

No. **10-2823**

0:30, 5:14

In the
United States Court of Appeals
for the **Seventh Circuit**

U.S.C.A. - 7th Circuit
RECEIVED

AUG - 3 2010 SMP

GINO J. AGNELLO
CLERK

PETITIONERS

IN RE ERICH SPECHT, AN INDIVIDUAL AND DOING
BUSINESS AS ANDROID DATA CORPORATION, AND
THE ANDROID'S DUNGEON INCORPORATED.

ERICH SPECHT, ET AL.,

v.

CASE NO. 09-CV-2572

GOOGLE, INC.

U.S.C.A. - 7th Circuit
FILED

AUG - 3 2010 SMP

GINO J. AGNELLO
CLERK

PETITION FOR WRIT OF MANDAMUS TO THE
UNITED STATES DISTRICT COURT FOR THE
NORTHERN DISTRICT OF ILLINOIS
THE HONORABLE **HARRY D. LEINENWEBER**, JUDGE PRESIDING.

PETITION FOR WRIT OF MANDAMUS

P. ANDREW FLEMING
Counsel of Record

JOHN F. SHONKWILER
RICHARD G. DOUGLASS
JOHN B. HAARLOW, JR.
NOVACK AND MACEY LLP
100 North Riverside Plaza
Chicago, Illinois 60606
(312) 419-6900

Attorneys for Petitioners

MARTIN MURPHY
2811 RFD
Long Grove, Illinois 60047
(312) 933-3200



COUNSEL PRESS · (866) 703-9373

PRINTED ON RECYCLED PAPER



TABLE OF CONTENTS

TABLE OF AUTHORITIES.....	ii
I. STATEMENT OF ISSUES AND RELIEF SOUGHT	1
II. FACTUAL BACKGROUND	2
III. JURISDICTION AND STANDARD OF REVIEW.....	7
IV. SUMMARY OF ARGUMENT.....	7
V. ARGUMENT	9
A. The Judge Should Not Have Ruled On The Motion To Amend.....	11
B. The Judge Has A Conflict Of Interest Even If AT&T Is Not A Party To The Proceedings	14
C. AT&T's Indemnity Agreement With Google Does Not Moot The Judge's Conflict of Interest	21
D. The Judge Is Also Disqualified Under Section 455(a)	23
VI. CONCLUSION	25

TABLE OF AUTHORITIES

<u>Cases</u>	<u>Page No.</u>
<i>Gordon v. Reliant Energy, Inc.</i> , 141 F.Supp.2d 1041, 1043 (S.D. Cal. 2001)	15, 17, 18, 20
<i>In re Aetna Casualty & Surety Co.</i> , 919 F.2d 1136, 1143 (6th Cir. 1990)	15, 16, 17, 18
<i>In re Kansas Pub. Employees Ret. Sys.</i> , 85 F.3d 1353, 1362 (8th Cir. 1996)	6, 13, 14, 18, 19, 20, 21
<i>In re United States</i> , 572 F.3d 301, 307 (7th Cir. 2009)	7, 11, 24, 25
<i>Liljeberg v. Health Serv. Acquisition Corp.</i> , 486 U.S. 847, 860 (1988)	11, 23
<i>SCA Servs., Inc. v. Morgan</i> , 557 F.2d 110, 117-18 (7th Cir. 1977)	7, 9, 10, 18, 19, 21, 22
<i>Tramonte v. Chrysler Corp.</i> , 136 F.3d 1025 (5th Cir. 1998)	15
 <u>Statutes</u>	
28 U.S.C. §455.....	<i>passim</i>
28 U.S.C. §1651.....	2, 7
 <u>Rules</u>	
Fed. R. App. Pro. 21	2
 <u>Other</u>	
H.R.Rep. No. 93-1453, 93d Cong. 2d Sess. 5 (1974)	9

I. STATEMENT OF ISSUES AND RELIEF SOUGHT

Judge Harry D. Leinenweber (the "Judge") has disclosed that his wife is a member of the Board of Directors of AT&T, Inc. She and the Judge own stock in AT&T, Inc. As a result, when Petitioners sought to add a subsidiary of AT&T, Inc. as a defendant in the case below -- AT&T Mobility LLC ("AT&T") -- the Judge announced that if AT&T were added as a defendant he would be required to recuse himself due to a conflict of interest, and that he would do so. Nevertheless, the Judge did not disqualify himself; instead, he denied Petitioners' request to add claims against AT&T.

The first issue tendered in this Petition is whether, given the foregoing, the Judge should have disqualified himself from deciding the question of *whether* Petitioners should be allowed to amend their complaint to add AT&T as a defendant? Petitioners submit that the answer to this first question is "yes."

The second issue to be decided is whether -- even if petitioners are not allowed to add AT&T as a defendant -- the Judge should nevertheless be disqualified from presiding over the case because: (a) any decisions in the case below that the Judge makes that are adverse to Petitioners will also benefit AT&T because those rulings will be collateral estoppel, or at least highly persuasive, in any other proceeding by Petitioners against AT&T; and (b) even in the absence of a separate proceeding, if Petitioners prevailed against Defendant Google, Inc.

("Google") in obtaining injunctive relief in the case below, AT&T would be harmed.

Petitioners submit that the answer to this second question is also "yes."

Based on the foregoing, and pursuant to the All Writs Act, 28 U.S.C. § 1651, and Rule 21 of the Federal Rules of Appellate Procedure, Petitioners respectfully request that this Court issue a Writ of Mandamus to the Judge disqualifying him from continuing to preside over the case below -- *i.e.*, *Erich Specht, et al. v. Google, Inc.*, Case No. 09-cv-2572, pending in the United States District Court for the Northern District of Illinois (the "Proceedings"). Petitioners further request that this Court vacate all Orders entered by the Judge in the Proceedings on and after July 23, 2010, the date on which Petitioners filed their Motion for Disqualification Pursuant to 28 U.S.C. §455 and Memorandum in Support thereof (collectively, the "Disqualification Motion"), a copy of which is attached hereto as Exhibit A.

II. FACTUAL BACKGROUND

Petitioners registered the trademark "Android Data" in 2002.¹ Several years later, Google created a new operating system (or "OS") for mobile phones and other devices. (Compl. at ¶46.) Google decided to name the new software "Android," and submitted an application to the U.S. Patent and Trademark Office (the "PTO") seeking to register the mark "Android." (*Id.* at ¶43 & Ex. C.) The PTO denied the registration because it found that there was a likelihood of confusion between

¹ See Petitioners' Third Amended Complaint ("Compl. at __") at ¶ 27 & Ex. B thereto. A copy of Petitioners' Third Amended Complaint is attached hereto as Exhibit B.

Google's proposed "Android" mark, and the "Android Data" mark previously registered by Petitioners. (*Id.* at ¶¶ 49 & 51; Exs. D & E.)

Despite the PTO's ruling, in 2008 Google launched its new Android OS product. (*Id.* at ¶53.) Since then -- and without Petitioner's permission -- Google has continued to use the name "Android" in connection with its marketing and distribution of the Android OS. (*Id.* at ¶¶47, 54-65, 90-92.) Likewise, at Google's urging, other companies started using the "Android" name in connection with the marketing and sale of mobile phones and devices that use the Android OS. (*Id.*)

On April 28, 2009, Petitioners sued Google (and others) for their allegedly wrongful use of the "Android" name. (Motion to Amend at ¶1.) In April 2010, AT&T began marketing and selling mobile phones and other electronic devices using the "Android" mark. (*Id.* at ¶5.) The status of AT&T's relationship with Google concerning the Android OS and the general nature of AT&T's revenues that derived from its use of the "Android" name came to light during a deposition held on July 9, 2010. (*Id.* at ¶¶5 & 7.) A few days later, on July 13, 2010, Petitioners filed their Third Amended Complaint. Petitioners believed that they were authorized by an earlier Court Order (attached as Ex. C hereto) to file the Third Amended Complaint without seeking additional leave. That Order, entered February 23, 2010, provided: "parties to file amended pleadings by July 15, 2010." (*Id.*) However, on July 15, 2010 -- the deadline for amendments to pleadings -- Petitioners also filed a Motion

for Leave to File Third Amended Complaint (the "Motion to Amend") (attached hereto, without exhibits, as Ex. D).

