

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

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

FINISAR CORPORATION,
Plaintiff,
v.
NISTICA, INC.,
Defendant.

Case No. [13-cv-03345-BLF](#) (JSC)

ORDER RE DISCOVERY DISPUTES

Re: Dkt. Nos. 223, 225, 230, 231

Now pending before the Court in this patent infringement action are three discovery disputes. Two disputes pertain to the adequacy of Nistica’s responses to Finisar’s discovery requests, while the third involves Finisar’s objection to Nistica’s expert witness. Having considered the parties’ letter briefs, the Court concludes that oral argument is unnecessary, *see* Civ. L.R. 7-1(b), and rules as follows.

LEGAL STANDARD

The Federal Rules of Civil Procedure provide that parties “may obtain discovery regarding any nonprivileged matter that is relevant to any party's claim or defense.” Fed. R. Civ. P. 26(b)(1). In a motion to compel, the moving party bears the burden of showing why the other party’s responses are inadequate or their objections unjustified. *See Williams v. Gate*, No. 090468, 2011 WL 6217378, at *1 (E.D. Cal. Dec. 14, 2011) (the moving party “bears the burden of informing the Court . . . for each disputed response, why [the responding party’s] objection is not justified[.] [The moving party] may not simply assert that he has served discovery responses, that he is dissatisfied, and that he wants an order compelling further responses.”). “Once the moving party establishes that the information requested is within the scope of permissible discovery, the burden shifts to the party opposing discovery. An opposing party can meet its burden by demonstrating

1 that the information is being sought to delay bringing the case to trial, to embarrass or harass, is
2 irrelevant or privileged, or that the person seeking discovery fails to show need for the
3 information.” *Khalilpour v. CELLCO P’ship*, No. 09–02712, 2010 WL 1267749, at *1 (N.D. Cal.
4 Apr. 1, 2010) (internal quotation marks and citations omitted).

5 **DISCUSSION**

6 **A. Finisar’s Request for an Order Compelling Nistica to Produce a 30(b)(6) Witness and**
7 **Forecast Reports (Dkt. No. 223)**

8 Finisar seeks an order compelling Nistica to provide (1) a person most knowledgeable to
9 testify about Topics 34 (Nistica’s communications with third parties regarding Finisar’s patents in
10 suit), 36 (Nistica’s communications with third parties regarding Finisar’s claims of infringement),
11 and 58 (Nistica’s expected, projected, or anticipated future sales revenue, costs, and profits from
12 the Accused Products) from Finisar’s first Notice of Deposition, and relatedly, (2) forecast report
13 documents responsive to Request for Production (“RFP”) No. 46. The parties have since resolved
14 their dispute regarding forecast reports. (Dkt. No. 242.)

15 Finisar contends that the two 30(b)(6) witnesses that Nistica has designated thus far have
16 not been adequately prepared to testify on those topics and thus further testimony is required.
17 Nistica contends that it has provided sufficient testimony on these topics from the two 30(b)(6)
18 witnesses and several fact witnesses, and that, while Topics 34 and 36 are overly broad as written,
19 the second 30(b)(6) witness it designated adequately testified to a narrower scope of topics to
20 which the parties agreed.

21 Finisar first noticed the 30(b)(6) deposition of these topics on June 19, 2014. (Dkt. No.
22 223-2.) The topics included No. 34 (Nistica’s communications with third parties regarding
23 Finisar’s patents in suit), 36 (Nistica’s communications with third parties regarding Finisar’s
24 claims of infringement), and 58 (Nistica’s expected, projected, or anticipated future sales revenue,
25 costs, and profits from the Accused Products). (*Id.*)

26 Nistica initially designated its CEO, Ashish Vengsarkar, to testify on these topics. After
27 rescheduling at the last minute, Nistica cancelled the Vengsarkar 30(b)(6) deposition altogether,
28 then designated its Vice President of Finance, Joanne Bisconti, as the person most knowledgeable

1 instead. (*See* Dkt. Nos. 223-6, 223-7.) At her June 9, 2015 deposition, Ms. Bisconti was not
2 adequately prepared to testify to the topics at issue, as several times she responded that she had no
3 personal knowledge about Nistica’s communications with third parties about the patents-in-suit or
4 the instant litigation—*i.e.*, Topics 34 and 36—and indicated that Mr. Vengsarkar and Nistica’s
5 Chief Technology Officer, Thomas Strasser, would have the relevant information and that she was
6 not fully aware of their knowledge. (*See, e.g.*, Dkt. No. 223-11.) With respect to Topic 58, Ms.
7 Bisconti testified that she did not have enough detail to discuss Nistica’s expected profits without
8 viewing the yearly sales forecast reports that she prepares (*id.*), the most recent of which had not
9 been produced to Finisar.

10 Following the Bisconti deposition, on June 19, 2015 the parties met and conferred about
11 designating a follow-up witness to testify further on these topics. (Dkt. No. 223-1 ¶ 2.) Nistica
12 eventually designated its Vice President of Sales & Marketing, Dario Falquier. The parties
13 dispute the scope of Mr. Falquier’s designated topics. Finisar contends that Nistica noticed Mr.
14 Falquier as 30(b)(6) designee for the topics in their entirety.

