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5 UNITED STATES DISTRICT COURT
6 WESTERN DISTRICT OF WASHINGTON
7 AT SEATTLE

8 SUSAN TIERNEY COCKBURN,

9 Plaintiff,

10 v.

11 SWS INDUSTRIES, INC. dba MCGILL,
12 INC., *et al.*,

13 Defendants.

Case No. C10-1566RSL

ORDER GRANTING IN
PART PLAINTIFF'S
MOTION TO COMPEL AND
AWARD SANCTIONS

14 This matter comes before the Court on Plaintiff's "Motion to Compel and for
15 Sanctions" (Dkt. # 78). Plaintiff alleges that Defendant McGill, Inc., has not yet
16 complied with discovery requests propounded in September 2011. Worse, she contends
17 that she has discovered that Defendant, and arguably its counsel, has willfully failed to
18 disclose relevant, responsive materials, agreeing to do so only after being "caught."
19 Plaintiff asks for reimbursement of her fees and costs in bring this motion and requests
20 oral arguments on the matter. The Court GRANTS the motion IN PART.

21 **I. BACKGROUND¹**

22 This case concerns the alleged use of Plaintiff Tierney Cockburn's copyrighted
23 "paper floral art" designs without her permission. Plaintiff is a Washington resident
24 who designs and creates methods of making floral art out of paper. Her works are
25 original and copyrightable.

26 ¹ The Court assumes the parties are familiar with the facts and allegations undergirding
this case and repeats them here only as necessary.

1 Defendant McGill, Inc., is a Illinois corporation that sells a line of “paper
2 punches” under the brand names “Perfect Petals” and “Paper Blossoms.” Plaintiff
3 alleges that specific punches infringe her original designs. She further alleges that the
4 entirety of Defendant’s line so resembles her own products that it violates Washington’s
5 trade dress infringement laws.

6 On September 27, 2011, Plaintiff served the discovery requests at issue on
7 Defendant. On November 15, 2011, Defendant responded, objecting to many of
8 Plaintiff’s requests as either irrelevant to the allegations of Plaintiff’s amended
9 complaint or unduly burdensome. Dkt. # 78-3. Plaintiff disagreed with Defendant’s
10 view. Within a week, she wrote to Defendant, explaining why she was entitled to each
11 of the items she requested. Dkt. # 78-4. The parties eventually conferenced and
12 compromised on some of the requests, but otherwise did not resolve their dispute. Mot.
(Dkt. # 78) at 4–5.

13 The plot thickened in the ensuing months. Plaintiff alleges that she discovered
14 through the deposition of numerous McGill witnesses that Defendant was in possession
15 of many materials responsive to her requests, yet still undisclosed. Defendant admits as
16 much, arguing that it is waiting for Plaintiff to give it a list of specific documents
17 unearthed during these depositions. Opp. (Dkt. # 79) at 1–2. After failing to make any
18 material headway at a subsequent “meet-and-confer” conference, Plaintiff filed the
19 present motion, asking the Court to compel Defendant to disclose documents in response
20 to her Requests for Production (“RFP”) Nos. 4, 10–14, 18, 24–28, 32, 38–70, 72, 78, 80,
21 84–98, and 100. Dkt. # 78.

22 **II. DISCUSSION**

23 The discovery standard is a liberal one. Generally, “[p]arties may obtain
24 discovery regarding any nonprivileged matter that is relevant to any party’s claim or
25 defense.” Fed. R. Civ. P. 26(b). “[I]nformation need not be admissible at the trial” to be

1 considered relevant. Id. Rather, information is discoverable so long as it “appears
2 reasonably calculated to lead to the discovery of admissible evidence.” Id.

3 With this understanding in mind, the Court turns to Defendant’s rationale for
4 resisting the multiple categories of documents requested by Plaintiff. It then considers
5 whether Plaintiff is entitled to her “reasonable expenses incurred in making th[is]
6 motion, including attorney’s fees,” Fed. R. Civ. P. 37(a)(5)(A), and whether oral
7 arguments are necessary.

