

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

United States District Court
Northern District of California

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

ERICKSON PRODUCTIONS INC, et al.,
Plaintiffs,
v.
KRAIG RUDINGER KAST, et al.,
Defendants.

Case No. [13-cv-05472-DMR](#)

**ORDER ON PLAINTIFFS' MOTION
FOR AN AWARD OF ATTORNEYS'
FEES AND COSTS**

Re: Dkt. No. 382

Plaintiffs Erickson Productions, Inc. (“Erickson Productions”) and Jim Erickson (together, “Erickson”) move pursuant to the Copyright Act, 17 U.S.C. § 505, for an award of attorneys’ fees and costs in this copyright infringement action. [Docket No. 382.] Pro se Defendant Kraig Kast opposes the motion. [Docket No. 388.] This matter is suitable for decision without a hearing. Civ. L.R. 7-1(b). For the following reasons, the motion is granted in part and denied in part. The court will determine the amount of attorneys’ fees and costs to which Erickson is entitled following supplemental briefing.

I. BACKGROUND

Erickson filed suit against Kast in September 2013 alleging that Kast infringed Erickson’s copyrights in three photos. Following a three-day trial in April 2015, a jury found that Kast vicariously and contributorily infringed Erickson’s copyrights and did so willfully. It awarded Erickson the maximum in statutory damages, \$150,000 per photo, for total damages of \$450,000, and the Honorable Howard R. Lloyd entered judgment for that amount against Kast. [Docket No. 118 (Aug. 19, 2015 Judgment).] Erickson then moved for an award of attorneys’ fees and costs pursuant to 17 U.S.C. § 505. [Docket No. 108.] Kast appealed the judgment against him to the United States Court of Appeals for the Ninth Circuit (the “first appeal,” Case No. 15-16801).¹

¹ Ninth Circuit Case No. 15-16801.

1 [Docket No. 123.]

2 Judge Lloyd issued several orders during the pendency of the appeal, three of which are
3 relevant to this motion. First, in July 2016, the court denied Erickson’s motion for fees and costs
4 without prejudice, finding that a fee award was “appropriate and will further the goals of the
5 Copyright Act” but denying the motion on the ground that Erickson had not presented sufficient
6 evidence supporting the reasonableness of the claimed hourly rates. [Docket No. 174 at 5-6.]
7 Following supplemental submissions by the parties, the court issued a second order in August
8 2017 granting in part and denying in part the motion for fees and costs and awarded Erickson
9 \$182,961.00 in attorneys’ fees and \$3,225.58 in costs. [Docket No. 242.]

10 Additionally, in October 2017, the court granted in part Erickson’s motion to amend the
11 judgment to add judgment debtors. [Docket No. 243.] The court issued an amended judgment on
12 October 18, 2017 that added the following judgment debtors to the judgment: Warren Craig
13 Rudinger; Kraig Kast, Trustee of the Black Oak Trust (a/k/a Kraig Kast, Trustee of The Black Oak
14 Trust, dated March 11, 1995); Atherton Trust; Atherton & Associates; Atherton Insurance
15 Services; The Atherton Company; Atherton Investment Advisors; and CB Real Estate Wealth
16 management. [Docket No. 246 (Oct. 18, 2017 Am. Judgment).] The amended judgment was for
17 \$636,186.58 plus post-judgment interest from August 19, 2015, which represented \$450,000 in
18 damages awarded by the jury, \$182,961.00 in attorneys’ fees, and \$3,225.58 in costs. *Id.*

19 Kast appealed the court’s order granting in part the motion to amend the judgment (the
20 “second appeal,” Case No. 17-17157).² [Docket No. 247.]

