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UNITED STATES DISTRICT COURT

CENTRAL DISTRICT OF CALIFORNIA

HALLE BERRY, an individual,

Plaintiff,

vs.

TOYWATCH S.p.A., an Italian corporation; TRIBOO DIGITALE USA, INC., a Delaware corporation; TRIBOO DIGITALE S.r.l., an Italian limited liability company; and DOES 1-30, inclusive,

Defendants.

Case No.: CV 13-05428 JAK (CWx)
Assigned for all purposes to the Hon. John A. Kronstadt, Ctrm. 750

JOINT LIST OF DISCOVERY DISPUTES

Conference: **June 26, 2014, at 2:00 p.m.**

Action Filed: May 30, 2013
Action Removed: July 26, 2013
Trial Date: Nov. 4, 2014

Defendants ToyWatch S.pA. ("ToyWatch"), Triboo Digitale USA and Triboo Digitale S.r.l (collectively "Triboo"), Cindy Capobianco, and We're With The Brand LLC, d/b/a Capobianco (collectively "Capobianco") (the defendants shall collectively be referred to as, "Defendants"), and Plaintiff Halle Berry ("Plaintiff"), hereby submit their Joint List of Discovery Disputes in advance of the conference scheduled to take place on Thursday, June 26, 2014, at 2:00 P.M., before the Honorable Carla M. Woehrle, in Courtroom 640 of the Roybal Federal Building.

INTRODUCTION

The following is a list of the discovery issues presently in dispute. The parties respectfully request the Court's assistance in resolving these issues.

ISSUES IN DISPUTE

I. DEPOSITIONS

1. Regarding The Number Of Depositions Defendants May Take:

Defendants: The issue is whether, with respect to Plaintiff's representatives,

the Court limited Defendants to taking only the depositions of two of Plaintiff's managers, one of Plaintiff's publicists, one of Plaintiff's stylists, and one of Plaintiff's personal assistants, or whether Defendants may also schedule depositions of Plaintiff's other representatives (if information is uncovered that such representatives have unique information that cannot be obtained from any other source).

Plaintiff: Plaintiff contends that this is a non-issue because Plaintiff has no other representatives who have any potentially relevant information.

2. Regarding The Timing Of Plaintiff's Deposition:

Defendants ToyWatch and Capobianco: During Mr. Wolman's deposition on June 18th, he testified to a number of instances in which the holder of percipient information would be plaintiff Halle Berry. It is expected as well that Ms. Berry may testify to information that defendants would, in the ordinary course, want to follow up on whether by deposition or written discovery. Given that Ms. Berry has not made herself available until ten days before the discovery cut-off, defendants request an agreement now from plaintiff's counsel that, if a showing is made to Magistrate Woerhle, following plaintiff's deposition, that additional discovery is necessary to adequately prepare a defense at trial, that plaintiff's counsel will not raise the discovery cutoff as a bar to that discovery.

The Triboo defendants: It is expected as well that Ms. Berry may testify to information as to which Defendants would, in the ordinary course, want to conduct discovery, whether by deposition or written discovery. Given that Ms. Berry has not made herself available until days before the discovery cutoff, Defendants request an agreement from Plaintiff's counsel that Plaintiff's counsel will not raise the discovery cutoff as a bar to that discovery, if a showing is made to Magistrate Woerhle that additional discovery is necessary to adequately prepare a defense at trial, following Plaintiff's deposition.

Plaintiff: Plaintiff disputes Defendants' characterization of Mr. Wolman's deposition testimony, and therefore disputes the need for the requested agreement. First, Mr. Wolman is Plaintiff's business manager. He has information relevant to Plaintiff's commercial endorsements. It is therefore not surprising that he would not have information concerning: (1) whether Plaintiff wears merchandise gifted to her before giving it away to charity; and (2) Plaintiff's understanding of the level of likelihood of her being photographed when outside her house. Second, those persons who are far more likely to have such information—Plaintiff's publicist and stylist/assistant—are currently scheduled to be deposed on June 24 and July 16, respectively. Fourth, the topics themselves are irrelevant and not reasonably calculated to lead to the discovery of admissible evidence, and thus should not be the basis for any extension of the discovery cutoff. Finally, Plaintiff contends that this issue was already addressed by the Court at the June 3 discovery conference and, as such, need not be revisited.

