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17 UNITED STATES DISTRICT COURT  
18 EASTERN DISTRICT OF CALIFORNIA

19 In the Matter Of a Petition By  
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21 INGENUITY13, LLC,  
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No. 2:11-mc-00084-JAM-DAD

**REPLY IN SUPPORT OF  
MOTION FOR RECONSIDERATION  
OF ORDER GRANTING  
INGENUITY13 LLC'S PETITION TO  
PERPETUATE TESTIMONY**

[Fed. R. Civ. P. 27(a) Proceeding]

[Reconsideration Respectfully Requested  
Pursuant to Local Rule 303]

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**STATUTES**

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1 **I. INTRODUCTION**

2 The Internet Service Providers’ opening brief explained that Ingenuity’s Petition suffers  
3 from multiple fatal defects, including disregard for (1) Rule 27(a)(1)’s requirement that Ingenuity  
4 must show that it “cannot presently bring” a copyright infringement action; (2) a long line of  
5 decisions explaining that Rule 27 is intended only to “perpetuate” —i.e., to preserve, not  
6 discover—information *already known to Petitioner*; and (3) Rule 27(a)(2)’s mandatory  
7 requirements for service on the Internet subscribers, a hearing, and court-appointed counsel for all  
8 subscribers not served “in the manner provided in Rule 4.”

9 Ingenuity’s opposition has no real answer to Rule 27’s plain language or the cited case  
10 law. It argues that the Doe defendant procedures and safeguards built into standard civil litigation  
11 should simply be disregarded in the analysis of whether Ingenuity has established it “cannot  
12 presently bring” a lawsuit—apparently because several district courts in California now recognize  
13 that standard civil actions seeking to obtain Internet subscribers’ information en masse are fraught  
14 with potentials for abuse and do not comply with the Federal Rules.

15 The opposition attempts to downplay rulings by an overwhelming majority of courts that  
16 have explained persuasively that Rule 27(a) is to be used only where the petitioner already knows  
17 the substance of the testimony to be perpetuated—and not as a device to identify potential  
18 defendants. In their place, Ingenuity urges the Court to rely on two unpublished decisions (also  
19 cited in the proposed order), which the ISPs’ opening brief explained are unpersuasive.

20 Additional reasons exist for denying the Petition—including Rule 27(a)(2)’s unambiguous  
21 requirements that Ingenuity “must” serve all expected adverse parties before a hearing on the  
22 Petition, and that court-appointed counsel “must” be provided for any subscribers who are not  
23 served with the Petition in the manner provided in Rule 4.

24 At bottom, Ingenuity’s Petition seeks to make an end-run around important protections for  
25 ISPs and their subscribers by doing through a “miscellaneous” action what the Federal Rules do  
26 not permit in standard civil cases. For all the reasons stated in the ISPs’ opening brief, and  
27 explained further herein, Ingenuity’s Petition should be denied.  
28

1 **II. THE INTERNET SERVICE PROVIDERS HAVE STANDING TO SEEK**  
2 **RECONSIDERATION OF AN ORDER THAT WOULD IMPOSE**  
3 **AFFIRMATIVE OBLIGATIONS UPON THEM AND GRANT INGENUITY**  
4 **LEAVE TO TAKE DISCOVERY OF THE ISPs—WITHOUT FILING A**  
5 **LAWSUIT OR COMPLYING WITH STANDARD “DOE” PROCEDURES.**

6 Ingenuity’s threshold argument that the ISPs lack standing to file their motion should be  
7 swiftly rejected. (Opp. at 3-4.) Ingenuity’s proposed order seeks to impose affirmative  
8 obligations upon the ISPs (including a data-preservation requirement that would constitute  
9 preliminary injunctive relief) and its sole objective is to authorize discovery *of the ISPs*. In this  
10 context, the ISPs necessarily have standing to object. *See, e.g., Brown v. Bd. of Bar Examiners*,  
11 623 F.2d 605, 608 (9th Cir. 1980) (non-parties have standing to appeal injunctions that bind  
12 them); *Gilchrist v. GE Capital Corp.*, 262 F.3d 295, 300 (4th Cir. 2001) (“nonparties have a right  
13 to challenge on appeal an order directed against them in a proceeding to which they were not a  
14 party”; citing *SEC v. Lincoln Thrift Assn.*, 577 F.2d 600, 603 (9th Cir. 1978)).

