

ESTTA Tracking number: **ESTTA397694**

Filing date: **03/11/2011**

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

Proceeding	92053454
Party	Defendant Facebook, Inc.
Correspondence Address	FACEBOOK, INC. 1601 SOUTH CALIFORNIA AVENUE PALO ALTO, CA 94304 UNITED STATES jnorberg@cooley.com, trademarks@cooley.com, mweiand@cooley.com, krobinson@cooley.com, mweiand@cooley.com
Submission	Motion to Dismiss - Rule 12(b)
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Filer's e-mail	trademarks@cooley.com, jnorberg@cooley.com, mweiand@cooley.com
Signature	/s/ Jeffrey T. Norberg
Date	03/11/2011
Attachments	Motion.pdf ( 75 pages )(2208874 bytes )

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

In the matter of Registration No. 3,041,791 for the Trademark FACEBOOK;  
Registration No. 3,801,147 for the trademark FACEBOOK; Registration No. 3,814,888 for the trademark  
FACEBOOK; and Registration No. 3,881,770 for the trademark FACEBOOK

EVERCLEAR COMMUNICATIONS INC.	)	
	)	
Petitioner,	)	
	)	Cancellation No. 92053454
v.	)	
	)	
FACEBOOK, INC.,	)	
	)	
Registrant.	)	
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**REGISTRANT FACEBOOK, INC.’S MOTION TO DISMISS EVERCLEAR  
COMMUNICATIONS INC.’S PETITION FOR CANCELLATION FOR FAILURE TO  
STATE A CLAIM UNDER RULE 12(b)(6)**

Pursuant to Federal Rule of Civil Procedure 12(b)(6), Registrant Facebook, Inc. (“Facebook”), through its undersigned counsel, moves to dismiss the Petition for Cancellation filed by Everclear Communications Inc. (“Everclear”) on the grounds that it fails to state a claim upon which relief may be granted.

**I. INTRODUCTION**

Everclear’s Petition to Cancel Facebook’s FACEBOOK registrations should be dismissed for two reasons. First, Everclear failed to bring these claims in an Opposition proceeding filed by Facebook against Everclear more than a year ago. This new Petition to Cancel relies exclusively on allegations of facts that were available to Everclear at the time it filed its answer to Facebook’s Opposition, and is therefore barred under the compulsory counterclaim rule.

Even if Everclear’s claims were not barred, however, Everclear’s allegations do not state a claim for fraud. Indeed, Everclear’s allegations do not include *any* facts to support the required elements of (1) a misrepresentation of fact; (2) materiality; and (3) reliance by the PTO. Far

from satisfying Rule 9(b)'s heightened pleading standard for alleging fraud, Everclear's Petition appears to be based on a fundamental misunderstanding of the requirements for prosecuting intent-to-use trademark applications. It should therefore be dismissed.

## II. BACKGROUND

This Petition for Cancellation ("the Petition") is the second of two TTAB actions between Facebook and Everclear. In September of 2009, Facebook instituted an Opposition proceeding (No. 91191915), requesting that the Board refuse Everclear's application to register the mark TALKBOOK for use in connection with "[c]ommunication services via the Internet, namely, the transmission of audio, video, data, image and voice information and recordings via the Internet" (the "Opposition"). Declaration of Jeffrey T. Norberg in Support of Respondent Facebook's Motion to Dismiss ("Norberg Decl.") Ex. A. The Opposition alleges, *inter alia*, that Everclear's use and registration of the TALKBOOK mark creates a likelihood of confusion with and dilution of Facebook's rights in its FACEBOOK mark. As a basis for Opposition, Facebook asserted its common law rights in the FACEBOOK mark and relied on several issued trademark registrations and pending applications, one of which (Registration No. 3,041,791) is included in the registrations Everclear seeks to cancel in this proceeding.

Everclear filed its answer to Facebook's Opposition more than a year ago, on January 8, 2010 (the "January 2010 Answer"). Norberg Decl. Ex. B. The January 2010 Answer did not include any counterclaims, nor did it include any allegations that Facebook's registrations were subject to cancellation for any reason. *Id.* Rather, it included only denials of Facebook's allegations and four short affirmative defenses, none of which alleged fraud. *Id.*

The parties subsequently exchanged written discovery and began negotiating dates for party depositions. During those negotiations, Everclear sought the depositions of several of Facebook's top executives, including Facebook's founder Mark Zuckerberg. Norberg Decl. Ex. C. Because Facebook's top executives were unlikely to have any unique information relevant to the claims to be decided in the pending proceeding – namely, whether the TALKBOOK mark

should be registered – Facebook resisted these requests under the *apex* deposition doctrine. *Id.*

More than 10 months after filing its answer, Everclear sent Facebook a proposed amended answer that included counterclaims for cancellation of several of Facebook’s registrations, and asked Facebook’s consent to filing the amended pleading. Norberg Decl. Ex. D. These proposed counterclaims, which asserted fraud and largely mirrored those asserted in this proceeding, did not rely on any information produced in discovery, but instead on alleged facts that were available to Everclear at the time it filed its answer nearly a year earlier. Moreover, like the claims in this proceeding, the proposed counterclaims for fraud were based on a fundamental misunderstanding of the requirements for prosecuting an intent-to-use trademark application. Everclear refused to explain why it waited nearly a year to attempt to add these new claims. In fact, the proposed amended pleading was nothing more than a belated attempt to expand the scope of the litigation in an effort to harass Facebook’s top executives with meritless deposition requests. Facebook therefore declined to consent to the proposed amended pleading.

Everclear never moved to amend its answer as threatened. Instead, shortly after Facebook declined to consent to Everclear’s proposed amended answer, Everclear filed a new Petition for Cancellation. As discussed in greater detail below, this new petition does not allege any facts that were not available to the petitioner at the time it filed its answer in the Opposition, and does not assert cognizable grounds for cancellation based on fraud. It should therefore be dismissed.

### **III. ARGUMENT**

Everclear has alleged facts in its Petition for Cancellation that, even if true, are insufficient to state a claim for cancellation based on fraud. *See Young v. AGB Corp.*, 152 F.3d 1377, 1378 (Fed. Cir. 1998). Everclear has made the same four basic allegations, in different combinations, against each of the four FACEBOOK registrations it seeks to cancel, namely: (1) that Facebook’s statements of use were allegedly false because it was using the mark “THEFACEBOOK” rather than “FACEBOOK” at the time of the claimed first use in commerce

(Petition ¶¶5, 21, 32, 35); (2) that Facebook signed its statements of use despite allegedly knowing that the term “facebook” was in limited use by others for items other than those claimed by Facebook in its trademark applications (Petition ¶¶6, 7, 22, 36); (3) that Facebook’s statements of use as of the first claimed date of use were allegedly false because, as of February 2004, Facebook only offered its service to a “limited number of people” (Petition ¶4); and (4) that Facebook did not use the mark on *all* of the goods and services recited in a particular class as of the earliest first use date identified in its Statement of Use (Petition ¶¶18, 20).

Facebook disputes the facts alleged in Everclear’s Petition. But even taking them as true as required in the context of a motion to dismiss, these allegations all fail to state a claim. *Advanced Cardiovascular Sys., Inc. v. SciMed Life Sys., Inc.*, 988 F.2d 1157, 1160-61 (Fed. Cir. 1993). All of the alleged facts contained in Everclear’s Petition come from publically available sources – primarily the file histories of the trademarks that Facebook asserted against Everclear in the earlier Opposition. Everclear declined to assert them in the earlier proceeding. The Petition should therefore be dismissed.

**A. Count I of The Petition is Barred by the Compulsory Counterclaim Rule**

Initially, Everclear’s petition for cancellation of U.S. Registration No. 3,041,791 (the “’791 Registration”) fails as a matter of law because Everclear failed to assert this counterclaim in response to an Opposition filed by Facebook in 2009. *See* Opposition No. 91191915. 37 C.F.R. §2.106(b)(2)(i) provides that “a defense attacking the validity of any one or more of the registrations pleaded in the Opposition shall be a compulsory counterclaim if grounds for such counterclaim exist at the time when the answer is filed.” If a cancellation counterclaim is deemed compulsory to a prior opposition, the applicant is precluded from maintaining a subsequent cancellation proceeding on the same basis. *Libertyville Saddle Shop Inc. v. E. Jeffries & Sons Ltd.*, 24 U.S.P.Q.2d 1376, 1378 (T.T.A.B. 1992).

Everclear’s claim against the ’791 Registration is a compulsory counterclaim because Everclear has not alleged any facts that were not available to Everclear at the time it filed its

Opposition Answer on January 28, 2010 (the “January 2010 Answer” (Norberg Decl. Ex. B)). 37 C.F.R. §2.106(b)(2)(i). Each of the four fraud bases asserted by Everclear, discussed above, are based on statements made in Facebook’s application filed and publically available on February 24, 2005 – *five years* before the Petitioner filed its answer in the Opposition proceedings.

First, the fact that in 2004 Facebook used the mark THEFACEBOOK is evident from the application file history. As Everclear alleges in Paragraph 8 of the Petition, Facebook initially filed the application for the mark THEFACEBOOK, and then on July 13, 2006 filed a request to amend the registration to FACEBOOK. Petition ¶8; Norberg Decl. Ex. E. This amendment was accepted by the PTO on November 14, 2006. Norberg Decl. Ex. F. Thus, the information upon which Everclear relies to make this allegation of fraud was available to the Petitioner via the public file history at the time of its January 2010 Answer, and Everclear has provided no explanation as to why it did not assert this claim then.

