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Filing date: **06/02/2008**

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

Proceeding	92049206
Party	Plaintiff Think Computer Corporation
Correspondence Address	Aaron Greenspan Think Computer Corporation 884 College Avenue Palo Alto, CA 94306-1303 UNITED STATES legal@thinkcomputer.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Aaron Greenspan
Filer's e-mail	legal@thinkcomputer.com
Signature	/Aaron Greenspan/
Date	06/02/2008
Attachments	20080602.respondeddismisscount3b.pdf (3 pages)(408691 bytes) 20080602.amendedcancellation.pdf (6 pages)(426172 bytes)

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

THINK COMPUTER CORPORATION

Petitioner,

v.

FACEBOOK, INC.,

Respondent.

Cancellation No. 92049206

**RESPONSE TO
RESPONDENT'S MOTION TO
DISMISS COUNT III OF PETITION
FOR CANCELLATION**

Mark: FACEBOOK

Reg. No. 3,122,052

Reg. Date: July 25, 2006

**RESPONSE TO MOTION TO DISMISS COUNT III OF PETITION FOR
CANCELLATION**

Petitioner, Think Computer Corporation, states as follows in response to Respondent's Motion to Dismiss Count III of Petition for Cancellation:

1. Respondent's pending Motion sought to dismiss Count III of Petitioner's Petition to Cancel.
2. Petitioner respectfully notes that Respondent's Motion and its Answer were filed late, past the stated deadline of May 26, 2008 set by the Trademark Trial and Appeal Board. Respondent has not provided an explanation for its late filing.
3. While Petitioner does not concede the correctness of Respondent's motion, Petitioner is herewith filing an Amended Petition to Cancel in order to expedite resolution of this matter.
4. Petitioner respectfully submits that Respondent's pending Motion is now moot and should be dismissed as such.

Respectfully submitted,

THINK COMPUTER CORPORATION

Dated: June 2, 2008

By _____

Aaron Greenspan
President & CEO
884 College Avenue
Palo Alto, CA 94306-1303
Phone: (415) 670-9350
Fax: (810) 963-4026

CERTIFICATE OF MAILING AND SERVICE

I certify that on June 2, 2008, the foregoing **RESPONSE TO MOTION TO DISMISS COUNT III OF PETITION FOR CANCELLATION** is being electronically transmitted to:

Trademark Trial and Appeal Board
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

It is further certified that on June 2, 2008, the foregoing **RESPONSE TO MOTION TO DISMISS COUNT III OF PETITION FOR CANCELLATION** is being served by mailing a copy thereof by first-class mail addressed to:

Cooley Godward Kronish LLP
Five Palo Alto Square
4th Floor
3000 El Camino Real
Palo Alto, CA 94306-2155

By _____
Aaron Greenspan
President & CEO
Think Computer Corporation
884 College Avenue
Palo Alto, CA 94306-1303

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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THINK COMPUTER CORPORATION

Petitioner,

v.

FACEBOOK, INC.,

Respondent.

Cancellation No. 92049206

AMENDED PETITION TO CANCEL

Mark: FACEBOOK

Reg. No. 3,122,052

Reg. Date: July 25, 2006

AMENDED PETITION TO CANCEL

Think Computer Corporation (“Think”), having its place of business at 884 College Avenue, Palo Alto, CA 94306-1303, has been and believes it will continue to be damaged by the continued registration of the mark shown in United States Trademark Registration 3,122,052 and hereby seeks cancellation of this registration.

As grounds for the cancellation, Think alleges:

1. Facebook, Inc. (“Respondent”) is the listed owner of United States Trademark Registration No. 3,122,052 for FACEBOOK “providing an online directory information service featuring information regarding, and in the nature of, collegiate life, classifieds, virtual community and social networking,” in International Class 035 and “providing online chat rooms for registered users for transmission of messages concerning collegiate life, classifieds, virtual community and social networking” in International Class 038 with a filing date of February 24, 2005, an issuance date of July 25, 2006, and an alleged first use in commerce date of November 16, 2004 (“the ‘052 Registration”).

2. Since at least as early as September 19, 2003, Think has been using “FACEBOOK,” “FACE BOOK,” “UNIVERSAL FACE BOOK,” and “FACENET” by themselves and in conjunction with other terms and symbols, as trademarks (“Think’s Marks”).

