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1:21-cv-01340-CMH-JFA Bedford, Freeman & Worth Publishing Group, LLC d/b/a Macmillan Learning et al v. Shopify Inc.

Claude M. Hilton, presiding

John F. Anderson, referral

















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included in this PDF.




















Date filed: 12/01/2021

Date of last filing: 04/22/2022

History

Doc. No.	Dates	Description
	<i>Filed & Entered:</i> 12/01/2021	Initial Case Assignment
1	<i>Filed & Entered:</i> 12/01/2021	Complaint
2	<i>Filed & Entered:</i> 12/01/2021	Proposed Summons
3	<i>Filed & Entered:</i> 12/01/2021	NOTICE
4	<i>Filed & Entered:</i> 12/01/2021	NOTICE
5	<i>Filed & Entered:</i> 12/01/2021	NOTICE
6	<i>Filed & Entered:</i> 12/01/2021	Proposed Summons
7	<i>Filed & Entered:</i> 12/01/2021	Corporate Disclosure Statement
8	<i>Filed & Entered:</i> 12/03/2021	Summons Issued
9	<i>Filed & Entered:</i> 12/16/2021 <i>Terminated:</i> 12/16/2021	Motion to appear Pro hac vice
10	<i>Filed & Entered:</i> 12/16/2021 <i>Terminated:</i> 12/16/2021	Motion to appear Pro hac vice
11	<i>Filed & Entered:</i> 12/16/2021	Order on Motion for Pro hac vice
12	<i>Filed & Entered:</i> 12/16/2021	Order on Motion for Pro hac vice
13	<i>Filed & Entered:</i> 12/17/2021	Notice of Appearance

14	<i>Filed & Entered:</i> <i>Terminated:</i>	12/17/2021 12/20/2021	 Motion to appear Pro hac vice
15	<i>Filed & Entered:</i> <i>Terminated:</i>	12/17/2021 12/20/2021	 Motion to appear Pro hac vice
16	<i>Filed & Entered:</i> <i>Terminated:</i>	12/17/2021 12/20/2021	 Motion to appear Pro hac vice
17	<i>Filed & Entered:</i> <i>Terminated:</i>	12/17/2021 12/20/2021	 Motion to appear Pro hac vice
18	<i>Filed & Entered:</i> <i>Terminated:</i>	12/17/2021 12/20/2021	 Motion to appear Pro hac vice
19	<i>Filed & Entered:</i>	12/17/2021	 Corporate Disclosure Statement
20	<i>Filed & Entered:</i>	12/17/2021	 Stipulation
21	<i>Filed & Entered:</i> <i>Terminated:</i>	12/17/2021 12/20/2021	 Motion for Extension of Time to File Answer
22	<i>Filed & Entered:</i>	12/20/2021	 Order on Motion for Extension of Time to Answer
23	<i>Filed & Entered:</i>	12/20/2021	 Order on Motion for Pro hac vice
24	<i>Filed & Entered:</i>	12/20/2021	 Order on Motion for Pro hac vice
25	<i>Filed & Entered:</i>	12/20/2021	 Order on Motion for Pro hac vice
26	<i>Filed & Entered:</i>	12/20/2021	 Order on Motion for Pro hac vice
27	<i>Filed & Entered:</i>	12/20/2021	 Order on Motion for Pro hac vice
28	<i>Filed & Entered:</i> <i>Terminated:</i>	12/28/2021 02/04/2022	 Motion to appear Pro hac vice
29	<i>Filed & Entered:</i> <i>Terminated:</i>	01/27/2022 02/04/2022	 Motion to appear Pro hac vice
30	<i>Filed & Entered:</i>	01/28/2022	Answer to Complaint
31	<i>Filed & Entered:</i>	02/04/2022	Order on Motion for Pro hac vice

32	<i>Filed & Entered:</i>	02/04/2022	 Order on Motion for Pro hac vice
33	<i>Filed & Entered:</i>	03/01/2022	 Scheduling Order
34	<i>Filed & Entered:</i> <i>Terminated:</i>	03/01/2022 03/08/2022	 Motion to appear Pro hac vice
35	<i>Filed:</i> <i>Entered:</i>	03/08/2022 03/09/2022	 Order on Motion for Pro hac vice
36	<i>Filed & Entered:</i> <i>Terminated:</i>	03/16/2022 03/21/2022	 Motion to appear Pro hac vice
37	<i>Filed & Entered:</i> <i>Terminated:</i>	03/16/2022 03/21/2022	 Motion to appear Pro hac vice
38	<i>Filed & Entered:</i> <i>Terminated:</i>	03/16/2022 03/21/2022	 Motion to appear Pro hac vice
39	<i>Filed & Entered:</i> <i>Terminated:</i>	03/16/2022 04/04/2022	 Motion to appear Pro hac vice
40	<i>Filed & Entered:</i>	03/16/2022	 Discovery Plan
	<i>Filed & Entered:</i>	03/17/2022	 Set/Reset Scheduling Order Deadlines
41	<i>Filed:</i> <i>Entered:</i>	03/21/2022 03/22/2022	 Order on Motion for Pro hac vice
42	<i>Filed:</i> <i>Entered:</i>	03/21/2022 03/22/2022	 Order on Motion for Pro hac vice
43	<i>Filed:</i> <i>Entered:</i>	03/21/2022 03/22/2022	 Order on Motion for Pro hac vice
44	<i>Filed & Entered:</i>	03/23/2022	 Pretrial Conference - Initial
45	<i>Filed & Entered:</i>	03/28/2022	 Discovery Plan
46	<i>Filed & Entered:</i>	03/29/2022	 Order Rule 16(b) Scheduling Order
47	<i>Filed & Entered:</i> <i>Terminated:</i>	03/29/2022 03/30/2022	 Motion for Miscellaneous Relief
48	<i>Filed & Entered:</i>	03/30/2022	 So Ordered
49	<i>Filed & Entered:</i> <i>Terminated:</i>	03/30/2022 03/31/2022	 Motion for Protective Order

50	Filed & Entered:	03/31/2022	Protective Order
51	Filed: Entered:	04/04/2022 04/05/2022	Order on Motion for Pro hac vice
52	Filed & Entered:	04/15/2022	Motion to Compel
53	Filed & Entered:	04/15/2022	Memorandum in Support
54	Filed & Entered:	04/15/2022	Notice of Hearing Date
55	Filed & Entered:	04/15/2022	Motion to Compel
56	Filed & Entered:	04/15/2022	Memorandum in Support
57	Filed & Entered:	04/15/2022	Notice of Hearing Date
	Filed & Entered:	04/18/2022	Set Motion and R&R Deadlines/Hearings
58	Filed & Entered:	04/18/2022	Order
59	Filed & Entered:	04/18/2022	Memorandum in Support
	Filed: Entered:	04/22/2022 04/25/2022	Set Motion and R&R Deadlines/Hearings
	Filed: Entered:	04/22/2022 04/25/2022	Motions Referred
60	Filed & Entered:	04/22/2022	Motion to Compel
61	Filed & Entered:	04/22/2022	Memorandum in Support
62	Filed & Entered:	04/22/2022	Notice of Hearing Date
63	Filed & Entered:	04/22/2022	Opposition
64	Filed & Entered:	04/22/2022	Memorandum in Opposition

PACER Service Center			
Transaction Receipt			
04/26/2022 11:01:27			
PACER Login:	WJ0578	Client Code:	
Description:	History/Documents	Search Criteria:	1:21-cv-01340-CMH-JFA

Billable Pages:	2	Cost:	0.20
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Billing Transactions

Date	Time	Pages	Court	Client Code	Description	Search	Cost
04/26/2022							
04/26/2022	11:01:26	2	VAEDC		History/Documents	1:21-cv-01340-CMH-JFA	\$0.20
04/26/2022	11:02:45	3	VAEDC		Image60-0	1:21-cv-01340-CMH-JFA Document 60-0	\$0.30
04/26/2022	11:02:45	2	VAEDC		Image60-1	1:21-cv-01340-CMH-JFA Document 60-1	\$0.20
04/26/2022	11:06:39	15	VAEDC		Image61-0	1:21-cv-01340-CMH-JFA Document 61-0	\$1.50
04/26/2022	11:06:40	30	VAEDC		Image61-1	1:21-cv-01340-CMH-JFA Document 61-1	\$3.00
04/26/2022	11:06:40	9	VAEDC		Image61-2	1:21-cv-01340-CMH-JFA Document 61-2	\$0.90
04/26/2022	11:06:41	30	VAEDC		Image61-3	1:21-cv-01340-CMH-JFA Document 61-3	\$3.00
04/26/2022	11:06:42	30	VAEDC		Image61-4	1:21-cv-01340-CMH-JFA Document 61-4	\$3.00
04/26/2022	11:06:42	3	VAEDC		Image61-5	1:21-cv-01340-CMH-JFA Document 61-5	\$0.30
04/26/2022	11:11:40	1	VAEDC		Image62-0	1:21-cv-01340-CMH-JFA Document 62-0	\$0.10
04/26/2022	11:18:37	28	VAEDC		Image63-0	1:21-cv-01340-CMH-JFA Document 63-0	\$2.80
04/26/2022	11:18:38	7	VAEDC		Image63-1	1:21-cv-01340-CMH-JFA Document 63-1	\$0.70
04/26/2022	11:18:38	7	VAEDC		Image63-2	1:21-cv-01340-CMH-JFA Document 63-2	\$0.70
04/26/2022	11:18:39	8	VAEDC		Image63-3	1:21-cv-01340-CMH-JFA Document 63-3	\$0.80
04/26/2022	11:18:40	7	VAEDC		Image63-4	1:21-cv-01340-CMH-JFA Document 63-4	\$0.70
04/26/2022	11:18:40	7	VAEDC		Image63-5	1:21-cv-01340-CMH-JFA Document 63-5	\$0.70
04/26/2022	11:18:40	3	VAEDC		Image63-6	1:21-cv-01340-CMH-JFA Document 63-6	\$0.30
04/26/2022	11:20:30	28	VAEDC		Image64-0	1:21-cv-01340-CMH-JFA Document 64-0	\$2.80
04/26/2022	11:20:31	5	VAEDC		Image64-1	1:21-cv-01340-CMH-JFA Document 64-1	\$0.50
04/26/2022	11:20:31	4	VAEDC		Image64-2	1:21-cv-01340-CMH-JFA Document 64-2	\$0.40
04/26/2022	11:21:57	2	VAEDC		History/Documents	1:21-cv-01340-CMH-JFA	\$0.20
Subtotal:				231 pages			\$23.10
				0 audio files (\$2.40 each)			\$0.00
							\$23.10

**UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA**

BEDFORD, FREEMAN & WORTH
PUBLISHING GROUP, LLC d/b/a
MACMILLAN LEARNING, *et al.*,

Plaintiffs,

v.

SHOPIFY INC., *et al.*,

Defendant.

Case No. 1:21-cv-01340-CMH-JFA

PLAINTIFFS' SECOND MOTION TO COMPEL

Pursuant to Federal Rule of Civil Procedure 37 and Local Rule 37, Plaintiffs hereby move to compel Defendant Shopify, Inc. to:

- (i) respond to Plaintiffs' Request for Production no. 33 by producing any digital copies of the works at issue in this suit that the merchants identified in Plaintiffs' infringement notices ("Pirate Merchants") uploaded to Shopify's platform, and produce any other digital files uploaded by the Pirate Merchants;
- (ii) respond to Plaintiffs' RFP 29 by providing records of which Shopify services each Pirate Merchant utilized and how;
- (iii) respond to Plaintiffs' Interrogatory no. 17 by stating in how many instances Shopify terminated, temporarily suspended, or took any other adverse action against a merchant for violations of Shopify's Acceptable Use Policy other than copyright or trademark infringement for each month from January 1, 2017 through March 1, 2022;

- (iv) respond to Plaintiffs' ROG 18 by stating, for each month from January 1, 2017 through March 1, 2022, the number of Shopify merchants whose services Shopify terminated for failing to pay amounts owing on the merchant's account;
- (v) respond to Plaintiffs' RFP 44 by producing all documents constituting or concerning reports, studies, research, presentations, or analysis concerning fraud or other illegal activity by Shopify merchants for the period January 1, 2017 through March 1, 2022; and
- (vi) respond to Plaintiffs' RFP 32 by producing all documents, including notes, comments, or communications, concerning Shopify's communications with any Pirate Merchant during the period January 1, 2017 through March 1, 2022 without limiting the production to documents concerning infringement.

For the reasons set forth in the accompanying Memorandum in Support, the Court should grant the Motion.

LOCAL RULE 37(E) MEET AND CONFER STATEMENT

Counsel for Plaintiffs conferred in good faith with counsel for Shopify and attempted to resolve the issues raised in this Motion. Counsel for Plaintiffs sent several emails to counsel for Shopify regarding Shopify's deficient objections and responses, including on March 18 and 21, and on April 5–8, 11, 12, 18, and 20. The parties' respective counsel held multiple telephonic meet-and-confers, including on March 23, 2022, and on April 8, 11, 13, 14, and 19, 2022, which included discussion of the issues raised in Plaintiffs' Motion. Those telephonic discussions lasted many hours. The parties resolved several discovery issues; others remain under consideration. Despite their efforts, the parties were unable to resolve all their disputes, including those raised by the

instant Motion, though Plaintiffs will continue to confer in good faith to determine whether any of the issues raised herein can be resolved without the Court's involvement.

Respectfully submitted,

Dated: April 22, 2022

/s/ Scott A. Zebrak

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**UNITED STATES DISTRICT COURT
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Case No. 1:21-cv-01340-CMH-JFA

**[PROPOSED] ORDER GRANTING PLAINTIFFS’
SECOND MOTION TO COMPEL**

Having considered Plaintiffs’ Second Motion to Compel, filed on April 22, 2022, it is hereby ORDERED that the Motion is GRANTED. Accordingly, Shopify is hereby ordered to:

- (i) respond to Plaintiffs’ Request for Production no. 33 by producing any digital copies of the works at issue in this suit that merchants identified in Plaintiffs’ infringement notices (“Pirate Merchants”) uploaded to Shopify’s platform, and produce any other digital files uploaded by the Pirate Merchants;
- (ii) respond to Plaintiffs’ RFP 29 by providing records of which Shopify services each Pirate Merchant utilized, and how;
- (iii) respond to Plaintiffs’ Interrogatory no. 17 by stating in how many instances Shopify terminated, temporarily suspended, or took any other adverse action against a merchant for violations of Shopify’s Acceptable Use Policy other than copyright or trademark infringement for each month from January 1, 2017 through March 1, 2022;

- (iv) respond to Plaintiffs' ROG 18 by stating, for each month from January 1, 2017 through March 1, 2022, the number of Shopify merchants whose services Shopify terminated for failing to pay amounts owing on the merchant's account;
- (v) respond to Plaintiffs' RFP 44 by producing all documents constituting or concerning reports, studies, research, presentations, or analysis concerning fraud or other illegal activity by Shopify merchants for the period January 1, 2017 through March 1, 2022; and
- (vi) respond to Plaintiffs' RFP 32 by producing all documents, including notes, comments, or communications, concerning Shopify's communications with any Pirate Merchant during the period January 1, 2017 through March 1, 2022 without limiting the production to documents concerning infringement.

It is so ORDERED this ____ day of _____, 2022.

John F. Anderson
United States Magistrate Judge

**UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA**

BEDFORD, FREEMAN & WORTH
PUBLISHING GROUP, LLC d/b/a
MACMILLAN LEARNING, *et al.*,

Plaintiffs,

v.

SHOPIFY INC., *et al.*,

Defendant.

Case No. 1:21-cv-01340-CMH-JFA

**MEMORANDUM IN SUPPORT OF PLAINTIFFS’
SECOND MOTION TO COMPEL**

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INTRODUCTION

Numerous merchants use defendant Shopify's ecommerce platform to sell pirated digital copies of Plaintiffs' textbooks and educational materials. Plaintiffs brought this suit against Shopify for secondary copyright and trademark infringement to hold Shopify responsible for facilitating, and profiting from, this infringement.

In the instant Motion, Plaintiffs ask this Court to compel Shopify to produce four categories of discovery: 1) copies of the infringing eBooks and other digital files the merchants identified in Plaintiffs' infringement notices uploaded to Shopify's platform; 2) records depicting how the Shopify merchants identified in Plaintiffs' infringement notices utilized Shopify's services; 3) information and documents concerning Shopify's response to other violations of its policies; and 4) Shopify's internal communications about the merchants identified in Plaintiffs' infringement notices.

These documents are important to multiple aspects of Plaintiffs' claims and Shopify's defenses, including showing that Shopify materially contributed to its merchants' direct infringement, that Shopify had the ability to supervise the infringing activity on its platform, that Shopify benefitted financially from its merchants' infringement, that Shopify acted willfully, and Shopify's contention that it is entitled to the safe harbors from monetary liability under section 512 of the Digital Millennium Copyright Act.

BACKGROUND

A. The instant suit

Shopify is an e-commerce platform that assists individual retailers to set up online stores to sell products. Compl. ¶ 29. In particular, Shopify provides services to sellers of digital copies of books. *Id.* at ¶ 34. Among many other services, Shopify can host its merchants' eBooks on

Shopify's servers, and deliver the eBook to the end customer. *Id.* at ¶¶ 2, 11(f). Unfortunately, numerous merchants use Shopify's services to sell pirated digital copies of Plaintiffs' textbooks and related pedagogical materials without authorization, thus infringing Plaintiffs' copyrights and trademarks. *Id.* at ¶ 38.

For more than four years before filing the instant suit, Plaintiffs notified Shopify of thousands of instances of infringement by merchants on its platform, including several merchants who infringed many works. *Id.* at ¶¶ 6, 57, 62. When the infringing activity nonetheless continued, Plaintiffs eventually brought the instant lawsuit in this Court, the U.S. venue in which Shopify is subject to personal jurisdiction. Shopify has challenged its susceptibility to U.S. legal process in the past, and promotes how it shields its merchants from legal action.¹ Shopify recognized it has no basis to challenge personal jurisdiction in this suit. Answer (Dkt. 30), ¶¶ 8–12. Plaintiffs allege three counts: contributory copyright infringement, vicarious copyright infringement, and contributory trademark infringement. Compl. ¶¶ 81–103.

B. State of discovery

After numerous meet-and-confer calls, Plaintiffs filed a motion to compel on April 15, 2022 raising two issues: Shopify's limiting nearly all of its discovery responses to what Shopify incorrectly called the statute of limitations period; and Shopify withholding information documenting its receipt, but refusal to take any action on (effectively ignoring), DMCA-compliant infringement notices. ECF 59. That motion is pending.

¹ See Shopify 2021 Transparency Report, <https://www.shopify.com/security/transparency-report/report-2021>.

C. The instant motion

In the instant motion Plaintiffs move to compel Shopify to produce four categories of documents.

First, with respect to the Shopify merchants identified in Plaintiffs' infringement notices ("Pirate Merchants"), Shopify must produce any digital files containing copies of Plaintiffs' works, including works in suit, that those merchants provided to Shopify. In addition, Shopify must produce copies of any other digital files that the Pirate Merchants provided to Shopify. Part I, *infra* (RFP 33).

Second, Shopify offers its merchants a menu of services that aid in the sale of infringing eBooks. Thus, Shopify must provide records sufficient to shown which services the Pirate Merchants actually utilized. Part II, *infra* (RFP 29).

Third, Shopify must produce information concerning how it has responded to other violations of its policies, including how many users it has terminated for violations of its acceptable use policy other than infringement, how many users it has terminated for failing to pay amounts owed to Shopify, and any reports or analyses in its possession concerning fraud and other illegal activity on Shopify's platform. Part III, *infra* (ROGs 17, 18; RFP 44).

Fourth, Shopify must not limit its production of communications concerning the Pirate Merchants to just those documents that Shopify believes concern infringement. Part IV, *infra* (RFP 32).

ARGUMENT

I. Shopify must produce the digital files that Pirate Merchants uploaded to Shopify's platform (RFP 33)

Plaintiffs requested all digital files that the Pirate Merchants uploaded to Shopify servers. Ex. 1, Shopify Responses and Objections to Plaintiffs' Requests for Production, Request for Production No. 33 (requesting "All information or digital files provided to You by or on behalf of any Accused Shopify Merchant, including, without limitation...the digital copies of books they uploaded for sale."). Shopify refuses to provide these files. *Id.* at Response to Request for Production No. 33 ("Shopify will not produce copies of any digital files or digital copies of books that any Accused Shopify Merchant uploaded for sale or otherwise provided to Shopify."). Shopify likewise has refused to inform Plaintiffs whether the Pirate Merchants provided Shopify with digital files at all, or whether Shopify still possesses any such files.

Shopify instead agreed to provide only two things. First, Shopify will provide an inventory list of items that each Pirate Merchant was selling via Shopify. *Id.*, Response to RFP 33. Second, Shopify will indicate whether each Pirate Merchant downloaded Shopify's Digital Downloads application. Ex. 2, Email Chain between Latham and O+Z, p. 5 ¶ B. Shopify's counsel represented that to the extent merchants uploaded files to Shopify, they would have done so only through the Digital Downloads app. But, according to Shopify's counsel, the information Shopify is providing will not indicate whether each merchant actually *used* the app to upload digital copies of works to Shopify. *Id.* In other words, Shopify has refused to produce the digital files themselves, and has refused to provide information as to whether each of the merchants uploaded digital files to Shopify.

Other courts have recognized the importance of digital files in copyright infringement cases, and ordered it produced. In *Viacom Int'l Inc. v. YouTube Inc.*, 253 F.R.D. 256, 261 (S.D.N.Y. 2008), the court ordered the defendants to produce “millions” of videos that were removed from YouTube “for any reason” so that plaintiffs could “identify which (if any) infringe their alleged copyrights”. Plaintiffs here have made a much narrower request—that Shopify produce the digital files uploaded by the Pirate Merchants. *See also Arista Recs. LLC v. Usenet.com, Inc.*, 608 F. Supp. 2d 409, 433 (S.D.N.Y. 2009) (“Defendants did have an obligation to preserve and produce the requested...Digital Music Files” that were alleged to be infringing).

Likewise, Shopify must produce 1) all digital copies of Plaintiffs’ copyrighted works, including the works in this suit, that the Pirate Merchants uploaded to Shopify servers; and 2) all copies of other works that those merchants uploaded to Shopify servers.²

a. Shopify must produce the digital copies of Plaintiffs’ works, including works in suit, that the Pirate Merchants provided to Shopify

The digital files Plaintiffs request are important for multiple reasons. In particular, the digital copies of the works in question are highly probative to the issue of contributory infringement. “A contributory infringer is one who, (1) with knowledge of the infringing activity, (2) induces, causes or materially contributes to the infringing conduct of another.” *Sony Music Ent. v. Cox Commc’ns, Inc.*, 464 F. Supp. 3d 795, 815 (E.D. Va. 2020) (internal quotations and alterations omitted). That Shopify stored digital copies of infringing eBooks and provided those files to end purchasers shows that Shopify materially contributed to the infringing conduct of its merchants. Likewise, the digital copies themselves are relevant to Shopify’s knowledge, as the

² If helpful to Shopify, Plaintiffs can limit this request to eBooks only.

files no doubt contain copyright and trademark notices that were accessible to Shopify. And, naturally, the digital files serve as additional proof of the Pirate Merchants' direct infringement.

Further, the digital files are highly probative on the first element of Plaintiffs' vicarious infringement claim. "Vicarious liability holds a defendant accountable for third-party infringement if he (1) possessed the right and ability to supervise the infringing activity; and (2) possessed an obvious and direct financial interest in the exploited copyrighted materials." *Sony Music Ent.*, 464 F. Supp. 3d at 813 (internal quotations and alterations omitted). That Shopify stored infringing files for its merchants, for Shopify's fulfillment to the merchant's customers, shows that Shopify had the ability to supervise its merchants' infringement. Shopify must produce these files.

b. Shopify must produce copies of other works the Pirate Merchants uploaded to Shopify

Shopify also must produce all digital files it has of other works that Pirate Merchants uploaded to Shopify. A review of the Pirate Merchants' other infringing files will provide support for the proposition that the Pirate Merchant's inventory was largely or entirely pirated items and, thus, make Shopify's decision not to terminate their accounts, or otherwise stop their infringement, that much more unreasonable. In addition, Shopify has indicated that it intends to argue that at least some of the merchants in question were not "pure" pirate merchants, but in fact were selling a mix of infringing and non-infringing content. Plaintiffs must have sufficient information to test, and rebut, this argument. In hopes of reducing the necessary discovery, Plaintiffs asked Shopify simply to stipulate that they would not offer such an argument in this case. But Shopify declined to do so.

Shopify must produce these digital files as well.

c. The Fourth Circuit has rejected Shopify's argument for not providing the digital files

During meet-and-confers on this issue, Shopify's counsel stated that it could not provide to Plaintiffs digital files of copyrighted works because doing so could violate the rights of other copyright holders. Caselaw squarely refutes this contention. The Fourth Circuit has held that the use of a copyrighted work in litigation can qualify for the fair use exception to copyright infringement, and that "the societal benefit of having all relevant information presented in a judicial proceeding" outweighs the author's rights with respect to his work. *Bond v. Blum*, 317 F.3d 385, 396 (4th Cir. 2003), *abrogated on other grounds, Kirtsaeng v. John Wiley & Sons, Inc.*, 579 U.S. 197 (2016). Other courts have reached the same conclusion. *See, e.g., Jartech, Inc. v. Clancy*, 666 F.2d 403, 407 (9th Cir. 1982) (upholding a finding that reproducing a copyrighted work for use as evidence in a nuisance abatement action constituted fair use); *Stern v. Does*, 978 F. Supp. 2d 1031, 1047 (C.D. Cal. 2011) ("Reproduction of copyrighted material for use in litigation or potential litigation is generally fair use, even if the material is copied in whole.").

d. Shopify's insistence on delay serves no purpose and is infeasible

Rather than produce these files before the May 2 document discovery deadline, Shopify believes that Plaintiffs should wait until Shopify produces the inventory lists and, afterwards, request specific files for specific Pirate Merchants. Such a delay is unreasonable. There is no purpose to waiting; Shopify will need to produce digital files for all of the titles appearing on the inventory list. Nothing about the inventory list would obviate the need for a full and proper production. Moreover, given the fast-approaching deadline that the parties are obligated to meet in this case, Shopify's desired delay is infeasible.

II. Shopify must provide records of which Shopify services the Pirate Merchants utilized, and how (RFP 29)

Plaintiffs requested “[d]ocuments sufficient to identify Shopify’s provision of products or services to any Accused Shopify Merchant and the extent of the Accused Shopify Merchant’s utilization of those products and services.” Ex. 1, RFP 29. Shopify has agreed to identify the Shopify service plan in which each Pirate Merchant was enrolled, and to list the products and services available under that plan. *Id.*, Response to RFP 29. Shopify further stated that “Shopify is also producing a number of details regarding each Accused Merchant’s utilization of its platform, such as information related to orders, products, and Shopify Payments.” Ex. 2, p. 5 ¶ C. But Shopify has declined to explain which Pirate Merchants actually used which services, and how. Shopify must provide this information.

Shopify offers numerous services that aid in the sale of infringing eBooks. For example, Shopify’s Digital Downloads app helps merchants sell digital products. A merchant can upload its digital file to Shopify,³ then a customer can download the file upon purchase.⁴ Shopify’s Inbox app allows merchants to communicate directly with end customers.⁵ Shopify’s Vitals app provides marketing services like discount offers, tiered pricing, reviews consolidation, and related product suggestions.⁶ Shopify’s Google channel helps users make their products appear in Google search results, create Google ad campaigns, list their products on Google Shopping, and process orders using Buy on Google.⁷ And Shopify’s Facebook channel allows users to sell their products through

³ <https://help.shopify.com/en/manual/products/digital-service-product/digital-downloads>

⁴ <https://apps.shopify.com/digital-downloads>.

⁵ https://apps.shopify.com/inbox?surface_inter_position=1&surface_intra_position=16&surface_type=category

⁶ https://apps.shopify.com/vitals?surface_inter_position=1&surface_intra_position=4&surface_type=category

⁷ <https://apps.shopify.com/google>

Facebook and Instagram.⁸ A merchant's use of these Shopify services, among others, would help show that Shopify materially contributed to that merchant's direct infringement.

Furthermore, to the extent Shopify was being paid for these services, those payments are relevant to the financial benefit prong of vicarious liability, *i.e.*, whether Shopify possessed an obvious and direct financial interest in the infringing materials. *Sony Music Ent.*, 464 F. Supp. 3d at 813. For example, the Vitals app is a paid service.⁹ And Shopify notes that it can be paid by Google when Shopify merchants use Shopify's Google channel.¹⁰ That compensation is highly relevant to the financial benefit prong of vicarious infringement.

Shopify's counsel has indicated that it "cannot ascertain what products or services individual merchants used", Ex. 2, p.5 ¶ C, but that does not seem possible. Usage data is critical to the operations of technology companies like Shopify; it is implausible that Shopify did not track usage in some form.

III. Shopify must produce information concerning how it has responded to other violations of its policies (ROGs 17, 18; RFP 44)

Plaintiffs asked for three forms of discovery concerning Shopify's response to violations of its policies outside of the infringement context. Plaintiffs asked Shopify to state in how many instances Shopify terminated a user for violations other than copyright or trademark infringement (ROG 17) and in how many instances Shopify terminated a user for failing to pay amounts owed to Shopify (ROG 18). Ex. 3, Shopify's Responses to Plaintiffs' First Set of Interrogatories, Interrogatory Nos. 17, 18. Shopify refused to respond to either of these interrogatories. *Id.* at

⁸ https://apps.shopify.com/facebook?surface_inter_position=1&surface_intra_position=8&surface_type=category

⁹ https://apps.shopify.com/vitals?surface_inter_position=1&surface_intra_position=4&surface_type=category

¹⁰ <https://apps.shopify.com/google>

Response Nos. 17, 18. Plaintiffs likewise requested “[a]ll documents constituting or concerning reports, studies, research, presentations, or analysis concerning fraud or other illegal activity by Shopify Merchants.” Ex. 1, RFP 44. By its terms, this request is limited to reports that are *already compiled*, and their related existing documents. In other words, Plaintiffs are not asking Shopify to create these reports, only to turn over any reports that have already been generated. Shopify, however, stated it would only produce documents concerning copyright or trademark infringement. Ex. 1, Response to RFP 44.

This discovery is important to Plaintiffs’ claims and to Shopify’s defenses. Documents showing that Shopify has terminated users for other offenses show that Shopify had the right and ability to supervise or control infringing activity (the second prong of vicarious liability, *Sony Music Ent.*, 464 F. Supp. 3d at 813). Other courts considering whether a defendant had such an ability to supervise have looked to whether the defendant could and did penalize violators of the defendant’s other policies. *Usenet*, 633 F. Supp. 2d at 157 (court relied on the fact that defendant had terminated or limited the access of users who posted “spam” or who downloaded a disproportionate volume of content); *Arista Records, Inc. v. MP3Board, Inc.*, No. 00 CIV. 4660, 2002 WL 1997918, at *11 (S.D.N.Y. Aug. 29, 2002) (court relied on fact that defendant had terminated users for posting links to pornography, hate, and illegally copied commercial software).

This discovery is also relevant to willfulness, a key consideration in statutory damages, 17 U.S.C. § 504(c)(1)–(2). Evidence that Shopify terminated subscribers for other offenses, but chose not to do so for infringement, helps to show that Shopify acted willfully.

Moreover, to the extent that Shopify argues it is reluctant to terminate merchants because termination is an extreme remedy (for example, because merchants rely on their Shopify stores to earn income), Plaintiffs must have access to the evidence that would support or contradict that

argument. In *Sony v. Cox*, for example, this Court ordered Cox to state how many subscribers it terminated for violating Cox's Acceptable Use Policy for reasons other than infringement, and it required Cox to state how many users it terminated for failing to pay amounts owed to Cox. *Sony Music Ent. v. Cox Commc'ns, Inc.*, 18-cv-00950, Dkt. 93 at 9–10 (E.D. Va. Feb. 1, 2019) (Ex. 4). When Cox argued at trial that it was reluctant to terminate customers because of the vital role its services play in its customers' lives, the Court allowed the plaintiffs to present the evidence of termination for non-payment. *Sony Music Ent.*, 18-cv-00950, Dkt. 626 (E.D. Va. Dec. 3, 2019) (Ex. 5).

On top of the foregoing, public reports indicate that Shopify's platform is rife with illegal activity. One report found that 21% of Shopify stores are fraudulent in some way, such as selling counterfeit or infringing products or simply not delivering products.¹¹ To the extent that Shopify seeks to present the infringing activity alleged in this suit as a small problem that is inconsistent with the larger activity on its platform, Plaintiffs must be able to rebut that argument.

The volume of information and documents sought here is minimal. Shopify should not be allowed to withhold this important evidence.

IV. Shopify must produce all communications concerning the Pirate Merchants, not merely those that Shopify believes concern infringement (RFP 32)

Plaintiffs requested “[a]ll documents, including notes, comments, or communications, concerning Shopify's communications with any Accused Shopify Merchant.” Ex. 1, RFP 32. Shopify has limited its response to communications concerning infringement. Ex. 2, p. 5 ¶ A

¹¹ John Koetsier, FORBES, *Analysis Of 124,044 Shopify Stores Says 25,788 Are Fraudulent Or Dangerous* (Jan. 18, 2021), <https://www.forbes.com/sites/johnkoetsier/2021/01/18/analysis-of-124044-shopify-stores-says-25788-are-fraudulent-or-dangerous/?sh=78deb2a13cd5>

(stating that Shopify will produce “all communications about any Accused Merchant related to infringement” but that “Shopify will not...produce communications *about* Accused Merchants related to fraud or other illegal activities that do not include copyright or trademark infringement.”). Nor has Shopify agreed to search for the term “eBook” in response to this request. All of these communications are relevant.

There is no justification for limiting communications about the Pirate Merchants to communications concerning copyright or trademark infringement. Communications with the Pirate Merchants likely will show Shopify materially contributing to the Pirate Merchants’ infringement, even if the communication does not explicitly concern infringement. For example, Shopify’s customer service team may have helped a merchant set up an ad campaign for eBooks. Or a technical support team may have helped a merchant store an eBook on Shopify’s servers, or deliver eBooks to an end purchaser. Any such communications would be evidence of Shopify materially contributing to a merchant’s direct infringement, whether they use the term “infringement” or not.

Likewise, communications about nefarious activities besides infringement, such as illegal activity or violations of Shopify’s other policies, are relevant to Shopify’s knowledge and willfulness. A failure to terminate a repeat infringer is all the more knowing and willful if Shopify knew that the merchant was engaged in other forbidden activity.

What’s more, Shopify declined to search its communications for terms like “fraud”, “illegal activity”, or “AUP violations”. Ex. 2, p. 1 ¶ 3 and p. 3 ¶ 3. Of course, communications about infringement may not use the literal word “infringement”, but might instead contain more generic terminology. So, even if Shopify were correct that it should search only for communications concerning infringement, these terms would need to be included in a reasonable search. Shopify

claims, “It is our understanding based on a reasonable investigation that, in every instance, Shopify personnel have referred to alleged infringement as ‘infringement’ and not some other generic term like ‘fraud’.” Ex. 2, p. 1 ¶ 3. Shopify has not found infringement-related communications that use those terms because Shopify has refused to search for those terms. Such a refusal is unreasonable. All these communications should be produced.

CONCLUSION

Plaintiffs respectfully request that the Court order Shopify to produce: 1) copies of the infringing eBooks and other digital files sold through Shopify’s platform by Pirate Merchants; 2) records depicting how the Pirate Merchants utilized Shopify’s services and how; 3) information and documents concerning Shopify’s response to other violations of its policies; and 4) Shopify’s internal communications about the Pirate Merchants.

Dated April 22, 2022

Respectfully Submitted,

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Plaintiffs' Exhibit 1

**UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
ALEXANDRIA DIVISION**

BEDFORD, FREEMAN & WORTH
PUBLISHING GROUP, LLC d/b/a
MACMILLAN LEARNING;
MACMILLAN HOLDINGS, LLC;
CENGAGE LEARNING, INC.;
ELSEVIER INC.; ELSEVIER B.V.;
MCGRAW HILL LLC; and PEARSON
EDUCATION, INC.,

Plaintiffs,

v.

SHOPIFY INC.,

Defendant.

Case No. 1:21-cv-01340

**SHOPIFY INC.’S RESPONSES AND OBJECTIONS TO PLAINTIFFS’ FIRST SET OF
REQUESTS FOR PRODUCTION OF DOCUMENTS AND THINGS TO DEFENDANT
SHOPIFY INC.**

Shopify Inc. (“Shopify”), pursuant to Rules 26 and 34 of the Federal Rules of Civil Procedure and the Local Rules of this Court, by and through its undersigned counsel, hereby provides these responses to Bedford, Freeman & Worth Publishing Group, LLC d/b/a Macmillan Learning, Macmillan Holdings, LLC, Cengage Learning, Inc., Elsevier Inc., Elsevier B.V., McGraw Hill LLC, and Pearson Education, Inc.’s (collectively, “Plaintiffs”) First Set of Requests for Production of Documents and Things (“Requests”) as follows:

PRELIMINARY STATEMENT

Shopify has and will continue to attempt in good faith to search for and provide documents responsive to the appropriate requests herein to the extent reasonably practicable at this stage of

these proceedings, based on information now known, as well as Shopify's present analysis of the case. Shopify has not completed its discovery and investigation in this action, and has not completed its preparation for trial. As a result, the documents produced in response to these requests, while based on diligent factual exploration, reflect only Shopify's current state of knowledge, understanding, and belief with regard to the matters about which requests have been made. Shopify's responses are given without prejudice to its right to amend or supplement its production after considering information obtained or reviewed through further discovery and investigation.

By responding to the requests herein, Shopify agrees to produce the responsive, relevant, non-privileged documents Shopify is able to locate after a reasonable search without undue burden or expense, but only to the extent (if any) indicated in the response to the particular Request. Shopify's responses and objections, including any agreement to produce responsive documents, should not be construed as confirming that any such responsive documents in fact exist.

Shopify will not produce any documents that are protected by the attorney-client privilege, common interest privilege, work-product doctrine, or any other applicable common law or statutory privilege, exemption, law, rule, or protection. To the extent any Request may be construed as calling for disclosure of information, documents, and/or things protected by any applicable privileges or doctrines ("Privileged Information"), nothing in Shopify's responses is intended to waive such privileges and Shopify's responses should not be construed as such a waiver. Shopify will produce responsive documents, to the extent any exist, which it believes are non-privileged and are otherwise properly discoverable. Shopify makes its production of documents on the condition that an inadvertent production of documents covered by such privileges or doctrines does not waive any of its rights to assert such privileges or doctrines and

that it may withdraw from production any such document inadvertently produced.

Shopify is producing documents without prejudice to Shopify's right to procure, rely on, and introduce expert witness testimony, and such expert's right to rely on documents or information deemed appropriate by that expert in formulating the expert's opinion, whether or not produced in response to these requests. Shopify's responses to these Requests, and any corresponding productions, do not constitute either an admission that any definitions provided by Plaintiffs are factually correct or legally binding upon Shopify, or a waiver of any of Shopify's objections, including but not limited to objections regarding discoverability of documents or other evidence.

Notwithstanding responses to these requests or the production of any information, documents, or things in response to a Request, Shopify expressly reserves all objections as to authenticity, relevance, materiality, and admissibility of any such information, documents, or things.

Shopify previously served general and specific objections to Plaintiffs' Interrogatories on March 16, 2022. Shopify incorporates its general objections and specific objections herein, in italicized text, for ease of reference.

GENERAL OBJECTIONS

1. *Shopify objects to the Requests, and all Instructions and Definitions thereto, to the extent that they purport to impose any requirement or discovery obligation greater than or different from those under the Federal Rules of Civil Procedure and the applicable Rules and Orders of the Court.*

2. *Shopify objects to the Requests to the extent that they seek information that is not relevant to the claims or defenses of any party in this proceeding, or are not reasonably calculated to lead to the discovery of information relevant to the claims or defenses of any party in this*

proceeding.

3. *Shopify objects to the Requests to the extent they seek documents or information beyond the possession, custody, or control of Shopify or would require Shopify to spend an unreasonable amount of time, effort, and resources in order to respond.*

4. *Shopify objects to the Requests to the extent they request “all” or “any” documents or impose similar obligations on Shopify. Subject to its objections, Shopify will make reasonable efforts to search for relevant information from those individuals employed by or on behalf of Shopify whom Shopify reasonably believes are likely to have responsive information associated with this proceeding, but each and every employee has not been, and could not be, contacted and questioned, nor their documents searched, for information that would assist in answering the Requests.*

5. *Shopify objects to the Requests to the extent they call for information the discovery of which is cumulative or duplicative.*

6. *Shopify objects to the Requests to the extent they are vague and/or ambiguous.*

7. *Shopify objects to the Requests to the extent they call for the disclosure of information or materials protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections. Shopify will exclude from its responses all information or materials protected by any applicable privilege or doctrine.*

8. *Shopify objects to the Requests to the extent that they seek the disclosure of information or documents that are controlled by or subject to an obligation of confidentiality owed by Shopify to any third party.*

9. *Shopify objects to the Requests, and all Instructions and Definitions thereto, to the extent they request information and documents that are a matter of public record, in the possession*

of a third party, in the possession of the Plaintiffs, or otherwise available to the Plaintiffs through a source other than Shopify.

10. *Shopify objects to the Requests, and all Instructions and Definitions thereto, to the extent they incorporate, contain characterizations of, or call for legal conclusions. A response to a Request or use of a defined term therein does not mean Shopify agrees with the definition of any defined term or any characterizations or legal conclusions contained therein.*

11. *Shopify objects to the Instructions and Definitions to the extent they seek to impose obligations beyond those set forth in applicable law, including but not limited to the Federal Rules of Civil Procedure and the applicable Rules and Orders of the Court.*

12. *Shopify objects to the Requests, and all Instructions and Definitions thereto, to the extent they call for the creation of new or voluminous documents, reports, spreadsheets, analyses, or data compilations that do not currently exist in the ordinary course of Shopify's business.*

13. *Any statement below that responsive documents will be produced does not constitute a representation or acknowledgment by Shopify that any such documents in fact exist or are in Shopify's possession, custody, or control, but is intended to convey that, if such documents exist and can be located after a reasonable search and inquiry of documents in Shopify's possession, custody, or control, they will be produced subject to any applicable objections.*

14. *Shopify anticipates the participants will agree to a common protocol for all productions of Electronically Stored Information ("ESI") in this proceeding. Shopify objects to the production of any ESI until a final ESI protocol is agreed upon.*

15. *No response or objection to any Request is intended to be, nor shall any response be construed as, an admission of the existence of any facts set forth in or assumed by any Request, or an admission that such response or objection constitutes admissible evidence. Likewise, the*

production of any documents in response to the Requests is not intended to be, and shall not be construed as, a waiver by Shopify of all or any part of any objection to any Request, an admission of the existence of any facts set forth in or assumed by any Request or any document produced in response thereto, or an admission that such response, objection, or document constitutes admissible evidence.

16. *Shopify objects to the definition of “you,” “your,” “Shopify,” or “Defendant” to the extent that they purport to impose duties beyond those imposed by the Federal Rules of Civil Procedure and the applicable Local Rules of the Court. Shopify further objects to these definitions as overbroad, unduly burdensome, and not proportional to the needs of this case to the extent they purport to include entities other than Shopify. Shopify objects to these definitions to the extent they purport to include within their scope any “attorneys” for Shopify. For purposes of its responses, Shopify will construe “you,” “your,” “Shopify,” or “Defendant” to mean only Shopify Inc., and not any “parents, subsidiaries, affiliates . . . and/or any other person or entity currently or previously acting or purporting to act on its behalf” or any attorneys not employed by Shopify Inc. acting on its behalf.*

17. *Shopify objects to the definition of “Shopify Merchant” as overbroad, unduly burdensome, and not proportional to the needs of the case to the extent it includes all of Shopify’s over two million merchants, the majority of which have no relevance to Plaintiffs’ claims whatsoever.*

18. *Shopify objects to the definition of “Plaintiffs’ Copyrighted Work” as overbroad, unduly burdensome, and not proportional to the needs of the case to the extent it refers to “any future additions or revisions to Exhibit A.”*

19. *Shopify objects to the definition of “Plaintiffs’ Mark” as overbroad, unduly*

burdensome, and not proportional to the needs of the case to the extent it refers to “any future additions or revisions to Exhibit B.”

20. *Shopify objects to the definition of “Infringement Notices” as overbroad, unduly burdensome, and not proportional to the needs of the case to the extent it calls for communications not sent by Plaintiffs and not related to Plaintiffs’ claims. Shopify further objects to this definition as it includes characterizations of, and legal conclusions regarding infringement of a copyright or a trademark and notifications pursuant to 17 U.S.C. § 512. Shopify further objects to the terms “processed” and “retained,” as referenced in the definition, as vague and/or ambiguous because they could have multiple meanings in this context.*

21. *Shopify objects to the definitions of “DMCA Policy” to the extent it includes characterizations of, and legal conclusions regarding any obligations, duties, and requirements under the Digital Millennium Copyright Act, and Shopify’s compliance with such obligations, duties, and requirements.*

22. *Shopify objects to the definition of “Repeat Infringer Policy” to the extent it includes characterizations of, and legal conclusions regarding copyright infringement, any obligations, duties, and requirements under the Digital Millennium Copyright Act, and Shopify’s compliance with such obligations, duties, and requirements. Shopify further objects to the term “address,” as referenced in the definition, as vague and/or ambiguous because it could have multiple meanings in this context.*

23. *Shopify objects to the definition of “Acceptable Use Policy” to the extent it mischaracterizes or is inconsistent with Shopify’s actual policy.*

24. *Shopify objects to the definition of “Accused Shopify Merchant” to the extent it incorporates the previously objected definition of “Plaintiff Infringement Notice.”*

25. *Shopify objects to the instruction that “[u]nless otherwise specified, the relevant time frame for these Requests is January 1, 2017 through the present” as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.*

26. *Shopify reserves the right to modify, supplement, or amend any or all of these responses, if necessary or appropriate, and to produce additional non-privileged, responsive documents if any are located.*

RESPONSES TO PLAINTIFFS’ REQUESTS FOR PRODUCTION

REQUEST FOR PRODUCTION NO. 1:

Documents sufficient to show Your formation and status as a legal entity, the identity of each of Your affiliates, and the nature and scope of Your relationship with Shopify Payments (USA) Inc.

RESPONSE TO REQUEST FOR PRODUCTION NO. 1:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request to the extent that it seeks documents protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections. Shopify further objects to this Request to the extent it seeks “[d]ocuments sufficient to show [Shopify’s] formation and status as a legal entity” and “the identity of each of [Shopify’s] affiliates” because such information is public or readily available to Plaintiffs. Shopify further objects to the Request because documents concerning “[Shopify’s] formation and status as a legal entity, the identity of each of [Shopify’s] affiliates, and the nature and scope of [Shopify’s] relationship with Shopify Payments (USA) Inc.” are not relevant to the claims or defenses of any party in this proceeding because Shopify’s status as a legal entity is not in question and none of Shopify’s affiliates are a

named party in this proceeding. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify will produce relevant, non-privileged documents sufficient to identify Shopify's formation and status as a legal entity, the identity of Shopify's principal affiliates, and the nature and scope of Shopify's relationship with Shopify Payments.

REQUEST FOR PRODUCTION NO. 2:

Organizational charts or other documents sufficient to show Your organizational structure for persons involved in receiving or addressing Infringement Notices, user terms of service, Acceptable Use Policies, privacy policies, eBook seller sites, promoting and creating eBook seller sites, the Digital Downloads app, the Digital Downloads by Uplinkly app, and finances, including the identity and title of each job occupant.

RESPONSE TO REQUEST FOR PRODUCTION NO. 2:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request to the extent that it seeks documents protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections. Shopify further objects to the Request as overbroad, overly burdensome, and not proportional to the needs of the case to the extent it purports to require Shopify to compile information in a manner that is not maintained in the ordinary course of business, and thus imposes burdens beyond the scope required by Rules 26 and 34 of the Federal Rules of Civil Procedure. Shopify further objects to

the term “promoting,” as referenced in this Request, as vague and/or ambiguous because it could have multiple meanings in this context. Shopify further objects to this Request as overbroad, unduly burdensome, and not proportional to the needs of the case to the extent it requires Shopify to compile information from third parties. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify will produce relevant, non-privileged organizational charts sufficient to show the organizational structure for persons in Trust & Safety (responsible for receiving or addressing Infringement Notices, user terms of service, Acceptable Use Policies, and privacy policies), Finance (responsible for finances), and SFN Engineering, Transportation Services (responsible for supporting the Digital Downloads app). Shopify does not have any persons whose job responsibilities specifically include eBook seller sites or promoting and creating eBook seller sites. It is the entire mission of Shopify to support seller sites. Accordingly, there is no specific person responsible for supporting seller sites. The Digital Downloads by Uplinkly is a third party product.

REQUEST FOR PRODUCTION NO. 3:

Documents sufficient to show, on a monthly, quarterly, and yearly basis, the number of Infringement Notices You received concerning copyright or trademark infringement by Shopify Merchants.

RESPONSE TO REQUEST FOR PRODUCTION NO. 3:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further

objects to this Request to the extent that it seeks documents protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections. Shopify further objects to the Request as overbroad, overly burdensome, and not proportional to the needs of the case to the extent it purports to require Shopify to compile information in a manner that is not maintained in the ordinary course of business, and thus imposes burdens beyond the scope required by Rules 26 and 34 of the Federal Rules of Civil Procedure. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify states that as part of its standard business practices, it tracks Infringement Notices through a ticketing system rather than by notice. For all Infringement Notices it receives, Shopify creates tickets in its ticketing system. In response to this Request, Shopify will produce relevant, non-privileged information sufficient to show the number of tickets created from all Infringement Notices that Shopify received concerning alleged copyright or trademark infringement by Shopify Merchants as the records are kept in the ordinary course of business from December 1, 2018 through March 1, 2022.

REQUEST FOR PRODUCTION NO. 4:

Documents sufficient to show, on a monthly, quarterly, and yearly basis, the number of instances in which You warned, suspended, terminated, or otherwise took adverse action against the account of a Shopify Merchant based on that Shopify Merchant's copyright or trademark infringement.

RESPONSE TO REQUEST FOR PRODUCTION NO. 4:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request to the extent that it seeks documents protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections. Shopify further objects to the Request as overbroad, overly burdensome, and not proportional to the needs of the case to the extent it purports to require Shopify to compile information in a manner that is not maintained in the ordinary course of business, and thus imposes burdens beyond the scope required by Rules 26 and 34 of the Federal Rules of Civil Procedure. Shopify further objects to the phrase “otherwise took adverse action,” as referenced in this Request, as vague and/or ambiguous because it could have multiple meanings in this context. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify will produce relevant, non-privileged information sufficient to show the number of instances in which Shopify terminated the account of a Shopify Merchant based on that Shopify Merchant’s alleged copyright or trademark infringement as the records are kept in the ordinary course of business, for the period of December 1, 2018 through March 1, 2022. Shopify does not otherwise compile information in the manner requested in this Request in the ordinary course of business, and thus this Request imposes burdens beyond the scope required by Rules 26 and 34 of the Federal Rules of Civil Procedure.

REQUEST FOR PRODUCTION NO. 5:

All documents and communications discussing or considering what actions to take in

response to Infringement Notices, including whether to terminate, suspend, or take other adverse action against a Shopify Merchant's account for copyright or trademark infringement, or for violating Your policies regarding copyright or trademark infringement. This includes documents and communications discussing the payment history of, service level of, or future revenue from a Shopify Merchant in connection with potential termination, suspension, or other adverse action.

RESPONSE TO REQUEST FOR PRODUCTION NO. 5:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request to the extent that it seeks documents protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections, including but not limited to privileged documents regarding whether to terminate, suspend, or take other adverse action against a Shopify Merchant's account that were made in connection with the advice of counsel. Shopify further objects to the phrase "otherwise took adverse action," as referenced in this Request, as vague and/or ambiguous because it could have multiple meanings in this context. Shopify further objects to the term "Infringement Notices," as referenced in this Request, as overbroad, unduly burdensome, and not proportional to the needs of the case: given the scope and burden implicated by this request, Shopify will limit its response to the "Infringement Notices" at issue in connection with Plaintiffs' claims of infringement. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify will produce relevant, non-privileged documents and communications discussing or considering what actions to take in

response to Infringement Notices associated with the Accused Shopify Merchants, for the period of December 1, 2018 through March 1, 2022, to the extent such documents exist in Shopify's possession, custody, or control and can be located after a reasonable search. For the reasons stated in its objections, Shopify will not produce documents or communications related to Shopify Merchants that are not Accused Shopify Merchants in response to this Request.

REQUEST FOR PRODUCTION NO. 6:

All documents and communications concerning Your strategies, approaches, policies, or procedures concerning copyright or trademark infringement by Shopify Merchants, including all versions and drafts of Your Repeat Infringer Policy.

RESPONSE TO REQUEST FOR PRODUCTION NO. 6:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request the extent that it seeks documents protected by the attorney-client privilege, attorney work product doctrine, or any other applicable privilege, including but not limited to any privileged drafts of strategies, approaches, policies, procedures, or communications. Shopify further objects to this Request to the extent it seeks public information or information that is readily available to Plaintiffs. Shopify further objects to this Request as overbroad, unduly burdensome, and not proportional to the needs of the case to the extent it calls for "all documents and communications," as opposed to documents sufficient to show Shopify's strategies, approaches, policies, or procedures during the limitations period. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of

fulfilling its discovery obligations in the current proceeding, Shopify will produce relevant, non-privileged documents sufficient to show Shopify's strategies, approaches, policies, or procedures concerning alleged copyright or trademark infringement by Shopify Merchants for the period of December 1, 2018 through March 1, 2022. For the reasons stated in its objections, Shopify will not produce drafts of Shopify's strategies, approaches, policies, or procedures concerning alleged copyright or trademark infringement that were not adopted.

REQUEST FOR PRODUCTION NO. 7:

All documents and communications concerning implementation or analysis of Your strategies, approaches, policies, or procedures concerning copyright or trademark infringement by Shopify Merchants.

RESPONSE TO REQUEST FOR PRODUCTION NO. 7:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request to the extent that it seeks documents protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections, including but not limited to privileged documents containing strategies, approaches, policies, and procedures concerning copyright or trademark infringement made in connection with advice of counsel. Shopify further objects to this Request as overbroad, unduly burdensome, and not proportional to the needs of the case to the extent it calls for "all documents and communications," as opposed to documents sufficient to show the relevant strategies, approaches, policies or procedures. Shopify further objects to the term "implementation," as referenced in this Request, as vague and/or ambiguous because it could have multiple meanings in this context. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through

December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify will produce relevant, non-privileged documents sufficient to show Shopify’s strategies, approaches, policies, or procedures concerning alleged copyright or trademark infringement by Shopify Merchants, as were put in force by Shopify, and will produce non-privileged documents and communications analyzing those strategies, approaches, policies, or procedures, for the period of December 1, 2018 through March 1, 2022, to the extent such documents exist in Shopify’s possession, custody, or control and can be located after a reasonable search.

REQUEST FOR PRODUCTION NO. 8:

All documents and communications concerning Your policies—whether directed to Shopify’s employees or its customers—relating to copyright or trademark infringement by Shopify Merchants, including any policies discussing a graduated response program for copyright or trademark infringement.

RESPONSE TO REQUEST FOR PRODUCTION NO. 8:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request to the extent that it seeks documents protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections. Shopify further objects to this Request to the extent it seeks public information or information that is readily available to Plaintiffs. Shopify further objects to this Request as overbroad, unduly burdensome, and not proportional to the needs of the case to the extent it calls for “all documents and communications,” as opposed to documents sufficient to show Shopify’s policies. Shopify further objects to this Request as vague and/or ambiguous to extent it seeks “any policies discussing a

graduated response program for alleged copyright or trademark infringement” because no program with that name exists and the term “graduated response program” could have multiple meanings in this context. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify will produce relevant, non-privileged documents sufficient to show (1) Shopify’s policies relating to alleged copyright or trademark infringement by Shopify Merchants, and (2) communication(s) relaying these policies to Shopify employees and customers, for the period of December 1, 2018 through March 1, 2022.

