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14 **UNITED STATES DISTRICT COURT**  
15 **NORTHERN DISTRICT**  
16 **SAN JOSE DIVISION**

18 VIACOM INTERNATIONAL INC. et al.,  
19 Plaintiffs,  
20 v.  
21 YOUTUBE, INC. et al.,  
22 Defendants.

CASE NO. 08-MC-80211 JF (PVTx)

**YOUTUBE'S REPLY IN SUPPORT OF  
MOTION TO COMPEL PRODUCTION  
OF DOCUMENTS**

Date: December 9, 2008  
Time: 10:00 a.m.  
Courtroom: 5, 4th Floor  
Judge: Hon. Patricia V. Trumbull

1 **INTRODUCTION**

2 As the agent designated by a host of media companies, including Viacom, to search for  
3 and redress instances of alleged copyright infringement in the online world, BayTSP possesses a  
4 hoard of documents central to YouTube’s defense of high-stakes copyright cases pending in New  
5 York. BayTSP concedes as much by not contesting relevance when opposing YouTube’ motion  
6 to compel. Instead, BayTSP continues a campaign of misdirection and delay.

7 BayTSP abstractly claims burden, but does not provide any *evidence* that complying with  
8 YouTube’s subpoena would actually cause it burden. While its failure of proof ends  
9 consideration of the issue, BayTSP actually refutes its own position by revealing that it has  
10 already collected a large cache of materials and made it available to its principal, Viacom, for  
11 pre-production review. Merely supplementing the extant production beyond what BayTSP has  
12 done thus far (to correct oversights and omissions) could not possibly cause significant burden,  
13 and BayTSP does not show how it would. In any event, Viacom is undoubtedly indemnifying  
14 BayTSP. Accordingly, BayTSP could not sustain a burden showing even if it had put in  
15 evidence on the point.

16 BayTSP also claims that YouTube should have continued meeting and conferring despite  
17 eleven months of active engagement, despite BayTSP’s repeated broken promises of production,  
18 and despite the fact that YouTube is suffering severe prejudice as it is forced to proceed with  
19 depositions in the underlying cases without the evidence that BayTSP has withheld. Only after  
20 YouTube filed this motion did BayTSP again commit to a date on which it would begin  
21 producing materials. But even then it backtracked, insisting for the first time in its Opposition  
22 that YouTube’s access to the documents be subject to absurd restrictions (two computers at  
23 BayTSP’s counsel’s office instead of the customary electronic transmittal of information that all  
24 parties to the litigation have employed). Those restrictions: (a) have no basis in law; (b) would  
25 render an effective review impossible; and (c) almost certainly were not imposed on Viacom for  
26 its pre-screening of the documents. Far from suggesting a need for further discussions, the meet  
27 and confer history demonstrates that BayTSP will not make its documents available absent  
28

1 definitive Court direction. Accordingly, YouTube asks that the Court order BayTSP to comply  
2 fully with YouTube’s subpoena by December 30, 2008.

3 **ARGUMENT**

4 **A. YouTube’s Subpoena Seeks Relevant Information**

5 As we explained in our opening brief, YouTube’s subpoena seeks essential information  
6 related to Viacom’s infringement claims and YouTube’s defenses. *See* YouTube’s Motion to  
7 Compel (“YouTube’s MTC”) at 10-14. BayTSP does not dispute YouTube’s relevance showing,  
8 and its silence answers affirmatively the threshold question of whether the discovery YouTube  
9 seeks “is relevant to any party’s claim or defense.” Fed. R. Civ. P. 26(b)(1).