15 Nistica, for its part, contends that the agreement was more limited and was part of a quid
16 pro quo for further 30(b)(6) testimony from each party. During the meet and confer on this issue,
17 counsel for Nistica asked Finisar “to specify what communications within topics 34 and 36 Finisar
18 actually cared about.” (*Id.* ¶ 2.) Nistica’s lawyer avers that, in response, with respect to Topic 34
19 Finisar’s counsel represented that it “wanted a witness to testify about the communications, and
20 specifically about a presentation, that NTT/NEL gave Nistica regarding the ’599 patent.” (*Id.*)
21 She further avers that, regarding topic 36, “Finisar’s counsel represented that Finisar cared only
22 about communications that Mr. Falquier, Mr. Strasser, Mr. Wagener, or Mr. Vengsarkar had with
23 certain customers, and specifically about any conversations about whether the current litigation
24 had settled.” (*Id.* ¶ 3.) Finisar appears to concede that these representations were made inasmuch
25 as this was the information it was most interested in, but it insists that it did not agree to limit Mr.
26 Falquier’s testimony in this manner.

27 In an email following that meet and confer, Nistica agreed to designate a witness “for a
28 limited deposition (no more than 3 hours) to testify regarding the following sub-issues for Topics

1 34 and 36:

2 [C]ommunications with NTT/NEL (and Fujikura, if any) about the
3 '599 patent and relating to the presentation referencing the '599
4 patent and to testify about communications with certain third parties
5 about the lawsuit. With the understanding that no witness can
6 testify about all Nistica communications with third parties about the
lawsuit Nistica is willing to designate someone to testify generally
about the substance of communications with certain customers,
including, whether or not Nistica has communicated to customers
about the settlement of the lawsuit.

7 (Dkt. No. 223-15 at 2.) With respect to Topic 58, Nistica agreed to prepare Mr. Falquier to testify
8 only about the 3 sales forecasts that were recently created and therefore not produced until June
9 22, 2015, not all sales forecasts that had been produced well before Ms. Bisconti's deposition.

10 (Dkt. No. 223-16; Dkt. No. 223-1 ¶ 4.)

11 Mr. Falquier's deposition occurred on June 26, 2015—the last day of fact discovery per the
12 scheduling order. With respect to Topic 34, Mr. Falquier gave substantial testimony about the
13 timing and content of certain meetings between NTT/NEL and Nistica when the intellectual
14 property—including Finisar's '599 Patent—was discussed, but testified that he did not know the
15 number of communications and exact content of Nistica's communications with NEL about the
16 '599 Patent other than the information that appeared on a presentation produced during discovery,
17 nor did he know how many other meetings or conversations there were about that patent or the
18 other patents-in-suit. (Dkt. No. 223-11.) Mr. Falquier repeatedly responded that Dr. Vengsarkar
19 and Mr. Strasser would be able to answer the patent-specific questions. With respect to Topic 36,
20 Mr. Falquier responded to most questions about whether Nistica has discussed this lawsuit with
21 certain other customers. With respect to Topic 58 and the forecast documents, the deposition
22 questions focused on certain portions that appeared in Japanese. Mr. Falquier provided substantial
23 testimony about the meaning of the forecast spreadsheet. However, Mr. Falquier was unable to
24 explain what the Japanese commentary meant or to answer whether the financial forecasts are sent
25 to Nistica's auditors with or without the Japanese commentary. He noted that Ms. Bisconti would
26 be able to answer that question.

27 Notably, Finisar has already deposed Dr. Vengsarkar and Mr. Strasser, both as fact
28 witnesses and Mr. Strasser was a corporate designee for certain other topics. (See Dkt. Nos. 223-

1 19, 223-20, 223-21.) Both were asked about Nistica’s communications with customers regarding
2 this patent litigation, including whether Nistica informed customers of its intention to settle. In his
3 capacity as 30(b)(6) witness, Mr. Strasser testified in detail about Nistica’s communications with
4 NEL about the ’599 Patent and about Nistica’s communications with customers regarding this
5 litigation.

6 The Court concludes that Mr. Falquier was not adequately prepared to testify about Topic
7 34. It appears that Nistica prepared Mr. Falquier solely to respond to questions about a particular
8 presentation between NTT/NEL and Nistica, rather than preparing him more broadly on the
9 subject of the company’s communications with that third party about the ’599 Patent or other
10 patents-in-suit more generally. Falquier was unable to answer questions about when Nistica and
11 NTT/NEL first discussed Finisar’s patents, besides generally identifying a 4-month timeframe
12 towards the end of 2012. Nor could Falquier testify about what NTT/NEL communicated to
13 Nistica about those patents, aside from information contained in the identified presentation. At
14 bottom, besides echoing the contents of the presentation, Falquier was unable to provide any
15 details about NEL-Nistica communications regarding Finisar’s patents or relevant IP protection
16 and how those communications led to the parties’ agreement to work together. The Court
17 accordingly GRANTS Finisar’s request with respect to Topic 34. However, examination on this
18 topic shall be limited to one hour.

