

ESTTA Tracking number: **ESTTA279254**

Filing date: **04/20/2009**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

Name	Facebook, Inc.
Granted to Date of previous extension	04/19/2009
Address	156 University Avenue Palo Alto, CA 94301 UNITED STATES

Attorney information	Christine K. Hsieh Cooley Godward Kronish LLP 3000 El Camino Real Palo Alto, CA 94306 UNITED STATES trademarks@cooley.com, chsieh@cooley.com Phone:650-843-5000
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**Applicant Information**

Application No	77481593	Publication date	10/21/2008
Opposition Filing Date	04/20/2009	Opposition Period Ends	04/19/2009
Applicant	Leaders2020 Inc. 3056 Dante Court San Jose, CA 95135 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 035. All goods and services in the class are opposed, namely: Providing a website for consumers to express and share opinions on companies
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**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

**Marks Cited by Opposer as Basis for Opposition**

U.S. Registration No.	3041791	Application Date	02/24/2005
Registration Date	01/10/2006	Foreign Priority Date	NONE
Word Mark	THEFACEBOOK		

Design Mark	<h1>FACEBOOK</h1>
Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 2004/02/04 First Use In Commerce: 2004/02/04 providing an online directory information service featuring information regarding, and in the nature of, collegiate life, classifieds, virtual community and social networking Class 038. First use: First Use: 2004/02/04 First Use In Commerce: 2004/02/04 providing online chat rooms for registered users for transmission of messages concerning collegiate life, classifieds, virtual community and social networking

U.S. Registration No.	3122052	Application Date	02/24/2005
Registration Date	07/25/2006	Foreign Priority Date	NONE

Word Mark	FACEBOOK
Design Mark	<h1>FACEBOOK</h1>
Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 2004/11/16 First Use In Commerce: 2004/11/16 providing an online directory information service featuring information regarding, and in the nature of, collegiate life, classifieds, virtual community and social networking Class 038. First use: First Use: 2004/11/16 First Use In Commerce: 2004/11/16 providing online chat rooms for registered users for transmission of messages concerning collegiate life, classifieds, virtual community and social networking

U.S. Application No.	78920322	Application Date	06/29/2006
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	FACEBOOK		

Design Mark	<b>FACEBOOK</b>
Description of Mark	NONE
Goods/Services	<p>Class 035. First use:          Providing an online directory information service featuring information regarding, and in the nature of, collegiate life, general interest, classifieds, virtual community, social networking, photo sharing, and transmission of photographic images; advertising and information distribution services, namely, providing classified advertising space via the global computer network; promoting the goods and services of others over the Internet; providing on-line computer databases and on-line searchable databases in the field of collegiate life, general interest, classifieds, virtual community, social networking, photosharing, video sharing, and transmission of photographic images</p> <p>Class 038. First use:          Providing online chat rooms and electronic bulletin boards for registered users for transmission of messages concerning collegiate life, general interest, classifieds, virtual community, social networking, photo sharing, and transmission of photographic images</p> <p>Class 042. First use:          Computer services, namely, hosting online web facilities for others for organizing and conducting online meetings, gatherings, and interactive discussions; and computer services in the nature of customized web pages featuring user-defined information, personal profiles and information</p> <p>Class 045. First use:          Internet based introduction and social networking services</p>

U.S. Application No.	77189479	Application Date	05/24/2007
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	FACEBOOK		
Design Mark	<b>FACEBOOK</b>		
Description of	NONE		

Mark	
Goods/Services	<p>Class 009. First use: Software to enable uploading, posting, showing, displaying, tagging, blogging, sharing or otherwise providing electronic media or information over the Internet or other communications network</p> <p>Class 038. First use: Audio and video broadcasting services over the Internet or other communications network, namely, uploading, posting, showing, displaying, tagging and electronically transmitting information, audio, and video clips; providing on-line chat rooms, listservers, and on-line forums for transmission of messages among computer users concerning user-defined content; providing on-line chat rooms and electronic bulletin boards for transmission of messages among users in the field of general interest</p> <p>Class 041. First use: On-line journals, namely, blogs featuring user-defined content</p> <p>Class 042. First use: Application service provider (ASP) featuring software to enable uploading, posting, showing, displaying, tagging, blogging, sharing or otherwise providing electronic media or information over the Internet or other communications network</p>