II. PLAINTIFF'S RESPONSES TO INTERROGATORIES AND DOCUMENT REQUESTS

1. Regarding Communications As To Agreements And Things Plaintiff Must Produce:

Defendants: At the June 3, 2014 hearing, this Court stated, "If there are any communications that constitute the agreements or reflect the kinds of agreements that we're talking about, those would need to be produced …." Transcript of the Discovery Conference at 65:24-66:2. This issue is whether Plaintiff must produce communications which relate to, regard, refer to, evidence, constitute, or reflect agreements and other things Plaintiff must produce; or whether Plaintiff must only produce communications which constitute agreements and things Plaintiff must produce.

It is necessary that Plaintiff produce communications that refer to the

agreements she was ordered to produce for many reasons. First, some trade-out agreements are likely to be oral agreements. Similarly, where Plaintiff received merchandise from someone connected to a marketing company, such transactions are likely to be evidenced only by written communications which make reference to them, that may not rise to the level of strict "agreements."

Further, certain documents that have been produced by Plaintiff in connection with the Court's order following the June 3, 2014 hearing are informal, incomplete, or otherwise in need of explanatory information. Mr. Wolman provided some information during his deposition, but referred to other individuals who might have additional information. Typically, this is why communications that relate to an agreement are typically required during the discovery process and the documents referred to hereinabove should not form the basis for any exception to that rule.

Plaintiff: Plaintiff contends that any correspondence beyond that which memorializes the formal terms of those agreements that this Court ordered produced is irrelevant and not reasonably calculated to lead to the discovery of admissible evidence. Since Defendants seek such agreements for the purpose of calculating damages, only the final, agreed-upon terms are relevant.

2. Regarding Charity Related Agreements:

Defendants: The issue is whether the Plaintiff must produce agreements where donations to charities were made in exchange for Plaintiff providing promotional, marketing, or advertising-related services.

Relatedly, Defendants believe that Plaintiff must not only produce agreements where Plaintiff provides promotional services to the brand offering the donation, but also those agreements where Plaintiff provides promotional services to the charity, since, as with the Michael Kors charity, Plaintiff may agree to support the "charity" of the entity making the donation rather than entity itself. However, in such situations, the entity clearly benefits from Plaintiff's endorsement

of the entity's charity.

Plaintiff: Plaintiff has produced, or will be producing, all agreements where a donation was made to a charity in exchange for Plaintiff providing promotional, marketing or advertising-related services to the company/brand making the charitable donation. In particular, Plaintiff has produced the Michael Kors agreement referred to by Defendants. Accordingly, there is no dispute requiring this Court's intervention.

3. Regarding Trade-Out Agreements:

Defendants: Whether a trade-out agreement is an agreement in which something of value was given to Plaintiff in exchange for promotional, marketing, or advertisement-related services, including the possibility that Plaintiff may be photographed using the thing of value.

Plaintiff: Plaintiff contends that any definition for the term "trade-out" agreement that includes the **possibility** that Plaintiff **might** use the merchandise is too vague and too broad. As Plaintiff has recently stated in interrogatory responses, Plaintiff often receives clothing and accessories from various designers. Such items are gifts. There is no understanding or obligation on the part of Plaintiff to ever wear any of those gifts; in fact, Plaintiff often does not wear them and instead donates them to charity. Plaintiff will agree to the Court's definition of "trade-out" agreements, as stated during the June 3, 2014, discovery conference—namely, "anything where there is an agreement that she wears it and she gets it or she wears it and she gets something else." Tr. at 52:25–53:1.

