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**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA**

PRESIDIO COMPONENTS, INC.,
Plaintiff,
v.
AMERICAN TECHNICAL CERAMICS
CORPORATION,
Defendant.

AMERICAN TECHNICAL CERAMICS
CORPORATION,
Counterclaimant,
v.
PRESIDIO COMPONENTS, INC.,
Counterdefendants.

Civil No. 08cv335 IEG (NLS)
**ORDER GRANTING IN PART AND
DENYING IN PART AMERICAN
TECHNICAL CERAMICS
CORPORATION’S MOTION FOR
LEAVE OF COURT TO ALLOW
DEPOSITIONS OF PRESIDIO’S
EXPERT WITNESSES**

[Doc. No. 70]

I. INTRODUCTION

This is a patent infringement case involving U.S. Patent No. 6,816,356 (“The ‘356 patent”). Presidio Components, Inc. (“Presidio”) filed suit against American Technical Ceramics Corporation (“ATC”) alleging infringement of the ‘356 patent. [Doc. No. 1 at ¶ 10.] ATC filed a counterclaim alleging, inter alia, tortious interference with contractual relations. [Doc. No. 10 at pp. 11-12.]

1 Defendant/Counterclaimant ATC filed a Motion for Leave of Court to Allow Depositions of four
2 expert witnesses designated by Plaintiff/Counterdefendant Presidio. [Doc. No. 70.] Because ATC has
3 already taken more than ten (10) depositions in this case, Rule 30 requires ATC to obtain permission
4 from either Presidio or the Court to take any additional depositions. Fed. R. Civ. P. 30(a)(2)(A)(i). In
5 addition to seeking leave to take the expert depositions, ATC also requests that the expert discovery
6 deadline and deadline for filing summary judgment motions be extended in order for ATC to take the
7 requested depositions and prepare summary judgment motions after hearing the experts' testimony.¹ *Id.*
8 at 1. Finally, one of the expert depositions that ATC seeks leave to take would be a second deposition
9 of Dr. Ewell. Presidio opposes ATC's motion. [Doc. No. 72.]

10 **II. RELEVANT FACTS**

11 The original scheduling order applicable to this case was filed September 20, 2007.² [*See* Case
12 No. 07cv893-IEG, Doc. No. 22.] On June 2, 2008, the parties filed a Joint Motion to Amend the
13 Scheduling Order to extend all remaining deadlines in the case for thirty days. [Doc. No. 13.] On June
14 3, 2008, the Court issued a Scheduling Order Regulating Discovery and Other Pretrial Proceedings in
15 this case. [Doc. No. 14.] On September 26, 2008, the parties filed a Joint Motion for Extension of Time
16 to Complete Discovery and to Amend the Scheduling Order, asking to extend remaining deadlines for a
17 period of seven weeks. [Doc. No. 35.] On October 1, 2008, the Court granted the joint motion and
18 issued a First Amended Scheduling Order. [Doc. No. 37.] Then, on December 16, 2008—after the
19 conclusion of fact discovery—the parties filed a third joint motion, this time asking that the Court again
20 modify the scheduling order and extend pretrial discovery deadlines so that they could complete expert
21 discovery. [Doc. No. 64.] The Court granted the motion and extended the deadline for submitting
22 expert reports until January 23, 2009, the deadline for submitting supplemental expert reports until
23 February 16, 2009, and the expert discovery cutoff until March 9, 2009. [Doc. No. 65.] On February
24 20, 2009, ATC filed this motion for leave to depose four of Presidio's expert witnesses. [Doc. No. 70.]

26 ¹ATC filed its Motion for Summary Judgment on March 16, 2009 [Doc. No. 77]. The request to
27 extend the summary judgment motion deadline is denied as moot.

28 ²After a Claims Construction hearing and Order Construing Claims, the parties jointly moved to
dismiss the first filed case and agreed that all proceedings in that case should apply in this second filed
case. The court entered an order to that effect. [Case No. 07cv893-IEG, Doc. No. 66.]

