

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

Oldcastle BuildingEnvelope, Inc.,

Plaintiff,

v.

Jon Todd Staley,

Defendant.

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Civil No. 3:11-cv-02668-F

MOTION FOR EARLY DISCOVERY AND BRIEF IN SUPPORT

Plaintiff Oldcastle BuildingEnvelope, Inc., by this motion and under Federal Rule of Civil Procedure 26(d), moves for an Order granting it access to the forensic copies of Defendant Jon Todd Staley’s personal computers currently in possession of the Court. In response to Oldcastle’s Motion for Expedited Discovery (Dkt. No. 5), the Court ordered that the Defendant provide to the Court a forensic image of his personal computers. (*See* Dkt. No. 8). The Court also allowed Oldcastle to take Staley’s deposition on an expedited basis. (*Id.*). During that deposition, Staley confirmed (1) that he had emailed to his personal email account numerous Oldcastle documents in the days immediately preceding his departure; (2) that he accessed these emails on his personal computer; (3) that he had possession of these emails, with their attached documents, after his departure from Oldcastle and after he had begun working for his new employer, Acralight (a competitor of Oldcastle’s); (4) that some of this information was saved from his email to his personal computer; and (5) that some of Oldcastle’s information may still be on his personal computer.

As explained in its Complaint, Oldcastle’s primary concern in this case is to secure and safeguard the confidential and proprietary information Staley took just before his departure. And

Staley's deposition has justified Oldcastle's concerns regarding its confidential information. Regardless of his motives, Staley took information that does not belong to him, kept that information after he left Oldcastle, and may still have at least some of that information on his computer. Oldcastle is accordingly entitled to make sure that its information is identified and returned or deleted. There is one way—and only one way—to accomplish this: a forensic examination of Staley's personal computers. Only through such an analysis can Oldcastle determine with certainty the extent to which its confidential information remains on Staley's computers and thereby remains subject to being disseminated, inadvertently or otherwise, to non-Oldcastle employees. Allowing Oldcastle to determine the extent to which Staley still possesses or has disseminated Oldcastle's information could vastly narrow, if not resolve, most of the issues in dispute. Oldcastle thus respectfully requests that the Court grant access to the copies of Staley's personal computers in the Court's possession for an independent forensic analysis.

I. Arguments and Authorities

Federal courts possess inherent power to manage their dockets to achieve orderly, expeditious disposition of cases. *See Chambers v. NASCO, Inc.*, 501 U.S. 32, 43 (1991). To that end, courts possess broad discretion to “expedite the discovery process.” *Barrett v. Atl. Richfield Co.*, 95 F.3d 375, 380 (5th Cir. 1996); *see also* Fed. R. Civ. P. 16(b), 26(d)(1). In certain circumstances, the Federal Rules allow discovery “before the time specified in Rule 26(d).” Fed. R. Civ. P. 30(a)(2)(A)(iii); *see also* Fed. R. Civ. P. 31(a), 33(b), 34(b), 36(a), 45. In the Fifth Circuit, courts have granted expedited discovery where the requesting party demonstrates “good cause.” *See, e.g., St. Louis Group, Inc. v. Metals & Additives Corp.*, 275 F.R.D. 236, 239-40 (S.D. Tex. 2011) (collecting cases); *Paul v. Aviva Life & Annuity Co.*, No. 3-09-cv-1490-B, 2009 WL 3815949, at *1 (N.D. Tex. Nov. 12, 2009) (using the good-cause standard to evaluate a

motion for expedited discovery). Good cause exists ““where the need for expedited discovery, in consideration of the administration of justice, outweighs the prejudice to the responding party.”” *Energy Prod. Corp. v. Northfield Ins. Co.*, No. 10-0933, 2010 WL 3184232, at *3 (E.D. La. Aug. 6, 2010) (quoting *In re Countrywide Fin. Corp.*, 542 F. Supp. 2d 1160, 1179 (C.D. Cal. 2008)). In the expedited-discovery context, the discovery requests should not be overly broad; instead, they should be narrowly tailored to the subject matter at issue. *St. Louis Group*, 275 F.R.D. at 240 (citing *Semitool, Inc. v. Tokyo Electron Am., Inc.*, 208 F.R.D. 273, 277 (N.D. Cal. 2002)); *Monsanto Co. v. Woods*, 250 F.R.D. 411, 413 (E.D. Mo. 2008). Good cause exists here because Oldcastle’s narrowly tailored request, which simply seeks to determine the extent to which Staley still possesses or has disseminated Oldcastle’s information, could resolve most of the issues in dispute in this case. Also, the safeguards contained in the proposed Order ensure that Staley does not suffer undue prejudice.