3. Think has used Think’s Marks in association with on-line information services featuring information regarding, and in the nature of, collegiate life, classifieds, virtual communities and social networking (“Think’s Goods”).

4. Think began using Think's Marks on Think's Goods at least as early as September 19, 2003.

COUNT I

(Priority of Use and Likelihood of Confusion)

5. Think incorporates by reference paragraphs 1 through 4 as if fully stated here.

6. Since prior to the filing date in '052 Registration, Think has been using Think's Marks in connection with Think's Goods.

7. Since prior to the claimed priority date in the '052 Registration, Think has been using Think's Marks in connection with Think's Goods.

8. The goods listed in the '052 Registration are either identical or closely related to Think's Goods.

9. The subject mark of the '052 Registration so resembles Think's Marks as to be likely to cause confusion, or to cause mistake, or to deceive when used in connection with the goods listed in the '052 Registration.

10. The continuous registration of the subject of the '052 Registration is causing injury to Think's business plans, is impairing Think's rights in its Marks, is inconsistent with Think's rights, and will continue to cause injury to Think until the registration is cancelled.

COUNT II

(Genericness)

11. Think incorporates by reference paragraphs 1 through 4 as if fully stated here.

12. Notwithstanding the foregoing, the terms "FACEBOOK" and "FACE BOOK" have been used, dating back many decades, to describe books of any format, whether paper or electronic, in which faces of students, employees or other individuals are displayed in a structured manner.

13. The wide general acceptance of the terms "FACEBOOK" and "FACE BOOK" are indicative of their status as generic terms, and as such they do not qualify for the protection granted by a federal trademark.

COUNT III

(Fraud on the Patent and Trademark Office)

14. Think incorporates by reference paragraphs 1 through 4 as if fully stated here.

15. Think alleges on information and belief that Respondent knew it did not have rights in the subject mark of the '052 Registration when Respondent submitted its application to the United States Patent and Trademark Office.

On February 18, 2005, Sean Parker, identified as the "President" of THEFACEBOOK, Inc.,

signed his name to the declaration following the application for trademark Serial No. 78574730. Clause (b) of the declaration reads as follows: “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.” In fact, by that date, Sean Parker and another officer of Respondent, Mark Zuckerberg, had already communicated directly and repeatedly with Petitioner by telephone and in writing only a few weeks prior concerning the resemblance of Respondent’s product to Petitioner’s product, the possibility of confusion between the products, and Petitioner’s prior rights to various intellectual property claims in connection with the product named “The Facebook.” Therefore, Sean Parker’s statements are demonstrably false, and according to the same declaration, “punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001” while also serving to “jeopardize the validity of the application or any resulting registration.”

On what must be presumed to be April 29, 2005 (due to the hand-written strike-through notation in the document), Sean Parker identified himself in ¶ 1 of “Declaration of Sean Parker in Support of Consolidated Petition to Make Special Under T.M.E.P. 1710” (the “Declaration of Sean Parker”) as “the Founder of TheFacebook, Inc.” On information and belief, Sean Parker may have been a co-founder, and had also identified himself as “President” in other documents, but he was never “the Founder” of Respondent. Therefore, the statement contained in ¶ 1 of the Declaration of Sean Parker is false.

In the same document, Sean Parker went on to claim “a demonstrable possibility of the loss of substantial rights if THEFACEBOOK and FACEBOOK applications are not granted expedited review.” In fact, Respondent did not have any rights to either THEFACEBOOK or FACEBOOK as marks given the generic nature of both terms, of which Respondent was well aware at the time. Rather, Respondent was afraid of losing a bidding war for the domain name “facebook.com” and wished to conjure up claims to rights it never had. Therefore, the statement contained in ¶ 3 of the Declaration of Sean Parker is false.

All statements in the Declaration of Sean Parker were made under penalty of perjury.

On May 16, 2005, upon amending the trademark application, Lisa Greenwald-Swire, acting as counsel on behalf of Respondent, signed a declaration similar or identical to the one signed by Sean Parker. This declaration was similarly false for the reasons explained above.

16. Think alleges on information and belief that Respondent made false statements with the intent to induce authorized agents of the United States Patent and Trademark Office to grant the ‘052 Registration, and reasonably relying on the truth of said false statements, the USPTO did, in

fact, grant this registration to Respondent.

Respondent had a significant incentive to deceive the USPTO, namely, the security of its desired “facebook.com” domain name. This caused Respondent to petition the USPTO, successfully, for Special standing. In turn, the expedited review process may have caused the USPTO to fail to take into account the generic references to FACEBOOK and other pseudo-marks that have existed for many years.

