

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF WISCONSIN

TOSHIBA CORPORATION,

Plaintiff,

v.

IMATION CORP., *et al.*,

Defendants.

OPINION and ORDER

09-cv-305-slc

In this civil action alleging patent infringement, I granted summary judgment to defendants Imation Corp., Moser Baer India Ltd, Glyphics Media, Inc., CMC Magnetics Corp., Hotan Corp., Khypermedia Corp., Ritek Corp. and Advanced Media, Inc. on December 28, 2010, leaving only a *de minimis* issue related to the testing activity of one defendant. Dkt. 277. On January 5, 2011, the parties entered into a stipulation and order dismissing the remaining claims for relief. Dkt. 278. I entered final judgment in favor of the defendants on January 7, 2011. Dkt. 280.

As prevailing parties, defendants are entitled to an award of costs as a matter of course. Fed. R. Civ. P. 54(d)(1). The following costs are recoverable under 28 U.S.C. § 1920:

- (1) Fees of the clerk and marshal;
 - (2) Fees for printed or electronically recorded transcripts necessarily obtained for use in the case;
 - (3) Fees and disbursements for printing and witnesses;
 - (4) Fees for exemplification and the costs of making copies of any materials where the copies are necessarily obtained for use in the case;
 - (5) Docket fees under section 1923 of this title; and
 - (6) Compensation of court appointed experts, compensation of interpreters, and salaries, fees, expenses, and costs of special interpretation services.
- Defendants request reimbursement in the amount of \$198,189.14 for the following costs:

1) \$90 for the service of witness subpoenas; 2) \$41,149.75 in transcript fees; 3) \$4,494.91 in fees and disbursements for witnesses; 4) \$1,799.10 for delivery charges; 5) \$133,182.79 for exemplification and copying; 6) \$5 in docket fees; and 7) \$17,467.59 for interpretation services. Dkts. 282 and 285. Plaintiff Toshiba Corporation objects to \$125,281.23 of these costs on the grounds that they are unsupported, not recoverable or unreasonable. Dkt. 288.

I. Copying

Section 1920(4) allows defendants to recover costs for making copies that are “necessarily obtained for use in the case.” Plaintiff asserts that defendants have failed to explain how the majority of copied documents for which they seek reimbursement relate to the presentation of evidence to the court. However, in their explanation of their bill of costs (dkt. 285), defendants state that the copying costs include \$124,263 for document production in response to 809 requests from plaintiff, \$1,133.66 for ordering and obtaining file histories related to the patents-in-suit and \$7,786.13 for both vendor provided and in-house photocopying. This court has held that a defendant is entitled to recovery of the cost of photocopying materials for discovery, provided that the number of copies is reasonable. *Thompson v. Eaton Corp.*, 2003 WL 23200258, *1 (W.D. Wis. May 12, 2003). I agree with defendants that their document production costs reflect the burden required to respond to Toshiba’s extensive discovery requests. Defendants also explain that the document production was important to the preparation of their case, assisting in their preparation for depositions, pretrial motions and their proposed exhibit list.

Plaintiff does not challenge the costs for obtaining the patent file histories but argues that

defendants have failed to provide sufficient information to allow it and the court to review the photocopy costs to be able to determine which ones were necessary to the litigation and which ones were not. But the Seventh Circuit has held that the court need not conduct a painstaking inspection of the costs to determine that certain costs are “reasonable and necessary” to the litigation, because market incentives will do a better job keeping costs in check than the court could possibly do after the fact. *Anderson v. Griffin*, 397 F.3d 515, 522 (7th Cir.2005) (citing *Taco Bell v. Continental Casualty Co.*, 388 F.3d 1069, 1075 (7th Cir. 2004). Generally, once it is established that costs were incurred for issues related to the case at hand, costs should generally be accepted so long as they fall into one of the categories of costs statutorily authorized for reimbursement. *Z-Trim Holdings, Inc. v. Fiberstar, Inc.*, 2008 WL 3843507, *2 (W.D. Wis. Aug. 12, 2008). Although defendants submitted only general invoices for photocopying costs, one of their attorneys has averred that the charges were related to the case. Under circuit law and consistent with this court’s practice in other cases, this is enough. Defendants’ award for copying will not be reduced.

II. Experts

Plaintiff objects to having to pay expenses for defendants’ experts to travel to Boston for depositions because defendants chose the location. Although defendants chose the location of the depositions, it was reasonable for all three experts to come to one city for depositions.

In the alternative, plaintiff argues that the hotel costs exceed the GSA per diem allowance for federal employees and that the witnesses incurred extra hotel stays for preparation time. Defendants have agreed to use the GSA per diem rate for lodging, reducing the fee request by

\$993.15. I agree that plaintiff should not be required to pay for an expert's expenses for preparation time. However, it appears that only one expert, Mr. Bero, incurred an additional night in lodging for preparation time. Beyond the amount already conceded, the expenses for Mr. Bero are reduced by \$154 (the GSA per diem rate for Boston in December of 2010). The other two witnesses, Dr. Mansurpipur and Mr. Liesagang, incurred one additional night beyond the number of days they were deposed. However, it is reasonable to arrive the night before a deposition and leave the following morning. Therefore, the travel expenses for Dr. Mansurpipur and Mr. Liesagang are approved in full.

Defendants will be awarded a total of \$3,347.76 in expert witness costs.

III. Interpreters

Plaintiff objects to defendants' request of \$9,880 for the costs of a second interpreter (or a "check interpreter") at depositions as unnecessary. I agree and will not allow those costs. If defendants had a concern about the accuracy or bias of an interpreter, then they should have worked with plaintiff to select a neutral third party to interpret. It is not a fair solution for one side to pay for two interpreters. *See General Elec. Co. v. SonoSite, Inc.*, 2008 WL 4062098, *2 (W.D. Wis. Jan. 22, 2008) (holding same in context of motion to compel discovery). Defendants must bear the cost of the second interpreters. The cost award for interpretation services will be reduced to \$7,587.59.

IV. Transcripts

Plaintiff objects to the \$4,819 defendants seek for syncing the video depositions of its own witnesses. Plaintiff does not oppose paying for syncing the depositions of the adverse witnesses and argues that if counter-designations of videotaped testimony proffered by plaintiff was necessary, defendants could have used plaintiff's version of the synced transcript. I will allow these costs because without agreement between the parties, defendants could not rely on the possibility that plaintiff would be willing to share its synced video depositions. Therefore, it was reasonable for defendants to incur this cost.

Plaintiff also objects to \$1200 for the use of additional realtime connections by its check interpreters during depositions. Because I have found that the check interpreters were not necessary, any expenses related to them will not be allowed.

Finally, plaintiff opposes the \$115.20 that defendants seek for multiple copies of hearing transcripts. Defendants have agreed to drop this request.

In sum, defendants costs for transcripts will be reduced to \$39,834.55.

ORDER

IT IS ORDERED that defendants are awarded costs as the prevailing parties in the amount of \$185,846.79.

Entered this 26th day of July, 2011.

BY THE COURT:

/s/

STEPHEN L. CROCKER
Magistrate Judge