

1
2
3
4
5
6
7
8 UNITED STATES DISTRICT COURT
9 SOUTHERN DISTRICT OF CALIFORNIA
10

11 FINJAN, LLC,

12 Plaintiff,

13 v.

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

15 Defendant.
16

Case No.: 17-cv-183-CAB-BGS

**ORDER ON DISCOVERY DISPUTE
REGARDING ACQUISITION
DOCUMENTS**

[ECF 849]
17

18 Defendants ESET, LLC and ESET SPOL. S.R.O (“ESET”) move to compel
19 Plaintiff Finjan, LLC (“Finjan”) to produce documents in response to eleven requests for
20 production of documents (“RFPs”). (ECF 849 at 4.¹) The parties have briefed the issues
21 in dispute through a Joint Statement. (ECF 849.)

22 **I. BACKGROUND**

23 This case was stayed from May 7, 2018 until July 23, 2020 as to the ’305 Patent,
24 one of six patents Finjan asserts ESET has infringed, and is currently stayed. (ECF 215,
25 802.) After the stay was lifted and the parties were proceeding with discovery, the Court
26

27
28 ¹ This Order cites the CM/ECF electronic pagination unless otherwise noted.

1 ordered the parties to submit proposed deadlines to complete any '305 discovery that was
2 not completed prior to the stay. (ECF 811.) The Court then issued two orders setting
3 deadlines to complete discovery as to the '305. (ECF 819, 832.²)

4 Since this briefing was filed, the district judge issued an order granting ESET's
5 renewed motion for summary judgment of indefiniteness as to all the other patents in this
6 case. (ECF 864.) The decision was followed by an order granting the parties' joint
7 request to sever the '305 patent from the others and stay it pending a final determination
8 on the decision as to the other patents. (ECF 871.)

9 The documents at issue in this dispute are related to Fortress Investment Group's
10 ("Fortress") acquisition of Finjan Holdings, Inc. on July 24, 2020 for \$43.9 million.
11 (ECF 849 at 2-5, 13-17.) ESET seeks communications between and documents
12 exchanged by Fortress and Finjan regarding: the patents asserted in this case and Finjan's
13 patent portfolio as a whole, including valuations for any damages claims for any of the
14 patents or any Finjan litigation (RFPs 222, 223, 226, 230 and 231); ESET (RFP 224);
15 substitution of Finjan's counsel in any litigation (RFP 225); any allocation associated
16 with the acquisition (RFP 227); potential invalidity, unenforceability, and prior art as to
17 any of the patents-in-suit (RFP 232); and any communications between Finjan and its
18 shareholders regarding the acquisition (RFP 229). (ECF 849.)

19 Fortress' acquisition of Finjan Holdings included Plaintiff Finjan, Inc., now Finjan,
20 LLC.³ (*Id.* at 13-14.) Finjan represents that Fortress' due diligence for this acquisition
21

22
23 ² The Court had ordered the parties to identify what additional discovery was needed as to
24 the '305 Patent and when it could be completed, however, the parties' initial proposals
25 only addressed written discovery as to the '305 Patent. A second order addressed
26 additional deadlines after receiving the parties' proposed deadlines to address all
27 remaining discovery deadlines as to the '305 Patent.

28 ³ After the acquisition, Finjan filed a Motion to Amend the Caption seeking to change the
name of the Plaintiff from Finjan Inc. to Finjan, LLC because Finjan's entity status had
been changed from a corporation to a limited liability corporation. (ECF 835.) ESET
opposed the Motion, arguing Finjan was acting in bad faith in not disclosing the

1 began in August 2018; and as part of it, Fortress and Finjan executed a non-disclosure
2 agreement (“NDA”) and common interest agreement (“CIA”), both in 2018. (*Id.* at 14
3 (citing Decl. of Regis Worley, Ex. G (Finjan’s Supplemental Privilege Log) at Doc. Nos.
4 2322-23)⁴.)

5 **II. DISCUSSION**

6 There are three primary issues raised in the parties’ briefing: (1) do ESET’s RFPs
7 seek discovery within the scope authorized by the Court; (2) do they seek discovery that
8 is relevant and proportional to the needs of the case; and (3) whether the withheld
9 documents are protected by the common legal interest doctrine. The Court first addresses
10 whether the discovery sought is within the scope of discovery authorized and if it is
11 relevant and proportional to the needs of the case.

12 **A. Relevant to the ’305 and Proportional to the Needs of the Case**

13 The relevance section of ESET’s briefing groups the RFPs as follows: (1)
14 valuation documents (RFPs 222, 223, 226, 227, 230, and 231); (2) documents regarding
15 ESET (RFPs 224); (3) Finjan’s shareholder communications (RFP 229); and (4)
16 documents regarding the validity and enforceability of the ’305 Patent (RFPs 232, 233).
17 (ECF 849 at 6-7.) In a different section of the Joint Statement, ESET identifies only
18 RFPs 222 and 226 as patent valuation documents and separates out RFP 223 as
19 documents referring to the asserted patents, RFP 227 as documents referring to the
20 allocation of the acquisition, and RFPs 230 and 231 as documents referring to the
21 valuation of infringement damages for the asserted patents. (ECF 849 at 4.) This section
22 also includes one RFP not identified in the relevance section, RFP 225, documents
23 referring to substitution of counsel. (*Id.*)

24 _____
25
26 acquisition documents that are in dispute here. (ECF 840.) The assigned district judge
27 granted the motion to amend the caption and understandably did not reach the issue of
28 these discovery documents. (ECF 846.)

⁴ Despite quoting from the NDA in redacted portions of its briefing, Finjan only cites its
privilege log for these two documents. (ECF 849 at 14.)

1 **1. Discovery Limited to '305 Patent**

2 **a) Parties' Positions on Authorized Scope of Discovery**

3 Finjan argues that the RFPs go beyond the '305 discovery authorized by the Court
4 because they seek documents and communications between Finjan and Fortress regarding
5 Finjan's whole patent portfolio, Finjan's former counsel, and ESET generally. (*Id.* at 12.)

