

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
SOUTHERN DISTRICT OF CALIFORNIA

FINJAN, INC.,

Plaintiff,

v.

ESET, LLC and ESET SPOL. S.R.O.,

Defendants.

Case No.: 17CV183 CAB (BGS)

ORDER GRANTING IN PART AND DENYING IN PART MOTION FOR ADDITIONAL DISCOVERY AND ISSUANCE OF LETTER OF REQUEST

[ECF 833]

I. INTRODUCTION

Defendants Eset, spol. s.r.o. and Eset, LLC (“Eset”) has filed this motion to permit a second deposition of Shlomo Touboul. (ECF 833.) Mr. Touboul’s first deposition occurred when the case was stayed as to one of the six patents asserted in this case, U.S. Patent No. 7,975,305 (“’305 Patent”). (*Id.* at 2.¹) Eset now seeks a second deposition to depose him regarding the ’305 Patent. (*Id.* at 3-5.) Eset also seeks issuance of a Letter of Request pursuant to the Hague Convention because Mr. Touboul is in Israel. (*Id.*, Ex. A.) Finjan is opposed to a second deposition. (ECF 834.) Finjan argues Eset should have

¹ Unless otherwise noted, all citations are to electronically generated CM/ECF pagination.

1 questioned Mr. Touboul regarding the '305 Patent during the first deposition and Finjan
2 should not have to expend additional resources attending another deposition of Mr.
3 Touboul. (*Id.* at 4.) Finjan additionally argues that the topics are duplicative, Eset
4 already used its allotted seven hours of deposition time, and a second full deposition on
5 duplicative topics is not proportional to the needs of the case. (*Id.* at 4-7.)

6 **II. DISCUSSION**

7 **A. Parties' Positions**

8 Eset seeks leave to depose Mr. Touboul a second time under Federal Rule of Civil
9 Procedure 30(a)(2)(A)(ii), which Eset acknowledges requires either the stipulation of the
10 parties or leave of court. (ECF 833 at 3.) Eset argues that it should be permitted to
11 depose Mr. Touboul a second time because the case was stayed as to the '305 Patent
12 when he was initially deposed and Eset did not depose him regarding the '305 Patent at
13 his initial deposition. (*Id.* at 2, 4-6.) Eset explains that when the case was stayed as to
14 the '305 Patent it stopped working on the case as to the '305 Patent, having not served its
15 amended invalidity contentions to address new asserted claims of the '305 Patent or
16 consulting its expert regarding the '305 Patent. (*Id.* at 5.) Eset argues that the additional
17 time and effort it would have had to invest in preparing to depose Mr. Touboul on the
18 '305 Patent would have defeated the purpose of the stay – to avoid the expense of
19 litigating the '305 Patent when that might ultimately be unnecessary. (*Id.*) Eset argues
20 that regardless of Finjan's questioning of Mr. Touboul in violation of the stay,² Eset did
21 not question him on the '305 Patent because of the stay. (*Id.* at 4.) Eset, anticipating one
22 of Finjan's challenges to the second deposition, also quotes from the transcript of a status
23 conference in which the assigned district judge specifically indicated that although the
24 parties could jointly agree to pursue '305 discovery for efficiency reasons despite the
25

26
27 ² Eset indicates that it objected to Finjan's questioning of Mr. Touboul on the '305 Patent
28 as being beyond the scope of Eset's direct examination and in violation of the stay. (ECF
833 at 2.)

1 stay, “[i]t doesn’t require that you do the discovery.” (*Id.* at 3-4 (quoting June 14, 2018
2 Hearing Transcript [ECF 277 at 9:24-25].))