U.S. Application No.	77039123	Application Date	11/07/2006
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	FACEBOOK
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Design Mark	
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Description of Mark	NONE
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Goods/Services	<p>Class 009. First use: Computer software development tools for social networking, building social networking applications and for allowing data retrieval, upload, access and management; application programming interface (API) for third-party software and online services for social networking, building social networking applications and for allowing data retrieval, upload, access and management</p> <p>Class 038. First use: providing access to computer databases; electronic transmission of instant messages and data</p> <p>Class 041. First use: Electronic publishing services, namely, publishing of online works of others featuring user-created text, audio, video, and graphics; providing on-line journals and web logs featuring user-created content</p> <p>Class 042. First use:</p>
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	Providing temporary use of non-downloadable software applications for classifieds, virtual community, social networking, photo sharing, video sharing, and transmission of photographic images
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U.S. Application No.	78962629	Application Date	08/29/2006
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	FACEBOOK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: Clothing for men, women and children, namely, shirts, t-shirts, belts, jackets, coats, tops, vests, blouses, jerseys, bottoms, shorts, pants, trousers, boxer shorts, dresses, skirts, neckties, scarves, bandannas, night gowns, night shirts, pajamas, loungewear, socks, sweaters, sweat shirts, sweat pants, cummerbunds, aprons, headwear, hats, caps; sun visors; slippers		

U.S. Application No.	77125103	Application Date	03/07/2007
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	FACEBOOK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 018. First use: Bags, namely, all purpose sports bags, all purpose carrying bags, bags and hold-alls for sports clothing, tote bags, duffle bags, backpacks, beach bags, belt bags, book bags, carry-all bags, clutch bags, cosmetic bags sold empty, gym bags; leather and imitations of leather; animal skins and hides; trunks for traveling and traveling bags; umbrellas; parasols; walking sticks; pocket books;		

	<p>handbags; wallets; credit card cases; drawstring pouches; attach-<sup>™</sup>cases; briefcase-type portfolios</p> <p>Class 020. First use: Plastic key rings; plastic novelty license plates; indoor and outdoor furniture; picture frames; wood boxes; pillows; cushions; inflatable plastic signs; plastic boxes; non-electric fans for personal use; mirrors; figurines made of plastic, wood, ivory, fabric, plaster, wax, bone, and cold-cast resin; non-metal clips for bags</p> <p>Class 021. First use: Beverage glassware; insulating sleeves for beverage cans; insulating sleeves for beverage bottles; portable can coolers; portable bottle coolers; thermally insulated containers for food and beverages; portable plastic coolers; portable metal coolers; coasters not of paper and not being table linen; bottle openers; pitchers; plastic buckets; plastic cups; serving trays not of precious metal; bottle stands; mugs; cups; foam drink holders; storage jars; glass and porcelain giftware, namely, vases, ornaments, plates, cups, jars, and decorative boxes; figurines made from glass, porcelain, ceramics, earthenware, and china</p>
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U.S. Application No.	77589935	Application Date	10/09/2008
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	FACEBOOK FOR GOOD		
Design Mark	 <b>FACEBOOK FOR GOOD</b>		
Description of Mark	NONE		
Goods/Services	<p>Class 035. First use: Charitable services, namely, promoting public awareness about charitable, philanthropic, volunteer, public and community service and humanitarian activities; contest and incentive award programs designed to recognize and reward individuals and groups which engage in self-improvement, self-fulfillment, charitable, philanthropic, volunteer, public and community service, and humanitarian activities; hosting a community featuring shared communications between community members interested in self-improvement, self-fulfillment, charitable, philanthropic, volunteer, public and community service, and humanitarian activities all via global communication networks; providing social networking services via global communication networks; providing social services and information in the field of personal development, namely self-improvement, self-fulfillment, charitable, philanthropic, volunteer, public and community services, and humanitarian activities</p>		