1 To date, ATC has taken one expert deposition (Dr. Godshalk) on claim construction issues,
2 which pursuant to Patent L.R. 4.3 does not count against the presumptive ten deposition limit set by
3 Rule 30(a)(2)(A)(i), and eleven other depositions. *See* Fed. R. Civ. P. 30(a)(2)(A)(i), Mem Ps&As at 5.
4 Presidio, on the other hand, has taken at most eight depositions, including experts, and argues that it
5 purposely “tailored its discovery strategy” to ensure that it would not exceed the presumptive ten
6 deposition limit. Opp’n at 5.

7 ATC seeks the Court’s permission to depose the following four expert witnesses designated by
8 Presidio: (1) Dr. Wayne Huebner, technical expert; (2) Dr. Gary Ewell, technical expert; (3) Mr. Glenn
9 Newman, damages expert; and (4) Mr. Richard Killworth, Esq., patent prosecution practice and
10 procedure expert. Memo Ps&As at 2. ATC, likewise, has designated a damages expert, a patent
11 prosecution and procedure expert, and a technical expert. *Id.* Presidio elected to forego the deposition
12 of one of ATC’s three experts so that it would not run afoul of the ten deposition limit. Opp’n at 5, n. 3.

13 **III. LEGAL STANDARDS**

14 Federal Rule of Civil Procedure 26 governs the scope and limits of all discovery and is
15 particularly instructive as to how parties should plan for discovery. *See* Fed. R. Civ. P. 26(a)(2),(b),(f).
16 Rule 26 requires the parties to confer and develop a discovery plan “stat[ing] the parties’ views and
17 proposals on . . . what changes should be made in the limitations on discovery imposed under these
18 rules . . .” Fed. R. Civ. P. 26(f)(3)(E).

19 Rule 30 governs when a party needs permission to take a deposition and provides in relevant
20 part: “A party must obtain leave of court, and the court must grant leave to the extent consistent with
21 Rule 26(b)(2): if the parties have not stipulated to the deposition and. . .the deposition would result in
22 more than 10 depositions being taken under this rule or Rule 31 . . . [or] the deponent has already been
23 deposed in the case” Fed. R. Civ. P. 30(a)(2)(A)(i-ii). The Advisory Committee Note to Rule
24 30(a)(2)(A) guides counsel for the parties to consider enlarging or reducing the number of depositions
25 permitted by Rule 30 at the initial planning meeting and again at scheduling conferences in order to
26 “eliminat[e] the need for special motions” such as the present motion. Fed. R. Civ. P. 30(a)(2)(A)
27 advisory committee notes, 1993 Amendments.

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1 When considering a motion for leave to take more than ten depositions, the Court must grant
2 leave to the extent consistent with Rule 26(b)(2), which provides pertinent part:

3 [T]he court must limit the frequency or extent of use of the discovery methods otherwise
4 allowed by these rules or by local rule if it determines that: (i) the discovery sought is
5 unreasonably cumulative or duplicative, or can be obtained from some other source that
6 is more convenient, less burdensome, or less expensive; (ii) the party seeking discovery
7 had ample opportunity to obtain the information by discovery in the action; or (iii) the
burden or expense of the proposed discovery outweighs its likely benefit, considering the
needs of the case, the amount in controversy, the parties' resources, the importance of the
issues at stake in the action, and the importance of the discovery in resolving the issues.
8 Fed. R. Civ. P. 26(b)(2)(c).