In the Third Amended Complaint, Petitioners assert virtually identical claims against Google and AT&T for trademark infringement and unfair competition under the Lanham Act (Sections 3231 & 4334, respectively), violation of the Illinois Deceptive Trade Practices Act (815 ILCS 510/2) and common law trademark infringement. (Compare Compl., Counts I, II, III & IV (against Google) with Counts VI, VII, VIII & IX (against AT&T and others).) The claims are based on Google and AT&T's use of the mark "Android" in connection with the sale and distribution of two new mobile devices that run on the Android OS.

On July 20, 2010, the Judge held a hearing on several motions, including the Motion to Amend. A copy of the Transcript of Proceedings dated July 20, 2010 (cited herein as "Tr. at ___") is attached to the Disqualification Motion as Exhibit A thereto. At the hearing, the Judge stated:

Actually, first, what I should say, and it is not the basis for my ruling, but in full disclosure, if I did allow the amendment, and AT&T came into the case, I would have to recuse myself. My wife is a board member of the parent company, AT&T, and we have an ownership interest. Obviously, we have many shares of AT&T.

* * *

Obviously if I let them in, I would have to get out immediately.

(Tr. at 4.) Petitioners' counsel then raised the question of whether the Judge should rule on the Motion to Amend in light of his interest in AT&T. (Tr. at 5.) The Judge acknowledged that "I really didn't think about it," but permitted the parties to submit in writing any grounds for disqualification by July 23, 2010. (Tr. at 5-6.)

On July 23, 2010, Petitioners filed the Disqualification Motion. In it, Petitioners argued three grounds for disqualification: (1) that the Judge could not decide the Motion to Amend pursuant to 28 U.S.C. §§455(b)(4) and (b)(5)(iii) because AT&T was directly interested in it; (2) that 28 U.S.C. §§455(b)(4) and (b)(5)(iii) further required the Judge's disqualification from the case as a whole because, even if AT&T were not made a party, AT&T would still benefit from the Judge's rulings through collateral estoppel or otherwise; and (3) in all events, the facts gave rise to an appearance of partiality, which required the Judge's disqualification pursuant to 28 U.S.C. §455(a). Google filed a response (as redacted, attached as Ex. E hereto), and Petitioners filed a reply (attached as Ex. F hereto). The Judge held a hearing on July 27, 2010. A copy of the Transcript of Proceedings dated July 27, 2010 (cited herein as "7/27/10 Tr. at ___") is attached hereto as Exhibit G.

At the hearing, Google's counsel said that Google had agreed to indemnify AT&T in this case in order to moot the Judge's conflict of interest. (7/27/10 Tr. at 3.) Google did not, however, provide copies of any indemnity agreement or describe its terms. (*Id.* at 3-4.) Upon hearing this, the Judge advised the parties that, although he was already prepared to deny the Disqualification Motion, he would

rewrite his decision to address the indemnity issue. Later that day, the Judge issued an Order (attached as Ex. H hereto (the "Order")) denying the Disqualification Motion as moot.

In the Order, the Judge first reiterated his and his wife's conflicts of interest, but held that Google's counsel's statement that Google would indemnify AT&T "removes any financial liability for AT&T in this case" and, therefore, "resolves any conflict of interest" and moots the Disqualification Motion. The Judge further wrote that, even if the Disqualification Motion were not moot, he would have denied it anyway because "there is no authority for the proposition that a judge's interest in a nonparty company in a separate case can create a conflict of interest mandating recusal." (*Id.*; citing *In re Kansas Pub. Employees Ret. Sys.*, 85 F.3d 1353, 1362 (8th Cir. 1996).) The Judge did not address Petitioners' arguments that, under 28 U.S.C. §§455(b)(4) and (b)(5)(iii), the Court could not decide the Motion to Amend, or that the Judge should be disqualified generally under 28 U.S.C. §455(a). Additionally, the Judge denied the Motion to Amend and struck the Third Amended Complaint filed on July 13, 2010.

Petitioners now ask this Court to disqualify the Judge, and vacate all orders entered by the Judge on or after the Disqualification Motion was filed on July 23, 2010.

III. JURISDICTION AND STANDARD OF REVIEW

“The All Writs Act, 28 U.S.C. §1651, permits courts created by an Act of Congress to ‘issue all writs necessary or appropriate in aid of their respective jurisdictions and agreeable to the usages and principles of law.’” *In re United States*, 572 F.3d 301, 307 (7th Cir. 2009) (quoting 28 U.S.C. §1651). A petition for writ of mandamus under the All Writs Act “is the proper -- indeed the only -- means of reviewing a district court’s denial of a motion for recusal.” *Id.* (citations omitted); *see also SCA Servs., Inc. v. Morgan*, 557 F.2d 110, 117-18 (7th Cir. 1977) (granting writ of mandamus to disqualify judge pursuant to 28 U.S.C. §455(a) and (b)(5)(iii)). “In considering a petition for a writ of mandamus seeking the disqualification of a district judge, [the Seventh Circuit] review[s] that judge’s denial of a recusal motion de novo.” *In re United States*, 572 F.3d at 307.

IV. SUMMARY OF ARGUMENT

The Judge should have disqualified himself for any *one* of at least *three*, independent reasons. *First*, the admitted conflict of interest under Section 455(b), which prevented the Judge from presiding over Petitioners’ claims against AT&T, also precluded him from deciding the Motion to Amend that determined whether Petitioners could bring those claims against AT&T in the case below.

Second, AT&T will be directly affected by the outcome of the Proceedings. In fact, any decision adverse to Petitioners made by the Judge on the merits of Petitioners’ claims or Google’s defenses in the Proceedings will be preclusive or, at

least, highly persuasive in any action by Petitioners against AT&T. The Judge is therefore disqualified from the Proceedings entirely under Section 455(b)

Google's purported indemnification of AT&T does not absolve the Judge of his and his wife's conflicts of interest under Section 455(b). The indemnity does nothing to remove the Judge and his wife's interest in seeing AT&T defeat any claims against it. Further, it does not eliminate the Judge and his wife's financial interest. Indeed, 28 U.S.C. §455(f) provides the means by which a Judge can continue in an action despite a financial conflict of interest -- divestment of the interest -- not inter-party indemnity.

Third, and in all events, the Judge should be disqualified under Section 455(a) because he has the appearance of partiality. The Judge has substantial personal and family interests in AT&T, and AT&T will benefit -- indeed, has already benefited -- from rulings made against Petitioners by the Judge. Moreover, Google's announcement of its indemnity agreement with AT&T was made specifically so that the Judge could continue in this case despite Petitioners' Disqualification Motion. This demonstrates that Google and AT&T are apparently working together in connection with the Proceedings, specifically for the purpose of keeping the Judge on the case. Further, the Judge determined that the purported indemnity cured all potential conflicts of interest, despite that he had never even seen it nor heard its terms. These facts could lead a reasonable person to doubt the Judge's impartiality. Thus, disqualification is required under Section 455(a).

V. ARGUMENT

Petitioners moved for disqualification pursuant to 28 U.S.C. §455. This section was completely re-written in 1974 to require “mandatory disqualification of a judge in certain specific circumstances, such as where family or financial interests are involved” -- *i.e.* Section 455(b) -- and to provide a “general, all-inclusive” disqualification standard --*i.e.* Section 455(a). *Morgan*, 557 F.2d at 113. These bright-line rules in Section 455(b) provide certainty for cases where bias may be imputed to a judge, while the general standard in Section 455(a) provides a flexible approach to avoid even the appearance of partiality. In revising Section 455, “Congress also intended to overrule the concept that close cases involving disqualification should be resolved on the ground that a judge had a ‘duty to sit.’” *Id.* (citing H.R.Rep. No. 93-1453, 93d Cong. 2d Sess. 5 (1974)).

Although a federal judge may disqualify him or herself under Section 455 without waiting for a motion by a party, parties are also allowed to move for disqualification under that Section. *E.g., Morgan*, 557 F.2d at 117. Further, because Section 455 is directed to protecting the integrity of the judiciary itself, it does not contain “any time limits within which disqualification must be sought” by a party, even if raised by motion. *Id.* (noting that Congress considered a time limit, but rejected it).

