

**UNITED STATES DISTRICT COURT  
MIDDLE DISTRICT OF FLORIDA  
TAMPA DIVISION**

**YELLOW PAGES PHOTOS, INC.,**

**Plaintiff,**

**vs.**

**CASE NO.: 8:08-cv-00930-SDM-EAJ**

**YELLOW BOOK USA, INC. and  
PINDAR SET INC.,**

**Defendants.**

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**PLAINTIFF'S MOTION TO COMPEL**

Plaintiff, Yellow Pages Photos, Inc. ("Yellow Pages"), by and through its undersigned attorneys and pursuant to Rule 37(a)(3)(B) of the Federal Rules of Civil Procedure and Rule 3.04 of the Local Rules for the Middle District of Florida, files this its Motion to Compel and requests that the Court compel Defendants to: (1) permit a search of their electronic databases to locate Yellow Pages' images at issue in this litigation and advertisements that contain Yellow Pages' images; (2) provide proper supplemental responses to Yellow Pages' First Requests for Production; (3) produce a complete, responsive set of documents to Yellow Pages' First Requests for Production; (4) provide proper supplemental answers to Yellow Pages' First Sets of Interrogatories; and (5) produce a privilege log. In support, Yellow Pages states as follows:

**I. BACKGROUND**

This is a copyright infringement action. Yellow Pages is in the business of producing and licensing to publishers of yellow pages directories copyrighted, full color, photographic images for use in creating, producing, and publishing print and online yellow pages

advertisements. Publishers use Yellow Pages' images to create and produce advertisements for customers that are published in such publishers' print and online directories. Defendant Yellow Book USA, Inc. ("Yellow Book") is the largest independent yellow pages directory publisher in the United States. Defendant Pindar Set Inc. ("Pindar") creates and produces yellow pages advertisements and directories for Yellow Book.

As discussed in Yellow Pages' Complaint, three customers of Yellow Pages, Clarke Directory Publications, Inc. ("Clarke"), Feist Publications, Inc. ("Feist"), and Transwestern Publishing ("Transwestern"), were acquired by Yellow Book.<sup>1</sup> After the acquisitions, advertisements containing Yellow Pages' images began appearing in Yellow Book's print and yellowbook.com online directories. Some of the print advertisements were copied by Yellow Book from directories of the acquired companies and used in Yellow Book's own directories. Other of the print advertisements were first published by Yellow Book post-acquisition in its directories. Of this latter category, in some instances images licensed to one of the acquired licensees doing business in a limited geographic area appeared in advertisements in Yellow Book directories for geographic areas where the licensee did not do business. Defendants were, and still are, copying and using Plaintiff's copyrighted, full color, photographic images. *See* Declaration of W. Trent Moore filed in support of this Motion ("Moore Decl.") for information and advertisements discovered by Yellow Pages thus far by random, manual searching of current and past Yellow Book print and yellowbook.com online directories.

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<sup>1</sup> Yellow Book acquired Feist in 2004, Transwestern in 2005 and Clarke in 2006. *See* Complaint, ¶¶ 28-30, at Dkt. No. 1 and Yellow Book's Answer, ¶¶ 28-30, at Dkt. No. 11.

In addition, after this action commenced, Yellow Pages discovered an advertisement from the San Diego, California market containing one of its images that was not licensed to any of the three companies acquired by Yellow Book. *See* Moore Decl., ¶27. In researching the issue, Yellow Pages discovered that Yellow Book had also acquired two directories for areas in Ohio and Pennsylvania from another of Plaintiff's customers, User Friendly Phone Book LLC ("User Friendly"), to whom that particular image had been licensed. Yellow Pages suspects that is how the image came to be in the California directory, but has not yet been able to adequately confirm its suspicion, and so has not yet sought to amend its Complaint.

Defendants' use of Yellow Pages' images is unauthorized. Yellow Pages' licenses to Clarke, Feist, Transwestern, and User Friendly, as with all Yellow Pages licenses, are non-transferable and restricted to use by the licensees and employees of the licensees only. At no point has either Yellow Book or Pindar been a licensee of Yellow Pages or otherwise been permitted to use any of Yellow Pages' images in any way. After Yellow Pages' inquiries and demands to Yellow Book were ignored and rejected, Yellow Pages commenced this action.

On July 21, 2008, Yellow Pages served its First Sets of Interrogatories and First Requests for Production on Yellow Book and Pindar. Complete copies of these requests are attached hereto as Exhibits A-D. At Defendants' request, Yellow Pages agreed to extend the response deadline for all these interrogatories and requests for production to September 9, 2008. However, when Defendants finally provided responses, they consisted almost entirely of page upon page of objections, and not a single document or a privilege log was provided. Complete copies of these responses are attached hereto as Exhibits E-H. On September 24,

2008, Yellow Pages sent Defendants a good faith letter setting forth, in detail, the numerous deficiencies in Defendants' responses, to which Yellow Pages has never received a direct written response. *See* Exhibit I.