Everclear’s second basis for asserting fraud with respect to the ’791 Registration – that there were other uses of “facebook” of which Facebook was aware at the time Facebook filed its application – is also based on alleged facts that were available to Everclear at the time it filed its January 2010 Answer. In Paragraph 6 of the Petition, Everclear alleges that third parties used the term “facebook” in connection with items other than those claimed in Facebook’s trademark applications. Everclear makes no claim that this allegation is made using information that was not available to it when it filed the January 2010 Answer, nor could it. Indeed, similar allegations appeared in at least one other petition to cancel this same mark, which was filed ten months before Everclear’s January 2010 Answer. *See, e.g.,* Cancellation No. 92050675.<sup>1</sup>

The basis for Everclear’s third allegation – that Facebook’s initial use was insufficient – is not based on pleaded facts. Everclear claims that Facebook did not use the mark “in commerce” as of February, 2004 and instead used it only with “a limited number of people.”

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<sup>1</sup> When ruling on a Motion to Dismiss, the Board may take judicial notice of the papers located in its files. 37 C.F.R. §2.122(b)(1).

But Everclear has not included *any* facts to support this allegation, as required by Rule 9(b). *See* Fed. R. Civ. P. 9(b) (fraud must be pled with particularity); *World Hockey Ass'n v. Tudor Metal Products Corp.*, 185 U.S.P.Q. 246, 247-48 (T.T.A.B. 1975). Moreover, the nature of Facebook's initial use of its mark has long been widely known to the public, and was even disclosed in paragraph 2 of the Opposition to which the January 2010 Answer was responding:

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.

Norberg Decl. Ex. A at ¶2. While it is unclear precisely what Petitioner is alleging with respect to Facebook's initial use of its mark, the nature of that early use was known to the Petitioner when it received Facebook's Notice of Opposition to the TALKBOOK application. Petitioner could have made this allegation in its January 2010 Answer, but failed to do so.

Everclear's fourth and final basis for alleging fraud – that Facebook did not use the mark in connection with all of the goods and services claimed in Facebook's Statement of Use, such as "classifieds," as of the earliest first use date identified in the Statement – is also an allegation that Everclear could have made at the time of the January 2010 Answer. Everclear's allegations on this issue are not based on some internal Facebook information learned during the course of discovery in the Opposition proceeding, but instead on the specimen contained in the file history. Petition ¶2. As Everclear admits, that specimen was filed (and therefore publically available) on January 24, 2005, years before Everclear filed its January 2010 Answer.

In short, the alleged grounds in Everclear's cancellation should have been known by Everclear long before it filed the January 2010 Answer. They were therefore compulsory counterclaims in the earlier Opposition proceeding and may not now be asserted in this Cancellation action.

**B. The Petition Fails to Plead Fraud**

As discussed above, all three of Everclear's counts for fraud are based on the same four basic allegations. Taken as true for purposes of this motion, none of these allegations support a finding of fraud.

**1. The PTO Has Already Determined That Facebook's Early Use of the Article "The" Before "Facebook" Was Immaterial**

Everclear's allegation that Facebook used THEFACEBOOK rather than FACEBOOK does not support a fraud claim because the PTO has already determined that the difference between these two marks is not material. For fraud the Petitioner must allege, among other things, that the registrant has "knowingly [made] a false, *material* representation with the intent to deceive the [USPTO]." *In re Bose Corp.*, 580 F.3d 1240, 1245 (Fed. Cir. 2009) (emphasis added). A material misrepresentation is one that, but for the misrepresentation, the registration would not or should not have issued. *Crown Wallcovering Corporation v. the Wall Paper Manufacturers Limited*, 188 U.S.P.Q. 141, 144 (T.T.A.B. 1975) ("it must be asserted that the false statements complained of were made willfully in bad faith with the intent to obtain that to which the party making the statements would not otherwise have been entitled").

The Petition itself establishes that the difference between THEFACEBOOK and FACEBOOK is immaterial. Facebook's initial application for Registration 3,041,791 was for the mark THEFACEBOOK. Petition ¶8. On July 13, 2006, Facebook filed a request to amend its registration to FACEBOOK, submitting that deletion of the article "THE" from the mark was an immaterial alteration under 37 C.F.R. §2.173(d). Norberg Decl. Ex. E. The PTO determined that this amendment was an immaterial alteration when it issued an amended certificate of registration on November 14, 2006. *Id.* Ex. F. Since the PTO has already determined that the difference between THEFACEBOOK and FACEBOOK is immaterial, Everclear cannot show that the PTO would not have issued the registrations at issue in this Petition but for some misrepresentation by Facebook.

**2. Alleged Awareness of Use of the Term “facebook” by Others Does Not Constitute Fraud**

Everclear’s claim that Facebook was aware of other uses of the term “facebook” at the time Facebook signed the statements of use fails because Everclear has failed to allege *any* of the four elements required to state this type of claim. To properly allege fraud based on a registrant’s failure to disclose third party use of the same or confusingly similar mark at the time the declaration was signed, a petitioner must allege facts that, if proven, would establish that: “(1) there was in fact another use of the same or a confusingly similar mark at the time the oath was signed; (2) the other user had legal rights superior to applicant’s rights; (3) applicant knew that the other user had rights in the mark superior to applicant’s, and either believed that a likelihood of confusion would result from applicant’s use of its mark or had no reasonable basis for believing otherwise; and (4) applicant, in failing to disclose these facts to the Patent and Trademark Office, intended to procure a registration to which applicant was not entitled.” *Ohio State University v. Ohio University*, 51 U.S.P.Q.2d 1289, 1293 (T.T.A.B. 1999).

Everclear’s Petition alleges no facts to support any of these four required elements, but instead makes a vague allegation that the term was used, in a very different way, by certain educational institutions. Petition ¶6. This is insufficient to meet Everclear’s burden of pleading, with particularity, *each* of the four elements required under the *Ohio State University* case. These allegations, therefore, should be dismissed.

**3. Everclear’s Vague Challenge to Facebook’s Extent of Use as of February 2004 is not Relevant**

Everclear’s allegation that Facebook’s statements of use were fraudulent because, as of February of 2004 Facebook was only offering its services to “a limited number of people,” is based on an apparent gross misunderstanding of the law. Everclear has not alleged that Facebook was not using the mark as of the date of the filing of the in-use application for Registration 3,041,791, or as of the date of filing of the statement of use in the intent-to-use application for Registrations 3,801,147 and 3,814,888. Rather Everclear’s allegations focus on the claimed earliest date of first use, February 4, 2004. As a matter of law Facebook’s claimed

first use date is irrelevant to a claim of fraud, even if false, which it is not. *Standard Knitting Ltd. v. Toyota*, 77 U.S.P.Q.2d 1917, 1926 (T.T.A.B. 2006); *Hecon Corp. v. Magnetic Video Corp.*, 199 U.S.P.Q. 502, 504 n.3 (T.T.A.B. 1978). Thus Everclear's allegation that Facebook did not use the marks in commerce as of the claimed February 4, 2004 first use in commerce date is insufficient as a matter of law to state a claim of fraud and must be dismissed.

Everclear's allegation is also too vague to satisfy the specificity requirements of Rule 9(b). That rule requires that every element of fraud be pleaded "with particularity" and be supported by allegations of facts that, if proven, would support a claim for fraud on the PTO. *World Hockey Ass'n.*, 185 U.S.P.Q. at 247-48. "Use in commerce" is defined as "the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in the mark." 15 U.S.C. §1127. Everclear has not alleged facts that, if proved, would show that Facebook's use was not bona fide, or that it was made merely to reserve a right in the mark. The number of people to whom Facebook was offered does not, in and of itself, establish fraud. Again, properly pled fraud requires a much more specific factual showing than what has been pled here. *World Hockey Ass'n.*, 185 U.S.P.Q. at 247-48.

#### **4. Everclear's Claim Regarding the Scope of Facebook's Claimed Services Fundamentally Misconstrues Prosecution Practice**

Count II of the Petition again fundamentally misconstrues the PTO requirements for prosecuting intent-to-use applications. Everclear's chief complaint in Count II is that Facebook did not use its mark in connection with the publication of video, one of numerous services claimed in Class 41, as of Facebook's earliest date of claimed use: February 4, 2004. This, however, is expressly allowed under the PTO rules. *See* 37 C.F.R. §2.88(c) ("[i]f more than one item of goods or services is specified in the statement of use, the dates of use required in paragraph (b)(1) of this section need be for only one of the items specified in each class..."). There can be no finding of fraud here, because it is not improper for Facebook to assert the earliest first use date with respect to some of the items in that class in its statement of use,

regardless of whether that first use date also covers the remaining items in the class.<sup>2</sup>

Count II also fails as a matter of law because Everclear has not alleged that Facebook made any misrepresentation of fact. The Petition quotes extensively from a declaration submitted by Facebook on December 18, 2009, which stated that as of the date of the declaration (and not the date of first use in commerce), the mark “*is*” in use with all of the claimed services. Petition ¶¶16-17. In the next three paragraphs, the Petition alleges that Facebook did not use the mark in connection with video *in February of 2004*. Petition ¶¶18-20. Thus, Everclear has failed to alleged any misrepresentation of fact, and Count II fails. *In re Bose Corp.*, 580 F.3d at 1243 (fraud requires a *false* representation).

#### IV. CONCLUSION

For the foregoing reasons, Everclear’s Petition for Cancellation fails to meet the requirements necessary to maintain this proceeding. Facebook respectfully requests that the Board grant its Motion to Dismiss Everclear’s Petition for Cancellation in its entirety.

Dated: March 11, 2011

COOLEY LLP  
ANNE H. PECK  
JEFFREY T. NORBERG  
KATHRYN D. ROBINSON



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Jeffrey Norberg  
Attorneys for Opposer

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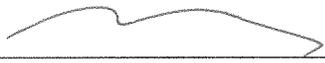
<sup>2</sup> Count I of the Petition also includes an allegation that Facebook did not use its mark in connection with classifieds or chat rooms as of February 4, 2004. Petition ¶3. It is unclear how this allegation is relevant to Petitioner’s fraud claim, as Petitioner does not assert that the mark was not in use for those services as of the date Facebook signed the declaration of use. For the same reasons discussed above, this allegation does not support a claim for fraud on the PTO.

