UNITED STATES DISTRICT COURT

SOUTHERN DISTRICT OF CALIFORNIA

ROBERT ALEXANDER KASEBERG,

Plaintiff,

v.

CONACO, LLC, et al.,

Defendants.

Case No.: 15-cv-01637-JLS (DHB)

ORDER REGARDING JOINT MOTION FOR DETERMINATION OF DISCOVERY DISPUTE RE MODIFYING THE SCHEDULING ORDER TO REOPEN DISCOVERY AND PERMIT THE DEPOSITION OF PLAINTIFF'S COUNSEL

(ECF No. 132)

On June 28, 2017, the parties filed a Joint Motion for Determination of Discovery Dispute Re: Modifying the Scheduling Order to Reopen Discovery and Permit the Deposition of Plaintiff's Counsel. (ECF No. 132.) In the Joint Motion, Defendants Conaco, LLC, Turner Broadcasting System, Inc., Time Warner, Inc., Conan O'Brien, Jeff Ross, and Mike Sweeney (collectively, "Defendants") seek to (1) modify the Scheduling Order and reopen discovery for a period of sixty days, and (2) take the deposition of Jayson Lorenzo, counsel for Plaintiff Robert Alexander Kaseberg ("Plaintiff").

After careful consideration of the papers submitted, the Court **ORDERS** that a telephonic, attorneys only Discovery Conference shall be held, as set forth below.

I. BACKGROUND

A. First Amended Complaint

Plaintiff commenced this copyright infringement action on July 22, 2015. (ECF No. 1.) Plaintiff filed a First Amended Complaint ("FAC") against Defendants on October 3, 2016. (ECF No. 58.) Plaintiff alleges he is a comedic writer engaged in the entertainment industry. (*Id*. at ¶ 14.) Plaintiff alleges that after he wrote and published five jokes on his personal online blog and/or Twitter account between December 2, 2014 and June 9, 2015, each joke was subsequently featured in the monologue segment of the "Conan" show. (*Id*. at ¶¶ 15-24.) These jokes, in order of date of alleged infringement, are (1) the "UAB Joke;" (2) the "Delta Joke;" (3) the "Tom Brady Joke;" (4) the "Washington Monument Joke;" and (5) the "Jenner Joke." (*See id*.)

Plaintiff alleges he filed copyright applications for each of the jokes at issue, deeming them "literary works," with the United States Copyright Office. (*Id*. at ¶ 26.) He further alleges these applications are pending. (*Id*.) Plaintiff seeks a permanent injunction, actual damages, statutory damages, increased statutory damages for willful infringement, and profits attributable to the infringement of Plaintiff's copyrights pursuant to 17 U.S.C. §§ 502(a) and 504. (*Id*. at pp. 6-8.) Plaintiff also seeks attorney's fees and costs and punitive damages. (*Id*. at p. 7.)

B. Answer

On October 17, 2016, Defendants filed an Answer to the FAC. (ECF No. 59.) Defendants assert eight affirmative defenses and reserve additional defenses. (*Id*. at pp. 5-6.) The affirmative defenses include: (1) failure to state a claim; (2) lack of copyrightable subject matter; (3) copyright non-infringement; (4) independent creation; (5) lack of originality; (6) fair use; (7) no willfulness; and (8) improper venue. (*Id*.)

C. Motion for Summary Judgment

On February 3, 2017, Defendants filed a Motion for Summary Judgment and/or Partial Summary Judgment. (ECF No. 70.) Defendants moved for summary judgment, in part, on the Tom Brady Joke and the UAB Joke on the basis that Plaintiff failed to register

these jokes. (ECF No. 70-1 at pp. 8-9.) Defendants argued that a party "cannot litigate an infringement claim until it has at least filed an application to register the allegedly infringed copyrights." (*Id*. at p. 9.) Based on Plaintiff's discovery responses, Defendants argued that Plaintiff "failed to produce any evidence proving that he registered the Tom Brady Joke and the UAB Joke, which were first published on February 3, 2015 and December 3, 2014, respectively." (*Id*.) Defendants asserted the Copyright Office's records are consistent with Plaintiff's production. (*Id*.) Thus, Defendants argued Plaintiff's claims as to the Tom Brady Joke and the UAB Joke must be dismissed for lack of standing. (*Id.*)