21 With respect to the first appeal, the Ninth Circuit affirmed the judgment in part, reversed
22 the judgment in part, and remanded on the issue of willfulness. *Erickson Prods., Inc. v. Kast*
23 (“*Erickson P*”), 921 F.3d 822 (9th Cir. 2019). In relevant part, the Ninth Circuit held that the
24 district court erred in including a negligence standard in the jury’s willfulness instruction, because
25 “[n]egligence is a less culpable mental state than actual knowledge, willful blindness, or
26 recklessness, the three mental states that properly support a finding of willfulness.” *Id.* at 833
27 (citations omitted). The Ninth Circuit further determined that “[t]he erroneous willfulness

28 ² Ninth Circuit Case No. 17-17157.

1 instruction was likely prejudicial to Kast” and “remand[ed] the issue of willfulness to the district
2 court on the existing record.” *Id.* at 833, 834. It observed that “[w]hile the evidence may have
3 established that Kast was negligent, it is much less clear that it established recklessness, willful
4 blindness, or actual knowledge,” and that “[i]f the jury had been properly instructed, it might well
5 have refused to find Kast willful on this record.” *Id.* at 834-45. However, it “disagree[d] with
6 Kast’s claim that ‘the record permits only one resolution of the factual issue’ of willfulness and
7 decline[ed] his invitation to enter judgment in his favor.” *Id.* at 835 (internal citation omitted). At
8 the conclusion of its opinion, the court ordered “[e]ach party to bear its own costs.” *Id.* at 836.

9 As to the second appeal, the Ninth Circuit affirmed the court’s October 2017 order
10 granting in part Erickson’s motion to amend the judgment in a separate memorandum disposition.
11 *Erickson Prods., Inc. v. Kast* (“*Erickson II*”), 769 Fed. Appx. 482 (9th Cir. 2019). The court
12 subsequently awarded attorneys’ fees on appeal to Erickson for the second appeal and referred the
13 determination of the amount of fees to the Appellate Commissioner. [Docket No. 384-4
14 (Kleinman Decl., Feb. 26, 2021) ¶ 10, Ex. 4 (Ninth Circuit Fees Order).] On October 3, 2019, the
15 Appellate Commissioner awarded Erickson \$13,955 in attorneys’ fees. *Id.*

16 Following Judge Lloyd’s retirement, the matter was reassigned to the undersigned upon
17 remand. [Docket No. 351.] The parties submitted cross-briefing regarding the issues of willful
18 infringement and the amount of statutory damages that should be awarded if the evidence did not
19 support a finding of willfulness. On February 12, 2021, the court ruled that the evidence
20 supported a finding of willfulness and awarded Erickson \$450,000 in statutory damages,
21 representing \$150,000 per photo. *Erickson Prods. Inc v. Kast* (“*Erickson III*”), No. 13-CV-05472-
22 DMR, 2021 WL 528769, at *1 (N.D. Cal. Feb. 12, 2021) (Order re: Willfulness and Damages
23 Following Remand). The court entered judgment in Erickson’s favor against Kast for that amount
24 the same day. [Docket No. 381.]

25 Erickson now seeks attorneys’ fees and costs pursuant to 17 U.S.C. § 505 for work
26 performed on: 1) the appeal in *Erickson I*; 2) the proceedings on remand in *Erickson III* regarding
27 the issue of willfulness; and 3) post-judgment collection efforts. Mot. 4-10. He also asks the
28 court to amend the February 12, 2021 judgment to include the awards of attorneys’ fees and costs

1 and to include the judgment debtors listed in the October 18, 2017 Amended Judgment.

2 **II. LEGAL STANDARD**

3 The Copyright Act provides that in any civil action for infringement, “the court in its
4 discretion may allow the recovery of full costs by or against any party other than the United
5 States,” including “a reasonable attorney’s fee to the prevailing party as part of the costs.” 17
6 U.S.C. § 505.