19 As for Topic 36, Nistica’s corporate designees have sufficiently testified regarding the
20 contents of their communications with third-parties, including customers, about this litigation.
21 Specifically, Mr. Falquier sufficiently testified about his own and others’ conversations with
22 certain customers at the inception of this lawsuit and during the course of discovery. He
23 adequately conveyed the content of those conversations. Further, the 30(b)(6) testimony of Mr.
24 Strasser, binding on Nistica, discusses at length conversations with a particular Nistica customer
25 regarding this action, including why Mr. Strasser communicated a particular message. Thus, the
26 Court DENIES Finisar’s request as to Topic 36.

27 With respect to Topic 58, there is no reason for Finisar to take another bite at the apple to
28 question a 30(b)(6) witness about financial forecasts it had in its possession prior to the noticed

1 30(b)(6) depositions. Thus, while Finisar laments Nistica’s attempt to “unilaterally” cabin Mr.
2 Falquier’s testimony to the three recently-produced financial forecasts, this is an entirely fair
3 approach. With respect to the recently-produced forecasts that were the subject of Mr. Falquier’s
4 deposition, Finisar laments that he was unable to explain the meaning of and procedures
5 associated with limited amounts of Japanese commentary on those documents. Nistica urges that
6 the Japanese commentary is minimal and “inconsequential” to the numbers listed in the forecasts,
7 but it does so only in attorney argument without providing any evidentiary basis for this statement.
8 Nevertheless, Finisar has failed to demonstrate why Falquier’s inability to answer questions about
9 the Japanese commentary is problematic. Having failed to do so, the Court cannot conclude that
10 Falquier’s substantial testimony about the forecasts is insufficient. Accordingly, the Court
11 DENIES Finisar’s request for an order compelling further 30(b)(6) designee on Topic 58.

12 **B. Finisar’s Request for an Order Compelling Nistica to Supplement its Responses to**
13 **Discovery Requests to Include Technical Information of Products Still Under**
14 **Development (Dkt. No. 225, 230)**

15 Next, Finisar seeks an order compelling Nistica to provide technical information
16 concerning Accused Products still in early research and development phases. (Dkt. No. 225.)
17 Finisar’s Amended Infringement Contentions identified a number of Nistica’s products series—
18 not just a particular product within the series—as infringing Finisar’s patents, listing over 120
19 specific product numbers as accused devices but also accusing “all revisions, variations, or custom
20 products based on a substantially similar design” as infringing. (Dkt. No. 225-1 at 4-5.) Finisar
21 seeks technical information about all products within the series, including products still in
22 development or only the subject of an offer for sale and including product numbers not
23 specifically identified in its contentions, in response to Interrogatory Nos. 1 and 5, and RFP Nos.
24 11, 19-20, 29-32, 35-37, 39-40, 59-60, 64, and 69-71.

25 Patent Local Rule 3-1 is a discovery device that sets forth the standards for disclosing
26 asserted claims and infringement contentions, and it “takes the place of a series of interrogatories
27 that defendants would likely have propounded had the patent local rules not provided for
28 streamlined discovery.” *Intertrust Techs. Corp. v. Microsoft Corp.*, No. 01-1640 SBA, 2003 WL
23120174, at *1 (N.D. Cal. Dec. 1, 2003) (internal quotation marks and citation omitted). The

1 Rule requires that infringement contentions present “each claim of each patent in suit that is
2 allegedly infringed by each opposing party’ and identify for each asserted claim ‘each accused
3 apparatus, product, device, process, method, act or instrumentality (“Accused Instrumentality”)
4 . . . of which the party is aware.” *Bender v. Freescale Semiconductor, Inc.*, No. 09-1156 PJH
5 (MEJ), 2010 WL 1689465, at *2 (N.D. Cal. Apr. 26, 2010) (citation omitted). The Rule is
6 “designed to require parties to crystallize their theories of the case early in the litigation and to
7 adhere to those theories once they have been disclosed.” *Integrated Circuit Sys., Inc. v. Realtek
8 Semiconductor Co.*, 308 F. Supp. 2d 1106, 1107 (N.D. Cal. 2004).

9 The Rules “place the burden of specifically identifying all accused devices on the
10 plaintiff.” *Infineon Techs. AG v. Volterra Semiconductor Corp.*, No. C 11-6239 MMC (DMR),
11 2012 WL 6184394, at *3 (N.D. Cal. Dec. 11, 2012). This Rule requires “specific identification of
12 particular accused products.” *Oracle Am., Inc. v. Google Inc.*, No. C 10-3561 WHA, 2011 WL
13 4479305, at *2 (N.D. Cal. Sept. 26, 2011); *see also Bender v. Maxim Integrated Prods., Inc.*, No.
14 09-1152 SI, 2010 WL 1135762, at *2 (N.D. Cal. Mar. 22, 2010) (noting that the plaintiff must
15 “compare an accused product to its patents on a claim by . . . basis”). If a party wishes to amend
16 contentions to add additional accused products, it may only do so “by order of the Court upon a
17 timely showing of good cause.” Patent L.R. 3-6.

