

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

YELLOW PAGES PHOTOS, INC.,

Plaintiffs,

vs.

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

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

Defendants.

**DEFENDANTS' JOINT RESPONSE AND MEMORANDUM OF LAW
IN OPPOSITION TO PLAINTIFF'S MOTION TO COMPEL DISCOVERY**

Defendants Yellow Book USA, Inc. ("Yellow Book") and Pindar Set Inc. ("Pindar") (collectively, "Defendants"), hereby file their Joint Response and Memorandum of Law in Opposition to Plaintiff Yellow Pages Photo, Inc.'s ("YPPI") Motion to Compel Discovery ("Motion") [D.E. 23] and state as follows:

I. INTRODUCTION

This lawsuit arises from a single count of copyright infringement. See D.E. 1. YPPI allegedly licensed various photographic images (the "Works") to three yellow pages telephone directory companies. Yellow Book later acquired the three companies. YPPI claims that Defendants infringed its copyrights in the Works by continuing to use yellow pages customer advertisements containing the Works in the post-acquisition directories published by Yellow Book. YPPI also asserts an unsubstantiated theory that Defendants must be using certain of the Works to create "new" advertisements in Yellow Book's many other directories.

The Motion seeks unfettered access to two separate and distinct electronic databases: (i) Pindar's image "Library" containing thousands of photographic images used by Pindar to create new customer advertisements in Yellow Book directories; and (ii) the massive "Clipper" customer advertisement database, used to manage and store millions of customer advertisements (not images) appearing in Yellow Book's almost 1,000 directories. See D.E. 23 at 1, 7, n.2; Declarations of J. Moore and J. Wragg, attached hereto as Exhibits A and B. Although the parties have been conferring in good faith regarding the scope and technical feasibility of searching the databases, YPPI precipitously filed this Motion seeking unlimited and immediate access to the entire databases just four business days after YPPI first provided Defendants with a proposed search protocol. As set forth herein, YPPI's Motion was prematurely and unnecessarily filed, lacks merit, and should be denied.

With respect to the Library of images, Defendants have agreed to provide a copy of the entire Library to YPPI so that they can confirm that the Works are not being used to create "new" Yellow Book customer advertisements. The only issues concerning the Library relate to the search's scope and cost. Defendants have agreed to permit a search in the Library for all of the Works. YPPI seeks to search for all of YPPI's images whether or not the images are part of the Works. As for costs of the search requested by YPPI, Defendants have already conducted a reasonable investigation and advised YPPI that the Works do not exist in the Library and thus YPPI should bear the cost to conduct any additional search.

With respect to the massive Clipper customer advertisement database, the parties agree that the Library should be searched first to determine if the Works have been used to create new advertisements before attempting to extract and search millions of customer advertisements from the Clipper database. Nevertheless, YPPI is now before the Court with a premature request to immediately search the entire contents of the Clipper database. Searching millions of Clipper advertisements would be exceedingly difficult, time consuming, expensive, and may not be necessary or feasible. Ex. B ¶ 8. Because Clipper does not allow for “mass” extraction of advertisements, significant additional cost and programming would also be required to even attempt the proposed search. *Id.*

With respect to the remaining items in the Motion unrelated to the database searches, these issues are largely moot as Defendants have conferred in good faith with YPPI to substantially resolve and clarify the remaining issues. Defendants are currently in the process of collecting additional documents and information and will be supplementing their prior discovery responses with additional documents and information (along with a privilege log). The supplementation will begin this week and continue on a rolling basis until completed, which Defendants expect should be done within the next several weeks. Accordingly, Defendants respectfully submit that the Motion was prematurely and unnecessarily filed, and Court intervention is unwarranted and unnecessary at this time.

II. NATURE OF THE CASE

YPPI asserts that after the three acquisitions by Yellow Book, advertisements containing the Works began appearing in post-acquisition editions of Yellow Book online and print directories.¹ See D.E. 1 ¶¶ 34-36; D.E. 23 at 2. YPPI also alleges "on information and belief" that (i) Yellow Book took possession of CDs and/or electronic files containing the Works following Yellow Book's acquisition, D.E. 1 ¶ 31; (ii) Yellow Book furnished CDs and/or electronic files containing the Works to Pindar, *id.* at ¶ 32, and (iii) Pindar created and produced new advertisements for Yellow Book directories using certain of the Works, D.E. 1 at ¶ 34.

A. The Parties and the Allegedly Copyrighted "Works"

Yellow Book is the leading independent publisher of print and online Yellow Pages directories nationwide. See D.E. 11 ¶ 1. Yellow Book, through its subsidiary companies, currently publishes and distributes approximately 1,000 print telephone directories. Pindar (now Yell Adworks) creates and produces advertisements exclusively for use in Yellow Book online and print yellow pages directories. See D.E. 12 ¶ 1. Pindar maintains its own "image library" database of various photographic images and artwork used to create new customer advertisements in Yellow Book directories (the "Library"). See Ex. A ¶ 3.