In his opposition, filed on February 24, 2017, Plaintiff asserted that he had submitted applications to the Copyright Office for all of the jokes at issue, including the Tom Brady and UAB Jokes, but that the applications for the Tom Brady Joke and the UAB Joke were currently pending. (ECF No. 97 at pp. 6-7.) Plaintiff represented that he sent an application for the UAB Joke on December 2, 2014, and that he sent applications for the Tom Brady Joke on September 3, 2015 and August 10, 2016, but they all remain pending. (*Id*.) Plaintiff argued that because he had submitted the applications, he has standing to proceed on these jokes. (*Id*.)

In their Reply, dated March 10, 2017, Defendants argued that they did not receive Plaintiff's copyright applications for the Tom Brady Joke and the UAB Joke until February 8, 2017. (ECF No. 106 at pp. 1-2.) Defendants argued the late disclosure were not harmless because the UAB Joke application appeared to be invalid, and Plaintiff failed to explain why he produced two different applications for the Tom Brady Joke. (*Id*. at p. 2.)

In supplemental briefing following oral argument, the parties addressed whether Plaintiff's failure to produce the applications was substantially justified or harmless, or whether such evidence should be excluded, under Federal Rule of Civil Procedure 37. (ECF Nos. 124, 126, 127.)

In the Honorable Janis L. Sammartino's Order Granting in Part and Denying in Part Defendants' Motion for Summary Judgment, dated May 12, 2017, she addressed the issue in detail. (ECF No. 131.) Judge Sammartino held "there is no question that Plaintiff failed

to timely produce the required disclosures," but ultimately found the failure "harmless" within the meaning of Federal Rule of Civil Procedure 37(c). (*Id.* at pp. 8-9.) Although Defendants could have conducted discovery that invalidates the applications if the applications were produced in a timely manner, Judge Sammartino found the fact remains that "Plaintiff did, in fact, submit applications which in turn confer Plaintiff with standing for the relevant jokes." (*Id*. at p. 9.) Because she found the failure to disclose harmless insofar as it relates to standing to bring suit, Judge Sammartino denied Defendants' summary judgment motion on this ground. (*Id.* at p. 10.)

However, Judge Sammartino added that "Defendants are correct that they should be permitted to reopen discovery regarding the relevant applications, associated documents, and communications from the Copyright Office. Further, if Defendants discover fatal deficiencies in Plaintiff's applications then Defendants should also again be permitted to move for Summary Judgment on those discrete grounds." (*Id*. at pp. 9-10.) Judge Sammartino instructed the parties to meet and confer regarding these issues, and "if possible," submit a joint motion to reopen discovery and modify the operative pre-trial schedule. (*Id*. at p. 10.)

Ultimately, Judge Sammartino granted summary judgment in favor of Defendants on the UAB Joke and the Delta Joke. (*Id*. at p. 28.) Summary judgment was granted as to the UAB Joke on grounds unrelated to registration with the Copyright Office. (*Id*. at pp. 22-23.) Judge Sammartino did not, however, grant summary judgment as to the Tom Brady Joke.

D. Scheduling Order

On July 7, 2017, Defendants filed an Ex Parte Motion to Continue Pretrial Deadlines Pending Resolution of the Parties' Joint Motion. (ECF No. 134.) On July 10, 2017, Judge Sammartino granted the Ex Parte Motion and vacated all current pretrial deadlines. (ECF No. 136; *see also* ECF No. 138.) Judge Sammartino will reset the pretrial deadlines after the present motion is resolved. (*Id.* at p. 2.)