REQUEST FOR PRODUCTION NO. 9:

All documents and communications supporting the allegations and affirmative defenses in Your Answer to the Complaint filed on January 28, 2022, including but not limited to all documents and communications concerning the following statements on pages 2 through 6 of Your Answer, whether supportive of or contrary to:

The truth is that Shopify has promptly and appropriately responded to the notices of claimed infringement these textbook publishers have sent. It has appropriately responded to court orders and requests for information consistent with its legal obligations as an international company with customers in multiple jurisdictions. See Guidelines for Legal Requests for Information, <https://www.shopify.com/legal/gvtaccesspolicy> (last updated Dec. 8, 2021). And Shopify has aggressively enforced its policy of terminating Merchants who are the subject of repeat infringement notices. Indeed, less than 2 percent of the Shopify Merchants who have been targeted with Plaintiffs’ takedown notices remain active on the platform today, amounting to less than 0.01 percent of all Shopify Merchants.

...

While Shopify does not control its Merchants’ products or their business

decisions, Shopify is committed to respecting intellectual property rights, and vigorously enforces its policies accordingly. . . .

Shopify employs robust procedures for taking down copyright-infringing content in accordance with the DMCA, 17 U.S.C. § 512(c). . . . Promptly upon receiving a complete DMCA Takedown Notice (that is, one that contains all information required by the DMCA), Shopify removes or disables access to the content or materials claimed to be infringing. . . . Shopify does the same thing upon receiving a complete Trademark Infringement Notice. . . .

Furthermore, Shopify rigorously implements its repeat infringer policy by disabling and/or terminating the accounts of Merchants who have been repeatedly accused of offering copyright-infringing products for sale, in accordance with Section 512(i)(1)(a) of the DMCA. And Shopify does the same for Merchants who have been accused of trademark infringement.

. . . Consistent with its policies, Shopify promptly and appropriately responds to the notices it receives, disabling infringing content, and removing repeat infringers from its platform, as the circumstances require.

RESPONSE TO REQUEST FOR PRODUCTION NO. 9:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request to the extent that it seeks documents protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections. Shopify further objects to this Request to the extent it seeks public information or information that is readily available to Plaintiffs. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify cannot determine which documents *Plaintiffs* might view as important to Shopify's affirmative defenses and Answer, and cannot agree to produce documents that Plaintiffs have not identified with reasonable particularity

as required by the Federal Rules. Shopify will produce relevant, non-privileged documents that Shopify views as supporting its Answer, including its affirmative defenses and the statements included in this Request. This case remains in its early stages, and Shopify will exercise its right under the Federal Rules of Civil Procedure to supplement its production as it learns more information as the case progresses.

REQUEST FOR PRODUCTION NO. 10:

All documents constituting or concerning reports, studies, research, presentations, or analysis relating to copyright or trademark infringement by Shopify Merchants.

RESPONSE TO REQUEST FOR PRODUCTION NO. 10:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request to the extent that it seeks documents protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections, including, but not limited to, any privileged analyses made by counsel or for purposes of obtaining their advice. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify will produce relevant, non-privileged studies, research, or presentations relating to alleged copyright or trademark infringement by Shopify Merchants, including reports and analysis, for the period of December 1, 2018 through March 1, 2022, to the extent such documents exist in Shopify's possession, custody, or control and can be located after a reasonable search.

REQUEST FOR PRODUCTION NO. 11:

All documents concerning any system used for tracking Infringement Notices, including documents describing the technical abilities of that system to track violations of any infringement-related policy by its users and to otherwise track or process Infringement Notices.

RESPONSE TO REQUEST FOR PRODUCTION NO. 11:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request as vague and/or ambiguous to the extent it seeks “[a]ll documents concerning any system used for tracking Infringement Notices” and “documents describing the technical abilities of that system” because these phrases could have multiple meanings in this context. Shopify further objects to this request as overbroad, unduly burdensome, and not proportional to the needs of the case to the extent it calls for “all documents and communications,” as opposed to documents sufficient to show the system used for tracking Infringement Notices. Shopify further objects to this Request as overbroad, unduly burdensome, and not proportional to the needs of the case to the extent it seeks all documents “describing the technical abilities of that system” about Shopify’s current system used to handle notices of alleged infringement received by Shopify, regardless of the document’s relation to the claims or defenses of any party in this proceeding. Shopify further objects to this Request to the extent it seeks confidential, personal, and/or proprietary information that is beyond the scope of this case, including to the extent the Request could be construed to call for proprietary and confidential technical details regarding Shopify’s technical tracking system. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify will produce relevant, non-privileged documents sufficient to show the capabilities of Shopify's system used for tracking and processing Infringement Notices, including Shopify's policies and procedures for tracking and processing Infringement Notices, for the period of December 1, 2018 through March 1, 2022.

REQUEST FOR PRODUCTION NO. 12:

All documents concerning all policies, practices, procedures, or capabilities that You considered, formulated, rejected, or adopted concerning actions to take in response to Infringement Notices, including without limitation adverse actions (including suspending or terminating Your provision of products and/or services) against Shopify Merchants for infringement or alleged infringement.

RESPONSE TO REQUEST FOR PRODUCTION NO. 12:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request the extent that it seeks documents protected by the attorney-client privilege, attorney work product doctrine, or any other applicable privilege, including but not limited to policies, practices, procedures, or capabilities that were considered, formulated, and/or rejected in connection with the advice of counsel. Shopify further objects to this Request to the extent it seeks disclosure of "adopted" policies, practices, procedures, or capabilities as being unduly cumulative to the extent it seeks documents duplicative of those that Plaintiffs have already requested from Shopify in other Requests. Shopify further objects to this Request to the extent it seeks disclosure of "considered, formulated, [or] rejected" policies, practices, procedures, or capabilities as such information is not relevant to any claims or defenses in this action. Shopify further objects to this Request to the extent it seeks public information or information that is readily

available to Plaintiffs. Shopify further objects to this Request as overbroad, unduly burdensome, and not proportional to the needs of the case to the extent it calls for “all documents concerning all policies, practices, procedures, or capabilities,” as opposed to documents sufficient to show Shopify’s actually adopted policies, procedures, or capabilities concerning actions to take in response to Infringement Notices. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify will produce relevant, non-privileged documents sufficient to show its policies, practices, procedures, and capabilities concerning actions to take in response to Infringement Notices, including its policies with respect to adverse actions, for the period of December 1, 2018 through March 1, 2022. For the reasons stated in its objections, Shopify will not produce drafts of Shopify’s policies, practices, procedures, and capabilities concerning actions to take in response to Infringement Notices that were considered, formulated, or rejected, but not adopted.

REQUEST FOR PRODUCTION NO. 13:

All documents concerning the impact or effectiveness of any policies, practices, or procedures You adopted, including any graduated response program, DMCA Policy, or Repeat Infringer Policy, in stopping Shopify Merchants’ infringement through use of Shopify’s products and services.

RESPONSE TO REQUEST FOR PRODUCTION NO. 13:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further

objects to this Request to the extent that it seeks documents protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections, including to the extent it implicates any legal analysis performed by or on behalf of Shopify. Shopify further objects to this Request as vague and/or ambiguous to the extent it refers to the “impact or effectiveness” of its policies, practices, or procedures regarding its DMCA Policy or Repeat Infringer Policy because this phrase could have multiple meanings in this context. Shopify further objects to this Request as vague and/or ambiguous to extent it seeks documents related to “any graduated response program” because no program with that name exists and the term “graduated response program” could have multiple meanings in this context. Shopify further objects to the Request as overbroad, overly burdensome, and not proportional to the needs of the case to the extent it purports to require Shopify to compile information in a manner that is not maintained in the ordinary course of business, and thus imposes burdens beyond the scope required by Rules 26 and 34 of the Federal Rules of Civil Procedure. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify will produce relevant, non-privileged documents concerning the impact or effectiveness of any policies, practices, or procedures Shopify adopted in reducing or eliminating allegations of purported copyright or trademark infringement, for the period of December 1, 2018 through March 1, 2022, to the extent such documents exist in Shopify’s possession, custody, or control and can be located after a reasonable search.

REQUEST FOR PRODUCTION NO. 14:

All documents, including summaries, reports, or analyses, concerning Your handling of and response to Infringement Notices and/or “tickets” created in response thereto, including documents relating to Your closing of Infringement Notices and/or tickets, and data or analyses concerning Your handling and processing of Infringement Notices and/or efforts to improve Your processes.

RESPONSE TO REQUEST FOR PRODUCTION NO. 14:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request to the extent that it seeks documents protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections. Shopify further objects to this Request as overbroad, unduly burdensome, and not proportional to the needs of the case to the extent it purports to require Shopify to compile information in a manner that is not maintained in the ordinary course of business, including but not limited to “all documents, including summaries, reports, or analyses,” and thus imposes burdens beyond the scope required by Rules 26 and 34 of the Federal Rules of Civil Procedure. Moreover, it is unclear whether Plaintiffs are literally looking for every document related to every infringement notice ever received by Shopify; to the extent that is requested, Shopify objects on the grounds that the request is overbroad, unduly burdensome, and not proportional to the needs of the case as it has created hundreds of thousands of tickets associated with every infringement notice Shopify has ever received. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify will produce relevant, non-privileged summaries, including reports and analyses, concerning Shopify's handling of, and response to, Infringement Notices, for the period of December 1, 2018 through March 1, 2022, to the extent such documents exist and are in Shopify's possession, custody, or control and can be located after a reasonable search.

REQUEST FOR PRODUCTION NO. 15:

All summaries, reports, or analyses of Infringement Notices You received, any tickets You generated in response, and/or any actions You took in response to such Infringement Notices or in connection with such tickets.

RESPONSE TO REQUEST FOR PRODUCTION NO. 15:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request to the extent that it seeks documents protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections. Shopify further objects to this Request as overbroad, unduly burdensome, and not proportional to the needs of the case to the extent it purports to require Shopify to compile information in a manner that is not maintained in the ordinary course of business, including but not limited to "all summaries, reports, or analyses of Infringement Notices You received," and thus imposes burdens beyond the scope required by Rules 26 and 34 of the Federal Rules of Civil Procedure. Moreover, it is unclear whether Plaintiffs are literally looking for every document related to every infringement notice ticket ever created by Shopify; to the extent that is requested, Shopify objects on the grounds that the request is overbroad, unduly burdensome, and not proportional to the needs of the case as it has created hundreds of thousands of tickets. Shopify further objects to the time frame of January

1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify will produce relevant, non-privileged summaries, including reports and analyses, of Infringement Notices it received, any tickets it generated in response, and/or any actions it took in response to such Infringement Notices or in connection with such tickets, for the period of December 1, 2018 through March 1, 2022, to the extent such documents exist and are in Shopify's possession, custody, or control and can be located after a reasonable search.

REQUEST FOR PRODUCTION NO. 16:

Documents sufficient to show all circumstances in which You would ignore, or otherwise take no action in response to the receipt of, an Infringement Notice.

RESPONSE TO REQUEST FOR PRODUCTION NO. 16:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request to the extent that it seeks documents protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections. Shopify further objects to the phrase "ignore, or otherwise take no action," as referenced in this Request, as vague and/or ambiguous because it could have multiple meanings in this context, including innocent misplacement. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify states that as part of its standard business practices, it tracks Infringement Notices through a ticketing system rather than by notice. For all Infringement Notices it receives, Shopify creates tickets in its ticketing system, regardless of the manner in which it receives the Infringing Notice. There are thus no circumstances in which Shopify would, pursuant to policy, “ignore, or otherwise take no action in response to the receipt of, an Infringement Notice,” and accordingly, there are no responsive documents to this Request. To the extent the Request seeks information regarding *what* actions Shopify may take in response to receipt of an Infringement Notice (such as sending an email requesting additional information from the complainant), Shopify will produce documents sufficient to show its policies concerning what actions Shopify may take in response to receipt of an Infringement Notice, for the period of December 1, 2018 through March 1, 2022.

REQUEST FOR PRODUCTION NO. 17:

All documents concerning the reactivation of service for any Shopify Merchant whose service You terminated for violation of any policy relating to copyright or trademark infringement.

RESPONSE TO REQUEST FOR PRODUCTION NO. 17:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request to the extent that it seeks documents protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections, including but not limited to any legal advice concerning the reactivation of service for any Shopify Merchant. Shopify further objects to this Request as overbroad, unduly burdensome, and not proportional to the needs of the case to the extent it calls for “all documents,” as opposed to documents sufficient to show Shopify’s policies and processes for reactivating the service for any Shopify Merchant

whose service Shopify terminated for violation of any policy relating to copyright or trademark infringement.” Shopify further objects to the term “reactivation,” as referenced in this Request, as vague and/or ambiguous because it could have multiple meanings in this context. Shopify further objects to this Request to the extent that it seeks the disclosure of information or documents that are controlled by or subject to an obligation of confidentiality owed by Shopify to any third party because service reactivation information may include a Shopify Merchant’s or a third party’s confidential, personal, and/or proprietary information. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify will produce relevant, non-privileged documents sufficient to show Shopify’s policies and processes for, and any actual reactivation of, Shopify Merchants whose service Shopify terminated for violation of any policy relating to copyright or trademark, for the period of December 1, 2018 through March 1, 2022.

REQUEST FOR PRODUCTION NO. 18:

All documents and communications reflecting Your consideration of the validity, accuracy, or reliability of Infringement Notices You received.

RESPONSE TO REQUEST FOR PRODUCTION NO. 18:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request to the extent that it seeks documents protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections. Shopify further objects to this Request as overbroad, unduly burdensome, and not proportional to the needs of the

case to the extent it calls for “all documents and communications,” as opposed to documents sufficient to show Shopify’s policies, procedures, and/or practices for considering “the validity, accuracy, or reliability of Infringement Notices [Shopify] received.” “[A]ll documents and communications” related to Shopify’s consideration of every “Infringement Notice” it has ever received, would be overbroad, unduly burdensome, and not proportional to the needs of the case as such notices have resulted in hundreds of thousands of tickets: Shopify will limit its response to the “Infringement Notices” at issue in connection with Plaintiffs’ claims of infringement. Shopify further objects to the phrase “consideration of the validity, accuracy, or reliability,” as referenced in this Request, as vague and/or ambiguous because it could have multiple meanings in this context. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify states that as part of its standard business practices, it tracks Infringement Notices through a ticketing system rather than by notice. For all Infringement Notices it receives, Shopify creates tickets in its ticketing system. Shopify will produce responsive, non-privileged information from its ticketing system for the tickets associated with each Accused Shopify Merchant for the period of December 1, 2018 through March 1, 2022, regardless of whether the ticket is associated with Plaintiffs’ Infringement Notice or a third party’s Infringement Notice. Shopify will also produce relevant, non-privileged communications concerning Infringement Notices associated with the Accused Shopify Merchants, for the period of December 1, 2018 through March 1, 2022, to the extent such

documents exist in Shopify's possession, custody, or control and can be located after a reasonable search. Shopify will also produce documents sufficient to show Shopify's policies, procedures, and/or practices for considering the validity, accuracy, or reliability of Infringement Notices. For the reasons stated in its objections, Shopify will not produce documents related to Shopify Merchants that are not Accused Shopify Merchants in response to this Request.

REQUEST FOR PRODUCTION NO. 19:

All public statements and all documents concerning public statements by any Shopify employee, agent, or other person speaking on Shopify's behalf concerning Shopify's policies and/or practices concerning copyright or trademark infringement by Shopify Merchants.

RESPONSE TO REQUEST FOR PRODUCTION NO. 19:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request to the extent that it seeks documents protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections, including but not limited to any legal advice related to public statements by Shopify or its agents. Shopify further objects to this Request to the extent it seeks public information or information that is readily available to Plaintiffs. Shopify further objects to this Request as overbroad, unduly burdensome, and not proportional to the needs of the case to the extent it calls for "all documents concerning public statements," rather than documents sufficient to show such statements. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of

fulfilling its discovery obligations in the current proceeding, Shopify will produce relevant public statements identified in Plaintiffs' Complaint, made by senior executives, made in regulatory filings, or made by a reasonable set of custodians, as well as relevant, non-privileged documents concerning those public statements, for the period of December 1, 2018 through March 1, 2022, to the extent such documents exist in Shopify's possession, custody, or control and can be located after a reasonable search.

REQUEST FOR PRODUCTION NO. 20:

Documents sufficient to identify how many Infringement Notices You received via email but, rather than processing the Infringement Notice, responded with an email informing the submitter that the Infringement Notice was not proper because it was submitted via email rather than through an online interface on Shopify.com.

RESPONSE TO REQUEST FOR PRODUCTION NO. 20:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request to the extent that it seeks documents protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections. Shopify further objects to the Request as overbroad, overly burdensome, and not proportional to the needs of the case to the extent it purports to require Shopify to compile information in a manner that is not maintained in the ordinary course of business, and thus imposes burdens beyond the scope required by Rules 26 and 34 of the Federal Rules of Civil Procedure. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of

fulfilling its discovery obligations in the current proceeding, Shopify states that as part of its standard business practices, it tracks Infringement Notices through a ticketing system rather than by notice. For all Infringement Notices it receives, Shopify creates tickets in its ticketing system, regardless of the manner in which it receives the Infringement Notice—thereby processing each notice. There are thus no circumstances under which Shopify, “rather than processing the Infringement Notice, responded with an email informing the submitter the Infringement Notice was not proper because it was submitted via email rather than through an online interface on Shopify.com,” and therefore, no documents responsive to this Request exist. To the extent this Request seeks information regarding the reason certain tickets were actioned in a certain manner, including by emailing the complainant, as stated in Shopify’s objections, this Request seeks information to be compiled in a manner that is not maintained in the ordinary course of business by Shopify, and thus imposes burdens beyond the scope required by Rules 26 and 34 of the Federal Rules of Civil Procedure. Such a compilation would also require legal and qualitative data analysis outside the scope of Fed. R. Civ. P. 33. Such manual review would be particularly burdensome and disproportionate in light of the high volume of notices and communications at issue. Shopify will produce responsive, non-privileged information from its ticketing system for the tickets associated with each Accused Shopify Merchant for the period of December 1, 2018 through March 1, 2022, regardless of whether the ticket is associated with Plaintiffs’ Infringement Notice or a third party’s Infringement Notice, from which this information may be ascertained.

REQUEST FOR PRODUCTION NO. 21:

Documents sufficient to identify how many Infringement Notices You received but did not process, including documents sufficient to identify how many Infringement Notices You received via email but, rather than processing the Infringement Notice, responded with an email informing

the submitter that the Infringement Notice was not proper because it reported infringements involving multiple Shopify Merchants or multiple copyrights or trademarks.

RESPONSE TO REQUEST FOR PRODUCTION NO. 21:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request to the extent that it seeks documents protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections. Shopify further objects to the Request as overbroad, overly burdensome, and not proportional to the needs of the case to the extent it purports to require Shopify to compile information in a manner that is not maintained in the ordinary course of business, and thus imposes burdens beyond the scope required by Rules 26 and 34 of the Federal Rules of Civil Procedure. Shopify further objects to the terms “process” and “processing,” as referenced in this Request, as vague and/or ambiguous because they could have multiple meanings in this context; for example, reviewing and responding with an email with a notice could be described as “processing” the email. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify states that as part of its standard business practices, it tracks Infringement Notices through a ticketing system rather than by notice. For all Infringement Notices it receives, Shopify creates tickets in its ticketing system, regardless of the manner in which it receives the Infringement Notice or the information contained in the notice—thereby processing each notice. There are thus no circumstances under which Shopify, “rather than processing the Infringement Notice, responded with an email informing the

submitter that the Infringement Notice was not proper because it reported infringements involving multiple Shopify Merchants or multiple copyrights or trademarks,” and therefore, no documents responsive to this Request exist. To the extent this Request seeks information regarding the reason certain tickets were actioned in a certain manner, including by emailing the complainant, as stated in Shopify’s objections, this Request seeks information to be compiled in a manner that is not maintained in the ordinary course of business by Shopify, and thus imposes burdens beyond the scope required by Rules 26 and 34 of the Federal Rules of Civil Procedure. Such a compilation would also require legal and qualitative data analysis outside the scope of Fed. R. Civ. P. 33. Such manual review would be particularly burdensome and disproportionate in light of the high volume of notices and communications at issue. Shopify will produce responsive, non-privileged information from its ticketing system for the tickets associated with each Accused Shopify Merchant for the period of December 1, 2018 through March 1, 2022, regardless of whether the ticket is associated with Plaintiffs’ Infringement Notice or a third party’s Infringement Notice, from which this information may be ascertained.

REQUEST FOR PRODUCTION NO. 22:

Documents sufficient to identify how many DMCA-compliant Infringement Notices that You received by email but did not process were resubmitted via Your online reporting tool.

RESPONSE TO REQUEST FOR PRODUCTION NO. 22:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request to the extent that it seeks documents protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections. Shopify further objects to this Request as overbroad, unduly burdensome, and not proportional to the needs of the case to the extent it calls for documents related to Shopify’s monitoring of resubmissions of

Infringement Notices because Shopify has no obligation to do such monitoring under the DMCA and thus such information is irrelevant to any party's claims or defenses in this proceeding. Shopify further objects to this Request to the extent it incorporates, contains characterizations of, or calls for legal conclusions regarding what constitutes a "DMCA-compliant" notice. Shopify further objects to the term "process," as referenced in this Request, as vague and/or ambiguous because it could have multiple meanings in this context; for example, reviewing and responding to an email with a notice could be described as "processing" the email. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, as stated in Shopify's objections, this Request seeks information to be compiled in a manner that is not maintained in the ordinary course of business by Shopify, and thus imposes burdens beyond the scope required by Rules 26 and 34 of the Federal Rules of Civil Procedure. Such a compilation would also require legal and qualitative data analysis outside the scope of Fed. R. Civ. P. 33. Such manual review would be particularly burdensome and disproportionate in light of the high volume of notices and communications at issue. Accordingly, there are no documents sufficient to respond to this Request.

REQUEST FOR PRODUCTION NO. 23:

All logs or other documents that track the Infringement Notices sent to You by any person concerning any Accused Shopify Merchant. This includes logs or other documents sufficient to show, as to each such Infringement Notice, all of the following information:

- the Subscriber ID
- Merchant name
- ticket number
- date and time of alleged infringement as set forth in the Infringement Notice
- each URL involved
- IP address
- each action You took or determined not to take with respect to such Infringement Notice
- the date and time of each such action or determination

RESPONSE TO REQUEST FOR PRODUCTION NO. 23:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request to the extent that it seeks documents protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections, including but not limited to legal advice regarding what action to take or not to take with respect to an Infringement Notice. Shopify further objects to this Request as vague and/or ambiguous to the extent it seeks “each action [Shopify] took or determined not to take with respect to such Infringement Notice” because the phrase “determined not to take” could have multiple meanings in this context. Shopify further objects to this Request as overbroad, unduly burdensome, and not proportional to the needs of the case to the extent it purports to require Shopify to compile information in a manner that is not maintained in the ordinary course of business, including but not limited to “IP address,” “each URL involved,” and “date and time of alleged infringement as set forth in the Infringement Notice,” and thus imposes burdens beyond the scope required by Rules 26 and 34 of the Federal Rules of Civil Procedure. Shopify further objects to this Request to the extent it seeks the disclosure of logs or documents that are controlled by or subject to an obligation of confidentiality owed by Shopify to any third party because Merchant name, IP address, and other fields may include an Accused Shopify Merchant’s or a third party’s confidential, personal, and/or proprietary information. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only

from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify states that as part of its standard business practices, it tracks Infringement Notices through a ticketing system rather than by notice. For all Infringement Notices it receives, Shopify creates tickets in its ticketing system. Shopify will produce responsive, non-privileged information from its ticketing system for the tickets associated with each Accused Shopify Merchant for the period of December 1, 2018 through March 1, 2022, regardless of whether the ticket is associated with Plaintiffs' Infringement Notice or a third party's Infringement Notice, including the data fields requested to the extent they exist, *i.e.*, are maintained by Shopify in the ordinary course of business and were included on the relevant Infringement Notices, subject to the parties' agreement in their Stipulated Protective Order that the parties may redact personally identifiable information.

REQUEST FOR PRODUCTION NO. 24:

All communications between You and any Accused Shopify Merchant, including but not limited to those concerning any Infringement Notice or violation of any Acceptable Use Policy or other policy regarding infringement.

RESPONSE TO REQUEST FOR PRODUCTION NO. 24:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request to the extent that it seeks communications protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections. Shopify further objects to this Request as overbroad, unduly burdensome, and not proportional to the needs of the case to the extent it calls for "all communications between You and any Accused Shopify

Merchant,” as routine communications with Merchants are not at issue in this Action. Shopify further objects to this Request as overbroad, unduly burdensome, and not proportional to the needs of the case to the extent it calls for “all communications” relating to “violation of any Acceptable Use Policy,” as such policies, other than as related to alleged copyright and trademark infringement, are not at issue in this Action. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify states that as part of its standard business practices, it tracks Infringement Notices through a ticketing system rather than by notice. For all Infringement Notices it receives, Shopify creates tickets in its ticketing system. Shopify will produce responsive, non-privileged information from its ticketing system for the tickets associated with each Accused Shopify Merchant for the period of December 1, 2018 through March 1, 2022, regardless of whether the ticket is associated with Plaintiffs’ Infringement Notice or a third party’s Infringement Notice, which will include communications with the Accused Shopify Merchant.

REQUEST FOR PRODUCTION NO. 25:

All documents and internal communications discussing any Plaintiff Infringement Notice, including any ticket generated in response to such Plaintiff Infringement Notice and any internal communications concerning any actual or potential adverse action against any Accused Shopify Merchant’s account with You.

RESPONSE TO REQUEST FOR PRODUCTION NO. 25:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request to the extent that it seeks documents and communications protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections, including but not limited to legal advice regarding any Plaintiff Infringement Notice. Shopify further objects to the phrase “any actual or potential adverse action,” as referenced in this Request, as vague and/or ambiguous because it could have multiple meanings in this context. Shopify will interpret this portion of the Request to seek non-privileged documents and communications regarding whether Shopify should terminate or suspend an Accused Shopify Merchant. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify will produce responsive, non-privileged information from its ticketing system for the tickets associated with each Plaintiff Infringement Notice for the period of December 1, 2018 through March 1, 2022. Shopify will also produce relevant, non-privileged communications concerning the tickets associated with any Plaintiffs Infringement Notice, for the period of December 1, 2018 through March 1, 2022, to the extent such documents exist in Shopify’s possession, custody, or control and can be located after a reasonable search.

REQUEST FOR PRODUCTION NO. 26:

Documents sufficient to show any instance in which You terminated, suspended, or

otherwise took adverse action against the account of any Accused Shopify Merchant.

RESPONSE TO REQUEST FOR PRODUCTION NO. 26:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request to the extent that it seeks documents protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections, including but not limited to documents related to advice from counsel in connection with Shopify's termination, suspension, or adverse action against an account. Shopify further objects to the phrase "otherwise took adverse action," as referenced in this Request, as vague and/or ambiguous because it could have multiple meanings in this context. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify will produce documents sufficient to show any instance in which Shopify terminated the account of any Accused Shopify Merchant for the period of December 1, 2018 through March 1, 2022. Shopify does not otherwise compile information in the manner requested in this Request in the ordinary course of business, and thus this Request imposes burdens beyond the scope required by Rules 26 and 34 of the Federal Rules of Civil Procedure.

REQUEST FOR PRODUCTION NO. 27:

Documents sufficient to show all Infringement Notices (from any rights holder) that identify or reference an Accused Shopify Merchant. Such documents should show at least the following infringement details:

- Date infringement detected
- Date notice sent
- Submitter
- Rights holder
- Details of infringing work (i.e., title, artist, author, etc.)
- Each URL identified
- Merchant name
- Merchant address

RESPONSE TO REQUEST FOR PRODUCTION NO. 27:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request to the extent that it seeks documents protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections. Shopify further objects to this Request as unduly burdensome and not proportional to the needs in this case to the extent it purports to require Shopify to compile information in a manner that is not maintained in the ordinary course of business, including but not limited to “Date infringement detected” and “Details of infringing work (i.e., title, artist, author, etc.),” and thus imposes burdens beyond the scope required by Rules 26 and 34 of the Federal Rules of Civil Procedure. Shopify further objects to this Request to the extent it seeks the disclosure of documents that are controlled by or subject to an obligation of confidentiality owed by Shopify to any third party because Merchant name, Merchant address, and other fields may include an Accused Shopify Merchant’s or a third party’s confidential, personal, and/or proprietary information. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify states that as part of its standard business practices, it tracks Infringement Notices through a ticketing system rather than

by notice. For all Infringement Notices it receives, Shopify creates tickets in its ticketing system. Shopify will produce responsive, non-privileged information from its ticketing system for all tickets associated with Infringement Notices from any rights holder that identify or reference an Accused Shopify Merchant, including the requested data fields, for the period of December 1, 2018 through March 1, 2022, to the extent such data fields exist, *i.e.*, are maintained by Shopify in the ordinary course of business and were included on the relevant Infringement Notices, subject to the parties' agreement in their Stipulated Protective Order that the parties may redact personally identifiable information.

REQUEST FOR PRODUCTION NO. 28:

All documents concerning Shopify's business and financial relationship with any Accused Shopify Merchant, including, without limitation, any agreements and billing and payment records.

RESPONSE TO REQUEST FOR PRODUCTION NO. 28:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request to the extent that it seeks documents protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections. Shopify further objects to this Request to the extent it seeks the disclosure of documents that are controlled by or subject to an obligation of confidentiality owed by Shopify to any third party. Shopify further objects to the phrase "business and financial relationship," as referenced in this Request, as vague and/or ambiguous because it could have multiple meanings in this context. Shopify will interpret "business and financial relationship" to refer to its own relationship with the Accused Shopify Merchant, and not, for example, the Accused Shopify Merchant's relationship with a third party company. Shopify further objects to this Request as overbroad, unduly burdensome, and not proportional to the needs of the case to the extent it calls for all business and financial relationship

documents with Accused Shopify Merchants with no limitation based on relevance to the claims and defenses of any party in this proceeding. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify will produce Shopify's billing and payment records for the Accused Shopify Merchants sufficient to determine their payments, if any, to Shopify, and documents sufficient to identify Shopify's business relationship with any Accused Shopify Merchant, for the period of December 1, 2018 through March 1, 2022, to the extent such documents are within Shopify's possession, custody, or control and can be located after a reasonable search.

REQUEST FOR PRODUCTION NO. 29:

Documents sufficient to identify Shopify's provision of products or services to any Accused Shopify Merchant and the extent of the Accused Shopify Merchant's utilization of those products and services.

RESPONSE TO REQUEST FOR PRODUCTION NO. 29:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request to the extent that it seeks documents protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections. Shopify further objects to this Request as overbroad, unduly burdensome, and not proportional to the needs of the case to the extent it purports to require Shopify to compile information in a manner that is not maintained in the ordinary course of business, and thus imposes burdens beyond the scope

required by Rules 26 and 34 of the Federal Rules of Civil Procedure . Shopify further objects to the Request because documents concerning “Shopify’s provision of products or services to any Accused Shopify Merchant and the extent of the Accused Shopify Merchant’s utilization of those products and services” are not relevant to the claims or defenses of any party in this proceeding. Shopify further objects to the Request as overbroad, unduly burdensome, and not proportional to the needs of the case to the extent “the extent of the Accused Shopify Merchant’s utilization of those products and services” requires manual review of every Accused Shopify Merchant’s usage of every Shopify product and service. Shopify further objects to the terms “products” and “services,” as referenced in this Request, as vague and/or ambiguous because they could have multiple meanings in this context. Shopify further objects to this Request to the extent it seeks the disclosure of documents that are controlled by or subject to an obligation of confidentiality owed by Shopify to any third party because utilization of such products and services may include an Accused Shopify Merchant’s or a third party’s confidential, personal, and/or proprietary information. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify will produce documents sufficient to identify the Accused Shopify Merchants’ Shopify plan(s), which specifies the types of products or services that are made available to each merchant by Shopify, along with the extent of time during which the Accused Shopify Merchant utilized the plan(s), for the period of December 1, 2018 through March 1, 2022. Shopify will also produce documents sufficient to

show the products or services available to its merchants for the period of December 1, 2018 through March 1, 2022. For the reasons stated in its objections, Shopify will not provide documents sufficient to identify each and every product or service that an Accused Shopify Merchant has ever utilized.

REQUEST FOR PRODUCTION NO. 30:

All documents concerning any warnings, ratings, risk assessments, flags, or other fraud, security or infringement risk concerning any Accused Shopify Merchant.

RESPONSE TO REQUEST FOR PRODUCTION NO. 30:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request to the extent that it seeks documents protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections. Shopify further objects to the phrase “security . . . risk,” as referenced in this Request, as vague and/or ambiguous because it could have multiple meanings in this context. Shopify further objects to this Request as overbroad, unduly burdensome, not proportional to the needs of the case, and not relevant to the claims or defenses of any party in this proceeding to the extent it calls for documents concerning “fraud” or “security . . . risk.” Shopify further objects to this Request as overbroad, unduly burdensome, and not proportional to the needs of the case to the extent it calls for “all documents,” as opposed to documents sufficient to show any warnings, ratings, risk assessments, flags, or other fraud, security or infringement risk. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of

fulfilling its discovery obligations in the current proceeding, Shopify will produce responsive, non-privileged information from its ticketing system for the tickets associated with each Accused Shopify Merchant for the period of December 1, 2018 through March 1, 2022, regardless of whether the ticket is associated with Plaintiffs' Infringement Notice or a third party's Infringement Notice, which will include information sufficient to show warnings, ratings, risk assessments, or flags for the Accused Shopify Merchants to the extent it exists in the ordinary course of business, for the period of December 1, 2018 through March 1, 2022.

REQUEST FOR PRODUCTION NO. 31:

Documents sufficient to show Shopify's receipt of revenue, payments, fees, or other compensation in connection with any Accused Shopify Merchant.

RESPONSE TO REQUEST FOR PRODUCTION NO. 31:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request to the extent that it seeks documents protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections. Shopify further objects to this Request to the extent it seeks the disclosure of documents that are controlled by or subject to an obligation of confidentiality owed by Shopify to any third party. Shopify objects to the phrase "Shopify's receipt of" as vague and ambiguous; Shopify will interpret this to refer to monies earned by or paid to Shopify by or on behalf of the Accused Shopify Merchant. Shopify further objects to this Request as overbroad, unduly burdensome, and not proportional to the needs of the case to the extent it calls for all financial transactions between Shopify and Accused Shopify Merchants with no limitation based on relevance to the claims and defenses of any party in this proceeding. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only

from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify will produce documents sufficient to show monies earned by or paid to Shopify by or on behalf of the Accused Shopify Merchants or Shopify's Shopify Payment processor in relation to the Accused Shopify Merchants' accounts for the period of December 1, 2018 through March 1, 2022.

REQUEST FOR PRODUCTION NO. 32:

All documents, including notes, comments, or communications, concerning Shopify's communications with any Accused Shopify Merchant.

RESPONSE TO REQUEST FOR PRODUCTION NO. 32:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request to the extent that it seeks documents protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections. Shopify further objects to this Request as overbroad, unduly burdensome, not proportional to the needs of the case, and not relevant to the claims or defenses of any party in this proceeding to the extent it calls for "all documents, including notes, comments, or communications," as opposed to documents sufficient to show Shopify's communications with the Accused Merchants. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify will produce responsive, non-

privileged information from its ticketing system for the tickets associated with each Accused Shopify Merchant for the period of December 1, 2018 through March 1, 2022, regardless of whether the ticket is associated with Plaintiffs' Infringement Notice or a third party's Infringement Notice, which will include Shopify's communications with the Accused Shopify Merchants. Shopify will also produce Shopify's communications regarding the tickets of the Accused Shopify Merchants, for the period of December 1, 2018 through March 1, 2022. For the reasons stated in its objections, Shopify will not produce "all documents, including notes, comments, or communications," concerning Shopify's communications with the Accused Shopify Merchants unrelated to alleged copyright or trademark infringement.

REQUEST FOR PRODUCTION NO. 33:

All information or digital files provided to You by or on behalf of any Accused Shopify Merchant, including, without limitation, all information listing items for sale and the digital copies of books they uploaded for sale.

RESPONSE TO REQUEST FOR PRODUCTION NO. 33:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request to the extent that it seeks information protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections. Shopify further objects to this Request as overbroad, unduly burdensome, and not proportional to the needs of the case to the extent it calls for "[a]ll information . . . provided to [Shopify] by or on behalf of any Accused Merchant." Shopify will not provide "all information." Shopify further objects to this Request as overbroad, unduly burdensome, and not proportional to the needs of the case to the extent it calls for "all information listing items for sale and the digital copies of books they uploaded for sale." Shopify further objects to this Request as overbroad, unduly burdensome, and

not proportional to the needs of the case to the extent it purports to require Shopify to compile information in a manner that is not maintained in the ordinary course of business, and thus imposes burdens beyond the scope required by Rules 26 and 34 of the Federal Rules of Civil Procedure. Shopify further objects to this Request to the extent it seeks the disclosure of documents that are controlled by or subject to an obligation of confidentiality owed by Shopify to any third party because product listings and digital copies of books may include an Accused Shopify Merchant's or a third party's confidential, personal, and/or proprietary information. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify will produce responsive, non-privileged documents sufficient to show items listed for sale by an Accused Shopify Merchant, for the period of December 1, 2018 through March 1, 2022, to the extent they exist, *i.e.*, are maintained by Shopify in the ordinary course of business, subject to the parties' agreement in their Stipulated Protective Order that the parties may redact personally identifiable information. For the reasons stated in its objections, Shopify will not produce copies of any digital files or digital copies of books that any Accused Shopify Merchant uploaded for sale or otherwise provided to Shopify.

REQUEST FOR PRODUCTION NO. 34:

Documents sufficient to show all listings on Your site offering for sale Plaintiffs' Copyrighted Work(s) by Shopify Merchants that are not Accused Shopify Merchants and all sales on Your site of Plaintiffs' Copyrighted Work(s) by Shopify Merchants that are not Accused

Shopify Merchants.

RESPONSE TO REQUEST FOR PRODUCTION NO. 34:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request to the extent that it seeks documents protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections. Shopify further objects to this Request as overbroad, unduly burdensome, and not proportional to the needs of the case because Shopify has no obligation under the DMCA to affirmatively search for all Shopify Merchants for certain works, and a search of the inventory and sales records of more than 2 million Merchants is extraordinarily burdensome, and neither relevant to any party's claim or defense nor proportional to the needs of the case. Shopify further objects to this Request as overbroad, unduly burdensome, and not proportional to the needs of the case to the extent it purports to require Shopify to compile information in a manner that is not maintained in the ordinary course of business, and thus imposes burdens beyond the scope required by Rules 26 and 34 of the Federal Rules of Civil Procedure. Shopify further objects to this Request to the extent it seeks public information or information that is readily available to Plaintiffs. Shopify further objects to this Request to the extent it seeks the disclosure of documents that are controlled by or subject to an obligation of confidentiality owed by Shopify to any third party because product listings and sale information may include a Shopify Merchant's or a third party's confidential, personal, and/or proprietary information. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of

fulfilling its discovery obligations in the current proceeding, Shopify's site does not contain listings for or otherwise offer for sale Plaintiffs' Copyrighted Works. To the extent this Request refers to copies of Plaintiffs' Works offered for sale by Shopify Merchants, Shopify does not compile information in a manner that is requested by this Request in the ordinary course of business, and thus this Request imposes burdens beyond the scope required by Rules 26 and 34 of the Federal Rules of Civil Procedure. For this reason and for the reasons stated in its objections, Shopify will not produce documents responsive to this Request.

REQUEST FOR PRODUCTION NO. 35:

For each Accused Shopify Merchant, documents sufficient to show:

- the identity and geographic location of any owner or operator of the account;
- all information or marketing listing items, including digital copies of books, for sale;
- all sales and any associated product fulfillment by that Shopify Merchant; and
- the digital files downloaded from Shopify's computer servers, whether in connection with a sale or otherwise, including the dates and geographic locations of such downloads.

RESPONSE TO REQUEST FOR PRODUCTION NO. 35:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request to the extent that it seeks documents protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections. Shopify further objects to this Request as overbroad, unduly burdensome, and not proportional to the needs of the case to the extent it purports to require Shopify to compile information in a manner that is not maintained in the ordinary course of business, including but not limited to "information or marketing listing items" and "dates and geographical locations" of downloads, and thus imposes burdens beyond the scope required by Rules 26 and 34 of the Federal Rules of Civil Procedure. Shopify further objects to this Request to the extent it seeks the disclosure of documents that are controlled by or subject to an obligation of confidentiality owed by Shopify to any third party

because identity, geographic, and sale information, as well as product listings and digital files, may include an Accused Shopify Merchant's or a third party's confidential, personal, and/or proprietary information. Shopify further objects to this Request to the extent it seeks public information or information that is readily available to Plaintiffs. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify does not compile all information requested in this Request in the ordinary course of business, including but not limited to “information or marketing listing items” and “dates and geographical locations” of downloads, and thus this Request imposes burdens beyond the scope required by Rules 26 and 34 of the Federal Rules of Civil Procedure. Shopify will produce responsive, non-privileged documents sufficient to show the requested information about Accused Shopify Merchants, for the period of December 1, 2018 through March 1, 2022, to the extent they exist, *i.e.*, are maintained by Shopify in the ordinary course of business, subject to the parties' agreement in their Stipulated Protective Order that the parties may redact personally identifiable information. For the reasons stated in its objections, Shopify will not produce digital files associated with any Accused Shopify Merchant.

REQUEST FOR PRODUCTION NO. 36:

Documents sufficient to show any common identity, common or related ownership, or other connection or relationship between any Accused Shopify Merchant and another Shopify Merchant, including, as may be applicable, records from account creation, registration, account usage, payments, transfers of funds, or other related or linked accounts.

RESPONSE TO REQUEST FOR PRODUCTION NO. 36:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request to the extent that it seeks documents protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections. Shopify further objects to the terms “common identity,” “common or related ownership,” and “other connection or relationship,” as referenced in this Request, as vague and/or ambiguous because they could have multiple meanings in this context. Shopify further objects to the Request as overbroad, overly burdensome, and not proportional to the needs of the case to the extent it purports to require Shopify to compile information in a manner that is not maintained in the ordinary course of business, and thus imposes burdens beyond the scope required by Rules 26 and 34 of the Federal Rules of Civil Procedure. Shopify further objects to this Request to the extent it seeks the disclosure of documents that are controlled by or subject to an obligation of confidentiality owed by Shopify to any third party because documents showing connections between Shopify Merchants may include a Shopify Merchant’s or a third party’s confidential, personal, and/or proprietary information. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify does not compile information in the manner requested in this Request in the ordinary course of business, and thus this Request imposes burdens beyond the scope required by Rules 26 and 34 of the Federal Rules of Civil Procedure. Shopify considers whether certain shops may be “connected” when they share identical

payment or billing information. Shopify will produce relevant, non-privileged documents sufficient to show the identity of Accused Shopify Merchants' connected shops, as kept in the ordinary course of business for the period of December 1, 2018 through March 1, 2022.

REQUEST FOR PRODUCTION NO. 37:

With respect to any Shopify Merchant account that Shopify terminated due to copyright or trademark infringement, all documents showing any access to or use of that account after termination. This includes but is not limited to any retrieval of information or files from Shopify's computer servers by or on behalf of any owner or operator of the account.

RESPONSE TO REQUEST FOR PRODUCTION NO. 37:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request to the extent that it seeks documents protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections. Shopify further objects to the terms "any access to" and "use of," as referenced in this Request, as vague and/or ambiguous because they could have multiple meanings in this context; for example, "any access to" could mean access by persons other than the terminated Merchant, for example, Shopify employee access for investigation purposes. Shopify will interpret this term to mean access to the account by the terminated Merchant. Shopify further objects to the Request as overbroad, overly burdensome, and not proportional to the needs of the case to the extent it purports to require Shopify to compile information in a manner that is not maintained in the ordinary course of business, and thus imposes burdens beyond the scope required by Rules 26 and 34 of the Federal Rules of Civil Procedure. Shopify further objects to this Request to the extent it seeks the disclosure of documents that are controlled by or subject to an obligation of confidentiality owed by Shopify to any third party because "retrieval of information" from Shopify's servers may include a Shopify

Merchant's or a third party's confidential, personal, and/or proprietary information. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify does not compile information in the manner requested in this Request in the ordinary course of business, and thus this Request imposes burdens beyond the scope required by Rules 26 and 34 of the Federal Rules of Civil Procedure. Shopify will produce relevant, non-privileged documents sufficient to show access by a terminated Accused Shopify Merchant to a terminated account after termination due to copyright or trademark infringement, for the period of December 1, 2018 through March 1, 2022, to the extent such documents exist in Shopify's possession, custody, or control and can be located after a reasonable search. For the reasons stated in its objections, Shopify will not produce documents related to Shopify Merchants that are not Accused Shopify Merchants in response to this Request.

REQUEST FOR PRODUCTION NO. 38:

All documents, including reports, studies, research, presentations, analysis, or communications, concerning Your plans or strategies, actual or considered, for promoting, supporting, or profiting from the sale of digital copies of books.

RESPONSE TO REQUEST FOR PRODUCTION NO. 38:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request to the extent that it seeks documents protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections. Shopify further

objects to this Request as overbroad, unduly burdensome, and not proportional to the needs of the case to the extent it calls for “all documents and communications,” as opposed to documents sufficient to show Shopify’s strategies for promoting, supporting, or profiting from the sale of digital copies of books. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify does not believe it has responsive documents to this request, but will conduct a reasonable search and will produce relevant, non-privileged documents sufficient to show Shopify’s adopted strategies for promoting the sale of digital copies of books to the extent they exist, for the period of December 1, 2018 through March 1, 2022.

REQUEST FOR PRODUCTION NO. 39:

All draft copies of the webpage at the URL <https://www.shopify.com/sell/ebooks> and all communications concerning those drafts.

RESPONSE TO REQUEST FOR PRODUCTION NO. 39:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request to the extent that it seeks documents and communications protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections. Shopify further objects to this Request as overbroad, unduly burdensome, and not proportional to the needs of the case to the extent it calls for “all draft copies of” and “all communications concerning th[e] drafts” of the URL <https://www.shopify.com/sell/ebooks>. Shopify further objects

to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify will produce relevant, non-privileged documents sufficient to show all prior versions of the webpage at the URL <https://www.shopify.com/sell/ebooks> and communications concerning those prior versions, for the period of December 1, 2018 through March 1, 2022, to the extent such documents exist in Shopify's possession, custody, or control and can be located after a reasonable search. For the reasons stated in its objections, Shopify will not produce "all draft copies" or "all communications concerning th[e] drafts" of the URL <https://www.shopify.com/sell/ebooks>.

REQUEST FOR PRODUCTION NO. 40:

All internal communications concerning the performance of the webpage at the URL <https://www.shopify.com/sell/ebooks>, including as to drawing views, free trial participants, and customers.

RESPONSE TO REQUEST FOR PRODUCTION NO. 40:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request to the extent that it seeks communications protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections. Shopify further objects to the Request as overbroad, overly burdensome, and not proportional to the needs of the case to the extent it purports to require Shopify to compile information in a manner that is not maintained in the ordinary course of business, and thus imposes burdens beyond the scope required by Rules 26 and 34 of the Federal Rules of Civil Procedure. Shopify further objects to

the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify does not compile information in the manner requested in this Request in the ordinary course of business, and thus this Request imposes burdens beyond the scope required by Rules 26 and 34 of the Federal Rules of Civil Procedure. Shopify will produce relevant, non-privileged internal communications concerning the performance of the webpage at the URL <https://www.shopify.com/sell/ebooks>, for the period of December 1, 2018 through March 1, 2022, to the extent such documents exist in Shopify's possession, custody, or control and can be located after a reasonable search.

REQUEST FOR PRODUCTION NO. 41:

Documents sufficient to show the performance of the webpage at <https://www.shopify.com/sell/ebooks>, including, without limitation, concerning (a) the number of views of the webpage, (b) how those views compare to views of other webpages at Your website, (c) the numbers of free trials signed up for from this webpage, (d) the number of Accused Shopify Merchants who signed up for your service from this webpage, and (e) the number of Accused Shopify Merchants who expanded their listings to include digital copies of books after viewing this webpage.

RESPONSE TO REQUEST FOR PRODUCTION NO. 41:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request to the extent that it seeks documents protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections. Shopify further

objects to the Request as overbroad, overly burdensome, and not proportional to the needs of the case to the extent it purports to require Shopify to compile information in a manner that is not maintained in the ordinary course of business, and thus imposes burdens beyond the scope required by Rules 26 and 34 of the Federal Rules of Civil Procedure. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify does not compile information in the manner requested in this Request in the ordinary course of business, and thus this Request imposes burdens beyond the scope required by Rules 26 and 34 of the Federal Rules of Civil Procedure. Shopify will produce relevant, non-privileged, non-public documents relating to the performance of the webpage at the URL <https://www.shopify.com/sell/ebooks> for the period of December 1, 2018 through March 1, 2022, including any documents comparing the performance of that webpage to any other Shopify webpage(s), to the extent such documents exist in Shopify's possession, custody, or control and can be located after a reasonable search. For the reasons stated in its objections, Shopify will not produce documents identifying the number of Accused Shopify Merchants who viewed or signed up through this webpage, as that information is not compiled in the manner requested in the Request in the ordinary course of business.

REQUEST FOR PRODUCTION NO. 42:

All advertising or marketing materials, including marketing reports, plans, studies, or consumer research materials, discussing the use or potential use of Your products and services for the sale of digital copies of books.

RESPONSE TO REQUEST FOR PRODUCTION NO. 42:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request to the extent that it seeks documents protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections. Shopify further objects to this Request to the extent it seeks public information or information that is readily available to Plaintiffs. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify will produce relevant, non-privileged, non-public marketing materials concerning the use of Shopify's products for the sale of digital copies of books, for the period of December 1, 2018 through March 1, 2022, to the extent such documents exist in Shopify's possession, custody, or control and can be located after a reasonable search.

REQUEST FOR PRODUCTION NO. 43:

Documents sufficient to show Your revenues, costs, and profits, actual and forecasted, in connection with Shopify Merchants who sell digital copies of books.

RESPONSE TO REQUEST FOR PRODUCTION NO. 43:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request to the extent that it seeks documents protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections. Shopify further objects to the Request as overbroad, overly burdensome, and not proportional to the needs of the

case to the extent it purports to require Shopify to compile information in a manner that is not maintained in the ordinary course of business, and thus imposes burdens beyond the scope required by Rules 26 and 34 of the Federal Rules of Civil Procedure. Shopify further objects to this Request to the extent it seeks the disclosure of documents that are controlled by or subject to an obligation of confidentiality owed by Shopify to any third party because revenues, costs, and profits may include a Shopify Merchant's or a third party's confidential, personal, and/or proprietary information. Shopify further objects to this Request as overbroad, unduly burdensome, and not proportional to the needs of the case to the extent it calls for information on all financial transactions between Shopify and all Shopify Merchants related to digital copies of books with no limitation based on relevance of the Shopify Merchant to the claims and defenses of any party in this proceeding. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify states it does not compile information in the manner requested in this Request in the ordinary course of business, and thus this Request imposes burdens beyond the scope required by Rules 26 and 34 of the Federal Rules of Civil Procedure. For these reasons and the reasons stated in its objections, Shopify will not produce documents responsive to this Request. Shopify is willing to meet and confer with Plaintiffs regarding this Request.

REQUEST FOR PRODUCTION NO. 44:

All documents constituting or concerning reports, studies, research, presentations, or

analysis concerning fraud or other illegal activity by Shopify Merchants.

RESPONSE TO REQUEST FOR PRODUCTION NO. 44:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request to the extent that it seeks documents protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections. Shopify further objects to this Request as overbroad, unduly burdensome, not proportional to the needs of the case, and not relevant to the claims or defenses of any party in this proceeding to the extent it calls for documents concerning “fraud.” Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify will produce relevant, non-privileged reports, studies, research, presentations, or analysis, concerning any alleged illegal activity pertaining to copyright or trademark infringement by Shopify Merchants for the period of December 1, 2018 through March 1, 2022, to the extent such documents exist in Shopify’s possession, custody, or control and can be located after a reasonable search. For the reasons stated in its objections, Shopify will not produce documents concerning fraud or illegal activity that is not alleged copyright and trademark infringement.

REQUEST FOR PRODUCTION NO. 45:

All documents concerning communications between You and Shopify Merchants or any other third-party concerning any lawsuits any of the Plaintiffs in this action commenced in the past against any Shopify Merchants. The foregoing includes any communications with any Shopify

Merchants or any third-party concerning the existence of the lawsuit, the claims asserted, any subpoenas, and any temporary, preliminary, or permanent injunctive relief or other court orders.

RESPONSE TO REQUEST FOR PRODUCTION NO. 45:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request to the extent that it seeks documents protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections. Shopify further objects to this Request as overbroad, unduly burdensome, and not proportional to the needs of the case to the extent it calls for “all documents concerning communications,” as opposed to documents sufficient to show Shopify’s communications with Shopify Merchant regarding any lawsuits Plaintiffs have previously brought against any Shopify Merchant. Shopify further objects to the phrase “any lawsuits any of the Plaintiffs in this action commenced in the past against any Shopify Merchant,” as referenced in this Request, as vague and/or ambiguous because it could have multiple meanings in this context and the identity of such lawsuits is not readily ascertainable by Shopify. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify will produce responsive, non-privileged documents sufficient to show communications with Shopify Merchants concerning Plaintiffs’ lawsuits and subpoenas for the period of December 1, 2018 through March 1, 2022. Shopify is also willing to meet and confer with Plaintiffs regarding the identity of the specific lawsuits in question referenced in this Request, as this information is more readily ascertainable to

Plaintiffs than Shopify.

REQUEST FOR PRODUCTION NO. 46:

All documents supporting, refuting, or otherwise concerning Your affirmative defenses or any other defenses in this case.

RESPONSE TO REQUEST FOR PRODUCTION NO. 46:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request to the extent that it seeks documents protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections. Shopify further objects to this Request as being unduly cumulative to the extent it seeks documents duplicative of those that Plaintiffs have already requested from Shopify in other Requests. Shopify further objects to this Request to the extent it seeks the disclosure of documents that are controlled by or subject to an obligation of confidentiality owed by Shopify to any third party because they may include a Shopify Merchant's or a third party's confidential, personal, and/or proprietary information. Shopify further objects to this Request to the extent it seeks public information or information that is readily available to Plaintiffs, or documents that are in Plaintiff's possession, custody, or control. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify cannot determine which documents *Plaintiffs* might view as supporting, refuting, or otherwise concerning Shopify's affirmative defenses or any other defenses, and cannot agree to produce documents that Plaintiffs

have not identified with reasonable particularity as required by the Federal Rules. Shopify will produce relevant, non-privileged documents that Shopify views as supporting, refuting, or otherwise concerning its affirmative defenses or any other defenses. This case remains in its early stages, and Shopify will exercise its right under the Federal Rules of Civil Procedure to supplement its production as it learns more information as the case progresses.

REQUEST FOR PRODUCTION NO. 47:

All documents You identify in responding to any interrogatories or requests for admission.

