

United States District Court
For the Northern District of California

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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION

SSI SYSTEMS INTERNATIONAL INC., a
California corporation,

Plaintiff,

v.

TEK GLOBAL S.R.L., TEK CORPORATION,

Defendants.

Case No.: C 11-774 PSG

**ORDER GRANTING-IN-PART
PLAINTIFF’S MOTION TO COMPEL**

(Re: Docket No. 119)

In this patent infringement case, Plaintiff SSI Systems International, Inc. (“SSI”) moves to compel Defendants TEK Global S.R.L. and TEK Corporation (“TEK”) to produce certain documents relating to TEK’s expert report on the validity of the patent-in-suit. On February 12, 2013, the parties appeared for oral argument. Having reviewed the papers and considered the arguments of counsel, the court GRANTS-IN-PART SSI’s motion.

I. BACKGROUND

SSI sued TEK for patent infringement. TEK countersued, asserting SSI’s products infringe U.S. Patent No. 7,789,110 (“the ‘110 Patent”).

TEK designated Dr. Kazerooni to testify as an expert on the validity of the ‘110 Patent. In his expert rebuttal report, Dr. Kazerooni concluded that the ‘110 Patent claims the priority date of

1 an Italian patent (application number TO 2004A000117) owned by TEK (“the Italian patent”).¹
2 Specifically, Dr. Kazerooni found that “[s]upport for a three-way valve and an addition hose can be
3 found in claim 1 of the Italian application.”² In forming this conclusion, Dr. Kazerooni quoted and
4 relied on a “certified English translation” of the Italian application.³ At his deposition, however,
5 Dr. Kazerooni admitted that the “certified English translation” might not be accurate.⁴ In
6 subsequent communications, TEK admitted the translation provided to Dr. Kazerooni was
7 incorrect. Upon request, TEK provided SSI with the original Italian application text, which did not
8 match up with the version cited by Dr. Kazerooni.⁵
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10 The incorrect translation contains the following additional language that is not present in
11 the Italian application:

12 “said kit further comprising and additional hose (83) cooperating with said inflatable article;
13 and a three-way valve (81) input connected to said compressor assembly (2), and output
14 connected to said container (3) and to said additional hose (83) to direct a stream of compressed
15 air selectively to said container (3) or to said additional hose (83).”⁶

16 On January 4, 2013, SSI requested the Italian application from which the translation
17 provided to Dr. Kazerooni was made, and any certifications of the translation.⁷ TEK responded
18 with the original Italian application, and the translation with the certification.⁸ Unsatisfied, SSI
19 asked again for the Italian application which the incorrect translation was created from and “any
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21 ¹ See Docket No. 119, Ex. A.

22 ² Id.

23 ³ See id.

24 ⁴ See Docket No. 119, Ex. B.

25 ⁵ See Docket No. 119, Ex. D.

26 ⁶ See Docket No. 119, Ex. E, F.

27 ⁷ See Docket No. 119, Ex. C.

28 ⁸ See Docket No. 119, Ex. D.

1 related documents.”⁹ On January 7, 2013, TEK responded that it had already provided the original
2 incorrect translation, the newly corrected translation, and the original Italian application, which the
3 translation was based on.¹⁰ TEK also stated that there were no other documents in its possession
4 responsive to SSI’s request.¹¹ Still SSI persisted, requesting all documents that were used in
5 producing the incorrect translation.¹²

6 On January 18, 2013, TEK provided SSI with a string of email communications between
7 administrative assistant for TEK’s counsel, Anabel Rodriguez (“Rodriguez”), and Ultra Translate,
8 the translation company that provided the original translation.¹³ The email communications
9 provided by TEK to SSI include Rodriguez’s original email request to Ultra Translate for the
10 translation, which states she has attached the Italian application and an uncertified English
11 translation.¹⁴ The Ultra Translate representative responded that as the first 4 pages of the text
12 needed translation and the following 19 pages only needed transcription of the uncertified English
13 transcription, TEK would receive a discount.¹⁵ TEK claims that Rodriguez actually attached only
14 the Italian application and the U.S. ‘110 Patent, but mistakenly referred to the ‘110 Patent as an
15 “uncertified translation.”¹⁶ To support this assertion, Payam Moradian (“Moradian”), TEK’s
16 counsel, explains that he instructed Rodriguez to obtain a translation of the Italian application,
17 attaching both the Italian application for translation and the ‘110 Patent to be used as a “glossary”
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21 ⁹ Docket No. 119, Ex. G.

22 ¹⁰ See Docket No. 119, Ex. H.

23 ¹¹ See id.

24 ¹² See Docket No. 119, Ex. I.

25 ¹³ See Docket No. 119, Ex. M.

26 ¹⁴ See Docket No. 119, Ex. N.

27 ¹⁵ See id.

28 ¹⁶ See Docket No. 127.