A. Early Discovery Is Appropriate Here to Potentially Narrow the Issues in Dispute

Courts often allow early discovery in cases such as this, where a party seeks injunctive relief to prevent potential disclosure of its confidential and trade secret information. For example, in *Asahi Glass Co. v. Toledo Engineering Co.*, 262 F. Supp. 2d 845 (N.D. Ohio 2003), *order modified by* 2005 WL 646076 (N.D. Ohio Mar. 21, 2005), the plaintiff alleged that the defendant misappropriated trade secrets, confidential information, and “know-how,” and that the defendant would imminently disclose the information to plaintiff’s competitor. 262 F. Supp. 2d at 846-47. To resolve the issue expediently, the court ordered the defendant to turn over to the plaintiff certain relevant project files. *Id.* at 848-49. The court’s reasoning emphasized the inherent sensibility of its order:

If, as a result of receipt of the project files and other documents being produced by [defendant], [the plaintiff] learns . . . that none of its know-how has been

received, used, or disclosed by [defendant], that will end this suit. If, however, [the plaintiff] discovers that the contrary is true, such discovery should not [be delayed pending the defendant's empty threats of appeal].

Id. at 849. *See also, e.g., Rodale, Inc. v. U.S. Preventive Med., Inc.*, No. 4:08-CV-120, 2008 WL 4682043, at *1 (E.D. Tex. Oct. 21, 2008) (expedited discovery available when “there is some showing of good cause to justify the order, including cases seeking preliminary injunctions); *Tracfone Wireless, Inc. v. King Trading, Inc.*, No. 3-08-CV-0398-B, 2008 WL 918243, at *1 (N.D. Tex. Mar. 13, 2008) (holding that expedited discovery was necessary to enable plaintiff to determine the nature and extent of defendants’ wrongful conduct).

Staley undeniably took the information—that much is clear. From July 13, 2011 (the very day Staley admits to sending his resume to an Acralight employee to seek employment there), until July 26, 2011, his final day at Oldcastle, Staley sent 26 emails from his Oldcastle email account to his personal email account, most of which contained one or more Oldcastle documents. App., p.1 (Declaration of Robert Vincent, ¶ 2). Staley testified that he would email himself “quite often” when he experienced spikes in his workload. *See* App., pp. 4-5 (Staley Deposition Transcript, 168:10-169:9). But this statement is demonstrably untrue. Indeed, for the 6½ months prior to his actively seeking employment with Acralight, Staley only sent 8 emails to his personal email account. App., p. 1 (Declaration of Robert Vincent, ¶ 2). By contrast, in just the final two weeks of his employment, after he began seeking employment with Oldcastle’s competitor, he more than tripled that total. *Id.* In other words, after Staley began seeking employment with Acralight, he increased the rate at which he emailed his personal account by over 4,380%.

Such behavior from a departing employee is more than suspicious. But even assuming for the sake of argument that Staley had absolutely no improper motive in sending himself these

documents,¹ and that the volume and timing of his emails were simply (although improbably) an unfortunate coincidence, Oldcastle has the right to get back its documents and to make sure that Staley no longer possesses them. Staley admitted that he still possessed these emails and documents after his departure from Oldcastle and subsequent employment with Acralight. *See* App., p. 10 (Staley Deposition Transcript, 227:13-22). He also admitted that at least one of the documents “somehow” was saved on his computer desktop, although he could not explain how that happened. App., pp. 12-14 (*Id.*, 233:21-235:11). Moreover, Staley admitted that it is possible Oldcastle’s information is “still sitting there” on his personal computer, even though he has long since left Oldcastle. App., pp. 13-16 (*Id.*, 234:9-237:10).

Even giving Staley every benefit of the doubt, there is no reason that Oldcastle should not be permitted to determine what Oldcastle information is still in Staley’s possession. If a forensic analysis reveals no trace that Staley still possesses or has transmitted Oldcastle’s documents, the vast majority of this dispute will be resolved. Of course, if the forensic analysis reveals that Staley still possesses Oldcastle’s information or has disseminated it to others or used it in his new job, Oldcastle is entitled to know that as soon as possible as well. In either case, good cause exists for Oldcastle’s requested independent forensic analysis.