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E. Meet and Confer Efforts

The parties met and conferred extensively on the present issue before the Court. (*See* ECF No. 132-1, Declaration of Nicholas Huskins ("Huskins Decl."); ECF No. 132-2, Declaration of Jayson M. Lorenzo ("Lorenzo Decl.").) After reviewing the submissions by the parties, the Court notes the following key dates in the history of this issue:

- **March 10, 2015**: Plaintiff submitted a Standard application to the Copyright Office for the Delta Joke, but included screenshots from Plaintiff's blog of the Delta Joke, the Tom Brady Joke, and the Washington Monument Joke. (Huskins Decl. at ¶¶ 12-13, Exhs. 7-8.)
- **March 11, 2015**: Plaintiff submitted a Single application for the Delta Joke, and again included screenshots from Plaintiff's blog of the Delta Joke, the Tom Brady Joke, and the Washington Monument Joke. (Huskins Decl. at ¶¶ 12-13, Exhs. 7-8.)
- **July 22, 2015**: Complaint filed alleging copyright infringement of the Delta Joke, the Tom Brady Joke, the Washington Monument Joke, and the Jenner Joke. (ECF No. 1.) The Complaint alleges Plaintiff filed copyright applications for each of these jokes on March 10, 2015, March 11, 2015, June 26, 2015, and July 8, 2015, and that these applications remain pending with the Copyright Office. (*Id.* at ¶ 23.)
- **August 11, 2015**: The Copyright Office sent a letter to Plaintiff's counsel advising him that it was refusing to register Plaintiff's March 2015 applications "because they are duplicate claims, or because they contain multiple works that require multiple applications, filing fees, and deposit copies." (Huskins Decl. at ¶ 13, Exh. 8.)
- **September 3, 2015**: Plaintiff filed a Single Application to register the Tom Brady Joke by itself. (Huskins Decl. at ¶¶ 9, 14, Exh. 4, 9.)
- **March 24, 2016**: Conaco, LLC's served its First Set of Requests for Production of Documents and Things to Plaintiff. (Huskins Decl. at ¶ 6, Exh. 1.) Request for Production No. 8 stated: "Please produce all DOCUMENTS related to the application and/or registration of the JOKES AT ISSUE with the United States Copyright Office." (*Id.* at Exh. 1.)
- **April 25, 2016**: Plaintiff responded to Conaco, LLC's Request for Production by stating: "Documents in Respondent's possession that do not violate the attorney-client privilege or attorney work product privileges will be produced." (Huskins Decl. at ¶ 7, Exh. 2.) In

response to Conaco, LLC's First Set of Interrogatories, Plaintiff responded: "Respondent objects to this Interrogatory on the basis that the question is vague and ambiguous as to the term 'ownership'. Without waiving said objections, Respondent has registered copyrights for the jokes created." (Huskins Decl. at ¶ 8, Exh. 3.)

- **July 20, 2016**: The Copyright Office sent a letter to Plaintiff's counsel advising him that it could not register the Brady Joke "because the material deposited represents less than the required minimum amount of original authorship." (Huskins Decl. at ¶ 15; Exh. 10.)
- **August 10, 2016**: Plaintiff filed a Standard Application to register the Tom Brady Joke and two others posted to Plaintiff's blog on February 3, 2015. (Huskins Decl. at ¶ 9, Exh. 4.)
- **October 3, 2016**: Plaintiff filed the FAC. (ECF No. 58.) The FAC added the UAB Joke. (*Id*. at ¶¶ 15-16.) The FAC alleges that Plaintiff filed copyright applications for each of the five jokes on March 10, 2015, March 11, 2015, June 26, 2015, July 8, 2015, and August 10, 2016, and that these applications remain pending with the Copyright Office. (*Id.* at ¶ 26.)
- **October 7, 2016**: Discovery closed. (ECF No. 57.) At the time discovery closed, Plaintiff had only produced registration certificates for the Delta Joke, the Bruce Jenner Joke, and the Washington Monument Joke. (Huskins Decl. at ¶ 2.) Plaintiff did not produce any applications, deposits, or correspondence with the United States Copyright Office related to any of the jokes at issue, and did not produce registration certificates for the Tom Brady Joke or the UAB Joke. (*Id*.)
- **October 19, 2016**: Plaintiff's counsel sent a letter to the Copyright Office asking it to reconsider its refusal to register the Tom Brady Joke. (Huskins Decl. at ¶ 16, Exh. 11.)
- **February 3, 2017**: Defendants filed a Motion for Summary Judgment and/or Partial Summary Judgment. (ECF No. 70.)
- **February 8, 2017**: Plaintiff produced two copyright registration applications for the Tom Brady Joke: the September 3, 2015 application and the August 10, 2016 application. (Huskins Decl. at ¶ 9, Exh. 4.)
- **March 23, 2017**: The Copyright Office sent a letter to Plaintiff's counsel denying his request for reconsideration, stating that the Tom Brady Joke "does not contain a sufficient amount of original and

creative literary authorship to support a copyright registration." (Huskins Decl. at ¶ 17, Exh. 12.)