Section 455(b) lists several specific circumstances where recusal is *required*, including the following that are pertinent to this matter:

(b) [A federal judge] shall also disqualify himself in the following circumstances:

* * *

(4) He knows that he, individually or as a fiduciary, or his spouse or minor child residing in his household, has a financial interest in the subject matter in controversy or in a party to the proceeding, or any other interest that could be substantially affected by the outcome of the proceeding;

(5) He or his spouse, or a person within the third degree of relationship to either of them, or the spouse of such a person:

* * *

(iii) Is known by the judge to have an interest that could be substantially affected by the outcome of the proceeding;

28 U.S.C. §455(b). For purposes of these sections, the term “financial interest” means “ownership of a legal or equitable interest, however small, or a relationship as director, adviser, or other active participant in the affairs of a party.” 28 U.S.C. §455(d)(4) (emphasis added). Moreover, these Sections are not limited to financial interests. *Morgan*, 557 F.2d at 115. Rather, Congress recognized that “non-economic interests may affect a judge’s bias or prejudice.” *Id.* at 115-16 (emphasis added). For instance, where a judge’s brother is a member of a law firm handling a case, the judge may have a non-financial interest in the “reputation and goodwill” of his brother’s law firm, which can serve as a potential disqualifying interest. *Id.*

In addition to the specific recusal circumstances contained in Section 455(b), the statute also contains a catch-all test for disqualification in Section 455(a). That Section requires a federal judge to disqualify him or herself "in *any* proceeding in which his impartiality might reasonably be questioned." 28 U.S.C. §455(a) (emphasis added). "The goal of section 455(a) is to avoid even the appearance of partiality." *Liljeberg v. Health Serv. Acquisition Corp.*, 486 U.S. 847, 860 (1988). Thus, even if recusal is not mandated under any part of Section 455(b), disqualification is nevertheless required when a "reasonable person perceives a significant risk that the judge will resolve the case on a basis other than the merits." *In re United States*, 572 F.3d at 308 (citations omitted).

As will now be shown, disqualification is required here under either or both of Sections 455(a) and (b).

A. The Judge Should Not Have Ruled On The Motion To Amend

The Judge recognized that he and his wife both have substantial interests in AT&T -- because they both own shares of AT&T's parent company and because the Judge's wife is on its Board of Directors. (Tr. at 4.) Based on these interests, "[i]t is undisputed that the [Petitioners'] cause of action against AT&T cannot proceed under this judge." (Order, citing 28 U.S.C. §455(b).)

If the Judge knows that he cannot preside over claims against AT&T, then he surely cannot decide whether Petitioners should be allowed to bring them in the first place. Indeed, when the Judge denied the Motion to Amend, AT&T benefited.

Most obviously, there is no doubt that AT&T, like any potential defendant, did not want to be named in a lawsuit, and when the Judge ruled on the Motion to Amend, he prevented that from happening. As a result, if the Judge's ruling on the Motion to Amend is not vacated, Petitioners only alternative will be to pursue two separate, but parallel actions before two different judges, which will make the prosecution of Petitioners' claims against AT&T more difficult, time-consuming and expensive for Petitioners -- still another benefit for AT&T. These facts alone, coupled with the Judge's interests in AT&T, required the Judge to disqualify himself from deciding the Motion to Amend. But there is more.

Another huge benefit AT&T gets from the Judge's denial of the Motion to Amend is that AT&T will get to take advantage of any rulings *against* Petitioners in the Proceedings. As noted, Petitioners are asserting the same claims against AT&T as they are against Google, all of which arise out of Google and AT&T's use of the "Android" name. If the sale and distribution of "Android" mobile devices infringes Petitioners' marks, then both Google (which supplies the Android OS) and AT&T (which sells "Android" devices and supplies customers with wireless service) should be held liable for infringement. Likewise, the claims are potentially subject to the same alleged legal defenses, particularly the defense of abandonment, which Google has announced it will be presenting to the Judge very soon on a motion for summary judgment. Because the abandonment defense turns on *Petitioners'* use and intent to use its trademarks, the legal and factual issues raised thereby will be

exactly the same whether the abandonment defense is raised by Google or AT&T. Accordingly, if the Judge were to grant summary judgment in favor of Google on its abandonment defense, that ruling could also be used by AT&T to defeat Petitioners' claims against it.

Due to the relatedness of Petitioners' claims against and alleged defenses by Google and AT&T, it is extremely likely that any ruling against Petitioners that the Judge enters in the Proceedings below could be asserted by AT&T as a collateral estoppel against Petitioners in any related proceeding against AT&T. At the very least, such rulings would be persuasive precedent. After all, the two parallel proceedings would be pending in front of two judges sitting in the same Court -- the Northern District of Illinois. Conversely, AT&T will also argue that it is not bound by any rulings in Petitioners' favor because it is not a party to the Proceedings. In other words, as a result of the Judge's denial of the Motion to Amend, AT&T gets the best of both worlds -- if the Judge finds in favor of Google, AT&T gets the benefit of that ruling. But, if the Judge finds in favor of Petitioners, AT&T can relitigate the issue. In sum, AT&T gets the benefits, but none of the risks, of the Judge's rulings.

Given the Judge's admitted conflict of interest arising from his and his wife's interests in AT&T, and that AT&T stood to (and did) directly benefit from the Judge's ruling on the Motion to Amend, it was error for the Judge not to disqualify himself from ruling on that motion. The only case cited in the Order -- *In re Kansas*

Pub. Employees Ret. Sys. (KPERS), 85 F.3d 1353 (8th Cir. 1996) -- favors disqualification on this point. In the next section of this Petition (Section B), we will show why *KPERS* is not relevant to the issue of disqualification from the Proceedings *as a whole*. But, the recitation of the district court proceedings in *KPERS* is on point as to whether the Judge here should have recused himself from deciding the Motion to Amend. Specifically, the district court judge in *KPERS* owned stock in a company that was seeking to intervene in the case. *Id.* at 1355. Based on this interest, the judge recused himself from deciding whether that party should become part of the lawsuit before him. *Id.* The Judge here should have done the same.

**B. The Judge Has A Conflict Of Interest
Even If AT&T Is Not A Party To The Proceedings**

Section 455(b) provides that a judge can have a disqualifying interest other than an interest in a party to the suit *sub judice*. For instance, Section 455(b)(4) identifies three separate types of disqualifying interests: (1) a "financial interest in the subject matter in controversy"; (2) a financial interest "in a party to the proceeding," or -- particularly relevant to the instant argument -- (3) "any other interest that could be substantially affected by the outcome of the proceeding". Similarly, Section 455(b)(5)(iii) defines the disqualifying interest without any reference to parties or actions; it includes any "interest that could be substantially affected by the outcome of the proceeding." 28 U.S.C. § 455(b)(5)(iii). Thus,

pursuant to the express language of the statute, a financial interest in a party is only one of the three types of disqualifying interests defined in Sections 455(b)(4) & (b)(5)(iii). Consistent therewith, cases interpreting Section 455 have required disqualification based on an interest in an entity that was *not a party* to the proceeding in front of the judge. See, e.g., *In re Aetna Cas. & Sur. Co.*, 919 F.2d 1136, 1143 (6th Cir. 1990) (interest in related litigation where rulings in the case *sub judice* could have preclusive effect required disqualification); *Gordon v. Reliant Energy, Inc.*, 141 F.Supp.2d 1041, 1043 (S.D. Cal. 2001) (same; and an interest in putative member of uncertified class required disqualification) (citing *Tramonte v. Chrysler Corp.*, 136 F.3d 1025 (5th Cir. 1998)). In sum, the issue of Section 455(b) disqualification does not turn solely on whether the Judge has an interest in a current party to the Proceedings. Instead, the Judge should have disqualified himself because he and his wife had a financial interest in the subject matter of the controversy, and/or another interest that could be substantially affected by the outcome of this proceeding.

Clearly, AT&T wants to use the "Android" name provided by Google. If Petitioners' demand for injunctive relief is granted, and Google is enjoined from using that name, AT&T will also be affected. Moreover, the outcome of Petitioner's claims against AT&T (even if in another case) will be directly affected by the Judge's rulings in the Proceedings against Google -- regardless of whether AT&T is a party. As noted above, Petitioners claims against AT&T turn on the same facts

and legal principles as its claims against Google. Thus, even if the AT&T claims are pursued in a separate case, those claims rise and fall together, under the doctrine of collateral estoppel or otherwise.²

A close parallel in the case law is *Aetna*, 919 F.2d at 1136. There, seven actions were filed by the Federal Deposit Insurance Corporation ("FDIC") against Aetna to recover money under a "Bankers Blanket Bond, Standard Form No. 24," which Aetna issued for each of the failed banks. *Id.* at 1138. The subject judge's daughter worked at a law firm involved in four of the seven suits. *Id.* at 1137-38. When the seven suits were consolidated for trial, the judge recused himself. *Id.* But, when the suits were later severed, the judge took over the three in which his daughter's firm had not appeared. *Id.* When this was challenged, the Sixth Circuit issued a writ of mandamus, compelling the judge to again recuse himself from those three cases. *Id.* at 1146.