7 Section 505 “grants courts wide latitude” to award attorneys’ fees in a copyright case
8 “based on the totality of the circumstances.” *Kirtsaeng v. John Wiley & Sons, Inc.*, 136 S. Ct.
9 1979, 1985 (2016). “Courts may consider (but [are] not limited to) five factors in making an
10 attorneys’ fees determination . . . (1) the degree of success obtained, (2) frivolousness, (3)
11 motivation, (4) [objective] reasonableness of [the] losing party’s legal and factual arguments, and
12 (5) the need to advance considerations of compensation and deterrence.” *Tresona Multimedia,*
13 *LLC v. Burbank High Sch. Vocal Music Ass’n*, 953 F.3d 638, 653 (9th Cir. 2020) (quotation marks
14 omitted) (quoting *Wall Data Inc. v. L.A. Cty. Sheriff’s Dep’t*, 447 F.3d 769, 787 (9th Cir. 2006)).
15 While these factors “are not exclusive and need not all be met,” *Fantasy, Inc. v. Fogerty*, 94 F.3d
16 553, 558 (9th Cir. 1996), the Supreme Court has instructed courts to accord “[s]ubstantial weight”
17 to the fourth factor, the reasonableness of the losing party’s legal and factual arguments. *Shame*
18 *on You Prods., Inc. v. Banks*, 893 F.3d 661, 666 (9th Cir. 2018) (quoting *Kirtsaeng*, 136 S. Ct. at
19 1989). Courts may also consider “the purposes of the Copyright Act, and whether the chilling
20 effect of attorney’s fees may be too great or impose an inequitable burden on an impecunious
21 [litigant].” *Glacier Films (USA), Inc. v. Turchin*, 896 F.3d 1033, 1037 (9th Cir. 2018) (citation
22 and quotation marks omitted).

23 Ultimately, when assessing requests for attorneys’ fees under section 505, “courts must
24 view all the circumstances of a case on their own terms, in light of the Copyright Act’s essential
25 goals,” including “enriching the general public through access to creative works” by “encouraging
26 and rewarding authors’ creations while enabling others to build on that work.” *Kirtsaeng*, 136 S.
27 Ct. at 1986, 1989 (internal citations and quotation marks omitted).

28

1 **III. DISCUSSION**

2 **A. Whether Erickson May Obtain A Supplemental Award of Attorneys' Fees and**
 3 **Costs**

4 Erickson seeks attorneys' fees and costs for work performed in connection with 1) the
 5 appeal in *Erickson I*; 2) the proceedings on remand in *Erickson III* regarding the issue of
 6 willfulness; and 3) post-judgment collection efforts.

7 Kast does not challenge the reasonableness of the hours billed, the hourly rates, or the
 8 requested costs. Instead, he opposes the motion by arguing that the Ninth Circuit's opinion in
 9 *Erickson I* ordered "[e]ach party to bear its own costs." *Erickson I*, 921 F.3d at 836 (emphasis
 10 added). According to Kast, "costs include attorney's fees"; therefore, he argues, the Ninth
 11 Circuit's order precludes any award of fees in this case, seemingly including those already
 12 awarded. Opp'n 2-3.

13 Kast's position that Erickson is not entitled to the fees and costs previously awarded by
 14 Judge Lloyd is without merit. Kast did not appeal the court's July 22, 2016 order finding that a
 15 fee award was "appropriate and will further the goals of the Copyright Act" following a
 16 consideration of the relevant factors, nor did he appeal the August 25, 2017 order granting in part
 17 Erickson's motion for fees and costs and awarding \$182,961.00 in fees and \$3,225.58 in costs.
 18 The Ninth Circuit did not address the issue in *Erickson I*. Accordingly, Judge Lloyd's conclusion
 19 that an award of fees and costs was warranted under section 505 remains undisturbed.³

20 Next, Kast argues that the Ninth Circuit's order in *Erickson I* that "[each] party [shall] bear
 21 its own costs" precludes Erickson's current fee request. Kast cites *Marek v. Chesny*, 473 U.S. 1
 22 (1985), in support of his assertion that the word "costs" in "[e]ach party to bear its own costs"
 23 must be interpreted to include attorneys' fees. In *Marek*, the Supreme Court considered "whether
 24 attorney's fees incurred by a plaintiff subsequent to an offer of settlement under Federal Rule of
 25 Civil Procedure 68 must be paid by the defendant under 42 U.S.C. § 1988, when the plaintiff
 26

27 ³ It is not clear whether Kast also challenges the fees awarded by the Ninth Circuit in connection
 28 with *Erickson II*. To the extent he does, the request is denied, as he offers no argument or
 authority that this court has jurisdiction to vacate the Ninth Circuit's award.

