

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

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. 145

Pending before the Court is the parties’ Joint Discovery Dispute Letter, filed January 21, 2015. Dkt. No. 145. Plaintiff Icon-IP Pty Ltd. (“Icon”) seeks to quash Defendant Specialized Bicycle Components, Inc.’s (“Specialized”) non-party subpoenas served on ACT Lab LLC and John Bogler, the president and founder of ACT Lab. Icon maintains that ACT Lab’s and Mr. Bogler’s roles in this litigation are limited to performing testing on bicycle seats<sup>1</sup> for Icon, certain of which Icon’s designated technical expert, Dr. Harrigan, relied on in his Federal Rule of Civil Procedure (“Rule”) 26(a)(2)(b) report. Jt. Ltr. at 1. As fact discovery in this case closed on November 26, 2014 (*see* Dkt. No. 134), Icon maintains that the subpoenas are untimely.

In response, Specialized argues that it is entitled to depose ACT Lab and Mr. Bogler, because both Dr. Harrigan and Icon relied upon their testing in the infringement contentions and throughout the case, but have now abandoned it. Jt. Ltr. at 4. Specialized “seeks the rest of the story and background relating to this sudden change in Icon’s basis for infringement.” *Id.* In addition, because Dr. Harrigan considered these tests, Specialized argues that its requests are expert discovery, which did not close until January 21, 2015, the day the parties filed this letter.

---

<sup>1</sup> Icon accuses 33 of Specialized’s 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”). Compl., Dkt. No. 1. Specialized has asserted a counterclaim for declaratory judgment of non-infringement and invalidity of the ’938 and ’180 Patents. Answer & Countercl., Dkt. No. 10.

1 See Dkt. No. 134.

2 Given that fact discovery closed in November, the subpoenas would only be proper if they  
3 are part of expert discovery. Rule 26(a)(2)(B)(ii) requires the production of “the facts or data  
4 considered by the [expert] witness in forming” his or her opinions. Courts have read the term  
5 “considered” to include information that an expert reviews or generates, “regardless of whether the  
6 experts actually rely on those materials as a basis for their opinions.” See, e.g., *S.E.C. v. Reyes*,  
7 2007 WL 963422, at \*1 (N.D. Cal. Mar. 30, 2007). However, Rule 26(b)(4)(D) provides that a  
8 party may not “discover facts known or opinions held by an expert who has been retained or  
9 specifically employed by another party in anticipation of litigation or to prepare for trial and who  
10 is not expected to be called as a witness at trial” unless, in relevant part, exceptional circumstances  
11 can be shown. Exceptional circumstances exist where the condition observed by the expert is no  
12 longer observable, where the costs of an independent examination would be judicially prohibitive,  
13 or where there are no other available experts in the same field or subject area. *Oki Am., Inc. v.*  
14 *Advanced Micro Devices, Inc.*, 2006 WL 2987022 at \*2 (N.D. Cal. Sept. 27, 2006).

15 Here, the Court concludes that Rule 26(b)(4)(D) does not provide a ground on which  
16 Specialized’s subpoenas could be considered expert discovery. First, Icon will not rely on ACT  
17 Lab’s or Mr. Bogler’s testimony at trial. *Jt. Ltr.* at 2. Thus, Rule 26 does not provide authority for  
18 their depositions outside the fact discovery period. See Fed. R. Civ. P. 26(b)(4)(A) (“A party may  
19 depose any person who has been identified as an expert whose opinions may be presented at  
20 trial.”). Second, Specialized has made no showing that any of Rule 26(b)(4)(D)’s exceptional  
21 circumstances exist in this case.

22 However, Specialized argues that the subpoenas are properly related to expert discovery  
23 because ACT Lab’s and Mr. Bogler’s testing and analysis required close collaboration with  
24 Dr. Harrigan. *Jt. Ltr.* at 4-5 (citing *Harrigan Dep., Jt. Ltr., Ex. E* at 55:17-58:22). In support,  
25 Specialized cites to *Apple Inc. v. Amazon.com, Inc.*, 2013 WL 1320760 (N.D. Cal. Apr. 1, 2013),  
26 where the court considered whether Apple should be compelled to produce discovery related to  
27 survey work completed by two non-testifying experts that later became assistants to Apple’s  
28 testifying expert. *Id.* at \*1. Because of the collaborative nature of the testifying and non-testifying

1 experts' subsequent work together, the court found that some discovery was appropriate, but only  
2 as to the work completed with the testifying expert. *Id.* at \*2. The court noted that the experts  
3 "sometimes jointly examine and discuss the results of the surveys," and that the billing records for  
4 their work with the testifying expert included hours spent on the initial survey work. *Id.* at \*1-2.  
5 However, the court did not require Apple to produce the experts' work from before they became  
6 the testifying expert's assistants, finding that it might violate Rule 26(b)(4)(D). *Id.* at \*2.

7 Here, although Specialized maintains that ACT and Mr. Bogler closely collaborated with  
8 Dr. Harrigan, Dr. Harrigan testified that he approved the protocols and directed the testing, and  
9 only spoke to Mr. Bogler and others at ACT about "incidentals," such as "getting there and  
10 making sure that everybody was going to be available," and looking at testing protocols "to make  
11 sure that everything was going well." Harrigan Dep. at 55:17-58:1. There is no indication that  
12 this interaction rises to the collaborative nature of the work of the experts in *Apple*.

13 Further, Specialized's deposition topics are not limited to the testing that Dr. Harrigan  
14 considered in his report in this case. Instead, Specialized's topics are directed towards testing that  
15 ACT Lab completed for different litigation involving related European patents (Jt. Ltr., Ex. A  
16 (Dep. Not.), Topics 6, 11); testing completed at the request of the inventor of the patents (Topic  
17 4); all testing completed at the request of Icon (Topic 1); communications between ACT Lab and  
18 the inventor (Topic 10); and between ACT Lab and Icon or Icon's counsel (Topic 9).

19 Based on the record before it, the Court finds that Specialized's "[Rule] 45 subpoenas  
20 constitute pretrial discovery that must be served within the specified discovery period."  
21 *MedImmune, LLC v. PDL Biopharma, Inc.*, 2010 WL 1266770, at \*1 (N.D. Cal. Apr. 1, 2010)  
22 (citations omitted). Accordingly, as fact discovery closed in November 2014, Specialized must  
23 seek leave from the presiding judge to conduct such discovery.

24 **IT IS SO ORDERED.**

25 Dated: January 22, 2015

26   
27 \_\_\_\_\_  
28 MARIA-ELENA JAMES  
United States Magistrate Judge