8 **A. The Disputed Requests**

9 **1. RFP Nos. 4, 18, and 32 — “Source Materials”**

10 Each of these requests pertains to Plaintiff’s request for the “source material” for
11 the design of specific products at issue in this suit. Dkt. # 78-3. Defendant contends
12 that it misunderstood Plaintiff’s request, believing Plaintiff wished to know only the
13 source for the raw materials used to produce the products. Opp. (Dkt. # 79) at 3. The
14 Court finds that representation incredible. In her November 22 letter to Defendant,
15 Plaintiff specifically stated that she sought documents relevant to “the source of the
16 design for [each] product.” Dkt. # 78-4. It was plain what Plaintiff sought, and the
17 Court ORDERS Defendant to comply with each of her requests. If it does not, the Court
18 will impose sanctions, including, but not limited to, “prohibiting [Defendant] from
19 supporting or opposing designated claims or defenses, or from introducing designated
20 matters in evidence.” Fed. R. Civ. P. 37(b)(2)(A).

21 **2. RFP Nos. 10, 24, and 38 — Income Materials**

22 Each of these requests pertains to Plaintiff’s request for documents, including
23 invoices, purchase orders, and/or collection letters, that demonstrate all income or
24 revenue received from the sale of some of the specific McGill products at issue here.
25 Dkt. # 78-3. Defendant argues that it provided Plaintiff with revenue figures, but that it

1 would be unduly burdensome to provide the more detailed documents requested. Opp.
2 (Dkt. # 79) at 3–4. The Court disagrees.

3 Defendant’s unsupported objections fall woefully short of demonstrating that
4 “the burden or expense of the proposed discovery outweighs its likely benefit,
5 considering the needs of the case, the amount in controversy, the parties’ resources, the
6 importance of the issues at stake in the action, and the importance of the discovery in
7 resolving the issues.” Fed. R. Civ. P. 26(b)(2)(C). And, given the obvious concerns
8 raised by Defendant’s history of non-disclosure, the Court ORDERS Defendant to
9 disclose all materials relevant to Plaintiff’s request.

10 **3. RFP Nos. 11, 25, 39, 53, and 67 — “Costs Associated” Materials**

11 Each of these requests pertains to Plaintiff’s request for documents that reflect the
12 “costs associated” with specific products. Dkt. # 78-3. Defendant argues that it
13 provided Plaintiff with the requested documents—a total of 32 pages. Opp. (Dkt. # 79)
14 at 4. Again, the Court finds reason to doubt that representation.

15 Defendant responded to RFP Nos. 53 and 67 by objecting to disclosure on the
16 grounds that the specific products at issue were not specifically named in Plaintiff’s
17 amended complaint. Of course, that is not the standard for disclosure. Evidence must
18 only be “reasonably calculated to lead to the discovery of admissible evidence” to be
19 discoverable. Fed. R. Civ. P 26(b). Regardless, Plaintiff has stated a claim alleging that
20 Defendant’s entire line, of which each of the disputed products is a part, “so resemble
21 Tierney Cockburn’s products, with respect to trade dress, that ordinary consumers are
22 mistaking one for the other.” Amended Complaint (Dkt. # 16) at ¶ 107. As a result,
23 Plaintiff is plainly entitled to the evidence she seeks.

24 Moreover, the Court notes that it expects that Defendant has both disclosed all
25 relevant materials and that it has done so in a manner that allows Plaintiff to readily
26 identify those materials. If the Court determines that Defendant is selectively disclosing

1 some documents and not others, or disclosing them in a manner intended to frustrate
2 Plaintiff's inquiry, it will impose substantial sanctions. Fed. R. Civ. P. 37(b)(2)(A).

3 **4. RFP Nos. 12, 13, 26, 27, 40, 72, 100 — Promotional Materials**

4 Plaintiff next requests that the Court order Defendant to fully respond to its
5 requests for promotional materials relevant to specific products. Reply (Dkt. # 81) at 3.
6 It notes that while Defendant has disclosed some materials, *cf.* Opp. (Dkt. # 79) at 4–5,
7 many more have been uncovered only through third-parties, even though Defendant has
8 apparently had each in its possession. Reply (Dkt. # 81) at 3. For reasons already
9 explained, the Court ORDERS Defendant to fully respond to Plaintiff's requests.

