

1 John D. Vaughn, State Bar No. 171801  
Jeffrey A. Feasby, State Bar No. 208759  
2 Christopher W. Rowlett, State Bar No. 257357  
PEREZ VAUGHN & FEASBY Inc.  
3 600 B Street, Suite 2100  
San Diego, California 92101  
4 Telephone: 619-702-8044  
Facsimile: 619-460-0437  
5 E-Mail: vaughn@pvflaw.com

6 Jeffrey L. Fillerup, State Bar No. 120543  
Rincon Law LLP  
7 90 New Montgomery St  
Suite 1400  
8 San Francisco, California 94105  
Telephone: (415) 996-8199  
9 Facsimile: (415) 996-8280  
E-Mail: jfillerup@rinconlawllp.com

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11 Attorneys for Defendant and Counterclaimant  
Windermere Real Estate Services Company  
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13 **UNITED STATES DISTRICT COURT**  
14 **CENTRAL DISTRICT OF CALIFORNIA**

15 BENNION & DEVILLE FINE  
HOMES, INC., a California  
16 corporation, BENNION & DEVILLE  
FINE HOMES SOCAL, INC., a  
17 California corporation, WINDERMERE  
SERVICES SOUTHERN  
18 CALIFORNIA, INC., a California  
corporation,

19 Plaintiffs,

20 v.

21 WINDERMERE REAL ESTATE  
22 SERVICES COMPANY, a Washington  
corporation; and DOES 1-10  
23

24 Defendant.

25  
26  
27 **AND RELATED COUNTERCLAIMS**  
28

Case No. 5:15-CV-01921 R (KKx)

Hon. Manuel L. Real

**OPPOSITION TO PLAINTIFFS  
AND COUNTER-DEFENDANTS'  
MOTION *IN LIMINE* TO  
PRECLUDE DEFENDANT FROM  
INTRODUCING EVIDENCE THAT  
B&D FINE HOMES WAS  
OBLIGATED TO TRANSFER  
DOMAINS AND EVIDENCE OF  
EXPENSES FOR OBTAINING  
DOMAIN NAMES**

Date: May 15, 2017

Time: 10:00 a.m.

Courtroom: 880

Complaint Filed: September 17, 2015

1           Once again, Counter-Defendants Bennion & Deville Fine Homes, Inc. (“B&D  
2 Fine Homes”), Bennion & Deville Fine Homes SoCal, Inc. (“B&D SoCal”),  
3 Windermere Services Southern California, Inc. (“WSSC”), Robert L. Bennion and  
4 Joseph R. Deville (collectively, “Counter-Defendants”) ask the Court to make a  
5 factual determination through an improper and overreaching motion *in limine*. This  
6 time, Counter-Defendants ask the Court to find, as a matter of law, that B&D Fine  
7 Homes was not required to transfer the Windermere mark or domain names to  
8 Defendant and Counterclaimant Windermere Real Estate Services Company  
9 (“WSC”) at the time B&D Fine Homes’ franchise agreement was terminated. They  
10 further request that the Court preclude WSC from presenting any evidence contrary  
11 to that finding. This is an improper use of a motion *in limine*. *Hana Financial, Inc.*  
12 *v. Hana Bank*, 735 F.3d 1158, 1162, n. 4 (9th Cir. 2013) (“A motion in limine is not  
13 the proper vehicle for seeking a dispositive ruling on a claim, particularly after the  
14 deadline for filing such motions has passed.”)

15           Whether B&D Fine Homes was obligated to return the Windermere mark  
16 and/or domain names utilizing that mark pursuant to the franchise agreement is a  
17 question of fact for the jury. Thus, WSC plainly must be permitted to present  
18 evidence of B&D Fine Homes’ failure and refusal to transfer this intellectual  
19 property to WSC, as well as evidence of the associated expenses.

20 **I. FACTUAL BACKGROUND AND ARGUMENT**

21           On August 1, 2001, B&D Fine Homes and WSC entered into the Windermere  
22 Real Estate License Agreement (the “Coachella Valley Agreement”). (Document  
23 No. 99-2, Deville Decl. ¶ 3.) Paragraph 3 of the Coachella Valley Agreement  
24 states, in its entirety:

25           Ownership of Trademark. WSC expressly reserves the sole and  
26 exclusive ownership of the name and any associated trademark, service  
27 mark, logotype or trade name using the words “Windermere Real  
28 Estate,” “Windermere” or any form thereof or variation thereon (the  
“Trademark”) and the Windermere System. Licensee agrees not to use  
such name or any combination of the words, with or without any other  
word or words, as part of its corporate name or for the purpose of

1 advertising its business, except in accordance with this Agreement, and  
2 in accordance with all approved reasonable standards of usage issued  
3 from time to time in writing by WSC. *Upon request by WSC,*  
4 *Licensee shall cooperate fully and in good faith assist WSC to the*  
*extent necessary in the procurement of any protection of or to protect*  
*any of WSC's rights in and to the Trademark and the Windermere*  
*System or any rights pertaining thereto.*

5 (Document No. 99-2, Ex. A, ¶ 3) (emphasis added). B&D Fine Homes owned  
6 hundreds of domains containing the Windermere name or a derivation thereof.  
7 (Document No. 99-2, ¶ 4.) After B&D Fine Homes terminated the Coachella Valley  
8 Agreement, WSC asked B&D Fine Homes to transfer those marks to WSC.  
9 B&D Fine Homes refused. Indeed, rather than return the domain names to WSC as  
10 requested, B&D Fine Homes deliberately and systematically released those domain  
11 names to the public, forcing WSC to expend time and resources to reacquire those  
12 domains on the open market. Whether B&D Fine Homes' refusal to transfer the  
13 domain names and instead release those domain names to the public violated its  
14 contractual obligation to "cooperate fully and in good faith" with an express request  
15 by WSC to protect its rights in the Windermere Trademark *is a question of fact for*  
16 *the jury. See Palmiero v. Spada Distributing Co., 217 F.2d 561, 565 (9th Cir. 1954)*  
17 (reversing trial court and holding that determining breach of contract is a question of  
18 fact for the jury). Thus, evidence regarding how B&D Fine Homes handled the  
19 domain names after termination of the Coachella Valley Agreement, and WSC's  
20 damages arising from that conduct, is highly relevant and admissible. (Fed. R. Evid.  
21 401, 402.) And because B&D Fine Homes admits that it owned the domain names,  
22 there is no danger the jury will be confused or that any party will be unfairly  
23 prejudiced.

## 24 **II. CONCLUSION**

25 Because this is a question of fact for the jury, Defendant and Counterclaimant  
26 Windermere Real Estate Services Company respectfully requests that the Court  
27 deny Counter-Defendants' Motion *in Limine* to Preclude WSC from Introducing  
28 Evidence that B&D Fine Homes was Obligated to Transfer Domains and Evidence

1 of Expenses for Obtaining Domain Names in its entirety. WSC should be permitted  
2 to: (1) present evidence that B&D Fine Homes refused to transfer their Windermere-  
3 related domains and instead released them to the public; (2) argue this conduct  
4 constitutes a breach of the Coachella Valley Agreement; and (3) present evidence of  
5 expenses and other damages incurred as a result of this breach.

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DATED: April 24, 2017                      PEREZ VAUGHN & FEASBY INC.

By: /s/ Jeffrey A. Feasby  
Jeffrey A. Feasby  
Attorneys for  
Windermere Real Estate Services Company