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UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA

MICHAEL E. DAVIS, et al.,

No. C-10-03328 RS (DMR)

Plaintiffs,

**ORDER GRANTING IN PART  
PLAINTIFFS’ MOTION TO COMPEL**

v.

ELECTRONIC ARTS INC.,

Defendant.

Before the Court is Plaintiffs’ Motion to Compel Responses to Discovery. [Docket No. 50.] Having considered the parties’ briefs and accompanying submissions, as well as the oral argument of counsel at the June 16, 2011 hearing, the Court GRANTS IN PART Plaintiffs’ Motion to Compel Responses to Discovery. This Order summarizes the rulings made by the Court on the record during the June 16, 2011 hearing.

**I. Factual and Procedural Background**

Plaintiffs Michael E. Davis, Vince Ferragamo, and Billy Joe Dupree are retired NFL football players. In July 2010, they filed a complaint on behalf of themselves and a proposed class of approximately 6,000 retired NFL players against Defendant Electronic Arts, Inc. (“EA”), a developer and publisher of video games. The complaint alleges that EA violated Plaintiffs’ statutory and common law rights of publicity through unauthorized use of their likenesses in EA’s *Madden NFL* video game franchise.

1 On January 6, 2011, EA moved to strike Plaintiffs' claims pursuant to California Code of  
2 Civil Procedure section 425.16, known as the "anti-SLAPP" statute. EA's anti-SLAPP motion  
3 asserts that EA's use of Plaintiffs' likenesses in *Madden NFL* qualifies for First Amendment  
4 protection under various tests, including the "transformative use" test, and that Plaintiffs' claims  
5 therefore should be dismissed. The parties subsequently filed a stipulated request that the Court  
6 continue the hearing on the anti-SLAPP motion until July 2011. On January 31, 2011, the  
7 Honorable Richard Seeborg issued an order denying EA's anti-SLAPP motion without prejudice,  
8 and ordered that EA could re-file its anti-SLAPP motion following the initial case management  
9 conference in April 2011. [Docket No. 35.]

10 On February 2, 2011, Plaintiff Davis served EA with his first sets of interrogatories, requests  
11 for admissions, and requests for the production of documents. On March 4, 2011, EA served  
12 objections to the discovery and refused to provide substantive responses on the grounds that  
13 California Code of Civil Procedure section 425.16(g) automatically stays all discovery during the  
14 pendency of an anti-SLAPP motion.<sup>1</sup>

15 In this motion, Plaintiffs argue that the rules regarding discovery during the pendency of an  
16 anti-SLAPP motion differ in federal court from those applied in state court actions. Specifically,  
17 Plaintiffs argue that section 425.16(g), the provision staying discovery upon the filing of an anti-  
18 SLAPP motion, is not applicable in federal court because it conflicts with Federal Rule of Civil  
19 Procedure 56(d). *See Metabolife Int'l. Inc. v. Wornick*, 264 F.3d 832, 846 (9th Cir. 2001) (holding  
20 that "discovery-limiting aspects" of California's anti-SLAPP statute "collide with the discovery-  
21 allowing aspects of Rule 56"). Plaintiffs argue that they are entitled to discover information that is  
22 within Defendant's exclusive control and that is probative of the issues raised in the anti-SLAPP  
23 motion. Plaintiffs seek an order compelling EA to respond to discovery regarding EA's affirmative  
24 defense that its use of retired NFL players' likenesses qualifies for First Amendment protection

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26 <sup>1</sup> On March 2, 2011, Judge Seeborg issued an order on EA's miscellaneous administrative  
27 request instructing the parties to proceed with discovery as though EA's anti-SLAPP motion were  
28 on file as of January 6, 2011. [Docket No. 44.] In the order, the Court clarified that "[n]o  
consideration [had] been given to the parties' discovery related issues as those issues [were] not  
before the court." EA re-filed its anti-SLAPP motion, along with a motion to dismiss the complaint,  
on June 9, 2011. A hearing on both motions is scheduled for August 25, 2011.