RESPONSE TO REQUEST FOR PRODUCTION NO. 47:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request to the extent that it seeks documents protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections. Shopify further objects to this Request as being unduly cumulative to the extent it seeks documents duplicative of those that Plaintiffs have already requested from Shopify in other Requests. Shopify further objects to this Request to the extent it seeks the disclosure of documents that are controlled by or subject to an obligation of confidentiality owed by Shopify to any third party because they may include a Shopify Merchant's or a third party's confidential, personal, and/or proprietary information. Shopify further objects to this Request to the extent it seeks public information or information that is readily available to Plaintiffs, or documents that are in Plaintiff's or a third party's possession, custody, or control. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Request to the limitations period.

Subject to and without waiving its general and specific objections and only for purposes of

fulfilling its discovery obligations in the current proceeding, Shopify will produce relevant, non-privileged documents that Shopify identifies in responding to interrogatories to the extent such documents are in Shopify's possession, custody, or control and can be located after a reasonable search. Shopify notes that no requests for admission have yet been served in this case, and thus this request is premature with respect to requests for admission. This case remains in its early stages, and Shopify will exercise its right under the Federal Rules of Civil Procedure to supplement its production as it learns more information as the case progresses.

REQUEST FOR PRODUCTION NO. 48:

All documents concerning any subpoena You issue in this lawsuit, including all communications with the subpoena recipient concerning the subpoena and all documents You receive in response to a subpoena.

RESPONSE TO REQUEST FOR PRODUCTION NO. 48:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request to the extent that it seeks documents protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections. Shopify further objects to this Request as being unduly cumulative to the extent it seeks documents duplicative of those that Plaintiffs have already requested from Shopify in other Requests. Shopify further objects to this Request to the extent it seeks public information or information that is readily available to Plaintiffs. Shopify further objects to this Request to the extent it seeks the disclosure of documents that are controlled by or subject to an obligation of confidentiality owed by Shopify to any third party because they may include a Shopify Merchant's or a third party's confidential, personal, and/or proprietary information. Shopify further objects to this Request because it is premature: Shopify has not yet issued any subpoenas to third parties in this action.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify states that Plaintiffs' Request is premature because Shopify has not yet issued any subpoenas to third parties in this proceeding. In the event that Shopify serves subpoenas in this matter, Shopify will produce documents relating to subpoenas to the extent required by the Federal Rules of Civil Procedure and the parties' Joint Discovery Plan.

REQUEST FOR PRODUCTION NO. 49:

All documents that You may use as exhibits in the trial or any hearing in this lawsuit.

RESPONSE TO REQUEST FOR PRODUCTION NO. 49:

Shopify incorporates its General Objections as if fully set forth herein. Shopify further objects to this Request as being unduly cumulative to the extent it seeks documents duplicative of those that Plaintiffs have already requested from Shopify in other Requests. Shopify further objects to this Request to the extent it calls for the production of portions of documents that are in the possession of Plaintiffs or a third party. Shopify further objects to this Request to the extent it seeks public information or information that is readily available to Plaintiffs.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify states that Plaintiffs' Request is premature because discovery is ongoing and Shopify has not yet chosen its exhibits for trial or any hearing in this proceeding. In addition, Shopify will not produce documents in the possession of Plaintiffs or a third party, or that are public, but it reserves all rights to use such documents in the trial or at any hearing in this lawsuit. Shopify will produce relevant, non-privileged documents that Shopify plans to use as exhibits in trial or in any hearing, to the extent such documents exist in Shopify's possession, custody, or control and can be located after a reasonable search, at a time

after Shopify determines to use such documents in trial or any hearing of this proceeding to the extent required by the Federal Rules of Civil Procedure and as required in accordance with the Court's scheduling orders.

Dated: March 31, 2022

/s/ Jessica Stebbins Bina

David L. Johnson (VSB No. 89289)
Sarang Vijay Damle (*pro hac vice*)
Sarah A. Tomkowiak (*pro hac vice*)
Elana Nightingale Dawson (*pro hac vice*)
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Attorneys for Defendant Shopify, Inc.

Plaintiffs' Exhibit 2

Subject: RE: Before v. Shopify - Shopify's ROG and RFP Responses
Date: Wednesday, April 20, 2022 at 22:25:16 Eastern Daylight Time
From: Elizabeth.Greenman@lw.com
To: Scott Zebrak, Jessica.StebbinsBina@lw.com, Sy.Damle@lw.com, Andrew.Gass@lw.com, Jess.Kurtz@lw.com, Andrew.Nietes@lw.com, Nicholas.Schlossman@lw.com, Alli.Stillman@lw.com, Sarah.Tomkowiak@lw.com, Joe.Wetzel@lw.com
CC: Jeff Kane, Corey Miller, Michele Murphy, Katheryn Jarvis Enters, Matt Oppenheim, Brian Stuart, Rebecca Weissman
Attachments: image001.png

Scott:

Shopify's Interrogatories:

While we appreciate that you are still conferring with your client with respect to the interrogatories, we note that you have failed to provide, by today, a simple yes or no regarding whether plaintiffs will agree to supplement the interrogatory responses as discussed, the answer of which will determine whether the parties avoid further motion practice. We advised plaintiffs that there were numerous issues related to the interrogatories as early as April 8, including informing you that it was improper that plaintiffs failed to respond at all to more than half of Shopify's interrogatories, and failed to meaningfully respond to nearly all of the interrogatories. Accordingly, plaintiffs have had nearly two weeks to consider whether they would amend their responses, despite the fact that we did not confer by phone until yesterday (we note this was after our request to do so on Monday of this week). Accordingly, while we will provide you with the courtesy of waiting until tomorrow, if we do not have a firm answer from you by **tomorrow at COB** that plaintiffs will supplement their responses, we will consider these Interrogatories ripe for motion practice.

Plaintiffs' Questions:

As for the second portion of your email, we strongly disagree that the parties have discussed searches related to "ebooks" in connection with RFPs 24 and 32 specifically, as opposed to generally or related to other RFPs. In any event, Shopify responds as follows to your specific points as to RFPs 24 and 32:

1. As we confirmed in our prior correspondence, we have already included the term "ebook" (including derivations), along with other appropriate search terms, in our searches to date, including searches that will be relevant to RFPs 24 and 32.
2. We have also confirmed multiple times that we are searching across, and plan to produce, communications with Accused Merchants that are in a customer-service-type database, as well as other databases that are likely to contain responsive documents, in accordance with our obligations under the FRCP. However, we have no obligation to identify "all relevant databases" for you. Notably, Plaintiffs have provided no visibility to date into which databases they are searching, and on our initial call, declined to identify the relevant databases.
3. It is our understanding based on a reasonable investigation that, in every instance, Shopify personnel have referred to alleged infringement as "infringement" and not some other generic term like "fraud". While it is possible that a document could use another word in addition to infringement (such as "copyright infringement" or "e-book infringement" or "infringement in violation of the AUP"), in each instance the use of "infringement" will result in the materials being captured by our search protocol.

Best regards,

Elizabeth A. Greenman

LATHAM & WATKINS LLP

10250 Constellation Blvd. Suite 1100 | Los Angeles, CA 90067

D: +1.424.653.5431

From: Scott Zebrak <Scott@oandzlaw.com>

Sent: Wednesday, April 20, 2022 4:02 PM

To: Greenman, Elizabeth (CC) <Elizabeth.Greenman@lw.com>; Stebbins Bina, Jessica (CC) <Jessica.StebbinsBina@lw.com>; Damle, Sy (DC-NY) <Sy.Damle@lw.com>; Gass, Andrew (Bay Area) <Andrew.Gass@lw.com>; Kurtz, Jess (NY) <Jess.Kurtz@lw.com>; Nietes, Andrew (NY) <Andrew.Nietes@lw.com>; Schlossman, Nicholas (DC) <Nicholas.Schlossman@lw.com>; Stillman, Alli (NY) <Alli.Stillman@lw.com>; Tomkowiak, Sarah (DC) <Sarah.Tomkowiak@lw.com>; Wetzel, Joe (Bay Area) <Joe.Wetzel@lw.com>

Cc: Jeff Kane <JKane@oandzlaw.com>; Corey Miller <Corey@oandzlaw.com>; Michele Murphy <michele@oandzlaw.com>; Katheryn Jarvis Enters <Katheryn@oandzlaw.com>; Matt Oppenheim <Matt@oandzlaw.com>; Brian Stuart <Brian@oandzlaw.com>; Rebecca Weissman <Rebecca@oandzlaw.com>

Subject: Re: Before v. Shopify - Shopify's ROG and RFP Responses

Elizabeth,

Shopify's Interrogatories:

As to the portion of your email concerning Shopify's Interrogatories to Plaintiffs, we're talking with our clients and will respond tomorrow.

Plaintiffs' Questions:

As to the portion of your email concerning Plaintiffs' discovery, you have misstated the record. You indicate that Jeff Kane's email was the first time Plaintiffs asked Shopify to search for the term "ebook" within Shopify's internal communications about the pirate merchants identified in Plaintiffs' notices. But that is simply not correct. Jeff Kane's email of *April 8* expressly inquired about a search concerning the pirate merchants identified in Plaintiffs' notices and the subject of ebooks. We then discussed that search term / subject in at least two separate conferrals.

We have conferred with you several times already as to RFPs 24/32, including on the specific questions below, but without receiving a clear response.

Accordingly:

1. Please confirm by tomorrow whether Shopify is searching the term "ebook" (and derivations) within the relevant systems / databases.
2. In your response tomorrow, please identify which databases constitute "all relevant databases" in which Shopify is searching. We've been asking this question since inception of our conferrals, without receiving sufficient clarification. In particular, we've asked many times for clear and unambiguous confirmation that Shopify is searching whatever database(s) have

Customer Service communications. Your response below again fails to address Customer Service database(s) specifically. We need a firm answer in your response tomorrow

3. As to Shopify's communications about Shopify merchants who were identified in Plaintiffs' notices, Plaintiffs believe that whether those merchants were engaged in fraud, illegal activity, or AUP violations is plainly relevant, for reasons we've explained. But even under Shopify's narrower view of relevance (i.e., only those communications that concern copyright or trademark infringement), has Shopify confirmed that its personnel do not sometimes refer to copyright or trademark infringement as either fraud, illegal activity, or an AUP violation? We've asked this question a few times in our conferrals without an answer. Please tell us tomorrow.

Thank you,

Scott A. Zebrak

Oppenheim + Zebrak, LLP

4530 Wisconsin Avenue, NW | 5th Floor

Washington, DC 20016

202.450.3758 direct | 202.420.9235 mobile

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Follow Oppenheim + Zebrak on Twitter.

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From: Elizabeth.Greenman@lw.com <Elizabeth.Greenman@lw.com>

Sent: Tuesday, April 19, 2022 11:37:03 PM

To: Jeff Kane <JKane@oandzlaw.com>; Jessica.StebbinsBina@lw.com <Jessica.StebbinsBina@lw.com>; Sy.Damle@lw.com <Sy.Damle@lw.com>; Andrew.Gass@lw.com <Andrew.Gass@lw.com>; Jess.Kurtz@lw.com <Jess.Kurtz@lw.com>; Andrew.Nietes@lw.com <Andrew.Nietes@lw.com>; Nicholas.Schlossman@lw.com <Nicholas.Schlossman@lw.com>; Alli.Stillman@lw.com <Alli.Stillman@lw.com>; Sarah.Tomkowiak@lw.com <Sarah.Tomkowiak@lw.com>; Joe.Wetzel@lw.com <Joe.Wetzel@lw.com>

Cc: Katheryn Jarvis Enters <Katheryn@oandzlaw.com>; Corey Miller <Corey@oandzlaw.com>; Michele Murphy <michele@oandzlaw.com>; Matt Oppenheim <Matt@oandzlaw.com>; Brian Stuart <Brian@oandzlaw.com>; Rebecca Weissman <Rebecca@oandzlaw.com>

Subject: RE: Before v. Shopify - Shopify's ROG and RFP Responses

Counsel:

Thank you for speaking with us today. We'd like to memorialize our understanding of the conversation today,

including our responses to your email below.

As to the outstanding issues regarding Shopify's interrogatories, please confirm plaintiffs' positions no later than COB tomorrow. To the extent that plaintiffs intend to supplement their responses to any specific interrogatories, please clearly identify which interrogatories you will supplement, and confirm that you will supplement these responses no later than COB on Friday, April 22. Absent such an agreement, Shopify will have no recourse but to resort to motion practice, particularly in light of the fact that plaintiffs have outright refused to respond to the majority of Shopify's interrogatories.

Shopify's Interrogatories:

1. **Rogs 1-3**: we understand that plaintiffs will not provide additional information responsive to these interrogatories unless the court grants Shopify's motion to compel documents responsive to the related RFPs, at which time, you will amend your responses to refer to the produced documents. Please confirm this understanding.
2. **Rog 4**: we discussed whether plaintiffs would be supplementing this response to generally describe the nature of your relationship with any third party complainant who monitors and/or submits notices on plaintiffs' behalf, including to identify specific documents reflecting those relationships. You indicated you would confer with your client. Please confirm by COB tomorrow whether you intend to supplement this response.
3. **Rog 6**: you indicated that you would confer with your client regarding identifying the general steps taken by plaintiffs or anyone on plaintiffs' behalf to monitor or identify alleged infringement related to plaintiffs' works or marks. We clarified that this description should include information related to both plaintiffs' general practices, as well as circumstances in which plaintiffs deviated from their "general" practice for any specific works or marks. Please confirm no later than COB tomorrow that you will supplement this response accordingly.
4. **For Rogs 5, 7, and 8**, you indicated that these were likely covered by related RFPs, and to the extent you are ordered to produce further documents for the related RFPs, you will supplement these RFPs in accordance with the court's order. This is not sufficient. Shopify believes that plaintiffs must supplement these interrogatories and identify specific documents that are responsive to these interrogatories. Please confirm no later than COB tomorrow that plaintiffs will supplement these responses accordingly.
5. **For Rog 10**, you indicated that you would confer with your clients, but you likely could describe generally plaintiffs' efforts to enforce their copyright interests in the works. Please confirm no later than COB tomorrow that plaintiffs will supplement this response.
6. **For Rogs 11, 12, and 15**, these interrogatories request that plaintiffs provide all facts upon which these specific contentions in the complaint are based. Plaintiffs have no basis for refusing to respond to these requests. If plaintiffs do not believe they have evidence to support these allegations at this time, they must state so. To the extent you believe certain categories of documents support these allegations, Rule 33(d) requires plaintiffs to identify with sufficient detail the documents that support these contentions. Please confirm no later than COB tomorrow that plaintiffs will supplement these responses.
7. **For Rog 14**, you have stated that you would confer with your clients regarding whether there is a list of titles of works where they have authorized the use of their marks, as kept in the ordinary course of business. Please confirm no later than COB tomorrow whether such a list exists, and if not, whether plaintiffs are willing to provide a more general response regarding whether their marks are still active,

and if so, how the marks are generally used with respect to specific goods or services.

8. **Rog 16:** as discussed, Shopify believes this interrogatory, which relates to all material contentions in the complaint, is valid and proper under the FRCP. To the extent you disagree, please provide us with case law supporting your position no later than COB tomorrow. Absent such support, we expect plaintiffs to supplement this response accordingly.

Plaintiffs' Questions:

- A. **RFPs 24/ 32:** Shopify confirms that it will produce all tickets for the Accused Merchants, all communications with any Accused Merchant, and all communications about any Accused Merchant related to infringement, during the SOL period, in response to these RFPs. These searches will not be limited to Shopify's ticketing system, but will include a search across all relevant databases where responsive documents would likely to be found.

Shopify will not, however, produce communications *about* Accused Merchants related to fraud or other illegal activities that do not include copyright or trademark infringement.

You have, for the first time in your email below, expressed a desire for Shopify to search for responsive documents about the merchants that involve "ebooks." While that has not been a part of discussions to date, Shopify is conferring with the client regarding this request, but can confirm that the term "ebooks" has been already been included in search results along with other appropriate search terms.

- B. **RFP 33:** Shopify has indicated that it is producing an inventory list of all products offered by each Accused Merchant, and information regarding whether each Accused Merchant has downloaded the Digital Downloads app. To clarify, the inventory list has no relation to the Digital Downloads app (in other words, the fact that an item appears on the inventory list does not by itself indicate that a file was ever on the Digital Downloads app, or remains there today). As discussed during our meet and confers, Shopify is not able to ascertain whether and to what extent each Accused Merchant in fact used the Digital Downloads app.

Shopify confirms that it will not produce wholesale all digital files an Accused Merchant uploaded to the Digital Downloads app, including digital files in which plaintiffs do not allege any ownership interest.

However, after reviewing the inventory list and the list of Accused Merchants who downloaded the Digital Downloads app, if plaintiffs have specific requests related to titles that plaintiffs believe are their own works from the inventory lists, Shopify is willing to meet and confer regarding whether it is able to ascertain whether such materials remain on the Digital Downloads app.

- C. **RFP 29:** Shopify confirms that it cannot ascertain what products or services individual merchants used. Shopify can and will provide information regarding what specific plan each Accused Merchant had, and what services were available under each plan. Shopify can also provide information regarding whether Accused Merchants downloaded Shopify-owned applications, such as the Digital Downloads app. Shopify is also producing a number of details regarding each Accused Merchant's utilization of its platform, such as information related to orders, products, and Shopify Payments. If plaintiffs have specific questions about particular services after reviewing these materials, Shopify remains willing to meet and confer regarding whether that particular service is one in which Shopify is able to provide additional specifics.

- D. **RFPs 4 / 46:** Shopify will provide information sufficient to show the number of strikes each Accused Merchant has received. Additionally, Shopify will provide information sufficient to show the number of overall terminations, and any “pass and hide” actions taken related to IP infringement. Shopify will also provide information sufficient to demonstrate the numbers of merchants terminated under the Repeat Infringer Policy and its Enhanced Repeat Infringer Policy.

Best regards,

Elizabeth A. Greenman

LATHAM & WATKINS LLP

10250 Constellation Blvd. Suite 1100 | Los Angeles, CA 90067
D: +1.424.653.5431

From: Jeff Kane <JKane@oandzlaw.com>

Sent: Monday, April 18, 2022 10:09 AM

To: Stebbins Bina, Jessica (CC) <Jessica.StebbinsBina@lw.com>; Damle, Sy (DC-NY) <Sy.Damle@lw.com>; Gass, Andrew (Bay Area) <Andrew.Gass@lw.com>; Greenman, Elizabeth (CC) <Elizabeth.Greenman@lw.com>; Kurtz, Jess (NY) <Jess.Kurtz@lw.com>; Nietes, Andrew (NY) <Andrew.Nietes@lw.com>; Schlossman, Nicholas (DC) <Nicholas.Schlossman@lw.com>; Stillman, Alli (NY) <Alli.Stillman@lw.com>; Tomkowiak, Sarah (DC) <Sarah.Tomkowiak@lw.com>; Wetzels, Joe (Bay Area) <Joe.Wetzels@lw.com>

Cc: Kathryn Jarvis Enters <Kathryn@oandzlaw.com>; Corey Miller <Corey@oandzlaw.com>; Michele Murphy <michele@oandzlaw.com>; Matt Oppenheim <Matt@oandzlaw.com>; Brian Stuart <Brian@oandzlaw.com>; Rebecca Weissman <Rebecca@oandzlaw.com>

Subject: Before v. Shopify - Shopify's ROG and RFP Responses

Counsel,

We've conferred multiple times already as to items A, B, and C below. In advance of our call tomorrow, please provide us with a clear response—via email—to these outstanding questions:

- A. **RFPs 24/ 32:** As to these requests, you've indicated by email that “Shopify will produce all tickets for the accused merchants, all communications with the accused merchants, and all non-privileged communications about the accused merchants regarding infringement and IP issues, to the extent locatable after a reasonable search.” But Shopify's written responses indicate that Shopify will produce only documents from its ticketing system. Responses to RFP 24, 32 (“Shopify will produce responsive, non-privileged information *from its ticketing system* for the tickets associated with each Accused Shopify Merchant...”); Response to RFP 32 (“Shopify will also produce Shopify's communications *regarding the tickets* of the Accused Shopify Merchants...”) (emphasis added throughout).
- i. Accordingly, please confirm that, notwithstanding its written responses, (1) Shopify's search for responsive documents will include a search of selected custodians; and (2) Shopify's search for responsive documents within its internal systems will NOT be limited to its “ticketing system” but will extend to other systems that can be expected to house responsive documents—including, specifically, whatever system includes communications with Shopify's Customer Service teams.

- ii. In the hope of narrowing issues for motions practice, please also let us know if Shopify will reconsider its refusal to search for responsive documents about the merchants identified in Plaintiffs' notices that involve the topics of "ebooks", "fraud", or "other illegal activity."
- B. **RFP 33** ("All information or digital files provided to You by or on behalf of any Accused Shopify Merchant, including, without limitation, all information listing items for sale and the digital copies of books they uploaded for sale").
 - i. You've indicated that you're investigating RFP 33, but we need a final answer. You've already had several weeks. What is Shopify prepared to produce here? In particular, in addition to lists of the items the merchants were selling: Is Shopify producing records identifying the digital files uploaded to Shopify for fulfillment? Is Shopify producing copies of the digital files themselves?
- C. **RFP 29** ("Documents sufficient to identify Shopify's provision of products or services to any Accused Shopify Merchant and the extent of the Accused Merchant's utilization of those products and services"). You indicated that Shopify is producing records as to the plans that the merchants were on, and, thus, the services available to them. We've asked several times for records as to how those merchants actually used the services.
 - i. Will Shopify run reports or produce data sufficient to discern the extent to which the Shopify Merchants identified in Plaintiffs' infringement notices utilized each of the Shopify products or services available to that merchant within their Shopify plan?
- D. Finally, besides the foregoing, we'd like to discuss RFPs 4 and 46 with you when we connect tomorrow. RFP 4 calls for "Documents sufficient to show, on a monthly, quarterly, and yearly basis, the number of instances in which You warned, suspended, terminated, or otherwise took adverse action against the account of a Shopify Merchant based on that Shopify Merchant's copyright or trademark infringement." And RFP 46 calls for "All documents supporting, refuting, or otherwise concerning Your affirmative defenses or any other defenses in this case." Shopify stated in response to RFP 4 that it would produce "information sufficient to show the number of instances in which Shopify *terminated* the account of a Shopify Merchant based on that Shopify Merchant's alleged copyright or trademark infringement..." (emphasis added).
 - i. Please advise whether Shopify is producing information sufficient to show instances in which Shopify "warned, suspended...or otherwise took adverse action against the account of a Shopify Merchant based on that Shopify Merchant's copyright or trademark infringement." We note that Shopify's interrogatory responses cited the number of instances in which Shopify took an action that resulted in a "Pass" (ROG 13), or a "Pass & Hide Final" (ROG 14). And Shopify's response to ROG 14 further broke down the number of terminations into ones completed under the Repeat Infringer and Enhanced Repeat Infringer policies. Please advise whether Shopify will produce the data underlying those assertions.

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Plaintiffs' Exhibit 3

**UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
ALEXANDRIA DIVISION**

BEDFORD, FREEMAN & WORTH
PUBLISHING GROUP, LLC d/b/a
MACMILLAN LEARNING;
MACMILLAN HOLDINGS, LLC;
CENGAGE LEARNING, INC.;
ELSEVIER INC.; ELSEVIER B.V.;
MCGRAW HILL LLC; and PEARSON
EDUCATION, INC.,

Plaintiffs,

v.

SHOPIFY INC.,

Defendant.

Case No. 1:21-cv-01340

**SHOPIFY INC.’S RESPONSES AND OBJECTIONS TO PLAINTIFFS’
FIRST SET OF INTERROGATORIES**

Shopify Inc. (“Shopify”), pursuant to Rule 33 of the Federal Rules of Civil Procedure and the Local Rules of this Court, by and through its undersigned counsel, provides these responses to the First Set of Interrogatories of Bedford, Freeman & Worth Publishing Group, LLC d/b/a Macmillan Learning, Macmillan Holdings, LLC, Cengage Learning, Inc., Elsevier Inc., Elsevier B.V., McGraw Hill LLC, and Pearson Education, Inc. (collectively, “Plaintiffs”) as follows:

PRELIMINARY STATEMENT

1. Shopify’s investigation and development of all facts and circumstances relating to this action is ongoing. These responses are made without prejudice to, and are not a waiver of, Shopify’s right to rely on other facts or documents at trial.

2. By making the accompanying responses to Plaintiffs' Interrogatories, Shopify does not waive, and hereby expressly reserves, its right to assert any and all objections as to the admissibility of such responses into evidence in this action, or in any other proceedings, on any and all grounds including, but not limited to, competency, relevancy, materiality, and privilege. Further, Shopify makes these responses herein without in any way implying that it considers the Interrogatories or responses thereto to be relevant or material to the subject matter of this action.

3. No response to any Interrogatory is intended to be, nor shall any response be construed as, an admission of the existence of any facts set forth in or assumed by any Interrogatory, or an admission that such response constitutes admissible evidence. Likewise, the production of any documents in response to the Interrogatories is not intended to be, and shall not be construed as, a waiver by Shopify of all or any part of any objection to any Interrogatory, an admission of the existence of any facts set forth in or assumed by any Interrogatory or any document produced in response thereto, or an admission that such response, objection, or document constitutes admissible evidence.

4. Shopify expressly reserves the right to supplement, clarify, revise, or correct any or all of the responses herein, and to assert additional objections or privileges, in one or more subsequent supplemental response(s).

5. Shopify previously served general and specific objections to Plaintiffs' Interrogatories on March 16, 2022. Shopify incorporates its general objections and specific objections herein, in italicized text, for ease of reference.

GENERAL OBJECTIONS

1. Shopify objects to the Interrogatories, and all Instructions and Definitions thereto, to the extent they incorporate, contain characterizations of, or call for legal conclusions. The

inclusion of a Defined term in Shopify's objections or responses does not indicate Shopify's assent to that Definition nor any legal conclusions contained therein.

2. *Shopify objects to the Interrogatories, and all Instructions and Definitions thereto, to the extent they call for the creation of new or voluminous analyses or data compilations that do not currently exist in the ordinary course of Shopify's business.*

3. *Shopify objects to the Interrogatories, and all Instructions and Definitions thereto, to the extent they request information and documents that are a matter of public record, in the possession of a third party, in the possession of the Plaintiffs, or otherwise available to the Plaintiffs through a source other than Shopify.*

4. *Shopify objects to the Interrogatories to the extent that they seek information that is not relevant to the claims or defenses of any party in this proceeding, or are not reasonably calculated to lead to the discovery of information relevant to the claims or defenses of any party in this proceeding.*

5. *Shopify objects to the Interrogatories to the extent they are overbroad, unduly burdensome, or not proportional to the needs of this case.*

6. *Shopify objects to the Interrogatories to the extent they are compound and include discrete sub-parts, which count as separate Interrogatories. Shopify reserves the right to raise any deficiencies related to the Plaintiffs' attempts to issue improper Interrogatories pursuant to the Federal Rules of Civil Procedure and the applicable Rules and Orders of the Court.*

7. *Shopify objects to the Interrogatories to the extent they seek documents or information beyond the possession, custody, or control of Shopify or that would require Shopify to spend an unreasonable amount of time, effort, and resources in order to respond. Shopify will make reasonable efforts to search for relevant information from those individuals employed by or*

on behalf of Shopify whom Shopify reasonably believes are likely to have responsive information associated with this proceeding, but each and every employee has not been, and could not be, contacted and questioned, nor their documents searched, for information that would assist in answering the Interrogatories.

8. *Shopify objects to the Interrogatories to the extent they call for information the discovery of which is cumulative or duplicative.*

9. *Shopify objects to the Interrogatories to the extent they are vague and/or ambiguous.*

10. *Shopify objects to the Interrogatories to the extent they call for the disclosure of information or materials protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections. Shopify will exclude from its responses all information or materials protected by any applicable privilege or doctrine.*

11. *Shopify objects to the Interrogatories to the extent that they seek the disclosure of information or documents that are controlled by or subject to an obligation of confidentiality owed by Shopify to any third party.*

12. *Shopify objects to the definition of “you,” “your,” “Shopify,” or “Defendant” to the extent that they purport to impose duties beyond those imposed by the Federal Rules of Civil Procedure and the applicable Rules and Orders of the Court. Shopify further objects to these definitions as unduly burdensome and overbroad to the extent they purport to include entities other than Shopify. Shopify objects to these definitions to the extent they purport to include within their scope any “attorneys” for Shopify. For purposes of its responses, Shopify will construe “you,” “your,” “Shopify,” or “Defendant” to mean only Shopify Inc., and not any “parents, subsidiaries, affiliates . . . and/or any other person or entity currently or previously acting or purporting to act*

on its behalf” or any attorneys not employed by Shopify Inc. acting on its behalf.

13. *Shopify objects to the definition of “Shopify Merchants” as overbroad, unduly burdensome, and not proportional to the needs of the case because Shopify has over two million merchants, the majority of which have no relevance to Plaintiffs’ claims whatsoever.*

14. *Shopify objects to the definition of “Infringement Notices” as overbroad, unduly burdensome, and not proportional to the needs of the case to the extent it calls for communications not sent by Plaintiffs and not related to Plaintiffs’ claims. Shopify further objects to this Definition as it includes characterizations of, and legal conclusions regarding, infringement of a copyright or a trademark and notifications pursuant to 17 U.S.C. § 512. Shopify further objects to the terms “processed” and “retained,” as referenced in the definition, as vague and/or ambiguous because they could have multiple meanings in this context.*

15. *Shopify objects to the definitions of “DMCA Agent”, “DMCA Notice”, and “DMCA Policy” to the extent it includes characterizations of, and legal conclusions regarding any obligations, duties, and requirements under the Digital Millennium Copyright Act, and Shopify’s compliance with such obligations, duties, and requirements.*

16. *Shopify objects to the definition of “Repeat Infringer Policy” to the extent it includes characterizations of, any legal conclusions regarding copyright infringement, any obligations, duties, and requirements under the Digital Millennium Copyright Act, and Shopify’s compliance with such obligations, duties, and requirements. Shopify further objects to the term “address,” as referenced in the definition, as vague and/or ambiguous because it could have multiple meanings in this context.*

17. *Shopify objects to the relevant time frame of January 1, 2017 to the present as overbroad, unduly burdensome, and not proportional to the needs of the case because of the*

relevant statute of limitations. Any responses provided by Shopify will be for the period of December 1, 2018 through December 1, 2022.¹

18. *Neither the fact that an objection is interposed to a particular interrogatory nor the fact that no objection is interposed necessarily means that responsive information exists.*

19. *All of these General Objections are incorporated into the Specific Objections set forth below as if repeated fully therein. The fact that Shopify may provide a response to an Interrogatory does not constitute a waiver of any general or specific objection.*

RESPONSES TO PLAINTIFFS' INTERROGATORIES

INTERROGATORY NO. 1:

Identify all persons, including current and former employees, with responsibility for designing, developing, or implementing Your policies, procedures, and practices for addressing copyright violations by Shopify Merchants, including by identifying the roles each such person held and the dates during which they had such responsibility.

RESPONSE TO INTERROGATORY NO. 1:

Shopify incorporates its General Objections, including with respect to Instructions and Definitions, as if fully set forth herein. Shopify further objects to the terms “designing”; “developing”; and “implementing,” as referenced in this Interrogatory, as vague and/or ambiguous because they could refer to multiple aspects and stages of Shopify’s creation and application of its policies, procedures, and practices to address notices of alleged copyright infringement. For the purposes of its response, Shopify will construe these terms to refer to the

¹ Subsequent to Shopify serving its Objections, the parties met and conferred on March 23, 2022 on Shopify’s Objections, including the temporal scope of Shopify’s Objections. Following this meet-and-confer process, Shopify has agreed to expand the temporal scope of its Responses herein to December 1, 2018 through March 1, 2022.

creation of its policies, procedures, and practices for addressing alleged copyright violations by Shopify Merchants after receiving valid written notice of the alleged violation pursuant to the DMCA. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Interrogatory to the limitations period. Shopify further objects to this Interrogatory to the extent it incorporates, contains characterizations of, or calls for legal conclusions with respect to copyright infringement. Shopify further objects to this Interrogatory to the extent that it seeks information that is protected by the attorney-client privilege, work product doctrine, or other privileges and protections, including that which may be implicated through the disclosure of the name of any attorneys. For the avoidance of doubt, should Shopify identify attorneys in its Response to Interrogatory No. 1, Shopify does not intend to waive, and is not waiving, its protections under the work product doctrine, attorney-client privilege, or any applicable privilege in connection with those attorneys.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify responds that Plaintiffs clarified during a meet-and-confer on March 23, 2022 that this Interrogatory seeks identification of Shopify personnel who were or are responsible for creating policies, procedures, and practices for addressing alleged copyright violations by merchants after receiving valid written notice of the alleged violation pursuant to the DMCA, or who have or had high-level managerial responsibility over implementation of those policies, procedures, and practices, but not lower-level employees responsible for day-to-day implementation thereof. Shopify identifies these individuals as:

1. Emily Hammond: Senior Manager, Trust & Safety Operations, February 2020 to

present; Manager of Trust & Safety Operations, February 2019 to February 2020; Manager, Legal Operations, December 2018 (and prior) to present.

2. Meghan Connolly: Senior Legal Counsel, Commercial, February 2022 to present; Legal Counsel, Product and Commercial, December 2018 to February 2022.

3. Monica Gallant: Director, Trust & Safety Operations, March 2019 to present; Director of Legal Operations, December 2018 (and prior) to March 2019.

4. Ryan Hubbard: Director, Litigation & Intellectual Property and Employment, February 2022 to present; Senior Legal Counsel – Litigation & Intellectual Property, August 2019 to February 2022.

5. Mike Bryan: Manager, Policy Operations, Intellectual Property Operations, Trust & Safety Operations, May 2021 to present; Manager, Trust & Safety Programs, January 2021 to May 2021; Senior Business Analyst, August 2020 to January 2021; Senior Intellectual Property Operations Specialist, December 2018 (and prior) to August 2020.

6. Anne Cobbett: Senior Manager, Trust & Safety Policy, January 2020 to present; Manager, Trust & Safety Policy, December 2018 (and prior) to December 2019.

7. Yolande Winegarten: Manager, Policy Operations, Trust & Safety, June 2021 to present; Team Lead, Intellectual Property Operations, Trust & Safety (Legal), January 2021 to June 2021; Intellectual Property Operations Specialist, Trust & Safety (Legal), January 2020 to January 2021.

8. Justin Howe: Manager, Trust & Safety Programs, February 2022 to present; Senior Technical Project Manager, May 2021 to February 2022; IP Operations Lead Operations Lead, February 2020 to May 2021; IP Operations Specialist - Trust & Safety, December 2018 (and prior) to February 2020.

9. Vivek Narayanadas: Vice President, Legal, Data Protection Officer, December 2018 (and prior) to December 2021.

INTERROGATORY NO. 2:

Identify all persons, including current and former employees, with responsibility for designing, developing, or implementing Your policies, procedures, and practices for addressing trademark violations by Shopify Merchants, including by identifying the roles each such person held and the dates during which they had such responsibility.

RESPONSE TO INTERROGATORY NO. 2:

Shopify incorporates its General Objections, including with respect to Instructions and Definitions, as if fully set forth herein. Shopify further objects to the terms “designing”; “developing”; and “implementing,” as referenced in this Interrogatory, as vague and/or ambiguous because they could refer to multiple aspects and stages of Shopify’s creation and application of its policies, procedures, and practices to address notices of alleged trademark infringement. For the purposes of its response, Shopify will construe these terms to refer to the creation of its policies, procedures, and practices for addressing alleged trademark violations by Shopify Merchants after receiving valid written notice of the alleged violation. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only to December 1, 2018. Shopify further objects to this Interrogatory to the extent it incorporates, contains characterizations of, or calls for legal conclusions with respect to trademark infringement. Shopify further objects to this Interrogatory to the extent that it seeks information that is protected by the attorney-client privilege, work product doctrine, or other privileges and protections, including that which may be implicated through the disclosure of the name of any attorneys. For

the avoidance of doubt, should Shopify identify attorneys in its Response to Interrogatory No. 2, Shopify does not intend to waive, and is not waiving, its protections under the work product doctrine, attorney-client privilege, or any applicable privilege in connection with those attorneys.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify responds that Plaintiffs clarified during a meet-and-confer on March 23, 2022 that this Interrogatory seeks identification of Shopify personnel who are or were responsible for creating Shopify's policies, procedures, and practices for addressing alleged trademark violations by merchants or who have or had high-level managerial responsibility over implementation of those policies, procedures, and practices, but not lower-level employees responsible for day-to-day implementation thereof. Shopify identifies these individuals as:

1. Emily Hammond: Senior Manager, Trust & Safety Operations, February 2020 to present; Manager of Trust & Safety Operations, February 2019 to February 2020; Manager, Legal Operations, December 2018 (and prior) to present.

2. Meghan Connolly: Senior Legal Counsel, Commercial, February 2022 to present; Legal Counsel, Product and Commercial, December 2018 to February 2022.

3. Monica Gallant: Director, Trust & Safety Operations, March 2019 to present; Director of Legal Operations, December 2018 (and prior) to March 2019.

4. Ryan Hubbard: Director, Litigation & Intellectual Property and Employment, February 2022 to present; Senior Legal Counsel – Litigation & Intellectual Property, August 2019 to February 2022.

5. Mike Bryan: Manager, Policy Operations, Intellectual Property Operations, Trust & Safety Operations, May 2021 to present; Manager, Trust & Safety Programs, January 2021 to

May 2021; Senior Business Analyst, August 2020 to January 2021; Senior Intellectual Property Operations Specialist, December 2018 (and prior) to August 2020.

6. Anne Cobbett: Senior Manager, Trust & Safety Policy, January 2020 to present; Manager, Trust & Safety Policy, December 2018 (and prior) to December 2019.

7. Yolande Winegarten: Manager, Policy Operations, Trust & Safety, June 2021 to present; Team Lead, Intellectual Property Operations, Trust & Safety (Legal), January 2021 to June 2021; Intellectual Property Operations Specialist, Trust & Safety (Legal), January 2020 to January 2021.

8. Justin Howe: Manager, Trust & Safety Programs, February 2022 to present; Senior Technical Project Manager, May 2021 to February 2022; IP Operations Lead Operations Lead, February 2020 to May 2021; IP Operations Specialist - Trust & Safety, December 2018 (and prior) to February 2020.

9. Vivek Narayanadas: Vice President, Legal, Data Protection Officer, December 2018 (and prior) to December 2021.

INTERROGATORY NO. 3:

Identify all persons, including current and former employees, with responsibility for designing, developing, or implementing any system You used for tracking Infringement Notices or with knowledge of the technical abilities of any system You used to receive and process Infringement Notices and take steps in response to such notices.

RESPONSE TO INTERROGATORY NO. 3:

Shopify incorporates its General Objections, including with respect to Instructions and Definitions, as if fully set forth herein. Shopify further objects to the Interrogatory on the ground that it is compound. Shopify further objects to the terms “designing”, “developing,”

“implementing”; and *“technical abilities,”* as referenced in this Interrogatory, as vague and/or ambiguous because they could refer to a number of different tasks related to software development. Shopify further objects to the term *“process,”* as referenced in this Interrogatory, as vague and/or ambiguous because it could have multiple different meanings in this context. Shopify further objects that this Interrogatory is overbroad, unduly burdensome, and not proportional to the needs of the case because as a software company many of Shopify’s employees have knowledge of the technical abilities of its system used to track Infringement Notices. For the purposes of its response, Shopify will identify the employees who created the system used to handle notices of alleged infringement received by Shopify. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Interrogatory to the limitations period. Shopify further objects to this Interrogatory to the extent that it seeks information that is protected by the attorney-client privilege, work product doctrine, or other privileges and protections, including that which may be implicated through the disclosure of the name of any attorneys. For the avoidance of doubt, should Shopify identify attorneys in its Response to Interrogatory No. 3, Shopify does not intend to waive, and is not waiving, its protections under the work product doctrine, attorney-client privilege, or any applicable privilege in connection with those attorneys.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify responds that the following Shopify personnel were responsible for creating the system used to handle notices of alleged infringement received by Shopify: Jason Seger, Anthony Clark, Emily Hammond, Monica Gallant, Justin Howe, Sacha Saroop, Mike Bryan, Anne Cobbett, Charles Watty, and John Duff.

INTERROGATORY NO. 4:

Describe in detail Your current policies, procedures, and practices with respect to terminating or suspending the Shopify accounts of Shopify Merchants repeatedly identified in Infringement Notices, including by identifying when you put in place each such policy, procedure, and practice.

RESPONSE TO INTERROGATORY NO. 4:

Shopify incorporates its General Objections, including with respect to Instructions and Definitions, as if fully set forth herein. Shopify further objects to this Interrogatory to the extent it seeks public information or information that is readily available to Plaintiffs. Shopify further objects to this Interrogatory as it imposes obligations and duties outside the scope of Fed. R. Civ. P. 33, and is more appropriately addressed through the production of business records pursuant to Fed. R. Civ. P. 33(d). Shopify further objects to this Interrogatory to the extent that it seeks information protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections, including with respect to legal analysis performed in connection with Infringement Notices. For the avoidance of doubt, Shopify does not intend to waive, and is not waiving, its protections under the work product doctrine, attorney-client privilege, or any applicable privilege in connection with Interrogatory No. 4.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify responds that pursuant to Fed. R. Civ. P. 33(d), it will produce non-privileged, non-work product documents in its possession, custody and control from which information responsive to Interrogatory No. 4 may be ascertained, to the extent such documents exist and have been located after a good-faith, reasonable search. This will include, without limitation, Shopify's:

IP Takedown Playbook, implemented prior to December 2018;

Repeat Infringer Policy, implemented prior to December 2018;

Enhanced Repeat Infringer Policy Playbook, implemented in or around February 2020;

Subsequent Notice Playbook, implemented in or around February 2022;

Enhanced IP Vetting Playbook, implemented in or around December 2020;

Reused Terminated Domain Playbook, implemented in or around April 2021;

Acceptable Use Policy, implemented prior to December 2018, available at <https://www.shopify.com/legal/aup>;

Terms of Service, implemented prior to December 2018, available at <https://www.shopify.com/legal/terms>;

Online Infringement Form, implemented prior to December 2018, available at <https://help.shopify.com/en/legal/dmca>; and

Help Center Documentation, implemented in or around March 2022 (previously incorporated in the Online Infringement Form), available at <https://help.shopify.com/en/manual/your-account/copyright-and-trademark>.

INTERROGATORY NO. 5:

Describe in detail any changes over time to Your policies, procedures, and practices with respect to terminating the Shopify account of a Shopify Merchant repeatedly identified in Infringement Notices, including by identifying when those changes took place.

RESPONSE TO INTERROGATORY NO. 5:

Shopify incorporates its General Objections, including with respect to Instructions and Definitions, as if fully set forth herein. Shopify further objects to this Interrogatory to the extent it seeks public information or information that is readily available to Plaintiffs. Shopify further

objects to this Interrogatory as it imposes obligations and duties outside the scope of Fed. R. Civ. P. 33, and is more appropriately addressed through the production of business records pursuant to Fed. R. Civ. P. 33(d). Shopify further objects to this Interrogatory to the extent that it is duplicative of Interrogatory No. 4. Shopify further objects to this Interrogatory to the extent that it seeks information protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections, including with respect to legal analysis performed in connection with Infringement Notices. For the avoidance of doubt, Shopify does not intend to waive, and is not waiving, its protections under the work product doctrine, attorney-client privilege, or any applicable privilege in connection with Interrogatory No. 5.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify responds that pursuant to Fed. R. Civ. P. 33(d), it will produce non-privileged, non-work product documents in its possession, custody and control from which information responsive to Interrogatory No. 5 may be ascertained, to the extent such documents exist and have been located after a good-faith, reasonable search. This will include, without limitation, Shopify's:

- IP Takedown Playbook;
- Repeat Infringer Policy;
- Enhanced Repeat Infringer Policy Playbook;
- Subsequent Notice Playbook;
- Enhanced IP Vetting Playbook;
- Reused Terminated Domain Playbook;
- Acceptable Use Policy;
- Terms of Service;

Online Infringement Form; and
Help Center Documentation.

INTERROGATORY NO. 6:

Identify the person(s) most knowledgeable about or responsible for Your current or former policies, procedures, and practices with respect to terminating or suspending the Shopify account of a Shopify Merchant repeatedly identified in Infringement Notices.

RESPONSE TO INTERROGATORY NO. 6:

Shopify incorporates its General Objections, including with respect to Instructions and Definitions, as if fully set forth herein. Shopify further objects that the phrase “most knowledgeable or responsible for” as used in this Interrogatory, is vague and/or ambiguous because there are many discrete topics within Shopify’s policies, procedures, and practices for which various person(s) have different degrees of knowledge. Shopify will use reasonable efforts to identify persons with relevant information regarding Shopify’s policies, procedures, and practices enacted pursuant to the DMCA. Shopify further objects to the Interrogatory to the extent it is cumulative and duplicative of other Interrogatories, including, for example, Interrogatories 1 and 2. Shopify further objects to this Interrogatory to the extent that it seeks information that is protected by the attorney-client privilege, work product doctrine, or other privileges and protections, including that which may be implicated through the disclosure of the name of any attorneys. For the avoidance of doubt, should Shopify identify attorneys in its Response to Interrogatory No. 6, Shopify does not intend to waive, and is not waiving, its protections under the work product doctrine, attorney-client privilege, or any applicable privilege in connection with those attorneys.

Subject to and without waiving its general and specific objections and only for purposes of

fulfilling its discovery obligations in the current proceeding, Shopify responds that the following individuals have relevant information regarding Shopify's policies, procedures, and practices with respect to terminating or suspending the Shopify account of a merchant repeatedly identified in Infringement Notices: Mike Bryan, Emily Hammond, Yolande Winegarden, and Monica Gallant.

INTERROGATORY NO. 7:

Where You terminate an account of a Shopify Merchant repeatedly identified in Infringement Notices, describe in detail any continued access to or use of the account, or digital files stored on Your computer servers in connection with the account, that You permit, support, or do not preclude thereafter.

RESPONSE TO INTERROGATORY NO. 7:

Shopify incorporates its General Objections, including with respect to Instructions and Definitions, as if fully set forth herein. Shopify further objects to this Interrogatory as it imposes obligations and duties outside the scope of Fed. R. Civ. P. 33, and is more appropriately addressed through the production of business records pursuant to Fed. R. Civ. P. 33(d). Shopify further objects to this Interrogatory to the extent it seeks information that is protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections to the extent it calls for privileged information of any kind. For the avoidance of doubt, Shopify does not intend to waive, and is not waiving, its protections under the work product doctrine, attorney-client privilege, or any applicable privilege in connection with Interrogatory No. 7.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify responds that pursuant to Fed. R. Civ. P. 33(d), it will produce non-privileged, non-work product documents in its possession, custody and control from which information responsive to Interrogatory No. 7 may be

ascertained, to the extent such documents exist and have been located after a good-faith, reasonable search. This will include, without limitation, Shopify's:

IP Takedown Playbook;
Repeat Infringer Policy;
Enhanced Repeat Infringer Policy Playbook;
Subsequent Notice Playbook;
Enhanced IP Vetting Playbook;
Reused Terminated Domain Playbook;
Acceptable Use Policy;
Terms of Service;
Online Infringement Form; and
Help Center Documentation.

INTERROGATORY NO. 8:

When Shopify terminates an account of a Shopify Merchant repeatedly identified in Infringement Notices, describe in detail any steps Shopify takes to (i) identify and suspend or terminate any other Shopify accounts held by that same Shopify Merchant, and (ii) prevent that Shopify Merchant from opening a new account.

RESPONSE TO INTERROGATORY NO. 8:

Shopify incorporates its General Objections, including with respect to Instructions and Definitions, as if fully set forth herein. Shopify further objects to this Interrogatory as it imposes obligations and duties outside the scope of Fed. R. Civ. P. 33, and is more appropriately addressed through the production of business records pursuant to Fed. R. Civ. P. 33(d). Shopify further objects to this Interrogatory to the extent that it seeks information that is protected by the

attorney-client privilege, attorney work product doctrine, or other privileges and protections to the extent it calls for privileged information, including with respect to the involvement of attorneys in the suspension or termination process. For the avoidance of doubt, Shopify does not intend to waive, and is not waiving, its protections under the work product doctrine, attorney-client privilege, or any applicable privilege in connection with Interrogatory No. 8.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify responds that pursuant to Fed. R. Civ. P. 33(d), it will produce non-privileged, non-work product documents in its possession, custody and control from which information responsive to Interrogatory No. 8 may be ascertained, to the extent such documents exist and have been located after a good-faith, reasonable search. This will include, without limitation, Shopify's:

Enhanced Repeat Infringer Policy Playbook;

Subsequent Notice Playbook;

Enhanced IP Vetting Playbook; and

Reused Terminated Domain Playbook.

INTERROGATORY NO. 9:

State how many Infringement Notices You received via email but, rather than processing the notice, responded with an email informing the submitter that the notice was not proper because it was submitted via email rather than through an online interface on Shopify.com.

RESPONSE TO INTERROGATORY NO. 9:

Shopify incorporates its General Objections, including with respect to Instructions and Definitions, as if fully set forth herein. Shopify further objects to the terms "processing" and "not proper," as referenced in this Interrogatory, as vague and/or ambiguous because they could have

multiple meanings in this context. Shopify further objects that this Interrogatory is overbroad, unduly burdensome, and not proportional to the needs of the case because it requires Shopify to compile and analyze data in a manner that is not maintained in the ordinary course of business and which would be unduly burdensome to compile, given Shopify's information management system. Shopify further objects to this Interrogatory as it imposes obligations and duties outside the scope of Fed. R. Civ. P. 33 because it calls for Shopify to perform additional legal and qualitative data analysis outside the scope of the Rules of Civil Procedure. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Interrogatory to the limitations period. Shopify further objects to this Interrogatory to the extent it incorporates, contains characterizations of, or calls for legal conclusions regarding what constitutes a "proper" notice. Shopify further objects to this Interrogatory to the extent that it seeks information that is protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections to the extent it calls for privileged information of any kind. For the avoidance of doubt, Shopify does not intend to waive, and is not waiving, its protections under the work product doctrine, attorney-client privilege, or any applicable privilege in connection with Interrogatory No. 9.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify states that as part of its standard business practices, it tracks Infringement Notices through a ticketing system rather than by notice. For all Infringement Notices it receives, Shopify creates tickets in its ticketing system, regardless of the manner in which it receives the Infringement Notice—thereby processing each

notice. There are thus no circumstances under which Shopify, “rather than processing the notice, responded with an email informing the submitter that the notice was not proper because it was submitted via email rather than through an online interface on Shopify.com,” and therefore, the number of Infringement Notices responsive to this Interrogatory is zero.

To the extent this Interrogatory seeks information regarding the reason certain tickets were actioned in a certain manner, including by emailing the complainant, as stated in Shopify’s objections, this Interrogatory seeks information to be compiled in a manner that is not maintained in the ordinary course of business by Shopify, and thus imposes burdens beyond the scope required by Rules 26 and 33 of the Federal Rules of Civil Procedure. Such a compilation would also require legal and qualitative data analysis outside the scope of Fed. R. Civ. P. 33, and would be particularly burdensome and disproportionate in light of the high volume of notices and communications at issue—totaling hundreds of thousands.

Shopify further responds pursuant to Fed. R. Civ. P. 33(d) that Shopify will produce non-privileged information from its ticketing system for the tickets associated with each Accused Shopify Merchant for the period of December 1, 2018 through March 1, 2022, regardless of whether the ticket is associated with Plaintiffs’ Infringement Notice or a third party’s Infringement Notice, from which information regarding the reason these tickets were actioned in a particular manner (including by emailing the complainant) may be ascertained, to the extent such documents exist and have been located after a good-faith, reasonable search.

INTERROGATORY NO. 10:

State how many Infringement Notices You received via email but, rather than processing the notice, responded with an email informing the submitter that the notice was not proper because it reported infringements involving multiple Shopify Merchants.

RESPONSE TO INTERROGATORY NO. 10:

Shopify incorporates its General Objections, including with respect to Instructions and Definitions, as if fully set forth herein. Shopify further objects to the terms “processing” and “not proper,” as referenced in this Interrogatory, as vague and/or ambiguous because they could have multiple meanings in this context. Shopify further objects that this Interrogatory is overbroad, unduly burdensome, and not proportional to the needs of the case because it requires Shopify to compile and analyze data in a manner that is not maintained in the ordinary course of business and which would be unduly burdensome to compile, given Shopify’s information management system. Shopify further objects to this Interrogatory as it imposes obligations and duties outside the scope of Fed. R. Civ. P. 33 because it calls for Shopify to perform additional legal and qualitative data analysis outside the scope of the Rules of Civil Procedure. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Interrogatory to the limitations period. Shopify further objects to this Interrogatory to the extent it incorporates, contains characterizations of, or calls for legal conclusions regarding what constitutes a “proper” notice. Shopify further objects to this Interrogatory to the extent that it seeks information that is protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections to the extent it calls for privileged information of any kind. For the avoidance of doubt, Shopify does not intend to waive, and is not waiving, its protections under the work product doctrine, attorney-client privilege, or any applicable privilege in connection with Interrogatory No. 10.

Subject to and without waiving its general and specific objections and only for purposes of

fulfilling its discovery obligations in the current proceeding, Shopify states that as part of its standard business practices, it tracks Infringement Notices through a ticketing system rather than by notice. For all Infringement Notices it receives, Shopify creates tickets in its ticketing system, regardless of the manner in which it receives the Infringement Notice—thereby processing each notice. There are thus no circumstances under which Shopify, “rather than processing the notice, responded with an email informing the submitter that the notice was not proper because it reported infringements involving multiple Shopify Merchants,” and therefore, the number of Infringement Notices responsive to this Interrogatory is zero.

To the extent this Interrogatory seeks information regarding the reason certain tickets were actioned in a certain manner, including by emailing the complainant, as stated in Shopify’s objections, this Interrogatory seeks information to be compiled in a manner that is not maintained in the ordinary course of business by Shopify, and thus imposes burdens beyond the scope required by Rules 26 and 33 of the Federal Rules of Civil Procedure. Such a compilation would also require legal and qualitative data analysis outside the scope of Fed. R. Civ. P. 33, and would be particularly burdensome and disproportionate in light of the high volume of notices and communications at issue—totaling hundreds of thousands.

Shopify further responds pursuant to Fed. R. Civ. P. 33(d) that Shopify will produce non-privileged information from its ticketing system for the tickets associated with each Accused Shopify Merchant for the period of December 1, 2018 through March 1, 2022, regardless of whether the ticket is associated with Plaintiffs’ Infringement Notice or a third party’s Infringement Notice, from which information regarding the reason these tickets were actioned in a particular manner (including by emailing the complainant) may be ascertained, to the extent such documents exist and have been located after a good-faith, reasonable search.

INTERROGATORY NO. 11:

Identify all persons, including current and former employees, with responsibility for promoting Shopify Merchants' use of Your products and services to market and sell digital copies of books.

RESPONSE TO INTERROGATORY NO. 11:

Shopify incorporates its General Objections, including with respect to Instructions and Definitions, as if fully set forth herein. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Interrogatory to the limitations period. Shopify further objects to this Interrogatory to the extent that it seeks information that is protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections to the extent it calls for privileged information of any kind. For the avoidance of doubt, Shopify does not intend to waive, and is not waiving, its protections under the work product doctrine, attorney-client privilege, or any applicable privilege in connection with Interrogatory No. 11.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify responds that there is no team or person(s) at Shopify specifically responsible for "promoting Shopify Merchants' use of Shopify's products and services to market and sell digital copies of books." That is, Shopify does not have a specific team or specific employees responsible for promoting merchants' use of Shopify to market e-books, as distinct from Shopify's general marketing function. Shopify further responds that the following individual has relevant information regarding the lack of Shopify personnel with responsibility for promoting Shopify Merchants' use of Shopify's products and

services to market and sell digital copies of books: Niree Noel Perian.

INTERROGATORY NO. 12:

State the number of Infringement Notices You received concerning Shopify Merchants, including DMCA Notices, each month January 1, 2017 to the present, and identify the person(s) most knowledgeable about such notices or communications.

