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UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA

CARY A. JARDIN,)	Civil No. 10-CV-2552-IEG(WVG)
)	
Plaintiff,)	ORDER
)	
v.)	
)	
DATALLEGRO, INC. <i>et al.</i> ,)	
)	
Defendants.)	
)	
_____)	

For the third time, Defendants seek to compel Plaintiff to respond to their "trade secret" interrogatory with "sufficient particularity." Plaintiff has provided four responses, all of which have been vague, unresponsive, and inadequate in Defendants' eyes. The Court has heretofore given Plaintiff multiple opportunities to craft its own response and has refrained from cabining the response with any mandated format. However, at this stage, a mandated format appears necessary since Plaintiff either does not fully comprehend what the Court seeks or refuses to comply. The Court therefore orders Plaintiff to again respond to the interrogatory and do so in the manner explained below.

1 I. BACKGROUND

2 A. Origin of the Dispute

3 The origin of the instant dispute lies in the wording of
4 certain allegations in Plaintiff's First Amended Complaint ("FAC").
5 Plaintiff essentially alleges that Defendant Frost worked for
6 Plaintiff's now defunct company, had access to non-public informa-
7 tion, simultaneously intended to form a company to compete with
8 Plaintiff's company, left Plaintiff's company, took certain non-
9 public information with him, formed a competing company, and filed
10 for, and received, a patent that incorporated the non-public
11 information he took from Plaintiff's company. Specifically,
12 Plaintiff alleges the following:

- 13 • Frost had access to XPrime intellectual property during the
14 period between the time DATAlegro was incorporated in
15 Delaware and the time Frost concluded his relationship with
16 XPrime. (FAC, Doc. No. 40 at ¶ 41.)
- 17 • Frost had access to non-public information regarding the
18 earlier-field [sic] Jardin applications during the period
19 between the time DATAlegro was incorporated in Delaware and
20 the time Frost concluded his relationship with XPrime. (Id.
21 at ¶ 42.)
- 22 • After concluding his relationship with XPrime, Frost main-
23 tained possession or control of intellectual property
24 belonging to XPrime. (Id. at ¶ 43.)
- 25 • The '510 application contains information originating from
26 Jardin. (Id. at ¶ 69.)
- 27 • The '510 application contains information first learned by
28 Frost from Jardin in 2003. (Id. at ¶ 70.)
- The '510 application contains intellectual property that
Frost obtained from XPrime. (Id. at ¶ 71.)
- The non-public information disclosed to Frost in 2003
provided enabling technology for the alleged inventions set
forth in the '510 application. (Id. at ¶ 72.)
- On October 19, 2010, the '510 application issued as United
States Patent Number 7,818,349 (the "'349 patent"). (Id. at
¶ 79.)

- 1 • Jardin made a contribution to the subject matter of one or
2 more claims of the '349 patent. (Id. at ¶ 80.)
- 3 • One or more claims of the '349 patent includes subject matter
4 that was previously XPrime intellectual property. (Id. at
5 ¶ 81.)
- 6 • Prior to the filing of the '428 provisional application,
7 Frost received non-public information originating from Jardin
8 and concerning the subject matter of the '349 patent. (Id.
9 at ¶ 103.)
- 10 • Prior to the filing of the '428 provisional application,
11 Frost received non-public information concerning the subject
12 matter of the '349 patent that he first learned from Jardin.
13 (Id. at ¶ 104.)
- 14 • Jardin contributed to the inventions set forth in the '349
15 patent by communicating to Frost non-public information and
16 know-how relating to database technology. (Id. at ¶ 105.)
- 17 • Jardin is entitled to a judgment under 35 U.S.C. § 256
18 ordering correction of the '349 patent to substitute or add
19 Jardin as an inventor, directing DATAlegro to take appropri-
20 ate action to change the inventorship designation
21 (Id. at ¶ 106.)
- 22 • Jardin's intellectual property is included in the claims of
23 the '349 patent. (Id. at ¶ 112.)
- 24 • During the prosecution leading to the issuance of the '349
25 patent, the pending claims were amended to include Jardin's
26 intellectual property. (Id. at ¶ 113.)
- 27 • Because Jardin's intellectual property was included in the
28 '349 patent, Jardin has a property interest in the '349
patent. (Id. at ¶ 114.)
- Because Jardin's intellectual property was included in the
invention claimed in the '349 patent, Jardin has a property
interest in the '349 patent. (Id. at ¶ 115.)
- Jardin is entitled to a judgment finding that he has an
ownership interest in the '349 patent, any purported sale or
assignment of the '349 patent is null and void absent
Jardin's consent, Frost's acts in bad faith preclude the
return of the '349 patent to his possession, and Jardin is
entitled to full ownership of the '349 patent, as well as any
other relief as this Court may deem necessary to make Jardin
whole. (Id. at ¶ 125.)

