted in part and denied in part. The Subpoena lists ten categories of documents to be produced. The motion to quash is granted as to Categories one through eight and denied as to Categories nine and ten.

I. Background

Plaintiff's home sustained water damage from a storm on January 9, 2023. Plaintiff submitted a claim under his Cincinnati homeowners policy. In the process of repairing the storm damage to his home, Plaintiff discovered pre-existing construction deficiencies unrelated to the storm and consequently undertook a complete remodel of the home. The policy issued by Cincinnati provided coverage for the damage resulting from the storm, with a dwelling policy limit of $2.2 million, but excluded coverage for costs to remedy construction deficiencies that pre-existed the storm and were not caused by it.

A dispute arose involving segregation of costs incurred to repair the storm damage from those incurred to repair construction defects that pre-existed the storm. On March 1, 2024, Plaintiff filed his Complaint against Cincinnati alleging breach of contract and breach of the implied covenant of good faith and fair dealing based on Cincinnati's alleged failure **[*4]** to pay all of the costs Plaintiff incurred in repairing his home. [Dkt. No. 1-1 at 4-17, Complaint.][1] Plaintiff hired Simmons to provide construction management services for the repairs of water damage at Plaintiff's property. [Dkt. No. 56-1, Declaration of Matthew Simmons, ¶ 3.]

Cincinnati filed a counterclaim against Plaintiff and Simmons for declaratory relief, fraud—intentional misrepresentation, fraud—concealment, negligent misrepresentation, rescission and unjust enrichment. [Dkt. No. 93.]

On November 11, 2024, Cincinnati served B of A with a subpoena for documents in Simmons' B of A account (the "Subpoena"). [Dkt. Nos. 58-1, 58-2.] The Subpoena calls for B of A to produce:

1. All DOCUMENTS RELATING TO the ACCOUNT from January 1, 2023 to the present.
2. All DOCUMENTS RELATING TO statements YOU sent and/or generated RELATING to SIMMONS from January 1, 2023 to the present.
3. All DOCUMENTS RELATING TO statements YOU sent and/or generated RELATING to the ACCOUNT from January 1, 2023 to the present.
4. All DOCUMENTS RELATING TO the monthly balance of the ACCOUNT from January 1, 2023 to the present.

5 All DOCUMENTS RELATING TO deposits into the ACCOUNT from January 1, 2023 to the present. **[*5]**
6. All DOCUMENTS RELATING TO any loan requests and/or applications by SIMMONS to YOU from January 1, 2023 to the present.
7. All DOCUMENTS RELATING TO any loans YOU offered to SIMMONS from January 1, 2023 to the present.

[1] The Court uses the page numbers placed on the document by the electronic docketing system.

8. All DOCUMENTS RELATING TO any loans YOU gave or made to SIMMONS from January 1, 2023 to the present.

9. All DOCUMENTS RELATING TO the PROPERTY.[2]

10. All DOCUMENTS RELATING TO the LOSS.[3]

[Dkt. No. 58-2.]

II. Applicable Law

A. *Rule 26*

Federal Rule of Civil Procedure 26(b) provides that parties may obtain discovery regarding:

> any nonprivileged matter that is relevant to any party's claim or defense and proportional to the needs of the case, considering the importance of the issues at stake in the action, the amount in controversy, the parties' relative access to relevant information, the parties' resources, the importance of the discovery in resolving the issues, and whether the burden or expense of the proposed discovery outweighs its likely benefit.

Fed. R. Civ. P. 26(b)(1). Relevant information "need not be admissible in evidence to be discoverable." *Id.* A court "must limit the frequency or extent of discovery otherwise allowed" if "(i) the discovery sought is unreasonably cumulative or duplicative, or can be obtained from some other source **[*6]** that is more convenient, less burdensome, or less expensive; (ii) the party seeking discovery has had ample opportunity to obtain the information by discovery in the action; or (iii) the proposed discovery is outside the scope permitted by *Rule 26(b)(1)*." *Fed. R. Civ. P. 26(b)(2)(C)*.

B. Third-Party Discovery under *Rule 45*

Rule 45 governs discovery of non-parties by subpoena. The scope of discovery that can be obtained by a subpoena under *Rule 45* is the same as that under *Rule 26(b)*. *See Fed. R. Civ. P. 45* Advisory Comm.'s Note (1970). The Court must quash or modify a subpoena that subjects a person to undue burden. *Fed. R. Civ. P. 45(3)(A)*. The party seeking to quash a subpoena has the burden of persuasion under *Rule 45(d)(3)*. *See, e.g., Travelers Indem. Co v. Metropolitan Life Insur. Co., 228 F.R.D. 111, 113 (D. Conn. 2005)*; *Wiwa v. Royal Dutch Petroleum Co., 392 F.3d 812, 818 (5th Cir. 2004)*.

C. Standing to Challenge the Subpoena

Although the Ninth Circuit has not defined the full scope of a party's standing to challenge a non-party subpoena, courts generally find that "a party may not quash a subpoena served upon a non-party on any grounds other than privilege." *M.S. v. Angus*, No. 2:23-cv-09957-MWF-MAR, 2025 WL 819722, at * 3 (C.D. Cal. Feb. 11, 2025) (quotation omitted). In this district, courts have entertained a party's challenges to non-party subpoenas based on relevance or proportionality in the context of a motion for a protective order under *Rule 26*. *Id.* Courts typically require that a party has a "personal right or privilege with regard to the documents **[*7]** sought." *Crispin v. Christian Audigier, Inc., 717 F. Supp. 2d 965, 973 (C.D. Cal. 2010)*.

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[2] The Property is defined by its address and is Plaintiff's property for which Plaintiff filed the claim with Cincinnati that gave rise to this action.

[3] The Loss is defined as the alleged water damage that occurred at Plaintiff's Property.

Here, Simmons argues that they are asserting personal rights over the records of their account at B of A and thus have standing to file the motion to quash. The Court agrees and finds that Simmons has standing to move to quash the Subpoena.

III. Analysis

As an initial matter, Cincinnati contends that the motion to quash is untimely, in that it had to be filed by November 25, 2024, and was not filed until December 12, 2024. [Dkt. No. 58 at 4.] Regardless of whether the motion is timely, the Court considers it on the merits.

Simmons requests that the Court quash the Subpoena on several grounds.

A. Relevance, Proportionality and Necessity

Simmons argues that its bank records are not relevant to the claims and defenses in this case and not necessary because Cincinnati obtained the documents directly from Simmons. [Dkt. No. 56 at 10-11, 14.] Cincinnati responds that Plaintiff claims to have incurred over $8.3 million in repairs to his home, and that the scope of coverage and the costs actually incurred for the repair work managed by Simmons are issues at the heart of this lawsuit. Cincinnati contends these issues are also relevant to its affirmative defenses that Plaintiff and others **[*8]** were responsible for the damages alleged in the Complaint, that the doctrine of unclean hands applies, that the damages were caused by the acts and/or omissions of others and by intervening and superseding acts of Plaintiff and others. [Dkt. No. 58 at 6.] According to Cincinnati, it has uncovered conduct by Plaintiff and others, including Simmons, that brings into question the validity of certain costs purportedly incurred. Cincinnati states, "As evidenced by charts and logs produced by both Plaintiff and Simmons, there are several invoices and proof of payments which are missing, and there exists a large discrepancy between what Plaintiff and Simmons allege was paid for repairs to Plaintiff's home, and what was actually incurred by same." [Id. at 2, 7.] Cincinnati's opposition to Simmons' motion specifies discrepancies, and possibly fraud, in Simmons' invoices for work allegedly performed on Plaintiff's property. [*See* Id. at 7-8; Dkt. No. 58-5.] The Counterclaim identifies additional invoices submitted to Cincinnati by Plaintiff, through Simmons and Solutions by Simmons, that Cincinnati alleges are fraudulent. [Dkt. No. 93 ¶¶ 15-24; *see also* Dkt. No. 58-1, Declaration of Angela Zanin **[*9]** ¶¶ 5-8, Dkt Nos. 58-5 through 58-8 (deposition testimony of contractors inconsistent with invoices submitted by Simmons).]

Simmons argues that Cincinnati "can and should seek the status of payment directly from the specific contractors it believes have or have not been paid." [Dkt. No. 56 at 11.] Simmons also argues the Subpoena is unnecessary because it already produced records in response to the subpoena it received from Cincinnati. Simmons cites *Nidec Corp. v. Victor Co. of Japan, 249 F.R.D. 575, 578 (N.D. Cal. 2007)*, in which the court quashed a subpoena to a third party because most of the discovery sought from the third party was obtainable from the party defendant. However, there is no indication in *Nidec* that the reliability of the party discovery was in question. Here, by contrast, Cincinnati has found discrepancies in the documents produced by Simmons as well as by Plaintiff. The Court agrees with Cincinnati that Simmons' bank records pertaining to Plaintiff's property are relevant and proportional for several reasons, including that Cincinnati is entitled to compare the information in the bank records to the discovery produced by Plaintiff and by Simmons.

B. Privacy and Confidentiality

Simmons contends that the Subpoena violates privacy and confidentiality **[*10]** interests. Simmons' discussion of this objection focuses on the overbreadth of the requested categories. As discussed below, the Court agrees with Simmons as to several categories. Moreover, Simmons can designate the records it produces as "CONFIDENTIAL" under the protective order in this case. [*See* Dkt. No. 38.]

C. Undue Burden

Simmons contends that the Subpoena imposes an undue burden, primarily because of the overbreadth of its categories. Simmons declares that its "accounts at Bank of America do not pertain solely to Plaintiff's property at issue in this lawsuit" and "reflect transactions for multiple clients, on multiple projects."[4] [Dkt. No. 56-1, Declaration of Matthew Simmons ¶ 5.] Simmons "occasionally pays subcontractors for more than one project in a single lump sum, making it exceedingly difficult — and time-consuming — to determine whether a portion of those lump sums relate specifically to Plaintiff's property in this case" and "[p]roducing financial records only associated with Plaintiff's property will require an extensive manual review and parsing of numerous transactions, dates, descriptions, and amounts." [Id. ¶ 6.] Simmons also states that he has non-disclosure agreements **[*11]** with certain clients, and consequently cannot share information about them and their projects. [Id. ¶ 7.]

Simmons' statements are somewhat inconsistent. To ensure compliance with the nondisclosure agreements, Simmons would need to segregate information regarding transactions involving those clients. Also, since Simmons only "occasionally" pays subcontractors for work on more than one project, it would not be unduly burdensome to look for instances where that occurred as to work on Plaintiff's property. In any event, Simmons must have a method to correlate subcontractor invoices with the projects where the work was performed so that Simmons can bill the client on whose property the work was conducted. This correlation would be critical for projects, such as Plaintiff's, where the invoices are submitted to an insurance company for payment under the terms of a policy.

However, the Court agrees with Simmons that the Subpoena is overbroad, in part. The Subpoena calls for ten categories of documents to be produced from the identified account at B of A. Two of them — categories nine and ten — seek relevant, proportional information. Category nine seeks all documents relating to the property **[*12]** for which Plaintiff filed the claim with Cincinnati that gave rise to this action. Category ten seeks all documents relating to the loss, which is defined as referring to the alleged water damage that occurred at Plaintiff's property on or about January 9, 2023. For all the reasons discussed above, these categories seek information relevant and proportional to the claims, defenses, and counterclaims in this case. Further, as to these two categories, Simmons has not shown that it is entitled to the costs associated with responding. Since Simmons is now a party, the cases it cites regarding the burden on non-parties are inapplicable. More importantly, as discussed above, Simmons must have a means of segregating information pertaining to the different clients and projects, and thus cannot show that it would be unduly burdensome to have B of A produce to Cincinnati the records from the one account identified in the Subpoena that pertain to Plaintiff's property and the records that pertain to the alleged water damage at that property on January 9, 2023. Accordingly, Simmons' request for reimbursement of its costs to respond to the Subpoena is denied.

As to the remainder of the Subpoena, **[*13]** Categories one through five are irrelevant and overbroad because they are not limited to Plaintiff's property or the damage thereto. These categories sweep in information pertaining to Simmons' other projects and clients, which have no demonstrable relevance to this matter. Categories six through eight seek information about loans applied for, offered to, or made to Simmons by B of A. Cincinnati does not explain the relevance of this information. Accordingly, the motion to quash categories one through eight is granted.

IV. Conclusion

For the reasons set forth above, the motion to quash is granted in part and denied in part. Cincinnati may serve the Subpoena along with a copy of the Order on B of A.

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[4] Although Simmons' declaration does not specify the account identified in the Subpoena [Dkt. No. 58-2 at 6], the Court presumes that the subpoena account is one of the "accounts at Bank of America" referenced in the Simmons Declaration.

IT IS SO ORDERED.

End of Document

Premer v. Corestaff Servs., L.P.

United States District Court for the Middle District of Florida, Tampa Division

August 4, 2005, Decided ; August 4, 2005, Filed

8:05-CV-00042-JDW-MAP

Reporter
232 F.R.D. 692 *; 2005 U.S. Dist. LEXIS 36067 **

CHARLENE PREMER, Plaintiff, v. CORESTAFF SERVICES, L.P., Defendant.

Core Terms

discovery, former employer, subpoena, after-acquired, evidence doctrine, independent basis, protective order, motion to quash, interrogatory, discovery of admissible evidence, reasonably calculated to lead, employment application, subpoena duces tecum, disciplinary action, district court, third party, fishing-expedition, intrusive, overbroad, personnel, terminate, routine, resist, style, hire

Case Summary

Procedural Posture
Plaintiff employee sought a protective order to quash subpoena duces tecum that defendant served on third parties who had been plaintiff's former employers. Plaintiff filed an action against defendant for alleged discrimination.

Overview
Defendant sought production from plaintiff's former employers, including production of all documentation, except medical records, that referenced plaintiff, including but not limited to documents in the personnel file and the benefits file. The court held that defendant's requests to obtain plaintiff's entire personnel and benefit files, records relating to her hiring, termination, performance, and discipline received were overbroad and not reasonably calculated to lead to the discovery of admissible evidence. The court noted that there was a discrepancy between plaintiff's employment application and her interrogatory responses, and limited production from the former employers was appropriate. Defendant had not provided sufficient supporting information to justify the broad search requested.

Outcome
The court granted plaintiff's motion to quash and for a protective order.

Counsel: [1]** For Charlene Premer, Plaintiff: Randall V. Shanafelt, Sharon A. Wey, Shanafelt Law Firm, P.A., Clearwater, FL.

For Corestaff Services, L.P., Defendant: Gail E. Farb, Ogletree, Deakins, Nash, Smoak & Stewart, P.C., Tampa, FL.

For Cary R. Singletary, Mediator, Pro se, Tampa, FL.

Judges: MARK A. PIZZO, UNITED STATES MAGISTRATE JUDGE.

Opinion by: MARK A. PIZZO

Opinion

232 F.R.D. 692, *692; 2005 U.S. Dist. LEXIS 36067, **1

[*692] ORDER

Plaintiff Charlene Premer seeks entry of a protective order (doc. 39) quashing subpoenas duces tecum Defendant served on third parties, Plaintiff's former employers. The subpoenas seek production of "any and all notes, memoranda, records, and documentation of any nature whatsoever (with the exception of medical records) which regard or reference CHARLENE PREMER . . . including but not limited to her personnel file and her benefit files as well as all records relating to her hiring, her termination, her performance, any disciplinary action received by her in the course of her employment, compensation, benefits and the like." Plaintiff claims the subpoenas are too remote in time (as far back as 1994), overbroad, seek confidential information, and are not reasonably **[*693]** calculated to lead to discovery of admissible evidence.

[2]** Defendant maintains the Plaintiff's motion to quash was untimely filed and the documents sought are relevant and reasonably calculated to lead to admissible evidence and to test the veracity of Plaintiff's future deposition testimony and written discovery responses. In support, Defendant states that while Plaintiff revealed six former employers in response to interrogatory three she disclosed only three of these former employers on her employment application. Defendant seeks to use the information obtained from the subpoenaed records to assist in establishing an after-acquired evidence defense.

Defendant's requests to obtain Plaintiff's entire personnel and benefit files, records relating to her hiring, termination, performance, any disciplinary action received by her in the course of her employment, compensation, and benefits, on its face, are overbroad and are not reasonably calculated to lead to the discovery of admissible evidence. Though the after-acquired evidence doctrine provides employers a mechanism to limit an employee's remedies based on evidence found during discovery, it should not be used as an independent basis to initiate discovery. In *McKennon v. Nashville Banner Publishing Co., 513 U.S. 352, 363, 115 S. Ct. 879, 130 L. Ed. 2d 852 (1995),* **[**3]** the United States Supreme Court recognized a "concern that employers might as a routine matter undertake extensive discovery into an employee's background or performance on the job to resist claims." Several district courts have limited employers' fishing-expedition style discovery based upon the Court's statements. *See EEOC v. Checkers Drive In Restaurants, Inc.,* 8:03-cv-568-T-24MAP (doc. 46) (granting plaintiffs' motion for protective order and quashing overly-broad third party subpoenas to plaintiffs' former employers); *Preston v. American Express Travel Related Services Co., Inc.,* 3:00CV312-J-25TJC (doc. 17) (stating that the after-acquired evidence doctrine provides no independent basis to initiate discovery of former employers designed to find evidence of past wrongdoing by the employee); *Graham v. Casey's General Stores, 206 F.R.D. 251, 256 (S.D. Ind. 2002)* (limiting employer's non-party subpoenas duces tecum in search of after- acquired evidence); *Yoscary v. Nederlander Organization, Inc.* 2001 WL 262754 (S.D.N.Y.) (finding defendant's interrogatories intrusive and limiting defendant's discovery of employee's background); *Perry v. Best Lock Corp.,* 1999 WL 33494858, **[**4]** *2 (S.D.Ind.) ("The [*McKennon*] Court's comment about potential abuse clearly implies that discovery is not warranted for the sole purpose of developing a possible after-acquired evidence defense.").

Because there is a discrepancy between Plaintiff's employment application and her interrogatory responses, limited production from her former employers is appropriate. However, even though Defendant argues the records requested may reveal Plaintiff made misrepresentations to it or to her pre-Corestaff employers and that such information would shed light on the her credibility, it has not provided any supporting information substantiating such a broad search. Likewise, Defendant failed to provide any reason to suspect Plaintiff made prior complaints of religious discrimination or retaliation during her previous employment, and thus production of records in this regard is overly intrusive and unnecessary. Accordingly, it is hereby

ORDERED:

1. The Plaintiff's Corrected Motion to Quash and for Protective Order (doc. 11) is GRANTED and the original subpoenas duces tecum propounded to Raymond James Financial, Randsted Employment Agency, Alps Corporation, Columbia Staffing, Spherion **[**5]** Atlantic Enterprises, and the Transportation Security Administration are QUASHED.

232 F.R.D. 692, *693; 2005 U.S. Dist. LEXIS 36067, **5

2. The Motion to Quash Subpoenas (doc. 9) is DENIED as moot.
DONE AND ORDERED in chambers at Tampa, Florida this 4th day of August, 2005.

MARK A. PIZZO

UNITED STATES MAGISTRATE JUDGE

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Silva v. Domino's Pizza

United States District Court for the Central District of California

July 22, 2019, Decided; July 22, 2019, Filed

SACV 18-2145 JVS (JDEx)

Reporter
2019 U.S. Dist. LEXIS 156189 *; 2019 WL 4187388

Eddie Silva v. Domino's Pizza, et al

Subsequent History: Motion granted by, in part, Motion denied by, in part, Without prejudice Silva v. Domino's Pizza, 2019 U.S. Dist. LEXIS 208426 (C.D. Cal., Sept. 30, 2019)

Counsel: [*1] For Eddie Silva on behalf of himself and all others similarly situated, Plaintiff: Aashish Y Desai, LEAD ATTORNEY, Desai Law Firm PC, Costa Mesa, CA USA; Maria Adrianne De Castro, Desai Law Firm PC, Costa Mesa, Ca.