RESPONSE TO INTERROGATORY NO. 12:

Shopify incorporates its General Objections, including with respect to Instructions and Definitions, as if fully set forth herein. Shopify further objects to this Interrogatory as compound with at least two subparts because it asks both for (1) the number of infringement notices and (2) the person most knowledgeable about such notices. Shopify further objects that the phrase “most knowledgeable about such notices or communications” as used in this Interrogatory, is vague and/or ambiguous because given the high volume of notices and communications at issue—totaling hundreds of thousands received annually—no person(s) can be said to be “most knowledgeable” about all such notices and communications. For the purpose of its response, Shopify will construe this phrase to mean the person(s) with primary responsibility for Shopify’s policies, procedures, and practices regarding handling of notices of alleged infringement generally. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Interrogatory to the limitations period. Shopify further objects to the Interrogatory to the extent it is cumulative and duplicative of other Interrogatories, including, for example, Interrogatories Nos. 1 and 2. Shopify further objects to this Interrogatory to the extent that it seeks information that is protected by the attorney-client privilege, attorney work product doctrine, or other

privileges and protections to the extent it calls for privileged information, including that which may be implicated through the disclosure of the name of any attorneys. For the avoidance of doubt, should Shopify identify attorneys in its Response to Interrogatory No. 12, Shopify does not intend to waive, and is not waiving, its protections under the work product doctrine, attorney-client privilege, or any applicable privilege in connection with those attorneys.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify states that as part of its standard business practices, it tracks Infringement Notices through a ticketing system rather than by notice. For all Infringement Notices it receives, Shopify creates tickets in its ticketing system, regardless of the manner in which it receives the Infringement Notice—thereby processing each notice. In total, 179,889 tickets related to alleged infringement of copyrighted works or trademarks were created by Shopify from December 1, 2018 through March 1, 2022. For each month, the number of tickets were as follows:

December 2018	1740
January 2019	2098
February 2019	1894
March 2019	2375
April 2019	2444
May 2019	2797
June 2019	2789
July 2019	3347
August 2019	3224
September 2019	3928
October 2019	4829
November 2019	4916
December 2019	4837
January 2020	4266
February 2020	3777
March 2020	4455
April 2020	5285
May 2020	6345

June 2020	6073
July 2020	6155
August 2020	5358
September 2020	7249
October 2020	7145
November 2020	5686
December 2020	6057
January 2021	6173
February 2021	6048
March 2021	5366
April 2021	5267
May 2021	4453
June 2021	5152
July 2021	4984
August 2021	5055
September 2021	5514
October 2021	4940
November 2021	4819
December 2021	4611
January 2022	4479
February 2022	3959

Shopify further states that the following person(s) had primary responsibility for Shopify's policies, procedures, and practices regarding handling of notices of alleged infringement generally during this time period: Mike Bryan, Emily Hammond, Monica Gallant, and Yolande Winegarden.

INTERROGATORY NO. 13:

State the number of notices or communications You sent to a Shopify Merchant notifying such Shopify merchant of any claim contained in an Infringement Notice, including any DMCA Notice, each month from January 1, 2017 to the present, and identify the person(s) most knowledgeable about such notices or communications.

RESPONSE TO INTERROGATORY NO. 13:

Shopify incorporates its General Objections, including with respect to Instructions and

Definitions, as if fully set forth herein. Shopify further objects to this Interrogatory as compound with at least two subparts because it asks both for (1) the number of infringement notices or communications sent to a Shopify Merchant and (2) the person most knowledgeable about such notices. Shopify further objects that the phrase “most knowledgeable” as used in this Interrogatory, is vague and/or ambiguous because given the high volume of notices and communications at issue—totaling hundreds of thousands received annually—no person(s) can be said to be “most knowledgeable” about all notices and communications. For the purpose of its response, Shopify will construe this phrase to mean the person(s) with primary responsibility for Shopify’s policies, procedures, and practices regarding handling of notices of alleged infringement generally. Shopify further objects that this Interrogatory is overbroad, unduly burdensome, and not proportional to the needs of the case because it requires Shopify to compile and analyze data in a manner that is not maintained in the ordinary course of business and which would be unduly burdensome to compile given Shopify’s information management system. Shopify further objects to this Interrogatory as it imposes obligations and duties outside the scope of Fed. R. Civ. P. 33 because it calls for Shopify to perform additional legal and qualitative data analysis outside the scope of the Rules of Civil Procedure. Shopify further objects to this Interrogatory to the extent it incorporates, contains characterizations of, or calls for legal conclusions regarding what constitutes a “DMCA Notice.” Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Interrogatory to the limitations period. Shopify further objects to the Interrogatory to the extent it is cumulative and duplicative of other Interrogatories, including, for example, Interrogatories Nos. 1 and 2. Shopify further objects to this Interrogatory to the extent

that it seeks information that is protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections to the extent it calls for privileged information, including that which may be implicated through the disclosure of the name of any attorneys. For the avoidance of doubt, should Shopify identify attorneys in its Response to Interrogatory No. 13, Shopify does not intend to waive, and is not waiving, its protections under the work product doctrine, attorney-client privilege, or any applicable privilege in connection with those attorneys.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, as stated in Shopify's objections, this Interrogatory seeks information to be compiled in a manner that is not maintained in the ordinary course of business by Shopify, and thus imposes burdens beyond the scope required by Rules 26 and 33 of the Federal Rules of Civil Procedure. Shopify's ticketing system does not compile the number of "notices or communications [Shopify] sent to a Shopify merchant notifying such merchant of any claim contained in an Infringement Notice." Such a compilation would also require legal and qualitative data analysis outside the scope of Fed. R. Civ. P. 33, and would be particularly burdensome and disproportionate in light of the high volume of notices and communications at issue—totaling hundreds of thousands.

Shopify further responds that within its ticketing system, various actions that Shopify may take on a ticket result in a "pass" of the ticket. Actions that result in a "pass" means that Shopify notifies the merchant of a claim contained in an Infringement Notice (*i.e.*, "passes" along the claim to the merchant). Actions that result in a "pass" are Shopify's standard business record of notices or communications that Shopify sends to merchants notifying merchants of any claim contained in an Infringement Notice. Shopify took 120,440 actions that resulted in a "pass" related to alleged infringement of copyrighted works or trademarks from December 1, 2018 through March 1, 2022.

For each month, the number of actions resulting in a “pass” were as follows:

December 2018	1173
January 2019	1357
February 2019	1248
March 2019	1551
April 2019	1608
May 2019	1804
June 2019	1933
July 2019	2348
August 2019	2258
September 2019	2552
October 2019	3109
November 2019	3513
December 2019	3083
January 2020	2868
February 2020	2724
March 2020	3037
April 2020	3418
May 2020	4376
June 2020	4125
July 2020	4252
August 2020	3636
September 2020	5043
October 2020	5057
November 2020	3947
December 2020	4061
January 2021	4311
February 2021	4254
March 2021	3415
April 2021	3738
May 2021	3105
June 2021	3467
July 2021	3394
August 2021	3367
September 2021	3558
October 2021	3040
November 2021	3131
December 2021	2572
January 2022	2689
February 2022	2318

Shopify further states that the following person(s) had primary responsibility for Shopify’s

policies, procedures, and practices regarding handling of notices of alleged infringement generally during this time period: Mike Bryan, Emily Hammond, Monica Gallant, and Yolande Winegarden.

INTERROGATORY NO. 14:

State, on a per penalty basis, the number of Shopify Merchants whose services You terminated, temporarily suspended, or otherwise adversely affected in response to Infringement Notices, including a DMCA Notice(s), for each month from January 1, 2017 to the present, and identify the person(s) most knowledgeable about such penalties and the person(s) responsible for the implementation of such penalties.

RESPONSE TO INTERROGATORY NO. 14:

Shopify incorporates its General Objections, including with respect to Instructions and Definitions, as if fully set forth herein. Shopify further objects to this Interrogatory as compound with at least three subparts because it asks for (1) “the number of Shopify Merchants whose services You terminated, temporarily suspended, or otherwise adversely affected in response to Infringement Notices”; (2) the person most knowledgeable about such penalties; and (3) the person(s) responsible for the implementation of such penalties. Shopify further objects that the phrases “on a per penalty basis”; “otherwise adversely affected”; and “most knowledgeable,” as used in this Interrogatory, are vague and/or ambiguous because these phrases could have many different meanings in this context, and because within Shopify’s policies, procedures, and practices regarding termination and temporary suspension of merchants in response to notices of alleged infringement, there are many discrete topics for which various person(s) have different degrees of knowledge. For the purpose of its response, Shopify will construe “person(s) most knowledgeable” to mean person(s) with primary responsibility for Shopify’s policies, procedures,

and practices regarding termination and temporary suspension of merchants in response to notices of alleged infringement generally. Shopify further objects that this Interrogatory is overbroad, unduly burdensome, and not proportional to the needs of the case because it requires Shopify to compile and analyze data in a manner that is not maintained in the ordinary course of business and which would be unduly burdensome to compile. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Interrogatory to the limitations period. Shopify further objects to the Interrogatory to the extent it is cumulative and duplicative of other Interrogatories, including, for example, Interrogatories Nos. 1 and 2. Shopify further objects to this Interrogatory to the extent that it seeks information that is protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections to the extent it calls for privileged information, including that which may be implicated through the disclosure of the name of any attorneys. For the avoidance of doubt, should Shopify identify attorneys in its Response to Interrogatory No. 14, Shopify does not intend to waive, and is not waiving, its protections under the work product doctrine, attorney-client privilege, or any applicable privilege in connection with those attorneys.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify responds that Shopify terminated 2,855 Shopify Merchants pursuant to Shopify's Repeat Infringer Policy from December 1, 2018 through March 1, 2022. For each month, the number of Shopify Merchants were as follows:

December 2018	20
January 2019	37

February 2019	21
March 2019	22
April 2019	25
May 2019	23
June 2019	22
July 2019	29
August 2019	44
September 2019	49
October 2019	67
November 2019	51
December 2019	51
January 2020	73
February 2020	66
March 2020	55
April 2020	77
May 2020	138
June 2020	166
July 2020	118
August 2020	138
September 2020	151
October 2020	99
November 2020	78
December 2020	94
January 2021	85
February 2021	47
March 2021	61
April 2021	51
May 2021	59
June 2021	75
July 2021	67
August 2021	89
September 2021	119
October 2021	96
November 2021	79
December 2021	88
January 2022	118
February 2022	107

Shopify further responds that Shopify terminated 58,551 Shopify Merchants pursuant to its Enhanced Repeat Infringer Policy from December 1, 2018 through March 1, 2022. For each month, the number of Shopify Merchants were as follows:

February 2020	8491
March 2020	2470
April 2020	4341
May 2020	3029
June 2020	3986
July 2020	11,833
August 2020	8518
September 2020	1657
October 2020	8439
November 2020	946
December 2020	182
January 2021	1146
February 2021	446
March 2021	508
April 2021	414
May 2021	83
June 2021	79
July 2021	94
August 2021	136
September 2021	115
October 2021	41
November 2021	119
December 2021	163
January 2022	118
February 2022	1197

Shopify further responds that its ticketing system does not compile “the number of Shopify Merchants whose services [Shopify] . . . temporarily suspended . . . in response to Infringement Notices[.]” As stated in Shopify’s objections, this Interrogatory seeks information to be compiled in a manner that is not maintained in the ordinary course of business by Shopify, and thus imposes burdens beyond the scope required by Rules 26 and 33 of the Federal Rules of Civil Procedure. Such a compilation would also require legal and qualitative data analysis outside the scope of Fed. R. Civ. P. 33, and would be particularly burdensome and disproportionate in light of the high volume of notices and communications at issue—totaling hundreds of thousands.

Shopify further responds that within its ticketing system, Shopify may take a “Pass & Hide

Final” action on a ticket. “Pass & Hide Final” actions are Shopify’s standard business record of instances in which a ticket may have resulted in the temporary suspension of a merchant’s account. Shopify took 12,292 “Pass & Hide Final” actions related to alleged infringement of copyrighted works or trademarks from December 1, 2018 through March 1, 2022. For each month, the number of “Pass & Hide Final” actions were as follows:

December 2018	342
January 2019	321
February 2019	276
March 2019	326
April 2019	160
May 2019	139
June 2019	185
July 2019	206
August 2019	194
September 2019	217
October 2019	277
November 2019	356
December 2019	298
January 2020	359
February 2020	325
March 2020	301
April 2020	310
May 2020	489
June 2020	490
July 2020	457
August 2020	431
September 2020	444
October 2020	376
November 2020	324
December 2020	310
January 2021	280
February 2021	404
March 2021	332
April 2021	326
May 2021	250
June 2021	300
July 2021	275
August 2021	382

September 2021	420
October 2021	270
November 2021	349
December 2021	305
January 2022	266
February 2022	220

Shopify further states that the following person(s) had primary responsibility for Shopify's policies, procedures, and practices regarding termination and temporary suspension of merchants in response to notices of alleged infringement generally during this time period: Mike Bryan, Emily Hammond, Monica Gallant, and Yolande Winegarden.

INTERROGATORY NO. 15:

Identify all persons, including current and former employees, who have reviewed, monitored, or taken any action with respect to any of the Shopify Merchants listed in Infringement Notices sent from or on behalf of Plaintiffs and, for each such person You identify, describe any such action(s) that person took.

RESPONSE TO INTERROGATORY NO. 15:

Shopify incorporates its General Objections, including with respect to Instructions and Definitions, as if fully set forth herein. Shopify further objects to this Interrogatory as compound with at least two subparts because it asks both for (1) all persons who have reviewed, monitored, or taken any action with respect to any Shopify Merchants listed in Infringement Notices and (2) descriptions of such action(s) that person took. Shopify further objects that the words "reviewed"; "monitored"; and "taken any action" as used in this Interrogatory, are vague and/or ambiguous because they could have many different meanings in this context. Shopify will construe these phrases to mean persons who have actioned any of the tickets created from Infringement Notices submitted on behalf of Plaintiffs. Shopify further objects to this Interrogatory as it imposes obligations and duties outside the scope of Fed. R. Civ. P. 33, and is more appropriately addressed

through the production of business records pursuant to Fed. R. Civ. P. 33(d). Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Interrogatory to the limitations period. Shopify further objects to the Interrogatory to the extent it is cumulative and duplicative of other Interrogatories, including, for example, Interrogatories Nos. 1 and 2. Shopify further objects to this Interrogatory to the extent that it seeks information that is protected by the attorney-client privilege, work product doctrine, or other privileges and protections, including that which may be implicated through the disclosure of the name of any attorneys or otherwise. For the avoidance of doubt, should Shopify identify attorneys in its Response to Interrogatory No. 15, Shopify does not intend to waive, and is not waiving, its protections under the work product doctrine, attorney-client privilege, or any applicable privilege in connection with those attorneys.

Subject to and without waiving its general and specific objections and only for purposes of fulfilling its discovery obligations in the current proceeding, Shopify responds that the following persons have actioned the tickets created from Infringement Notices submitted on behalf of Plaintiffs from December 1, 2018 through March 1, 2022: Mitchell Hamlyn, Justin Howe, Lia Cox, Mike Bryan, Emily Hammond, Matt Poirier, Yolande Winegarden, Abdulla Khatib, Kali Tripodis, Ollie Raskovsky, Brendan Holsberry, Carmen Morales, and Sage Johnston. Persons who have “actioned” a ticket means persons who were assigned in Shopify’s ticketing system to review the ticket in question to determine what, if any, action should be taken in response to the Infringement Notice(s) reflected therein.

Shopify further states that each Infringement Notice is processed in a ticket. In turn, each ticket may be subject to multiple actions by Shopify employees (such as reviewing a ticket,

communicating with the sender of the Notice, communicating with the merchant, or dispositioning the ticket, including by terminating a merchant). Plaintiffs' request for identification of any and all "action(s)" that any Shopify employees took on any Infringement Notices sent from or on behalf of Plaintiffs is unduly burdensome and disproportionate, because it would require the identification of thousands of discrete actions taken on thousands of tickets recording thousands of Notices.

Shopify further states that actions taken in response to notices of alleged infringement are stated in Shopify's policies and procedures, as well as in the tickets created upon receipt of Infringement Notices. Pursuant to Fed. R. Civ. P. 33(d), Shopify will produce non-privileged, non-work product documents in its possession, custody and control from which information responsive to Interrogatory No. 15 may be ascertained, to the extent such documents exist and have been located after a good-faith, reasonable search. These include, without limitation, tickets associated with each Accused Shopify Merchant for the period of December 1, 2018 through March 1, 2022, along with Shopify's:

- IP Takedown Playbook;
- Repeat Infringer Policy;
- Enhanced Repeat Infringer Policy Playbook;
- Subsequent Notice Playbook;
- Enhanced IP Vetting Playbook;
- Reused Terminated Domain Playbook;
- Acceptable Use Policy;
- Terms of Service;
- Online Infringement Form; and
- Help Center Documentation.

INTERROGATORY NO. 16:

Describe in detail all measures You have undertaken to confirm whether DMCA-compliant Infringement Notices that you receive by email but do not process are re-submitted via your online reporting tool.

RESPONSE TO INTERROGATORY NO. 16:

Shopify incorporates its General Objections, including with respect to Instructions and Definitions, as if fully set forth herein. Shopify further objects to the term “process,” as referenced in this Interrogatory, as vague and/or ambiguous because it could have many different meanings in this context. Shopify further objects to this Interrogatory as it imposes obligations and duties outside the scope of Fed. R. Civ. P. 33, and is more appropriately addressed through the production of business records pursuant to Fed. R. Civ. P. 33(d). Shopify further objects to the Interrogatory to the extent it is cumulative and duplicative of other Interrogatories, including, for example, Interrogatories Nos. 4, 5, 9 and 10. Shopify further objects to the extent this Interrogatory is unlimited in time, as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only from December 1, 2018 through December 1, 2021, and Shopify will limit its response to this Interrogatory to the limitations period. Shopify further objects to this Interrogatory to the extent that it seeks information that is protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections to the extent it calls for privileged information, including with respect to legal analysis with respect to infringement claims. For the avoidance of doubt, Shopify does not intend to waive, and is not waiving, its protections under the work product doctrine, attorney-client privilege, or any applicable privilege in connection with Interrogatory No. 16.

Subject to and without waiving its general and specific objections and only for purposes of

fulfilling its discovery obligations in the current proceeding, Shopify states that as part of its standard business practices, it tracks Infringement Notices through a ticketing system rather than by notice. For all Infringement Notices it receives, Shopify creates tickets in its ticketing system, regardless of the manner in which it receives the Infringement Notice—thereby processing each notice. There are thus no “measures” that could be undertaken with respect to “Infringement Notices that [Shopify] receive[s] by email but do[es] not process.”

INTERROGATORY NO. 17:

State, on a per penalty basis, the number of Shopify Merchants whose services You terminated, temporarily suspended, or otherwise adversely affected for violation(s) of Your Acceptable Use Policy other than copyright or trademark infringement for each month from January 1, 2017 to the present.

RESPONSE TO INTERROGATORY NO. 17:

Shopify incorporates its General Objections, including with respect to Instructions and Definitions, as if fully set forth herein. Shopify further objects that this Interrogatory seeks information not relevant to the claims or defenses of any party in this proceeding to the extent it seeks information regarding topics “other than copyright or trademark infringement” because this information falls squarely outside of Plaintiffs’ claims and is thus overbroad, unduly burdensome, and not proportional to the needs of the case. Shopify further objects that the phrases “on a per penalty basis” and “otherwise adversely affected” as used in this Interrogatory, are vague and/or ambiguous because these phrases could have multiple different meanings in this context. Shopify further objects to the time frame of January 1, 2017 as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only to December 1, 2018. Shopify further objects to this Interrogatory to the extent it incorporates,

contains characterizations of, or calls for legal conclusions regarding potential violation(s) of Shopify's Acceptable Use Policy. Shopify further objects that this Interrogatory is overbroad, unduly burdensome, and not proportional to the needs of the case because it requires Shopify to compile and analyze data in a manner that is not maintained in the ordinary course of business and which would be unduly burdensome to compile, given Shopify's information management system. Shopify further objects to this Interrogatory to the extent that it seeks information that is protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections to the extent it calls for privileged information, including to the extent the bases for termination could implicate privileged communications. For the avoidance of doubt, Shopify does not intend to waive, and is not waiving, its protections under the work product doctrine, attorney-client privilege, or any applicable privilege in connection with Interrogatory No. 17.

Based on its objections, Shopify will not respond to this Interrogatory.

INTERROGATORY NO. 18:

State the number of Shopify Merchants whose services You terminated for failing to pay amounts owing on the Shopify Merchant's account for each month from January 1, 2017 to the present.

RESPONSE TO INTERROGATORY NO. 18:

Shopify incorporates its General Objections, including with respect to Instructions and Definitions, as if fully set forth herein. Shopify further objects that this Interrogatory seeks information not relevant to the claims or defenses of any party in this proceeding to the extent it seeks information regarding termination for "failing to pay" because this information falls squarely outside of Plaintiffs' claims and is thus overbroad, unduly burdensome, and not proportional to the needs of the case. Shopify further objects to the time frame of January 1, 2017

as overbroad, unduly burdensome, and not proportional to the needs of the case: the statute of limitations extends only to December 1, 2018. Shopify further objects that this Interrogatory is overbroad, unduly burdensome, and not proportional to the needs of the case because it requires Shopify to compile and analyze data in a manner that is not maintained in the ordinary course of business and which would be unduly burdensome to compile, given Shopify's information management system. Shopify further objects to this Interrogatory to the extent that it seeks information that is protected by the attorney-client privilege, attorney work product doctrine, or other privileges and protections to the extent it calls for privileged information, including to the extent the bases for termination could implicate privileged communications. For the avoidance of doubt, Shopify does not intend to waive, and is not waiving, its protections under the work product doctrine, attorney-client privilege, or any applicable privilege in connection with Interrogatory No. 18.

Based on its objections, Shopify will not respond to this Interrogatory.

* * * * *

Objections and Responses by:

Dated: March 31, 2022

/s/ Jessica Stebbins Bina

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VERIFICATION OF INTERROGATORY RESPONSES

I, Monica Gallant, am the Director, Trust & Safety Operations at Shopify Inc. I believe, based on reasonable inquiry, that the foregoing answers are true and correct to the best of my knowledge, information and belief.

I verify under penalty of perjury that the foregoing is true and correct.

Executed March 31, 2022



Monica Gallant
Director, Trust & Safety Operations

Plaintiffs' Exhibit 4

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF VIRGINIA
Alexandria Division

-----: :
: :
SONY MUSIC ENTERTAINMENT, et al., :
Plaintiffs, :
: :
-vs- : Case No. 1:18-cv-950
: :
COX COMMUNICATIONS, INC., et al., :
Defendants. :
: :
-----:

HEARING ON MOTIONS

January 25, 2019

Before: John F. Anderson, U.S. Mag. Judge

APPEARANCES:

Matthew J. Oppenheim, Scott A. Zebrak, Jeffrey M. Gould,
and Kerry M. Mustico, Counsel for the Plaintiffs

Thomas M. Buchanan, Jennifer A. Golinveaux, and
Sean R. Anderson, Counsel for the Defendants

1 NOTE: The case is called to be heard at 10:01 a.m.
2 as follows:

3 THE CLERK: Sony Music Entertainment, et al. versus
4 Cox Communications, Inc., et al., civil action number
5 18-cv-950.

6 THE COURT: Go ahead, introduce yourselves, please.

7 MR. ZEBRAK: Good morning, Your Honor. Scott Zebrak,
8 counsel for the plaintiffs. With me today are my colleagues
9 Matthew Oppenheim, Kerry Mustico, Jeffrey Gould. My colleague,
10 Matthew Oppenheim, will be arguing.

11 MR. BUCHANAN: Good morning, Your Honor. Thomas
12 Buchanan on behalf of the defendant Cox. With me today are my
13 colleagues Jennifer Golinveaux and Sean Anderson. We will be
14 splitting the arguments. I'll be arguing the plaintiffs'
15 motion to compel, and then we're splitting the other argument.

16 THE COURT: Well --

17 MR. BUCHANAN: With regard to our motion to compel.

18 THE COURT: When you say "splitting," help me
19 understand what you mean by that.

20 MR. BUCHANAN: So I think there is six motions to
21 compel. I guess if we relate to the evidence --

22 THE COURT: Well, there is one motion to compel.

23 MR. BUCHANAN: Right, six parts.

24 THE COURT: There are a number of components parts to
25 that motion to compel.

1 MR. BUCHANAN: Right. So Ms. Golinveaux will be
2 arguing the motion to compel with regard to financial
3 information, with regard to the validity and ownership of the
4 copyrights, and with regard to the Cox documents.

5 And then the next four I will be arguing.

6 THE COURT: Okay. All right. We'll see how that
7 goes.

8 All right. I am going to take up the Sony motion
9 first.

10 I've read, certainly for the Sony motion, I have read
11 all the materials that were filed. I can't say that I've read
12 each and every exhibit from beginning to end, certainly in the
13 moving papers on the Cox.

14 But, Mr. Oppenheim, let me hear when you have got to
15 say about your motion to compel.

16 MR. OPPENHEIM: Good morning, Your Honor. The
17 plaintiffs' motion to compel, Your Honor, is seeking to require
18 Cox to disclose the number of subscribers it terminate -- Cox
19 terminated for violations of its Acceptable Use Policy or
20 failure to pay for the limited time period of 2010 to 2014.

21 And what we're moving to compel, Your Honor, are two
22 specific interrogatories, interrogatory number 6 and
23 interrogatory number 11, that we issued to the defendants.

24 I believe through the coerce of briefing that
25 we've -- we've narrowed down really what the dispute is here.

1 There is -- there is apparently no dispute by the defendants as
2 to burden or privilege. And the sole question before the Court
3 is whether or not the requested information is relevant to the
4 case.

5 THE COURT: Well, why is the level of detail that
6 you're asking necessary? And, you know, if you look at the
7 Acceptable Use Policy, your request to break it down by, you
8 know, area, really doesn't make any sense.

9 Because if you look at the Acceptable Use Policy, it
10 says, you know, we have the right to violate you for any breach
11 of law. And then it outlines a number of different other areas
12 in which you could be terminated.

13 And so, your request to do it by month, is that
14 right, and my category in the Acceptable Use Policy, just -- I
15 don't understand why you would ask for that level of detail.

16 MR. OPPENHEIM: So let me take those as two pieces.

17 Your Honor, the month-by-month request is so that it
18 will match up to the information that the defendants provided
19 us with respect to copyright terminations.

20 THE COURT: Well, what -- so what use is that?

21 MR. OPPENHEIM: Your Honor, what we would like to be
22 able to do is put in front of the jury or the Court, right, a
23 chart which shows month by month, here is the number of
24 warnings they received -- excuse me, notices they received.
25 Here are the number of warnings they sent. Here are the number

1 of terminations for AUP violations.

2 We don't need to break down all the AUP violations
3 outside of the copyright. So we're not -- to the extent that
4 there was any lack of clarity on this, we're not asking for
5 this person was terminated for spamming. This person -- we're
6 not asking for that, Your Honor --

7 THE COURT: Well, yes, you are. I mean, that's what
8 your motion asks for.

9 MR. OPPENHEIM: Well, Your Honor, what we're asking
10 for is broken down. We have copyright, they've given us that.

11 THE COURT: Right.

12 MR. OPPENHEIM: We want AUP as a category. And then
13 we want terminations for -- for non-payment month by month so
14 it fits in the same chart they have already given us on the
15 copyright policy.

16 And the reason, Your Honor, we believe this is
17 important, it goes both to the issue of liability and the issue
18 of damages.

19 THE COURT: Well, you don't even ask for that in your
20 interrogatory. For the terminations for non-payment, you only
21 asked for it by quarter, right?

22 MR. OPPENHEIM: Yes, Your Honor, but that was before
23 we had received the information, the documents from the
24 defendants that gave it month by month on the copyright basis.
25 We want to be able to match up, Your Honor.

1 If all they want to do is do it quarter by quarter, I
2 suppose that is what we asked, Your Honor. But we are just
3 trying to get a consistent spreadsheet so that we have one easy
4 set of data that we can put before the Court and the jury.

5 And I don't believe that they've articulated that the
6 month-by-month or -- is burdensome. Or that by -- by type of
7 violation, that is AUP or non-payment, is burdensome. All they
8 have said is it's not relevant. They can do it, they can do it
9 without burden.

10 And the question on relevance, Your Honor, is, okay,
11 should a jury know how easily and how quickly they terminate
12 subscribers when it fits their purpose. Right.

13 THE COURT: Nobody knows how easy it is.

14 MR. OPPENHEIM: Well --

15 THE COURT: Giving you the number of people that were
16 terminated doesn't tell you it was easy or hard, how long the
17 process went through. It is that was the end point of the
18 process.

19 MR. OPPENHEIM: But if they've terminated significant
20 volumes of users on the basis of non-payment or on the basis of
21 AUP violations as compared to copyright violations, then they
22 will be hard pressed, Your Honor, to put somebody on the stand
23 and say, well, it's quite burdensome to do these terminations
24 because the data will show otherwise.

25 And a jury has the right to know, to the extent that

1 Cox decides to put its own interests ahead of that of the
2 copyright owners in weighing the culpability.

3 THE COURT: I understand. Why 2010, '11, and '12 and
4 not just 2013 and 2014?

5 MR. OPPENHEIM: Your Honor, the data that Cox
6 provided on the copyright violations was --

7 THE COURT: Well -- okay. They had that in the can
8 from the other thing. They said, okay, we'll just give that to
9 you. That then doesn't drive the answer as to whatever else
10 you are entitled to get.

11 MR. OPPENHEIM: There is a marked change in the way
12 Cox terminated between those years, 2010 to 2014. And we want
13 to see -- excuse me, on the copyright side there is a marked
14 change. We want to see whether there is a marked change with
15 respect to the AUP violations and then on payment violations.

16 Again, they're not saying that it's burdensome.
17 They're just saying, well, it's not relevant.

18 Your Honor, I believe that a jury will want to know
19 what it is that Cox was doing to serve its own purpose while it
20 was undermining what the copyright owners were asking it to do
21 to serve their purposes and to abide by the law.

22 THE COURT: All right. I think I understand your
23 argument.

24 So this one --

25 MR. OPPENHEIM: Any --

1 THE COURT: -- Mr. Buchanan, are you -- you're
2 responding to this one?

3 MR. BUCHANAN: I'll be brief, Your Honor.

4 First of all, counsel didn't really address the
5 relevance of these documents. He focused on the issue that a
6 jury should be able to hear this and that somehow we would say
7 it's very burdensome to terminate.

8 Well, in their complaint, and in their papers they've
9 cited to our Accepted Use Policy. And as you've just pointed
10 out, it lists the reasons we can terminate people, violations
11 on a whole number of reasons. And there is no question we did
12 terminate people for these. But how is it relevant to the
13 issue of willfulness or the issue of whether we infringed
14 vicariously. That we could supervise our customers and our
15 subscribers. Whether in fact we terminated people more often
16 for phishing and to obtain someone's financial information and
17 possibly destroy their financial record and their name, and
18 identity theft, and whether they did it by hacking.

19 How, if you put those numbers up, is it relevant
20 whether we had 13 steps to terminate someone for copyright
21 infringement when someone could actually go copy that for a
22 dollar-seventeen. So I just -- I don't see the issue of
23 relevance.

24 How does it prove willfulness, that we knew of a
25 specific act of infringement? How does it show that we could

1 supervise and control our customers when the policy states,
2 which they have, that we can terminate? So they already have
3 that. They know that we can terminate for these reasons.

4 They just want to know, get the numbers up there up
5 there to say, look how greedy and corrupt they are. They
6 terminated when someone didn't pay, but then they took all
7 these steps to terminate when someone was infringing our rights
8 and our copyrights.

9 THE COURT: How does Cox maintain the data for
10 terminations? My question is, if I decide to require Cox to
11 produce some information as to terminations, how difficult is
12 it to do on a quarterly versus annual basis?

13 MR. BUCHANAN: First of all, we only have the
14 information back to 2012 for what they requested. I have
15 checked on that. So we don't go back -- they have asked to go
16 back to 2008, 2010.

17 And I think, obviously, it would be easy for us do it
18 annually and biannually than quarterly or monthly. So that's
19 certainly the case.

20 But we did not argue that it would be overly
21 burdensome to do this. But certainly that would be easier for
22 us to do.

23 THE COURT: Okay. Thank you.

24 All right, I think I understand the issues and have
25 read all the briefs. What I'm going to do is I am going grant

1 the motion in part. I'm going to require Cox to produce
2 for years 2013 and 2014 only quarterly. So not monthly,
3 quarterly, the number of people terminated for violation of the
4 Accepted -- Except -- Acceptable Use Policy. So -- and the
5 number of people terminated for failure to pay.

6 Just so that it's clear, for those two years, '13 and
7 '14 on a quarterly basis. You don't have to break down the
8 category on the Acceptable Use Policy. It's just the total
9 number of people. And I assume that would also include people
10 who were terminated for copyrights. So you will have to back
11 out those numbers.

12 So if the first quarter of 2013 had 10,000 people as
13 having been terminated, you've already got the information as
14 to the three months in 2013, and then you can do the math and
15 figure out for what other reasons.

16 But it will be granted in part as to those two years
17 only on a quarterly basis without having to break it down by
18 category in the Acceptable Use Policy.

19 MR. OPPENHEIM: Your Honor, may I ask one clarifying
20 question? Are you ordering that they produce a list of
21 terminations of AUP policy as one set of numbers and failure to
22 pay as a separate set of numbers?

23 THE COURT: Right. No, there are two separate
24 interrogatories.

25 MR. OPPENHEIM: Very well, thank you.

1 THE COURT: For the interrogatory number 6, they need
2 to provide that information for the Acceptable Use Policy. For
3 interrogatory number 11, they need to provide that information
4 for the failure to terminate on the financial reasons.

5 Okay. All right. So I'll now take up Cox's motion
6 to compel.

7 I guess I can do this -- again, I guess, let me -- I
8 am going to, I guess, do it -- there are seven different
9 categories. And it's Cox's intention to divide this up in
10 motions. Let me -- let me make sure I understand how that
11 works.

12 MR. BUCHANAN: Yes, Your Honor. So that the -- the
13 first -- in the first component --

14 THE COURT: The financial, the ownership, are going
15 to be argued by who?

16 MR. BUCHANAN: By Ms. Golinveaux.

17 THE COURT: Okay.

18 MR. BUCHANAN: And as well as the information
19 regarding Cox, Cox documents, that was the third one.

20 THE COURT: All right.

21 MR. BUCHANAN: Then I'm arguing the next four.

22 THE COURT: Okay.

23 MR. BUCHANAN: Which have to do with MarkMonitor,
24 RIAA, peer-to-peer information, and CAS.

25 THE COURT: Okay. All right, well, let's take them

1 up -- we will take up -- I'll do the arguments item by item.
2 So I'll hear argument from Cox first, and then I'll hear
3 argument from the plaintiffs, and then I'll decide that issue,
4 and then we'll move on to the second one.

5 So we'll take up the financial, the revenue and
6 profits information. And I -- you know, I -- one thing that
7 concerns me about this is that you filed a motion, you outlined
8 a number of document requests that you were asking me to order
9 them to produce documents in response to it, which are far
10 beyond what you now say in your reply brief that we got last
11 night that you're really looking for.

12 I mean, you say, we're not looking for profit and
13 loss information, but you include in your motion requests that
14 only ask for profit and loss information.

15 You know, you say that the plaintiff has, you know,
16 made all these arguments that are not necessary to be made.
17 Well, you actually include in your motion document requests
18 that are specifically only asking for profit and loss
19 information.

20 I don't -- I'm confused about that. I mean, I spent
21 a lot of time going through your document requests that ask for
22 profit and loss information because you put them in your motion
23 and said, I want this to be a part of, you know, what you rule
24 on. And then we get this reply brief and you say, you know,
25 oh, never mind.

1 Help me understand that.

2 MS. GOLINVEAUX: Yes, Your Honor. So Cox's initial
3 request, the document request, sought profit, expenses, and
4 revenue per work per medium because that's what our expert has
5 told us would be most useful.

6 We spent -- we've spent a number of hours on the
7 phone with plaintiffs, and they said they don't maintain the
8 profit and loss information by work. They don't do it.

9 So as part of the process to compromise, we offered
10 during the meet and confers to narrow those requests to just
11 their revenue per work per channel because they said they also
12 didn't keep it by medium.

13 So we tried to make that clear in our -- in our
14 opening motion, that what we're moving on is what we think they
15 likely do have.

16 THE COURT: Well then, why would you include in your
17 list of document requests that you were moving this Court on:
18 Your detailed and itemized profit and loss statements or
19 reports provided in readable and useable format organized by
20 each of the copyrighted works for each of the last ten years?

21 MR. BUCHANAN: Because, Your Honor, those were the
22 initial requests. And during the process of meeting and
23 conferring, we narrowed them because plaintiffs explained to us
24 that they didn't maintain the data that way.

25 THE COURT: Well, you don't -- you know, narrow them

1 and completely rewriting them are completely different things.

2 I mean, you know, there are other requests that cover
3 financial information. But that's neither here nor there, I
4 guess. I just -- all right.

5 Also help me understand why you think this
6 information is readily available, which you've indicated in
7 your pleadings.

8 MS GOLINVEAUX: Your Honor, plaintiffs have told us
9 specifically that the profit and loss statements per work is
10 not available, they don't maintain their records that way.

11 But they've never said they don't have revenue per
12 work. And they don't say that in their opposition brief.

13 And in fact, that's just what BMG produced in the
14 last case. And Your Honor may recall because that issue was up
15 in --

16 THE COURT: Well, they voluntarily did it. I didn't
17 order them to produce it. They said, we have this and we'll
18 produce it. So the idea that I ordered them to produce it I
19 think is an overstatement.

20 MS. GOLINVEAUX: Fair enough, Your Honor. There
21 was -- there was an order with respect to the scope of that
22 production.

23 THE COURT: Right.

24 MS. GOLINVEAUX: And our expert, who has -- our
25 financial expert, who we've disclosed to the plaintiffs, who

1 has dealt with this issue in a number of cases, believes also
2 that this would be a way that the major -- the labels and the
3 music publishers would keep the information.

4 And, Your Honor, if you look at the declarations they
5 put in with their opposition, they never say they don't keep
6 that information.

7 THE COURT: Well, one of them hints at it, but the
8 others talk about profit and loss. One does make a mention as
9 to revenue.

10 MS. GOLINVEAUX: And that's Mr. Abithol, I think,
11 Your Honor, who seems to indicate that the revenue numbers do
12 exist, at least for Sony ATV. But nowhere have they said those
13 don't exist. If they don't -- we have been on the phone with
14 them for hours now. They could have told us that, we would
15 have worked something out.

16 We're not trying to put them to a lot of work to
17 organize documents in a way -- or data in a way that doesn't
18 exist. We're just trying to get meaningful data for our
19 financial expert.

20 THE COURT: Right. And when you say, "revenue by
21 work and by channel," help me understand what you mean by
22 "channel," given that there is some indication that there is
23 many different channels or types of revenue streams having to
24 do with TV commercials and other things.

25 And I am trying to understand how granular you need

1 that information for your purposes in this case.

2 MS. GOLINVEAUX: Well, Your Honor, we initially
3 requested by medium, which they said they didn't have. By
4 channel, which is what we moved to because it sounds like that
5 may be the way the data is maintained, what we mean by that is
6 the different channels through which they distribute these
7 works. And that would be physical sales, which would be CDs or
8 records. Digital downloads would be another channel.
9 Streaming would be another. And licensing would be another.

10 THE COURT: Okay. So if you get -- I understand your
11 argument on revenue by work by channel. Okay. I don't
12 understand how you think any other aggregate information will
13 be useful as far as profits go.

14 So, profit by artist, you know, profit by something
15 that is a much larger than by work information, I don't see how
16 that can be used.

17 Breaking it down, maybe in an overall sense as to,
18 you know, this type of industry, what things are. But having
19 them go through the process of saying how much a certain artist
20 might do when only one or two of his or her works are part of
21 here, how that comes into play and how that is, I would say,
22 important to the issue at stake and how it would be used in
23 resolving an issue at stake, and the level of detail it would
24 take to do that.

25 MS. GOLINVEAUX: Right. Your Honor, we agree with

1 you that that would not -- if we can get the revenue by
2 channel, by work, that's more directly relevant. And we don't
3 need to you put them through the task of that -- of those other
4 data points. Really, those were, if we can't get that
5 information, we really have nothing else to go on. That would
6 be a proxy. But if we could get the revenue by work, that
7 would be acceptable.

8 THE COURT: All right. And you're asking for it from
9 2010 to 2014; is that right? That's what the limited --

10 MS. GOLINVEAUX: That's correct, Your Honor.

11 THE COURT: Okay. And help me understand why we're
12 going three years beyond the claim period -- the claim period
13 I'm -- I know it's only 22 months, but I'm saying it is 2013
14 through 2014. So you're asking for 2010, 2011, and 2012.

15 MS. GOLINVEAUX: Your Honor, certainly the most
16 relevant information would be for the claim period. We have
17 asked for the three years prior as well because it would be
18 relevant to showing trends in terms of how these works were
19 distributed.

20 The music industry in terms of distribution has
21 changed dramatically over that time period in terms of whether
22 people were primarily downloading these works versus streaming
23 them, for example. And that type of data would help us show
24 that.

25 If the plaintiffs say, well, going back to 2010

1 really gets more difficult because it's not maintained as
2 readily, I think we could certainly live with going two years
3 back before the claim period.

4 THE COURT: Okay. Thank you.

5 I will hear plaintiffs' response. First of all, have
6 you filed something with the Court that specifically limits
7 your damages to statutory damages?

8 MR. OPPENHEIM: Not with the Court. But we have
9 given an affirmation --

10 THE COURT: Well, you need to do that, and you need
11 to do that right away.

12 MR. OPPENHEIM: Yes, Your Honor, we can do that.

13 THE COURT: And, you know, I don't want there to be
14 any backtracking. I don't want there to be any, you know,
15 rethinking of that issue. I'm now deciding this case as if you
16 have filed with the Court a binding stipulation that you are
17 only seeking statutory damages.

18 Are you comfortable with that?

19 MR. OPPENHEIM: Absolutely, Your Honor, we have
20 elected statutory damages and we've informed the defendants of
21 that both orally and in writing, Your Honor, and we will file
22 something with the Court. Not an issue.

23 THE COURT: And you plan to have your expert serve
24 his or her report on damages by April 10; is that correct?

25 MR. OPPENHEIM: I don't have the schedule in front of

1 me. Whatever the schedule is, Your Honor, that is our --

2 THE COURT: I believe that's the date for the initial
3 expert reports.

4 MR. OPPENHEIM: Very well, Your Honor.

5 THE COURT: I assume you've got an expert that you're
6 going to have on damages; is that right?

7 MR. OPPENHEIM: We are still working through all of
8 our expert issues, Your Honor, but I assume we will have some
9 experts who will speak to financial issues.

10 THE COURT: Okay. All right.

11 MR. OPPENHEIM: If I -- I'm sorry, Your Honor.

12 THE COURT: Go ahead. And now I need you to address
13 the -- why I shouldn't require the plaintiffs in this case, who
14 decided to bring this case, decided to bring this case alleging
15 11,000 works with various different entities, you made that
16 decision, and why they shouldn't be required to produce revenue
17 by work by channel for a period of time.

18 MR. OPPENHEIM: And, Your Honor, let me answer that.
19 Once again, I want to address your first point first.

20 Your Honor, in the defendants' proposed order that
21 they filed with their motion, they actually asked the Court to
22 compel production of all of those requests for production --

23 THE COURT: Well, it also says, as modified by my --
24 by their memorandum. And I don't know what that means. So,
25 I'm --

1 MR. OPPENHEIM: Anyway. You understand -- we
2 appreciate Your Honor understands that. Very well.

3 THE COURT: I was confused, you were confused, but we
4 are going to deal with these issues directly.

5 MR. OPPENHEIM: Very well. So the defendants want
6 this information, they say, because they want to put an actual
7 damages analysis in front of a jury. So they say, let us get
8 the historical revenue information. That, Your Honor, however,
9 it's a non sequitur. Right. The fact that they want an actual
10 damages analysis has nothing to do with the historical revenue
11 streams. Right. Historical revenue streams won't help anybody
12 do an actual damages analysis.

13 If you want to do an actual damages analysis and you
14 want to figure out what the lost revenues were, you would say,
15 okay, what would be the revenues per, per lost digital download
16 or per lost stream, multiplied times the number of losses.
17 Right. How many distributions did each of their subscribers
18 make. And it's a calculus, it's a simple mathematical
19 equation. And there are two -- there are two variables.

20 So the historical information doesn't help inform
21 either one of those variables.

22 THE COURT: It may. I mean, if there is a
23 copyrighted work in which there has been no revenue for four
24 years, don't you think that's going to be significant?

25 MR. OPPENHEIM: No, Your Honor, because if there is

1 -- if there are illegal distributions of it, right, and that
2 work was -- was displaced sales. Maybe that's why there were
3 no sales, because their subscribers were massively infringing
4 it.

5 Now, in reality, we're talking about 11,000 works.
6 The overwhelming majority of them are very well known because
7 they are distributed by one of the major record companies or
8 music publishers in this country.

9 But, Your Honor, what -- we've tried to work with the
10 defendants to get at what they want here.

11 THE COURT: All right. Well, they want revenue by
12 work by channel.

13 MR. OPPENHEIM: But the historical revenue, Your
14 Honor, doesn't inform that first variable.

15 What does inform that first variable is what would be
16 the lost revenue for each one of the distribution. Leave
17 aside, they're never going to get the second variable, that is
18 how many distributions there were, they can't tell us, nobody
19 can tell us. Right. But even if they want that first
20 variable, we've given them a proffer, Your Honor, a detailed
21 proffer from each of the entities of what that -- what that
22 lost revenue per work is. Right.

23 We didn't have to do that. We did that to address
24 their request. So we went ahead and we did that. And that
25 actually informs on that one variable.

1 So we've -- we've done what they need for their
2 purposes. Now they come and they say, well, we want historical
3 revenue data on 11,000 works.

4 And we have declarations from every one of the
5 companies saying, this would be a massively burdensome --

6 THE COURT: No, you don't. And I went through, after
7 I got the reply last night, to see what your declarations say.
8 And they talk about how profit and loss information and how to
9 decide how much money you would take from the gross revenues to
10 determine, you know, all those other kinds of things is
11 difficult and would take a long time.

12 Nowhere does anybody say, we don't keep profit and --
13 we don't keep revenue by work data.

14 MR. OPPENHEIM: And, Your Honor, to be clear, I'm not
15 saying that they say that they don't keep it. But there is a
16 huge distinction between they don't keep it and how burdensome
17 it would be to collect it.

18 THE COURT: All right. Show me --

19 MR. OPPENHEIM: So Mr. Leak's --

20 THE COURT: -- in any one of the declarations.

21 MR. OPPENHEIM: Sure.

22 THE COURT: -- where they say it's burdensome to
23 produce revenue by work by channel.

24 MR. OPPENHEIM: So in Mr. Leak's declaration,
25 paragraph 9, Your Honor.

1 THE COURT: Which -- which exhibit is he?

2 MR. OPPENHEIM: Let me see which declaration that is.
3 It's 82-8, Your Honor, in the filing, if that helps.

4 THE COURT: 82-8. Okay.

5 MR. OPPENHEIM: And I am just going to turn as one
6 example, paragraph 9, Your Honor. It says in the second
7 sentence: Determining all the revenue generated on a
8 track-by-track basis (or even worse, including albums or EPs)
9 in a particular time period going back a number of years is
10 extremely time consuming, even if the inquiry is limited to
11 U.S. revenue.

12 THE COURT: Where are we?

13 MR. OPPENHEIM: I am sorry, the second sentence of
14 paragraph 9.

15 THE COURT: The second sentence: Determining all the
16 revenue generated on a track-by-track basis -- okay.

17 MR. OPPENHEIM: It goes on, Your Honor, and it
18 discusses the difficulty in gathering this.

19 Or, Your Honor, I mean, I can go through --

20 THE COURT: All right. You know, that's the one that
21 I think discussed difficulty, but doesn't really put any meat
22 on the bones as to extremely difficult, a lot of different
23 things to do, and then puts the caveat, they're demanding all
24 related documentation, that would include certain things, which
25 they're not. They just want to know now the revenue by

1 channel.

2 MR. OPPENHEIM: Your Honor --

3 THE COURT: Okay.

4 MR. OPPENHEIM: We had to respond on many numerous
5 requests, including profit and loss, because they included
6 everything in their works. We did this on a two-day basis.
7 They did it on a holiday weekend. To the extent you want
8 supplemental declarations on the burden, we're happy to provide
9 them.

10 Every one of these declarations, I can go through
11 them, Your Honor, Mr. McMullan's declaration for Universal
12 Music -- give me that number, please. Similarly in paragraph
13 11 says: Revenue data --

14 THE COURT: Hold on, I want to get it because I tried
15 to go through here and find out where any of these things
16 focussed on the issue of -- all right, what paragraph do you
17 say?

18 MR. OPPENHEIM: 82-2, sorry, in paragraph 11.

19 THE COURT: I have got it. Cost data with respect to
20 given sound recordings. It's complicated, costs include, and
21 then he goes through and talks about that. Many of the
22 costs -- revenue data would be voluminous and include documents
23 or information related to millions of tracks each year, as well
24 as licensing and so and so.

25 It doesn't say -- it would be voluminous, of course,

1 you have got a 11,000 copyrights, so --

2 MR. OPPENHEIM: Well, he says --

3 THE COURT: So, you know, no doubt that is going to
4 be voluminous.

5 MR. OPPENHEIM: Well, he says revenue data would be
6 similarly voluminous, and include documents or information
7 relating to millions and millions of track and album sales made
8 each year, as well as licensing deals and television and movie
9 studios, retailers, streaming service, satellite and cable
10 service.

11 By the way, the request for licensing deals, when --
12 that a record company or a music publisher does a deal with a
13 movie studio to put a track on a movie, how that is relevant, I
14 have no idea.

15 But every one of these declarations discussions the
16 burden associated with providing this revenue data. And when
17 you compare that burden with the relevance for what they are
18 using it, that is to show actual damages in a statutory damage
19 case where we've given them a proffer, which they haven't even
20 explored yet with any witnesses, Your Honor, seems to go too
21 far.

22 So we have -- so the burden has to be measured in
23 comparison to the relative value of the discovery in this
24 context.

25 I'm happy to go through other declarations, Your

1 Honor, but --

2 THE COURT: No, I mean --

3 MR. OPPENHEIM: -- they have -- so, Your Honor, there
4 are statements by each one of the plaintiff groups in this case
5 describing that providing this revenue data would be
6 burdensome. It would require an enormous amount of pulling of
7 information. It is described as to each plaintiff group. And
8 that burden needs to be measured as against the value of it.

9 Your Honor, to be clear, we're not saying that the
10 data doesn't exist, but it doesn't exist in a single system
11 where it's just a computer-generated printout. If that were
12 the case, then we would just simply be arguing relevance.

13 But it would require an enormous amount of effort and
14 time and money to extract all of this information for -- for a
15 purpose that the defendants haven't explained.

16 THE COURT: Well, I think they have explained the
17 purpose for it. I don't think -- and again, I'm focusing on a
18 very limited aspect of what was requested in the various
19 document requests, 27, 28, 29, 36, 41, 43, and 44, and
20 interrogatories 2 and 3.

21 You know, I think under the circumstances -- and, you
22 know, I -- you know, there is no reasonable argument that
23 revenues do come into play even when you have statutory
24 damages. So that puts it in the realm of we don't just get to
25 wash our hands of, you know, profit and loss information and

1 revenues and lost revenues and things like that, just because
2 we have statutory damages.

3 And I understand that getting revenues doesn't
4 translate directly into it, but it gives one a sense of how one
5 could calculate on an industry basis what one could expect a
6 general range of profit and loss to be based on revenues.

7 MR. OPPENHEIM: So, Your Honor, what's interesting is
8 that the defendants pointed to the BMG case and what happened
9 in that case. We went back and looked. And without seeing
10 exactly what data was produced, we do know what their expert
11 said and did.

12 And all he did -- he didn't actually point to the
13 revenues, lost revenue per track. What he did is he did an
14 analysis to determine the proportion of revenue from digital
15 downloads versus streaming. So he took -- he got all of this
16 massive historical data and then he came up with just a simple
17 percentages.

18 That is, frankly, if that's all the expert wants,
19 that's publicly available information. You don't need to ask
20 for historical revenue data to figure out the proportion of
21 streaming to downloads. IFPI issues international reports on
22 those kinds of statistics, and their expert, I am sure, has
23 them or can easily find them.

24 So they argued for it, ultimately agreed, BMG agreed
25 to provide all that historical data in light of the motion, but

1 then it wasn't even -- wasn't even used.

2 He did nothing whatsoever, Your Honor, with
3 information with respect to licenses or physical sales. The
4 only information the expert in BMG used was downloads and
5 streams, and only for developing proportional information.

6 THE COURT: Well, that -- are you indicating that if
7 I was to order it, that I should only order it for downloading
8 and streaming and not for physical sales and licenses revenue?

9 MR. OPPENHEIM: So, Your Honor, I don't -- to be
10 clear, we think that you should deny it outright.

11 But if Your Honor were going to go down the road of
12 ordering something here, what I would -- what I would think to
13 do is start with a sample. Pick -- if what they want to get is
14 a sense of what the revenue per track is on streaming or on
15 downloading, let's pick 50 compositions, 50 sound recordings
16 and provide that on those two categories. And then let them
17 ask questions.

18 And if that sample shows anything to justify more
19 information, then we can certainly have a discussion about
20 that.

21 But the idea, given the burden and the relative use
22 here, I think the idea of asking us to produce all of the
23 historical revenue information for all 11,000 tracks when Cox
24 in the past didn't use it after asking for it --

25 THE COURT: Well, you know, I told you all this every

1 time you come in here, this is not the BMG case. You've got
2 different counsel representing Cox, you know. So, you know,
3 this is different counsel representing the plaintiffs in this
4 case who are different plaintiffs. So this is not just a redo
5 of the BMG case.

6 MR. OPPENHEIM: Absolutely, Your Honor, we agree, we
7 absolutely agree. But we've put forward, Your Honor,
8 declarations of burden. The defendants in their reply brief
9 say we haven't. We absolutely have, Your Honor, and they are
10 there.

11 THE COURT: All right. All right, quickly. Why
12 shouldn't I limit it to downstream -- to downloading and
13 streaming before I provide the revenue information?

14 I mean, licensing, I don't see how that one could
15 come into play significantly in someone who is allegedly using
16 peer-to-peer software to download certain individual
17 copyrighted works and who was doing licensing it to be used in
18 a movie or something like that.

19 Physical sale probably is a little bit closer, but
20 let me hear why I shouldn't just limit it to downloading and
21 streaming, those channels.

22 MS. GOLINVEAUX: Yes, Your Honor. For the licensing
23 royalty, I really think goes to the point Your Honor made about
24 the value of these individual works. Some of them, the
25 plaintiffs enjoy far more revenue than others. And the

1 licensing royalty would be relevant to that, and that would be
2 relevant to an appropriate level of statutory damages.

3 I think it is more attenuated than the physical
4 sales, the digital downloads, and the streaming revenue, but
5 that's the relevance of the licensing revenue.

6 And with physical sales -- with physical sales, the
7 expert would use those in the same way that he would use the
8 download and streaming revenue to look at the relative
9 proportions. And because we don't know if -- but for the
10 alleged infringement in the case, how that person would have
11 enjoyed the track otherwise.

12 THE COURT: Well, you know, I'm pretty ignorant in
13 this issue, so you'll have to help me understand.

14 But a copyrighted work that you're saying being
15 infringed, let's just say it's one song by an artist. If that
16 song is included in a CD that includes many other songs, how
17 would one know that the physical purpose -- purchase of a CD
18 would relate to that individual copyrighted work and what
19 percentage of it would apply to that individual sale of a
20 physical CD.