U.S. Application No.	77321801	Application Date	11/05/2007
Registration Date	NONE	Foreign Priority	NONE

		Date	
Word Mark	FACEBOOK PAGES		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use:  Computer software development tools for social networking, building social networking applications and for allowing data retrieval, upload, access and management; application programming interface (API) for use with third-party software and for use with online services for social networking, building social networking applications and for allowing data retrieval, upload, access and management; Software to enable uploading, posting, showing, displaying, tagging, blogging, sharing or otherwise providing electronic media or information over the Internet or other communications network</p> <p>Class 035. First use:  Providing an online directory information service featuring information regarding, and in the nature of, collegiate life, general interest, classifieds, virtual community, social networking, photo sharing, and transmission of photographic images; advertising and information distribution services, namely, providing classified advertising space via the global computer network; promoting the goods and services of others over the Internet; providing on-line computer databases and on-line searchable databases in the field of classifieds</p> <p>Class 038. First use:  Providing online chat rooms and electronic bulletin boards for registered users for transmission of messages concerning collegiate life, general interest, classifieds, virtual community, social networking, photo sharing, and transmission of photographic images; telecommunication services, namely, worldwide switched text and message transmission services, electronic message sending and outcall notification services; providing electronic and digital transmission of voice, data, images, signals, and messages in relation to using mobile devices, namely, to look up user profile information, search for users, send messages to users, post information viewable by users, add contacts, and provide notifications; Audio and video broadcasting services over the Internet or other communications network, namely, uploading, posting, showing, displaying, tagging and electronically transmitting information, audio, and video clips; providing multiple use access to global computer information networks for the transfer and dissemination of a wide range of information, namely, providing access to information, audio, and video via websites, online forums, chat rooms, listservs and blogs over the Internet; Providing access to computer databases; electronic transmission of instant messages and data; providing on-line computer databases and on-line searchable databases in the fields of transmission of photographic images, provision of virtual communities, and provision of on-line forums for communications on topics of general interest</p> <p>Class 041. First use:  Providing on-line computer databases and on-line searchable databases in the</p>		

	<p>fields of collegiate interest; photosharing and video sharing</p> <p>Class 042. First use:  Computer services, namely, hosting online web facilities for others for organizing and conducting online meetings, gatherings, and interactive discussions; and computer services in the nature of customized web pages featuring user-defined information, personal profiles and information; Application service provider (ASP) featuring software to enable uploading, posting, showing, displaying, tagging, blogging, sharing or otherwise providing electronic media or information over the Internet or other communications network; Providing temporary use of non-downloadable software applications for posting and reading classifieds, for creating and maintaining virtual communities, for social networking, photo sharing, video sharing, and transmission of photographic images</p> <p>Class 045. First use:  Internet based introduction and social networking services; providing on-line computer databases and on-line searchable databases in the fields of social networking</p>
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U.S. Application No.	77321779	Application Date	11/05/2007
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	FACEBOOK ADS		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 035. First use:  Advertising and information distribution services, namely, providing advertising space via the global computer network; promoting the goods and services of others over the Internet; providing on-line computer databases and on-line searchable databases in the field of classifieds</p> <p>Class 038. First use:  Providing access to information, audio, and video via websites, online forums, chat rooms, listservs and blogs over the Internet; providing access to computer databases; electronic transmission of instant messages and data; providing on-line computer databases and on-line searchable databases in the fields of transmission of photographic images, provision of virtual communities, and provision of on-line forums for communications on topics of general interest</p> <p>Class 041. First use:  Electronic publishing services, namely, publishing of online works of others featuring user-created text, audio, video, and graphics; providing on-line journals and web logs featuring user-created content; providing on-line computer databases and on-line searchable databases in the fields of collegiate interest, photosharing and video sharing</p> <p>Class 042. First use:</p>		