15 Ingenuity’s cited cases address standing principles generally—but have nothing to do with  
16 Rule 27 petitions or orders that impose obligations on non-parties. (Opp. at 3 citing *Lujan v.*  
17 *Defenders of Wildlife*, 504 U.S. 555, 560 (1992) [addressing general standing rules for plaintiffs  
18 in declaratory relief actions]; *Spencer v. Kemna*, 523 U.S. 1, 11 (1998) [addressing standing of  
19 prisoner-plaintiff who had completed his term of incarceration].) Indeed, abundant authority  
20 cited in the ISPs’ opening brief confirms that non-parties who are the targets of discovery in a  
21 Rule 27 proceeding have standing to oppose the petition. *See, e.g., Nevada v. O’Leary*, 63 F.3d  
22 932, 934 (9th Cir. 1995) (government responded to Rule 27 petition on behalf of non-party U.S.  
23 Department of Energy employees, whose testimony petitioner State of Nevada sought);  
24 *In re I-35w Bridge Collapse Site Inspection*, 243 F.R.D. 349, 350 (D. Minn. 2007) (considering  
25 objections to Rule 27 petition by target of discovery and denying petition on grounds that Rule 27  
26 is not a substitute for discovery); *In re Application of Checkosky*, 142 F.R.D. 4, 5 (D.D.C. 1992)  
27 (granting motion to dismiss Rule 27 petition by target of discovery—there, the SEC).  
28

1 **III. INGENUITY’S PETITION DOES NOT COMPLY WITH FEDERAL RULE OF**  
2 **CIVIL PROCEDURE 27 AND SHOULD HAVE BEEN DENIED.**

3 **A. Ingenuity Has Not Satisfied Its Burden to Show That It Is Unable to Bring**  
4 **a Lawsuit Using Proper Doe Defendant Pleading.**

5 Ingenuity now acknowledges Rule 27’s requirement that Petitioner must show it “cannot  
6 presently bring [an action] or cause it to be brought.” Fed. R. Civ. P. 27(a)(1). Its sole response  
7 is that “it does not know the infringers’ identities.” (Opp. at 5.) That is no answer. As the  
8 opening brief explained, that is what standard Doe defendant procedures are for. *E.g., Merritt v.*  
9 *Cty. of Los Angeles*, 875 F.2d 765, 768 (9th Cir. 1989) (approving use of single Doe procedures).

10 The reason Ingenuity does not want to use standard Doe defendant pleading is plain:  
11 Courts are increasingly cognizant of this plaintiff’s counsel’s abuse of Doe complaints, and have  
12 required plaintiffs in similar situations to follow proper rules for joinder—and not to seek  
13 (as here) discovery of a large number of accused infringers in a single action. (*See* ISPs’ Mtn.  
14 at 2 & Attachment A.) Recent rulings have addressed the “logistical nightmare” presented by  
15 mass copyright actions filed by Ingenuity’s current counsel, and explained:

16 [T]he court shares the concern that these cases potentially open  
17 the door to abusive settlement tactics. . . . Nothing currently  
18 prevents Plaintiff from sending a settlement demand to the  
19 individual that the ISP identifies as the IP subscriber. That  
20 individual—whether guilty of copyright infringement or not—  
21 would then have to decide whether to pay money to retain legal  
22 assistance to fight the claim that he or she illegally downloaded  
23 sexually explicit materials, or pay the money demanded. This  
24 creates great potential for a coercive and unjust “settlement.”

25 *Hard Drive Prods. v. Does*, 2011 U.S. Dist. LEXIS 132449, at \*9 (N.D. Cal. Nov. 16, 2011)  
26 (dismissing Does 2-130 and imposing ongoing obligations upon plaintiff and its counsel to  
27 demonstrate that the discovery sought of Doe 1 is used for a proper purpose).<sup>1</sup>

28 <sup>1</sup> *See also* cases cited at footnote 1 of opening brief and *Hard Drive Prods. v. Does 1-84*,  
2011 U.S. Dist. LEXIS 135565, at \*3 (N.D. Cal. Nov. 23, 2011) (explaining that, after the court  
“learned of a host of similar lawsuits pending in this district . . . the court now agrees with the  
view and reasoning of many other courts, including in this district, that plaintiff has not  
sufficiently established that joinder” of multiple accused copyright infringers is appropriate);  
*On the Cheap, LLC v. Does 1-5011*, 2011 U.S. Dist. LEXIS 99831, at \*16-17 & n. 6 (N.D. Cal.  
Sept. 6, 2011) (disapproving use of mass actions and noting abusive settlement tactics).