The Sixth Circuit held that the judge should be disqualified from all seven cases, even though his disqualifying interest related directly only to the four that he was not hearing. *Id.* at 1143-44. The court reasoned as follows:

A decision on the merits of any important issue in any of the seven cases . . . could or might constitute the law of the case in all of them, or involve collateral estoppel, or might be highly persuasive as a precedent. Thus, even if [his daughter's] firm were not counsel of record for FDIC

² Petitioners have not yet filed a separate action because they still believe that the Motion to Amend should be granted by any successor to the Judge.

in all of the seven cases but only some of them, and was not of counsel in the three cases reassigned by Judge Hull to himself, we would find that the circumstances would indicate to a reasonable party, such as Aetna, that his partiality might be implicated, and/or that §455 would apply.

Id. at 1143. Thus, the court concluded, the involvement of the judge's daughter in a related case "involves appearance of partiality [under Section 455(a)] and also conflict of interest principles under §455(b)(4) and (b)(5)(ii)," even though she was not associated with the cases that were actually before the judge. *Id.* at 1144.

The *Gordon* case reached a similar result. There, two class actions were brought against generators and traders of wholesale electricity on behalf of a putative class of electricity consumers. 141 F.Supp.2d at 1042. The judge recognized that he was a member of the putative class. *Id.* And, even though the class had not yet been certified, the judge recused himself. *Id.* at 1043. Later, another case was brought against similar parties based on similar claims (the "Sweetwater" case). *Id.* at 1045. The judge again recused himself, even though he had no interest in any party to the Sweetwater case. The judge reasoned:

The Sweetwater defendants are identical to the majority of the Hendricks and Gordon defendants. Moreover, the Sweetwater causes of action are brought under the same provisions of California law as are the claims in Hendricks and Gordon.

* * *

Thus, any decision on the merits made by the Court could result in collateral estoppel in the related cases in which

the undersigned judge, a member of his family, or a member of his staff has a personal interest.

Id. at 1045-46. In other words, the judge recognized that his interest in a related case could be substantially affected by the outcome of the case before him. So, he recused himself.

The situation here is closely analogous. The Judge admitted that he has a financial interest in any case against AT&T. Because the Judge's wife is a member of the Board of Directors of AT&T, Inc., the Judge also has non-economic interests in any case against AT&T -- including the reputation and good will concerns recognized in *Morgan*. 557 F.2d at 115-16. And here, as in *Aetna* and *Gordon*, the claims being decided by the Judge are virtually identical to those that are being asserted against AT&T. Thus, any decision on the merits of Petitioners claims or Google's defenses that the Judge makes in the Proceedings will have preclusive or persuasive effect in any parallel case against AT&T. Accordingly, the Judge should have disqualified himself due to his personal and spousal conflicts of interest.

As noted above, the only case cited in the Order is *KPERS*. Citing *KPERS*, the Judge ruled that "there is no authority for the proposition that a judge's interest in a nonparty company in a separate case can create a conflict of interest mandating recusal." (Order, p. 1.) However, as just discussed, there is such authority. Indeed, although this authority was specifically raised in the Disqualification Motion, it is not addressed in the Order denying the Disqualification Motion.

Moreover, the *KPERS* case does not support the quoted proposition. The judge in *KPERS* was faced with three motions for intervention, one of which was filed by a bank ("Boatman's"). *KPERS*, 85 F.3d at 1355. When the motions for intervention were filed, the judge disclosed that he owned stock in Boatmen's parent company, and asked the parties to anonymously submit any objections to his presiding over the case. *Id.* *KPERS* did not raise any objection to the judge continuing in the case at that time. *Id.* at 1355-56. Nevertheless, as noted, the judge disqualified himself from ruling on Boatmen's motion for intervention because of his interest in the parent company. But, when Boatmen's motion to intervene was denied, the judge resumed his involvement in the case.

Approximately a year later, *KPERS* moved to disqualify the judge because, *inter alia*, Boatman's was the plaintiff in a separate action against *KPERS*. *Id.* at 1357. The Eighth Circuit held that the motion to disqualify was untimely. *Id.* at 1359. This is because the Eighth Circuit -- unlike the Seventh Circuit -- imposes a non-statutory timeliness requirement on motions brought under Section 455. *Id.* at 1360 ("even though §455 has no express timeliness requirements, claims under §455 will not be considered unless timely made") (citations omitted). Conversely, the Seventh Circuit has explicitly rejected any timeliness requirement for motions under Section 455. *E.g., Morgan*, 557 F.2d at 117. As a result, the *KPERS* decision is based on a requirement that does not exist in the Seventh Circuit.

Notwithstanding its ruling that the request was untimely, the *KPERS* court discussed whether the judge should have been disqualified because of the potential collateral estoppel effect of rulings in the main case on the separate, Boatmen's action. *KPERS*, 85 F.3d at 1361. Although the court held that the judge did not need to be disqualified on this basis -- that was *not* because the legal proposition was unsound. Indeed, *KPERS* did not universally reject the potential for disqualification based on a related case; it just found that the issues raised in the allegedly related cases were *not sufficiently similar for collateral estoppel to be applied*. *Id.* The court noted that the claim in the Boatmen's case arose out of "separate and distinct contractual obligations" which were "not presented in the case pending before [the judge]." *Id.* Based on the lack of overlapping issues, the court concluded "we do not view this case as one involving potential collateral estoppel." *Id.*; *see also Gordon*, 141 F.Supp.2d at 1046 (recognizing that, in *KPERS* "the Eighth Circuit declined to consider whether a judge's ruling in one case would have a collateral effect on issues in a separate case because there were *no common issues* remaining in the two cases") (emphasis added).

Here, as described above, the issues raised by Petitioners' claims against Google and Petitioners' claims against AT&T are identical in virtually every respect. They are the same claims, they turn on the same facts, and they are subject to the same defenses. Thus, while there was no commonality between the

actions at issue in *KPERS*, here, the claims and defenses will be exactly the same.

As such, *KPERS*' dicta regarding collateral estoppel is inapplicable.

**C. AT&T's Indemnity Agreement With Google
 Does Not Moot The Judge's Conflict Of Interest**

The Judge held that Google's statement "that it will indemnify AT&T in regard to this case . . . removes any financial liability for AT&T in this case."

(Order, p. 1.) The Judge reached this conclusion despite the fact that Google did not provide any evidence of the terms of such an agreement to the court. (See 7/27/10 Tr. at 3-4.) Rather, the Judge decided that the statement of counsel that some form of indemnity would be provided "resolves any conflict of interest." (Order, p. 1.)

This conclusion is erroneous for several reasons.

First, the Judge and his wife have non-economic interests in AT&T that are not affected by the purported indemnity. Obviously, the Judge wants his wife's company to win any lawsuit filed against it -- particularly a high-stakes case like this one. Section 455(b) reflects Congress' understanding that such "*non-economic interests* may affect a judge's bias or prejudice." *Morgan*, 557 F.2d at 115-16 (emphasis added). For instance, this Court recognized that when a judge's brother is a member of a law firm handling a case, the judge may have a non-financial interest in the "reputation and goodwill" of his brother's law firm should the firm lose. *Id.* at 115. Here, the Judge's wife sits on the Board of Directors of AT&T's parent company. The Judge's interest in AT&T defeating Petitioner's claims that it

intentionally infringed Petitioner's trademarks is at least as strong -- and probably much stronger -- than the *Morgan* judge's potential concern that his brother's law firm might lose a case. This non-economic conflict of interest is not addressed in any way by the purported indemnity.

Second, in addition to money damages, Petitioners are seeking injunctive relief. (Compl. at p. 24.) In sum, Petitioners are trying to stop Google *and* AT&T from using the "Android" name at all. If Petitioners prevail against AT&T, and are awarded injunctive relief, AT&T would have to immediately stop selling its Android phones, pull the Android phones from its shelves, replace packaging and rewrite advertising campaigns. AT&T would also have to update the software on the Android phones it has already sold by, among other things, removing the Android name from the phones themselves and whatever applications its customers have downloaded for those phones. The financial and non-financial impact of an injunction could not practically be addressed by any indemnity agreement. For this additional reason, the indemnity agreement -- whatever its terms -- does not moot the Judge's conflicts of interest.

