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

ROSENBAUM & ASSOCIATES, P.C., *et al*	:	**CIVIL ACTION**
	:	
	:	
v.	:	
	:	**NO. 17-4250**
MORGAN & MORGAN, *et al*	:	

ORDER

AND NOW, this 15th day of December 2017, upon considering Plaintiffs' Motion to compel (ECF Doc. No. 28), Defendants' Response (ECF Doc. No. 29), mindful we granted Plaintiffs' motion for expedited discovery necessary for their preliminary injunction request in our November 14, 2017 Order (ECF Doc. No. 19) resulting in discovery presently limited (upon Plaintiffs' request) to adducing evidence necessary for the Plaintiffs to establish imminent irreparable harm caused by Defendants' ongoing representations but Plaintiffs presently fail to establish good cause to review Defendants' advertising or referral relationships before August 1, 2017 in the Plaintiffs' selected context of a preliminary injunction motion, it is **ORDERED** Plaintiffs' Motion (ECF Doc. No. 28) is **DENIED** without prejudice to seek more fulsome discovery of conduct before August 1, 2017 as we prepare for trial.[1]

KEARNEY, J.

[1] Plaintiffs sued their competitor law firm seeking damages and injunctive relief. They chose to immediately move to enjoin the competitor's advertising. They then sought discovery focused on their request for immediate relief. ECF Doc. No. 15. After argument, we granted Plaintiffs' request for immediate discovery to prepare for their requested January 4, 2018 hearing on imminent relief. ECF Doc. No. 19. We offered to hold the hearing much earlier to address alleged imminent harm but Plaintiffs declined. Consistent with Plaintiffs' requested scope of

relief confirmed in our November 14, 2017 Order, Defendants produced discovery relating to their advertising and referrals beginning several weeks before Plaintiffs filed suit. Plaintiffs now object to Defendants' failure to provide information from **before** August 1, 2017 as to the number of clients who signed a fee agreement with Defendants, the number of clients referred by Defendants to other attorneys, those attorneys' identities and referral arrangements, and number of personal injury complaints filed by Defendants in Pennsylvania. Defendants provided this information from August 1, 2017 until November 30, 2017 arguing information from before August 1, 2017 is not relevant to Plaintiffs' request to stop the present advertising.

To stop ongoing or threatened recurring conduct, Plaintiffs must "demonstrate [they are] likely to suffer irreparable harm if an injunction is not granted." *Ferring Pharmaceuticals, Inc. v. Watson Pharmaceuticals, Inc.*, 765 F.3d 205, 217 (3d Cir. 2014). Our court of appeals "has stressed that imminence is a key aspect of [our] analysis" for irreparable harm. *Colorcon, Inc. v. Lewis*, 792 F. Supp. 2d 786, 804 (E.D. Pa. 2011) (citing *Continental Grp., Inc. v. Amoco Chems. Corp.*, 614 F.2d 351, 358-59 (3d Cir. 1980)). In *Ferring*, our court of appeals distinguished the relevancy of discontinued conduct on irreparable harm in a preliminary injunction context from its relevancy for plaintiff to prove its case at trial. Our court of appeals found a defendant's certification it would no longer use the alleged false statements "certainly a relevant consideration" for our irreparable harm inquiry. *Ferring*, 765 F.3d at 217.

Plaintiffs do not explain how information from before August 1, 2017 is relevant to show Defendants are now causing imminent irreparable harm. We cannot enjoin history. This information may be discoverable for trial but Plaintiffs do not show how it relates to the advertising occurring now and leading up to our January 4, 2018 hearing.

Anticipating the quandary caused by expedited discovery limited to the requested immediate relief, Plaintiffs argue we should follow the reasoning applied **following trial** in *Novartis Corp. v. FTC,* 223 F.3d 783, 785 (D.C. Cir. 2000). In *Novartis,* an administrative law judge found Novartis' advertising violated the Lanham Act but denied the Commission's request for corrective advertising. *Id.* at 785-86. The Commission affirmed the administrative law judge's finding of deceptive advertising but reversed the judge's finding on corrective advertising. *Id.* at 786. The Commission found Novartis' eight-year advertising campaign "created or reinforced consumer misbelief" and ordered a year-long corrective advertising campaign. *Id.* The Court of Appeals for the District of Columbia affirmed the corrective advertising requirement finding sufficient evidence Novartis' eight-year advertising campaign played a "substantial role in creating or reinforcing" the consumers' false belief, and evidence the false belief lingered because six months after Novartis ended the deceptive advertising campaign a study adduced at trial showed the false belief still existed in a "disproportionately high" percentage of consumers. *Id.* at 787-88.

Plaintiffs do not show us the same fact basis. They do not seek corrective advertising. The court of appeals in *Novartis* reviewed an appropriate remedy after a full trial on the merits challenging an eight-year deceptive advertising campaign without corrective advertising. The reasoning in *Novartis* and of a "lag effect" created in past advertising may apply during our study of post-trial remedies if sought. As Plaintiffs chose to seek expedited discovery limited to its motion to stop

present advertising without fulsome discovery or a trial record, we are not close to deciding discovery disputes based on an unplead corrective advertising theory.

The same reasoning also sustains the Defendants' present refusal to provide information on who contacted them about possible representation. These issues may be material for trial and we express no opinion on whether this information is discoverable with appropriate confidentiality protections. *See Karoly v. Mancuso*, 65 A.3d 301, 314 (Pa. 2013). But these details do not affect our analysis on whether we must stop the advertising as of the date of our hearing – the only issues presently in discovery.