	<p>Application service provider (ASP) featuring software to enable uploading, posting, showing, displaying, tagging, blogging, sharing or otherwise providing electronic media or information over the Internet or other communications network; Providing temporary use of non-downloadable software applications for posting and reading classifieds, for creating and maintaining virtual communities, for social networking, photo sharing, video sharing, and transmission of photographic images</p> <p>Class 045. First use: Providing on-line computer databases and on-line searchable databases in the field of social networking</p>
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U.S. Application No.	78920347	Application Date	06/29/2006
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	FBOOK		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 038. First use: Providing services in relation to online chat rooms for transmission of messages and online directory information for registered users featuring information regarding, and in the nature of, collegiate life, general interest; classifieds, virtual community, social networking; telecommunication services, namely, worldwide switched text and message transmission services, electronic message sending and outcall notification services; providing transmission services in relation to using mobile devices, namely, to look up user profile information, search for users, send messages to users, post information viewable by users, add contacts, and provide notifications</p>		

U.S. Application No.	77039127	Application Date	11/07/2006
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	FBOOK		

Design Mark	
Description of Mark	NONE
Goods/Services	<p>Class 009. First use:  Computer software development tools for social networking, building social networking applications and for allowing data retrieval, upload, access and management; application programming interface (API) for third-party software and online services for social networking, building social networking applications and for allowing data retrieval, upload, access and management</p> <p>Class 038. First use:  Providing access to computer databases; electronic transmission of instant messages and data</p> <p>Class 041. First use:  Electronic publishing services, namely, publishing of online works of others featuring user-created text, audio, video, and graphics; providing on-line journals and web logs featuring user-created content</p> <p>Class 042. First use:  Providing temporary use of non-downloadable software applications for classifieds, virtual community, social networking, photo sharing, video sharing, and transmission of photographic images</p>

Attachments	78574726#TMSN.jpeg ( 1 page )( bytes ) 78574730#TMSN.jpeg ( 1 page )( bytes ) 78920322#TMSN.jpeg ( 1 page )( bytes ) 77189479#TMSN.jpeg ( 1 page )( bytes ) 77039123#TMSN.jpeg ( 1 page )( bytes ) 78962629#TMSN.jpeg ( 1 page )( bytes ) 77125103#TMSN.jpeg ( 1 page )( bytes ) 77589935#TMSN.jpeg ( 1 page )( bytes ) 77321801#TMSN.jpeg ( 1 page )( bytes ) 77321779#TMSN.jpeg ( 1 page )( bytes ) 78920347#TMSN.jpeg ( 1 page )( bytes ) 77039127#TMSN.jpeg ( 1 page )( bytes ) Facebook Notice of Opposition to Leaders2020 (OFFICEBOOK).pdf ( 10 pages )(319445 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Christine K. Hsieh/
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Name	Christine K. Hsieh
Date	04/20/2009

**Certificate of Transmission**

I hereby certify that this correspondence is being transmitted via the Electronic System for Trademark Trials and Appeal (ESTTA) to: the Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451.

Christine Hsieh (Name)

4/20/09 (Date)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of application Serial No. 77/481593  
For the Trademark OFFICEBOOK  
Published in the Official Gazette on October 21, 2008

FACEBOOK, INC.,	)	
	)	
Opposer,	)	
	)	Opposition No.
v.	)	
	)	
Leaders2020 Inc.	)	
	)	
Applicant.	)	
_____	)	

**NOTICE OF OPPOSITION**

Opposer Facebook, Inc. ("Facebook"), a Delaware corporation having its principal place of business at 156 University Avenue, Palo Alto, CA 94301, believes that it will be damaged by the issuance of a registration for the mark OFFICEBOOK, as applied for in Application Serial No. 77/481593 filed on May 22, 2008 by Applicant Leaders2020, Inc. ("Applicant"), a Delaware corporation, with a mailing address at 3056 Dante Court, San Jose, California 95135.

