

**IN THE UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION**

Brook + Whittle LTD,

Plaintiff,

v.

Nestlé USA, Inc., Fuji Seal International, Inc.

Defendants.

CASE NO. 2:24-CV-00735-JRG-RSP

JURY TRIAL DEMANDED

PLAINTIFF'S MOTION TO COMPEL DEFENDANTS' E-DISCOVERY DEPOSITIONS

I. INTRODUCTION

Plaintiff Brook + Whittle LTD (“B+W”) seeks an order compelling Defendants to comply with this case’s entered and agreed-upon E-Discovery Order and produce witnesses for ESI depositions. Indeed, this Court has *already ordered* Defendants to do the very thing that B+W seeks here—namely, make deponents available to allow B+W to determine the proper custodians, search terms, and time frame for e-mail production requests. As set forth in the Court’s E-Discovery Order “[e]ach requesting party may . . . take one deposition per producing party to identify the proper custodians, proper search terms, and proper time frame for e-mail production requests.” *See* Dkt. 28, ¶ 7 (the “Order”). That is exactly what Plaintiff seeks from this motion – and what Defendants’ have refused to comply with.

Defendants’ reasons for disregarding the Order are specious. Defendants unilaterally assert that the depositions requested by Plaintiff are not “necessary,” although they agree that these depositions are “permitted” by the E-Discovery Order. Defendants also assert that other written discovery should take place first but provide no basis for this position: the E-Discovery Order does not require this, nor does any case that Defendants have cited (or that B+W can locate). Indeed, it is contrary to the entire purpose of such a deposition: Plaintiff is entitled to take a deposition of a corporate representative of each Defendant specifically to “identify the proper custodians [and] proper search terms” that will govern Defendants’ forthcoming productions.

Further still, Defendants have unreasonably failed to comply with the bare minimum of their discovery obligations, as “[a] party served with a Rule 30(b)(6) deposition notice must respond in one of two ways: (1) designate a person to testify at a deposition, or (2) move for a protective order.” *Active Wireless Techs. LLC v. T-Mobile USA, Inc.*, No. 2:23-CV-00261-JRG, 2024 WL 5108441, at *2 (E.D. Tex. Dec. 13, 2024). If Defendants believed that the noticed ESI depositions should not have proceeded, they should have sought a protective order. Their failure

to do so *and* failure to produce any witnesses violates both the Rules and the terms of the Order.

II. BACKGROUND

B+W and Defendants discussed, negotiated, and jointly submitted a proposed E-Discovery Order). Dkts. 26, 26-1. The proposed E-Discovery Order provides that “[e]ach requesting party may . . . take one deposition per producing party to identify the proper custodians, proper search terms, and proper time frame for e-mail production requests,” consistent with the Court’s Model Order Regarding E-Discovery in Patent Cases. *Id.*, ¶ 7. The Court entered the jointly submitted E-Discovery Order on December 10, 2024 (the “Order”). Dkt. 28.

Pursuant to the Order, on January 21, 2025, B+W issued deposition notices to each Defendant for the purpose of identifying custodians, search terms, and time frames for email production requests. Shi Decl. ¶ 6. The deposition notices further contained topics for examination to guide and streamline the depositions. *Id.*

On February 5, 2025, Defendants responded that they “generally object to the timing and the proposed location of the depositions.” Ex. 1 at 2. Notably, Defendants acknowledged that these depositions were proper: “the deposition topics appear to be designed ‘to identify the proper custodians, proper search terms, and proper time frame for e-mail production requests,’ *which is permitted by paragraph 7 of the Court’s E-Discovery Order.*” *Id.*¹ Nonetheless, Defendants refused to produce witnesses, stated that the depositions were “premature,” and proposed tabling discussion of depositions in favor of written discovery. *Id.* On February 6, 2025, B+W responded to remind Defendants that “written objections are not sufficient to satisfy Defendants’ obligations to produce witnesses.” *Id.* at 1 (quoting *Active Wireless*, 2024 WL 5108441 at *2). B+W later re-noticed the depositions for March 4 and 5 to allow time for the Parties to meet and confer. *See* Shi

¹ Unless otherwise noted, all emphasis is supplied.