The parties had several discussions relative to discovery over the course of the following months, and the parties were ultimately able to agree to the form of a Stipulation and Protective Order, which was filed on November 7, 2008, and entered by the Court on November 18, 2008. However, other than verbal representations made to Yellow Pages in those discussions, nothing, not a supplemental production response, not a document, not a supplemental interrogatory answer, not a privilege log, was received until December 10, 2008. On that date, nearly three months after Defendants' responses that they would at least produce some documents, Defendants made their first (and thus far only) document production, consisting of a scant 396 pages, which included nothing more than partial agreements and disclosure schedules relative to the Clarke, Feist, and Transwestern acquisitions and print portions of three customer advertisement files. Notably, the production relative to the customer advertisement files did not include any electronic files relative to the print ads, any related online ads, or any image files incorporated into the ads. Indeed, the production did not include any electronic files at all. If electronic files were produced, unaltered and in native format, they would be expected to reveal significant discoverable information, including, but not limited to, their dates of creation, unique identifiers, etc.

This case centers around the unauthorized presence of Yellow Pages' images in Defendants' possession and unauthorized use of such images in advertisements published in Yellow Book's print and yellowbook.com online directories. Yellow Pages requested

electronic files from Defendants that contain images owned by Yellow Pages and advertisements with images owned by Yellow Pages. In response, Defendants have continually asserted that Yellow Pages' images have not been and are not in their possession, and that Yellow Book's use of Yellow Pages' images has been limited to republishing advertisements containing Yellow Pages' images that were in Clarke, Feist, or Transwestern directories at the time of the acquisitions. Not only is such re-publication an infringement, but no viable explanation has been provided for new advertisements containing Yellow Pages' images that were first published after, in some cases several years after, such acquisitions. Defendants also have asserted that their electronic databases are not searchable in an automated manner that would locate Yellow Pages' images or advertisements that contain Yellow Pages' images, suggesting that images and directories need to be reviewed manually, image by image, advertisement by advertisement. A manual review is not feasible, as Defendants purportedly have more than 800,000 images in their image library and publish more than 1,000 directories each year.

Defendants must have electronic files in their possession containing such advertisements in order for Yellow Book to publish them in its print and yellowbook.com online directories. Further, Defendants must have electronic files in their possession containing such images in order for certain of the advertisements to have been created. In an effort to facilitate disclosure of such electronic files, Yellow Pages has engaged consultants from Navigant Consulting, Inc. ("Navigant") that specialize in electronic discovery issues. Navigant has located reliable software that will enable it to search Defendants' databases and locate Yellow Pages' images by comparing Yellow Pages' images to data extracted from

Defendants' databases. Navigant is a well known, respectable consulting firm. *See* Exhibit J. Yellow Pages has discussed this concept with Defendants during multiple telephone conferences and even conducted a conference call with Navigant and Defendants. Yellow Pages also provided a detailed letter from Navigant elaborating as to the software and searching process. *See* Exhibit K.

While Defendants have not to date expressly refused to allow Navigant to proceed with the proposed search, they are impeding the progress of discovery in that they have neither responded to Navigant's letter in any substantive fashion, nor expressly committed to when they will respond. The worst that could result from Navigant's proposed search is it turns up nothing, which would seem to work in Defendants' favor. Yet Defendants have not agreed to the proposed search by Navigant, nor committed to when they will provide a definitive response.

Further, Defendants have not confirmed when, if ever, they will provide supplemental production responses, produce additional documents, provide supplemental interrogatory answers, or produce a privilege log. Discovery opened July 15, 2008. Plaintiff's First Sets of Interrogatories and First Requests for Production have been outstanding since July 21, 2008. Some of the first deadlines in this case, namely expert disclosures, are in January of 2009, and discovery closes May 1, 2009. The continued delay by Defendants is prejudicing Plaintiff's ability to proceed with discovery within these time frames.