For Dominos Pizza Llc, a Michigan Corporation, Defendant: Margaret A Keane, LEAD ATTORNEY, Eric Alejandro Ortiz, DLA Piper LLP, San Francisco, CA USA.

Judges: James V. Selna, United State District Judge.

Opinion by: James V. Selna

Opinion

CIVIL MINUTES - GENERAL

Proceedings: (IN CHAMBERS) Order Regarding Motion to Dismiss

Defendant Domino's Pizza ("Domino's") filed a motion to dismiss and motion to strike Plaintiff Eddie Silva's ("Silva") claims. (Mot., Dkt. No. 34-1.) Silva opposed the motion. (Opp'n, Dkt. No. 35.) Domino's filed a reply. (Reply, Dkt. No. 36.)

For the following reasons, the Court **defers** decision on Domino's motion to dismiss, **stays** the Private Attorney General Act ("PAGA") claims predicated on California meal and rest break violations, **denies** the motion to strike as to PAGA claims, and grants in part the motion to strike injunctive relief.

I. BACKGROUND

Silva alleges the following. Silva worked as a truck driver for Domino's Pizza from October 2005 to March 28, 2015 delivering products, including [*2] dough balls to Domino's various pizza stories. (First Amended Complaint ("FAC"), Dkt. No. 30 ¶ 1.) Silva drove out of Domino's Riverside facility and spent most of his time driving routes in California and drove routes through and in Orange County and the Los Angeles area. (Id.) From a nationwide network of 16 supply chain centers, Domino's supports its individual stores. (Id. ¶ 3.) The Domino's truck drivers drive a truck/trailer weighing nearly 80,000 pounds and deliver and unload various products (cheese, boxes, trays, meats, dough, and sauce). (Id. ¶¶ 1, 8.) The drivers also perform pre-trip duties, including "reviewing driver manifests, counting and checking customer invoices of products that have been loaded, moving tractors to the loading dock to attach pre-loaded trailers, completing required trailer temperature checks, and performing pre-trip safety inspections according to [Department of Transportation ("DOT")] regulations." (Id. ¶ 5.) After driving in accordance with strict delivery schedules, the drivers survey the customer's site for hazards, unload products from the trailer to designated storage areas, verify delivery of correct items, and collect payment when required. [*3] (Id.) Drivers then perform post-trip responsibilities such as unloading damaged

goods and customer returns, filling out paperwork, performing safety checks on the vehicle, and completing DOT logs and company vehicle maintenance reports. (Id.) Drivers occasionally drive back hauls and attend mandatory company meetings. (Id.)

Domino's pays its drivers piece-rate compensation based on the number of miles and the weight of the load they carry. (Id. ¶ 6.) Domino's does not pay its drivers for any of the pre or post-trip work that they perform nor waiting time during their routes. (Id. ¶¶ 6-7) Domino's also fails to provide rest and meal breaks in accordance with California law, as drivers are encouraged to skip them. (Id. ¶¶ 8, 12.) Domino's also fails to reimburse drivers for expenses, including those related to their cell phones, because drivers are required to purchase their own cell phones to communicate with and be available for Domino's. (Id. ¶ 9.) In addition, Domino's inaccurately computes the miles driven. (Id. ¶ 11b.) Because of these violations, Domino's fails to provide accurate, itemized wage statements, as well as all compensation due at the termination of employment. (Id. [*4] ¶ 10.)

On October 23, 2018, Silva filed a putative class action suit against Domino's on behalf of himself and all California drivers who performed work for Domino's under its piece-rate compensation scheme for (1) Violation of California PAGA; (2) failure to provide meal breaks; (3) failure to provide rest breaks; (4) failure to separately pay all wages for work performed; (5) failure to reimburse for work expenses; (6) failure to issue accurate itemized wage statements; (7) waiting time penalties; and (8) unfair business practices under Cal. Civ. Code § 17200 ("UCL"). (Complaint, Dkt. No. 1-1, Ex. A ¶ 23.)

On November 30, 2018, Domino's removed the case to this Court. (Not., Dkt. No. 1.) The parties then stipulated to allow Silva to file the FAC, alleging only PAGA claims, which Silva then filed. (FAC, Dkt. No. 30.)

II. LEGAL STANDARD

A. Motion to Dismiss

Under Rule 12(b)(6), a defendant may move to dismiss for failure to state a claim upon which relief can be granted. A plaintiff must state "enough facts to state a claim to relief that is plausible on its face." Bell Atl. Corp. v. Twombly, 550 U.S. 544, 570, 127 S. Ct. 1955, 167 L. Ed. 2d 929 (2007). A claim has "facial plausibility" if the plaintiff pleads facts that "allow[] the court to draw the reasonable inference that the defendant is liable for the [*5] misconduct alleged." Ashcroft v. Iqbal, 556 U.S. 662, 678, 129 S. Ct. 1937, 173 L. Ed. 2d 868 (2009).

In resolving a 12(b)(6) motion under Twombly, the Court must follow a two-pronged approach. First, the Court must accept all well-pleaded factual allegations as true, but "[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements, do not suffice." Iqbal, 556 U.S. at 678. Nor must the Court "'accept as true a legal conclusion couched as a factual allegation.'" Id. at 678-80 (quoting Twombly, 550 U.S. at 555). Second, assuming the veracity of well-pleaded factual allegations, the Court must "determine whether they plausibly give rise to an entitlement to relief." Id. at 679. This determination is context-specific, requiring the Court to draw on its experience and common sense, but there is no plausibility "where the well-pleaded facts do not permit the court to infer more than the mere possibility of misconduct." Id.

B. Motion to Strike

Under Rule 12(f), a party may move to strike any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter. Fed. R. Civ. P. 12(f). A motion to strike is appropriate when a defense is insufficient as a matter of law. Kaiser Aluminum & Chem. Sales, Inc. v. Avondale Shipyards, Inc., 677 F.2d 1045, 1057 (5th Cir. 1982). The grounds for a motion to strike must appear on the face of the pleading under attack, or from matters of which the Court may take judicial notice. [*6] SEC v. Sands, 902 F. Supp. 1149, 1165 (C.D. Cal. 1995).

The essential function of a Rule 12(f) motion is to "avoid the expenditure of time and money that must arise from litigating spurious issues by dispensing with those issues prior to trial." Fantasy, Inc. v. Fogerty, 984 F.2d 1524, 1527 (9th Cir. 1993), rev'd on other grounds by Fogerty v. Fantasy, Inc., 510 U.S. 517, 114 S. Ct. 1023, 127 L. Ed. 2d 455 (1994). "As a general proposition, motions to strike are regarded with disfavor because [they] are often used as delaying tactics, and because of the limited importance of pleadings in federal practice." Sands, 902 F. Supp. at 1165-66 (alteration in original) (internal quotation marks omitted).

Therefore, courts frequently require the moving party to demonstrate prejudice "before granting the requested relief, and 'ultimately whether to grant a motion to strike falls on the sound discretion of the district court.'" Greenwich Ins. Co. v. Rodgers, 729 F. Supp. 2d 1158, 1162 (C.D. Cal. 2010) (quoting Cal. Dep't of Toxic Substances Control v. Alco Pac., Inc., 217 F. Supp.2d 1028, 1033 (C.D. Cal. 2002)).

III. DISCUSSION

A. Motion to Dismiss

On December 28, 2018, the Federal Motor Carrier Safety Administration's (the "FMCSA") issued an order granting the American Trucking Associations ("ATA") and the Specialized Carriers and Rigging Association's ("SCRA") petition for determination that California Labor Code §§ 226.7 and 512 are preempted by 49 U.S.C. § 31141 as applied to property-carrying commercial motor vehicle drivers covered by the FMCSA's hours of service ("HOS") regulations. California's Meal and Rest Break ("MRB") Rules for Commercial [*7] Motor Vehicle ("CMV") Drivers; Petition for Determination of Preemption, 83 FR 67470-01 (Dec. 28, 2018). Specifically, the decision stated:

> [T]he FMCSA concludes that: (1) The MRB Rules are State laws or regulations "on commercial motor vehicle safety," to the extent they apply to drivers of property-carrying CMVs subject to the FMCSA's HOS rules; (2) the MRB Rules are additional to or more stringent than the FMCSA's HOS rules; (3) the MRB Rules have no safety benefit; (4) the MRB Rules are incompatible with the FMCSA's HOS rules; and (5) enforcement of the MRB Rules would cause an unreasonable burden on interstate commerce. Accordingly, the FMCSA grants the petitions for preemption of the ATA and the SCRA, and determines that the MRB Rules are preempted pursuant to 49 U.S.C. 31141. California may no longer enforce the MRB Rules with respect to drivers of property-carrying CMVs subject to FMCSA's HOS rules.

Id. at 67480 (emphasis added). The December 2018 decision reversed the FMCSA's prior position taken in 2008 that "the MRB Rules at issue cannot be regulation 'on commercial motor vehicle safety' because they 'cover far more than the trucking industry.'" Id. at 67471. See Petition for Preemption of California Regulations on Meal Breaks and Rest Breaks for Commercial Motor Vehicle Drivers; Rejection for Failure to Meet Threshold Requirement, 73 FR 79204 (Dec. 23, 2008), Desai Decl., Dkt. No. 35-3, Ex. B).

Domino's argues that Silva's PAGA claims for violations of California MRB [*8] laws as applied to the class are preempted by 49 U.S.C. § 31141, a provision of the Federal Motor Carrier Safety Act of 1984 (the "1984 Act") per the FMCSA determination and thus must be dismissed or stricken. (Mot., Dkt. No. 34-1 at 2-3.) See In re Garda Wage and Hour Cases, No. JCCP 4828 (Cal. Sup. Ct. 2019), Request for Judicial Notice ("RJN"), Dkt. No. 34-3, Ex. D;[1] Ayala v. U.S Xpress Enterprises, Inc., No. EDCV 16-137-GW(KKX), 2019 U.S. Dist. LEXIS 77089, 2019 WL 1986760, at *3 (C.D. Cal. May 2, 2019)

Silva instead contends that the FMCSA's 2018 decision was incorrect. (Opp'n, Dkt. No. 35 at 1.) But only circuit courts have jurisdiction to review that decision; thus, the Court does not consider arguments related to the merits of the FMCSA's decision. See 49 U.S.C. § 31141(f) and 28 U.S.C. § 2342(3)(A) (vesting federal appeals courts with exclusive jurisdiction to review the Secretary of Transportation's decisions regarding rules, regulations or final orders under 49 U.S.C. § 31141(c)). Silva next argues that the FMCSA decision is not retroactive and thus should not affect Silva's claims that accrued before December 28, 2018. (Id. at 1.) See Robert North v. Superior Hauling and Fast Transit, Inc., EDCV 18-2564 JGB (KKx) (C.D. Cal. May 31, 2019) (denying in part defendant's motion to dismiss California MRB claims accrued prior to the FMCSA's [*9] 2018 decision).[2]

After one of its attorneys expressed the position that the December 2018 FMCSA decision was not retroactive, the FMCSA later provided a legal opinion indicating its position that the decision does bar retroactive relief for California MRB claims for drivers covered by the HOS rules. FMCSA Legal Opinion of the Office of the Chief Counsel (March 22, 2019) at 1. Specifically, the opinion stated:

> FMCSA's legal opinion is that an FMCSA preemption decision under Section 31141 precludes courts from granting relief pursuant to the preempted State law or regulation at any time following issuance of the decision, regardless of whether the conduct underlying the lawsuit occurred before or after the decision was issued, and regardless of whether the lawsuit was filed before or after the decision was issued.

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[1] Under Federal Rule of Evidence 201, the Court may take judicial notice of matters of public record if the facts are not "subject to reasonable dispute." Lee v. City of Los Angeles, 250 F.3d 668, 688-89 (9th Cir. 2001); see Fed. R. Evid. 201(b). The Court takes judicial notice of the documents in the Requests for Judicial Notice ("RJN") filed by both parties pursuant to Fed. R. Evid. 201. All of the documents in the RJNs contain facts that "can be accurately and readily determined from sources whose accuracy cannot reasonably be questioned." Fed. R. Evid. 201(b)(2).

[2] Silva also cites a tentative order from a California Superior Court. Because the order is not finalized, the judge could change his or her mind; thus, the Court does not rely on it for purposes of this order. See Desai Decl. Dkt. No. 35-2, Ex. A.

Id. at 4 (emphasis added).

The reversal of FMCSA's position with respect to the preemption of California MRB Rules complicates claims, including those in this case, that are based on conduct that took place and were filed in the period between the 2008 and 2018 FMCSA decisions because they arose at a time when the FMCSA had determined that the California MRB Rules were *not* preempted. The FMCSA's [*10] stance is that the legal basis for enforcing those claims, although perhaps perfectly valid when filed, is now void. Id. at 3. The FMCSA characterizes the remaining lawsuits on claims that arose before the 2018 decision as involving somewhat prospective (rather than retroactive) relief since the State "may no longer enforce" the preempted MRB Rules as to these drivers and grating relief "unquestionably gives force and effect to that law." Id. Even if the relief is considered retroactive, the FMCSA takes the position that the presumption against retroactivity is overcome by Congress's intent to allow FMCSA decisions under Section 31141 to reach past claims when it stated that "a State may not enforce a State law or regulation on commercial motor vehicle safety that the Secretary decides under this section may not be enforced." Id. at 4 (citing 49 U.S.C. § 31141(a)).

Nonetheless, the FMCSA also appears to recognize that its position on its authority does not foreclose alternative interpretations by courts. See id. at 2, n.2 ("This opinion represents the considered views of the agency charged with administering Section 31141. Questions about the applicability of FMCSA preemption decisions to particular lawsuits will ultimately be determined by the courts presiding [*11] over those lawsuits, and litigants remain free to argue their own views on these issues."). One federal court in this district held that "the 2018 FMCSA Order takes away or impairs vested rights acquired under existing California state law" and the FMCSA decision is not retroactive because the court was "unable to identify . . . clear statutory authority granting the Secretary of Transportation the authority to promulgate retroactive preemption determinations." North, No. 18-2564 JGB (KKx), at 4, Desai Decl., Dkt. No. 35-4, Ex. C.

Silva also points out that the State of California has sought review of the FMCSA's 2018 Decision in the Ninth Circuit, and briefing is potentially set to be completed by October 9, 2019. (Opp'n, Dkt. No. 35 at 2.) See Labor Commissioner for the State of California v. Fed. Motor Carrier Safety Admin., No. 19-70329, (9th Cir. May 30, 2019) (denying motion to stay the FMCSA's determination of preemption pending review and establishing a briefing schedule in which respondents' consolidated answering brief is due October 9, 2019 and petitioners' optional consolidated reply brief is due within 21 days after service of the answering brief and an intervenor's optional reply brief within [*12] 35 days after service of respondents' brief). Silva contends that the Court should deny the motion to dismiss without prejudice "so that the Ninth Circuit has an opportunity to definitively settle whether the 2018 Decision preempts Plaintiff's [MRB] claims." (Opp'n, Dkt. No. 35 at 2.) Alternatively, Silva requests that the Court stay decision on the post-December 28, 2018 claims until the Ninth Circuit decides whether the California MRB claims in this context are preempted. (Id. at 7.)

The Court instead finds that a stay regarding all MRB claims as a basis for the PAGA action is appropriate pending decision by the Ninth Circuit in Labor Commissioner, No. 19-70329. The parties point out that there is a split of authority from judges within the Central District of California as to whether the 2018 FMCSA decision applies retroactively. Compare Ayala, 2019 WL 1986760, at *3 ("The Court currently has no authority to enforce the regulations under which Plaintiff brings his first cause of action. Therefore, the issue of retroactive effect is irrelevant.") with North, No. 18-2564 JGB (KKx), at 4. If the Ninth Circuit determines that California's MRB Rules are not preempted, however, the Court will not need to decide whether the FMCSA's 2018 decision [*13] applies retroactively because it will be wholly inapplicable to Silva's claims. Although the briefing will not be complete for several months, the Court believes that a stay on the MRB claims will best conserve the Court's and the parties' time and resources. Thus, the Court opts to await the Ninth Circuit's decision rather than make a determination affecting the case that may require undoing at a later time. Cf. Henry v. Cent. Freight Lines, Inc., No. 216CV00280JAMEFB, 2019 U.S. Dist. LEXIS 99594, 2019 WL 2465330, at *4 (E.D. Cal. June 13, 2019) (granting defendant's motion for summary judgment on California MRB claims, but stating that plaintiff may "move for reconsideration of this order should the Ninth Circuit invalidate the FMCSA Preemption Order"); Ayala, 2019 WL 1986760, at *3, n. 1 (same). If the Ninth Circuit ultimately decides that the California MRB claims are preempted, the Court will then determine whether the 2018 decision applies to those claims accrued before the date of decision. The Court directs the parties to file a Joint Report within ten (10) days of the Ninth Circuit's decision in Labor Commissioner, No. 19-70329. The parties may still proceed on Silva's other bases for the PAGA action, including those for failure to reimburse and failure to provide accurate wage statements [*14] to the extent it is based on inaccurate mileage.

B. Motion to Strike

Domino's also argues that Silva's PAGA claims should be stricken because they are unmanageable. (Mot., DKt. No. 34-1 at 7.) First, Domino's states that the PAGA claim for unpaid wages in unmanageable because "for each pay payroll period and for each aggrieved employee, Plaintiff must establish: (1) that the D&S Driver engaged in off-the-clock work; (3) that the time reflected in the payroll records is inaccurate; (3) the amount of time and pay discrepancy in the payroll records; (4) that the D&S Drivers were not compensated for off-the-clock work; and (5) that Domino's was aware of should have been aware that they were performing off-the-clock work." (Id. at 8.) Second, Domino's indicates that the reimbursement claim is unmanageable because "the necessity, frequency and expense of utilizing one's own phone for work purposes will vary by individual." (Id. at 9.) Third, Domino's contends that the MRB claims are unmanageable because "the Court would be required to determine (1) whether each individual took a particular meal or rest break (2) on a particular occasion and (3) [] if the individual skipped the break, why it was skipped for [*15] each of the aggrieved employees. (Id. at 10.)

Domino's recognizes that "district courts are divided as to whether a plaintiff may bring representative PAGA claims without satisfying Rule 23 requirements," but urges the Court to require that Silva either meet the Rule 23 standard by exercising its inherent authority to control its cases or determine that proceeding with a representative PAGA action would be unmanageable. (Id. at 5-6.) Compare Bowers v. First Student, Inc., No. 2:14-CV-8866-ODW EX, 2015 U.S. Dist. LEXIS 54238, 2015 WL 1862914, at *4 (C.D. Cal. Apr. 23, 2015) ("Some courts have stricken PAGA claims ruling that the third-party representative nature of PAGA claims warrants conformity to the procedural requirements of Rule 23. . . . Even if Rule 23 did not apply to PAGA representative claims, such claims can be stricken if they are found to be 'unmanageable.'") with Jordan v. NCI Grp., Inc., No. EDCV161701JVSSPX, 2017 WL 1821122, at *4 (C.D. Cal. Mar. 22, 2017) (quoting Plaisted v. Dress Barn, Inc., No. 2:12-CV-01679-ODW, 2012 U.S. Dist. LEXIS 135599, 2012 WL 4356158, at *1 (C.D. Cal. Sept. 20, 2012)) ("[T]he majority of federal courts facing these claims have . . . held that PAGA actions, though representative, need not be brought as class actions in which Rule 23's requirements are necessarily applicable.'") and Tseng v. Nordstrom, Inc., No. CV11-8471-CAS (MRWx), 2016 U.S. Dist. LEXIS 176790, 2016 WL 7403288, at *5 (C.D. Cal. Dec. 19, 2016) (quoting Zackaria v. Wal-Mart Stores, Inc., 142 F. Supp. 3d 949, 959 (C.D. Cal. 2015)) ("'Holding that individualized liability determinations make representative [*16] PAGA actions unmanageable, and therefore untenable,' would be inconsistent with PAGA's purpose, because it 'would impose a barrier on such actions that the state law enforcement agency does not face when it litigates those cases itself.'").

