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

Proceeding	91200221
Party	Defendant SNRG Ventures LLC
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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. 85/046,798
Mark: SHAGBOOK
Published: January 25, 2011

FACEBOOK, INC.,	§	
	§	
	§	
<i>Opposer,</i>	§	
	§	
v.	§	Opposition No. 91200221
	§	
SNRG VENTURES LLC,	§	
	§	
<i>Applicant.</i>	§	

**APPLICANT’S ANSWER TO OPPOSER’S
NOTICE OF OPPOSITION AND COUNTERCLAIMS**

SNRG Ventures, L.L.C. (“Applicant”) answers the Notice of Opposition filed by Facebook, Inc. as follows:

1. With respect to paragraph 1 of the Notice of Opposition, Applicant denies the allegation that FACEBOOK is highly distinctive as it is a generic term. With regard to the remaining allegations of paragraph 1, Applicant is without information or knowledge sufficient to form a belief as to the truth of the allegations, and therefore, denies same.
2. With respect to paragraph 2 of the Notice of Opposition, Applicant denies that any U.S. registrations for the mark FACEBOOK are valid. Applicant is without information or knowledge sufficient to form a belief as to the truth of the remaining allegations, and therefore, denies same.

3. With respect to paragraph 3 of the Notice of Opposition, Applicant denies that any of the registrations attached are valid. Applicant is without information or knowledge sufficient to form a belief as to the truth of the remaining allegations, and therefore, denies same.

4. With respect to paragraph 4 of the Notice of Opposition, Applicant denies that Opposer has common law rights in the FACEBOOK mark. Applicant is without information or knowledge sufficient to form a belief as to the truth of the remaining allegations, and therefore, denies same.

5. With respect to paragraph 5 of the Notice of Opposition, Applicant denies the allegations therein.

6. With respect to paragraph 6 of the Notice of Opposition, Applicant admits that it uses the mark SHAGBOOK in connection with offering dating services at the website <http://www.shagbook.com>. Applicant denies the remaining allegations of paragraph 6.

7. With respect to paragraph 7 of the Notice of Opposition, Applicant admits that it uses the SHAGBOOK mark in connection with offering and promoting its online dating service and that the documents attached as Exhibit C appear to be true and correct copies of the home page and other pages from shagbook.com. Applicant denies the remaining allegations of paragraph 7.

8. With respect to paragraph 8 of the Notice of Opposition, Applicant admits that the allegations therein accurately describe the description of services identified in Applicant's application, that the application was filed May 24, 2010 in the United States and that a true and correct copy of the online status page for the application is attached as Exhibit D. Applicant denies the remaining allegations of paragraph 8.

9. With respect to paragraph 9 of the Notice of Opposition, Applicant admits the allegations therein.

10. With respect to paragraph 10 of the Notice of Opposition, Applicant incorporates by reference paragraphs 1 through 9 above.

11. With respect to paragraph 11 of the Notice of Opposition, Applicant is without information or knowledge sufficient to form a belief as to the truth of the allegations, and therefore, denies same.

12. With respect to paragraph 12 of the Notice of Opposition, Applicant denies the allegations therein.

13. With respect to paragraph 13 of the Notice of Opposition, Applicant denies the allegations therein.

14. With respect to paragraph 14 of the Notice of Opposition, Applicant admits that it offers its dating services via the internet and admits that Opposer offers its services via the internet. Applicant denies the remaining allegations of paragraph 14.

15. With respect to paragraph 15 of the Notice of Opposition, Applicant admits that a true and correct copy of the specimen submitted by Applicant to the USPTO is attached as Exhibit E. Applicant denies the remaining allegations of paragraph 15.

16. With respect to paragraph 16 of the Notice of Opposition, Applicant denies the allegations therein.

17. With respect to paragraph 17 of the Notice of Opposition, Applicant admits the allegations therein.

18. With respect to paragraph 18 of the Notice of Opposition, Applicant admits that Opposer has no control over the nature and quality of the services offered by Applicant.

Applicant denies the remaining allegations of paragraph 18.

19. With respect to paragraph 19 of the Notice of Opposition, Applicant denies the allegations therein.

20. With respect to paragraph 10 of the Notice of Opposition, Applicant incorporates by reference paragraphs 1 through 19 above.

21. With respect to paragraph 21 of the Notice of Opposition, Applicant denies the allegations therein.

22. With respect to paragraph 22 of the Notice of Opposition, Applicant is without information or knowledge sufficient to form a belief as to the truth of the allegations, and therefore, denies same.

23. With respect to paragraph 23 of the Notice of Opposition, Applicant is without information or knowledge sufficient to form a belief as to the truth of the allegations, and therefore, denies same.

24. With respect to paragraph 24 of the Notice of Opposition, Applicant is without information or knowledge sufficient to form a belief as to the truth of the allegations, and therefore, denies same.