6 ESET does not directly dispute that discovery at this point is limited to the '305.
7 However, ESET argues that even if portions of responsive documents are beyond the
8 '305, extending to patent portfolio documents, Finjan should not be allowed to withhold
9 or redact those portions that extend beyond the '305 if they otherwise contain information
10 relevant to the '305. (*Id.* at 6-7, 11 (citing *Finjan, Inc. v. SonicWall, Inc.*, Case No. 17-cv-
11 04467-BLF (VKD), 2020 WL 4192285, at *3 (N.D. Cal. July 21, 2020).) ESET seems to
12 be arguing that if the documents are responsive and relevant for purposes of the '305 then
13 they should not be withheld just because they encompass more than the '305. As to some
14 of the RFPs, ESET also argues they are related to the '305 even though the language of
15 the RFP does not limit its scope to the '305. Additionally, in a footnote, ESET asks that
16 if the Court finds the valuation documents in dispute are not related to the '305 and
17 beyond the scope of current discovery, "ESET requests that an additional discovery
18 period be ordered that will enable ESET to take fulsome discovery of the Fortress
19 transaction sufficiently to assess whether Finjan LLC even retained standing to sue." (*Id.*
20 at 11 n.12.)

21 **b) Analysis of Authorized Scope**

22 The only discovery the parties were authorized to conduct when this dispute arose
23 was '305 discovery. As noted above, discovery in this case was proceeding as to all the
24 patents-in-suit when the case was stayed as to the '305 on May 7, 2018, however, all
25 other discovery was completed, and the case proceeded to trial⁵ while the stay was in
26

27
28 ⁵ A mistrial was declared on March 16, 2020 as a result of the COVID-19 Pandemic.
(ECF 783.) Additionally, since this briefing was filed, ESET's motion for summary

1 place. (ECF 447 (close of expert discovery on March 19, 2019), 780-82 (trial).) In this
2 respect, the only discovery the parties were authorized to pursue once the stay was lifted
3 on July 23, 2020 was on the '305 because discovery was closed as to everything else.
4 (ECF 802, 819, 832.⁶) The Court also notes that the Court's first order requiring the
5 parties to submit proposals to complete '305 discovery ordered them to identify discovery
6 that was not cumulative or duplicative of discovery already completed. (ECF 811.)
7 Additionally, in ordering the parties to address all discovery deadlines (they had only
8 addressed written discovery in their initial competing proposals) the Court reminded
9 them that '305 discovery should only be updated as necessary because discovery as to the
10 '305 was already in progress when it was stayed. (ECF 819.)

11 On their face, the RFPs are not limited to the '305. For example, RFP 222 requests
12 "All Communications between Finjan, Inc. or Finjan Holdings, Inc. and Fortress
13 Investment Group LLC regarding any valuation *of the Patents-in-Suit or the Finjan*
14 *patent portfolio as a whole.*" (ECF 849-6 at 12 (emphasis added).) In this respect, the
15 language of these RFPs is overbroad in seeking discovery beyond the scope authorized
16 by the Court. However, as to this and other similarly worded RFPs, the issue is not
17 necessarily resolved by substituting "the '305 Patent" in place of "Patents-in-Suit or
18 Finjan patent portfolio as a whole" or something similar to narrow every RFP to the '305.
19 As discussed below, in the context of discovery related to a purchase of patents or an
20 acquisition that includes patents, an RFP may arguably seek discovery relevant to the
21 value of one patent even when it encompasses documents related to the value of other
22 patents. (*See* I.A.1.b)(1)(b).) Rather than eliminate RFPs entirely because they do not

23
24
25 judgment of invalidity of the other patents, based on indefiniteness, was also granted.
26 (ECF 864.)

27 ⁶ Neither party has sought to reopen discovery regarding anything beyond the '305 and
28 their briefing does not directly address any of the factors courts are required to consider
in reopening discovery.

1 specify they are only asking for the discovery as to the '305 or substitute in “the '305” for
2 the broader language in a blanket fashion, the Court considers below whether the RFPs as
3 currently stated seek any discovery that is relevant to the '305 and narrows them
4 accordingly.

5 The Court briefly addresses the parties’ arguments regarding obtaining discovery
6 as to Finjan’s standing below in addressing relevancy and proportionality. (*See*
7 I.A.1.b(3)) However, to the extent ESET’s footnote regarding an “additional discovery
8 period” could be considered a request to reopen discovery or open discovery more
9 broadly than the '305, it is denied at this time for not properly raising it. “When ruling on
10 a motion to amend a Rule 16 scheduling order to reopen discovery, [the Ninth Circuit]
11 instructs” courts to consider:

- 12 1) whether trial is imminent, 2) whether the request is opposed, 3)
- 13 whether the non-moving party would be prejudiced, 4) whether the
- 14 moving party was diligent in obtaining discovery within the guidelines
- 15 established by the court, 5) the foreseeability of the need for additional
- 16 discovery in light of the time allowed for discovery by the district court,
- and 6) the likelihood that the discovery will lead to relevant evidence.

17 *City of Pomona v. SQM N. Am. Corp.*, 866 F.3d 1060, 1066 (9th Cir. 2017)
18 (quoting *United States ex rel. Schumer v. Hughes Aircraft Co.*, 63 F.3d 1512, 1526 (9th
19 Cir. 1995) *vacated on other grounds*, 520 U.S. 939 (1997)). Not only is a footnote not a
20 proper avenue to seek to reopen discovery, ESET has not addressed this standard or any
21 alternative standard it might advance to justify obtaining discovery beyond the '305.
22 Raising it in a footnote with little analysis leaves the Court to speculate as to the standard
23 ESET might think applies and ESET’s justifications under this or another standard.
24 Additionally, by raising it in a footnote with little analysis, it also denies Finjan the
25 opportunity squarely address the appropriate standard or ESET’s arguments. The Court
26 will not rule on an issue raised in this way.

27 ///

28 ///

1 **2. Relevance and Proportionality**

2 **a) Scope of Discovery**

3 The Federal Rules of Civil Procedure provide that “parties may obtain discovery
4 regarding any non-privileged matter that is relevant to any party’s claim or defense and
5 proportional to the needs of the case, considering the importance of the issues at stake in
6 the action, the amount in controversy, the parties’ relative access to relevant information,
7 the parties’ resources, the importance of the discovery in resolving the issues, and
8 whether the burden or expense of the proposed discovery outweighs its likely benefit.”
9 Fed. R. Civ. P. 26(b)(1). Here, as discussed above, the scope is further limited to the
10 ’305.