3 Finjan first argues that some of the topics identified for the second deposition are
4 duplicative of topics Mr. Touboul testified to at his initial deposition, including about his
5 employment, relationship and communications with Finjan, Finjan’s products, Eset’s
6 products, participation in Finjan litigation, the history of Finjan, and the state of the art in
7 computer security as of 2009. (ECF 834 at 4 (citing ECF 833, Ex. A ¶ 5).) Finjan then
8 proceeds to identify where these topics were already testified to. (*Id.* at 4.) Finjan also
9 argues Eset is now seeking documents that overlap with documents requested in the prior
10 subpoena to Mr. Touboul. (*Id.* at 5.) Finjan acknowledges that “Eset was not required to
11 pursue discovery on the ’305 Patent” when Mr. Touboul was deposed, but seems to argue
12 a second deposition should be denied because Eset *could have* deposed him on the stayed
13 ’305 Patent for the sake of efficiency, but declined to. (*Id.*) Finjan’s argument regarding
14 proportionality is similar. (*Id.* at 6.) Finjan acknowledges a second deposition that is
15 narrowly tailored could be within the scope of Rule 26(b)(1), but argues it is not
16 proportional to the needs of the case because Eset could have questioned Mr. Touboul on
17 the stayed ’305 Patent at his initial deposition and failed to budget the deposition time
18 appropriately. (*Id.* at 4, 6.) In the alternative to prohibiting the deposition entirely,
19 Finjan asks the Court require Eset to amend the Letter of Request to limit the length of
20 the deposition, eliminate duplicative topics, and narrow the topics to those Eset could not
21 have asked in the first deposition. (*Id.* at 7.)

22 **B. Legal Standards**

23 Under Federal Rule of Civil Procedure 30(a)(2)(A)(ii), “[a] party must obtain leave
24 of court, and the court must grant leave to the extent consistent with Rule 26(b)(1) and (2):
25 (A) if the parties have not stipulated to the deposition and: . . . (ii) the deponent has already
26 been deposed in the case.” Many courts have applied a good cause standard to the taking
27 of a second deposition even though it is not stated in Rule 30(a)(2), however they disagree
28 as to which party must show good cause. *Kleppinger v. Texas Dep’t of Transp.*, 283 F.R.D.

1 330, 335 n.7 (S.D. Tex. 2012) (“[T]his Court notes that other district courts have utilized a
2 ‘good cause’ standard when making such determinations pursuant to Rule
3 30(a)(2)(A)(ii).”) (collecting cases); *Clark v. Penn Square Mall Ltd. P’ship*, 2013 WL
4 139778, * 1 (W.D. Okla. Jan. 10, 2013) (Explaining “[s]ome courts require parties to show
5 good cause before they can conduct a second deposition” and “[o]ther courts require a
6 showing of good cause to prevent—rather than allow—the second deposition,” but finding
7 “[e]ither way, a good cause standard would involve disregard of Rule 30(a)(2)(A)(ii) when
8 its terms mandate leave for a second deposition); *Jade Trading, LLC v. United States*, 64
9 Fed. Cl. 85, 86 (2005) (“Some courts have opined that leave to conduct a second deposition
10 should ordinarily be granted, and that the party opposing the second deposition must
11 demonstrate good cause why the second deposition should not be taken.”) (citing *Judicial*
12 *Watch, Inc. v. United States DOC*, 34 F. Supp 2d 47, 54–55 (D.D.C.1998); *Plaisance v.*
13 *Beef Connection Steakhouse*, 1998 WL 214740 (E.D. La. April 30, 1998)); *see also*
14 *Entrata, Inc. v. Yardi Sys., Inc.*, Case No. 2:15-cv-102 CW, 2018 WL 6171890, *2 (D.
15 Utah, Nov. 26, 2018) (Noting the good cause standard is not in Rule 30(a)(2), some courts
16 required a showing of good cause to take a second deposition, and some courts require a
17 showing of good cause to prevent a second deposition). The Court need not address the
18 variation in courts’ standards here because, as discussed below, Eset has shown good cause
19 to conduct a second deposition as limited by the Court to conform with Rule 26(b)(2).

20 Rule 30(d)(1) provides that “[u]nless otherwise stipulated or ordered by the court, a
21 deposition is limited to one day of 7 hours.” However, “[t]he court must allow additional
22 time consistent with Rule 26(b)(1) and (2) if needed to fairly examine the deponent or if
23 the deponent, another person, or any other circumstance impedes or delays the
24 examination.” “The party seeking a court order to extend the examination [beyond the
25 presumptive seven hours of actual deposition time], or otherwise alter the limitations, is
26 expected to show good cause to justify such an order.” Rule 30, Adv. Comm. Notes to
27 2000 amend.

