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GUARDIAN ALLIANCE TECHNOLOGIES, INC.

IN THE UNITED STATES DISTRICT COURT

FOR THE EASTERN DISTRICT OF CALIFORNIA

SACRAMENTO DIVISION

In the Matter of Subpoena to GUARDIAN ALLIANCE TECHNOLOGIES, INC.,

Nonparty,

MILLER MENDEL, INC.; and TYLER MILLER,

Plaintiffs,

v.

THE CITY OF OKLAHOMA CITY,

Defendant.

Case No. 2:20-AT-00083

NONPARTY GUARDIAN ALLIANCE TECHNOLOGIES INC'S MOTION TO QUASH THE GUARDIAN SUBPOENA AND BRIEF IN SUPPORT

(Subpoena issued from U.S. District Court for the Western District of Oklahoma, *Miller Mendel, Inc. et al. v. The City of Oklahoma City*, No. CIV-18-990-JWD)

Guardian Alliance Technologies, Inc., pursuant to Fed. R. Civ. P. 45(d)(3), moves to quash the nonparty subpoena (the "Guardian Subpoena") served upon it on January 7, 2020 by Tyler Miller and Miller Mendel, Inc. (collectively "Miller Mendel") and noting compliance for January 24, 2020 at LDA and Associates dba Legal Document Assistants, 3550 Watt Avenue, Suite 140, Sacramento, CA 95821. The Guardian Subpoena was served pursuant to a patent infringement lawsuit in the United States District Court for the Western District of Oklahoma, captioned as *Miller Mendel, Inc. et al. v. The City of Oklahoma City*, Case No. CIV-18-990-JWD. As the Guardian

Subpoena is unduly burdensome, overly broad, seeks irrelevant information not proportional to the needs of the case, and seeks Guardian's trade secret, proprietary, and confidential information without any account for the proper handling of such information, the Court should grant this motion to quash the Guardian Subpoena.

The Guardian Subpoena, Guardian's objections thereto, and this potential Motion were discussed with opposing counsel on December 30, 2019.

DATED: January 24, 2020

COLEMAN & HOROWITT, LLP

By: /s/ Sherrie M. Flynn
DARRYL J HOROWITT
SHERRIE M. FLYNN
Attorneys for Nonparty
GUARDIAN ALLICANCE
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MEMORANDUM OF POINTS AND AUTHORITIES

INTRODUCTION AND BACKGROUND

The Guardian Subpoena, attached hereto as Exhibit 1, was served pursuant to a patent infringement lawsuit in the United States District Court for the Western District of Oklahoma, captioned as *Miller Mendel, Inc. et al. v. The City of Oklahoma City*, Case No. CIV-18-990-JWD, in which Miller Mendel accuses Guardian's customer, the City of Oklahoma City ("OKC"), of infringing U.S. Patent No. 10,043,188 by virtue of OKC's use of Guardian Alliance Technologies' background investigation software platform. Miller Mendel did not originally include Guardian as a defendant in that suit, but is presently seeking leave of court to add Guardian as a defendant.

The Guardian Subpoena should be quashed because it seeks Guardian's fundamental business information relating to Guardian's background investigation platform, Guardian's financial information, Guardian's market strategy, as well as Guardian's overarching business plans. The scope of what Miller Mendel asks for is breathtaking: many of Miller Mendel's requests would be improper, even for a party defendant, which is the point, as Miller Mendel purposefully chose not to name Guardian as a defendant in the underlying lawsuit. In order to do so, Miller Mendel would have been required to sue Guardian for patent infringement in the U.S. District Court for the Eastern District of California—the only proper venue for Guardian under controlling precedent. Guardian is a nonparty to this litigation and, as a nonparty, the scope of permissible discovery Miller Mendel is entitled to obtain from Guardian is significantly narrowed and prescribed versus that of a party litigant.