25. With respect to paragraph 25 of the Notice of Opposition, Applicant is without information or knowledge sufficient to form a belief as to the truth of the allegations, and therefore, denies same.

26. With respect to paragraph 26 of the Notice of Opposition, Applicant denies that the marks became famous before SNRG began using the SHAGBOOK mark in United States

commerce. Applicant is without information or knowledge sufficient to form a belief as to the truth of the remaining allegations, and therefore, denies same.

27. With respect to paragraph 27 of the Notice of Opposition, Applicant denies the allegations therein.

28. With respect to paragraph 28 of the Notice of Opposition, Applicant admits that one definition of “Shag” is “to have sexual intercourse with.” Applicant denies the remaining allegations of paragraph 28.

29. With respect to paragraph 29 of the Notice of Opposition, Applicant admits that it offers online dating services under the SHAGBOOK mark. Applicant denies the remaining allegations of paragraph 29.

30. With respect to paragraph 30 of the Notice of Opposition, Applicant admits that members of the dating service at www.shagbook.com are allowed to post photographs of themselves. Applicant denies the remaining allegations of paragraph 30.

31. With respect to paragraph 31 of the Notice of Opposition, Applicant denies the allegations therein.

32. With respect to paragraph 32 of the Notice of Opposition, Applicant denies the allegations therein.

33. With respect to paragraph 33 of the Notice of Opposition, Applicant denies the allegations therein.

34. Any allegations within the Notice of Opposition not already specifically admitted or denied herein, are hereby denied.

FIRST AFFIRMATIVE DEFENSE

35. Opposer does not have the exclusive right to use the term “facebook” because the primary significance of the term is an indication of the nature or class of the product or service provided by Opposer and is not an indicator of source. The term was in common use in the English language well before Opposer began using the term in connection with its services. The term is used generically by many members of the public and by a wide variety of organizations. Because the term “facebook” was used by many parties descriptively and generically well before Opposer’s date of first use of the term, the term is generic and incapable of trademark protection under the laws of the United States.

SECOND AFFIRMATIVE DEFENSE

36. Opposer’s opposition should be denied under the equitable doctrine of unclean hands. Opposer has engaged in trademark misuse and trademark bullying by abusively using oppositions, litigation, and threats of the same to maintain a competitive market advantage. For these reasons as well as those outlined in Applicant’s counterclaims below, the opposition should be denied.

THIRD AFFIRMATIVE DEFENSE

37. In the alternative, assuming Opposer does have rights in the term FACEBOOK and assuming *arguendo* that Opposer’s marks were called to mind by consumer’s of Applicant’s dating services, the consumers would have understood such reference to be a parody, said parody authorized by the First Amendment to the United States Constitution, and therefore, there is no tarnishment or dilution.

FOURTH AFFIRMATIVE DEFENSE

38. Opposer's mark does not qualify for anti-dilution protection of the Lanham Act because the term FACEBOOK is highly diluted already by others using identical or very similar marks, including numerous uses of the term "book" in connection with online networking and dating websites.

FIFTH AFFIRMATIVE DEFENSE

39. On information and belief, Opposer has at times made public statements that its website at facebook.com is not a dating site and in fact has removed individuals from the site upon discovering that said individuals had been using the site as a "dating site" to meet new people for sexual encounters. Thus, Opposer should be estopped from arguing that it provides services that are the same as or related to the services provided by Applicant.

SIXTH AFFIRMATIVE DEFENSE

40. There is no likelihood of confusion between Applicant's proposed mark and the mark cited by Opposer even reading the description of Applicant's services broadly. Alternatively, Applicant is only using the mark in connection with its online dating related services, and as such, there is no likelihood of confusion with respect to the actual services provided by Applicant as Opposer does not provide online dating services.

SEVENTH AFFIRMATIVE DEFENSE

41. All of the pertinent registrations cited by Opposer against the registration of Applicant's mark should be canceled, or in the alternative, restricted to goods and services related to the services actually provided by Opposer, namely an online directory for social networking.

EIGHTH AFFIRMATIVE DEFENSE

42. In addition to numerous uses by third parties, Opposer has actually used the term “facebook” in a generic sense, and is estopped from now claiming that it is not generic.