27 Based on the nature of these allegations, Defendants asked
28 the Court to exercise its inherent authority to regulate the
discovery process by using California's pre-discovery trade secret

1 statement procedure, see Cal. Code Civ. Proc. § 2019.210, to delay
2 general discovery until Plaintiff provides a "trade secret state-
3 ment." They argued that Plaintiff would unfairly benefit if he
4 could first view all of the discovery in the related 2008 case and
5 construct his case based on information he previously could not
6 identify. In other words, Plaintiff should already know, without
7 any discovery, what non-public information was misappropriated and
8 incorporated into the subject patent. Thus, as in trade secret
9 cases, the information that Plaintiff has to designate is currently
10 in his possession because it was his own from the start.

11 Although this case does not contain any actual trade secret
12 claims, the above allegations regarding Plaintiff's non-public
13 information function similarly, and the Court was persuaded by the
14 case law that discussed Section 2019.210. On June 27, 2011, the
15 Court directed Defendants to propound one interrogatory to Plaintiff
16 to identify the allegedly misappropriated information. In doing so,
17 the Court left the wording of the interrogatory and the format of
18 the response to the parties' discretion. The Court specifically
19 declined to adopt DATAlegro's suggestion that Plaintiff's response
20 be modeled after the claims construction chart procedure set forth
21 in the Southern District of California Patent Local Rule 3.1.

22 On July 11, 2011, Plaintiff objected to the Court's orders,
23 and Chief Judge Gonzalez overruled the objections on July 29, 2011.
24 Jardin v. DATAlegro, Inc., 2011 U.S. Dist. LEXIS 84507 (S.D. Cal.
25 July 29, 2011). The stage was then set to proceed with the
26 interrogatory and response. Defendants thereafter propounded their
27 special interrogatory and Plaintiff responded. Defendants was not
28 satisfied with Plaintiff's response and lodged their first of
several objections.

1 On September 15, 2011, the Court convened a discovery hearing
2 regarding the wording of the interrogatory as well as the adequacy
3 of Plaintiff's response. (Doc. Nos. 77, 79.) The Court found that
4 Plaintiff's response did not comport with the Court's order to
5 respond with "reasonable particularity." Specifically, Plaintiff's
6 reference to voluminous documents did nothing to identify the non-
7 public information. The information was not identified with any
8 particularity, much less reasonable particularity. The Court also
9 found that the propounded interrogatory was overbroad. The Court
10 ordered DATAlegro to revise its interrogatory and ordered Plaintiff
11 to respond with greater detail. The Court again declined to dictate
12 the format in which Plaintiff should respond, instead opting to
13 reserve evaluating the sufficiency of the response at a later date
14 and allow Plaintiff to craft his own response. The Court mentioned
15 several times that the California state court opinion in Brescia v.
16 Angelin, 90 Cal. Rptr. 3d 842 (Cal. Ct. App. 2009), should guide the
17 parties.

18 On November 14, 2011, the Court convened a second discovery
19 hearing regarding the sufficiency of Plaintiff's third response^{1/} in
20 addition to the breadth of the interrogatory. (Doc. Nos. 82, 83.)
21 The Court again found that Plaintiff's response was overbroad partly
22 because he identified document ranges without further specifying
23 what information within those documents was allegedly misappropri-
24 ated. The Court again ordered Plaintiff to redo his response, but
25 again left the format to his discretion. As for the adequacy of the

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28 ¹ Between Plaintiff's first response and the response the Court
ordered on September 15, 2011, Plaintiff supplemented its first
response on his own. Thus, as of November 14, 2011, Plaintiff had
provided three responses.

1 propounded interrogatory, the Court overruled Plaintiff's objections
2 and found the interrogatory was acceptable.