8 **IV. DISCUSSION**

9 ATC argues that Patent L.R. 4.3³ and the Case Management Order in this action exempt expert
10 depositions from the ten deposition limit prescribed by Fed. R. Civ. P. 30. *See* Memo Ps&As at 5. In
11 support of its argument, ATC quotes a portion of the Patent Local Rule that provides: "Fed. R. Civ. P.
12 30 applies to depositions taken pursuant to Patent L.R. 4.3, except as to experts." As Presidio points out,
13 the portion of the Patent Local Rule quoted by ATC must be read in conjunction with the rest of the rule
14 which allows for the further deposition of a claims construction expert "on all substantive issues." *Id.*
15 Thus, as Presidio contends, the Patent Local Rule could be read to provide an exception only to that
16 portion of Federal Rule 30 that precludes a witness from being deposed more than once without leave of
17 court. *See* Fed. R. Civ. P. 30(a)(2)(A)(ii); Opp'n at 6. On the other hand, Patent L.R. 4.3 could be read
18 to exclude expert witnesses from the presumptive ten deposition limit of Rule 30, particularly in light of
19 the complexity of many patent cases and the absence of case law or commentary to Rule 30 itself as to
20 whether expert witnesses are included in the ten deposition limit. *See* Opp'n at 6-7.⁴ The Court need
21 not decide the issue here. Rather, it need only follow Rule 30(b)(2)'s directive that leave to take
22 additional depositions be granted to the extent consistent with Rule 26(b)(2).

23
24 ³Patent L.R. 4.3 Completion of Claim Construction Discovery: ". . . Fed. R. Civ. P. 30 applies to
25 depositions taken pursuant to Patent L.R. 4.3, except as to experts. An expert witness identified in a
26 party's Joint Hearing Statement pursuant to Patent L.R. 4.2.c, may be deposed on claim construction
issues. The identification of an expert witness in the Joint Hearing Statement may be deemed good
cause for a further deposition on all substantive issues." Patent L.R. 4.3.

27 ⁴Expert depositions are governed by Fed. R. Civ. P. 26(b)(4)(A) which provides in pertinent part:
28 "A party may depose any person who has been identified as an expert whose opinions may be presented
at trial" The ten deposition limit in Rule 30(a)(2)(A)(i), however, is directed to depositions taken
under Rule 30 and 31; not depositions of experts taken under Rule 26(b)(4). Expert depositions may or
may not be subsumed in Rule 30(a)(1)'s broad reference to "any person."

1 **Depositions of Dr. Huebner, Mr. Newman, and Mr. Killworth**

2 ATC argues that the discretionary factors identified in Rule 26(b)(2) support a decision granting
3 it leave to take the depositions of Presidio’s four designated expert witnesses. Memo Ps&As at 6-8. In
4 support of its argument, ATC claims that: (1) the experts’ opinions and the bases for those opinions are
5 not discoverable from any other source; (2) expert discovery only opened on February 17, 2009,
6 therefore, ATC has not had an opportunity to obtain the information it now seeks; and (3) the resolution
7 of this case will turn on the subjects Presidio’s experts testify about, thus, without the opportunity to
8 depose these witnesses ATC will be denied its right to a fair trial. *Id.* at 7-8.

9 ATC is mistaken that the expert’s opinions and bases therefore are not otherwise discoverable.
10 Rule 26(a)(2)(B) requires that each of Presidio’s testifying experts prepare and submit a complete and
11 detailed report stating the testimony that they plan to present at trial, as well as the bases for that
12 testimony. Accordingly, the opinions of these experts should already be known to ATC. Rule 26(b)(4)
13 does permit depositions of testifying experts after the expert’s report is prepared, but the purpose of this
14 rule is to reduce the length of expert depositions, or ideally, entirely eliminate the need to take an
15 expert’s deposition. *See* Fed. R. Civ. P. 26(a)(2) advisory committee notes, 1993 Amendments.

16 On the other hand, in cases where expert testimony is central to the claims, such as in the present
17 case, expanded discovery of expert trial witnesses often will result in better cross-examination and
18 rebuttal at trial. *Id.* at 26(b)(4) advisory committee notes, 1993 Amendments. Depositions of expert
19 witnesses has become standard practice in most courts. *See* Fed. R. Civ. P. 26(b)(4)(a) advisory
20 committee notes, 1993 Amendments. Allowing depositions of Dr. Huebner, Mr. Newman, and Mr.
21 Killworth would be neither unreasonably cumulative nor duplicative since ATC has not deposed any of
22 these expert witnesses, and no other experts have testified on the subjects that these experts will testify
23 about. *See* Fed. R. Civ. P. 26(b)(2). In addition, Presidio has not offered any evidence that any of the
24 requested depositions would be unreasonably cumulative or duplicative, or could be obtained from a
25 more convenient and less burdensome source.

