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UNITED STATES DISTRICT COURT
Northern District of California

NUANCE COMMUNICATIONS, INC.,

Plaintiff,

v.

ABBYY SOFTWARE HOUSE *et al.*,

Defendants.

No. C 08-02912 JSW (MEJ)

**ORDER ON PARTIES' JOINT
DISCOVERY DISPUTE LETTERS
(RE: DKT. NOS. 449, 450, AND 451)**

On June 15, 2012 — two weeks after fact discovery closed in this patent action — Plaintiff Nuance Communications and Defendants ABBYY and Lexmark International filed three joint letters addressing separate discovery disputes. Dkt. Nos. 449, 450, and 451. The Court addresses these letters in turn below.

A. Nuance's Request for Leave to File a Motion for Discovery Sanctions

In the first letter, Nuance seeks permission from the Court to file a Federal Rule of Civil Procedure ("FRCP") 37 motion for sanctions to remedy the alleged harm it suffered from ABBYY's discovery misconduct. Dkt. No. 449. Nuance outlines several transgressions on the part of ABBYY, including ABBYY's production of over 10,000 pages of documents after the close of discovery and refusal to delay scheduled depositions or offer subsequent depositions to ameliorate this late production. ABBYY refutes Nuance's accusations and points out that Nuance would have the opportunity to question witnesses about the recently produced documents at depositions scheduled for the end of June 2012.

While ABBYY's response has alleviated the Court's concerns with respect to some of Nuance's allegations of discovery misconduct, several issues still remain. For instance, ABBYY never explains why it produced e-mails from its CEO after the close of discovery — e-mails that

1 Nuance claims were highly relevant and responsive to earlier document requests. This unanswered
2 question, as well as some others, have persuaded this Court to GRANT Nuance leave to file a
3 motion for sanctions **if it still believes one is warranted.**

4 The Court notes that one of the sanctions Nuance seeks is an 8-week extension to the
5 discovery cut-off so that it could explore the issues raised by ABBYY's late production of
6 documents. The undersigned, however, does not have the authority to make any changes to the
7 presiding judge's trial schedule. *UMG Recordings, Inc. v. Disco Azteca Distribs., Inc.*, 2006 WL
8 2034689, at *3 (E.D. Cal. July 18, 2006) ("Of course, the magistrate judge is not empowered to
9 modify the district judge's scheduling order."). Accordingly, if Nuance wishes to reopen discovery,
10 it must file such a request before the presiding judge.

11 B. Nuance's Request to Strike Defendants' Supplemental Disclosures

12 The parties' second letter concerns ABBYY and Lexmark's supplemental FRCP 26(a)
13 disclosures, which were served on Nuance after the close of business on the last day of fact
14 discovery. Dkt. No. 450. In these supplemental disclosures, Defendants identify 25 potential
15 witnesses for trial that were not included in their initial disclosures served in September 2008.
16 Nuance asks the Court to strike these witnesses because their untimely disclosure was neither
17 justified nor harmless. Defendants contend that they were not required to update their disclosures
18 since Nuance had learned about most of the witnesses through previous discovery and
19 correspondence.

20 Nuance's position in the joint letter is misplaced. It argues that a party can never rely on
21 witnesses who were only disclosed during the discovery process and not officially identified through
22 supplemental disclosures.¹ But that is not the law. Under FRCP 26(a), a party's initial disclosures
23 must identify witnesses who are "likely to have discoverable information . . . that the disclosing
24 party may use to support its claims or defenses." There is also an affirmative obligation to

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26 ¹ See, e.g., Dkt. No. 450 at 3 ("Therefore, according to Defendants, Nuance already had
27 notice that these individuals had some relevant knowledge. But, of course, listing these 25 new
28 witnesses in Rule 26(a) disclosures is much different than these names being scattered through
various declarations, subpoenas, emails and interrogatory responses.").

1 supplement these initial disclosures “in a timely manner” if they become incomplete or incorrect.
2 Fed. R. Civ. Pro. 26(e)(1)(A). Supplementation, however, is not mandatory “if the additional or
3 corrective information has [] been made known to the other parties during the discovery process or
4 in writing” *Id.*; *see also Vieste, LLC v. Hill Redwood Dev.*, 2011 WL 2181200, at *3 (N.D. Cal.
5 June 3, 2011) (“The information regarding [the witnesses] thus ‘was made known to [Plaintiffs]
6 during the discovery process,’ per Rule 26(e)(1), which discharged Defendants’ duty to supplement
7 their disclosures with respect to these two individuals.”); *Coleman v. Keebler Co.*, 997 F.Supp.
8 1102, 1107 (N.D. Ind. 1998) (“In fact, both the Advisory Committee and leading commentators
9 indicate that the incidental discovery, particularly during a deposition, of information ordinarily
10 subject to supplementation satisfies the Rule 26(e)(1) duty as sufficiently as a formal filing”)²