The Court is persuaded by the reasoning in Jordan and Tseng and declines to (1) hold Silva to the requirements of Fed. R. Civ. P. 23 for his PAGA action, (2) impose a manageability requirement, or (3) exercise its inherent authority to control its cases to strike the PAGA claims because doing so would be inconsistent with PAGA's purpose. The Court therefore denies Domino's motion to strike on this basis.

With respect to Domino's motion to strike injunctive relief, however, the Court grants the motion and strikes paragraph 9 of the FAC under the section "Request for Relief," as Silva does not have standing to pursue injunctive relief as a former employee. See Ellis v. Costco Wholesale Corp., 657 F.3d 970, 986 (9th Cir. 2011)

IV. CONCLUSION

For the foregoing reasons, the Court **grants** stays the PAGA action to the extent that it relies on California MRB claims pending decision from the Ninth Circuit in Labor Commissioner, No. 19-70329, denies the motion to strike PAGA claims, and grants in part the motion to strike a request for injunctive [*17] relief. The Court directs the parties to file a joint report within ten (10) days of decision by the Ninth Circuit.

IT IS SO ORDERED.

End of Document

Sky Fin. & Intel., LLC v. Cliq, Inc.

United States District Court for the Central District of California

September 24, 2024, Decided; September 24, 2024, Filed

8:22-cv-01670-ADS

Reporter
2024 U.S. Dist. LEXIS 185989 *

Sky Financial and Intelligence, LLC v. Cliq, Inc.

Prior History: *Sky Fin. & Intel., LLC v. Cliq, Inc., 2023 U.S. Dist. LEXIS 19768, 2023 WL 2629887 (C.D. Cal., Feb. 2, 2023)*

Core Terms

discovery, non-party, documents, Subpoena, relevant information, deposition, information relevant, scope of discovery, motion to compel, proportional, outweighed, defenses, reasons, thrust

Counsel: [*1] For Cliq Inc., a California Corporation, Defendant: James Cannon Huber, Joshua John Herndon, Global Legal Law Firm, Encinitas, CA.

For Sky Financial and Intelligence LLC, a limited liability company, Plaintiff: Steven Alan Heath, Heath Steinbeck LLP, Beverly Hills, CA; Oliver D. Griffin, Peter N. Kessler, PRO HAC VICE, Griffin Partners LLP, Philadelphia, PA.

For Jaspreet Mathur, Material Witness: Ronald N. Richards, Law Offices of Ronald Richards and Associates APC, Beverly Hills, CA.

Judges: Honorable Autumn D. Spaeth, United States Magistrate Judge.

Opinion by: Autumn D. Spaeth

Opinion

CIVIL MINUTES — GENERAL

Proceedings: (IN CHAMBERS) ORDER DENYING MOTION TO COMPEL DEPOSITION OF SABIN BURRELL AND PRODUCTION OF DISCOVERY (DKT. NO. 92)

Before the Court is Defendant Cliq, Inc.'s ("Cliq") Motion to Compel Deposition of Sabin Burrell and Production of Discovery (the "Motion"). (Dkt. No. 92.) By this Motion, Cliq seeks to compel deposition testimony and documents from Mr. Burrell, a non-party, based on a subpoena Cliq served pursuant to *Federal Rule of Civil Procedure 45* (the "Subpoena"). In addition to Mr. Burrell's deposition, the Subpoena requests "all documents and communications" between him and "any entity that [he] owns" and between him and Ken Haller, **[*2]** Plaintiff Sky Financial Intelligence, LLC's member, "from 2019 through the present." The Motion is suitable for decision without a hearing. For the reasons discussed below, the Motion is **DENIED**.

District courts have broad discretion in deciding whether to permit or deny discovery. *Sablan v. Dept. of Fin. of Com. Of No. Mariana Islands, 856 F.2d 1317, 1321 (9th Cir. 1988)*. *Rule 45* governs non-party subpoenas for testimony and production of documents. *Fed. R. Civ. P. 45(a)(1)(A)(iii)*. The scope of discovery allowed under a

Rule 45 subpoena is the same as the scope of discovery allowed under *Rule 26*. Leprino Foods Co. v. Avani Outpatient Surgical Ctr., Inc., 2024 U.S. Dist. LEXIS 72101, 2024 WL 2106730, at *7 (C.D. Cal. Apr. 19, 2024); Zucchella v. Olympusat, Inc., 2020 U.S. Dist. LEXIS 210858, 2020 WL 13250450, at *4 (C.D. Cal. Apr. 1, 2020); Much v. Gessesse, 339 F.R.D. 625, 629 (C.D. Cal. 2018). *Rule 26* permits discovery of "any nonprivileged matter that is relevant to any party's claim or defense and proportional to the needs of the case, considering the importance of the issues at stake in the action, the amount in controversy, the parties' relative access to relevant information, the parties' resources, the importance of the discovery in resolving the issues, and whether the burden or expense of the proposed discovery outweighs its likely benefit." See *Fed. R. Civ. P. 26(b)(1)*. "The party seeking to compel discovery has the burden of establishing relevance. The party opposing discovery then has the burden of showing that the discovery should be prohibited, and the burden of clarifying, explaining or supporting its objections." Alves v. Riverside County, 339 F.R.D. 556, 559 (C.D. Cal. 2021).

Here, Cliq fails **[*3]** to meet its initial burden of establishing that the Subpoena seeks relevant information that is proportional to the needs of this case. According to the Motion, Mr. Burrell's only involvement in this case is that he is financially backing Plaintiff. The thrust of Cliq's argument is that, for this reason alone, Cliq needs to depose and gather documents from him "to determine whether he might have any information relevant to this lawsuit." Cliq cites no authority, and the Court is aware of none, to support its position. A subpoena does not seek relevant information simply because it will determine one way or the other whether the non-party has relevant information. That is not the standard for relevance. Cliq fails to sufficiently articulate how or why Mr. Burrell would have information relevant to the specific claims or defenses in this case. See New Prime, Inc. v. Prime Grp. Holdings LLC, No. CV 23-103 DSF (KSx), 2024 U.S. Dist. LEXIS 58322, 2024 WL 2106734, at *13 (C.D. Cal. Mar. 28, 2024) ("Any analysis of 'relevance' in the context of discovery must be squarely grounded in the specific claims and defenses at issue in the case."); Nguyen v. Lotus by Johnny Dung Inc., No. CV 17-1317 JVS (JDEx), 2019 U.S. Dist. LEXIS 122787, 2019 WL 3064479, at *1 (C.D. Cal. June 5, 2019) ("Relevance has been construed broadly to encompass any matter that bears on, or that reasonably could lead to other matter that could bear on, any issue that is or may be in the case.").

At most, **[*4]** Mr. Burrell's limited connection to this case suggests only that his testimony and documents would be minimally relevant. See, e.g., *Hallett v. Morgan, 296 F.3d 732, 751 (9th Cir. 2002)* (upholding denial of plaintiff's motion to compel documents from defendant that were only minimally relevant to plaintiff's case). Such minimal relevance is outweighed by the fact that Mr. Burrell is a nonparty and that Cliq, as the movant, has not given reason to believe the information sought is unavailable from a party in this case. See Dart Industries Co., Inc. v. Westwood Chemical Co., 649 F.2d 646 (9th Cir. 1980) ("While discovery is a valuable right and should not be unnecessarily restricted, the 'necessary' restriction may be broader when a non-party is the target of discovery."); Katz v. Batavia Marine & Sporting Supplies, Inc., 984 F.2d 422, 424 (Fed. Cir. 1993) ("Although *Rule 26(b)* applies equally to discovery of nonparties, the fact of nonparty status may be considered by the court in weighing the burdens imposed in the circumstances."); Amini Innovation Corp. v. McFerran Home Furnishings, Inc., 300 F.R.D. 406, 409 (C.D. Cal. 2014) ("Concern for the unwanted burden thrust upon non-parties is a factor entitled to special weight in evaluating the balance of competing needs in a Rule 45 inquiry." (cleaned up)); Moon v. SCP Pool Corp., 232 F.R.D. 633, 638 (C.D. Cal. 2005) ("Since plaintiffs have not shown they have attempted to obtain these documents from defendant, the Court finds that, at this time, requiring nonparty KSA to produce these documents is an undue burden on **[*5]** nonparty KSA.").

For these reasons, the Motion is **DENIED**.

IT IS SO ORDERED.

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SPS Techs., LLC v. Briles Aero., Inc.

United States District Court for the Central District of California

June 24, 2019, Decided; June 24, 2019, Filed

CV 18-9536 MWF (ASx)

Reporter
2019 U.S. Dist. LEXIS 241074 *; 2019 WL 13108018

SPS Technologies, LLC, d/b/a PB Fasteners v. Briles Aerospace, Inc., et al.

Prior History: *SPS Techs., LLC v. Briles Aero., Inc., 2019 U.S. Dist. LEXIS 77556, 2019 WL 1974902 (C.D. Cal., Mar. 11, 2019)*

Core Terms

confidential, trade secret, Aerospace, manufacture, subpoena, Requests, proprietary information, tapered, sleeve, bolts, commercial information, request information, nonparty, confidential information, discovery, preliminary injunction, public domain, misappropriation, protections, processes, qualifies, contends

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For Briles Aerospace Inc., Defendant: Alexandria Deep Conroy, PRO HAC VICE, Quinn Emanuel Urquhart and Sullivan LLP, New York, NY.

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For Lisi Aerospace North America Inc, Defendant: Nicholas Matthew Zovko, Knobbe Martens Olson and Bear LLP, Irvine, CA.

For Michael Briles, Defendant: Duane R. Lyons, LEAD ATTORNEY, Quinn Emanuel Urquhart and Sullivan LLP, Los Angeles, CA.

For Space-Lok Inc., Defendant: Spencer Persson, Davis Wright Tremaine LLP, Los Angeles, CA.

For Space-Lok Inc., Movant: Brett C Govett, PRO HAC VICE, Norton Rose Fulbright LLP, Dallas, TX.

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For SPS Technologies LLC, doing business as, Plaintiff: William B Snyderwine, PRO HAC VICE, Williams and Connolly LLP, Washington, DC.

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For SPS Technologies LLC, PB Fasteners, Plaintiff: Michelle L Hood, PRO HAC VICE, Williams and Connolly LLP, Washington, DC.

For SPS Technologies LLC, PB Fasteners, Plaintiff: Miranda R Petersen, PRO HAC VICE, Williams and Connolly LLP, Washington, DC.

For SPS Technologies LLC, PB Fasteners, Plaintiff: Thomas H L Selby, PRO HAC VICE, Williams and Connolly LLP, Washington, DC.

For Briles Aerospace Inc., Defendant: Patrick Schmidt, Quinn Emanuel Urquhart and Sullivan LLP, Los Angeles, CA.

For Michael Briles, Defendant: Nima Hefazi, Quinn Emanuel Urquhart and Sullivan LLP, Los Angeles, CA.

For Michael Briles, Defendant: Christopher A Mathews, LEAD ATTORNEY, Quinn Emanuel Urquhart and Sullivan LLP, Los Angeles, CA.

For Michael Briles, Defendant: Alexandria Deep Conroy, PRO HAC VICE, Quinn Emanuel Urquhart and Sullivan LLP, New York, NY.

For Space-Lok Inc., Defendant: Barton W. Cox, PRO HAC VICE, Norton Rose Fulbright LLP, Dallas, TX.

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For Blanc Aero Industries SAS, Defendant: Lynda J Zadra-Symes, Knobbe Martens Olson and Bear LLP, Irvine, CA.

For Blanc Aero Industries SAS, Defendant: Marko R Zoretic, Knobbe Martens Olson and Bear LLP, Irvine, CA.

For Briles Aerospace Inc., Defendant: Brian M Wheeler, Atkinson Andelson Loya Ruud and Romo, Cerritos, CA.

For Briles Aerospace Inc., Defendant: Duane R. Lyons, LEAD ATTORNEY, Quinn Emanuel Urquhart and Sullivan LLP, Los Angeles, CA.

For Briles Aerospace Inc., Defendant: Jason Frank Lake, LEAD ATTORNEY, Quinn Emanuel Urquhart and Sullivan LLP, Los Angeles, CA.

For Briles Aerospace Inc., Defendant: Dawn M. David, PRO HAC VICE, Quinn Emanuel Urquhart and Sullivan LLP, Salt Lake City, UT.

For Hi-Shear Corp, Defendant: Lynda J Zadra-Symes, Knobbe Martens Olson and Bear LLP, Irvine, CA.

For Hi-Shear Corp, Defendant: Nicholas Matthew Zovko, Knobbe Martens Olson and Bear LLP, Irvine, CA.

For Lisi Aerospace Canada Corp., Defendant: **[*4]** Marko R Zoretic, Knobbe Martens Olson and Bear LLP, Irvine, CA.

For Lisi Aerospace North America Inc, Defendant: Marko R Zoretic, Knobbe Martens Olson and Bear LLP, Irvine, CA.

For Richard Briles as an individual and as Trustee of the Rick and Keanna A. Briles Family Trust dated December 12 1990, Defendant: William A Molinski, Orrick Herrington and Sutcliffe LLP, Los Angeles, CA.

For Robert Briles, Defendant: Brian M Wheeler, Atkinson Andelson Loya Ruud and Romo, Cerritos, CA.

For Robert Briles, Defendant: William A Molinski, Orrick Herrington and Sutcliffe LLP, Los Angeles, CA.

For Space-Lok Inc., Defendant: Lesley Holmes, Norton Rose Fulbright US LLP, Los Angeles, CA.

For Space-Lok Inc., Defendant: Jacqueline G. Baker, PRO HAC VICE, Norton Rose Fulbright LLP, Dallas, TX.

For Space-Lok Inc., Movant: Jacqueline G. Baker, PRO HAC VICE, Norton Rose Fulbright LLP, Dallas, TX.

For SPS Technologies LLC, PB Fasteners, Plaintiff: Bruce R Genderson, PRO HAC VICE, Williams and Connolly LLP, Washington, DC.

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For Hi-Shear Corp, Defendant: Marko R Zoretic, Knobbe Martens Olson and Bear LLP, **[*5]** Irvine, CA.

For Lisi Aerospace Canada Corp., Defendant: Lynda J Zadra-Symes, Knobbe Martens Olson and Bear LLP, Irvine, CA.

For Lisi Aerospace Canada Corp., Defendant: Nicholas Matthew Zovko, Knobbe Martens Olson and Bear LLP, Irvine, CA.

For Michael Briles, Defendant: Jason Frank Lake, LEAD ATTORNEY, Quinn Emanuel Urquhart and Sullivan LLP, Los Angeles, CA.

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For Space-Lok Inc., Movant: Lesley Holmes, Norton Rose Fulbright US LLP, Los Angeles, CA.

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For SPS Technologies LLC, doing business as, Plaintiff: Matthew Donald Umhofer, LEAD ATTORNEY, Spertus Landes and Umhofer LLP, Los Angeles, CA.

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For SPS Technologies LLC, doing business as, Plaintiff: Edward C Reddington, PRO HAC VICE, Williams and Connolly LLP, Washington, **[*6]** DC.

For SPS Technologies LLC, doing business as, Plaintiff: Miranda R Petersen, PRO HAC VICE, Williams and Connolly LLP, Washington, DC.

For SPS Technologies LLC, doing business as, Plaintiff: Thomas H L Selby, PRO HAC VICE, Williams and Connolly LLP, Washington, DC.

For SPS Technologies LLC, PB Fasteners, Plaintiff: Elizabeth Anne Mitchell, LEAD ATTORNEY, Spertus Landes and Umhofer LLP, Los Angeles, CA.

For Briles Aerospace Inc., Defendant: Jon M Setoguchi, Atkinson Andelson Loya Ruud and Romo, Cerritos, CA.

For Briles Aerospace Inc., Defendant: Nima Hefazi, Quinn Emanuel Urquhart and Sullivan LLP, Los Angeles, CA.

For Briles Aerospace Inc., Defendant: Tigran Guledjian, LEAD ATTORNEY, Quinn Emanuel Urquhart and Sullivan LLP, Los Angeles, CA.

For Michael Briles, Defendant: Brian M Wheeler, Atkinson Andelson Loya Ruud and Romo, Cerritos, CA.

For Michael Briles, Defendant: Richard H Doss, Quinn Emanuel Urquhart and Sullivan LLP, Los Angeles, CA.

For Robert Briles, Defendant: Alyssa Margaret Caridis, Orrick Herrington and Sutcliffe LLP, Los Angeles, CA.

For Sidney K Kanazawa, Mediator (ADR Panel): Sidney Kanazawa, LEAD ATTORNEY, SK Law Mediation, Los Angeles, CA.

For Space-Lok Inc., Defendant: Nathan **[*7]** B Baum, PRO HAC VICE, Norton Rose Fulbright LLP, Dallas, TX.

For SPS Technologies LLC, doing business as, Plaintiff: James W Kirkpatrick, PRO HAC VICE, Williams and Connolly LLP, Washington, DC.

For SPS Technologies LLC, doing business as, Plaintiff: Joseph Q Wood, PRO HAC VICE, Williams and Connolly LLP, Washington, DC.

For SPS Technologies LLC, PB Fasteners, Plaintiff: Edward C Reddington, PRO HAC VICE, Williams and Connolly LLP, Washington, DC.

For SPS Technologies LLC, PB Fasteners, Plaintiff: Jagmeet Singh, PRO HAC VICE, William and Connolly LLP, Washington, DC.

For SPS Technologies LLC, PB Fasteners, Plaintiff: James W Kirkpatrick, PRO HAC VICE, Williams and Connolly LLP, Washington, DC.

For SPS Technologies LLC, PB Fasteners, Plaintiff: Joseph Q Wood, PRO HAC VICE, Williams and Connolly LLP, Washington, DC.

For SPS Technologies LLC, PB Fasteners, Plaintiff: William B Snyderwine, PRO HAC VICE, Williams and Connolly LLP, Washington, DC.

For Briles Aerospace Inc., Defendant: Steven A Morphy, Hunton Andrews Kurth LLP, Los Angeles, CA.

For Briles Aerospace Inc., Defendant: John W McCauley IV, Quinn Emanuel Urquhart and Sullivan LLP, San Francisco, CA.

For Briles Aerospace Inc., Defendant: **[*8]** Christopher A Mathews, LEAD ATTORNEY, Quinn Emanuel Urquhart and Sullivan LLP, Los Angeles, CA.

For Michael Briles, Defendant: Patrick Schmidt, Quinn Emanuel Urquhart and Sullivan LLP, Los Angeles, CA.

For Michael Briles, Defendant: Tigran Guledjian, LEAD ATTORNEY, Quinn Emanuel Urquhart and Sullivan LLP, Los Angeles, CA.

For Michael Briles, Defendant: Dawn M. David, PRO HAC VICE, Quinn Emanuel Urquhart and Sullivan LLP, Salt Lake City, UT.

For Robert Briles as Trustee of the Rob Briles Revocable Family Trust dated March 28 1991, Defendant: William A Molinski, LEAD ATTORNEY, Orrick Herrington and Sutcliffe LLP, Los Angeles, CA.

For Space-Lok Inc., Defendant: Brett C Govett, PRO HAC VICE, Norton Rose Fulbright LLP, Dallas, TX.

For Space-Lok Inc., Movant: Spencer Persson, Davis Wright Tremaine LLP, Los Angeles, CA.

For Space-Lok Inc., Movant: Nathan B Baum, PRO HAC VICE, Norton Rose Fulbright LLP, Dallas, TX.

For SPS Technologies LLC, PB Fasteners, Plaintiff: Matthew Donald Umhofer, LEAD ATTORNEY, Spertus Landes and Umhofer LLP, Los Angeles, CA.

Judges: Alka Sagar, United States Magistrate Judge.