18 Where products are not specifically named in infringement contentions, courts have denied
19 discovery into those other products even where, as here, the contentions include “reasonably
20 similar” products. *See, e.g., Mediatek, Inc. v. Freescale Semiconductor, Inc.*, No. 11-5341 YGR
21 (JSC), 2013 WL 588760, at *1 (N.D. Cal. Feb. 13, 2013) (denying motion to compel discovery
22 into products that were not specifically identified as accused products under the local rules);
23 *Oracle Am., Inc. v. Google Inc.*, No. C 10—3561 WHA, 2011 WL 4479305, at *2 (N.D. Cal. Sept.
24 26, 2011) (noting that the local patent rules do not “tolerate broad categorical identifications” or
25 “the use of mere representative examples” and rather contentions must disclose “a full list of
26 accused products”); *Kelora Sys., LLC v. Target Corp.*, No. C 11-01548 CW (LB), 2011 WL
27 5444419, at *2 (N.D. Cal. Nov. 9, 2011) (denying discovery as to products not specifically
28 accused in plaintiff’s infringement contentions).

1 Here, Finisar seeks an order compelling Nistica to produce technical specifications
2 (“NSPs”) and bills of material (“BOMs”) for all products in the Accused Series—including
3 products not specifically listed in Finisar’s contentions by name and model number—or, to the
4 extent no such documents exist, to provide a narrative response regarding the technical function of
5 the product in response to a number of RFPs. Nistica has responded to these discovery requests
6 by producing NSPs and BOMs for a number of Accused Products, but not others. In December of
7 2014, Nistica represented that it was producing responsive documents, including NSPs, for both
8 commercial products and those still in the research and development phase. (Dkt. No. 225-3.) By
9 April 2015, Nistica produced further NSPs and BOMs, including those for products in
10 development; several of these were not produced earlier due to technical issues, while the NSP for
11 a particular newly developed product was not in existence at the time of Nistica’s earlier
12 production. (Dkt. Nos. 225-4, 225-5.) As of the filing of Nistica’s response, it has produced NSPs
13 and BOMs for all product numbers accused in Finisar’s contentions and also conducted a
14 reasonable search and produced these documents for other product numbers for materials still in
15 development. In light of *Mediatek*, *Oracle*, and the Patent Local Rules, Nistica has not only met
16 but exceeded its discovery obligations by producing documents for products not specifically listed
17 in Finisar’s contentions.

18 Finisar’s arguments to the contrary are unavailing. First, Finisar laments the scope of
19 Nistica’s search, contending that Nistica limited its search to an engineering database—Omnify—
20 that contains information only about products made or sold, and it should have also searched the
21 files of its engineers and product designers for specifications about products that have not yet
22 reached that stage of development. (See Dkt. No. 230 at 2.) But Finisar does not seek discovery
23 on “abandoned products not in active development” (*id.*), so its request may be overbroad.
24 Moreover, Nistica has clarified that “[e]very new design or idea, even if only on paper and never
25 made or commercialized,” is given a product number in the Omnify database. (Dkt. No. 230 at 2
26 n.2.) Thus, a search of the Omnify database is not limited to made or sold products, but rather
27 encompasses all products at every stage of development.

28 Finisar’s reliance on *Advanced Micro Devices, Inc. v. Samsung Electronics Co.*, No. 08-

1 cv-986-SI, 2009 WL 1834147, at *3 (N.D. Cal. June 24, 2009), is misplaced. There, the court
2 ordered the defendant to produce discovery on products identified during discovery that were
3 substantially similar to those accused in plaintiff's infringement contentions. *Id.* at *3. But in that
4 case, not only was there a showing that the products were substantially similar, the plaintiff had
5 shown that it only discovered the new products during a recent deposition. *Id.* Finisar makes no
6 such showing here. At bottom, if Finisar wishes to obtain discovery on these other products, it
7 must demonstrate good cause to amend its infringement contentions. It has not done so, and the
8 Court therefore DENIES Finisar's request for an order compelling Nistica to supplement its
9 responses to requests for production of documents pertaining to technical details of Accused
10 Products.

11 The Court reaches the same conclusion with respect to Interrogatory Nos. 1 and 5.
12 Nistica's responses to these interrogatories include sufficient responses for all product numbers
13 accused on infringement in Finisar's contentions. Absent a showing of good cause to amend, the
14 Court DENIES Finisar's request for an order compelling Nistica to supplement its responses to
15 include information about other products not specifically accused therein.

16 **C. Nistica's Request to Overcome Finisar's Claim that Expert Witness Keren Bergman**
17 **has a Conflict of Interest (Dkt. No. 231)**

18 Nistica seeks an order overruling Finisar's objection to Professor Keren Bergman,
19 Chairman of the Electrical Engineering Department at Columbia University, Nistica's technical
20 expert witness. (Dkt. No. 231.)