1 recovers a judgment less than the offer.” *Id.* at 3.⁴ The Court examined “whether the term
2 “costs’ as used in Rule 68 includes attorney’s fees awardable under 42 U.S.C. § 1988” and
3 concluded that it does, holding that “[c]ivil rights plaintiffs—along with other plaintiffs—who
4 reject an offer more favorable than what is thereafter recovered at trial will not recover attorney’s
5 fees for services performed after the offer is rejected.” *Id.* at 7, 10.

6 *Marek* does not apply here. The current case does not involve a Rule 68 offer of judgment,
7 and nothing in *Marek* suggests that the Supreme Court intended to define the term “costs” beyond
8 the meaning of Rule 68. Here, the Ninth Circuit ordered “[e]ach party to bear its own costs” in the
9 context of Federal Rule of Appellate Procedure 39, which governs the taxation of costs on appeal.⁵
10 In *Family PAC v. Ferguson*, 745 F.3d 1261, 1269 (9th Cir. 2014), the Ninth Circuit specifically
11 held that “the term ‘costs’ under Federal Rule of Appellate Procedure 39 does not include
12 attorney’s fees recoverable as part of costs under 42 U.S.C. § 1988 and similar statutes.” *See also*
13 *id.* at 1263-64 (noting that section 1988 “is one of a number of federal fee shifting statutes that
14 allow a prevailing party to recover ‘a reasonable attorney’s fee as part of the costs.’”). Therefore,
15

16 _____
17 ⁴ Rule 68 provides in relevant part that “[i]f the judgment that the offeree finally obtains is not
18 more favorable than the unaccepted offer, the offeree must pay the costs incurred after the offer
19 was made.” Fed. R. Civ. P. 68(d).

⁵ In relevant part, Rule 39 sets forth rules regarding “against whom [costs] are assessed” on
20 appeal, as follows:

21 **(a) Against Whom Assessed.** The following rules apply unless the
22 law provides or the court orders otherwise:

23 **(1)** if an appeal is dismissed, costs are taxed against the
24 appellant, unless the parties agree otherwise;

25 **(2)** if a judgment is affirmed, costs are taxed against the
26 appellant;

27 **(3)** if a judgment is reversed, costs are taxed against the
28 appellee;

(4) if a judgment is affirmed in part, reversed in part, modified,
or vacated, costs are taxed only as the court orders.

...

Fed. R. App. P. 39(a).

1 the Ninth Circuit’s order in *Erickson I* that “[e]ach party [...] bear its own costs” does not preclude
 2 Erickson from recovering an additional attorneys’ fees award at this stage.

3 However, the court finds that Erickson may not obtain attorneys’ fees incurred on appeal in
 4 *Erickson I* because he did not first present an application for fees to the Ninth Circuit. Ninth
 5 Circuit Rule 39-1.6 governs the timing and form of requests for attorneys’ fees. It provides in
 6 relevant part that

7 [a]bsent a statutory provision to the contrary, a request for attorneys’
 8 fees shall be filed no later than 14 days after the expiration of the
 9 period within which a petition for rehearing may be filed, unless a
 10 timely petition for rehearing is filed. If a timely petition for rehearing
 is filed, the request for attorneys[’] fees shall be filed no later than 14
 days after the Court’s disposition of the petition.