From a facial reading of the Guardian Subpoena, it is apparent that Miller Mendel is attempting to quite brazenly flout the discovery rules for nonparty witnesses. The Guardian Subpoena demands production of numerous open-ended categories of documents and information without any restriction in temporal scope. As but one example of their overreach, Miller Mendel demands that Guardian produce ***all*** versions of its source code and supporting documentation—including versions of Guardian's software that were developed prior to the '188 Patent's issuance. It should also be noted that Miller Mendel demanded this information without a cursory mention of any proper procedural safeguards to maintain the confidential and highly proprietary nature of

Guardian's source code. If its request for source code wasn't enough, Miller Mendel further demands that Guardian produce its in-depth financial, marketing, and strategic business plans—types of information that have absolutely nothing to do with the claims of the present case. If Guardian were a party to this litigation, relief from Miller Mendel's subpoena would be proper since it is nothing more than a fishing expedition.

Regardless of any purported "litigation strategy" in originally omitting Guardian from this lawsuit, Miller Mendel cannot now creatively attempt to misuse a Rule 45 subpoena in order to circumvent the scope of nonparty discovery. As the Guardian Subpoena is unduly burdensome, overly broad, seeks irrelevant information not proportional to the needs of the case, and seeks Guardian's trade secret, proprietary, and confidential information without any account for the proper handling of such information, the Court should grant this motion to quash the Guardian Subpoena.

DISCUSSION

A. STANDARD GOVERNING MOTIONS TO QUASH NONPARTY SUBPOENAS

Fed. R. Civ. P. 26(b)(1) provides that "parties may obtain discovery regarding any nonprivileged matter that is relevant to any party's claim or defense and proportional to the needs of the case, considering the importance of the issues at stake in the action, the amount in controversy, the parties' relative access to relevant information, the parties' resources, the importance of the discovery in resolving the issues, and whether the burden or expense of the proposed discovery outweighs its likely benefit."

Fed. R. Civ. P. 45, in turn, governs discovery of nonparties by subpoena. Fed. R. Civ. P. 45(d) governs motions for protective orders and motions to quash subpoenas directed to nonparties, requires a party or attorney responsible for issuing and serving a subpoena to take reasonable steps to avoid imposing undue burden on the person subject to the subpoena, and mandates that a district court shall quash or modify such a subpoena if it "subjects a person to undue burden." Fed. R. Civ. P. 45(d)(1)-(3). The permissible scope of discovery under a Rule 45 subpoena is the same as the scope of discovery under Fed. R. Civ. P. 26 and 34. Fed. R. Civ. P. 45 Advisory Comm.'s Note

(1970) ("[T]he scope of discovery through a subpoena is the same as that applicable to Rule 34 and other discovery rules").

A court must quash or modify a subpoena that:

(i) Fails to allow a reasonable time to comply;

(ii) Requires a person to comply beyond the geographical limits specified in Rule 45(c);

(iii) Requires disclosure of privileged or other protected matter, if no exception or waiver applies; or

(iv) Subjects a person to undue burden.

Fed. R. Civ. P. 45(d)(3)(A)(i–iv). A court may quash or modify a subpoena if it requires:

(i) Disclosing a trade secret or other confidential research, development, or commercial information; or

(ii) Disclosing an unretained expert's opinion or information that does not describe specific occurrences in dispute and results from the expert's study that was not requested by a party.

Fed. R. Civ. P. 45(d)(3)(B)(i–ii).

Whether a subpoena imposes an undue burden on a witness is a case-specific inquiry that turns on "such factors as relevance, the need of the party for the documents, the breadth of the document request, the time period covered by it, the particularity with which the documents are described and the burden imposed." *Goodyear Tire & Rubber Co. v. Kirk's Tire & Auto Servicenter of Haverstraw, Inc.*, 211 F.R.D. 658, 662 (D. Kan. 2003) (quoting *Concord Boat Corp. v. Brunswick Corp.*, 169 F.R.D. 44, 53 (S.D.N.Y. 1996)). The courts are required to balance the need for the requested discovery against the burden imposed on the person ordered to produce documents, and the status of a person as a nonparty is a factor that weighs against disclosure. *Id.* at 662-63 (citing *Katz v. Batavia Marine & Sporting Supplies*, 984 F.2d 422, 424 (Fed. Cir. 1993)).

The overwhelming weight of authority agrees that status as a nonparty is a significant factor in determining whether responding to a subpoena poses an undue burden. *See, e.g., Cusumano v. Microsoft Corp.*, 162 F.3d 708, 717 (1st Cir. 1998) (cautioning against the "unwanted burden thrust upon non-parties" by overly intrusive or overbroad discovery requests and recognizing that non-

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