11 District courts have broad discretion in determining what is relevant. *Facedouble,*
12 *Inc. v. Face.com*, No. 12cv1584 DMS (MDD), 2014 WL 585868, at *1 (S.D. Cal. Feb.
13 13, 2014). “Evidence is relevant if (a) it has any tendency to make a fact more or less
14 probable than it would be without the evidence; and (b) the fact is of consequence in
15 determining the action.” Fed. R. Evid. 401. “The party who resists discovery has the
16 burden to show that discovery should not be allowed, and has the burden of clarifying,
17 explaining, and supporting its objections.” *Global Ampersand, LLC v. Crown*
18 *Engineering and Construction, Inc.*, 261 F.R.D. 495, 499 (E.D. Cal. 2009) (quoting
19 *Oakes v. Halvorsen Marine Ltd.*, 179 F.R.D. 281, 283 (C.D. Cal. 1998) and *Nestle Foods*
20 *Corp. v. Aetna Casualty & Surety Co.*, 135 F.R.D. 101, 104 (D. N.J. 1990)); *see also*
21 *Gordon v. Nexstar Broad., Inc.*, Case No. 1:18-cv-007 DAD-JTL, 2019 WL 2177656, at
22 *4 (E.D. Cal. May 20, 2019) (“Once the party seeking discovery establishes that a request
23 seeks relevant information, the party who resists discovery has the burden to show
24 discovery should not be allowed, and has the burden of clarifying, explaining, and
25 supporting its objections.”) (citations omitted).

26 The 2015 Amendments to Rule 26 made clear that “[r]elevancy alone is no longer
27 sufficient—discovery must also be proportional to the needs of the case.” *In re Bard IVC*
28 *Filters Prods. Liability Litig.*, 317 F.R.D. 562, 564 (D. Ariz. 2016). When a dispute

1 implicates proportionality, the party claiming undue burden has an obligation to explain
2 what is burdensome about complying with the request and the party claiming it is
3 important enough to require a response must explain why it is important. Fed. R. Civ. P.
4 26 advisory committee's notes. "The court's responsibility, using all the information
5 provided by the parties, is to consider these, [undue burden or expense and importance of
6 information sought,] and all the other factors in reaching a case-specific determination of
7 the appropriate scope of discovery." *Id.* Limits on discovery may be issued where the
8 "burden or expense outweighs the likely benefits." *Id.* (citing Fed. R. Civ. P. 26(b)).

9 **b) Rule 26 Analysis of RFPs**

10 Finjan argues that the RFPs seek discovery that is beyond the '305 and not
11 proportional to the needs of the case. Finjan asserts that these RFPs seek production of
12 irrelevant documents and communications regarding Finjan's entire patent portfolio,
13 Finjan's former counsel, and ESET generally. Finjan argues the only information
14 relevant to the value of a hypothetical license, the basis for the reasonable royalty
15 calculation, is the actual purchase price, not the broad pre-acquisition negotiations,
16 valuations, or purchase price allocations ESET seeks in these RFPs. (ECF 849 at 12, 17.)

17 In justifying such broad discovery as to the acquisition, ESET relies on an alleged
18 discrepancy between Finjan's expert's opinion as to a reasonable royalty as to the other
19 patents and what Fortress paid in total to acquire Finjan. ESET explains that in the filing
20 period ending March 31, 2020, prior to the acquisition, Finjan Holdings reported total
21 current assets of \$36 million and additionally identified 12 pending patent infringement
22 actions in which Finjan was a plaintiff (6 of them involving the '305 patent). (ECF 849
23 at 2 (relying on Worley Decl., Ex. C).) By comparing this 10-Q filing and the amount
24 Fortress paid to acquire Finjan, \$43.9 million, ESET argues Fortress paid only \$8 million
25 more for Finjan than its total cash assets. ESET argues this purchase price significantly
26 discounts, potentially to zero, the value of the ESET litigation, as well as Finjan's other
27 reported litigations, and the value of its intellectual property assets. (*Id.* at 2-3.) It asserts
28 there is a significant difference between nothing, what it asserts Fortress paid for these

1 patents among others, and the opinion of Finjan’s expert as to the reasonable royalty
2 owed by ESET to Finjan for alleged infringement of the other five patents asserted in this
3 case.⁷ (*Id.* at 2, 11.) Based on this difference, ESET argues it is entitled to review
4 everything Finjan told Fortress about the value of this case.

5 The Court addresses the RFPs as categorized by ESET in its briefing starting with
6 the largest group, the “valuation documents.”

7 (1) Valuation Documents

8 ESET identifies RFPs 222, 223, 226, 227, 230, and 231 as seeking valuation
9 documents. (ECF 849 at 6.) As discussed in more detail below, ESET argues documents
10 responsive to these RFPs are relevant to the value of the ’305 and calculation of a
11 reasonable royalty rate. (*Id.* at 3, 6.)

12 When a patent is infringed, the patentee is entitled to ‘damages adequate to
13 compensate for the infringement, but in no event less than a reasonable royalty for the use
14 made of the invention by the infringer.’” *Whitserve, LLC v Computer Packages, Inc.*,
15 694 F.3d 10, 26 (Fed. Cir. 2012) (quoting 35 U.S.C. § 284). “A reasonable royalty can
16 be calculated from an established royalty, the infringer’s profit projections for infringing
17 sales, or a *hypothetical negotiation* between the patentee and infringer based on the
18 factors in *Georgia–Pacific Corp. v. U.S. Plywood Corp.*, 318 F. Supp. 1116, 1120 (S.D.
19 N.Y.1970).”⁸ *Wordtech Sys., Inc. v. Integrated Network Solutions, Inc.*, 609 F.3d 1308,

21 ⁷ The parties have not yet completed expert discovery in this case as to the ’305. ESET
22 relies on a modified expert report provided by Finjan’s expert as to the other patents-in-
23 suit.

24 ⁸ The *Georgia-Pacific* factors are:

- 25 (1) royalties the patentee has received for licensing the patent to others; (2)
26 rates paid by the licensee for the use of comparable patents; (3) the nature
27 and scope of the license (exclusive or nonexclusive, restricted or
28 nonrestricted by territory or product type); (4) any established policies or
marketing programs by the licensor to maintain its patent monopoly by not
licensing others to use the invention or granting licenses under special
conditions to maintain the monopoly; (5) the commercial relationship

1 1319 (Fed. Cir. 2010) (emphasis added) (citing *Lucent Techs. v. Gateway, Inc.*, 580 F.3d
2 1301, 1324 (Fed. Cir. 2009) and *Minks v. Polaris Indus.*, 546 F.3d 1364, 1372 (Fed. Cir.
3 2008)); *see also Uniloc USA, Inc. v. Microsoft Corp.*, 632 F.3d 1292, 1317 (Fed. Cir.
4 2011) (“This court has sanctioned the use of the *Georgia-Pacific* factors to frame the
5 reasonable royalty inquiry. Those factors properly tie the reasonable royalty calculation
6 to the facts of the hypothetical negotiation at issue.”); *see also* N.D. Cal. Model Patent
7 Jury Instruction 5.7. As noted above, ESET is relying on an alleged discrepancy between
8 Finjan’s expert’s opinion regarding a reasonable royalty as to all the other patents-in-suit
9 and what Fortress paid for Finjan in total, including the ’305. Finjan’s expert’s
10 reasonable royalty calculation that ESET seeks discovery to challenge is based on a
11 hypothetical negotiation.