**CERTIFICATE OF SERVICE**

I hereby certify that on March 11, 2011, a true and correct copy of the foregoing **REGISTRANT FACEBOOK, INC.'S MOTION TO DISMISS EVERCLEAR COMMUNICATIONS INC.'S PETITION FOR CANCELLATION FOR FAILURE TO STATE A CLAIM UNDER RULE 12(b)(6)** was placed in the United States Mail, postage prepaid, addressed to counsel for Petitioner as follows:

James T. Nikolai  
Nikolai & Mersereau, P.A.  
900 2<sup>nd</sup> Ave. S. Ste. 820  
Minneapolis, MN 55402

Date: March 11, 2011

  
\_\_\_\_\_  
Jeffrey T. Norberg

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

In the matter of Registration No. 3,041,791 for the Trademark FACEBOOK;  
Registration No. 3,801,147 for the trademark FACEBOOK; Registration No. 3,814,888 for the trademark  
FACEBOOK; and Registration No. 3,881,770 for the trademark FACEBOOK

EVERCLEAR COMMUNICATIONS INC.	)	
	)	
Petitioner,	)	
	)	Cancellation No. 92053454
v.	)	
	)	
FACEBOOK, INC.,	)	
	)	
Registrant.	)	
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**DECLARATION OF JEFFREY T. NORBERG IN SUPPORT OF REGISTRANT  
FACEBOOK, INC.’S MOTION TO DISMISS**

I, Jeffrey T. Norberg, hereby declare as follows:

1. I am an attorney at the law firm of Cooley LLP and counsel of record for Facebook, Inc. (“Facebook”) in this matter. Unless otherwise stated, I have personal knowledge of the facts set forth in this declaration and, if called to testify as a witness, could and would testify competently hereto.

2. Attached hereto as Exhibit A is a true and correct copy of the Notice of Opposition filed by Facebook on September 14, 2009 against Everclear Communications, Inc.’s (“Everclear”) application Serial No. 76/693,743.

3. Attached hereto as Exhibit B is a true and correct copy of Everclear’s Answer to the Notice of Opposition against application Serial No. 76/693,743, filed January 8, 2010.

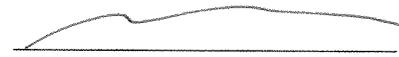
4. Attached hereto as Exhibit C is a true and correct copy of a September 14, 2010 letter from Kathleen E. Johnston, at the time an attorney in this office, to James T. Nikolai, counsel for Everclear.

5. Attached hereto as Exhibit D is a true and correct copy of an e-mail and attachment I received from Mr. Nikolai on or about November 29, 2010.

6. Attached hereto as Exhibit E is a true and correct copy of Facebook's Request for Amendment of Mark Under Section 7(e) dated July 11, 2006, and obtained from the TDR Portlet available on the United States Patent and Trademark Office website.

7. Attached hereto as Exhibit F is a true and correct copy of the Amended Registration Certificate for U.S. Registration No. 3,041,791, dated November 14, 2006, and obtained from the TDR Portlet available on the United States Patent and Trademark Office website.

I declare under penalty of perjury that the foregoing statements are true and correct.  
Executed in Palo Alto, California this 11<sup>th</sup> day of March, 2011.

  
\_\_\_\_\_  
Jeffrey T. Norberg

# **EXHIBIT A**

ESTTA Tracking number: **ESTTA315398**

Filing date: **11/05/2009**

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

Proceeding	91191915
Party	Plaintiff Facebook, Inc.
Correspondence Address	Christen Dubois Cooley Godward Kronish LLP 3000 El Camino Real, Five Palo Alto Sq. Palo Alto, CA 94306 UNITED STATES kjohnston@cooley.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Christen Dubois
Filer's e-mail	trademarks@cooley.com, ncmahon@cooley.com
Signature	/Christen Dubois/
Date	11/05/2009
Attachments	AMENDED NOTICE NOV 5.pdf ( 15 pages )(432986 bytes )



Communications Inc. (“Applicant”), a Canadian corporation, with a mailing address at 117 Girton Blvd., Winnipeg, Manitoba R3P 0A4, Canada.

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 September 2009, Facebook provides online networking services in over 50 languages to over 250 million active users worldwide, more than 120 million of whom log on to the Facebook website at least once per day. The fastest growing demographic on the Facebook site is users over age 35 – as of September, 2009, more than two-thirds of Facebook users are age 35 or older.

3. Facebook provides tools for each of its users to create a personal web page (a “Profile Page”) on which the user can choose to display personal information such as education, professional background, and contact information. In addition, Facebook provides on each

Profile Page a means through which users can communicate with each other, including private messages that are sent directly to users' inboxes, similar to e-mail as well as online real-time chat. Facebook users are also able to send items such as textual messages, links, photographs, or video on its own or another user's Profile Page and in private messages.

4. Facebook users are also able to update their status and send items such as textual messages, links, photographs, or video from their mobile devices such as the Blackberry and iPhone smartphones, among others. As of September 2009, there are more than 65 million active users currently accessing the Facebook service through their mobile devices.

5. Facebook provides a "Groups" feature which allows users to create and join groups focused on various topics, including business, common interest, entertainment and arts, geography, internet and technology, music, organizations, sports and recreation, and student groups. The Groups feature allows group members to participate on discussion boards and to upload, post and share photos, videos, and other media with other members of the group.

6. Worldwide, Facebook users spend more than 5 billion minutes on the Facebook site each day. The Facebook site is regularly used for photo and video sharing, with more than 1 billion photos and 10 million videos uploaded each month. In addition, the Facebook Platform allows for the creation of software programs such as tools and gadgets for personalizing and increasing the utility of user profiles, and interactive games. There are more than a million entrepreneurs and software developers worldwide who have created over 350,000 software programs (known as "applications") for the Facebook Platform.

## FACEBOOK'S MARKS

7. 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.

8. 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.

9. Facebook is the owner of U.S. Trademark Registration 3,659,516 for the mark FACEBOOK, which was filed on August 29, 2006 and registered on July 21, 2009, covering goods in class 25.

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

- 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. 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;
- 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.

11. 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."

12. The FACEBOOK Marks are inherently distinctive.

13. 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 The Webby Award's "People's Voice Winner" for Social Networking in 2007, Harvard Business School's "Entrepreneurial Company of the Year" in June 2008, *BusinessWeek's* "The World's 50 Most Innovative Companies" in 2008 and The Crunchie Award for Best Overall Startup in 2008.

14. As a result of the nature and quality of Facebook's services, its widespread use of the FACEBOOK mark, the extensive and continuous media coverage, the high degree of consumer recognition of the FACEBOOK mark, Facebook's enormous and loyal user base, numerous trademark registrations and pending applications and other factors, the FACEBOOK mark is 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 TALKBOOK NAME AND MARK**

15. Applicant filed Application Serial No. 76/693,743 for TALKBOOK ("TALKBOOK Application") on an in-use basis on October 22, 2008, claiming a first use date of January 31, 2008, for "[c]ommunication services via the Internet, namely, the transmission of

audio, video, data, image and voice information and recordings via the Internet” in International Class 38.

16. The TALKBOOK Application was published in the Official Gazette on October 22, 2008.

17. The services covered by Applicant’s TALKBOOK Application overlap with the services claimed in Facebook’s FACEBOOK registrations and applications and as provided by Facebook in connection with the FACEBOOK Marks. Similar to the services Facebook offers under its FACEBOOK Marks, the services contemplated in the TALKBOOK Application appear to enable users to communicate and exchange photos, videos, and other media as well as information over a website. Thus the services claimed to be offered under the TALKBOOK Mark are highly similar and/or identical to those provided by Facebook, namely, online networking services.

18. Applicant is using its TALKBOOK mark in connection with an application on the Facebook platform that facilitates telephone calls between Facebook users. In order to use the TALKBOOK application, one must first sign up for the Facebook service and use the Facebook service to connect with other Facebook users (the user’s “Facebook Friends”). Once a Facebook user has signed up for the TALKBOOK application they are able to initiate a phone call to any of their Facebook Friends who have also signed up for the TALKBOOK application. The TALKBOOK application shows a list of the user’s Facebook Friends who have signed up for the TALKBOOK application along with those users’ Facebook profile pictures. The phone call is initiated by clicking on a Friend’s Facebook profile picture and then clicking a link that says “Call [Friend’s Name]” that appears next to that profile picture. On information and belief,

Applicant provides services under the TALKBOOK mark exclusively to Facebook users, and exclusively through the Facebook website.

19. On information and belief, Applicant does not, and has not ever, used the TALKBOOK mark in connection with some of the services claimed in the TALKBOOK application. Specifically, on information and belief, Applicant does not, and has not ever, used the TALKBOOK mark in connection with the transmission of video, data, image and recordings via the Internet. Facebook's information and belief is based on correspondence from the Applicant in which the Applicant describes its services consistently with the allegation in Paragraph 18, *supra*. Facebook's information and belief is further supported by trial of Applicant's services on the Facebook Platform.

20. The mark Applicant proposes to register, TALKBOOK, is substantially similar to the FACEBOOK Marks. With respect to the TALKBOOK trademark, the term "talk" is generic of Applicant's services as it relates to allowing users to talk to one another, while the term BOOK is distinctive and arbitrary as used in connection with an online networking application. Thus, by combining the generic term "talk" with the dominant and inherently distinctive term BOOK, Applicant has created a mark that creates a misleading association with Facebook.

21. Upon information and belief, Applicant selected the TALKBOOK Mark with knowledge of and intent to cause confusion with, and to capitalize on the enormous goodwill of, the FACEBOOK Marks. On information and belief, as stated above, Applicant provides services under the TALKBOOK mark exclusively to Facebook users, and exclusively through the Facebook website. On information and belief, Applicant's similar service provided online outside of the Facebook Platform is called GUERRILLA TEL.

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

23. 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 claimed first use date of the TALKBOOK mark.