Opinion by: Alka Sagar

Opinion

CIVIL MINUTES — GENERAL

Proceedings (In Chambers): Order GRANTING Nonparty Space-Lok, Inc.'s Motion [*9] To Quash (Docket Entry Nos. 139, 140, 141)

On June 6, 2019, nonparty Space-Lok, Inc. and Defendant Briles Aerospace, Inc. filed a joint stipulation (Dkt. No. 140 ("Joint Stip.")) regarding Space-Lok's Motion to Quash (Dkt. No. 139 ("Motion to Quash")). The Court finds this discovery dispute appropriate for resolution without a hearing.[1] For the reasons discussed below, the Motion to Quash is **GRANTED**.

A. Background

This case arises from the alleged misappropriation of Plaintiff's confidential and proprietary information by Defendants, in relation to a Request for Proposal issued by The Boeing Company to qualified manufacturers of tapered sleeve bolts in September 2018. (Joint Stip. at 6). Shortly after first learning that Defendants had taken and used its confidential and proprietary information, Plaintiff initiated this lawsuit, asserting claims for, *inter alia*, trade secret misappropriation. (Dkt. No. 1). Plaintiff filed its First Amended Complaint ("FAC") on December 17, 2018. (Dkt. No. 68). On March 11, 2019, the Court denied Plaintiff's request for a preliminary injunction. (Dkt. No. 113). Nonexpert discovery closes on June 28, 2019. (Dkt. No. 118).

Both Plaintiff and Defendant directly **[*10]** compete with Space-Lok. (Dkt. No. 140, Ex. B (Motamedi Decl.) at ¶ 3). Like both parties, Space-Lok specializes in the manufacturing and multiple component mechanisms for the aerospace industry. (Id.). However, Space-Lok has not been qualified to manufacture or supply tapered sleeve bolts to Boeing. (Id. ¶ 4).

B. Motion to Quash

On May 7, 2019, Briles Aerospace issued a subpoena to Space-Lok, requesting that it produce eleven categories of documents. (Dkt. No. 140, Ex. A ("Subpoena"). Counsel for Briles Aerospace and Space-Lok conducted a meet and confer via letter on May 20, 2019, and via telephone on May 21, 2019. (Joint Stip. at 5). Counsel were unable to reach an agreement with respect to Request Nos. 8, 9, and 11 (the "Requests"). (Id.). Space-Lok requests that this Court squash and otherwise protect it from disclosure of information responsive to the Requests. (Id.).

C. Discussion

The "Requests" seek information related to Space-Lok's manufacture or attempt to manufacture tapered sleeve bolts. (Joint Stip. at 7). Space-Lok objects, asserting that the Requests seek "confidential research and development information about its actual and potential products." (Id.). It also contends **[*11]** that the Requests are "irrelevant and unnecessary to prove Defendant's case." (Id. at 8).

The Subpoena seeks confidential and proprietary information. *Rule 45* "provides . . . protections where a subpoena seeks trade secret or confidential commercial information from a nonparty." *Gonzales v. Google, Inc., 234 F.R.D. 674, 684 (N.D. Cal. 2006)*; see *Fed. R. Civ. P. 45(d)(3)(B)* ("To protect a person subject to or affected by a subpoena, the court for the district where compliance is required may, on motion, quash or modify the subpoena if it requires: (i) disclosing a trade secret or other confidential research, development, or commercial information . . . ."). Briles Aerospace contends that "Space-Lok has not demonstrated through competent evidence that the information sought through discovery is a trade secret." (Joint Stip. at 11). However, *Rule 45* does not limit its protections to "trade secrets." It also includes "confidential . . . commercial information." And here, Space-Lok's General Manager

[1] Space-Lok and Briles Aerospace stipulated and requested that this matter be decided without a hearing. (Dkt. No. 141).

attests that the requested information "is confidential and proprietary information related to Space-Lok's manufacturing, testing and design processes which, if disclosed . . . , would cause Space-Lok competitive harm in future bids for contracts with aerospace manufacturers." (Motamedi Decl. **[*12]** ¶ 5). Space-Lok also "requires its employees to with knowledge of its confidential and proprietary information to execute non-disclosure agreements and to maintain the confidentiality of such information." (Id.). Further, the requested information "is not a matter of public knowledge or interest." (Id. ¶ 7). Thus, Space-Lok has competently demonstrated that the information sought by the Subpoena is trade secret or confidential commercial information and that it has historically sought to maintain the confidentiality of this information. See *Gonzalez, 234 F.R.D. at 684* ("Trade Secrets or commercially sensitive information must be 'important proprietary information' and the party challenging the subpoena must make 'a strong showing that it has historically sought to maintain the confidentiality of this information.'") (quoting *Compaq Computer Corp. v. Packard Bell Elecs., Inc., 163 F.R.D. 329, 338 (N.D. Cal. 1995)*).

Briles Aerospace has not met its burden to demonstrate a substantial need for the information. "Once the nonparty shows that the requested information is a trade secret or confidential commercial information, the burden shifts to the requesting party to show a 'substantial need for the testimony or material that cannot be otherwise met without undue hardship.'" *Gonzales, 234 F.R.D. at 684* (quoting *Fed. R. Civ. P. 45(d)(3)(C)*). Defendant argues **[*13]** that "[p]iecing together the industry practice and whether various competitors who attempt to produce Tapered Sleeve Bolts for Boeing all use the same information, processes and manufacturing techniques [Plaintiff] claims are trade secrets is highly relevant to the question of whether this information qualifies as a trade secret." (Joint Stip. at 14). But the standard is not whether the requested confidential information is relevant; instead, Briles Aerospace bears the burden to demonstrate its substantial need for the information. *Fed. R. Civ. P. 45(d)(3)(C)*. In other words, Defendant must show how Space-Lok's confidential information is "essential" to its case. See *Gonzalez, 234 F.R.D. at 685* (a party subpoenaing confidential information from a nonparty must not only "demonstrate that the requested information is relevant [but that it is also] essential to a judicial determination of its case"). Defendant has not shown how information related to Space-Lok's attempts to manufacture tapered sleeve bolts—which have not been qualified by Boeing—are essential to proving that Plaintiff's qualified tapered sleeve bolts do not qualify as a trade secret. Further, in successfully defeating Plaintiff's attempt to secure a preliminary injunction, **[*14]** Briles Aerospace provided the Court with evidence indicating that the purported trade secrets are in the public domain or ascertainable through proper means, and can be reverse engineered within two years based on nonproprietary information in the public domain, such as catalogs, drawings, and expired patents widely disseminated over the past 50 years. (Dkt. No. 113 at 16-27). Defendant has not met its burden to explain how the information requested from Space-Lok is not duplicative or superfluous to the evidence already presented to the Court in this case.

D. Conclusion

The Motion to Quash is **GRANTED**. Briles Aerospace's Request Nos. 8, 9, and 11 are **QUASHED**.

IT IS SO ORDERED.

End of Document

Stewart v. Mitchell Transp.

United States District Court for the District of Kansas

July 11, 2002, Decided

CIVIL ACTION No. 01-2546-JWL

Reporter
2002 U.S. Dist. LEXIS 12958 *; 2002 WL 1558210

JAMES STEWART, et al., Plaintiffs, v. MITCHELL TRANSPORT, et al., Defendants.

Prior History: *Stewart v. Mitchell Transp., 2002 U.S. Dist. LEXIS 10332*.

Disposition: [*1] Defendants' motions to quash denied in part and granted in part, defendants' motions for protective order denied; Associates Insurance Company's motion to quash subpoena granted in part and denied in part; Associates Insurance Company's motion for protective order granted.

Core Terms

subpoenas, documents, protective order, quashing a subpoena, confidential, disclosure, discovery, parties, overly broad, objects, personnel file, motion for a protective order, records, non-parties, performance evaluation, job application, motion to quash, entities, job description, claim file, Overbreadth, proprietary, personal rights, filing date, drivers, grounds, travel, commands, secret, proprietary information

Case Summary

Procedural Posture
Before the United States District Court for the District of Kansas were motions including a renewed Motion to Quash Subpoenas and/or Motion for Protective Order filed by defendants, driver, driver's former employer, and the insurer of the driver's former employer, on personal injury claims arising from an accident between the plaintiff, injured driver and defendant, driver.

Overview
The injured driver and his insurer served six subpoenas on various entities that were not parties to his personal injury action, including entities located in Texas, Kentucky, Tennessee, and Wisconsin. The subpoenas directed at the defendant driver's former employers and his present employer sought "all records, documents or information regarding the driver, including . . . personnel file, job application, job description and performance evaluations." The district court found that the request for the driver's personnel related records appeared relevant on its face, and the driver failed to convince and concluded that it was unlikely that there was "no possibility" that the documents requested could have a "possible bearing" on a claim or defense of the parties. Accordingly, the court overruled the defendant driver's relevancy objections to the subpoenas. However, the court did recognize that at least the potential for injury existed if documents containing medical information about the driver were disclosed to non-parties and directed the parties to submit an agreed protective order prohibiting disclosure of the alleged confidential documents to non-parties.

Outcome
Defendants' Renewed Motion to Quash was denied, in part and granted in part to the extent it was brought by defendant, driver and commanded his current and previous employers to produce "all" documents in their possession regarding the driver.

Counsel: For JAMES STEWART, GLORIA STEWART, plaintiffs: Lawrence D. Flick, Prairie Village, KS.

For MITCHELL TRANSPORT, INC., LARRY **[*2]** G RAMSEY, INSURANCE CORPORATION OF HANNOVER, INSURANCE CORPORATION OF HANOVER, defendants: Roger W. Warren, Jeffrey C. Baker, Sanders Conkright & Warren LLP, Kansas City, MO.

For ASSOCIATES INSURANCE COMPANY, movant: Michael D. Matteuzzi, Michael L. Belancio, Niewald, Waldeck & Brown, P.C., Kansas City, MO.

Judges: David J. Waxse, U.S. Magistrate Judge.

Opinion by: David J. Waxse

Opinion

MEMORANDUM AND ORDER

This matter is before the Court on the following Motions: (1) Renewed Motion to Quash Subpoenas and/or Motion for Protective Order filed by Defendants Mitchell Transport, Inc., Larry G. Ramsey, and Insurance Corporation of Hannover (hereinafter referred to collectively as "Defendants") (doc. 43); (2) Motion to Quash, or in the Alternative, for Protective Order, filed by Associates Insurance Company (doc. 24); and (3) Motion to Quash Second Subpoena, or in the Alternative, for Protective Order, filed by Associates Insurance Company (doc. 51).

I. Nature of the Matter Before the Court

This is a personal injury action arising out of the collision between a pickup truck driven by Plaintiff James Stewart and a tractor-trailer driven by Defendant Larry Ramsey ("Ramsey"). **[*3]** According to Plaintiffs' Complaint, the tractor-trailer was operated by Defendant Mitchell Transport, Inc. ("Mitchell Transport") and insured by Defendant Insurance Corporation of Hannover ("Hannover"). Plaintiffs assert claims against Mitchell Transport and Ramsey for violations of the Interstate Transportation Act. Plaintiffs also assert claims against Mitchell Transport and Ramsey for negligence and reckless conduct. In addition, Plaintiffs assert a claim against Hannover for breach of the insurer's duty to act in good faith.

Plaintiffs have served six subpoenas [1] on various entities that are not parties to this action, including Associates Insurance Company ("AIC"). AIC is located in Texas, while the other entities served are located in Kentucky, Tennessee, and Wisconsin.

[*4] II. Defendants' Renewed Motion to Quash and/or Motion for Protective Order (doc. 43)

A. Defendants' Standing to Move to Quash the Subpoenas

Before the Court analyzes the merits of Defendants' objections to the subpoenas and their arguments in support of their Renewed Motion to Quash, the Court must first determine whether Defendants have standing to move to quash the subpoenas. These subpoenas were not served on Defendants but rather on various third parties. Generally speaking, a party to the lawsuit does not have standing to quash a subpoena served on a nonparty.

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[1] In their reply brief, Defendants state that Plaintiffs later served a seventh subpoena on AXA Global Risks US Insurance Company ("AXA subpoena"). *See* Ex. L, attached to doc. 52. The AXA subpoena was signed by Plaintiffs' counsel on May 15, 2002 and apparently served some time thereafter, which was at least more than eight days after Defendants' Renewed Motion to Quash was filed. There is no indication that counsel for the parties have ever conferred regarding the AXA subpoena, as required by D. Kan. Rule 37.2. Because the document request contained in the AXA subpoena differs from the document requests contained in the other six subpoenas at issue, and because Defendants' counsel has failed to satisfy the duty to confer as to the AXA subpoena, the Court will decline to entertain Defendants' Motion to Quash as it applies to the AXA subpoena.

Johnson v. Gmeinder, 191 F.R.D. 638, 640 n. 2 (D. Kan. 2000); Hertenstein v. Kimberly Home Health Care, Inc., 189 F.R.D. 620, 635 (D. Kan. 1999). A motion to quash a subpoena "may only be made by the party to whom the subpoena is directed except where the party seeking to challenge the subpoena has a personal right or privilege with respect to the subject matter requested in the subpoena." *Id.* (quoting Smith v. Midland Brake, Inc., 162 F.R.D. 683, 685 (D. Kan. 1995)).

Thus, for Defendants to bring this motion, each must have a personal right **[*5]** or privilege with respect to the subject matter of the documents requested in the subpoenas. The subpoenas directed at Ramsey's former employers (Boyd Brothers Transportation, Mayfield Printing, and General Tire and Rubber) and his present employer (Goodyear Tire and Rubber) seek "all records, documents or information . . . regarding Larry G. Ramsey, including, but not limited to your complete personnel file, job application, job description and performance evaluations." Exs. A-D, attached to doc. 44.

The Court finds that Ramsey clearly has a personal right with respect to the information contained in his personnel files, job applications, and performance evaluations. Thus, the Court holds that Ramsey has standing to move to quash the subpoenas served on his employers and to assert objections to the document requests contained therein. *See* Beach v. City Olathe, Kansas, 2001 U.S. Dist. LEXIS 16214, No. 99-2210- GTV, 2001 WL 1098032, at *1 (D. Kan. Sept. 17, 2001) (defendant "clearly has a 'personal right' in his personnel file and applications for employment that would give him standing to move to quash the subpoenas."). In contrast, the Court finds that neither Mitchell Transport nor Hannover **[*6]** has any personal right or privilege with respect to the personnel files and other employment-related records sought. The Court thus rules that neither Mitchell Transport nor Hannover has standing to move to quash the subpoenas served on Ramsey's employers.

The subpoenas served on AIC and Sentry Select Insurance Company ("Sentry") request "all insurance applications, your complete underwriting file, and complete claims files regarding all collisions or incidents that trucks operated by Mitchell Transport or any driver employed by Mitchell Transport were involved in from July 1, 1997 through the present." Exs. E-F, attached to doc. 44. Mitchell Transport asserts that these documents contain proprietary information such as Mitchell Transport's client lists, routes of travel, and net worth. It also contends that these documents likely contain privileged communications and materials protected by the work product doctrine.

The Court finds that Mitchell Transport has a personal right with respect to these requested documents. Accordingly, the Court holds that Mitchell Transport has standing to move to quash the subpoenas served on AIC and Sentry. In contrast, Ramsey and Hannover **[*7]** have presented no information or argument that would lead the Court to believe that they too have any personal right in any of the information contained in the documents requested by these subpoenas. The Court therefore holds that neither Ramsey nor Hannover has standing to move to quash the subpoenas served on AIC and Sentry.

In light of the above, the Court will deny the Renewed Motion to Quash to the extent it is brought by Ramsey and Hannover to quash the subpoenas served on AIC and Sentry. The Court will also deny the Renewed Motion to Quash to the extent it is brought by Mitchell Transport and Hannover to quash the subpoenas served on Ramsey's employers, Boyd Brothers Transportation, Mayfield Printing, General Tire and Rubber, and Goodyear Tire and Rubber.

B. Ramsey and Mitchell Transport's Procedural Objections to the Subpoenas

Ramsey and Mitchell Transport object to all of the subpoenas on procedural grounds, arguing that each of the entities upon which these subpoenas were served is outside the 100-mile geographical limitation provided for in Rule 45(b)(2). That provision allows a subpoena to be served "at any place within the district of the court by **[*8]** which it is issued, or at any place without the district *that is within 100 miles of the place of the deposition, hearing, trial, production, or inspection* specified in the subpoena . . . ." Fed.R.Civ.P. 45(b)(2) (emphasis added). Ramsey and Mitchell Transport contend that the subpoenas should be quashed pursuant to Rule 45(c)(3)(A), which states that the court from which a subpoena was issued shall quash the subpoena if it requires a third party "to travel to a place more than 100 miles from the place where that person resides, is employed or regularly transacts business in

person." Ramsey and Mitchell Transport argue that these subpoenas should be quashed because they require the subpoenaed parties, who are located in Kentucky, Tennessee, Texas, and Wisconsin, "to travel outside the 100 mile limit allowed by Rule 45." Doc. 44 at p. 4.

The Court disagrees. The subpoenas do not require the attendance of any witnesses. They only require the production of documents. [2] The documents are required to be produced at Plaintiffs' counsel's law firm in Prairie Village, Kansas. In other words, the place of production is in Prairie Village, Kansas. The entities subpoenaed are merely **[*9]** required to mail the documents, or have them delivered, to Plaintiffs' counsel's office in Kansas. No representative is required *to travel* to Kansas. Furthermore, Rule 45(a)(2) expressly states that such document subpoenas *must* issue from the district in which the production is to take place. It provides:

If separate from a subpoena commanding the attendance of a person, a subpoena for production or inspection **[*10]** *shall* issue from the court for the district in which the production or inspection is to be made.

Fed.R.Civ.P. 45(a)(2) (emphasis added).

In light of the above, the Court holds that the subpoenas were properly issued from this district, where the production was to take place, and that the subpoenas do not require any of the entities served to travel in violation of the Rule's 100-mile limitation. The Court thus declines to quash the subpoenas based on this procedural objection.

C. Ramsey's Substantive Objections to the Subpoenas Served on His Employers

Ramsey objects to the subpoenas directed to three former employers and to his current employer. The subpoenas request:

All records, documents or information in your possession regarding Larry G. Ramsey, including, but not limited to, your complete personnel file, job application, job description and performance evaluations.

Exs. A-D, attached to doc. 44.

Ramsey objects to the subpoenas on the basis that the document request contained therein is overly broad and seeks irrelevant documents. He also objects on the basis that the subpoenas seek confidential documents, including some that contain **[*11]** confidential medical information about himself.

1. Overbreadth and irrelevance

Overbreadth and irrelevance are not contained within Rule 45's list of enumerated reasons for quashing a subpoena. It is well settled, however, that the scope of discovery under a subpoena is the same as the scope of discovery under *Rules 26(b)* [3] and 34. *See* Advisory Committee Note to the 1970 Amendment of Rule 45(d)(1) (the 1970 amendments "make it clear that the scope of discovery through a subpoena is the same as that applicable to Rule 34 and the other discovery rules."). *See also* 9A Charles A. Wright and Arthur R. Miller, *Federal Practice and Procedure,* § 2459 at p. 42 (2d ed.) (scope of discovery through a subpoena is "exceedingly broad" and incorporates the provisions of *Rules 26(b)* and 34). Thus, the court must examine whether a request contained in a

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[2] Rule 45 expressly provides that a subpoena may be issued to compel a nonparty to produce documents independent of any deposition, hearing, or trial. *See* Fed.R.Civ.P. 45(c)(2)(A) ("A person commanded to produce . . . designated books, papers, documents or tangible things . . . need not appear in person at the place of production . . . unless commanded to appear for deposition, hearing or trial.") *See also* Fed.R.Civ.P. 45(a)(1) (setting forth procedure for issuance of subpoena for production of documents that is "separate from a subpoena commanding the attendance of a person").