11 Ninth Cir. Rule 39-1.6(a). Ninth Circuit Rule 39-1.8 provides that “[a]ny party who is or may be
 12 eligible for attorneys[’] fees on appeal to this Court may, within the time permitted in Circuit Rule
 13 39-1.6, file a motion to transfer consideration of attorneys[’] fees on appeal to the district court . . .
 14 from which the appeal was taken.” In *Cummings v. Connell*, 402 F.3d 936, 940 (9th Cir. 2005),
 15 the Ninth Circuit held that, “pursuant to Ninth Circuit Rule 39-1.6, a request for attorney’s fees
 16 incurred on appeal must be made to us, not to the district court. The district court is not authorized
 17 to award attorney’s fees for an appeal unless we transfer the fee request to the district court for
 18 consideration.” *See also id.* at 947-48 (“the decision to permit the district court to handle [a fees-
 19 on-appeal request] rests with the court of appeals.”).

20 Here, the Ninth Circuit filed *Erickson I* on April 16, 2019. It denied Erickson’s petition for
 21 panel rehearing and rehearing en banc on May 23, 2019. *Erickson Productions v. Kast*, No. 15-
 22 16801, at Docket No. 100 (9th Cir. May 23, 2019). Therefore, any request for fees in connection
 23 with the appeal was due 14 days later.

24 In a footnote, Erickson acknowledges that he did not first seek to recover attorneys’ fees
 25 directly from the Ninth Circuit. He states that such failure “is not a bar to this Court’s awarding
 26 such fees now,” citing *Twentieth Century Fox Film Corp. v. Entertainment Distrib.*, 429 F.3d 869,
 27 884 (9th Cir. 2005), *abrogated on other grounds by Rimini Street, Inc. v. Oracle USA, Inc.*, 139 S.
 28 Ct. 873 (2019). Mot. 5 n.1. *Twentieth Century Fox* does not help Erickson. In that case, a district

1 court awarded section 505 attorneys' fees for certain work incurred by the prevailing party in
2 connection with an intermediate appeal that it had lost. *Twentieth Century Fox*, 429 F.3d at 875.
3 The court affirmed the award on the ground that the prevailing party was "to be compensated for
4 attorney[s'] fees incurred for services that contribute to the ultimate victory in the lawsuit," noting
5 that "[r]are . . . is the litigant who doesn't lose some skirmishes on the way to winning the war."
6 *Id.* at 884 (quoting *Cabrales v. Los Angeles*, 935 F.2d 1050, 1052, 1053 (9th Cir. 1991)). The
7 Ninth Circuit mentioned the losing party's argument that the prevailing party had not filed a fee
8 request with the Ninth Circuit but did not discuss or rule on it. The opinion only addresses a
9 prevailing party's substantive entitlement to a fee award; it does not rule on the procedural
10 requirements for such an award, which are set forth in Ninth Circuit Rule 39-1.6 and governed by
11 *Cummings*. Accordingly, Erickson's request for attorneys' fees incurred in connection with the
12 appeal in *Erickson I* is denied. *See, e.g., Asset Mktg. Sys., Inc. v. Gagnon*, No. 03-CV-2234-B
13 (CAB), 2009 WL 10720557, at *7-8 (S.D. Cal. May 7, 2009) (denying section 505 fees incurred
14 on appeal for failure to comply with Ninth Circuit Rules).

15 **B. Analysis of the Section 505 Discretionary Factors**

16 The court now turns to the question of whether the totality of circumstances supports a
17 supplemental award of attorneys' fees and costs for the proceedings on remand in *Erickson III*
18 regarding the issue of willfulness and for post-judgment collection efforts.

19 As noted, the factors the court may consider in determining whether Erickson should be
20 awarded attorneys' fees and costs include "(1) the degree of success obtained, (2) frivolousness,
21 (3) motivation, (4) [objective] reasonableness of [the] losing party's legal and factual arguments,
22 and (5) the need to advance considerations of compensation and deterrence." *Tresona*, 953 F.3d at
23 653. The court may also consider "the purposes of the Copyright Act, and whether the chilling
24 effect of attorney's fees may be too great or impose an inequitable burden on an impecunious
25 [litigant]." *Glacier Films*, 896 F.3d at 1037 (citation and quotation marks omitted).