Third, the only statutorily recognized mechanism for removing a financial conflict of interest is divestment. 28 U.S.C. §455(f). Specifically, the statute allows a Judge to remove a conflict of interest by eliminating the source of that conflict. Here, to satisfy the conditions of Section 455(f), the Judge and his wife would have to sell off their shares in AT&T, and his wife would have to resign her position with

AT&T. Of course, this is an extreme measure, designed to completely eliminate any potential conflict. An inter-party indemnity agreement falls far short. While divestment is absolute, a contractual right of indemnity is not. As noted, an indemnity does not address any non-economic interests at all. It also cannot fully and adequately address the potential losses resulting from an injunction, including interruption of business, loss of goodwill and reputational injury. And, like any contractual right, it comes with a risk of non-performance. Indeed, except for the Judge's Order, Petitioners could not locate any decision in any jurisdiction holding that an indemnity agreement resolved a conflict of interest under Section 455(b).

D. The Judge Is Also Disqualified Under Section 455(a)

For the reasons set forth above, the Judge has a conflict of interest under Section 455(b) and should, therefore, be disqualified. Alternatively, he should be disqualified under the Section 455(a) because his and his wife's substantial interests in AT&T -- and AT&T's substantial interest in this case -- create the appearance of partiality.

"The goal of section 455(a) is to avoid even the appearance of partiality." *Liljeberg*, 486 U.S. at 860. As such, "[s]cienter is not an element of a violation of §455(a)." *Id.* at 859. "If it would appear to a reasonable person that a judge has knowledge of facts that would give him an interest in the litigation, then an appearance of partiality is created" *Id.* at 860. The question to be answered is

“whether a reasonable, well-informed observer could question the Judge’s impartiality. *In re United States*, 572 F.3d at 310.

Here, a reasonable, well-informed person would know that Petitioners are claiming that Google and AT&T’s use of the “Android” name is wrongful, and that Petitioners are asserting several identical claims against Google and AT&T as a result. That observer would also know that AT&T directly benefitted from the Judge’s denial of the Motion to Amend. The well-informed observer would further know that any rulings made by the Judge against Petitioners in the Proceedings will have preclusive or persuasive effect that will benefit AT&T. Conversely, the observer would know that rulings in Petitioners’ favor in the Proceedings could not be used against AT&T -- i.e., AT&T would get a second chance to re-litigate any issues Petitioners win in the Proceedings. In light of these facts, a reasonable person could question the Judge’s impartiality.

Moreover, Google’s offer to indemnify AT&T in the face of the Judge’s conflict of interest greatly compounds the appearance of partiality. After the Judge identified a conflict of interest and Petitioners’ moved for disqualification, Google and AT&T together came up with a way they thought the Judge could continue in the case. That bears repeating; AT&T worked with Google to find a way for the Judge to continue in the Proceedings despite his conflict of interest. If there was any doubt before as to whether AT&T and Google were working together, the

indemnity agreement lays it to rest. For purposes of the Proceedings, Google and AT&T are now essentially one and the same.

In these circumstances, “[a] reasonable, well-informed observer well may” conclude that any decision in this case that is adverse to Plaintiffs -- and beneficial to AT&T -- was not made by the Court “acting as a neutral arbiter,” but was the result of partiality in favor of AT&T. *In re United States*, 572 F.3d at 311. So, even if the Court concludes that disqualification is not mandated under Sections 455(b)(4) and 455(b)(5)(iii), the Court should still disqualify the Judge under Section 455(a) to avoid the appearance of partiality.

VI. CONCLUSION

WHEREFORE, Petitioners respectfully request that this Court issue a Writ of Mandamus disqualifying the Honorable Harry D. Leinenweber from continuing his involvement in the Proceedings, vacating all orders entered on and after July 23, 2010, and directing the District Court to assign the case to a different judge.

Respectfully submitted,

ERICH SPECHT, individually and doing business
as ANDROID DATA CORPORATION, and THE
ANDROID'S DUNGEON INCORPORATED,

By: P. Andrew Fleming
One of Their Attorneys

P. Andrew Fleming
John F. Shonkwiler
Richard G. Douglass
John B. Haarlow, Jr.

NOVACK AND MACEY LLP
100 North Riverside Plaza
Chicago, IL 60606
(312) 419-6900

Doc. #375043v2

Martin Murphy
2811 RFD
Long Grove, IL 60047
(312) 933-3200

Here, Plaintiffs contend that AT&T Mobility LLC ("AT&T") is one of the parties that infringed Plaintiffs' trademark. On July 13, 2010, Plaintiffs filed a Third Amended Complaint, which named AT&T and others as additional defendants. Two days later, Plaintiffs filed their Motion for Leave to File Third Amended Complaint (the "Motion to Amend") asking, among other things, that they be granted leave to add AT&T as an additional party defendant. As required by 28 U.S.C. §455(c), the Court determined that his wife is a board member of the parent company of AT&T, and that the Court and his wife hold "many shares" of AT&T's parent company, (See Transcript of Proceedings dated July 20, 2010 (cited as "Tr. at ___"), at 4, a copy of which is attached hereto as Exhibit A.) Based on this determination, the Court held that it would have to disqualify itself "immediately" if AT&T becomes a party to this action. (Tr. at 5.) However, the Court asked the parties to provide it with their views of the law as to "whether I should recuse myself now, because you have raised the specter of adding a party which would force me to recuse myself." (Tr. at 14.)

Plaintiffs respectfully believe that the Court must disqualify itself immediately, without taking any further action in this case. The Court already has a financial interest in the subject matter in controversy because the outcome of this case will likely determine the outcome of Plaintiffs' claims against AT&T -- regardless of whether AT&T is named as a party in this action or pursued in a separate proceeding. Even if the Motion to Amend were denied, and Plaintiffs had to file a separate action, AT&T will certainly argue that any rulings against Plaintiffs in this case should be given preclusive effect in favor of AT&T. For instance, if this Court decides that Plaintiffs abandoned their mark -- the primary defense raised by Defendant Google, Inc. ("Google") in this action -- then AT&T would undoubtedly try to use that determination against Plaintiffs in any parallel proceeding under the doctrine of collateral estoppel. Thus, AT&T

already has a direct and substantial interest in the outcome of this action, and the Court's rulings in this case. Accordingly, the Court's financial interest in AT&T is already an issue. Therefore, Plaintiffs respectfully suggest that the Court is required to immediately disqualify itself from further proceedings in this case pursuant to 28 U.S.C. §§455(b)(4) and/or (b)(5)(iii).

Furthermore, if the Court would have to disqualify itself if AT&T became a party, it should also disqualify itself from deciding whether it will allow AT&T to become a party. AT&T, like any potential defendant, has an interest in not being sued, which interest is directly implicated by the Motion to Amend. Essentially, denying the Motion to Amend would give AT&T a victory by staving off an adverse claim -- even if only for days or weeks -- and making it more time-consuming and costly for Plaintiffs to pursue their claims against AT&T. For this additional reason, the Court should disqualify itself.

II.

BACKGROUND

Plaintiffs have owned the federally-registered trademark "Android Data" since 2002. Plaintiffs contend that Google is liable for trademark infringement due to its use of the mark "Android" to market and describe software utilized on mobile phones and, more recently, other electronic devices. Earlier this year, AT&T began marketing and selling mobile phones and other electronic devices using the "Android" mark. Plaintiffs contend that AT&T's use of the Android mark also infringes their trademark rights.

On July 13, 2010, Plaintiffs filed their Third Amended Complaint, which included AT&T (and others) as additional Defendants. At the time, Plaintiffs believed that this filing was permitted by the Court's earlier Orders. Nevertheless, on July 15, 2010 -- before the deadline to amend pleadings and add parties expired -- Plaintiffs filed their Motion to Amend, seeking leave to file the Third Amended Complaint.

The Court held a hearing on several motions on July 20, 2010. At that hearing, the Court advised the parties as follows:

Actually, first, what I should say, and it is not the basis for my ruling, but in full disclosure, if I did allow the amendment, and AT&T came into the case, I would have to recuse myself. My wife is a board member of the parent company, AT&T, and we have an ownership interest. Obviously, we have many shares of AT&T.

* * *

Obviously if I let them in, I would have to get out immediately. (Tr. at 4; see also id. at 11 & 14.) The Court then asked both sides to address the question of whether the Court's financial interest in AT&T precluded it from ruling on a motion that would determine whether Plaintiff could pursue claims against AT&T in this action; or, even if the Court legally could rule, whether it should nevertheless refrain from doing so. (Tr. at 5-6.) In this Memorandum, Plaintiffs respectfully suggest that, because AT&T already has a direct interest in the outcome of this case, the Court is required to immediately disqualify itself from this case and, consequently, cannot rule on the Motion to Amend.