3 **B. Legal Background**

4 Regardless of whether California's trade secret statement
5 procedure is binding in federal courts, the Court voluntarily
6 adopted the procedure because it appeared to be a reasonable way to
7 proceed given the nature of the current litigation. The essence of
8 Plaintiff's claim is Defendant Frosts misappropriation of Plain-
9 tiff's own confidential, non-public information^{2/} and using that
10 information to obtain a patent that incorporated Plaintiff's ideas
11 and information. While Plaintiff does not seek damages for the
12 specific act of trade secret misappropriation, his theory for
13 inventorship correction essentially relies on such misappropriation.
14 As a result, the Court adopted California's trade secret statement
15 procedure as a common-sense method for the progression of this suit.
16 The Court also opted to use California and federal case law
17 interpreting the statute as its guideposts on this journey.

18 California Code of Civil Procedure Section 2019.210 simply
19 states that "[i]n any action alleging the misappropriation of a
20 trade secret under the Uniform Trade Secrets Act . . . , before
21 commencing discovery relating to the trade secret, the party

22
23 ² Regardless of whether Plaintiff wishes to label this information as
24 a "trade secret," the language in the FAC certainly has the flavor
25 of a trade secret. For example, the Uniform Trade Secret Act
26 defines a trade secrets as

[I]nformation, including a formula, pattern, compilation,
program, device, method, technique, or process, that:

(i) derives independent economic value, actual or potential,
from not being generally known to, and not being readily
ascertainable by proper means by, other persons who can obtain
economic value from its disclosure or use, and

(ii) is the subject of efforts that are reasonable under the
circumstances to maintain its secrecy.

28 United States v. Chung, 659 F.3d 815, 825 n.7 (9th Cir. 2011)
(quoting Unif. Trade Secrets Act § 1(4) (amended 1985), 14 U.L.A.
438 (1990)).

1 alleging the misappropriation shall identify the trade secret with
2 reasonable particularity"

3 The amorphous term, "reasonable particularity," is open to
4 interpretation and California courts have noted that, "just what
5 constitutes a sufficient showing of 'reasonable particularity' is
6 not addressed by the statutes or the case law,' primarily because
7 the 'law is flexible enough for the referee or the trial court to
8 achieve a just result depending on the facts, law, and equities of
9 the situation." Advanced Modular Sputtering, Inc. v. Super. Ct., 33
10 Cal. Rptr. 3d 901, 907 (Cal. Ct. App. 2005). Considering the issue
11 as one of first impression, the court in Advanced Modular Sputtering
12 clarified the phrase's meaning, holding that:

13 "Reasonable particularity" mandated by section 2019.210
14 does not mean that the party alleging misappropriation has
15 to define every minute detail of its claimed trade secret
16 at the outset of the litigation. Nor does it require a
17 discovery referee or trial court to conduct a miniature
18 trial on the merits of a misappropriation claim before
19 discovery may commence. Rather, it means that the
20 plaintiff must make some showing that is reasonable, i.e.,
fair, proper, just and rational[,] under all of the
circumstances to identify its alleged trade secret in a
manner that will allow the trial court to control the
scope of subsequent discovery, protect all parties'
proprietary information, and allow them a fair opportunity
to prepare and present their best case or defense at a
trial on the merits.

21 Id. at 908 (citations omitted). That being said, when a suit arises
22 in the context of a highly technical field, courts agree that
23 Section 2019.210 disclosures must include a greater level of detail
24 and distinguish the party's claimed information from matters
25 generally known to those skilled in the trade. See, e.g., Perlan
26 Therapeutics, Inc. v. Super. Ct., 101 Cal. Rptr. 3d 211, 222-26
27 (2009); Brescia v. Angelin, 90 Cal. Rptr. 3d 842, 853 & n.2 (2009).

28

1 information. Moreover, Plaintiff cites entire documents that appear
2 to be Powerpoint presentations. Unless he claims that every piece
3 of information within those presentations was misappropriated and
4 incorporated into the subject patent, identifying an entire document
5 violates the Court's instructions. What the Court has wanted all
6 along is for Plaintiff to identify what specific information he
7 claims Defendants misappropriated, and designating entire presenta-
8 tions does not satisfy this mandate.