1 Rule 26(b)(1) provides that “[p]arties may obtain discovery regarding any non-
2 privileged matter that is relevant to any party’s claim or defense and proportional to the
3 needs of the case, considering the importance of the issues at stake in the action, the amount
4 in controversy, the parties’ relative access to relevant information, the parties’ resources,
5 the importance of the discovery in resolving the issues, and whether the burden or expense
6 of the proposed discovery outweighs its likely benefit.” Fed. R. Civ. P. 26(b)(1).

7 Rule 26(b)(2)(C) also requires the court, on motion or on its own, to limit the
8 frequency or extent of discovery otherwise allowed by the rules if it determines that “(i)
9 the discovery sought is unreasonably cumulative or duplicative, or can be obtained from
10 some other source that is more convenient, less burdensome, or less expensive; (ii) the
11 party seeking discovery has had ample opportunity to obtain the information by discovery
12 in the action; or (iii) the proposed discovery is outside the scope permitted by Rule
13 26(b)(1).” Fed. R. Civ. P. 26(b)(2)(C)(i)-(iii).

14 **C. Analysis**

15 As limited by the parties’ briefing,³ the primary issues are whether the testimony
16 sought should be denied or limited under Rule 26(b)(2) as “unreasonably cumulative or
17 duplicative,” if Eset “has had ample opportunity to obtain the information by discovery in
18 the action,” and if the discovery sought it proportional to the needs of the case. Rule
19 26(b)(1) and (2).

20 ///

21 ///

22 ///

23
24
25 ³ The Court is not addressing unbriefed issues and nothing in this Order should be
26 interpreted as such. For example, as the Court explains below, proportionality is raised
27 but most of the factors are not addressed and the parties do not raise relevancy. Given
28 Finjan’s brief acknowledges that Mr. Touboul is the founder of Finjan and a named
inventor on the ’305 Patent (ECF 834 at 2), the Court can conclude that the relevancy of
his testimony is not in dispute, at least for purposes of this Motion.

1 **1. Cumulative or Duplicative**

2 The Court finds that the proposed “Subject of Examination”⁴ as reflected in Eset’s
3 request to depose Mr. Touboul, includes topics that are duplicative of topics previously
4 covered but also includes topics specific to the ’305 Patent that Eset did not previously
5 pursue, and was not required to pursue at the time of the initial deposition because of the
6 stay. (ECF 833, Ex. A ¶ 5.)

7 As Finjan points out in their briefing, Eset previously deposed Mr. Touboul
8 regarding his “employment, business relationship, and communications with Finjan;
9 Finjan’s products; Eset’s products; participation in Finjan litigation; corporate, financial,
10 and marketing history of Finjan; and state of the art computer security as of 2000.” (ECF
11 833 (citing ECF 833, Ex. A ¶ 5 (describing topics for deposition).) However, nothing in
12 the record reflects that Eset deposed Mr. Touboul regarding the other topics also included
13 in this section, “the alleged conception, development, reduction to practice, protection,
14 validity, enforceability, and infringement of the ’305 Patent.” (*Id.*) Additionally, the
15 Court recognizes that there might be questions to ask specific to the ’305 Patent that
16 relate to the broader topics of ¶ 5 noted above. The deposition Eset seeks covers material
17 specific to the ’305 Patent that has not previously been covered, but it also includes topics
18 Mr. Touboul was previously deposed on. The inclusion of topics he was previously
19 deposed on creates the potential it will be unreasonably duplicative.
20
21

22
23 ⁴ It states in full:

24 The examination of Shlomo Touboul will concern at least: the alleged
25 conception, development, reduction to practice, protection, validity,
26 enforceability, and infringement of the ’305 Patent; employment, business
27 relationship, and communications with Finjan; Finjan’s products; ESET’s
28 products; participation in Finjan litigation; corporate, financial, and
29 marketing history of Finjan; and state of the art of computer security as of
30 2000.

