

**IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION**

**MOBILE TELECOMMUNICATIONS  
TECHNOLOGIES, LLC,**

**Plaintiff,**

v.

**BLACKBERRY CORPORATION,**

**Defendant.**

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**Civil Action No. 3:12-CV-1652-M-BK**

**ORDER**

Pursuant to the District Court’s orders of reference, [Doc. 223](#); [Doc. 227](#), the undersigned now considers Plaintiff Mobile Telecommunications Technologies, LLC’s *Motion to Compel Discovery*, [Doc. 221](#), and *Motion to Compel 30(b)(6) Depositions*, [Doc. 224](#). For the reasons that follow, the motions are **GRANTED IN PART**.

**I. BACKGROUND**

On May 29, 2012, Plaintiff Mobile Telecommunications Technologies, LLC, sued Defendant BlackBerry Corporation asserting infringement of five of Plaintiff’s patents -- [U.S. Patent Nos. 5,809,428 \(the “428 Patent”\)](#), [5,754,946 \(the “946 Patent”\)](#), [5,559,862 \(the “862 Patent”\)](#), [5,894,506 \(the “506 Patent”\)](#), and [5,581,804 \(the “804 Patent”\)](#) (collectively the “patents-in-suit”). [Doc. 1 at 1](#). Through a series of requests for production, Plaintiff sought expert infringement and damages reports, expert deposition transcripts, settlement or licensing agreements, and all non-privileged information related to those agreements (collectively the “Litigation Papers”) from five previous infringement suits brought against Defendant -- the

*Motorola, Softvault, Mformation, Prism, and SmartPhone* cases.<sup>1</sup> [Doc. 221 at 1-3](#). Defendant refused to produce the requested documents on the grounds that information from the prior lawsuits was irrelevant and that their production would be unduly burdensome given the existence of protective orders in those cases. [Doc. 222-1 at 174-75](#). Plaintiff argues that discovery is relevant to its infringement and damages analysis because the present litigation concerns systems and products “identical” to those at issue in the prior litigations (*e.g.*, BlackBerry smartphones/tablets, BlackBerry Enterprise Server, etc.). *Doc. 221 at 3, 5-6*.

Throughout the discovery period, Plaintiff has also sought corporate representative depositions through five Rule 30(b)(6) notices, to which Defendant has produced two witnesses, Jean-Paul Cormier and Randy Mishler. [Doc. 224 at 3-4](#). Plaintiff seeks additional witnesses to testify on Topics 5, 6, 7, 13, 25, and 26 from its Third Notice and Topics 1 to 27 and 30 to 37 from its Fifth Notice. [Doc. 224 at 5](#).

In the Third Notice, Topics 5, 6, and 7 each inquire into the process that occurs when a BlackBerry device switches between the channels (*e.g.*, Wi-Fi, cellular, etc.) that connect it to different wireless networks; Topic 13 concerns Defendant’s use of error correcting codes; and Topics 25 and 26 inquire into the process underlying the “get more” function on BlackBerry devices. [Doc. 233 at 67-69](#).

In the Fifth Notice, Topic 1 inquires about Defendant’s intellectual property licensing practices; Topics 2 and 3 seek licensing agreements and information regarding the negotiations

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<sup>1</sup> *Motorola, Inc. v. Research in Motion Limited*, No. 2:08-CV-0069 (E.D. Tex. 2008), [No. 3:10-CV-0048 \(N.D. Tex. 2010\)](#), [Certain Wireless Communication System Server Software, Wireless Handheld Devices and Battery Packs, Inv. No. 337-TA-706 \(U.S. Int’l Trade Comm’n\)](#) (collectively “*Motorola*”); *SoftVault Systems, Inc. v. Research in Motion Corp.*, No. 5:12-CV-5544 (N.D. Cal. 2012); [Mformation Techs., Inc. v. Research in Motion Ltd.](#), 830 F. Supp. 2d 815 (N.D. Cal. 2011); *Prism Techs. v. Research in Motion Ltd.*, No. 8:08-CV-0537 (D. Neb. 2008); *SmartPhone Techs. LLC v. Research in Motion Corp.*, No. 6:10-CV-0074 (E.D. Tex. 2010).