As grounds for opposition, Facebook alleges that:

1. Facebook is the world's leading provider of online networking services. Indeed, Facebook's website at [www.facebook.com](http://www.facebook.com) has been recognized as among the top five most-trafficked websites of any kind in the world. The Facebook website allows computer users to communicate with existing friends, make new friends, organize groups and events and share their personal profiles, statuses, activities, photos, links and videos and to create online communities of users with shared interests and connections. For all of the reasons further discussed herein, the FACEBOOK Marks, as defined below, are famous in connection with those services.

2. Facebook's services were first offered in 2004 as a networking site at Harvard University. Over the following year, 800 additional college networks were added in rapid succession. In 2006, access to the Facebook service was progressively expanded so that anyone with a valid email address could register as a Facebook user. Currently, Facebook is accessible not only through the Facebook website but also via mobile devices. As of 2009, Facebook provides online networking services in 35 languages to over 175 million active users worldwide. The Facebook site is currently the most popular photosharing application on the Internet, with more than 850 million photos and 7 million videos uploaded each month. There are more than 660,000 entrepreneurs and software developers worldwide who have created over 52,000 software programs (known as "applications") for the Facebook platform. Worldwide, Facebook users spend more than 3 billion minutes on the Facebook site each day.

3. Facebook allows companies to create Facebook Pages that display information regarding their business, including website address, corporate overview, year of founding, and a list of offered products or services. Facebook also allows participating companies to upload

photographs and post on message boards for their Facebook Pages. Once a company has created a Facebook Page, Facebook users can become fans and engage in discussions with other Facebook users regarding the business.

#### **FACEBOOK'S MARKS**

4. Facebook is the owner of U.S. Trademark Registration 3,041,791 for the mark FACEBOOK, which was filed on February 24, 2005, claims a first use date of at least as early as February 2004, and registered on January 10, 2006, for the following services:

- in International Class 35: providing an online directory information service featuring information regarding, and in the nature of, collegiate life, classifieds, virtual community and social networking and
- in International Class 38: providing online chat rooms for registered users for transmission of messages concerning collegiate life, classifieds, virtual community and social networking.

5. Facebook is the owner of U.S. Trademark Registration 3,122,052 for the mark FACEBOOK, which was filed on February 24, 2005 and registered on July 25, 2006, also covering services in classes 35 and 38.

6. Facebook is also the owner of numerous U.S. pending U.S. applications to register marks consisting of or incorporating FACEBOOK or a variant thereof, including the following:

- FACEBOOK word mark (Serial No. 78/920,322), filed on June 29, 2006 in International Classes 35, 38, 42, and 45;
- FACEBOOK word mark (Serial No. 77/189,479), filed on May 24, 2007 in International Classes 9, 38, 41, and 42;
- FACEBOOK word mark (Serial No. 77/039,123), filed on November 7, 2006 in International Classes 9, 38, 41, and 42;
- FACEBOOK word mark (Serial No. 78/962,629), filed on August 29, 2006 in International Class 25;

- FACEBOOK word mark (Serial No. 77/125,103), filed on March 7, 2007 in International Classes 18, 20, and 21;
- FACEBOOK FOR GOOD word mark (Serial No. 77/589,935), filed on October 9, 2008 in International Class 35;
- FACEBOOK PAGES word mark (Serial No. 77/321,801), filed on November 5, 2007 in International Classes 9, 35, 38, 41, 42 and 45;
- FACEBOOK ADS word mark (Serial No. 77/321,779), filed on November 5, 2007 in International Classes 35, 38, 41, 42, and 45;
- FBOOK word mark (Serial No. 78/920,347), filed on June 29, 2006 in International Class 38; and
- FBOOK word mark (Serial No. 77/039,127), filed on November 7, 2006 in International Classes 9, 38, 41 and 42.

7. In addition, Facebook owns common law rights in the FACEBOOK mark, which has been continuously, prominently, and conspicuously in use on its website and other materials in interstate commerce in the United States since at least as early as February 2004. All of Facebook's marks that consist of or incorporate the term FACEBOOK or a variant thereof will hereafter be referred to as the "FACEBOOK Marks."

