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4 IN THE UNITED STATES DISTRICT COURT
5 FOR THE NORTHERN DISTRICT OF CALIFORNIA
6

7 FINISAR CORP.,

No. C 08-03388 MMC

8 Plaintiff,

ORDER RE DISCOVERY DISPUTE

9 vs.

10 JDS UNIPHASE CORP.,

11 Defendant.
12 _____/

13 **I. INTRODUCTION**

14 This case involves, in large part, whether a document created by the parties on August 21,
15 2007 entitled "Outline of Picolight/JDSU/Finisar Agreement" (the "August 2007 Document") is a
16 binding contract that modifies the parties' rights and obligations under a prior written contract. On
17 March 4, 2009, Defendant JDS Uniphase Corp. ("JDSU") and Plaintiff Finisar Corp. filed a Joint
18 Letter regarding a discovery dispute concerning Finisar's objections to two interrogatories that JDSU
19 propounded. (Dkt. #93.) Having considered the parties' arguments in the Joint Letter, the Court
20 now rules as follows.

21 **II. DISCUSSION**

22 **A. The Discovery Request**

23 The two interrogatories currently in dispute read:

24 Interrogatory No. 24:

25 Identify separately by patent number each and every one of your
26 patents, and for each state whether or not you contend it is within the
27 scope of the August 2007 Agreement alleged by you in your amended
28 complaint.

Interrogatory No. 25:

Identify by patent number every JDSU patent that you contend is

1 within the scope of the August 2007 Agreement alleged by you in your
2 amended complaint.

3 (*Id.* at 1.) In its Responses, Finisar objected to both interrogatories as ambiguous, overbroad,
4 irrelevant, and burdensome. (*Id.*, Ex. A at 2-3.) JDSU now seeks an order compelling Finisar to
5 respond to interrogatories numbers 24 and 25 "by identifying which specific patents it contends are
6 within the scope of the contract that Finisar has alleged in its pleadings as the 'August 2007
7 Agreement.'" (*Id.* at 2.)

8 **B. JDSU's Position**

9 In support of its request, JDSU explains that its position in this case is that the August 2007
10 Document cannot be a binding contract because there are many terms that were left to be negotiated
11 by the parties. (*Id.*) Particularly, JDSU contends that the August 2007 Document is incomplete
12 because the parties never agreed on which of their hundreds of patents would be subject to any
13 agreement, and cites to the "scope" provision in the Document as illustrative of that ambiguity. This
14 provision reads: "All patents related to transceivers, transponders, modules, components and chips
15 for use in optical data transmission applications." (*Id.*) Thus, JDSU contends that Finisar's refusal
16 to respond to interrogatories 24 and 25 is unjustified because: (1) they seek Finisar's contentions as
17 to the specific terms of the contract that Finisar claims was formed and seeks to enforce in this
18 lawsuit; and (2) the information is discoverable pursuant to Federal Rule of Civil Procedure
19 26(b)(1). (*Id.* at 3.)

20 **C. Finisar's Position**

21 Finisar opposes the discovery request on four bases. First, Finisar contends that the requests
22 are unduly burdensome because, to compile the list in response to the interrogatories, it would have
23 to review every claim in each of its approximately 900 patents, as well as each of the claims in
24 JDSU's hundreds of patents. (*Id.*) Next, Finisar contends that the requests call for a legal
25 conclusion, in that, to respond to the requests, it would have to first construe the language in each
26 claim and then determine whether each claim embraces the device, method, or subject matter in
27 question. (*Id.* at 2-3.) Third, Finisar argues that the discovery JDSU seeks is unnecessary to JDSU's
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1 defense. Specifically, it asserts that, if JDSU wants to argue that the "scope" provision is
2 ambiguous, nothing prevents JDSU from offering testimony from a licensing expert or from
3 reviewing the parties' patent portfolios itself to make its point. (*Id.* at 4.) Fourth, Finisar argues that
4 the discovery requests do not lead to relevant evidence.

5 **D. Ruling**

6 The Court has considered the parties' arguments and reviewed the materials submitted in
7 support. The Court finds that interrogatories 24 and 25 seek discovery relevant JDSU's defense that
8 the August 2007 Document is not an enforceable contract. With respect to Finisar's objections that
9 the requests are unduly burdensome and unnecessary, the Court agrees with Finisar that there are
10 other less burdensome ways for JDSU to seek the discovery that interrogatories 24 and 25 target.
11 (*Id.* at 4.) Accordingly, the Court will order Finisar to file a verified declaration under oath stating -
12 consistent with its representations at page 3 in the Joint Letter - (1) that the scope provision in the
13 August 2007 Document does not list specific patents, and (2) explaining the steps it would have to
14 undertake to determine which patents are covered by the August 2007 Document.

15 **III. CONCLUSION**

16 Based on the foregoing analysis, the Court ORDERS as follows:

17 1. JDSU's request to compel further responses to interrogatories Numbers 24 and 25 is
18 **GRANTED** as follows: Finisar shall file a verified declaration under oath stating - consistent with
19 its representations at page 3 in the Joint Letter - that (1) the scope provision in the August 2007
20 Document does not list specific patents, and (2) explaining the steps it would have to undertake to
21 determine which patents are covered by the August 2007 Document.

22 2. Finisar shall have 20 days from the date of this Order to file its verified declaration.

23 **IT IS SO ORDERED.**

24
25 Dated: March 20, 2009



26 MARIA-ELENA JAMES
27 United States Magistrate Judge