

- 1 • Rudolph breached the implied covenant of good faith and fair dealing by
2 exercising its control over Nikoonahad's technology pursuant to the exclusive
3 license it held under the Agreement to deprive Nikoonahad of the ability to
4 license, sell, or otherwise commercialize his technology to others in the
5 industry.
- 6 • Rudolph breached the implied covenant of good faith and fair dealing by exercising
7 its control over the development of products in such a way as to ensure no products
8 requiring payment of royalties were developed before the expiration of the
9 Agreement.
- 10 • Rudolph breached the implied covenant of good faith and fair dealing by retaining the
11 subject intellectual property for its own benefit after terminating the contract.

12 Plaintiff moved to compel with regard to 60 document requests without first adequately
13 meeting and conferring with opposing counsel.² The meet and confer efforts that occurred before
14 Judge Fogel ruled on the motion to dismiss the Second Amended Complaint are not sufficient for the
15 present motion because they took place before this case was limited to just one out of the four causes
16 of action. While the court agrees with Plaintiff that the scope of discovery for the remaining cause of
17 action is broader than the scope proposed by Defendant,³ a cursory review of the document requests
18 reveals that many are overly broad as written. Further, in light of the parties' and the court's desire
19 to streamline discovery prior to mediation,⁴ limiting this motion to 20 of the document requests for
20 now is warranted. The parties' meet and confer shall include discussion of what responsive
21 electronically stored information, if any, is available only from backup tapes, and what burden is
22 entailed in producing such information from the backup tapes. This order is without prejudice to
23 Plaintiff moving to compel as to the remaining 40 document requests after the mediation.

24 ² Plaintiff also filed a 78 page memorandum in violation of this court's Civil Local Rule
25 7-2(b). Although the document is styled as a "Separate Statement," there is no authority for such a
26 separate statement, and Plaintiff filed no other document as the memorandum that is required by Local
27 Rule 7-2(a). Local Rule 37-2 anticipates that the statement of discovery requests and objections thereto
28 be included in the memorandum required by Local Rule 7-2(b).

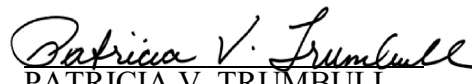
29 ³ Contrary to Defendant's argument, Plaintiff's remaining cause of action does not turn
30 solely on "whether Rudolph exercised its discretion to not use the licensed technology because of a bad
31 faith intent and/or out of an ill will toward Plaintiff." See Opposition Brief, 13:1-4. Judge Fogel order
32 on Defendant's motion to dismiss expressly acknowledges that the cause of action includes an allegation
33 that Defendant breached the implied covenant of good faith and fair dealing by "retaining the subject
34 intellectual property for its own benefit after terminating the contract." That allegation was neither
35 dismissed nor stricken from the complaint. Thus, information regarding any use of Plaintiff's
36 technology by Defendant after the contract was terminated is within the scope of discovery.

37 ⁴ See Transcript of Proceedings Before the Honorable Jeremy Fogel on file herein at
38 Docket Number 71.

1 IT IS FURTHER ORDERED that after completing the further meet and confer ordered
2 herein, Plaintiff may bring a renewed motion on 21 days notice for any of the 20 document requests
3 that remain in dispute. Plaintiff need not set forth each request and response, because they are
4 already included in the separate statement he originally filed for this motion. Instead, for each such
5 request, Plaintiff shall set forth his position regarding: 1) the relevance of the information sought;
6 and 2) whether the burden and expense of producing the discovery is warranted by its likely benefit.
7 See CIVIL L.R. 37-2 and FED.R.CIV.PRO. 26(b)(2)(C)(iii). Defendant may file its opposition no later
8 than one week before the noticed hearing date. No reply shall be filed absent further order of the
9 court.

10 IT IS FURTHER ORDERED that all electronically stored information produced by
11 Defendant in response to Plaintiff's document requests shall be produced in its native format absent
12 agreement of the parties otherwise or further order of this court. Defendant did not respond to
13 Plaintiff's argument that producing .pdf copies is insufficient. Moreover, Rule 34(b)(2)(E)(ii)
14 provides that: "If a request does not specify a form for producing electronically stored information, a
15 party must produce it in a form or forms in which it is ordinarily maintained or in a reasonably
16 usable form or forms." Defendant has not proposed any "reasonably usable form" other than the
17 native format in which it ordinarily maintains its electronically stored information.

18 Dated: *July 2, 2009*

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20 PATRICIA V. TRUMBULL
21 United States Magistrate Judge
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