COUNTERCLAIMS

Applicant, as a result of the overreaching claims by Opposer, has been and will continue to be damaged by the continued registration of the marks shown in United State Registration Nos. 3,041,791, 3,122,052, 3,801,147, 3,814,888, 3,881,770, and 3,734,637 and hereby brings these counterclaims seeking cancellation of these registrations. As grounds, Applicant alleges as follows:

HISTORY OF “FACEBOOK”

1. Books containing pictures of the members of an organization along with biographical information have been in existence for many decades. Organizations such as college fraternities and sororities, among others, have historically provided such books to encourage the networking of individuals within the organization by making it easier for the individuals within the organization to make contact with other members. The books also allowed an easy way for a member to identify another member with whom he or she recently became acquainted.
2. With the advent of the internet, organizations began to replace the printed books with online books. Such books included search capabilities to allow users to search the database by first or last name, for example.
3. In 2003, many different organizations at various universities and colleges around the country had online books for the organization that in most cases, although not all, were only

meant to be accessible by the members of the respective organizations. At that time, these online books were commonly referred to by students and administrative personnel as “facebook.”

Another term used in the past to describe these books was “look book.” The relevant consuming public thus considered the term facebook to be a generic term at the time Opposer and/or its predecessor in interest first began using “thefacebook” to identify its services.

4. On information and belief, during the 2003-2004 school year at Harvard University, students began to talk about the need for a “universal face book within Harvard.” Mark Zuckerberg, the CEO of Opposer, was then a student at Harvard. At that time, the University had made plans to create a “Harvard facebook” and had every intention of completing the facebook by the end of the spring semester of 2004.

5. On information and belief, Mr. Zuckerberg decided he did not want to wait for the university to create a facebook. Instead, he launched “thefacebook.com” website in February of 2004. The website allowed only individuals with a Harvard email address to upload their pictures, personal information, and academic information. The site also allowed these students to search for other people in their classes to encourage the formation of friendships and study groups.

6. Even before the introduction of “thefacebook.com” website by Mr. Zuckerberg, however, students have historically used printed and online facebook to assist in locating other students that may be in their classes. The introduction of “thefacebook.com” website helped move at least a portion of this social networking from the real world where students communicated in person or over the telephone, to an online world where the computer is used as a means of communication.

7. On information and belief, at least as early as September 2003, Think Computer Corporation began using the terms “FACEBOOK,” “FACE BOOK,” “UNIVERSAL FACEBOOK,” and “FACENET” in conjunction with a unique computer software application at Harvard University used to provide on-line information services featuring information regarding, and in the nature of, collegiate life, classifieds, virtual communities, and social networking.

8. On information and belief, Aaron Greenspan, the CEO of Think Computer, and Mark Zuckerberg, the CEO of Opposer, were simultaneously enrolled at Harvard University in 2003 and 2004, and further were enrolled together in an independent study computer science course in the spring of 2004.

9. On information and belief, Mr. Zuckerberg was a user of Think Computer’s facebook software application, and without Applicant’s permission or consent, he reverse engineered the software to create his own software application that he implemented at thefacebook.com, and which he referred to by the same name and publicized without Think Computer’s involvement. Mr. Zuckerberg did all of this while communicating with Mr. Greenspan on a regular basis.

10. On information and belief, the name of Think Computer’s software application was chosen because universities nationwide had been using the term “facebook” to refer to the directories (whether printed or online) of the members of an organization. On information and belief, the term “facebook” was also adopted by corporations to describe employee directories, as well. These circumstances formed the basis of a trademark dispute between Think Computer and Opposer beginning in 2008.

11. On information and belief, Think Computer and Opposer reached a settlement agreement in May, 2009 concerning Think Computer’s two Petitions to Cancel Opposer’s

FACEBOOK and THEFACEBOOK trademarks (Cancellation Nos. 92049206 and 92050675).

The TTAB never reached a decision on the merits of these two cancellation proceedings.

Despite reaching a settlement, Think Computer and Opposer are now involved in another trademark dispute in which Opposer has opposed Think Computer's application for registration of FACEMAIL.

12. Opposer is well-known as a "trademark bully." With billions of dollars in outside investment, Opposer appears to consider the court system, the United States Patent and Trademark Office and the TTAB within it to be nothing more than tools it can use to fend off potential competitive threats before they actually materialize.

13. Opposer has filed unjustified trademark litigation against Lamebook LLC, Teachbook.com LLC, Femillionaires LLC, Vision Promotions, Inc., and many others for the independent use of the common words "face" and "book," to which Opposer owns no legal rights whatsoever in the United States of America. Yet, on information and belief, Opposer has never used the word "book" in the context of a trademark apart from the word "face" nor has it used the word "face" in the context of a trademark apart from the word "book."

14. Opposer's attempts to enforce its alleged rights are arbitrary and inconsistent. Opposer has never contested to use of the FACEBOOK mark by Harvard University or any other educational institution, when such institutions use the mark to describe the same goods and services as those provided by Opposer.

15. Widespread uses of the words "face" and "book" in trademarks registered with the United States Patent and Trademark Office pre-date Opposer's existence by decades. There are even trademark registrations that use the word "book" which also cover online services for

dating and social networking. Examples of such registrations include MY YEARBOOK, HOOK BOOK, WEBOOK, and BOOKOFMATCHES.COM.