10 In the underlying case, Viacom asks the court to disregard the protections of the Digital  
11 Millennium Copyright Act (“DMCA”) because the alleged burden on copyright owners to  
12 monitor websites for alleged infringement is so great. *See* Baum Decl. Ex. C (Complaint ¶¶ 43-  
13 44). YouTube wants to refute Viacom’s burden claims, and there is no better source of  
14 information to do so than Viacom’s primary agent, BayTSP, to whom Viacom has contracted out  
15 its monitoring efforts. In addition, Viacom claims that an online service should be able to detect  
16 alleged infringement merely by looking at a user-submitted video clip. But YouTube will  
17 undermine that position by showing that even Viacom’s dedicated monitoring agent, BayTSP,  
18 cannot make such determinations on the fly, that it requires detailed instructions to perform the  
19 task at a rudimentary level, and that even with these instructions BayTSP often mistakenly  
20 identifies for removal content that plainly does not infringe the copyrights of its principal. These  
21 are not tangential points to the litigation but some of the most critical ones.

22 The documents that YouTube seeks are also relevant to its defenses. One of YouTube’s  
23 primary defenses is that it has complied fully with the notice and take-down regime of the  
24 DMCA. *See* 17 U.S.C. § 512(c). BayTSP is the party that Viacom has charged with identifying  
25 allegedly infringing material, sending take-down notices to YouTube under the DMCA and  
26 following up on those notices. Accordingly, it has stores of percipient information showing that  
27 YouTube removes material upon BayTSP’s request. Perhaps more telling will be the materials  
28 showing that Viacom knows that its content is on YouTube but, for promotional purposes, does

1 not ask BayTSP to remove it. Those documents will demonstrate Viacom’s acquiescence to its  
2 content appearing on YouTube and will further show that, given this acquiescence, an observer  
3 of any particular video clip on the YouTube service could not tell merely by looking at it  
4 whether it has been authorized by a content owner to appear on the service.

5 BayTSP recognizes its central role in the underlying action given its agency relationship  
6 with Viacom and its daily communications with YouTube, but nonetheless seeks to exclude at  
7 least two categories of documents from production: (1) documents regarding BayTSP’s  
8 interactions with third parties; and (2) documents regarding its proprietary software. *See*  
9 BayTSP’s Opp’n at 18. These proposed exclusions are unjustifiable.

10 BayTSP asserts, without elaboration, that “documents related to BayTSP’s clients other  
11 than the plaintiffs [are] wholly irrelevant.” *Id.* at 3:21-22. That *ipse dixit* runs contrary to the  
12 facts. BayTSP’s work with non-party content owners to identify material on YouTube and other  
13 websites is relevant for all of the reasons noted above and detailed in YouTube’s opening brief.  
14 These documents will also show that:

- 15 • content owners all over the world, not just Viacom and the other Plaintiffs, use YouTube  
16 to market their content while issuing elaborate instructions to BayTSP for the selective  
17 enforcement of their copyrights, further dispelling the notion that one can look at a video  
18 clip and make an authorization determination at a glance.
- 19 • YouTube’s industry-leading commitment to copyright protection far exceeds what any  
20 other online services have done. BayTSP wishes to limit the documents it produces to  
21 one narrow category – Plaintiffs’ enforcement efforts on YouTube. But that tunnel view  
22 prevents YouTube from showing the full picture of online copyright enforcement and  
23 YouTube’s place in it.
- 24 • copyright protection online is anything but standardized and that YouTube thus  
25 necessarily complies with Section 512(i) of the DMCA. *See* 17 U.S.C. § 512(i)(1)(B).  
26 (the DMCA requires a service provider to “accommodate[] and [] not interfere with  
27 standard technical measures” for copyright protection).
- 28 • the extra-judicial, rapid response option of the DMCA, and not the misguided litigation  
route selected by the Plaintiffs here, is the industry standard for copyright enforcement  
online.

25 For all of these reasons, BayTSP’s arbitrary attempt to carve out from production documents  
26 related to non-party clients must be rejected.