21 MS. GOLINVEAUX: Well, Your Honor, with alleged
22 infringement, it's an issue in the case, there are -- there
23 will likely be users who are downloading albums as opposed to
24 songs. So I think it is relevant to the alleged infringements.

25 THE COURT: But they're also, I assume, individual

1 songs as well, right?

2 MS. GOLINVEAUX: Your Honor, I think that is likely
3 true, yes.

4 THE COURT: Okay. Well, again, one does not strive
5 for perfection in ruling on these things. One tries to rule
6 and move on and let the parties try and do things as best they
7 can given the information that they will have and have to do.

8 You're going to get their expert report on April 10,
9 it is going to have damages information. So my ruling is not
10 going to preclude you from seeking more information once you
11 get their expert report and provide -- come to me and say, you
12 know, based on their expert, my expert needs X.

13 I'll tell you that if your expert report comes in and
14 it has a lot of information that you say was too hard to get,
15 too tough to do, couldn't do it, all that kind of stuff, your
16 expert may not be able to testify.

17 I mean, I will consider a motion that would preclude
18 him or her from testifying if your representations that you and
19 your clients have made were only to defend against discovery
20 and not to prepare your own case.

21 MR. OPPENHEIM: Understood, Your Honor.

22 THE COURT: So you're going to be stuck with that.

23 You know, in reading through the declarations, you
24 know, I don't find that they are adequate to support a
25 proportionality argument relating to revenue information by

1 work. I think that a time period from 2011 through 2014 of
2 providing revenue by work is appropriate. And I think under
3 the circumstances of doing it, I'm going to at this point in
4 time, going to go ahead and do it by channel, including
5 physical sales, downloads, streaming, and licensing.

6 I mean, I think, you know, that's certainly
7 information that is relevant. Whether it is highly relevant, I
8 think arguably probably doesn't meet the highly relevant
9 component, but I do think it's relevant. And I am going to
10 require them to produce that information.

11 So it's going to be from 2011 through 2014, revenue
12 by work by channel, including those four channels, physical,
13 downloads, streaming, and licensing. Okay? Thank you.

14 MR. OPPENHEIM: May I ask a question, Your Honor?

15 THE COURT: Okay.

16 MR. OPPENHEIM: I guess I don't understand why the
17 information from 2011 and 2012 would be required.

18 Cox isn't required to provide termination information
19 for those years, but we have to provide revenue information for
20 those years? Clearly to the extent they are trying to show
21 actual damages, that revenue information wouldn't be relevant.

22 THE COURT: Well, it shows trends, so --

23 MR. OPPENHEIM: But similarly with respect to the AUP
24 terminations, we asked for it for purposes of showing trends
25 and changes and what their behavior --

1 THE COURT: Well, no. I mean, the real reason you're
2 getting that information is to show that they have the
3 authority to do something and they exercised that authority
4 during the time period.

5 I'm not going to let you reargue this. I have
6 decided it. You know, if you need clarification on what the
7 actual ruling is -- but that's the ruling. That's what your
8 client is going to be required to do. Okay?

9 MR. OPPENHEIM: Very well, Your Honor.

10 THE COURT: Okay. Ownership and validity. Let me
11 hear your argument on why you need more than what they're
12 doing. Why it isn't appropriate to -- if you have specific
13 concerns about specific works not being -- them not having
14 standing to pursue the damages that they're claiming for
15 specific works, why shouldn't that be done on an individual
16 specific basis after you've gone through and seen their
17 information and raised it as opposed to this, we want all
18 documents concerning everything?

19 MS. GOLINVEAUX: Yes, Your Honor. With our motion
20 we're seeking three categories of documents. Number one are
21 the work-for-hire agreements for the works in suit.

22 With respect to the work for hire --

23 THE COURT: What basis do you have that they aren't
24 in existence? I mean, they have a valid copyright -- I mean,
25 they're providing you with copyright registrations, which is a

1 presumption that they have the rights that they are pursuing.

2 MS. GOLINVEAUX: Yes.

3 THE COURT: What basis do you have to go behind that
4 and say, I want every work-for hire agreement?

5 MS. GOLINVEAUX: Your Honor, two issues. Number one,
6 plaintiffs' responses are concerning because what they
7 specifically say in their written responses is that we'll
8 provide you with chain of title documents that they, quote,
9 deem sufficient to demonstrate ownership. So we don't know
10 what they deem sufficient. And that's not the proper standard.

11 The reason we need the work-for-hire agreements is
12 that the plaintiffs have now produced a number of the
13 registration certificates. It looks like a good many of them
14 were filed to be registered as works for hire.

15 And under the Copyright Act, in order for a copyright
16 claimant to file -- to register a work as a work for hire,
17 there has to be a work-for-hire agreement in place when the
18 work is created. It can't be created down the road, unlike an
19 assignment or a license.

20 So we can't know, without getting those work-for-hire
21 agreements, whether or not was in place or not. So that's the
22 issue with the work-for-hire agreements.

23 THE COURT: Well, if in fact -- go ahead.

24 MS. GOLINVEAUX: Would you like me to go to the next
25 category, Your Honor?

1 THE COURT: Sure.

2 MS. GOLINVEAUX: So the next category is the core
3 chain of title documents, the assignments and licenses by which
4 plaintiffs took title to the works in suit.

5 Maybe they're producing them. The problem is, we
6 don't know if they're cherry picking and producing some and not
7 others, or if when we don't get them for one of the 10,000-plus
8 works in suit, it's because they didn't have it. We can't know
9 that.

10 So it's much more practical to simply order them to
11 produce the assignments and licenses to the extent they have
12 them and then we can take it from there. If they don't produce
13 them for certain ones, we can deal with that in deposition.

14 But they have got to show that they actually took
15 title to the work. And then --

16 THE COURT: It's their burden. If you don't think
17 they've met their burden, then you can attack it.

18 MS. GOLINVEAUX: Well, it's our burden to challenge
19 the prima facie presumption they enjoy from the copyright
20 registration certificate, Your Honor. And without seeing --
21 for copyrights, unlike some other IP, it requires a written
22 instrumentality to transfer ownership.

23 So we should be able to get those written
24 instrumentalities. And they've really articulated no burden,
25 no specific burden with respect to simply producing the

1 assignments and the licenses by which they took title if
2 they -- if they have them.

3 THE COURT: And your third category?

4 MS. GOLINVEAUX: The third category is documents
5 concerning challenges to their ownership or the validity of the
6 copyrights that they are claiming in the case.

7 So if people are coming in -- if artists are coming
8 in and saying, you registered -- you included this album or
9 track in a group registration or you registered for it, but
10 that wasn't part of our deal, that's highly relevant to this
11 case.

12 THE COURT: Why, if it got resolved in their favor
13 and they still have the copyright? Why is that -- I mean,
14 you're asking for that forever. You know, somebody who had a
15 dispute eight years ago -- if somebody filed a lawsuit saying,
16 you know, you this copyrighted work was really my work because
17 I did something, I was the one who came up with it, and that
18 dispute got resolved and, you know, the plaintiffs are still
19 the copyright owner, why does that dispute have any
20 significance at all?

21 MS. GOLINVEAUX: Your Honor, we would be limit that
22 going back to 2010.

23 THE COURT: Okay. So it got resolved in 2012. Why
24 does that have any relevance?

25 MS. GOLINVEAUX: Well, we don't know, we don't even

1 know what has been challenged without getting those documents,
2 is the problem, Your Honor. And they haven't articulated a
3 clear burden with that, or even let us -- told us how those
4 documents are maintained.

5 THE COURT: Help me understand what you're going to
6 do -- if I was to order all of that information, what are you
7 going to do with it?

8 MS. GOLINVEAUX: Well, Your Honor, when you have got
9 this number of works in the case and they're seeking up to
10 \$150,000 in statutory damages per work, then if we dropped --

11 THE COURT: If they get to willfulness, that's what
12 they would be titled to on the upper realm.

13 MS. GOLINVEAUX: And their complaint, Your Honor, is
14 all about willfulness. So it's --

15 THE COURT: So you're going to try and challenge --

16 MS. GOLINVEAUX: Correct, Your Honor.

17 THE COURT: -- in the trial of this case whether they
18 have standing for 11,000 individual copyrights?

19 MS. GOLINVEAUX: We're not as to each and every
20 copyright, Your Honor, but we are entitled to see the documents
21 where third parties are saying that you didn't actually -- you
22 improperly registered it, you don't own it, particularly for
23 that limited time period. Because even if we knock out ten of
24 those, that's \$1.5 million in the case. That certainly
25 proportional to whatever burden it would take for the client --

1 for the plaintiffs to produce those documents.

2 THE COURT: All right. Thank you.

3 Tell me what it is you're producing as far as
4 ownership and validity materials.

5 MR. OPPENHEIM: So, Your Honor, we're producing all
6 the documents -- first of all, all the copyright registrations
7 or proof of registration. And then to the extent that that
8 registration is in the name other than the plaintiff, we're
9 producing the chain of title to show the connection between the
10 plaintiff and the registrant.

11 And that's exactly what, Your Honor, Judge O'Grady
12 ruled on his summary judgment decision in the BMG case. I know
13 we're plowing our own course here, but the law is the law.
14 There is no -- so what Judge O'Grady said is there is no basis
15 for Cox's argument that the chain of title must relate back to
16 the author instead of the original plaintiff.

17 We're producing that --

18 THE COURT: That was on a summary judgment motion.
19 This is a discovery motion.

20 MR. OPPENHEIM: Absolutely. And we have said
21 repeatedly in the meet and confer process with the defendants,
22 if there is a work for which you have any basis whatsoever, any
23 colorable basis to say that there is an issue, tell us and
24 we'll go and look.

25 But what they're doing is just purely speculative, we

1 want all of these documents. They have no basis to believe
2 there are any issues. They haven't even reviewed what we've
3 produced or allowed us to produce everything to them that they
4 have asked for already.

5 And yet they're here and they're asking the Court,
6 you know, because we don't think we're going to get necessarily
7 what we want, we want you to order it before we have even
8 looked at what they're going to produce.

9 And, by the way, in the -- they did ask for way more
10 in their motion than they are now asking for again, Your Honor.

11 THE COURT: All right. Well, again, I think I
12 understand this issue well enough. You know --

13 MS. GOLINVEAUX: Your Honor, may I have a brief point
14 in response?

15 THE COURT: Okay.

16 MS. GOLINVEAUX: Mr. Oppenheim referred to Judge
17 O'Grady's order. We're not seeking chain of title going all
18 the way back to the original creator. We are seeking the
19 assignments of licenses that put it in the name of the
20 plaintiffs. We know that they don't -- they are employees.
21 These are not created by employees of the plaintiff. So that's
22 what we're seeking, and that's the distinction with what Judge
23 O'Grady ruled.

24 THE COURT: Okay. Well I think what they have agreed
25 to produce to date is going to be sufficient. If there is any

1 specific questions that you've got that relate to specific
2 issues for copyrighted works, then I'll consider dealing with
3 this issue on a copyrighted work-by-copyrighted work basis. Of
4 if it's a many copyrighted works that are subject to a similar
5 work or a wire for hire or something like that.

6 But, you know, at this point in time the idea that
7 you know, for all 11,000 copyrighted works, you know, the three
8 areas that you've asked for or have now made clear in your
9 reply brief that you're asking for, I don't -- I don't see that
10 being appropriate under the circumstances of this case.

11 So I'm going to deny the motion to compel as to this
12 second category.

13 All right. So now we're dealing with these narrowly
14 tailored requests that include a request such as: All
15 documents that mention, refer to, or relate to Cox that were
16 created, received, or sent from 2013 to the present.

17 That was described in your motion as a narrowly
18 tailored request.

19 MS. GOLINVEAUX: Your Honor, we think all documents
20 the plaintiffs have talking about Cox are relevant in this
21 case. They have been targeting Cox for years. They have been
22 tracking the BMG litigation.

23 We met and conferred with them and discussed this.
24 They said there are certain categories that would make that
25 burdensome. And we asked them what those might be. And they

1 said, for example, monthly invoices. We said, we don't want
2 monthly invoices.

3 Now for the first time in their opposition they say,
4 well, we are producing documents concerning Cox and copyright
5 infringement. That may be sufficient, Your Honor, but that's
6 not what their written supplemental responses say.

7 The written supplemental responses say, in response
8 to these requests, we'll give you the notices of infringement
9 that we sent you, downloads that our agent captured, and a
10 couple of other categories that would not at all get the
11 correspondence about Cox and copyright infringement that we're
12 entitled to.

13 THE COURT: Okay. Well, let me hear from the
14 plaintiffs as to what it is you actually are -- and I share
15 Cox's confusion as to what it really means. I mean, you said
16 in the meet and confer, we're doing this. And then it sounds
17 to me like what you've said in your opposition is more
18 expansive than what you actually said in the meet and confers.

19 MR. OPPENHEIM: The defendants' description of the
20 meet and confer process, we couldn't disagree with more, Your
21 Honor.

22 They have never -- in none of these meet and confers,
23 with rare exception, have they ever said, no, we're not seeking
24 that. They will say, yes, we'll take that. But they never
25 limit what they want. Which is exactly what they did in their

1 motion. They moved on everything, and then they scale back and
2 say, but this is what we're really focussed on.

3 But, Your Honor, so just to understand, a number of
4 these requests we're working on trying to produce reasonable
5 responses and we've wanted to engage in a discussion about ESI
6 and search terms. The defendants have refused to have that
7 dialog.

8 But that's the dialog you need to have to resolve
9 these disputes so we're not doing it, Your Honor, in front of
10 you, with you. No offense intended, I don't think this is a
11 valuable use of our time.

12 THE COURT: No offense taken, believe me.

13 MR. OPPENHEIM: Or your time. So, for instance, when
14 you run the term "Cox" through the system, there are artists
15 who have the name Cox. There are employees who have the name
16 Cox. Right. There are e-mails that have the Cox domain.
17 Right, so just searching on Cox alone doesn't work.

18 And so, you have to search on Cox with some subject
19 matter and some restrictions. That's the dialog we need to
20 have with them, but they've refused to have with us.

21 So we are working on the searches that are set forth
22 in our document. We are happy to sit down and have an ESI
23 discussion with them about search terms that is bilateral.
24 They have refused to do that.

25 So in the meantime, we are trying to search on "Cox"

1 and "copyright infringement" without necessarily pulling
2 documents that are wholly unrelated to this case. An artist by
3 the name of Cox whose work was infringed, but, having nothing
4 to do with this case or nothing at all. Right.

5 So we're trying to find the very specific searches
6 that will get at what they want, but really it's got to be a
7 search term dialog, Your Honor.

8 THE COURT: Well, but it also has to be a, what do
9 you do after you get -- what documents are you actually
10 producing once you do that search and get the hits.

11 And I think their concern is that if you get hits
12 from a reasonable search using search terms such as "Cox" and
13 "copyright infringement," what are you going to take out of
14 that. And is it going to be only those documents that are, you
15 know, as you outlined in your meet and confer letters, or is it
16 going to be a broader set that relates to Cox and copyright
17 infringement.

18 MR. OPPENHEIM: So there are some categories, Your
19 Honor, which I think we're going to get at shortly, for
20 instance, the Copyright Alert System, which the CAS system,
21 where I think there is a dispute about whether or not that's
22 relevant.

23 So without getting to that issue in this, to the
24 extent that we find documents that are not privileged that
25 relate to Cox or the relevant time period in copyright

1 infringement, our goal is to attempt to produce them. But we
2 wouldn't include that as a backdoor effort to try to get at
3 things like the CAS system. Right? Or things that have
4 nothing to do with the claims in this case.

5 The problem is that their document requests are so
6 broad that you can't -- you can't even start with them. And
7 then they move on them, but then they don't even move on them,
8 Your Honor. You know, they're in their motion papers, we've
9 got to respond to it, and then they try to narrow in the motion
10 papers.

11 I feel like I'm trying to grab Jello, Your Honor, and
12 I can't figure out where it's going next.

13 So again, I'm happy to have this dialog, but it has
14 to be within the construct of a back and forth, I think, Your
15 Honor.

16 THE COURT: All right.

17 MR. OPPENHEIM: Which we regularly do with opposing
18 counsel all the time. I'm not why search terms here is
19 different and why we can't have that dialog here.

20 THE COURT: Okay. Well, again, I'm still not
21 understanding completely what it is you intend to do once you
22 get the results of your searches of what you believe are
23 reasonable custodians using search terms and get documents
24 concerning "Cox" and "copyright infringement."

25 Is it only those items that have to do with notices

1 of infringement, downloads of unauthorized copies of the
2 copyrighted works, documents sufficient to show information
3 concerning the infringement, documents concerning the analysis
4 of the reliability, documents concerning Cox's response to
5 receiving an infringement notice, and documents concerning the
6 number of infringement notices Cox accept from plaintiffs?

7 MR. OPPENHEIM: So I'm sorry, just to file -- you're
8 on page 16 of our opposition?

9 THE COURT: I'm looking at your opposition where you
10 say, those are the six items. And then you say:

11 Notwithstanding this, plaintiffs are conducting reasonable
12 search terms to target non-privileged documents concerning
13 "Cox" and "copyright infringement," but it doesn't really tell
14 me what you're going to do once you do that.

15 MR. OPPENHEIM: Well, Your Honor, that's part of the
16 process. Is we have to see what we sweep up, and have no idea
17 what we haven't thought of that is going to get captured in
18 that, that would be entirely irrelevant.

19 So we would exclude the CAS documents, Your Honor, we
20 know that, which we've indicated. We would exclude any
21 privileged documents, right, Your Honor.

22 But other than that, at the moment we're not aware of
23 what else we would be excluding. But that's got to be part of
24 the process as we examine the searches.

25 But, look, what we tried to do, Your Honor, we took

1 their incredibly broad requests, which they have refused to
2 meet and confer on, and we tried to come up with a concrete set
3 of things to produce. I mean, we are informatively trying to
4 resolve this dispute, but -- but really can't do it in a
5 vacuum.

6 THE COURT: Well, however along are you in the
7 process of producing these documents?

8 MR. OPPENHEIM: We've collected from custodians and
9 run the searches, and we're now having a team of lawyers review
10 those documents to see what's there. In terms of the time
11 frame, Your Honor, at the moment I don't know. But we -- I
12 know we have a good group of people working on it every day
13 right now.

14 THE COURT: Okay. All right. Well, you know, on
15 this one, I'm not quite sure this one is really ripe yet to be
16 decided, to be honest with you.

17 I have heard from counsel for the plaintiffs that
18 they are in the midst of doing their searching, that they are
19 providing or looking for and will be producing documents that
20 concern "Cox" and "copyright infringement" with certain
21 restrictions as to -- and we'll get to the CAS documents later.
22 But beyond that, and I guess the time period, I guess is the
23 other issue that probably I can address today.

24 Why any time after 2014? Let me hear from --

25 MS. GOLINVEAUX: Your Honor, two things. One, it's

1 not clear to me if they have got documents where their clients
2 are -- that are non-privileged that -- where the clients are
3 discussing Cox and copyright infringement and they also happen
4 to be discussing CAS, why those wouldn't be produced. Those
5 seem highly relevant.

6 If they are comparing Cox's policies, for example, to
7 CAS, how is that not relevant? Putting aside the dispute we
8 have about the relevance of CAS generally.

9 So what I seem to hear now is that the plaintiffs
10 will do these searches, but then they will cherry-pick the
11 categories of the documents that they're going to produce, and
12 we don't have visibility about that. So that's the concern.

13 With respect to the date range, Your Honor, the
14 reason we asked for it up to current time is even if there are
15 documents discussing how Cox's policies stack up against the
16 industry, with respect to the relevant time period in the case,
17 even if they were discussing that in 2017 or 2018, those are
18 still highly relevant, highly relevant and not burdensome to
19 search for.

20 And with all due respect, Mr. Oppenheim's example
21 about the artist who might have the last name of Cox, when
22 we're talking about Cox and copyright infringement, we're
23 talking about the defendants in the case.

24 So that limitation would not sweep up anyone who
25 happened to have the last name Cox.

1 THE COURT: All right. Well, this one I am afraid I
2 am going to really at this point deny without prejudice.

3 I think the time period of 2014 is appropriate for
4 the cutoff period for the plaintiffs to be producing these
5 documents. They are in the midst of producing the documents.
6 I think we need to see what it is they actually produce.

7 If issues come up, you find out that their production
8 hasn't been as complete, then you need to tell them what it is.
9 I mean, I'm not talking about a privilege log issue. But to
10 the extent that you are finding categories of documents that
11 otherwise would be done and you're not producing them -- again,
12 I'm not, you know, document-by-document basis, but I think
13 there has to be some transparency as to, you know, what it
14 actually is that you're producing and what you're not
15 producing.

16 And then once you all have had a chance to be a
17 little bit more specific in your discussions about them, then
18 you can raise this issue with me again.

19 But this -- you know, there are plenty of things to
20 fight about in this case and, you know, I think focusing on
21 some of the more merit-based issues are probably a better
22 expenditure of your clients' resources than some of these other
23 things.

24 But go ahead and continue your production. Be as
25 transparent as you can as far as, you know, what you have

1 gotten, what you have -- the process that you've taken to
2 search the results from your search terms, and what types of
3 information that have been categorized out of the production.

4 Okay?

5 So that one --

6 MS. GOLINVEAUX: Your Honor, may I ask one point of
7 clarification?

8 THE COURT: Okay.

9 MS. GOLINVEAUX: In what forms do you -- would you
10 anticipate that would take place, that they would provide us
11 with information about the categories?

12 THE COURT: Informal. I mean, discussions, letters.

13 MS. GOLINVEAUX: Oh, letters. Thank you, Your Honor.

14 THE COURT: Something like that. It's not something
15 that I'm going to have them file with the Court at this time.
16 If it becomes the subject of a motion, then we will do it, but
17 after that. Okay.

18 So I guess now we're to your areas, Mr. Buchanan.

19 MR. BUCHANAN: Yes, Your Honor. We're now discussing
20 the defendants' motion to compel documents concerning CAS and
21 the Copyright Alert System, which was established in February
22 of 2013 on 18 companies involved in the copyright industry,
23 including vendors and ISPs, as well as Sony and
24 other defendants -- or other plaintiffs.

25 So there is no real issue about burden here. It's --

1 there is one short paragraph and three declarations that really
2 just says, the discussions and the negotiations went on for a
3 long time.

4 The plaintiffs refuse to produce any documents with
5 regard to CAS. And you just heard from plaintiffs' counsel to
6 suggest that they don't want to search "Cox" and "CAS"
7 together. Suggesting that that's going to produce documents
8 which we think are relevant, as Ms. Golinveaux just pointed
9 out.

10 And they are relevant because throughout the
11 complaint in this matter the plaintiffs assert that the manner
12 by which Cox handled the notices of infringement were
13 unreasonable and arbitrary and a violation of the copyright
14 laws.

15 I can just read you just briefly --

16 THE COURT: Well --

17 MR. BUCHANAN: Well, I won't read.

18 THE COURT: I understand the argument.

19 MR. BUCHANAN: Okay. So they go on and on, paragraph
20 after paragraph, how arbitrary and unreasonable we were in the
21 parameters that we set up, and the notices and the limitations
22 on them.

23 So we know that through CAS all of these entities got
24 together, you know, copyright owners and vendors and ISPs, and
25 they came up with a formula by which it would be acceptable to

1 the copyright owners, like the plaintiffs, many of the
2 plaintiffs, and the ISPs. And they put caps on the number of
3 notices that would be acceptable and whether they needed to
4 terminate or not. And we believe that they didn't require them
5 to terminate.

6 So the plaintiffs' counsel in their papers suggest
7 that that's meaningless because it's not a legal standard.
8 Well, there is no legal standard. There is no statute or
9 regulation that states you must accept so many notices in a
10 day, and you must act on them in a certain fashion, and you
11 must accept so many per complainant or subscriber.

12 THE COURT: Or that you can turn down any notices. I
13 mean, there is no legal standard that you can only accept a
14 certain amount as opposed to a legal standard that you're not
15 required to accept every copyright notice, every notice of
16 infringement.

17 MR. BUCHANAN: Right, correct. So but if the
18 plaintiffs and 18 others in the industry, including most of the
19 ISPs, had an agreement during the time period in question that
20 said, look, accept this amount of notices, and Sony is a big
21 player, they are driving the train, accept 500 a day, that
22 works, and you don't need to terminate, just work with us.

23 Then they come into court and argue for the jury, and
24 it's all through their complaint, 200, 300, 500 was arbitrary,
25 it was unreasonable, they just did it to save money, they are

1 totally greedy, and they don't care, and they only pass on so
2 many notices and only terminate so many people.

3 Well, if that's what they're saying is an
4 unreasonable and arbitrary standard and, therefore, we should
5 be hit with a billion dollars in damages involving deterrence
6 because they're saying you need to deter them because they're
7 unreasonable and arbitrary in the way they handled the notices
8 and how many they processed, then we suggest -- we think that
9 these documents are reasonable and that they be produced and
10 they are relevant.

11 And the Court in BMG found the same thing with regard
12 to BMG and Rightscorp. They found that the plaintiffs in that
13 case needed to produce documents that showed that the
14 plaintiffs may have had different communications and different
15 requirements and treated other ISPs differently than they were
16 treating Cox. So we already have a prior ruling that is almost
17 directly on point.

18 And this is not burdensome. It's very limited
19 documents. We want the master contract, the agreements they
20 had with the other ISPs, maybe eight or ten of them, the
21 communications that led up, and just the documents that just
22 show what's the standard they were utilizing. Because if they
23 are going to tell them these guys are the outliers, they did it
24 different than anyone else -- because if we did it the same as
25 everyone else and it was acceptable to them, how can it not be

1 acceptable in this case?

2 THE COURT: Well, it's --

3 MR. BUCHANAN: They didn't sue any of those people.

4 THE COURT: That doesn't make it right. I mean, two
5 wrongs don't make a right.

6 MR. BUCHANAN: No, it doesn't, but also it suggests
7 that you can't argue to the jury that you're arbitrary and
8 unreasonable when you negotiate and do side deals with all the
9 others where you don't even require them to terminate.
10 Certainly it's relevant at this stage of the case, Your Honor.

11 THE COURT: All right. Let me -- give me an
12 understanding as to -- and it's unclear to me how this worked.

13 Apparently there was a memorandum of understanding
14 and then there may be certain implementation agreements. Are
15 there separate documents, or was there a memorandum of
16 understanding that people would sign on to or not?

17 MR. OPPENHEIM: Here is my understanding, Your Honor.
18 Over the course of many years there was a negotiation with
19 movie studios, record companies, ISPs, and technology companies
20 about creating an entity that would have a couple different
21 components to it, an educational component, and a technology
22 component, and a notice component with respect to copyright
23 infringement.

24 Those entities negotiated for several years, created
25 a corporate entity. That corporate entity was run by

1 representatives from all the different industries. And that
2 entity used vendors to send millions and millions of notices
3 and engage in an education campaign. All of which, I
4 understand, the details of which are subject to confidentiality
5 agreements to that entity, which has now been dissolved because
6 it doesn't exist anymore.

7 So I presume those confidentiality obligations now
8 exist, you would have to get some kind of approval from each of
9 the different movie studios and other entities involved.

10 So it was a lengthy effort from negotiation to its
11 creation of the entity. The entity existed for several years,
12 and then there --

13 THE COURT: From when to when?

14 MR. OPPENHEIM: I don't have the exact dates, Your
15 Honor. I am not privy to them as I stand here. It was several
16 years.

17 THE COURT: Well, apparently there is some indication
18 of a memorandum of understanding that was signed on July 6,
19 2011, is that --

20 MR. OPPENHEIM: I think that's right, Your Honor.

21 THE COURT: Okay.

22 MR. OPPENHEIM: And then, so it operated for several
23 years and then was dissolved. And dissolved in 2017. And the
24 dissolution, I think negotiations went on for quite sometime as
25 well.

1 So I think that's an overview. I think there is --
2 as I understand it, it could, based on the defendants'
3 requests, which again are massively overbroad --

4 THE COURT: Right, and we're focusing on -- not all
5 documents relating to, not all documents concerning certain
6 things.

7 MR. OPPENHEIM: So -- okay. So I have a few more
8 details --

9 THE COURT: Okay.

10 MR. OPPENHEIM: -- with the benefit of my colleague.
11 Thank you, Mr. Gould.

12 The negotiations went on between 2009 and 2011. The
13 program itself existed from 2013 to 2017. Dissolved in 2017.
14 I know that the negotiations over the dissolution took quite
15 some time as well.

16 But the point here, Your Honor, is -- is Mr. Buchanan
17 made a legal point that's just not right. He said, there is no
18 legal standard on notices. And there is a hundred years of
19 case law on what somebody is supposed to when they receive a
20 notice of infringement. It goes back to -- to cases where, you
21 know, somebody found an entity playing music that they
22 shouldn't, and they sent a cease and desist letter, and then
23 that entity didn't respond. There is a huge number of cases
24 over a long, long period of time.

25 And in none of those cases do courts say, well, it

1 was okay for that bar to continue to play that music because
2 other bars were violating the law and not getting a license,
3 for example.

4 Or for a movie theatre to say -- to say, it was okay
5 for us to show a pirated copy of a movie because other movie
6 theatres did that. That's the argument that the defendants are
7 making here, that their legal obligation should be measured by
8 a comparison to others.

9 And that's not the law. And that's not -- we don't
10 say anything about Cox as compared to others in the industry in
11 our complaint. It is nowhere to be seen, contrary to their
12 statements.

13 Their conduct is measured against the legal standards
14 which are well-known and have been articulated by the Supreme
15 Court. And those standards don't ask for a comparison to the
16 rest of the industry.

17 So that's number one, Your Honor.

18 Number two, they say that we have not articulated a
19 burden in our documents, and that's not true. In Wade Leak's
20 declaration from Sony, just by way of example, we have it,
21 there is an entire paragraph about the burden.

22 But you don't even need to look at that declaration
23 to see that. All you have to do is look at the ridiculous
24 number of requests and the overbreadth of those requests to
25 understand the burden. I mean, they are moving on things that

1 on their face are just ridiculously overbroad and burdensome
2 and certainly not proportional.

3 So, Your Honor, I think you don't need to get to the
4 burden or proportionality issues because I think as a matter of
5 law the legal standards don't look at what others are doing.

6 But if you -- if you want to look at burden and
7 proportionality, it's on its face a ridiculous request. And
8 the idea that they have narrowed it in their papers is, again,
9 not the way this should work.

10 THE COURT: Well, help me understand that. We -- and
11 I am frustrated with this often in dealing with these types of
12 motions.

13 The Court requires the parties to have a good faith
14 consultation in order to try and narrow the issues. So you
15 send out arguably what may be a very broad, sweeping document
16 request. In the scope of those negotiations, the propounding
17 party agrees to narrow it to a certain subset of what was
18 initially requested.

19 As much as the Court would like to be able to look
20 and just say, well, you have got to stand by the document
21 request that you sent out and, you know, I can't order them to
22 produce it, that would ignore the requirement of the parties
23 having to go through a good faith consultation.

24 So, you know, it can't be, well, you know, if that's
25 really what you want, you have got to go back and ask for it

1 again.

2 MR. OPPENHEIM: So I have two responses to that, Your
3 Honor. One is the way I think it's supposed to work. Right.

4 First off, you shouldn't issue -- the requests as
5 they were issued were grossly overbroad to begin with. I mean,
6 we're the plaintiffs in the case. Cox's conduct is at issue.
7 We issued half the number of document requests that Cox did,
8 just by comparison.

9 THE COURT: Okay.

10 MR. OPPENHEIM: So they same at it both fists -- or I
11 should say octopus style, Your Honor.

12 But beyond that, in the meet and confer process, if
13 you're going to narrow, you then memorialize that in writing,
14 have a discussion about that narrowing, and then you move to
15 compel on that narrowed request. They moved to compel on the
16 underlying request.

17 And they never narrowed in the meet and confers. We
18 would repeatedly ask them to narrow and they would never
19 concede an inch of territory.

20 Having said that, Your Honor, we're happy to have
21 those meet and confers and we're happy to work on it. It
22 shouldn't happen in front of the Court, in my view.

23 Now, we were here in December on our motion with
24 respect to notices Cox had received from other ISPs. And we
25 had a discussion and you said, our request is too broad. If we

1 had issued a request with respect to just the IP addresses at
2 issue in the case, well, then maybe that, you know, would be
3 acceptable.

4 So Your Honor didn't allow us to narrow it, didn't
5 order them. So we issued new requests. They still haven't
6 responded to them.

7 THE COURT: Well, we will deal with those when the
8 time comes.

9 MR. OPPENHEIM: So anyway, getting back -- somehow we
10 got afield. I apologize if that was my -- my doing, Your
11 Honor.

12 But with respect to CAS, if we're going to create a
13 whole kind of separate trial on how Cox is compared to the rest
14 of the industry, we are moving -- we are totally changing over
15 100 years of case law here. There is -- there is -- there are
16 notice cases where they say that you compare to what the rest
17 of the industry was doing.

18 The Supreme Court articulated what the contributory
19 and vicarious standards were in the Grokster case. And those
20 standards, nowhere in them do they -- do they look to other
21 courts or other -- other players to justify conduct.

22 MR. BUCHANAN: Your Honor, just briefly.

23 THE COURT: All right.

24 MR. BUCHANAN: In terms of the meet and confer, yes,
25 we did issue 13 broad and narrow requests regarding CAS. And

1 the response from the plaintiffs in every meet and confer was
2 you get zero documents on CAS.

3 In terms of that paragraph that was supposed to
4 educate the Court about the burden, I will just read it
5 briefly. It says: CAS was a private agreement between 18
6 parties. 30 parties, including all entities, including trade
7 groups, copyrighted holders, ISPs, designed to educate
8 consumers, deter online infringement, and direct consumers to
9 lawful online legitimate sources and content. Cox did not
10 participate in CAS.

11 There is nothing, the word "burden" --

12 THE COURT: Sure. You go to paragraph 24, it talks
13 about everything that you've asked for: All documents
14 concerning CAS or the copyright system as well as copyright
15 infringement practices of other ISP providers, including all
16 documents concerning a multitude of topics such as, and then
17 they outline those eight topics.

18 And then they go in paragraph 25 and say: All
19 documents concerning a host of issues.

20 So, I mean, they certainly -- the negotiations
21 spanned years. Each participating company, 30 parties
22 involved. I mean, the idea that they don't talk about the
23 burden --

24 MR. BUCHANAN: Well, they say the length of time.
25 But if you look at what we're asking for, what we're asking for

1 is very simple. It's just the master agreement, the individual
2 agreements, and any correspondence that relates to it. And
3 that's what we said in the meet and confer. That's what we
4 want. It can't be that many documents.

5 We don't want the whole history of every phone call
6 and every e-mail. What we want is what ultimately happened
7 because in their complaint, as I said before --

8 THE COURT: All right.

9 MR. BUCHANAN: -- they constantly say, we're
10 arbitrary, unreasonable in the way we handled complaints and
11 notices.

12 So it is pretty narrow, and we narrowed it in our
13 reply to try to capture and boil down what we thought was
14 ultimately relevant.

15 Thank you, Your Honor.

16 THE COURT: All right. Well, I think many of the
17 document requests that were served relating to this are
18 certainly overbroad, unduly burdensome, and I wouldn't require
19 additional responses.

20 The ones that do have some more, I would say,
21 reasonable basis for consideration or narrowing are 167 and 168
22 and 169. Taking those ones into consideration, I am going to
23 require that the plaintiffs produce a copy of the memorandum of
24 understanding concerning CAS, which I assume is this July 6,
25 2011 memorandum of understanding, their -- if it's in their

1 possession, custody, or control.

2 Any implementation agreements that they may have had
3 with CAS. So if the individual plaintiffs had any other
4 implementation agreements with CAS, they should be provided.

5 And documents that would be sufficient to show. And
6 that is not all documents relating to, but documents sufficient
7 to show whether they were a signatory or member of this CAS
8 organization from 2013 and 2014, at any time during that time
9 period.

10 Yes, sir.

11 MR. OPPENHEIM: Your Honor, we -- they already have
12 the memorandum of understanding, we provided it.

13 But with respect to the last point you made, whether
14 they were a participant, you are referring to the plaintiff
15 parties, not the defendant -- I'm just trying to understand.

16 THE COURT: No, I know the defendant wasn't a party
17 to it. And there are multiple plaintiffs in the case. So we
18 need -- each plaintiff needs to get on the record as to whether
19 they were or weren't part of this. Okay.

20 MR. OPPENHEIM: Understood, Your Honor, we will
21 provide that in the form of an interrogatory type affirmation,
22 be all right, Your Honor?

23 THE COURT: I think so. The documents, obviously,
24 you need to -- the implementation agreements and the memorandum
25 of understanding, if there are any implementations.

1 MR. OPPENHEIM: I am sorry, Your Honor, just one
2 logistics issue. Under -- I believe under the logistics --
3 excuse me, under the implementation agreement, we have to serve
4 notice on each of the participants before we can produce it.
5 So we will go through that process expeditiously, Your Honor.

6 THE COURT: Okay.

7 MR. OPPENHEIM: I wanted to make the Court aware.

8 THE COURT: All right, MarkMonitor.

9 MR. BUCHANAN: Your Honor, this is, I think you've
10 acknowledged with some others, is a bit of a moving target.

11 THE COURT: Have you -- are you doing third-party
12 discovery on MarkMonitor?

13 MR. BUCHANAN: Yes, Your Honor.

14 THE COURT: Well, what -- let's focus on what you
15 think you need to get from the plaintiffs versus what you're --
16 and where is that going to take place? I know you served them
17 on counsel, but where is MarkMonitor actually located?

18 MR. BUCHANAN: I think they are in California.

19 THE COURT: California. So any issues having to do
20 with the scope and production are going to be in California,
21 not here, is that --

22 MR. BUCHANAN: That's correct, Your Honor.

23 THE COURT: Okay.

24 MR. BUCHANAN: So we've narrowed it to sort of four
25 categories. Documents relating to Cox, the present litigation,

1 the relationship between the plaintiffs and MarkMonitor, and
2 copyrighting policy or monitoring services. So that sort of
3 goes to the contract, what they were doing.

4 They have agreed to give us certain documents from
5 2012 to 2014. They have expanded that to 2010 to 2014. And
6 then they responded that they are also conducting reasonable
7 searches to target non-privileged documents concerning
8 MarkMonitor and a broad array of topics and keywords.

9 That's the first we have heard of that. I am sure
10 they will say, well, we didn't discuss keywords in the meet and
11 confer, but that's neither here nor there.

12 So I think maybe it would be helpful if plaintiffs'
13 counsel identified what those keywords and topics that they
14 were utilizing to do the search, and if they are going back to
15 2010. If they are doing that and the keywords that they are
16 utilizing capture the four categories I just outlined, then we
17 do not have an issue.

18 THE COURT: Okay. All right. Well, let's clarify
19 whether you're going back to 2010 or not on the search.

20 MR. OPPENHEIM: Sorry, Your Honor, I am trying to
21 understand --

22 THE COURT: There is a lot going on in these motions.

23 MR. OPPENHEIM: There is, Your Honor.

24 THE COURT: So I understand.

25 MR. OPPENHEIM: And as I said, it seems to be a

1 moving target. We would love to have a bilateral discussion
2 about search terms and ESI, Your Honor. We come back to that
3 over and over again.

4 Again, the requests that they issued here were
5 prolific and broad. We made an effort to describe categories
6 that -- of documents that we were going to produce, and that's
7 on page 24 of our opposition brief, Your Honor. We laid out
8 six, six categories.

9 We said that we would produce documents for the
10 period of 2012 to 2014, but we extended that period for one
11 category, and that was to the extent that the defendants wanted
12 documents about the reliability of the MarkMonitor system, that
13 we would not time restrict that.

14 To the extent that, obviously, that we can get access
15 to those old documents. But, yes, we -- so that's the time
16 frame that we've agreed to produce, Your Honor.

17 As you noted, I mean, many of these requests should
18 probably better be directed to MarkMonitor, who has their own
19 counsel, and I presume is responding to the subpoena that was
20 issued to them.

21 So -- but to be clear, Your Honor, kind of,
22 MarkMonitor, these requests seek a lot of things, a lot of
23 documents that have nothing to do with the MarkMonitor program
24 that was involved in sending notices to Cox.

25 So MarkMonitor has been involved in a variety of

1 different enforcement programs over the years for the
2 plaintiffs. And so, just searching kind of generically for
3 MarkMonitor documents pulls up a lot of -- a lot of documents
4 that are wholly irrelevant and, frankly, would reveal
5 anti-piracy efforts that would be highly confidential, Your
6 Honor.

7 So we have tried to -- to target what is appropriate
8 here. If the defendants want to have a bilateral ESI
9 discussion, I think that would be great. We ought to do that.
10 Maybe Your Honor would encourage that to happen. I don't -- I
11 am not in a position to do what Mr. Buchanan asks and have a
12 discussion through Your Honor of our ESI search terms here
13 today.

14 THE COURT: Well, why -- help me understand why you
15 limited the expansion of the results of your search to 2010
16 only having to do with the reliability issue.

17 Is that what you indicated? That otherwise you were
18 going from 2012 to 2014, but for documents relating to the
19 reliability of the way that MarkMonitor generated the notices
20 and sent the notices, you were going back to 2010. Is that
21 what you are saying?

22 MR. OPPENHEIM: So on the issue of -- I don't know
23 word to use other than reliability, but how effective the
24 MarkMonitor system was, we recognize that that's a generic,
25 overall, over-encompassing issue and agreed to produce that

1 without time restriction.

2 For the other requests, categories, they seem to be
3 directed at the issue of plaintiffs' claims against the
4 defendants, which are restricted to a restricted period of
5 time. And so, for the exact same reasons that we have
6 restricted other things to the period of the claims, we
7 restricted it here.

8 I mean, we would be happy to pursue claims that
9 predate 2012 and provide the documents for those, but I suspect
10 the defendants would object to that.

11 THE COURT: Well, what are you producing? I mean,
12 are you producing your agreements with MarkMonitor showing your
13 relationships with MarkMonitor?

14 MR. OPPENHEIM: As it relates to this program, Your
15 Honor --

16 THE COURT: Yes.

17 MR. OPPENHEIM: I believe we are. And we have
18 already produced all of the notice data that we have --

19 THE COURT: Okay.

20 MR. OPPENHEIM: -- from MarkMonitor.

21 THE COURT: So 280,000 of your 300,000 documents that
22 you produced are the notices. So, right?

23 MR. OPPENHEIM: I don't know if those numbers are
24 correct, Your Honor. We are producing on a rolling basis, and
25 have been very active in trying to get the defendants what they

1 have asked for.

2 THE COURT: Okay. So you have provided them with the
3 notices. What other information have you provided to them that
4 is responsive to their requests relating to MarkMonitor.

5 MR. OPPENHEIM: So on page 24, Your Honor, we
6 describe -- we either have produced or are going to produce
7 downloads of the unauthorized copies of the copyrighted works
8 infringed by Cox's subscribers. Documents sufficient to --

9 THE COURT: What does that have to do with
10 MarkMonitor? I mean, MarkMonitor says these are the
11 downloaded -- this is what our investigation has resulted in
12 this work having been improperly downloaded. And then you are
13 providing them with a copy of the downloaded work, right?

14 MR. OPPENHEIM: It's the evidence that MarkMonitor
15 has captured for purposes of the case. It's great, they get to
16 play all the music.

17 THE COURT: Okay.

18 MR. OPPENHEIM: Documents to show the information
19 concerning the infringement of the copyrighted works in suit by
20 their subscribers. Documents concerning the reliability of the
21 MarkMonitor system. Documents relating to Cox's response to
22 receiving infringement notices.

23 All right. So, we -- MarkMonitor would forward the
24 notice. We would get responses back from Cox, we have those.
25 And documents concerning the number of infringement notices

1 that Cox was taking.

2 So, you know, if there are other search terms and
3 categories, narrowed categories that they want to discuss,
4 happy to have that ESI discussion, Your Honor. I really -- I
5 come back to, I think this isn't the way to do this. We're
6 trying our best.

7 THE COURT: I don't see anything in here that talks
8 about your agreement or relationship -- documents sufficient to
9 describe your relationship with MarkMonitor.

10 MR. OPPENHEIM: One moment, Your Honor.

11 So, Your Honor, it's not listed, but we have agreed
12 and I believe told them in the meet and confer, that the
13 agreement concerning this program with MarkMonitor either has
14 been or will be produced. Okay.

15 So, Your Honor, we actually had a two-step process in
16 our responding to their requests on MarkMonitor. We initially
17 agreed to produce certain documents. We then met and
18 conferred. We then provided a supplemental response and agreed
19 in the supplemental response to provide the six categories
20 here.

21 So the agreement to provide the underlying agreement
22 was in our initial response, not the supplemental response.
23 More detailed than Your Honor probably wanted.

24 THE COURT: Okay. Mr. Buchanan, what --

25 MR. BUCHANAN: Just briefly, Your Honor. The

1 plaintiffs at no time indicated that they were going to give us
2 the contractual documents regarding MarkMonitor either as to
3 this case or to other matters.

4 We think it's important that we -- you know, they
5 listed the eight search terms here that they are utilizing,
6 which they came up with those for the first time in their
7 opposition.

8 And again, my question at the inception was as to the
9 four categories of documents that we've identified in our reply
10 brief, were they going to search for those? And if they are,
11 then we don't have an issue.

12 But, for example, MarkMonitor may have been using a
13 system to detect infringement with regard to Cox that was
14 different than what they used for, say, the other CAS members
15 or other ISPs that they were hired by the plaintiffs to
16 investigate. We think that's significant.

17 In their search terms they should search for all
18 communications about Cox. I am sure there is discussion about
19 Cox in there with regard to MarkMonitor as to that we didn't
20 join CAS, and then they're going to go looking for us, and they
21 are going to come at us, and here is what you should do, here
22 is what you should look at. All those sort of comments about
23 Cox, why they are pursuing Cox and nobody else. You know, the
24 effort they took the means, they took, those discussions are
25 relevant.

1 And discussions about the present litigation that are
2 not attorney/client privilege. They should search for those.
3 And what were the discussions when with MarkMonitor about how
4 to pursue Cox, how to make the case, how to develop the case,
5 how to investigate them and prove the case. If those aren't
6 privileged, we should get those documents.

7 THE COURT: How to investigate the case, why wouldn't
8 that be work product?

9 MR. BUCHANAN: I said if there were attorneys
10 involved that hired MarkMonitor and they had discussions with
11 them, yes. But if it's business-to-business people saying,
12 these guys didn't join CAS, let's zero in on them and you go
13 pursue them, and here is what you want to do, that wouldn't be
14 work product unless there were lawyers involved. And there may
15 well be. That's why I said, if it was not privileged.

16 THE COURT: Okay.

17 MR. BUCHANAN: But we identified these categories in
18 our reply brief. And the question for counsel was, are you
19 going to include those in your search? And he said, well, we
20 can talk about it, we will look for it, we're doing --

21 THE COURT: Well, he got the reply brief last night
22 at 5 o'clock. So, you know --

23 MR. BUCHANAN: I understand, Your Honor. You got --
24 there was -- there is way too much information submitted on
25 this.

1 THE COURT: And I --

2 MR. BUCHANAN: We should have done a better job of
3 resolving this issue.

4 THE COURT: You know -- well, let me just -- we have
5 the ability to use the expedited briefing schedule on motions.
6 It's not required that the parties do that.

7 And, you know, this is a motion that upon further
8 reflection might have been better presented on a regular
9 briefing schedule during a non-holiday week that would have
10 given the parties an opportunity to fully prepare an
11 opposition, to have several days to prepare a reply as opposed
12 to a very busy 20 hours that I suspect people were working hard
13 to get a very substantial reply put in. And then, you know,
14 for the parties to review the reply and see if they couldn't
15 have narrowed the issues a little bit more before they actually
16 had to come in and argue it.

17 So, you know, you had the right to do it. It doesn't
18 mean you have got to do it. So, just --

19 MR. BUCHANAN: I agree, Your Honor. I agree that the
20 way you suggested is the way it should have been done and
21 that's how we'll proceed. Because if it is a narrow issue,
22 then that's -- the expedited path is correct.

23 But that would have given us time to resolve some of
24 these, correct, and it put too much burden on the Court. And I
25 apologize for that.

1 THE COURT: Well, on this one -- and again, I really
2 try not to do this very often, but I think this is another one
3 in which I think other than making it clear that I am requiring
4 a production of the documents that are sufficient to show the
5 relationship between MarkMonitor and each individual plaintiff.

6 So again, I don't know -- you know, we have a number
7 of different plaintiffs here. And so, if there are individual
8 agreements with MarkMonitor or understandings.

9 But, you know, there has to be some documents that
10 are sufficient to show the relationship, which would be I think
11 probably 156 is the one that -- the relationship agreements,
12 not all communications, but the relationships and agreements
13 between the plaintiff and MarkMonitor. So --

14 MR. OPPENHEIM: I am sorry, can I ask -- I feel like
15 I am always getting --

16 THE COURT: It's like your contractual obligation. I
17 mean, if you signed a contract with them, if you have a written
18 agreement, if you have an understanding, you know, a letter
19 agreement that says you're going to do this, we will pay you
20 this, you provide me with these services, these are your
21 obligations, these are my obligations, that kind of agreement
22 or description of the relationship between MarkMonitor and your
23 clients.

24 MR. OPPENHEIM: As it respect -- with respect --

25 THE COURT: With respect to --

1 MR. OPPENHEIM: -- to the program at issue in this
2 case.

3 THE COURT: -- the program at issue in this case,
4 right.

5 MR. OPPENHEIM: Very well, Your Honor.

6 THE COURT: All right. The other issues I think are
7 really at this point more of a moving target than something
8 that I can deal with. I mean, I think they are doing the
9 search. They again need to be transparent in what they are
10 producing as far as the results of the search terms and what it
11 is that they are and aren't producing as a result of those
12 search terms.

13 And if there is a need to, you know, I -- they have
14 at least indicated in their opposition some of the search terms
15 that they are having. I didn't hear that you have actually
16 suggested anything more to them at this point in time. But you
17 all are going to need to talk about that one some more before I
18 do that.

19 So other than the documents specifying, which I don't
20 think are included in items 1 through 6 in the opposition on
21 page 24, obviously they need to produce what they agreed to
22 produce in this opposition, including the information that goes
23 beyond the 2012-2014 range for the reliability or issues, plus
24 the agreement and relationship. Okay?

25 MR. BUCHANAN: The next component, Your Honor, is a

1 motion to compel regarding documents concerning communications
2 with RIAA. And as the Court is aware, they are the plaintiffs'
3 agents for the purposes of managing MarkMonitor and the
4 copyright infringement notices program.

5 I believe we had five document requests that are
6 relevant. I think they are all pretty narrow. They go to,
7 essentially, the relationship between RIAA and the plaintiffs
8 with regard to this litigation and Cox.

9 We have tried to narrow it further, make it more
10 simpler in our reply brief by --

11 THE COURT: Well, let me just -- I hate to do this,
12 but when you say, we have served five narrow document requests,
13 one of which you're saying is: All documents concerning the
14 RIAA in either this lawsuit, Cox, and/or copyright works.

15 That really isn't narrow, is it? All documents
16 concerning RIAA and this lawsuit, Cox, and/or the copyrighted
17 works?

18 MR. BUCHANAN: I would say that you're correct that
19 as to copyrighted works, may be broad.

20 As to this case, or this lawsuit and Cox, I would
21 think RIAA's discussions and communications with the
22 plaintiffs -- you know, they wouldn't be talking about Cox
23 other than in the context of what we were doing vis-à-vis the
24 copyrights.

25 And, you know, we are talking about the copyright

1 works in question. I am sure RIAA is not having a lot of
2 discussions about these individual copyright works with the
3 plaintiffs except in the context of this litigation. Or they
4 may be. But if we tied that together, I think it is narrow.

5 But the way it's written, maybe it is a little too
6 broad in terms of copyright works and discussions.

7 But the others go really to Cox, the lawsuit,
8 copyright works, MarkMonitor. We are trying to, essentially,
9 get all their documents and communications that relate to the
10 relationship generally. And then, but more importantly, to
11 this case, this litigation, Cox and how they are looking at
12 Cox, examining Cox, preparing to investigate Cox, and the steps
13 they took.

14 So -- and we outlined that in the reply brief,
15 documents relating to the present lawsuit, Cox, MarkMonitor,
16 and the systems used to monitor/police copyrights.

17 So they indicated in their opposition that they were
18 now expanding their search, and they are going to be searching
19 for non-privileged documents concerning RIAA and Cox during the
20 period 2012 to 2014.

21 So what does that mean? If they come up and say,
22 look, yes, Your Honor, we will pursue the documents that are
23 contained in these requests, particularly focus on Cox, the
24 lawsuit, MarkMonitor, and the systems and monitoring police
25 copyrights, I think then we're in agreement.

1 THE COURT: Okay. Again, the relationship issue is
2 another one on RIAA. I mean, are all the plaintiffs a member
3 of RIAA?

4 MR. OPPENHEIM: I will answer that.

5 THE COURT: Yeah.

6 MR. OPPENHEIM: So the answer is no, Your Honor. The
7 music publishers are not members of the Recording Industry
8 Association, which is a trade association for record companies.
9 So in this case we have a group of record companies,
10 we have a group of music publishers.

11 Your Honor, just by way of background because it
12 seems like -- a little level set here.

13 So the RIAA is a trade association. They do a lot of
14 things. They handle anti-piracy for the entire record
15 industry. They handle anti-piracy on all of the works that are
16 typically pirated of the record companies, including,
17 undoubtedly, thousands, no, millions of notices on the 11,000
18 works at issue here outside of the Cox case. And the requests
19 here would subsume every single -- probably every single
20 anti-piracy investigation that the RIAA has engaged in over the
21 last whatever years.

22 The other thing the RIAA does is they certify all
23 gold and platinum albums and diamond albums and other
24 achievements by artists on recordings. And this request would
25 require disclosure of every one of those documents. Right.

1 So the RIAA also engages in work before the Copyright
2 Office on behalf of the record industry. Work in Congress on
3 the copyright -- work with the copyright Czar.

4 So they do a lot of different things, Your Honor,
5 that have absolutely nothing to do with this case. And the
6 defendants managed to draft their request that would capture
7 virtually every single function of what the RIAA does.

8 So this one, in my mind, rung the bell for the
9 broadest requests.

10 THE COURT: Well, what is it that you are intending
11 to produce?

12 MR. OPPENHEIM: So on page 27 of our opposition, Your
13 Honor, I think we describe three categories of documents that
14 we are working to produce.

15 I will note that there is some overlap here, right,
16 with the MarkMonitor and CAS issues. So, you know, even though
17 we may not list things in -- on page 27 within those three
18 categories, they may be subsumed by the other -- other requests
19 that we've discussed.

20 So on page 27 we describe at the bottom of the page:
21 Documents concerning analysis of the reliability of the
22 MarkMonitor system as it relates to this case. Documents
23 relating to Cox's response to receiving infringement notices.
24 Documents concerning the number of infringement notices Cox
25 would accept from plaintiffs on behalf of plaintiffs.

1 Again, we -- we are happy to engage in an ESI
2 discussion. I feel like this is now my chorus, it is a music
3 case, so I can use that expression, this is my chorus on this
4 motion.

5 And an ESI, bilateral ESI discussion would resolve a
6 lot of these issues. And we are happy to do that.

7 I will also note that they have served a subpoena on
8 the RIAA. The RIAA is not just an agent for the plaintiffs in
9 this respect, but they also serve as counsel because there are
10 attorneys there that manage this program, and they serve as
11 counsel for the plaintiffs on many of these matters.

12 THE COURT: Well, a lot of what you just indicated
13 looks like it's a search for MarkMonitor information and not
14 RIAA information.

15 I mean, you're saying we're already giving them this
16 information about MarkMonitor, we're already giving them the
17 information that MarkMonitor sent them about infringement
18 notices, we're already giving them the information about the
19 number of infringements. I don't see anything that goes beyond
20 what you're doing in relation to MarkMonitor for the RIAA.

21 MR. OPPENHEIM: Well, so I'm -- kind of a two-part
22 response to that, Your Honor.

23 The first is, that's really the only thing the RIAA
24 was involved in with respect to this case was their interaction
25 with MarkMonitor, right, and the sending of the notices.