## II. ARGUMENT

### A. YELLOW PAGES IS ENTITLED TO SEARCH DEFENDANTS' DATABASES TO LOCATE YELLOW PAGES' IMAGES.

Since the commencement of this action, Defendants have claimed that their databases do not contain Yellow Pages' images and that their databases are not searchable in an automated manner that would locate Yellow Pages' images or advertisements that contain Yellow Pages' images.<sup>2</sup> *See* Yellow Book's responses to Plaintiff's Interrogatory Nos. 1-4, 6 and 7 and Request Nos. 1-4, 12, 15 and 17; Pindar's responses to Plaintiff's Interrogatory Nos. 1, 2, 4 and 5 and Request Nos. 1-4, 10 and 12 at Exhibits E-H. Yellow Pages has every reason to believe that these assertions are untruthful. Yellow Pages has located numerous advertisements in Yellow Book print directories around the country and in the yellowbook.com online directory, containing its images, and has spoken with some of the business owners who inform Yellow Pages that the advertisements were created for them by Yellow Book.

For concrete examples, though, that demonstrate Yellow Pages' contentions Yellow Pages directs the Court to a comparison of advertisements containing Yellow Pages' images that have appeared in recent Yellow Book directories, with the same customers' advertisements from the previous year without Yellow Pages' images. For example:

1. Yellow Pages located an advertisement for Blair C. Greene from the 2008-2009 Hacienda Heights, California Yellow Book publication that contains a car crash image owned by Yellow Pages. However, the advertisements for

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<sup>2</sup> Defendants have represented that they have one database of images referred to as the "Pindar" database, and another separate database of advertisements referred to as the "Clipper" database.

Blair C. Greene in the 2007-2008 Yellow Book directory do not contain an image owned by Yellow Pages. *See* Moore Decl., ¶ 29.

2. Another example is the advertisements for C. William Sanchez. There are three different advertisements containing legal images owned by Yellow Pages in the 2008-2009 Hacienda Heights, California directory. However, the corresponding 2006-2007 and 2007-2008 directories have no advertisement for Mr. Sanchez containing a Yellow Pages' image. *See* Moore Decl., ¶ 30.
3. Another example is the advertisements for Canyon Air Service. There are two advertisements containing an image of a home owned by Yellow Pages in the 2008-2009 Pasadena, California directory. However, the advertisements for Canyon Air Service in the 2007-2008 Pasadena, California directory did not contain an image owned by Yellow Pages. *See* Moore Decl., ¶ 31.
4. Another example is the advertisements for Quality Plumbing. In the 2006 Hacienda Heights, California directory, Quality Plumbing has an advertisement that does not contain an image owned by Yellow Pages. In the 2007-2008 directory, there was one Quality Plumbing advertisement that contains a plumbing image owned by Yellow Pages. In addition, the 2008-2009 directory contains two Quality Plumbing advertisements, each containing a plumbing image owned by Yellow Pages. *See* Moore Decl., ¶ 32.
5. Another example is the Frank Rosas Painting advertisements. The 2006 Hacienda Heights, California directory does not contain an advertisement for

Frank Rosas. The 2007-2008 and 2008-2009 directories both contain advertisements for Frank Rosas with two painting images owned by Yellow Pages. *See* Moore Decl., ¶ 33.

6. Another example is the Quality Door Service advertisements. The 2006 Hacienda Heights, California directory did not contain an advertisement for Quality Door Service. The 2007-2008 and 2008-2009 directories both contain advertisements for Quality Door Service with a garage image owned by Yellow Pages. *See* Moore Decl., ¶ 34.
7. Another example is the Life Chiropractic advertisements. The 2006 Hacienda Heights, California directory did not contain an advertisement for Life Chiropractic. The 2007-2008 directory contained a full page advertisement for Life Chiropractic with a car crash image owned by Yellow Pages. The 2008-2009 directory contained a half page advertisement for Life Chiropractic with the same image owned by Yellow Pages. *See* Moore Decl., ¶ 35.
8. Another example is the Professional Home and Office Cleaning advertisements. The 2006 Hacienda Heights, California directory does not contain an advertisement for Professional Home and Office Cleaning. The 2007-2008 directory did contain an advertisement, which had a home image owned by Yellow Pages. *See* Moore Decl., ¶ 36.
9. Another example is the advertisements for Discount Tree Service. The 2006-2007 Pasadena, California directory contains a Discount Tree Service advertisement that does not have an image owned by Yellow Pages. The

2007-2008 Pasadena, California directory does contain a Discount Tree Service advertisement with a home image owned by Yellow Pages. *See* Moore Decl., ¶ 37.

These are only some of the many examples Yellow Pages has been able to locate where Defendants are using Yellow Pages' images in advertisements that seem to directly contradict Defendants' assertions.