27 With regard to software, Viacom placed the effectiveness of BayTSP’s copyright  
28 monitoring system at issue by pleading that it “has a limited ability to monitor for infringing

1 videos and send takedown notices” and that it “cannot necessarily find all infringing videos.”  
2 Baum Decl. Ex. C (Complaint ¶¶ 43-44). YouTube must be allowed to evaluate the efficacy of  
3 BayTSP’s monitoring system in general to respond to Viacom’s characterizations of the system.  
4 Indeed, discovery about BayTSP’s software will likely reveal that the notice and take-down  
5 provisions of the DMCA provide ample protection to copyright owners. Documents regarding  
6 BayTSP’s software will also help YouTube prove the point that technical measures to protect  
7 content online have not been standardized. *See* 17 U.S.C. § 512(i)(1)(B). BayTSP’s contention  
8 that YouTube agreed not to seek documents related to BayTSP’s software badly misstates the  
9 record. YouTube was willing to forego the production of these documents in the first instance as  
10 a compromise to ensure the prompt production of other documents. *See* Baum Decl. Ex. J.  
11 When BayTSP dragged its feet and failed to produce any documents, YouTube was forced to file  
12 a motion to compel, and naturally did so for the full scope of its subpoena given the parties’  
13 inability to arrive at a negotiated resolution.

14 In short, YouTube’s subpoena seeks relevant materials and BayTSP’s Opposition does  
15 not seriously dispute the point.

16 **B. BayTSP Has Not Made a Burden Showing of Any Kind**

17 BayTSP cites law stating that courts may protect a third party from undue hardship  
18 occasioned by a subpoena. *See* BayTSP’s Opp’n at 12-14. Those authorities have no place here  
19 because BayTSP has not even tried to prove up any burden it would suffer by complying with  
20 YouTube’s subpoena. There is simply no evidence on the topic whatsoever. BayTSP’s failure  
21 to put in *any* competent evidence attempting to make a burden showing disposes of the issue.  
22 *See, e.g., A. Farber and Partners, Inc. v. Garber*, 234 F.R.D. 186, 188 (C.D. Cal. 2006) (“As an  
23 initial matter, general or boilerplate objections such as ‘overly burdensome and harassing’ are  
24 improper-especially when a party fails to submit any evidentiary declarations supporting such  
25 objections.”).

26 Regardless, BayTSP reports that it has collected and reviewed over one million  
27 documents and has deemed approximately 650,000 documents responsive to YouTube’s  
28 subpoena. *See* BayTSP’s Opp’n at 1-2, 11-12. Accordingly, BayTSP has already completed the

1 lion's share of the work; it can hardly complain that the incremental burden associated with full  
2 compliance with the subpoena would be prohibitive. Again, it has not even tried to prove that.  
3 Moreover, YouTube noted in its opening brief that "BayTSP almost certainly will be  
4 compensated by Viacom for its costs in responding to the subpoena." YouTube's MTC at 14.  
5 BayTSP does not dispute that point and notes that it has already provided Viacom with its  
6 proposed document production. *See* BayTSP's Opp'n at 2. The only conclusion to be drawn is  
7 that Viacom is in fact indemnifying BayTSP. Any burden claim therefore lacks merit.

8 BayTSP also invokes the apparition of third party confidentiality to continue withholding  
9 documents. It asserts, without explanation, that the requested materials describing third parties'  
10 use of YouTube and BayTSP are irrelevant. But as YouTube showed above and in its opening  
11 brief, such documents bear directly on the case. BayTSP's failure to respond to YouTube's  
12 relevance arguments speaks much louder than its conclusory assertion. Beyond that, BayTSP  
13 speculates, again without any evidentiary support, that its business might suffer if clients knew  
14 that BayTSP could be ordered to produce information relating to them.<sup>1</sup> But it will come as no  
15 surprise to BayTSP's clients that a business, particularly one as involved in litigation activities as  
16 BayTSP, faces discovery obligations. Far more relevant is the fact that in over a year since  
17 YouTube served its subpoena, no third party has come forward to assert an objection to the  
18 production of any information in BayTSP's possession. Regardless, the stringent Protective  
19 Order governing the underlying actions amply protects third party confidences. *See* Second  
20 Amended Stipulated Pre-Trial Protective Order (attached hereto as Exhibit A); *Malletier v.*  
21 *Dooney & Bourke, Inc.*, Case No. 04-Civ.5316 (RMB) (MHD), 2007 WL 187692, at \*1  
22 (S.D.N.Y. Jan. 22, 2007) ("concern about commercial sensitivity is belied by the availability of a  
23 mechanism under the governing protective order for a non-party to designate documents as  
24 confidential or even for attorney's eyes only."). Here, as in any context, confidentiality

25  
26 <sup>1</sup> BayTSP heaps absurdity upon that speculation, claiming that YouTube actually desires to  
27 deter others' use of BayTSP through enforcement of its subpoena. If YouTube had any such  
28 objective, which it does not, enforcement of a subpoena after a year-long meet and confer would  
hardly be a sensible method of achieving it.