1 under the transformative use test, as well as information probative of the claim that EA contractually  
2 waived its First Amendment rights.

## 3 II. Legal Standards

4 Known as the “anti-SLAPP” statute, California Code of Civil Procedure section 425.16 “was  
5 enacted to allow for early dismissal of meritless first amendment cases aimed at chilling expression  
6 through costly, time-consuming litigation.” *Metabolife*, 264 F.3d at 839. “The hallmark of a  
7 SLAPP suit is that it lacks merit, and is brought with the goals of obtaining an economic advantage  
8 over a citizen party by increasing the cost of litigation to the point that the citizen party’s case will  
9 be weakened or abandoned, and of deterring future litigation.” *United States ex rel. Newsham v.*  
10 *Lockheed Missiles & Space Co.*, 190 F.3d 963, 971-972 (9th Cir. 1999) (citing *Wilcox v. Superior*  
11 *Court*, 27 Cal. App. 4th 809, 816 (1994)). To protect the public’s interest in “participation in  
12 matters of public significance,” section 425.16(b) provides that any “cause of action against a person  
13 arising from any act of that person in furtherance of that person’s right of . . . free speech . . . in  
14 connection with a public issue shall be subject to a special motion to strike, unless the court  
15 determines that the plaintiff has established that there is a probability that the plaintiff will prevail on  
16 the claim.” Cal. Code Civ. Proc. § 425.16(a), (b).

17 Consideration of an anti-SLAPP motion involves a two-step process:

18 The moving defendant’s burden is to demonstrate that the act or acts  
19 of which the plaintiff complains were taken “in furtherance of the  
20 [defendant]’s right of petition or free speech under the United States  
21 or California Constitution in connection with a public issue,” as  
22 defined in the statute. (§ 425.16, subd. (b)(1).) If the court finds  
23 such a showing has been made, it then determines whether the  
24 plaintiff has demonstrated a probability of prevailing on the claim.”<sup>2</sup>

22 *Equilon Enters. v. Consumer Cause, Inc.*, 29 Cal. 4th 53, 67 (2002). In making these  
23 determinations, “the court shall consider the pleadings, and supporting and opposing affidavits  
24 stating the facts upon which the liability or defense is based.” *Id.* (quoting Cal. Code Civ. Proc. §  
25 425.16(b)(2)).

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27 <sup>2</sup> “At the second step of the anti-SLAPP inquiry, the required probability that [plaintiff]  
28 will prevail need not be high.” *Keller v. Elec. Arts, Inc.*, No. 09-1967, 2010 U.S. Dist. LEXIS  
10719, at \*34 (Feb. 8, 2010), *argued*, No. 10-15387 (9th Cir. Feb. 16, 2011) (quoting *Hilton v.*  
*Hallmark Cards*, 580 F.3d 874, 888-89 (9th Cir. 2009)).

1 An anti-SLAPP motion “may be filed within 60 days of the service of the complaint, or in  
2 the court’s discretion, at any later time upon terms it deems proper.” Cal. Code Civ. Proc. §  
3 425.16(f). Furthermore, discovery is automatically stayed and the opposing party must demonstrate  
4 “good cause” under section 425.16(g) to justify “specified discovery” as an exception to the stay.  
5 See Cal. Code Civ. Proc. § 425.16(g). “Together, these two subsections ‘create a default rule that  
6 allows the defendant served with a complaint to immediately put the plaintiff to his or her proof  
7 before the plaintiff can conduct discovery.’” *Metabolife*, 264 F.3d at 846 (quoting *Rogers v. Home*  
8 *Shopping Network, Inc.*, 57 F. Supp. 2d 973, 980 (C.D. Cal. 1999)).

