

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

THE WEATHER UNDERGROUND, INC.,  
a Michigan corporation,

Plaintiff,

Case No. 2:09-cv-10756  
Hon. Marianne O. Battani

vs.

NAVIGATION CATALYST SYSTEMS, INC.,  
a Delaware corporation; BASIC FUSION, INC.,  
a Delaware corporation; CONNEXUS CORP.,  
a Delaware corporation; and FIRSTLOOK, INC.,  
a Delaware corporation,

Defendant.

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**PLAINTIFF'S MOTION IN LIMINE TO EXCLUDE TESTIMONY OF  
AND PORTIONS OF THE EXPERT REPORT OF DEFENDANTS' EXPERT  
JOHN BERRYHILL AND BRIEF IN SUPPORT**

NOW COME Plaintiff, by and through counsel, TRAVERSE LEGAL, PLC and HOOPER HATHAWAY, P.C., and hereby submits its Motion in Limine to exclude testimony of and portions of the expert report of Defendants' Expert John Berryhill and states as follows:

1. Plaintiff has sued Defendants under the Anti-Cyberquatting Consumer Protection Act ("ACPA"). The ACPA requires that the Plaintiff prove by a preponderance of the evidence that Defendants (1) registered, used, or trafficked in a domain name; (2) that is confusingly similar to; (3) a trademark in which Plaintiff has rights; and (4) with a bad faith intent to profit from that mark. 15 U.S.C. §1125(d)(1).

2. Defendants' expert, John Berryhill ("Berryhill") concluded that (1) bulk registration of domain names in order to publish advertising material does not amount to bad faith cybersquatting and (2) bulk domain name registrants that utilize a filtering system and cooperate when trademark owners demand infringing domains does not amount to bad faith cybersquatting. Expert Report ¶ 11, 29. In doing so, Berryhill offers a legal conclusion about the threshold issue in the case, which is whether Defendants activity evidences the requisite bad faith intent to profit from Plaintiff's trademarks as set forth in 15 U.S.C. §1125(d)(1)(A)(i) in violation of FRE 704.

3. Furthermore, pursuant to FRE 403, this Court should not admit testimony by Berryhill regarding Defendants' intent or any evidence from his Expert Report about what evidences bad faith because embraces an ultimate issue reserved for the trier of fact and would unduly prejudice Plaintiff and mislead the jury.

4. In addition, Berryhill offers opinions interpreting the ACPA, including its scope, history, meaning, and application. Thus, again, based upon FRE 704, this Court should exclude

paragraphs 12-14 of Berryhill's Expert Report and preclude any testimony by Berryhill that instructs the jury as the law of the ACPA, including its scope, history and application.

5. Counsel exchanged intended motions in limine by e-mail, setting forth the nature of the motion and its legal basis. No concurrence regarding this motion was obtained.

Respectfully submitted this 24<sup>th</sup> day of February, 2012.

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## **BRIEF IN SUPPORT**

### **Concise Statement of Issues Presented**

1. Whether the Court should exclude Defendants' expert Berryhill's testimony on an ultimate issue in the case, namely what constitutes bad faith intent to profit in violation of the ACPA, under FRE 704 because such determination is a legal conclusion reserved for the trier of fact?

Plaintiff answers: YES

Defendants answer: NO

2. Whether the Court should exclude Defendants' expert Berryhill's testimony as to what constitutes bad faith intent to profit in violation of the ACPA under FRE 403 because such determination prejudices the Plaintiff and misleads the trier of fact?

Plaintiff answers: YES

Defendants answer: NO

3. Whether the Court should exclude Defendants' expert Berryhill's testimony regarding the scope, history, and application of the ACPA under FRE 704 because such instruction and legal conclusions are reserved for the judge and trier of fact, respectively?

Plaintiff answers: YES

Defendants answer: NO

**Controlling or Most Appropriate Authority for the Relief Sought**

FRE 403 .....2, 3

FRE 702 .....2

FRE 704 .....1, 3

## Table of Authorities

### Cases

<i>H.C. Smith Investments, L.L.C. v. Outboard Marine Corp.</i> , 181 F. Supp. 2d 746, 749 (W.D. Mich. 2002).....	2
<i>Shahid v. City of Detroit</i> , 889 F.2d 1543 (6th Cir. 1989) .....	1
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<i>United States v. Zipkin</i> , 729 F.2d 384, 386-87 (6 <sup>th</sup> Cir. 1984).....	3
<i>Woods v. Lecureux</i> , 110 F.3d 1215, 1220 (6 <sup>th</sup> Cir. 1997).....	1

### Statutes

15 U.S.C. § 1125(d)(1)(A)(i) .....	2
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### Rules

FRE 403 .....	2, 3
FRE 702 .....	2
FRE 704 .....	1, 3

## **I. Factual Background**

Defendants' expert, John Berryhill, is an attorney. He issued an Expert Report and was deposed in this case.

## **II. Argument**

### **A. Defendants' Expert Berryhill's Legal Conclusions as to the Ultimate Issues of Bad Faith Intent Should Be Excluded**

FRE 704 is intended to avoid admission of opinions which would merely tell the jury what result to reach. FRE 704 Notes of Advisory Committee on Proposed Rules. Admittedly an expert may testify as to ultimate issues in a case, but such testimony must not amount to a legal conclusion, as it is for the judge alone to instruct the jury on the applicable principles of law at issue in the case. *See Shahid v. City of Detroit*, 889 F.2d 1543 (6th Cir. 1989); *see also Woods v. Lecureux*, 110 F.3d 1215, 1220 (6<sup>th</sup> Cir. 1997) ("It is, therefore, apparent that testimony offering nothing more than a legal conclusion-i.e., testimony that does little more than tell the jury what result to reach-is properly excludable under the Rules.").