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

24. Facebook incorporates by reference Paragraphs 1 through 23, inclusive, as if fully set forth herein.

25. Applicant's TALKBOOK Mark is confusingly similar to the FACEBOOK Marks in appearance, sound, and commercial impression. Both marks consist of a single-syllabic term combined with the term "book." The TALKBOOK mark combines the generic term "talk" with the distinctive and dominant term "book." Thus the most distinctive and dominant component of the TALKBOOK mark is identical to the distinctive "book" component of the FACEBOOK Marks.

26. The services described in the TALKBOOK Application and those used under the TALKBOOK mark 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 TALKBOOK application, Applicant claims to use the TALKBOOK mark in connection with "communication services via the Internet, namely, the transmission of audio, video, data, image and voice information and recordings via the Internet." Applicant is using the TALKBOOK mark on the Facebook website in connection with a Facebook application that facilitates communications between Facebook users via phone calls. These services are confusingly similar and/or identical to Facebook's online networking services.

However, Facebook is not affiliated or connected with Applicant or its services, nor has Facebook endorsed or sponsored Applicant or its services.

27. The types of services identified in the TALKBOOK Application and used under the TALKBOOK mark 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. On information and belief, Applicant provides services under the TALKBOOK mark exclusively to Facebook users, and exclusively through the Facebook website. Accordingly, the Facebook service is the sole channel of trade for the TALKBOOK application.

28. On information and belief, Applicant chose the TALKBOOK 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.

29. Accordingly, registration of the TALKBOOK 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 TALKBOOK 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 TALKBOOK 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.

30. 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

TALKBOOK 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**

31. Facebook incorporates by reference Paragraphs 1 through 30 inclusive, as if fully set forth herein.

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

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

34. Facebook is the owner of numerous U.S. registrations and applications for the FACEBOOK mark.

35. Facebook and the FACEBOOK mark have been the subject of extensive and continuous media attention.

36. Facebook has continuously used the FACEBOOK mark throughout the United States and many countries around the world.

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

38. The FACEBOOK mark became famous before Applicant's claimed first use of the TALKBOOK Mark on March 18, 2008.

39. The dominant portion of the TALKBOOK Mark is identical to the "book" portion of the FACEBOOK mark, and Applicant's use of the TALKBOOK Mark is likely to cause

dilution of the famous FACEBOOK mark. Applicant's use of the TALKBOOK Mark in connection with online networking services will blur and weaken the connection in consumers' minds between the FACEBOOK mark and Facebook's goods and services, thereby diluting the distinctiveness of the famous FACEBOOK mark to Facebook's severe detriment.

40. 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.

**THIRD GROUND FOR OPPOSITION:  
FAILURE TO USE MARK WITH ALL CLAIMED SERVICES**

41. Facebook incorporates by reference Paragraphs 1 through 40 inclusive, as if fully set forth herein.

42. Applicant filed Application Serial No. 76/693,743 for TALKBOOK ("TALKBOOK Application") on an in-use basis on October 22, 2008, claiming a first use date of January 31, 2008, for the following goods and services in International Class 38: "[c]ommunication services via the Internet, namely, the transmission of audio, video, data, image and voice information and recordings via the Internet."

43. The specimen submitted by Applicant to the PTO on October 21, 2008 with its application for the TALKBOOK Mark, states "Call your friends, phone to phone, via Talkbook." No mention is made of the transmission of video, data, image and recordings via the Internet.

44. On information and belief, Applicant does not, and has not ever, used the TALKBOOK mark in connection with the transmission of video, data, image and recordings via the Internet. Facebook's information and belief is based on correspondence from the Applicant in which the Applicant describes its services consistently with the allegation in Paragraph 18,

*supra*. Facebook's information and belief is further supported by trial of Applicant's services on the Facebook Platform.

45. Accordingly, Applicant's Mark is unregistrable pursuant to Section 1(a) of the United States Trademark Act, as amended, 15 U.S.C. § 1051(a) with respect to the transmission of video, data, image and recordings via the Internet, and should be refused registration with respect to those services.

**FOURTH GROUND FOR OPPOSITION:  
FRAUD ON THE PTO**

46. Facebook incorporates by reference Paragraphs 1 through 45 inclusive, as if fully set forth herein.

47. On October 21, 2008, in its application for the TALKBOOK Mark, Applicant's CEO, John Pozios, submitted a sworn declaration dated September 17, 2008, to the United States Patent and Trademark Office ("PTO") that that all statements in the application were believed to be true. The TALKBOOK application stated that the mark was in use, and in use in United States commerce, on or in connection with the claimed services, as of January 31, 2008.

48. On information and belief, Applicant is not using, and has never used, the TALKBOOK Mark on or in connection with the transmission of video, data, image and recordings via the Internet services claimed in the TALKBOOK Application. Facebook's information and belief is based on correspondence from the Applicant in which the Applicant describes its services consistently with the allegation in Paragraph 18, *supra*. Facebook's information and belief is further supported by trial of Applicant's services on the Facebook Platform. Therefore, on information and belief, when Applicant submitted its application to the PTO indicating that it was using the mark TALKBOOK on or in connection with the claimed services as of January 31, 2008, such information was false.

49. On information and belief, Applicant misrepresented the nature of its use in commerce of the TALKBOOK Mark at the time it submitted its application. On information and belief, Applicant has attempted to procure registration of the TALKBOOK Mark by false means and/or by knowingly and willingly making false and/or fraudulent declarations or representations to the PTO, *inter alia*, falsely alleging in an Application supported by a Declaration under 18 U.S.C. §1001 that Applicant's first use of the TALKBOOK Mark was on January 31, 2008 for the claimed services, when, on information and belief, Applicant did not then and still does not use the mark on or in connection with all the claimed services. On information and belief, said false statements were made with the intent to induce authorized agents of the PTO to grant a registration, and reasonably relying on the truth of said false statements, the PTO has allowed the TALKBOOK Application to proceed to publication.

50. On information and belief, Applicant knew at the time it was made that the statement of first use made in the TALKBOOK Application was false.

51. In view of the above allegations, Applicant is not entitled to maintain the TALKBOOK Application since Applicant, on information and belief, committed fraud in the prosecution of the TALKBOOK Application.

52. Wherefore, Facebook prays that this Opposition be sustained, and that Application Serial No. 76/693,743 be refused.

Respectfully submitted,

COOLEY GODWARD KRONISH LLP

Date: November 2, 2009

By: 

Christen M.R. Dubois  
Attorneys for Opposer Facebook, Inc.

**CERTIFICATE OF SERVICE**

I hereby certify that on November 2, 2009, a true and correct copy of the foregoing **Notice of Opposition** was placed in the United States Mail, postage prepaid, addressed to counsel for Applicant as follows:

James T. Nikolai  
Nikolai & Mersereau, P.A.  
900 2<sup>nd</sup> Ave. S. Ste. 820  
Minneapolis, MN 55402

Date: November 5 2009

  
\_\_\_\_\_  
Nonie McMahon

# **EXHIBIT B**

ESTTA Tracking number: **ESTTA325948**

Filing date: **01/08/2010**

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

Proceeding	91191915
Party	Defendant Everclear Communications Inc.
Correspondence Address	JAMES T. NIKOLAI, NIKOLAI & MERSEREAU, P.A. 900 2ND AVE S STE 820 MINNEAPOLIS, MN 55402-3325 UNITED STATES jim@nm-iplaw.com
Submission	Answer
Filer's Name	James T. Nikolai
Filer's e-mail	jim@nm-iplaw.com
Signature	/JAMES T NIKOLAI/
Date	01/08/2010
Attachments	Answer to Notice of Opposition.pdf ( 9 pages )(90681 bytes )

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

In the matter of application Serial No. 76/693,743. Published  
in the Official Gazette on March 17, 2009.

Facebook, Inc.,

January 8, 2010

Opposer,

v.

Opposition No. 91191915

Everclear Communications Inc.,

Applicant.

-----  
**ANSWER TO NOTICE OF OPPOSITION**

TTAB  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

Everclear, Everclear Communications, Inc. (hereinafter "Everclear") in response to the First Amended Notice of Opposition (hereinafter "Notice of Opposition") filed by Opposer, Facebook, Inc. (hereinafter "Facebook"), denies each and every allegation contained in the Notice of Opposition unless specifically admitted herein below. With respect to the numbered paragraphs contained in the Notice of Opposition, Everclear states as follows:

1. Everclear admits 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, but denies the remaining allegations of Paragraph 1 of the Notice of Opposition.

2. Everclear is without sufficient information to admit or deny the allegations of Paragraph 2 of the Notice of Opposition and therefore denies the same leaving Facebook to its proof.

3. Everclear admits the allegations of Paragraph 3 of the Notice of Opposition.

4. In response to Paragraph 4 of the Notice of Opposition, Everclear admits Facebook users are able to update their status and send items such as textual messages, links, photographs or video from mobile devices such as Blackberry and iPhone smartphones, but is without sufficient information to either admit or deny the remaining allegations of Paragraph 4 and therefore denies the same leaving Facebook to its proof.

5. Everclear admits the allegations of Paragraph 5 of the Notice of Opposition.

6. Everclear is without sufficient information to admit or deny the allegations of Paragraph 6 of the Notice of Opposition and therefore denies the same leaving Facebook to its proof.

7. Everclear admits the allegations of Paragraph 7 of the Notice of Opposition, but denies the registration cited therein

is valid and subsisting.

8. Everclear admits the allegations of Paragraph 8 of the Notice of Opposition, but denies the registration cited therein is valid and subsisting.

9. Everclear admits the allegations of Paragraph 9 of the Notice of Opposition, but denies the registration cited therein is valid and subsisting.

10. Everclear admits the allegations of Paragraph 10 of the Notice of Opposition.

11. Everclear is without sufficient information to admit or deny the allegations of Paragraph 11 of the Notice of Opposition and therefore denies the same leaving Facebook to its proof.

12. Everclear denies the allegations of Paragraph 12 of the Notice of the Opposition.

13. Everclear is without sufficient information to admit or deny the allegations of Paragraph 13 of the Notice of Opposition and therefore denies the same leaving Facebook to its proof.