1 requirements to third parties that BayTSP has voluntarily assumed must yield to YouTube's need  
2 for relevant information to defend itself.<sup>2</sup>

3 BayTSP next implies that YouTube's unwillingness to bless BayTSP's search term list  
4 creates a burden for it. See BayTSP's Opp'n at 15. Indeed, it actually claims that YouTube  
5 objects to the use of search terms at all. Both are nonsense. YouTube objected to BayTSP using  
6 search terms as the *exclusive* basis for finding responsive documents and objected to an unending  
7 negotiation related to the list holding up production. See Hemminger Decl. Ex. R (May 29, 2008  
8 letter from Baum to Ellinikos). At bottom though, only BayTSP possesses the intricate  
9 knowledge of its documents, systems and partners required to create an adequate list in the first  
10 instance. See, e.g., *U.S. v. O'Keefe*, 537 F. Supp. 2d 14, 23-24 (D.D.C. 2008) (“[w]hether search  
11 terms or ‘keywords’ will yield the information sought is a complicated question involving the  
12 interplay, at least, of the sciences of computer technology, statistics and linguistics.”). YouTube  
13 does not seek an order requiring BayTSP to use any particular search term list (much less an  
14 order precluding search terms at all), but an order requiring BayTSP to perform a reasonably  
15 diligent search in response to YouTube's document requests. That process will invariably  
16 include keyword searching as well as interviewing custodians and collecting relevant materials  
17 as a result.

18 The Court, however, should reject BayTSP's blanket assertion that its keyword list is  
19 “entirely appropriate” (BayTSP's Opp'n at 15:9). That position has no factual support; BayTSP  
20 has not provided the Court or YouTube with the list that it has employed. YouTube is especially

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21 <sup>2</sup> BayTSP also suggests that it would face undue burden in reviewing documents for  
22 privilege. See BayTSP's Opp'n at 16-17. It is not clear whether BayTSP's concern is for its  
23 own privilege or those of third parties. If its interest is in protecting its own privilege, BayTSP  
24 has already reviewed a substantial majority of the relevant documents for privilege. It should not  
25 be heard to claim undue burden based upon the marginal, additional effort required to review the  
26 documents YouTube actually sought (as opposed to those BayTSP unilaterally selected to  
27 produce). If BayTSP's concern relates to privileges held by third parties, it lacks standing to  
28 assert such privileges. See *Avago Technologies General IP Pte. Ltd. v. Elan Microelectronics  
Corp.*, 2007 WL 841785, \*2 (N.D. Cal. March 20, 2007) (“the attorney-client privilege is  
personal and can only be asserted by the holder of the privilege, which is the client.”). Put  
simply, BayTSP cannot rely on others' privileges to withhold materials responsive to YouTube's  
subpoena. PAUL R. RICE, ATTORNEY-CLIENT PRIVILEGE IN THE UNITED STATES (2d Ed. 1999)  
§ 11:1 (“Neither an attorney on his own behalf ... nor third parties who attempt to excuse their  
failure to produce information or communications in their possession or to suppress evidence  
possessed by others, may employ the privilege.”).