(ECF 833, Ex. A ¶ 5.)

1 As to the document production, the Court agrees that Mr. Touboul should not be
2 required to produce additional documents for his second deposition. The prior subpoena
3 included documents related to the '305 Patent and the deposition testimony cited by
4 Finjan reflects his searches did not exclude the '305 Patent.⁵ (ECF 834-3, Ex. B at 1
5 (definitions section includes '305 Patent within Patents-in-Suit), 9-12 (document requests
6 relying on that definition); ECF 833, Ex. A ¶ 6 (documents to be produced for second
7 deposition).) This is not an opportunity to revisit previous requests by asking for some of
8 the same documents again or to revisit any issues with the prior productions.
9 Additionally, eliminating this duplicative document production relieves Mr. Touboul of
10 the burden of conducting an additional search for documents when that search was
11 previously conducted and documents produced. As explained below, this is also
12 significant in the Court' proportionality analysis. However, this does not mean Eset is
13 precluded from questioning Mr. Touboul regarding previously produced documents
14 specific to the '305 Patent. As discussed below, because Eset has not yet deposed Mr.
15 Touboul on the '305 Patent, it may question him on it, including documents related to the
16 '305 Patent subject to the limitations imposed by the Court.

17 Accordingly, to avoid a deposition that is unreasonably cumulative or duplicative
18 in violation of Rule 26(b)(2), the Court requires Eset to narrow the scope of the topics of
19 the deposition to those specific to the '305 Patent. The portion of the Subject of
20 Examination, identified above that is specific to the '305 Patent need not be altered,
21 however, the broader topics that have already been covered more generally in Mr.
22 Touboul's prior deposition, must be eliminated or narrowed to those topics as they relate
23 to the '305 Patent. And, the Court expects the questioning will strictly address only the
24

25
26 ⁵ This conclusion presumes that Finjan's counsel did not previously withhold or has since
27 produced any documents related to the '305 Patent that Mr. Touboul provided from his
28 searches. Mr. Touboul testified that he provided everything he located in his searches to
Finjan's counsel.

1 '305 Patent. This is not an opportunity to revisit topics previously covered or clarify
2 prior testimony with further questioning.

3 **2. Opportunity to Obtain the Information by Discovery in the Action**

4 Finjan attempts to preclude Eset from deposing Mr. Touboul regarding the '305
5 Patent under Rule 26(b)(2)(C) because Eset could have joined Finjan in questioning him
6 on the '305 during his initial deposition. Finjan points to it having deposed him and
7 Finjan telling Eset at the deposition that it should also question him on the '305 Patent at
8 that time. Although Rule 26(b)(2)(C)(ii) limits discovery when a party has "had an
9 opportunity to obtain the information," Finjan accurately acknowledges that Eset was not
10 required to depose him on the '305 Patent during his first deposition because of the stay.

11 The parties agree that Eset was not required to seek '305 discovery from Mr.
12 Touboul regarding the '305 Patent at his initial deposition because the case was stayed.
13 (ECF 833 (Eset's Motion; ECF 834 (Finjan's Opp'n) at 5 ("While Eset was not required
14 to pursue discovery on the '305 patent, it was not prohibited either.")) And, the Court's
15 own review of the transcript of a status hearing that both parties rely on reflects as much.
16 (ECF 277 at 9:20-10:6.) The parties were allowed to pursue discovery on '305 "to the
17 extent the parties wish to jointly pursue discovery on the '305 for economic and
18 efficiency reasons." (*Id.* at 10:22-24 (emphasis added).) To the extent the voluntary
19 nature of that was not clear, it was followed by "It doesn't require that you do the
20 discovery." (*Id.* at 10:24-25.⁶) The Court cannot now find Eset is precluded from
21 deposing Mr. Touboul regarding the '305 Patent under Rule 26(b)(2) because it "had
22 ample opportunity to obtain the information by discovery in the action" at his initial
23 deposition. To do so would be the equivalent of requiring Eset to depose Mr. Touboul
24

25
26 ⁶ This is consistent with the court's prior statement that "I'm not going to force the
27 defendants to take discovery" (ECF 277 at 8:17-18) and Eset's lack of objection "as long
28 as the order of the Court is clear we don't have to pursue that discovery . . ." (*Id.* at 9:15-
19.)