- **April 21, 2017**: Plaintiff's counsel sent a letter to the Copyright Office advising them of the pending lawsuit, the application history of the Tom Brady Joke, as well as the collective work application filed on August 10, 2016. (Lorenzo Decl. at ¶ 19, Exh. O.)
- **May 12, 2017**: Judge Sammartino issued her Order Granting in Part and Denying in Part Defendants' Motion for Summary Judgment, ordering the parties to meet and confer. (ECF No. 131.) Judge Sammartino granted Defendants' Motion for Summary Judgment for failure to establish a genuine issue of material fact regarding the UAB Joke and the Delta Joke. (*Id*.)
- **May 19, 2017**: Upon request, Plaintiff produced seventy-one (71) pages of documents, which included the registration applications, deposits, and letters with the Copyright Office related to the Washington Monument Joke, the Tom Brady Joke, and the Bruce Jenner Joke. (Lorenzo Decl. at ¶ 5, Exh. C; Huskins Decl. at ¶¶ 3, 12.)
- **May 30, 2017**: Plaintiff's counsel sent a letter to the Copyright Office seeking reconsideration of its decision on the Brady Joke based on Judge Sammartino's ruling on Defendants' Motion for Summary Judgment and/or Partial Summary Judgment. (Huskins Decl. at ¶ 18, Exh. 13.)
- **June 2, 2017**: Plaintiff's counsel sent an email to the Copyright Office advising them "of the procedural history related to the Tom Brady Joke, which included the filing of a collective work application." (Lorenzo Decl. at ¶ 11, Exh. H.)
- **June 5, 2017**: Plaintiff produced fifty-one (51) additional pages of application-related documents pertaining to the jokes at issue. (Huskins Decl. at ¶ 4.)
- **June 13, 2017**: Plaintiff's counsel sent a letter to the Copyright Office withdrawing the August 10, 2016 application for the Tom Brady Joke, prior to registration being received. (Lorenzo Decl. at ¶ 15, Exh. K; Huskins Decl. at ¶ 19, Exh. 14.)
- **June 19, 2017**: Plaintiff's counsel received a registration for the collective work application on the Tom Brady Joke. (Lorenzo Decl. at ¶ 20, Exh. P.) Plaintiff forwarded the registration to Defendants. (*Id*.)

- **June 28, 2017**: Plaintiff's counsel sent a letter to the Copyright Office requesting the copyright registration for the Tom Brady Joke be voluntarily cancelled. (Lorenzo Decl. at ¶ 21, Exh. Q.)

II. LEGAL STANDARD

A. Modifying the Scheduling Order

Pursuant to Federal Rule of Civil Procedure 16(b)(3)(A), district courts must enter a scheduling order to establish deadlines to, among other things, "complete discovery." Fed. R. Civ. P. 16(b)(3)(A). Once issued, a Rule 16 scheduling order "may be modified only for good cause and with the judge's consent." Fed. R. Civ. P. 16(b)(4). The decision to modify a scheduling order is within the broad discretion of the district court. *Johnson,* 975 F.2d at 607 (citation omitted). Under Rule 16(b)(4)'s good cause standard, the court's primary focus is on the movant's diligence in seeking the amendment. *Johnson,* 975 F.2d at 609. "Good cause" exists if a party can demonstrate that the scheduling order could not or "cannot reasonably be met despite the diligence of the party seeking the extension." *Id.* (citations omitted). "[C]arelessness is not compatible with a finding of diligence and offers no reason for a grant of relief." *Id.* "Although the existence or degree of prejudice to the party opposing the modification might supply additional reasons to deny a motion, the focus of the [Rule 16] inquiry is upon the moving party's reasons for seeking modification." *Id.* (citations omitted). The party seeking to continue or extend the deadlines bears the burden of proving good cause. *See Zivkovic v. S. Cal. Edison Co.,* 302 F.3d 1080, 1087 (9th Cir. 2002); *Johnson,* 975 F.2d at 608–09.