4. Regarding Clothing And Accessories Given To Plaintiff, For Which Plaintiff Did Not Pay Money:

Defendants: The issue is whether, per ToyWatch's discovery request, Plaintiff must produce documents and communications relating to, regarding, referring to, evidencing, reflecting, or constituting clothing or accessories which

she received, but for which she did not pay money. Defendants would consider limiting this to situations where things of value were given to Plaintiff by individuals whom she (or her agent accepting the thing of value) knew were connected to marketing, advertising, or promotional companies, or where Plaintiff was given something of value by someone other than a close friend or relative.

To prove that Defendants violated her right of publicity, Plaintiff must prove that her likeness was used without her consent. However, if Plaintiff has a history of accepting merchandise from individuals whom she knows are employed by marketing agencies, for example, it is likely that Plaintiff consented to the use of her image when she accepted the subject watch.

Plaintiff: Plaintiff contends this request is overbroad, irrelevant and not reasonably calculated to lead to the discovery of admissible evidence. Plaintiff has provided interrogatory responses explaining that she often receives clothing and accessories from various designers. Such items are gifts. There is no understanding or obligation on the part of Plaintiff to ever wear any of those gifts; in fact, Plaintiff often does not wear them and instead donates them to charity. Moreover, Defendants have served at least 15 subpoenas for the production of documents on this topic. All of the responses received by Defendants thus far confirm Plaintiff's interrogatory responses. Such items are gifts and no terms are attached to Plaintiff's receipt of any of these gifts. Plaintiff's acceptance or use of such gifts in no way constitutes Plaintiff's consent or authorization to the designer to use images of Plaintiff wearing the items in the designer's marketing, advertising or promotional materials. If Defendants contend otherwise, that is a legal argument they may attempt to make; no further discovery is necessary or appropriate.

5. Regarding Appearances:

Defendants: At the June 3, 2014 hearing, the Court stated that it would not order Plaintiff to produce "[a]ppearances unrelated to promotional issues or to

promotional deals." The issue is whether Plaintiff must produce documents and communications relating to, regarding, referring to, evidencing, or reflecting appearances she made which were connected to the promotion, marketing, or advertising of a product, service, or charity.

Plaintiff: Plaintiff has produced all agreements whereby Plaintiff, in exchange for something of value, made an appearance in connection with the promotion, marketing or advertising of a product, company or brand. Plaintiff has not produced documents concerning her appearances on behalf of charities, unless her appearance was in exchange for a company's, product's or brand's donation to a charity.

6. Regarding Documents, Including Tax Returns, As To Agreements And Things Plaintiff Must Produce:

Defendants ToyWatch and Capobianco: Whether Plaintiff has produced, or must produce documents, including tax information (in light of Mr. Wolman's deposition), which relate to, regard, refer to, evidence, constitute, or reflect agreements and other things Plaintiff must produce.

The Triboo Defendants: Plaintiff's agreement that it has already produced the relevant agreements and is now willing to produce the relevant 1099 tax information is sufficient for the Triboo defendants purposes at trial.

Plaintiff: Plaintiff has searched for and produced the following: (1) commercial endorsement agreements; (2) agreements whereby Plaintiff, in exchange for something of value, made an appearance in connection with the promotion, marketing or advertising of a product, company or brand; and (3) agreements where a donation was made to a charity in exchange for Plaintiff providing promotional, marketing or advertising-related services to the company/brand making the charitable donation.

Plaintiff has searched for trade-out agreements, as that term was defined by

the Court at the June 3 discovery conference (*i.e.*, "anything where there is an agreement that she wears it and she gets it or she wears it and she gets something else" (Tr. at 52:25–53:1)), and has not found any additional documents reflecting such agreements. Plaintiff served discovery responses explaining why there are no such agreements—namely, because the items are provided as gifts without any obligation on the part of Plaintiff to wear them, be photographed in them, or allow the giver to use Plaintiff's name and/or image for commercial purposes. Third parties' responses to Defendants' subpoenas confirm the foregoing arrangement.