26 Kast only discusses two factors: the degree of success obtained and deterrence. Opp'n 3.
27 First, he argues that he prevailed on "more than just the vicarious infringement and willfulness
28 portion of the appeal," but "was held not to be a direct infringer nor a vicarious infringer and Kast

1 won the willfulness argument.” *Id.* Therefore, Kast argues, he “won on three quarters of
2 [Erickson’s] original complaint,” and he has moved for a new trial on the issue of willfulness and
3 to amend the judgment.⁶ *Id.* Kast inaccurately minimizes the degree of success obtained by
4 Erickson in this litigation. Although Erickson did not succeed on his direct or vicarious liability
5 theories of infringement, the Ninth Circuit affirmed the contributory liability verdict and remanded
6 the issue of willfulness to the district court. *See Erickson I*, 921 F.3d at 829-35. On remand, the
7 court concluded that the evidence supports a finding of willfulness and awarded Erickson
8 \$450,000, the maximum available statutory damages. *Erickson III*, 2021 WL 528769, at *12-13.⁷
9 Erickson thus obtained substantial success in this litigation, which weighs in favor of a
10 supplemental award. He also prevailed on the issue of willful infringement, which the Ninth
11 Circuit has held “is an important factor favoring an award of fees[.]” *See Historical Research v.*
12 *Cabral*, 80 F.3d 377, 379 (9th Cir. 1996).

13 As to whether an award would “advance considerations of compensation and deterrence,”
14 Kast states that “deterrence isn’t necessary as the gigantic size of the damage award is enough to
15 deter anyone in their right mind from using unlicensed photos, knowingly or otherwise.” Opp’n 3.
16 The court agrees that a supplemental fee award would not likely advance the consideration of
17 deterrence because Erickson was awarded \$450,000 in damages. The concern expressed by the
18 Ninth Circuit that a smaller damages award may be “insufficient to deter future copyright
19 infringements” simply is not present in this case. *See Magnuson v. Video Yesteryear*, 85 F.3d
20 1424, 1432 (9th Cir. 1996) (remanding for reconsideration of motion for attorneys’ fees under
21 section 505 where prevailing party was awarded only \$375 in damages and district court denied
22 fees); *Glacier Films*, 896 F.3d at 1039-40 (finding that court “did not appropriately weigh the
23 interests of deterrence and compensation” where the plaintiff obtained only \$1,500 in stipulated
24 judgment and district court denied fees).

25
26 _____
27 ⁶ The court denied Kast’s motion for a new trial on August 30, 2021. [Docket No. 409.]

28 ⁷ Had the court found that the evidence did not establish willfulness, the maximum amount of
statutory damages Erickson could recover per photo is \$30,000, for a total maximum award of
\$90,000 in statutory damages. *See* 17 U.S.C. § 504(c)(1).

1 At the same time, an award of attorneys' fees would further the goal of compensating
2 Erickson for the expenses incurred in enforcing the copyrights. As Judge Lloyd previously found,
3 "a fee award encourages valid copyright owners, such as Erickson, to protect their works where it
4 might otherwise not be economical to do so." [Docket No. 174 at 4.] The court notes, however,
5 that Erickson has already received a substantial fee award in this case. Therefore, the
6 compensation factor weighs somewhat in favor of a supplemental award.

7 As to the reasonableness of Kast's factual and legal positions, Erickson argues that Kast's
8 conduct subsequent to the trial and his trial testimony were objectively unreasonable, noting that
9 the court's order on willfulness references numerous instances in which Kast's trial testimony was
10 "undermined" or "expressly contradicted" by other evidence in the record. Mot. 8; *see Erickson*
11 *III*, 2021 WL 528769, at *10, 11. The court declines to find that Kast's factual and legal positions
12 were unreasonable on the basis of the evidence introduced at trial; as the Ninth Circuit observed in
13 *Erickson I*, "[i]f the jury had been properly instructed" on the issue of willfulness, "it might well
14 have refused to find Kast willful" based on such evidence. 921 F.3d at 835.