1 Right. I don't know what else they're looking for in that
2 respect.

3 And, you know, their document requests certainly
4 don't help us to understand what would be reasonably relevant
5 to this case outside of that.

6 But we are searching to see what documents hit both
7 RIAA and Cox. As part of our Cox searches, I guess you would
8 call them part of our RIAA searches, right, but we have yet to
9 see what's going to come up on that outside of what we've
10 already described, Your Honor.

11 THE COURT: All right. All right. Well, Mr.
12 Buchanan, other than making them produce information that -- as
13 to which plaintiffs have relationships, sufficient to show the
14 relationship of RIAA, their search that they're doing with what
15 they're going to provide you, why shouldn't I just also defer
16 on this issue until you get what they have? Again, they have
17 to be somewhat transparent in the -- what they have gotten and
18 what they are withholding from their production.

19 MR. BUCHANAN: Well, Your Honor, rather than -- maybe
20 we could expand that a little bit and just get those documents
21 -- because as the Court just pointed out, they repeatedly offer
22 us MarkMonitor analysis documents like in response to every
23 request we have, whether it is MarkMonitor, RIAA, and the
24 peer-to-peer documents, they just offer the same things. And
25 it's just documents that they're going to use in their case in

1 chief. So it's not really helping.

2 But to answer your question, to move this along, if
3 we could get those documents, they could search for the ones
4 between the plaintiffs, RIAA, relating to this litigation
5 relating to Cox. If you could add that in there because that
6 could -- you know, because, obviously, if they are just -- RIAA
7 is discussing Cox with the plaintiffs, and it's about this
8 litigation or about Cox and about copyright infringement, on
9 Cox, they can run those search terms pretty easy and capture a
10 lot of the information we're looking for beyond just the
11 contractual documents.

12 THE COURT: What would be the issue with producing
13 non-privileged documents between RIAA and the plaintiffs
14 relating to Cox and this lawsuit?

15 MR. OPPENHEIM: First of all, Your Honor, I think
16 what that would produce is 100 percent privileged documents. I
17 can't imagine anything that wouldn't be privileged there.

18 So we would -- I mean, it would be a huge effort to
19 then they demand a lengthy log.

20 But, Your Honor, I guess the question is --

21 THE COURT: Haven't you all agreed to limit the log?

22 MR. OPPENHEIM: We have had discussions on the log,
23 Your Honor, and I think we have been working on that.

24 But, Your Honor, I think that the question is with
25 respect to these requests on the RIAA, outside of the

1 MarkMonitor relationship, right, and overseeing MarkMonitor,
2 how do these documents relate to any of the defendants' -- any
3 of plaintiffs' claims or defendants' defenses. And that's
4 where I am struggling.

5 I mean, leave aside that I don't think that there is
6 anything that directly relates to this litigation that won't be
7 privileged, I just can't understand how what they're asking us
8 to search for is related to their defenses.

9 THE COURT: All right. Well, I'm going to defer that
10 issue. When you talk about this litigation, that does give one
11 pause as to it would probably -- given that they were their
12 agent, probably would involve a substantial amount of
13 privileged documents. I am not so sure that whatever might not
14 fall within that net, however little it might be, would be the
15 worth the time and effort to cull it out.

16 So again, that one is going to be for a later day
17 once you get their response, have a little bit more discussion
18 with them. If there are specific items that you need, you need
19 to talk to them about those specific items and then focus only
20 on those specific items if I have to deal with the issues at a
21 later time.

22 MR. BUCHANAN: So -- thank you, Your Honor. Just on
23 that, to close that out. I assume that if we propose to them
24 certain keywords, such as "RIAA" and "Cox" and "infringement,"
25 to run something like that so the focus is on discussions about

1 Cox, infringement, and with the other plaintiffs, that's
2 obviously not privileged, that that would be something that
3 would be reasonable?

4 THE COURT: Well, you all -- I mean, I'm not going to
5 sit here today and decide on what search terms are reasonable.
6 Okay.

7 So, all right, let's hear -- well, at long last there
8 was one that there is an agreement as to at least two of the
9 document requests, 50 and 51 are no longer part of this issue.

10 What really -- what is it that you're looking for on
11 the peer-to-peer issue?

12 MR. BUCHANAN: I think where we -- if they can expand
13 it to -- they have agreed to go 2012, 2014, most of these, and
14 they indicated that they are subsumed or covered by other
15 responses.

16 I think that if can get them to go back to 2010. And
17 then, you know, what we're looking for is this -- their
18 utilization of BitTorrent. Both, you know, not only in terms
19 of investigating BitTorrent, but in determining whether the
20 utilization of BitTorrent by subscribers to ISPs was negatively
21 impacting them. But whether there was -- their clients or
22 musical artists for whose works they own, whether those people
23 were using BitTorrent to sell or promote their work.

24 So what we're really looking for now, I guess into
25 all these categories, is to go back to 2010. We think that

1 that period is important because it shows not only the trend,
2 but the overall -- an overall picture leading up to the time
3 period in question and through it.

4 And so, that's what we're looking for here, Your
5 Honor.

6 THE COURT: Okay. All right. So if we're talking
7 about doing what you're doing but doing it from 2010 to 2014 as
8 opposed to 2012 to 2014.

9 MR. OPPENHEIM: I'm a little confused. I apologize,
10 Your Honor.

11 So the defendants are saying that 50 and 501 are not
12 an issue anymore, so I suppose they are not moving on them
13 anymore.

14 On 52 and -- and I hate to do this, but I feel like
15 we have to go through this request by request. 52 and 53, as
16 we look at them, they are horribly overbroad. They would
17 request virtually every infringement --

18 THE COURT: Well, what he has suggested is that what
19 you have agreed to provide, that you provide that, but for a
20 longer time period than what you have indicated.

21 So as I understand Mr. Buchanan's position, and
22 maybe I'm -- Mr. Buchanan, if I misstate it, let me know, is
23 what you have agreed to produce so far in response to this
24 information, if you have done it -- you have agreed to do it
25 from 2012 to 2014. What his suggestion is, to resolve this,

1 that it should be from 2010 to 2014.

2 So plaintiffs agreed to produce documents concerning
3 any permitted or authorized uses of plaintiffs' copyrighted
4 works, so and so, during the 2012 to 2014 period.

5 What his proposal is is to make that 2010 to 2014.

6 MR. OPPENHEIM: So, Your Honor, let me take the one
7 sliver of that, the 2015 period after the period of our claims,
8 I'm not sure how that would bear any relevance.

9 THE COURT: All right. So 2010 to 2014.

10 MR. OPPENHEIM: And then with respect to the earlier
11 years, again, different reason, but I still don't think it's
12 relevant to the claims and defenses here.

13 And then search -- so could we do it? Yes. But I
14 don't -- it would produce more documents and more searching,
15 probably unnecessary.

16 This notice program that is at issue -- the notice
17 program is not at issue, I apologize. The notice program that
18 was used to develop evidence against Cox for this case started
19 in 2012. So predating 2012 for these documents, I'm not sure I
20 understand.

21 But 2012 through 2014, we would agree to do that,
22 Your Honor.

23 THE COURT: All right. Well, on this one I'm going
24 to split the difference. It is going to be from 2011 -- to the
25 extent the documents exist, that as you've indicated that you

1 are going to be producing in your opposition on page 29, the
2 time period now needs to be 2011 to 2014 for that.

3 Okay. Thank you, counsel.

4 MR. OPPENHEIM: May I ask one last question, Your
5 Honor?

6 During the course of today's proceedings you have
7 asked that the plaintiffs be transparent in what we're
8 producing and not producing to response to keyword searches,
9 which we absolutely will, Your Honor.

10 I assume that that obligation is a bilateral
11 obligation --

12 THE COURT: I deal with the motions that are in front
13 of me. That's -- you know, that's not an issue that is front
14 of me today. Counsel should work -- try and work together to
15 resolve as many of these issues as you can. If it needs to
16 talk through -- part of the good faith consultation would be
17 to, you know, what you're doing and how you're doing it and why
18 you're doing it.

19 MR. OPPENHEIM: Very well, Your Honor.

20 THE COURT: Okay.

21 MR. OPPENHEIM: Thank you for your time, Your Honor.

22 THE COURT: Thank you. Court will be adjourned.

23 NOTE: The hearing concluded at 12:05 p.m.

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C E R T I F I C A T E of T R A N S C R I P T I O N

I hereby certify that the foregoing is a true and accurate transcript that was typed by me from the recording provided by the court. Any errors or omissions are due to the inability of the undersigned to hear or understand said recording.

Further, that I am neither counsel for, related to, nor employed by any of the parties to the above-styled action, and that I am not financially or otherwise interested in the outcome of the above-styled action.

/s/ Norman B. Linnell

Norman B. Linnell

Court Reporter - USDC/EDVA

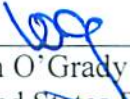
Plaintiffs' Exhibit 5

termination decisions by Cox are relevant. Specifically, the Court **VACATES** its conditional grant of Defendants' Motion *in limine* in its Order of November 19, 2019 (Dkt. 590).

Defendants' motion is hereby **DENIED**, and Plaintiffs may introduce evidence of Cox's terminations for non-payment as identified in Motion *in limine* No. 9 (Dkt. 499).

It is **SO ORDERED**.

December 3, 2019
Alexandria, Virginia



Liam O'Grady
United States District Judge

UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA

BEDFORD, FREEMAN & WORTH
PUBLISHING GROUP, LLC d/b/a
MACMILLAN LEARNING, *et al.*,

Plaintiffs,

v.

SHOPIFY INC., *et al.*,

Defendant.

Case No. 1:21-cv-01340-CMH-JFA

NOTICE OF HEARING

PLEASE TAKE NOTICE that on Friday, April 29, 2022, at 10:00 a.m., or as soon thereafter as counsel may be heard, Plaintiffs will present oral argument in support of their Motion to Compel (ECF No. 60).

Dated: April 22, 2022

Respectfully submitted,

/s/ Scott A. Zebrak

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**UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA**

BEDFORD, FREEMAN & WORTH
PUBLISHING GROUP, LLC d/b/a
MACMILLAN LEARNING, *et al.*,

Plaintiffs,

v.

SHOPIFY INC.,

Defendant.

Case No. 1:21-cv-01340-CMH-JFA

**PLAINTIFFS' MEMORANDUM IN OPPOSITION TO DEFENDANT SHOPIFY INC.'S
MOTION TO COMPEL PRODUCTION OF DOCUMENTS RESPONSIVE TO
SHOPIFY'S FIRST SET OF REQUESTS FOR PRODUCTION**

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CITATION GUIDE

Declarations:

- “**Essig Decl.**” refers to the Declaration of Richard P. Essig on Behalf of Plaintiff Pearson Education, Inc. in Opposition to Defendant Shopify Inc.’s Motion to Compel.
- “**McCann Decl.**” refers to the Declaration of Kelly McCann on Behalf of Plaintiff Elsevier Inc. in Opposition to Defendant Shopify Inc.’s Motion to Compel.
- “**Miller Decl.**” refers to the Declaration of Corey Miller.
- “**Naggar Decl.**” refers to the Declaration of Roger Naggar on Behalf of Plaintiff Bedford, Freeman & Worth Publishing Group, LLC d/b/a Macmillan Learning in Opposition to Defendant Shopify Inc.’s Motion to Compel.
- “**Rosenthal Decl.**” refers to the Declaration of on Behalf of Plaintiff McGraw Hill LLC in Opposition to Defendant Shopify Inc.’s Motion to Compel.
- “**Stitt Decl.**” refers to the Declaration of Jessica Stitt on Behalf of Plaintiff Cengage Learning, Inc. in Opposition to Defendant Shopify Inc.’s Motion to Compel.

Other References:

- “**ECF No.**” refers to a document filed publicly via ECF in this case.
- “**Ex.**” refers to an Exhibit.
- “**Memorandum**” or “**Mem.**” refers to the Memorandum in Support of Defendant Shopify Inc.’s Motion to Compel Production of Documents Responsive to Shopify’s First Set of Requests for Production, ECF No. 53.
- “**Motion to Compel**,” “**Motion**,” or “**Mot.**” refers to Defendant Shopify Inc.’s Motion to Compel Production of Documents Responsive to Shopify’s First Set of Requests for Production, ECF No. 52.
- “**Plaintiffs**” refers to Plaintiffs Bedford, Freeman & Worth Publishing Group, LLC d/b/a Macmillan Learning; Macmillan Holdings, LLC; Cengage Learning, Inc.; Elsevier Inc.; Elsevier B.V.; McGraw Hill LLC; and Pearson Education, Inc.
- “**Shopify**” refers to Defendant Shopify Inc.

INTRODUCTION

Shopify's Motion to Compel cannot withstand scrutiny and should be denied in its entirety. Shopify should not be permitted to use discovery as a bludgeon, to make the costs of enforcing one's rights so high that it is practically impossible to proceed.

Shopify seeks an order requiring initial or further responses to a broad array of discovery that, taken individually or collectively, defy the concept of proportionality under Rule 26. Shopify's discovery demands, upon which it seeks to compel in full, would require a herculean search, review, and production wildly disproportionate to any marginal relevance the requested information may have to any issues in this case. Indeed, in support of its requests, Shopify largely offers statements of only speculation, not relevance.

As to Shopify's assertion that it is producing "vast swaths of documents," whereas Plaintiffs "have agreed to produce almost nothing in return," and "refuse to play by the[] basic rules," that is pure spin. The parties' respective discovery motions will speak for themselves. Plaintiffs are producing substantial discovery, will meet their obligations, and are confident that what they seek and are producing is proportional to the needs of the case.

BACKGROUND

The discovery Shopify seeks to compel is extraordinarily and insupportably broad. For many of the requests at issue, Shopify seeks "all Documents and Communications" concerning a wide range of subject matter:

- "*All Documents and Communications, Including with Third Parties, Concerning Your copyright ownership for each Copyrighted Work . . .*" (RFP 1) (emphasis added).
- "*All Documents and Communications, Including with Third Parties, Concerning licenses or other agreements related to each Work . . .*" (RFP 5) (emphasis added).

- “For each Copyrighted Work, *all Documents and Communications* concerning Your registration of each Copyrighted Work with the U.S. Copyright Office” (RFP 6) (emphasis added).
- “For each Copyrighted Work, *all Documents and Communications* Concerning Plaintiffs’ registration of the Copyrighted Work with any governmental entity located outside of the United States” (RFP 7) (emphasis added).
- “*All Documents and Communications* Concerning the first publication for each Copyrighted Work” (RFP 8) (emphasis added).
- “*All Documents and Communications* Concerning Your relationship with the author(s) for each Copyrighted Work” (RFP 11) (emphasis added).
- “*All Documents and Communications* between You and any other copyright owner(s) Concerning the Copyrighted Works.” (RFP 12) (emphasis added).
- “To the extent a Copyrighted Work is a Work Made for Hire, *all Documents and Communications* Concerning the Work Made for Hire agreement with the author(s) of each such work” (RFP 14) (emphasis added).
- “*All Documents and Communications* Concerning Your efforts, whether past or present, to market, sell, rent, distribute, or otherwise exploit each Copyrighted Work” (RFP 22) (emphasis added).
- “*All Documents and Communications* Concerning royalty distributions resulting from sale, rental, distribution, or any other exploitation of the Copyrighted Work.” (RFP 24) (emphasis added).
- “For each Copyrighted Work, *all Documents and Communications* Concerning Your contention that You suffered financial harm from the alleged infringement of the Copyrighted Work, as alleged in the Complaint.” (RFP 45) (emphasis added).

Mot. Ex. 1, at 6-21.¹

The above referenced “all Documents and Communications” requests are so devoid of proportionality that Shopify resorts to obscuring their breadth. As reflected above, Shopify seeks to compel Plaintiffs “to immediately produce all non-privileged documents responsive to” those requests for production as drafted. Mem. 24; Proposed Order, ECF No. 52-1. Yet, in its Memorandum, Shopify selectively quotes from its requests and never sets forth their full extent.

¹ Shopify’s Motion also includes RFPs 2 to 4, 9 to 10, 13, and 21.

The phrase “All Documents” appears in each of the above-referenced requests but not even once in Shopify’s Memorandum.

FAILURE TO MEET AND CONFER

Normally, Plaintiffs would not bother the Court with the details of disputes over conferrals, but the issue here is important to the orderly progress of the case. While the parties conferred for nearly seven hours on various discovery disputes, those conferrals did not include discussion of RFPs 7, 8, 9, 10, 12, 21, and 22, all of which Shopify included in its Motion. *See* Miller Decl. ¶ 3. Invoking the expedited discovery process on the Friday leading into the Easter and Passover weekend, Shopify simply moved on these requests without ever conferring on them. *Id.* ¶¶ 3–4. For instance, as to RFP 22, Shopify does not dispute that the parties never specifically conferred regarding RFP 22. Instead, Shopify claimed that, because the parties had conferred on *other* “damages-related requests” and Shopify had included RFP 22 in a list of potential conferral topics, Miller Decl. ¶ 6 (quoting emails dated Apr. 15, 2022 from Jessica Stebbins Bina to Corey Miller, copying other counsel at Latham & Watkins and Oppenheim & Zebrak) (emphasis added), Shopify had no obligation to specifically confer on RFP 22. But the other requests on which the parties conferred are not co-extensive with RFP 22, which uniquely seeks “[a]ll Documents and Communications Concerning Your efforts, whether past or present, to market, sell, rent, distribute, or otherwise exploit each Copyrighted Work” Mot. Ex. 1.

ARGUMENT

I. Wide-ranging discovery on Plaintiffs’ ownership is not justified.

A. There is no basis to believe that further ownership discovery would uncover evidence affecting Plaintiffs’ ownership claims.

There is simply no reason to doubt that Plaintiffs own or have exclusive licenses to the works at issue. These copyrights are among their respective core assets. Essig Decl. ¶ 5; McCann

Decl. ¶ 5; Naggar Decl. ¶ 5; Rosenthal Decl. ¶ 5; Stitt Decl. ¶ 5. Courts have repeatedly held that the Plaintiff publishers own the rights in the textbooks they publish. *See, e.g., John Wiley & Sons, Inc. v. Book Dog Books, LLC*, 327 F. Supp. 3d 606, 624 (S.D.N.Y. 2018) (holding that “[t]he jury was entirely justified in concluding that Plaintiffs [including Cengage, Pearson, and McGraw Hill] established ownership for all works” where the evidence showed “that when an author is listed as the copyright holder, the author signs a written agreement that the publishing company has the exclusive rights to market and distribute that particular title”) (internal quotation marks omitted).

To demonstrate ownership, Plaintiffs are producing copyright registrations for the works in suit, and, for each work in suit for which the registration lists someone other than Plaintiff as the copyright claimant, documents sufficient to show Plaintiffs’ chain of title to the claimant on the registration. Essig Decl. ¶ 6; McCann Decl. ¶ 6; Naggar Decl. ¶ 6; Rosenthal Decl. ¶ 6; Stitt Decl. ¶ 6. Shopify’s argument that Plaintiffs’ registrations are insufficient to carry their burden of proving ownership is wrong. The Copyright Act provides that, “[i]n any judicial proceedings the certificate of a registration made before or within five years after first publication of the work shall constitute prima facie evidence of the validity of the copyright and of the facts stated in the certificate.” 17 U.S.C. § 410(c).

Courts regularly hold that a plaintiff satisfies its burden to prove ownership simply by showing registration. *See, e.g., United Fabrics Int’l, Inc. v. C&J Wear, Inc.*, 630 F.3d 1255, 1258 (9th Cir. 2011) (holding that “[The plaintiff] did not have to produce any evidence. As the copyright claimant, [the plaintiff] is presumed to own a valid copyright, 17 U.S.C. § 410(c), and the facts stated therein, including the chain of title in the source artwork, are entitled to the presumption of truth.”); *Thomas v. Artino*, 723 F. Supp. 2d 822, 830 (D. Md. 2010) (granting summary judgment on ownership where “Plaintiff provided his certificate of registration”); *Yash*

Raj Films (USA) v. Kumar, No. 05-CV-3811 (FB)(KAM), 2006 WL 3257215, at *1 (E.D.N.Y. Nov. 9, 2006) (denying a request for chain-of-title documents for hundreds of copyrighted works because “[p]laintiff . . . is entitled to the presumption of validity” and the defendants had “not shown why the Court should compel the chain of title information for over one hundred works . . . given the significant burden that this would place on plaintiff”).

As the Fifth Circuit has stated, requiring the plaintiff to prove chain-of-title from the authors to the registration claimant “would deprive the copyright registration of its prima facie evidentiary effect.” *Lewis v. Ichiban Recs., Inc.*, 105 F.3d 655 (5th Cir. 1996); *see also Marobie-FL, Inc. v. Nat'l Ass'n of Fire Equip. Distribs.*, 983 F. Supp. 1167, 1173 (N.D. Ill. 1997) (holding that “[a] plaintiff’s chain of title from the author is presumed by reason of the registration certificate where the plaintiff obtained an assignment of rights prior to registration”) (citing 4 Melville B. Nimmer and David Nimmer, *NIMMER ON COPYRIGHT*, § 13.01[A]).

In *BMG v. Cox*, the Court specifically rejected Cox’s argument that “chain of title must relate back to the author[.]” 149 F. Supp. 3d 634, 645 (E.D. Va. 2015) (collecting cases) (granting summary judgment to BMG on ownership based on chain of title documents connecting named claimant on the registration certificate to named plaintiffs). In *Sony v. Cox*, this Court likewise rejected a similar demand to that from Shopify here. *See* Jan. 25, 2019 Hr’g Tr. 33:10–10:12, *Sony Music Ent. v. Cox Commc’ns, Inc.*, No. 1:18-cv-950 (E.D. Va.) (Anderson, M.J.) (denying motion to compel production of underlying ownership evidence for all works in suit on the basis that registrations and chain-of-title back to the non-plaintiff registrant is sufficient).

Indeed, easing a plaintiff’s burden to establish ownership is one of the core purposes of the presumption. The drafters of the presumption made this clear, stating that “[t]he plaintiff should not ordinarily be forced in the first instance to prove all of the multitude of facts that underline the

validity of the copyright unless the defendant, by effectively challenging them, shifts the burden of doing so to the plaintiff.” H.R. Rep. No. 94-1476, at 157 (1976).

That the presumption of validity is rebuttable does not justify the discovery Shopify seeks. To justify the extensive discovery it seeks, Shopify must establish “the importance of the discovery in resolving the issues” and that “the burden or expense of the proposed discovery outweighs its likely benefit.” Fed. R. Civ. P. 26(b)(1). In light of the presumption of validity, Shopify must demonstrate some concrete basis to believe that the discovery it seeks will uncover evidence casting doubt on Plaintiffs’ ownership. Shopify has entirely failed to do this.

The cases Shopify cites, *see* Mem. 9–11, do not remotely justify the expansive discovery that it seeks.

Shopify relies on *Princeton Payment Solutions*, a summary judgment decision that says nothing about discovery. *Princeton Payment Sols., LLC v. ACI Worldwide, Inc.*, No. 1:13-CV-852, 2014 WL 4104170 (E.D. Va. Aug. 15, 2014). Further, that case has vastly different facts: at the time the alleged copyright violations occurred, the plaintiff had not yet filed copyright applications for software at issue, and the work at issue was created by an independent contractor who never assigned the plaintiff any rights. *Id.* at *4.

Shopify mischaracterizes *ALS Scan, Inc. v. Cloudflare, Inc.*, which, contrary to Shopify’s argument, did not compel production of ownership documents. No. 2:16-CV-05051-GW-AFM, 2017 WL 4769435, at *1 (C.D. Cal. June 28, 2017). There, the plaintiff did not object to producing ownership documents, but claimed it had produced them all, and the court required the plaintiff to provide a sworn verification confirming production. *Id.* In *Tapscan, Inc. v. Friberg*, the plaintiff did not make a burden objection, and that case was decided under the old Rule 26 standard which

did not require a proportionality analysis. No. 2:04CV696 DB, 2005 WL 8174972, at *2 (D. Utah June 21, 2005).

In *Napster*, the defendant identified potential inaccuracies in some of the plaintiffs' registrations that justified further discovery. *In re Napster, Inc. Copyright Litig.*, 191 F. Supp. 2d 1087, 1098 (N.D. Cal. 2002). The court concluded that, due to these inaccuracies, the defendant "has raised serious questions as to the validity of plaintiffs' claims of ownership as authors," and ordered further discovery on ownership. *Id.* at 1100. But in doing so, the court cautioned that "this court will not permit Napster to engage in a 'fishing expedition.' The advantage of the current statutory scheme is that plaintiffs need not produce mounds of documents in order to maintain an infringement action." *Id.*

Monge v. Maya Mags., Inc. did not concern a plaintiff's ownership discovery obligations at all; instead, it denied a motion to quash a third-party subpoena for deposition testimony. No. 2:10-CV-00230-RCJ-PA, 2010 WL 2776328, at *5 (D. Nev. July 14, 2010). And *Arista Records LLC v. Myxer Inc.* is a one-paragraph opinion containing minimal analysis and no background or explanation of the ownership dispute in the case. No. CV 08-3935, 2009 U.S. Dist. LEXIS 132668, at *1–2 (C.D. Cal. Nov. 30, 2009 (Mem. Ex. 7)).

That Shopify has pled Plaintiffs' lack of ownership as an affirmative defense has no effect on the discovery analysis. In fact, what Shopify has pled is not even a true affirmative defense. An affirmative defense is a defense that "can absolve an individual of liability regardless of actual wrongdoing." *Nickens v. State Emps. Credit Union, Inc.*, No. CIV.A. RDB-13-1430, 2014 WL 3846060, at *4 (D. Md. Aug. 4, 2014). By contrast, "allegations [that] solely point out specific alleged defects in the Plaintiff's prima facie case" are not "true affirmative defenses." *Id.* Shopify's claim that "Plaintiffs do not own or hold the exclusive rights under 17 U.S.C. § 106" merely alleges

that Plaintiffs cannot establish an element of their claims (ownership), and so is not a true affirmative defense.

B. Shopify’s contention that Plaintiffs obtain their copyrights from the wrong parties is contrived and lacks any factual basis.

1. There is no evidence that authors who transacted with Plaintiffs lacked the rights to do so.

Shopify’s theory—alleged in a footnote in its Answer—is that Plaintiffs obtained copyright rights from individuals (authors) who never owned them in the first place, because the works are works for hire owned by universities. Answer 6 n.3; Mem. 12–16. This theory is nothing more than a speculative fiction with no basis in fact.

This is the dog that didn’t bark. These books are not published in secret. Plaintiffs have been openly commercializing many of the works in suit for many years, even decades in some cases. They are openly promoted and distributed, including at universities where authors are professors. Essig Decl. ¶ 13; McCann Decl. ¶ 13; Rosenthal Decl. ¶ 13; Stitt Decl. ¶ 13. If, as Shopify suggests, universities own copyrights worth potentially enormous amounts of money that others are exploiting, one would expect to see universities asserting those claims. But Shopify points to no evidence that any university has ever done so. Shopify’s Motion does not identify a single instance in which a university has sent a demand letter or brought a lawsuit asserting ownership rights in any of the works at issue, or even in Plaintiffs’ textbooks more generally.

The material Shopify cites undermines, rather than supports, Shopify’s theory. Shopify cites two examples of authors of works in suit who are professors at universities. Mem. 13 n.8. Those professors are employed by The Ohio State University and Marquette University, respectively. *Id.* Ohio State’s Intellectual Property Policy makes clear that textbooks like the works in suit are not works for hire, stating, “[a]ll copyrights in instructional works, scholarly works [including textbooks], and artistic works whose creators are faculty members, except for software,

remain with their creators. The university hereby assigns any of its copyrights in such works, insofar as they exist, to their creators.”² Similarly, Marquette’s policy states, “[i]n keeping with academic tradition . . . the University does not claim ownership to pedagogical, scholarly or artistic works, regardless of their form of expression, and *such works are not works made for hire*. These copyrighted works include, but are not limited to, *textbooks*”³ Both of these policies accord with the observation in *Molinelli-Freytes*, which Shopify cites, that “[m]ost academic institutions today have already responded to the uncertainty regarding the ‘teacher exception’ by enacting policies, returning ownership of works traditionally copyrighted by professors to the professors themselves.” *Molinelli-Freytes v. Univ. of Puerto Rico*, 792 F. Supp. 2d 164, 172 (D.P.R. 2010).

The university policies Shopify cites as purportedly establishing that textbooks are works for hire, Mem. 15, n.12, actually show the opposite. Shopify cites the University of North Texas’s policy, but this policy states that “‘Creator-Owned Intellectual Property’ means Intellectual Property *owned by the Creator with no ownership by UNT* . . . pedagogical, scholarly or artistic works by UNT faculty, staff or students are also included as Creator-Owned Intellectual Property (examples are *most textbooks*”⁴ Shopify cites Florida State’s website, which simply restates the law on work for hire as a general matter, without any discussion of professors or textbooks.⁵ Shopify ignores Florida State’s Collective Bargaining Agreement with its faculty union, which

² The Ohio State University, INTELLECTUAL PROPERTY UNIVERSITY POLICY 3 (revised Apr. 15, 2018), available at <https://oied.osu.edu/sites/default/files/pdfs/IP-Policy.pdf> (last accessed Apr. 16, 2022) (emphasis added).

³ Marquette University, MARQUETTE UNIVERSITY INTELLECTUAL PROPERTY POLICY 4 (effective Apr. 1, 2013), available at <https://www.marquette.edu/orsp/documents/IntellectualPropertyPolicy.pdf> (last accessed Apr. 16, 2022) (emphasis added).

⁴ University of North Texas, POLICIES OF THE UNIVERSITY OF NORTH TEXAS 08.003 INTELLECTUAL PROPERTY 2 (revised Apr. 2018), available at <https://policy.unt.edu/sites/default/files/08.003%20Research%20Intellectual%20Property.pdf> (emphasis added) (last accessed Apr. 33, 2022).

⁵ *Copyright Ownership: Who Owns What?*, Florida State University, <https://www.research.fsu.edu/research-offices/oc/fsu-invention-disclosure-form-and-inventor-information/copyrights/>.

states that “[t]he University shall not assert rights to . . . [t]hose works for which the intended purpose is to disseminate the results of academic research, scholarly study, or creative efforts, *such as books*”⁶ Finally, the Navarro College policy says nothing about textbooks.⁷

Shopify cites two academic articles, one of which is more than thirty years old. Mem. 14. Neither is authoritative, let alone applicable here. Further, while Shopify cites one of the articles for the proposition that universities own scholarly works, Shopify ignores the article’s next paragraph, which begins, “And yet . . . the answer is not always that easy,” and then goes onto to explore how authors can continue to own rights in their scholarly works. Sara Benson, “*I own it, don’t I?*” *The Rules of Academic Copyright Ownership and You*, 25 COLL. & UNDERGRADUATE LIBRARIES 317, 322 (2017).

It is axiomatic that Shopify’s conjecture and argument are not a basis for discovery. See *Surles v. Air France*, No. 00 5004 (RMB) (FM), 2001 WL 1142231, at *2 (S.D.N.Y. Sept. 27, 2001) (“the information sought by Defendant does not become relevant merely because Defendant speculates that it might reveal useful material”); *In re Alliance Pharmaceutical*, 1995 WL 51189, *1 (S.D.N.Y. Feb. 9, 1995) (“[D]iscovery requests . . . cannot be based on pure speculation or conjecture.”).

⁶ Art. 18, Inventions and Works, COLLECTIVE BARGAINING AGREEMENT: THE FLORIDA STATE UNIVERSITY BOARD OF TRUSTEES AND THE UNITED FACULTY OF FLORIDA GENERAL FACULTY BARGAINING UNIT 2019 – 2022 84, available at https://hr.fsu.edu/sites/g/files/upcbnu2186/files/PDF/Publications/UFF_CBA_Updated_2021.pdf (last accessed Apr. 16, 2022) (emphasis added).

⁷ Navarro College, BUSINESS AND SUPPORT SERVICES INTELLECTUAL PROPERTY POLICY (issued Jan. 22 2015), <https://www.navarrocollege.edu/boardpolicies/section-c/section-co.html> (last accessed Apr. 16, 2022).

2. University policies disclaiming ownership vest the copyright in the author, and Shopify lacks standing to challenge the sufficiency of ownership assignments between third parties and Plaintiffs.

Shopify's complaint that university policies do not constitute a signed writing sufficient to transfer ownership to the authors ignores that these policies' clear language explicitly disclaims that such works are works for hire in the first place. These policies are part of the contract between the university and the author. *See Charest v. President & Fellows of Harvard Coll.*, No. CV 13-11556-DPW, 2016 WL 614368, at *12 and n.5 (D. Mass. Feb. 16, 2016) (holding that a university's IP policy forms part of the contract between the university and its employees and citing cases reaching the same conclusion). Where the contract between the university and author specifically excludes scholarly works from works for hire, the copyright initially vests in the author, not the university.

Shopify has no standing to challenge any purported lack of transfer of ownership between universities, professors, and Plaintiffs. The Fourth Circuit has held that the Copyright Act's ownership transfer requirements "w[ere] intended to resolve disputes between owners and alleged transferee[s], and w[ere] not intended to operate for the benefit of a third-party infringer when there is no dispute between the owner and transferee." *Metro. Reg'l Info. Sys., Inc. v. Am. Home Realty Network, Inc.*, 722 F.3d 591, 601 (4th Cir. 2013). In such cases, it would be an "anomaly [to] allow[] [the third-party infringer] to fabricate for its own benefit a dispute between" Plaintiffs, authors, and universities. *Id.* Fabricating a dispute is exactly what Shopify has attempted to do, as there is no evidence of any dispute between the universities, authors, and Plaintiffs. Accordingly, Shopify's argument must be rejected.⁸

⁸ *See also Complex Sys., Inc. v. ABN Ambro Bank N.V.*, 979 F. Supp. 2d 456, 474 (S.D.N.Y. 2013) (holding that infringer could not assert defense that a third party owned rights in the work in suit where the statute of limitations barred the third party from itself asserting ownership); *Easter Unlimited, Inc. v. Rozier*, No.

C. The specific requests to which Shopify seeks to compel responses are not proportional to the needs of the case.

In light of these considerations, Plaintiffs now turn to Shopify’s specific requests at issue.

RFP 1 seeks “[a]ll Documents and Communications, Including with Third Parties, Concerning Your copyright ownership for each Copyrighted Work” Here, Plaintiffs have agreed to produce copyright registrations and, for each Copyrighted Work for which the registration lists someone other than Plaintiff as the copyright claimant, documents sufficient to establish Plaintiff’s ownership of or exclusive rights in that Copyrighted Work (*i.e.*, documents sufficient to show chain-of-title to the claimant on the registration). *See* Essig Decl. ¶ 6; McCann Decl. ¶ 6; Naggar Decl. ¶ 6; Rosenthal Decl. ¶ 6; Stitt Decl. ¶ 6. As part of this production, Plaintiffs will produce evidence of chain-of-title for more than 200 works, including at least one work for each Plaintiff. This sufficiently satisfies Plaintiffs’ burden to demonstrate ownership.

Shopify’s claim that it needs all documents and communications concerning Plaintiffs’ ownership “to test Plaintiffs’ assertion of ownership” fails the Rule 26 standard because Shopify cannot explain the discovery it seeks is likely to produce evidence that undermines Plaintiffs’ ownership claims. Shopify argues that there are “serious challenges Plaintiffs face in establishing they obtained ownership rights from the original rights-holders, *i.e.*, from universities rather than professors.” Mem. 17. But, as shown above, there is no reason to think this is a “serious challenge.” Even if it were, Shopify cannot explain how the discovery it seeks is likely to uncover significant evidence concerning Shopify’s work-for-hire theory. Shopify does not need every agreement with every author of every work in suit to establish that Plaintiffs generally contract for copyright

18-CV-06637 (KAM), 2021 WL 4409729, at *8 (E.D.N.Y. Sept. 27, 2021) (holding that, where a third party “is time-barred from asserting a claim under the Copyright Act against Plaintiff, [] Defendant may not rely on this time-barred theory to defeat the presumption of Plaintiff’s copyright validity”). To allow otherwise would threaten “the principles of repose integral to a properly functioning copyright market” that the statute of limitations aims to promote. *Merch. v. Levy*, 92 F.3d 51, 56 (2d Cir. 1996)

ownership or other publishing rights with authors, not universities, as Plaintiffs do not dispute this point. Essig Decl. ¶ 13; McCann Decl. ¶ 13; Naggar Decl. ¶ 13; Rosenthal Decl. ¶ 13; Stitt Decl. ¶ 13. Plaintiffs' ownership documents are not likely to contain the information Shopify seeks regarding the relationships between universities and professors, as those are relationships between those third parties. Further, the burdens associated with producing these agreements are significant. *See* Essig Decl. ¶¶ 7–9; McCann Decl. ¶¶ 7–9; Naggar Decl. ¶¶ 7–9; Rosenthal Decl. ¶¶ 7–9; Stitt Decl. ¶¶ 7–9.

Shopify's claim that it "offered Plaintiffs the option of initially producing just a sampling of responsive ownership records," Mem. 12, ignores that Plaintiffs are already producing chain-of-title evidence for more than 200 works. Shopify rejected Plaintiffs' suggestion that Shopify review this production and then confer with Plaintiffs regarding any additional need for documents, and instead filed this Motion.

RFP 2 seeks "[a]ll Documents and Communications sufficient to identify the ownership percentage for each Copyrighted Work for any Person other than You." Here, each Plaintiff responded that, "based on information currently available to it, it is unaware of any document responsive to this request in its possession, custody, or control." *See, e.g.*, Mem. Ex. 1, at 6–7. This is because, to the best of Plaintiffs' knowledge, there are no other persons besides Plaintiffs who own the rights to publish, reproduce, or distribute the works in suit. Shopify's Motion does not dispute Plaintiffs' response; it ignores it entirely. Accordingly, there is nothing for Plaintiffs to produce and Shopify's Motion on this RFP should be denied.

RFP 3 seeks "[a]ll Documents and Communications sufficient to show the entire chain-of-title for the copyright of each Copyrighted Work." This request is subsumed by RFP 1, and Shopify's Motion fails for the same reasons.

RFP 4 seeks “[a]ll licenses and other agreements Concerning each Copyrighted Work” Shopify’s request for licenses and agreements with third parties should be denied.⁹ Shopify’s argument that it needs this discovery because “some of the merchants who allegedly engaged in copyright infringement using Shopify’s platform may have obtained valid licenses to the Copyrighted Works from such distributors or third parties,” Mem. 18, is meritless. There is no factual basis suggesting that any of the Shopify merchants at issue had valid licenses to sell digital copies of the books at issue. Despite having commercial relationships with each of the Shopify merchants at issue, Shopify has not identified a single one claiming it had a valid license. Plaintiffs have offered to produce: (i) once Shopify has identified the Shopify merchants at issue, any licenses or agreements Plaintiffs have with those Shopify merchants; and (ii) for any particular Shopify merchant Shopify can identify that claims to have a valid license from a third party, any licenses or agreements with the third party from whom the merchant claims a license. Nothing further is required.

Shopify’s conclusory claim that it needs Plaintiffs’ licenses with third parties for damages purposes does not withstand scrutiny. *See* Mem. 18. Shopify’s Motion does not explain how Shopify could use these licenses to determine the scope of Plaintiffs’ harm. Absent such a showing, Shopify’s request should be denied.

RFP 5 seeks and “[a]ll Documents and Communications, Including with Third Parties, Concerning licenses or other agreements related to each Work” In its Motion, Shopify does not even attempt to justify this enormous request. Shopify lumps this request in with its request for the agreements themselves (RFP 4), but Shopify’s arguments address only the agreements, not

⁹ To the extent these requests seek agreements between the authors and Plaintiffs, they are duplicative of RFPs 1 and 3 and should be denied for the same reasons.

the documents and communications concerning the agreements. Such documents and communications have no relevance. Further, responding to this request would impose an immense burden: this request seeks all communications with, or concerning, all of Plaintiffs' authorized distributors concerning a broad subject area across many years.

RFP 6 seeks, “[f]or each Copyrighted Work, all Documents and Communications concerning Your registration of each Copyrighted Work with the U.S. Copyright Office in which You allege You possess an ownership interest.” Shopify claims to seek this information “to determine whether Plaintiffs’ registrations are in fact valid,” Mem. 19, but Shopify presents no basis to question the validity of Plaintiffs’ registrations. The Copyright Act presumes such registrations are valid, and Shopify has presented no basis to doubt that presumption. 17 U.S.C. § 410(c). The registration process hardly ever includes substantive communications with the Copyright Office regarding Plaintiffs’ entitlement to registration. Essig Decl. ¶¶ 14-16; McCann Decl. ¶¶ 14-16; Naggar Decl. ¶¶ 14-16; Rosenthal Decl. ¶¶ 14-16; Stitt Decl. ¶¶ 14-16. There is no basis to suggest that these documents would somehow undermine Plaintiffs’ registrations. If a defendant could always obtain wide-ranging discovery into the validity of a plaintiff’s registrations without any basis to suggest that discovery would uncover evidence casting doubts on the registration’s validity, the presumption would be meaningless.

Shopify’s claim that it needs the deposit copies does not justify its request. Plaintiffs have already agreed to produce copies of all of the works in suit in their possession. *See, e.g.*, Mem. Ex. 1 at 17–18 (“Plaintiff will produce . . . legitimate exemplars of Plaintiff’s authentic Copyrighted Works . . .”). These are identical to the deposit copies. There is no basis to require anything else. Nor does Shopify need the deposit copies to assess whether “any materials within that scope have actually been sold through Shopify’s platform.” Mem. 20. Substantial similarity is not likely to be

a key issue in this case: the pirated copies of Plaintiffs' works that Shopify merchants sold are identical to the authentic works—that is the whole point of selling counterfeits.¹⁰

RFP 7 seeks “[f]or each Copyrighted Work, all Documents and Communications Concerning Plaintiffs’ registration of the Copyrighted Work with any governmental entity located outside of the United States” As Plaintiffs have registered all of the works at issue in the United States, any foreign registrations have no relevance here. Shopify’s Motion does not even attempt to explain any need for foreign registrations, let alone for “all documents and communications” concerning any foreign registrations.

RFPs 8 and 9 seek “[a]ll Documents and Communications Concerning the first publication for each Copyrighted Work” and “[f]or each Copyright Work first published outside of the United States, all Documents and Communications sufficient to show when the Copyrighted Work was first published in the United States or a treaty party.” Here, Plaintiffs are producing the registrations for each work, and the Form TX registration has specific fields for the date and nation of publication.¹¹ Those facts are entitled to the presumption of validity. *See* 17 U.S.C. § 410(c) (including within the validity presumption “the facts stated in the certificate”). Shopify presents no reason to doubt it, nor to think that further discovery would contradict it. Nor does Shopify’s purported need to determine the date of first publication justify production of “all Documents and Communications Concerning the first publication.”

¹⁰ If Shopify wants to compare the copies Plaintiffs produce to the copies deposited with the Copyright Office, it can obtain the deposit copies itself from the Copyright Office. *See Mercer Publ’g Inc. v. Smart Cookie Ink, LLC*, No. C12-0188JLR, 2012 WL 12863933, at *1 (W.D. Wash. Nov. 27, 2012) (observing that both parties can equally obtain deposit copies from the Copyright Office and holding that, where a plaintiff has introduced a valid registration, “it is Defendants’ burden to acquire deposit copies if they want them”).

¹¹ *See* Form TX, U.S. Copyright Office, <https://www.copyright.gov/forms/formtx.pdf> (May 2019) (at Space 3.b).

RFP 10 seeks “[a]ll Documents and Communications sufficient to show the author(s) for each Copyrighted Work.” Here, Plaintiffs have agreed to produce the registrations for each work, which typically list the authors of the work, and copies of the works themselves, which identify the authors on the title page. *See* Mem. Ex. 1, at 17–18. Shopify’s Motion does not even try to explain why this response is insufficient, because it is not.

RFP 11 seeks “[a]ll Documents and Communications Concerning Your relationship with the author(s) for each Copyrighted Work” Contrary to Shopify’s claim, each Plaintiff’s ownership does not “hinge[] on . . . communications reflecting *who* has purported to transfer rights to Plaintiffs, and whether such transfers were in fact authorized.” *See* Mem. 18. Plaintiffs’ ownership relies on their actual agreements with authors, as reflected in their registrations, in which the authors represent that the authors have authority to transfer copyright. *See* Essig Decl. ¶ 6; McCann Decl. ¶ 6; Naggar Decl. ¶ 6; Rosenthal Decl. ¶ 6; Stitt Decl. ¶ 6. Shopify’s forlorn hope that Plaintiffs might possess communications in which “a professor request[s] to a Plaintiff that ‘we need to re-write our publishing agreement, as my university is now claiming ownership of the book,’” but that such situation was then ignored, is precisely the kind of “fishing expedition” that courts do not permit.

Moreover, even if Shopify’s work-for-hire theory had any merit (and it does not), the discovery Shopify seeks does not address it. Evidence supporting or disproving Shopify’s theory that universities’ contracts with professors and policies regarding professors’ work render professors’ books works for hire is not likely to be found in *Plaintiffs’* files. Plaintiffs do not dispute that they generally contract with the authors, not the universities. There is nothing further to be gained by forcing Plaintiffs to shoulder the immense burden of producing all of their communications with the authors.

Make no mistake, that burden is immense. For any single work in suit, Plaintiffs likely have at least several employees, if not dozens, who communicated with the authors of that work. Essig Decl. ¶¶ 10–12; McCann Decl. ¶¶ 10–12; Naggar Decl. ¶¶ 10–12; Rosenthal Decl. ¶¶ 10–12; Stitt Decl. ¶¶ 10–12. Further, Plaintiffs’ employees who communicated with the authors of one title are unlikely to be the same employees who communicated with authors of another title. *Id.* Thus, finding all communications with the authors of the works in suit would require collecting the emails of up to hundreds, of employees. *Id.* Plaintiffs would then need to craft individualized search terms for each employee to find communications with the authors of the specific works at issue. *Id.* And the time period could often cover many years, and sometimes decades. *Id.*

While Shopify frames its request in terms of ownership issues, its actual request is much broader, seeking “all Documents and Communications Concerning Your relationship.” This could conceivably require producing nearly all Plaintiffs’ communications with the authors, regardless of relevance to the case. Shopify has not even attempted to justify the actual scope of the request it asks the Court to enforce.

RFP 12 seeks “[a]ll Documents and Communications between You and any other copyright owner(s) Concerning the Copyrighted Works.” Shopify’s Motion does not identify who the “other copyright owner(s)” are that are at issue in this request. If Shopify is referring to the authors of the works in suit, then the request is duplicative. If Shopify is referring to copyright owners other than the authors, Shopify has not attempted to explain why communications with these mystery copyright owners are likely to be relevant, nor how Plaintiffs could search for communications with unidentified persons.

RFPs 13 and 14 seek “[a]ll Documents sufficient to show whether any of the Copyrighted Works are Works Made For Hire” and, “[t]o the extent a Copyrighted Work is a Work Made for

Hire, all Documents and Communications Concerning the Work Made for Hire agreement with the author(s) of each such work” Here, the registrations Plaintiffs are producing indicate whether a work is a work for hire, and that information is entitled to the presumption of validity. *See* 17 U.S.C. § 410(c) (including within the validity presumption “the facts stated in the certificate”). Shopify has not provided any basis to doubt the registrations’ accuracy, such that additional discovery is necessary.

II. Shopify cannot justify the extremely broad financial discovery it seeks.

Shopify’s Motion inaccurately characterizes Plaintiffs’ position on damages discovery. While Plaintiffs have elected statutory damages, Plaintiffs have never maintained that Plaintiffs’ “election of statutory damages means that any further discovery into their actual harm is irrelevant,” as Shopify claims. Mem. 21. On the contrary, as Plaintiffs have repeatedly explained to Shopify in conferrals and emails, Plaintiffs’ position is that, having elected statutory damages, Plaintiffs have no obligation to *prove* actual damages—which is a correct statement of the law. *See, e.g., F. W. Woolworth Co. v. Contemp. Arts*, 344 U.S. 228, 230, 233 (1952) (upholding statutory damages award even though “the record is inadequate to establish an actually sustained amount [of damages]” because “[e]ven for uninjurious and unprofitable invasions of copyright the court may, if it deems it just, impose a liability within statutory limits to sanction and vindicate the statutory policy”). Further, contrary to Shopify’s claim, it is incorrect that Plaintiffs are refusing to produce any documents on their damages. Plaintiffs have agreed to search for and produce significant damages-related discovery, including non-privileged documents in the following categories:

- Documents sufficient to show the prices at which the works in suit were legitimately sold in the United States;
- Analyses of the effects of digital piracy on Plaintiff’s business; and

- Reports that show the valuation for a work in suit.

Mem. Ex. 1 at 29-32.

A. Plaintiffs have agreed to produce documents regarding valuation.

Shopify's assertion that Plaintiffs have refused to produce documents regarding valuation of the works in suit is incorrect. In response to Shopify's RFP 21, seeking "[a]ll Documents and Communications sufficient to show Plaintiffs' valuation of each Copyrighted Work, Including any valuation reports or similar evaluative assessments conducted by Plaintiffs or third parties," Plaintiffs agreed to produce "any nonprivileged reports created since January 1, 2017, that show the valuation for a Copyrighted Work, to the extent any such reports exist and can be found after a reasonable search." *See, e.g.*, Mem. Ex. 1 at 29. Shopify does not explain why this response is insufficient, because it is not.

B. Shopify's request for all documents concerning exploitation of the works in suit is grossly overbroad.

Again, Shopify's Motion elides the extreme breadth of its requests. Shopify did not limit its Motion to the "documents concerning Plaintiffs' alleged harms as result of alleged infringement of the Copyrighted Works on Shopify's platforms." Mem. 20. The requests Shopify asks the Court to enforce seek:

- **RFP 22:** All Documents and Communications Concerning Your efforts, whether past or present, to market, sell, rent, distribute, or otherwise exploit each Copyrighted Work, Including without limitation Documents sufficient to show the revenue You receive for each Copyrighted Work for each such exploitation." Mem. Ex. 1 at 29 (RFP 22).
- **RFP 24:** All Documents and Communications Concerning royalty distributions resulting from sale, rental, distribution, or any other exploitation of the Copyrighted Work.

Efforts to market, sell, rent, distribute, or otherwise exploit textbooks comprise a significant share of Plaintiffs' respective operations, touching on nearly every aspect of Plaintiffs' businesses,

including editorial, sales, marketing, customer service, finance, strategy, distribution, and rights and permissions. Essig Decl. ¶¶ 19-20; McCann Decl. ¶¶ 19-20; Naggar Decl. ¶¶ 19-20; Rosenthal Decl. ¶¶ 19-20; Stitt Decl. ¶¶ 19-20. Similarly, Shopify does not explain why it needs all documents and communications concerning royalty distributions. The burden of responding to these requests would be overwhelming, *id.*, and Shopify does not even attempt to justify it.

C. The revenues and royalties Shopify seeks are irrelevant because they do not show the harm resulting from infringement.

Shopify's Motion to Compel production of revenue data and royalties for Plaintiffs' works should be denied because Plaintiffs' revenues are not relevant to statutory damages. Shopify acknowledges that the relevant statutory damages factor is "plaintiff's actual losses, including any lost revenue." Mem. 22 (internal quotations omitted). Plaintiffs' revenues and royalties earned from sales that took place will not show in any way Plaintiffs' lost revenues from sales that never occurred. Similarly, Shopify cites *Oppenheimer v. Griffin* for the proposition that the "the price that the Defendants would have paid to license the Work" is relevant to statutory damages analysis, but Plaintiffs' revenues and royalties earned will not show the price Defendants would have paid to license the work. *See* Mem. 22 (quoting *Oppenheimer v. Griffin*, No. 1:18-cv-00272-MR-WCM, 2019 WL 7373784, at *6 (W.D.N.C. Dec. 31, 2019)).

For these reasons, courts have rejected requests for the type of information Shopify seeks. *See Capitol Records Inc. v. MP3Tunes*, No. 07 Civ. 9931 (WHP), (S.D.N.Y. Apr. 12, 2010), ECF No. 168 (declining to compel production of historical profitability data, taking into consideration plaintiffs' election of statutory damages and the limited utility of this type of data in calculating actual damages); *Io Grp. Inc. v. GLBT Ltd.*, No. C-10-01282 MMC (DMR), 2011 WL 3443773, at *3-4 (N.D. Cal. Aug. 8, 2011) (rejecting defendant's motion to compel the production of profit

and revenue data for infringed works, finding that this information is irrelevant to the issue of statutory damages).

Instead, the relevant evidence that is available concerning Plaintiffs' lost revenues is in Shopify's possession, in the form of the Shopify merchants' sales records. While such records will understate the total extent of the harm—because Shopify merchants sold infringing digital copies of Plaintiffs' works in an unrestricted format that can lead to subsequent viral distribution—these records, unlike Plaintiffs' revenues, at least speak to the correct issue. Plaintiffs have agreed to produce the prices at which the works in suit were sold legitimately. Thus, Shopify will have both prices (from Plaintiffs) and units sold (from the pirate Shopify merchants).

Shopify relies on *Mon Cheri Bridals v. Cloudflare* for the proposition that “statutory damages should bear some kind of relationship to actual damages,” Mem. 22 (quoting *Mon Cheri Bridals, LLC v. Cloudflare, Inc.*, No. 19-cv-01356-VC (TSH), 2021 WL 1222492, at *3 (N.D. Cal. Apr. 1, 2021)). But the Fourth Circuit has squarely rejected Shopify's argument. *See Superior Form Builders, Inc. v. Dan Chase Taxidermy Supply Co.*, 74 F.3d 488, 496 (4th Cir. 1996) (upholding jury's award of \$400,000 for four infringements—the maximum then allowable—even though defendant's gross revenue from the infringement was at most \$10,200, and the plaintiff had not proven any actual damages); *Tattoo Art Inc. v. TAT Int'l LLC*, 498 F. App'x 341, 348 (4th Cir. 2012) (rejecting argument that, because statutory damages award was purportedly either 25 times or 68 times greater than the plaintiff's actual damages—depending on the measure—the award was “grossly disproportional”).

The cases Shopify cites are factually inapposite. In *Mon Cheri Bridals v. Cloudflare*, the plaintiff, a small business, had already produced redacted corporate financial statements showing its company-wide revenues, and the court required the plaintiff to unredact the financial statements

to show its company-wide profits; the case had nothing to do with discovery of individualized revenues for every work in suit. *See* 2021 WL 1222492, at *3. In *Oppenheimer v. Episcopal Communicators, Inc.*, a known copyright troll was required to provide revenue information to show whether he was “asserting this claim to be made whole or as part of a primary or secondary revenue stream,” a consideration not present here. *See Oppenheimer v. Williams*, No. 2:20-cv-4219-DCN, 2021 WL 4086197, at *4 (D.S.C. Sept. 8, 2021), *reconsideration denied*, 2021 WL 5359283 (D.S.C. Nov. 17, 2021) (discussing *Oppenheimer v. Episcopal Communicators, Inc.*, No. 1:19-cv-00282-MR, 2020 WL 4732238, at *3 (W.D.N.C. Aug. 14, 2020)).

D. Shopify fails to identify any insufficiencies in Plaintiffs’ response to RFP 45.

Shopify asks the Court to compel a response to RFP 45 seeking, “[f]or each Copyrighted Work, all Documents and Communications Concerning Your contention that You suffered financial harm from the alleged infringement of the Copyrighted Work, as alleged in the Complaint.” Here, Plaintiffs have already agreed to search for and, if found, produce non-privileged documents concerning: (i) the prices at which the works in suit were legitimately sold in the United States; (ii) analyses of the effects of digital piracy on Plaintiffs’ businesses; and (iii) valuation reports for the works in suit. Besides the documents whose production Shopify seeks to compel in response to RFPs 22 and 24, which should be denied for the reasons explained above, Shopify’s Motion does not explain what additional documents it seeks in for RFP 45 that Plaintiffs are not already producing. Accordingly, Shopify’s Motion should be denied.