YPPI is allegedly in the business of licensing photographic images for use in yellow pages telephone directory advertisements. D.E. 1 ¶ 1. YPPI markets and

¹ Although a number of advertisements identified in Trent Moore's Declaration were located on Yellow Book's website (www.yellowbook.com), Mr. Moore correctly points out that each of the advertisements also appear in a Yellow Book print directory. D.E. 24 ¶ 10.

licenses CDs with various categories of photographic images for use in telephone directory advertisements, i.e., "Homes", "Attorneys", "Plumbers", etc. See *id.*, Ex. 1-65. The only alleged copyrighted YPPI images at issue are the "Works" defined as the "series of images" attached as Exhibits 1-65 to the Complaint. See *id.* ¶ 14. YPPI allegedly obtained copyrights on the Works between January 2007 and May 2008. *Id.* ¶ 17, Exs. 66-76.² The Works include approximately 3,250 photographic images grouped by directory category or heading. *Id.* at Exs. 1-65. Because YPPI only alleges copyright infringement in the "Works", see, e.g., *id.* at ¶¶ 44-46, none of YPPI's other images are relevant to this lawsuit.³

B. The Three Acquisitions Giving Rise to YPPI's Claim

As alleged in the Complaint, YPPI's claim arises from Yellow Book's acquisition of three yellow pages directory publishers: (i) Feist Publications, Inc. ("Feist") on or about March 25, 2004; (ii), Transwestern Publishing ("TWP") on or about July 15, 2005; and (iii) Clarke Directory Publications, Inc. ("Clarke") on or about January 5, 2006. See D.E. 1 ¶¶ 19-35; D.E. 23 at 2. YPPI alleges that it licensed certain of the Works to each of the acquired companies. *Id.* At the time of the acquisitions: Feist allegedly had a license to use three (3) CDs of Works (approximately 150 images), D.E. 1 ¶¶ 22-23; TWP allegedly had a license to use

² The date of YPPI's purported copyright registration is significant to the amount in controversy because only actual damages as opposed to statutory damages under the Copyright Act are available for any alleged pre-registration acts of copyright infringement. See 17 U.S.C. § 412.

³ Although YPPI offers speculation that Yellow Book may also be using a single YPPI image not licensed to Clarke, Feist, or TWP as a result of an unrelated Yellow Book acquisition of directories from User-Friendly Phone Book, LLC, YPPI concedes that it "has not yet been able to adequately confirm its suspicion, and so has not yet sought to amend its Complaint." See D.E. 23 at 3.

twenty-two (22) CDs of Works (approximately 1,100 images), D.E. 1 ¶¶ 25-26; and Clarke allegedly had a license to use fifty-nine (59) CDs of Works (approximately 2,950 images), D.E. 1 ¶¶ 19-20.

Although YPPI repeatedly claims in the Complaint and Motion that the acquired companies had exclusively “non-transferable” licenses from YPPI to use the Works, D.E. 23 at 3, the purported YPPI license to Clarke provides that: “Should the licensed publisher sell [its] directories, standing ads/images may continue publishing with the new publisher without charge[;] however, the standing ad/image may not be copied or used in other directories . . .” See Ex. D.⁴ Thus, to the extent Yellow Book continued to publish the same customer advertisements containing Works in subsequent Clarke directories, it appears likely that any such use of the Works was permitted by the license.⁵

C. YPPI’s Purported Evidence of Copyright Infringement

Since the lawsuit was filed, YPPI has only identified a small number of alleged infringing uses of the Works. D.E. 24. Most of the alleged examples (if not all) can be traced back to advertisements from the acquired directories and/or customer supplied advertisements. See Declaration of T. Hershey, attached hereto as Exhibit C. The Motion purports to identify examples of infringing uses to establish that the Works “must” be in the Library and Defendants “must” be using the Works to create “new” advertisements. D.E. 23 at 5. However, the vast majority of the

⁴ The License Agreement between YPPI and Clarke was provided by YPPI’s prior counsel before commencement of litigation, and accordingly is not subject to the Protective Order [D.E. 21], but in an abundance of caution, Defendants have redacted unrelated portions of the Agreement.

⁵ Defendants have asserted various defenses to YPPI’s copyright claims and do not concede that YPPI’s copyrights are valid or that any alleged uses are unauthorized or unlawful. See D.E. 11, 12.

purported examples of alleged infringing uses appear to be derived from advertisements appearing in several Yellow Book directories in the geographic area served by the acquired Clarke directories. See Ex. C ¶ 5. To date, Defendants have not identified a single instance of a new customer advertisement being created using any of the Works from the Library. *Id.* at ¶ 6.