III.

ARGUMENT

The question of disqualification in this case is governed by 28 U.S.C. §455.¹ This section was completely re-written in 1974 to contain both a "general, all-inclusive" disqualification standard (in Section 455(a)), as well as "mandatory disqualification of a judge in certain specific circumstances, such as where family or financial interests are involved" (in Section 455(b)). SCA Servs., Inc. v. Morgan, 557 F.2d 110, 113 (7th Cir. 1977). The bright-line rules provide

¹ Because Plaintiffs are not moving under 28 U.S.C. §144, any arguments that Google makes in its filing based thereon, or on cases interpreting Section 144, are irrelevant.

certainty for certain cases, while the general standard provides a flexible approach to avoid even the appearance of partiality. Further, in revising Section 455, “Congress also intended to overrule the concept that close cases involving disqualification should be resolved on the ground that a judge ‘had a duty to sit.’” Id. (citing H.R.Rep. No. 93-1453, 93d Cong. 2d Sess. 5 (1974)).

Although a federal judge may disqualify him or herself under Section 455 without waiting for a motion by a party, parties are allowed to move for disqualification under that Section. E.g., Morgan, 557 F.2d at 117. Further, because Section 455 is directed to protecting the integrity of the judiciary itself, it does not contain “any time limits within which disqualification must be sought” by a party, even if raised by motion. Id. (noting that Congress considered a time limit, but rejected it).

Turning first to mandatory disqualification, Section 455(b) lists several specific circumstances where recusal is required, including the following that are pertinent to this matter:

(b) [A federal judge] shall also disqualify himself in the following circumstances:

* * *

- (4) He knows that he, individually or as a fiduciary, or his spouse or minor child residing in his household, has a financial interest in the subject matter in controversy or in a party to the proceeding, or any other interest that could be substantially affected by the outcome of the proceeding;
- (5) He or his spouse, or a person within the third degree of relationship to either of them, or the spouse of such a person:

* * *

- (iii) Is known by the judge to have an interest that could be substantially affected by the outcome of the proceeding;

28 U.S.C. §455(b). For purposes of these sections, the term “financial interest” means “ownership of a legal or equitable interest, however small, or a relationship as director, adviser, or other active participant in the affairs of a party.” 28 U.S.C. §455(d)(4) (emphasis added). Further, these Sections are not limited to financial interests. Morgan, 557 F.2d at 115. Rather, Congress recognized that “non-economic interests may affect a judge’s bias or prejudice.” Id. at 115-16 (noting that judge’s brother’s interest in the “reputation and goodwill” of his law firm were potential disqualifying interests). Finally, where Section 455(b) applies, disqualification is mandatory; it may not be waived by the parties. 28 U.S.C. §455(e); see also Morgan, 557 F.2d at 117 (“The provisions are mandatory; they are addressed to the judge and require that he disqualify himself in certain circumstances.”)

Section 455(a) also provides that a federal judge should also disqualify himself “in any proceeding in which his impartiality might reasonably be questioned.” 28 U.S.C. §455(a) (emphasis added).² “The goal of section 455(a) is to avoid even the appearance of partiality.” Liljeberg v. Health Serv. Acquisition Corp., 486 U.S. 847, 860 (1988). Thus, even if recusal is not mandated under any part of Section 455(b), disqualification is nevertheless required “when a reasonable person perceives a significant risk that the judge will resolve the case on a basis other than on the merits.” In re United States, 572 F.3d 301, 308 (7th Cir. 2009) (citations omitted).

A. The Court Is Disqualified By Sections 455(b)(4) and 455(b)(5)(iii)

As required by 28 U.S.C. §455(c), this Court has determined that he and his spouse have financial and other interests in AT&T. Specifically, the Court disclosed that he has “an ownership interest” in AT&T’s parent entity. (Tr. at 4.) The Court further disclosed that he and

² Section 455(b)(5)(i) also provides that a federal judge must disqualify himself if he or his spouse is “an officer, director, or trustee of a party.” Because AT&T is not yet a party to this case, this section is not yet applicable.

his wife “have many shares of AT&T.” (*Id.*) Thus, the Court has a “financial interest” in the outcome of Plaintiffs’ claims against AT&T, as defined in Section 455(b)(4). 28 U.S.C. § 455(b)(4). Additionally, the Court disclosed that his wife “is a board member of the parent company, AT&T.” (Tr. at 4.) Thus, the Court’s spouse has an additional “interest that could be substantially affected” by the outcome of Plaintiffs’ claims against AT&T, as those terms are used in Section 455(b)(4) and 455(b)(5)(iii).

This Court already found that it would need to recuse itself if AT&T was a party to this action. (Tr. at 4, 5 & 6.) Although the Court did not specify the basis for its recusal, presumably it would come under Section 455(b)(4) and/or Section 455(b)(5)(iii). However, disqualification under these Sections is required even if the disqualifying interest does not relate to a present party in the case. *See, e.g., In re Aetna Casualty & Surety Co.*, 919 F.2d 1136, 1143 (6th Cir. 1990) (interest in related litigation where rulings in the case *sub judice* could have preclusive effect required disqualification); *Gordon v. Reliant Energy, Inc.*, 141 F.Supp.2d 1041, 1043 (S.D. Cal. 2001) (same; and an interest in putative member of uncertified class required disqualification) (citing *Tramonte v. Chrysler Corp.*, 136 F.3d 1025 (5th Cir. 1998)). Rather, Section 455(b)(4) identifies three separate types of disqualifying interests: (1) a “financial interest in the subject matter in controversy”; (2) a financial interest “in a party to the proceeding,” or (3) “any other interest that could be substantially affected by the outcome of the proceeding”. 28 U.S.C. § 455(b)(4). Similarly, Section 455(b)(5)(iii) defines the disqualifying interest without any reference to parties; it includes any “interest that could be substantially affected by the outcome of the proceeding.” 28 U.S.C. § 455(b)(5)(iii). In sum, the issue of disqualification does not turn solely on whether AT&T is a party. Instead, the Court must disqualify itself if it or its spouse has any financial interest in the subject matter of the

controversy, or any other interest that could be substantially affected by the outcome of this proceeding.

Plaintiffs are actively pursuing claims against AT&T for infringement of Plaintiffs' "Android Data" mark. (See Third Amended Complaint (Docket 216), ¶¶ 76-77, 82, 91-98121-137.) Even if the Court ultimately denies the Motion to Amend, the claims against AT&T will proceed in a parallel action. (Tr. at 5-6.) Plaintiffs' claims against AT&T rest largely on the same facts and circumstances as the claims Plaintiffs are asserting in this case against Google. More importantly, the defenses raised by Google in this action -- particularly, the defense of abandonment -- are equally applicable to Plaintiffs' claims against AT&T. Indeed, "Google intends to file a motion for summary judgment in short order, on the basis that Plaintiffs possess no trademark rights whatsoever." (See Google's Response to Plaintiffs' Motion for Leave to File Their Third Amended Complaint and Memorandum in Support of Its Motion to Strike Same (Docket No. 222), p. 12.)

Due to the relatedness of Plaintiffs' claims against Google and AT&T, it is extremely likely that any ruling the Court enters in this case that is adverse to Plaintiffs could be asserted by AT&T as a collateral estoppel against Plaintiffs. Or, at the very least, such rulings would be persuasive precedent in any parallel action. For instance, if Google were to prevail in this Court on its abandonment defense (we do not think it should), AT&T would certainly argue that this determination is binding on Plaintiffs under the doctrine of collateral estoppel in any case against AT&T for infringement of the same mark. Thus, by virtue of its ownership of AT&T's parent company, the Court has a "financial interest in the subject matter of this controversy" because the resolution of the key issues in this case will directly impact the success or failure of Plaintiffs' claims against AT&T. For the same reason, Plaintiffs' claims against AT&T will be

“substantially affected by the outcome of this proceeding” -- and the Court’s interests in AT&T will be substantially affected thereby. This is true regardless of whether AT&T is made a direct party to this action.

