



present record, outside the context of trial, that Respondent seeks to rely on its counsels' opinions, advice, or other privileged information in defense of this action, or that Complaint Counsel will be unable to effectively challenge the witnesses' trial testimony due to the privileged information withheld at their depositions." Order Denying Motion in Limine to Preclude Testimony of Bryan Pratt and Mark Miller at 2 (April 3, 2017). The Court further instructed the parties that its "Order is not a determination as to the admissibility of any particular testimony that may be offered at trial." *Id.* at 4. Accordingly, Complaint Counsel submits this trial brief to explain the objections that appear most likely to arise regarding Mr. Pratt's testimony.

ARGUMENT

Based on Respondent's previous briefing and representations, we understand that a principal focus of Mr. Pratt's testimony will be "factual issues regarding 1-800-Contacts' trademark cease-and-desist letters and litigation, including issues addressed in the Complaint or by the retailer witnesses' testimony on which Complaint Counsel intend to rely." Respondent 1-800 Contacts, Inc.'s [Amended] Opposition to Complaint Counsel's Motion *In Limine* to Preclude the Testimony of Messrs. Bryan Pratt, Esq. and Mark Miller, Esq. at 1 (March 28, 2017) (hereinafter, "Resp. Opp. to MIL"). Mr. Pratt might permissibly recount the contents of the complaints filed against Respondent's competitors and testify as to the allegations that were made. However, Mr. Pratt should not be permitted to testify to the truth of any allegations made in complaints, correspondence, or conversations, because Respondent broadly asserted privilege over the factual basis of the complaints' allegations,¹ as well as the investigation that Mr. Pratt

conducted before preparing complaints.²

Likewise, Respondent anticipates that Mr. Pratt will testify regarding “oral and written communications and negotiations with counsel (and, in some instances, employees) of

Q. Next paragraph, paragraph 21, Memorial Eye's actions are specifically aimed at diverting web users who are expressly looking for 1-800 Contacts and the 1-800 Contacts goods and services is the first sentence of that paragraph. Did I read that correctly?

MR. STONE: Objection. Improper as to form. Document speaks for itself. Best evidence.

THE WITNESS: So far as I tracked it.

Q. (By Mr. Matheson) Okay. What evidence did you have before you filed this complaint that Memorial Eye's actions were specifically aimed at diverting web users who were expressly looking at 1-800 Contacts?

MR. STONE: Instruct you not to answer on the grounds of attorney work product.

Q. (By Mr. Matheson) Follow that instruction?

A. I am.

Q. What empirical evidence have you seen that web users who are expressly looking for 1-800 Contacts were actually diverted by Memorial Eye's actions?

MR. STONE: Same objection; same instruction.

Q. (By Mr. Matheson) Are you going to refuse to answer based on the advice of counsel?

A. I am.

See Exhibit A (Dec. 15 Dep. Tr. and Jan. 5 Dep. Tr. (together, “Dep. Tr.”)) at 195:15-196:17.

² Mr. Pratt refused to testify as to the investigations he conducted prior to filing lawsuits:

Q. (By Mr. Matheson) . . . [W]hat other things did you investigate prior to filing a lawsuit against Lens.com?

A. And I'll refuse to answer that based on attorney-client privilege, work product.

...

Q. Did you always investigate factors other than a screenshot indicating the appearance of an advertisement on a search engine results page prior to filing a lawsuit on behalf of 1-800 Contacts relating to the display of search advertising?

MR. STONE: I think you can answer that yes or no.

THE WITNESS: Yes.

Q. (By Mr. Matheson) If I asked you in any specific case what were those factors, would you decline to answer in order to protect a privilege?

A. Unless there's an instance where the privilege has already been waived, yes.

Dep. Tr. at 95-96.

Respondents' competitors regarding trademark issues." Resp. Opp. to MIL at 1. Mr. Pratt might be able to recount the conversations he had with third parties, inasmuch as these communications are not privileged. However, because Mr. Pratt regularly refused to testify as to his legal analysis underlying these conversations,³ these statements can be admitted only to prove that Mr. Pratt made the statement, and not for the purpose of suggesting that the position that Respondent took was well-founded or supportable. *Cary Oil Co. v. MG Ref. & Mktg.*

227, 236.⁴ In light of these assertions of privilege, Mr. Pratt should not be permitted to testify regarding the truth of statements made in complaints and other documents.⁵



CERTIFICATE FOR ELECTRONIC FILING

I certify that the electronic copy sent to the Secretary of the Commission is a true and correct copy of the paper original and that I possess a paper original of the signed document that is available for review by the parties and the adjudicator.

April 27, 2017

By: /s/ Daniel J. Matheson
Attorney