III. DEFENDANTS' GOOD FAITH DISCOVERY EFFORTS

YPPI is before the Court on a premature and unnecessary Motion. Despite Defendants' good faith discovery responses and continuing efforts to amicably resolve discovery issues, YPPI filed its sweeping Motion.

A. Defendants' Discovery Responses

On July 21, 2008, Plaintiff served 57 separate discovery requests, including 33 Requests for Production and 24 Interrogatories. See D.E. 23, Exs. A-D. Many of the requests sought production or identification of advertisements containing any of the Works and related information. See D.E. 23, Ex. A, Int. Nos. 1-4, 6, 7; Ex. B, Int. Nos. 1, 2, 4, 5; Ex. C, Req. Nos. 1-4, 12, 15, 17; Ex. D, 1-4, 10, 12.

On September 9, 2008, Defendants responded to the voluminous discovery. Among other things, Defendants accurately responded that advertisements were not stored in the ordinary course of business in such a manner to permit the automated search for advertisements based on whether such advertisements contain certain images, i.e., the Works. See Ex. B ¶ 7. In other words, Defendants "[do] not maintain [their] records in a manner that readily or reasonably allows for automated searches or retrieval of customer advertisements based on specific images included

within the advertisements, and ... cannot readily determine which customer advertisements include images allegedly owned by Plaintiff" See D.E. 23, Ex. G, Resp. to Req. Nos. 3, 4, 12; Ex. H, Resp. to Req. Nos. 1, 3, 10; Ex. E, Resp. to Int. Nos. 1-4, 6, 7; Ex. F, Resp. to Int. Nos. 1, 2, 4.

Contrary to YPPI's assertions, Defendants have not refused to provide responsive information relating to allegedly infringing uses of the Works. To the contrary, Defendants have agreed to produce advertisements containing the Works, but simply had no automated way to identify particular images among the advertisements stored in Clipper. Defendants agreed to produce copies of post-acquisition directories so that YPPI could undertake a review to identify any allegedly infringing uses (the same and only search method available to Defendants). In addition, Defendants agreed to work with YPPI and to produce additional advertisements if the parties identified "a reasonable and efficient method for identifying customer advertisements that include images allegedly owned by [YPPI]". See, e.g., D.E. 23, Ex. G, Resp. to Req. Nos. 3, 4; Ex. H, Nos. 1, 3, 5.

In addition to responding to interrogatories and making the print directories available, Defendants agreed to produce: (i) purchase agreements and relevant schedules related to the Clarke, Feist, and TWP acquisitions; (ii) communications between the parties relating to the use of the Works by Defendants, to the extent they exist; (iii) copies of CDs or other electronic compilations of the Works, to the extent any exist; and (iv) copies of customer contract files for advertisements

identified as containing the Works. See D.E. 23, Ex. G, Resp. to Req. No. 5-11, 13, 15; Ex. H, Resp. to Req. 6-9,11, 12.

On November 21, 2008, following the entry of the Protective Order [D.E. 21], Defendants made their initial production of documents consisting of: (i) the various agreements and relevant schedules governing Yellow Book's acquisitions of Clarke, Feist, and TWP; and (ii) customer contract files for the initial three customer advertisements identified by YPPI as allegedly containing the Works.⁶ Defendants are currently in the process of collecting additional documents and information, including the customer contract files and Clipper advertisement files for each additional example of allegedly infringing uses identified by YPPI in its Motion.

B. Defendants' Continued Good Faith Meet and Confer Efforts

Between September and December 2008, the focus of the parties' ongoing meet and confer efforts was the threshold issue of how to identify the allegedly infringing uses of the Works. YPPI rejected Defendants' offer to make the post-acquisition directories available for "manual" review (which is apparently what was done to identify allegedly infringing advertisements referenced in the Motion). Rather, the parties instead engaged in ongoing meet and confer efforts for several months principally regarding database searchability issues.

YPPI concedes the parties were engaged in meet and confer efforts during the months following Defendants' initial discovery responses. D.E. 23 at 4. Despite

⁶ Although YPPI complains about the timeliness of Defendants' initial document production on December 10, 2008, YPPI's initial production of documents and a privilege log was only forthcoming on November 21, 2008. Like Defendants, YPPI awaited the entry of the Protective Order. D.E. 21.

YPPI's disingenuous claim that they "never received a direct written response" to their September 24th correspondence, YPPI acknowledges the parties engaged in numerous subsequent "discussions" regarding discovery issues. *Id.* Indeed, a few of the selected email exchanges between counsel regarding database searchability issues are attached hereto as Composite Exhibit E.

On November 19, 2008, the parties held a conference call with a Pindar application architect and YPPI's consultants from Navigant Consulting, Inc. ("Navigant"). Ex. B ¶ 11. During the conference call, Defendants described the Library and Clipper databases and their differing functions, in addition to the technical and scope issues rendering searches of Clipper infeasible. Notably, during the November 19th call, Navigant had not yet identified any proposed "image recognition" software or any other "solution" to search the databases for the Works. *Id.* Navigant agreed to complete their research following the November 19th call and to provide a written search proposal to focus first on a search of the Library due to technical difficulties associated with searching Clipper.