21 1. Background

22 a. *Issues in the Case*

23 Finisar accuses a number of Nistica products of infringing six of Finisar's patents directed
24 at devices and components used in optical communications networks. The products that practice
25 the six patents-in-suit include several types of line cards products used in optical devices. Fact
26 discovery closed on June 26, 2015. (*See* Dkt. No. 214 at 2.) The deadline for expert reports is
27 July 27, 2015. (*Id.*)
28

b. *Dr. Bergman’s Relationship with Finisar*

The parties dispute the scope of Professor Bergman’s discussions with Finisar. From Nistica’s perspective, it was minimal. Professor Bergman’s declaration indicates that she had only a 30-minute introductory phone call regarding whether she had time or interest in serving as Finisar’s expert in another case, but she was not hired and did not sign a confidentiality agreement. (*See* Dkt. No. 231-3 ¶¶ 3-7.) Professor Bergman avers that Finisar did not provide any confidential information or legal strategy, and while Finisar sent her copies of certain patents, she did not do any analysis of Finisar’s products. (*Id.* ¶ 7.)

Finisar submits that its outside counsel, David Radulescu and Tigran Vardanian, consulted with Dr. Bergman on Finisar’s behalf in connection with prior patent litigation involving the same technology at issue in this case—*i.e.*, WSS products. It is undisputed that Finisar never retained Dr. Bergman as an expert in the cases, *Finisar Corp. v. Cheetah Omni, LLC*, No. 2:11-cv-15526 (E.D. Mich.), and *Cheetah Omni LLC v. Alcatel-Lucent USA Inc.*, No. 6:11-cv-00390 (E.D. Tex.) (together, the “*Cheetah* cases”). However, Mr. Radulescu avers that he had a 42-minute phone call with Dr. Bergman on July 31, 2012 to discuss the expert work needed in the *Cheetah* cases. (Dkt. No. 235-6 ¶ 5.) Mr. Radulescu avers “[t]o the best of [his] recollection” that he “disclosed attorney work product and confidential Finisar information to Dr. Bergman during this call, including information about Finisar technology and Finisar’s invalidity strategy[.]” (*Id.*) Mr. Radulescu maintains that he discussed Dr. Bergman’s possible role as an expert and discussed sending her an engagement agreement. (*Id.*) Mr. Radulescu avers that on August 1, 2012, he emailed Dr. Bergman the patents-in-suit in the *Cheetah* cases for her review. (*Id.* ¶ 6.) Mr. Radulescu believes that another attorney at his then-law firm drafted a consulting agreement and emailed it to Dr. Bergman. (*Id.* ¶ 7.) Mr. Radulescu further avers that he had a second telephone call with Dr. Bergman during which “confidential and attorney work product information was discussed[.]” though he has no record of such call.¹ (*Id.* ¶ 8.)

¹ In fact, no emails or other records of these discussions are attached to Mr. Radulescu’s declaration. He explains that they took place while he was associated with a different law firm; he has sought the documents from that firm, but has not received any. (Dkt. No. 235-6 ¶ 3.)

1 c. *Dr. Bergman's Relationship with Nistica*

2 Finisar also seeks to disqualify Dr. Bergman based on her relationship with Nistica,
3 including her friendship with Nistica's CEO, Dr. Vengsarkar, and her "research and consulting
4 ties" with the company. (Dkt. No. 236 at 2.)

5 With respect to the Bergman-Vengsarkar relationship, Finisar cites a 2008 email in which
6 Mr. Vengsarkar described running into Dr. Bergman, noting that he agreed to visit her lab, get an
7 overview of her work, and explore the possibility of collaboration. (Dkt. No. 235-10 at 2.) Finisar
8 also cites emails from 2011 indicating that Dr. Bergman referred students to Nistica for possible
9 jobs or internships. (Dkt. No. 235-12.) In addition, in 2013 Nistica's Director of Sales proposed
10 giving Dr. Bergman a discount on one of Nistica's WSS products for use in her lab because she
11 was Vengsarkar's friend. (Dkt. No. 235-14.) Dr. Bergman, for her part, avers that Dr. Vengsarkar
12 is a professional acquaintance and the two interact at technical conferences. (Dkt. No. 231-3
13 ¶ 12.)

