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UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA

Valentino S.p.A.,  
Plaintiff,  
v.  
Mario Valentino S.p.A., et al.,  
Defendants.

Case No. LA CV19-06306 JAK  
(GJSx)

**[PROPOSED] ORDER  
GRANTING PLAINTIFF  
VALENTINO S.P.A.'S MOTIONS  
TO COMPEL DEFENDANTS'  
DISCOVERY RESPONSES**

Judge: Hon. Gail J. Standish

1 After full briefing in support of and in opposition to Plaintiff Valentino S.p.A.'s  
2 Motion to Compel Defendant Mario Valentino S.p.A.'s ("MV") Discovery Responses  
3 (the "MV Motion") and Plaintiff Valentino S.p.A.'s Motion to Compel Defendant  
4 Yarch Capital, LLC's ("Yarch", and together with MV, "Defendants") Discovery  
5 Responses (the "Yarch Motion", and together with the MV Motion, the "Motions"),  
6 and oral argument by the parties, and finding good cause thereon, Plaintiff Valentino  
7 S.p.A.'s ("Plaintiff") Motions are GRANTED. The Court HEREBY ORDERS as  
8 follows:

9 **Document Requests**

10 1. Plaintiff served Plaintiff's First Set of Requests for the Production of  
11 Documents and Things Directed to Defendant Mario Valentino S.p.A. (the "MV  
12 Document Requests") and Plaintiff's First Set of Requests for the Production of  
13 Documents and Things Directed to Defendant Yarch Capital, LLC (the "Yarch  
14 Document Requests", and together with the MV Document Requests, the "Document  
15 Requests") on December 12, 2019. After an agreed-upon extension of time,  
16 Defendants responded to the Document Requests on February 13, 2020 and produced  
17 documents thereafter. On April 17, 2020, Plaintiff sent meet and confer letters to  
18 Defendants, which was followed up by meet and confer calls among the parties in  
19 May 2020 and an exchange of meet and confer letters in late May and early June  
20 2020.

21 2. After meeting and conferring, Plaintiff and MV were unable to reach any  
22 agreement on MV's objections to MV Document Request Nos. 12-15, 18-22, 28-32,  
23 44-55, 57-58, 62-66, 70, 73-74 (the "MV Specific Dispute Requests"), and Plaintiff  
24 and Yarch were unable to reach any agreement on Yarch's objections to Yarch  
25 Document Request Nos. 1, 7, 12-15, 18-30, 32-33, 43-54, 56, 60, 64-66, 68-85 (the  
26 "Yarch Specific Dispute Requests", and together with the MV Specific Dispute  
27 Requests, the "Specific Dispute Requests").  
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1           3. As to the remaining Document Requests, the parties were able to reach  
2 agreement, except with respect to Defendants’ objections based on Defendants’  
3 pending potentially dispositive motions and the COVID-19 crises (the “General  
4 Dispute Requests”).

5           4. Defendants filed a motion to stay discovery pending resolution of their  
6 potentially dispositive motions and the COVID-19 crises before the District Judge  
7 on May 14, 2020. Dkt. 54. The District Judge denied that motion on July 9, 2020.  
8 Dkt. 71.

9           5. The Court now overrules all of Defendants’ objections to the Specific  
10 Dispute Requests, except for objections based on any applicable privileges.

11           6. No later than **August 28, 2020**, Defendants shall complete production to  
12 Plaintiff of all documents in their possession, custody, or control that are responsive  
13 to the Document Requests and/or make such documents and things available for  
14 inspection, except for documents protected by attorney-client privilege or work  
15 product doctrine and described on appropriately detailed privilege logs and except  
16 as set forth in Affidavits contemplated in Paragraph 20 of this Order. Defendants’  
17 productions in response to the Specific Dispute Requests shall be in accordance with  
18 the terms set-forth below.

19           7. No later than **August 28, 2020**, Yarch shall serve amended responses to  
20 Yarch Document Request Nos. 1, 7, 12-13, 18, 32-33, 56, 60, 64-66, 68-86 that  
21 remove the proviso that its production is “[s]ubject to and without waiver of”  
22 Yarch’s objections (other than objections of attorney-client privilege and work  
23 product).

24           8. Geographic Scope: Defendants shall produce responsive documents to  
25 the Document Requests to the extent they concern Defendants’ activities in the  
26 United States either in whole or in part. Defendants shall produce responsive  
27 documents regardless of the location where the documents were created or where  
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1 they are stored. Defendants need not produce documents that have no connection to  
2 the United States. The following are examples of documents that must be produced,  
3 to the extent they exist and are located by Defendants after a reasonable search.

