

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

Defendants.

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**NAVIGATION CATALYST SYSTEMS, INC.'S MOTION TO COMPEL FURTHER
RESPONSES AND PRODUCTION OF DOCUMENTS**

**NOTICE OF MOTION AND MOTION TO COMPEL FURTHER RESPONSES AND
PRODUCTION OF DOCUMENTS**

TO THIS HONORABLE COURT, ALL PARTIES, AND THEIR ATTORNEYS OF RECORD:

PLEASE TAKE NOTICE THAT, pursuant to Fed. R. Civ. P. 37(a), Defendant Navigation Catalyst Systems, Inc. hereby moves this Court for an order compelling Plaintiff The Weather Underground, Inc. to: (i) supplemental its responses to indicate whether responsive documents have been produced instead of stating that “relevant” documents would be produced; (ii) produce documents it has agreed to produce but, to date, has not produced; (iii) produce legible documents in the manner they are maintained in the ordinary course of business, and (iv) produce documents which it has refused to produce but which are nevertheless non-privileged and relevant, all within ten (10) days of the Court’s order hereon.

This Motion is based on the facts and arguments set forth in the accompanying Memorandum of Points and Authorities; to wit, that (i) the Federal Rules require a party to set forth clearly whether it is complying with a particular request and does not permit Plaintiff to unilaterally decide what is relevant; (ii) Weather Underground has had sufficient time to produce all documents it has agreed to produce; (iii) Weather Underground should be required to produce documents in a legible format in the manner they are kept in the ordinary course of business so that they can be analyzed properly; and (iv) Weather Underground’s objections to certain categories of documents are not merited and should be overruled, and the Court should order production.

This Motion is supported by the attached Memorandum of Points and Authorities, the Declaration of William A. Delgado filed concurrently herewith and the exhibits thereto, the case file, and the arguments of counsel that the Court would entertain at a hearing on this motion.

The parties have met and conferred, including telephonically on March 9 and 22, 2010. NCS has explained the nature of the motion, its legal basis and requested, but has not obtained, concurrence in the relief sought.

RESPECTFULLY SUBMITTED this 21st day of April, 2010.

/s/William A. Delgado

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MEMORANDUM OF POINTS AND AUTHORITIES

Statement of the Issues Presented

At issue in this Motion are four questions:

1. Whether Plaintiff is permitted to respond to a Request for Production by stating that it will produce “relevant” documents and proceed to make a unilateral decision as to relevancy?
2. Whether Plaintiff should be compelled to produce documents it originally stated it would produce but, to date, has not yet produced?
3. Whether Plaintiff should be compelled to produce documents that are legible and in the manner they are kept in the ordinary course of business?
4. Whether Plaintiff should be compelled to produce relevant, non-privileged documents despite its unmerited objections?

Controlling Authority

The controlling authority for this motion is Fed. R. Civ. P. 37(a) which permits a party to bring a motion before the Court to compel responses and the production of documents.

I. Introduction

This motion requests that Plaintiff be compelled to do four simple things.

First, Plaintiff should be compelled to provide supplemental responses to indicate that it will produce “responsive” documents as opposed to “relevant” documents. Plaintiff is not permitted to unilaterally decide what is or is not relevant and produce documents in accordance with its own determination.

Second, Plaintiff should be compelled to produce documents it agreed to produce nearly two months ago. There is no good reason why these documents have not been produced already.

Third, Plaintiff should be compelled to produce documents that are legible. This request is straightforward; NCS has the right to actually see what the documents in Plaintiff’s possession say. Moreover, Plaintiff’s documents should be produced as they are kept in the ordinary course of business, complete with color, graphics, photographs, etc. They should not have been produced as black and white TIFF images that provide none of the information required for a trademark infringement analysis.

Fourth, Plaintiff should be compelled to produce various categories of documents that are relevant to this matter such as financial documents (which are relevant to show whether Plaintiff’s marks are “famous” or have “commercial strength”), ownership documents (which are relevant to show which witnesses have a potential bias), and trademark files (which are relevant as to trademark validity).

As to each category, Plaintiff should be required to produce these documents within ten (10) days of the Court’s order hereon.

II. Statement of Facts

A. Background

Plaintiff Weather Underground, Inc. filed this trademark infringement lawsuit alleging that Defendant NCS (and other companies) purposefully registered and monetized domain names that were similar to Plaintiff's trademarks, WEATHER UNDERGROUND and the WUNDER marks, with a "bad faith" intent to profit from those domain names, in violation of various sections of the Lanham Act, including 15 U.S.C. § 1125(d), the Anti-Cybersquatting Consumer Protection Act ("ACPA").