[3] ***Fed.R.Civ.P. 26(b)*** provides that "parties may obtain discovery regarding any matter, not privileged, that is relevant to the claim or defense of any party. . . . Relevant information need not be admissible at the trial if the discovery appears reasonably calculated to lead to the discovery of admissible evidence."

subpoena duces tecum is overly broad or seeks irrelevant information under the same standards as set forth in *Rule 26 (b)* and as applied to *Rule 34* requests for production. *See* *Phalp v. City of Overland Park, Kan., 2002 U.S. Dist. LEXIS 9684*, No. 00-2354- *JAR, 2002 WL 1162449, at *3-4 (D. Kan. May 8, 2002)* (applying general principles **[*12]** of overbreadth and irrelevance to subpoena duces tecum).

a. Overbreadth

The Court will first turn to Ramsey's objection that the request is overly broad. A party objecting to a discovery request on the grounds that the request is overly broad has the burden to support its objection, unless the request is overly broad on its face. *Etienne v. Wolverine Tube, Inc., 185 F.R.D. 653 at 656*; *Hilt v. SFC Inc., 170 F.R.D. 182, 186 (D. Kan. 1997)*. Here, the subpoenas request "all records, documents or information in your possession *regarding* Larry G. Ramsey, including, but not limited to, your complete personnel file, job applications, job description and performance **[*13]** evaluations." Exs. A-D, attached to doc. 44 (emphasis added). The Court finds that the use of the term "regarding" makes this request overly broad on its face. *See* *Bradley v. Val-Mejias, 2001 U.S. Dist. LEXIS 25278*, No. 00-2395- *GTV, 2001 WL 1249339, *6 (D. Kan. Oct. 9, 2001)* (use of the term "pertaining to" rendered document request overly broad on its face); *Mackey v. IBP, Inc., 167 F.R.D. 186, 197 (D. Kan.1996)* (same). The use of such omnibus phrases as "regarding" or "pertaining to" requires the answering party "to engage in mental gymnastics to determine what information may or may not be remotely responsive." *Id.*

The Court also finds the request overly broad on its face to the extent it commands the employers to produce "all . . . information" regarding Ramsey. *Rule 45* expressly provides that a subpoena may require the production of "designated books, documents or tangible things" in the possession, custody, or control of the subpoenaed individual or entity. *Fed.R.Civ.P. 45(a)(1)*. There is no provision for a subpoena that seeks "information."

The Court does not, however, find that the request is overly broad on its face to the extent it asks the employer to **[*14]** produce discrete documents, *i.e.,* Ramsey's personnel file, job application, job description, and performance evaluations. Moreover, the Court does not find that Ramsey has satisfied his burden to show how the request for these particular documents is overly broad. The Court will therefore overrule his overbreadth objection to the extent the subpoena requests each employer to produce Ramsey's personnel file, job application, job description, and performance evaluations.

b. Irrelevance

The Court will now turn to Ramsey's relevance objections to the requested personnel files, job applications, job descriptions, and performance evaluations. Relevancy is broadly construed, and a request for discovery should be considered relevant if there is "any possibility" that the information sought may be relevant to the claim or defense of any party. *Sheldon v. Vermonty, 204 F.R.D. 679, 689-90 (D. Kan. 2001)* (citations omitted). A request for discovery should be allowed "unless it is clear that the information sought can have no possible bearing" on the claim or defense of a party. *Id.* (citations omitted). When the discovery sought appears relevant on its face, the **[*15]** party resisting the discovery has the burden to establish the lack of relevance by demonstrating that the requested discovery (1) does not come within the broad scope of relevance as defined under *Rule 26(b)(1)*, or *(2)* is of such marginal relevance that the potential harm the discovery may cause would outweigh the presumption in favor of broad disclosure. *Scott v. Leavenworth Unified School Dist. No. 453, 190 F.R.D. 583, 585 (D. Kan. 1999)*. Conversely, when relevancy is not apparent on the face of the request, the party seeking the discovery has the burden to show the relevancy of the request. *Steil v. Humana, Inc., 197 F.R.D. 442, 445 (D. Kan. 2000)*.

Applying these principles, the Court finds that the request for Ramsey's personnel file, job application, job description, and performance evaluations appears relevant on its face, and Ramsey has failed to convince the Court otherwise. The Court is unable to find that there is "no possibility" that the documents requested could have a "possible bearing" on a claim or defense of the parties. Ramsey's safety record, work history and performance issues--while employed as a truck driver or even in some **[*16]** other capacity--may reveal that Ramsey has a history of other accidents or safety violations. The Court therefore overrules Ramsey's relevancy objections to these

subpoenas to the extent they request his personnel files, job applications, job descriptions, and performance evaluations.

2. Confidentiality

Ramsey also objects to the subpoenas on the grounds they seek private and confidential information about himself, including some medical information that he contends should remain private. Ramsey does not elaborate on the confidential nature of the requested documents.

Ramsey fails to recognize that a party may not rely on the confidential nature of documents as a basis for refusing to produce them, because "confidentiality does not equate to privilege." *Hill v. Dillard's, Inc., 2001 U.S. Dist. LEXIS 24450*, No. 00-2523- *JWL, 2001 WL 1718367, *4 (D. Kan. Oct. 9, 2001)* (quoting *Folsom v. Heartland Bank, 1999 U.S. Dist. LEXIS 7814*, No. 98-2308- *GTV, 1999 WL 322691, *2 (May 14, 1999))*. *See also Federal Open Mkt. Comm. v. Merrill, 443 U.S. 340, 362, 61 L. Ed. 2d 587, 99 S. Ct. 2800 (1979))* ("there is no absolute privilege for . . . confidential information"). Thus, the Court will **[*17]** overrule Ramsey's confidentiality objection to the subpoenas.

Apparently recognizing the fact that the Court might overrule his confidentiality objection, Ramsey asks the Court, in the event it enforces the subpoenas, to enter a protective order to prevent the disclosure of the documents to third parties. Although documents are not shielded from discovery on the basis of confidentiality, it is true that a party may request the court to enter a protective order pursuant to *Fed.R.Civ.P. 26(c)* as a means to protect the confidential information from disclosure to individuals or entities not connected with the litigation. *Hill, 2001 WL 1718367, at *4*. The decision whether to enter a protective order is within the court's discretion. *See Thomas v. Int'l Bus. Mach., 48 F.3d 478, 482 (10th Cir. 1995)*. *Rule 26(c)* nevertheless requires that the party seeking the protective order establish "good cause" for the protective order. *Johnson v. Gmeinder, 191 F.R.D. 638, 642 (D. Kan. 2000)*. In determining whether good cause exists for the court to issue a protective order that prohibits partial or complete dissemination of documents or other materials **[*18]** obtained in discovery to non-parties, "the initial inquiry is whether the moving party has shown that disclosure of the information will result in a 'clearly defined and very serious injury.' " *Zapata v. IBP, Inc., 160 F.R.D. 625, 627 (D. Kan. 1995)* (quoting *Koster v. Chase Manhattan Bank, 93 F.R.D. 471, 480 (S.D. N.Y. 1982))* (internal quotations omitted).

Although Ramsey has asked the Court to enter such a protective order, he has failed to show how disclosure of the alleged confidential and medical information to any non-parties would result in a "clearly defined" or "serious injury." Without such information, the Court is not in a position to determine whether the requisite good cause exists to issue a protective order prohibiting dissemination of Ramsey's personnel files and other requested job-related documents. The Court does, however, recognize that at least the potential for injury exists if the alleged confidential documents, and, in particular, documents containing medical information about Ramsey, are disclosed to non-parties. In the interest of justice, the Court will direct the parties to submit an agreed protective order prohibiting **[*19]** disclosure of the alleged confidential documents/information to non-parties and prohibiting the use of these documents/information outside of this lawsuit. *See Hill, 2001 WL 1718367, at *5* (directing parties to attempt to draft a protective order to prevent disclosure of requested documents to non-parties).

Within ten (10) days of the date of filing of this Order, counsel for the parties shall confer and attempt to agree upon such a protective order. If the parties are unable to reach an agreement, the Court will allow Ramsey five (5) days thereafter to move for a protective order prohibiting the disclosure of these documents to non-parties and prohibiting the use of these documents outside of this lawsuit. Plaintiffs shall file their response to the motion for protective order within five (5) days after service of the motion.

3. Annoyance, harassment, and embarrassment

Ramsey also urges the Court to quash the subpoenas on the basis that "Plaintiffs [through the subpoenas] are simply attempting to annoy, harass and embarrass" him. Doc. 44 at 2. *Rule 45* does not provide for the quashing of a subpoena on this basis. **[*20]** *Rule 26(c)*, however, does allow a court to enter a protective order to protect a

party from annoyance, embarrassment or oppression. The Court will therefore treat Ramsey's request as a *Rule 26(c)* motion for protective order to prevent the discovery from being had.

As noted above, the moving party has the burden to show good cause for granting a protective order. *Johnson v. Gmeinder, 191 F.R.D. 638, 642 (D. Kan. 2000)*. To establish good cause, that party must make "a particular and specific demonstration of fact, as distinguished from stereotyped and conclusory statements." *Gulf Oil Co. v. Bernard, 452 U.S. 89, 102 n. 16, 68 L. Ed. 2d 693, 101 S. Ct. 2193 (1981)*. Ramsey has made nothing more than conclusory statements that Plaintiffs seek to annoy, harass, and embarrass him through these subpoenas. These conclusory statements are insufficient to satisfy Ramsey's *Rule 26(c)* burden. The Court therefore declines to enter a protective order on this basis.

B. Mitchell Transport's Substantive Objections to the Subpoenas Served on AIC and Sentry

The subpoenas served on AIC and Sentry command them to produce the following:

Any and **[*21]** all information, documents or records in your possession regarding Mitchell Transport, Inc., including but not limited to all insurance applications, your complete underwriting file, and complete claims files regarding all collisions or incidents that trucks operated by Mitchell Transport or any driver employed by Mitchell Transport were involved in from July 1, 1997 through the present.

Exs. E-F, attached to doc. 44.

Apparently, Mitchell Transport applied for, or obtained, liability insurance from these entities at one time. Mitchell Transport objects to the document request contained in the subpoenas on the grounds that it is overly broad and does not seek relevant information. It also objects on the basis that "the information contained in the insurance applications and underwriting files is proprietary in nature in that it contains information such as client lists, routes of travel, net worth, etc." Doc. 44 at p. 3. Finally, it asserts that any underwriting or claims files produced "will likely contain" privileged information. Doc. 52 at 5.

1. Overbreadth and irrelevance

Mitchell Transport argues that the request is overly broad in its scope and time frame **[*22]** (July 1, 1997 [4] to the present) and that any records relating to any other accidents or claims involving Mitchell Transport drivers have no bearing on the issue in this case, *i.e.,* whether *Ramsey* negligently caused the accident involving Plaintiff James Stewart. Plaintiffs do not directly respond to these overbreadth and relevance arguments, and instead assert that irrelevance and overbreadth are not proper grounds for quashing a subpoena.

As discussed above, a court may quash a subpoena duces tecum that is overly broad or that seeks irrelevant documents. The Court will thus examine the merits of Mitchell Transport's objections. The Court finds the request to be relevant on its face and can easily conceive how the requested documents might reveal information about other accidents and safety violations that would be relevant to Plaintiffs' punitive damages claims. At the same time, however, the Court finds the time period covered to be overly **[*23]** broad. The Court will therefore limit the subpoena to the time frame July 1, 1997 through June 30, 1998, which is the one-year period following the collision in this case.

In addition, for the same reasons discussed above in Part II.C.1.a, the Court finds the request to be overly broad to the extent the subpoenas command AIC and Sentry to produce (1) "information," and (2) all documents and records "regarding" Mitchell Transport. The Court therefore quashes the subpoenas served on AIC and Sentry to the extent they request this information and these documents.

2. Proprietary nature of the documents

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[4] The collision in this case occurred on July 1, 1997.

The Court will next address Defendants' objection that the subpoenaed documents contain "proprietary information" such as "client lists, routes of travel, net worth, etc." *See* Doc. 44 at p. 3. Defendants contend that this proprietary information falls within the scope of *Rule 45(c)(3)(B)(1)*, which requires the Court to quash a subpoena that will result in "disclosure of a trade secret or other confidential research, development, or commercial information." *Fed.R.Civ.P. 45(c)(3)(B)(1)*.

The Federal Rules of Civil Procedure do not define the term "trade secret" or **[*24]** "confidential research, development, or commercial information." Case law, however, has defined these terms to mean "information, which, if disclosed would cause substantial economic harm to the competitive position of the entity from whom the information was obtained." *In re S3 LTD, 242 B.R. 872, 876 (Bankr. E.D. Va. 1999)* (quoting *Diamond State Ins. Co. v. Rebel Oil Co., 157 F.R.D. 691, 697 (D. Nev. 1994)*).

The party moving to quash a subpoena under *Rule 45(c)(3)(B)(1)* has the burden to establish that the information sought is confidential and that its disclosure will work a clearly defined and serious injury to the moving party. *Heat & Control, Inc. v. Hester Indus., Inc., 785 F.2d 1017, 1025 (Fed. Cir. 1986)*; *Composition Roofers Union Local 30 Welfare Trust Fund v. Graveley Roofing Enter., Inc., 160 F.R.D. 70, 72 (E.D. Pa. 1995)*. The claim "must be expressly made and supported by a sufficient description of the nature of the documents, communications, or things not produced so as to enable the demanding party to contest the claim." *Diamond State Ins., 157 F.R.D. at 697-98*.

Mitchell Transport **[*25]** has not satisfied this burden. It has failed to show that any specific or serious injury would result from the disclosure of this alleged "proprietary" information. In addition, it has failed to describe the documents with sufficient particularity so as to enable Plaintiffs to contest its claim. The Court will therefore decline to grant the motion to quash under *Rule 45(c)(3)(B)(1)*. Mitchell Transport asks the Court--in the event it denies the motion to quash--to enter a protective order preventing disclosure of this alleged proprietary information to non-parties and prohibiting the use of these documents outside of this lawsuit. For the same reason discussed above with respect to Ramsey's request for a protective order (*see* Part II.C.2, *supra*), the Court will direct counsel for the parties to work together with AIC and Sentry to submit an agreed protective order guarding the confidentiality of the alleged proprietary documents/information.

3. Claim of privilege

Finally, Mitchell Transport alleges that the requested underwriting and claims files "will likely contain information which is protected by the attorney/client privilege, work product doctrine and/or insurer/insured **[*26]** privilege." Doc. 52 at 5. Mitchell Transport seeks to quash the subpoenas pursuant to *Rule 45(c)(3)(A)(3)*, which requires a court to quash a subpoena that will result in "disclosure of privileged or other protected matter [where] no exception or waiver applies."

This Court recently summarized the rules regarding subpoenas and privilege as follows:

Parties objecting to [a subpoena] on the basis of . . . privilege bear the burden of establishing that it applies. To carry the burden, they must describe in detail the documents or information to be protected [5] and provide precise reasons for the objection to discovery. A blanket claim as to the applicability of a privilege does not satisfy the burden of proof.

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[5] *Rule 45 (d)(2)* expressly provides that "when information subject to a subpoena is withheld on a claim that such information is privileged or subject to protection as trial preparation materials, the claim shall be made expressly and shall be supported by a description of the nature of the documents, communications or things not produced that is sufficient to enable the demanding party to contest the claim."

[*27] *Phalp v. City Of Overland Park, Kan., 2002 U.S. Dist. LEXIS 9684*, No. 00-2354- *JAR, 2002 WL 1162449, at *2 (D. Kan. May 8, 2002)* (citations and internal quotations omitted).

Mitchell Transport has failed to satisfy these requirements with respect to its privilege and work product objections. The Court therefore does not possess sufficient information to enable it to determine whether each element of the asserted privilege/protection has been satisfied. Given Mitchell Transport's failure to provide the required information, the Court could deny the motion to quash to the extent it is based on Mitchell Transport's assertion of privilege and work product protection. The Court, however, will decline to do so at this time. Instead, the Court will grant the motion to quash as to the alleged privileged/protected documents, and AIC and Sentry shall not be required to produce, at least at this time, the requested documents that Mitchell Transport contends are privileged/protected. Notwithstanding the above, however, the Court will direct Mitchell Transport to provide to Plaintiffs a privilege log containing "a detailed description of the materials in dispute and specific and precise reasons **[*28]** for its claim of protection from disclosure." *See id.* (citation omitted) (requiring party moving to quash on privilege grounds to provide privilege log). The log should, at a minimum, include the following for each document that Mitchell Transport contends is privileged or protected by the work product doctrine:

1. A description of the document (i.e., correspondence, memorandum, etc.);

2. Date prepared or date notations made;

3. Date of document (if different from # 2);

4. Who prepared the document or made notations on the document;

5. For whom the document was prepared and to whom it was directed;

6. Purpose of preparing the document or making the notations;

7. Number of pages of each document; and

8. Basis for withholding discovery.

See id (setting forth minimum requirements for privilege log).

Mitchell Transport shall provide this privilege log to Plaintiffs within ten (10) days from the date of filing of this Memorandum and Order. [6] Plaintiffs may then request production of any document for which the claim of privilege/protection appears inadequate or waived, and, if Mitchell Transport objects as provided for under **[*29]** *Rule 45(c)(2)(B)*, Plaintiffs may file a motion to compel pursuant to that same rule.

III. AIC's Motions to Quash, or in the Alternative, for Protective Order (doc. 24 and 51)

A. AIC's Motion to Quash First Subpoena, or in the Alternative, for Protective Order (doc. 24)

Plaintiffs have served, or have attempted to serve, two subpoenas on AIC. AIC moves to quash the first subpoena, arguing that it was not properly served on AIC. Although Plaintiffs do not concede that the first subpoena was improperly served, they do state in their response that they have re-served the subpoena on AIC. By serving the second subpoena, Plaintiffs effectively withdrew the first subpoena, thereby rendering moot the issues raised in this first motion to quash.

B. AIC's **[*30]** Motion to Quash Second Subpoena, or in the Alternative, for Protective Order (doc. 51)

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[6] In Part III.B.1, below, the Court grants in part AIC's motion to quash the second subpoena served on it. The Court recognizes that its rulings with respect to AIC's motion to quash may render Mitchell Transport's privilege concerns moot.

AIC moves to quash the second subpoena on numerous grounds. In the event the Court denies the motion to quash, AIC requests that the Court enter a protective order to guard the confidentiality of any documents AIC produces pursuant to this subpoena.

1. Irrelevance

AIC raises much the same argument as Mitchell Transport regarding the lack of relevance of the subpoenaed documents. For the same reasons discussed above in Part II.B.1, the Court will limit the second subpoena to the time period July 1, 1997 to June 30, 1998 and will quash the second subpoena to the extent it commands AIC to produce documents outside of that time frame.

The Court also notes that its ruling above with respect to the overly broad nature of the subpoena (*see* Part II.C.1.a, *supra*), applies equally to AIC. The Court thus grants AIC's motion to quash to the extent the second subpoena commands AIC to produce (1) "information," and (2) all documents and records "regarding" Mitchell Transport.

2. Privacy rights of other drivers

AIC also moves to quash the second subpoena on the basis **[*31]** that the subpoena requires AIC to divulge information about the driving records of thirty-six drivers who are not parties to this action. AIC asserts that disclosure of this information would violate Tennessee and federal law protecting against the disclosure of such information. *See* Tenn. Code Ann. *§ 55-25-107*; *18 U.S.C. § 2721*. As Plaintiffs correctly point out, however, those laws allow the disclosure of such information "for use in connection with any civil . . . proceeding." *See Tenn. Code Ann. § 55-25-107*; *18 U.S.C. § 2721*.

Accordingly, the Court will decline to quash the second subpoena based on AIC's privacy objections. [7] The Court will, however, grant AIC's motion for protective order to guard against disclosure of these documents to non-parties and to prohibit use of these documents outside of this litigation. Counsel for AIC shall work together with counsel for the parties to agree to a protective order prohibiting the disclosure of these documents to non-parties and prohibiting the use of these documents outside of this lawsuit. In the event an agreement cannot be reached, AIC shall, within ten (10) days **[*32]** from the date of filing of this Order, submit to the Court a proposed protective order for the Court's review.