Decl. ¶ 10

The parties met and conferred on February 19, 2025, where B+W expressed willingness to work with Defendants to find appropriate times and locations for the convenience of Defendants' witnesses. Shi Decl., ¶ 7. B+W also reminded Defendants that the Order does not require any prerequisite written discovery before these depositions; in response, Defendants *agreed* to identify testifying witnesses by February 26, 2025. *Id.* Defendants later recanted and stated that “we still have a disagreement regarding . . . whether the depositions would even be necessary after written lists of e-mail custodians and other written discovery has been exchanged.” *Id.*

On February 26, 2025, Defendants confirmed their refusal to produce witnesses, stating that the requested depositions were both “unnecessary at this time” and “unduly burdensome at this time.” Shi Decl. ¶ 8. Defendants continued by alleging—with no basis or explanation—that “[i]t appears that the true purpose of the depositions is to discover irrelevant information and to harass Defendants, rather than to discover a list of email custodians and the relevant parameters for conducting email discovery.” *Id.*

On March 3, 2025, B+W confirmed its understanding with Defendants that “neither Fuji nor Nestle intends to produce witnesses” for the depositions. *Id.* at ¶ 9. Defendants did not respond, did not appear for the March 4 and 5 depositions, and did not seek a protective order. *Id.* at ¶ 10. The parties met and conferred on March 25, 2025, and confirmed that they were at an impasse. *Id.* at ¶ 11. Subsequently, Defendants asserted that “Defendants did not ‘fail’ to produce witnesses, nor are we ‘refusing’ to produce witnesses.” *Id.* at ¶ 12. But Defendants have still not made any witnesses available for deposition. *Id.*

III. LEGAL STANDARD

“On notice to other parties and all affected persons, a party may move for an order compelling disclosure or discovery.” Fed. R. Civ. P. 37(a)(1). “Absent a protective order, the

Federal Rules of Civil Procedure do not give a party the right to not respond to a Rule 30(b)(6) notice.” *Active Wireless*, 2024 WL 5108441, at *2 (E.D. Tex. Dec. 13, 2024).

IV. ARGUMENT

B+W has been seeking these highly relevant depositions since January, and Defendants have no basis for their months-long refusal to comply with their discovery obligations. **First**, contrary to Defendants’ belief, these depositions are not “unnecessary.” In fact, as Defendants acknowledge, these depositions are specifically provided for by the Order. *See* Dkt. 28, ¶ 7; . This provision is no anomaly—it is included in the Court’s model E-Discovery Order.

Second, Defendants are incorrect that these depositions are “unduly burdensome.” As explained above, these depositions were expressly allowed by this Court’s entry of the Order, and Defendants’ assertion frustrates the Court’s express facilitation of such discovery. Moreover, B+W took affirmative steps to reduce the burden on Defendants and their witnesses by streamlining the depositions and narrowly tailoring the topics. Specifically, B+W seeks to depose Nestlé regarding the proper custodians, search terms, and time frame for e-mail production requests across seven topics, related to the development, manufacture, monetization of the Accused Products; IP related to the Accused Products; and Nestlé’s electronic storage systems. Similarly, B+W seeks to depose Fuji on these same topics (modified to be directed towards Fuji) and three additional topics, covering Fuji’s relationship with its American subsidiary, other Fuji subsidiaries, and third-party collaborators on the Accused Products. To be sure, each topic is prefaced with “[t]he proper custodians, proper search terms, and proper time frame for e-mail production requests regarding discovery into” to make clear that B+W does not seek exhaustive substantive testimony on these topics, but rather information to guide further electronic discovery. *See* Dkt. 28, ¶ 7.

Third, Defendants’ primary objection is that other written discovery should take place first to potentially obviate the need for ESI depositions, but this position finds no support in the Order

or authority from this District. No provision in the Order requires that any written discovery take place before the allowed ESI depositions—nor do Defendants point to any. This alone is sufficient to reject Defendants’ argument. *See Ward v. AI Absolute Best Care, L.L.C.*, No. CV 19-73, 2020 WL 12893294, at *3 (E.D. La. Sept. 8, 2020) (holding that parties may not “read more or less from the language in a District Court’s order”); *see also Frew v. Janek*, 5 F. Supp. 3d 845, 853 (E.D. Tex. 2013), *aff’d*, 780 F.3d 320 (5th Cir. 2015) (holding that an order’s scope “must be discerned within its four corners, and not by reference to what either party hoped to achieve”). And as B+W explained during meet-and-confers, sworn testimony regarding ESI issues can streamline future written discovery and ensure that ESI searches are efficiently conducted on relevant repositories.²

Further, this Court recently rejected Defendants’ very arguments (that written discovery must occur before ESI depositions and may render ESI depositions moot) in *Sportscaster*. *See Sportscaster Inc. v. Sportradar Group, AG*, Case No. 2:23-cv-472-JRG, Dkt. 113 at 1–7 (E.D. Tex. Dec. 18, 2024). In that case, the defendant opposed an ESI deposition on the grounds that it was unnecessary given that the ESI Order “provide[d] a variety of mechanisms to facilitate email discovery.” *See Sportscaster*, Dkt. 118 at 3 (E.D. Tex. Jan. 2, 2025). The defendant also argued that the ESI deposition would be moot following written discovery, rhetorically asking “[w]hat more information does Plaintiff require?” *Id.* at 4. The Court rejected these arguments and ordered the deposition in view of the ESI Order’s clear allowance of ESI depositions. *See Sportscaster*, Dkt. 152 at 2 (E.D. Tex. Dec. 18, 2024). The same reasoning applies here, and Defendants have provided no basis to depart from this Court’s holding.