12 **(a) RFPs**

13 RFP 222:

14 All Communications between Finjan, Inc. or Finjan Holdings, Inc. and
15 Fortress Investment Group LLC regarding any valuation of the Patents-in-
16 Suit or the Finjan patent portfolio as a whole.

17
18 between the licensor and licensee, such as whether they are competitors; (6)
19 the effect of selling the patented specialty in promoting sales of other
20 products of the licensee; (7) the duration of the patent and license term; (8)
21 the established profitability of the product made under the patent, including
22 its commercial success and current popularity; (9) the utility and advantages
23 of the patent property over old modes or devices; (10) the nature of the
24 patented invention and the benefits to those who have used the invention;
25 (11) the extent to which the infringer has used the invention and the value of
26 that use; (12) the portion of profit or of the selling price that may be
27 customary in that particular business to allow for use of the invention or
28 analogous inventions; (13) the portion of the realizable profit that should be
credited to the invention as opposed to its non-patented elements; (14) the
opinion testimony of qualified experts; and (15) *the results of a hypothetical
negotiation between the licensor and licensee.*

i4i Ltd. P’ship v. Microsoft Corp., 598 F.3d 831, 853 n.3 (Fed. Cir. 2010) (emphasis added).

1
2 RFP 223:

3 All Documents provided to Fortress Investment Group LLC prior to the
4 acquisition of Finjan referring or relating to any of the Patents-in-Suit.

5 RFP 226:

6 All Communications between Finjan, Inc. or Finjan Holdings, Inc. and
7 Fortress Group LLC regarding any valuation assigned to the Patents-in-
8 Suit.

9 RFP 227:

10 All Documents pertaining to any purchase price allocations associated with
11 the acquisition of Finjan by Fortress Investment Group LLC.

12 RFP 230:

13 All Communications between Finjan, Inc. or Finjan Holdings, Inc. and
14 Fortress Investment Group LLC regarding any valuation assigned to
15 pending claims for damages for alleged infringement of any of the Patents-
16 in-Suit in any Finjan Litigation.

17 RFP 231:

18 All Communications between Finjan, Inc. or Finjan Holdings, Inc. and
19 Fortress Investment Group LLC regarding any valuation assigned to
20 pending claims for damages for any alleged infringement by ESET of any
21 of the Patents-in-Suit.

22 RFP 229:⁹

23 All Communications between Finjan and any of its shareholders regarding
24 the acquisition of Finjan by Fortress Investment Group LLC.

25 (ECF 849-6 at 12-19.)
26

27 ⁹ RFP 229 was not listed as a valuation RFP, however, because ESET asserts it is relevant
28 to the valuation attributed to this litigation and Finjan's damages claims and those issues
are addressed in this section, the Court considers it here.

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

(b) Analysis

The Court finds some of the documents sought in the valuation RFPs are relevant, however, the RFPs are also overbroad because they encompass discovery that is not relevant or proportional to the needs of the case.

As Finjan accurately explains, ESET already has the purchase price for the acquisition. (ECF 849 at 17 (Arguing ESET fails to explain “why preacquisition documents are relevant to this inquiry when it may account for the actual purchase price (of \$43.9 million noted above) in its valuation of a hypothetical license”).) The issue then is whether broader discovery into all Finjan and Fortress’ pre-acquisition documents and communications regarding Finjan’s entire patent portfolio and litigations are relevant to the ’305 and calculation of, or challenging a calculation of, a reasonably royalty based on a hypothetical negotiation. As explained in detail below, even the cases ESET relies on in support of the valuation RFPs do not support production of the breadth of discovery ESET seeks. However, the Court finds that documents that specifically value the ’305 or other patents acquired as part of the acquisition are within the scope of relevant ’305 discovery and proportional to the needs of the case.

In its section addressing relevance as to RFPs 222, 223, 226, 230, and 231, ESET states the “valuation documents are highly relevant to the issue of a reasonable royalty.” (*Id.* at 6.) ESET then cites three cases in support of this assertion. (*Id.* (citing *Integra Lifesciences I, Ltd. v. Merck KGaA*, 331 F.3d 860, 871 (Fed. Cir. 2003), *vacated on other grounds*, 545 U.S. 193 (2005), *Uniloc USA, Inc. v. Apple Inc.*, No. 19-cv-01692-EJD (VKD), 2020 WL 4368207, at *2 (N.D. Cal. July 30, 2020), and *Fresenius Med. Care Holding, Inc. v. Baxter Int’l, Inc.*, 224 F.R.D. 644, 653 (N.D. Cal. 2004)).

Of the cases cited by ESET, the one most procedurally aligned with the dispute here is *Uniloc v. Apple*. 2020 WL 4368207. The decision addresses damages discovery in the context of multiple transactions selling large groups of patents. *Uniloc*, 2020 WL 4368207, at *1-2. The patent at issue was sold three different times, first in a portfolio with over one thousand others, second with hundreds of others, and third as part of

1 another large group. *Id.* at 1. The dispute focused on whether documents valuing the
2 other patents¹⁰ that were sold were relevant to the value of the patent at issue for purposes
3 of determining a reasonable royalty. *Id.* at 2. Despite plaintiff’s arguments that they
4 were too far removed from the reasonable royalty calculation to be relevant to damages,
5 the court found the relative values of the patents sold together were relevant to damages
6 as to the single patent at issue. *Id.* at 1, 3 (citing *Integra*, 331 F.3d at 871) (other citations
7 omitted)

8 This case provides support for ESET’s assertion that an opposing party’s
9 valuations can be relevant to a damages calculation. (ECF 849 at 3, 6 (Arguing
10 valuations are “highly relevant to determining the value of the ’305 patent” and “bear
11 directly on Finjan’s highly-inflated damages claims for the other asserted patents-in-
12 suit.”).) Additionally, the finding that values of other patents sold in the same group are
13 relevant to the value of a single patent at issue would suggest that valuations of other
14 patents sold in a portfolio with the ’305 could be within the limited scope of discovery
15 permitted here, discovery as to the ’305. Valuations of other patents sold in the
16 acquisition may reflect how much or little of the acquisition price should be attributed to
17 the ’305.