1           Ingenuity seeks to do here what courts have refused to permit plaintiffs in similar  
2 situations to do even after filing a complaint and pursuing discovery under the Court’s ongoing  
3 supervision: Petitioner wants information en masse about the ISPs’ subscribers. (Pet. ¶¶ 3-4.)

4           Ingenuity attempts to distinguish a subset of the ISPs’ cited cases on their facts (Opp. at 6-  
5 7), but it does not refute the legal principle: A petitioner must show that it cannot presently bring  
6 a lawsuit, and the *inability to identify a defendant by name is no excuse*. See, e.g., *Wilkins v.*  
7 *County of Alameda*, 2011 U.S. Dist. LEXIS 24642, \*2-3 (N.D. Cal. Feb. 25, 2011) (denying  
8 petition seeking information to “name proper defendants” because “Rule 27 is inappropriate in  
9 this situation where it appears that Plaintiff is seeking discovery of unknown information, in the  
10 hopes that it will assist him in obtaining judicial relief in the future”); *In re Ford*, 170 F.R.D. 504,  
11 507 (M.D. Ala. 1997) (“Ford simply wants to know who shot Roberts and why. Rule 27 simply  
12 does not provide for such discovery.”); *In re Ramirez*, 241 F.R.D. 595, 596 (W.D. Tex. 2006)  
13 (denying Rule 27 petition that sought to identify police officers who were potential defendants);  
14 *In re Landry-Bell*, 232 F.R.D. 266, 267 (W.D. La. 2005) (denying Rule 27 petition that sought to  
15 identify person who posted photos on adult website); *In re Vioxx Prods. Liab. Litig.*, 2008 U.S.  
16 Dist. LEXIS 36744, at 10-11 (E.D. La. May 6, 2008) (using Rule 27 to obtain “basic identifying  
17 information” of Vioxx class members to pursue potential future claims against them held to be a  
18 misuse of Rule 27).

19           The two cases cited by Ingenuity for support are uninformative: First, *GWA, LLC v. Cox*  
20 *Communs., Inc.*, 2010 WL 1957864 (D. Conn. May 17, 2010), appears to be a form order issued  
21 without any appearance by the ISP; it permitted discovery of only a single account-holder’s data  
22 and did not address the point that Rule 27 applies to “known testimony” only. It is axiomatic that  
23 cases are not authority for propositions not considered. *Haire v. United States*, 869 F.2d 531, 533  
24 (9th Cir. 1989). Second, *General Bd. of Global Ministries v. Cablevision Lightpath, Inc.*, 2006  
25 WL 3479332 (E.D.N.Y. Nov. 30, 2006), also involved a request to identify a single account-  
26 holder. This order, issued by a Magistrate Judge in New York, does not cite or discuss the long  
27 line of authority that, relying on the Ninth Circuit’s decision in *O’Leary*, 63 F.3d 932 and on *Ash*  
28 *v. Cort*, 512 F.2d 909 (3d Cir. 1975), has held that Rule 27 is “not a substitute for discovery,” nor

1 does the *Global Ministries* order address the mandatory requirements of Rule 27(a)(2).

2 *Global Ministries* is simply not persuasive or in sync with “[t]he overwhelming weight of  
3 authority” that holds that Rule 27 is not to be used to identify potential defendants.

4 *In re Vratoric*, 2009 U.S. Dist. LEXIS 98703, at \*4 (W.D. Pa. Oct. 23, 2009).

5 In sum, Ingenuity’s inability to show that it “cannot presently bring” a single-defendant  
6 Doe lawsuit and then seek discovery under the Court’s ongoing supervision is fatal to its Petition.