15 However, Erickson also notes that Kast "has repeatedly made misleading and outright false
16 representations" about his finances and arguments related to Erickson's collection efforts, which
17 he argues are "clearly intended to multiply these proceedings and increase the costs of litigation."
18 *Id.* at 8-9. Erickson argues that in granting his motion to amend or alter the original judgment,
19 Judge Lloyd found that "it appears that Kast has used the purported conveyances to the
20 Baker/Black Oak Trust as a ruse to avoid payment of the judgment as to Erickson" and found
21 some of Kast's assertions in opposition to the motion were not credible. [Docket No. 243 at 18.]
22 Judge Lloyd also noted Kast's inability to respond to assertions about actions it appeared Kast
23 took to avoid creditors. *Id.* at 16-18. In a subsequent order on a motion to compel post-judgment
24 discovery, Judge Lloyd found that Erickson presented evidence that "raised legitimate suspicions
25 about the extent of comingling of Kast's and [his fiancé] Baker's finances." [Docket No. 297 at
26 4.] Erickson also cites emails by Kast from 2012, 2015, and 2016 in which he made "baseless
27 allegations" of misconduct by Erickson's counsel and threatened to report him to law enforcement,
28 among other things. [Docket No. 383 (McCulloch Decl. Feb. 26, 2021) ¶¶ 6, 7, Exs. 1, 2.]

1 Kast does not respond to this argument and makes no attempt to show that his conduct in
2 this litigation, particularly with respect to Erickson's efforts to collect on the judgment, has been
3 reasonable. The record is therefore un rebutted that Kast has taken unreasonable, uncooperative
4 positions on the issue of collection.⁸

5 The remaining factors do not weigh against a supplemental fee award. Erickson's lawsuit
6 was not frivolous; the jury found that Erickson's copyrights had been infringed and the court
7 concluded that the evidence supported a finding of willfulness on remand. As to Erickson's
8 motivations in bringing this lawsuit, Erickson sought to enforce the copyrights and recover an
9 award for Kast's infringement, neither of which is improper.

10 Reviewing the totality of the circumstances, the court finds that Erickson obtained
11 substantial success in the litigation, including a ruling that Kast's infringement was willful.
12 Considerations of compensation are present but somewhat less compelling at this juncture given
13 that Erickson has already received a substantial fee award. Additional fees are not necessary to
14 deter Kast from further infringing behavior in light of the \$450,000 damages award he faces.
15 However, Kast's unreasonable positions in the collection efforts, identified in rulings by Judge
16 Lloyd, may both justify a supplemental fee award as well as deter Kast from similar future
17 behavior. The court finds on balance that Erickson has established that a supplemental award of
18 fees and costs is appropriate and would further the objectives of the Copyright Act by encouraging
19 the enforcement of copyrights.

20 However, the court is unable to determine the amount of an appropriate supplemental fee
21 award on the current record. Although Erickson submitted detailed time records for the time
22

23 ⁸ Kast did not object to Erickson's fee request for post-judgment collection work as not
24 compensable under section 505 and has thereby waived any argument on this point. It is
25 nevertheless worth noting that at least one court held that "[t]he language of § 505 is broad enough
26 to encompass an award of fees for post-judgment collection efforts," including obtaining an
27 amendment of the original judgment to add judgment debtors. *See Odnil Music Ltd. v. Katharsis*
28 *LLC*, No. CIV S-05-0545WBSEFBP, 2008 WL 958109, at *2 (E.D. Cal. Apr. 8, 2008), *report and*
recommendation adopted, No. S-05-0545 WBS EFB, 2008 WL 1930301 (E.D. Cal. May 1, 2008)
(granting motion for supplemental award of attorneys' fees under section 505, including fees
incurred in requesting amendment of the judgment to add judgment debtors and obtaining
injunctive relief).

