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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. Nos. 128, 131

INTRODUCTION

Pending before the Court are two Joint Discovery Dispute Letters, filed on October 31, 2014 and November 3, 2014. Dkt. Nos. 128 (“Ital. Lit. Ltr.”) and 131 (“Phys. Embodiments Ltr.”). In the first Joint Letter, Defendant Specialized Bicycle Components, Inc. (“Specialized”) seeks to compel Plaintiff Icon-IP Pty Ltd. (“Icon”) to produce documents relating to Icon’s patent litigation against the Italian corporation Selle Royal. Ital. Lit. Ltr. In the second Joint Letter, Icon seeks to compel Specialized to produce design documents and physical embodiments of each accused saddle model for the years of 2006 to present. Phys. Embodiments Ltr.

BACKGROUND

On July 23, 2012, Icon filed a complaint against Specialized accusing 33 bicycle saddles of infringing U.S. Patent No. 6,378,938 (“the ‘938 Patent”) and/or U.S. Patent No. 6,254,180 (“the ‘180 Patent”), and seeking damages, injunctive and other relief. Dkt. No. 1. Specialized responded to the Complaint on August 14, 2012, denying allegations of infringement and asserting a counterclaim for declaratory judgment of non-infringement and invalidity of the ‘938 and ‘180

1 Patents. Dkt. No. 10.

2 In June 2013, Specialized served Icon with a request for all documents related to any
3 enforcement of or litigation involving the Asserted Patents or any Related Patents, and any
4 documents relating to actual or potential prior art raised during such litigations. *See, e.g.*, Ital. Lit.
5 Ltr., Ex. A, Specialized’s First Set of Document Requests Nos. 27, 28, 48, 53, and 54. Icon
6 produced documents referencing its lawsuit against Selle Royal in Italy (“the Italian Litigation”),
7 but did not produce the Italian Litigation documents themselves. Ital. Lit. Ltr. Upon learning of the
8 pending Italian Litigation on August 1, 2014, Specialized immediately propounded a document
9 request applicable to the Italian Litigation Documents. *See id.*, Ex. B, Specialized’s Third Set of
10 Document Requests, No. 84. On August 22, 2014, Icon produced some of these documents, many
11 of them in Italian. Ital. Lit. Ltr. Specialized received them on August 28, 2014. *Id.*

12 On October 15, 2014, Specialized notified Icon that it had failed to produce the entire file
13 from the Italian Litigation, specifically substantive documents filed by Icon relating to
14 infringement or invalidity and Icon’s expert reports and claim charts. *Id.* Specialized now seeks an
15 order requiring Icon to produce all technical reports, opinions, and claim charts relating to the
16 Italian Litigation, including English versions thereof, as well as all things considered by Icon’s
17 expert, Dr. Harrigan. *Id.*

18 Icon asserts that it has produced all documents from the Italian Litigation, but Specialized
19 maintains that it has sent these documents to its Italian counsel for verification and thus cannot
20 confirm or deny Icon’s assertion. *Id.* Icon has also agreed to produce all documents considered¹ by
21 Dr. Harrigan, and attributes any delay to Dr. Harrigan’s back surgery during the week of October
22 27, 2014. *Id.* Thus, the only dispute arising from the Italian Litigation Letter appears to be whether
23 Icon is required to produce the Italian Litigation documents in English. *Id.* As the deadline to file
24 motions to compel in this case has passed, Specialized has filed this motion to preserve its rights
25 should it later deem that production is not complete. *Id.*

26 _____
27 ¹ Initially there was some dispute as to whether Icon was required to produce all documents
28 “considered” by Dr. Harrigan, or only those he “relied upon” in preparing his expert report. Icon
has since agreed to produce all documents Dr. Harrigan considered in preparing his report. Ital.
Lit. Ltr.

1 With regard to the design documents and physical embodiments of the accused saddle
2 models, Icon requested documents describing the design and materials of the accused saddles on
3 June 12, 2013, and has propounded an interrogatory requiring Specialized to identify the Bates
4 numbers of the specific documents describing the design for each saddle. *See Phys. Embodiments*
5 *Ltr.*, Ex. A, Request No. 9 and Ex. B, at Interrogatory 2.