B. Chronology of Discovery

NCS issued a First Set of Interrogatories and a First Set of Requests for Production to Plaintiff on January 21, 2010. Plaintiff responded to NCS's discovery on February 22, 2010 but did not provide a verification for its response to NCS's interrogatories and provided no documents. Plaintiff produced documents on March 22, 2010 and again on April 12, 2010. Declaration of William A. Delgado, dated April 21, 2010, at ¶¶ 2-4.

Plaintiff's document production violated Federal Rule of Civil Procedure 34(b)(2)(E)(i) which requires that "[a] party must produce documents as they are kept in the usual course of business or must organize and label them to correspond to the categories in the request." Despite this requirement, Plaintiff's production was disorganized. There was no attempt to categorize or label and the documents did not appear to be produced in the manner kept in the ordinary course of business. For example, letters to third parties and subpoenas in this matter were interspersed in the production in the midst of other documents such as screenshots and newspaper articles.

Delgado Decl. at ¶ 5. To make matters worse, many of the documents produced by Plaintiff are completely illegible while others are mostly illegible. Delgado Decl. at ¶¶ 6-7 and Exs. B and C.

Counsel for NCS has written to Plaintiff's counsel various times in an effort to resolve disputes relating to Plaintiff's responses and Plaintiff's production. Delgado Decl. at ¶ 8-11 and Exs. D-G. After all, certain issues (e.g., producing legible documents) should not require a motion. But, notably, NCS has received no reply whatsoever to its most recent letters of April 15, 2010 which immediately preceded this Motion.

Argument

I. PLAINTIFF SHOULD NOT BE ALLOWED TO UNILATERALLY DETERMINE WHAT IS RELEVANT.

In certain responses, Plaintiff only agreed to produce "relevant" documents making it impossible for NCS or this Court to determine what was produced and what was withheld as part of Plaintiff's production. *See, e.g.*, Plaintiff's Responses to Request Nos. 7, 10-14, 16, and 38. Such a response is plainly improper. *Young v. Reconstructive Orthopaedic Associates, II, P.C.*, 2004 WL 1813232 *2 (E.D. Pa. 2004) ("Courts have held that '[i]t is not for a party to determine, by a unilateral review of documentation, whether information is relevant to the case.'"); *Moore v. Kaye Ins. Associates*, 1995 WL 600244 *3 (S.D.N.Y.1995) ("[I]t is not for plaintiff to unilaterally determine what is and what is not relevant for discovery.") Indeed, as the *Koninklijke* case recently cited by Plaintiff itself in its own Motion to Compel indicates, NCS "should not be forced to rely on what [NCS] selectively identify[ies] as relevant [] information." *Koninklijke Philips Elecs. N.V. v. KXD Tech., Inc.*, 2007 U.S. Dist. LEXIS 13956, 22-23 (D. Nev. 2007).

Plaintiff should be compelled to supplemental its responses to Request Nos. 7, 10-14, 16, and 38 within ten (10) days to indicate that it will produce responsive documents in its possession, custody, and/or control without first making a unilateral determination as to their “relevancy.”

II. PLAINTIFF SHOULD BE COMPELLED TO PRODUCE DOCUMENTS IT HAS ALREADY AGREED TO PRODUCE.

In its Responses to Requests for Production dated February 22, 2010, Plaintiff stated it would produce documents in response to Request Nos. 1-2 and 34. It also stated that it was searching for responsive documents and would produce responsive documents in response to Request Nos. 18, 24, 25, 30, 31, and 32. *See* Plaintiff’s Responses at Delgado Decl. Ex. A. To date, however, Plaintiff has not produced documents in response to any of these requests nor supplemented its discovery responses to indicate that such documents have not been located. Delgado Decl. at ¶ 12.

It has been nearly two months since Plaintiff agreed to search and produce these documents. Plaintiff should be compelled to abide by its original response and produce responsive documents in its possession, custody, and/or control within ten (10) days.

III. PLAINTIFF SHOULD BE COMPELLED TO PRODUCE LEGIBLE DOCUMENTS AND IN THE MANNER THEY ARE MAINTAINED IN THE ORDINARY COURSE OF BUSINESS.

First, NCS’s request for legible documents is imminently reasonable. Attached as Exhibit B to the Delgado Declaration are exemplars of documents produced by Plaintiff which are illegible. A list of illegible documents was provided in the April 15, 2010 letter to Plaintiff’s

counsel, Enrico Schaefer but, to date, Plaintiff has not agreed to produce legible documents.

Plaintiff should be compelled to review its own production and re-produce legible copies of all illegible documents, including those identified in the April 15th letter¹, within ten (10) days.