4 This list is illustrative and not intended to be exhaustive:

- 5 a. Documents concerning any rules, policies, guidelines, steps, or practices  
6 applicable in the United States, in whole or in part, that are intended to  
7 minimize confusion between Plaintiff's products and Mario Valentino-  
8 branded products;
- 9 b. Documents relevant to construing portions of the Co-Existence Agreement  
10 at issue, except Plaintiff's and MV's prior pleadings in arbitrations and/or  
11 litigation;
- 12 c. Documents evincing confusion between Plaintiff and MV (i) concerning  
13 products sold or distributed from or into the United States, (ii) by a person  
14 apparently located in the United States, (iii) by a person who apparently  
15 resides in the United States, or (iv) by a person whose location or residence  
16 cannot be determined;
- 17 d. Agreements that are applicable in both the United States and another  
18 country;
- 19 e. Advertisements used in the United States, regardless of whether the  
20 advertisements were also used outside of the United States;
- 21 f. Communications about a Defendant's activities in the United States,  
22 regardless of the location of the parties to the communication; and
- 23 g. Communications about Mario Valentino-branded products marketed in the  
24 United States, regardless of the location of the parties to the  
25 communication.

26 9. Temporal Scope: With the exception of MV Document Request Nos.  
27 73-74, the temporal scope shall be from January 1, 2013 to present. The temporal  
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1 scope for MV Document Request Nos. 73-74 shall be from the time of negotiation  
2 of the Co-Existence Agreement to present. MV shall not be obliged to produce  
3 pleadings and filings submitted in the proceedings between Plaintiff and MV before  
4 the Court of Milan at No. 39504/2017 General Registry in response to MV  
5 Document Request Nos. 73-74, or other arbitrations or legal proceedings between  
6 Plaintiff (and/or affiliated entities) and MV.

7 10. In response to MV Document Request No. 19 and Yarch Document  
8 Request No. 19, MV and Yarch, respectively, need not produce purchase orders,  
9 invoices, receipts, and bills of lading if MV and Yarch, respectively, produce  
10 documents sufficient to show (a) its monthly revenue, costs, and profits with respect  
11 to handbags sold in the United States; and (b) the identity and location of any  
12 manufacturers of handbags sold in the United States. If a Defendant does not have  
13 documents sufficient to show the foregoing, it shall produce all responsive purchase  
14 orders, invoices, receipts, and bills of lading, if such documents exist. MV's and  
15 Yarch's respective obligations to produce documents responsive to MV Document  
16 Request No. 19 and Yarch Document Request No. 19 aside from purchase orders,  
17 invoices, receipts, and bills of lading is limited to documents and communications  
18 between MV or Yarch, as applicable, and any person concerning the manufacture,  
19 purchase, sale and/or distribution of any Mario Valentino-branded products in the  
20 United States that (a) provide any descriptions of, or guidelines for, the design of  
21 Mario Valentino-branded products, (b) mention or otherwise reference Plaintiff, or  
22 (c) address any measures to be taken to avoid confusion between Mario Valentino-  
23 branded products and Plaintiff's products. Nothing in this paragraph is intended to  
24 limit a Defendant's obligation to produce documents responsive to other Document  
25 Requests than MV Document Request No. 19 or Yarch Document Request No. 19.

26 11. In response to MV Document Request No. 20 and Yarch Document  
27 Request No. 20, MV and Yarch, respectively, need produce only agreements  
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1 concerning the manufacture of Mario Valentino-branded products intended for  
2 distribution in the United States to the extent that such agreements (a) provide any  
3 descriptions of, or guidelines for, the design of the products subject to the  
4 agreement, (b) address the location of manufacture of the products subject to the  
5 agreement, (c) mention or otherwise reference Plaintiff, or (d) address any measures  
6 to be taken to avoid confusion between the products subject to the agreement and  
7 Plaintiff's products or the products of any other person or entity.

8 12. In response to MV Document Request No. 22 and Yarch Document  
9 Request No. 22, MV and Yarch, respectively, need produce only documents or  
10 communications with manufacturers to the extent that such documents or  
11 communications (a) provide any descriptions of, or guidelines for, the design of  
12 Mario Valentino-branded products, (b) address the location of manufacture of Mario  
13 Valentino-branded products, (c) mention or otherwise reference Plaintiff, or (d)  
14 address any measures to be taken to avoid confusion between Mario Valentino-  
15 branded products and Plaintiff's products or the products of any other person or  
16 entity.