18 However, even as broad as the discovery authorized in this case is, it would not,
19 for example, require production of “*All documents* provided . . . prior to the acquisition . .
20 . *referring to or related to* any of the patents-in-suit” (RFP 223 (emphasis added)) or any
21 documents or communications that only relate or refer to valuations (RFPs 222, 226, 230,
22 and 231). The court specifically excluded the broad language used in ESET’s RFPs,
23 “documents that ‘refer or relate to’” the specific documents the court ordered produced.
24 *Id.* at 3. Additionally, the court’s primary basis for allowing discovery into the valuation
25

26
27 ¹⁰ The parties had already agreed that documents reflecting the value of the patent at issue
28 and the other patents sold with it that were at issue in other litigations with the same
parties would be produced. *Id.* at 2.

1 documents is determination of “the price paid to acquire all rights to a patent” because
2 that “may be considered in assessing a reasonable royalty for a hypothetical license to the
3 patent.” *Id.* at 2-3 (citing *Integra*, 331 F.3d at 871 and collecting cases addressing
4 experts’ and juries’ reliance on values of patents in sales).

5 The Court is not convinced that every document or communication exchanged in
6 relation to this acquisition is relevant. Rather, under this court’s rationale, only a
7 document that places an actual value on a patent that is sold would be relevant to
8 determine the portion of the total amount paid that should be attributed to one patent or
9 another. Documents valuing patents sold together are relevant to determine what portion
10 of the price is attributable the patent at issue, here the ’305. Additionally, the
11 proportionality analysis here is very different. There, the court found the very broad
12 discovery proportional to the needs of the case primarily based on the \$1.1 billion at
13 issue. *Id.* at 3-4. Although neither party has addressed it here, a review of Finjan’s
14 Complaint confirms there is certainly not \$1.1 billion at issue. Fed. R. Civ. P. 26 (Listing
15 among others, amount in controversy as a proportionality factor). Production of
16 essentially every communication or document related to this acquisition or even related to
17 a valuation is not proportional to the needs of this case.

18 The only other discovery decision ESET relies on for the relevancy of the
19 valuation RFPs, *Fresenius Medical v. Baxter*, authorizes discovery beyond actual
20 valuations, including some similar to ESET’s here. 224 F.R.D. at 653. For example, one
21 seeks all documents relating to one party’s evaluation, purchase, and acquisition of the
22 other. *Id.* However, the analysis is very brief and only states the acquisition price and
23 allotment of it to a particular patent is relevant. *Id.* (citing *Integra*, 331 F.3d at 871).
24 Additionally, the court appears to rely on the absence of proposed alternatives to narrow
25 the RFPs and a lack of other available documents regarding the valuation of the patents-
26 in-suit. *Id.* at 654.

27 The final case ESET relies on as to the valuation RFPs is also cited as supporting
28 the discovery authorized in both *Fresenius* and *Uniloc*. The *Integra* decision recognizes

1 that the purchase price for an acquisition that includes patents at issue in a case could be
2 of consequence to the calculation of a reasonable royalty. 331 F.3d at 870-71. After
3 identifying numerous other problems with a \$ 15 million jury verdict for infringement
4 and finding the “royalty also [did] not appear to take into account numerous factors that
5 would considerably reduce the value of a hypothetical license” the court cited as an
6 example a potential discrepancy between an acquisition price and the verdict. *Id.* The
7 court explained that the \$15 million jury award for infringement of only some patents
8 “seem[ed] unbalanced” with a \$20 million acquisition that included all the company’s
9 patents, products, and know-how. *Id.* As Finjan accurately points out, ESET already has
10 the acquisition price to take into account. In that respect, ESET has the piece of
11 information the court indicated should have been considered.

12 There is also a factual distinction the parties do not address. The *Integra* court
13 found the jury’s verdict, based on a hypothetical negotiation, out of balance with an
14 acquisition price when the acquisition took place within one or two years of the
15 hypothetical negotiation. *Id.* at 870-71 (Hypothetical negotiation in 1994 or 1995 and
16 acquisition in 1996). It is not entirely clear from the parties’ briefing that a similar
17 imbalance would be relevant when, as here, the hypothetical negotiation and acquisition
18 are farther apart. “A ‘reasonable royalty’ contemplates a hypothetical negotiation
19 between the patentee and the infringer at a time before the infringement began.” *Riles v.*
20 *Shell Expl. and Prod. Co.*, 298 F.3d 1302, 1311 (Fed. Cir. 2002) (citing *Hanson v. Alpine*
21 *Valley Ski Area, Inc.*, 718 F.2d 1075, 1078, (Fed. Cir. 1983)); *see also Wordtech*, 609
22 F.3d at 1319 (citing *Lucent Techs.*, 580 F.3d at 1324–25) (“The hypothetical negotiation
23 attempts to ascertain the royalty upon which the parties would have agreed had they
24 successfully negotiated an agreement just before infringement began and necessarily
25 involves an element of approximation and uncertainty.”) Finjan’s Complaint alleges the
26 ’305 was issued in 2011 and Finjan informed ESET of its alleged infringement of the
27 ’305 in 2015. (ECF 1 ¶¶ 16, 79.)

1 Despite neither party addressing this distinction, the Court’s own review of cases
2 suggests that even when there are significant time gaps between the hypothetical
3 negotiation and an acquisition of a company with its patents or the purchase of patents,
4 the acquisition may still be relevant. *Comcast Cable Comms., LLC v. Spring Comms.*
5 *Co., LP*, 262 F. Supp. 3d 118, 145-146 (E.D. Penn. 2017) (Noting some difference in
6 bargaining position between 2005 hypothetical negotiation and 2010 purchase of a
7 portfolio of patents that included the patent at issue, but finding sufficient evidence
8 bargaining position was comparable); *Personal Audio, LLC v. Apple, Inc.*, 2011 WL
9 3269330, at *9-11 (E.D. Tex. July 29, 2011 (jury properly considered 2008 offer to sell a
10 patents-in-suit when hypothetical negotiation was in 2001). The Court does not find the
11 acquisition entirely irrelevant to the hypothetical negotiation on this basis.