Despite the fact that Defendants have never formally requested Plaintiff's 1099 tax forms, Plaintiff has agreed to search for and produce all 1099 forms (if any) reflecting Plaintiff's receipt of goods in exchange for her appearance or other services provided in connection with the promotion of a product, brand or awards show for the time period 2010 through the present.

No other documents are relevant or reasonably calculated to lead to the discovery of admissible evidence. This litigation is about Defendants' use of Plaintiff's name and multiple images of her on Defendants' commercial websites and social media sites. Defendants ToyWatch and Capobianco's eleventh-hour demand that Plaintiff further produce other unspecified "tax information" (potentially including privileged tax returns) is overbroad and beyond the scope of permissible discovery.

III. DEFENDANTS TOYWATCH AND CAPOBIANCO'S INCOMPLETE DISCOVERY RESPONSES

1. Regarding Whether Defendants ToyWatch and Capobianco May Withhold Documents TW000416–19 as Privileged

Plaintiff: On June 20, 2014, Defendants ToyWatch and Capobianco produced a privilege log, which asserts the work product and joint defense privileges over email correspondence between ToyWatch and Capobianco

representatives from October 4, 2012, through October 7, 2012. Plaintiff disputes that such communications are privileged. First, the above-captioned lawsuit was not filed until May 2013, more than six months **after** the withheld communications between ToyWatch and Capobianco. Thus, it is unclear how these two defendants could have been communicating pursuant to a joint defense agreement at that time. Second, the log does not reflect that any lawyers were copied on any of these communications. Indeed, there was no lawsuit pending at that time, so it is unclear how the communications could reflect any protected attorney work product. To the extent that these defendants anticipated potential litigation from Plaintiff, their action or inaction in response to that anticipation constitute operative facts that cannot be concealed by privilege claims.

Since *in camera* inspection may prove necessary, Plaintiff requests that all of the subject documents be brought to the June 26 conference.

Defendants ToyWatch and Capobianco: Plaintiff's point that the instant lawsuit was not filed until May 2013, is irrelevant. At the time the party prepared the document, "the attorney must at least have had a subjective belief that litigation was a real possibility, and that belief must have been objectively reasonable." *Equal Rights Ctr. v. Post Properties, Inc.*, 247 F.R.D. 208, 210 (D. D.C. 2008) (internal quotes omitted). Actual notice of a potential lawsuit is not required for a party to anticipate litigation for the purposes of work product. *See Florida. District Bd. of Trustees of Miami-Dade Community College v. Chao*, 739 So. 2d 105 (Fla. 1999) (accident report made by school guard in slip and fall case deemed in anticipation of litigation despite the fact it was made before specific claim was filed). Here, Toywatch was involved in a prior lawsuit involving actress Sandra Bullock at the time the documents were authored. The communication involved evaluation of that ongoing suit, as well as the objectively reasonable belief of litigation involving Halle Berry.

Relatedly, it is irrelevant that the log does not reflect that any lawyers were copied on any of these communications. The protection for documents prepared in anticipation of litigation is not limited to materials prepared by an attorney. It extends to materials prepared (1) by the party or (2) by any "representative" of the party, including the attorney, consultant, surety, indemnitor, insurer or agent. Fed. R. Civ. P. 26(b)(3)(A); *U.S v. Adlman*, 68 F.3d 1495, 1501-02 (2nd Cir. 1995) (finding auditor's memo protectable if prepared in anticipation of litigation with IRS over claimed tax loss); *In re Grand Jury Subpoena (Mark Torf/Torf Environmental Management)*, 357 F.3d at 909-10 (discussing documents created by investigator or consultant working for attorney). Here, documents were authored by parties and agents of parties to this litigation, bringing them under the work product umbrella. Additionally, an attorney was involved in the substance of the communication, even though he was not the author of the email rendering the communication opinion work product.

Defendants will present their arguments to the Court at the hearing.