of such agreements; Topics 4 and 8 inquire into Defendant's strategy for marketing its mobile devices and messaging services; Topics 5 to 7, 9, 10, 15, and 19 seek information about the revenue, profits, cost savings, and value generated by BlackBerry services, software, and devices; Topics 11, 12, 20 to 22, and 30 inquire into the frequency with which emails, emoticons/emojis, "calendar sync" and "browser refresh" requests, and push messages are sent by BlackBerry device users; Topics 16, 23, and 26 inquire into the cost of materials, components, and infrastructure necessary to provide the accused BlackBerry products and services; Topic 13 inquires about documents provided to Defendant by a Mobile/Wireless Network Operator relating to data usage requirements; Topic 14 inquires about non-infringing alternatives to the accused messaging services; Topics 17 and 18 concern studies and analyses regarding the battery life of BlackBerry devices; Topics 24 and 25 inquire into the servers and relays utilized by Defendant's accused messaging services; Topic 27 inquires about the storage of data packets while sending MDP in the PINGING state; Topics 31, 32, and 33 each inquire into the process by which BlackBerry devices connect to and switch between transport channels (e.g., Wi-Fi, cellular, etc.) that connect it to a network; Topic 34 concerns the process by which the BlackBerry Network determines and updates the IP address of a BlackBerry device; Topics 35 and 36 inquire into the extent Defendant's systems track and store messages sent to a BlackBerry device; and Topic 37 inquires about whether messages sent to and from BlackBerry devices use RCP along with, or instead of, MDPv2. [Doc. 233 at 104-128](#).

Defendant refused to produce witnesses for the Third and Fifth Notice on the grounds that (1) Plaintiff was required to seek leave of court to depose additional corporate witnesses, and (2) the topics in the Third and Fifth Notice are duplicative of previously noticed topics. [Doc. 225-1 at 48](#); [Doc. 233 at 104-129](#). Plaintiff now seeks as order compelling production of the

Litigation Papers and additional 30(b)(6) deposition testimony on Plaintiff's Third Notice (Topics 5, 6, 7, 13, 25, and 26) and Fifth Notice (Topics 1-27 and 30-37). [Doc. 221](#); [Doc. 224](#).

**A. Motion to Compel Litigation Papers**

Plaintiff argues that because the prior cases involved the same BlackBerry devices and systems, the Litigation Papers contain information relevant to its infringement and damages inquiry. [Doc. 221](#) 5-6. Plaintiff contends that production of this "narrow category" of documents would not unduly burden Defendant, considering Defendant has made the same document requests on Plaintiff, with which Plaintiff complied at its own expense. [Doc. 221 at 6-7](#). In response, Defendant argues that it has already provided or agreed to provide relevant settlement and licensing agreements from the previous cases, stating further that *Mformation* is the only case in which expert reports exists. [Doc. 230 at 4](#), 10. Defendant further contends that the prior cases are not relevant merely because they concern the same devices and systems, asserting instead that a showing of relevancy must be more particularized. [Doc. 230 at 5-6](#). Lastly, Defendant maintains that producing the Litigation Papers would require modifying *Mformation's* protective order in the Northern District of California, unduly burdening the court, *Mformation*, and Defendant. [Doc. 230 at 9](#).

In reply, Plaintiff notes how its efforts to pursue the Litigation Papers through other means have been stymied by Defendant's dilatory tactics, such as repeated empty promises to "[look] into" Defendant's document requests. [Doc. 245 at 2-4](#). Additionally, Plaintiff argues that production of *Mformation's* expert reports would not be burdensome considering (1) the protective order allows Defendant to disclose its own discovery material -- which is all Plaintiff seeks -- without modifying the order, and (2) Defendant already disclosed confidential information from *SmartPhone* and *Prism*, both of which had protective orders. [Doc. 245 at 6](#).