On December 11, 2008, Navigant for the first time provided its proposed search protocol using a new "image recognition" product. See D.E. 23, Ex. K. Incredibly, YPPI filed its Motion just four business days later, claiming that Defendants had not timely responded or committed to a definitive timetable for a response to Navigant's "reasoned proposition," although it took Navigant more than three weeks after the November 19th call to submit a proposal. *Id.* The protocol consisted of a two-page letter and a one-page advertisement for a new software

product called LTU-Finder. The Motion relies on the unsworn letter proposal as purported evidence that the LTU-Finder is the “appropriate” solution to search both databases although the proposal itself contains factual errors.⁷ Moreover, although Defendants do not dispute that Navigant generally has experience with “electronic discovery” issues, YPPI’s consultants acknowledged during the November 19th call they did not have “image recognition” search experience.

Following the unsuccessful mediation on December 16, 2008, YPPI’s counsel demanded an on-the-spot response to the December 11, 2008 proposal. YPPI’s counsel was advised that a response would be forthcoming (although Defendants’ counsel could not commit to a date certain while in Tampa at the mediation). The next day YPPI’s counsel emailed Defendants’ counsel advising of their intent to file the Motion. See Ex. F. Defendants’ counsel immediately responded by email to advise that Defendants were reviewing the proposal and requesting that the parties continue to confer in attempt to resolve as many discovery issues as possible. *Id.* Nevertheless, YPPI filed its Motion that same day.

Although the Motion acknowledges that Defendants never refused to allow a search of the databases, YPPI claims Defendants impeded discovery because “they have neither responded to Navigant’s letter in any substantive fashion, nor expressly committed to when they will respond.” See D.E. 23 at 6. This statement is belied by the fact that the Motion was filed ***less than one week*** after the Navigant proposal

⁷ Among other things, the protocol inaccurately states that Clipper “was designed for the storage... search and retrieval of large numbers of discrete ***images*** for use in phone book advertisements.” See D.E. 23, Ex. K at 2. This is fundamentally wrong as the Library contains discrete images, whereas Clipper manages and stores completed customer ***advertisement*** files, not discrete images.

was first provided on December 11, 2008 and before Defendants had a reasonable opportunity to respond (especially given that it took Navigant three weeks to research and prepare the proposal following the November 19th call).

MEMORANDUM OF LAW

I. YPPI'S DEMAND FOR UNFETTERED DATABASE ACCESS

Although the Motion makes no distinction between the Library and Clipper databases, each separate and distinct database stores different information in different ways for different purposes. See Exs. A and B. The Library contains approximately 90,000 photographic *images* used by Pindar to create new customer advertisements. Ex. A ¶ 13. The images in the Library are searchable in several ways. *Id.* ¶ 5. In contrast, the Clipper System ("Clipper") is the advertisement database used to manage and store customer advertisements for Yellow Book directories. Ex. B ¶ 3. Clipper contains more than five million customer *advertisements* and approximately ten (10) terabytes of information. *Id.* ¶¶ 3, 8. Clipper does not permit automated searches for particular images contained with particular advertisements. *Id.* ¶ 7.⁸ Moreover, Clipper does not allow for the "mass" extraction of advertisements; rather it is only programmed to permit extractions of one or a small number of advertisements. *Id.* ¶ 8.

1. The Pindar Image Library. Although Pindar conducted a reasonable search and investigation to determine whether any Works exist in the Library, see

⁸ YPPI's consultant acknowledges that there is no automated way to identify advertisements within Clipper containing the Works. See D.E. 23, Ex. K, p. 1.

Ex. A, Defendants have agreed to permit the additional search requested by YPPI, provided that (i) the search is limited to the Works, and (ii) YPPI bears the cost.

As a threshold matter, YPPI is not entitled to further search the Library. Pindar has already conducted a reasonable search and investigation in an effort to confirm that the Works were not added to the Library following Yellow Book's acquisitions. See Ex. A ¶¶ 7-9. In addition, the Pindar Librarian searched the Library for YPPI's naming conventions and reviewed various categories of images within the Library. See *id.* ¶ 9. Defendants clearly met their Rule 34 discovery obligations. Moreover, it is well-settled in the Eleventh Circuit that a party is not entitled to unfettered access to an opposing party's databases absent evidence of discovery abuse, which does not exist here. See *In re Ford Motor Co.*, 345 F.3d 1315, 1316-17 (11th Cir. 2003); *U & I Corp. v. Advanced Med. Design*, 251 F.R.D. 667, 674 (M.D. Fla. 2008); see also *Suncast Techs., L.L.C. v. Patrician Prods., Inc.*, No. 07-80414-CIV, 2008 WL 179648, at *6 (S.D. Fla. Jan. 17, 2008) (denying access to database where defendant agreed to produce relevant information); *Scotts Co. v. Liberty Mut. Ins. Co.*, No. 2:06-CV-899, 2007 WL 1723509, at *2 (S.D. Ohio June 12, 2007) ("[W]ithout a qualifying reason, plaintiff is no more entitled to access to defendant's electronic information storage systems than to defendant's warehouses storing paper documents.").

