

IN THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF PENNSYLVANIA

HERMAN DOUGLAS, SR. : CIVIL ACTION  
 :  
 v. :  
 :  
 KIMBERLY-CLARK CORPORATION : NO. 96-2428

**MEMORANDUM AND ORDER**

HUTTON, J.

April 2, 1998

Presently before the Court is Defendant Kimberly-Clark Corporation's Second Renewed Motion for Award of Costs Including Attorneys Fees, and Plaintiff Herman Douglas Sr.'s opposition thereto. The Court held a hearing on this matter, at which all parties were represented, on the morning of January 26, 1998. For the reasons that follow, the Defendant's motion is granted in the amount of \$5,000.00.

**I. BACKGROUND**

On March 3, 1996, Herman Douglas Sr. sued Kimberly-Clark Corporation ("K-C") pro se for copyright infringement and unfair competition, in connection K-C's packaging of its Huggies® brand diapers. These claims turned out to be meritless, and in an April 9, 1997 Memorandum and Order, the Court granted K-C summary judgment on all counts of Douglas' Complaint.

Thereafter, K-C timely moved for an award of costs and fees under Rule 54(d) of the Federal Rules of Civil Procedure, 17 U.S.C. § 505 (1994), and 28 U.S.C. § 1920(2) (1994). The Court denied K-C's first motion, with leave to renew, on grounds that K-C had

provided insufficient documentation of its expenses. K-C then filed a second motion, which included extensive billing records documenting total expenses of \$45, 304.43, and sought reimbursement for the full amount. After a hearing in open court, conducted on October 29, 1997, the Court denied K-C's motion for a second time because K-C failed to offer any testimony as to the reasonableness of the work done and the fees incurred. The Court, however, invited K-C to renew its motion and support its claim for fees once again, supported by the proper evidence.

K-C then moved for a third time, prepared to offer the necessary evidence of reasonableness. On January 26, 1998, the Court held a second hearing in which K-C offered the testimony of John A. Dondrea, the Texan intellectual property attorney who billed most of the hours in the case, as to the reasonableness of the work performed and fees charged. Dondrea substantiated all of K-C's legal expenses in the Douglas action, and the Court will assume that they are reasonable.

## **II. DISCUSSION**

Section 505 of the Copyright Act provides authority to award a prevailing party costs and fees, but allows the Court a range of discretion as to whether, and to what extent, to award them. See Fogarty v. Fantasy, Inc., 114 S.Ct. 1023, 1033 n.19 (1994) (holding that a prevailing defendant in a copyright infringement case, though not entitled to fees and costs as of right, is subject to the same standard of proof as a prevailing plaintiff). In Lieb v.

Topstone Indus., Inc., 788 F.2d 151, 156 (3d Cir. 1986), the Third Circuit announced a non-exclusive list of factors to be considered in the exercise of this discretion, including "frivolousness, motivation, objective unreasonableness (both in the factual and legal components of the case) and the need in particular circumstances to advance considerations of compensation and deterrence." Id. It further suggested considerations for the decision as to how much to award, including (1) the complexity of the litigation, (2) the relative financial strength of the parties, (3) the degree of damages, and (4) the presence of bad faith. See id. However, the Lieb case specifically states that the award of fees should not result in the loser's "ruination." See id. at 156. The Supreme Court recently quoted the Lieb factors with approval in Fogarty, 114 S.Ct. at 1033 n.19.

In this case, K-C is entitled to an award of some attorney's fees. The plaintiff has a ten-year history of unsuccessful intellectual property litigation with K-C over the same subject matter. In 1992, K-C obtained the invalidation of the Douglas' patents on his training diaper products. The present litigation, though under a copyright infringement theory, was at its heart an attempt to relitigate matters already decided adversely to Mr. Douglas in that matter. In a deposition taken in this case, Douglas refused to accept the earlier decisions of the Federal Circuit and the Honorable Ronald L. Buckwalter of this Court.

Furthermore, Mr. Douglas' case was entirely without legal merit. Lacking a sophisticated understanding of intellectual

property law, Mr. Douglas confused protection of a tangible expression with protection of the underlying idea. The allegedly infringing expression--an illustration of a diaper on the Huggies® packaging--was similar only in the concept it sought to convey: a diaper. Otherwise, it was clearly not "substantially similar" to Douglas' copyrighted work. Its difficult to believe a reputable intellectual property lawyer would have advised Douglas to pursue this case, or at least in the manner that he brought it.

Given the facts, the Court finds that Mr. Douglas' case was "objectively unreasonable," and that compensation and deterrence considerations support making Douglas reimburse K-C for some of its expenses in defending this suit. The difficulty is in the amount to award.

Courts have varied in their approach to awarding fees against pro se litigants. Many courts have reduced awards in recognition of a pro se litigant's lack of sophistication, but others have found that the full amount should be imposed anyway. See Taylor v. Times Herald Record, Newspaper, 1992 Copr. L. Dec. ¶ 26,938 (S.D.N.Y. 1992) (imposing full fees on pro se litigant in spite of his lack of legal sophistication because the claim was completely baseless). In a similar 1993 case regarding disposable diapers, the Honorable John P. Fullam ordered Douglas to pay the Weyerhouser Corporation \$5000.00 in attorney's fees for defending a similarly baseless claim. See Douglas v. Weyerhouser Corp., Civ. A. No. 93-1123, 1993 WL 523691 (E.D. Pa. Dec. 14, 1993).

The Court believes that Judge Fullam's approach provides a good model for resolving the present motion. Although the Lieb factors counsel an award of fees to perform a deterrence function, the Third Circuit specifically held that such an award should not result in the loser's ruination. At the hearing, Douglas testified that he is completely unable to afford K-C's litigation expenses. The Court will not ruin him by ordering him to do so. However, the Court believes that an award of some amount is necessary to prevent Douglas from bringing a similar claim in the future. Therefore, the Court has determined to award K-C attorney's fees in the amount of \$5,000.

An appropriate Order follows.

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O R D E R

AND NOW, this 2nd day of April, 1998, upon consideration of Defendant Kimberly-Clark Corporation's Second Renewed Motion for Award of Costs Including Attorney's Fees and Plaintiff Herman Douglas' Motion in Opposition thereto, IT IS HEREBY ORDERED that the Defendant's Motion is **GRANTED**.

IT IS FURTHER ORDERED that **JUDGMENT** is entered in favor of the Defendant and against the Plaintiff in the amount of \$5,000.

BY THE COURT:

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HERBERT J. HUTTON, J.