14 With respect to Dr. Bergman's involvement in Nistica's research, Finisar highlights emails
15 that it contends evidence a much deeper relationship based on several examples. First, Finisar
16 points to Dr. Bergman's role as co-leader of the Center for Integrated Access Networks ("CIAN"),
17 of which Nistica is an industry affiliate. (*See* Dkt. No. 235-14.) Second, Finisar highlights Dr.
18 Bergman's "extensive" discussions about Nistica's WSS products with the company's VP of Sales
19 and Marketing, Mr. Falquier. At a CIAN meeting in January 2012, the two discussed Nistica's
20 WSS; Mr. Falquier wrote that Dr. Bergman had expressed interest in learning more about the
21 product. (Dkt. No. 235-16 at 2.) Dr. Bergman further avers that "[t]here was some discussion in
22 the past about joint research, but that did not occur." (*Id.*) Lastly, in 2013 Nistica sold Dr.
23 Bergman's research laboratory certain WSS and WSS-related product. (Dkt. No. 235-14.) Dr.
24 Berman signed a non-disclosure agreement in order to have access to more detailed information
25 from Nistica about the product. (*Id.*)

26 d. *Nistica's Disclosure of its Expert & the Instant Motion*

27 Nistica disclosed Professor Bergman as one of its experts on June 30, 2015. Pursuant to
28 the parties' Stipulated Protective Order ("Protective Order"), on July 7, 2015 Finisar objected to

1 Professor Bergman having access to Finisar’s confidential information. (*See* Dkt. No. 140 § 8(b).)
2 Under the terms of the Protective Order, Professor Bergman is therefore prohibited from viewing
3 materials marked Confidential—Attorneys’ Eyes Only or HIGHLY CONFIDENTIAL—
4 OUTSIDE ATTORNEYS’ EYES ONLY “until the matter is resolved by agreement between the
5 parties in question or until decided by the Court.” (*Id.*) After what appears to be some limited
6 meet-and-confer efforts, Nistica brought the matter to the Court’s attention, and Finisar filed an
7 opposition.

8 2. Legal Standard

9 “Federal courts have the inherent power to disqualify expert witnesses to protect the
10 integrity of the adversary process, protect privileges that otherwise may be breached, and promote
11 public confidence in the legal system.” *Hewlett-Packard Co. v. EMC Corp.*, 330 F. Supp. 2d
12 1087, 1092 (N.D. Cal. Aug. 10, 2004) (citations omitted). But disqualification is a “drastic
13 measure” that courts should impose only “hesitantly, reluctantly, and rarely.” *Id.* (citation
14 omitted). There is no brightline rule for determining whether an expert should be disqualified, but
15 courts generally find disqualification warranted “based on a prior relationship with an adversary if
16 (1) the adversary had a confidential relationship with the expert and (2) the adversary disclosed
17 confidential information to the expert that is relevant to the current litigation.” *Id.* (citation
18 omitted); *see also Oracle Corp. v. DrugLogic, Inc.*, No. C-11-00910-JCS, 2012 WL 2244305, at
19 *5 (N.D. Cal. June 15, 2012) (citation omitted). The party seeking to disqualify the expert bears
20 the burden of establishing these factors. *Hewlett-Packard*, 330 F. Supp. 2d at 1092. However, if
21 only one factor is present, disqualification is inappropriate. *Id.* (citation omitted). “In addition to
22 these two factors, the Court also should consider whether disqualification would be fair to the
23 affected party and would promote the integrity of the legal process.” *Id.*

24 3. Discussion

25 Dr. Bergman’s alleged relationship with Nistica is not grounds for the drastic measure of
26 disqualification, though it may provide fertile ground for cross-examination at trial on the question
27 of bias. The concern disqualification seeks to address is a potential expert’s use of the *adversary’s*
28 confidential information, such as legal strategy—information to which the party that retained the

1 expert otherwise would not have access. Thus, that Dr. Bergman signed an NDA with Nistica or
2 has had discussions with Mr. Falquier about Nistica’s WSS products is irrelevant to the analysis.
3 Nor has Finisar persuaded the Court that Dr. Bergman’s relationship with Dr. Vengsarkar is so
4 close that it will either color her expert testimony in this case or will cause her to share Finisar’s
5 highly confidential source code directly with him, as the examples Finisar identifies do not
6 establish anything other than professional courtesy and a successful working relationship—just as
7 Dr. Bergman avers. In short, no deeper analysis of Dr. Bergman’s relationship with Nistica is
8 required; it does not create a conflict that requires prohibiting Dr. Bergman from viewing Finisar’s
9 confidential information. However, the Court will address in detail Finisar’s claim that Dr.
10 Bergman should be disqualified due to her prior relationship with Finisar.

11 a. *Confidential Relationship*

12 The Court turns to the first factor: whether Finisar maintained a confidential relationship
13 with Dr. Bergman. “The critical inquiry with regard to this factor is not whether there was a
14 formal agreement between the adversary and the expert, but rather whether there was a
15 relationship such that the adversary would ‘reasonably . . . expect that any communication would
16 be maintained in confidence.’” *CreAgri, Inc. v. Pinnacliffe Inc.*, No. 5:11-CV-06635-LHK, 2013
17 WL 6700395, at *3 (N.D. Cal. Dec. 18, 2013) (quoting *Hewlett-Packard*, 330 F. Supp. 2d at
18 1093). When making this determination, courts consider a number of factors, including the length
19 of the relationship and number of meetings between the adversary and the expert, whether the
20 expert was retained to assist in litigation, whether there was a formal confidentiality agreement in
21 place, whether the expert was paid a fee, and whether the expert derived any of her specific ideas
22 from work done under the direction of the retaining party. *See CreAgri, Inc.*, 2013 WL 6700395,
23 at *3; *Hewlett-Packard*, 330 F. Supp. 2d at 1093. No single factor is dispositive. Thus, there is no
24 per se rule that an expert must be disqualified merely because she signed a confidentiality
25 agreement with the adversary. *See CreAgri, Inc.*, 2013 WL 6700395, at *3 (citation omitted);
26 *Hewlett-Packard*, 330 F. Supp. 2d at 1094. Ultimately, disqualification depends not on whether
27 there is a confidentiality agreement in place, but whether the expert actually began reviewing
28 confidential factual information and theories concerning litigation. *See Hewlett-Packard*, 330 F.