3. Proprietary and trade secret information

AIC objects to producing certain documents that "contain numbers, dollars and codes used by AIC in calculating premiums" (doc. 51 at p. 2) on the basis that they contain proprietary and trade secret information. Plaintiffs respond that they are not interested in these documents. The Court will therefore grant the motion to quash to the extent it commands AIC to produce documents containing such information.

AIC also objects to producing a "Fleet Safety Evaluation" on the basis that it too contains proprietary and trade secret information. AIC states that the Fleet Safety **[*33]** Evaluation was conducted in September 2001. Because the Court has already ruled that the only relevant time period is July 1, 1997 to June 30, 1998, AIC is not required to produce the Fleet Safety Evaluation and the Court need not address AIC's trade secret argument regarding the Evaluation.

4. Claim of privilege as to AIC's claims files

AIC states that it has already provided Plaintiffs with the claims file relating to Plaintiff James Stewart's accident. AIC objects to producing privileged documents from any other claims files, because those files all relate to other accidents. According to AIC, those accidents occurred after September 2001. Because these other claims files fall

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[7] The Court recognizes that ten drivers whose records are covered by the second subpoena were not even hired by Mitchell Transport until 2002. Given the Court's ruling as to the relevant time period of the second subpoena, those drivers' records need not be produced.

outside the relevant time period, AIC is not required to produce them, and the Court need not address AIC's privilege objection.

IT IS THEREFORE ORDERED that Defendants' Renewed Motion to Quash (doc. 43-1) is denied to the extent it is brought by Defendants Larry G. Ramsey and Insurance Corporation of Hannover to quash the subpoenas served on Associates Insurance Company and Sentry Select Insurance Company.

IT IS FURTHER ORDERED that Defendants' Renewed Motion to Quash (doc. **[*34]** 43-1) is denied to the extent it is brought by Defendants Mitchell Transport, Inc. and Insurance Corporation of Hannover to quash the subpoenas served on Boyd Brothers Transportation, Mayfield Printing, General Tire and Rubber, and Goodyear Tire and Rubber.

IT IS FURTHER ORDERED that the Court declines to entertain Defendants' Renewed Motion to Quash (doc. 43-1) to the extent it seeks to quash the subpoena served on AXA Global Risks US Insurance Company.

IT IS FURTHER ORDERED that Defendants' Renewed Motion to Quash (doc. 43-1) is granted to the extent it is brought by Defendant Larry G. Ramsey to quash that portion of the subpoenas served on Boyd Brothers Transportation, Mayfield Printing, General Tire and Rubber, and Goodyear Tire and Rubber which commands them to produce "all records, documents or information in [their] possession regarding Larry G. Ramsey." The Renewed Motion to Quash (doc. 43-1) is denied in all other respects as it applies to the subpoenas served on Boyd Brothers Transportation, Mayfield Printing, General Tire and Rubber, and Goodyear Tire and Rubber.

IT IS FURTHER ORDERED that the Motion for Protective Order (doc. 43-2) brought **[*35]** by Larry G. Ramsey to protect the confidentiality of documents subpoenaed from Boyd Brothers Transportation, Mayfield Printing, General Tire and Rubber, and Goodyear Tire and Rubber is denied. However, within ten (10) days of the date of filing of this Order, counsel for the parties shall confer and attempt to agree upon a protective order guarding the confidentiality of any private or medical information about Ramsey contained in any documents subpoenaed from Boyd Brothers Transportation, Mayfield Printing, General Tire and Rubber, and Goodyear Tire and Rubber. If the parties are unable to reach an agreement, the Court will allow Ramsey five (5) days thereafter to move for a protective order protecting the confidentiality of the documents/information. Plaintiffs shall respond to the motion for protective order within five (5) days after service of the motion. If neither an agreed-upon protective order nor a motion for protective order is filed within the time period specified, production of the documents requested in the subpoenas served on Boyd Brothers Transportation, Mayfield Printing, General Tire and Rubber, and Goodyear Tire and Rubber. shall proceed **[*36]** without the protection of any such order.

IT IS FURTHER ORDERED that Defendants' Renewed Motion to Quash (doc. 43-1) is granted in part and denied in part, as set forth herein, to the extent it is brought by Defendant Mitchell Transport, Inc. to quash the subpoenas served on Associates Insurance Company and Sentry Select Insurance Company.

IT IS FURTHER ORDERED that Mitchell Transport, Inc. shall, within ten (10) days from the date of filing of this Order, serve on Plaintiffs a privilege log as set forth herein. Plaintiffs may then request production of any document for which the claim of privilege/protection appears inadequate or waived, and, if Mitchell Transport, Inc. objects as provided for in *Rule 45(c)(2)(B)*, Plaintiffs may file a motion to compel pursuant to that same rule.

IT IS FURTHER ORDERED that the Motion for Protective Order (doc. 43-2) brought by Mitchell Transport, Inc. to protect the confidentiality of alleged proprietary information contained in the documents subpoenaed from Associates Insurance Company and Sentry Select Insurance Company is denied. However, within ten (10) days of the date of filing of this Order, **[*37]** counsel for the parties, in conjunction with Associates Insurance Company and Sentry Select Insurance Company, shall confer and attempt to agree upon such a protective order. If an agreement is not reached, the Court will allow Mitchell Transport five (5) days thereafter to move for a protective order protecting the confidentiality of the alleged proprietary documents/information. Plaintiffs shall respond to the motion for protective order within five (5) days after service of the motion.

IT IS FURTHER ORDERED that Associates Insurance Company's Motion to Quash Subpoena, or in the Alternative, for Protective Order (doc. 24) is denied as moot.

IT IS FURTHER ORDERED that Associates Insurance Company's Motion to Quash Second Subpoena (doc. 51-1) is granted in part and denied in part as set forth herein.

IT IS FURTHER ORDERED that Associates Insurance Company's Motion for Protective Order (doc. 51-2) is granted as to the records of those drivers that Associates Insurance Company is required to produce pursuant to this Order. Counsel for Associates Insurance Company shall work together with counsel for the parties to agree to a protective **[*38]** order protecting the confidentiality of these documents. In the event an agreement cannot be reached, Associates Insurance Company shall, within ten (10) days from the date of filing of this Order, submit to the Court a proposed protective order for the Court's review.

IT IS SO ORDERED.

Dated in Kansas City, Kansas on this 11th day of July, 2002.

David J. Waxse

U.S. Magistrate Judge

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Villanueva v. Cnty. of Los Angeles

United States District Court for the Central District of California

April 14, 2025, Decided; April 14, 2025, Filed

2:24-cv-04979-SVW-JC

Reporter
2025 U.S. Dist. LEXIS 116120 *; 2025 LX 109472; 2025 WL 1674379

Alex Villanueva v. County of Los Angeles, et al.

Prior History: *Villanueva v. Cnty. of Los Angeles, 2024 U.S. Dist. LEXIS 171670, 2024 WL 4720870 (C.D. Cal., Sept. 20, 2024)*

Core Terms

subpoena, quashing a subpoena, offset, collateral source rule, medical information, collateral source, employee benefits, privacy concerns, right to privacy, lost wages, proportional, tortfeasor, pension, privacy, notice

Counsel: **[*1]** For Alex Villanueva, Plaintiff: John Michael David, Shegerian and Associates Inc., Los Angeles, CA; Carney R Shegerian, LEAD ATTORNEY, Mahru Madjidi, Shegerian and Associates Inc, Los Angeles, CA; Alex Karl DiBona, Shegerian & Associates, Los Angeles, CA; Yesenia Cardoza, Shegerian and Associates, Los Angeles, CA.

For County Equity Oversight Panel, Los Angeles County Office of Inspector General, County of Los Angeles Sheriffs Department, County of Los Angeles, Mercedes Cruz, Roberta Yang, Defendants: Brian Neach, Steven G Williamson, Jason H. Tokoro, Miller Barondess LLP, Los Angeles, CA.

For Constance Komoroski, Defendant: Jason H. Tokoro, Brian Neach, Steven G Williamson, Miller Barondess LLP, Los Angeles, CA.

For Esther Lim, Laura Lecrivain, Ron Kopperud, Defendants: Steven G Williamson, Jason H. Tokoro, Brian Neach, Miller Barondess LLP, Los Angeles, CA.

For Max-Gustaf Huntsman, Los Angeles County Board of Supervisors, Defendants: Steven G Williamson, Brian Neach, Jason H. Tokoro, Miller Barondess LLP, Los Angeles, CA.

For Does, 1 to 100 inclusive, Defendant: Jason H. Tokoro, Miller Barondess LLP, Los Angeles, CA.

For Robert G Luna, Sergio V Escobedo, Defendants: Jason H. Tokoro, Steven **[*2]** G Williamson, Brian Neach, Miller Barondess LLP, Los Angeles, CA.

Judges: Jacqueline Chooljian, United States Magistrate Judge.

Opinion by: Jacqueline Chooljian

Opinion

CIVIL MINUTES - GENERAL

Proceedings: (IN CHAMBERS)

ORDER GRANTING IN PART AND DENYING IN PART PLAINTIFF'S MOTION TO QUASH SUBPOENA TO THIRD PARTY LACERA (DOCKET NOS 67-70)

Pending before the Court is Plaintiff's Motion to Quash Subpoena to Third Party-Party LACERA [Los Angeles County Employees Retirement Association] ("Motion"), which Defendant opposes and which has been submitted for decision.[1] The Motion essentially requests that the Court quash a subpoena ("Subpoena") issued by Defendant the County of Los Angeles ("County" or "Defendant") which seeks specified pension records.[2] (See Notice/Amended Notice of Motion to Quash (Docket Nos. 68, 69); JS at 2 (Docket No. 70)).[3]

Based on the Court's consideration of the parties' submissions in connection with the Motion and the pertinent facts and law, the Court grants in part and denies in part the Motion. The Motion is granted and the Subpoena is quashed to the extent it calls for the production of Plaintiff's medical information and records prior to 2021 and is otherwise denied.

First, the Court rejects Plaintiff's **[*3]** assertion that the information sought by the Subpoena, to the extent not quashed — is not relevant. As Plaintiff seeks the loss of employee benefits as part of his damages, the information sought appears to be relevant at least to the calculation of damages.[4] Further, notwithstanding case law disapproving the *admissibility* of evidence of the receipt of benefits to demonstrate that a plaintiff lacks motivation to work/is incentivized not to return to work under *Fed. R. Evid. 403* or as an offset to damages sought (see, e.g.,

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[1] In connection with the Motion, the parties filed a Notice and Amended Notice of Motion to Quash, two copies of what appears to be the same Joint Stipulation ("JS"), a Declaration of Alex DiBona ("DiBona Decl.") with exhibits ("DiBona Ex."), and a Declaration of Jason Tokoro ("Tokora Decl.") with exhibits (Tokora Exs."). (Docket Nos. 67-70).

[2] More specifically, the Subpoena essentially calls for the production of: (1) all documents relating to any pension or retirement benefits administered or managed by LACERA on behalf of, or for the benefit of, Plaintiff; (2) all communications between LACERA and Plaintiff relating to any of Plaintiff's pension or retirement benefits; (3) all documents and communications reflecting any disbursements of pension payments or retirement benefits from LACERA to Plaintiff; (4) all documents and communications reflecting any disbursements of payments of any kind from LACERA to Plaintiff; (5) all documents reflecting policies that explain how the total amounts in Plaintiff's pension or retirement benefit accounts are calculated; (6) all documents reflecting policies that explain how the amounts of any disbursements of pension payments or retirement benefits from LACERA to Plaintiff are calculated; (7) all documents reflecting policies that explain Plaintiff's eligibility to receive any pension payments or retirement benefits from LACERA; (8) all documents reflecting policies that explain whether Plaintiff was eligible to accrue any pension or retirement benefits with LACERA during the time he held elected office as Los Angeles County Sheriff; (9) all documents reflecting policies that explain whether Plaintiff would be eligible to receive any pension payments or retirement benefits from LACERA if he resumes employment with the County;); (10) all documents reflecting policies that explain whether Plaintiff would be eligible to receive any pension payments or retirement benefits from LACERA if he was retained by the County as an independent contractor or consultant; (11) all documents reflecting policies that explain whether Plaintiff would be eligible to receive any pension payments or retirement benefits from LACERA if he gains employment with any entity other than the County; and (12) all documents reflecting policies that explain whether Plaintiff would be eligible to receive any pension payments or retirement benefits from LACERA if he is retained as an independent contractor or consultant by any entity other than the County. (DiBona Ex. 1).

[3] This Court addresses only the grounds for quashal that are actually argued in the Joint Stipulation.

[4] Plaintiff alleges that he has sustained and continues to sustain losses of earnings and other employment benefits and prays for general, special, exemplary, punitive, and nominal damages, pre- and post-judgment interest on all damages awarded, reasonable attorneys' fees and costs, declaratory relief, an injunction requiring Defendants to rescind his placement on the "Do Not Hire" list, equitable relief, and such other relief as the Court may deem just and proper. (FAC ¶¶ 33, 38; FAC at 20). Plaintiff's Supplemental ***Rule 26*** Disclosures more specifically reflect that Plaintiff seeks (1) economic damages of past and future loss of earnings corresponding to the amount he would have earned should he be able to return to work for the County absent its unlawful acts in an amount that exceeds $1 million; (2) economic damages of past and future loss emotional distress of at least $25 million; (3) all attorney fees, costs, and interest and injunctive relief as the prevailing party; and (4) injunctive relief in the form of removal from the "Do Not Rehire" list. (Tokoro Ex. 2; Docket No. 70-2 at 35).

*Davis v. CVS Pharmacy, Inc., 2023 U.S. Dist. LEXIS 46937, 2023 WL 2558412, at *2 & *5 (C.D. Cal. Feb. 10, 2023)*), this Court declines to find that pension benefits are not *relevant* to Plaintiff's motivation/incentive to work or to a potential offset. Whether the former evidence should be admitted under *Rule 403* or otherwise considered by the District Judge in offsetting damages without presentation to the jury are matters for the District Judge, not the Magistrate Judge to decide.

Second, this Court rejects Plaintiff's assertion that the "collateral source" rule warrants quashal of the Subpoena. "The collateral source rule provides that 'if an injured party receives some compensation for his injuries from a source *wholly independent of the tortfeasor*, such payments should not be deducted from the damages **[*4]** which the plaintiff would otherwise collect from the tortfeasor.'" *Betkey v. Cnty. of Los Angeles, 2017 U.S. Dist. LEXIS 235755, 2017 WL 11632310, at *4 (C.D. Cal. Sept. 5, 2017)* (quoting *Helfend v. S. Cal. Rapid Trans. Dist., 2 Cal. 3d 1, 6, 84 Cal. Rptr. 173, 465 P.2d 61 (1970)*) (emphasis added in Betkey). Subject to any different determination by the assigned District Judge, it appears to this Court that such rule is not applicable here because the County — as a contributor to LACERA/the employee benefit fund — is not a "collateral" source. See *Betkey, 2017 U.S. Dist. LEXIS 235755, 2017 WL 11632310, at *4*; *Smart v. Cal. Highway Patrol, 2021 U.S. Dist. LEXIS 76009, 2021 WL 1549698, at *1 (E.D. Cal. Apr. 20, 2021)* (denying motion to quash subpoena seeking, among other things, retirement benefit documents)); *Davis, 2023 U.S. Dist. LEXIS 46937, 2023 WL 2558412, at *2* (rejecting assertion that collateral source rule barred consideration of workers' compensation payments to offset claim for lost wages where defendant was source of payments and thus they did not come from a "collateral source"; noting that it was unnecessary for defendant to prove to jury that plaintiff had already been compensated for part of his lost wages as court itself could offset such payments against any recovery at trial).

Third, the Court declines to quash the whole Subpoena based on Plaintiff's right to privacy but, as noted above, has narrowed it somewhat in part because of Plaintiff's privacy concerns. Federal courts ordinarily recognize a constitutionally-based right of privacy that can be raised in response to discovery requests. **[*5]** *A. Farber & Partners, Inc. v. Garber, 234 F.R.D. 186, 191 (C.D. Cal. 2006)*. Courts balance the need for the information sought against the privacy right asserted. Id. Here, the Court has conducted the requisite balancing and finds that the County's need for the information sought by the Subpoena as narrowed by the Court, outweighs Plaintiff's right to privacy relative to such records and that Plaintiff's privacy concerns can adequately be addressed by the existing Protective Order in this action. (Docket No. 66).

Fourth, the Court grants in part and denies in part the Motion to the extent it seeks to quash the Subpoena based on overbreadth/lack of proportionality. Plaintiff complains that the Subpoena is broad enough to encompass medical evaluations — something Defendant indicates it "is not seeking" from LACERA, so the Court has quashed the Subpoena to the extent it can be read to call for the production of Plaintiff's medical information. Further, the Court notes that the Subpoena is not bounded by time and deems it appropriate to limit the Subpoena to responsive information from 2021 to the present. As narrowed, the Court views the Subpoena to call for relevant information proportional to the needs of the case and does not view it to be overbroad in light **[*6]** of Plaintiff's allegations and request for damages.

Finally, the Court declines to quash the Subpoena based on Plaintiff's "undue burden" objection. The Subpoena is directed to LACERA, not Plaintiff. LACERA has not itself complained of burden and Plaintiff presents no evidence to support his assertion that it imposes a burden upon him.[5]

IT IS SO ORDERED.

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[5] Plaintiff asserts that *Ditton v. BNSF Ry. Co., 2014 U.S. Dist. LEXIS 204883, 2014 WL 12928305, at *6 (C.D. Cal. Jan. 6, 2014)* held that "subpoenas that require plaintiffs to produce extensive financial records unrelated to damages calculations are unduly burdensome and should be quashed." (JS at 7). This Court locates no such holding in *Ditton*. In any event, the Subpoena here is directed to LACERA and does not require Plaintiff to produce anything.

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Williams v. City of Dallas

United States District Court for the Northern District of Texas, Dallas Division

March 5, 1998, Decided ; March 5, 1998, Filed

Civil Action No. 3:97-CV-0296-D

Reporter
178 F.R.D. 103 *; 1998 U.S. Dist. LEXIS 2583 **

ERIK WILLIAMS, Plaintiff, VS. THE CITY OF DALLAS, BENJAMIN CLICK, JAMES CHANDLER, DAVID GOELDEN, ROSS SALVERINO, KIM SANDERS, and certain UNNAMED MEMBERS OF THE DALLAS POLICE DEPARTMENT, individually and in their official capacities as police officers of the City of Dallas, Defendants.

Disposition: [1]** Subpoenas, enforced as modified, motions to quash subpoenas duces tecum filed by two attorneys who represented parties in now-concluded, related litigation initiated by the plaintiff in the present case granted in part and denied in part.

Core Terms

subpoena, discovery, undue burden, deposition, videotape, nonparty, modify, attorney-client, overbroad, sexual assault, assault, cowboy, gun, present case, burdensome, television, facially, parkland, rape, attorney's work product, production of documents, quashing a subpoena, opposing counsel, credibility, doctrine, custody, deprive, violent, notice, player

Case Summary

Procedural Posture

Plaintiff professional football player, in an action filed in the court against defendants, City of Dallas, its police chief, and certain officers, served a subpoena duces tecum on nonparty attorneys requiring them to appear for deposition and produce all documents relating to a rape charge that formed the basis of the instant action. Nonparty attorneys filed a motion to quash the subpoena as unduly burdensome pursuant to *Fed. R. Civ. P. 45*.