14. Everclear denies the allegations of Paragraph 14 of the Notice of Opposition.

15. Everclear admits the allegations of Paragraph 15 of the Notice of Opposition.

16. Everclear admits the allegations of Paragraph 16 of

the Notice of Opposition.

17. Everclear denies the allegations of Paragraph 17 of the Notice of Opposition.

18. Everclear denies the allegations of Paragraph 18 of the Notice of Opposition.

19. Everclear denies the allegations of Paragraph 19 of the Notice of Opposition.

20. Everclear denies the allegations of Paragraph 20 of the Notice of Opposition.

21. Everclear denies the allegations of Paragraph 21 of the Notice of Opposition.

22. Everclear does not understand the allegations of Paragraph 22 of the Notice of Opposition and therefore denies the same.

23. Everclear denies the allegations of Paragraph 23 of the Notice of Opposition.

24. In response to Paragraph 24 of the Notice of Opposition, Everclear restates its responses to Paragraphs 1 - 23.

25. The allegations of Paragraph 25 of the Notice of Opposition are denied.

26. Everclear denies the allegations of Paragraph 26 of the Notice of Opposition.

27. Everclear denies the allegations of Paragraph 27 of

the Notice of Opposition.

28. Everclear denies the allegations of Paragraph 28 of the Notice of Opposition.

29. Everclear denies the allegations of Paragraph 29 of the Notice of Opposition.

30. Everclear denies the allegations of Paragraph 30 of the Notice of Opposition.

31. In response to Paragraph 31 of the Notice of Opposition, Everclear restates its responses to Paragraphs 1-30.

32. Everclear denies the allegations of Paragraph 32 of the Notice of Opposition.

33. Everclear denies the allegations of Paragraph 33 of the Notice of Opposition.

34. Everclear admits that Facebook is the owner of the three registrations listed in Paragraphs 7 - 9 of the Notice of Opposition (but denies they are valid and subsisting) and the applications listed in Paragraph 10 of the Notice of Opposition, but otherwise denies the allegation of Paragraph 34 of the Notice of Opposition.

35. Everclear does not agree with the characterization made by Facebook in Paragraph 35 of the Notice of Opposition and therefore denies the same leaving Facebook to its proof.

36. Everclear is without sufficient information to admit or deny the allegations of Paragraph 36 of the Notice of

Opposition and therefore denies the same leaving Facebook to its proof.

37. Everclear is without sufficient information to admit or deny the allegations of Paragraph 37 of the Notice of Opposition and therefore denies the same leaving Facebook to its proof.

38. Everclear denies the allegations of Paragraph 38 of the Notice of Opposition.

39. Everclear denies the allegations of Paragraph 39 of the Notice of Opposition.

40. Everclear denies the allegations of Paragraph 40 of the Notice of Opposition.

41. In response to Paragraph 41 of the Notice of Opposition, Everclear restates its responses to Paragraph 1-40.

42. Everclear admits the allegations of Paragraph 42 of the Notice of Opposition.

43. The allegations of Paragraph 43 of the Notice of Opposition mischaracterize the specimen submitted by Everclear which was found to be acceptable by the U.S. Patent and Trademark Office. However, Everclear does admit that one of many statements made in the specimen is: "Call your friends, phone to phone, via Talkbook."

44. Everclear denies the allegations of Paragraph 44 of the Notice of Opposition.

45. Everclear denies the allegations of Paragraph 45 of the Notice of Opposition.

46. In response to Paragraph 46 of the Notice of Opposition, Everclear restates its responses to Paragraphs 1-45.

47. Everclear admits the allegations of Paragraph 47 of the Notice of Opposition.

48. Everclear denies the allegations of Paragraph 48 of the Notice of Opposition.

49. Everclear denies the allegations of Paragraph 49 of the Notice of Opposition.

50. Everclear denies the allegations of Paragraph 50 of the Notice of Opposition.

51. Everclear denies the allegations of Paragraph 51 of the Notice of Opposition.

52. In response to Paragraph 52 of the Notice of Opposition, Everclear prays this Opposition be denied and that registration of its mark be granted.

#### **AFFIRMATIVE DEFENSES**

1. Everclear's Talkbook mark and the marks asserted by Facebook are substantially different in sound, appearance, meaning, pronunciation, and overall commercial impression.

2. Facebook does not have the right to exclude others from using the "BOOK" component of its FACEBOOK marks. There are currently more than 3000 registrations or pending

applications for registration which include "book" as a component. Facebook's marks are therefore weak and entitled to only a very narrow scope of protection.

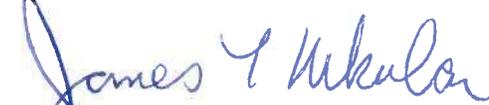
3. The "TALK" component of the TALKBOOK mark distinguishes the TALKBOOK mark from those marks used by Facebook.

4. There is no likelihood of confusion between Facebook's marks and Everclear's TALKBOOK mark.

WHEREFORE, Everclear respectfully requests this Opposition be dismissed with prejudice.

Respectfully submitted,

NIKOLAI & MERSEREAU, P.A.



James T. Nikolai  
Attorney for Applicant, Everclear  
900 Second Avenue So.  
Suite 820  
Minneapolis, MN 55402  
(Phone: 612) 339-7461  
Fax: (612) 349-6556

Date: Jan 8, 2010

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

In the matter of application Serial No. 76/693,743. Published in  
the Official Gazette on March 17, 2009.

Facebook, Inc.,

January 8, 2010

Opposer,

v.

Opposition No. 91191915

Everclear Communications Inc.,

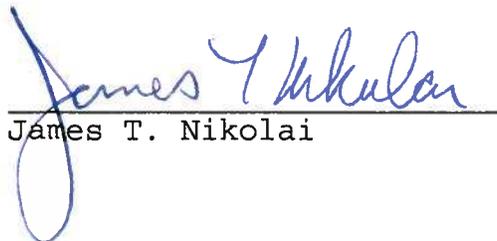
Applicant.

-----  
**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the following documents:

1. Answer to Notice of Opposition; and
2. Certificate of Service.

was served upon Kathleen E. Johnston, Esq., COOLEY GODWARD  
KRONISH LLP, 101 California Street, 5<sup>th</sup> Floor, San Francisco, CA  
94111-5800 (Attorney for Opposer) by First Class Mail this 8<sup>th</sup>  
day of January, 2010.

  
James T. Nikolai

# **EXHIBIT C**



Kathleen E. Johnston  
(415) 693-2107  
kjohnston@cooley.com

VIA EMAIL

September 14, 2010

James T. Nikolai  
Nikolai & Mersereau, P.A.  
900 Second Avenue So.  
Suite 820  
Minneapolis, MN 55402

**RE: Facebook, Inc. v. Everclear Communications, Inc. (TALKBOOK)**  
**TTAB Opposition Number: 91191915**

Dear Jim:

I write to follow up on the discovery matters we discussed.

First, my client had some edits to your proposed protective order. Attached is our revised proposed order. Please let us know if you have any comments or questions. We are ready to produce documents as soon as this order is entered.

Second, we are willing to agree to a 60 day extension of discovery deadlines at this time. Should additional extensions be warranted, we will certainly consider them. Please provide written confirmation of your consent to a 60 day extension and we will

With respect to depositions, we confirm that we will make Jonathan Ehrlich available for deposition at our offices in Palo Alto. We are working on obtaining some available dates.

You have also expressed an interest in deposing a veritable who's who of Facebook officers and directors: Mark Zuckerberg,<sup>1</sup> Founder and CEO, David Ebersman, CFO, Sheryl Sandberg, COO, and the following members of Facebook's Board of Directors: James Breyer, Peter Thiel, Marc Andreessen, Donald Graham. When I questioned your basis for seeking to depose these individuals, the only subject matter you were able to articulate was the history of Facebook and decisions relating to the Facebook brand.

As I previously explained, there are plenty of other witnesses with equal or greater knowledge on relevant issues relating to Facebook's history and brand strategy, and we encourage you to depose Mr. Ehrlich and/or serve a 30(b)(6) notice. Failure to exhaust those opportunities before reaching for the top of the company would be a mistake. Any persistence in deposing these individuals without specific justification would be a transparent attempt to exert pressure on Facebook through the harassment of its executives, and would constitute an abuse of discovery that will not be tolerated.

---

<sup>1</sup> Although your May 7, 2010 letter identified a "Mark Zuckerman," we understand you intended to identify Facebook's Founder and CEO Mark Zuckerberg.



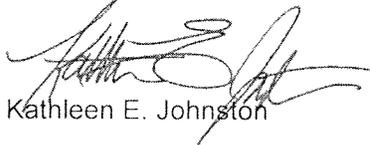
James T. Nikolai  
September 14, 2010  
Page Two

Meanwhile, we look forward to receiving your available dates in the first half of October for depositions of Anthony Goldstein and John Pozios, as well as the locations where the depositions would be held.

We also look forward to receiving your supplemental responses regarding Interrogatories 10-12 and 19-40, as well as Request for Admission Nos. 1, and 86-100. In addition, we look forward to receiving confirmation whether or not you will stand by Everclear's responses to Request for Admission Nos. 57, 61 and 66.

Very truly yours,

COOLEY LLP



Kathleen E. Johnston

Enclosure

KEJ:ll

1193455 v1/SF

# **EXHIBIT D**

## Norberg, Jeffrey

---

**From:** Jim Nikolai [Jim.Nikolai@nm-iplaw.com]  
**Sent:** Monday, November 29, 2010 12:10 PM  
**To:** Norberg, Jeffrey  
**Cc:** john@pozios.com  
**Subject:** RE: Facebook v. Everclear Document Production  
**Attachments:** Amended Answer to Notice of Opposition.pdf

Jeff-

I hope you had a good Thanksgiving holiday. I am attaching the Amended Answer and Counterclaim we previously discussed. I would appreciate it if you would review this document and let me know if Facebook will consent to the filing of this amended pleading in the pending opposition.

