UNITED STATES DISTRICT COURT
DISTRICT OF NEW JERSEY

OANDA CORPORATION Plaintiff, v. GAIN CAPITAL HOLDINGS, INC. et al, Defendants.	Civil Action No. 20-5784 (ZNQ)(DEA) **MEMORANDUM ORDER**

THIS MATTER comes before the Court on OANDA Corporation's ("Plaintiff") Motion to Compel Production of Data from GAIN's JIRA System. ECF No. 173. Defendants oppose the Motion. ECF No. 178. The Court decides this Motion without oral argument pursuant to Federal Rule of Civil Procedure 78 and Local Civil Rule 78.1. For the reasons below, the Court **DENIES** Plaintiff's Motion.

I. Background and Procedural History

The parties are familiar with the history of the case and the facts pertaining to the present Motion. As such, the Court will not recite them at length. On April 19, 2021, OANDA ("Plaintiff") filed an Amended Complaint alleging that its competitor GAIN's foreign exchange trading technologies infringe two of Plaintiff's patents, U.S. Patents No. 7,146,336 (the '336 Patent) and No. 8,392,311 (the '311 Patent) (collectively the "Patents"). ECF No 58. These patents claim systems and methods for online currency trading that improve upon prior art online currency trading. Specifically, the Amended Complaint alleged Defendants have infringed one or more claims of the Patents by making, using, selling, offering for sale, or selling products and/or services that meet each of the limitations of one or more claims of the Patents. *Id.* at 21-22.

Plaintiff filed the present Motion to Compel on May 10, 2023, seeking the production of data from JIRA, an issue tracking and project management software employed by GAIN during the relevant period. ECF No. 173. Specifically, Plaintiff seeks data from JIRA because "JIRA is the software tool GAIN has used to track when particular versions of the accused products were deployed or retired," and "JIRA thus contains material technical information, including information relevant to understanding the design and function of GAIN's accused products, as well as when particular versions of the software were deployed." *Id.* at 4.

Defendants argue the Motion should summarily be denied, for several reasons. ECF No. 178 at 8. Background provided by Defendants covers that 1) JIRA is simply a third party tracking and management software, and not used to "conduct substantive work," thus, "source code and technical documents are stored elsewhere" and likely have already been produced by GAIN; 2) JIRA is used by departments across GAIN and this will contain confidential customer, employee, and privileged material; 3) GAIN has spent time and resources looking into alternative means to produce JIRA materials, identifying ONNA, a third party software to assist with OANDA's request for production in a specific manner; and 4) Plaintiff refuses to bear the costs associated with using ONNA (~$14,500). *Id.* at 9-13.

II. Argument

A. Legal Standards

"A party seeking discovery may move for an order compelling. . . production, or inspection." The motion can be made where "a party fails to produce documents." Fed. R. Civ. P. 37(a)(3)(B)(iv). The Third Circuit has previously upheld a denial of a Motion to Compel Discovery where the party moving to compel "never forwarded interrogatories, nor a request for production of documents" to the adverse party and thus, "pursuant to Rule 37, the prerequisite for compelling

discovery was never fulfilled." *Petrucelli v. Bohringer & Ratzinger*, 46 F.3d 1298, 1311 (3d Cir. 1995).

Parties may obtain electronically stored information ("ESI") that is relevant, non-privileged, and reasonably accessible, subject to discovery limitations set out in Rule 26(b)(2)(C). Fed. R. Civ. P. 26(b)(1); (b)(2)(B)-(C). Where it is shown that the source of ESI is not reasonably accessible, "[t]he decision whether to require a responding party to search for and produce information that is not reasonably accessible depends not only on the burdens and costs of doing so, but also on whether those burdens and costs can be justified in the circumstances of the case." Advisory Committee Notes to Fed.R.Civ.P. 26(b)(2)(B), 2006 Amendment. Factors to consider in such circumstances are:

> (1) the specificity of the discovery request; (2) the quantity of information available from other and more easily accessed sources; (3) the failure to produce relevant information that seems likely to have existed but is no longer available on more easily accessed sources; (4) the likelihood of finding relevant, responsive information that cannot be obtained from other, more easily accessed sources; (5) predictions as to the importance and usefulness of further information; (6) the importance of the issues at stake in the litigation; and (7) the parties' resources.