7 **B. Ingenuity Has No Real Response to the Authority Holding That Rule 27**  
8 **Is Intended Only to “Perpetuate” *Known* Testimony, Not to Discover**  
9 **Information Currently Unknown to Petitioner.**

10 The ISPs’ motion cited 11 decisions that conclude correctly that for Rule 27 to apply, the  
11 information Petitioner seeks to preserve must already be known *to the Petitioner*. (Mtn. at 9-10.)  
12 Ingenuity has no real response—it simply reasserts that it is seeking “the name[s], address[es],  
13 telephone number[s], email address[es] and Media Control Access number[s]” for 38 subscriber,  
14 whose identities Ingenuity seeks to *learn* (not merely “perpetuate”) in discovery. (Opp. at 7.)

15 Again, recent authority makes clear: “[T]he Petitioner must know *the substance of the*  
16 *testimony to be preserved before it can call for a Rule 27 deposition.*” *In re Yamaha Motor*  
17 *Corp.*, 251 F.R.D. 97, 100 (N.D.N.Y. 2008) (emphasis added; citing supporting authority)?

18 Here, “the substance” (if any) of the discovery sought is the names and other identifying  
19 information of the ISPs’ subscribers, which Ingenuity admittedly does not know.

20 Contrary to Ingenuity’s argument, *Martin v. Reynolds Metals Corp.*, 297 F.2d 49  
21 (9th Cir. 1961), does not support Petitioner’s proposed use of Rule 27 to obtain the subscribers’  
22 personal identifying information to pursue potential copyright infringement claims against them.  
23 (Opp. at 7-8.) *Martin* permitted discovery to be taken by a putative *defendant*—on the ground  
24 that physical evidence from a neighbor’s property was required to be preserved because the

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25 <sup>2</sup> See also *O’Leary*, 63 F.3d at 933 (“Rule 27 is not appropriate where . . . the petitioner  
26 seeks discovery of unknown information that the petitioner hopes will assist it in the future when  
27 the petitioner applies for judicial relief.”); *Landry-Bell*, 232 F.R.D. at 267; *Ford*, 170 F.R.D.  
28 at 507; *Vratoric*, 2009 U.S. Dist. LEXIS 98703, at \*4; *Wilkins*, 2011 U.S. Dist. LEXIS 24642,  
at \*2-3; *Vioxx Prods. Litig.*, 2008 U.S. Dist. LEXIS 36744, at \*10-11; *Briscoe v. Winslow Twp.*,  
2010 U.S. Dist. LEXIS 86248, at \*14-15 (D.N.J. Aug. 23, 2010).

1 neighbor had threatened suit against the petitioner for contaminating his adjacent land.<sup>3</sup> It does  
2 not appear that either side raised the requirement of perpetuating “known” testimony—articulated  
3 primarily in post-1961 case law—and *Martin* does not address it.

4 Accordingly, Ingenuity’s Petition should be denied for the additional reason that Rule 27  
5 is not intended to permit putative plaintiffs to discover information unknown to them.

6 **C. The Requirements for Proper Service Upon All Expected Adverse**  
7 **Parties—or Court-Appointed Counsel to Represent Them—Are**  
8 **Mandatory and Render Ingenuity’s Petition Fatally Defective.**

9 Rule 27(a)(2)’s requirements are unambiguous:

10 *At least 21 days before the hearing date, the petitioner must serve*  
11 *each expected adverse party with a copy of the petition and a*  
12 *notice stating the time and place of the hearing . . . . If that service*  
13 *cannot be made with reasonable diligence on an expected adverse*  
14 *party, the court may order service by publication or otherwise.*  
15 *The court must appoint an attorney to represent persons not served*  
16 *in the manner provided in Rule 4 and to cross-examine the*  
17 *deponent if an unserved person is not otherwise represented.*

18 Fed. R. Civ. P. 27(a)(2) (emphasis added).

19 The requirement for service upon all expected adverse parties (here, the account-holders)  
20 is mandatory, as is the requirement for a hearing at least 21 days after service on the account-  
21 holders—if the Court is considering granting the Petition. *Hewitt v. Helms*, 459 U.S. 460, 471  
22 (1983) (“must” is “language of an unmistakably mandatory character”); *In re Landry*, 232 F.R.D.  
23 at 267 (denying Rule 27 petition for failure to properly serve expected adverse parties).<sup>4</sup>

24 <sup>3</sup> Putative defendants do not, a fortiori, use Rule 27 to obtain information for a complaint,  
25 and thus satisfy the rule’s requirement that petitioner “cannot presently bring” an action.