9 In *Lockheed*, the Ninth Circuit held that certain provisions of California’s anti-SLAPP statute  
10 may be invoked in federal court. Applying *Erie R.R. v. Tompkins*, 304 U.S. 64 (1938), the Court  
11 held that there is no direct conflict between section 425.16, subdivisions (b) (providing the  
12 availability of the special motion to strike) and (c) (providing for attorneys’ fees) and the Federal  
13 Rules of Civil Procedure, and that the purposes of *Erie* would be advanced by adopting the  
14 California procedural rules. Therefore, those provisions may be used in federal court. *Lockheed*,  
15 190 F.3d at 973.

16 Two years later, in *Metabolife*, the Ninth Circuit addressed the applicability in federal court  
17 actions of the discovery stay provision embodied in section 425.16(g). The Court discussed the  
18 potential collision that would occur between the expedited procedures in the anti-SLAPP statute and  
19 Federal Rule of Civil Procedure 56, if the anti-SLAPP motion were used in federal court to test the  
20 plaintiff’s evidence before the plaintiff has completed discovery. *Metabolife*, 264 F.3d at 846  
21 (discussing *Rogers*, 57 F. Supp. 2d at 980). Comparing section 425.16(g) with Rule 56, the Ninth  
22 Circuit noted that “[a]lthough Rule 56[] facially gives judges the discretion to disallow discovery  
23 when the non-moving party cannot yet submit evidence supporting its opposition, the Supreme  
24 Court has restated the rule as requiring, rather than merely permitting, discovery ‘where the  
25 nonmoving party has not had the opportunity to discover information that is essential to its  
26 opposition.’” 264 F.3d at 846 (quoting *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 250 n.5  
27 (1986)). Therefore, the Ninth Circuit concluded that California’s automatic discovery stay  
28 mechanism should not apply in federal court actions “[b]ecause the discovery-limiting aspects of §

1 425.16(f) and (g) collide with the discovery-allowing aspects of Rule 56 . . . .” *Metabolife*, 264 F.3d  
2 at 846.

### 3 III. Discussion

4 Defendant argues that *Metabolife* is inapposite and that section 425.16(g) applies in this case.  
5 According to Defendant, the anti-SLAPP motion at issue in *Metabolife* was akin to a motion for  
6 summary judgment. By contrast, the anti-SLAPP motion now before the Court identifies legal  
7 defects in the complaint while accepting its factual allegations as true and does not rely on evidence  
8 outside the complaint. Therefore, Defendant argues that its anti-SLAPP motion must be treated as a  
9 Federal Rule of Civil Procedure 12(b)(6) motion to dismiss, and accordingly, there is no conflict  
10 between the stay on discovery and Rule 56(d). In the alternative, Defendant argues that if the  
11 discovery stay does not apply, then Plaintiffs’ requested discovery is not narrowly tailored to  
12 opposing the anti-SLAPP motion, and should be disallowed.

13 For purposes of the section 425.16(g) discovery stay provision, at least one court has noted a  
14 distinction between an anti-SLAPP motion that is in the nature of a Rule 12(b)(6) motion to dismiss  
15 and one that presents issues of fact, akin to a Rule 56 summary judgment motion. In *Aeroplite*  
16 *Corp. v. Arch Insurance Co.*, the Court described the general rule from *Metabolife* and *Rogers* as  
17 follows: “the discovery-limiting provisions of section 425.16, subdivisions (f) and (g), collide with  
18 the discovery-permitting provisions of Rule 56, and therefore are not available in federal court  
19 unless either: (1) the factual basis of the case has been developed through discovery or similar prior  
20 proceedings to the extent a motion for summary judgment would be appropriate; (2) the parties  
21 agree that further discovery is not necessary; or (3) *the only issue presented by the motion is an issue*  
22 *of law* and the motion is suitable for decision as a motion to dismiss pursuant to Rule 12(b)(6).” No.  
23 06-1099, 2006 WL 3257487, at \*9 (E.D. Cal. Nov. 9, 2006) (internal citations omitted, emphasis  
24 added). In other words, *Aeroplite* noted that if a particular anti-SLAPP motion requires no factual  
25 evaluation, there is no collision between section 425.16(g) and Rule 56.