CONCLUSION

For the reasons stated above, Plaintiffs respectfully request that Shopify’s Motion to Compel Production of Documents Responsive to Shopify’s First Set of Requests For Production be denied in its entirety.

Dated: April 22, 2022

Respectfully submitted,

/s/ Scott A. Zebrak

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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on April 22, 2022, I caused the foregoing document to be filed electronically with the Clerk of the Court using the CM/ECF system, which will send a notice of electronic filing to all counsel of record registered with CM/ECF.

/s/ Scott A. Zebrak
Scott A. Zebrak

UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA

BEDFORD, FREEMAN & WORTH
PUBLISHING GROUP, LLC d/b/a MACMILLAN
LEARNING, *et al.*,

Plaintiffs,

v.

SHOPIFY INC.,

Defendant.

Case No. 1:21-cv-01340-CMH-JFA

**DECLARATION OF RICHARD P. ESSIG ON BEHALF OF PLAINTIFF PEARSON
EDUCATION, INC. IN OPPOSITION TO DEFENDANT SHOPIFY INC.'S MOTION TO
COMPEL**

I, Richard P. Essig, hereby declare, pursuant to 28 U.S.C. § 1746, as follows:

1. I am currently employed as Vice President Intellectual Property for Pearson Education, Inc. (“Pearson”). I have held this position since 2007 and have worked for Pearson since December 1974. I have worked in the publishing industry for 47 years. I have personal knowledge of the facts set forth below and/or have learned of these facts as a result of my position and responsibilities at Pearson. If called upon and sworn as a witness, I could and would testify competently as to the matters set forth herein.

2. Pearson is a leading educational publisher devoted to creating and publishing high quality textbooks and other learning materials. We are the world’s leading learning company, serving customers in nearly 200 countries with digital content, assessments, qualifications.

3. I am generally familiar with Pearson’s practices and procedures with regard to acquiring ownership of or exclusive licenses to the copyrights in the works it publishes and

registering the copyrights in those works. I am also generally familiar with Pearson's business practices regarding licensing of works it publishes. In addition, through my position at Pearson, I am generally familiar with the books and records of Pearson, including documents such as copyright registration certificates and agreements pursuant to which Pearson acquires, maintains, and licenses rights in the works at issue in this litigation.

4. I understand that this declaration is to be submitted to the Court in connection with requests for discovery and a motion to compel filed by Defendant Shopify Inc. ("Shopify").

Ownership of Pearson's Copyrighted Works

5. Textbooks and other educational materials are among the core assets owned by Pearson, and the foundation of Pearson's publishing business. In the course of regular operations, the routine practice of Pearson's higher education business is to obtain copyright ownership of the copyrights in, or exclusive licenses to publish, reproduce, and distribute, the works it publishes through agreements with the author(s) of those works. Pearson often then registers those copyrights with the U.S. Copyright Office.

6. When Pearson agrees to publish a work, it is Pearson's standard practice to execute an agreement with the authors of that work in which the authors either assign the copyright in the work to Pearson or grant Pearson an exclusive right to publish, reproduce, and distribute the work. These agreements between Pearson and the authors typically contain a clause in which the author represents that he or she owns the copyright in the work to be published and has all necessary authority to assign that copyright or grant an exclusive license as to the rights under Section 106 of the Copyright Act, including as to reproduction and distribution, to Pearson. Typically, the author indemnifies Pearson for breach of any such representation or warranty. Pearson has produced or is producing in this litigation the documents sufficient to show that it owns or has an

exclusive license to publish, reproduce, and distribute the relevant works in this case. In most cases, that consists of a copyright registration certificate and/or a copy of the United States Copyright Office's publicly available database entry showing registration and the details therein, which show that Pearson owns the work or has an exclusive license to publish, reproduce, and distribute the work. Where the copyright registration for a work does not list Pearson as the copyright claimant, Pearson has produced or is producing documents sufficient to establish Pearson's chain of title for that work going back to the person or entity listed as the claimant on the work's copyright registration. As a result, Pearson's production will include copies of agreements with authors of works in suit.

7. It would be extremely burdensome to produce documents showing Pearson's chain of title going back to the original author(s) for every work in suit. For each agreement to be collected, a Pearson employee must manually search an online repository for that specific agreement and then review the results of the search to confirm whether any of the documents found is the agreement specifically sought. Further complicating matters, for some works there can be multiple agreements that must be collected (*e.g.*, if the original agreement has been amended, or if the work has multiple authors who executed separate agreements).

8. Once collected, each agreement must then be reviewed and redacted for certain Personally Identifying Information (such as home addresses and phone numbers), which these agreements typically contain.

9. As a result, collecting chain-of-title documents for all works in suit would likely require, at a minimum, hundreds of hours of employee time in addition to the substantial time and expense required by in-house and outside attorneys to manage this process.

10. It would be even more burdensome to produce every document or piece of

correspondence with authors that may have been generated in the course of acquiring the copyrights for the works in suit. The documents related to acquiring the rights for any single work may involve agreements and communications between many people. For any given work, there are typically at least several, and potentially dozens of, Pearson employees who communicate with the author(s) of that work during the negotiation of the agreement, the publication process and afterward. Further, the current and former employees likely to have communicated with the authors for one work in suit are unlikely to be the same employees who communicated with the authors for the other works in suit. Thus, attempting to collect all the documents and communications for all of the works in suit would require collecting, searching, and reviewing the documents and communications of a very large number, potentially hundreds or more, of current and former Pearson employees. For each one of this enormous number of custodians, Pearson would have to develop individually customized search terms related to the specific works and authors about which that custodian is likely to have documents.

11. Further, some of the works in suit were initially published, and Pearson acquired the rights in those works, many years ago, in some cases decades ago. Finding all documents and communications with the authors of those works, to the extent such documents still exist, would potentially involve searching sources of data that are not readily accessible for such purpose.

12. In sum, collecting, reviewing, and producing all of the documents and communications associated with Pearson ownership of all of its copyrights in the works at issue, including all of its communications with the authors of the works at issue, would be an enormous undertaking. For the reasons discussed above, it is difficult to assess the amount of material involved. I estimate that, at least, hundreds of thousands of documents would need to be located, collected, and reviewed in such an effort. This process would require potentially hundreds of hours

or more of employee time in addition to the enormous time and expense required by in-house and outside attorneys to manage this process. I would estimate that the expense of such an undertaking could easily cost at least hundreds of thousands of dollars or more.

13. As mentioned above, pursuant to Pearson's standard practices in its Higher Education business, Pearson's agreements through which Pearson obtains an assignment of the copyright or an exclusive license are with the authors, rather than with any university in which the author may be affiliated as a professor. In my 47 years of experience in the higher education publishing industry, I am not aware of even a single instance in which a university has sent a letter, filed a lawsuit, or raised a dispute in which it claims it owns the copyright in a textbook authored by a professor employed by that university on the basis that the textbook is a work-for-hire by an employee of the university. On the contrary, it is a longstanding industry practice for professors to author books, while working closely with publishers, and transfer ownership rights to publishers or grant publishers exclusive licenses to publish, reproduce, and distribute such books. These books are then often sold and used, among other places, at universities.

Registration of Pearson's Copyrighted Works

14. Pearson's current process for registering copyrights with the U.S. Copyright Office involves completing the Copyright Office's online submission form. Submission of this form generates a confirmation email from the Copyright Office with a shipping slip for submitting the deposit copies. A Pearson employee then prints the shipping slip and uses it to mail the deposit copies to the Copyright Office.

15. If there is an issue with the registration, the Copyright Office will contact Pearson regarding the issue and the appropriate remedy. Such communications generally concern clerical issues, such as an information field that was inadvertently left blank or if the Copyright Office

cannot find the deposit copies. Communications with the Copyright Office regarding Pearson's claims of ownership in the registration application are extremely rare, if not unheard of.

16. Pearson instituted its current registration process in 2019. Many of Pearson's works in suit were registered many years ago, before Pearson instituted the current process. Pearson is unlikely to have any records or documents regarding registration or communications with the Copyright Office from before Pearson instituted its current process.

Pearson's Distribution Agreements with Third Parties

17. I am generally familiar with Pearson's agreements with third parties for digital distribution of Pearson's works. These agreements are not stored in an online repository. To collect these agreements would require working with the relevant business unit to identify every relevant agreement and then have that business unit conduct a manual search for that agreement. This manual process cannot be automated.

18. Pearson does not generally permit Pearson's distribution partners to authorize third parties to digitally distribute Pearson's works. In any limited instances in which Pearson does permit a distribution partner to authorize a third party to digitally distribute Pearson's works, that third party is not an unknown third-party conducting business from an unknown URL. Further, Pearson does not permit its distribution partners to authorize any such third party to digitally distribute copies of Pearson's textbooks in unrestricted formats that allow for further dissemination.

Pearson's Financial Information

19. I am generally familiar with Pearson's processes for storing financial data. Obtaining revenue information for any particular title has both manual and automated components. Revenue data for all titles is not all stored in a single system. The degree of difficulty of obtaining

revenue information for a particular title varies depending on the age of the title and the system that houses the data.

20. Collecting all documents and communications related to Pearson's commercial exploitation of the works in suit would be an enormous undertaking, to the extent it is even possible to do so. Commercially exploiting copyrighted works is one of the core focuses of Pearson's business, and documents related to those activities touch on dozens, if not hundreds, of Pearson's employees across many aspects of Pearson's operations, including sales, editorial, marketing, customer service, finance, strategy, distribution, and rights and permissions. I estimate that potentially at least hundreds of thousands of documents would need to be located, collected, and reviewed in such an effort. This process would require potentially hundreds or thousands of hours of employee time in addition to the enormous time and expense required by in-house and outside attorneys to manage this process. I would estimate that the expense of such an undertaking could easily cost at least hundreds of thousands of dollars or more.

I declare under penalty of perjury under the laws of the United States that the foregoing is true and correct.


RICHARD P. ESSIG

Executed this 22 day of April, 2022.

**UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA**

BEDFORD, FREEMAN & WORTH
PUBLISHING GROUP, LLC d/b/a MACMILLAN
LEARNING, *et al.*,

Plaintiffs,

v.

SHOPIFY INC.,

Defendant.

Case No. 1:21-cv-01340-CMH-JFA

**DECLARATION OF KELLY MCCANN ON BEHALF OF PLAINTIFF ELSEVIER INC.
IN OPPOSITION TO DEFENDANT SHOPIFY INC.'S MOTION TO COMPEL**

I, Kelly McCann, hereby declare, pursuant to 28 U.S.C. § 1746, as follows:

1. I am currently employed as Director, Commercial Operations for Elsevier Inc. (“Elsevier”). I have held this position since March, 2021 and have worked for Elsevier since August 2006. I have worked in the publishing industry for 22 years, including 15 years in higher education publishing. I have personal knowledge of the facts set forth below and/or have learned of these facts as a result of my position and responsibilities at Elsevier. If called upon and sworn as a witness, I could and would testify competently as to the matters set forth herein.

2. Founded in 1880, the Elsevier publishing houses take their name from Elzevir, a venerable publishing house that dates back to the year 1580. Elsevier is a leading educational publisher devoted to creating and publishing high quality textbooks and other learning materials. It publishes its textbooks and reference works under a number of well-known imprints including Mosby, Hanley & Belfus, Academic Press, Butterworth-Heinemann, Cell Press, Churchill

Livingstone, Harcourt, Morgan Kaufmann, Pergamon Press, and Saunders.

3. I am generally familiar with Elsevier's practices and procedures with regard to acquiring ownership of or exclusive licenses to the copyrights in the works it publishes and registering the copyrights in those works. I am also generally familiar with Elsevier's business practices regarding licensing of works it publishes. In addition, through my position at Elsevier, I am generally familiar with the books and records of Elsevier, including documents such as copyright registration certificates and agreements pursuant to which Elsevier acquires, maintains, and licenses rights in the works at issue in this litigation.

4. I understand that this declaration is to be submitted to the Court in connection with requests for discovery and a motion to compel filed by Defendant Shopify Inc. ("Shopify").

Ownership of Elsevier's Copyrighted Works

5. Textbooks and other educational materials are among the core assets owned by Elsevier, and the foundation of Elsevier's publishing business. In the course of regular operations, Elsevier's routine practice is to obtain copyright ownership of the copyrights in, or exclusive licenses to publish, reproduce, and distribute, the works it publishes through agreements with the author(s) of those works. Elsevier often then registers those copyrights with the U.S. Copyright Office.

6. When Elsevier agrees to publish a work, it is Elsevier's standard practice to execute an agreement with the authors of that work in which the authors either assign the copyright in the work to Elsevier or grant Elsevier an exclusive right to publish, reproduce, and distribute the work. These agreements between Elsevier and the authors typically contain a clause in which the author represents that he or she owns the copyright in the work to be published and has all necessary authority to assign that copyright or grant an exclusive license as to the rights under Section 106

of the Copyright Act, including as to reproduction and distribution, to Elsevier. Elsevier has produced or is producing in this litigation the documents sufficient to show that it owns or has an exclusive license to publish, reproduce, and distribute the relevant works in this case. In most cases, that consists of a copyright registration certificate and/or a copy of the United States Copyright Office's publicly available database entry showing registration and the details therein, which show that Elsevier owns the work or has an exclusive license to publish, reproduce, and distribute the work. Where the copyright registration for a work does not list Elsevier as the copyright claimant, Elsevier has produced or is producing documents sufficient to establish Elsevier's chain of title for that work going back to the entity listed as the claimant on the work's copyright registration.

7. It would be extremely burdensome to produce documents showing Elsevier's chain of title going back to the original author(s) for every work in suit. For each agreement to be collected, an Elsevier employee must conduct a time-consuming manual search for that specific agreement and then review the results of the search to confirm whether any of the documents found is the agreement specifically sought. Further complicating matters, for some works there can be multiple agreements that must be collected (*e.g.*, if the original agreement has been amended).

8. Once collected, each agreement must then be reviewed and redacted for certain Personally Identifying Information (such as home addresses, phone numbers, social security numbers, etc.), which these agreements typically contain.

9. As a result, collecting, reviewing, and redacting chain-of-title documents for all works in suit would likely require, at a minimum, hundreds of hours of employee time, in-house legal department time, and outside attorney time.

10. It would be even more burdensome to produce every document or piece of

correspondence with authors that may have been generated in the course of acquiring the copyrights for the works in suit, to the extent such documents still exist. The documents related to acquiring the rights for any single work may involve agreements and communications between many people. For any given work, there are typically at least several Elsevier employees who communicate with the author(s) of that work during the publication process and afterward. Further, the employees likely to have communicated with the authors for one work in suit are unlikely to be the same employees who communicated with the authors for the other works in suit. Thus, attempting to collect all the documents and communications for all of the works in suit would require collecting, searching, and reviewing the documents and communications of a very large number, potentially hundreds or more, of Elsevier employees. For each one of this enormous number of custodians, Elsevier would have to develop individually customized search terms related to the specific works and authors about which that custodian is likely to have documents.

11. Further, some of the works in suit were initially published, and Elsevier acquired the rights in those works, many years ago, in some cases decades ago. Finding all documents and communications with the authors of those works, if such documents still exist, would potentially involve searching sources of data that are not readily accessible for such purpose.

12. In sum, collecting, reviewing, and producing all of the documents and communications associated with Elsevier's ownership of all of its copyrights in the works at issue, including all of its communications with the authors of the works at issue, would be an enormous undertaking. For the reasons discussed above, it is difficult to assess the amount of material involved. I estimate that, at least, hundreds of thousands of documents would need to be located, collected, and reviewed in such an effort. This process would require potentially hundreds of hours or more of employee time in addition to the enormous time and expense required by in-house and

outside attorneys to manage this process. I would estimate that the expense of such an undertaking could easily cost in the hundreds of thousands or even millions of dollars.

13. As mentioned above, pursuant to Elsevier's standard practices, Elsevier's agreements through which Elsevier obtains an assignment of the copyright or an exclusive license are with the authors, rather than with any university in which the author may be affiliated as a professor. In my 15 years of experience in the higher education publishing industry, I am not aware of even a single instance in which a university has sent a letter, filed a lawsuit, or raised a dispute in which it claims claimed it owns the copyright in a textbook authored by a professor employed by that university on the basis that the textbook is a work-for-hire by an employee of the university. On the contrary, it is a longstanding industry practice for professors to author books, while working closely with publishers, and transfer ownership rights to publishers or grant publishers exclusive licenses to publish, reproduce, and distribute such books. These books are often then sold and used, among other places, at such universities.

Registration of Elsevier's Copyrighted Works

14. Elsevier's current process for registering copyrights with the U.S. Copyright Office involves completing the Copyright Office's online submission form. Submission of this form generates a confirmation email from the Copyright Office with a shipping slip for submitting the deposit copies. An Elsevier employee then prints the shipping slip and uses it to mail the deposit copies to the Copyright Office.

15. If there is an issue with the registration, the Copyright Office will contact Elsevier regarding the issue and the appropriate remedy. Such communications generally concern clerical issues, such as an information field that was inadvertently left blank or if the Copyright Office cannot find the deposit copies. Communications with the Copyright Office regarding Elsevier's

claims of ownership in the registration application are rare.

16. Elsevier instituted its current registration process in 2018. Many of Elsevier's works in suit were registered many years ago, before Elsevier instituted the current process. Elsevier is unlikely to have any records or documents regarding registration or communications with the Copyright Office from before Elsevier instituted its current process.

Elsevier's Distribution Agreements with Third Parties

17. I am generally familiar with Elsevier's agreements with third parties for digital distribution of Elsevier's works. To collect these agreements would require working with the relevant business unit to identify every relevant agreement and conducting a manual search for those agreements. This manual process cannot be automated.

18. Elsevier does not generally permit Elsevier's distribution partners to authorize third parties to digitally distribute Elsevier's works. In any limited instances in which Elsevier does permit a distribution partner to authorize a third party to digitally distribute Elsevier's works, that third party is not an unknown third-party conducting business from an unknown URL. Further, Elsevier does not permit its distribution partners to authorize any third parties to digitally distribute copies of Elsevier's textbooks in a format that allows for further dissemination.

Elsevier's Financial Information

19. I am generally familiar with Elsevier's processes for storing financial data. Obtaining revenue information for any particular title has both manual and automated components. Revenue data for all titles is not all stored in a single system. The degree of difficulty of obtaining revenue information for a particular title varies depending on the age of the title and the system that houses the data.

20. Collecting all documents and communications related to Elsevier's commercial

exploitation of the works in suit would be an enormous undertaking, to the extent it is even possible to do so. Commercially exploiting copyrighted works is one of the core focuses of Elsevier's business, and documents related to those activities touch on dozens, if not hundreds, of Elsevier's employees across many aspects of Elsevier's operations, including editorial staff, sales, marketing, customer service, finance, strategy, and distribution. I estimate that potentially millions of documents would need to be located, collected, and reviewed in such an effort. This process would require potentially hundreds or thousands of hours of employee time in addition to the enormous time and expense required by in-house and outside attorneys to manage this process. I would estimate that the expense of such an undertaking could easily cost in the hundreds of thousands of dollars.

I declare under penalty of perjury under the laws of the United States that the foregoing is true and correct.



Kelly McCann

Executed this 22 day of APRIL, 2022.

UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA

BEDFORD, FREEMAN & WORTH
PUBLISHING GROUP, LLC d/b/a MACMILLAN
LEARNING, *et al.*,

Plaintiffs,

v.

SHOPIFY INC.,

Defendant.

Case No. 1:21-cv-01340-CMH-JFA

**DECLARATION OF ROGER NAGGAR ON BEHALF OF PLAINTIFF BEDFORD,
FREEMAN & WORTH PUBLISHING GROUP, LLC D/B/A MACMILLAN LEARNING
IN OPPOSITION TO DEFENDANT SHOPIFY INC.'S MOTION TO COMPEL**

I, Roger Naggar, hereby declare, pursuant to 28 U.S.C. § 1746, as follows:

1. I am currently employed as Director of Procure-to-Pay for Bedford, Freeman & Worth Publishing Group, LLC d/b/a Macmillan Learning (“Macmillan Learning”). I have held this position since April 1, 2017 and have worked for Macmillan Learning for 18 years. Among other responsibilities, I work on Macmillan Learning’s efforts to protect its intellectual property, including its rights in copyrights and trademarks in connection with online piracy matters. I have worked in the publishing industry for nearly 20 years. I have personal knowledge of the facts set forth below and/or have learned of these facts as a result of my position and responsibilities at Macmillan Learning. If called upon and sworn as a witness, I could and would testify competently as to the matters set forth herein.

2. Macmillan Learning is a leading educational publisher devoted to creating and publishing high quality textbooks and other learning materials which improves lives through

learning. By linking research to learning practice, Macmillan Learning develops pioneering products and learning materials for students that are highly effective and drive improved outcomes. Macmillan Learning's engaging content is developed in conjunction with the country's best researchers, educators, administrators and developers. Macmillan Learning's textbooks include some of the most popular and widely used titles in their field in the United States.

3. I am generally familiar with Macmillan Learning's practices and procedures with regard to acquiring ownership of or exclusive licenses to the copyrights in the works it publishes and registering the copyrights in those works. I am also generally familiar with Macmillan Learning's business practices regarding authorizing distribution and sales of works it publishes. In addition, through my position at Macmillan Learning, I am generally familiar with the books and records of Macmillan Learning, including documents such as copyright registration certificates and agreements pursuant to which Macmillan Learning acquires, maintains, and licenses rights in the works at issue in this litigation.

4. I understand that this declaration is to be submitted to the Court in connection with requests for discovery and a motion to compel filed by Defendant Shopify Inc. ("Shopify").

Ownership of Macmillan Learning's Copyrighted Works

5. Textbooks and other educational materials are among the core assets owned by Macmillan Learning, and the foundation of Macmillan Learning's publishing business. In the course of regular operations, Macmillan Learning's routine practice is to obtain copyright ownership of the copyrights in, or exclusive licenses to publish, reproduce, and distribute, the works it publishes through agreements with the author(s) of those works. Macmillan Learning often then registers those copyrights with the U.S. Copyright Office.

6. When Macmillan Learning publishes a textbook, it is Macmillan Learning's

standard practice to execute an agreement with the authors of that work in which the authors either assign the copyright in the work to Macmillan Learning or grant Macmillan Learning an exclusive right to publish, reproduce, and distribute the work. These agreements between Macmillan Learning and the authors typically contain a clause in which the author makes representations that he or she has all necessary rights, power and authority to assign that copyright or grant the copyright rights granted to Macmillan Learning. Macmillan Learning has produced or is producing in this litigation the documents sufficient to show that it owns or has an exclusive license to publish, reproduce, and distribute the relevant works in this case. In most cases, that consists of a copyright registration certificate and/or a copy of the United States Copyright Office's publicly available database entry showing registration and the details therein, which show that Macmillan Learning as the copyright claimant owns the copyright in the work, in the name of Macmillan Learning or another of its imprint names. Where the copyright registration is in the name of an imprint name, Macmillan Learning has produced or is producing documents sufficient to show that the imprint name is a legal name of Macmillan Learning. Where the copyright registration for a work does not list Macmillan Learning as the copyright claimant, Macmillan Learning has produced or is producing documents sufficient to establish Macmillan Learning's chain of title for that work going back to the person or entity listed as the claimant on the work's copyright registration. As a result, Macmillan Learning's production will include copies of at least one agreement with an author of a work in suit.

7. It would be burdensome to produce documents showing Macmillan Learning's chain of title going back to the original author(s) for every work in suit. For each agreement to be collected, an employee must conduct a manual search of a digital repository for the title and then review the results of the search to confirm whether the documents found are the agreement

specifically sought for the specific work in the suit, while excluding documents relating to editions or supplemental works (such as workbooks, study guides, test banks or other related works) that are not related to the lawsuit. Further complicating matters, for some works there can be multiple agreements that must be collected (*e.g.*, if the original agreement has been amended, or if the work has multiple authors who executed separate agreements).

8. Once collected, each agreement must then be reviewed and redacted for certain Personally Identifying Information (such as home addresses), which these agreements often contain.

9. As a result, collecting chain-of-title documents for all works in suit would likely require, at a minimum, one hundred hours of employee time in addition to the substantial time and expense required by in-house and outside attorneys to manage this process.

10. It would be even more burdensome to produce every document or piece of correspondence with authors that may have been generated in the course of acquiring the copyrights for the works in suit, to the extent such documents still exist. The documents related to acquiring the rights for any single work may involve agreements and communications between many people. For any given work, there are typically one or more Macmillan Learning employees who communicate with the author(s) of that work during the publication process and afterward. Further, the employees likely to have communicated with the authors for one work in suit are unlikely to be the same employees who communicated with the authors for the other works in suit. Thus, attempting to collect all the documents and communications for all of the works in suit would require collecting, searching, and reviewing the documents and communications of a large number of Macmillan Learning employees. For each one of this number of custodians, Macmillan Learning would have to develop individually customized search terms related to the specific works

and authors about which that custodian is likely to have documents.

11. Further, some of the works in suit were initially published, and Macmillan Learning acquired the rights in those works, many years ago, in some cases decades ago. Finding all documents and communications with the authors of those works, if such documents still exist, would potentially involve searching sources of data that are not readily accessible for such purpose.

12. In sum, collecting, reviewing, and producing all of the documents and communications associated with Macmillan Learning's ownership of all of its copyrights in the works at issue, including all of its communications with the authors of the works at issue, would be an enormous undertaking. For the reasons discussed above, it is difficult to assess the amount of material involved. I estimate that, at least, tens of thousands of documents would need to be located, collected, and reviewed in such an effort. This process would require potentially hundreds of hours or more of employee time in addition to the enormous time and expense required by in-house and outside attorneys to manage this process. I would estimate that the cost of such an undertaking could easily cost in the hundreds of thousands or even millions of dollars.

13. As mentioned above, pursuant to Macmillan Learning's typical practices, Macmillan Learning's agreements through which Macmillan Learning obtains an assignment of the copyright or an exclusive license are with the authors, rather than with any university with which the author may be affiliated as a professor.

Registration of Macmillan Learning's Copyrighted Works

14. Macmillan Learning's current process for registering copyrights with the U.S. Copyright Office involves having completing the Copyright Office's online submission form. Submission of this form generates a confirmation email from the Copyright Office with a shipping slip for submitting the deposit copies. A Macmillan Learning employee (or an employee of our

affiliate at our warehouse under the direction of Macmillan Learning) then prints the shipping slip and uses it to mail the deposit copies to the Copyright Office.

15. If there is an issue with the registration, the Copyright Office will contact Macmillan Learning regarding the issue and the appropriate remedy. Such communications generally concern clerical issues, such as an information field that was inadvertently left blank or if the Copyright Office cannot find the deposit copies, as well as requests for clarification on the copyright claim's scope. Communications with the Copyright Office regarding Macmillan Learning's claims of ownership in the registration application are extremely rare.

16. Macmillan Learning instituted its current registration process as recently as 2015. Many of Macmillan Learning's works in suit were registered many years ago, before Macmillan Learning instituted the current process. Macmillan Learning is less likely to have substantial records or documents regarding registration or communications with the Copyright Office from before Macmillan Learning instituted its current process.

Macmillan Learning's Distribution Agreements with Third Parties

17. I am generally familiar with Macmillan Learning's agreements with third parties for digital distribution of Macmillan Learning's works. To collect these agreements would require working with the relevant business unit to identify every relevant agreement and conducting a manual search for those agreements. This manual process cannot be automated.

18. In its distribution agreements, Macmillan Learning often does not permit Macmillan Learning's distribution parties to have sub-distributors for digital distribution of the works. In any limited instances in which Macmillan Learning does permit a distribution party to have a sub-distributor for digital distribution of its works, that sub-distributor is not an unknown third-party conducting business from an unknown URL. Further, Macmillan Learning requires the

distribution party, and all such sub-distributors, to use Digital Rights Management technology to protect against the unauthorized dissemination of copies of the works.

Macmillan Learning's Financial Information

19. I am generally familiar with Macmillan Learning's processes for storing financial data. Obtaining revenue information for any particular title has both manual and automated components. Revenue data for all titles is not all stored in a single system. The degree of difficulty of obtaining revenue information for a particular title varies depending on the age of the title and the system that houses the data, and other factors.

20. Collecting all documents and communications related to Macmillan Learning's commercial exploitation of the works in suit would be an enormous undertaking. Commercially exploiting copyrighted works is one of the core focuses of Macmillan Learning's business, and documents related to those activities touch on dozens, if not hundreds, of Macmillan Learning's employees across many aspects of Macmillan Learning's operations, including departments such as finance, content, marketing, sales, product, content management, technology, and operations. I estimate that potentially tens of thousands of documents or more would need to be located, collected, and reviewed in such an effort. This process would require potentially thousands of hours of employee time in addition to the enormous time and expense required by in-house and outside attorneys to manage this process. I would estimate that the expense of such an undertaking could easily cost in excess of hundreds of thousands of dollars.

I declare under penalty of perjury under the laws of the United States that the foregoing
is true and correct.



Roger Naggar

Executed this 22nd day of April, 2022.

UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA

BEDFORD, FREEMAN & WORTH
PUBLISHING GROUP, LLC d/b/a MACMILLAN
LEARNING, *et al.*,

Plaintiffs,

v.

SHOPIFY INC.,

Defendant.

Case No. 1:21-cv-01340-CMH-JFA

**DECLARATION OF STEVEN ROSENTHAL ON BEHALF OF PLAINTIFF MCGRAW
HILL LLC. IN OPPOSITION TO DEFENDANT SHOPIFY INC.'S MOTION TO
COMPEL**

I, STEVEN ROSENTHAL, hereby declare, pursuant to 28 U.S.C. § 1746, as follows:

1. I am currently employed as Senior Director, Anti-Piracy and Web Security for McGraw Hill, LLC (“McGraw Hill”). I have held this position since October 2014. Among other responsibilities, I focus on enforcement of McGraw Hill’s intellectual property rights, including the protection of its copyrights and trademarks in connection with online piracy matters. I have personal knowledge of the facts set forth below and/or have learned of these facts as a result of my position and responsibilities at McGraw Hill. If called upon and sworn as a witness, I could and would testify competently as to the matters set forth herein.

2. McGraw Hill is a leading educational publisher devoted to creating and publishing high quality textbooks and other learning materials. By providing high-quality, trusted content developed with world-class authors to educators and students, McGraw Hill is a leading education partner for millions of educators, learners and professionals around the world, helping them

achieve success on their own terms.

3. I am generally familiar with McGraw Hill's practices and procedures with regard to acquiring ownership of or exclusive licenses to the copyrights in the works it publishes and registering the copyrights in those works. I am also generally familiar with McGraw Hill's business practices regarding licensing of works it publishes. In addition, through my position at McGraw Hill, I am generally familiar with the books and records of McGraw Hill, including documents such as copyright registration certificates and agreements pursuant to which McGraw Hill acquires, maintains, and licenses rights in the works at issue in this litigation.

4. I understand that this declaration is to be submitted to the Court in connection with requests for discovery and a motion to compel filed by Defendant Shopify Inc. ("Shopify").

Ownership of McGraw Hill's Copyrighted Works

5. Textbooks and other educational materials are among the core assets owned by McGraw Hill, and the foundation of McGraw Hill's publishing business. In the course of regular operations, McGraw Hill's routine practice is to obtain copyright ownership of the copyrights in, or exclusive licenses to publish, reproduce, and distribute, the works it publishes through agreements with the author(s) of those works. McGraw Hill often then registers those copyrights with the U.S. Copyright Office.

6. When McGraw Hill agrees to publish a work, it is McGraw Hill's standard practice to execute an agreement with the authors of that work in which the authors either assign the copyright in the work to McGraw Hill, grant McGraw Hill an exclusive right to publish, reproduce, and distribute the work or confirm that the work is created as a work-for-hire under the US Copyright Act so that McGraw Hill controls the copyright therein. These agreements between McGraw Hill and the authors typically contain a clause in which the author represents that he or

she created the work to be delivered and has all necessary authority to assign that copyright or grant an exclusive license as to the rights under Section 106 of the Copyright Act, including as to reproduction and distribution, to McGraw Hill. McGraw Hill has produced or is producing in this litigation the documents sufficient to show that it owns or has an exclusive license to publish, reproduce, and distribute the relevant works in this case. In most cases, that consists of a copyright registration certificate and/or a copy of the United States Copyright Office's publicly available database entry showing registration and the details therein, which show that McGraw Hill owns the work or has an exclusive license to publish, reproduce, and distribute the work. Where the copyright registration for a work does not list McGraw Hill as the copyright claimant, McGraw Hill has produced or is producing documents sufficient to establish McGraw Hill's chain of title for that work going back to the person or entity listed as the claimant on the work's copyright registration. As a result, McGraw Hill's production will include copies of agreements with authors of works in suit.

7. It would be extremely burdensome to produce documents showing McGraw Hill's chain of title going back to the original author(s) for every work in suit. For each agreement to be collected, a McGraw Hill employee or agent must conduct a time-consuming manual search of an online repository for that specific agreement and then review the results of the search to confirm whether any of the documents found is the agreement specifically sought. Further complicating matters, for some works there can be multiple agreements that must be collected (*e.g.*, if the original agreement has been amended, or if the work has multiple authors who executed separate agreements).

8. Once collected, each agreement must then be reviewed and redacted for certain Personally Identifying Information (such as addresses, phone numbers, social security numbers,

etc.), which these agreements typically contain.

9. As a result, collecting chain-of-title documents for all works in suit would likely require, at a minimum, hundreds of hours of employee and third-party vendor time in addition to the substantial time and expense required by in-house and outside attorneys to manage this process.

10. It would be even more burdensome to produce every document or piece of correspondence with authors that may have been generated in the course of acquiring the copyrights for the works in suit, to the extent such documents still exist. The documents related to acquiring the rights for any single work may involve agreements and communications between many people. For any given work, there are typically at least several, and potentially dozens of, McGraw Hill employees who communicate with the author(s) of that work in preparation for and during the publication process and afterward. Further, the employees likely to have communicated with the authors for one work in suit are unlikely to be the same employees who communicated with the authors for the other works in suit. Thus, attempting to collect all the documents and communications for all of the works in suit would require collecting, searching, and reviewing the documents and communications of a very large number, potentially hundreds, of McGraw Hill employees. For each one of this enormous number of custodians, McGraw Hill would have to develop individually customized search terms related to the specific works and authors about which that custodian is likely to have documents.

11. Further, some of the works in suit were initially published, and the rights in those works acquired, by McGraw Hill many years ago, in some cases decades ago. Finding all documents and communications with the authors of those works, if such documents still exist, would potentially involve searching sources of data that are not readily accessible for such purpose.

12. In sum, collecting, reviewing, and producing all of the documents and

communications associated with McGraw Hill's ownership of all of its copyrights in the works at issue, including all of its communications with the authors of the works at issue, would be an enormous undertaking. For the reasons discussed above, it is difficult to assess the amount of material involved. I estimate that, potentially, hundreds of thousands of documents would need to be located, collected, and reviewed in such an effort. This process would require potentially hundreds of hours or more of employee time in addition to the enormous time and expense required by in-house and outside attorneys to manage this process. I would estimate that the expense of such an undertaking could prove to be very costly.

13. As mentioned above, pursuant to McGraw Hill's standard practices, McGraw Hill's agreements through which McGraw Hill obtains an assignment of the copyright or an exclusive license are with the authors, rather than with any university in which the author may be affiliated as a professor. In my eight years of experience in the higher education publishing industry, I am not aware of even a single instance in which a university has sent a letter, filed a lawsuit, or raised a dispute in which it claims it owns the copyright in a textbook authored by a professor employed by that university on the basis that the textbook is a work-for-hire by an employee of the university. On the contrary, it is a longstanding industry practice for professors to author books, while working closely with publishers, and transfer ownership rights to publishers or grant publishers exclusive licenses to publish, reproduce, and distribute such books. These books are often then sold and used, among other places, at such universities.

Registration of McGraw Hill's Copyrighted Works

14. McGraw Hill's current process for registering copyrights with the U.S. Copyright Office involves having a vendor complete the Copyright Office's online submission form. Submission of this form generates a confirmation email from the Copyright Office with a shipping

slip for submitting the deposit copies. A McGraw Hill contractor then prints the shipping slip and uses it to mail the deposit copies to the Copyright Office.

15. If there is an issue with the registration, the Copyright Office will contact McGraw Hill's vendor regarding the issue and the appropriate remedy. Such communications generally concern clerical issues, such as an information field that was inadvertently left blank or if the Copyright Office cannot find the deposit copies. Communications with the Copyright Office regarding McGraw Hill's claims of ownership in the registration application are extremely rare, if not unheard of.

16. McGraw Hill instituted its current registration process in 2015. Many of McGraw Hill's works in suit were registered many years ago, before McGraw Hill instituted the current process. McGraw Hill is unlikely to have any records or documents regarding registration or communications with the Copyright Office readily available, if at all, from before McGraw Hill instituted its current process.

McGraw Hill's Distribution Agreements with Third Parties

17. I am generally familiar with McGraw Hill's agreements with third parties for digital distribution of McGraw Hill's works. To collect these agreements would require working with the relevant business unit to identify every relevant agreement and then having that business unit conduct a manual search for that agreement. This manual process cannot be automated.

18. McGraw Hill does not generally permit its authorized eBook distributors to allow third parties to digitally distribute McGraw Hill's eBooks. In any limited instance where McGraw Hill does permit an authorized eBook distributor to permit a third party to digitally distribute McGraw Hill's eBooks, that third party would not be an unknown third-party conducting business from an unknown URL. Further, McGraw Hill does not have a practice of permitting its authorized

eBook distributors to allow any such third party to digitally distribute copies of McGraw Hill's textbooks in an unprotected format that allows for further dissemination.

McGraw Hill's Financial Information

19. I am generally familiar with McGraw Hill's processes for storing financial data. Obtaining revenue information for any particular title has both manual and automated components. Revenue data for all titles is not all stored in a single system. The degree of difficulty of obtaining revenue information for a particular title varies depending on the age of the title and the system that houses the data.

20. Collecting all documents and communications related to McGraw Hill's commercial exploitation of the works in suit would be an enormous undertaking, to the extent it is even possible to do so. Commercially exploiting copyrighted works is one of the core focuses of McGraw Hill's business, and documents related to those activities touch on dozens, if not hundreds, of McGraw Hill's employees across many aspects of McGraw Hill's operations, including functions such as sales, marketing, customer service, finance, strategy, and distribution. A potentially innumerable amount of documents would need to be located, collected, and reviewed in such an effort. This process would require potentially hundreds or thousands of hours of employee time in addition to the enormous time and expense required by in-house and outside attorneys to manage this process. I would estimate that the expense of such an undertaking would be very costly.

I declare under penalty of perjury under the laws of the United States that the foregoing is true and correct.



STEVEN ROSENTHAL

Executed this 22nd day of APRIL, 2022.

**UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA**

BEDFORD, FREEMAN & WORTH
PUBLISHING GROUP, LLC d/b/a MACMILLAN
LEARNING, *et al.*,

Plaintiffs,

v.

SHOPIFY INC.,

Defendant.

Case No. 1:21-cv-01340-CMH-JFA

**DECLARATION OF JESSICA STITT ON BEHALF OF PLAINTIFF CENGAGE
LEARNING, INC. IN OPPOSITION TO DEFENDANT SHOPIFY INC.'S MOTION TO
COMPEL**

I, JESSICA STITT, hereby declare, pursuant to 28 U.S.C. § 1746, as follows:

1. I am currently employed as Manager, Global Anti-Piracy for Cengage Learning, Inc. (“Cengage”). I have held this position for the past 7 years and have worked for Cengage since February 18, 2003. I have worked in the publishing industry for 19 years. I have personal knowledge of the facts set forth below and/or have learned of these facts as a result of my position and responsibilities at Cengage. If called upon and sworn as a witness, I could and would testify competently as to the matters set forth herein.

2. Cengage is a leading educational publisher devoted to creating and publishing high quality textbooks and other learning materials with deep historic roots. Cengage develops, markets, distributes, and sells a comprehensive range of traditional and digital educational content, including textbooks, to educators and students. Cengage’s textbooks have achieved acclaim not only in the United States, but also in many other countries around the world, and are among the

most popular and widely used titles in their fields. Cengage publishes its textbooks under many imprints or brands and trademarks associated with them, which are well known and highly respected. Cengage invests significant time and money into publishing its textbooks. For example, Cengage makes substantial investments in content creation and in the support, advertisement, and promotion of its textbooks in the United States. Cengage and its predecessors have also invested decades of effort in building a reputation of quality in the publishing industry, which consumers associate with Cengage, its textbooks, and its trademarks.

3. I am generally familiar with Cengage's practices and procedures with regard to acquiring ownership of or exclusive licenses to the copyrights in the works it publishes and registering the copyrights in those works. I am also generally familiar with Cengage's business practices regarding licensing of works it publishes. In addition, through my position at Cengage, I am generally familiar with the books and records of Cengage, including documents such as copyright registration certificates and agreements pursuant to which Cengage acquires, maintains, and licenses rights in the works at issue in this litigation.

4. I understand that this declaration is to be submitted to the Court in connection with requests for discovery and a motion to compel filed by Defendant Shopify Inc. ("Shopify").

Ownership of Cengage's Copyrighted Works

5. Textbooks and other educational materials are among the core assets owned by Cengage, and the foundation of Cengage's publishing business. In the course of regular operations, Cengage's routine practice is to obtain copyright ownership of the copyrights in, or exclusive licenses to publish, reproduce, and distribute, the works it publishes through agreements with the author(s) of those works. Cengage often then registers those copyrights with the U.S. Copyright Office.

6. When Cengage agrees to publish a work, it is Cengage's standard practice to execute an agreement with the authors of that work in which the authors either assign the copyright in the work to Cengage or grant Cengage an exclusive right to publish, reproduce, and distribute the work. These agreements between Cengage and the authors typically contain a clause in which the author represents that he or she owns the copyright in the work to be published and has all necessary authority to assign that copyright or grant an exclusive license as to the rights under Section 106 of the Copyright Act, including as to reproduction and distribution, to Cengage. Cengage has produced or is producing in this litigation the documents sufficient to show that it owns or has an exclusive license to publish, reproduce, and distribute the relevant works in this case. In most cases, that consists of a copyright registration certificate and/or a copy of the United States Copyright Office's publicly available database entry showing registration and the details therein, which show that Cengage owns the work or has an exclusive license to publish, reproduce, and distribute the work. Where the copyright registration for a work does not list Cengage as the copyright claimant, Cengage has produced or is producing documents sufficient to establish Cengage's chain of title for that work going back to the person or entity listed as the claimant on the work's copyright registration. As a result, Cengage's production will include copies of some agreements with authors of works in suit.

7. It would be extremely burdensome to produce documents showing Cengage's chain of title going back to the original author(s) for every work in suit. For each agreement to be collected, a Cengage employee must conduct a time-consuming manual search for that specific agreement and then review the results of the search to confirm whether any of the documents found is the agreement specifically sought. Further complicating matters, for some works there can be multiple agreements that must be collected (*e.g.*, if the original agreement has been amended).

8. Once collected, each agreement must then be reviewed and redacted for certain Personally Identifying Information (such as home addresses, phone numbers, social security numbers, etc.), which these agreements typically contain.

9. As a result, collecting chain-of-title documents for all works in suit would likely require, at a minimum, hundreds of hours of employee time in addition to the substantial time and expense required by in-house and outside attorneys to manage this process.

10. It would be even more burdensome to produce every document or piece of correspondence with authors that may have been generated in the course of acquiring the copyrights for the works in suit, to the extent such documents still exist. The documents related to acquiring the rights for any single work may involve agreements and communications between many people. For any given work, there are typically at least several Cengage employees who communicate with the author(s) of that work during the publication process and afterward. Further, the employees likely to have communicated with the authors for one work in suit are unlikely to be the same employees who communicated with the authors for the other works in suit. Thus, attempting to collect all the documents and communications for all of the works in suit would require collecting, searching, and reviewing the documents and communications of a very large number, potentially hundreds or more, of Cengage employees. For each one of this enormous number of custodians, Cengage would have to develop individually customized search terms related to the specific works and authors about which that custodian is likely to have documents.

11. Further, some of the works in suit were initially published, and Cengage acquired the rights in those works, many years ago, in some cases decades ago. Finding all documents and communications with the authors of those works, if such documents still exist, would potentially involve searching sources of data that are not readily accessible for such purpose.

12. In sum, collecting, reviewing, and producing all of the documents and communications associated with Cengage's ownership of all of its copyrights in the works at issue, including all of its communications with the authors of the works at issue, would be an enormous undertaking. For the reasons discussed above, it is difficult to assess the amount of material involved. I estimate that, potentially, hundreds of thousands of documents would need to be located, collected, and reviewed in such an effort. This process would require potentially hundreds of hours or more of employee time in addition to the enormous time and expense required by in-house and outside attorneys to manage this process. I would estimate that the expense of such an undertaking could easily could be very expensive.

13. As mentioned above, pursuant to Cengage's standard practices, Cengage's agreements through which Cengage obtains an assignment of the copyright or an exclusive license are with the authors, rather than with any university in which the author may be affiliated as a professor. In my 19 years of experience in the higher education publishing industry, I am not aware of even a single instance in which a university has sent a letter, filed a lawsuit, or raised a dispute in which it claims it owns the copyright in a textbook authored by a professor employed by that university on the basis that the textbook is a work-for-hire by an employee of the university. On the contrary, it is a longstanding industry practice for professors to author books, while working closely with publishers, and transfer ownership rights to publishers or grant publishers exclusive licenses to publish, reproduce, and distribute such books. These books are often then sold and used, among other places, at such universities.

Registration of Cengage's Copyrighted Works

14. Cengage's current process for registering copyrights with the U.S. Copyright Office involves completing the Copyright Office's online submission form. Submission of this form

generates a confirmation email from the Copyright Office with a shipping slip for submitting the deposit copies. A Cengage employee then prints the shipping slip and uses it to mail the deposit copies to the Copyright Office.

15. If there is an issue with the registration, the Copyright Office will contact Cengage regarding the issue and the appropriate remedy. Such communications generally concern clerical issues, such as an information field that was inadvertently left blank or if the Copyright Office cannot find the deposit copies. Communications with the Copyright Office regarding Cengage's claims of ownership in the registration application are extremely rare.

16. Many of Cengage's works in suit were registered many years ago, and the Cengage employees responsible for this process have changed over time. Cengage is unlikely to have any records or documents regarding registration or communications with the Copyright Office involving Cengage employees no longer involved in the registration process.

Cengage's Distribution Agreements with Third Parties

17. I am generally familiar with Cengage's agreements with third parties for digital distribution of Cengage's works. To collect these agreements would require working with the relevant business unit to identify every relevant agreement and conducting a manual search for those agreements. This manual process cannot be automated.

18. Cengage does not generally permit Cengage's distribution partners to authorize third parties to digitally distribute Cengage's works. In any limited instances in which Cengage does permit a distribution partner to authorize a third party to digitally distribute Cengage's works, that third party is not an unknown third party conducting business from an unknown URL. Further, Cengage does not permit its distribution partners to authorize any such third party to digitally distribute copies of Cengage's textbook in a format that allows for further dissemination.

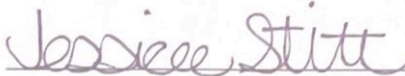
Cengage's Financial Information

19. I am generally familiar with Cengage's processes for storing financial data. Obtaining revenue information for any particular title has both manual and automated components. Revenue data for all titles is not all stored in a single system. The degree of difficulty of obtaining revenue information for a particular title varies depending on the age of the title and the system that houses the data.

20. Collecting all documents and communications related to Cengage's commercial exploitation of the works in suit would be an enormous undertaking, to the extent it is even possible to do so. Commercially exploiting copyrighted works is one of the core focuses of Cengage's business, and documents related to those activities touch on dozens, if not hundreds, of Cengage's employees across many aspects of Cengage's operations, including sales, marketing, customer service, finance, strategy, manufacturing and distribution. I estimate that an overwhelming amount of documents would need to be located, collected, and reviewed in such an effort. This process would require potentially hundreds or thousands of hours of employee time in addition to the enormous time and expense required by in-house and outside attorneys to manage this process. I would estimate that the expense of such an undertaking could easily cost in the millions of dollars.

I declare under penalty of perjury under the laws of the United States that the foregoing is true and correct.

Executed this 22nd day of April, 2022.


JESSICA STITT

**UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA**

BEDFORD, FREEMAN & WORTH
PUBLISHING GROUP, LLC d/b/a
MACMILLAN LEARNING, *et al.*,

Plaintiffs,

v.

SHOPIFY INC., *et al.*,

Defendant.

Case No. 1:21-cv-01340-CMH-JFA

DECLARATION OF COREY MILLER

I, Corey Miller, hereby declare pursuant to 28 U.S.C. § 1746 that the following statements are true and correct to the best of my personal knowledge and belief:

1. I am an associate at Oppenheim + Zembrak, LLP, and am admitted to practice law in the District of Columbia, among other jurisdictions. I am counsel for Plaintiffs in the above-captioned case.

2. I submit this declaration in support of Plaintiffs' Opposition to Defendant Shopify Inc.'s Motion to Compel Production of Documents Responsive to Shopify's First Set of Requests For Production.

3. I have participated in all of the conferrals between counsel regarding the parties' discovery disputes. While the parties conferred for nearly seven hours on various discovery disputes before Defendant filed Defendant Shopify Inc.'s Motion to Compel Production of Documents Responsive to Shopify's First Set of Requests For Production (the "Motion"), those

conferrals did not include discussion of RFPs 7, 8, 9, 10, 12, 21, and 22, to all of which the Motion requested the Court compel a response.

4. On Friday, April 15, 2022, before Defendant filed the Motion later in the day, Plaintiffs advised Defendant as follows:

Even interpreting our conferrals broadly (such that, e.g., our discussion of author communications within the context of RFP 1 could apply as well to RFP 11), we have not conferred with you regarding foreign registrations (RFP 7), documents regarding first publication (RFPs 8/9), documents sufficient to show the authors (RFP 10), communications with other copyright owners (RFP 12), and documents sufficient to show whether a work is a work-for-hire (RFP 13).

If you move on these requests today, please include in your Rule 37(E) statement that Plaintiffs disagree that a good-faith effort has been made to resolve these requests.

Email dated Apr. 15, 2022 from Corey Miller to Jessica Stebbins Bina, copying other counsel at Latham & Watkins and Oppenheim & Zebrak.

5. On Friday, April 15, 2022, after Defendant filed the Motion, Plaintiffs advised Defendant as follows:

We are surprised to see that the motion to compel Shopify filed this afternoon seeks to compel a response to RFPs 21, 22, and 45, because the parties have never conferred on RFPs 21 and 22, and Plaintiffs' response to RFP 45 incorporates their responses to RFPs 21 and 22 by reference. We note that none of the emails below discussing the outcomes of our conferrals reference the results of any conferral on RFPs 21 and 22 (because none occurred).

Further, Shopify's motion inaccurately states that Plaintiffs are refusing to produce documents in response to RFP 21, when in fact Plaintiffs responded that they "will produce any nonprivileged reports created since January 1, 2017, that show the valuation for a Copyrighted Work, to the extent any such reports exist and can be found after a reasonable search."

The failure to confer regarding RFP 22 is significant, because the issues related to responding to that RFP are complex. Had you conferred with us on that RFP, we would have explained why responding to RFP 22 is complicated and would impose significant burdens, and potentially worked with you to devise a reasonable and proportional response.

Please file an amended motion tonight withdrawing your motion with regard to RFPs 21, 22, and 45, so that, consistent with Local Rule 37(E), the parties can confer regarding Plaintiffs' responses to these requests.

Email dated Apr. 15, 2022 from Corey Miller to Jessica Stebbins Bina, copying other counsel at Latham & Watkins and Oppenheim & Zebrak.

6. On Friday, April 15, 2022, Defendant responded that "we understood counsel's position on all damages-related requests to be the position you stated repeatedly at our meet and confers," that "w[e] raised both RFPs in our initial conferral email below," and that "[w]e engaged in conferrals for seven hours. We provided the requests we were concerned about in writing. We filed our motion based on our understanding of plaintiff's position, which has not changed." Emails dated Apr. 15, 2022 from Jessica Stebbins Bina to Corey Miller, copying other counsel at Latham & Watkins and Oppenheim & Zebrak.

Executed in Washington, DC, this 22nd day of April, 2022.

/s/ Corey Miller
Corey Miller

**UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
ALEXANDRIA DIVISION**

BEDFORD, FREEMAN & WORTH
PUBLISHING GROUP, LLC d/b/a
MACMILLAN LEARNING; MACMILLAN
HOLDINGS, LLC; CENGAGE LEARNING,
INC.; ELSEVIER INC.; ELSEVIER B.V.;
MCGRAW HILL LLC; and PEARSON
EDUCATION, INC.,

Plaintiffs,

v.

SHOPIFY INC.,

Defendant.

Case No. 1:21-cv-01340

**DEFENDANT SHOPIFY INC.'S MEMORANDUM IN OPPOSITION
TO PLAINTIFFS' MOTION TO COMPEL**

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I. INTRODUCTION

Shopify has agreed to produce—and has already begun producing—extensive, costly, time-intensive, and voluminous material relevant to the claims Plaintiffs actually pled (*i.e.*, infringement of Plaintiffs’ specific copyrighted works by the Alleged Merchants¹) and Shopify’s defenses in this case. In an effort to needlessly harass and significantly increase the burden on Shopify, Plaintiffs have moved to compel two additional sets of data: (1) information related to Shopify’s records with respect to responding to notices of infringement and enforcing its repeat infringer policy; and (2) information on a wide swath of discovery requests where Shopify agreed to respond, but limited its response to the past three-and-a-half years, rather than the five-and-a-half years demanded by Plaintiffs. Both requests should be denied, but for different reasons.

With respect to the first set of data, regarding responding to notices of infringement and enforcing the repeat infringer policy, Plaintiffs’ motion is moot. Shopify *agrees* that during the relevant limitations period, Plaintiffs should receive relevant, proportionate information on Shopify’s infringement policies, procedures, and practices, beyond the Alleged Merchants. The parties were deep in conferral on *how* to accomplish this, when Plaintiffs jumped the gun, filing their motion despite Shopify’s good-faith efforts to produce essentially everything Plaintiffs have asked for within the limitations period. Shopify continues, in good faith, to identify and produce this information. To the extent any live dispute remains, the Court should hold that Shopify’s planned production of responsive information is adequate.

With respect to the second set of data—Plaintiffs’ proposal to require Shopify to search for and produce an additional *two years* of records, including from a legacy infringement tracking

¹ The “Alleged Merchants” refers to any Shopify Merchants that were identified in response to an Infringement Notice sent by or on behalf of Plaintiffs, regarding any of the Copyrighted Works or Trademarks upon which Plaintiffs bring suit (Exhibits A and B to the Complaint), within the limitations period, *i.e.*, between December 1, 2018 and March 1, 2022.

system that was not used at all during the limitations period—Plaintiffs’ motion should be denied as exceeding the bounds of permissible discovery under the Federal Rules. The pre-limitations information Plaintiffs seek (including records of merchants that are not accused of infringement in this case) is neither relevant nor proportional to the needs of the case. Plaintiffs’ arguments to the contrary are premised on fundamental misstatements of governing law, including the binding law of the Fourth Circuit on Shopify’s relevant “knowledge.” Even if the documents sought by Plaintiffs were of some attenuated relevance to this case, that marginal relevance is far outweighed by the burden of reviewing an additional two years of materials, which would increase by approximately 60 percent the temporal scope of Shopify’s (already robust) document review.

Shopify is committed to providing relevant and proportionate discovery, so that this case may be expeditiously decided on its merits. It has agreed to produce information on all “tickets” concerning the Alleged Merchants from Shopify’s ticketing system used for tracking notices of infringement, communicating with Alleged Merchants, applying infringement “strikes,” and terminating Merchants. It has agreed to produce all communications with the Alleged Merchants themselves, including those relating to infringement tickets, strikes, notices, or IP infringement generally, without time limitations. It has agreed to produce all communications, during the limitations period, concerning alleged infringement by the Alleged Merchants. It has already produced 13,000 pages of responsive documents, and is preparing to produce thousands more. But Plaintiffs’ requests in their Motion for further and additional discovery stray far beyond the bounds of relevant and proportionate discovery under the Federal Rules, and should be denied.