26 <sup>4</sup> See also *In re I-35W Bridge Collapse*, 243 F.R.D. at 353 (“[a] court must hold a hearing  
27 on a Rule 27 petition”). As Ingenuity notes (Opp. at 13), a few cases have stated in dicta that  
28 courts might be sympathetic to requests to modify the 21-day notice period, including, e.g., where  
a witness is terminally ill; others hold that Rule 27 provides no flexibility to modify the statutory  
notice period. *In re Petition of Jacobs*, 110 F.R.D. 422, 424 (N.D. Ind. 1986) (“The court does  
not understand Rule 27(a)(2) to empower the court to dispense with the requirement that the  
movant attempt to afford the adverse parties with twenty days’ notice.”).

1           Ingenuity ignores Rule 27’s plain language in arguing, without citation to authority, that  
2 “court-appointed counsel is necessary only when the potential adverse parties are not given any  
3 notice of the petition.” (Opp. at 13:27-28.) Not so. “The court *must* appoint an attorney to  
4 represent persons not served in *the manner provided in Rule 4*,” which of course has not  
5 happened here. Fed. R. Civ. P. 27(a)(2). Courts apply Rule 27(a)(2) as it is written: “Service  
6 must be made in accordance with Rule 4 of the Federal Rules of Civil Procedure.” *Cole v. Bank*  
7 *of Am., LLC*, 2011 U.S. Dist. LEXIS 100921, at \*3 (C.D. Cal. Sept. 7, 2011) (citing Rule 27(a)(2)  
8 and denying petition for failure to comply with rule’s procedural and substantive requirements).

9           Given the recent proliferation of mass copyright actions involving sexually explicit films,  
10 the practical effects of interpreting Rule 27 to permit pre-suit discovery to identify potential  
11 defendants would include requiring courts (or petitioners) to find appointed counsel for tens of  
12 thousands of Does—all before any lawsuit is filed and based on nothing more than the  
13 petitioners’ professed intent to “investigate potential claims” against Internet subscribers.  
14 This fact underscores that Rule 27 is not a vehicle for identifying potential defendants.

15           Accordingly, Ingenuity’s failure to satisfy the mandatory requirements of Rule 27(a)(2)  
16 provides another compelling reason to deny the Petition.

17           **D.     Ingenuity Also Has Not Satisfied the Final Required Element: Showing**  
18           **That Denial of the Petition May Cause a “Failure or Delay of Justice.”**

19           Because Ingenuity has not demonstrated that all other substantive and procedural  
20 requirements for “perpetuating testimony” under Rule 27 are satisfied, the Court need not  
21 consider the additional element of whether Ingenuity has established that “perpetuating the  
22 testimony may prevent a failure or delay of justice.” Fed. R. Civ. P. 27(a)(3); *see I-35W Bridge*  
23 *Collapse*, 243 F.R.D. at 352 (“a Rule 27 petition must meet both the procedural requirements of  
24 Rule 27(a)(1) and ‘the substantive standard set forth in Rule 27(a)(3)’”).

25           Even if, arguendo, Ingenuity had established all other elements for Rule 27 to apply, the  
26 Petition fails because denying it would not risk a failure of justice. First, Ingenuity can follow  
27 standard Doe procedures and pursue any claims that have merit by adhering to the requirements  
28 in civil actions summarized in Attachment A hereto. Second, the procedural safeguards built into

1 standard civil litigation—but absent in a “miscellaneous” Rule 27 proceeding—are intended to  
2 prevent failures of justice, including those caused by the misuse of subscribers’ personal  
3 identifying information for coercing unjust settlements outside the context of a pending lawsuit.