8. The FACEBOOK Marks are inherently distinctive.

9. Facebook has been the subject of thousands of unsolicited stories in television, radio, and print media, highlighting Facebook's innovation and success in providing online networking services. Facebook has been recognized and awarded for its endeavors, including Harvard Business School's "Entrepreneurial Company of the Year" in June 2008, *BusinessWeek's* "The World's 50 Most Innovative Companies" in 2008, The Webby Award's "People's Voice Winner" for Social Networking in 2007 and The Crunchie Award for Best Overall Startup in 2008.

10. As a result of the nature and quality of Facebook's services, its widespread use of the FACEBOOK Marks, the extensive and continuous media coverage, the high degree of

consumer recognition of the FACEBOOK Marks, Facebook's enormous and loyal user base, numerous trademark registrations and pending applications and other factors, the FACEBOOK Marks are famous within the meaning of Section 43(c) of the United States Trademark Act, 15 U.S.C. § 1125(c).

**APPLICANT'S USE OF THE OFFICEBOOK NAME AND MARK**

11. Applicant filed Application Serial No. 77/481593 for OFFICEBOOK ("OFFICEBOOK Application") on an intent-to-use basis on May 22, 2008, for "Providing a website for consumers to express and share opinions on companies" in class 35.

12. The OFFICEBOOK Application was published in the Official Gazette on October 21, 2008.

13. The services covered by Applicant's OFFICEBOOK Application overlap significantly with the services claimed in Facebook's FACEBOOK registrations and applications and as provided by Facebook in connection with the FACEBOOK Marks.

14. On information and belief, Applicant has used the OFFICEBOOK mark in connection with software on the Facebook website that allowed users to express opinions of a company or business.

15. On information and belief, Applicant intends to use its OFFICEBOOK mark in connection with an online service providing user-generated content and reviews about companies. One of the features that Facebook offers in connection with its online networking services under the FACEBOOK Marks allows users to share their opinions about businesses. Thus the services intended to be offered under the OFFICEBOOK Mark are highly similar and/or identical to those provided by Facebook.

16. The mark Applicant proposes to register, OFFICEBOOK, is substantially similar to the FACEBOOK Marks. With respect to the OFFICEBOOK trademark, the term “office” is generic of Applicant’s services as it relates to businesses, while the term BOOK is distinctive as it relates to online networking. Thus, by combining the generic term “office” with the dominant and inherently distinctive term BOOK, Applicant has created a mark that creates a misleading association with Facebook.

17. Upon information and belief, Applicant selected the OFFICEBOOK Mark with knowledge of and intent to cause confusion with, and to capitalize on the enormous goodwill of, the FACEBOOK Marks.

18. Facebook is not affiliated or connected with Applicant or its services; nor has Facebook endorsed or sponsored Applicant or its services.

19. There is no issue as to priority of use. Facebook began using its FACEBOOK Marks, and enjoys priority as a result of the filing dates of its trademark registrations and applications, well prior to the filing date of the OFFICEBOOK Application.

**FIRST GROUND FOR OPPOSITION:  
LIKELIHOOD OF CONFUSION**

20. Facebook incorporates by reference Paragraphs 1 through 19, inclusive, as if fully set forth herein.

21. Applicant’s OFFICEBOOK Mark is confusingly similar to the FACEBOOK Marks in appearance, sound, and commercial impression. Both marks consist of a single term combined with the term “book.” The OFFICEBOOK mark combines the generic term “office” with the distinctive and dominant term “book.” Thus the most distinctive and dominant component of the OFFICEBOOK mark is identical to the distinctive “book” component of the FACEBOOK Marks.

**22.** The services described in the OFFICEBOOK Application are the same as or closely related to the services offered by Facebook under the FACEBOOK Marks and identified in Facebook's trademark registrations and applications. According to the identification of services in its OFFICEBOOK application, Applicant intends to use the OFFICEBOOK mark in connection with a website where consumers can express and share opinions on businesses and companies. These services are confusingly similar and/or identical to Facebook's online networking services and in particular, to the Facebook feature that allows users to discuss various companies. However, Facebook is not affiliated or connected with Applicant or its services, nor has Facebook endorsed or sponsored Applicant or its services.