II. FACTUAL BACKGROUND

Plaintiffs’ Motion challenges (i) Shopify’s limitation of its responses to seven Requests for Production (RFPs 6, 11, 14, 20, 21, 25, and 30) and five Interrogatories (Rogs. 1-3, 9, and 10) to the statute of limitations period, and (ii) Shopify’s ostensible limitation of three Requests for

Production (RFPs 17, 20 and 21) and two Interrogatories (Rogs. 9 and 10) to the 3,426 alleged infringements and the approximately 1,800 alleged infringing merchants actually at issue in this suit. Dkt. 56 at 6-7, 10-12; *see also* Dkt. 1 at Exs. A-B. Critically, for RFPs Nos. 6, 11, 14, 25, and 30, and Rogs. Nos. 1-3, Plaintiffs challenge only the temporal scope of Shopify’s discovery responses—Plaintiffs seek information going back to January 1, 2017, despite the limitations period beginning nearly two years later—but Plaintiffs do not presently dispute the adequacy of the categories of responsive information that Shopify has agreed to produce. For RFP 17, Plaintiffs challenge the substantive limits of Shopify’s response, but not the limitation of its response to the limitations period. For the remaining RFPs 20 and 21, and Rogs. 9 and 10, Plaintiffs dispute both the substantive and temporal limits of Shopify’s response. However, as explained below, with respect to the substantive dispute, Plaintiffs’ motion is premature and there is actually little or no difference between the parties’ respective positions.

As detailed *infra*, Shopify believes that it has already agreed to produce all discovery to which Plaintiffs are entitled under the standard articulated by Rule 26 of the Federal Rules of Civil Procedure. But Plaintiff’s motion obscures, rather than illuminates, the voluminous discovery on these topics that Shopify has already agreed to produce, and in many cases has already commenced producing, namely the following:

- **Alleged Merchant Information (RFPs Nos. 25, 30):** Plaintiffs requested all documents discussing any “Infringement Notice” from Plaintiffs to Shopify concerning Shopify Merchants; and all documents concerning any “warnings, ratings, risk assessments, flags” relating to risk for the foregoing Merchants. Dkt. 56-1 at 38, 45. In response, Shopify is willing to produce (i) all communications *with* the Alleged Merchants in Shopify’s possession, custody, or control (without time limitation); (ii) all “information from [Shopify’s]

[infringement notice] ticketing system for the tickets” associated with each Alleged Merchant from December 1, 2018 to March 1, 2022 (the limitations period) (*i.e.*, the main location of documentation regarding Shopify’s process for and responses to infringement notices); (iii) all communications concerning these Alleged Merchants insofar as they relate to infringement (including notices, flags, warnings, and infringement risk assessments, to the extent they exist), from December 1, 2018 to March 1, 2022 (the limitations period); and (iv) any infringement-related flags or strikes on the Alleged Merchant accounts from January 1, 2017 onward. *See* Dkt. 56-1 at 39, 46; Stebbins Bina Decl. ¶ 5.²

- **Infringement Policies and Procedures: (RFP No. 6, Rog Nos. 1-2):** Plaintiffs requested all documents concerning Shopify’s “strategies, approaches, policies, or procedures” concerning “infringement,” along with “all persons” with any responsibility for “designing, developing, or implementing” such policies, procedures, or practices. Dkt. 56-1 at 14; Dkt. 56-2 at 6, 9. Shopify has agreed to produce the discovery responsive to these requests during the limitations period, from December 1, 2018 to March 1, 2022. *See id.*
- **Shopify’s Infringement Tracking System (RFP No. 11, Rog. No. 3):** Plaintiffs requested all documents concerning “any system used for tracking Infringement Notices,” including its “technical abilities,” along with “all persons” with any responsibility for “designing, developing, or implementing” that system. Dkt. 56-1 at 20; Dkt. 56-2 at 11. Shopify agreed to produce “documents sufficient to show the capabilities of Shopify’s system used for tracking and processing Infringement Notices,” and “personnel . . . responsible for creating the system,”

² In response to Plaintiffs’ concerns articulated through the meet-and-confer process, Shopify’s agreements to produce information, as reflected in this Motion, are more expansive than those articulated in Shopify’s initial discovery Responses served on March 31, 2022. Stebbins Bina Decl. ¶¶ 5-7.

but only for its current infringement system that Shopify first deployed in October 2018 (two months prior to the limitations period), and not the legacy infringement system that was used prior to October 2018. *See* Dkt. 56-1 at 21; Dkt. 56-2 at 12.

- **Infringement Summaries, Reports, and Analyses (RFP No. 14):** Plaintiffs requested all “documents” “including summaries, reports, or analyses, concerning [Shopify’s] handling of and response to Infringement Notices. . . .” Dkt. 56-1 at 24. Shopify agreed to produce “non-privileged summaries, including reports and analyses, concerning Shopify’s handling of, and response to, Infringement Notices,” during the limitations period. *Id.* at 25.
- **Reactivation of Terminated Merchants (RFP No. 17):** Plaintiffs seek information regarding any merchants Shopify terminated for infringement and reactivated, during the limitations period. As explained below, Shopify agreed to produce this information in its initial responses; it is unclear why Plaintiffs have moved on this RFP as there appears to be no dispute.
- **Alleged Rejections of Infringement Notices via Email (RFPs Nos. 20-21, Rogs. Nos. 9-10):** Plaintiffs seek information about “Infringement Notices” Shopify “received via email” and did not “process[,]” instead responding that the Notice was “not proper” because it was “submitted via email” or “reported multiple infringements” or “multiple . . . Merchants.” Dkt. 56-1 at 31-33; Dkt. 56-2 at 19-21. As detailed below in Section I, Shopify is willing to produce this information during the limitations period, from December 1, 2018 to March 1, 2022.

III. ARGUMENT

“Parties may obtain discovery regarding any nonprivileged matter that is relevant to any party’s claim or defense and proportional to the needs of the case” Fed. R. Civ. P. 26(b)(1). Under this standard, “it is proper to deny discovery of matter that is relevant only to . . . *events that occurred before an applicable limitations period, unless* the information sought is otherwise

relevant to issues in the case.” *Oppenheimer Fund, Inc. v. Sanders*, 437 U.S. 340, 352 (1978) (emphasis added). That is, discovery prior to the limitations period is properly denied unless the movant shows the requested discovery is nonetheless “relevant” to the claims or defenses. *Id.*

Additionally, all discovery must be proportional. Fed. R. Civ. P. 26(b)(1). Courts evaluate proportionality by considering “the amount in controversy,” the “importance” of the material sought, the parties’ “resources,” the parties’ “access” to materials, and “whether the burden or expense of the proposed discovery outweighs its likely benefit.” *Brink’s Co. v. Chubb Eur. Grp. Ltd.*, No. 3:20-520, 2021 WL 5083335, at *4 (E.D. Va. Feb. 24, 2021), *adopted*, 2021 WL 5083332 (E.D. Va. Mar. 12, 2021).

Shopify has already agreed to provide Plaintiffs all of the information that is relevant and proportional to this case. Their motion to compel further discovery should be denied.

A. Relevant Legal Standard For the Parties’ Claims and Defenses

Under Rule 26, discovery must be “relevant to any party’s claim or defense.” Fed. Rule Civ. Pro. 26(b)(1). Here, Plaintiffs bring claims for contributory copyright and trademark infringement, and Shopify defends based on its own lack of involvement in the alleged infringement by its users, and based on the statutory safe harbor under Section 512 of the Digital Millennium Copyright Act (“DMCA”). *See generally* Answer, Dkt. 30.

The first, threshold element of a claim for a claim of contributory copyright infringement is an act of direct copyright infringement, during the limitations period, by a third party. *See, e.g., Bridgeport Music, Inc. v. Diamond Time, Ltd.*, 371 F.3d 883, 890 (6th Cir. 2004). Under the Copyright Act, the statute of limitations is three years from the filing of this suit on December 1, 2021. *Id.*; 17 U.S.C. § 507(b); Compl., Dkt. 1. Accordingly, Plaintiffs can bring claims only as to acts of direct infringement that took place during the limitations period, *i.e.*, since December 1,

2018. *Bridgeport Music*, 371 F.3d at 890.³ If Plaintiffs prove such an act of infringement, they must prove two more elements, within the limitations period: That Shopify, “[2] with knowledge of the infringing activity, [3] induce[d], cause[d] or materially contribute[d] to the infringing conduct.” *CoStar Grp., Inc. v. LoopNet, Inc.*, 373 F.3d 544, 550 (4th Cir. 2004); *see also Bridgeport Music*, 371 F.3d at 890 (“claims against a contributory infringer who commits no acts within the limitations period are also time barred”).

The DMCA’s safe harbor, in turn, shields Shopify from liability for contributory copyright infringement by its third-party customers, if *during the limitations period*, Shopify “has adopted and reasonably implemented, and inform[ed] subscribers and account holders . . . of, a policy that provides for the termination in appropriate circumstances of subscribers and account holders . . . who are repeat infringers.” 17 U.S.C. § 512(i)(1)(A); *see also* Answer, Dkt. 30 at 37; *cf. Rosen v. eBay, Inc.*, No. 16-9183, 2018 WL 4808513, at *5 (C.D. Cal. Apr. 4, 2018) (explaining that DMCA defense depends on the adequacy of defendant’s policies during time period subject to suit). This policy must apply to all of Shopify’s merchants, not just those alleged to have infringed in this specific case. *See, e.g., Rosen*, 2018 WL 4808513, at *5-6.

Finally, if liability is proven and Shopify’s defenses are overcome, a jury may consider a number of factors in determining the amount, if any, of statutory damages, including: “(1) whether the defendant was the original provider of the infringed content to its distribution network; (2)

³ Plaintiffs argue that it is possible that the statute of limitations might be tolled if they did not discover (and should not have discovered) a given infringement prior to the limitations period. Dkt 56 at 5 n.1; *cf. Werner v. BN Media, LLC*, 477 F. Supp. 3d 452, 455-56 (E.D.V.A. 2020) (explaining that claim accrues when “one has knowledge of a violation or is chargeable with such knowledge” but that damages are limited to the three years prior to filing suit regardless). But this is a red herring: Plaintiffs do not allege any recently “discovered” pre-December 1, 2018 infringement; to the contrary, Plaintiffs maintain vigorous monitoring and rights enforcement practices. *See, e.g.,* Dkt. 1, ¶ 6.

whether, and how much, the defendant profited or saved in connection with the infringement; (3) the plaintiff's actual losses; (4) [deterrence]; and (5) the defendant's willfulness and intent in infringing the plaintiff's protected content." *ME2 Prods., Inc. v. Fox*, No. 3:17-CV-00057, 2018 WL 1470251, at *2 (E.D. Va. Mar. 26, 2018).⁴

B. Plaintiffs' Requests For Information Regarding Non-Alleged Merchants Should Be Denied As Unnecessary

The bulk of Plaintiffs' motion, and of this opposition, addresses Plaintiffs' demand for discovery for a full *two years* prior to the start of the limitations period in this case. Before delving into this genuine dispute between the parties with respect to temporal limitations, however, Shopify first addresses Plaintiffs' demand for additional substantive material with respect to Requests for Production 17, 20, and 21, and Interrogatories 9 and 10. Shopify addresses these matters first because it does not believe there *is* any genuine dispute between the parties—a fact that would have become apparent to Plaintiffs had they not rushed to file their motion in the midst of the parties' meet and confer efforts.

1. ***Shopify Has Already Agreed to Produce Relevant and Proportionate Information Concerning Non-Alleged Merchants***

With these five requests (RFPs 17, 20, and 21, and Rogs 9 and 10), Plaintiffs assert that they are entitled to explore Shopify's repeat infringer policy generally, and not just with respect to the Alleged Merchants. *See* Dkt. 56 at 13-16. But this is not disputed: Shopify *agrees* to produce reasonable, proportionate discovery on each of these requests. As to the first request (RFP No. 17), Shopify agreed *in its initial responses* to provide Plaintiffs the requested materials concerning "reactivation" of Shopify Merchants. As to the other four requests, the parties were in the middle

⁴ Plaintiffs do not address the elements of trademark infringement or argue that there is any material difference that would impact the outcome of this motion. Shopify concurs: These elements closely parallel contributory copyright infringement. *See, e.g., Passport Health, LLC v. Avance Health Sys.*, 823 F. App'x 141, 146 (4th Cir. 2020) (discussing "indirect infringers").

of the meet-and-confer process on a tailored solution when Plaintiffs filed their motion, and Shopify is in the middle of carrying out a reasonable protocol to provide Plaintiffs the requested information, consistent with Plaintiffs' requests.

a. **Plaintiffs Misread Shopify's Response to RFP No. 17, and Then Needlessly Moved To Compel Without Conferring**

For RFP No. 17, Plaintiffs requested all documents "concerning the reactivation of service for any Shopify Merchant whose service You terminated for violation of any policy relating to copyright or trademark infringement." Dkt. 56-1 at 27. That is, Plaintiffs want to know about *any* Merchant that was "terminated" due to infringement, and then "reactivated." *Id.* Plaintiffs claim that Shopify's Response to RFP No. 17 is insufficient because Shopify "agreed to provide this information for the merchants identified in this suit, but not for other merchants," and "Shopify should respond to this document request in full, *without limiting its response to the infringing merchants identified in Plaintiffs' notices.*" Dkt. 56 at 16 (emphasis added).

But this is not true. Even a cursory review of Shopify's Response demonstrates that Shopify *agreed* to produce the information Plaintiffs are moving to compel, *i.e.*, documents sufficient to show reactivation of *any* merchants terminated for infringement:

Shopify will produce relevant, non-privileged documents sufficient to show Shopify's policies and processes for, and any actual reactivation of, *Shopify Merchants* whose service Shopify terminated for violation of any policy relating to copyright or trademark, for the period of December 1, 2018 through March 1, 2022.

Dkt. 56-1 at 28 (emphases added). There is no dispute here, as Plaintiffs would have known had they conferred on this RFP before filing their motion. Stebbins Bina Decl. ¶ 8. Since Shopify already agreed to provide everything requested by Plaintiffs in their Motion on RFP No. 17 (*i.e.*, information about a broader set of Shopify Merchants), the Motion is moot as to that RFP and should be denied.

b. Shopify Has Proposed A Reasonably Tailored Solution to Address RFPs Nos. 20-21 and Rogs. Nos. 9-10.

In RFPs Nos. 20-21 and Interrogatories Nos. 9-10, Plaintiffs seek information about the *number* of “Infringement Notices” Shopify “received via email” and did not “process[,]” but instead “responded with an email informing the submitter” that the Infringement Notice was “not proper” because it was “submitted via email” or reported “multiple Shopify Merchants or multiple copyrights or trademarks.” Dkt. 56-1 at 31-34; Dkt. 56-2 at 19-23. Plaintiffs allege this is relevant because they hope to prove that: (1) copyright owners submit notices of infringement to Shopify via email that comply with the requirements of the DMCA, but (2) rather than “processing” these DMCA-compliant infringement notices, Shopify allegedly “responds” to complainants that the notices need to be resubmitted through Shopify’s online web form, or reformatted and resubmitted without combining “multiple Shopify Merchants or multiple copyrights or trademarks.” *Id.*

As an initial matter, Plaintiffs are mistaken on the facts. As Shopify explained in its Responses, “Shopify creates tickets in its ticketing system, regardless of the manner in which it receives the Infringement Notice—thereby processing each notice.” Dkt. 56-1 at 33; Dkt. 56-2 at 23. That is, under Shopify’s policies, in no case would Shopify fail to “process” the notice by creating a ticket—regardless of whether the notice was submitted via email, or contained multiple entries—even if the notice was defective under the DMCA. *See id.* Accordingly, as Shopify explained in its Responses themselves, “no documents responsive to th[ese] Request[s] exist,” and “the number of Infringement Notices responsive to th[ese] Interrogator[ies] is zero.” Dkt. 56-1 at 31-34; Dkt. 56-2 at 19-23. Plaintiffs obviously cannot compel responses to discovery requests as to which Shopify has already responded that no responsive information exists.

Plaintiffs have clarified through the meet-and-confer process, however, that notwithstanding the language of the requests, they are trying to explore a slightly different concept

here, seeking “information regarding the reason certain tickets were actioned in a certain manner, including by emailing the complainant.” Dkt. 56-1 at 31-34; Dkt. 56-2 at 19-23. In other words, Plaintiffs want to know not only if an infringement notice was “processed,” but *how* the ticket was *actioned* by Shopify’s team after processing, and particularly if the initial action taken was a follow-on email to the party who sent the notice. Specifically, Plaintiffs want Shopify to quantify the number of infringement notices that Shopify responded with an email to the sender citing certain enumerated deficiencies, rather than immediately issuing a takedown notice.

The problem with this is, as Shopify explained to Plaintiffs, this is not information Shopify classifies in this way in the ordinary course of business, and trying to determine the information Plaintiffs seek requires a qualitative legal analysis of historical information that is both burdensome and imprecise. From December 1, 2018 to March 1, 2022 alone, Shopify has identified “179,889 tickets” relating to infringement. Dkt. 56-1 at 26. There is no automatic way to isolate the tickets Plaintiffs seek, and a linear review of all the individual tickets would be unduly burdensome. At a review rate of, *e.g.*, 200 documents per hour, that would amount to 899 hours of review time. Spending nearly 1,000 hours to manually review 179,889 tickets to respond to just 4 of Plaintiffs 72 discovery requests is facially disproportionate. *See, e.g.*, Fed. R. Civ. P. 26(b)(1); *Rodríguez-Torres v. Government Dev. Bank of P.R.*, 265 F.R.D. 40, 44 (D.P.R. 2010) (denying requests in light of “costs” of “review that Defendant . . . will have to undertake on what could turn out to be hundreds or thousands of documents.”).

Against that background, Shopify met and conferred with Plaintiffs to try to find a reasonable solution that would permit Shopify to identify the requested information, without performing a manual review of each of the 179,889 tickets relating to infringement (within the limitations period alone). As detailed immediately below, the parties were close to an agreement

on a solution on this issue when Plaintiffs unexpectedly filed their Motion on these four discovery requests. Stebbins Bina Decl. ¶ 6.

First, Plaintiffs clarified during meet-and-confers that they are *not* seeking production of the tickets responsive to these four requests, just identification of the *number* of “Infringement Notices” Shopify “received via email” and did not “process” for the reasons Plaintiffs enumerated in their requests. Stebbins Bina Decl. ¶ 6.

Second, Shopify has already agreed to produce information for *all* tickets associated with the Alleged Merchants since December 2018, over 5,000 tickets, forming a meaningful sample that would allow Plaintiffs to explore this issue themselves, directly. *See Bridge v. Credit One Fin.*, 294 F. Supp. 3d 1019, 1031 (D. Nev. 2018) (approving production of “sample”). Stebbins Bina Decl. ¶ 6

Third, and most critically, Plaintiffs and Shopify were in the middle of negotiating search terms that would be most likely to return responsive documents for RFPs Nos. 20-21 and Rogs. Nos. 9-10,⁵ and thereby allow Shopify to determine, or at least reasonably estimate, the answers to Plaintiffs’ inquiries for the limitations period *in full*, when Plaintiffs filed their motion. *Id.*

Since the Motion’s filing, Shopify has continued its efforts, and now believes it *has* identified search terms that are likely to capture the information Plaintiffs are seeking. Stebbins Bina Decl. ¶ 7. Shopify remains ready and willing to confer with Plaintiffs and further refine acceptable search terms. However, Plaintiffs have generally indicated that they do not intend to

⁵ Plaintiffs themselves initially proposed that they could identify to Shopify search terms that would allow Shopify to identify responsive tickets. Stebbins Bina Decl. ¶ 6. Shopify agreed that this proposal offered a potential way forward to a solution. Plaintiffs proposed search terms in writing on April 12, 2022. Dkt. 53-9 at 12. On April 14, 2022, Shopify responded via email that “Shopify will discuss with the client the search term results, and if there is a way to reasonably provide this information to plaintiffs.” Dkt. 53-9 at 8. Plaintiffs filed this Motion the next day.

confer further on discovery that is subject to pending motions. *Id.* Accordingly, Shopify has begun to implement the search terms on its own in order to provide further responses to RFPs Nos. 20-21 and Rogs. Nos. 9-10, *id.*, as provided for by applicable case law. *See, e.g., Treppel v. Biovail Corp.*, 233 F.R.D. 363, 374 (S.D.N.Y. 2006) (where parties do not stipulate to search methodology, defendant should proceed “unilaterally, producing all responsive documents located by its search”). Shopify intends to produce information responsive to RFPs Nos. 20-21 and Rogs. Nos. 9-10, as their scope has been clarified by Plaintiffs, for the period December 1, 2018 through March 1, 2022, expeditiously following this review. Stebbins Bina Decl. ¶ 7.

For all of these reasons, Plaintiffs’ Motion as to RFPs Nos. 20-21 and Rogs. Nos. 9-10 is almost entirely moot. The only remaining question is whether the search procedure that Shopify is applying to its current ticketing system should be applied against records located only in Shopify’s distinct, *legacy* infringement tracking system, prior to October 2018. For all of the reasons detailed *infra* in Section C, it should not: Aside from the burden and disproportionality of doing so, *see infra* at 22-24, Plaintiffs have acceded to (and not moved upon) such temporal restrictions to the limitations period with respect to their Interrogatories that seek similar, parallel information concerning Shopify’s compliance program as a whole. *See, e.g.,* Shopify’s Responses to Rogs. 12, 13, 14 Dkt. 56-2 at 26-27, 30, 32-35 (providing overall statistics of Shopify’s compliance program as whole, such as monthly numbers of tickets, and monthly actions on tickets). There is no reason to provide more than 5 years of data on RFPs Nos. 20-21 and Rogs. Nos. 9-10, when providing only 3.5 years of data on all other aspects of Shopify’s infringement system. *Id.* The Court should deny Plaintiffs’ requests for further discovery, other than that Shopify has agreed to provide, with respect to RFPs 20 and 21, and Rogs 9 and 10.

C. Plaintiffs' Requests For Discovery Outside The Limitations Period Are Irrelevant And Disproportionate

The remainder of Plaintiffs' motion, and this opposition, address Plaintiffs' motion to compel an additional *two years* of discovery, across a broad range of requests (RFPs 11, 14, 20, 21, 25, and 30, and Rogs 1-3, 9, and 10), prior to the applicable limitations period. This portion of Plaintiffs' motion should be denied in full. Shopify is willing to produce, and is in the midst of producing, comprehensive discovery that fully satisfies its obligations under Rule 26. Plaintiffs' demand for additional information *two years* outside the statute of limitations is neither relevant nor proportional, and would impose a substantial and disproportionate burden on Shopify.

1. Documents Years Outside the Limitations Period Are Not Relevant

As outlined above, Plaintiffs as a general matter can only bring claims for infringements that took place *during* the relevant limitations period. *See supra* at 6-7. Similarly, as a general matter, the adequacy of Shopify's repeat infringer policy is examined *only* during the relevant limitations period. *See supra* at 6-7, *infra* at 17-20. Against that background, the dispositive problem for Plaintiffs is that they are seeking two years of additional information prior to the December 1, 2018 limitations period, dating back as far as January 1, 2017, that has no relevance to determining Shopify's alleged liability, DMCA defense, or statutory damages for any actionable acts of infringement *within* the limitations period.

a. Alleged Pre-Limitations Infringement by Shopify Merchants "Writ Large" Does Not Demonstrate "Knowledge."

Plaintiffs' motion focuses largely on Shopify's alleged "knowledge." Dkt. 56 at 7-15. As noted *supra*, Shopify's liability for its merchants' acts of copyright infringement turns on whether it had "knowledge of the infringing activity" of the accused direct infringers during the limitations period. *CoStar Grp.*, 373 F.3d at 550; *see also Bridgeport Music*, 371 F.3d at 889-890. This is a standard of "actual knowledge" or "willful blindness" to specific acts of infringement by the

Alleged Merchants: If Shopify merely “*should* have known of such infringing activity,” *i.e.*, was “negligen[t],” that does *not* suffice under Circuit law. *BMG Rts. Mgmt. (US) LLC v. Cox Commc’ns., Inc.*, 881 F.3d 293, 307-308 (4th Cir. 2018) (emphasis added).

Plaintiffs argue that discovery into *any* historical knowledge of *any* infringement by *any* Merchants using Shopify’s platform “writ large” is relevant to its “knowledge.” Dkt. 56 at 9. That is not the law; indeed, were it the case, there would be no need for Plaintiffs to *ever* demonstrate actual knowledge of the specific infringements alleged. *Cf. UMG Recordings, Inc. v. Shelter Cap. Partners LLC*, 718 F.3d 1006, 1021 (9th Cir. 2013) (under such a “general knowledge” theory, the DMCA’s “safe harbor would be rendered a dead letter”). Instead, the Fourth Circuit has found that “contributory infringement requires ‘actual knowledge of specific acts of infringement’ or ‘[w]illful blindness of specific facts’” of infringement. *BMG Rts. Mgmt.*, 881 F.3d at 310. “[G]eneralized knowledge — that infringement was occurring somewhere on [a] network — is exactly what falls short” of proving sufficient knowledge of the actionable, specific acts of infringement on an online platform. *Id.* at 311.

The relevant inquiry is thus *not* whether Shopify knew, at some time, that “some number of its subscribers were infringing [plaintiff’s] copyrights, even if the data did not show which ones were infringing,” but rather, whether Shopify had “knowledge that infringement [wa]s substantially certain to result from [its] continued provision of [service] *to particular subscribers.*” *Id.* (emphasis added). That is, the issue is whether “*a specific customer . . . is substantially certain*” to engage in infringement. *Id.* (emphasis added). Based on Plaintiffs’ complaint, Shopify has identified approximately 1,800 Alleged Merchants that allegedly engaged in infringement of Plaintiffs’ intellectual property since December 1, 2018. It is these 1,800 Alleged Merchants, and their actions during the limitations period, for whom Shopify’s “knowledge” is arguably relevant.

Plaintiffs thus misstate the law when they claim that knowledge of “infringement by Shopify merchants writ large” is relevant here. Dkt. 56 at 9. Under black-letter law, it is not.⁶

b. The Specific Discovery Sought By Plaintiffs Is Not Relevant To Knowledge

Against this background, it is clear that Shopify’s “knowledge” of infringements on its network “writ large” is simply not relevant to liability, *especially* in the pre-limitations period sought by Plaintiffs. Rather, what is relevant whether Shopify was aware of specific facts with respect to the 1,800 Alleged Merchants that made those Alleged Merchants “substantially certain” to engage in infringement during the limitations period. *BMG Rights Mgmt.*, 881 F.3d at 311. To be clear: Shopify is producing *all* communications with those Alleged Merchants in its possession, custody, and control, regardless of date, and it is producing information sufficient to show any infringement-related warnings given to those Alleged Merchants, or risks or flags posted on those Alleged Merchants’ accounts, going back to January 1, 2017. Shopify is also producing thousands of additional documents regarding alleged infringement, and Shopify’s policies, procedures, and systems for handling alleged infringement *during the limitations period*. *See supra* at 4-5.

Yet the discovery Plaintiffs seek is far broader: Plaintiffs seek all documents concerning *every* infringement notice sent by Plaintiffs (even those sent prior to the limitations period regarding Merchants who never allegedly infringed again) (RFP 25),⁷ and information regarding

⁶ Plaintiffs’ counsel should know better: They served as counsel for two interest group *amici curiae* that unsuccessfully sought *en banc* review to overturn the *BMG* panel’s adoption of this demanding standard of “actual knowledge of specific acts of infringement,” in favor of a less-rigorous “should have known” negligence standard. *See* Br. of Recording Indus. Ass’n of Am., Inc. & Nat’l Music Publishers’ Ass’n as Amici Curiae in Supp. of Pet. for Hr’g & Rehr’g En Banc at 8-10, *BMG Rts. Mgmt. (US) LLC v. Cox Commc’ns, Inc.*, No. 16-01972 (4th Cir. Feb. 22, 2018), Dkt. 121. But the Court denied *en banc* review, *id.* No. 16-01972 (4th Cir. Feb. 27, 2018), Dkt. 123, and the more stringent standard articulated in *BMG* remains the law in this Circuit.

⁷ For example, if Plaintiffs sent a single notice of infringement in early 2017, but never again sent another notification regarding the same Merchant, Plaintiffs’ request would require Shopify to

all of Shopify’s infringement policies, strategies, approaches, procedures, and tracking systems—even those indisputably *not* in place during the limitations period (RFPs 6, 11, 14, 20, 21, 30 and Rogs 1-3, and 9-10)—for example, Shopify’s legacy infringement ticketing system that was replaced with its current system in October 2018. Requiring Shopify to produce this broad swath of materials would be extremely burdensome: Shopify would have to search an additional *two years*’ worth of internal communications, and it would have to provide data and information on an infringement ticketing system that it has not used since October 2018. Gallant Decl. ¶¶ 10-15. Yet none of this is calculated to produce the sort of “knowledge” information that is relevant under Circuit precedent. *See BMG Rights Mgmt.*, 881 F.3d at 311. Indeed, there is no possible relevance of pre-limitations records of merchants that are *not* accused of engaging in acts of infringement during the limitations period. *See BMG Rights Mgmt.*, 881 F.3d at 311 (the issue for actionable liability within the relevant time period is whether “a specific customer . . . is substantially certain” to engage in infringement). Shopify should not be compelled to produce such information.

c. Shopify’s Policies Prior To The Limitations Period Are Not Relevant To Its DMCA Safe Harbor Defense

Plaintiffs’ alternative argument, that discovery concerning Shopify’s pre-limitations infringement policies, procedures, and practices, including all related “communications,” are relevant to determine the sufficiency of Shopify’s *within*-limitations policies, and thus Shopify’s *within*-limitations DMCA safe harbor defense, is similarly wrong. Dkt. 56 at 8-12.

search for and produce every communication related to that notification, even though the Merchant is not alleged to have infringed in this lawsuit. By contrast, under what Shopify has *agreed* to produce, if Plaintiffs accused an e-book merchant of infringement in early 2019, during the limitations period, and that merchant previously had been accused of infringement in 2017 and early 2018, Shopify would produce communications with that Merchant, as well as information sufficient to show the earlier flags or infringement strikes on the Merchant’s account, to the extent in Shopify’s possession, custody, or control.

The DMCA’s safe harbor shields Shopify from liability if it “*has adopted and reasonably implemented . . . a policy that provides for the termination in appropriate circumstances of subscribers and account holders . . . who are repeat infringers.*” 17 U.S.C. § 512(i)(1)(A) (emphasis added). By the statute’s plain language, the italicized participles refer to the then-present state of Shopify’s policies *at the time of each infringement*, not historical policies outside the limitations period. *See id.*; *cf. Henson v. Santander Consumer USA Inc.*, 137 S. Ct. 1718, 1722 (2017) (such participles are routinely used “as adjectives . . . to describe the present state of the nouns they modify”). In accordance with the statute’s plain text, policies from *outside* the limitations period have no relevance in determining whether Shopify’s existing repeat infringer policy, in place during the limitations period, qualifies for the safe harbor. Abundant case law confirms this. For instance, in *Rosen v. eBay, Inc. (Rosen II)*, the court granted summary judgment in a prior suit (“*Rosen I*”) on a DMCA defense, finding the defendant had adequately “adopted, implemented, and published a repeat infringer policy.” No. 16-9183, 2018 WL 4808513, at *5 (C.D. Cal. Apr. 4, 2018). But in a subsequent lawsuit, plaintiff argued—and the court agreed—that the proven adequacy of the defendant’s policies during the former period did not control the DMCA defense during the new, actionable “relevant time period.” *Id.* at *5-6.

So too here: the only relevant question is whether the policy in effect during the limitations period qualifies for the DMCA safe harbor or not. *Id.*; *see also UMG Recordings, Inc. v. Veoh Networks Inc.*, 665 F. Supp. 2d 1099, 1102-03, 1116-18 (C.D. Cal. 2009), *aff’d*, 718 F.3d 1006 (9th Cir. 2013) (finding defendant eligible for DMCA safe harbor by reviewing defendant’s “current Copyright Policy”). Shopify has already agreed through the meet-and-confer process to produce its policies and procedures, and communications concerning them, during the limitations period. Nothing further is warranted.

Plaintiffs’ contrary argument that courts “routinely permit pre-limitations period discovery” into such “policies” is mistaken. Plaintiffs rely on an unpublished three-page order on a motion *in limine* to exclude evidence at trial, *BMG Rts. Mgmt. (US) LLC et al. v. Cox Enters., Inc.*, No. 14-1611 (E.D. Va. Aug. 21, 2018), Dkt. 1018, for the proposition that a “court in this district rejected the same argument that Shopify makes here, and *held that emails from prior to the statute of limitations period* not only were discoverable but were admissible at trial” Dkt. 56 at 8-9 (emphasis added). To begin, such a three-page “unpublished order [is] of no precedential value.” *In re Braxton*, 258 F.3d 250, 259 n. 7 (4th Cir. 2001). Much more importantly, Plaintiffs’ recitation of the court’s “holding” on the “statute of limitations” is made up: Neither the court’s ruling, nor the briefing, mention the “statute of limitations” even once.⁸ Rather, the case involved the question of whether documents bearing on the infringement policies actually enforced with respect to Plaintiff’s allegations, some of which pre-dated Plaintiff’s notices of infringement, were admissible at trial. Order at 2, *BMG Rts. Mgmt.*, No. 1:14-cv-01611 (E.D. Va. Aug. 21, 2018), Dkt. 1018. The order thus in no way “holds” that discovery into pre-limitations policies should be routinely available. *See, e.g., United States v. L. A. Tucker Truck Lines, Inc.*, 344 U.S. 33, 38 (1952) (an issue that was not “raised in briefs or argument nor discussed in the opinion of the Court” is not precedential); *United States v. Bruguiere*, 735 F.3d 754, 762-63 (8th Cir. 2013) (it is “axiomatic” that implicit resolution of an issue that “was not argued or decided” provides “absolutely no support” for a legal position). The court was addressing a small number of

⁸ *BMG Rts. Mgmt. (US) LLC*, No. 1:14-cv-01611-LO-JFA (E.D. Va.) (Dkt. Nos. 936, 937: Defs.’ Mot. in Limine to Preclude Evid. & Test. as to Certain Internal Cox Emails & Commc’ns Concerning Cox’s Termination Policies & Treatment of Alleged Infringers; Mem. of Law in Supp. (July 20, 2018); Dkt. 974: BMG’s Opp’n (July 27, 2018); Dkt. 982: Defs.’ Reply Mem. (July 31, 2018); Dkt. 1018: Order (Aug. 21, 2018).

documents (less than two dozen), addressing the particular facts of that case—not *ex ante* authorizing a fishing expedition into *two years'* worth of additional document discovery.

Plaintiffs' citation to *UMG Recordings, Inc. v. Grande Communs. Networks, LLC*, No. A-17-CA-365-LY, 2018 WL 4627276, at *3 (W.D. Tex. Sep. 26, 2018), is similarly unhelpful. There, the court ruled that policies and “[i]nformation on how [defendant] handled DMCA issues prior to 2013 could be relevant” to the case. *Id.* But in briefing that motion, the plaintiffs contended that the limitations time period extended back to 2010 or “at least 2011.” Mot. to Compel at 4-5, *UMG Recordings, Inc.*, No. A-17-CA-365-LY (W.D. Tex. July 6, 2018), Dkt. 108, at 4-5 (citing Ex. L, Dkt. 108-12 at 1). So the court’s grant of discovery “prior to 2013” granted discovery *within* the alleged limitations period. *See id.* *UMG* is also unpersuasive, because the Texas district court’s reasoning, that pre-2013 discovery could be relevant to showing that defendant “was aware of infringing conduct on its system,” 2018 WL 4627276, at *3, is contrary to the Fourth Circuit’s binding “actual knowledge” standard articulated in *BMG*. *See BMG Rts. Mgmt.*, 881 F.3d at 311 (“generalized knowledge . . . that infringement was occurring somewhere on [a] network” does not support liability); *see also Viacom Int’l, Inc. v. YouTube, Inc.*, 676 F.3d 19, 31-32 (2d Cir. 2012) (adopting similar “actual knowledge” standard for DMCA safe harbor).

d. Pre-Limitations Discovery Is Not Relevant To Statutory Damages

Plaintiffs make the same mistake when they argue that scorched-earth discovery regarding Shopify’s entire history of infringement policies bears on Shopify’s “willfulness,” along with the “history of copyright infringement, the need for deterrence or rehabilitation, and misleading or false statements by the defendant.” Dkt. 56 at 5, 11. Under Circuit precedent, “willfulness” turns, again, on willful conduct as to the *specific, actionable infringements* in suit, *i.e.*, infringement of Plaintiffs’ copyrights by the Alleged Merchants during the limitations period. *See BMG Rts.*

Mgmt., 881 F.3d at 312. Indeed, the Fourth Circuit upheld a jury instruction that infringement is willful if defendant “had knowledge that its subscribers’ actions constituted infringement of [plaintiff’s] copyrights, acted with reckless disregard for the infringement of [plaintiff’s] copyrights, or was willfully blind to the infringement of [plaintiff’s] copyrights.” *Id.* at 312 n.7. (emphases added). And again, Shopify has agreed to produce broad discovery on the Alleged Merchants, including pre-limitations discovery with respect to communications with those Alleged Merchants and any warnings placed on their accounts. *Supra* at 3-5. But the law does not support Plaintiffs’ demand to fish through years’ of additional documents and communications.

The Fourth Circuit’s decision nearly thirty-year-old decision in *Superior Form Builders, Inc. v. Dan Chase Taxidermy Supply Co.*, 74 F.3d 488, 496 (4th Cir. 1996) does not merit a different result. There, the court affirmed jury instructions permitting the jury to consider, among other factors, “evidence that the defendants have a history of copyright infringement,” whether defendant is “impervious to either deterrence or rehabilitation,” “defendant’s knowledge of the copyright laws,” “misleading or false statements,” or other indicia that defendant “disregarded the fact that its conduct constituted . . . infringement.” 74 F.3d at 496. These generalized factors do not support broad fishing expeditions into material that otherwise bears no relevance to the case.

Indeed, more-recent case law following the Fourth Circuit’s decision in *BMG* has found, consistent with *BMG*, that the focus of the statutory damages inquiry is the defendant’s willfulness with respect to the actionable acts of infringement *within* the limitations period. For instance, in *ME2 Productions, Inc. v. Fox*, the Eastern District of Virginia identified the statutory damages factors as including “(1) whether the defendant was the original provider of the infringed content to its distribution network; (2) whether, and how much, the defendant profited or saved in connection with the infringement; (3) the plaintiff’s actual losses; (4) the deterrent effect of

statutory damages; and (5) the defendant's willfulness and intent *in infringing the plaintiff's protected content.*" No. 3:17-CV-00057, 2018 WL 1470251, at *2 (E.D. Va. Mar. 26, 2018) (emphasis added). That is, consistent with *BMG*, the statutory damages is not a roving inquiry into any and all instances of historical infringement anywhere on a provider's network. *See id.*; *see also ME2 Prods., Inc. v. Ahmed*, 289 F. Supp. 3d 760, 763 (W.D. Va. 2018) (similar).

Understandably then, damages discovery on infringement claims generally focuses on facts within the limitations period, not earlier. *See, e.g., Structured Asset Sales, LLC v. Sheeran*, 433 F. Supp. 3d 608, 612 (S.D.N.Y. 2020) (granting request for "documents reflecting revenues received or earned, and expenses incurred or paid . . . on or after June 28, 2015," *i.e.*, three years before the date of filing of the complaint); *Martinez v. McGraw*, No. 3:08-0738, 2012 WL 3987527, at *2–3 (M.D. Tenn. Sept. 11, 2012) (declining to compel documents, based on "three-year statute of limitations for copyright infringement," as "to the extent that plaintiff's request for production seeks information . . . that predated this period, such information is n[ot] relevant."). The jury can readily determine Shopify's "knowledge of the copyright laws," its statements, its knowledge of whether its conduct constituted contributory infringement, and all the rest of these factors by examining the extensive evidence Shopify is *already* producing. Plaintiffs do not need two years of further documents, related to legacy data processing systems and legacy processes, in order to put forward their evidence regarding statutory damages.

2. ***The Requested Pre-Limitations Production Would Be Unduly Burdensome and Disproportionate***

Even were the documents sought by Plaintiffs of some attenuated relevance to this case, that limited relevance would be outweighed by the burden of collecting, reviewing, and producing those materials. Such discovery is disproportionate, and should be denied.

Courts evaluate proportionality by considering "the amount in controversy," the

“importance” of the material sought, the parties’ “resources,” the parties’ “access” to materials, and “whether the burden or expense of the proposed discovery outweighs its likely benefit.” *Brink’s Co.*, 2021 WL 5083335, at *13-14. Proportionality concerns are at their apex where, as here, the “relevance argument on the [legal] issue is tenuous,” with the “relevance of the requested information hovering at the outer boundary of Rule 26.” *Id.* at 14. Courts consider the relevance of the material sought against the burden of production, including not just the “time and expense” of such a collection and production, but also the “cost of attorney review.” *Id.*

Shopify’s agreed productions, which Shopify has detailed above, encompass thousands of documents and will contain all the significant information Plaintiffs seek. By contrast, it would be unduly burdensome to produce almost two years of additional materials drawn from other repositories of information, for each of Plaintiffs’ discovery requests. Doing so would mean increasing by approximately 60 percent the temporal scope of Shopify’s document review, which presently stretches from December 2018 to March 2022, from just over 3 years to more than 5 years. This increase of roughly 60 percent in the temporal scope of Shopify’s review, and a concomitant increase in review volume—which already amounts to tens of thousands of documents—would stretch across not just one repository of information, but would stretch across multiple repositories, such as email, communications over the “Slack” application, and documents found on Shopify personnel’s devices. *See Gallant Decl.* ¶¶ 9, 12. And a 60 percent increase in temporal scope is likely to equate to more than 60 percent increase in burden: Both because legacy personnel and repositories of information in use over 3.5 years ago will be more difficult to locate, *Gallant Decl.* ¶¶ 11, 13-14, and sifting through such minimally relevant materials requires additional care, compared to reviewing core sets of clearly responsive and materials.

The undue burden of expanding Shopify’s review to encompass two additional years of

discovery would be particularly acute in this case, given that in October 2018, Shopify transitioned from its legacy system for tracking infringement notices, to Shopify’s current system for tracking infringement notices (including related communications). *See* Gallant Decl. ¶¶ 5, 13. Collecting documents concerning this pre-October 2018 legacy system would be particularly difficult, time consuming, and costly—especially as it relates to the creation and design of that legacy system, which was a third party system not created by Shopify, and was implemented prior to January 2017. *Id.* ¶ 13. Likewise, it would be time consuming and burdensome to collect and review related communications stored outside of this legacy system, in other repositories, from the Shopify team members who were involved during that historical time period. *See* Gallant Decl. ¶¶ 11-15. The burden of collecting, reviewing, and producing documents related to a legacy system and processes outside the limitations period is excessive and unnecessary.

Plaintiffs cannot demonstrate that such discovery is proportional. Given the asserted “relevance of the requested information hovering at the outer boundary of Rule 26,” an increase of approximately 60 percent in the temporal scope of Shopify’s review, as well as documents related to a legacy system and processes outside the actionable time period, would be unduly burdensome and disproportionate. *Brinks*, 2021 WL 5083335, at *13-14. Plaintiffs’ requests for an additional *two years* of pre-limitations discovery should be denied.

IV. CONCLUSION

For the foregoing reasons, the Court should enter an Order denying Plaintiffs’ Motion to Compel in its entirety.

Dated: April 22, 2022

/s/ David L. Johnson

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CERTIFICATE OF SERVICE

I hereby certify that on April 22, 2022, a true and correct copy of the foregoing was served using the Court's CM/ECF system, with electronic notification of such filing to all counsel of record.

/s/ David L. Johnson

David L. Johnson (VSB No. 89289)

**UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
ALEXANDRIA DIVISION**

**BEDFORD, FREEMAN & WORTH
PUBLISHING GROUP, LLC d/b/a
MACMILLAN LEARNING; MACMILLAN
HOLDINGS, LLC; CENGAGE LEARNING,
INC.; ELSEVIER INC.; ELSEVIER B.V.;
MCGRAW HILL LLC; and PEARSON
EDUCATION, INC.,**

Plaintiffs,

v.

SHOPIFY INC.,

Defendant.

Case No. 1:21-cv-01340

**DECLARATION OF MONICA GALLANT IN SUPPORT OF SHOPIFY INC.'S
OPPOSITION TO PLAINTIFFS' MOTION TO COMPEL**

I, Monica Gallant, declare as follows:

1. I am the Director of Trust & Safety for Shopify, Inc. ("Shopify"). I have held this position since March 2019. I served as a Director of Legal Operations for Shopify between April 2017 and March 2019, and as the Senior Manager for Legal Operations for Shopify between January 2017 and April 2017.

2. I submit this Declaration in support of Shopify's Opposition to Plaintiffs' Motion to Compel. I have personal knowledge of the facts set forth in this Declaration and, if called to testify as a witness, I could and would testify competently thereto.

3. Trust & Safety is responsible for receiving and taking action on notices sent by third parties alleging that Shopify merchants have made infringing content available on their third-party shops that make use of Shopify's services.

4. In my current and prior positions, I helped develop and implement Shopify's policies, practices, and procedures regarding alleged copyright and trademark infringement by third-party merchants. These policies, practices, and procedures include those used in processing notices of alleged copyright and trademark infringement. As part of my current and prior positions, I am also familiar with the other Shopify personnel who have historically been involved in developing and implementing Shopify's policies, practices, and procedures regarding alleged copyright and trademark infringement by third-party merchants.

5. Through my roles at Shopify, I have also had involvement in the creation and implementation of the ticketing system that Shopify uses to process the notices ("Monpliance"). This system has been in use since October 2018; prior to that, a different, legacy system was used.

6. I also currently oversee and supervise the personnel that receive, process, and review these infringement notices, and take actions on those tickets within the system, such as applying copyright "strikes," removing content from merchants' online interfaces, or terminating merchants from Shopify's platform.

The Current Infringement Tracking System

7. Shopify's current infringement notice tracking system, the Monpliance ticketing system, is unique to Shopify and was developed specifically for Shopify's Trust & Safety team, including but not limited to compliance with intellectual property obligations. For each intellectual property infringement notice it receives, Shopify creates tickets in Monpliance, regardless of the manner in which it receives the notice (*i.e.*, via email, or via Shopify's web-form). Shopify

receives and processes a substantial number of notices of alleged infringement. Shopify created approximately 179,889 tickets related to alleged infringement of copyrighted works or trademarks in the system from December 1, 2018 through March 1, 2022. I understand that these tickets are being reviewed and searched in connection with Shopify's discovery productions in this case.

8. The Monpliance system contains all actions that Shopify takes in response to a notice of infringement received. It includes copyright "strikes" made, warnings given, communications made with any merchant alleged to have engaged in infringement, and all other actions taken, including merchant account termination.

9. In addition to the Monpliance system, Shopify Trust & Safety personnel communicate by Slack and, less frequently, by email. I understand that Shopify has collected substantial Slack, email, and other documents for review in connection with this case, based on a date range from December 1, 2018 through March 1, 2022.

The Prior Infringement Tracking System(s)

10. Beginning prior to January 2017, and running through October 2018, Shopify used an entirely different system to track notices of infringement. This legacy system, Zendesk, tracked not only communications about alleged copyright and trademark infringement but also a broad set of communications to, from, or concerning merchants.

11. The Zendesk system, like the Monpliance system, would typically have recorded all communications with a merchant and notes of actions with respect to a given notice of infringement. However, Zendesk did not have the Trust & Safety-specific capabilities and reporting features. Obtaining data on all tickets created in Zendesk relating to infringement between January 1, 2017 and October 2018 (when Monpliance was adopted) would require substantial resources, time, and efforts.

12. In addition, then, as now, Shopify Trust & Safety team members sometimes used other methods to communicate with one another *about* a given notice of infringement; for example, through company Slack channels or email. To uncover any relevant materials that were not recorded in Zendesk, Shopify would likely need to collect and review substantial additional documents from Trust & Safety team personnel. To collect and review such documents covering an additional two year period (January 1, 2017 through December 1, 2018) would require substantial resources.

13. Since Zendesk, Shopify's legacy system for tracking alleged infringement notices, was only used at Shopify for that purpose up until October 2018, documents regarding ZenDesk itself would be particularly difficult, time consuming, and costly to obtain, particularly as it relates to the creation and design of Zendesk, which is a third party system not created by Shopify, and as the Zendesk system was implemented prior to January 1, 2017. Indeed, it is unclear whether documents concerning Trust & Safety work queues within the legacy Zendesk system still exist, given that process was sunset over 3.5 years ago. If such documents continue to exist, it would take considerable effort to locate and produce them.

14. Similarly, Shopify had policies, practices, and procedures during the Zendesk era, for processing notices of infringement. To evaluate these materials prior during 2017 and early and mid 2018, it would likely be necessary to review records, to the extent they still exist, drawn from individuals going back two additional years.

15. Taking the various steps outlined above to produce additional documents and records from the period between January 1, 2017 and December 1, 2018 would be substantially burdensome to the Trust & Safety team and to Shopify.

I declare under penalty of perjury under the laws of the United States of America pursuant to 28 U.S.C. § 1746 that the foregoing is true and correct.

I executed this Declaration on April 22, 2022 at Ottawa, Canada.

Monica Gallant
Monica Gallant

**UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
ALEXANDRIA DIVISION**

**BEDFORD, FREEMAN & WORTH
PUBLISHING GROUP, LLC d/b/a
MACMILLAN LEARNING; MACMILLAN
HOLDINGS, LLC; CENGAGE LEARNING,
INC.; ELSEVIER INC.; ELSEVIER B.V.;
MCGRAW HILL LLC; and PEARSON
EDUCATION, INC.,**

Plaintiffs,

v.

SHOPIFY INC.,

Defendant.

Case No. 1:21-cv-01340

**DECLARATION OF JESSICA STEBBINS BINA IN SUPPORT OF SHOPIFY
INC.'S OPPOSITION TO PLAINTIFFS' MOTION TO COMPEL**

I, Jessica Stebbins Bina, declare as follows:

1. I am an attorney duly licensed to practice law and I am partner at the law firm of Latham & Watkins LLP, counsel of record for Shopify, Inc. (“Shopify”) in this matter. I am admitted *pro hac vice* before this court, and I am familiar with the pleadings and records in this case.

2. I submit this Declaration in support of Shopify’s Opposition to Plaintiffs’ Motion to Compel. I have personal knowledge of the facts set forth in this Declaration and, if called to testify as a witness, I could and would testify competently thereto.

3. Prior to filing their motion to compel (“motion”), counsel for plaintiffs Bedford, Freeman & Worth Publishing Group, LLC d/b/a Macmillan Learning, Macmillan Holdings, LLC, Cengage Learning, Inc., Elsevier Inc., Elsevier B.V., McGraw Hill LLC, and Pearson Education,

Inc. (collectively “plaintiffs”) and I, along with several of my colleagues, met and conferred extensively about plaintiffs’ discovery requests, including the discovery requests that are the subject of plaintiffs’ motion. In total, the parties met and conferred for more than six and a half hours on April 8th, 11th, and 13th, and another hour on April 19th, 2022, to discuss both plaintiffs’ and Shopify’s discovery requests. Both during those meetings and in email correspondence thereafter, Shopify offered several compromises with respect to many of the discovery requests at issue in plaintiffs’ motion. Despite the fact that the parties were still conferring as to several of these requests as of April 15, 2022, plaintiffs filed their motion that day.

4. Plaintiffs’ motion challenges Shopify’s limitation of its responses to seven Requests for Production (RFPs 6, 11, 14, 20, 21, 25, and 30) and five Interrogatories (Rogs 1-3, 9, and 10) to the statute of limitations period, and Shopify’s limitation of three Requests for Production (RFPs 17, 20 and 21) and two Interrogatories (Rogs 9 and 10) to the 3,426 alleged infringements and the approximately 1,800 alleged infringing merchants (“Accused Merchants”) actually at issue in this suit. During the meet and conferral process, Shopify has already offered several compromises to plaintiffs with respect to these requests.

5. Specifically with respect to the discovery requests where plaintiffs allege Shopify limited the requests to the statute of limitations period, Shopify explained to plaintiffs in detail why it believes that pre-statute of limitations documents and communications are not relevant and would be unduly burdensome to produce. In an effort to compromise, Shopify is nevertheless willing to provide pre-statute of limitations information related to the Accused Merchants, for the period January 1, 2017 through December 1, 2018. Specifically, Shopify will provide all communications *with* the Accused Merchants during that time period, as well as any infringement-

related flags or warnings regarding the Accused Merchants, to the extent such documents and communications exist.

6. With respect to the discovery requests where plaintiffs allege Shopify limited its responses to the Accused Merchants, RFPs 20 & 21 and related Interrogatories 9 & 10 seek information about the number of “Infringement Notices” Shopify “received via email” and did not “process[,]” but instead “responded with an email informing the submitter” that the Infringement Notice was “not proper” because it was “submitted via email” or reported “multiple Shopify Merchants or multiple copyrights or trademarks.” During the meet and confer process, Shopify explained to plaintiffs several concerns with these requests, including that Shopify has actioned at least 179,889 tickets during the relevant statute of limitations period, and that the tickets do not contain information that would enable Shopify to ascertain this information without doing a manual search and review of the tickets. Shopify also expressed concern with producing tickets for non-Accused Merchants due to the presence of personal identifiable information (“PII”). Plaintiffs then clarified that they do not want the actual tickets responsive to these requests, but rather want summary data regarding the number of times the circumstances cited in their Requests took place. Based on these representations and after conferring extensively, in addition to producing more than 5,000 tickets associated with the Accused Merchants, which will contain a meaningful sample from which plaintiffs could explore this issue, Shopify also agreed to consider reasonable search terms based on an example provided by plaintiffs of the kinds of communications plaintiffs are targeting in these requests. Plaintiffs proposed search terms to Shopify on April 12, 2022. Shopify’s counsel responded on April 14, 2022 that Shopify was open this concept, explaining, “Shopify will discuss with the client the search term results, and if there

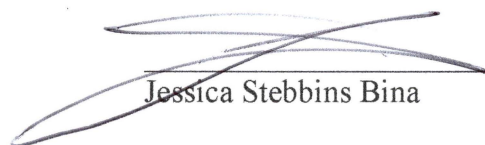
is a way to reasonably provide this information to plaintiffs that protects the confidentiality of non-accused merchants.” The next day, plaintiffs filed their motion.

7. Since then, Shopify has tested and adapted plaintiffs’ proposed search terms and identified search terms that are most likely to identify responsive documents, including identifying the exemplar provided by plaintiffs to Shopify. However, plaintiffs have told Shopify’s counsel that they did not consider it appropriate to confer regarding pending discovery motions because it would “alter the foundation” of the pending discovery motions. Shopify has nevertheless continued to move forward with the search terms and begun reviewing documents based on these search terms. Shopify intends to produce information responsive to RFPs 20 & 21 and Interrogatories 9 & 10 following this review.

8. With respect to RFP 17, this request seeks all documents regarding the reactivation of service for any Shopify Merchant whose services were terminated for violation of any policy relating to copyright or trademark infringement. Shopify stated in its written responses that it intends to produce relevant, non-privileged documents sufficient to show any actual reactivation of Shopify Merchants whose services Shopify terminated for violation of any policy related to copyright or trademark, not just Alleged Merchants. The parties thereafter never met and conferred about this request, and as Shopify has already agreed to produce responsive documents, Shopify believes there is no dispute as to this RFP.

I declare under penalty of perjury under the laws of the United States of America pursuant to 28 U.S.C. § 1746 that the foregoing is true and correct.

I executed this Declaration on April 22, 2022 at Los Angeles, California.


Jessica Stebbins Bina