Defendants' assertions that the Pindar and Clipper databases are not readily searchable also appear to be inaccurate. A manual search of images and advertisements in the databases is not feasible due to the tremendous amount of images and advertisements. The only cost and time effective solution to locating the images and advertisements is to utilize software to analyze and compare Yellow Pages' images with the images in the Pindar and Clipper databases to identify potential matches, and then perform a manual comparison to confirm the match. Along these lines, Yellow Pages contacted consultants from Navigant who specialize in these types of electronic discovery issues. As explained in Navigant's letter, Navigant believes that LTU Technologies' LTU-Finder is the appropriate software solution for this matter. LTU-Finder is an add-on to Guidance Software's Encase, a court-tested standard for computer forensics, and is used by a wide variety of commercial and law enforcement entities.<sup>3</sup> *See* Exhibit K.

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<sup>3</sup> In order for the software to properly compare the images, data must be extracted from the Pindar and Clipper databases and loaded onto another server so that they can be compared file by file. Navigant would initiate and make available to the parties chain of custody documentation upon receipt of the extracted images from Defendants and maintain the data in a secured forensic laboratory in its office. Navigant also would ensure that only Navigant staff cleared to work on the matter would have access to the data. *See* Exhibit K for more details on the software and searching process.

Initially, both Yellow Book and Pindar stated they would permit access to electronic storage media to search for the images at issue, see Yellow Book's response to Plaintiff's Request No. 15 and Pindar's response to Request No. 12 at Exhibits G and H, but, to date, Yellow Pages has been unable to get a firm commitment from Defendants for Navigant to proceed, despite Navigant's reasoned proposition. Proper searching of Defendants' electronic databases is an essential element of this case. There is no way for Yellow Pages to know the full scope of its copyright infringement claims if it cannot determine whether its images were in fact downloaded into Defendants' databases or the extent and number of advertisements in which Yellow Pages' images were used. Therefore, Yellow Pages requests that the Court compel Defendants to allow a search by Navigant of their Pindar and Clipper databases for Yellow Pages' images.<sup>4</sup>

Yellow Pages further requests this Court to direct Defendants to pay for any and all costs associated with Navigant's searching of the databases. The presumption under the Federal Rules of Civil Procedure is that the producing party bears the costs of complying with a discovery request. *D'Onofrio v. SFX Sports Group, Inc.*, 2008 WL 4737202, \*7 (D.C. Oct. 29, 2008) (for an electronic discovery search, the court stated that the presumption is that "the producing party bears the costs of complying with a discovery request"). Yellow

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<sup>4</sup> In regards to searching for advertisements in Defendants' publications that contain images owned by Yellow Pages, Defendants' discovery responses suggest "producing for inspection copies of print telephone directories published by Yellow Book that were formerly published by Clarke, Feist, and/or Transwestern at a mutually agreeable time and place." See Yellow Book responses to Plaintiff's Interrogatory No. 6 and Request No. 1 and Pindar's response to Plaintiff's Interrogatory No. 4 at Exhibits E-G. Obviously it is not feasible, nor should Yellow Pages be required, to search manually through Yellow Book's thousands of publications to determine all of Defendants' acts of infringement. Moreover, Yellow Pages is aware of Yellow Book directories *not* formerly published by Clarke, or Feist, or Transwestern, that nevertheless contain Yellow Pages' images in advertisements, as well as online directories. In addition, Yellow Pages would be entitled to the electronic files, not merely the hard copy files, particularly since the act of downloading Yellow Pages' images into Defendants' databases alone constitutes an act of infringement in and of itself.

Pages' discovery requests regarding Defendants' databases containing images owned by Yellow Pages are proper, relevant, and in fact a necessary part of this case. Therefore, Defendants, as the producing party, should cover the costs of searching for the documents.<sup>5</sup>

**B. DEFENDANTS' DOCUMENT PRODUCTION IS DRASTICALLY INSUFFICIENT AND NO PRIVILEGE LOG HAS BEEN PROVIDED.**

Defendants' written responses to Yellow Pages' First Set of Document Requests were served on September 9, 2008, yet despite Yellow Pages' repeated inquiries, no document production of any kind was provided until December 10, 2008. That production consisted only of sections of the agreements relating to the acquisitions of Clarke, Feist, and Transwestern, as well as Defendants' print files relating to three advertisements containing Yellow Pages' images discovered and identified by Yellow Pages. The production is essentially partially responsive to two of the many document requests that Yellow Pages served on Defendants and does not even include any electronic files of Defendants or a single email or other piece of correspondence requested. In addition, despite Defendants' multiple objections to document requests based on the attorney-client privilege and work product doctrine, no privilege log has been provided, which is clearly required under Rule 26 of the Federal Rules of Civil Procedure. Yellow Pages has repeatedly asked Defendants when it will be receiving more documents, as well as a privilege log, but to date, Defendants have been unable to provide Yellow Pages such information.

