

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS

CAPITOL RECORDS, INC., et al.,)
Plaintiffs,)
)
v.)
)
NOOR ALAUJAN,)
Defendant.)

Case No. 03CV11661-NG
LEAD DOCKET NO.

SONY BMG MUSIC ENTERTAINMENT, et al.,)
Plaintiffs,)
)
v.)
)
JOEL TENENBAUM,)
Defendant.)

Case No. 07cv11446-NG
ORIGINAL DOCKET NO.

GERTNER, D.J.:

MEMORANDUM AND ORDER

May 6, 2009

Defendant's Motion for a Protective Order (document #672) is **GRANTED** in part and **DENIED** in part.

Plaintiffs have sought to inspect two computers belonging to Joel Tenenbaum: (a) a Gateway desktop computer; and (b) a Toshiba laptop. In particular, they seek to examine the two computers for evidence supporting their infringement claims by creating mirror-images of the hard-drives, which involves making an exact copy of the full contents of each drive for inspection by a forensic computer expert. Importantly, the computer that was originally used to download the songs identified by the Plaintiffs in the Complaint has been discarded or destroyed. Instead, the computers at issue were subsequently owned by the Defendant and, as Tenenbaum has conceded, were also used for file-sharing activities.

In their opposition to the Motion for a Protective Order, the Plaintiffs barely address the Toshiba laptop; as a result, the Court sees no reason to permit its inspection. The dispute centers

instead on the Gateway computer, which Tenenbaum took to college after the alleged file-sharing occurred on his parents' home computer. Significantly, Tenenbaum admitted in his deposition that the Gateway was his only computer during college and further, that it was used for subsequent file-sharing, although he denied remembering certain details related to those activities.

The Plaintiffs contend that because the Gateway replaced the earlier computer, it was likely used to upload the copyrighted files from CDs, which Tenenbaum admits he made, and then used for further redistribution over file-sharing networks. They argue that such evidence is relevant to the claims stated in the Complaint under Fed.R.Civ.P. 26(b) because it bears on where the identified songs were uploaded and potentially transmitted; and because it contains data likely to lead to admissible evidence of the Defendant's continuous and willful copyright infringement by virtue of his subsequent file-sharing. The Defendant objects that such disk-imaging is overbroad, unduly burdensome, would violate his privacy, and would jeopardize confidential attorney-client communications.

I. FINDINGS

While mirror-imaging poses serious privacy concerns, where the computer itself is at the heart of the litigation -- where it is, in effect, an instrumentality of the alleged copyright infringement -- it is plainly relevant under Fed.R.Civ.P. 26(b). This is particularly so given Tenenbaum's admissions and the scope of his defenses. The Gateway computer is one of the very devices used by the Defendant for file-sharing, as he admitted at his deposition. See Ameriwood Industries, Inc. v. Liberman, 2006 WL 3825291 at *4 (E.D. Mo. 2006) ("[A]llegations that a defendant downloaded trade secrets onto a computer provide a sufficient

nexus between plaintiff's claims and the need to obtain a mirror image of the computer's hard drive." His inability to remember relevant details of this file-sharing and his inconsistent discovery responses further open the door to the mirror-imaging that Plaintiffs seek. At the same time, Tenenbaum's argument that the statutory damages available under the Copyright Act are unconstitutional and excessive when compared to the actual harm suffered by Plaintiffs also supports allowing inspection of the Gateway hard-drive. This defense puts squarely at issue the question of exactly how substantial, continuous, and significant his file-sharing activities actually were.

The Court has the authority under Fed.R.Civ.P. 34 and 26(b) to order mirror-imaging of a party's hard drive. See Balboa Threadworks, Inc. v. Stucky, 2006 WL 763668 (D. Kan. 2006); Ameriwood Industries, 2006 WL 3825291; Communications Center, Inc. v. Hewitt, 2005 WL 3277983, at * 1 (E.D. Cal. 2005). The principal issue in these cases centers instead on concerns for defendants' privacy, especially where "the connection between the computers and the claims in the lawsuit are unduly vague or unsubstantiated in nature." Balboa Threadworks, 2006 WL at *3. In the instant case, the Court finds that there is a sufficiently close connection between the Gateway computer, but not the Toshiba laptop, and the claims in this lawsuit. It further concludes that the Defendant's privacy objections can be addressed through a robust protective order, as described in detail below. See Ameriwood Industries, 2006 WL 3825291; Arista Records, Inc. v. Tschirhart, Case No. 05-CA03720G, slip op. (W.D. Tex. Jan. 25, 2006) (ordering mirror imaging of file-sharing defendant's hard drive with protective order to preserve confidential and privileged information from disclosure).

