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5 IN THE UNITED STATES DISTRICT COURT  
6 FOR THE NORTHERN DISTRICT OF CALIFORNIA  
7

8 PROCONGPS, INC.,

No. C 11-03975 SI

9 Plaintiff,

**ORDER RE: MOTIONS TO COMPEL  
PRODUCTION OF DOCUMENTS AND  
INTERROGATORY ANSWERS**

10 v.

11 STAR SENSOR, LLC, et al.,

12 Defendants.  
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15 Plaintiff ProconGPS, Inc. (“Procon”) filed two letter briefs requesting the Court to compel  
16 defendants Star Sensor, LLC, and Skypatrol, LLC, to produce certain documents as requested by  
17 plaintiff. Skypatrol has also filed a letter brief requesting the Court to compel Procon to produce certain  
18 documents and respond to certain interrogatories. Having considered the papers submitted by the  
19 parties, the Court GRANTS plaintiff’s and defendant’s requests.  
20

21 **1. Procon Motion re: Star Sensor’s Responsive Documents**

22 Procon seeks an order compelling Star Sensor to produce all of the documents that it agreed to  
23 produce in response to Procon’s first document production request. Procon asserts that Star Sensor has  
24 only produced documents in response to Request for Production (“RFP”) No. 1, although it has also  
25 agreed to produce documents in response to RFP Nos. 2, 4, 7-13, 15-44, and 46-50. Dkt 85, Exh. 2.

26 Star Sensor had objected that Procon’s definition of “GPS Products” was overly broad. *See id.*,  
27 RFP Nos. 3, 5, 6, 14, 45. However, the parties have since agreed on a narrower definition of “GPS  
28 Products.” Dkt 88 at 1. With this new definition taken into account, Star Sensor has agreed to the

1 production of documents in response to Procon’s RFP Nos. 1-50.

2 Star Sensor had also objected to producing certain documents dating earlier than July 7, 2011,  
3 because it contended that Procon was barred from seeking damages past that date. Procon argues that  
4 it is entitled to seek damages for the last six years under 35 U.S.C. § 286. Without conceding the merits  
5 of Procon’s argument, Star Sensor has stated that it intends to produce documents that are no longer  
6 limited to the time period of July 7, 2011.

7 Accordingly, Star Sensor is ORDERED to produce documents responsive to Procon’s Request  
8 for Production Nos. 1-50, incorporating the agreed narrower definition of “GPS Products,” and for the  
9 last six years prior to the filing of the suit.

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11 **2. Procon Motion re: Star Sensor’s Source Code Format**

12 Procon objects to the format in which it received Star Sensor’s source code. Star Sensor sent  
13 Procon a disc of the source code, but Procon has objected that the nearly 28,000 pages are not in a  
14 “useable” format because it is not a format that is “searchable, reflects the hierarchy of the code, [or]  
15 contains developer notes.” Dkt 85 at 1. Star Sensor does not dispute these characterizations, but instead  
16 has stated that the source code is “in a text-based programming language and is legible in printed form.”  
17 Dkt. 88 at 2.

18 Rule 34 requires a party to produce discovery in “a form or forms in which it is ordinarily  
19 maintained or in a reasonably usable form or forms.” Fed. R. Civ. P. 34(b)(2)(E)(ii). Some courts have  
20 found that a reasonably usable form should include a search function, if the original format had a search  
21 function. *See L.H. v. Schwarzenegger*, 2008 U.S. Dist. LEXIS 86829, \*12-13 (E.D. Cal. May 14, 2008);  
22 *In re Verisign*, 2004 WL 2445243 at \*1 (N.D. Cal. 2004). Here, it is unknown whether the format of  
23 the code as it was ordinarily maintained was searchable, hierarchical, or contained developer notes. To  
24 the extent that the source code was originally maintained in a format that contained these three  
25 characteristics, Star Sensor is ORDERED to produce the source code in that format.