16. Opposer has no evidence of any actual confusion by consumers caused by Applicant's use of the SHAGBOOK mark.

OPPOSER'S HISTORY OF TRADEMARK FILINGS

17. On information and belief, on or about February 24, 2005, Opposer filed an application for registration of THEFACEBOOK covering, as later amended, the services of "providing an online directory information service featuring information regarding, and in the nature of, collegiate life, classifieds, virtual community and social networking" and "providing online chat rooms for registered users for transmission of messages concerning collegiate life, classifieds, virtual community and social networking." In that application, Opposer alleged a date of use "at least as early as 02/04/2004." A registration issued for THEFACEBOOK as Registration No. 3,041,791. Subsequently, on or about July 11, 2006, Opposer requested amendment of the registration from THEFACEBOOK to FACEBOOK, claiming the deletion of the article "THE" to be an "extremely minimal" alteration.

18. On information and belief, on or about February 24, 2005, the same day that the application for THEFACEBOOK was filed, Opposer filed an application for registration of FACEBOOK on an "intent to use" basis covering identical services as the THEFACEBOOK application of the same date. Subsequently, on or about April 28, 2006, Opposer filed a statement of use stating that the mark was in use in interstate commerce at least as early as November 16, 2004.

19. Up until at least August of 2005, Opposer used the mark THEFACEBOOK to identify the services provided at the "thefacebook.com" website and not FACEBOOK. On

information and belief, Mr. Zuckerberg chose “Thefacebook” as the name of “thefacebook.com” website to distinguish the site from other facebook that were already in existence at the time he started “thefacebook.com” website.

20. On information and belief, on or about August of 2005, Opposer purchased the domain “facebook.com” and changed the name of the website to “facebook” from “Thefacebook” sometime thereafter. Prior to August of 2005, Opposer had always used THEFACEBOOK as the name of the website.

21. Opposer has filed numerous other applications for registration of FACEBOOK, while alleging in many instances that services and/or goods were being provided under this mark at least as early as February of 2004. Yet, Opposer was using the mark THEFACEBOOK to identify all of its goods and services at that time.

22. On information and belief, Opposer has recognized the merits of arguments by third parties that the term “facebook” is a generic term when used in connection with printed and online directories. As a result, Opposer has taken the strategy of filing numerous other applications covering various services described in a way that Opposer can argue that the FACEBOOK mark is not generic as to these other services. Yet all of these services identified by Opposer are provided in connection with the same website that Opposer uses to provide its online directory of people. And all of these services are closely related to the primary service being provided by Opposer in the field of social networking. Thus, Opposer should be estopped from arguing that these other services are so different from the services of providing an online directory of people so as to render the term “facebook” non-generic.

Count 1
U.S. Trademark Registration No. 3,041,791

23. Applicant incorporates by reference paragraphs 1-22 above as if fully set forth herein.

24. Opposer 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.

25. On February 18, 2005, Sean Parker, identified as the “President” of THEFACEBOOK, Inc., signed his name to a declaration filed with the application for trademark Serial No. 78,574,726. The declaration reads, in pertinent part, “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.”

26. Applicant knew, on the date the declaration was signed, and before, that the term “facebook” was already in use by numerous organizations, and therefore knew, that it had falsely stated that “no other person, firm, corporation, or association” had the right to use the mark in commerce in a manner in which was 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.” At

the time the declaration was signed and on the date Applicant began providing services on “thefacebook.com” website, numerous organizations were already using the term “facebook” to refer to services similar or identical to those identified by Applicant in the trademark application.

27. On information and belief, Sean Parker and another officer of Opposer, had been communicating directly and repeatedly with Think Computer a few weeks prior to February 18, 2005 regarding the resemblance of Think Computer’s product and Opposer’s product, the possibility of confusion between the products, and Think Computer’s prior rights to various intellectual property claims in connection with the product named “The Facebook.”

28. The specimen submitted by Opposer to the United States Patent and Trademark Office on February 24, 2005 with its application to register the mark makes no mention of “classifieds” or “providing online chat rooms for registered users for transmission of messages.”

29. Opposer did not use the mark FACEBOOK or the mark THEFACEBOOK in connection with “classifieds” or “providing online chat rooms for registered users for transmission of messages” on or before February 4, 2004.

30. Opposer never provided any of the services listed in its application on or before February 4, 2004 in interstate commerce. On that date, Opposer only offered services to a limited number of people at Harvard University and not in interstate commerce.

31. Opposer did not use the mark FACEBOOK on February 4, 2004 or for a period of time thereafter. Instead, Opposer used the mark THEFACEBOOK. The original application filed on February 24, 2005, the specimen submitted therewith and the original certificate of registration demonstrates that Opposer used the mark THEFACEBOOK.