B. Staley will suffer no prejudice by expedited discovery.

In the weeks before launching this litigation, and again after filing its Complaint, Oldcastle requested several times that it be allowed to conduct an independent forensic review of Staley’s relevant electronic devices, in effort to determine the extent to which Staley possessed or transmitted any confidential information belonging to Oldcastle. Staley has refused because,

¹ While Staley’s motives are immaterial to this motion, Staley admitted that he used some of the most sensitive information, including productivity and service metrics, not for Oldcastle business, but for his “resumé” to show that he had “improved productivity” over time. App., pp. 7-9 (Staley Deposition Transcript, 190:1-192:16).

among other things, he is reluctant to submit the contents of his personal computer and email for forensic review. There are two responses to Staley's privacy concerns. First, Oldcastle did not make Staley's computer devices relevant to this dispute—Staley did. Staley, not Oldcastle, emailed Oldcastle's documents to his personal email account, and he, not Oldcastle, accessed and stored this information on his personal computer. Staley cannot now claim undue prejudice when the necessity of a forensic analysis was caused by his own actions.

Second, the proposed Order is carefully tailored to alleviate any privacy concerns. Oldcastle has proposed a search protocol—common in these types of cases—designed to excise from Staley's devices only that information relevant to this case, while assuring Staley's personal information remains undisclosed. First, Oldcastle proposes that an independent forensic examiner conduct the search. Second, the examiner will conduct a focused search of Staley's electronic devices for information relating only to Oldcastle's confidential, proprietary, or trade-secret information and the transmission of that information. The targeted scope of the search will ensure the examiner identifies and discloses only that data relating to Oldcastle's information. Also, neither Oldcastle nor its counsel will be present during any searches of Staley's computer devices. This protocol ensures that any Oldcastle information existing on Staley's devices will be identified, but without divulging to Oldcastle or its counsel any personal, non-Oldcastle-related information. Indeed, the proposed Order, which was given to Staley's counsel in mid-December, contains the same safeguards Oldcastle proposed in its prior Motion for Expedited Discovery. At no time during the numerous conferences on this issue over the past few weeks has Staley stated that the proposed protocol fails to adequately safeguard Staley's personal information. In any event, as Oldcastle has explained on several occasions, Oldcastle is

willing to entertain other reasonable safeguards to prevent disclosure of Staley's private information.

The timing of Oldcastle's request also creates no prejudice. Indeed, there can be no credible dispute that Staley's relevant electronic equipment and electronically stored information are discoverable, whether the discovery is conducted now or later. Staley's privacy concerns, which are easily alleviated, will remain the same, as will the potential that Staley still possesses Oldcastle information on his computers. There is simply no reason to wait weeks or months to resolve this issue, until after general discovery commences, after Staley has again refused on the same grounds to provide access to his personal computers, and after Oldcastle is forced to move the Court to resolve this issue on precisely the same facts that exist now. Moreover, Staley has already turned over to the Court forensic images of his personal computers; all Oldcastle requests at this time is access to those copies. If anything, Oldcastle's request could reduce the burden on all parties and the Court by dramatically and expeditiously narrowing the disputed issues depending on the results of the forensic analysis.

II. Conclusion

Staley undeniably took information that does not belong to him just as he was preparing to leave Oldcastle to work for a competitor. He has admitted that he accessed this information on his personal computer, and that at least some of this information may still be stored on his computer. Given those admissions, as well as the precautions set forth in the proposed Order, it is difficult to imagine how Oldcastle's request for a forensic review of his computers could be objectionable. Oldcastle thus requests that the Court grant access to the forensic copies of Staley's computers in the Court's possession for an analysis in accordance with the proposed Order.

DATE: January 9, 2012

Respectfully submitted,

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CERTIFICATE OF CONFERENCE

This motion is opposed. I certify that on December 19 and 20, 2011 and January 4 and 5, 2012, I contacted Defendant's counsel, David Bell, by telephone and/or email. Mr. Bell has indicated that Defendant opposes this motion. Mr. Bell stated his belief that Oldcastle has provided no evidence demonstrating that it has a legitimate claim for relief, and that he will consider Oldcastle's request for a forensic analysis only if Oldcastle produces new evidence supporting its claims at the upcoming depositions of Mollie Hines and Mary Carol Witry. Because Oldcastle believes it has provided ample evidence supporting its requested relief, and because Oldcastle cannot conceive of any information that could be uncovered during the depositions that would alter Defendant's position, this motion is being presented to the Court for determination at this time.

/s Robert Vincent

Robert Vincent

CERTIFICATE OF SERVICE

I hereby certify that on this 9th day of January, 2012, I caused a copy of the foregoing document upon all counsel of record via the Court's ECF/CM electronic filing system.

/s Robert Vincent

Robert Vincent