10 Again, if the Court determines that Defendant is selectively disclosing some documents
11 and not others, or disclosing them in a manner intended to frustrate Plaintiff's inquiry,
12 the Court will not hesitate to impose substantial sanctions. Fed. R. Civ. P. 37(b)(2)(A).

13 **5. RFP Nos. 13, 27, 41, and 72 — “Sue Eldred” Materials**

14 Plaintiff's contention in regard to each of these documents is its belief that
15 Defendant is selectively disclosing only certain materials and not fully responding to her
16 requests. Dkt. # 78-4. The Court ORDERS Defendant to fully comply with Plaintiff's
17 requests. As stated before, the Court will not hesitate to impose substantial sanctions
18 should it find that Defendant is failing to do so. Fed. R. Civ. P. 37(b)(2)(A).

19 **6. RFP Nos. 14, 28, and 42**

20 Plaintiff complains that Defendant provided materials only in relation to
21 individual customers and ignored its request for materials relevant to distributors and
22 resellers. Dkt. # 78-4. The Court ORDERS Defendant to supplement its response to
23 account for Plaintiff's request for materials relevant to distributors and resellers.

24 **7. RFP Nos. 43–70 — “Product Line” Materials**

25 Each of these requests pertain to Plaintiff's request for “documents that discuss,
26 reflect, or relate to the creation, design and manufacture” of specific McGill products.

1 Dkt. # 78-3. Defendant responded to each by objecting to disclosure on the grounds that
2 the specific products at issue were not specifically named in Plaintiff’s amended
3 complaint. As the Court has already explained, that is irrelevant. Plaintiff has stated a
4 claim alleging that Defendant’s entire line, of which each of the disputed products is a
5 part, “so resemble Tierney Cockburn’s products, with respect to trade dress, that
6 ordinary consumers are mistaking one for the other.” Amended Complaint (Dkt. # 16)
7 at ¶ 107. Again, Plaintiff is plainly entitled to the evidence she seeks, and the Court
8 ORDERS Defendant to produce the requested information.

9 **8. RFP No. 78 – “Catalog” Materials**

10 Plaintiff also requested that Defendant produce “documents that discuss, reflect,
11 or relate to the distribution of catalogs . . . , including[,] but not limited to, mailing lists,
12 show marketing reports, business cards, or customer lists.” Dkt. # 78-3. Defendant
13 objected on the grounds that the request was “not reasonably calculated to lead to the
14 discover of admissible evidence.” *Id.* The Court disagrees. It is certainly relevant to
15 both infringement and damages. Accordingly, the Court ORDERS Defendant to fully
16 disclose the requested information.

17 **9. RFP No. 80 and 84–85 — “Distributor and Retailer” Materials**

18 Plaintiff’s next request was for documents related to any agreements between
19 Defendant and third-parties to distribute or sell the allegedly infringing products and
20 product line. Dkt. # 78-3. Defendant asserts that it has complied with that request. Dkt.
21 # 79 at 7. In response, Plaintiff contends that Defendant has only provided summary
22 data, rather than the objective raw data it seeks. Dkt. # 81 at 4. Given the circumstances
23 and Defendant’s behavior in this case, the Court thinks that request to be eminently
24 reasonable. It ORDERS Defendant to provide the requested agreements and documents
25 themselves rather than mere summaries.

1 **9. RFP No. 86-98 — “Financial” Materials**

2 Finally, Plaintiff requested that Defendant produce specific financial documents
3 relevant to the revenue earned by Defendant as a result of its sale of the allegedly
4 infringing products and line. Dkt. # 78-3. She asserts that Defendant again provided
5 only summaries, not actual objective financial data. Reply (Dkt. # 81) at 4.

6 In response, Defendant contends that Plaintiff is only entitled to discover its gross
7 revenue, because the burden is on Defendant to demonstrate any appropriate reductions.
8 Opp. (Dkt. # 79) at 8-9. While that is certainly a correct statement of the law, see, e.g.,
9 Polar Bear Prods., Inc. v. Timex Corp., 384 F.3d 700, 711 (9th Cir. 2004) (“In
10 establishing the infringer’s profits, the copyright owner is required to present proof only
11 of the infringer’s gross revenue, and the infringer is required to prove his or her
12 deductible expenses and the elements of profit attributable to factors other than the
13 copyrighted work.” (quoting 17 U.S.C. § 504(b))), it does not support Defendant’s
14 refusal to produce the requested documents. Unless Defendant wishes to be precluded
15 from introducing any evidence of “deductible expenses and the elements of profit
16 attributable to factors other than the copyrighted work,” e.g., Dkt. # 78-3 (RFP Nos.
17 Id. (RFP Nos. 95-97)).

