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.
_____/

Enrico Schaefer (P43506)
Brian A. Hall (P70865)
TRAVERSE LEGAL, PLC
810 Cottageview Drive, Unit G-20
Traverse City, MI 49686
231-932-0411
enrico.schaefer@traverselegal.com
brianhall@traverselegal.com
Lead Counsel for Plaintiff

Nicholas J. Stasevich (P41896)
Benjamin K. Steffans (P69712)
BUTZEL LONG, PC
150 West Jefferson, Suite 100
Detroit, MI 48226
(313) 225-7000
stasevich@butzel.com
steffans@butzel.com
Local Counsel for Defendants

Anthony Patti (P43729)
HOOPER HATHAWAY, P.C.
126 South Main Street
Ann Arbor, MI 48104
734-662-4426
apatti@hooperhathaway.com
Co-counsel for Plaintiff

William A. Delgado (admitted pro hac vice)
WILLENKEN WILSON LOH & LIEB LLP
707 Wilshire Blvd., Ste. 3850
Los Angeles, CA 90017
213-955-9240
williamdelgado@willenken.com
Lead Counsel for Defendants

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**PLAINTIFF'S RESPONSE TO DEFENDANTS' MOTION FOR PROTECTIVE ORDER**

NOW COME Plaintiff, by and through counsel, TRAVERSE LEGAL, PLC and HOOPER HATHAWAY, P.C., and hereby submits its response to Defendants' Motion for Protective Order and states as follows:

## I. Statement of the Issue Presented

Whether the Court should issue an order to protect Defendants from a second deposition of Seth Jacoby, on the eve of trial, for which Plaintiff did not seek leave of Court?

Defendants respectfully submit that the answer is "Yes."

Plaintiff respectfully submits that the question is inaccurate. As Defendants know, Plaintiffs are taking Mr. Jacoby's trial testimony in New York where he lives, as he allegedly no longer works for Defendants' companies and is outside this Court's subpoena power to compel him to attend trial in Detroit. Defendants' Motion scheduled for hearing two days before testimony is to be taken should be denied.

## II. Introduction

Defendants move to preclude Plaintiff from taking the de bene esse trial testimony of Firstlook's former President, Seth Jacoby. Defendants recently indicated that Mr. Jacoby, along with all but one other witness deposed in the case, no longer works for Defendants' companies. His most recent contact information was only begrudgingly provided to counsel for Plaintiff on February 7, 2012. Counsel for Plaintiff tried to contact Mr. Jacoby to arrange for his trial testimony, but Mr. Jacoby failed to respond. Accordingly, counsel issued a de bene esse subpoena to take Mr. Jacoby's trial testimony where he lives in New York on February 21, 2012, with service by hand on February 22, 2012. (***Exhibit A***, Executed Subpoena.) Testimony is

scheduled to be taken on Thursday, March 1, 2012, at 9:00 AM in New York. Defendant waited until today, February 27, 2012, to file this motion.

On November 11, 2011, counsel for Plaintiff asked about the status of witness' attendance at trial. In that letter, Plaintiff's counsel requested that contact information be provided for any witness no longer working for Defendants or any related company. (***Exhibit B***, November 11, 2012, letter to Delgado.) Counsel for Defendants responded on November 29, 2012, that only two key witnesses were still employed by Defendants for the purposes of trial. Defendants' counsel did not provide any contact information as previously requested. Instead, counsel suggested that Plaintiff read in the deposition testimony of Mr. Jacoby for trial.

On February 3, 2012, counsel for Plaintiff again asked for contact information for those witnesses which Mr. Delgado contented no longer worked for Defendants or related companies, noting that subpoenas would need to be issued for de bene esse depositions to preserve their trial testimony. (***Exhibit C,*** February 3, 2012, letter to Delgado.) Over two months after Plaintiff's counsel's original request, Defendants provided contact information for witnesses, including Seth Jacoby, on February 7, 2012. (***Exhibit D***, February 7, 2012, letter from Delgado.) Counsel noted "The various witnesses are all outside the subpoena power of the Eastern District of Michigan so it is unclear what you intend to send them." ***Exhibit D***, February 7, 2012, letter from Delgado.)

