

## A “Crowbar to Get Everything”: Motorola v. Hytera and the Issues with Imaging Computers in Discovery

Insights

6.04.18

In an interesting 15-page discovery order, Magistrate Judge Jeffrey Cole of the Northern District of Illinois rejected Motorola’s attempt to obtain images of the computers of a number of Hytera employees. Motorola has brought claims against Hytera, alleging that the defendant misappropriated Motorola trade secrets to develop a two-way radio. Hytera filed a motion to dismiss, arguing that the statute of limitations had expired on the claims. Judge Samuel Der-Yeghiayan converted the motion to dismiss into a motion for summary judgment and authorized discovery solely on the statute of limitations issue, namely whether Motorola was entitled to an equitable tolling exception based on Hytera fraudulently concealing its activity.

As is often the case in litigation, a limited discovery issue became more expansive. A one-month discovery period became eight, Motorola received nearly three million pages from Hytera (a collection that would be 100 stories high, as Judge Cole noted), and then the parties found themselves fighting over a new request from Motorola for images of seven Hytera employees’ computers. In fact, as Judge Cole explained, Motorola only wanted these images as the beginning of a new phase.

Judge Cole denied the motion to compel for two reasons. First, he said that Motorola had not explained how the images were germane to the question of whether Hytera fraudulently concealed its alleged acts of misappropriation from Motorola. Imaging a computer is sometimes necessary in a trade secrets case to demonstrate the access, use, disclosure, or deletion of the trade secrets at issue. Judge Cole found that these issues are separate from fraudulent concealment: “Motorola never had access to any of Hytera’s computers any more than it does now, so how would Hytera deleting or hiding the files in China prevent Motorola from discovering it had a claim in Chicago or Malaysia?” He ruled that Motorola had not invoked Federal Rule of Civil Procedure 56(d), and that their participation in the summary judgment process implied that the Hytera images were not necessary to adjudicate the statute of limitations issue.

Second, Judge Cole found that a forensic examination of the computers in China would be out of proportion with the needs of this case at the stage of deciding whether the claims are time-barred. He cited a number of different sources for the principle that forensic examination is a “drastic step even in general discovery.”

This decision is interesting for several reasons. First, it is unusual to see a judge so readily admit a recent mistake. Magistrate Judge Jeffrey Cole initially agreed with Motorola that it was entitled to image the computers of a number of Hytera employees, but then changed his mind in this discovery order. Moreover, he states that he is not blaming Motorola's counsel: "Mistakes are ultimately (and in most cases) the responsibility of the court."

Second, the decision can be useful for practitioners defending against requests in discovery for the forensic examination of computers. This step is often necessary in trade secret matters, but it needs to be approached with care and the analysis needs to be tied to the needs of the case.

Third, the decision is enjoyable to read. The opinion starts with a quote from Justice Frankfurter on the utility of wisdom even when it comes late (a reference to the fact that Judge Cole changed his mind on the dispute) and then references the Punic Wars and Winston Churchill within the first three pages. Benefits of a classical education, one supposes.

### ***Related People***

---



**Michael P. Elkon**

Partner

404.240.5849

Email