12 Another relevancy issue unexplained is how the values Finjan might have assigned
13 to its infringement claims as to ESET or in other Finjan litigations (RFPs 230-231) in the
14 context of selling the patents and their associated litigation to Fortress would be
15 comparable to or used by an expert to calculate a reasonable royalty based on a
16 hypothetical negotiation between Finjan and ESET.¹¹ Although the Court understands
17 ESET is arguing the discrepancy between the acquisition price and Finjan’s higher
18 reasonable royalty calculation based on the hypothetical negotiation means Finjan’s
19 expert’s calculation is inflated, the hypothetical negotiation to license a patent is not the
20 same as a transaction to purchase the patents and their litigation. As one court explained,
21 when “the thing being valued in the transaction [is] this litigation,” the “transaction . . . is
22 not comparable to the hypothetical negotiation.” *In re ChanBond, LLC Patent Litig.*,
23 2020 WL 550786, at *2 (D. Del. Feb. 4, 2020). “Instead of being an agreement between
24

25
26 ¹¹ The Court does not necessarily expect ESET to provide an expert opinion explaining
27 how this information would be used. However, the absence of any explanation how
28 valuations beyond the actual patents could be used, particularly when the RFPs on their
face are overbroad, leaves the Court with little to rely on to find the RFPs seek relevant
discovery.

1 a party who has a patent and a party that wants to be able to use the patent, it is an
2 agreement between two parties who want to be on one side of that transaction, that of
3 licensor.” *Id.* (Excluding as unreliable a portion of an expert opinion that was based on
4 two completed transactions and statements made during the same time period).¹²

5 The Court is only persuaded that valuations of the patents conveyed in the
6 acquisition are relevant based on the cases discussed above and numerous other cases that
7 have found the value given for a patent relevant to determination of a reasonable royalty
8 based on a hypothetical negotiation. *Endress Hauser, Inc. v. Hawk Measurement Sys.*
9 *Pty. Ltd.*, 892 F. supp. 1123, 1133 (S.D. Ind. 1995) (“Where, as here, the current patent
10 owner purchased the patent, the value of the consideration given in exchange for the
11 patent may be relevant to the determination of a reasonable royalty because it may bear
12 on the amount that might have been accepted by a prudent patentee who was engaging in
13 a hypothetical licensing negotiation”); *Parthenon Unified Memory Architecture LLC v.*
14 *Apple, Inc.*, 2016 WL 7670833, at *1-2 (E.D. Tex. Sept. 21, 2016) (Finding experts
15 could, but were not required to consider a patent purchase agreement in calculating a
16 reasonable royalty based on hypothetical negotiation).

17 The Court finds valuations of the ’305 or patents sold with it and documents
18 allocating the acquisition price among the patents are relevant. (RFPs 222, 226, and
19 227.) These valuations or allocations may indicate what portion of the acquisition price
20 is attributable to the ’305 and, based on the cases discussed above this may be relevant to
21 the hypothetical negotiation. However, these RFPs are limited to documents assigning a
22

23
24 ¹² This case and others cited in this section have determined that experts and juries have
25 appropriately considered certain pieces of information in determining a reasonable
26 royalty. The Court’s reliance on these cases for purposes of determining what discovery
27 is relevant is not a determination or indication what could reliably be considered by an
28 expert or jury in this case. Rather, the Court considers them to address the broader
question of relevancy. *See* Fed. R. Civ. P. 26(b)(1) (“Information within this scope of
discovery need not be admissible in evidence to be discoverable”). It is

1 value to a patent conveyed in the acquisition or indicating an allocation among them.
2 This would include a communication or document that compares the value of the patents.
3 Communications or documents that only relate to or regard valuations are overbroad and
4 not proportional.

5 Similarly, RFP 223, seeking all documents provided to Fortress related to any of
6 the patents-in-suit is overbroad and Finjan is not required to respond to it. Additionally,
7 the Court is not persuaded that valuations of its claims in all its litigations (RFP 230) or
8 against ESET (RFP 231) are relevant to the calculation of a reasonable royalty. The
9 further the requests are removed from the actual values of the patents conveyed, the less
10 relevant they are to the hypothetical negotiation, the basis argued for relevancy. Not only
11 do the cases relied on not support it, there is also not sufficient explanation how they
12 would be relevant to the case. Similarly, it is not clear how all communications between
13 Finjan and any of its shareholders regarding the acquisition would be relevant. (RFP
14 229.) Other than arguing they are relevant to standing, addressed below, ESET only
15 asserts they would be relevant to the value Finjan attributed to this litigation and Finjan's
16 damages claims, but there is no explanation how this would be relevant and there are no
17 cases cited in support on this point. Accordingly, Finjan is not required to respond to
18 RFPs 229-231.

19 (2) RFPs Regarding ESET

20 ESET argues "documents regarding ESET shared between Fortress and Finjan,
21 including whether to replace counsel after the ESET mistrial, may relate to any or all
22 aspects of this action, and therefore are also relevant." (ECF 849 at 6.) This argument is
23 associated with RFP 224. (ECF 849 at 6 n.7.) Given the reference to replacement of
24 counsel, the Court presumes ESET also intends to cover RFP 225 because it relates to
25 replacement of counsel.

26 RFP 224:

27 All Documents provided to Fortress Investment Group LLC prior to the
28 acquisition of Finjan referring or relating to ESET.

1
2 RFP 225:

3 All Documents provided to Fortress Investment Group LLC prior to the
4 acquisition of Finjan referring or relating to substituting Kramer Levin as
5 counsel of record in any Finjan Litigation, including this litigation.

6 As noted above, Rule 26(b)(1) indicates that parties are entitled to “discovery
7 regarding any non-privileged matter that is relevant to any party’s claim or defense and
8 proportional to the needs of the case.” ESET has not explained how documents provided
9 to Fortress prior to the acquisition referring or related to ESET are relevant to a claim or
10 defense. And, it certainly has not explained how documents relating to Finjan’s choice of
11 counsel in any litigation it is engaged in would be relevant to a claim or defense in this
12 case. The Court understands that the documents might relate in some respect to this case
13 because ESET is the defendant in this case, but that does not make the discovery sought
14 relevant to a claim or defense or proportional to the needs of the case. Finjan is not
15 required to produce documents responsive to these RFPs.