Rather than proceed to search the Library for the Works, YPPI now demands the right to conduct a fishing expedition to see if any other YPPI images exist in the Library. The "Works" are the only images that are the subject of YPPI's claim in the

lawsuit. But YPPI demands to search the Library for not only the Works, but also thousands of other YPPI images that were not licensed to the acquired companies. Discovery must be tailored to the issues involved in the case. See Fed. R. Civ. P. 26(b)(1); *Awad v. CiCi Enters.*, No. 8:06-cv-1278-T-24TBM, 2006 WL 4824477, at *1 (M.D. Fla. Nov. 20, 2006); see also *Dellacasa, LLC v. John Moriarty & Assocs. of Fla.*, No. 07-21659-CIV, 2007 WL 4117261, at *2 (S.D. Fla. Nov. 16, 2007). Much like the plaintiff in *Dellacasa*, YPPI has alleged copyright infringement based on one series of "works," but seeks discovery of other works that are not the subject of its copyright claim. 2007 WL 4117261, at **1-2. Accordingly, the demand to search for thousands of additional YPPI images not included in the Works is improper and does "not relate to an *actual claim* ... in the instant action." *Id.* at *2 (emphasis added).

As for the cost of the additional search of the Library, YPPI cites to a single case for the general proposition that "the producing party" should bear "the costs of complying with a discovery request." D.E. 23 at 11 (citing *D'Onofrio v. SFX Sports Group, Inc.*, 2008 WL 4737202, at *7 (D.D.C. Oct. 29, 2008)). As noted above, Pindar already conducted a reasonable search and investigation of the Library, but nevertheless agreed to allow YPPI to conduct an additional search at its own cost. Thus, Pindar has complied with the discovery requests by responding that based on its reasonable investigation, the Works do not exist in the Library.

Even assuming the additional search was warranted, cost-shifting is appropriate where such a request is unduly burdensome or expensive. See *id.*; see also *Zubulake v. UBS Warburg LLC*, 217 F.R.D. 309, 318 (S.D.N.Y. 2003) (defining

undue burden or expense as that which outweighs request's likely benefit when considering certain factors); Fed. R. Civ. P. 26(b)(2)(C)(iii) (stating a "court must limit the ... extent of discovery ... if it determines that ... the burden or expense of the proposed discovery outweighs its likely benefit, considering" certain factors). Cost-shifting factors to consider include: (1) "[W]hether the information is reasonably accessible as a technical matter without undue burden or cost"; (2) "[T]he extent to which the request is specifically tailored to discover relevant information"; (3) "[T]he availability of such information from other sources ..."; (4) "[T]he total cost of production, compared to the amount in controversy"; (5) "[T]he total cost of production, compared to the resources available to each party"; (6) "[T]he relative ability of each party to control costs and its incentive to do so"; (7) "[T]he importance of the issues at stake in the litigation"; and (8) "[T]he relative benefits to the parties of obtaining the information." See Advisory Committee Notes to the 2006 Amendments to Fed. R. Civ. P. 26; *Zubulake*; Comment 13.a, *The Sedona Principles*, 2d ed. 67 (The Sedona Conference Working Group Series, 2007).

Here, most factors favor cost-shifting. Pindar conducted a reasonable investigation, and YPPI's additional search requires a substantial cost (estimated "conservatively" by Navigant at \$20,000 to \$30,000 or perhaps more). If Defendants are correct that the Works are not in the Library, then the search was unnecessary. Moreover, under YPPI's proposed protocol, only YPPI retains the ability to control costs with no incentive to do so if Defendants have to pay. Finally, because the additional search is for the purpose of allowing YPPI to verify the results of a prior

reasonable investigation, the search is solely for YPPI's benefit. Accordingly, YPPI should bear the cost to conduct the additional search.

2. The Clipper System. The Motion should be denied as premature with respect to searching Clipper. The parties have agreed that it makes sense to proceed with a "phased" approach beginning with additional searches by YPPI's consultant for Works in the Library. If the Library does not include any of the Works, the scope of the alleged infringement is not widespread as YPPI suspects. A phased approach is the most efficient way to determine the scope of the alleged infringement. Defendants do not believe there is any evidence to support YPPI's grandiose theory that Defendants have been using the actual Works to create new advertisements (as opposed to the discrete continued use of migrated and/or customer supplied advertisements that may contain the Works). If Defendants are correct, the scope of the alleged infringement is much more limited and the search for any alleged infringing uses will be more focused and manageable.