9 Moreover, while the seven enumerated concepts listed on page
10 7 of Plaintiff's fourth response are a small step in the right
11 direction, they nonetheless miss the mark when it comes to specific-
12 ity. All seven concepts are couched in general terms, and Defen-
13 dants object that "each [is] very broad and well-known in the
14 distributed database field for at least a decade before the alleged
15 misappropriation." They further object that, "[t]hese concepts were
16 not even arguably confidential or invented by Plaintiff." Defen-
17 dants objections certainly appear to have merit at least insofar as
18 they object to the concepts' vagueness and overbreadth. For
19 example, while it may be Plaintiff's contention that Defendants
20 misappropriated the concept for "distributing and replicating tables
21 across the available pool of slave nodes," complying with the
22 "reasonable specificity" order would require Plaintiff to further
23 identify what specific information or data was misappropriated and
24 used to develop this general concept such that he is the rightful
25 inventor or co-inventor of the subject patent. Specificity requires
26 that Plaintiff dig deeper into each of the general concepts he
27 listed and identify each specific information or data that is the
28 building block for the general concept. Essentially, while the
Court asks for the ingredients in the recipe and the quantity of

1 each ingredient, Plaintiff continues to provide only the name of the
2 recipe.

3 Moreover, on page 9 of his response, Plaintiff notes that
4 discovery has not begun and that he reserves the right to supplement
5 his response. However, this assertion also misses the point of this
6 exercise because the subject patent and each claim element within it
7 are publicly available information, and Plaintiff claims his own
8 secret information or data was taken. If the misappropriated
9 information was Plaintiff's to begin with, this begs the question
10 why he needs additional discovery to identify that information when
11 all he has to do is look at the publicly available patent and
12 identify what information was taken from him and incorporated into
13 the patent. This is not to say that Plaintiff cannot amend his
14 response in the future, but he certainly cannot "use broad, 'catch-
15 all' language as a tactic to preserve an unrestricted, unilateral
16 right to subsequently amend" his response. See Perlan Therapeutics,
17 Inc., 101 Cal. Rptr. 3d at 226

18 Plaintiff's protest that he is being forced to prematurely
19 prove his case is also unfounded. Unlike in other cases, where
20 discovery is necessary to ascertain unknown information, here,
21 Plaintiff relies on the theory that his own information or data was
22 taken and incorporated in a patent, which in turn contains claim
23 elements that are readily available to him. While discovery may
24 help Plaintiff ascertain how his information was misappropriated, he
25 already knows what information was allegedly taken. In this sense,
26 this case does resemble a trade secret case, in which the informa-
27 tion has always been within the plaintiff's knowledge precisely
28 because it was his own information to begin with.

1 Finally, Plaintiff emphasizes that this case is an
2 inventorship case and cites Atl. Research Mktg. Sys., Inc. v. Troy,
3 659 F.3d 1345, 1357 (Fed. Cir. 2011), for the unremarkable proposi-
4 tion that information that was once trade secret loses that
5 designation once it is incorporated into an issued patent. In that
6 case, the plaintiff brought claims for patent infringement and trade
7 secret theft. The Court noted the inherent conflict these two
8 claims created:

9 [Defendant's] argument illustrates the inherent tension
10 Atlantic Research created by contending that Troy misappropriated
11 trade secrets, while simultaneously asserting that the products Troy
12 developed with the misappropriated trade secrets infringed its patent.
13 In response, Troy contended that Atlantic Research's patent disclosed
the trade secret, but also contended that the patent asserted against
it was invalid These conflicting positions left little room
for either party to prevail on both claims.

14 Id. Noting that a trade secret loses that designation once it is
15 disclosed in a patent, the Court affirmed the trial court's jury
16 instruction that "[o]nly if you find that the trade secret . . . is
17 not present or disclosed in the '245 patent may you conclude that
18 such information is a protectable trade secret.'" Id. (alterations
19 in original). The above case is unhelpful in the instant case, as
20 Plaintiff's case is neither an infringement nor trade secret case.
21 As a result, Plaintiff does not have to prove to the trier of fact
22 that any of the misappropriated information existed outside of the
23 issued patent. Rather, his entire nonjoinder theory is that his
24 misappropriated information was part of the issued patent, and he
25 should be declared the patent's sole inventor or co-inventor as a
26 result. Thus, unlike in the above case, the resolution of Plain-
27 tiff's claims will not depend on whether information existed outside
28 of the patent and can be actionable trade secret as a result.