32. Opposer adopted the mark THEFACEBOOK rather than FACEBOOK to distinguish its services from similar goods and services offered by Harvard University and other

organizations using the term “facebook.” A number of organizations before February 4, 2004 routinely published directories that were referred to as a “facebook” to help people identify others at the organization. For example, 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.

33. Many such organizations that had published a “facebook” in print form for years were, by February 4, 2004, also publishing these “facebook” online or were in the process of doing so.

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

35. Opposer asserted in its request to amend the mark that:

“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.”

Opposer’s request to amend the mark also demonstrates Opposer 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 Opposer’s services from the goods and services offered by others using the term “facebook.”

36. In filing its request to amend the mark, Opposer withheld material information from the U.S. Patent Trademark Office.

37. Opposer 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 Opposer misrepresented when such use in commerce began in its application.

Opposer also withheld information material to its request to amend the mark from THEFACEBOOK to FACEBOOK. Opposer 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 United States Patent and Trademark Office. Such false statements were made with the intent to induce authorized agents of the United States Patent and Trademark Office to grant and then amend U.S. Trademark Registration No. 3,041,791.

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

39. Opposer is asserting in this opposition proceeding its fraudulently procured registration as a basis for denying Applicant the registration it seeks for the mark SHAGBOOK, all to the injury and damage of Applicant.

Count 2
U.S. Trademark Registration No. 3,122,052

40. Applicant incorporates by reference paragraphs 1-39 above as if fully set forth herein.

41. Opposer filed Application Serial No. 78/574,730 for the mark FACEBOOK on an intent to use basis on February 24, 2005. After amendment, the application was allowed with the following services identified: "providing an online directory information service featuring information regarding, and in the nature of, collegiate life, classifieds, virtual community and social networking" and "providing online chat rooms for registered users for transmission of messages concerning collegiate life, classifieds, virtual community and social networking."

42. On or about April 28, 2006, Opposer filed a statement of use alleging a date of first use at least as early as November 16, 2004 for the services identified above. Opposer did

not use the mark FACEBOOK in connection with any of its services until at least as late as August of 2005.

43. The specimen submitted by Opposer to the United States Patent and Trademark Office on April 28, 2006 makes no mention of “classifieds” or “providing online chat rooms for registered users for transmission of messages.”

44. Opposer did not use the mark FACEBOOK or the mark THEFACEBOOK in connection with “classifieds” or “providing online chat rooms for registered users for transmission of messages” on or before November 16, 2004.

45. Opposer adopted the mark THEFACEBOOK rather than FACEBOOK to distinguish its services from similar goods and services offered by Harvard University and other organizations using the term “facebook.”

46. On February 18, 2005, Sean Parker, identified as the “President” of THEFACEBOOK, Inc., signed his name to a declaration filed with the application for trademark Serial No. 78,574,730. The declaration reads, in pertinent part, “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.”

47. Applicant knew, on the date the declaration was signed, and before, that the term “facebook” was already in use by numerous organizations, and therefore knew, that falsely stated that “no other person, firm, corporation, or association” had the right to use the mark in commerce in a manner in which was 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.” At the time the declaration was signed and on the date Applicant began providing services on “thefacebook.com” website, numerous organizations were already using the term “facebook” to refer to services similar or identical to those identified by Applicant in the trademark application.

48. On information and belief, Sean Parker and another officer of Opposer, had been communicating directly and repeatedly with Think Computer a few weeks prior to February 18, 2005 regarding the resemblance of Think Computer’s product and Opposer’s product, the possibility of confusion between the products, and Think Computer’s prior rights to various intellectual property claims in connection with the product named “The Facebook.”

49. On May 16, 2005, Lisa Greenwald-Swire, acting as counsel on behalf of Opposer, signed a declaration similar or identical to the one signed by Sean Parker on February 18, 2005. This declaration contains identical or similar false statements as those in the Parker declaration.

50. On information and belief, at the time it filed the application Serial No. 78/574,730, Opposer was in a bidding war with ConnectU regarding the domain name “facebook.com.” Consequently, Opposer filed a petition to make special to give it some leverage in the dispute over the name.

51. Opposer has willfully and intentionally misrepresented the nature of its use in commerce of the mark FACEBOOK. Opposer has willfully and intentionally misrepresented the date of first use in its declaration of use. Opposer has willfully and intentionally misrepresented that it had no knowledge of other uses of the mark on the dates claimed when in fact it was aware of use of the mark by Think Computer and numerous other third parties and was in fact aware that the mark is generic when used in connection with the services identified in the application.. Opposer 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 United States Patent and Trademark Office. Such false statements were made with the intent to induce authorized agents of the United States Patent and Trademark Office to grant and then amend U.S. Trademark Registration No. 3,122,052.