6 Icon asserts that the physical embodiments of the accused saddles are plainly relevant
7 because Icon’s technical expert requires them to prepare his infringement report. *Phys.*
8 *Embodiments Ltr.* As Icon may recover damages for up to six years prior to the filing of its
9 Complaint on July 23, 2012 pursuant to 35 U.S.C. § 286, the accused saddle models and design
10 documents from 2006 to the present are relevant to the present litigation. *Id.* Though Icon has been
11 able to obtain several of the accused saddles from the internet and from Specialized bicycle
12 dealers, Icon claims that the remaining accused saddles are not available on the public market. *Id.*

13 Specialized has produced three physical saddles to date. *Id.* These saddles are model year
14 2015 saddles that are currently being manufactured and sold on bikes, and are not available on the
15 website. As to the rest of the accused saddle models, Specialized claims that it does not keep an
16 inventory of seats. However, Specialized has invited Icon to inspect the saddle models it has in its
17 possession at the offices of Specialized’s counsel, and has also offered to sell Icon the saddles in
18 Specialized’s possession if Icon provides Specialized with the SKU number for each desired
19 model. *Phys. Embodiments Ltr.*, Ex. B, Response to Interrogatory No. 2. Specialized maintains
20 that it cannot confirm whether it has models of older saddles in its possession without the SKU
21 numbers.

22 Specialized also provided Icon with a chart listing various design changes to the accused
23 models within the damages period of this case. *Id.* Icon interprets this chart as demonstrating that
24 Specialized either “has the older seats in its possession or documents that show these changes,”
25 which Specialized has not produced. *Id.* According to Icon, of the documents Specialized has
26 produced, none suggest or demonstrate that structural changes were made to the seats listed in the
27 chart. *Id.* To the extent that Specialized has any of these documents that show specific designs of
28 accused models from 2006 through the present and has failed to produce them, Icon seeks an order

1 compelling Specialized to do so. *Id.* Icon also seeks an order compelling Specialized to produce
2 physical models of accused saddles. *Id.*

3 As to the design documents, Specialized responded to Icon’s Request for Production of
4 “all CAD drawings, materials lists, specifications, and sales manuals,” with several objections,
5 including ESI objections. Specifically, Specialized argued that a search of its emails and electronic
6 documents would be costly, “overly burdensome, oppressive, and not reasonably calculated to
7 lead to the discovery of admissible evidence.” *Id.*, Ex. C, Response to Request for Production No.
8 9. Specialized claims that, subject to its objections, it conducted a reasonable search responsive to
9 Icon’s requests. Phys. Embodiments Ltr. Specialized also states that it did not use CAD or design
10 files for many of its saddles. *Id.*, Ex. D, Bird Depo. at 26:4-33-21. Finally, Specialized points out
11 that the parties signed a stipulation agreeing upon specific search terms for Specialized’s email
12 searching, with which Specialized has complied. Phys. Embodiments Ltr. Icon has not responded
13 to Specialized’s objections. *Id.*

14 DISCUSSION

15 A. Italian Litigation Letter

16 Because Icon has either already produced or agreed to produce the documents requested by
17 Specialized, the only issue apparent in the Italian Litigation Letter is whether Icon is obligated to
18 produce the Italian Litigation documents in English. Specialized specifically requests “all
19 technical reports, opinions and claim charts relating to the Italian Litigation, including English
20 versions thereof.” Ital. Lit. Ltr.

