

ESTTA Tracking number: **ESTTA547530**

Filing date: **07/09/2013**

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

Proceeding	91200221
Party	Defendant SNRG Ventures LLC
Correspondence Address	VINCENT J ALLEN CARSTENS CAHOON LLP 13760 NOEL ROAD, SUITE 900 DALLAS, TX 75240 UNITED STATES hilton@cclaw.com,tmdocketing@cclaw.com,allen@cclaw.com
Submission	Opposition/Response to Motion
Filer's Name	Zachary W. Hilton
Filer's e-mail	tmdocketing@cclaw.com, hilton@cclaw.com, allen@cclaw.com
Signature	/Zachary W. Hilton/
Date	07/09/2013
Attachments	SNRG's Resp to Mot to Dismiss (Filed 07.09.2013).pdf(659874 bytes) Ex. A - FB MSJ (TimeLines).pdf(792660 bytes) Ex. B -- FB Reply MSJ (Timelines).pdf(198489 bytes)

**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.,

Opposer,

v.

SNRG VENTURES LLC,

Applicant.

§
§
§
§
§
§
§
§
§
§

Opposition No. 91200221

**APPLICANT SNRG VENTURES LLC'S RESPONSE IN OPPOSITION
TO OPPOSER'S MOTION TO DISMISS COUNTERCLAIMS**

Applicant SNRG Ventures LLC ("SNRG") submits this Response in Opposition to Opposer Facebook, Inc.'s ("Opposer") Motion to Dismiss and respectfully requests that the Motion be denied in all respects. In support of its foregoing request, SNRG would show the Board as follows:

I. INTRODUCTION

SNRG has alleged numerous well-supported facts showing that "facebook" was and is a generic term for the types of services Opposer provides under such term, and that Opposer knew the term was generic when it filed the applications that matured into the subject registrations. Nevertheless, Opposer would have the Board disregard those facts and instead improperly adopt Opposer's own version of the facts in dismissing SNRG's counterclaims. However, adopting Opposer's version of the facts would ignore the Board's well-established precedent requiring that all disputed issues be construed

favorably to the complainant and that all reasonable inferences be drawn in favor of the complainant.

SNRG has pled facts demonstrating that the “facebook” term was and is generic, regardless of whether Opposer had intent to deceive the USPTO. In particular, SNRG points to past and current dictionary entries defining the “facebook” term generically, and to generic usage of the term by numerous third parties. For example, the company that previously provided facebook services on facebook.com before it sold the web domain to Opposer, used the “facebook” term generically to refer to its online facebook services. However, the most powerful evidence of the genericness of the “facebook” term is Opposer’s own generic usage of the term to refer to its facebook services in public statements, and in its originally submitted specimen of use for “THEFACEBOOK.” (compare “We recently opened up Thefacebook at the following schools” to “Your facebook is limited to your own college or university.”)

Opposer relies heavily on the fact that it has amassed a substantial number of users over the last decade in arguing that the “facebook” term is now famous and therefore supposedly cannot possibly be generic. However, one of the cardinal rules of trademark law, and one that Opposer itself urges courts to apply when it finds it in its interests to do so, is that a generic term can *never* function as a trademark. *See Timelines, Inc. v. Facebook, Inc.*, No. 11-cv-6867, 2013 U.S. Dist. LEXIS 46490, at *26 (N.D. Ill. April 1, 2013) (“a generic term cannot become a trademark under any circumstances.”) The foregoing rule should apply even more forcefully in cases such as this, when a party such as Opposer fraudulently procures trademark registrations from the USPTO for a term it knows to be generic. It would be unjust to permit a party to procure trademark

registrations for a generic term through fraud, use those registrations as a sword to prevent other legitimate use of the generic term by others, and then use its purported fame and whatever ill-gotten secondary meaning the term has attained to shield it against allegations of fraud and genericness.

With respect to fraud, the Board has clearly stated in its post-*Bose* decisions that if a party alleges that an applicant knowingly made material misrepresentations to the USPTO in order to procure a registration, the deceptive intent element of a fraud claim has been sufficiently pleaded. Opposer's own use of the "facebook" term generically in its specimen of use and in public statements demonstrates that Opposer knew the term was generic when it submitted sworn declarations to the USPTO claiming exclusive rights in the term.

SNRG has not made "merely conclusory" allegations regarding fraud and genericness as argued by Opposer. Rather, SNRG has pled well-supported factual allegations buttressed by excerpts from supporting documents that SNRG has incorporated into its pleading. While Opposer improperly tries to put its own spin on these facts and documents, all reasonable inferences must be drawn in favor of SNRG. Accordingly, SNRG respectfully requests that the Board find that its pleadings are more than sufficient to meet the "facial plausibility" standard applied at this early stage of the proceeding.

II. FACTUAL BACKGROUND

In order to provide the Board with a better understanding of the factual context of SNRG's Amended Counterclaims, SNRG provides the following summary of the history

of the generic usage of the “facebook” term, and Opposer’s activities in fraudulently obtaining trademark registrations for such term.

Prior to the late 1990’s, the terms “facebook” and “face book” were understood by members of the public to generically refer to books or directories in which pictures of individuals, together with information relating to those individuals, were displayed in an organized fashion. (Am. Counterclaims ¶ 1.) As the general public’s use of computers and in particular, the World Wide Web, increased dramatically in the mid to late 1990’s, it was only natural that the publicly recognized meaning of the “facebook” term would expand to encompass online web-based directories of individuals and other associated goods and services. At least as early as May 1998, Atlantic Media Corporation (“AMC”) was using the <www.facebook.com> web domain to advertise its online facebook services. (*Id.* ¶ 3.) In May 1998, AMC applied for a U.S. trademark registration for its ABOUTFACE mark and submitted a specimen (see partial image below) to the USPTO of one of its advertisements that heralded its online directory as “[t]he fastest and easiest way to produce an electronic facebook for your organization.” (*Id.* ¶¶ 3, 4.)

The specimen submitted by AMC in 1998 also includes a screenshot from its www.facebook.com web domain showing the online facebook profile of an individual (see image below). (*Id.*) The online facebook profile included the individual’s name, position, professional licenses, work location, education, and contact information. (*Id.*)

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.