1 to facilitate translation.¹⁷ Tek submits an email from Moradian to Rodriguez reflecting this request
2 – the November 14, 2012 email is blank, but attaches the Italian application and the ‘110 Patent.¹⁸

3 SSI now moves to compel the following: (1) the incorrect translation that was provided to
4 Dr. Kazerooni, (2) the document upon which the translation was based, and (3) any documents and
5 communications to and from the original party that performed the incorrect translation relied upon
6 by Dr. Kazerooni. SSI also asks that portions of Dr. Kazerooni’s expert rebuttal discussing the
7 incorrect translation be stricken.
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9 II. LEGAL STANDARD

10 Pursuant Rule 26, parties generally may discover “any nonprivileged matter that is relevant
11 to any party’s claim or defense – including the existence, description, nature, custody, condition,
12 and location of any documents or other tangible things and the identity and location of persons who
13 know of any discoverable matter.”¹⁹ Additionally, the court may for good cause order discovery of
14 “any matter relevant to the subject matter involved in the action.”²⁰

15 III. DISCUSSION²¹

16 SSI first asks for the incorrect translation that was provided to Dr. Kazerooni. SSI also
17 appears to request any other documents relied upon by Dr. Kazerooni. As noted by TEK, the
18 incorrect translation relied upon by Dr. Kazerooni has been produced several times. The incorrect
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22 ¹⁷ Docket No. 126 ¶ 8-9.

23 ¹⁸ See Docket No. 126, Ex. 1.

24 ¹⁹ Fed. R. Civ. P. 26(b)(1).

25 ²⁰ Id.

26 ²¹ As a preliminary matter, TEK argues that SSI did not meet and confer in good faith before
27 bringing this motion as required by Fed. R. Civ. P. 37(a)(1). Considering the pending fact
28 discovery deadlines and dispositive motions before the court, and the importance of the issues
presented, the court will consider the instant motion despite possible procedural deficiencies.

1 translation was attached as Exhibit A to Dr. Kazerooni's Expert Rebuttal Report.²² TEK also
2 reproduced the incorrect translation again on January 24, 2013.²³ TEK has also produced the email
3 communication between Moradian and Dr. Kazerooni, attaching the incorrect translation.²⁴ SSI's
4 first request is therefore moot.

5 SSI also requests that the court strike portions of Dr. Kazerooni's Expert Rebuttal Report
6 referencing the incorrect translation. TEK agrees, pointing out that they informed SSI on February
7 5, 2013 that they would be withdrawing the portions of the report based on the erroneous
8 translation; namely, TEK agreed to withdraw paragraphs 10-12 on page 9.²⁵ The parties do not
9 dispute that the original translation was incorrect and the portions of Dr. Kazerooni's report relying
10 on the incorrect translation should be withdrawn. The court therefore finds it appropriate to strike
11 the lines of Dr. Kazerooni's report referencing the incorrect translation.

12 SSI then asks that documents between TEK's counsel and the translation company be
13 produced. SSI asserts the documents are relevant to the issues of the priority date of the asserted
14 claims, the credibility of TEK's expert witness, the reasonableness of his reliance on this
15 translation, and the invalidity of the '110 Patent. As TEK has already admitted the original
16 translation to be incorrect and the parties have agreed to strike that portion of the report, the court
17 fails to see how communications with the translation company would relate to the issues of priority
18 date and invalidity of the '110 Patent. The validity of the Expert Rebuttal is no longer at issue.
19 Similarly, no evidence suggests that Dr. Kazerooni was involved with the translation process; TEK
20 has provided evidence showing Dr. Kazerooni was merely provided with the incorrect translation.
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25 ²² See Docket No. 125 ¶ 8, 10.

26 ²³ See Docket No. 125 ¶ 15. See also Docket No. 125, Ex. 2.

27 ²⁴ See Docket No. 126, Ex. 4.

28 ²⁵ See Docket No. 126, Ex. 5.

1 Communications between TEK and the translation company are therefore not relevant to Dr.
2 Kazerooni's credibility.

3 The court nevertheless finds that there is good cause to discover these documents.
4 Although TEK produced a PDF version of the email chain between Rodriguez and Ultra Translate,
5 and TEK asserts that Rodriguez mistakenly referenced the '110 Patent as the attached "uncertified
6 English translation," the court finds that SSI is still entitled to native forms of all communications
7 between TEK's counsel and the translation company to resolve this dispute. As TEK has
8 represented to opposing counsel and the court that the incorrect translation was due to honest error
9 and problems with the translation company, SSI's request should pose no problem. TEK should
10 bear the cost of resolving the ambiguity it created.
11


12 IV. CONCLUSION

13 SSI's request for the incorrect translation provided to Dr. Kazerooni is MOOT. The court
14 STRIKES strike paragraphs 10-12 of Dr. Kazerooni's Expert Rebuttal Report because they refer to
15 an incorrect translation of the Italian application.
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17 No later than February 22, 2013, TEK shall produce native versions of all communications
18 between TEK and Ultra Translate relating to the incorrect translation, including any attached
19 documents. The court specifically notes that TEK must provide a native version of the email
20 communication between Rodriguez and Ultra Translate dated November 14, 2012, with all
21 attached documents.
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23 **IT IS SO ORDERED.**

24 Dated: February 13, 2013

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27 PAUL S. GREWAL
28 United States Magistrate Judge