26 Though it is true that ATC could not depose Presidio’s designated experts before each expert’s
27 written report was prepared, ATC is incorrect in its assertion that “expert discovery only opened . . . on
28 February 17, 2009.” Memo Ps&As at 7. Presidio’s initial expert reports on infringement and damages

1 were due on January 23, 2009. *See* Amended Scheduling Order [Doc. No. 65]. Accordingly, ATC
2 could have noticed these depositions in January when the initial expert reports were submitted.
3 Moreover, when the parties sought the third modification to the scheduling order on December 16, 2008,
4 ATC had taken ten depositions and was well aware of the anticipated number of expert reports and their
5 corresponding due dates. Memo Ps&As at 4, Ex. A. Thus, it is misleading for ATC to argue the “issue
6 of expert depositions only became ripe now” and “could not have brought it to the Court’s attention
7 earlier.” *Id.* at 4.

8 Particularly troubling is ATC’s statement that “it saw no need to engage in hypothetical
9 discussions with Presidio regarding the presumptive 10-deposition limit” until the eve of the case’s
10 discovery deadline. *Id.* at 2. In fact, such discussions are exactly what the rules governing discovery
11 anticipate. Rule 16 states that provisions to modify the number or length of depositions permitted under
12 the rules should be considered before the initial scheduling order is issued. *See* Fed. R. Civ. P. 16
13 advisory committee notes, 1993 Amendments. In fact, the objective of Rule 30 is to highlight the
14 obligation of counsel to develop a “mutual cost-effective plan for discovery in the case.” Fed. R. Civ.
15 P. 30 advisory committee notes, 1993 Amendments. “Consideration should normally be given at the
16 planning meeting of the parties under Rule 26(f) and at the time of a scheduling conference under Rule
17 16(b) as to enlargements or reductions in the number of depositions, eliminating the need for special
18 motions.” *Id.* ATC, as the party requesting more depositions, should have raised the issue with Presidio
19 or the Court as soon as it became aware of the strong likelihood that this case would require more than
20 ten depositions. However, it is unlikely the depositions would go forward without a court order given
21 Presidio's view of the ten deposition limit. Therefore, the Court cannot conclude ATC had ample
22 opportunity to obtain the information.

23 Despite ATC’s failure to appropriately plan for and time discovery in this case, when
24 considering the need for expert discovery in light of the principles articulated in Rule 26(b)(2), the likely
25 benefit of the requested discovery outweighs the burden or expense of going forward with the
26 depositions primarily because of the importance of expert testimony in patent cases. “Rule 26(b)(4) was
27 designed to permit the parties to prepare adequately for cross-examination prior to trial and to avoid any
28 surprises or other delays during the trial.” *Weekley v. Transcraft, Inc.*, 113 F.R.D. 683, 684 (1987).

1 Furthermore, because the expense of taking these expert depositions is borne by the party seeking
2 discovery—ATC—the burden on Presidio is less critical than ATC's need for the depositions. *See Fed.*
3 *R. Civ. P. 26(b)(4)(C)(i) advisory committee notes, 1993 Amendments.* After fully considering the
4 criteria in Rule 26(b)(2) and the circumstances of the case, permitting a limited number of specified
5 expert depositions is consistent with the principles stated in the rule.

6 **Second Deposition of Dr. Ewell**

7 Rule 30(a)(2)(A)(ii) requires a party to obtain leave of court before deposing a person that has
8 already given a deposition in the case. Absent a showing of good cause, generally the court will not
9 require a witness to appear for another deposition. *See Cuthbertson v. Excel Indus., Inc.*, 179 F.R.D.
10 599, 604-605 (D. Kan. 1998) (quoting *Sentry Ins. v. Shivers, et. al.*, 164 F.R.D. 255 (D. Kan. 1996)).
11 ATC is requesting leave to depose Presidio's expert, Dr. Ewell, a second time. Reply at 6.⁵

