



**I. BACKGROUND**

On December 5, 2011, Dynetix filed suit against Synopsys, alleging Synopsys' products infringe U.S. Patent No. 6,466,898 ("the '898 Patent").<sup>1</sup> Synopsys filed a counterclaim for patent infringement against Dynetix, alleging two Dynetix products, V2Sim and RaceCheck, infringe U.S. Patent No. 5,784,593 ("the '593 Patent") and U.S. Patent No. 5,706,473 ("the '473 Patent").<sup>2</sup>

Dynetix answered the counterclaim on July 5, 2012.<sup>3</sup> On September 21, 2012, just over two months later, Dynetix filed a "Motion to Dismiss or, Alternatively, for Summary Judgment of Non-infringement" regarding Synopsys' counterclaims ("motion for summary judgment").<sup>4</sup> The summary judgment motion hearing is set for January 9, 2013.<sup>5</sup>

To address Dynetix's motion for summary judgment, Synopsys requested a 30(b)(6) deposition of Dynetix on topics related to the functions of Dynetix's accused products. The deposition was noticed for October 24, 2012.<sup>6</sup> Synopsys' notice of the deposition described the scope of the deposition topics, including: (1) "[t]he detailed design, structure, and operation of the Accused Products;" (2) "[t]he detailed design, development, structure, and operation of any feature of the Accused Products that simulates circuits containing finite state machines;" (3) "[t]he detailed design, development, structure, and operation of any feature of the Accused Products that detects or evaluates combinational feedback loops;" and (4) "[t]he factual bases for any contention that Dynetix's V2Sim or RaceCheck Products do not meet the limitations of the asserted claims of the '473 Patent and the '593 Patent."<sup>7</sup>

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<sup>1</sup> See Docket No. 1.

<sup>2</sup> See Docket No. 58.

<sup>3</sup> See Docket No. 60.

<sup>4</sup> See Docket No. 87.

<sup>5</sup> See Docket No. 161.

<sup>6</sup> See Docket No. 155, Ex. A.

<sup>7</sup> Id.

1 Dynetix eventually agreed that Synopsys was entitled to discovery for the counterclaims  
2 and the motion to dismiss.<sup>8</sup> In subsequent meet-and-confer discussions, the parties agreed the  
3 deposition would occur on November 21, 2012.<sup>9</sup> Dynetix designated Chan as the 30(b)(6)  
4 witness.<sup>10</sup> Chan is the founder, chief executive officer, and sole employee of Dynetix.<sup>11</sup> He also  
5 authored the '898 Patent and assigned the patent to Dynetix.

6 The parties disputed whether Synopsys would be entitled to both a 30(b)(6) deposition of  
7 Chan as well as an individual deposition of him. Dynetix refused to allow the 30(b)(6) deposition  
8 unless Synopsys agreed to waive its right to depose Chan in his individual capacity in the future.<sup>12</sup>  
9 Synopsys did not agree. As the parties reached an "impasse," Synopsys filed this motion to compel  
10 the 30(b)(6) deposition.<sup>13</sup>

## 11 II. LEGAL STANDARDS

12 "In its notice or subpoena, a party may name as the deponent a public or private  
13 corporation."<sup>14</sup> "The named organization must then designate one or more officers... or designate  
14 other persons who consent to testify on its behalf; and it may set out the matters on which each  
15 person designated will testify."<sup>15</sup>

16 Rule 26(b)(1) states that "parties may obtain discovery regarding any nonprivileged matter  
17 that is relevant to any party's claim or defense." Even relevant discovery may be limited, however,  
18 if: "(i) the discovery sought is unreasonably cumulative or duplicative, or can be obtained from  
19 some other source that is more convenient, less burdensome, or less expensive; (ii) the party

20 <sup>8</sup> See Docket No. 155, Ex. C.

21 <sup>9</sup> See Docket No. 155, Ex. D.

22 <sup>10</sup> See Docket No. 155, Ex. E.

23 <sup>11</sup> See Docket No. 1 ¶ 9-10; Docket No. 155 Ex. F.

24 <sup>12</sup> See Docket No. 155, Ex. E, F, G.

25 <sup>13</sup> Docket No. 154 at 5.

26 <sup>14</sup> Fed. R. Civ. P. 30(b)(6).

27 <sup>15</sup> Id.

1 seeking discovery has had ample opportunity to obtain the information by discovery in the action;  
2 or (iii) the burden or expense of the proposed discovery outweighs its likely benefit, considering  
3 the needs of the case, the amount in controversy, the parties' resources, the importance of the  
4 issues at stake in the action, and the importance of the discovery in resolving the issues."<sup>16</sup>

### 5 III. DISCUSSION

6 Synopsys clearly is entitled to depose Chan as the 30(b)(6) witness designated by Dynetix.  
7 The matters noticed to Dynetix are discoverable because they may lead to relevant information on  
8 Synopsys' defenses against Dynetix's pending motion for summary judgment. Synopsys itself  
9 concedes that the topics of the deposition are relevant and discoverable.

10 Synopsys also is entitled to depose Chan in his individual capacity regarding the principle  
11 action. The original action alleged Synopsys products infringed the '898 Patent. Chan is the  
12 founder of Dynetix and the named inventor of the '898 Patent. As the named inventor, Chan's  
13 personal deposition is relevant to at least the issues of "the written description, enablement,  
14 inequitable conduct, novelty, obviousness, and damages."<sup>17</sup>

15 The designation of Chan as Dynetix's 30(b)(6) witness does not somehow divest Synopsys'  
16 right to take the individual deposition of Mr. Chan. Ninth Circuit courts have held that individuals  
17 noticed as an individual witness under Rule 30(b)(1) and also as the corporate representative under  
18 30(b)(6) are "presumptively subject to independent seven-hour time limits."<sup>18</sup>

19 Dynetix argues Synopsys should be required to simultaneously depose Chan in both his  
20 representative and individual capacity. But nothing requires Synopsys to take the individual  
21 deposition of Chan at this same time,<sup>19</sup> especially when Synopsys must focus on deposing Chan as

22 <sup>16</sup> Fed. R. Civ. P. 26(b)(2)(C).

23 <sup>17</sup> Genentech, Inc. v. Trustees of Univ. of Pennsylvania, Case No. 10-2037 PSG, 2011 WL  
24 7074212, at \*1 (N.D. Cal. Oct. 18, 2011)

25 <sup>18</sup> Wesley v. Gates, Case No. C08-CV-2719 SI, 2009 WL 1955997, at \*1 (N.D. Cal. July 2, 2009).

26 <sup>19</sup> See Louisiana Pac. Corp. v. Money Mkt. 1 Institutional Inv. Dealer, Case No. 09-03529 JSW  
27 LB, 2012 WL 3939337, at \*6 (N.D. Cal. Sept. 10, 2012) (holding that "testimony of an  
individual... is distinct from the testimony of an entity").

1 the corporate representative to prepare to oppose Dynetix's pending motion for summary  
2 judgment. This Synopsis is entitled to do.

3 **IV. CONCLUSION**

4 Synopsis' motion to compel the 30(b)(6) deposition of Dynetix is GRANTED. No later  
5 than two days before Synopsis' opposition to Dynetix's summary judgment is due, Dynetix shall  
6 produce one or more corporate witnesses to be deposed on the topics noticed in Synopsis' 30(b)(6)  
7 notice. Synopsis will not be precluded from noticing the individual deposition of the designated  
8 witness at a later date.

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10 **IT IS SO ORDERED.**

11 Dated: November 27, 2012

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15 PAUL S. GREWAL  
16 United States Magistrate Judge  
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