² To the extent Fuji contends that depositions are impracticable because its witnesses are in Japan, this is a non-issue: Fuji’s witnesses regularly travel to the United States, and two of its own executives are the President and VP of Operations of Fuji’s U.S. subsidiary in Kentucky. Fuji can certainly educate and designate one of its witnesses who regularly travels to the United States to be deposed, and B+W is willing to travel to Kentucky for the convenience of that witness.

Even Defendants’ cited case, *Danco*, supports this conclusion. *Danco, Inc. v. Lavelle Indus., Inc.*, No. 5:16CV48-CMC, 2017 WL 10154231 (E.D. Tex. May 4, 2017). In that case, the court ordered an ESI deposition after some written discovery had taken place. *See id.* at *1–4. But the court did not order the deposition **because** written discovery had started, but instead made clear that “the [E-]Discovery Order does **not** explicitly require full exchange of [certain written discovery] before a deposition to identify proper custodians.” *Id.* In short, the *Danco* court did not require any amount of written discovery as a prerequisite to an ESI deposition—nor have Defendants provided any authority to this effect. *See also Active Wireless*, 2024 WL 5108441, at *2 (“[A] party’s ‘prefer[ence] to provide answers to interrogatories than to prepare a witness for a Rule 30(b)(6) deposition’ [is] irrelevant.”). Indeed, some document discovery has already started here, as confirmed by Defendants’ recent concession to B+W’s previously-filed motion to compel document discovery. Dkts. 53, 61, 62.

At bottom, this Court should order Defendants to immediately produce witnesses for depositions pursuant to paragraph 7 of this Court’s E-Discovery Order.

V. CONCLUSION

Given the straightforward nature of this request, the Order’s express statements the requested ESI depositions, and this Court’s own recent precedent confirming the appropriateness of this relief, Plaintiff requests that Defendants be compelled to each produce a corporate representative to testify specifically to Plaintiff’s requested ESI topics.

This is Plaintiff’s second straight-forward motion to compel. As this Court knows, B+W previously filed a motion to compel seeking production of documents from Fuji’s wholly-owned and controlled U.S. subsidiary, after Fuji contended (incorrectly) that it was not in “custody or control” of such documents. Fuji withdrew its objections only after forcing B+W to file that motion.

Here, too, Plaintiff's motion addresses a simple issue that goes to Defendants' continued failure to participate in discovery. In violation of the Federal Rules, Defendants have failed to take any required action, including either (1) producing witnesses in response to B+W's deposition notices or (2) seeking a protective order prior to the noticed dates. Defendants' refusal is not a mere mistake: B+W specifically gave Defendants an opportunity to remedy this failure, which they rebuffed, stating "B+W's request to take depositions of Defendants' corporate witnesses is unnecessary and unduly burdensome at this time." Shi Decl. ¶ 8.

B+W should not have to come to the Court multiple times to request orders compelling Defendants to comply such basic requirements of litigation. Accordingly, B+W respectfully requests that the Court grant this motion and grant any other relief the Court deems appropriate.

Dated: April 21, 2025

Respectfully submitted,

/s/ Brandon H. Brown

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CERTIFICATE OF CONFERENCE

The undersigned hereby certifies that Plaintiff has complied with the meet and confer requirements in L.R. CV-7(h) and this Court's standing orders, and further certifies that the parties had a conversation about the basis for this Motion, and that counsel for Defendants stated that they are opposed to the relief requested herein. As a result, the parties were unable to reach an agreement and are at an impasse, leaving open issues for the Court to resolve. Brandon H. Brown attended the lead-local meet-and-confer on March 25, 2025, as lead counsel for Plaintiff and Garrett Parish of Miller Fair Henry PLLC attended as local counsel for Plaintiff. John Bennett attended this lead-local meet-and-confer as lead counsel for Defendants and Amy LaValle attended as local counsel for Defendants.

/s/ Brandon H. Brown

Brandon H. Brown
Lead Counsel

/s/ Andrea Fair

Andrea Fair
Local Counsel

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the above and foregoing document has been served to counsel representing Nestlé USA, Inc. and Fuji Seal International, Inc. via CM/ECF per Local Rule CV-5(a)(3).

/s/ Brandon H. Brown

Brandon H. Brown