26 That is not the case here. Assuming that EA is able to meet its initial burden of establishing  
27 that the challenged causes of action arise from protected free speech activity, the Court necessarily  
28 must engage in some factual evaluation at the second step of the anti-SLAPP process in order to

1 determine whether Plaintiffs have demonstrated a probability of prevailing on their claims. Here,  
2 EA seeks to defeat Plaintiffs’ right of publicity claim by showing that it has a complete defense.  
3 Specifically, EA argues that the use of Plaintiffs’ likenesses in *Madden NFL* qualifies for First  
4 Amendment protection under the “transformative use” test, and therefore Plaintiffs’ causes of action  
5 are barred as a matter of law. *See Peregrine Funding, Inc. v. Sheppard Mullin Richter & Hampton*  
6 *LLP*, 133 Cal. App. 4th 658, 676 (2005) (“Generally, a defendant may defeat a cause of action by  
7 showing the plaintiff cannot establish an element of its cause of action *or* by showing there is a  
8 complete defense to the cause of action . . .”) (emphasis in original); *see also Traditional Cat Ass’n,*  
9 *Inc. v. Gilbreath*, 118 Cal. App. 4th 392, 398-399 (2004) (noting the anti-SLAPP statute  
10 contemplates consideration of the merits of the plaintiff’s case “as well as all available defenses to  
11 it.”).

12 Consequently, in order for Plaintiffs to make their required showing at the second step of the  
13 anti-SLAPP analysis, Plaintiffs must meet “an *evidentiary burden, not a pleading requirement*. The  
14 court must consider the pleadings and the evidence submitted by the parties; it cannot weigh the  
15 evidence but instead must simply determine whether the [plaintiffs’] evidence would, if credited, be  
16 sufficient to meet its burden of proof.” *Flores v. Emerich & Fike*, No. 05-0291, 2006 WL 2536615,  
17 at \*10 (E.D. Cal. Aug. 31, 2006) (internal citations omitted, emphasis in original). The Court may  
18 also consider Defendant’s opposing evidence to determine whether it defeats Plaintiffs’ case as a  
19 matter of law. *Traditional Cat Ass’n*, 118 Cal. App. 4th at 398.

20 In sum, while it is generally Defendant’s burden to prove its affirmative defense (*see*  
21 *Peregrine*, 133 Cal. App. 4th at 676), Plaintiffs are entitled to present evidence to counter that  
22 defense in order to satisfy their burden at the second step of the court’s anti-SLAPP inquiry.  
23 Accordingly, the Court concludes that the section 425.16(g) discovery stay collides with Rule 56(d)  
24 and should not be applied in this case.

25 The Court next turns to the specific discovery at issue in this motion. Plaintiffs urge the  
26 Court to compel Defendant to respond to a significant amount of discovery -- over 30 requests for  
27 admission, 27 requests for the production of documents, and eight interrogatories -- arguing that  
28 Plaintiffs are entitled to broad discovery of “information that [is] in EA’s exclusive control and [is]

1 probative of the issues raised in EA’s anti-SLAPP motion.” (Pls.’ Reply Br. [Docket No. 60] 6.)  
2 Defendant argues that, if allowed at all, discovery must be analyzed under Rule 56(d)’s requirement  
3 that the requested discovery be “essential” to opposing the motion.

4         Although the section 425.16(g) discovery stay should not be applied in this case, the Court is  
5 nevertheless mindful of the policy considerations supporting California’s anti-SLAPP statutory  
6 scheme, and in particular, the statute’s goal of “early dismissal of meritless first amendment cases  
7 aimed at chilling expression through costly, time-consuming litigation.” *Metabolife*, 264 F.3d at  
8 839. Permitting wide-ranging discovery of matters that are merely “probative of” or “relevant to”  
9 the issues in an anti-SLAPP motion would subvert the intent of the anti-SLAPP statute by delaying  
10 adjudication of the anti-SLAPP motion and increasing the financial burden on Defendant. *See Price*  
11 *v. Stossel*, 590 F. Supp. 2d 1262, 1267 (2008) (discussing the good cause standard for discovery  
12 under the anti-SLAPP statute). Moreover, the Court notes that in concluding that section 425.16(f)  
13 collides with Rule 56, the Court in *Metabolife* relied on the Supreme Court’s statement in *Liberty*  
14 *Lobby* that a court is required to permit discovery “where the nonmoving party has not had the  
15 opportunity to discover information that is *essential to its opposition*” to a summary judgment  
16 motion. 264 F.3d at 846 (quoting *Liberty Lobby*, 477 U.S. at 250 n.5) (emphasis added).