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<sup>5</sup> If the Court decides that Yellow Pages should pay for some or all of the costs associated with searching for the images and advertisements, Yellow Pages requests that, if Yellow Pages' images are in fact found in the databases, Defendants then be required to pay for all the costs associated with the searching, since they continue to deny that Yellow Pages' images are in the databases at all and refuse to affirmatively move forward in allowing a search to be conducted.

In addition to Defendants' insufficient production and failure to provide a privilege log, Defendants refuse to provide documents for many topics in their written responses that are clearly relevant and seek information to which Yellow Pages is entitled.

1. Request No. 14 to Pindar

Request No. 14 to Pindar requests the following documents:

All documents comprising, evidencing or relating to the number of graphic design artists, or other related staff involved in the processing of advertisements, employed, hired or contracted by Pindar.

*See* Exhibit D. Pindar refused to produce documents responsive to this request, claiming in part that, "there is absolutely no relevance or relationship between the number of graphic design artists employed by Pindar and the Defendants' alleged use or reproduction of images allegedly owned by Plaintiff."<sup>6</sup> *See* Exhibit H. Yellow Pages calculates fees for licenses to use its images primarily on a per artist basis. Therefore, the license fee to which Yellow Pages would be entitled from Defendants directly relates to the number of artists employed by Defendants, and thus Yellow Pages' damages calculation in this case. Documents related to this topic are highly relevant and must be produced.

2. Request Nos. 1-5 to Pindar and Request Nos. 1-4 to Yellow Book

Request Nos. 1-5 to Pindar request the following documents:

All advertisements that Pindar has worked on or created for Yellow Book that contain images owned by Plaintiff.

All documents comprising, evidencing or relating to spec advertisements, proposed advertisements, drafts of advertisements, promotional materials promoting

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<sup>6</sup> Defendants' complete objections and responses are shown in Exhibits E-H. Due to Yellow Book's lengthy objections to each document request and interrogatory, Yellow Pages does not have sufficient space in this motion to include every answer in full within this brief.

advertisements or other related materials that Pindar has worked on or created that contain images owned by Plaintiff.

All documents comprising, evidencing or relating to what Pindar was compensated for each advertisement that Pindar worked on or created containing an image owned by Plaintiff, including, but not limited to, any contracts associated with such advertisements.

All documents comprising, evidencing or relating to what Pindar is compensated for advertisements worked on or created that do not contain images, including, but not limited to, any contacts associated with such advertisements.

All documents comprising, evidencing or related to the relationship between Pindar and Yellow Book, such as the terms regarding any work done by Pindar involving images owned by Plaintiff, including, but not limited to, any contracts or agreements between Pindar and Yellow Book.

*See* Exhibit D. Request Nos. 1-4 to Yellow Book seek essentially the same documents. *See* Exhibit C. For each of these requests, Defendants either refuse to produce documents altogether, or claim that, “to the extent the parties agree upon a reasonable and efficient method for identifying customer advertisements created by Pindar that include images allegedly owned by Plaintiff that appeared in print telephone directories published by Yellow Book that were formerly published by Clarke, Feist, and/or Transwestern, Pindar will produce responsive copies of such advertisements at a mutually agreeable time and place.” *See* Exhibit H.

First, the parties have clearly not been able to agree upon a method for identifying Defendants’ advertisements containing Yellow Pages’ images since Defendants claim their databases cannot be readily searched and thus far will not allow Navigant to search them. Second, as Yellow Pages notified Defendants, Yellow Pages is aware of instances of infringement not only in print directories, but also in online directories in Yellow Book’s yellowbook.com online directory. A manual search of print directories obviously would not

uncover the online directory infringements. Third, as Yellow Pages also has notified Defendants, Yellow Pages is aware of instances of infringement in directories that were not formerly published by Clarke, or Feist, or Transwestern. Therefore, a search of all directories published by Yellow Book, in print and online, is warranted. Third, a manual search of print directories also would not reveal spec advertisements. As is readily understood in this industry, “spec advertisements” are advertisements created to sell to a potential customer and, as such, may never be published. Use of Yellow Page’s images in unpublished spec advertisements would thus not be revealed by a manual search of print directories, but nevertheless would constitute infringement. Yellow Pages is clearly entitled to uncover each instance of Defendants’ infringement, as well as the compensation received for each infringing advertisement, as that directly relates to Yellow Pages’ damages and Defendants’ wrongfully gained profits to be disgorged in this case.

3. Request Nos. 12 and 17 to Yellow Book and Request No. 10 to Pindar

Request Nos. 12 and 17 to Yellow Book request the following documents:

All documents comprising, evidencing or relating to any communications referencing the profitability of advertisements that contain images owned by Plaintiff, the profitability of advertisements that contain images in general and/or the profitability of advertisements that do not contain images.