II. PROTECTIVE ORDER

Mindful of the potential exposure of non-relevant personal information occasioned by mirror-imaging, the Court allows this discovery only subject to a Protective Order consistent with the terms provided below. The very technological reasons that necessitate a mirror-image of the entire hard-drive -- i.e., the manner in which digital information is stored on the computer and the way in which "deleted" files are retained -- also makes Plaintiffs' Proposed Protective Order markedly insufficient in light of the Court's substantial privacy concerns. See Decl. of Dr. Doug Jacobson, Exh. F to Pl. Opp. to Protective Order (document # 682-2). Because 'deleted' but non-relevant files no longer remain in the operating system's directory, the Defendant would be unable to designate them in the privilege log proposed by Plaintiffs. Moreover, the categories of documents slated for exclusion by the Plaintiffs -- attorney-client communications, student grades, unpublished research, and medical records -- are woefully inadequate to cover the range of non-relevant personal information likely stored on the hard-drive.

A more rigorous procedure is provided here, as adapted from that used by the district court in Ameriwood Indus. Inc. v. Liberman, 2006 WL 3825291, at *4 (E.D. Mo. 2006):

1. Plaintiffs shall select a computer forensic expert of their choosing to produce a mirror-image of the Gateway computer's hard-drive.
2. The Expert and any assistants assigned to the computer inspection shall execute a Confidentiality Agreement agreed to by the parties and shall sign a copy of and abide by the Protective Order in place in this action.
3. The Defendant shall make the Gateway computer available to the Plaintiffs' Expert at his counsel's office at a mutually agreeable time within 10 business days of the approved Protective Order. The Expert shall make a mirror-image of the Gateway computer's hard-drive, a process which should require no more than several hours. He or she may not remove the Defendant's computer from the premises.
4. Only the Expert and his or her assistants assigned to this project are authorized to inspect, or otherwise handle the Defendant's computer or the mirror-image

generated. No employee of the Plaintiffs, or their counsel, will inspect or otherwise handle the mirror-image produced. The Expert will also maintain all information in the strictest confidence. Furthermore, the Expert will maintain a copy of the mirror images and all recovered data and documents until 60 days after the conclusion of this litigation.

5. The Expert shall examine any recoverable file-sharing data on the mirror-image, including electronic records generated by file-sharing software and "metadata" associated with music files. Recoverable data includes 'deleted' files that no longer appear in the operating system's directory.
6. The Expert shall not examine any non-relevant files or data, including those belonging to the following categories: emails, word-processing documents, PDF documents, spreadsheet documents, image files, video files, or stored web-pages. On their face, none of these types of electronic files appear to have any established relevance to Tenenbaum's use of file-sharing software or allegedly infringing activities. As an added precaution, the Defendant shall also be permitted to designate any attorney-client communications or privileged work-product files in a Privilege Log provided to both the Expert and the Plaintiffs' counsel prior to inspection. These files shall be immediately deleted from the mirror-image by the Expert and, under no circumstances, may they be opened or their contents examined by the Expert.
7. Based on this inspection of the mirror-image, the Expert shall produce a report which describes the music files found on the computer and any file-sharing information associated with each one, as well as any other records of file-sharing activity. The report may also address any evidence that the hard-drive has been "wiped" or erased since the initiation of this litigation.
8. The Expert shall disclose this report only to the Defendant's counsel, who will have five business days to lodge any objections to the report based on privilege. Any such objections shall first be communicated in writing to Plaintiffs' counsel. If the parties cannot resolve any dispute themselves, the Plaintiffs shall file a Motion to Compel the production of the Expert's report. If there is no dispute, or the parties reach an agreement themselves, the Defendant shall promptly disclose the Expert's report to the Plaintiffs.
9. In resolving any Motion to Compel, the Court may require the Defendant to submit the Expert's report for review in camera.

Before this discovery proceeds, a Protective Order consistent with these terms must be submitted for the Court's approval by the Plaintiffs. After that approval, the parties shall

promptly meet and confer to determine the contents of the confidentiality agreement and an appropriate time, within ten business days, for the Expert to access the Gateway computer for mirror-imaging.

III. CONCLUSION

For the foregoing reasons, the Defendant's Motion for a Protective Order (document #672) is **GRANTED** with respect to the Toshiba laptop and **DENIED** with respect to the Gateway computer. Inspection of the Gateway computer's hard-drive shall proceed consistent with the procedures specified by the Court.

SO ORDERED.

Date: May 6, 2009

/s/ Nancy Gertner
NANCY GERTNER, U.S.D.C.