1 regarding the '305 Patent at his initial deposition. However, Eset was not required to
2 expend resources preparing to question Mr. Touboul or to actually question him
3 regarding the '305 Patent when initially deposed. The option was available if the parties
4 jointly wanted to, but it was not required. In this respect, a second deposition limited to
5 the '305 Patent is not precluded under Rule 26(b)(2)(C)(ii).

6 However, Eset has had the opportunity to depose him on everything else.
7 Accordingly, the Court finds the same restrictions imposed above to avoid duplicative or
8 cumulative discovery are similarly justified to comply with Rule 26(b)(2)(C)(ii)'s
9 prohibition on discovery a party has had ample opportunity to obtain.

10 **3. Length of Second Deposition and Proportionality**

11 Finjan argues that a second deposition is not proportional to the needs of the case,
12 but addresses only the final factor, whether the burden outweighs its benefit. Finjan
13 argues the burden and expense of a potentially duplicative deposition outweighs the
14 benefit of it. (ECF 834 at 6.) In the same section of the Opposition, Finjan also argues
15 Eset failed to budget its deposition time or to take advantage of the opportunity to depose
16 Mr. Touboul on the '305 Patent when it could have and instead gambled on obtaining a
17 full deposition on duplicative topics. (ECF 834 at 6.) Although not entirely clear, the
18 Court construes this argument and Finjan's assertion that Eset failed to manage the seven
19 hours it was allowed in a different section, (*id.* at 4) as an assertion that the second
20 deposition of Mr. Touboul will exceed the presumptive seven-hour limit in Rule 30(d).
21 However, Finjan has not indicated how long Mr. Touboul was actually deposed.
22 Additionally, Finjan asks that if the Court allows a second deposition that the deposition
23 should be limited in length, although it does not specify a length. (*Id.* at 7.) Eset did not
24 address this issue as it was only raised in Finjan's Opposition.

25 The Court finds Eset may exceed the presumptive seven-hour limit, assuming the
26 second deposition will do so, but only for a maximum of two hours. Eset has not
27 deposed Mr. Touboul on one of the patents-in-suit because the case was stayed as to it at
28 the initial deposition. Eset has shown good cause for a brief deposition that complies

1 with the limitations set forth above to comply with Rule 26(b)(1) and (2) – strictly
2 narrowed to the '305 Patent without an additional document production. *See* Rule
3 30(d)(1) (“The court must allow additional time consistent with Rule 26(b)(1) and (2) if
4 needed to fairly examine the deponent or if the deponent, another person, or any other
5 circumstance impedes or delays the examination.”) The Court finds that with a narrowed
6 deposition covering only one patent and not revisiting any topics previously covered in
7 the initial deposition, the deposition should be short. This time limit also significantly
8 limits the burden imposed by the deposition on Mr. Touboul and Finjan for purposes of
9 the burden in assessing proportionality.

10 **4. Cost Shifting**

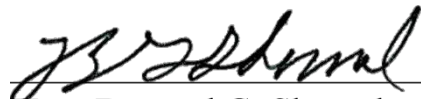
11 At the conclusion of its Opposition, when Finjan argues for limits on the
12 deposition if it goes forward, Finjan states “ESET should also be required to cover all
13 costs for a reconvened deposition.” (ECF 834 at 7.) There is no further explanation for
14 what costs Finjan is seeking or the basis for it. Accordingly, this unsupported or
15 explained request is denied.

16 **III. CONCLUSION**

17 The Court **GRANTS in part and DENIES in part** Eset Motion as set forth above.
18 The Court will allow a second deposition of Mr. Touboul, but as limited by this Order.
19 Eset must modify the Letter of Request previously submitted to conform to the
20 limitations in this Order and resubmit it for approval by the Court within 10 days.

21 **IT IS SO ORDERED.**

22 Dated: December 16, 2020

23 
24 Hon. Bernard G. Skomal
25 United States Magistrate Judge
26
27
28