1 leery of BayTSP’s claims given the facial inadequacy of BayTSP’s first set of proposed search  
2 terms, which omitted, among many other obvious terms, “Google” and “YouTube” (see excerpts  
3 below):

4 101. GC  
5 102. Gladiator  
6 103. Global Film  
7 104. Golden UIP  
8 105. Grace Productions

9 232. XFire  
10 233. Yalian  
11 234. Z+  
12 235. Zarina  
13 236. Zoo Films

14 Hemminger Decl. Ex. O. Any search based on inadequate lists of search terms is almost certain  
15 to “fail[] to locate or perceive the significance of” responsive information. *Diabetes Centers of*  
16 *America, Inc. v. Healthpia America, Inc.*, 2008 WL 336382, \*2 (S.D. Tex. Feb. 2, 2008).  
17 Accordingly, the Court should order BayTSP to perform a reasonably diligent search as opposed  
18 to relying entirely on an undisclosed list of search terms.

19 **C. The Failed Negotiations Demonstrate Why an Order Compelling Production**  
20 **is Appropriate and Necessary**

21 There can be no dispute that YouTube adequately met and conferred prior to bringing the  
22 instant motion to compel. Indeed, YouTube served its subpoena in September 2007. Baum  
23 Decl. Ex. A. BayTSP originally responded with a series of boilerplate objections, without any  
24 commitment to produce a single document. Since that time, YouTube has repeatedly met and  
25 conferred with counsel for BayTSP in an effort to convince BayTSP to agree to produce the  
26 documents sought by the subpoena. *See* Baum Decl. Exs. J-N. In that extensive meet and confer  
27 process, BayTSP created a host of obstacles to production. At each turn, YouTube tried to  
28 accommodate BayTSP’s concerns – *on the express condition that such accommodations would*  
*be without prejudice to revisit any limitation and on the further express condition that documents*  
*be produced to YouTube on an expedited basis.* *See* Baum Decl. Ex. J (May 13, 2008 letter from  
Baum to Ellinikos) (“as we have previously agreed, [BayTSP’s expedited production] is without  
prejudice to further meet and confer after these documents are produced and have been reviewed,  
and if necessary, to a further subpoena seeking code.”).

After many months of back and forth, the parties engaged in a lengthy teleconference on  
May 12, 2008 to reach a final agreement on all outstanding issues. Baum Decl. Ex. J. (May 13,



1 2008 letter from Baum to Ellinikos). YouTube confirmed its understanding of BayTSP's  
2 commitments in a detailed letter the next day, setting forth, among other things, BayTSP's  
3 commitment to produce documents the week of May 26, 2008. *Id.* BayTSP responded the  
4 following day by merely saying that YouTube "failed to accurately reflect our discussions" but  
5 without detailing any specific disagreements or issues or setting forth an alternative date for  
6 production. Baum Decl. Ex. N. (May 14, 2008 letter from Ellinikos to Baum). When the week  
7 of May 26 came and went, it became clear that BayTSP's commitments were once again hollow.  
8 In response, YouTube requested one last meet and confer -- in person so there could be no  
9 misunderstandings -- to resolve outstanding issues, clearly stating that absent a definitive  
10 resolution YouTube would "be filing a motion to compel full compliance with the subpoena with  
11 the court." Hemminger Decl. Ex. T. (May 30, 2008 letter from Baum to Ellinikos). YouTube's  
12 letter also withdrew "[a]ll prior offers to narrow the scope of the subpoena in an effort to secure  
13 speedier compliance." *Id.* In response, BayTSP attempted to forestall the inevitable by again  
14 promising that the document production process was underway. Baum Decl. Ex. N. (June 10,  
15 2008 letter from Ellinikos to Baum) ("Hence, we will be better able to estimate when BayTSP  
16 can complete its document production after processing, *which we expect to be completed around*  
17 *the second week in July.*") (emphasis added). Thus, BayTSP was clearly on notice, as of May  
18 30th, that YouTube would be seeking judicial intervention, as the protracted meet and confer  
19 process had accomplished nothing except significant prejudice to YouTube. That prejudice has  
20 grown considerably since, given that YouTube has already deposed numerous Viacom witnesses  
21 without the benefit of documents from BayTSP and that many more depositions will take place  
22 in the coming months.

