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7 UNITED STATES DISTRICT COURT  
8 SOUTHERN DISTRICT OF CALIFORNIA  
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10 IMPACT ENGINE, INC.,

11 Plaintiff,

12 vs.

13 GOOGLE LLC,

14 Defendant.  
15  
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CASE NO. 3:19-cv-01301-CAB-DEB

**ORDER ON MOTION TO COMPEL  
PRODUCTION OF CERTAIN  
DOCUMENTS**

[Doc. No. 118]

17 Google propounded a request on Impact Engine for production of “[all]  
18 Documents Regarding any contracts or agreements between Plaintiff and any Third  
19 Party concerning (1) This Litigation and/or (2) any Asserted Patent or Related  
20 Patent.” [Doc. No. 101.] Impact Engine indicated it would produce non-privileged  
21 responsive documents except for potential agreements related to litigation funding  
22 on the basis such documents were not relevant. The magistrate judge found the  
23 withheld documents relevant and therefore discoverable. He did not however make  
24 any determination regarding privilege or other protections. [Id.]

25 Impact Engine appealed the order and finding no clear error in the magistrate  
26 judge’s ruling, the Court overruled Impact Engine’s objection to the relevancy  
27 determination. [Doc. No. 113.] Impact Engine was then instructed to produce the  
28 responsive documents and/or serve a privilege log for those documents it asserts are

1 protected and submit the documents to the Court for *in camera* review. Impact  
2 Engine made the submission. [Doc. No. 118.] Google filed a response. [Doc. No.  
3 122].

4 Impact Engine asserts work product protection for the documents at issue.  
5 Under the work product doctrine, Fed.R.Civ.P. 26(b)(3)(A), a party generally may  
6 not obtain discovery of “documents and tangible things that are prepared in  
7 anticipation of litigation or trial by and for another party or its representative  
8 (including the other party’s attorney, consultant, surety, indemnitor, insurer or  
9 agent).” This protect may be overcome if the requesting party shows that they have  
10 a “substantial need for the materials” and cannot “obtain their substantial equivalent  
11 by other means.” *Id.* Even if a party makes this showing, they cannot obtain core  
12 work product – information revealing “the mental impressions, conclusions,  
13 opinions, or legal theories of a party’s attorney or other representative concerning  
14 the litigation.” Fed.R.Civ.P. 26(b)(3)(B).

15 Impact Engine submitted a non-disclosure agreement and a litigation funding  
16 agreement, along with drafts of that agreement, term sheets and a “case discussion.”  
17 The Court has reviewed each of the documents. It is clear these documents were  
18 created because of the litigation they will fund.

19 “A document should be deemed prepared ‘in anticipation of litigation’ and  
20 thus eligible for work product protection under Rule 26(b)(3) if ‘in light of the  
21 nature of the document and the factual situation in the particular case, the document  
22 can be fairly said to have been prepared or obtained because of the prospect of  
23 litigation.” *In re Grand Jury Subpoena (Mark Torfl Torf Envtl. Mgmt.)*, 357 F.3d  
24 900, 907 (9th Cir. 2004) (quoting Charles Alan Wright, Arthur R. Miller, and  
25 Richard L. Marcus, 8 Federal Practice and Procedure §2024 (2d ed. 1994)). The  
26 submitted documents satisfy the “because of” test and constitute work product. *See*  
27 *e.g., Continental Circuits LLC v. Intel Corp.* 435 F.Supp.3d 1014, 1020-21(D. Ariz  
28 2020).

1 The work product protection is not waived because it was shared with another  
2 person or entity. Work product doctrine protects against disclosure to potential  
3 adversaries. In this case, disclosure of the litigation funding agreement, including  
4 the preparatory materials, to the litigation funder, a party to the agreements, did not  
5 substantially increase the opportunity for Google, Impact Engine's litigation  
6 adversary, to obtain the agreements. The documents reviewed by the Court included  
7 confidentiality provisions regarding the agreements, the terms and the information  
8 related to them.


9 Disclosure to a person with interest common to that of the attorney or the  
10 client is not inconsistent with the intent to invoke the protection of the work product  
11 doctrine. *Id.* at 1022. The documents at issue reflect a common interest between  
12 Impact Engine and the funder. They also reflect the clear expectation of both parties  
13 to the documents that the information would remain confidential.

14 Several courts have held that the work product protection for litigation  
15 funding documents is not waived when such documents containing confidentiality  
16 provision are disclosed to litigation funders with common interests. *Id.* (cases cited  
17 therein).

18 The Court finds that work product protection applies to the documents  
19 produced *in camera* and Impact Engine is not required to produce them.

20 IT IS SO ORDERED.

21 Dated: October 20, 2020

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24 Hon. Cathy Ann Bencivengo  
25 United States District Judge  
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