Id. The requesting party bears the burden of showing that its "need for the discovery outweighs the burdens and costs of locating, retrieving, and producing the information." *Id.* The responding party bears the burden of "whether the identified sources are not reasonably accessible in light of the burdens and costs required to search for, retrieve, and produce whatever responsive information may be found." *Id.*

Rule 34 governs the production of ESI. Under Rule 34(b), "[u]nless otherwise stipulated or ordered by the court, these procedures apply to producing documents or electronically stored information:"

> (i) A party must produce documents as they are kept in the usual course of business or must organize and label them to correspond to the categories in the request;
>
> (ii) If a request does not specify a form for producing electronically stored information, a party must produce it in a form or forms in which it is ordinarily maintained or in a reasonably usable form or forms; and
>
> (iii) A party need not produce the same electronically stored information in more than one form.

Fed. R. Civ. P. 34(b)(2)(E); *Peterson v. Matlock*, 2014 WL 5475236, at *1 (D.N.J. Oct. 29, 2014).

In multiple instances, this District has "declined to permit requests for additional, voluminous productions of discovery where it found the discovery would be cumulative, burdensome, and/or expensive." *Lincoln Adventures, LLC v. Those Certain Underwriters at Lloyd's London Members of Syndicates*, 2020 WL 13158012, at *10 (D.N.J. Oct. 14, 2020) (collecting cases).

B. RFP Nos. 4, 33-35, 37-38

The Court is inclined to deny the Motion at the outset because Plaintiff failed to make a formal and specific discovery request for JIRA materials before filing the present Motion. *See Petrucelli v. Bohringer & Ratzinger*, 46 F.3d 1298, 1311 (3d Cir. 1995). The Court will examine the RFPs identified by Plaintiff that it purports JIRA materials are responsive to.

RFP No. 4 sought "[d]ocuments sufficient to show the design, function, and operation" of each version of the accused products. Plaintiff does not appear to argue that GAIN did not provide such documents. Rather, Plaintiff takes issue that the response "did not include any data from JIRA." ECF No. 173 at 6. The Court agrees with Defendants that Plaintiff's issue with this RFP is that "GAIN did not satisfy its production obligations in the exact manner [Plaintiff] desired." ECF No. 178 at 16.

RFP No. 33 sought "[a]ll computer files including but not limited to the following: source code, object code, compiled executables, build scripts, deployment scripts, server configuration files, or other electronic information presently in use in the compiling, assembling, building, deployment, or provision of the accused products or any portion thereof, whether for use internally or by GAIN's customers, including but not limited to direct customer end users or white label customers." Based on Defendants description of JIRA, as a task list type tracking tool, the Court is not convinced that JIRA materials would be responsive to RFP No. 33. With no explanation from Plaintiff demonstrating otherwise, there is no basis for compelling Defendants to produce JIRA materials in response to this RFP.

RFP No. 34 sought "[a]ll documents identifying the source code (or source code repositories) used to implement any aspect of the accused products." RFP No. 35 sought the same but for the date range of May 10, 2014 and present. Defendants objected to these requests because they were duplicative of RFP No. 29 and even if JIRA materials were responsive, such materials would have been "entirely cumulative" of documents already provided. Defendants argue "searching JIRA for even more would be duplicative, unduly burdensome, and disproportionate to the needs of the case." ECF No. 178 at 17.

RFP No. 37 sought "[a]ll documents or communications supporting or refuting your allegation that 'GAIN has not infringed, and does not infringe, directly or indirectly, any valid and enforceable claim of the '336 Patent." RFP No. 38 sought the same but for claim of the '311 Patent. Defendants argue "[a]s GAIN does not currently intend to rely on the JIRA Materials for its contentions and, thus, the JIRA Materials are not responsive to RFP Nos. 37 and 38." *Id.*

C. Relevance of JIRA Materials

Plaintiff's further "evidence" that relevant or non-cumulative documents exist within JIRA falls flat. First, upon review of Mr. Leach's testimony, the Court is unable to identify where Mr.

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