Though it may not have been Respondent’s primary intention to file a trademark application solely for the purpose of deceiving the USPTO, it was nonetheless a factor. Respondent willfully weighed the costs and benefits of winning its domain name battle and deceiving the USPTO through the omission of key facts versus losing the battle and respecting trademark law, and ultimately decided that deception and fraud were an acceptable price to be paid for victory in another legal dispute.

17. The continuous registration of the subject mark of the ‘052 Registration is causing injury to Think’s business plans, is impairing Think’s rights in its Marks, is inconsistent with Think’s rights, and will continue to cause injury to Think until the registration is cancelled.

First, though Think maintains an interest in all of Think’s Marks and has consistently maintained such interests since 2003, Think can no longer pursue development of its product under the FACEBOOK name due to the existence of Respondent’s registered trademark. This has caused Think to forego a significant amount of revenue as well as industry recognition.

Second, the “Think Press” publishing division of Petitioner has been prohibited from advertising one of its products, a trade book entitled *Authoritas: One Student’s Harvard Admissions and the Founding of the Facebook Era* on at least one major search engine with the keyword “Facebook.” The prohibition stems explicitly from the existence of Respondent’s registered trademark on FACEBOOK. The book in question is merely a recitation of facts that does not infringe on any purported registered trademark. Nonetheless, an appeal for an exception to the search engine’s policy, which prohibits advertising based on select third-party trademarks, was denied.

The continued inability to advertise the book constitutes an infringement on Think’s First Amendment rights and the continued existence of the registration constitutes infringement on Think’s common law trademark rights. Most of all, the inability to advertise using the “Facebook” keyword will cause Think to forego a significant amount of revenue.

18. Respondent is not entitled to continued registration of the ‘052 Registration because Respondent willfully committed fraud in the procurement of that registration by making material false representations. Had Respondent taken into account Think’s prior use of the FACEBOOK mark and many other prior uses of the mark that in aggregate made it a generic term, neither registration for FACEBOOK nor THEFACEBOOK would have been granted by the USPTO.

19. Respondent has a history of willfully making false statements in public and may

intend to use these statements as evidence in these proceedings. On October 26, 2005 at Stanford University in Palo Alto, California, speaking on behalf of Respondent in a videotaped talk, Mark Zuckerberg was interviewed in a public forum. In response to a general question about the origins of the product entitled "The Facebook," he stated as follows: "So, um, I did two years at Harvard. During my sophomore year, I decided that Harvard needed a face book. It didn't have one. So I made it." This statement is demonstrably false.

On information and belief, long before (and during) Mark Zuckerberg's time at Harvard, the University did in fact have several face books, referred to by the terms "Register," "Face Book," and "Facebook," in both paper and electronic forms. Furthermore, the first electronic Face Book to cover the scope of the entire Harvard University campus was the property of Petitioner. Mark Zuckerberg was both familiar with and a member of this particular product, called both "The Universal Face Book" and "The Facebook." Therefore, his statement concerning his product's origin was false on several counts: Harvard University did have several face books already of which he was already aware and did not "need" a face book per se. Mark Zuckerberg's role in the formation and operation of Respondent has been instrumental, and his notable tendency to willfully act in a deceptive manner speaks to the reliability and veracity of Respondent's claims.

On information and belief, Sean Parker is no longer affiliated with Respondent in any official capacity and Sean Parker's affiliation with Respondent was terminated due to serious substance abuse issues. The circumstances of his departure also speak to the reliability and veracity of Respondent's claims during the time that Sean Parker acted on behalf of Respondent.

20. Respondent is accustomed to using fraud as a strategic business tactic. Respondent's statements and actions surrounding the origins of Respondent's product and its business operations have led to numerous other civil lawsuits being filed against Respondent.

WHEREFORE, Think hopes that this cancellation be sustained and that United States Trademark Registration No. 3,122,052 be cancelled.

Respectfully submitted,

THINK COMPUTER CORPORATION

Dated: June 2, 2008

By _____

Aaron Greenspan
President & CEO
884 College Avenue
Palo Alto, CA 94306-1303
Phone: (415) 670-9350
Fax: (810) 963-4026

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Five Palo Alto Square
4th Floor
3000 El Camino Real
Palo Alto, CA 94306-2155

By _____
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