12 ATC deposed Dr. Ewell on August 1, 2008, and the main topic of the deposition was the
13 declaration he submitted in opposition to ATC's motion for summary judgment. Opp'n at 4. Now ATC
14 wants to depose Dr. Ewell in connection with the rebuttal report he recently submitted regarding validity
15 of the '356 patent. Memo Ps&As at 1. ATC argues that it should not be foreclosed from taking Dr.
16 Ewell's deposition a second time because additional depositions of expert witnesses are permitted when
17 a deposition is taken in consideration of a subsequent expert report. *Id.* at 6. ATC cites to *Ice Corp. v.*
18 *Hamilton Sundstrand Corp.*, 2007 U.S. District LEXIS 39699 *1, (D. Kan. May 30, 2007), as support
19 for its position. *Ice Corp.*, however, involved facts quite different to those at issue here. In *Ice Corp.*,
20 the expert witness submitted his initial report on January 15, 2007, and was deposed April 4, 2007. *Id.*
21 On April 16, 2007, the expert submitted a supplemental report containing new opinions not stated in the
22 January report and not the subject of questioning at his deposition. *Id.* at *3-4. In contrast, Dr. Ewell's
23 rebuttal report addresses the '356 patent—the same subject about which he gave a declaration and
24 deposition previously. *See Doc. No. 23, Ex. 4; see also Doc. No. 31.*⁶

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27 ⁵This is not a request by ATC for a "further deposition" of Dr. Ewell pursuant to Patent L.R. 4.3.
28 Dr. Ewell was not designated and did not give a deposition as a claims construction expert.

⁶ATC has not demonstrated either that it did not, or could not cover the topic of invalidity during
Dr. Ewell's first deposition.

1 The other case ATC cites to support its argument, *Express One Int’l, Inc. v. Sochata*, is also
2 inapposite. In *Express One*, the court granted leave permitting a second deposition because the subject
3 of the first expert deposition was solely jurisdictional. 2001 WL 363073 *1, 3 (N.D. Tex. March 2,
4 2001). In contrast, Dr. Ewell’s first deposition was about the same substantive issue—the ‘356
5 patent—that ATC wants to question him about now. Memo Ps&As at 1.

6 In seeking leave from the Court to depose Dr. Ewell again, ATC has not demonstrated that the
7 benefit of subjecting Dr. Ewell to a second deposition would outweigh the burden and expense. Further,
8 ATC has failed to show it will be prejudiced at trial, having already deposed Dr. Ewell in connection
9 with a summary judgment motion. Accordingly, ATC’s Motion for Leave to allow a second deposition
10 of Dr. Ewell is denied.

11 **Sanctions**

12 ATC argues that it should be granted fees and costs for having to bring this motion for leave of
13 court. *Id.* at 9. While the Court agrees that special motions such as the present one can generally be
14 avoided, Presidio’s objection to ATC exceeding the clear limits on depositions as set by the Federal
15 Rule 30 is substantially justified given the ambiguity in the Rules as to whether the ten deposition limit
16 applies to experts. Moreover, ATC could have raised the issue at any time during the numerous
17 scheduling conferences in this case. Pursuant to Rule 37 and its requirement that the Court “must not”
18 order sanctions if “the opposing party’s . . . objection was substantially justified,” ATC’s request is
19 denied. Fed. R. Civ. P. 37(a)(5)(A)(ii).

20 **IV. CONCLUSION**

21 For the foregoing reasons, it is hereby ordered that:

22 (1) ATC’s Motion for Leave to Allow Depositions of Presidio’s Experts is **Granted** with respect
23 to Dr. Huebner, Mr. Newman, and Mr. Killworth, Esq.;

24 (2) ATC must bear the expense of the experts’ fees for the preparation for and taking of
25 depositions;

26 (3) ATC’s Motion for Leave to Allow the Deposition of Dr. Ewell is **Denied**; and


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1 (4) ATC may take the depositions of Dr. Huebner, Mr. Newman, and Mr. Killworth after the
2 expert discovery deadline.

3 **IT IS SO ORDERED**

4 DATED: March 25, 2009

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6 Hon. Nita L. Stormes
7 U.S. Magistrate Judge
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