Defendants' expert Berryhill provided an Expert Report on September 13, 2010. In that Expert Report, he concluded as follows:

1. "it is my opinion that bulk registration of internet domain names for the purpose of publishing advertising material does not demonstrate a bad faith intent to profit from trade or service marks." *See Exhibit A*, Expert Report ¶ 11.
2. "The behavior of responsible bulk domain registrants, in the continuing development of trademark filtering techniques and cooperative engagement with brand owners, in the registration of domain names based purely on



obtaining user traffic, does not evince a bad faith intent to profit from trade or service marks.” *See Exhibit A*, Expert Report ¶ 29.

Both of these statements amount to legal conclusions. In particular, Berryhill’s testimony specifically addresses one of the requisite elements of the ACPA, namely 15 U.S.C. § 1125(d)(1)(A)(i). It also tells the jury which result to reach regarding the ultimate issue in the case – whether Defendants had a bad faith intent to profit from Plaintiff’s marks. FRE 702 and the law of this Court requires such legal conclusions be deemed inadmissible. *See H.C. Smith Investments, L.L.C. v. Outboard Marine Corp.*, 181 F. Supp. 2d 746, 749 (W.D. Mich. 2002) (holding that courts must “not to allow expert testimony to infringe on its own authority to instruct as to the law or the jury’s authority to determine ultimate issues such as the **intent** of a party.”) (emphasis added).

Berryhill may indeed provide opinions and testimony concerning the practice of bulk domain name registration and monetization, but offering a legal conclusion that usurps the jury’s role regarding whether or not it evidences a bad faith intent or constitutes cybersquatting under the ACPA is entirely improper. As such, Paragraphs 11 and 29 as it relates to the legal conclusion that Defendants did not act in bad faith, along with any testimony mirroring the same, should be excluded.

Furthermore, in order to avoid undue prejudice or juror confusion under FRE 403, any testimony regarding what constitutes bad faith intent should be excluded from trial and not admissible as evidence. *See U.S. v. Gallon*, 257 F.R.D. 141 (E.D. KY 2009) (holding that expert’s, who was a lawyer, opinions regarding Defendants’ alleged good faith reliance on the Judge’s Orders were misleading, and thus inadmissible under FRE 403). This is supported by

the fact that Berryhill has no opinion as to whether or not Defendants engaged in bad faith cybersquatting in this particular case under these particular facts. *See Exhibit B*, Berryhill Deposition at pg. 128, lines 19-25. Berryhill's expert testimony regarding what constitutes bad faith cybersquatting is too prejudicial to Plaintiff, misleading and confusing to the jury, and thus inadmissible under FRE 403.

**B. Defendants' Expert Berryhill's Testimony Regarding the Law of the ACPA, Including Historical Developments of Cybersquatting, Should Be Excluded**

Berryhill provides testimony in his expert report entitled "Historical Development of Cybersquatting." *See Exhibit A*, Expert Report, Section IV.A., paragraphs 12-14. He recites both case law and the legislative history related to the ACPA. In doing so, his Expert Report reads more like a legal brief. He also interprets the ACPA throughout his deposition.

Following *United States v. Zipkin*, which held that allowing introduction of testimony by a bankruptcy judge testifying as an expert regarding the Bankruptcy Act was a prejudicial error, this Court should not allow Berryhill to testify regarding the ACPA. *United States v. Zipkin*, 729 F.2d 384, 386-87 (6<sup>th</sup> Cir. 1984). The legal knowledge of Your Honor, as supplemented by the jury instructions, would make any instruction on the ACPA by Berryhill "superfluous." *See id.* Thus, again, based upon FRE 704, this Court should exclude paragraphs 12-14 of Berryhill's Expert Report and preclude any testimony by Berryhill that instructs the jury as to the law of the ACPA, including its history and application.

**III. Conclusion**

For the reasons stated above, the Court should exclude:

1. any and all testimony, including that present in Berryhill's Expert Report (¶¶ 11, 29) regarding what constitutes bad faith intent as an inadmissible legal conclusion under FRE 704;
2. any and all testimony, including that present in Berryhill's Expert Report (¶¶ 11, 29) regarding what constitutes bad faith intent as unduly prejudicial to Plaintiff and in order to avoid any misleading of the jury under FRE 403;
3. any and all testimony, including that present in Berryhill's Expert Report (¶¶ 12-14) regarding the scope, history, and application of the ACPA under FRE 704.

WHEREFORE, for all of the above-stated reasons, this Honorable Court is respectfully asked to grant Plaintiff's Motion in Limine to Exclude Testimony of and Certain Portion of the Expert Report of Defendants' Expert John Berryhill.

Respectfully submitted this 24<sup>th</sup> day of February, 2012.

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## CERTIFICATE OF SERVICE

I hereby certify that on the 24<sup>th</sup> day of February, 2012, I electronically filed the foregoing paper with the Court using the ECF system which will send notification of such filing to the following:

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