11 Accordingly, Defendants are correct that they did not have to supplement their disclosures
12 with respect to witnesses that had been identified earlier through the discovery process.³ The
13 question that remains is whether Defendants adequately disclosed the witnesses at issue before the
14 discovery cut-off. As other courts have recognized, merely mentioning the individual’s name at a
15 deposition or in a discovery response may not be enough to put the other party on notice that the
16 individual is being disclosed as a trial witness. *See Vieste*, 2011 WL 2181200, at *2 (striking
17 witnesses from supplemental disclosures because even though the deponent testified that the
18 witnesses were employees, she did not know if they had any information related to the case and a
19 subsequent interrogatory response further obscured the role played by the employees); *Ollier v.*
20 *Sweetwater Union High Sch. Dist.*, 267 F.R.D. 339, 343 (S.D. Cal. 2010) (“Certainly the mere
21

22 ² A party that fails to disclose witnesses pursuant to FRCP 26 may be prohibited from using
23 that witness to supply evidence during any proceeding, unless that “failure was substantially
24 justified or is harmless.” Fed. R. Civ. Pro. 37(c)(1). The burden is on the party facing sanctions to
25 establish that its conduct was substantially justified or harmless. *Yeti by Molly, Ltd. v. Deckers*
Outdoor Corp., 259 F.3d 1101, 1107 (9th Cir. 2001).

26 ³ Even though FRCP 26 allows parties to identify trial witnesses through the discovery
27 process, the Court notes that this is not good practice and parties should strive to always officially
28 supplement earlier disclosures as soon as it becomes warranted. *See Schwarzer, Tashima &*
Wagstaffe, Cal. Prac. Guide: Fed. Civ. Pro. Before Trial, ¶ 11:1249 (The Rutter Group 2011).

1 mention of a name in a deposition is insufficient to give notice to the opposing party that defendants
2 intend to present that person at trial.”). The Court, however, cannot analyze this issue because
3 Nuance based its request to strike the witnesses on the incorrect argument that FRCP 26 does not
4 permit disclosure through the discovery process or other writing — and not on whether Defendants
5 had adequately disclosed the witnesses at an earlier time. Thus, the Court does not address in this
6 order whether Defendants’ previous identification of the witnesses was sufficient. Nuance’s request
7 to strike the witnesses at issue based on the grounds that the supplemental disclosures were untimely
8 is DENIED. Nuance remains free to file another joint letter if it believes any of Defendants’
9 witnesses were not adequately disclosed during the discovery process or by other writing pursuant to
10 FRCP 26(e)(1)(A).⁴

11 C. Lexmark’s Request to Compel Nuance to Respond to Interrogatories

12 In the final letter, Lexmark moves to compel Nuance to respond to Lexmark interrogatories
13 numbers 18, 19, 20, and 21. Dkt. No. 451. Nuance argues that it cannot be compelled to respond to
14 these interrogatories because they — when properly counted, including the required subparts —
15 exceed the 25-interrogatory limit under FRCP 33(a)(1). Even though Nuance does not raise this
16 argument in the joint letter, the Court denies Lexmark’s request for another reason: it is untimely.
17 Under Civil Local Rule 37-3, the deadline to file a motion to compel discovery is seven days after
18 the discovery cut-off. Here, the presiding judge set the discovery cut-off for June 1, 2012. Dkt.
19 Nos. 336 and 339. Accordingly, any request to compel discovery responses should have been filed
20 by June 8, 2012. Lexmark offers no explanation for why it did not comply with this deadline. Its
21 request to compel answers to its interrogatories is therefore DENIED. *See Kennedy v. Jackson Nat’l*
22 *Life Ins. Co.*, CV07-0371 CW (MEJ), Dkt. No. 277 (N.D. Cal. Sept. 21, 2010) (finding that the

23
24 ⁴ Lexmark concedes that two of its newly identified witnesses (Todd Hamblin and Keith
25 Jones) were never revealed to Nuance during discovery. But, as Lexmark explains, these individuals
26 are recent replacements for a witness (William Lucas) who was identified earlier in an interrogatory
27 response but has now left the company. Considering these circumstances, Lexmark was
28 substantially justified with respect to the late disclosure of these two new witnesses. Because
Nuance has not moved to strike Hamblin and Jones on the grounds that Lucas was not adequately
disclosed in the interrogatory response, the Court does not consider this issue.

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plaintiff's request to compel production of certain documents was untimely pursuant to Civil Local Rule 37-3 because it was not filed within seven days of the discovery cut-off).

IT IS SO ORDERED.

Dated: July 10, 2012



Maria-Elena James
Chief United States Magistrate Judge