1 Supp. 2d at 1093. The party seeking to disqualify the expert bears the burden of establishing the
2 existence of a confidential relationship. *CreAgri, Inc.*, 2013 WL 6700395, at *3 (citing *Mayer v.*
3 *Dell*, 139 F.R.D. 1, 3 (D.D.C. 1991)).

4 While not dispositive, at the time of the alleged disclosures, no formal confidentiality
5 agreement governed the relationship between Finisar and Dr. Bergman, which weighs against
6 finding a confidential relationship here. While Mr. Radulescu avers that he prepared and sent a
7 consulting agreement to Dr. Bergman, he is unable to state with certainty whether one was even
8 sent to her, and he nowhere declares that she executed one. (*See* Dkt. No. 235-6.) Thus, Finisar
9 has not presented evidence to rebut Dr. Bergman’s assertion that there was no confidentiality
10 agreement in place. At bottom, Finisar seeks to disqualify Dr. Bergman based on one 42-minute
11 telephone conversation with Mr. Radulescu about possibly serving as Finisar’s expert in the
12 *Cheetah* cases. At best, this relationship spans two phone calls, which is not the type of
13 continuing relationship that generates a reasonable belief in a confidential relationship. *Cf.*
14 *CreAgri*, 2013 WL 6700395, at *4; *Oracle*, 2012 WL 2244305. If anything, it appears that this
15 was a mere introductory call to determine whether Dr. Bergman was interested in serving as
16 Finisar’s expert rather than any in-depth, substantive analysis of claims and defenses in the
17 *Cheetah* cases. Thus, the Court concludes that Finisar has not met its burden of demonstrating
18 that it reasonably believed it had a confidential relationship with Dr. Bergman.

19 b. *Confidential Information*

20 Even if the Court were to find a reasonable basis for Finisar to believe it had a confidential
21 relationship with Dr. Bergman, Finisar likewise has not met its burden of showing that it disclosed
22 confidential information relevant to this case during the course of that relationship. Confidential
23 information for the purposes of expert witness disqualification is information of “particular
24 significance.” *Hewlett-Packard*, 330 F. Supp. 2d at 1094 (citation omitted). Specifically, “courts
25 inquire whether the adversary disclosed confidential information to the expert that is relevant to
26 the current litigation.” *Kane v. Chobani, Inc.*, No. 12-02425, 2013 WL 399107, at *6 (N.D. Cal.
27 Aug. 2, 2013). Confidential communications may include discussions related to litigation, such as
28 strategy, types of experts and their planned roles, and the strengths and weaknesses of each side’s

1 case. *Hewlett-Packard*, 330 F. Supp. 2d at 1094. However, “[c]ourts have held that technical
2 information as opposed to legal advice is not considered confidential” for the purposes of this
3 analysis. *CreAgri*, 2013 WL 6700395, at *5 (citation omitted). The party seeking disqualification
4 bears the burden of demonstrating that confidential information was exchanged by “point[ing] to
5 *specific and unambiguous disclosures* that if revealed would prejudice the party.” *Hewlett-*
6 *Packard*, 330 F. Supp. 2d at 1094 (emphasis added) (citations omitted).

7 Finisar has not done so here. Finisar relies exclusively on the Radulescu Declaration’s
8 general and conclusory assertion that Mr. Radulescu disclosed “information about Finisar’s
9 technology and Finisar’s invalidity strategy” during the course of two phone calls with Dr.
10 Bergman. (Dkt. No. 235-6 ¶¶ 5-6.) While Mr. Radulescu has sufficiently averred that the
11 products at issue in the *Cheetah* cases also practice the patents-in-suit here (*id.* ¶ 2), he provides no
12 details about what the disclosures about those products were, which is insufficient to meet
13 Finisar’s burden. Indeed, district courts have declined to disqualify experts based on general
14 claims that confidential litigation strategy was disclosed in phone calls without “specific details of
15 such discussion[,]” especially in complex patent cases. *See, e.g., Hewlett-Packard*, 330 F. Supp.
16 2d at 1096; *see also Mays v. Reassure Am. Life. Ins.*, 293 F. Supp. 2d 954, 957 (D. Ark. 2003)
17 (“[I]n the 60 to 90 minute meeting, it is highly unlikely that there was any detailed or involved
18 discussion concerning litigation strategies, the strengths and weaknesses of each side, the
19 witnesses to be called, the types of experts to be retained and anticipated defenses.”). To the
20 contrary, reading the Radulescu Declaration as a whole supports exactly what Dr. Bergman herself
21 avers: that the phone call was merely meant to inquire into *whether* she was interested or available
22 to serve as Finisar’s expert. While Mr. Radulescu avers that he and Dr. Bergman discussed the
23 scope of a potential consultancy agreement, this does not rise to the level of confidential
24 information that makes disqualification appropriate. Likewise, that he emailed Finisar patents to
25 Professor Bergman is of no consequence, as the patents are publicly available. In short, Finisar
26 has not persuaded the Court that Mr. Radauescu and Dr. Bergman had confidential conversations
27 regarding Finisar’s products. Because Finisar has not met its burden of demonstrating that
28 confidential information was disclosed, disqualification is inappropriate. *See Hewlett-Packard*,