Rather than proceed with the agreed and logical phased approach, Plaintiff now seek to conduct an unfettered and simultaneous search of both the images in the Library and the millions of customer advertisements from almost 1,000 directories stored in the Clipper database. However, YPPI's demand to conduct a search of the massive Clipper database is premature and presents significant scope, cost, burden and technological feasibility issues that must still be resolved and that will depend in part on the outcome of the search of the Library. See Ex. ¶¶ 8, 10.

Moreover, Navigant did not provide its proposed protocol until December 11, 2008, six days before YPPI filed the Motion. Navigant proposed a new image recognition software, LTU-Finder. Neither the protocol nor this Motion provide any evidence or information related to the feasibility, effectiveness, or cost of applying this software to search the massive Clipper database. This new software product was not identified during the parties' November 19th teleconference. Indeed, there is no indication that Navigant has ever used the new LTU-Finder product. Although it appears LTU-Finder may allow a search of the images in the Library, there is insufficient evidence regarding its ability to search Defendants' entire Clipper database, which contains millions of advertisements and terabytes of information stored in various formats that would need to be extracted requiring significant programming time and expense. See Ex. B ¶¶ 3, 8.

YPPI demands an unfettered search of Clipper to be paid for by Defendants, but fails to provide any evidence to address the fundamental issues of the proposed search's technological feasibility, effectiveness, scope, and cost. In contrast, Defendants have identified numerous technical obstacles and burdens associated with searching Clipper and other issues highlighting the questionable feasibility and effectiveness of YPPI's protocol. See Ex. B ¶¶ 7, 8, 10, 11. For these reasons, it is premature to order a blanket search of Clipper, much less a search of all of Clipper, without additional investigation and evidence regarding the proposed search's technological feasibility, cost, and effectiveness. In other words, this Court cannot decide the appropriateness of an electronic search protocol without "the benefit of

information from some reliable source -- whether an affidavit from a qualified expert, a learned treatise, or, if appropriate, from information judicially noticed." *Victor Stanley, Inc. v. Creative Pipe, Inc.*, 250 F.R.D. 251, 260-61 n.10 (D. Md. 2008) (Grimm, M.J.) (addressing disputed ESI and keyword-search protocol).

Finally, the Rule 26(b)(2)(C)(iii) proportionality requirements allow the Court to limit or modify discovery if its burdens outweigh its likely benefit. Rule 26(b)(2) "should be used to discourage costly, speculative, duplicative, or unduly burdensome discovery of computer data and systems" *In re Seroquel Prods. Liab. Litig.*, 244 F.R.D. 650, 654 (M.D. Fla. 2007) (quoting MANUAL FOR COMPLEX LITIGATION § 11.446 (4th ed. 2004)). In light of the massive size and complexity of Clipper, the consideration of these proportionality factors would require at the very least an effective sampling and testing protocol, rather than requiring a potentially futile, unnecessary, and exorbitantly costly attempt to extract millions of files from Clipper. See *id.* at § 11.493 ("Acceptable sampling techniques ... can save substantial time and expense"); Advisory Committee Notes to the 2006 Amendments to Fed. R. Civ. P. 26(b)(2) (determining good cause for producing ESI that is not reasonably accessible may require focused discovery, including sampling, to better assess the burdens and costs of accessing the information and its value to the litigation in light of available information); see also Ex. B ¶¶ 8, 10.

II. RESPONSES TO REMAINING ITEMS IN THE MOTION

For the ease and efficiency of the Court's consideration of the numerous items addressed in the Motion, Defendants have grouped the various related Requests and Interrogatories by topic or category.

A. The Motion is Premature and Violates the Local Rules

The Motion unreasonably and prematurely seeks Court intervention regarding 34 separate discovery requests. Many of these requests relate to the database search issues. The parties had agreed in concept to a phased approach starting with the Library search before evaluating the scope, feasibility, and necessity of searching Clipper. As for the non-database issues, Defendants have agreed to supplement their discovery responses. Accordingly, it is Defendants' position that all of the voluminous discovery requests cited in the Motion are now moot, and that Court intervention is not necessary.

Moreover, YPPI's Motion failed to comply with the Local Rules. YPPI's Motion violates the spirit of Local Rule 3.01(g), which requires a good faith effort to resolve discovery disputes before seeking Court intervention. See *Broughton v. City of Jacksonville*, No. 3:06-cv-234-J-32MCR, 2007 WL 2964174, at *2 (M.D. Fla. Oct. 10, 2007). "Local Rule 3.01(g), requiring certification of a good faith conference before any discovery motion is filed, is *strictly enforced*." *Id.* at *2 (quoting Middle District Discovery (2001) at 20); see also *H2Ocean, Inc. v. Schmitt*, 2006 WL 3837411, at *5 & n.4 (N.D. Fla. Dec. 22, 2006). Most, if not all, of the issues in the

Motion could have been resolved without the need for filing the Motion (and indeed virtually all of the issues in the Motion have now been resolved).