Attached as Exhibit C to the Delgado Declaration are exemplars of several screenshots produced by Plaintiff. As can be seen, these screenshots are largely illegible. It is particularly unfair and improper for Plaintiff to produce illegible copies of these screenshots when it has the electronic source files (e.g., the JPEGs, BMPs, etc.) from which these copies were extracted. Those source files are not only legible but also undoubtedly capture such incidentals as color, font size, photographs, graphics, etc. in a way that the produced copies do not. All of these minute details are vitally important in a trademark matter. *See, e.g., Coca-Cola Co. v. Cleo Syrup Corp.*, 48 F. Supp. 567, 568 (D.C. Mo. 1942) (“The similarity or dissimilarity of a mark...is not determined by the examination of segregated parts of a mark, nor is it to be determined by the whole of the mark *without the accompanying arrangement, color and all other incidentals*. It must be determined by an inspection of the whole of the two marks *with all of their attributes...*”) (emphasis added). Plaintiff should be compelled to produce the electronic

¹ This list included: WU01207, WU01210, WU01775, WU01828, WU01850, WU02475, WU02618, WU02619-27, WU02861, WU02863, WU02876, WU2877, WU2879-86, WU02889, WU02890, WU02892, WU03386, WU03391, WU03398, WU03406, WU03408-10, WU03412, WU03413, WU03415, WU03418, WU03419, WU03421, WU03423-26, WU03428, WU03430-32, WU03435-37, WU03439, WU03440, WU03442, WU03444, WU03447, WU03452, WU03471, WU03698, WU03769, WU03770, WU03771-73, WU03890, WU03892, WU03899, WU03900, WU03902-04, WU03908, WU03918, WU03924-28, WU0393, WU03959, WU03961, WU03994, WU03997, WU03998.

source files for all screenshots that it has produced within ten (10) days so that NCS can adequately view these files.²

Second, NCS's request that documents be produced in the manner they are kept in the ordinary course of business is not only reasonable but required by the Federal Rules. *See* Fed. R. Civ. P. 34(b)(2)(E)(i). Plaintiff's production consisted entirely of black and white TIFF files despite the fact that the overwhelming majority of their documents actually exist in color. *See, e.g.*, Marketing Materials marked as WU03946-3958 (attached as Delgado Decl. Ex. H). Again, in a trademark case, things like color, layout, font size, graphics, etc. are extremely important in making a determination on similarity. Plaintiff should be compelled to produce documents in their native format so that their inherent qualities can be viewed and analyzed.

IV. PLAINTIFF'S OBJECTIONS SHOULD BE OVERRULED AND PLAINTIFF SHOULD BE COMPELLED TO PRODUCE RELEVANT, NON-PRIVILEGED DOCUMENTS.

As to certain categories of documents, Plaintiff has objected to producing documents altogether. For the reasons stated below, Plaintiff's objections should be overruled and Plaintiff should be compelled to produce documents in response to these requests.

A. Request Nos. 6, 28.

These requests call for the production of documents related to the application to register the Weather Underground Marks which are at issue in this lawsuit, including the trademark application files which evidence the application process with the United States Patent and

² As a separate matter from the legibility of such documents, these electronic source files should have been produced in their native format if they are maintained in that matter in the ordinary course of business. Fed. R. Civ. P. 34(b)(2)(E)(ii).

Trademark Office. It is unclear from Plaintiff's response whether it has agreed to produce any documents in response to these requests. It *is* clear, however, that Plaintiff has already stated in its Initial Disclosures³ that it has various "non-privileged, non-work product, relevant documents that are in its possession, custody or control and that tend to support Plaintiff's position in this case, including:...18. U.S. Patent and Trademark Office files for the following Serial and/or Registration numbers and any related proceedings: (a) 2281088, (b) 2297683, (c) 2308658, (d) 2324272, (e) 2318973, (f) 2447954, (g) 3527030, (h) 3647301, (i) 77755078, (j) 77755212, (k) 77755229."

Having stated that these documents are in its possession, custody, and/or control, and that it intends to rely on these documents and NCS having made a formal demand for such documents, Plaintiff is obligated to produce them. Admittedly, Plaintiff has produced some limited documentation in response to this request (e.g., Certificates of Registration), but it certainly has not produced the complete USPTO files or all communications with the USPTO, such as Office Actions during registration. Delgado Decl. at ¶ 14.

B. Request Nos. 12, 27

These requests call for Plaintiff's financial information and general ledger. Plaintiff has refused to produce any financial information on the basis that it is not seeking its own lost profits as a measure of damages. Notwithstanding this election of damages, this information is discoverable for a number of reasons.

First, Plaintiff has brought a claim for dilution pursuant to 15 U.S.C. § 1125(c). That claim is only available to owners of "famous" marks. In making the determination of whether a

³ Plaintiff's Initial Disclosures are attached as Exhibit I to the Delgado Decl.

mark is “famous,” the Lanham Act sets forth various factors that the court may consider including: (i) the duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties and (ii) the amount, volume, and geographic extent of sales of goods or services offered under the mark. 15 U.S.C. § 1125(c)(2)(A). Thus, as the statute makes clear, NCS is entitled to discovery as to the “extent” of the Plaintiff’s advertising (which can be determined, in part, by the amount of money spent on advertising) as well as the “amount, volume, and geographic extent of sales” which can *only* be determined through financial documentation.