18 Finally, the Court sees no issue with Plaintiff’s request that Defendant disclose
19 all documents “sufficient to identify all potential and actual manufacturers” of the
20 relevant products. Id. (RFP Nos. 94). If Defendant did not consider and is not
21 considering any potential manufacturers, it is certainly free to say so, but the request as a
22 whole is certainly relevant as to damages.

23 * * *

24 In sum, the Court ORDERS Defendant to fully comply with each of Plaintiff’s
25 requests or run the risk of sanctions, including, but not limited to, the Court “prohibiting

1 [Defendant] from supporting or opposing designated claims or defenses, or from
2 introducing designated matters in evidence.” Fed. R. Civ. P. 37(b)(2)(A). Defendant
3 has received its one and only warning. The Court will not look kindly on any further
4 obstructionist behavior.

5 **B. Award of Fees**

6 Pursuant to Federal Rule of Civil Procedure 37(a)(5)(A), Plaintiff is entitled to
7 any “reasonable expenses incurred in making the motion, including attorney’s fees,”
8 unless:

9 (i) the movant filed the motion before attempting in good faith to obtain the
disclosure or discovery without court action;

10 (ii) the opposing party’s nondisclosure, response, or objection was
11 substantially justified; or

12 (iii) other circumstances make an award of expenses unjust.

13 Defendant has not raised any argument as to why fees and expenses are not warranted in
14 this case, see Dkt. # 79, and the Court sees no reason not to award Plaintiff her
15 reasonable expenses.

16 Plaintiff attempted in good faith to obtain disclosure without court action.

17 Plaintiff’s counsel sent Defendants a lengthy letter explaining Plaintiff’s entitlement to
18 the information she sought, Dkt. # 78-4, and twice conferenced with Defendant in an
19 attempt to persuade it to furnish the requested information. Moreover, Defendant’s
20 positions were entirely unjustified. And, finally, the Court has been presented with no
evidence of any circumstances that would “make an award of expenses unjust.”

21 Accordingly, the Court directs Plaintiff to file a declaration within seven days of
22 the date of this Order that sets forth any “reasonable expenses incurred in making th[is]
23 motion.”²

24
25 ² To be clear, time spent meeting and conferring is not included.

1 **C. Oral Argument**

2 Because the Court finds that oral arguments would not aid its resolution of this
3 dispute, it DENIES Plaintiff’s request.


4 Notably, though, the Court wishes to correct Defendants’ mistaken belief that
5 their location out of state is reason enough to preclude oral argument. While the judges
6 in this district are indeed “committed to assisting the bar and litigants to reduce costs in
7 civil cases,” that commitment hinges on counsel’s obligation “to work toward the
8 prompt completion of each case and to minimize the costs of discovery.” Thus, when
9 counsel fails to hold up its end of the bargain, and engages in obstructionist tactics that
10 lack any substantial justification, it is counsel who is responsible for increasing costs,
11 including those associated with being ordered to attend a hearing in Seattle.

12 Should this behavior continue, the Court will not hesitate to require Defendants
13 and their counsel to explain their conduct in person.

13 **III. CONCLUSION**

14 For all of the foregoing reasons, the Court GRANTS Plaintiff’s motion IN PART.
15 Defendant is ORDERED to fully and adequately respond to Plaintiff’s Requests for
16 Production Nos. 4, 10–14, 18, 24–28, 32, 38–70, 72, 78, 80, 84–98, and 100 within 21
17 days of the date of this Order. In addition, Plaintiff is entitled to her reasonable
18 expenses in bringing her motion. Fed. R. Civ. P. 37(a)(5)(A). She is directed to file
19 within seven days of the date of this Order a declaration detailing those expenses.

20 DATED this 4th day of April, 2012.

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23 
24 Robert S. Lasnik
25 United States District Judge