Please let me know as soon as possible.

Thanks.

JAMES T. NIKOLAI  
*Attorney at Law*  
DIRECT DIAL: 612.392.7302



NIKOLAI & MERSEREAU, P.A.  
900 SECOND AVENUE SOUTH, SUITE 820  
MINNEAPOLIS, MINNESOTA 55402-3813  
TELEPHONE: 612.339.7461  
FACSIMILE: 612.349.6556  
WEBSITE: WWW.NM-IPLAW.COM

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**From:** Norberg, Jeffrey [<mailto:jnorberg@cooley.com>]  
**Sent:** Tuesday, November 09, 2010 3:19 PM  
**To:** Jim Nikolai  
**Subject:** RE: Facebook v. Everclear Document Production

Thanks Jim – I will have our mail room look for it. In the future, please direct all correspondence to me at Cooley's Palo Alto office, in my signature block below.

---

**From:** Jim Nikolai [<mailto:Jim.Nikolai@nm-iplaw.com>]  
**Sent:** Tuesday, November 09, 2010 12:42 PM  
**To:** Norberg, Jeffrey  
**Subject:** RE: Facebook v. Everclear Document Production

Here is a copy of the service letter and certificate of service. If you can't locate the disk I can try to e-mail the documents to you, but it is quite a large file so I don't know if it will go through.

JAMES T. NIKOLAI  
*Attorney at Law*  
DIRECT DIAL: 612.392.7302



NIKOLAI & MERSEREAU, P.A.  
900 SECOND AVENUE SOUTH, SUITE 820  
MINNEAPOLIS, MINNESOTA 55402-3813  
TELEPHONE: 612.339.7461  
FACSIMILE: 612.349.6556  
WEBSITE: WWW.NM-IPLAW.COM

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---

**From:** Norberg, Jeffrey [<mailto:jnorberg@cooley.com>]  
**Sent:** Tuesday, November 09, 2010 1:40 PM  
**To:** Jim Nikolai  
**Cc:** Weiand, Maria  
**Subject:** Facebook v. Everclear Document Production

Jim:

We still have not received Everclear's document production. Can you please reconfirm that it was sent on Friday and to whom?

Sincerely,

**Jeffrey T. Norberg**  
Cooley LLP • Five Palo Alto Square  
3000 El Camino Real • Palo Alto, CA 94306-2155  
Direct: 650-843-5889 • Fax: (650) 857-0663 • Cell: (415) 359-5656  
Bio: [www.cooley.com/jnorberg](http://www.cooley.com/jnorberg)

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

In the matter of application Serial No. 76/693,743. Published  
in the Official Gazette on March 17, 2009.

Facebook, Inc.,

November 29, 2010

Opposer,

v.

Opposition No. 91191915

Everclear Communications Inc.,

Applicant.

-----

**AMENDED ANSWER TO NOTICE OF OPPOSITION AND COUNTERCLAIM**

TTAB  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

Everclear, Everclear Communications, Inc. (hereinafter  
"Everclear") in response to the First Amended Notice of  
Opposition (hereinafter "Notice of Opposition") filed by  
Opposer, Facebook, Inc. (hereinafter "Facebook"), denies each  
and every allegation contained in the Notice of Opposition  
unless specifically admitted herein below. With respect to the  
numbered paragraphs contained in the Notice of Opposition,  
Everclear states as follows:

1. Everclear admits 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, but denies the remaining allegations of Paragraph 1 of the Notice of Opposition.

2. Everclear is without sufficient information to admit or deny the allegations of Paragraph 2 of the Notice of Opposition and therefore denies the same leaving Facebook to its proof.

3. Everclear admits the allegations of Paragraph 3 of the Notice of Opposition.

4. In response to Paragraph 4 of the Notice of Opposition, Everclear admits Facebook users are able to update their status and send items such as textual messages, links, photographs or video from mobile devices such as Blackberry and iPhone smartphones, but is without sufficient information to either admit or deny the remaining allegations of Paragraph 4 and therefore denies the same leaving Facebook to its proof.

5. Everclear admits the allegations of Paragraph 5 of the Notice of Opposition.

6. Everclear is without sufficient information to admit or deny the allegations of Paragraph 6 of the Notice of Opposition and therefore denies the same leaving Facebook to its proof.

7. Everclear admits the allegations of Paragraph 7 of the

Notice of Opposition, but denies the registration cited therein is valid and subsisting.

8. Everclear admits the allegations of Paragraph 8 of the Notice of Opposition, but denies the registration cited therein is valid and subsisting.

9. Everclear admits the allegations of Paragraph 9 of the Notice of Opposition, but denies the registration cited therein is valid and subsisting.

10. Everclear admits the allegations of Paragraph 10 of the Notice of Opposition.

11. Everclear is without sufficient information to admit or deny the allegations of Paragraph 11 of the Notice of Opposition and therefore denies the same leaving Facebook to its proof.

12. Everclear denies the allegations of Paragraph 12 of the Notice of the Opposition.

13. Everclear is without sufficient information to admit or deny the allegations of Paragraph 13 of the Notice of Opposition and therefore denies the same leaving Facebook to its proof.

14. Everclear denies the allegations of Paragraph 14 of the Notice of Opposition.

15. Everclear admits the allegations of Paragraph 15 of

the Notice of Opposition.

16. Everclear admits the allegations of Paragraph 16 of the Notice of Opposition.

17. Everclear denies the allegations of Paragraph 17 of the Notice of Opposition.

18. Everclear denies the allegations of Paragraph 18 of the Notice of Opposition.

19. Everclear denies the allegations of Paragraph 19 of the Notice of Opposition.

20. Everclear denies the allegations of Paragraph 20 of the Notice of Opposition.

21. Everclear denies the allegations of Paragraph 21 of the Notice of Opposition.

22. Everclear does not understand the allegations of Paragraph 22 of the Notice of Opposition and therefore denies the same.

23. Everclear denies the allegations of Paragraph 23 of the Notice of Opposition.

24. In response to Paragraph 24 of the Notice of Opposition, Everclear restates its responses to Paragraphs 1 - 23.

25. The allegations of Paragraph 25 of the Notice of Opposition are denied.

26. Everclear denies the allegations of Paragraph 26 of the Notice of Opposition.

27. Everclear denies the allegations of Paragraph 27 of the Notice of Opposition.

28. Everclear denies the allegations of Paragraph 28 of the Notice of Opposition.

29. Everclear denies the allegations of Paragraph 29 of the Notice of Opposition.

30. Everclear denies the allegations of Paragraph 30 of the Notice of Opposition.

31. In response to Paragraph 31 of the Notice of Opposition, Everclear restates its responses to Paragraphs 1-30.

32. Everclear denies the allegations of Paragraph 32 of the Notice of Opposition.

33. Everclear denies the allegations of Paragraph 33 of the Notice of Opposition.

34. Everclear admits that Facebook is the owner of the three registrations listed in Paragraphs 7 - 9 of the Notice of Opposition (but denies they are valid and subsisting) and the applications listed in Paragraph 10 of the Notice of Opposition, but otherwise denies the allegation of Paragraph 34 of the Notice of Opposition.

35. Everclear does not agree with the characterization

made by Facebook in Paragraph 35 of the Notice of Opposition and therefore denies the same leaving Facebook to its proof.

36. Everclear is without sufficient information to admit or deny the allegations of Paragraph 36 of the Notice of Opposition and therefore denies the same leaving Facebook to its proof.

37. Everclear is without sufficient information to admit or deny the allegations of Paragraph 37 of the Notice of Opposition and therefore denies the same leaving Facebook to its proof.

38. Everclear denies the allegations of Paragraph 38 of the Notice of Opposition.

39. Everclear denies the allegations of Paragraph 39 of the Notice of Opposition.

40. Everclear denies the allegations of Paragraph 40 of the Notice of Opposition.

41. In response to Paragraph 41 of the Notice of Opposition, Everclear restates its responses to Paragraph 1-40.

42. Everclear admits the allegations of Paragraph 42 of the Notice of Opposition.

43. The allegations of Paragraph 43 of the Notice of Opposition mischaracterize the specimen submitted by Everclear which was found to be acceptable by the U.S. Patent and

Trademark Office. However, Everclear does admit that one of many statements made in the specimen is: "Call your friends, phone to phone, via Talkbook."

44. Everclear denies the allegations of Paragraph 44 of the Notice of Opposition.

45. Everclear denies the allegations of Paragraph 45 of the Notice of Opposition.

46. In response to Paragraph 46 of the Notice of Opposition, Everclear restates its responses to Paragraphs 1-45.

47. Everclear admits the allegations of Paragraph 47 of the Notice of Opposition.

48. Everclear denies the allegations of Paragraph 48 of the Notice of Opposition.

49. Everclear denies the allegations of Paragraph 49 of the Notice of Opposition.

50. Everclear denies the allegations of Paragraph 50 of the Notice of Opposition.

51. Everclear denies the allegations of Paragraph 51 of the Notice of Opposition.

52. In response to Paragraph 52 of the Notice of Opposition, Everclear prays this Opposition be denied and that registration of its mark be granted.

## **AFFIRMATIVE DEFENSES**

1. Everclear's Talkbook mark and the marks asserted by Facebook are substantially different in sound, appearance, meaning, pronunciation, and overall commercial impression.

2. Facebook does not have the right to exclude others from using the "BOOK" component of its FACEBOOK marks. There are currently more than 3000 registrations or pending applications for registration which include "book" as a component. Facebook's marks are therefore weak and entitled to only a very narrow scope of protection.

3. The "TALK" component of the TALKBOOK mark distinguishes the TALKBOOK mark from those marks used by Facebook.

4. There is no likelihood of confusion between Facebook's marks and Everclear's TALKBOOK mark.

5. Facebook bases its Notice of Opposition at least in part on various registrations and applications for registration of marks which it claims to own. As set forth below, such registrations should be cancelled because Facebook has committed fraud on the U.S. Patent and Trademark Office in connection with the filing and prosecution of such applications and the securing of such registrations.