Clearly, Defendants don't want certain witnesses to have their trial testimony taken de bene esse. As of this last Sunday, and after repeated further requests, counsel is still largely non-committal about what 'former employees' they intend to bring to trial. (Exhibit E, email dated February 26, 2012.)

### A. Federal Rule of Civil Procedure 30(a) and 32 provide for Preserving Trial Testimony by De Bene Esse Deposition.

Under Fed. R. Civ. P. 32(a)(4), a party may use for any purpose the deposition of a witness, whether or not a party, if the court finds that the witness is more than 100 miles from the place of hearing or trial or is outside the United States, unless it appears that the witness's absence was procured by the party offering the deposition or that the party offering the deposition could not procure the witness's attendance by subpoena. In this case, Seth Jacoby lives in New York and, according to Defendants, no longer works for Defendant companies.

In *Charles v. Wade*, 665 F.2d 661 (5th Cir. 1982), the court noted the difference between a trial deposition and a discovery deposition, reversing the trial court's refusal to allow a de bene esse deposition to be taken for trial.

> "When appellant sought the court's leave to depose Nixon, the court denied permission on the basis that the discovery period had closed. This was clearly an inappropriate reason for denying appellant's motion to depose. Although the discovery period had indeed closed at the time appellant made his motion, the requested deposition would not have been taken for purposes of discovery but as the testimony of a witness unavailable for trial. Appellant's motion underscored this distinction by informing the court that the deposition would "not be taken for discovery purposes, but in lieu of Mr. Nixon's live testimony at trial." The distinction is a valid one. Appellant was not seeking to discover Nixon's testimony, appellant knew what Nixon had to say, but was seeking a means for introducing Nixon's testimony at trial. A party to a lawsuit obviously is entitled to present his witnesses. The fact that the discovery period had closed had no bearing on appellant's need, or his right, to have the jury hear Nixon's testimony. We hold that the court clearly erred in denying appellant's deposition motion on the ground stated in its order."

*Charles v. Wade*, 665 F.2d 661, 664 (5th Cir. 1982). It should be noted that in Wade, the deponent was in jail, which triggered the requirement to obtain leave of court before proceeding under Fed R. Civ P 30(a)("(t)he deposition of a person confined in prison may be taken only by

leave of court on such terms as the court prescribes."). In this case, Mr. Jacoby is simply beyond the subpoena power of this Court and, according to Defendants, no longer an employee of a party.

**B. Defendants Continue to Play Shell Games with Witnesses.**

Mr. Jacoby allegedly now works for a company called "Flipside." The flipside.com web site contains extremely illusive information about what the company does, stating: "We're a talented group of engineers and project managers who know how to create, manage, maintain, and monetize quality user experiences on the Internet. We're particularly talented when it comes to paid search and lead generation." (***Exhibit F***, Flipside website screenshot.) Interestingly, the Flipside home page contains a secure "Customer Login" with the flowing code from Defendants' firstlook.com and referring specifically to "domainparking.firstlook.com.":

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<div id="clientlogin"><a href="#">Customer Login</a></div>
<div id="form_wrapper" class="form_wrapper">
  <form class="login active" method="post"
action="https://domainparking.firstlook.com/Account/LogOn">
    <h3><a href="#" class="close">x</a>Customer Login</h3>
    <div>
      <label>Username:</label>
      <input id="username" name="username" type="text" />
    </div>
    <div>
      <label>Password:</label>
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            <input id="password" name="password" type="password" />
          </div>
          <div class="bottom">
            <input type="submit" value="Login"></input>
          </div>
        </form>
      </div>
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(***Exhibit G***, HTML Code for flipside.com.) Flipside.com is a domain previously owned by Navigation Catalyst Systems (or its precursor company), from 2004 until Sept, 2011, when it was flipped to an untraceable registrant called "Corporation Service Corp." (***Exhibit H***, Domain Tools WHOIS information.) "Flipside" was a trademark owned Navigation Catalyst Systems according to Defendants' counterclaims in the Verizon case. (***Exhibit I***, NCS Counterclaims, pgs. 14-15.) Flipside, LLC was a company that was owned by Navigation Catalyst Systems or "its related companies" as also noted in the NCS Counterclaims against Verizon.