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27 **3. Procon Motion re: Skypatrol’s Responsive Documents**

28 First, Procon seeks an order compelling Skypatrol to produce documents required by Patent

1 Local Rule 3-4(a). This local rule requires the party defending a claim of infringement to make  
2 available “[s]ource code, specifications, schematics, flow charts, artwork, formulas, or other  
3 documentation sufficient to show the operation of any aspects of elements of an Accused Instrumentality  
4 identified by the patent claimant in its Patent L.R. 3-1(c) chart.” Procon argues that Skypatrol has not  
5 produced these required documents, with the exception of certain prior art, manuals, and quickstart  
6 guides already publically available. Skypatrol asserts that it has already produced or will produce these  
7 technical documents to comply with Patent Local Rule 3-4(a). Accordingly, Shypatrol is ORDERED  
8 to do so.

9 Second, Procon requests that the Court compel Skypatrol to produce the documents it has  
10 already agreed to produce. In response to Procon’s first request for production, Skypatrol agreed to  
11 produce documents for RFP Nos. 2, 7-10, 13, 15-16, 18-20, 24-32, 38, 41, and 43. Dkt. 86, Exh. 2.  
12 Procon asserts that Skypatrol has not yet produced all of these documents. Skypatrol asserts that it will  
13 produce these documents. The Court ORDERS that it do so.

14 Third, Procon requests that the Court compel Skypatrol to produce certain documents for the six  
15 years from this suit’s filing date. Skypatrol has agreed to produce documents responsive to RFP Nos.  
16 4, 35, and 39-40, as long as they are after July 7, 2011. Skypatrol argues that it does not have to produce  
17 earlier documents because damages will not accrue before then under the doctrine of “intervening  
18 rights.” However, Procon argues that the doctrine does not apply, and it will seek damages for six years  
19 from the date of suit. Under Federal Rules of Civil Procedure 26(b)(1), each party has the right to  
20 discover “any nonprivileged matter that is relevant to any party’s claim or defense,” and for good cause,  
21 the court may permit discovery of information “relevant to the subject matter involved in the action.”  
22 Even though there are two competing theories of damages, the documents from the last six years are  
23 reasonably relevant to the issue of damages if Procon’s theory is correct. Thus, the Court ORDERS that  
24 Skypatrol produce documents responsive to RFP Nos. 4, 35, and 39-40 for the six years from the filing  
25 of this suit.

26  
27 **4. Skypatrol’s Motion re: Procon’s Responsive Documents**

28 Skypatrol asserts that, although Procon agreed to produce documents in response to Skypatrol’s

1 first set of document requests, it has failed to comply completely. Specifically, Skypatrol seeks an order  
2 that Procon produce documents responsive to Request Nos. 1-4, 6-12, 14-18, 21-22, 32-34, 36, 39, 42,  
3 51, 56-58, 63-64, 66-79, and 81-83. Dkt 87, Exhs. 3-4. Procon asserts that it has produced or will  
4 produce the documents that it has agreed to produce, if they exist. The Court ORDERS that it do so.

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6 **5. Skypatrol’s Motion re: Procon’s Interrogatory Answers**

7 Skypatrol also requests that Procon be compelled to provide complete responses to Skypatrol’s  
8 Interrogatory Nos. 1-2. See Dkt. 87, Exh. 5. Regarding Interrogatory No. 1, Procon has agreed to  
9 supplement its response to identify the licenses that it has already produced. The Court ORDERS that  
10 it do so.

11 Interrogatory No. 2 seeks a complete description of Procon’s damages calculations. Procon  
12 announced in a press release that it estimated damages at \$10 million. However, Procon asserts that this  
13 was only an “early estimate,” and it cannot respond to Skypatrol’s interrogatory until Skypatrol has  
14 produced all of its documents and an expert has rendered an opinion on those documents. Dkt. 89 at  
15 2. The Court ORDERS that Procon answer Skypatrol’s Interrogatory No. 2 explaining how it reached  
16 the \$10 million early estimate, and then answer Interrogatory No. 2 again with a more refined estimate  
17 once Skypatrol has produced all of its documents and an expert has analyzed them.

18 Accordingly, both plaintiff’s and defendant’s requests to compel documents and interrogatory  
19 answers are GRANTED [Docket Nos. 85, 86, 87, 88, 89].<sup>1</sup>

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21 **IT IS SO ORDERED.**

22 Dated: October 29, 2012

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25 SUSAN ILLSTON  
26 United States District Judge

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28 <sup>1</sup> Had counsel met and conferred in a meaningful way, neither side would have been required to brief these issues or to expend the attorneys’ fees attendant on them