Rule 26(b)(1) governs the scope of discovery, providing that “[p]arties may obtain discovery regarding any nonprivileged matter that is relevant to any party’s claim or defense” or “appears reasonably calculated to lead to the discovery of admissible evidence.” [FED. R. CIV. P. 26\(b\)\(1\)](#). Although discovery rules are given broad and liberal treatment, they do have “ultimate and necessary boundaries.” [Oppenheimer Fund, Inc. v. Sanders, 437 U.S. 340, 350-51 \(1978\)](#) (quoting [Hickman v. Taylor, 329 U.S. 495, 507 \(1947\)](#)). The moving party bears the burden of showing that the materials sought are relevant to the action or will lead to the discovery of admissible evidence. [Spiegelberg Mfg., Inc. v. Hancock, No. 3-07-CV-1314, 2007 WL 4258246 at \\*1 \(N.D. Tex. Dec. 3, 2007\)](#) (Fish, J.). Once the moving party establishes that the materials sought are within the permissible bounds of discovery, the burden shifts to the nonmovant to show why the discovery is irrelevant, overly broad, unduly burdensome, or should not be permitted. [Id.](#)

According to Defendant, out of its five previous lawsuits, only the *Mformation* case went to expert discovery; thus, no such expert infringement and damages reports exist regarding the *Motorola*, *SoftVault*, *Prism*, and *SmartPhone* cases. [Doc. 230 at 2](#). As to the other requested documents from these cases, Plaintiff has failed to adequately show their relevancy. Plaintiff’s arguments for discovery of Litigation Papers from the *Motorola*, *SoftVault*, *Prism*, and *SmartPhone* cases are predicated on the fact that the plaintiffs in those cases asserted patents against the same BlackBerry products and systems at issue here. [Doc. 221 at 1-3](#). While the Court of Appeals for the Fifth Circuit has yet to address this issue, other courts have refused to allow discovery of documents from prior litigations absent a specific showing of relevancy. [See In re Agent Orange Prod. Liab. Litig., 517 F.3d 76, 102-03 \(2d Cir. 2008\)](#) (upholding the refusal to compel production of documents from other litigations involving the same product where the

request was made “without any attempt . . . to tailor [it] to materials reasonably expected to produce relevant, non-duplicative information”); [In re Google Litig., No. 08-03172, 2011 WL 286173 at \\*9 \(N.D. Cal. Jan. 27, 2011\)](#) (denying motion to compel discovery of Google’s unrelated lawsuit where movant failed to make “any particularized showing that the additional discovery sought . . . [was] relevant” and “[chose] instead to speculate what the transcripts and reports ‘likely [contained].’”). The mere fact that prior litigations concern the same accused products and systems is not necessarily a particularized showing of relevancy -- rather, relevancy of past litigation documents is better determined by comparing the patents asserted in prior litigations with the patents-in-suit. See [High Point SARL v. Sprint Nextel Corp., No. 09-2269, 2012 WL 1533213 at \\*6-7 \(D. Kan. Apr. 30, 2012\)](#).

Here, the patents asserted in the prior litigations are entirely different from the patents-in-suit and do not concern the same or comparable functionalities as the patents-in-suit. The [’428](#), [’946](#), [’862](#), [’506](#), and [’804](#) Patents involve systems and devices for storing undeliverable messages, re-transmitting received messages that are incomplete or contain errors, adding the appropriate prefix to a received call-back number, receiving and sending “canned messages,” and enabling communication between a network and a mobile unit over a relatively large area, respectively. [Doc. 1 at 3-4](#). The *Motorola*, *SoftVault*, *Prism*, and *SmartPhone* cases involve a total of 27 patents; however, outside of one sentence concerning the *SmartPhone* case, Plaintiff is silent as to how the functions of these 27 patents are similar to the functions of the patents-in-suit. [Doc. 222-1 at 2-54](#). As a result, Plaintiff’s bare assertion that the Litigation Papers are relevant is too imprecise and conclusory as it relates to the *Motorola*, *SoftVault*, *Prism*, and *SmartPhone* cases. [In re Agent Orange, 17 F.3d at 102-03](#); [In re Google Litig., 2011 WL 286173 at \\*9](#). Moreover, the Court has reviewed the patents at issue in *Motorola*, *SoftVault*,

*Prism*, and *SmartPhone*, and it does not appear that they bear any clear relation to the patents-in-suit.