In addressing the diligence requirement, one district court in this Circuit noted:

> [T]o demonstrate diligence under Rule 16's "good cause" standard, the movant may be required to show the following: (1) that [it] was diligent in assisting the Court in creating a workable Rule 16 order..; (2) that [its] noncompliance with a Rule 16 deadline occurred or will occur, notwithstanding [its] diligent efforts to comply, because of the development of matters which could not have been reasonably foreseen or anticipated at the time of the Rule 16 scheduling conference ...; and (3) that [it] was diligent in seeking amendment of the Rule 16 order, once it became apparent that [it] could not comply with the order . . . .

Jackson v. Laureate, Inc., 186 F.R.D. 605, 608 (E.D. Cal.1999) (internal citations omitted); *see also Sharp v. Covenant Care LLC*, 288 F.R.D. 465, 466 (S.D. Cal. 2012) (McCurine Jr., J.). If the district court finds a lack of diligence, "the inquiry should end." *Johnson*, 975 F.2d at 609; *see also Zivkovic v. So. Cal. Edison Co.*, 302 F.3d 1080, 1088 (9th Cir. 2002).

B. Reopening Discovery

District courts have broad discretion to manage discovery and to control the course of litigation under Rule 16. *Hunt v. Cnty. of Orange*, 672 F.3d 606, 616 (9th Cir. 2012). In determining whether to reopen discovery, courts consider such factors as:

> 1) whether trial is imminent, 2) whether the request is opposed, 3) whether the non-moving party would be prejudiced, 4) whether the moving party was diligent in obtaining discovery within the guidelines established by the court, 5) the foreseeability of the need for additional discovery in light of the time allowed for discovery by the district court, and 6) the likelihood that the discovery will lead to relevant evidence.

United States ex rel. Schumer v. Hughes Aircraft Co., 63 F.3d 1512, 1526 (9th Cir. 1995), rev'd on other grounds, 520 U.S. 939 (1997) (quoting *Smith v. United States*, 834 F.2d 166, 169 (10th Cir. 1987)); *see also Mikell v. Baxter Healthcare Corp.*, No. CV 13-07611 MMM (PJWx), 2014 WL 12588640, at *7 (C.D. Cal. Sept. 16, 2014).

III. DISCUSSION

The parties do not dispute that Defendants were diligent in seeking to modify the Scheduling Order, and that the need for modification could not have reasonably been foreseen or anticipated at an earlier date. Despite requesting the documents in discovery, Defendants first received the copyright applications for the UAB Joke and the Tom Brady Joke on February 8, 2017, after they filed their Motion for Summary Judgment and/or Partial Summary Judgment. During subsequent meet and confer efforts ordered by Judge Sammartino, Plaintiff produced seventy-one (71) pages of new documents, which included the registration applications, deposits, and letters with the Copyright Office related to the Washington Monument Joke, the Tom Brady Joke, and the Bruce Jenner Joke on May 19,

2017, and an additional fifty-one (51) pages of new application-related documents pertaining to the jokes at issue on June 5, 2017. (Lorenzo Decl. at ¶ 5, Exh. C; Huskins Decl. at ¶¶ 3-4, 12.) Plaintiff subsequently sent Defendants the registration for the Tom Brady Joke on June 19, 2017. (Lorenzo Decl. at ¶ 20, Exh. P.) After failing to resolve their issues as part of their meet and confer, this motion was filed shortly thereafter, on June 28, 2017. As the Court finds Defendants were diligent in seeking to modify the Scheduling Order, the Court now turns to address whether reopening discovery is appropriate.