52. In view of Opposer's conduct, Registration No. 3,122,052 should be cancelled. Opposer is asserting in this opposition proceeding its fraudulently procured registration as a basis for denying Applicant the registration it seeks for the mark SHAGBOOK, all to the injury and damage of Applicant.

Count 3
U.S. Trademark Registration No. 3,801,147 and
U.S. Trademark Registration No. 3,814,888

53. Applicant incorporates by reference Paragraphs 1-52 above as if fully set forth at length.

54. Opposer filed Application Serial No. 77/039,123 on November 7, 2006. In this application Opposer sought registration of the mark FACEBOOK 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.

55. On or about December 18, 2009, Opposer filed a Statement of Use in Connection with Application Serial No. 77/039,123. This statement of use contains false and misleading statements made with the intent that such statement may be relied upon by the United States Patent and Trademark Office. By way of example, Opposer'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 the interest at least as early as 02/00/2004, and first used in commerce at least as early as 02/22/2004, 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.

56. The Statement of Use filed by Facebook and signed by Richard Nessary,

Opposer'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 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.

57. Opposer did not provide “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.

58. An article published on February 9, 2004, in the Harvard Crimson Newspaper quotes Mark Zuckerberg, Opposer’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.

59. Opposer did not publish online works of others featuring user-created video until sometime well after February of 2004.

60. Opposer did not use the mark FACEBOOK on or in connection with any goods or services before the end of February 2004. No related company, licensee or predecessor in interest of Opposer used the mark FACEBOOK on or in connection with any goods or services before the end of February 2004. At that time, Opposer used the mark THEFACEBOOK.

61. At the time Opposer filed its Application Serial No. 77/039,123, and throughout the United States Patent and Trademark Office proceedings related to that application, Opposer never disclosed to the United States Patent and Trademark Office that others were using the term “facebook” for related goods and services, some of whom continue to do so to this day.

62. Opposer has willfully and intentionally misrepresented the nature of its use in commerce of the mark FACEBOOK. Opposer has willfully and intentionally misrepresented the date of first use in its declarations. Opposer has willfully and intentionally misrepresented that it had no knowledge of other uses of the mark on the dates claimed when in fact it was aware of

use of the mark by Think Computer and numerous other third parties and was in fact aware that the mark is generic when used in connection with the services identified in the application.

Opposer 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 United States Patent and Trademark Office.

63. Opposer 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 Registration No. 3,801,147. Opposer attempted to procure and did procure Registration 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 the 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. These false statements were made with the intent to induce authorized agents of the United States Patent and Trademark Office to grant Registration No. 3,801,147.

64. On or about April 16, 2010, the United States Patent and Trademark Office 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 Registration No. 3,801,147 and the parent application in the grant of Registration No. 3,814,888.

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

66. Opposer is asserting these fraudulently procured registrations as a basis for denying Applicant registration of Applicant's SHAGBOOK mark all to the injury and damage of Applicant.

Count 4
U.S. Trademark Registration No. 3,881,770

67. Applicant incorporates by reference Paragraphs 1-66 above as if fully set forth at length.

68. Opposer filed Application Serial No. 78/920,322 on June 29, 2006. In this application Opposer sought registration of the mark FACEBOOK for a variety of services under Section 1(b) of the Trademark Act, including:

- International Class 035: Providing an online directory information service featuring information regarding, and in the nature of, collegiate life, general interest, classifieds, virtual community, social networking, photo sharing, and transmission of photographic images; advertising and information distribution services, namely, providing classified advertising space via the global computer network; promoting the goods and services of others over the Internet; providing on-line computer databases and on-line searchable databases.
- International Class 038: Providing online chat rooms and electronic bulletin boards for registered users for transmission of messages concerning collegiate life, general interest, classifieds, virtual community, social networking, photo sharing, and transmission of photographic images.
- International Class 042: Computer services, namely, hosting online web facilities for others for organizing and conducting online meetings, gatherings, and interactive discussions; and computer services in the nature of customized web pages featuring user-defined information, personal profiles and information.
- International Class 045: Introduction and social networking services.

69. Throughout the course of the prosecution of Application Serial No. 78/920,322 various amendments were made to the description of the services.

70. On or about August 4, 2010, Opposer filed a Statement of Use in connection with Application Serial No. 78/920,322. This Statement of Use contains false and misleading statements made with the intent that such statement be relied upon by the United States Patent and Trademark Office. By way of example, Opposer's Statement of Use includes the following recitations:

“For International Class 035:

Current identification: Advertising and information distribution services, namely, providing classified advertising space via the global computer network; promoting the goods and services of others over the Internet; providing on-line computer databases and on-line searchable databases in the field of classifieds.

The 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 02/04/2004, and first used in commerce at least as early as 04/00/2004, and is now in use in such commerce. The applicant is submitting one specimen for the class showing the mark as used in commerce or in connection with any item in the class, consisting of a(n) page from Applicant's website featuring the mark and promoting its advertising and information distribution services.