2. Regarding ToyWatch's and Capobianco's Contention that They Have Produced All Non-Privileged Communications

Plaintiff: Plaintiff continues to believe that ToyWatch and Capobianco have not produced all non-privileged communications within ToyWatch, within Capobianco, between ToyWatch and Triboo, and between ToyWatch and Capobianco regarding the use of Plaintiff's name or image to promote Defendants' products. Plaintiff's suspicion is especially strong since Triboo's newly-retained counsel has produced certain Italian-language emails **between ToyWatch and Triboo**, which appear to relate to the use of Plaintiff's name and/or image to promote Defendants' products. It is unclear why ToyWatch has not produced at least those communications. ToyWatch's June 20, 2014, privilege log does not explain the absence of such communications from its document production.

Defendants ToyWatch and Capobianco: The subject document was already produced by Triboo. Defendants ToyWatch and Copabianco will produce all nonprileged communications.

3. Regarding Depositions of Defendants ToyWatch and Capobianco

Plaintiff: Counsel for ToyWatch and Capobianco previously communicated that ToyWatch would be available for a deposition on July 10, and that Capobianco's corporate designee would be available on July 8. The remaining depositions were scheduled based on that communication. ToyWatch and Capobianco are now trying to postpone those depositions to later in July, which will upset the schedule for all remaining depositions. Plaintiff asks the Court to require ToyWatch and Capobianco to appear for their depositions as previously scheduled.

Since Defendant Capobianco will be designating someone other than Defendant Cindy Capobianco as its corporate designee, Plaintiff will require an additional deposition of Cindy Capobianco on July 9 immediately following the July 8th deposition of the corporate designee. Plaintiff is willing to try to accommodate Defendants' request that the corporate designee and Ms. Capobianco be deposed on the same day, but cannot confirm that both depositions can be completed in one day. Plaintiff thus requests that Defendants confirm Ms. Capobianco's availability for deposition on July 9.

Defendants ToyWatch and Capobianco: As early as June 12, 2014, Defendants ToyWatch and the Capobianco defendants informed Plaintiff's counsel and Triboo's counsel that ToyWatch was presently available for depositions from July 7-25, 2014, and that the Capobianco defendants were presently available on June 30, July 1, 7-8, 25, and 28-31. Further, ToyWatch offered to extend the courtesy of flying from Italy to appear in Los Angeles for its deposition.

Plaintiff's counsel did not "schedule" these depositions until almost a week

later, on June 18, 2014. The Capobianco defendants and ToyWatch's depositions were **only tentatively** scheduled for July 8 and July 10, respectively. Counsel for ToyWatch and the Capobianco defendants told Plaintiff's counsel that these dates would need to be confirmed with ToyWatch and the Capobianco defendants, as it was almost a week since ToyWatch and the Capobianco defendants provided their dates of availability.

ToyWatch's expected 30(b)6 witness, Stefano Cassina, and the Capobianco defendants' availability has changed. Cindy Capobianco and Robert Rosenbeck, the expected 30(b)6 witness for the Capobianco defendants, are available on July 10, 11, 28, 29, 30, and 31. In addition, now that Plaintiff's have indicated they wish to mediate, ToyWatch would reasonably like to attend the mediation and deposition in one trip to Los Angeles. ToyWatch has indicated that it would make itself available on or about July 24 for this purpose (or possibly earlier, if Plaintiff produces the documents Defendants require before a meaningful mediation can be conducted).

These changes will not disrupt the deposition schedule, since the only change would be to move the Capobianco depositions (which can likely be completed in one day) from July 8 to July 10, and the ToyWatch deposition to approximately July 24, 2014. ToyWatch believes that if it is extending Plaintiff the courtesy of agreeing to travel from Italy to Los Angeles, it should not be forced to expend the time and expense of doing so twice.

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CONCLUSION

The parties respectfully seek the Court's assistance in resolving the foregoing issues in dispute.

DATED: June 25, 2014 LECLAIRRYAN, LLP

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