16 **(3) Standing**

17 ESET seems to argue that standing is an additional basis to establish the relevancy
18 of the RFPs as a general matter; no specific RFPs are cited on this point.¹³ (ECF 849 at
19 3.) ESET asserts in a footnote that “Finjan has provided ESET with no discovery
20 regarding Finjan, LLC’s standing to continue to assert the patents-in-suit as a result of
21 any corporate restructuring.” (ECF 849 at 2 n.1.) Other than saying “Finjan bears the
22 burden of proving its right to maintain suit,” ESET fails to explain why Finjan would
23 automatically be required to produce documents related to its standing. ESET seems to
24 be arguing that Finjan is automatically required to produce discovery related to standing
25

26
27 ¹³ As discussed above, to the extent ESET is seeking to reopen discovery more broadly
28 than the limited discovery allowed as to the ’305, that request, made in a footnote is
denied because it has not been properly raised with the Court.

1 as a result of its acquisition but cites no Federal Rule of Civil Procedure or case that
2 stands for the proposition that standing is automatically an issue as the result of an
3 acquisition. (*Id.*) Additionally, Finjan indicates that its entity conversion documents are
4 publicly available with the Delaware Secretary of State. (*Id.* at 17.) Without some basis
5 to think that Finjan's standing is somehow at issue as a result of this acquisition, the only
6 basis referenced by ESET, the Court is not going to order Finjan to respond to broad
7 RFPs regarding almost every aspect of this acquisition.

8 (4) Remaining RFPs

9 There is little analysis by either party as to the relevancy of the remaining two
10 RFPs. ESET simply asserts they are relevant because invalidity, unenforceability, and
11 prior art are relevant. (ECF 849 at 6-7.) Finjan does not specifically address them at all,
12 only arguing as with all the other RFPs that they are not within the scope of authorized
13 discovery, '305 discovery. (*Id.* at 12-13, 16-18.)

14 RFP 232:

15 All Communications between Finjan, Inc. or Finjan Holdings, Inc. and
16 Fortress Investment Group LLC regarding any potential invalidity or
17 unenforceability of any of the Patents-in-Suit.

18 RFP 233:

19 All Communications between Finjan, Inc. or Finjan Holdings, Inc. and
20 Fortress Investment Group LLC regarding any prior art to any of the
21 Patents-in-Suit.

22 On their face, these RFPs seek discovery on relevant topics, but they are beyond
23 the scope of discovery authorized by the Court, '305 discovery, in seeking discovery on
24 these topics as to all the patents-in-suit. Unlike the RFPs discussed above, here, there is
25 no explanation or cases cited for the proposition that prior art, invalidity or enforceability
26 of all the patents-in-suit is relevant to the '305. However, while Finjan objects that these
27 RFPs are beyond the scope of the '305, it does not otherwise explain why these topics
28 would not be relevant if limited to the '305. Even when narrowed to only '305, the Court

1 has concerns that these may be duplicative or cumulative of discovery already produced
2 regarding these topics, but in the absence of any argument from Finjan, the Court will
3 simply narrow them to the '305. *Gordon*, 2019 WL 2177656, at *4 (“Once the party
4 seeking discovery establishes that a request seeks relevant information, the party who
5 resists discovery has the burden to show discovery should not be allowed, and has the
6 burden of clarifying, explaining, and supporting its objections.”) (citations omitted); *see*
7 *also Global Ampersand, LLC*, 261 F.R.D. at 499.

8 **B. Common Interest Protection**

9 **1. Parties' Positions**

10 Finjan argues that documents responsive to these RFPs are protected by attorney
11 client privilege, the work product doctrine, and the common interest protection. (ECF
12 849 at 12, 15-16, 18-21.) Finjan asserts that Finjan and Fortress entered into a non-
13 disclosure agreement (“NDA”) and common interest agreement (“CIA”) as part of
14 Fortress’ due diligence process for its eventual acquisition of Finjan and that these
15 agreements “contemplate the exchange of privileged and attorney work product
16 information while ensuring confidentiality of that information.” (*Id.* at 13.)

17 ESET argues Finjan has not met its obligation in establishing the privilege due to
18 deficiencies in its privilege log (*id.* at 7, 10), any privilege that may have existed was
19 waived by disclosure to Fortress during the course of the arms-length transaction (*id.* at
20 7-8), and the common interest protection does not apply because Finjan and Fortress do
21 not and did not have a common legal interest (*id.* at 7-11).

22 **2. Legal Standards**

23 **a) Attorney-Client Privilege**

24 Information is covered by the attorney-client privilege if it meets an eight-part test:

25 (1) Where legal advice of any kind is sought (2) from a professional
26 legal adviser in his capacity as such, (3) the communications relating to
27 that purpose, (4) made in confidence (5) by the client, (6) are at his
28 instance permanently protected (7) from disclosure by himself or by the
legal adviser, (8) unless the protection be waived.

1 *United States v. Ruehle*, 583 F.3d 600, 607 (9th Cir. 2009) (citations omitted). The
2 burden is on the party asserting the privilege to establish all elements of the privilege.
3 *United States v. Martin*, 378 F.3d 988, 999-1000 (9th Cir. 2002); *United States v. Bauer*,
4 132 F.3d 504, 507 (9th Cir. 1997) (citation omitted); *see also Weil v. Inv./Indicators*,
5 *Research & Mgmt., Inc.*, 647 F.2d 18, 25 (9th Cir. 1981) (“As with all evidentiary
6 privileges, the burden of proving that the attorney-client privilege applies rests not with
7 the party contesting the privilege, but with the party asserting it.”). The privilege is
8 narrowly construed. *Trammel v. United States*, 445 U.S. 40, 50 (1980); *Martin*, 278 F.3d
9 at 999 (“[b]ecause it impedes full and free discovery of the truth, the attorney-client
10 privilege is strictly construed.”).