Overview

Nonparty attorneys were served with a subpoena duces tecum requiring them to appear for depositions and provide certain documents to plaintiff professional football player for his use in an action against defendants, City of Dallas, its police chief, and police officers. The nonparty attorneys had represented a television station and its reporter in separate but related litigation initiated by plaintiff in connection with a false charge of rape. The nonparty attorneys sought to have the subpoena quashed as unduly burdensome pursuant to *Fed. R. Civ. P. 45*. The court found that as drafted, the subpoena was facially broad and burdensome, but held that modification was preferable to quashing, and narrowed its scope. The court ordered movants to comply with the narrowed subpoena. The court agreed with movants that their status as nonparties was an important factor to be considered, but held that this fact, on its own, did not support a finding of undue burden. The court rejected the argument that the subpoena should have been quashed because it required disclosure of privileged information, holding that such assertion could only be made on a document by document basis.

Outcome

The court found that the subpoena duces tecum issued to nonparty attorneys was facially broad and burdensome, but held that narrowing the subpoena was preferable to quashing it. The court narrowed the scope of the subpoena

178 F.R.D. 103, *103; 1998 U.S. Dist. LEXIS 2583, **1

and as modified, ordered nonparty attorneys to comply, and rejected their arguments of attorney-client and attorney work-product privilege, advising them that such arguments could only be made on a document specific basis.

Counsel: Jack Balagia, Jr., McGinnis, Lochridge & Kilgore, L.L.P., Houston, TX, for Charles L. Babcock and E. Leon Carter, movants.

Charles L. Babcock, E. Leon Carter, and James M. McCown, Jackson Walker L.L.P., Dallas, TX, for Charles L. Babcock and E. Leon Carter, movants.

Peter R. Ginsberg and Linda B. Popejoy, Foley Hoag & Eliot L.L.P., Washington, D.C., for plaintiff.

Jack W. Pirozzolo and Colin Owyang, Foley Hoag & Eliot L.L.P., Boston, MA, for plaintiff.

Illona Sheffey-Rawlings, Dallas, TX, for plaintiff.

Judges: SIDNEY A. FITZWATER, UNITED STATES DISTRICT JUDGE.

Opinion by: SIDNEY A. FITZWATER

Opinion

[*105] FITZWATER, District Judge:

The court is asked to decide motions to quash subpoenas *duces tecum* filed by two attorneys who represented parties in now-concluded, **[*106]** related litigation initiated by the plaintiff in the present case. The principal question presented is whether the attorneys will be subjected to an undue burden, within the meaning **[**2]** of *Fed. R. Civ. P. 45(c)(3)(A)(iv)*, if they are required to appear for deposition and produce the subpoenaed documents. Because the court concludes that the subpoenas, although facially overbroad, can be enforced as modified, it grants the motions in part and denies them in part.

I

This is an action by plaintiff Erik Williams ("Williams"), a lineman for the Dallas Cowboys professional football team, against defendants the City of Dallas ("City"); Bennie R. Click ("Chief Click"), [1] the Chief of Police of the Dallas Police Department ("DPD"); James Chandler ("Sgt. Chandler"), an officer assigned to the DPD Public Information Office; David Goelden ("Lt. Goelden"), a Lieutenant in the DPD Crimes Against Persons ("CAPERS") Unit; Ross Salverino ("Sgt. Salverino"), a sergeant in the CAPERS Sexual Assault Unit; Kim Sanders ("Detective Sanders"), a DPD drug task force detective; and certain unnamed members of the DPD, individually and in their official capacities as police officers of the City of Dallas. Williams alleges that some or all the defendants are liable pursuant to *42 U.S.C. § 1983* for violating his rights under the *Fourth* and *Fourteenth Amendments*, and based on various pendent **[**3]** state-law claims, for conduct in which they engaged following an allegation by Nina Shahravan ("Shahravan") that Williams and an unnamed male had raped her in Williams' home while Dallas Cowboys teammate Michael Irvin ("Irvin") threatened her with a gun and videotaped the assault. [2]

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[1] Chief Click is sued as "Benjamin" Click. The court refers to him by his true name.

[2] Irvin has filed a separate suit, *Irvin v. City of Dallas, Tex.*, Civil Action No. 3:97-CV-1327-D, which is pending before the court.

178 F.R.D. 103, *106; 1998 U.S. Dist. LEXIS 2583, **3

For purposes of deciding the present motion, the court recounts the background facts as Williams has pleaded them in his complaint. [3] Shahravan had for some period of time been a Dallas Cowboys "hanger-on" who had attended parties hosted by team players and had social contact with Irvin. Martin Griffin ("Griffin"), a reporter for the Dallas-Fort Worth NBC affiliate KXAS-TV, who was well-known for his tabloid-style of journalism and attacks on Cowboys players, capitalized on Shahravan's relationship with **[**4]** these athletes to use her as a source for stories critical of their off-field activities. In November 1996 Shahravan and Griffin approached Detective Sanders and other defendants with allegations of drug use and other activities by Cowboys players. Defendants declined to investigate because they doubted Shahravan's credibility. The same month, Shahravan devised a scheme to falsely implicate Irvin--who was already on probation for a prior drug conviction--in a drug transaction by acting as a courier who would supply him with drugs. She later decided not to go through with her plan. Despite this, Shahravan and Griffin contacted the DPD, including certain of the defendants, with a story that Shahravan has been used as a drug runner for Irvin. Defendants again determined that Shahravan was not credible, and declined to investigate.

[5]** Although Irvin was the principal target of Griffin's and Shahravan's activities, Williams eventually became involved after Irvin terminated social contact with Shahravan. On December 28, 1996 the Cowboys won an NFL playoff game. The next day, December 29, Williams attended a gathering of players and coaches. Shahravan contacted Williams, and the two agreed to meet at his house later that evening. Williams arrived with a male friend, and Shahravan consented to engage in sexual intercourse with both of them and to be videotaped while doing so. **[*107]** Irvin was not present and had not been to Williams' home in more than one year. No one threatened Shahravan with a gun and no gun was displayed to her. None of the three used drugs and no drugs were present in the house. Shahravan voluntarily engaged in sex with both men.

On December 30, 1996 Shahravan paged Williams and he returned her call. Shahravan asked him for tickets to the upcoming playoff game, but her true intent in calling him was to create a record that Williams had telephoned her the day after he "assaulted" her. Shahravan then spoke with Griffin about her story that Williams had raped her while Irvin had videotaped the assault and **[**6]** threatened her at gun point. Griffin and Shahravan then agreed to report the story to the DPD. Griffin either knew the allegations to be false, or acted negligently or in reckless disregard for the falsity of her claims.

Shahravan and Griffin approached the DPD with her charges. The afternoon of December 30 Shahravan and Griffin spoke with Detective Sanders. Despite the fact that Shahravan did not appear to be distraught, and the absence of corroborating signs of the violent sexual assault that Shahravan had described to him, Detective Sanders advised Shahravan to go immediately to Parkland Memorial Hospital ("Parkland"), the Dallas County public hospital, so that she could be examined for physical evidence of rape. Shahravan did not go to Parkland and Griffin did not take her there. Shahravan later told the defendants that she could not find the hospital, but her real reason for not going was her concern that there would be no physical evidence of rape.

That evening Shahravan returned to the DPD and met with Sgt. Salverino, a member of the DPD CAPERS Sexual Assault Unit, to whom she repeated her charges. She falsely informed Sgt. Salverino that Williams had violently assaulted her, **[**7]** slapped her, physically hurt her during sexual intercourse, and telephoned her to say that he would be more gentle the next time. Sgt. Salverino arranged for Shahravan to be examined at Parkland. The examination failed to corroborate the violent sexual assault that she had recounted. Although Shahravan had small bruises on her leg and back, the signs of the sexual encounter were consistent with consensual intercourse.

In response to Shahravan's charges, Sgt. Salverino executed an affidavit to obtain a search warrant. He described a violent sexual assault, mentioned that a videotape and gun might be found, and stated that a pool table might contain fingerprints. Sgt. Salverino did this despite the fact that defendants knew Shahravan not to be credible, that

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[3] Defendants deny the material allegations of Williams' complaint and deny that they are liable to him on any of the claims in this suit. As the court explains *infra* at § II(C), however, for purposes of deciding whether subpoenas impose an undue burden on subpoenaed nonparties, the court measures relevance according to the standard prescribed by ***Rule 26(b)(1)***. The court therefore concludes that it should decide the motions to quash according to the allegations of Williams' complaint.

she had first reported her allegations to a tabloid-style television reporter known for attacking Dallas Cowboys football players, that the physical examination did not corroborate her description of a violent sexual attack, that she had offered the implausible explanation that she could not find Parkland, and that she did not appear to be distraught. In order to obtain a search warrant, Sgt. Salverino knowingly mischaracterized **[**8]** the Parkland examination results and omitted information that would have shed light on Shahravan's lack of credibility.

Based on the affidavit, on December 31, at 4:55 a.m., a state judge issued a search warrant for Williams' home. Chief Click, Sgt. Salverino, and other officers held a meeting after the affidavit was prepared and the warrant was issued. They decided to alert members of the media that a search was to be conducted of Williams' home. During the course of the search, they advised the local ABC affiliate.

At approximately 5:00 a.m. police officers arrived at Williams' home, knocked and announced their presence, and initiated a search. Officers cut eight pieces of felt from a pool table and seized a video camera, videotapes, three guns, hair samples, other personal items, and a videotape depicting Williams and Shahravan engaged in consensual sex.

Following the search, Chief Click convened a press conference and granted other exclusive press interviews. Defendants publicly announced that Williams and Irvin were suspects in an alleged rape, thereby violating a DPD policy that forbids disclosing the surnames of suspects in the narrative of any report of a sexual assault **[**9]** offense. Lt. Goelden **[*108]** stated in one interview that he believed a sexual assault had occurred at Williams' house and that charges would be filed against Williams. He also negligently or recklessly falsely stated that the arrests of Williams and Irvin were imminent, and that there was videotaped evidence of the assault.

Almost immediately following the press conference and interviews, defendants learned or should have learned that additional information belied Shahravan's allegations. The videotape depicted consensual sex and otherwise contradicted Shahravan's story in material respects. Defendants knew or should have known of evidence that Irvin was not present and that drugs were not used. Sgt. Chandler falsely and either negligently or recklessly advised the media that the DPD had no reason "to doubt [Shahravan's] credibility at this point." One defendant falsely advised the media that Irvin's voice could be heard on the videotape.

On January 10, 1997 the DPD announced that Williams and Irvin had been cleared and that Shahravan had recanted her story. Shahravan was charged and pleaded guilty to the misdemeanor offense of making a false report to a peace officer, a Class B misdemeanor **[**10]** under Texas law. DPD has refused to return the videotape to Williams, and DPD personnel have circulated it within the department, where it has been viewed as a form of entertainment in circumstances that could have no investigatory purpose.

B

At about the time Williams brought the instant suit in this court, he also sued Griffin, Lin Television of Texas, Inc., and Lin Television of Texas, L.P. d/b/a KXAS Television (collectively "Lin") in Texas state court. Respondents Charles L. Babcock, Esq. ("Babcock") and E. Leon Carter, Esq. ("Carter") represented Griffin and Lin in the suit, which later settled and was dismissed in August 1997.

Several months later Williams served Babcock and Carter with notices of depositions and subpoenas *duces tecum* to produce three categories of documents:

1. Any and all documents relating to Erik Williams, Michael Irvin and Nina Shahravan;
2. All documents that Lin Television or KXAS-TV turned over to the Dallas County District Attorneys' office in connection with the criminal case against Nina Shahravan, except to the extent Lin Television or KXAS-TV has already produced said documents to Williams; and

3. All documents that were **[**11]** turned over to you by the Dallas County District Attorneys' office relating to the criminal case against Nina Shahravan in 1997.

Babcock and Carter responded by moving to quash the subpoenas and the notices of deposition. In identical arguments, they contend that the subpoenas should be quashed pursuant to *Rule 45(c)(3)(A)(iii)* because they require that Babcock and Carter disclose documents that are protected by the attorney-client privilege, the attorney work product doctrine, and the journalist's privilege. They also rely on *Rule 45(c)(3)(A)(iv)*, contending that the document requests are so broad in scope that it would be unduly burdensome to comply with the subpoenas and deposition notices. Babcock and Carter posit that they should be treated as opposing counsel, and that Williams' attempt to obtain discovery from them should be narrowly confined to the circumstances in which such discovery may be conducted. They move to quash their respective depositions on the ground that the only relevant facts within their knowledge are protected as attorney work product or by the attorney-client privilege.

Of the three categories of documents requested, Babcock and Carter contend that **[**12]** Lin has already produced to Williams all documents that are responsive to category 2 and that there are no documents responsive to category 3. Br. at 5 n.1. Williams acknowledges that categories 2 and 3 are no longer at issue, and has limited his response to category 1. Opp. Br. at 2 n.1.

II

A

Babcock and Carter contend that the subpoenas are facially overbroad and burdensome **[*109]** because Williams has not identified any specific document to be produced; the request is not limited in time or topic to any issue of consequence to this litigation or to any other litigation; the deposition notices fail to define the term "document," which could be interpreted to include any type of information that relates to Williams, Irvin, or Shahravan, regardless whether connected to the present suit; Babcock and Carter possess extensive materials that fall within the scope of the subpoenas, and complying with the request would impose tremendous expense on them to review each document for any applicable privilege or for relevance; and Lin has already provided many of these documents to Williams, and most of the other documents can be obtained from other sources, such as the parties to this lawsuit. In **[**13]** their reply brief, Babcock and Carter emphasize that they are entitled to greater protection because they were opposing counsel in Williams' state court suit against Griffin and Lin.

Williams responds that category 1, the sole category in dispute, is only intended "to cover documents relating to the allegations made by Shahravan which gave rise to this suit as well as to Williams' suit against KXAS and Griffin." Opp. Br. at 7. He refutes their assertion that it would be burdensome to require that they examine the documents in their possession, contending that they have failed to offer evidence that responding to the subpoenas would be unreasonable or oppressive. He posits that any burden is outweighed by his need for discovery because Babcock and Carter possess information that is critical to his claims, they may have evidence that one or more defendants improperly obtained, and "they may even have participated with the defendants in improper conduct in obtaining some of that information." *Id.*

B

Rule 45(c)(3)(A)(iv) requires that on timely motion, the court by which a subpoena was issued must quash or modify the subpoena if it "subjects a person to undue burden." [4] The movant **[**14]** has the burden of proof, *Linder v. Department of Defense, 328 U.S. App. D.C. 154, 133 F.3d 17, 24 (D.C. Cir. 1998)* (citing *Northrop Corp. v. McDonnell Douglas Corp., 243 U.S. App. D.C. 19, 751 F.2d 395, 403 (D.C. Cir. 1984)*); *Vitale v. McAtee, 170 F.R.D. 404, 407 (E.D. Pa. 1997)*, and must meet "the heavy burden of establishing that compliance with the subpoena would be 'unreasonable and oppressive.'" *Barnes Found. v. Township of Lower Merion, 1997 U.S. Dist.*

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[4] *Rule 45(c)(3)(A)(iv)*:

On timely motion, the court by which a subpoena was issued shall quash or modify the subpoena if it . . . subjects a person to undue burden.

LEXIS 4444, 1997 WL 169442, at *4 (E.D. Pa. Apr. 7, 1997) (quoting Composition Roofers Union Local 30 Welfare Trust Fund v. Graveley Roofing Enters., Inc., 160 F.R.D. 70, 72 (E.D. Pa. 1995)).

"Whether a burdensome subpoena is reasonable 'must be determined according to the facts of the case,' such as the party's need for the documents and the nature and importance of the litigation." Linder, 133 F.3d at 24 **[**15]** (quoting Northrop, 751 F.2d at 407). Among the factors that the court may consider in determining whether there is an undue burden are "relevance, the need of the party for the documents, the breadth of the document request, the time period covered by it, the particularity with which the documents are described and the burden imposed." Concord Boat Corp. v. Brunswick Corp., 169 F.R.D. 44, 49 (S.D.N.Y. 1996) (quoting United States v. International Bus. Machs. Corp., 83 F.R.D. 97, 104 (S.D.N.Y. 1979)). [5] The status of a witness as a nonparty entitles the witness to consideration regarding expense and inconvenience. *Id.* (citing Rule 45(c)(2)(B)). Undue burden can be found when a subpoena is facially overbroad. *E.g.,* 169 F.R.D. at 51; Semtek Int'l, Inc. v. Merkuriy Ltd., 1996 WL 238538, * at 2 (N.D.N.Y. May 1, 1996).

[16]** **[*110]** C

Category 1 of the instant subpoenas is overbroad on its face. It requires production of "any and all documents relating to Erik Williams, Michael Irvin and Nina Shahravan." It is limited neither by reasonable restrictions on time nor by particular documentary descriptions. *See* Amcast Indus. Corp. v. Detrex Corp., 138 F.R.D. 115, 121 (N.D. Ind. 1991) (holding that document request that was unlimited as to time frame, as well as to the types of writings sought, fell far short of fulfilling requirement of Rule 34(b) that each item or category of documents be described with reasonable particularity). [6] As Babcock and Carter point out, the category as phrased would require that they produce newspaper articles that mention Williams' and Irvin's performances in a football game. In this sense it is akin to an impermissible attempt to "obtain every document which could conceivably be relevant to the issues in this case." Borden, Inc. v. Florida E. Coast Ry. Co., 772 F.2d 750, 756 (11th Cir. 1985).

[17]** Modification of a subpoena is preferable, however, to quashing it. Tiberi v. Cigna Ins. Co., 40 F.3d 110, 112 (5th Cir. 1994); *accord* Linder v. National Sec. Agency, 320 U.S. App. D.C. 359, 94 F.3d 693, 698 (D.C. Cir. 1996) ("modification of a subpoena is generally preferred to outright quashing"). Williams contends that he only intends to request in category 1 that Babcock and Carter produce "documents relating to the allegations made by Shahravan which gave rise to this suit as well as to Williams' suit against KXAS and Griffin." [7]

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[5] *Concord Boat* derives this standard from a case decided prior to the 1991 amendments that included Rule 45(c)(3)(A)(iv). In view of Linder, 133 F.3d at 24, a 1998 decision that recognizes similar factors, and the *Concord Boat* court's decision in 1996 to apply its earlier test to Rule 45(c)(3)(A)(iv), the court concludes that these factors are applicable to a motion to quash made pursuant to this Rule.

[6] The court does not suggest that subpoenas must always specify time or other limitations to avoid the undue burden restriction of Rule 45(c)(3)(A)(iv). For example, if a witness had limited involvement in the matters pertinent to the issues in the suit, merely identifying him by name and subpoenaing all documents that referred to him could be reasonable. The question of undue burden is fact specific. *Cf* Mack v. Great Atl. & Pac. Tea Co., 871 F.2d 179, 187 (1st Cir. 1989) ("For the most part, there are no barbed-wire fences marking the precise boundaries of pretrial discovery. Management of discovery is a largely empirical exercise, requiring judges to balance the inquirer's right to know against the responder's right to be free from unwarranted intrusions, and then to factor in systemic concerns. Limits can best be set case by case.").

[7] Williams points out that Babcock and Carter never sought clarification or discussion of the breadth of the request prior to moving to quash the subpoenas. Opp. Br. at 6-7. Babcock and Carter respond that it would be "absurd" to require that they confer with Williams' counsel to decipher the intended scope of the subpoena. Rep. Br. at 4. The court disagrees. Nearly ten years ago, in Dondi Properties Corp. v. Commerce Sav. & Loan Ass'n, 121 F.R.D. 284 (N.D. Tex. 1988) (en banc), this court adopted standards of litigation conduct to be observed in civil actions. Lawyers who are admitted to practice in this court, and those admitted *pro hac vice, see* N.D. Tex. Civ. R. 83.9(b), are obligated to read and comply with *Dondi*. It would have been consonant with the *Dondi* standards for Williams' counsel and Babcock and Carter's counsel to have conferred in an attempt to

[18]** The category, as modified, is considerably narrower and more focused in its temporal and substantive scope. Williams requests documents that relate to Shahravan's allegations that gave rise to Williams' present action and his related suit against Griffin and Lin. The allegations are explosive but circumscribed: Williams and an unnamed male raped her in Williams' home while Irvin threatened her with a gun and videotaped the assault. Her claims are narrow in time because they concern events that occurred on or about December 29, 1996, the date Shahravan asserted that Williams and the unnamed male assaulted her in Irvin's presence. They began no earlier than that date (when Shahravan contacted Williams to arrange their meeting) and ended no later than January 10, 1997 (when the DPD announced that Williams and Irvin had been cleared and that Shahravan had recanted her story).