Conversely, Plaintiff has adequately demonstrated *Mformation*'s relevancy to the present case. Plaintiff specifically notes the overlapping functionalities of its ['428 Patent](#) and [U.S. Patent No. 6,970,917](#) ("the *Mformation Patent*"), which was at issue in that case. [Doc. 245 at 4-5](#). For example, Plaintiff's '418 Patent concerns the use of "probe messages" to determine the location of a mobile unit; similarly, the *Mformation Patent* concerns methods used to locate a mobile unit within a wireless network. *Compare* [U.S. Patent No. 5,809,428 \(filed July 25, 1996\)](#), with [U.S. Patent No. 6,970,917 \(filed Aug. 10, 2001\)](#). Given the similarity, the *Mformation* expert reports (which are the only category of the Litigation Papers sought that relate to *Mformation*) are relevant to Plaintiff's infringement and damages inquiry. [Doc. 245 at 6](#); *High Point SARL*, [2012 WL 1533213 at \\*7](#).

Defendant's argument that producing the reports would be too burdensome given the protective order in *Mformation* is unavailing. [Doc. 230 at 9-10](#). First, the protective order states that "[a]ny party is free to use its own Discovery Material for any purpose." [Doc. 231-9 at 21](#). Here, Plaintiff is only seeking documents generated by Defendant, therefore production of the requested materials would not require any modification of the protective order. Plaintiff has even asked that any confidential information belonging to *Mformation* contained in the requested documents be redacted. [Doc. 245 at 6](#). Additionally, this production is made less burdensome considering Defendant has already provided confidential information from the *Prism* and *SmartPhone* cases, both of which had protective orders as well. [Doc. 245 at 6](#). Accordingly, Plaintiff's motion to compel Litigation Papers is **GRANTED IN PART** as to Plaintiff's request for expert reports from *Mformation*, and **DENIED** in all other respects.

## **B. Motion to Compel Corporate Depositions**

Plaintiff argues that additional corporate depositions are necessary to discuss new topics and to receive answers for previously noticed topics that Defendant's two witnesses, Cormier and Mishler, were unable or unprepared to answer. [Doc. 224 at 3-4](#), 10-11. Further, Plaintiff contends that Rule 30(a)(2)(A)(ii) does not require that leave of court be sought for additional 30(b)(6) testimony when the additional topics are different from the previously noticed topics. [Doc. 224 at 6](#). Alternatively, Plaintiff asserts that leave should be granted because the additional topics are not cumulative or duplicative; Defendant has stymied discovery of this information, which is relevant to prove damages and infringement, by other means; and Defendant would not be burdened by furnishing additional witnesses. [Doc. 224 at 10-11](#). Additionally, Plaintiff notes that -- although not stipulated to and absent from the Court's *Scheduling Order* -- Defendant initially agreed to at least four 30(b)(6) depositions (a total of 24 hours with no witness deposed for more than 7 hours).

Defendant responds that because Plaintiff has already deposed the corporation through Cormier and Mishler, leave of court must be sought to take additional 30(b)(6) depositions pursuant to Rule 30(a)(2)(A)(ii). Defendant states that the additional topics Plaintiff seeks are (1) unreasonably cumulative and duplicative of previously noticed topics, (2) could have been obtained during the previous 30(b)(6) depositions, and (3) would unduly burden Defendant by requiring production of three additional witness. [Doc. 232 at 15-21](#). In reply, Plaintiff emphasizes that Cormier -- who was unprepared for 20 Topics -- and Mishler -- who answered "I don't know" 106 times -- were deficient 30(b)(6) witnesses. [Doc. 251 at 2](#). Plaintiff also argues that Defendant has not shown how producing three additional 30(b)(6) deponents would be highly prejudicial. [Doc. 251 at 5](#).