For International Class 038:

Current identification: Providing online chat rooms and electronic bulletin boards for registered users for transmission of messages concerning collegiate life, general interest, classifieds, virtual community, social networking, photo sharing, and transmission of photographic images; provision of on-line forums for the transmission of photographic images; provision of on-line forums for communications on topics of general interest.

The 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 02/04/2004, and first used in commerce at least as early as 02/04/2004,

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) page from Applicant's website promoting its services.

For International Class 041:

Current identification: Providing on-line computer databases and on-line searchable databases in the field of collegiate life concerning college athletics, concerts, entertainment events, art, performing arts, music, dance and academics; providing on-line computer databases and on-line searchable databases featuring collegiate student groups concerning subjects in the fields of academics and entertainment.

The 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 02/04/2004, and first used in commerce at least as early as 02/04/2004, 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) page from Applicant's website promoting its services.

For International Class 042:

Current identification: computer services, namely, hosting online web facilities for others for organizing and conducting online meetings, gatherings, and interactive discussions; and computer services in the nature of customized web pages featuring user-defined information, personal profiles and information; computer services, namely, creating an on-line community for registered users to participate in discussion, get feedback from their peers, form virtual communities, and engage in social networking; peer-to browser photo sharing services namely, providing a website featuring technology enabling users to upload, view and download digital photos.

The 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 the 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 02/04/2004, and first used in commerce at least as early as 02/04/2004, 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) page from Applicant's website promoting its services.

For International Class 045:

Current identification: Internet based introduction and social networking services; providing on-line computer databases and on-line searchable databases in the field of social networking.

The 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 02/04/2004, and first used in commerce at least as early as 02/04/2004, 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) page from Applicant's website promoting its services."

71. The Statement of use filed by Opposer and signed by Michael Richter, Opposer's Deputy General Counsel, including 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; 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."

72. Opposer did not use the mark FACEBOOK on or in connection with any goods or services on or before February 4, 2004. At that time, Opposer used the mark THEFACEBOOK.

73. No related company, licensee or predecessor in interest of Opposer ever used the mark FACEBOOK on or in connection with any goods or services on or before February 4, 2004.

74. Opposer never used the mark FACEBOOK in commerce on or before February 4, 2004. No related company, licensee or predecessor in interest of Opposer ever used the mark FACEBOOK in commerce on or before February 4, 2004.

75. At the time Opposer filed its Application Serial No. 78/920,322, and throughout the USPTO proceedings related to that application, Opposer never disclosed to the United States Patent and Trademark Office in connection with that application that the mark Opposer was using on or before February 4, 2004 was THEFACEBOOK rather than FACEBOOK.

76. At the time Opposer filed its Application Serial no. 78/920,322, and throughout the USPTO proceedings related to that application, Opposer never disclosed to the United States Patent and Trademark Office that others were using the term “facebook” for related goods and services, some of whom continue to do so to this day.

77. Opposer has willfully and intentionally misrepresented the nature of its use in commerce of the mark FACEBOOK. Opposer has willfully and intentionally misrepresented the date of first use in its declaration of use. Opposer has willfully and intentionally misrepresented that it had no knowledge of other uses of the mark on the dates claimed when in fact it was aware of use of the mark by Think Computer and numerous other third parties and was in fact aware that the mark is generic when used in connection with the services identified in the application. Opposer 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 United States Patent and Trademark Office. Such false statements were

made with the intent to induce authorized agents of the United States Patent and Trademark Office to grant and then amend U.S. Trademark Registration No. 3,881,770.

78. Opposer 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 services covered by Registration No. 3,881,770. Opposer attempted to procure and did procure Registration No. 3,881,770 by knowingly and willingly making false and/or fraudulent declarations or representations to the United States Patent and Trademark Office, *inter alia*, falsely alleging in connection with its Application and in its Statement of Use, supported by a Declaration under 18 U.S.C. Section 1001, that its first use of the FACEBOOK mark was on February 4, 2004 for the claimed services, when no such use of the FACEBOOK mark was made until well after February 4, 2004. These false statements were made with the intent to induce authorized agents of the PTO to grant Registration No. 3,881,770.

79. Opposer is asserting these fraudulently procured registrations as a basis for denying Applicant registration of Applicant's SHAGBOOK mark all to the injury and damage of Applicant.

Count 5
U.S. Trademark Registration No. 3,734,637

80. Applicant incorporates by reference Paragraphs 1-79 above as if fully set forth at length.

81. Opposer filed Application Serial No. 77/189,479 on May 24, 2007. In this application Opposer sought registration of the mark FACEBOOK for a variety of services under Section 1(b) of the Trademark Act, including:

- International Class 009: Software to enable uploading, posting, showing, displaying, tagging, blogging, sharing or otherwise providing electronic

media or information over the Internet or other communications network.