1 330 F. Supp. 2d at 1093.

2 c. *Fundamental Fairness & Policy Concerns*

3 The third factor—fundamental fairness and prejudice—compels the same result. Here, the
4 Court considers whether other experts would be available if the expert at issue were disqualified
5 and whether disqualification at this stage of litigation will likely disrupt judicial proceedings. *See*
6 *id.* at 1095. “Consideration of prejudice is especially appropriate at late stages in the litigation, at
7 which time disqualification is more likely to disrupt the judicial proceedings.” *Life Tech. Corp. v.*
8 *Biosearch Tech., Inc.*, No. 12-0852, 2012 WL 1604710, at *10 (N.D. Cal. May 7, 2012).

9 On the one hand, Finisar provided notice of its objection to Dr. Bergman immediately
10 upon learning that Nistica was offering her as an expert. Thus, although the deadline for expert
11 reports is fast approaching, that Nistica did not disclose Dr. Bergman until weeks of the deadline
12 for expert reports should not count against Finisar. On the other hand, while Nistica apparently
13 has other experts in its lineup, it clearly seeks to rely on Dr. Bergman for some purpose and would
14 need to search for, retain, and bring up to date a new expert if Dr. Bergman were disqualified;
15 because this likely would require pushing back the deadlines for expert reports (and, like a judicial
16 domino effect, the deadlines for dispositive motions and trial), disqualification would disrupt the
17 judicial proceedings, causing prejudice. *See Hewlett-Packard*, 330 F. Supp. 2d at 1094; *Life Tech.*
18 *Corp.*, 2012 WL 1604710, at *10.

19 Finally, policy concerns weigh in favor of allowing Professor Bergman to serve as
20 Nistica’s expert over Finisar’s objection. *See Ziptronix, Inc. v. Omnivision Techs., Inc.*, No. C-10-
21 05525 SBA (EDL), 2013 WL 146413, at *3 (N.D. Cal. Jan. 14, 2013) (noting that policy concerns
22 are relevant to the analysis to avoid creating “troublesome incentives for both experts and the
23 retaining party” and to “promot[e] public confidence in the legal system” (citations omitted)).
24 What is more, disqualification in this scenario would greatly hamper all experts’ ability to serve as
25 expert witnesses because a party could use a mere exploratory phone call that resulted in no
26 contract as a purported conflict. As other courts have made clear, “[t]his concern is especially
27 important in high-technology patent infringement cases, in which the courts, as well as the public,
28 rely on experts to explain complicated technologies.” *Hewlett-Packard*, 330 F. Supp. 2d at 1098.

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

Public policy therefore dictates that introductory conversations with an adversary's attorneys regarding prior litigation does not create a conflict of interest that warrants the expert's disqualification.

* * *

For each of these reasons, the Court GRANTS Nistica's request to overcome Finisar's claim that Professor Bergman has a conflict of interest. It follows that Professor Bergman may view Finisar's highly confidential material subject to the Protective Order.

CONCLUSION

For the reasons discussed above, the Court GRANTS IN PART and DENIES IN PART Finisar's request for an order compelling further 30(b)(6) testimony. Specifically, Nistica must identify and make available for a one-hour deposition a corporate designee on Topic 34 as set forth above. If the parties cannot agree on a location for the deposition, it shall take place in San Francisco. The Court DENIES Finisar's request for further 30(b)(6) testimony on Topic 36.

The Court also DENIES Finisar's request for an order compelling Nistica to supplement its discovery responses to provide technical information about products not specifically accusing in its infringement contentions. This denial is without prejudice to Finisar renewing the request after demonstrating good cause to amend its contentions to accuse additional products.

Finally, the Court GRANTS Nistica's motion to overcome Finisar's claim that Nistica's proposed expert witness, Keren Bergman, has a conflict of interest.

This Order disposes of Docket Nos. 223, 225, 230, and 231.

IT IS SO ORDERED.

Dated: July 21, 2015


JACQUELINE SCOTT CORLEY
United States Magistrate Judge