17 13. In response to MV Document Request No. 25 and Yarch Document  
18 Request No. 24, MV and Yarch, respectively, need produce only documents or  
19 communications concerning any vendor agreements concerning Mario Valentino-  
20 branded products intended to be distributed in the United States to the extent that  
21 such vendor agreements (a) provide any descriptions of, or guidelines for, the design  
22 of Mario Valentino-branded products, (b) mention or otherwise reference Plaintiff,  
23 or (c) address any measures to be taken to avoid confusion between Mario  
24 Valentino-branded products and Plaintiff's products.

25 14. The Court specifically overrules the following objections:

- 26 a. That discovery or any part of it should be stayed pending resolution of  
27 Defendants' potentially dispositive motions.

- 1 b. That discovery should be stayed pending resolution of the COVID-19  
2 crises.
- 3 c. That issues of confusion are limited to “consumer confusion” or “actual  
4 commercial confusion.”
- 5 d. That the term “confusion” is ambiguous.
- 6 e. That Defendants need not produce documents concerning actions taken on  
7 a case-by-case basis intended to minimize confusion.
- 8 f. That the statute of limitations defense precludes discovery of documents  
9 concerning the time period before 2016.
- 10 g. That documents concerning pricing are limited to documents sufficient to  
11 show retail prices at which Defendants products are sold.
- 12 h. That Defendants need not produce documents concerning complaints about  
13 Mario Valentino-branded products.
- 14 i. That Defendants need not produce documents concerning past cases of  
15 infringement.
- 16 j. That MV need not conduct a reasonable search for documents concerning  
17 the Co-Existence Agreement.

18 15. No later than **September 22, 2020**, Defendants shall each serve an  
19 appropriate privilege log. The parties are negotiating an agreement over the scope  
20 of documents that must be included on a privilege log. If the parties are unable to  
21 reach agreement, the parties may submit a joint email to the Court with their  
22 respective proposals, and the Court will resolve the dispute.

23 **Interrogatories**

24 16. No later than **August 28, 2020**, Defendants shall, respectively, serve on  
25 Plaintiff amended responses to Plaintiff’s First Set of Interrogatories Directed to  
26 Defendant Mario Valentino S.p.A. and Plaintiff’s First Set of Interrogatories  
27 Directed to Defendant Yarch Capital, LLC (collectively, the “Interrogatories”).

1           17. The amended responses shall, respectively, provide Plaintiff with all  
2 known facts in each Defendant's possession supporting its contentions that  
3 Plaintiff's patents-in-suit are invalid due to prosecution history estoppel or  
4 obviousness. If a Defendant does not currently possess any such facts, then such  
5 Defendant must serve amended interrogatory responses so stating.

6           18. The amended responses shall provide Plaintiff with all examples of prior  
7 art that each Defendant contends invalidate the patents-in-suit.

8           19. Defendants may further amend or supplement their responses at any  
9 time for good cause. Nothing in this Order shall be construed as suspending  
10 Defendants' obligations to supplement their responses to discovery.

11           **Compliance With this Order**

12           20. No later than **September 4, 2020**, counsel for each Defendant shall each  
13 serve a declaration on Plaintiff either (a) attesting to substantial compliance with  
14 this Order; (b) identifying areas where compliance remains outstanding and the  
15 timeline for achieving compliance; and, if applicable, (c) an explanation as to why a  
16 continuing search for specifically potentially responsive documents is unduly  
17 burdensome (an "Affidavit"). If no documents responsive to a request or a portion  
18 of a request are found, counsel for the applicable Defendant shall provide an  
19 explanation sufficient to allow Plaintiff and the Court to assess the adequacy of such  
20 Defendant's search. A conclusory statement that such Defendant has conducted a  
21 reasonable search does not constitute compliance with this Order. The disclosures  
22 required by this Paragraph and Paragraph 21 do not require Defendants or their  
23 counsel to disclose documents or communications protected by any applicable  
24 privilege.

25           21. Defendants shall be under a continuing obligation to meet and confer in  
26 good faith with Plaintiff on Defendants' document search strategies, including, at  
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Plaintiff's request, to discuss custodians or locations searched for documents and any electronic search terms used to locate responsive documents.

22. The parties shall be under a continuing obligation to meet and confer in good faith regarding the sufficiency of Defendants' compliance with this Order.

FOR GOOD CAUSE SHOWN, IT IS SO ORDERED.

DATED: August 10, 2020 \_\_\_\_\_



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GAIL J. STANDISH  
UNITED STATES MAGISTRATE JUDGE