Under Rule 30(b)(6), a party may depose a private corporation through a designated individual who consents to testify on the corporation's behalf. [FED. R. CIV. P. 30\(b\)\(6\)](#). The corporation has a responsibility to prepare that individual to fully answer the questions posed, "beyond matters personally known to that [individual] or to matters in which that [individual] was personally involved." [Brazos River Auth. v. GE Ionics, Inc.](#), 469 F.3d 416, 433 (5th Cir. [2006](#)) (citation omitted). If the 30(b)(6) witness is deficient, the corporation must provide a substitute. *Id.* On the other hand, under [Rule 30\(a\)\(2\)](#), a party must obtain leave of court if the person to be examined has already been deposed in the case and leave must be granted to the extent consistent with [Rule 26\(b\)\(2\)](#). [FED. R. CIV. P. 30\(a\)\(2\)\(A\)\(ii\)](#). While the Rules are silent regarding the application of [Rule 30\(b\)\(6\)](#) to [Rule 30\(a\)\(2\)\(A\)\(ii\)](#), their incompatibility has been noted. See [WRIGHT & MILLER, FEDERAL PRACTICE & PROCEDURE § 2103 \(3d ed. 1998\)](#) ("The fact that a [Rule 30\(b\)\(6\)](#) notice must specify limited topics for examination implies that additional inquiry into other relevant topics should not be precluded by the fact that inquiry has first been made on the topics designated for the first [Rule 30\(b\)\(6\)](#) deposition."). Additionally, courts in this Circuit have affirmed this understanding. See *Stambler v. Amazon.Com, Inc.*, No. 2:09-CV-0310, Dkt. 527 at 2 (E.D. Tex. Sept. 14, 2011) ("[[Rule 30\(a\)\(2\)\(A\)\(ii\)](#)] does not require a party to seek leave of court to take a second or third deposition of a corporate entity when the topics in the disputed deposition notice are different from the topics in prior notices."); *Frank's Casing Crew and Rental Tools, Inc. v. Tesco Corp.*, No. 2:07-CV-0015, [Dkt. 149 at 1](#) (E.D. Tex. Jan. 21, 2009) ("There is no Rule or law from this Circuit requiring a party to seek leave of court in order to take a second 30(b)(6) deposition of a corporate entity, when the topics in the second deposition notice are different from the first.").

Although Plaintiff has already deposed two 30(b)(6) corporate witnesses, Plaintiff need not seek leave for additional 30(b)(6) deposition testimony on topics different from those previously noticed. Additionally, Plaintiff need not seek leave to depose additional 30(b)(6) witnesses on previously noticed topics that Cormier and Mishler were unprepared to answer. [Brazos River Authority, 469 F.3d at 433](#). While the aims of [Rule 30\(b\)\(6\)](#) prevent a party from seeking additional 30(b)(6) witnesses for new topics *ad infinitum*, [WRIGHT & MILLER, FEDERAL PRACTICE & PROCEDURE § 2103](#), allowing Plaintiff to depose Defendant on additional topics to supplement unprepared witnesses and broach relevant new topics cannot be considered an abuse of [Rule 30\(b\)\(6\)](#).

