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

THE WEATHER UNDERGROUND, INC.,
a Michigan corporation,

Plaintiff,

vs.

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

NAVIGATION CATALYST SYSTEMS, INC., a Delaware corporation; CONNEXUS CORP., a Delaware corporation; FIRSTLOOK, INC., a Delaware corporation; and EPIC MEDIA GROUP, INC., a Delaware corporation,

Defendants.

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CONNEXUS, FIRSTLOOK, AND NCS'S EVIDENTIARY OBJECTIONS AND RESPONSE TO PLAINTIFF'S MOTION IN *LIMINE* REGARDING JOHN BERRYHILL

MEMORANDUM OF POINTS AND AUTHORITIES

I. INTRODUCTION.

Mr. Berryhill's opinions are rooted in fact; will assist the jury in this matter; do not simply tell the jury how they should find in this case; and are, therefore, ultimately admissible.

II. ARGUMENT.

A. Mr. Berryhill's Admissible Opinions Will Assist the Jury.

As Plaintiff plainly concedes, "[a]n expert may testify as to ultimate issues in a case." Mot. at p. 1. That concession is plainly required in light of the federal rules. Fed. R. Evid. 704(a) ("An opinion is not objectionable just because it embraces an ultimate issue."); *U.S. v. Brawner*, 173 F.3d 966, 970 (6th Cir. 1999) (approving of trial court's decision to admit expert witness testimony citing Fed. R. Evid. 704(a)). Nevertheless, Plaintiff proceeds to argue that Mr. Berryhill's testimony potentially "usurps the jury's role," an argument that has already been deemed as "empty rhetoric." Fed. R. Evid. 704 Notes of Advisory Committee on Proposed Rules ("The basis usually assigned for the [no-ultimate-issues-testimony] rule, to prevent the witness from 'usurping the province of the jury,' is aptly characterized as 'empty rhetoric.'") *citing* 7 Wigmore § 1920, p. 17.

The actual test for admissibility is whether the expert's opinion will help the trier of fact. Fed. R. Evid. 702(a). Of course, there is a limitation on such expert testimony. "Expert opinions should not be admitted if they merely tell the jury what result to reach." *George S. Hofmesiter Family Trust Dated June 21, 1991 v. FGH Indus., LLC*, 2008 WL 1809216 (E.D. Mich. 2008) *citing Woods v. Lecureux*, 110 F.3d 1215, 1220 (6th Cir. 1997). The Advisory Notes to Federal Rule of Evidence 704 give a good example of this distinction:

> Thus, the question "Did T have capacity to make a will?" would be excluded, while the question "Did T have sufficient mental capacity to know the nature and extent of his property and the natural objects of his bounty and to formulate a rational scheme of distribution?" would be allowed.

With this example in mind, the Court should examine paragraphs 11 and 29 of the Berryhill Report.

Clearly, Mr. Berryhill is not going to be asked "Did the Defendants have a bad faith intent to profit from domain names that were confusingly similar to Plaintiff's marks?" That question would be similar to the example in the Advisory Notes that is forbidden because it simply tells the jury how to rule with no foundational facts. As Plaintiff correctly points out, Mr. Berryhill has no opinion on that question anyway. Mot. at p. 3.

But, Mr. Berryhill ***should*** be allowed to answer questions like: "What is bulk domain name registration?" "What is domain name monetization?" "What are the risks involved in bulk domain name registrations and domain name monetization?" "What practices might a bulk registrant engage if they were acting in good faith?"[1]

This last question is particularly important. This is not a criminal case where the jury will at least have some idea of the judicial process because they watch *Law & Order* or *CSI*. Nor is it a civil case about a contract, a concept with which many business people have some knowledge. It is a case involving a statute of which lay people are typically unaware and a business practice (e.g., bulk domain name registration and monetization) of which lay people are also unaware. Natural questions will arise: Is bulk registration inherently bad? Are there industry practices or industry customs in bulk registration? What can a bulk registrant do to

[1] Notably, Plaintiff concedes that "Berryhill may indeed provide opinions and testimony concerning the practice of bulk domain name registration and monetization…" Mot. at 2.

show they are not acting in bad faith? Mr. Berryhill has the knowledge and experience to provide the jury with that useful testimony. *See* Paragraphs 11 and 29 (discussing why bulk registration is not inherently wrong and the trademark filtering techniques and cooperative engagement with brand owners which evidence a lack of bad faith). He should be allowed to do so.

B. A Brief History of the ACPA Would Assist the Jury.

Plaintiff also seeks to prohibit Mr. Berryhill from providing the jury with a brief history of the ACPA. Plaintiff essentially argues that Mr. Berryhill's testimony on the history of the ACPA is equivalent to a jury instruction on its application. That is nonsense. The history of the ACPA is one thing; jury instructions on how it should be applied in this particular case are something altogether different (and not the subject of Mr. Berryhill's report).[2]

The primary question for this Court is: would some testimony on the background of the ACPA and the harm that it seeks to prevent assist the jury? The answer is obviously yes. As noted, above, the ACPA is a law that is likely to be foreign to the jury. The jury would greatly benefit from some background information about the ACPA, just as the Court has. As the Court will undoubtedly recall, in providing its earlier ruling on the Cross Motions for Partial Summary Judgment, this Court relied on the history of the ACPA (including citations to the legislative history) to assess the harm that the ACPA intended to redress and to explain its ruling. *See* Order, dated November 19, 2011, at p. 6 (examining reference to the Senate Report accompanying the ACPA and then stating "With this harm in mind, the Court considers the

[2] To the extent that Plaintiff complains that Berryhill "interprets the ACPA throughout his deposition" (Mot. at 3), Plaintiff has only itself to blame. After all, Plaintiff was asking the questions that resulted in Mr. Berryhill having to interpret the ACPA to provide an answer.

arguments.") (Docket No. 232). Just as the Court analyzed the parties' arguments after first considering the background of the ACPA, so, too, should the jury be afforded the opportunity to hear the background of the ACPA as they consider the parties' arguments.

Notably, at least one other district court has found it appropriate for an expert witness to provide a jury with the history of the ACPA. *Fancaster v. Comcast Corp.*, --- F. Supp. 2d ---, 2011 WL 6426292 *20 (D.N.J. December 22, 2011) ("Paragraphs 11-14 and 17 describe the origin and development of the system of Internet domain names and the problems created by cybersquatters. This provides a background for the enactment of the ACPA. In the present case, these are claims under the ACPA with which the jury will have to deal. This information in Mr. Lastowka's report will be of assistance to the jury as it deals with these claims.").

For these reasons, Mr. Berryhill should be allowed to testify on the background and history of the ACPA.

III. CONCLUSION.

Plaintiff's Motion seeks to exclude evidence that Defendants have not attempted to elicit from Mr. Berryhill; to wit, that in *this* case, Defendants did not violate the ACPA because they did not have the bad faith intent to profit from the registration of domain names that were confusingly similar to Plaintiff's marks.

Rather, Mr. Berryhill's opinions focus on an explanation of bulk domain name registration and industry practice. Even if Mr. Berryhill's actual opinions embrace an ultimate issue (e.g., that the business practice of trademark filtering evidences a lack of bad faith), these opinions are rooted in fact, not law, and are admissible opinions which assist the trier of fact. Lastly, Mr. Berryhill's explanation of the background of the ACPA will help assist the jury

understand a statute which they are unlikely to know. For the foregoing reasons, Plaintiff's motion should be denied.

Dated: February 27, 2012

Respectfully Submitted,

/s/William A. Delgado

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CERTIFICATE OF SERVICE

I hereby certify that on February 27, 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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