1 Having given Plaintiff ample opportunity to craft his own
2 acceptable response, the Court will now order Plaintiff to do what
3 Defendants have been asking all along, but the Court hesitated to
4 order with the hope that Plaintiff would provide an adequate
5 response on his own. The Court will now compel Plaintiff to respond
6 in a detailed and structured fashion and will dictate the specific
7 manner in which he is to respond. Accordingly, the Court adopts, as
8 modified, the chart format Defendants originally proposed.
9 Specifically, Plaintiff shall:

10 (1) From the patent at issue, identify each claim element that
11 Plaintiff contends contains his misappropriated information, data,
12 or both.

13 (2) Next, for each identified claim element, Plaintiff shall
14 identify the specific confidential, non-public information, data, or
15 both that Defendants allegedly misappropriated and incorporated into
16 the identified claim element.

17 (a) If the information is in the form of source code,
18 Plaintiff shall identify the specific lines of code, either by
19 reproducing the code verbatim in his response or by reference to
20 Bates-numbered documents, and then only to specific pages and lines
21 of code within those pages.

22 (b) If the information is contained in a document, Plaintiff
23 shall either reproduce the information directly in his response or
24 cite to specific Bates-numbered documents, and then only to specific
25 individual pages. If the specific page contains lines of text (as
26 opposed to charts or photographs), Plaintiff shall further designate
27 which specific lines of text he alleges contain his misappropriated
28 information, data, or both. If Plaintiff claims all information

1 within a specific identified page was misappropriated, he shall
2 indicate as much.

3 (c) If the information is not contained in document form,
4 Plaintiff shall reproduce the information verbatim in his response.

5 (3) Plaintiff's response shall not be in narrative form or in
6 declaration form. Rather, it shall appear as a chart formatted
7 exactly as follows:

Claim Element	Nonpublic/Confidential Information
[In this column, Plaintiff shall identify the specific claim element he alleges includes the nonpublic, confidential information that he alleges Defendants misappropriated]	[In this column, Plaintiff shall state with specificity the specific corresponding nonpublic, confidential information he alleges Defendants misappropriated and incorporated into the claim element he identifies to the immediate left of this column. The manner in which he identifies this information shall comply with (2)(a)-(c) above.]
[Plaintiff to repeat each row for each claim element which he alleges contains his misappropriated information]	

18
19 The level of specificity above serves two purposes. First,
20 it provides Plaintiff a very specific framework by which he can now
21 draft his response. Second, given the comparatively complex nature
22 of technology at issue, a greater level of specificity is desirable.
23 The following succinctly explains the need for a higher level of
24 specificity in this case given Plaintiff's claim that his misappropriated
25 information contributed to the subject invention:

26 [A] long line of decisions holds that a person is a
27 joint inventor only if he or she contributes to the
28 conception of the claimed invention. The line between
actual contributions to conception and the remaining
more prosaic contributions to the inventive process that
do not render the contributor a co-inventor is sometimes
a difficult one to draw. Contributions to realizing an

1 invention may not amount to a contribution to conception
2 if they merely explain what was then the state of
3 art

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5 One who simply provides the inventor with well-known
6 principles or explains the state of the art without ever
7 having a firm and definite idea of the claimed combina-
8 tion as a whole does not qualify as a joint inventor.

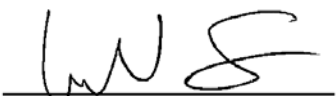
9 Robert L. Harmon, Patents and the Federal Circuit 574, 575-76 (BNA
10 Books 2009); see also Shum v. Intel Corp., 630 F. Supp. 2d 1063,
11 1073 (N.D. Cal. 2009) ("A purported co-inventor does not satisfy
12 this standard by contributing an element which is obvious or exists
13 in the prior art.") (citing cases); see generally Eli Lilly & Co. v.
14 Aradigm Corp., 376 F.3d 1352, 1358-59 (Fed. Cir. 2004) (providing
15 background of joint inventorship doctrine and correction of
16 inventorship claims); Trovan, Ltd. v. Sokymat Sa, 299 F.3d 1292,
17 1301-02 (Fed. Cir. 2002) (same). Given that the misappropriated
18 information will likely have to be distinguished from prior art, and
19 given the heavy burden of proof in such cases, *i.e.* by clear and
20 convincing evidence, the procedure outlined above will be helpful as
21 this case progresses and will aid the ultimate resolution of the
22 case on the merits.

23 **III. CONCLUSION**

24 Plaintiff shall draft a new response that complies with this
25 Order and serve it no later than February 11, 2012.

26 IT IS SO ORDERED.

27 DATED: January 11, 2012

28 
Hon. William V. Gallo
U.S. Magistrate Judge