All documents comprising, evidencing or relating to Yellow Book’s profits made on advertisements using images in general, as opposed to advertisements without images.

*See* Exhibit C. Request No. 10 to Pindar seeks the same information. *See* Exhibit D. For Request Nos. 12 and 10, Defendants refuse to provide any documents based on numerous objections, including that they cannot determine which customer advertisements include Yellow Pages’ images, and that they do not measure profitability of images based on whether

they include images.<sup>7</sup> *See* Exhibits G and H. For Request No. 17, Yellow Book objects on multiple grounds and then directs Yellow Pages to determine its profits on its own by looking up Yellow Book's public documents on the Internet. *See* Exhibit G.

Under the Copyright Act, Yellow Pages is entitled to disgorgement of Defendants' profits attributable to infringement of Yellow Pages' images. Obviously Yellow Pages cannot determine that amount if Defendants will not reveal their profits made on advertisements containing Yellow Pages' images. Assuming Defendants validly claim that they are unable to determine which advertisements contain images owned by Yellow Pages, Yellow Pages proposed search of Defendants' databases should reveal such advertisements, and Defendants should then be able to determine their related profits. There is no way Yellow Pages can discern Defendants' profits derived from their infringement from the public records, as such records are not broken down and publicly reported by (1) profits from infringement of Yellow Pages' rights and (2) profits not from such infringement. This information is highly relevant and necessary for Yellow Pages' damages calculation and must be provided.

3. Request No. 14 to Yellow Book

Request No. 14 to Yellow Book requests the following documents:

All documents comprising, evidencing or relating to amounts paid by Yellow Book to purchase images for advertisements from parties other than Plaintiff.

*See* Exhibit C. Yellow Book refused to produce documents on multiple grounds, including that documents relating to amounts paid by Yellow Book to purchase images other than those

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<sup>7</sup> Defendants also assert an objection to many of the requests that they seek "confidential and/or proprietary information." The parties stipulated to a protective order in this case, which the Court entered on November 18, 2008. *See* Dkt. No. 21. Therefore, this is not a valid objection, and the applicable information should be produced.

owned by Yellow Pages is not relevant in any way. *See* Exhibit G. Amounts paid by Yellow Book for other images are highly relevant because it provides a potential alternate basis for calculating Yellow Pages' damages in this case, namely, calculating the licensing revenue lost as a result of Defendants' infringement, as it is probative of what Yellow Book pays and expects to pay to license the right to use images from third parties. Responses should be provided.

4. Request No. 18 to Yellow Book and Request No. 15 to Pindar

Request No. 18 to Yellow Book requests the following documents:

All documents comprising, evidencing or relating to Yellow Book's document retention policy.

*See* Exhibit C. Request No. 15 to Pindar requests the same information. *See* Exhibit D. Despite the obviously relevant and routine nature of these requests, Defendants incredulously refuse to provide documents and instead object in part because "document retention policy" is "objectionable because it is undefined and exceedingly broad." *See* Exhibits G and H. Whether Defendants have been or are taking steps to cease purging evidence of infringement is highly relevant and attempts by Defendants to claim ignorance as to the information these requests seek cannot possibly be asserted in good faith.

**C. YELLOW PAGES IS ENTITLED TO SUPPLEMENTAL INTERROGATORY RESPONSES FROM DEFENDANTS.**

Defendants' interrogatory responses consist of page upon page of objections, with little, if any, substantive responses. In addition, for those instances where Defendants did provide a substantive response, the answers for the most part do not constitute a good faith effort to comply with its discovery obligation.

1. Interrogatory Nos. 1-3 to Yellow Book and Interrogatory No. 1 to Pindar

Interrogatory No. 1 to Yellow Book requests the following:

Please identify the person(s) with the most knowledge regarding any electronic files containing images owned by Plaintiff obtained from Clarke as a result of Yellow Book's acquisition of Clarke, or its assets.

Interrogatory No. 1 to Pindar, similarly requests the following:

Please identify the person(s) with the most knowledge regarding any electronic files containing images owned by Plaintiff that Pindar has obtained from Yellow Book or on behalf of Yellow Book.