17         Therefore, the Court concludes that the appropriate standard by which Plaintiffs’ discovery  
18 should be evaluated is whether a request is “essential” to Plaintiff’s opposition to the anti-SLAPP  
19 motion. Application of this standard, as opposed to the “probative” or “relevant” standards urged by  
20 Plaintiffs, honors the policy behind California’s anti-SLAPP statute and advances the “twin purposes  
21 of the *Erie* rule- ‘discouragement of forum-shopping and avoidance of inequitable administration of  
22 the law.’” *Lockheed*, 190 F.3d at 973 (quoting *Hanna v. Plumer*, 380 U.S. 460, 468 (1965)).

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1 The discovery at issue in this motion can be divided into two subjects: (1) EA’s affirmative  
2 defense based on the transformative use test<sup>3</sup> and (2) Plaintiffs’ assertion that EA waived its First  
3 Amendment rights as a result of licensing agreements regarding its use of NFL player likenesses.

4 A defendant may raise an affirmative defense that a challenged work is “protected by the  
5 First Amendment inasmuch as it contains significant transformative elements or that the value of the  
6 work does not derive primarily from the celebrity’s fame.” *Comedy III Prods., Inc. v. Saderup*, 25  
7 Cal. 4th 387, 407 (2001). To determine whether a work is transformative, a court must inquire:

8 whether the celebrity likeness is one of the “raw materials” from which an  
9 original work is synthesized, or whether the depiction or imitation of the  
10 celebrity is the very sum and substance of the work in question. We ask, in  
11 other words, whether a product containing a celebrity’s likeness is so  
12 transformed that it has become primarily the defendant’s own expression  
13 rather than the celebrity’s likeness. And when we use the word  
14 “expression,” we mean expression of something other than the likeness of  
15 the celebrity.

16 *Id.* at 406. In making a transformative use determination, Defendant argues that the Court need only  
17 view the video games at issue to determine whether Plaintiffs’ alleged likenesses are one of several  
18 “raw materials” comprising the work, or whether they are the “sum and substance” of the work.  
19 According to Defendant, if the Court “observes that the game is synthesized from other raw  
20 materials in addition to Plaintiffs’ alleged likenesses, the work is ‘transformative’ and no further  
21 analysis is required to bar Plaintiffs’ claims under the First Amendment.” (Def.’s Opp’n [Docket No.  
22 58] 9.) Therefore, Defendant argues, since the Court may resolve the question of whether EA’s use  
23 of Plaintiffs’ alleged likenesses is transformative by simply viewing the games themselves,  
24 discovery pertaining to this issue is not essential to Plaintiffs’ opposition.

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25 <sup>3</sup> Plaintiffs also seek an order compelling responses to discovery they claim is necessary to  
26 rebut statements contained in the declaration of an executive producer of the video games submitted  
27 in support of Defendant’s anti-SLAPP motion. Defendant claims that the declaration is nothing  
28 more than a summary of voluminous information pursuant to Federal Rule of Evidence 1006.  
Defendant asserts that the declaration merely explains the basics of how the video games work,  
thereby saving the Court from countless hours of having to play the video game itself in order to  
obtain the same information. Plaintiffs assert that the statements in the declaration go well beyond a  
mere summary of information, and bear on how Defendant used Plaintiffs’ likenesses in the video  
games and whether Defendant transformed the likenesses. Since such discovery is not essential to  
opposing the anti-SLAPP motion, the Court does not authorize any discovery directed at the  
declaration. The Court expresses no opinion as to whether the declaration is proper under Rule  
1006, as such a ruling is more appropriately made by Judge Seeborg upon consideration of the anti-  
SLAPP motion itself.