4 In this regard, Ingenuity’s discussion of First Amendment principles misses the point:  
5 Given the prevalence of shared (and unsecured) Internet connections in ISP subscribers’ homes, a  
6 court’s ongoing supervision in a traditional civil action is warranted to avoid shakedown tactics  
7 involving “not only those who allegedly committed copyright infringement—proper defendants  
8 to Plaintiff’s claims—but [innocent] ISP ‘Subscriber[s]’ over whose internet connection the Work  
9 allegedly was downloaded.” *Hard Drive Prods.*, 2011 U.S. Dist. LEXIS 132449, at \*6-7;  
10 *see also London-Sire Records, Inc. v. Doe 1*, 542 F. Supp. 2d 153, 178-79 (D. Mass. 2008)  
11 (explaining the need for the court’s ongoing supervision and need “for a pragmatic solution that  
12 carefully respects the anonymity of potentially innocent parties” whose Internet connections were  
13 used without authorization); *Digital Sin, Inc. v. Does 1-5698*, 2011 U.S. Dist. LEXIS 128033, at  
14 \*10 (N.D. Cal. Nov. 4, 2011) (“Here, as has been discussed by other courts in this district, the ISP  
15 subscribers may not be the individuals who infringed upon Digital Sin’s copyright.”).

16 **IV. CONCLUSION**

17 The ISPs respectfully urge reconsideration of the proposed Order submitted by Ingenuity.  
18 Given the recent filing of copycat Rule 27 petitions in other courts, a published decision  
19 addressing the proper scope of Rule 27 petitions in this context may be appropriate.

20 Dated: December 29, 2011

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21  
22  
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ATTACHMENT A

Standard “Doe” Pleading and Civil Practice

Ingenuity’s Proposed Use of Rule 27

Rule 11 requires a proper pre-filing investigation before filing a complaint.

Ingenuity may never file a lawsuit.

Plaintiff must file its lawsuit.

N/A

Plaintiff has the burden to show that joinder of multiple alleged infringers in the same lawsuit is proper. *See, e.g., Digital Sin, Inc. v. Does*, 2011 U.S. Dist. LEXIS 128033, at \*7-8 (N.D. Cal. Nov. 4, 2011) (addressing similar copyright case against multiple Doe defendants).

Rule 20’s rules for joinder apparently do not apply.

All known defendants must be served with the summons and complaint, and all other papers.

N/A. (Ingenuity expects the non-party ISPs to give notice to their account-holders *after* subpoenas have issued.)

Plaintiff must file a Rule 26 report addressing its proposed discovery and pre-trial plans, etc.

No Rule 26 report is required.

The Court will set a scheduling conference at which time it will have an opportunity to inquire about the parties’ claims and defenses, service issues, and anticipated discovery issues.

No scheduling conference is held.

No discovery is permitted until after the Rule 26 conference, absent ex parte relief which is granted only in extraordinary circumstances. *Mission Power Eng’g Co. v. Continental Cas. Co.*, 883 F. Supp. 488, 492 (C.D. Cal. 1995).

No Rule 26 conference is held. Ingenuity wants to serve its subpoenas immediately.

Once discovery commences, the Court retains jurisdiction to supervise it.

An order granting a Rule 27 petition is a final order that concludes the miscellaneous proceeding. *Martin v. Reynolds Metals Corp.*, 297 F.2d 49, 54 (9th Cir. 1961).

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Interested third-parties may assert any valid objection by moving to quash the subpoena.

The proposed order limits the objections that account-holders or other interested third-parties may assert in a motion to quash. (Ingenuity’s Proposed Order ¶ 3.)

The Court may enter a protective order limiting the use and further dissemination of information produced in discovery.

The miscellaneous action concludes with a ruling on the Rule 27 petition.

Non-parties are not required to preserve records for litigation in which they have no interest.

Ingenuity seeks an order requiring the ISPs to preserve records. (Proposed Order ¶ 4.)

Subpoenaed non-parties are permitted to seek reimbursement for costs incurred responding to subpoenas.

Ingenuity seeks to require the ISPs to “confer with Petitioner before assessing [sic] any charge” for costs incurred in responding to the subpoenas. (Protective Order ¶ 5.)

Documents produced in discovery that contain private information (including account-holders’ information) typically are to be used only for purposes of the pending litigation, consistent with a standard stipulated protective order.

Ingenuity seeks to use the account-holders’ data for any purpose, provide that the information is used to “protect its rights” to the adult film. (Protective Order ¶ 7.)

Plaintiff must seek leave to amend the complaint to identify Doe defendants.

No complaint has been filed.

The Court is informed if settlements are reached; dismissal of the lawsuit requires court approval.

Ingenuity would never be required to disclose to the Court any coerced settlements with account-holders.

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