11 **b) Waiver**

12 As a general rule, “attorney-client communications made ‘in the presence of, or
13 shared with, third-parties destroys the confidentiality of the communications and the
14 privilege protection that is dependent upon that confidentiality.” *Nidec Corp. v. Victor*
15 *Co. of Japan*, 249 F.R.D. 575, 578 (N.D. Cal. 2007); *see In re Pac. Pictures Corp.*, 679
16 F.3d 1121, 1126-27 (9th Cir. 2012) (“[V]oluntarily disclosing privileged documents to
17 third parties will generally destroy the privilege.”); *Cohen v. Trump*, No. 13-CV-2519-
18 GPC WVG, 2015 WL 3617124, at *13 (S.D. Cal. June 9, 2015) (“As a general rule, the
19 attorney-client privilege is waived by voluntary disclosure of private communications to
20 third parties.”). Further, the voluntary disclosure of privileged attorney-client
21 communications constitutes waiver of the privilege as to all other such communications
22 dealing with the same subject matter. *United States v. Zolin*, 809 F.2d 1411, 1415 (9th
23 Cir. 1987). Any disclosure inconsistent with maintaining the confidential nature of the
24 attorney-client relationship waives the privilege. *Id.*

25 **c) Common Interest or Joint Defense Privilege**

26 The “common interest” protection, is an exception to the rule that disclosure of an
27 attorney-client communication to a third party destroys the confidentiality and thereby
28 waives the privilege. *Nidec*, 249 F.R.D. at 578. The Ninth Circuit has recognized that the

1 purpose of this privilege is to allow persons with a common interest to “communicate
2 with their respective attorneys and with each other to more effectively prosecute or
3 defend their claims.” *United States v. Gonzalez*, 669 F.3d 974, 978 (9th Cir. 2012)
4 (quoting *In re Grand Jury Subpoena*, 902 F.2d 244, 249 (4th Cir. 1990)). However, this
5 is not “a separate privilege.” *Pac. Pictures*, 679 F.3d at 1129. Instead, it is an extension
6 of the attorney-client privilege, *Gonzalez*, 669 F.3d at 978, that saves an otherwise
7 waived privileged communication only where the communication is shared with the third
8 party to further a matter of common legal interest, and the privilege itself has not
9 otherwise been waived by the party who made the communication. *Nidec*, 249 F.R.D. at
10 578-80. The common interest exception “applies where (1) the communication is made
11 by separate parties in the course of a matter of common interest; (2) the communication is
12 designed to further that effort; and (3) the privilege has not been waived.” *United States*
13 *v. Bergonzi*, 216 F.R.D. 487, 495 (N.D. Cal. 2003).

14 Although an agreement need not necessarily be written, *Gonzalez*, 669 F.3d at 979,
15 the asserting party must produce adequate proof of the existence of a common interest
16 agreement, showing why the privilege is applicable. *Whitney v. Tallgrass Beef Co. LLC*,
17 No. 13 C 7322, 2015 WL 3819373, at *4 (N.D. Ill. June 18, 2015). (Agreement “may be
18 implied from conduct and situation, such as attorneys exchanging confidential
19 communications from clients who are, or potentially may be, co-defendants or have
20 common interest in litigation.”) There must be some evidence of an agreement to share
21 information for the specific purpose of coordinating a common legal defense. *See United*
22 *Food & Commercial Workers Local 1776 & Participating Employers Health & Welfare*
23 *Fund v. Teikoku Pharma USA*, No. 14-MD-02521-WHO, 2016 WL 5906590, at *5 (N.D.
24 Cal. Oct. 11, 2016) (“While Endo is correct that a joint defense agreement or other
25 agreement sufficient to create a common interest need not be in writing, there still must
26 be some evidence of an actual agreement between the parties.”); *N. Am. Rescue Prod.,*
27 *Inc. v. Bound Tree Med., LLC*, No. 2:08-CV-101, 2010 WL 1873291, at *4 (S.D. Ohio
28 May 10, 2010). “[A] shared desire to see the same outcome in a legal matter is

1 insufficient to bring a communication between two parties within [the privilege].” *Pac.*
2 *Pictures*, 679, F.3d at 1129.

3 **3. Analysis**

4 Based on the full scope of the RFPs discussed above, Finjan indicated in its
5 briefing that the documents that would be produced in response to these RFPs would
6 encompass advice from Finjan attorneys and attorney opinions regarding Finjan’s active
7 litigations, projections for damages from patent litigation, projections from licensing, and
8 other attorney analysis. (ECF 849 at 14.) The responsive documents and
9 communications shared between them would also have included opinions from Finjan’s
10 counsel regarding all these subjects for many defendants and potential licensees. (*Id.*)

11 Because the Court has narrowed the scope of these RFPs and found some need not
12 be responded to at all, the scope of documents and communications Finjan would be
13 producing has changed. Although the Court could speculate that it might be reduced
14 significantly, that is not clear.

15 The Court is not inclined to determine whether communications and documents are
16 protected by attorney-client privilege, whether the privilege has been waived by
17 disclosure to Fortress, and whether the common interest protection exception applies
18 based on Finjan and Fortress’ non-disclosure agreement NDA and CIA without knowing
19 what documents and communications are actually at issue. The Court could be making
20 findings regarding whether documents are protected by attorney client privilege when
21 they are no longer even at issue.

22 Accordingly, the next step in the Court’s analysis of this issue is to have Finjan
23 submit the documents and communications that are responsive to the narrowed RFPs
24 discussed above for *in camera* review along with the NDA and CIA. The Court can then
25 assess whether they are protected by attorney-client privilege and if the privilege was
26 waived by disclosure to Fortress or if the common interest protection applies.

27 ///

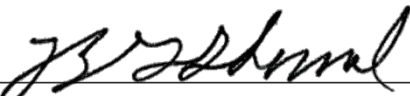
28 ///

1 **III. CONCLUSION**

2 Because the case is currently stayed as to the '305, the parties are not required to
3 proceed regarding this Order now. Rather, within seven days of the stay being lifted for
4 purposes of proceeding with the case as to the '305, the parties shall provide the Court
5 with a brief joint status report. It must indicate a date by which the documents responsive
6 to the narrowed RFPs and the NDA and CIA can be submitted for *in camera* review. The
7 status report must also indicate a date by which the parties will meet and confer regarding
8 their other discovery disputes and update the Court on their status. Because the parties
9 have indicated that the Court's order on this dispute may impact the parties' positions
10 regarding other discovery disputes, (ECF 849 at 4 n.5; ECF 858), the parties must briefly
11 indicate whether this decision resolves those disputes or if the Court's decision on the
12 common interest protection is needed before resolving those disputes.¹⁴

13 **IT IS SO ORDERED.**

14 Dated: April 20, 2021

15 
16 Hon. Bernard G. Skomal
17 United States Magistrate Judge
18
19
20
21
22
23
24
25
26

27 ¹⁴ Based on the information provided to the Court regarding these disputes, it would
28 appear the Court's relevancy conclusion above would at least narrow these disputes.