

UNITED STATES DISTRICT COURT  
DISTRICT OF CONNECTICUT

WHITSERVE, LLC,  
Plaintiff,

v.

GODADDY.COM, INC.  
Defendant.

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CIVIL ACTION NO.  
3:11-CV-948 (JCH)

DECEMBER 15, 2011

**RULING RE: DEFENDANT’S MOTION TO DISQUALIFY COUNSEL (DOC. NO. 67)**

**I. INTRODUCTION**

Plaintiff, Whitserve, LLC (“Whitserve), brings this action against GoDaddy.com, Inc. (“GoDaddy.com”), alleging that GoDaddy.com has infringed WhitServe’s patents, in violation of 35 U.S.C. § 271, et seq. GoDaddy.com has filed a Motion to Disqualify Whitserve’s law firm, St. Onge, Steward, Johnston, & Reens (hereafter “SSJR”), pursuant to Local Rule 83.13.

For the reasons set forth below, the Motion is granted.

**II. BACKGROUND**

GoDaddy.com filed this Motion on October 12, 2011. See Doc. No. 67. Whitserve opposed the Motion on November 7, 2011, and GoDaddy.com submitted a reply brief on November 10, 2011. See Doc. Nos. 79, 80. On November 16, 2011, the court held oral argument on this Motion, as well as other motions that were pending at the time. See Doc. No. 83. The court took this Motion under advisement. See id.

On December 8, 2011, GoDaddy.com filed a Motion for Leave to File a Supplemental Record in support of their Motion to Disqualify Counsel, which was later

amended. See Doc. Nos. 88, 90, 93. The court granted leave to file the supplement. See Doc. No. 92.

### **III. DISCUSSION**

Pursuant to Local Rule 83.13, “[a] lawyer shall not accept employment in contemplated or pending litigation if he or she or a lawyer in the same firm ought to be called as a witness,” unless the testimony will relate solely to an uncontested matter, the testimony will relate solely to a matter of formality, or the testimony will relate solely to the nature and value of the legal services performed on behalf of the client. See L.R. 83.13(a). Similarly, Local Rule 83.13(b) provides that, if it becomes apparent after undertaking employment in contemplated or pending litigation that a client’s lawyer or another lawyer from the same firm “ought to be called as a witness on behalf of the client,” the lawyer or law firm shall withdraw from the trial unless the exceptions listed above apply. See 83.13(b).

Wesley Whitmyer is the sole inventor of the patents at issue in this case, and he is a member of SSJR. See Whitmyer Decl. at ¶¶ 4, 21. It is undisputed that Whitmyer will be a key witness at trial for both parties. See Mem. Supp. Summ. J. at 1–2; Mem. Opp. Summ. J. at 2. Similarly, it appears to be undisputed that Whitmyer’s testimony will not be related solely to uncontested issues, matters of formality, or the value of legal services. See Mem. Supp. Summ. J. at 9; Mem. Opp. Summ. J. at 8. It is clear that, under a literal reading of Local Rule 83.13, especially subsection (a), SSJR should be disqualified as counsel for Whitserve, as an attorney from SSJR will be a key witness at trial.

The court is mindful, however, of the Second Circuit's decision in Bottaro v. Hatton Associates, interpreting language nearly identical to Local Rule 83.13(b), and holding that a "lawyer-litigant-witness" is entitled to select a law partner as trial counsel. See 680 F.2d 895, 897 (2d Cir. 1982). In this court's opinion, however, Bottaro is distinguishable from this case and, consequently, is not controlling for the purposes of this Motion.

First, Whitmyer is not the plaintiff in this case. Whitmyer is one of three members, and the managing member of the plaintiff, Whitserve, LLC, but is not named personally as a plaintiff. See id. at ¶ 3. Consequently, Whitmyer does not fit the role of "lawyer-litigant-witness" as contemplated by Bottaro because Whitmyer the witness is not a litigant. As a result, Whitmyer's personal interest in choosing SSJR as counsel is lessened. In addition, this court is mindful of the Bottaro court's analysis of the purpose of the Rule:

DR5-102(A) of the ABA Model Code,<sup>1</sup> however, impacts principally upon two situations: 1) where a lawyer acts both as a witness and as an advocate, and 2) where the trial counsel's law partner is a witness but not a party. In Flanzer, we stated that DR5-102(A) serves the threefold purpose of avoiding: 1) a situation in which "the public might think that the lawyer [as witness] is distorting the truth for the sake of the client," 2) the possibility that the lawyer will enhance his or her credibility as an advocate by virtue of having taken an oath as a witness, and 3) the "unfair" and "difficult" situation which arises when an opposing counsel must cross-examine a lawyer-adversary and impeach his or her credibility. These purposes are not implicated when a lawyer is a litigant as well as a witness, but not an advocate, even though a member of his or her firm is trial counsel. The role of the lawyer-litigant-witness is confined to testifying and his or her interest in the outcome of the litigation is clear to the trier of fact. No confusion of role or undue enhancement of advocacy results where the lawyer-witness' lack of disinterestedness is evident from his or her status as a party-litigant.

Bottaro, 680 F.2d at 897 (internal citations omitted) (emphasis added). In this case, while Whitmyer is the managing member of Whitserve, he is not a party litigant. The

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<sup>1</sup> The language of DR5-102(A) is essentially identical to the language of Local Rule 83.13(b).

court concludes that Whitmyer's interest will not be clear to the jury, and he will more likely be viewed by the jury as an attorney in plaintiff counsel's firm, not as the plaintiff in the case.

Second, GoDaddy.com has produced evidence demonstrating SSJR's involvement with prosecuting the patents at issue and helping to reduce the patented invention to practice. See Mem. Supp. Mot. at Ex. D, Ex. E; Caulfield Aff., Ex. 4 (noting that St. Onge hired a full-time programmer to help design the system). Consequently, GoDaddy.com raises concerns that were not apparent in the Bottaro case, such as the possibility that allowing SSJR access to confidential business information could be detrimental to GoDaddy.com's business interests, as SSJR remains counsel involved in competitive decision-making with regard to these patents. See, e.g., In re Deutsche Bank Trust Co. Ams., 605 F.3d 1373, 1379 (Fed. Cir. 2010) ("The concern over inadvertent disclosure manifests itself in patent infringement cases when trial counsel also represent the same client in prosecuting patent applications before the PTO.").

As the court finds that Bottaro is not controlling in this situation, Local Rule 83.13 governs. Consequently, as Whitmyer is an attorney at SSJR and a key witness in this litigation, SSJR may not represent Whitserve, pursuant to Local Rule 83.13(a) and (b).

**III. CONCLUSION**

For the reasons set forth above, GoDaddy.com's Motion to Disqualify Counsel is **granted** (Doc. No. 67).

**SO ORDERED.**

Dated at Bridgeport, Connecticut this 15th day of December, 2011.

/s/ Janet C. Hall  
Janet C. Hall  
United States District Judge