**23.** The types of services identified in the OFFICEBOOK Application and the types of services offered by Facebook under the FACEBOOK Marks are normally offered through the same channels of trade, namely, through an on-line website.

**24.** On information and belief, Applicant chose the OFFICEBOOK Mark with knowledge of, and the intent to create an association with or create a likelihood of confusion with Facebook's services and the FACEBOOK Marks.

**25.** Accordingly, registration of the OFFICEBOOK Mark will injure Facebook by causing the public to be confused or mistakenly believe that the services provided by Applicant are associated with, endorsed, or sponsored by Facebook. Facebook has no control over the nature and quality of the services offered by Applicant under the OFFICEBOOK Mark, and Facebook's reputation and goodwill will be damaged and the value of the FACEBOOK Marks jeopardized, all to Facebook's detriment. Further, any defect, objection or fault found with Applicant's services marketed under the OFFICEBOOK name would necessarily reflect upon

and seriously injure the reputation that Facebook has established for the goods and services it offers in connection with the FACEBOOK Marks.

26. Accordingly, registration of the mark herein opposed will damage Facebook because Applicant's Mark is likely, when used on or in connection with the services described in the opposed application, to cause confusion, or to cause mistake or to deceive. Thus the OFFICEBOOK Mark is unregistrable under Sections 2(d) and 3 of the Trademark Act, as amended, 15 U.S.C. §§ 1052(d) and 1053, and should be refused registration.

**SECOND GROUND FOR OPPOSITION:  
DILUTION OF A FAMOUS MARK**

27. Facebook incorporates by reference Paragraphs 1 through 26 inclusive, as if fully set forth herein.

28. FACEBOOK is inherently distinctive in relation to Facebook's goods and services.

29. Facebook has used the FACEBOOK Marks since at least as early as 2004 for online networking services, and has expanded use of the FACEBOOK Marks to many other goods and services, as evidenced by its applications and as alleged.

30. Facebook is the owner of numerous U.S. registrations and applications for the FACEBOOK Marks.

31. Facebook and the FACEBOOK Marks have been the subject of extensive and continuous media attention.

32. Facebook has continuously used the FACEBOOK Marks throughout the United States and many countries around the world.

33. As a result of the considerable publicity afforded the FACEBOOK Marks and the enormous and loyal base of customers that Facebook has for its services, the FACEBOOK Marks have extensive consumer recognition.

34. Accordingly, when the public encounters the term FACEBOOK, it immediately associates the term with Facebook and its services, and thus the FACEBOOK Marks are famous.

35. The FACEBOOK Marks became famous before the Applicant filed its application for the OFFICEBOOK Mark on May 22, 2008.

36. The dominant portion of the OFFICEBOOK Mark is identical to the “book” portion of the FACEBOOK Marks, and Applicant’s use of the OFFICEBOOK Mark is likely to cause dilution of the famous FACEBOOK Marks. Applicant’s use of the OFFICEBOOK Mark in connection with online networking services will blur and weaken the connection in consumers’ minds between the FACEBOOK Marks and Facebook’s goods and services, thereby diluting the distinctiveness of the famous FACEBOOK Marks to Facebook’s severe detriment.

37. Accordingly, Applicant’s Mark is unregistrable pursuant to Sections 2(a)(d), 3, 13, and 43(c) of the United States Trademark Act, as amended, 15 U.S.C. §§ 1052(a)(d), 1053, 1063, and 1125, and should be refused registration.

38. Wherefore, Facebook prays that this Opposition be sustained, and that Application Serial No. 77/481593 be refused.

Respectfully submitted,

COOLEY GODWARD KRONISH LLP

Date: April 20, 2009

By: 

Christine K. Hsieh  
Attorneys for Opposer Facebook, Inc.