

1 evidence to be discoverable.” *Id.* District courts have broad discretion to
2 limit discovery where the discovery sought is “unreasonably cumulative or
3 duplicative, or can be obtained from some other source that is more
4 convenient, less burdensome, or less expensive.” Fed. R. Civ. P. 26(b)(2)(C).

5 An interrogatory may relate to any matter that may be inquired of
6 under Rule 26(b). Fed. R. Civ. P. 33(a)(2). The responding party must
7 answer each interrogatory by stating the appropriate objection(s) with
8 specificity or, to the extent the interrogatory is not objected to, by
9 “answer[ing] separately and fully in writing under oath.” Rule 33(b). The
10 responding party has the option in certain circumstances to answer an
11 interrogatory by specifying responsive records and making those records
12 available to the interrogating party. Rule 33(d).

13 Similarly, a party may request the production of any document within
14 the scope of Rule 26(b). Fed. R. Civ. P. 34(a). “For each item or category, the
15 response must either state that inspection and related activities will be
16 permitted as requested or state an objection to the request, including the
17 reasons.” Rule 34(b)(2)(B). If the responding party chooses to produce
18 responsive information, rather than allow for inspection, the production must
19 be completed no later than the time specified in the request or another
20 reasonable time specified in the response. *Id.* An objection must state
21 whether any responsive materials are being withheld on the basis of that
22 objection. Rule 34(b)(2)(C). An objection to part of a request must specify the
23 part and permit inspection or production of the rest. *Id.* The responding
24 party is responsible for all items in “the responding party’s possession,
25 custody, or control.” Rule 34(a)(1). Actual possession, custody or control is
26 not required. Rather, “[a] party may be ordered to produce a document in the
27 possession of a non-party entity if that party has a legal right to obtain the

1 document or has control over the entity who is in possession of the
2 document.” *Soto v. City of Concord*, 162 F.R.D. 603, 620 (N.D. Cal. 1995).

3 DISCUSSION

4 A. REQUESTS FOR PRODUCTION (“RFPs”)

5 1. RFP No. 1

6 Alphatec requests the production of all information produced by
7 Plaintiff NuVasive in any opposition, litigation, patent office or other
8 proceedings relating to the validity, enforceability, infringement and other
9 aspects of the patents-in-suit. NuVasive’s objection that the term “produced”
10 is vague, is frivolous. NuVasive responded that it has responsive information
11 but only in electronic format and has invited Alphatec to meet and confer
12 regarding that information.

13 This Court subscribes to the view expressed in Principle No. 6 of the
14 Sedona Principles:

15 Responding parties are best situated to evaluate the procedures,
16 methodologies, and technologies appropriate for preserving and
17 producing their own electronically stored information.

18 *The Sedona Principles, Third Edition*, 19 SEDONA CONF. J. 1, Principle 6,
19 118 (2018). The Court also subscribes to Principles 1 and 3 which provide
20 that electronic discovery is generally subject to the same discovery
21 requirements as other relevant information and that the parties should seek
22 to reach agreement regarding production of electronically stored information.
23 *Id.* at 56, 71.

24 The parties refer to the Court’s Model Order Governing Discovery of
25 Electronically Stored Information in Patent Cases appended to the Patent
26 Local Rules. Although the applicability of the Model Order was discussed in
27 the parties’ Joint Discovery Plan, no version of the Order, or any Order

1 governing ESI production, appears to have been filed or granted by the Court.
2 Accordingly, the provisions of the Model Order are not relevant.

3 The result is that NuVasive is obligated to search its data, collect and
4 produce relevant, non-privileged information even without input from
5 Alphatec. NuVasive cannot delay production because Alphatec declines to
6 offer search terms. Alphatec, on the other hand, runs the risk that by not
7 participating in the process, any challenge it may raise to the reasonableness
8 of NuVasive's search may be viewed with some skepticism. NuVasive's
9 objections are overruled.

10 2. RFP No. 2

11 Alphatec seeks production of information regarding any transfer of
12 rights, assignment, license, proposed license, offer to assign or license, sale,
13 offer to sell, request for license, grants of rights, covenants not to sue,
14 indemnities, agreements not to assert patent rights, or settlements NuVasive
15 entered into the field of spinal fusion surgery, including but not limited to,
16 with respect to any of the patents-in-suit, any patent application leading to
17 the patents-in-suit, any related patent applications and patents, any foreign
18 counterparts, and/or any embodying product.

19 NuVasive, in response, has agreed to produce all executed patent
20 license agreements in the field of spinal fusion surgery and to produce
21 executed agreements, "however titled, responsive to this request that related
22 to the patents-in-suit or related patents." (ECF No. 117 at 22).¹ Alphatec
23 believes that it is entitled to more and that the information is relevant to
24 damages. The Court finds that NuVasive's agreement is sufficient to provide

25
26
27 ¹ The Court will refer to page numbering supplied by CM/ECF rather than original
page numbering throughout.

1 Alphatec what it needs. The Court finds that draft offers and draft licenses
2 need not be produced. The Court is not convinced of the relevance of draft
3 documents nor convinced that the effort of finding them is proportional to the
4 needs of the case.

5 NuVasive also has agreed to contact third parties implicated by these
6 disclosures to the extent that the agreements to be produced have
7 confidentiality clauses. Issues regarding such disclosures are not properly
8 before the Court at this time. Alphatec's motion to compel a further
9 response, beyond NuVasive's agreement is denied. To the extent this
10 information is stored electronically, NuVasive is not relieved of its obligation
11 to collect, analyze and produce such information that is responsive, relevant
12 and non-privileged.

13 3. RFP No. 3

14 This RFP is related to RFP No. 2. Alphatec seeks production of
15 documents reflecting payments made by sale or royalty for the agreements
16 produced in connection with RFP No. 2. NuVasive has agreed to produce this
17 information consistent with its agreement to produce the underlying
18 agreements. Alphatec complains that NuVasive intends to produce this
19 information in a summary format as opposed to the actual transaction
20 documents. The Court finds that a summary production is sufficient at this
21 time. If Alphatec, after receipt and review of the summary documents is
22 unsatisfied, the parties must meet and confer and agree on a number of
23 transactions for which NuVasive will produce the underlying documentation
24 to verify that the summary provided is accurate. NuVasive also has agreed
25 to contact third parties implicated by these disclosures to the extent that the
26 agreements to be produced have confidentiality clauses. Issues regarding
27 such disclosures are not properly before the Court at this time. To the extent

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