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UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA

ICON-IP PTY LTD.,  
Plaintiff,  
v.  
SPECIALIZED BICYCLE COMPONENTS,  
INC.,  
Defendant.

Case No. [12-cv-03844-JST](#) (MEJ)

**DISCOVERY ORDER**

Re: Dkt. No. 116

**INTRODUCTION**

Pending before the Court is the parties' Joint Discovery Dispute Letter, filed October 09, 2014. Dkt. No. 116. By this Joint Letter, Defendant Specialized Bicycle Components, Inc. ("Specialized") seeks a protective order preventing Plaintiff Icon-IP Pty Ltd. ("Icon") from deposing Specialized's CEO and Chairman of the Board, Mike Sinyard. Jt. Ltr. at 1. After considering the parties' arguments and controlling authorities, the Court GRANTS the motion for a protective order for the reasons set forth below.

**BACKGROUND**

On July 23, 2012, Icon filed a Complaint against Specialized in which it accused 33 bicycle saddles of infringing U.S. Patent No. 6,378,938 and/or U.S. Patent No. 6,254,180. Dkt. No. 1. Icon has propounded 93 document requests, 25 interrogatories, and noticed 8 depositions. Jt. Ltr. at 1. Additionally, Icon seeks to depose Specialized's CEO and Chairman of the Board regarding four topics: (1) a declaration Mr. Sinyard made during the prosecution of an unrelated Specialized patent application; (2) alleged communications between Mr. Sinyard and third parties Selle Italia, Paul Nelson, and Selle San Marco; (3) negotiations of contracts and royalties with inventor Dr. Minkow; and (4) development of the accused saddle technology. *Id.* at 1-3.

1 Specialized now seeks a protective order preventing Icon from deposing Mr. Sinyard,  
2 arguing that he does not possess unique, non-repetitive knowledge material to the issues in the  
3 case, and, even if he did, Icon has not yet exhausted less intrusive means of discovery.

#### 4 DISCUSSION

5 “A party seeking to prevent a deposition carries a heavy burden to show why discovery  
6 should be denied.” *Websidestory, Inc. v. Netratings, Inc.*, 2007 WL 1120567, at \*2 (S.D. Cal.  
7 Apr. 6, 2007). Unless extraordinary circumstances exist, it is unusual for a court to deny a party  
8 the opportunity to take a deposition. *Affinity Labs of Tex. v. Apple, Inc.*, 2011 WL 1753982,  
9 at \*15 (N.D. Cal. May 9, 2011). However, courts have consistently observed that deposition  
10 notices directed to officials at the highest levels of corporate management (so-called “apex”  
11 depositions) create “‘a tremendous potential for abuse or harassment’ that may require the court’s  
12 intervention for the witness’s protection under Rule 26(c).” *K.C.R. v. Cnty. of Los Angeles*, 2014  
13 WL 3434257, at \*3 (C.D. Cal. July 11, 2014) (quoting *Apple, Inc. v. Samsung Elecs. Co., Ltd.*,  
14 282 F.R.D. 259, 263 (N.D. Cal. 2012)). For this reason, a party seeking to depose a high-ranking  
15 corporate official bears the burden of demonstrating that (1) “the deponent has unique first-hand,  
16 non-repetitive knowledge of facts at issue in the case,” and (2) “the party seeking the deposition  
17 has exhausted other less intrusive discovery methods.” *Groupion, LLC v. Groupon, Inc.*, 2012  
18 WL 359699, at \*2 (N.D. Cal. Feb. 2, 2012). “In sum, while a party opposing a deposition ‘carries  
19 a heavy burden to show why discovery should be denied,’ courts may ‘protect high level corporate  
20 officers from depositions when the officer has no first hand knowledge of the facts of the case or  
21 where the officer’s testimony would be repetitive.’” *K.C.R.*, 2014 WL 3434257, at \*4 (quoting  
22 *Google Inc. v. Am. Blind & Wallpaper Factory, Inc.*, 2006 WL 2578277, at \*3 n.3 (N.D. Cal. Sept.  
23 6, 2006)).

24 The Court need not determine at this time whether Mr. Sinyard possesses unique, non-  
25 repetitive, first-hand knowledge of the facts at issue in this case, because Icon has failed to meet  
26 the second prong of this conjunctive test. That is, Icon has not demonstrated that it has exhausted  
27 other means of obtaining this information, such as interrogatories and depositions of lower-level  
28 employees. According to Specialized, it offered Icon the opportunity to propound up to 12

1 additional interrogatories addressing the four identified subject areas, and has stated that it will  
2 provide detailed responses in a shortened time, all without prejudicing Icon’s ability to later seek  
3 to depose Mr. Sinyard should the responses not yield the information Icon seeks. Jt. Ltr. at 1.  
4 Icon refused to avail itself of this less intrusive discovery option. *Id.* Additionally, it appears  
5 from the Joint Letter that – at least as to the first and fourth subject areas – Icon has noticed, but  
6 not yet conducted depositions for other individuals involved in Specialized’s development of  
7 saddle patents. *Id.* at 2.

8 Accordingly, the Court finds that Icon has not adequately exhausted available, less  
9 intrusive means of discovery, and therefore GRANTS the motion for a protective order. This  
10 ruling is without prejudice to Icon’s ability to later seek to depose Mr. Sinyard should its  
11 utilization of less intrusive discovery methods such as the additional interrogatories and  
12 depositions discussed above prove unsuccessful.

13 **CONCLUSION**

14 For the foregoing reasons, Specialized’s motion for a protective order preventing Icon  
15 from deposing its CEO and Chairman of the Board, Mike Sinyard, is GRANTED, without  
16 prejudice to Icon seeking to depose him at a later time should less intrusive discovery methods  
17 prove unsuccessful.

18 **IT IS SO ORDERED.**

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20 Dated: October 21, 2014

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23 MARIA-ELENA JAMES  
24 United States Magistrate Judge  
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