Second, the amount of money garnered through sales and the amount spent on advertising is also relevant to whether Plaintiff has a “strong mark” for purposes of its False Designation of Origin claim pursuant to 15 U.S.C. § 1125(a). *See, Frisch’s Restaurants, Inc. v. Elby’s Big Boy of Steubenville, Inc.*, 670 F.2d 642, 648 (6th Cir. 1982) (adopting the Ninth Circuit’s *Sleekcraft* test for determining “likelihood of confusion” of which one factor is “strength of the plaintiff’s mark”); *GoTo.com, Inc. v. Walt Disney Co.*, 202 F.3d 1199, 1207 (9th Cir. 2000) (“This ‘strength’ of the trademark is evaluated in terms of its conceptual strength and ***commercial strength.***”) (emphasis added).

Third, in its Initial Disclosures Plaintiff has stated it intends to rely on this information. *See* Plaintiff’s Initial Disclosures, Categories of Documents Nos. 12-14 (identifying documents on “advertisement agreements and revenue model”, “volume of sales and money spent on advertising”, and “sales data”). Once again, it is improper for Plaintiff to refuse to produce documents that (i) it has identified in its Initial Disclosures, (ii) have been specifically requested, and (iii) are relevant and non-privileged.

Lastly, even if the Plaintiff elects statutory damages under the ACPA, Defendant should not be precluded from determining whether it has suffered any actual damage as the extent of actual damage, if any, would be relevant to the statutory damages inquiry, particularly since the ACPA provides for such a broad range (between \$1,000 and \$100,000 per domain name).

For the foregoing reasons, Plaintiff should be compelled to produce its financial documents from 2006 to the present within ten (10) days.

C. Request No. 22

This request calls for documents identifying the owners of Plaintiff. Plaintiff refuses to produce documents. Nevertheless, these documents are relevant and should be produced because the owner(s) of Plaintiff may be (indeed, almost certainly are) biased in Plaintiff's favor. *Cf. Competitive Edge, Inc. v. Staples, Inc.*, 2010 WL 1292464 (N.D. Ill. 2010) *12 (acknowledging possible bias by Plaintiff's owner but not discounting affidavit solely on that basis). NCS should be allowed to know which witnesses are owners so that they can be cross-examined about such bias.

D. Request No. 33.

This request calls for "documents evidencing, referring or relating to the Search Engine Optimization efforts for the domain names You own or control." Plaintiff has objected to producing documents because (i) they are not relevant and (ii) because it does not understand the term "Search Engine Optimization."

In ruling on these objections, the Court should consider Plaintiff's Request No. 44 to NCS which Plaintiff issued to NCS *before* NCS issued Request No. 33 to Plaintiff. Plaintiff's Request No. 44 called for "[a]ll Search Engine Optimization (SEO) efforts regarding (a) the

Domains At Issue and (b) each domain identified in response to Request # 35.” Clearly, Plaintiff believed that Search Engine Optimization (and any overlap on this issue) *was* relevant, and, certainly, it knew what the term meant. Otherwise, Plaintiff is admitting that it sent out irrelevant, vague requests, and Plaintiff is unlikely to admit as such. Thus, Plaintiff’s refusal to produce the very same documents it has requested of NCS on meritless objections is nothing short of gamesmanship.

Plaintiff should be compelled to produce responsive documents to this request within ten (10) days.

E. Request No. 34

This request calls for documents that evidence, refer, or relate to how visitors to Plaintiff’s websites heard of Plaintiff or otherwise learned of Plaintiff. These documents are absolutely crucial. NCS registers websites based on the premise of “direct navigation” (i.e., the idea that users will directly type something into a web browser address bar and add a TLD such as “.com” or “.net” on the end). Thus, for purposes of determining whether there is any overlap between potential visitors to each party’s respective websites and whether Plaintiff has suffered any harm, it is relevant whether Plaintiff’s visitors also use direct navigation or whether Plaintiff’s visitors arrive at its websites through other means (e.g., through a search engine, redirected from a third party website, etc.).

During the meet and confer process, Plaintiff’s counsel stated that Plaintiff would produce whatever documents it had that were responsive to this request. To date, no such documents have been produced. Plaintiff should be compelled to produce such documents within ten (10) days.

Conclusion

For the foregoing reasons, NCS respectfully requests that its Motion to Compel be granted in full.

RESPECTFULLY SUBMITTED this 21st day of April, 2010.

/s/William A. Delgado

William A. Delgado (admitted *pro hac vice*)

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CERTIFICATE OF SERVICE

I hereby certify that on April 21, 2010, 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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