## **COUNTERCLAIM**

Applicant, Everclear Communications, Inc., believes that it is damaged by Registration No. 3,041,791, Reg. No. 3,801,147 and 3,814,888 and hereby requests cancellation of same under the provisions of 15 U.S.C. § 1064(3). As grounds for cancellation, Applicant asserts that:

### **Count I**

#### **U.S. Trademark Registration 3,041,791**

1. Facebook filed Application Serial No. 78/574,726 for the mark THEFACEBOOK on a use basis on February 24, 2005, claiming a date of first use and a date of first use in commerce of February 4, 2004, for the following services: "providing online directory information services featuring information regarding, and in the nature of, collegiate life, classifieds, virtual community and social networking" in International Class 35 and "providing online chat rooms for registered users for transmission of messages concerning collegiate life, classifieds, virtual community and social networking" in International Class 38.

2. The specimen submitted by Facebook to the PTO on February 24, 2005 with its application to register the FACEBOOK mark makes no mention of "classifieds" or "providing online chat rooms for registered users for transmission of messages".

3. On information and belief, Facebook never used the FACEBOOK mark in connection with "classifieds" or "providing online chat rooms for registered users for transmission of messages" on or before February 4, 2004.

4. On information and belief, Facebook never provided any of the services listed in its application on or before February 4, 2004 in commerce. On that date, Facebook only offered services to a limited number of people.

5. On information and belief, on February 4, 2004 and for a period of time thereafter, the mark FACEBOOK was never used. Instead, Facebook used the mark THEFACEBOOK. This is demonstrated by the original application filed on February 24, 2005, the specimen submitted therewith and the original certificate of registration.

6. On information and belief, Facebook adopted the mark THEFACEBOOK rather than FACEBOOK to distinguish its services from similar goods and services offered by Harvard University and other educational institutions using the term "facebook". A number of educational institutions before February 4, 2004 routinely published directories called a "facebook" to help people identify others at the school. Such books were used to help students and faculty search for people at the school, find out who is in a particular class, look up friends of friends,

and see pictures of people in a student's social network.

7. On information and belief, many such educational institutions which published a "facebook" in print form for years were, by February 4, 2004, also publishing their "facebook" online or were in the process of doing so.

8. On or about July 13, 2006, Facebook filed with the U.S. Patent and Trademark Office a request to amend the mark covered by the registration from THEFACEBOOK to FACEBOOK.

9. The papers submitted with Facebook's request demonstrate that Facebook asserted: "This amendment is proper under 37 C.F.R. § 2.173(a) because it does not materially alter the mark in that it only deletes the insignificant definite article "THE" from the mark. As such, the modified mark contains the complete essence of the original mark and creates the same exact commercial impression." These papers also demonstrate Facebook never told the U.S. Patent and Trademark Office about others using the term "facebook" in connection with related goods and services and that the mark THEFACEBOOK was originally adopted to distinguish Facebook's services from the goods and services offered by others using the term "facebook".

10. In filing its request to amend the mark, Facebook withheld material information from the U.S. Patent and Trademark Office.

11. On information and belief, Facebook has misrepresented the nature of its use in commerce of the mark THEFACEBOOK on the dates claimed in the application and at the time it submitted its application, and Facebook misrepresented when such use in commerce began in its application. Facebook also withheld information material to its request to amend the mark from THEFACEBOOK to FACEBOOK. On information and belief, Applicant has attempted to procure and then amend its registration of the FACEBOOK mark by false means and/or by knowingly and willingly making false and/or fraudulent declarations or representations to the PTO. On information and belief, such false statements were made with the intent to induce authorized agents of the PTO to grant and then amend U.S. Trademark Reg. No. 3,041,791.

12. In view of Facebook's conduct, Registration No. 3,041,791 should be cancelled.

13. Facebook, in this opposition proceeding, is asserting this fraudulently procured registration as a basis for denying Applicant the registration it seeks for the mark TALKBOOK, all to the injury and damage of Applicant.

#### **Count II**

#### **U.S. Trademark Registrations 3,801,147 and 3,814,888**

14. Applicant realleges and incorporates by reference Paragraphs 1-13 of this Counterclaim.

15. Facebook filed Application Serial No. 77/039,123 on November 7, 2006. In this application Facebook sought registration for a number of goods and services under Section 1(b) of the Trademark Act, including, among others, "electronic publishing services, namely, publication of text, audio, video and graphic works online" in International Class 41.

16. On or about December 18, 2009, Facebook filed a Statement of Use in connection with Application Serial No. 77/039,123. On information and belief, this Statement of Use contains false and misleading statements made with the intent that such statement be relied upon by the PTO. By way of example, Facebook's Statement of Use includes the following:

For International Class 041:  
Current identification: 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.

This mark is in use in commerce on or in connection with all goods or services listed in the application or Notice of Allowance or as subsequently modified for this specific class

The mark was first used by the applicant, or the applicant's related company, licensee, or predecessor in interest at least as early as 02/00/2004, and first used in commerce at least as early as 02/00/2004, and is now in use in such commerce. The applicant is submitting one specimen for the class showing the mark as used in commerce on or in connection with any item in the class, consisting of a(n) The specimen is a page from Applicant's website which reflects use

of Applicant's mark in connection with the electronic publishing of online works of others.

17. The Statement of Use filed by Facebook and signed by Richard Nessary, Facebook's Lead Counsel, IP and Competition, included the following Declaration:

Applicant requests registration of the above-identified trademark/service mark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq., as amended). Applicant is the owner of the mark sought to be registered, and is using the mark in commerce on or in connection with the goods/services identified above, as evidenced by the attached specimen(s) showing the mark as used in commerce.

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements may jeopardize the validity of the form or any resulting registration, declares that he/she is properly authorized to execute this form on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the form is being filed under 15 U.S.C. Section 1126(d) or (e), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

18. On information and belief, Facebook was not providing "electronic publishing services, namely, publishing online works of others featuring user-created...video" before the end of February 2004, the date claimed in the Statement of Use.

19. An article published on February 9, 2004, in the Howard Crimson Newspaper quotes Mark Zuckerberg, Facebook's Founder. The article, in listing the features then being offered, does not include publishing user-created video. The article further indicates, in a statement attributed to Mr. Zuckerberg, that the website thefacebook.com did not have the capability to upload videos.

20. On information and belief, Facebook did not publish online works of others featuring user-created video until some time well after February of 2004.

21. On information and belief, the mark FACEBOOK was never used on any goods or services before the end of February 2004 by Facebook. At that time, the mark used was THEFACEBOOK.

22. At the time Facebook filed its Application Serial No. 77/039,123, and throughout the USPTO proceedings related to that application, Facebook never disclosed to the PTO that others were using the term "Facebook" for related goods and services, some of whom continue to do so to this day.

23. On information and belief, Facebook misrepresented the

mark it was using, the nature of its use in commerce and the date it first used the mark or any mark in commerce related to the goods and services covered by Reg. No. 3,801,147. On information and belief, Facebook attempted to procure and did procure Reg. No. 3,801,147 by knowingly and willingly making false and/or fraudulent declarations or representations to the PTO, inter alia, falsely alleging in connection with its Application and in its Statement of Use, supported by a Declaration under 18 U.S.C. § 1001, that its first use of the FACEBOOK mark was in February 2004 for the claimed services, when no such use of the FACEBOOK mark was made until well after February 2004. On information and belief, these false statements were made with the intent to induce authorized agents of the PTO to grant Reg. No. 3,801,147.

24. On or about April 16, 2010, the PTO divided Application Serial No. 77/039,123 and assigned Serial No. 77/979,375 to the child application. The child application resulted in the grant of Reg. No. 3,801,147 and the parent application in the grant of Reg. No. 3,814,888.

25. Registration No. 3,814,888 is also tainted by the false statements and fraudulent conduct of Facebook and its representatives. That registration, like Reg. No. 3,801,147 should therefore be cancelled.

26. Facebook is asserting, or is likely to assert, these fraudulently procured registrations in this opposition as a basis for denying Applicant registration of Applicant's TALKBOOK mark all to the injury and damage of Applicant.

WHEREFORE, Applicant requests Facebook's opposition be dismissed and Facebook's Reg. Nos. 3,041,791; 3,801,147; and 3,814,888 be cancelled.

Respectfully submitted,

NIKOLAI & MERSEREAU, P.A.

James T. Nikolai  
Attorney for Applicant, Everclear  
900 Second Avenue So.  
Suite 820  
Minneapolis, MN 55402  
(Phone: 612) 339-7461  
Fax: (612) 349-6556

Date: \_\_\_\_\_, 2010

# **EXHIBIT E**

# HellerEhrman<sub>LLP</sub>

July 11, 2006

*Via First Class Mail*

Lisa Greenwald-Swire  
[lisa.greenwald-swire@hellerehrman.com](mailto:lisa.greenwald-swire@hellerehrman.com)

Main (650) 324-7000  
Fax (650) 324-0638

41446-1000

Commissioner for Trademarks  
PO Box 1451  
Alexandria, VA 2213-1451

**Re: US Trademark Application**  
**Registration No. 3041791**  
**Mark: THEFACEBOOK**  
**Applicant: Facebook, Inc.**  
**Our ref. 41446-1000**

Dear Sir or Madam:

Enclosed for filing is Applicant's **Request for Amendment of the Mark Under Section 7(e)** for the above referenced trademark, including the following:

1. Request for the Amendment of Mark;
2. Declaration Under 37 C.F.R. § 2.20 in Support of Specimen;
3. Amended drawing page;
4. Specimen displaying use of the mark as amended;
5. A stamped, self-addressed postcard to acknowledge receipt; and
6. A check in the amount of \$100 for the filing fee.

In the event the enclosed amount is insufficient for the fee, you are authorized to draw on our deposit account No. 08-1645 (Our Reference No. 41446-1000), as necessary. A copy of this transmittal letter is enclosed for this purpose.