Consequently, Plaintiff may seek additional 30(b)(6) deposition testimony on Topics 5 to 7, 13, 25, and 26 from Plaintiff's Third Notice and Topics 1 to 23, 26, 30, 35, and 36 from Plaintiff's Fifth Notice without leave of court because such topics are not duplicative of any previously noticed topics. [Doc. 233 at 68-69](#). While Cormier was questioned about the "get more" function mentioned in Topics 25 and 26 from the Third Notice, he was neither able to answer any questions about the BlackBerry 10 operating system, nor discuss the "get more" function in the context of viewing large images. [Doc. 252 at 5, 7](#). Further, as to the Fifth Notice, Topics 5 to 7, 9, 10, 15, and 19 (relating to revenues, valuations, and costs savings of accused devices and services); Topics 11, 12, 20 to 22, and 30 (relating to usage of device features by way of accused services and features); and Topics 16, 23, and 26 (relating to cost of maintaining and using accused devices and services) are each pertinent to Plaintiff's damages inquiry and do not appear to have been previously noticed. [Doc. 233 at 107-24](#).

Conversely, given their unnecessarily cumulative and duplicative nature, Plaintiff may not seek additional 30(b)(6) testimony on Topics 24, 25, 27, 31 to 34, and 37 from the Fifth

Notice. Topics 24 and 25 inquire into the servers and relays utilized by Defendant's accused messaging services, an area already discussed in Topics 5 and 10 (Second Notice). [Doc. 233 at 120](#); [Doc. 233 at 52](#), 54. It is unclear whether Cormier addressed these topics, but to the extent he adequately discussed Topics 5 and 10 from the Second Notice, further inquiry through Topics 24 and 25 is unnecessarily duplicative. Topic 27, concerning storage of data packets during MDP messaging in the PINGING state, was already discussed during Cormier's previous testimony. [Doc. 226-1 at 17](#). Despite Cormier's inability to answer a few MDP-related questions, his discussion of MDP in the context of data packets and the PINGING state was not deficient so as to warrant re-questioning. [Doc. 226-1 at 13-14](#), 16-17. Inquiry into Topics 31 to 33, discussing the process by which a device connects to Wi-Fi and cellular networks, would be redundant given that the Court has already permitted inquiry into this area through Topics 5 and 6 of Plaintiff's Third Notice. Topic 34's inquiry into the determination of a device's IP address is unnecessarily duplicative given Cormier's discussion of IP addresses in his initial deposition. [Doc. 226-1 at 32](#). Topic 37, inquiring into whether messages sent to and from BlackBerry devices use RCP along with, or instead of, MDPv2, is barred to the extent further discussion of MDPv2 is repetitive of Cormier's initial testimony on the subject. [Doc. 226-1 at 16](#). Inquiry into RCP and MDPv2 that is new and/or supplemental is permissible.

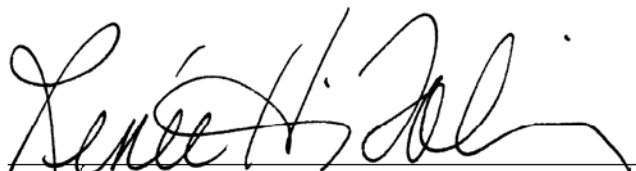
In sum, Plaintiff's motion is **GRANTED IN PART** as to Topics 5 to 7, 13, 25, and 26 of Plaintiff's Third Notice and Topics 1 to 23, 26, 30, 35, and 36 of Plaintiff's Fifth Notice, and **DENIED** in all other respects.

### **C. Conclusion**

Accordingly, Plaintiff's *Motion to Compel Discovery*, Doc. 221, is **GRANTED IN PART** as to Plaintiff's request for expert reports from the *Mformation* case and **DENIED** in all

other respects. Plaintiff's *Motion to Compel 30(b)(6) Depositions*, [Doc. 224](#), is **GRANTED IN PART**. Plaintiff may take additional 30(b)(6) deposition on Topics 5 to 7, 13, 25, and 26 from the Third Notice and Topics 1 to 23, 26, 30, 35, and 36 from the Fifth Notice. Plaintiff's motion is **DENIED** in all other respects.

**SO ORDERED** on July 15, 2015.



RENEE HARRIS TOLIVER  
UNITED STATES MAGISTRATE JUDGE