YPPI's Motion also violated Local Rule 3.04(a) requiring YPPI to recite each discovery request and response at issue "in full." Here, YPPI selectively quotes discovery requests and responses, presenting the disputed issues out of context and making it more difficult for the Court and Defendants to evaluate the arguments. YPPI did not seek leave of Court or confer with Defendants; rather, they simply ignored the Rule because they claim compliance would be too burdensome. D.E. 23 at 13 n.6. This is exactly why the Local Rules require parties to confer in an effort to resolve as many discovery disputes as possible to avoid filing voluminous, premature, and/or unnecessary motions to compel.

B. Discovery Requests Contingent Upon Database Searches

Many of the discovery requests seek information relating to advertisements or electronic files containing the Works. With respect to these requests, Defendants correctly explained that its databases did not permit searches in an automated fashion. Nevertheless, they offered to provide copies of print directories and agreed to provide more specific information if the parties were able to identify a reasonable, efficient protocol for identifying advertisements containing the Works.

1. Advertisements (Request Nos. 1 and 2 to Pindar and 1 and 2 to Yellow Book; Interrog. Nos. 4 and 5 to Pindar and 6 and 7 to Yellow Book):

Several discovery requests seek advertisements containing the Works. As Defendants explained in their responses, Defendants do not have an automated means to identify each advertisement including the Works. Until the results of the

Library search are known and the technological issues relevant to the feasibility and effectiveness are resolved as to Clipper, this Motion is premature. However, Defendants have agreed to provide electronic and hard copy files relating to each alleged infringing advertisement identified by YPPI to date. In fact, Defendants are in the process of extracting and copying such files, which will be made available on a rolling basis beginning this week. Ex. B ¶ 9; Ex. C ¶ 3.

Defendants agreed from the beginning that YPPI is entitled to information identifying the alleged infringing use of the Works and offered to produce print directories and additional information “to the extent the parties agree upon a reasonable and efficient method for identifying customer advertisements created by Pindar that include [the Works]”⁹ See, e.g., D.E. 23, Ex. H, Req. No. 1. Though YPPI chafes at Defendants' suggestion to review print directories, this is the only method currently available to locate advertisements containing the Works. YPPI incorrectly states that “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.” D.E. 23 at 5.¹⁰ The number of Library images is irrelevant to the manual review of directories. Moreover, there is no evidence to suggest that the Works appear in even a fraction of the approximately 1,000 directories published each year. YPPI also complains that no electronic files were produced. But, as of early December 2008, YPPI had only identified a dozen or so alleged examples of

⁹ Pindar's response to Request No. 1 mirrors responses to Request Nos. 3 and 4 to Yellow Book, D.E. 23, ex. G, and Request Nos. 3 and 5 to Pindar, D.E. 23, ex. H.

¹⁰ Actually, the Library contains approximately 90,000 digital photograph images and the Clipper database includes more than 5,000,000 customer advertisements. See Ex. A ¶ 3; Ex. B ¶ 3.

Works appearing in Yellow Book directories. The parties agree this case hinges on identification of each use of the Works, and Defendants are in the process of extracting electronic files for each of the allegedly infringing advertisements identified by YPPI to date.

2. Electronic Files Containing the Works or "Most Knowledgeable" Persons (Request Nos. 12 to Pindar and 15 to Yellow Book; Interrog. Nos. 1 and 2 to Pindar and 1-4 to Yellow Book):

Interrogatory Nos. 1 through 4 to Yellow Book and Interrogatory Nos. 1 and 2 to Pindar seek information regarding individuals with the "most knowledge" regarding electronic files or advertisements containing the Works. However, Defendants explained their inability to readily identify advertisements containing the Works. Thus, Defendants cannot identify persons with "most knowledge" of each alleged use unless they can identify the alleged use. Nevertheless, Defendants identified in good faith the persons with the most knowledge regarding the three acquisitions, in addition to the persons with knowledge regarding Defendants' information technology systems. To the extent additional individuals with more specific knowledge can be identified, Defendants have agreed to supplement these responses. In fact, Defendants have already identified Pindar application architect John Wragg and Pindar's Librarian Joe Moore. Defendants' responses adequately permit YPPI to determine whether the Works were loaded into the Library. D.E. 23 at 18. Accordingly, YPPI's Motion should be denied.

Similarly, the Motion with respect to Request No. 12 to Pindar and No. 15 to Yellow Book should be denied, because Defendants had already agreed to produce

CDs or other electronic media files containing the Works to the extent they exist and can be located after a reasonable and diligent search.