By all appearances, Mr. Jacoby is working for a company using a domain name, trademark and software code of Defendants in this case. Defendants' representation that Mr. Jacoby no longer works for a company related to Defendants is highly suspect.

Since late November 2011, Plaintiff has been trying to identify the availability of witnesses for trial and has been trying to obtain contact information for supposed "former employees" who departure from the companies was not provided as part of Defendants duty to supplement its discovery responses. Defendants' motives for trying to avoid trial testimony from

Mr. Jacoby are unclear. As perhaps the most important witness in the case, the jury is entitled to more than his deposition transcript at trial.

Any inconvenience of travel to take this deposition is born by both parties and caused by Defendants continued tactics of obfuscation and delay. Because Mr. Jacoby is not responding for counsel's requests to contact us, it is not anticipated that Mr. Jacoby will cooperate in rescheduling.

## III. Conclusion

Obtaining de bene esse trial testimony is standard procedure. In this case, virtually every key defense witness in the case allegedly is no longer working for Defendants. Defendants' efforts to avoid trial testimony by Mr. Jacoby and limit Plaintiff to deposition testimony are transparent. This Court should deny Defendants' Motion for a protective order and order (a) the de bene esse deposition to proceed forward as scheduled or (b) on another date assuming Defense counsel can get Mr. Jacoby to agree to a schedule change which works for everyone's schedule.

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Respectfully submitted this 27th day of February, 2012.

/s/Enrico Schaefer
Enrico Schaefer (P43506)
Brian A. Hall (P70865)
TRAVERSE LEGAL, PLC
810 Cottageview Drive, Unit G-20
Traverse City, MI 49686
231-932-0411
enrico.schaefer@traverselegal.com
Lead Counsel for Plaintiff

Anthony P. Patti (P43729)
HOOPER HATHAWAY, PC
126 South Main Street
Ann Arbor, MI 48104
734-662-4426
apatti@hooperhathaway.com
Co-Counsel for Plaintiff

**CERTIFICATE OF SERVICE**

I hereby certify that on the 27th 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:

Enrico Schaefer (P43506)
Brian A. Hall (P70865)
TRAVERSE LEGAL, PLC
810 Cottageview Drive, Unit G-20
Traverse City, MI 49686
231-932-0411
enrico.schaefer@traverselegal.com
brianhall@traverselegal.com
Lead Counsel for Plaintiff

Nicholas J. Stasevich (P41896)
Benjamin K. Steffans (P69712)
BUTZEL LONG, PC
150 West Jefferson, Suite 100
Detroit, MI 48226
(313) 225-7000
stasevich@butzel.com
steffans@butzel.com
Local Counsel for Defendants

Anthony Patti (P43729)
HOOPER HATHAWAY, P.C.
126 South Main Street
Ann Arbor, MI 48104
734-662-4426
apatti@hooperhathaway.com
Co-counsel for Plaintiff

William A. Delgado (admitted pro hac vice)
WILLENKEN WILSON LOH & LIEB LLP
707 Wilshire Blvd., Ste. 3850
Los Angeles, CA 90017
213-955-9240
williamdelgado@willenken.com
Lead Counsel for Defendants

/s/Enrico Schaefer
Enrico Schaefer (P43506)
Brian A. Hall (P70865)
TRAVERSE LEGAL, PLC
810 Cottageview Drive, Unit G-20
Traverse City, MI 49686
231-932-0411
enrico.schaefer@traverselegal.com
Lead Counsel for Plaintiff