- International Class 038: Audio and video broadcasting services over the Internet or other communications network, namely, uploading, posting, showing, displaying, tagging and electronically transmitting information, audio, and video clips; providing access to information, audio, and video via websites, online forums, chat rooms, listservs and blogs over the Internet; providing on-line chat rooms and electronic bulletin boards for transmission of messages among users in the field of general interest.
- International Class 042: Application service provider (ASP) featuring software to enable uploading, posting, showing, displaying, tagging, blogging, sharing or otherwise providing electronic media or information over the Internet or other communications network.

82. During the course of the prosecution of Application Serial No. 77/189,479 the description of services in class 38 were amended to the following: Audio and video broadcasting services over the Internet or other communications network, namely, uploading, posting, showing, displaying, tagging and electronically transmitting information, audio, and video clips; providing on-line chat rooms, listservers, and on-line forums for transmission of messages among computer users concerning user-defined content; providing on-line chat rooms and electronic bulletin boards for transmission of messages among users in the field of general interest.

83. On or about November 9, 2009, Opposer filed a Statement of Use in connection with Application Serial No. 77/189,479. This Statement of Use contains false and misleading statements made with the intent that such statement be relied upon by the United States Patent and Trademark Office. By way of example, Opposer's Statement of Use states that all of the services, with the exception of those in class 9, were being provided under the FACEBOOK mark at least as early as February of 2004.

84. The Statement of Use filed by Opposer and signed by Richard Nessary, Opposer's Lead Counsel, IP & Competition, stated that "he believes applicant to be the owner of the mark

sought to be registered; and all statements made on his knowledge are true and all statements made on information and belief are believed to be true.”

85. Opposer did not use the mark FACEBOOK on or in connection with any goods or services on or before February, 2004. At that time, Opposer used the mark THEFACEBOOK.

86. No related company, licensee or predecessor in interest of Opposer ever used the mark FACEBOOK on or in connection with any goods or services on or before February, 2004.

87. Opposer never used the mark FACEBOOK in commerce on or before February, 2004. No related company, licensee or predecessor in interest of Opposer ever used the mark FACEBOOK in commerce on or before February, 2004.

88. At the time Opposer filed its Application Serial No. 77/189,479, and throughout the USPTO proceedings related to that application, Opposer never disclosed to the United States Patent and Trademark Office in connection with that application that the mark Opposer was using on or before February 4, 2004 was THEFACEBOOK rather than FACEBOOK.

89. At the time Opposer filed its Application Serial No. 77/189,479, and throughout the USPTO proceedings related to that application, Opposer never disclosed to the United States Patent and Trademark Office that others were using the term “facebook” for related goods and services, some of whom continue to do so to this day.

90. On information and belief, Opposer has never used the FACEBOOK mark in commerce in connection with the sale of any goods in International Class 9. Rather, on information and belief, Opposer is using the goods on its own website and facebook.com to provide services and is not actually selling the software.

91. Opposer has willfully and intentionally misrepresented the nature of its use in commerce of the mark FACEBOOK. Opposer has willfully and intentionally misrepresented the

date of first use in its declaration of use. Opposer has willfully and intentionally misrepresented that it had no knowledge of other uses of the mark on the dates claimed when in fact it was aware of use of the mark by Think Computer and numerous other third parties and was in fact aware that the mark is generic when used in connection with the services identified in the application. Opposer has attempted to procure 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 United States Patent and Trademark Office. Such false statements were made with the intent to induce authorized agents of the United States Patent and Trademark Office to grant and then amend U.S. Trademark Registration No. 3,734,637.

92. Opposer 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 services covered by Registration No. 3,734,637. Opposer attempted to procure and did procure Registration No. 3,734,637 by knowingly and willingly making false and/or fraudulent declarations or representations to the United States Patent and Trademark Office, *inter alia*, falsely alleging in connection with its Application and in its Statement of Use, supported by a Declaration under 18 U.S.C. Section 1001, that its first use of the FACEBOOK mark was on February 4, 2004 for the claimed services, when no such use of the FACEBOOK mark was made until well after February, 2004. These false statements were made with the intent to induce authorized agents of the PTO to grant Registration No. 3,734,637.

93. Opposer is asserting these fraudulently procured registrations as a basis for denying Applicant registration of Applicant's SHAGBOOK mark all to the injury and damage of Applicant.

94. WHEREFORE, Applicant requests Opposer's Registration. Nos. 3,041,791; 3,122,052; 3,801,147; 3,814,888, 3,881,770, and 3,734,637 each be cancelled.

Date: July 25, 2011

Respectfully submitted,

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CERTIFICATE OF SERVICE

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