On July 10, 2017, Judge Sammartino vacated the trial pending the outcome of this Joint Motion. (ECF Nos. 136, 138.) Accordingly, although trial would be the next step in this case absent additional discovery, there is no trial imminent. Furthermore, while Defendants' request is opposed, given Plaintiff's failure to timely comply with discovery, it would be difficult for Plaintiff to argue that he would be prejudiced by reopening discovery. These factors weigh in favor of reopening discovery. However, in light of Judge Sammartino granting summary judgment in favor of Defendants on the UAB Joke, and Plaintiff's voluntary cancellation of the Tom Brady Joke registration, the key question is whether there is any likelihood additional discovery will lead to relevant evidence.

Plaintiff argues the requested discovery is not relevant to any of Defendants' claims or defenses. (ECF No. 132 at 18-23.) In response, Defendants argue "the intended discovery is highly relevant, as it bears directly on [Plaintiff's] ability to assert an infringement claim as to the Tom Brady Joke, and any potential relief he may be afforded." (*Id*. at 9.) In particular, Defendants argue the intended discovery – written discovery and depositions of Plaintiff and his counsel – is crucial to determine whether Defendants can assert the affirmative defenses of fraud and unclean hands to the Tom Brady Joke. (*Id*.) These defenses, Defendants argue, "may invalidate the Tom Brady registration." (*Id*.)

Unfortunately, because Plaintiff's counsel did not send the letter to the Copyright Office requesting voluntary cancellation of the Tom Brady Joke registration until the day the present Joint Motion was filed, Defendants did not have an opportunity to address in

detail the relevance of their intended discovery, if such registration was cancelled. Instead, Defendants were left to argue:

> While [Plaintiff] may offer that he will abandon the Tom Brady registration, rendering Defendants' proposed affirmative defenses and discovery moot – this misses the point. Defendants are entitled to the discovery they were prejudicially denied so they can explore and develop potential claims, affirmative defenses, and evidentiary issues for trial. Until Defendants take discovery, they cannot know the extent of what it will bear, and what other issues may present themselves.

(*Id.* at 5-6.) As they were dealing with a hypothetical and were constrained by page limits, Defendants did not further explain what types of potential claims, affirmative defenses, and evidentiary issues they expect to find. Without further explanation, the Court is not inclined to grant the Joint Motion.

However, in light of Plaintiff's late decision to seek cancellation of the Tom Brady Joke claim, the uncertain status of the claim,[1] and the prejudice that may result to Defendants if they are not given an opportunity to present further argument, the Court finds it appropriate to set a Discovery Conference. At the Discovery Conference, Plaintiff shall be prepared to discuss how he intends to proceed on the Tom Brady Joke, and Defendants shall be prepared to discuss how their intended discovery is relevant and necessary, given Plaintiff's request to cancel the registration on the Tom Brady Joke. The parties should also be prepared to discuss whether the intended discovery is relevant to Plaintiff's

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[1] Plaintiff argues that Defendants' potential affirmative defenses to the Tom Brady Joke must fail because the request for a cancellation was made. (ECF No. 132 at 23.) However, Plaintiff does not discuss the status of his Tom Brady Joke claim after the request was sent, other than stating "[i]n the event that the request for cancellation is not granted prior to this Court making a ruling on this dispute, Plaintiff will and continues to agree not to use the August 10, 2016 registration at trial." (*Id.*) Thus, it is unclear whether Plaintiff intends to pursue a copyright infringement claim as to this "unregistered" joke, and whether he is entitled to all the damages he seeks in the FAC. *See*, *e.g.*, 17 U.S.C. § 412.

remedies under 17 U.S.C. §§ 411(b)(1), 412. Defendants shall also address whether they intend to amend their Answer to the FAC.

IV. CONCLUSION

Based on the foregoing, the Court hereby **ORDERS** as follows:

1. A telephonic, attorneys only Discovery Conference shall be held on **July 28, 2017** at **10:00 a.m.** before Magistrate Judge Louisa S Porter.

2. The parties shall use the Court's conferencing system:

Conference number:	(888) 684-8852
Access code:	2236596
Participant security code:	1637

IT IS SO ORDERED.

Dated: July 25, 2017

LOUISA S PORTER
United States Magistrate Judge