Very truly yours,

*Lisa Greenwald-Swire (Hm)*

Lisa Greenwald-Swire



07-13-2006

U.S. Patent & TMO/c/TM Mail Rpt Dt. #72

Enclosures

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 2.197(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to the Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451, on:

Margaret Trevino  
Print Name

7/11/06  
Date of Deposit

Margaret Trevino  
Signature

7/11/06  
Date

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

---

**Registrant:** Facebook, Inc.

**Registration No:** 3041791

**Filed:** February 24, 2005

**Mark:** THEFACEBOOK

**Registered:** January 10, 2006

---

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

**REQUEST FOR AMENDMENT OF THE MARK UNDER SECTION 7(e)**

Dear Sir or Madam:

Applicant respectfully requests amendment of the present mark, THEFACEBOOK (in standard character form) to FACEBOOK (in standard character form). This amendment is proper under 37 C.F.R. § 2.173(a) because it does not materially alter the mark in that it only deletes the insignificant definite article "THE" from the mark. As

such, the modified mark contains the complete essence of the original mark and creates the same exact commercial impression.

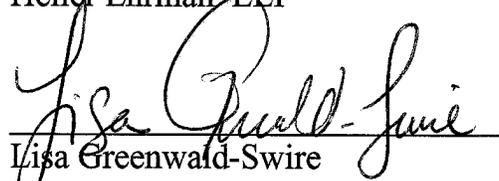
The Trademark Trial and Appeal Board held that the addition of the word “THE” to a mark is not a material alteration. *See In re Reese Brothers, Inc.*, No. 74/668,052, 1999 WL 149838, at \*2 (T.T.A.B. March 9, 1999) (“We agree with the applicant that the addition of the word “THE” is insignificant.”). Similar to the addition of the word “THE,” the deletion of the word “THE” is an insignificant, non-material alteration to the mark.

Indeed, this alteration is extremely minimal in comparison with other alterations approved by the Patent and Trademark Office. *See, e.g., In re Larios, S.A.*, 35 U.S.P.Q.2d 1214 (T.T.A.B. 1995) (approving amendment from GRAN VINO MALAGA LARIOS to VINO DE MALAGA LARIOS); *In re Finlay Fine Jewelry Corp.*, 41 U.S.P.Q.2d 1152 (T.T.A.B. 1996) (approving amendment from NY JEWELRY OUTLET to NEW YORK JEWELRY OUTLET). If dropping the insignificant term “GRAN” is an immaterial alteration, then certainly dropping the even more insignificant term “THE” should be as well. As such, Applicant therefore respectfully requests that the Examiner accept this amendment.

Applicant encloses herewith (1) a drawing of the mark; (2) a specimen displaying use of the mark as amended; (3) a Declaration under 37 C.F.R. § 2.20 in Support of the Specimen; and (4) a check for the prescribed fee of \$100 for the amendment. In the event of over or underpayment, you are authorized to withdraw from our deposit, as necessary,

the amount in deficiency in excess to Deposit Order Account No. 08-1645 (Reference No. 41446-1000).

Respectfully submitted,  
Heller Ehrman LLP

A handwritten signature in black ink, reading "Lisa Greenwald-Swire", written over a horizontal line.

Lisa Greenwald-Swire  
Attorney for Registrant  
275 Middlefield Road  
Menlo Park, CA 94025  
(650) 324-7000

**In the United States Patent and Trademark Office**

Registrant: Facebook, Inc.  
Registration No.: 3041791  
Registered: January 10, 2006  
Proposed Trademark: FACEBOOK

**Declaration Under 37 C.F.R. § 2.20 in Support of Specimen for Request  
for Amendment of Mark**

Rudy Gadre declares that he is the Vice President and the General Counsel of the Registrant corporation and is authorized to execute this declaration on behalf of said corporation.

The Registrant states that the specimen was in use in commerce at least as early as the date the Section 7 amendment was filed.

Pursuant to 37 C.F.R. § 2.20, the undersigned declares that he is properly authorized to execute this Declaration on behalf of the Registrant; that he believes the Registrant to be the owner of the mark sought to be amended; that all statements made herein of his own knowledge are true; that all statements made on information and belief are believed to be true; that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code; and that such willful false statements may jeopardize the validity of the application or document or any registration resulting therefrom.

Date: 6/27/06

Facebook, Inc.  
By: R. Gadre

Name: Rudy Gadre  
Title: Vice President and  
General Counsel

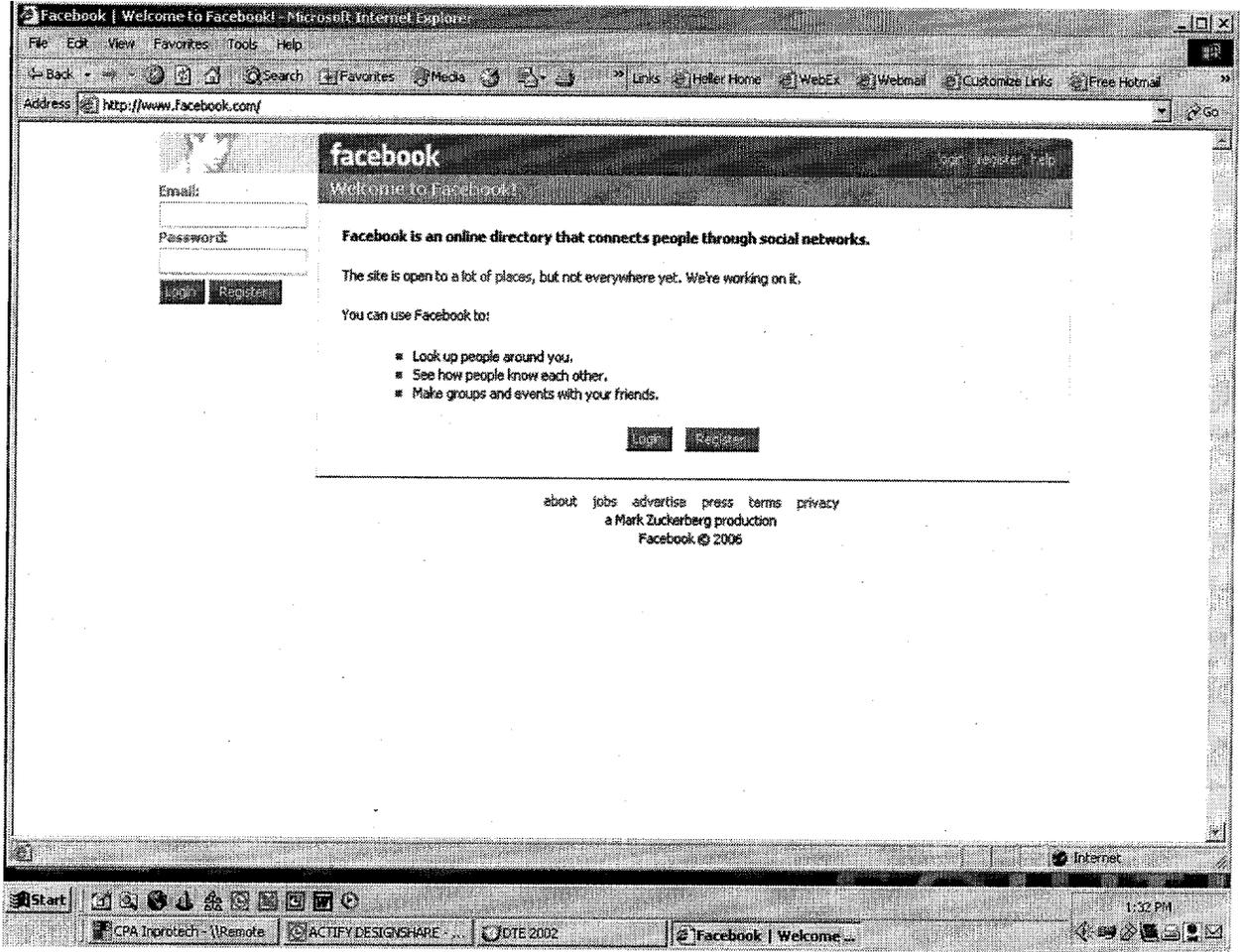
**AMENDED DRAWING PAGE**

Registration No. 3,041,791

Registrant: Facebook, Inc.  
a Delaware corporation

Business Address: 156 University Avenue  
Palo Alto, CA 94301

**FACEBOOK**



# **EXHIBIT F**

Int. Cls.: 35 and 38

Prior U.S. Cls.: 100, 101, 102 and 104

Reg. No. 3,041,791

United States Patent and Trademark Office

Registered Jan. 10, 2006

Amended

OG Date Nov. 14, 2006

**SERVICE MARK  
PRINCIPAL REGISTER**



FACEBOOK, INC. (DELAWARE CORPORATION)  
156 UNIVERSITY AVENUE  
PALO ALTO, CA 94301

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

FOR: PROVIDING AN ONLINE DIRECTORY INFORMATION SERVICE FEATURING INFORMATION REGARDING, AND IN THE NATURE OF, COLLEGIATE LIFE, CLASSIFIEDS, VIRTUAL COMMUNITY AND SOCIAL NETWORKING, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 2-4-2004; IN COMMERCE 2-4-2004.

FOR: PROVIDING ONLINE CHAT ROOMS FOR REGISTERED USERS FOR TRANSMISSION OF MESSAGES CONCERNING COLLEGIATE LIFE, CLASSIFIEDS, VIRTUAL COMMUNITY AND SOCIAL NETWORKING, IN CLASS 38 (U.S. CLS. 100, 101 AND 104).

FIRST USE 2-4-2004; IN COMMERCE 2-4-2004.

SER. NO. 78-574,726, FILED 2-24-2005.

*In testimony whereof I have hereunto set my hand and caused the seal of The Patent and Trademark Office to be affixed on Nov. 14, 2006.*

**DIRECTOR OF THE U.S. PATENT AND TRADEMARK OFFICE**