1 In determining whether a likeness of an individual has been sufficiently transformed, courts  
2 focus on the depiction of the individual, comparing the similarities and differences between the work  
3 in question and the individual’s likeness. *See Kirby v. Sega of Am., Inc.*, 144 Cal. App. 4th 47, 59  
4 (2006) (concluding video game character “Ulala” was “more than a mere likeness or literal depiction  
5 of [plaintiff]” given differences in attire, setting, and physical movements); *Keller*, 2010 U.S. Dist.  
6 LEXIS 10719, at \*16 (finding depiction of plaintiff insufficiently transformative where video game  
7 player character wore “same jersey number, [was] the same height and weight and hail[ed] from the  
8 same state,” and represented plaintiff as what he was, “starting quarterback for Arizona State  
9 University.”).

10 Thus, in order to conduct its comparison of the work in question and Plaintiffs’ likenesses,  
11 the Court cannot solely look to the video games themselves, devoid of any context or reference, as  
12 Defendant urges. The Court must be provided with a baseline understanding of which individuals’  
13 likenesses should be compared to which particular player characters in the video games. In addition,  
14 Plaintiffs (and the Court) should have access to Defendant’s contentions regarding the  
15 transformative use defense, as well as the basic supporting documents. The Court finds that such  
16 discovery is essential to Plaintiffs’ opposition to Defendant’s anti-SLAPP motion.

17 However, because the Court will conduct a *visual* comparison of the work in question and  
18 Plaintiffs’ likenesses, information related to the actual process of transformation of Plaintiffs’  
19 likenesses, such as the fields of data used to create the player characters and source information for  
20 the fields of data, is not essential for the Court to make its determination. Further, as a class has not  
21 yet been certified in this case, discovery is limited to the three named plaintiffs.

22 Plaintiffs also seek discovery directed at the issue of whether Defendant waived its First  
23 Amendment rights as a result of licensing agreements governing EA’s use of former NFL player  
24 likenesses in its video games. Plaintiffs seek to obtain complete, unredacted copies of the licensing  
25 agreements at issue, the correspondence relating thereto, and copies of deposition testimony from  
26 Defendant’s witnesses regarding licensing.

27 In *Navellier v. Sletten*, the California Supreme Court applied the two-step anti-SLAPP  
28 analysis and held that a party’s First Amendment rights can be waived via a validly formed contract.



1 Ferragamo, and/or Dupree. However, Defendants must also produce any documents that speak  
2 generally about the transformation of likenesses or characteristics of actual players, where such  
3 documents do not specifically identify actual players. Finally, Defendant is ordered to produce  
4 unredacted licensing agreements regarding use of former NFL player likenesses in the 2008 and  
5 2009 versions of the video games.

6 Specifically, **by no later than July 7, 2011**, Defendant shall provide Plaintiffs with  
7 responses to the following discovery: Request for Admission Nos. 11, 23-27, 30-35, 38, 39, 42, 43,  
8 46, and 47; Request for Production Nos. 33, 34, and 82; and Interrogatory Nos. 8 and 10. Defendant  
9 shall also produce documents responsive to Request for Production No. 10, limited to agreements  
10 covering the 2008 and 2009 versions of the games, to the extent that unredacted copies of such  
11 agreements have not already been produced by Defendant to Plaintiffs. Defendant's response to  
12 RFP Nos. 33, 34 and 82 shall be limited to documents regarding any or all of the three named  
13 plaintiffs. However, Defendant's responses to RFP Nos. 33 and 34 shall include documents  
14 regarding retired NFL players in general, to the extent that responsive documents address the subject  
15 without specifically identifying individual players.

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17 IT IS SO ORDERED.

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19 Dated: July 5, 2011