23 In August, to stave off motion practice again, BayTSP promised to "present [documents]  
24 [] for inspection in the next several weeks." Baum Decl. Ex. P (August 21, 2008 email from  
25 Hemminger to Baum). BayTSP then *broke its promise once more*. When "the next several  
26  
27  
28

1 weeks” turned into radio silence for *over two months*, YouTube was left with no option but to  
2 file the instant motion to compel.<sup>3</sup>

3 BayTSP’s opposition brief not only glosses over key points of this history, but  
4 affirmatively misstates it. It is false to claim, as BayTSP does, that YouTube ever accepted  
5 BayTSP’s unilateral limits on its production. Hemminger Decl. Ex. T (May 30, 2008 letter from  
6 Baum to Ellinikos). It is likewise false to claim that there was an agreement between that parties  
7 that led “YouTube [to] drop[] its threats of a motion to compel related to electronic searching in  
8 June, apparently satisfied with BayTSP’s efforts towards production of this sizable volume of  
9 documents.” BayTSP’s Opp’n at 14:23-26 (citing Baum Decl. Ex. N (June 9, 2008 letter from  
10 Baum to Ellinikos)). Indeed, in the very letter BayTSP cites for its fictional proposition,  
11 YouTube informed BayTSP that there was no such agreement and that:

12 we have carried on this way for nine months—when BayTSP takes what  
13 appears to be a hard-line refusal to produce, YouTube informs BayTSP  
14 that the position is unacceptable and that we are at an impasse, and Bay  
15 TSP then ‘clarifies’ that it did not mean what it said.

16 ***In the meantime, not a single document has been produced.***

17 *Id.* (emphasis in original).

18 Only by moving to enforce the subpoena did YouTube ostensibly make progress towards  
19 obtaining the information it has long sought. After YouTube filed this motion, BayTSP again  
20 promised a date certain on which its production would begin – this time, November 21, 2008.  
21 Hemminger Decl. Ex. V. But that promise also proved illusory. In its Opposition, BayTSP  
22 revealed that it did not truly intend to produce documents on that date. Instead, that was merely  
23 the date on which BayTSP would begin making available two computer terminals in its counsel’s  
24 office from which it expected YouTube to conduct a review of some 650,000 documents. *See*  
25 BayTSP’s Opp’n at 2:1-2, 18:5-10.

26 <sup>3</sup> It is difficult to imagine how BayTSP could legitimately have interpreted YouTube’s  
27 forbearance as an indication that “there were no outstanding issues” between the parties  
28 (BayTSP’s Opp’n at 12 n.2). YouTube had expressed, again and again, its dissatisfaction with  
BayTSP’s unilateral restrictions and its delayed production. But even if BayTSP truly believed  
the parties had an accord, such an accord would have required it to adhere to its promised  
production deadlines – something that it plainly did not do.

1 While YouTube first learned of these planned access restrictions in BayTSP's  
2 Opposition, they are reminiscent of the tactics BayTSP used during the parties' meet and confer  
3 to defer its document production indefinitely. Such restricted access is unworkable for a host of  
4 reasons and would impose massive cost, burden and delay on YouTube. Nowhere does BayTSP  
5 offer authority for these draconian restrictions, or even attempt to explain how they could be  
6 justified in the modern world of electronic discovery. BayTSP certainly did not review the  
7 documents under such conditions, nor did Viacom. And no party acting in good faith would  
8 make such a proposal.

9 This most recent episode reconfirms what YouTube said in its opening brief – absent this  
10 Court's intervention, Viacom's agent, BayTSP, will continue to deny YouTube information that  
11 is not only undisputedly relevant, but central to the litigation of Viacom's claims. BayTSP's  
12 delaying tactics have gone on long enough. It should be ordered to produce all documents  
13 responsive to YouTube's subpoena, in a manner designed to provide as easy access to them as  
14 that afforded to Viacom, by no later than December 30, 2008.

### 15 CONCLUSION

16 For the foregoing reasons, YouTube respectfully requests an Order compelling BayTSP  
17 to produce documents responsive to YouTube's subpoena and overruling BayTSP's objections.

18 November 25, 2008

Respectfully submitted,

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