*See* Exhibits A and B. Interrogatories No. 2 and 3 to Yellow Book request the same regarding Feist and Transwestern. *See* Exhibit A. Obviously, Yellow Pages is entitled to know the individuals most knowledgeable on Defendants' electronic files of images owned by Yellow Pages so that they may be deposed. Whether or not Defendants downloaded images owned by Yellow Pages into their databases, and if so, how that came about, is an important issue in this case. Despite that fact, the Defendants' responses consisted of a full page of objections, beginning with the following, for example, in response to Interrogatory No. 1 to Yellow Book:

Yellow Book incorporates by reference its General Objections herein. Additionally, Yellow Book objects to this Interrogatory because it is overly broad, unduly burdensome, impermissibly vague and ambiguous, and fails to identify a time period. Specifically, the phrases "most knowledge," and "any electronic files," and "containing" are objectionable because they are undefined, exceedingly broad, unduly burdensome and to the extent they purport to require Yellow Book to attempt to identify which one or more persons among its many hundreds of employees possess the "most knowledge regarding any electronic files containing images [allegedly] owned by Plaintiff." Yellow Book also objects to the extent this Interrogatory purports to require Yellow Book to identify one or more corporate representatives pursuant to the Federal Rules of Civil Procedure 30(b)(6) because the subject matter of the Interrogatory is not defined with reasonable particularity

sufficient to allow Yellow Book to reasonably do so. Yellow Book also objects to the extent this interrogatory states or assumes that certain images are “owned” by Plaintiff because Plaintiff’s alleged ownership, which Yellow Book does not concede, has not been established. Yellow Book further objects to this Interrogatory to the extent it assumes Yellow Book maintains or generates “electronic files” or records in the ordinary course of business in such a manner that reasonably allows for automated searches or retrieval of specific images included in a particular customer advertisement appearing in a particular telephone directory.

*See* Exhibit G. At the end of the interrogatory, Yellow Book then lists seven individuals with no other information than their current or former title. Yellow Book provides essentially the same response for Interrogatory Nos. 2 and 3, listing nine individuals for No. 2 and seven individuals for No. 3. *See* Exhibit G. Pindar also provides essentially the same response for Interrogatory No. 1, listing five individuals. *See* Exhibit H.

In addition to the long list of meritless boilerplate objections, listing seventeen different individuals who supposedly have the “most knowledge” on one given topic is certainly not a good faith effort to answer the interrogatories. *Williams v. Taser Int’l, Inc.*, 2007 WL 1630875, \*3 (N.D. Ga. June 4, 2007) (compelling party to omit boilerplate objections). Indeed, Rule 30 of the Federal Rules of Civil Procedure imposes a limit of ten depositions total per party. Defendants clearly made no effort to investigate which individuals do in fact have the most knowledge, and likely provided a large amount of individuals in order to force Yellow Pages to engage in a fishing expedition and conduct numerous depositions. And even though Yellow Pages agreed to do so and requested dates for such depositions, see Exhibit I, Defendants never responded with a single date for a single identified individual. Yellow Pages has subpoenaed three of the individuals that it

knows it will need to depose, but is otherwise entitled to a good faith response to these interrogatories.

2. Interrogatory No. 4 to Yellow Book and Interrogatory No. 2 to Pindar

Interrogatory No. 4 to Yellow Book requests the following:

Please identify the person(s) with the most knowledge regarding advertisements containing images owned by Plaintiff, appearing in a Yellow Book publication.

Interrogatory No. 2 to Pindar requests the following:

Please identify the person(s) with the most knowledge regarding advertisements containing images owned by Plaintiff, that Pindar has created or worked on for Yellow Book or on behalf of Yellow Book.

*See* Exhibits A and B. Yellow Pages is entitled to know who is most knowledgeable about advertisements containing its images since that is at the core of this case. In addition, Yellow Pages already is aware of numerous advertisements appearing in Yellow Book publications that contain images owned by Yellow Pages. Despite these facts, Yellow Book and Pindar both respond again with nearly a page of objections, refusing to identify even one individual. *See* Exhibits E and F. Each of Defendants' objections states in part that the interrogatory is unduly burdensome "to the extent they purport to require Pindar to attempt to identify which one or more persons among its many hundreds of employees involved in the generation of customer advertisements for Yellow Book's almost 1,000 print telephone directories possess 'the most knowledge regarding advertisements, containing images [allegedly] owned by Plaintiff.'" *Id.* Defendants' objection apparently asserts that larger companies cannot be asked to identify persons knowledgeable about particular topics because they have too many employees to make such a determination. Such an assertion is patently absurd.

3. Interrogatory Nos. 5 and 11 to Yellow Book and Interrogatory Nos. 3 and 9 to Pindar Set

Interrogatory No. 5 to Yellow Book states the following:

Please identify the number of artists employed, hired or contracted by Yellow Book to create, edit or otherwise perform work on advertisements to appear in Yellow Book publications.

Interrogatory No. 11 to Yellow Book states the following:

Please state whether any salespeople employed, hired or contracted by Yellow Book generate, create or otherwise propose advertisements on-site with customers, and if so, how many such salespeople are employed, hired or contracted by Yellow Book.