21 Icon is not obligated to translate the Italian Litigation documents for Specialized.
22 “Normally, in responding to a request for production of documents, the requesting party [] bear[s]
23 the cost of translating documents written in a foreign language.” *E&J Gallo Winery v. Cantine*
24 *Rallo, S.p.A.*, 2006 WL 3251830, at *5 (E.D. Cal. Nov. 8, 2006); *see also Cook v. Volkswagen of*
25 *America, Inc.*, 101 F.R.D. 92 (S.D. W. Va. 1984) (commenting that the better reasoned view
26 requires the party making a document request to bear the expense of translation at the discovery
27 phase of litigation). However, to the extent that Specialized seeks “*original reports* in English that
28 correspond to . . . Italian reports,” it is entitled to discovery. *Id.* (emphasis added).

1 **B. Physical Embodiments Letter**

2 1. Physical Saddles

3 Icon seeks an order compelling Specialized to produce physical models of accused saddles
4 so that Icon can assess the alleged design changes of the accused seats as related to infringement.
5 Ital. Lit. Ltr. Specialized has agreed to sell Icon whatever sample saddles it has in its possession if
6 Icon provides the SKU numbers for the desired saddles. *Id.* According to Specialized, “Icon has
7 the catalogs and sales information for the accused products and could easily provide” the SKU
8 numbers. *Id.* Icon does not suggest that providing the SKU numbers would constitute an undue
9 burden, nor does it respond to Specialized’s request for SKU numbers at all in the Joint Letter. *See*
10 Ital. Lit. Ltr.

11 Because Specialized has agreed to produce all saddle models in its possession upon receipt
12 of the SKU numbers and Icon has failed to show that providing the SKU numbers would
13 constitute an undue burden, the Court hereby orders Specialized to comply with Icon’s specific
14 requests for saddle models identified by SKU number. *See ASUS Computer Int’l v. Round Rock*
15 *Research, LLC*, 2013 WL 6113253, at *1 (N.D. Cal. Nov. 20, 2013) (granting motion to compel
16 production of relevant documents because the accused infringer failed to demonstrate how
17 production would impose a significant burden).

18 2. Design Documents

19 Icon seeks an order from the Court compelling Specialized to produce materials documents
20 from the years 2006 through the present that allow Icon to assess the alleged design changes of the
21 accused seats as relating to infringement. Specialized asserts that it has complied with Icon’s
22 requests for design documents subject to its objections regarding unlimited ESI searching and the
23 parties’ stipulation setting forth specific search terms for Specialized’s email searching. Ital. Lit.
24 Ltr.

25 Regarding ESI searching for emails, the parties stipulated that Specialized would use
26 specific search terms and custodians for its email searching. *Id.* The stipulation explicitly stated
27 that Specialized would not conduct further email searches beyond those agreed to in the stipulation
28 with two exceptions, neither of which is applicable here. *Id.* Specialized states that it has complied

1 with the stipulation, and that email production was completed on October 22, 2014.

2 With regard to Icon’s request for other electronic design documents, Specialized objects
3 that unlimited ESI searching “would be extremely cumbersome, time consuming, disruptive to
4 Specialized’s operations, and very costly.” *Id.*; Ex. B., Specialized’s Response to Interrogatory
5 No. 2. However, Specialized does not explain how and why this is so. Thus, Specialized has not
6 articulated what it considers it to be an unreasonable ESI search and, without more, Specialized
7 has not met its burden of showing that Icon’s request is unduly burdensome. Accordingly, Icon is
8 entitled to discovery of Specialized’s non-email ESI design documents.

9 **CONCLUSION**

10 For the foregoing reasons, to the extent that Icon has not already produced the technical
11 reports, opinions, and claim charts relating to the Italian Litigation, as well as all documents
12 considered by Dr. Harrigan, Specialized’s motion is GRANTED. Icon’s motion to compel
13 Specialized to produce for sale all physical saddle models in its possession is GRANTED, so long
14 as Icon first identifies the SKU numbers of the saddle models it seeks. Finally, Icon’s motion to
15 compel Specialized to produce all design documents relating to the accused products is
16 GRANTED, except that, pursuant to the parties’ stipulation, Specialized need not conduct any
17 further email searches.

18 **IT IS SO ORDERED.**

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20 Dated: December 2, 2014

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22 MARIA-ELENA JAMES
23 United States Magistrate Judge
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