1 requested, he did not categorize or organize the records in a way that enables the court to
2 determine what time was spent on the appeal in *Erickson I*, which is not compensable due to
3 procedural defects, what time was spent on post-judgment collections, and what time was spent on
4 *Erickson III*, which covered the willfulness briefing on remand. [See Docket No. 384 (Kleinman
5 Decl. Feb. 26, 2021) ¶¶ 7-8, Ex. 2.]

6 Additionally, Erickson asks for fees for work performed by attorney Lynda Chung but
7 does not set forth her hourly rate or submit evidence supporting her hourly rate. Instead, he
8 simply submitted her invoices. *Id.* at ¶ 9, Ex. 4. This is insufficient. Chung’s invoices also
9 include costs, but Erickson does not specifically address these in his motion or supporting
10 declarations. If Erickson seeks an award of costs, he must set forth the categories of costs
11 requested and provide authority that each category is compensable. *See Rimini Street, Inc. v.*
12 *Oracle USA, Inc.*, 139 S. Ct. 873, 875 (2019) (holding that the Copyright Act’s reference to “full
13 costs” in section 505 “covers only the six categories specified in the general costs statute”).

14 Within 14 days, Erickson shall resubmit the evidence supporting his request for a
15 supplemental award of attorneys’ fees (and costs, if requested) in accordance with the rulings set
16 forth in this order. Erickson must eliminate all fees for work performed in the *Erickson I* appeal
17 and may not change any time records or add any new ones. He shall mark the time records (using
18 color coding, symbols, or any other reasonable method) to denote whether the specific record
19 reflects work performed on remand in *Erickson III*, or work performed on post-judgment
20 collection efforts. He shall submit the evidence along with a declaration signed under penalty of
21 perjury setting forth the total amount of fees requested in each of the two allowable categories. If
22 he seeks an award of costs, the declaration shall also categorize the costs and set forth the total
23 amount of costs in each category along with authority that each category is compensable.
24 Erickson shall also submit a proposed amended judgment with the evidence in support of a
25 supplemental award of fees. Kast did not challenge the reasonableness of the hours or the rates
26 and has thus waived the right to do so now. However, Kast may submit a response to challenge
27 the categorization of specific time records that will be reflected in Erickson’s new submission.
28 Kast’s response may not exceed three pages and must be filed within seven days of the date that

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

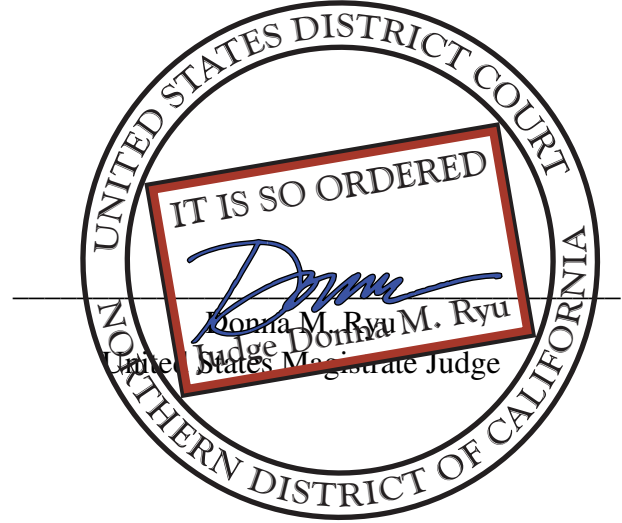
Erickson files the evidence.

IV. CONCLUSION

For the foregoing reasons, Erickson’s motion for a supplemental award of attorneys’ fees and costs is granted in part and denied in part.

IT IS SO ORDERED.

Dated: August 31, 2021



United States District Court
Northern District of California