*See Exhibit A.* Interrogatory Nos. 3 and 9 to Pindar seek the same information. *See Exhibit B.* Defendants again assert a laundry list of objections, refusing to provide a substantive answer of any kind. Defendants stated, in part, that “there is absolutely no relevance or relationship between the number of ‘artists’ employed by Yellow Book to ‘work on’ customer advertisements.” *See Exhibits E and F.* The number of artists and/or salespeople who create or propose advertisements for Defendants is highly relevant in this case. As previously explained, Yellow Pages calculates fees for licenses to use its images primarily on a per artist basis, which ties directly to Yellow Pages’ damages calculation in this case. To the extent salespeople are creating or otherwise proposing advertisements on-site with customers, they would also qualify as “artists” in the licensing fee calculation. Such information must be provided.

4. Interrogatory Nos. 6 and 7 to Yellow Book and Interrogatory Nos. 4 and 5 to Pindar

Interrogatory No. 6 to Yellow Book requests the following:

Please list each advertisement that has appeared or will appear in a Yellow Book publication that contains an image or images owned by Plaintiff, and for each such

advertisement, please refer to the corresponding document produced that shows such advertisement.

Interrogatory No. 7 to Yellow Book requests the following:

Please list each spec advertisement that has been created for presentation to a Yellow Book customer that contains an image or images owned by Plaintiff, and for each such advertisement, please refer to the corresponding document produced that shows such advertisement.

*See* Exhibit A. Interrogatory Nos. 4 and 5 to Pindar request the same information. *See* Exhibit B. After stating numerous objections, Defendants ultimately state that, the requested information “can be derived from an examination of print editions of telephone directories published by Yellow Book and formerly published by Clarke, Feist, and/or Transwestern that will be made available by Yellow Book for inspection.” *See* Exhibits E and F. As explained above in Section B(2), a search of all directories published by Yellow Book, in print and on the website, is warranted for multiple reasons. These responses again demonstrate why it is clear that, as discussed above, Yellow Pages must be allowed to search Defendants’ databases through its Navigant consultants.

5. Interrogatory No. 12 to Yellow Book and Interrogatory No. 10 to Pindar

Interrogatory No. 12 to Yellow Book states the following:

Please state Yellow Book’s document retention policy and how often, if ever, electronic files are purged, recycled or deleted.

Interrogatory No. 10 to Pindar seeks the same information. *See* Exhibits A and B. Similar to the document requests discussed above in Section B(4), Defendants refuse to provide substantive answers and instead object in part because “document retention policy” and “electronic files” are “objectionable because they are undefined and overly broad.” *See*

Exhibits E and F. Information on document retention policies is routinely discoverable and these objections are indicative of the obstructive, non-responsive approach that pervades Defendants' discovery responses. This information is highly relevant and must be provided.

### **III. CONCLUSION**

Defendants' discovery responses are woefully deficient in virtually every respect. Since Defendants not only continue to assert that their databases do not contain Yellow Pages' images, but also have not permitted Yellow Pages to move forward with searching their databases for the images, Yellow Pages should be allowed to engage the consultants from Navigant to search the databases. Any and all costs associated with the searching should be paid by Defendants, as they are the producing party and have refused to cooperate in a timely manner. In addition, Defendants should be compelled to make a sufficient document production and produce a privilege log, including documents in response to Request Nos. 1-4, 12, 14, 17, and 18 to Yellow Book and Request Nos. 1-5, 10, 14, and 15 to Pindar. Last, Defendants should be compelled to provide proper answers to Interrogatory Nos. 1-7, 11, and 12 to Yellow Book and Interrogatory Nos. 1-5, 9, and 10 to Pindar.

Respectfully submitted,

/s/ Mindi M. Richter

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**CERTIFICATE OF COMPLIANCE WITH LOCAL RULE 3.01(g)**

I HEREBY CERTIFY that we have conferred with counsel for Defendants in a good faith effort to resolve the issues raised by this motion and secure the information and material sought through discovery without court action, but the parties have been unable to agree on the resolution of this motion.

/s/ Mindi M. Richter  
Mindi M. Richter, Esquire

**CERTIFICATE OF SERVICE**

I HEREBY CERTIFY that on December 17, 2008, I electronically filed the foregoing with the Clerk of the Court by using the CM/ECF system, which will send electronic filing to the following attorneys for Defendants: R. Eric Bilik, Esquire, Jeffrey S. York, Esquire, Sara F. Holladay-Tobias, Esquire, and Michael M. Giel, Esquire, McGuireWoods LLP, 50 North Laura Street, Suite 3300, Jacksonville, Florida 32202.

/s/ Mindi M. Richter  
Mindi M. Richter, Esquire