A close parallel in the case law is Aetna. Aetna, 919 F.2d at 1136. There, seven actions were filed by the Federal Deposit Insurance Corporation (“FDIC”) against Aetna to recover money under a “Bankers Blanket Bond, Standard Form No. 24,” which Aetna issued for each of the failed banks. Id. at 1138. The subject judge’s daughter worked at a law firm involved in four of the seven suits. Id. at 1137-38. When the seven suits were consolidated for trial, the judge recused himself. Id. But, when the suits were later severed, the judge took over the three in which his daughter’s firm had not appeared. Id. The Sixth Circuit issued a writ of mandamus, compelling the judge to again recuse himself from those three cases. Id. at 1146.

The Aetna court held that the judge should be disqualified from all seven cases, even though his disqualifying interest related directly only to four. Id. at 1143-44. The court reasoned as follows:

A decision on the merits of any important issue in any of the seven cases . . . could or might constitute the law of the case in all of them, or involve collateral estoppel, or might be highly persuasive as a precedent. Thus, even if [his daughter’s] firm were not counsel of record for FDIC in all of the seven cases but only some of them, and was not of counsel in the three cases reassigned by Judge Hall to himself, we would find that the circumstances would indicate to a reasonable party, such as Aetna, that his partiality might be implicated, and/or that §455 would apply.

Id. at 1143. The court further noted that the judge’s daughter’s association with a firm on some of the related cases “involves appearance of partiality [under Section 455(a)] and also conflict of interest principles under §455(b)(4) and (b)(5)(ii),” even though she was not associated with the firms handling the cases that were actually before the judge. Id. at 1144.

Moreover, because the Court must recuse itself if AT&T were made a party, it likewise should recuse itself from deciding whether AT&T may be made a party to the case. Acting on the Motion to Amend will directly affect AT&T's interests. If the Court denies the Motion to Amend, then AT&T will benefit because requiring Plaintiffs to initiate and pursue a separate action will make the prosecution of those claims against AT&T more difficult, time-consuming and expensive for Plaintiffs. Denying the Motion to Amend would also give AT&T an advantage over Plaintiffs in any parallel litigation; AT&T would argue that it should get the benefit of any rulings in this case against Plaintiffs as a result of the doctrine of collateral estoppel, but would conversely argue that it cannot be bound by any decisions in Plaintiffs' favor. For this additional reason, the ruling on the Motion to Amend directly implicates the Court's and its spouse's interests in AT&T under Section 455(b)(4) and 455(b)(5)(iii).

In sum, no matter how the Motion to Amend is decided, the Court still has a disqualifying interest in this case because: (1) the Motion to Amend itself directly implicates the interests of AT&T; and (2) "[a] decision on the merits of any important issue" in this case could be "collateral estoppel, or might be highly persuasive as a precedent," in any other case against AT&T. Id. at 1043; see also Gordon, 141 F.Supp.2d at 1043 (finding disqualification appropriate if rulings in the case could be collateral estoppel in another case where judge had a disqualifying interest). Accordingly, the Court should immediately disqualify itself pursuant to Section 455(b)(4) and 455(b)(5)(iii).

B. Alternatively, The Court Must Disqualify Itself Pursuant to Section 455(a)

For the reasons discussed above, the Court is required to disqualify itself from further action in this case pursuant to Section 455(b)(4) and 455(b)(5)(iii). However, even if the Court determines that it is not disqualified pursuant to those provisions, the Court should still disqualify itself pursuant to Section 455(a).

“The goal of section 455(a) is to avoid even the appearance of partiality.” Liljeberg, 486 U.S. at 860. As such, “[s]cienter is not an element of a violation of §455(a).” Id. at 859. “If it would appear to a reasonable person that a judge has knowledge of facts that would give him an interest in the litigation, then an appearance of partiality is created” Id. at 860. The question to be answered is “whether a reasonable, well-informed observer could question the Judge’s impartiality. In re United States, 572 F.3d at 310.

Here, a reasonable, well-informed person would know that Plaintiffs are pursuing claims against AT&T (either in this case or in a separate case). That observer would also know that AT&T would benefit from the Court’s denial of the Motion to Amend because it would make it more costly and time-consuming for Plaintiffs to pursue their claims for money damages against AT&T. The well-informed observer would further know that, if the Motion to Amend is denied, any rulings made by the Court in this case that are adverse to Plaintiffs could be used by AT&T to its benefit in any separate case filed against it by Plaintiffs. Conversely, the observer would know that rulings in Plaintiffs favor in this case could not be used against AT&T -- i.e., AT&T would get a second bite at the apple to re-litigate any issues Plaintiffs wins in this case.

In these circumstances, “[a] reasonable, well-informed observer well may” conclude that any decision in this case that is adverse to Plaintiffs -- and beneficial to AT&T -- was not made by the Court “acting as a neutral arbiter,” but was the result of partiality in favor of AT&T. In re United States, 572 F.3d at 311. So, even if the Court concludes that disqualification is not mandated under Sections 455(b)(4) and 455(b)(5)(iii), the Court should still disqualify itself under Section 455(a) to avoid even the appearance of partiality.³

³ If the Court denies the Motion to Disqualify, Plaintiffs must immediately seek a writ of mandamus so that they do not waive their right to appeal the issue of disqualification under Section 455(a). E.g., In re United States, 572 F.3d 301, 307 (7th Cir. 2009).

C. In Any Event, the Court Should Not Rule on the Motion to Amend

Once a basis for disqualification arises, the Court should not issue any further orders in a case except those necessary to recuse itself and transfer the case. See, e.g., In re United States, 572 F.3d at 312 (holding “all orders entered by the Judge after the motion for recusal was filed must be vacated.”) As described above, because Plaintiffs are pursuing claims against AT&T (preferably, in this case), the Court already has a disqualifying interest under Section 455(b)(4) and (b)(5)(iii) and must disqualify itself pursuant to those Sections or, alternatively, under Section 455(a). As such, the Court is not permitted to make any further decisions in this matter, including a decision on the Motion to Amend.

Furthermore, the Motion to Amend itself relates directly to the interests of AT&T. As noted above, the ruling will decide where, when and how the Plaintiffs’ claims against AT&T are decided. If the Court denies the Motion to Amend, AT&T will benefit; it would be harder and more expensive for Plaintiffs to pursue their claims against AT&T, and AT&T would gain a strategic advantage over Plaintiffs because of the doctrine of collateral estoppel. For this additional reason, the ruling on the Motion to Amend directly implicates the Court’s and its spouse’s interests in AT&T under Section 455(b)(4) and 455(b)(5)(iii). As such, the Court should disqualify itself immediately, and leave the Motion to Amend to the successor judge.

IV.

CONCLUSION

For the foregoing reasons, Plaintiffs respectfully request that the Court grant their Motion to Disqualify, enter an Order to transfer this case to another Judge of the District Court, and award Plaintiffs any such other and further relief as is appropriate.

Respectfully submitted,

ERICH SPECHT, individually and doing business
as ANDROID DATA CORPORATION, and THE
ANDROID'S DUNGEON INCORPORATED

By: /s/ P. Andrew Fleming
One of Their Attorneys

P. Andrew Fleming
John F. Shonkwiler
John B. Haarlow, Jr.
NOVACK AND MACEY LLP
100 North Riverside Plaza
Chicago, IL 60606
(312) 419-6900
Doc. #374085v2

Martin Murphy
2811 RFD
Long Grove, IL 60047
(312) 933-3200

CERTIFICATE OF SERVICE

P. Andrew Fleming, an attorney, certifies that he caused copies of the foregoing Memorandum in Support of Plaintiffs' Motion to Disqualify Pursuant to 28 U.S.C. §455 to be served by electronically filing the document with the Clerk of Court using the ECF system this 23rd day of July, 2010.

/s/ P. Andrew Fleming

EXHIBIT A

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

ERICH SPECHT, et al.,

Plaintiffs,

vs.

GOOGLE, INC., et al.,

Defendants.

No. 09 C 2572

Chicago, Illinois

July 20, 2010

9:30 o'clock a.m.