C. Miscellaneous Moot Discovery Items

1. Defendants' Artists or Salespeople (Request No. 14 to Pindar and Interrog. Nos. 3 and 9 to Pindar and 5 and 11 to Yellow Book):

The Motion should be denied as moot with respect to these request seeking information regarding the number of Defendants' artists and salespersons. This Request is moot because Defendants have already informally provided information regarding the number of Pindar artists and Yellow Book salespeople and agreed to supplement the interrogatory response accordingly. However, Defendants do not concede the relevance of these requests to the extent the Pindar artists and the Yellow Book salesforce do not "create" new advertisements using the Works.

2. Document Retention Policies (Request No. 15 to Pindar and No. 18 to Yellow Book; Interrog. No. 10 to Pindar and No. 12 to Yellow Book):

These requests seek sweeping information relating to Defendants' document retention policies. Though YPPI did not explain the relevance of these requests, Defendants agreed to provide their written document retention policies. Indeed, YPPI produced no evidence that Defendants' document retention policies are relevant to any claim or defense. See *India Brewing, Inc. v. Miller Brewing Co.*, 237 F.R.D. 190, 192 (E.D. Wis. 2006) (denying motion to compel because party did not show retention policy was relevant). Nor has YPPI explained how its overbroad requests, which seek not just retention policies but all documents relating to such policies, are relevant. See *U.S. Fire Ins. Co. v. Bunge N. Am., Inc.*, 68 Fed. R. Serv.

3d (Callaghan) 134, 2007 WL 1531846, at *15 (D. Kan. May 25, 2007). Accordingly, this Motion should be denied. See *id.*; *India Brewing, Inc.*, 237 F.R.D. at 192.

3. Compensation for Advertisements (Request Nos. 3, 4, and 5 to Pindar and Nos. 3 and 4 to Yellow Book):

Request No. 3 to Pindar and Nos. 3 and 4 to Yellow Book seek information regarding Defendants' compensation for advertisements containing the Works, which presents the same difficulty as noted above. Until Defendants can identify such advertisements, they cannot produce advertisement-specific information. Nevertheless, these items are moot by agreement of counsel. Defendants have agreed to first produce customer contract and advertisement files for each of the allegedly infringing advertisements identified in Mr. Moore's Declaration.

Request No. 5 to Pindar, seeking documents regarding the Yellow Book and Pindar business relationship, is also moot. Defendants have agreed to produce the agreements between Yellow Book and Pindar, which is the exclusive supplier of images used to create new advertisements in Yellow Book directories. See Ex. B ¶ 2. Likewise, that agreement renders moot Request No. 4 to Pindar, which seeks documents related to Pindar's compensation for advertisements.

4. Profitability of Advertisements (Request No. 10 to Pindar and Nos. 12 and 17 to Yellow Book):

Request No. 17 to Yellow Book seeks documents relating to the profitability of advertisements using images generally compared to advertisements without images. Notwithstanding Defendants' explanation that they do not measure advertisement profitability based on the presence of images in the ordinary course of business,

Defendants have agreed to provide any such documents, to the extent any exist. For the same reasons, Request No. 10 to Pindar and Request No. 12 to Yellow Book, seeking communications regarding the profitability of advertisements containing (a) the Works, (b) images generally, or (c) no images, are moot.

5. Amounts Paid to Third Parties (Request No. 14 to Yellow Book):

This Request seeks documents relating to amounts paid by Yellow Book to purchase or license images from third parties. This item is moot; Defendants have agreed to produce agreements with third parties relating to images in the Library.

6. Privilege Log:

As noted above, Defendants are in the process of collecting documents and information for their forthcoming supplemental production. Defendants will provide a privilege log along with their forthcoming discovery supplementation.

For the foregoing reasons and authorities, Defendants respectfully request that this Court deny Plaintiff's Motion to Compel in its entirety.

McGUIREWOODS LLP

By: s/R. Eric Bilik
R. Eric Bilik
Florida Bar No. 0987840
Jeffrey S. York
Florida Bar No. 0987069
Michael M. Giel
Florida Bar No. 0017676
50 N. Laura Street, Suite 3300
Jacksonville, FL 32202
(904) 798-3200
(904) 360-6330 (fax)
ebilik@mcquirewoods.com
nyork@mcquirewoods.com
mgiel@mcquirewoods.com

ATTORNEYS AND TRIAL COUNSEL FOR
DEFENDANTS YELLOW BOOK USA, INC.
AND PINDAR SET INC.

Certificate of Service

I HEREBY CERTIFY that a true and correct copy of the foregoing was filed with the Clerk of the Court using the CM/ECF system which will send notice of the electronic filing on January 12, 2009 to:

J. Todd Timmerman, Esq.
Mindi M. Richter, Esq.
Shumaker, Loop & Kendrick, LLP
101 East Kennedy Boulevard
Suite 2800
Tampa, FL 33602
(813) 229-7600
(813) 229-1660 (fax)
ttimmerman@slk-law.com
mrichter@slk-law.com

s/R. Eric Bilik
ATTORNEY