Category 1, as modified, also seeks relevant materials. When a subpoena is issued as a discovery device, relevance for purposes of the undue burden test is measured according to the standard of *Rule 26(b)(1)*. *See* Linder, 133 F.3d at 24 (citing *Rule 26(b)(1)* discovery standard in determining whether subpoena **[**19]** for relevant information imposed undue burden within meaning of Rule ***[*111]*** 45(c)(3)(A)(iv)); Concord Boat, 169 F.R.D. at 48 (addressing Rule 45(c) protections in context of *Rule 26(b)(1)* scope of discovery, and stating that Rule 45(c) provides a level of protection that corresponds to *Rule 26(c)*). *Rule 26(b)(1)*, of course, permits discovery of

> any matter, not privileged, which is relevant to the subject matter involved in the pending action, whether it relates to the claim or defense of the party seeking discovery or to the claim or defense of any other party, including the existence, description, nature, custody, condition, and location of any books, documents, or other tangible things and the identity and location of persons having knowledge of any discoverable matter. The information sought need not be admissible at the trial if the information sought appears reasonably calculated to lead to the discovery of admissible evidence.

Williams alleges that the defendants are liable for violating his Fourth and Fourteenth Amendment rights, and on the basis of Texas law claims for defamation, intentional infliction of emotional distress, negligence, conversion, and trespass. There **[**20]** are several components of his case against the present defendants that appear to have a logical nexus to unprotected information that Babcock and Carter may possess: these include Griffin's complicity in Shahravan's false claims to the DPD; defendants' publication of false or private information to media sources, in violation of Williams' rights; Griffin's and Lin's possession of evidence seized from his home, particularly the videotape that depicts Williams and Shahravan engaged in consensual sexual activity, which Williams contends defendants improperly released; and evidence that corroborates Williams' assertions that the individual defendants conducted the investigation in a manner that was objectively unreasonable. Babcock and Carter may at least have custody of evidence that would lead to the discovery of admissible evidence.

D

Babcock and Carter argue that Williams can obtain these materials from other sources, including the parties in this case. This assertion was at least partially correct when made in response to Williams' initially overbroad formulation of category 1. The category was so expansively framed that a host of sources were available. As modified, however, the **[**21]** category is not objectionable on this basis.

First, from Williams' standpoint, it is substantively critical to confirm that Griffin and Lin possessed materials that he contends the defendants in the present case should not have revealed at all or should not have disclosed when they did. The fact that defendants also have the evidence is irrelevant. What is probative is that Babcock and Carter have custody of materials that they obtained because defendants disclosed them--materials that Williams contends should have remained private or that were illegally obtained in the first instance.

Second, the individual defendants have asserted the affirmative defense of qualified immunity. A stay of discovery is currently in place, and any discovery that is permitted of the individual defendants will be limited in scope unless and until Williams defeats the defense. *See, e.g.,* Wicks v. Mississippi State Employment Servs., 41 F.3d 991, 994

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narrow the intended scope of the subpoena. *Cf.* In re Exxon Valdez, 142 F.R.D. 380, 381 (D.D.C. 1992) (noting that opposing counsel attempted to negotiate scope and costs of production). In no event is such a proposition "absurd."

(5th Cir. 1995) (holding that "when the district court 'is unable to rule on the immunity defense without further clarification of the facts' and when the discovery order is 'narrowly tailored to uncover only those facts needed to rule on the immunity **[**22]** claim,' an order allowing such limited discovery is neither avoidable nor overly broad" (footnote omitted)) (quoting Lion Boulos v. Wilson, 834 F.2d 504, 507-08 (5th Cir. 1987)). Under these circumstances, Williams' need to obtain evidence from a nonparty is heightened by the unavailability of discovery from a party. *Cf.* Concord Boat, 169 F.R.D. at 49 (stating that "need of the party for the documents" is fact that court can consider in determining undue burden).

Third, several of Williams' allegations are based on his contention that the defendants knew or should have known that Shahravan was lying, and that they should have questioned the reliability of Shahravan's and Griffin's representations. There may be unprotected documents in the care of Babcock and **[*112]** Carter that the defendants do not possess, but that substantiate his claims.

E

Babcock and Carter advance the related arguments that as nonparties, and as counsel for parties whom Williams sued in the related state court case, they are entitled to greater protection against undue burden and harassment.

The court may quickly dispense with the adverse counsel harassment argument. The opposing counsel cases that Babcock **[**23]** and Carter cite in their reply brief each involve an attempt to depose counsel for an opposing party to the case in which the discovery was requested. Rep. Br. at 2. [8] Moreover, although Babcock and Carter were opposing counsel in Williams' suit against Griffin and Lin, they have not established that Williams' attempt to obtain documents from them is driven by a harassing animus. Williams did not, for example, lose the case against Griffin and Lin and then vindictively subpoena opposing counsel. The parties settled. And as the court has already explained, Williams has demonstrated that he seeks relevant evidence that, viewed through the substantive prism of his claims in the present case, he reasonably is pursuing from counsel for Griffin and Lin.

[24]** Babcock and Carter correctly point out that the fact that they are nonparties is an important factor that the court may consider in deciding whether to quash the subpoenas. Katz v. Batavia Marine & Sporting Supplies, Inc., 984 F.2d 422, 424 (Fed. Cir. 1993) (collecting cases); United States v. Columbia Broadcasting Sys., Inc., 666 F.2d 364, 371-72 (9th Cir. 1982). Nevertheless, for the reasons already explained in this opinion, the court holds that Babcock's and Carter's status as nonparties, either by itself or in combination with other factors, does not support a finding of undue burden.

F

The court turns next to the contention that the subpoenas are unduly burdensome because they will require that Babcock and Carter review potentially thousands of documents and incur approximately $ 9,000 in attorney's fees in doing so. This argument does not justify quashing the subpoenas because the court is authorized to award Babcock and Carter any relief that is necessary to obviate their incurring significant expenses.

The court must address initially its authority to award such relief. Rule 45 was amended in 1991. The amended Rule contains certain monetary protections for subpoenaed **[**25]** parties. *See* Rule 45(c)(1) (providing for imposition of appropriate sanction if subpoenaing party or attorney breaches duty to take reasonable steps to avoid

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[8] *See* Shelton v. American Motors Corp., 805 F.2d 1323, 1325, 1326-27 (8th Cir. 1986) (addressing deposition of in-house litigation department supervising attorney assigned to case, and criticizing "increasing practice of taking opposing counsel's deposition" in context of opposing trial counsel in case in which deposition was noticed); Harriston v. Chicago Tribune Co., 134 F.R.D. 232, 233 (N.D. Ill. 1990); Advance Sys., Inc. of Green Bay v. APV Baker PMC, Inc., 124 F.R.D. 200, 200-01 (E.D. Wis. 1989). Babcock and Carter also cite this court's December 11, 1997 order, in which it denied defendants' request to take the deposition of Williams' counsel. *See Williams v. City of Dallas*, Civil Action No. 3:97-CV-0296-D, Order at 1-2 (N.D. Tex. Dec. 11, 1997) (Fitzwater, J.). This order is also distinguishable, however, because it relates to an attempt to depose opposing counsel in the case in which the deposition was sought.

imposing undue burden or expense on subpoenaed person); Rule 45(c)(2)(B) (directing that court order compelling production shall protect nonparty or person who is not an officer of a party from significant expense resulting from inspection and copying commanded); and Rule 45(c)(3)(B)(iii) (providing that if nonparty or person who is not an officer of a party must incur substantial expense to travel more than 100 miles to attend trial, court may order compliance with subpoena when *inter alia* subpoenaed person will be reasonably compensated). None of these remedies is available in the present case.

One commentator has suggested that Rule 45(c)(1) is so narrow in scope that "only a step taken under a given provision that is so far beside the mark as to be patently *unreasonable* should invoke a sanction." David D. Siegel, *Practice Commentary C45-20*, 28 **[*113]** U.S.C.A., Fed. R. Civ. P. 45, at 385 (emphasis in original). Williams' conduct is not sanctionable under this standard. The relief provided by Rule 45(c)(2)(B) applies **[**26]** when a motion to compel is filed in response to an objection to a subpoena. *See* In re Exxon Valdez, 142 F.R.D. 380, 381 (D.D.C. 1992) (interpreting Rule in the context of motion to compel); *cf.* Standard Chlorine of Del., Inc. v. Sinibaldi, 821 F. Supp. 232, 262-63 & 263 n.31 (D. Del. 1992) (recognizing that Rule 45(c)(2)(B) would apply if subpoenaed party had filed motion to compel, but applying Rule to subpoenaed party's motion for protective order). Williams has not filed a motion to compel. Rule 45(c)(3)(B)(iii) is limited on its face to trial (not discovery) subpoenas. *But see* In re Letters Rogatory, 144 F.R.D. 272, 278-79 (E.D. Pa. 1992) (citing Rule 45(c)(3)(B)(iii) as support for award of reasonable costs of production for nonparty who moved to quash or modify subpoena, issued pursuant to Letters Rogatory, for production of documents and material). Williams' subpoenas *duces tecum* are not trial subpoenas.

Nevertheless, prior to the 1991 amendment to Rule 45, courts recognized their discretion to condition enforcement of subpoenas on nonparties on the serving party's paying the costs of production. Standard Chlorine, 821 F. Supp. at 263 (citing Exxon Valdez, ***[**27]*** 142 F.R.D. at 383). Because the relevant changes adopted in 1991 converted the court's pre-amendment discretionary authority to a mandatory obligation, *see* Exxon Valdez, 142 F.R.D. at 383, the court holds that the absence of a mandate to protect subpoenaed parties does not deprive it of the discretion to do so. *Cf.* Standard Chlorine, 821 F. Supp. at 262-65 (addressing pre- and post-1991 amendment jurisprudence, implicitly declining to treat them as mutually exclusive, and awarding conditional relief to subpoenaed party on both bases).

Courts that have imposed discretionary relief prior to the amendment to Rule 45 generally have considered such non-exclusive factors as the scope of the discovery, the depth of the invasion involved in the request, the extent to which the producing party must separate responsive information from privileged or even irrelevant material, and the reasonableness of the expenses involved in making the production. Id. at 263 (citing cases); *see* Exxon Valdez, 142 F.R.D. at 383 (addressing factors). Having considered these factors, the court holds that Babcock and Carter should be awarded their reasonable costs and expenses of complying with **[**28]** the subpoenas.

The anticipated expenses are not of sufficient magnitude to justify prepayment, but they are still potentially substantial. *Cf.* Standard Chlorine, 821 F. Supp. at 265 (tentatively awarding $ 1,750.00 in anticipated document production expenses). Babcock has adduced affidavit evidence that responding to the subpoenas, with the use of paralegals and younger attorneys where appropriate, will potentially involve reviewing 30 boxes of documents and other items that relate to Williams' suit against Griffin and Lin. These boxes contain approximately 210 individual files, 52 audio and video tapes and accompanying transcripts, 23 trial and research notebooks, several hundred newspaper articles and investigative documents, and approximately 1,000 documents produced in response to nine depositions. Babcock Aff. at PP 4-5. These expenses presumably must be absorbed by Lin, which likely did not consider the potential for such expenses when it calculated the amount for which it was willing to settle Williams' suit against it. In view of the privilege issues that are likely to arise because the parties were involved in prior litigation, Babcock and Carter will perforce be required **[**29]** to give careful scrutiny to the materials in their custody. And since Williams seeks to obtain materials directly from counsel for Griffin and Lin rather than from the parties themselves, there will likely be a considerable amount of attorney work product that falls within the literal scope of the modified subpoenas.

The court declines to direct that Williams advance to Babcock and Carter their expected costs. The sum of $ 9,000 in attorney's fees that Babcock and Carter estimate they will incur is based on projected work in responding to the unmodified version of category 1, and will perhaps be significantly lower. The court is unable to calculate this **[*114]** uncertain cost with sufficient precision to make an advance award. *See* Fed. R. Civ. P. 45(c)(2)(B) advisory committee's note ("The court is not required to fix the costs in advance of production, although this will often be the most satisfactory accommodation to protect the party seeking discovery from excessive costs. In some instances, it may be preferable to leave uncertain costs to be determined after the materials have been produced, provided that the risk of uncertainty is fully disclosed to the discovering party.").

After **[**30]** Babcock and Carter comply with the subpoenas, they may move for appropriate relief in the event the parties cannot resolve the issue amicably.

G

The court now turns to Babcock and Carter's contention that the subpoenas should be quashed because they do not define the term "document," and could therefore be interpreted to include any type of information that relates to Williams, Irvin, and Shahravan, regardless whether pertinent to the present suit. This assertion appears to mix two concepts: the meaning of the term "document," and the scope of the documents that are responsive to the subpoenas, as phrased. [9]

Although the term "document" is undefined in the subpoenas, **[**31]** it certainly has meaning when used in Rule 45 (which concerns subpoenas) and Rule 34 (which governs production of documents), both of which are germane here. Rule 45(c)(2)(A) [10] **[**32]** does not define the term "document," although it does suggest that documents are not necessarily the same as books, papers, or intangible things (otherwise, why use four terms disjunctively?). Rule 34(a) [11] likewise does not define the term, but it contemplates that documents include writings, drawings, graphs, charts, photographs, phonorecords, and other data compilations. Rules 45 and 34 can be read together to convey a comprehensible understanding of the types of materials that must be produced when a subpoena refers to the term "documents" without defining it. The subpoenas in the present case are not defective for failing to supply a definition. [12]

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[9] The argument also appears to be somewhat disingenuous. When Babcock filed his affidavit quantifying the undue burden that would be imposed in responding to the subpoenas, he several times used the term "documents" in a manner that reflects a clear understanding of the term in everyday use in the legal profession. *See, e.g.*, Babcock Aff. at P 4.

[10] Rule 45(c)(2)(A):

A person commanded to produce and permit inspection and copying of designated books, papers, documents or tangible things, or inspection of premises need not appear in person at the place of production or inspection unless commanded to appear for deposition, hearing or trial.

[11] Rule 34(a):

Any party may serve on any other party a request (1) to produce and permit the party making the request, or someone acting on the requestor's behalf, to inspect and copy, any designated documents (including writings, drawings, graphs, charts, photographs, phonorecords, and other data compilations from which information can be obtained, translated, if necessary, by the respondent through detection devices into reasonably usable form), or to inspect and copy, test, or sample any tangible things which constitute or contain matters within the scope of *Rule 26(b)* and which are in the possession, custody or control of the party upon whom the request is served; or (2) to permit entry upon designated land or other property in the possession or control of the party upon whom the request is served for the purpose of inspection and measuring, surveying, photographing, testing, or sampling the property or any designated object or operation thereon, within the scope of *Rule 26(b)*.

[12] In fact, in those courts where ***Rule 26(a)(1)(B)*** applies, it requires that parties produce all "documents" in the possession, custody, or control of the party that are relevant to disputed facts alleged with particularity in the pleadings. Were the term "documents" difficult to comprehend without a definition, the Rule would have little value as a self-executing directive.

[33]** Babcock and Carter's assertion that the scope of the request is overbroad has now been addressed by the court's decision that the modified subpoena does not subject them to an undue burden.

III

The next question presented is whether the subpoenas and deposition notices should **[*115]** be quashed pursuant to *Rule 45(c)(3)(A)(iii)* because they require production of documents that are protected by the attorney-client privilege, by the work product doctrine under *Rule 26(b)(3)*, and by the Texas journalist's privilege. Although Williams advances several responsive arguments, some of which address the merits of these assertions, the court need only reach his contention that Babcock and Carter have failed to comply with *Rule 45(d)(2)*, which provides:

> When information subject to a subpoena is withheld on a claim that it is privileged or subject to protection as trial preparation materials, the claim shall be made expressly and shall be supported by a description of the nature of the documents, communications, or things not produced that is sufficient to enable the demanding party to contest the claim.

This provision is necessary "to provide a party whose discovery is constrained **[**34]** by a claim of privilege or work product protection with information sufficient to evaluate such a claim and to resist if it seems unjustified." *Fed. R. Civ. P. 45(d)(2)* advisory committee's note. To reject Babcock and Carter's argument that the subpoenas should be quashed because they seek production of protected matters, it is sufficient to point to their obligation under *Rule 45(d)(2)* to lodge objections on the basis of the attorney-client privilege, the work product doctrine, and the journalist's privilege that are "supported by a description of the nature of the documents, communications, or things not produced that is sufficient to enable the demanding party to contest the claim." [13] When those objections have been made, the court can then decide whether quashal is warranted under *Rule 45(a)(3)(A)(iii)*.

[35]** Williams maintains that Babcock's and Carter's failure to comply with *Rule 45(d)(2)* results in waiver of these protections. The court disagrees in the context of the present case. Williams served subpoenas that were facially overbroad. Babcock and Carter had no obligation to undertake the task of lodging objections to a potentially vast array of protected materials that technically fell within the scope of the subpoenas. *See* *Concord Boat, 169 F.R.D. at 48, 51-52* (holding that fact that subpoena was facially overbroad and exceeded bounds of fair discovery presented unusual circumstance and good cause that excused failure to object); *Semtek, 1996 WL 238538*, at *2 (same). To adopt Williams' view would be to deprive a subpoenaed party of its right to quashal or modification by requiring that it comply with *Rule 45(d)(2)* notwithstanding the protection afforded by *Rule 45(a)(3)(A)*.

Until the *Rule 45(d)(2)* procedure is followed, the court declines to reach the merits of Williams' reliance on the crime-fraud exception and the proper scope of the attorney-client privilege, the work product doctrine, and the journalist's privilege, because the court is uncertain what protection will **[**36]** be claimed and with respect to what documents. The court will not engage in hypothetical decisionmaking about documents that may need to be reviewed *in camera*. *Cf.* *RTC v. Bright, 157 F.R.D. 397, 401 (N.D. Tex. 1994)* (Fitzwater, J.) (conducting *in camera* inspection before determining whether documents were privileged).

IV

Babcock and Carter contend their depositions should be quashed because any facts that they obtained were derived as part of their representation of Lin, and all information that they possess is privileged or attorney work product. The court disagrees.

In order to deprive Williams of his "venerable 'right to every man's evidence,'" *Smith v. Smith, 154 F.R.D. 661, 670 (N.D. Tex. 1994)* (Fitzwater, J.), Babcock and Carter must do more than advance a blanket assertion of attorney-

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[13] Babcock and Carter did include in their contemporaneous objections to the subpoenas *duces tecum* the assertion that category 1 required the production of materials that are protected by the attorney-client or journalist's privilege, or are attorney work product. They did not include in their objections the supporting descriptions required by *Rule 45(d)(2)*.

client privilege and attorney work product. *See* *Varo, Inc. v. Litton Sys., Inc., 129 F.R.D. 139, 142 (N.D. Tex. 1989)* (Fitzwater, J.); *Hugley v. Art Institute of Chicago, 981 F. Supp. 1123, 1128 (N.D. Ill. 1997)* ("Further, a party cannot simply make a blanket **[*116]** claim of privilege; rather, the party must claim and establish the attorney-client privilege on a document-by-document **[**37]** basis."). Largely for the reasons that the court has already discussed, they are not entitled to have their depositions quashed *in toto*. The court holds that they can be required to give their depositions, and it denies their motions to quash to the extent that seek to preclude the depositions outright.

* * *

Except to the extent that the court concludes that the subpoenas should be complied with as modified, the court grants the motions to quash. The stay imposed by the court in its November 25, 1997 order is hereby vacated.

SO ORDERED.

March 5, 1998.

SIDNEY A. FITZWATER

UNITED STATES DISTRICT JUDGE

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