TRANSCRIPT OF PROCEEDINGS - MOTIONS
BEFORE THE HONORABLE HARRY D. LEINENWEBER

APPEARANCES:

For the Plaintiff:

NOVACK & MACEY
MR. P. ANDREW FLEMING
MR. JOHN F. SHONKWILER
100 North Riverside Plaza
Chicago, Illinois 60606
312-419-6900
and
MR. MARTIN J. MURPHY

For the Defendants,
Google, Inc.:

GREENBERG TRAURIG, LLP
MR. HERBERT H. FINN
MR. RICHARD D. HARRIS
77 West Wacker Drive
Chicago, Illinois 60601
312-456-8400

For the Defendant,
T-Mobile:

LOEB & LOEB, LLP
MR. ROBERT M. ANDALMAN
321 North Clark Street
Chicago, Illinois 60610
312-464-3100

1	Court Reporter:	FEDERAL OFFICIAL COURT REPORTER
2		MS. KRISTA FLYNN BURGESSON
3		219 South Dearborn Street
4		Chicago, Illinois 60604
5		312-435-5567
6		
7		
8		
9		
10		
11		
12		
13		
14		
15		
16		
17		
18		
19		
20		
21		
22		
23		
24		
25		

1 THE CLERK: 09 C 2572, Specht versus Google.

2 MR. FLEMING: Good morning, your Honor. Andrew
3 Fleming, John Shonkwiler, and Martin Murphy appearing on
4 behalf of the plaintiffs.

5 MR. SHONKWILER: Good morning, your Honor.

6 MR. MURPHY: Good morning.

7 MR. HARRIS: Good morning, your Honor. Richard
8 Harris and Herb Finn on behalf of defendant Google.

9 MR. FINN: Good morning, your Honor.

10 MR. ANDALMAN: Good morning, your Honor. Robert
11 Andelman for T-Mobile. We were a party previously. That is
12 spelled A-n-d-a-l-m-a-n.

13 THE COURT: All right.

14 MR. FLEMING: Your Honor, there are 3 motions up this
15 morning.

16 There is a motion for leave to amend the complaint
17 filed by the plaintiffs, which includes the joinder of 4
18 defendants, Sprint, T-Mobile, AT&T Mobility, and Verizon.

19 There is a motion to strike that motion filed by
20 Google, and --

21 THE COURT: I think it is a motion to strike the
22 complaint that was filed.

23 MR. FINN: Yes.

24 MR. HARRIS: Yes, that is correct. We filed a motion
25 originally and --

1 THE COURT: And you responded this morning or last
2 night to their motion?

3 MR. FLEMING: Yes, your Honor.

4 THE COURT: And then there is a motion to compel that
5 position.

6 MR. HARRIS: That is correct, Judge.

7 THE COURT: And you responded to that?

8 MR. FLEMING: We have not filed a written response to
9 that motion.

10 THE COURT: Yes, you did.

11 I read it this morning.

12 MR. FLEMING: Yes, okay, yes, we did address that in
13 the --

14 THE COURT: You did address that, okay. So I have
15 read everything you have written.

16 Now, does anybody want to say anything?

17 Actually, first, what I should say, and it is not the
18 basis for my ruling, but in full disclosure, if I did allow
19 the amendment, and AT&T came into the case, I would have to
20 recuse myself. My wife is a board member of the parent
21 company, AT&T, and we have an ownership interest. Obviously
22 we have many shares of AT&T.

23 MR. HARRIS: That is understood, your Honor.

24 I would like to respond with the Court's permission
25 on just a few points.

1 THE COURT: Okay.

2 MR. FLEMING: Could I just address that comment your
3 Honor has made?

4 THE COURT: Yes.

5 MR. FLEMING: Does your Honor feel that that would
6 effect your Honor's position in terms of ruling on the
7 motion?

8 THE COURT: I don't think so, because they are not a
9 party to the case, but I really didn't think about it.
10 Obviously if I let them in, I would have to get out
11 immediately.

12 MR. FLEMING: I mean, there will be a case filed
13 against them, your Honor, it is not --

14 THE COURT: If there is, obviously I would have to
15 recuse myself under whatever the statute is.

16 MR. FLEMING: I think even in ruling on it then --

17 We have not looked at the issue, your Honor, but we
18 would like to be able to look at the issue.

19 THE COURT: Let's ask Google.

20 What is your view of that?

21 MR. HARRIS: Your Honor, we have been before this
22 Court so many times over the years, we have no doubts
23 whatsoever that this Court can rule fairly and equitably.

24 THE COURT: The question is whether it can do so
25 legally.

1 I think I can rule fairly.

2 MR. HARRIS: Yes.

3 THE COURT: But legally whether I can rule, that is
4 the issue.

5 If it is a motion to bring in a party -- if it
6 brought in, I would have to recuse myself.

7 MR. HARRIS: Well, thanks to plaintiff, your Honor,
8 that is really not a problem. It was just stated on the
9 record that they are going to go after AT&T no matter what the
10 Court rules.

11 So, in essence, regardless of how the Court rules,
12 AT&T eventually, according to what we have just heard, will be
13 a party in some case, probably assigned to some other Judge,
14 and I don't believe it effects at all this Court's ability to
15 rule on the motion.

16 MR. FINN: Moreover, your Honor, AT&T stands with the
17 other 3 potential defendants, or at least in the similar
18 position of the other potential defendants, and we assume you
19 have no issue with that, and that the ruling would be based
20 more on --

21 THE COURT: I have no issue with any of the other
22 defendants.

23 MR. FINN: Right.

24 And since they are similarly situated, it would
25 appear logical that you should be able to rule on the

1 entirety.

2 MR. FLEMING: Well, we do have a concern, your Honor,
3 and we would like to present something in writing to the
4 Court. We would like to look at this issue and present
5 something in writing.

6 We certainly are not going to --

7 THE COURT: Well, if I continue that motion --

8 I can rule on the motion for depositions, I believe.

9 MR. HARRIS: Very well, your Honor.

10 And also, certainly you can rule on the motion --

11 THE COURT: I can give a time and --

12 This is more for my own concern. I mean, I don't
13 want to do something illegal. I don't think it would be
14 illegal for me to rule on the motion, but --

15 MR. HARRIS: Understood.

16 MR. FLEMING: We can certainly get something on file
17 very quickly, your Honor.

18 THE COURT: That is what I am thinking of.

19 MR. FLEMING: We would certainly do that.

20 And we are back in court next Tuesday on the
21 continued motion to --

22 THE COURT: I am concerned about the motion because
23 of the discovery deadline, the other motion, which there is no
24 question I can rule on, having not taken up the issue of
25 bringing in any other additional defendants.

1 MR. HARRIS: Your Honor, could the Court rule on the
2 other 3 named parties, 2 of which were named in one of the
3 early amended complaints or one of the original complaints
4 over a year ago? Could the Court address just the 3, and
5 remove for now the issue of AT&T, so that this Court can
6 fairly and equitably address a motion for leave to amend a
7 complaint that is being brought ten days, in essence, before
8 the close of discovery in this case, while a separate motion
9 for extending discovery is still pending?

10 This is another approach, and I should mention to the
11 Court that there are 4 depositions scheduled over the next ten
12 days, one of which is the court ordered deposition --

13 THE COURT: That is what I was thinking of ruling on,
14 a motion --

15 MR. HARRIS: (Continuing) -- which was the subject of
16 a sanction order.

17 THE COURT: (Continuing) -- a motion to compel
18 depositions.

19 Now, that I can put off say until next week for
20 ruling on the motion to amend. They have tied them together,
21 but I don't see the basis for not ordering the depositions to
22 go forward.

23 It was agreed -- as I understood from looking at all
24 the E-mails back and forth, they were agreed to, the dates, up
25 to a few days ago, a week ago. I don't have it in my mind

1 exactly what the date was when Mr. Shonkwiler, I think,
2 notified Google's attorneys that the depositions would not go
3 forward because of the plan to file the third amended
4 complaint, bringing in new parties.

5 MR. SHONKWILER: Judge, this all happened rather
6 fast, and the one part of this that I think needs a little
7 clarifying is we don't want to postpone dispositive briefing
8 and we don't want to postpone discovery any more than we have
9 to if no new defendants were added.

10 There is some extension of the discovery deadline
11 that is necessary, and we will file a brief tomorrow if that
12 deadline stays on the calendar for filing a brief for the
13 defendant motion to extend discovery, just because discovery
14 is not complete between Google and the plaintiffs.

15 But apart from the extension that is needed for that
16 purpose, we don't want to postpone dispositive briefing, any
17 summary judgment briefing, in this case.

18 If we can add the new parties, and get that briefing
19 schedule on the same track, it would be otherwise. None of
20 this needs to be cause for delay or expense, and no party here
21 wants to delay this trial or this summary judgment briefing,
22 and no party here wants to add expense.

23 I think that is the part where we missed each other
24 apparently on the phone, and at the briefing.

25 I talked to counsel outside of the courtroom this

1 morning, but just very briefly, and I don't know whether we
2 will be able to agree to a schedule for briefing and/or for
3 the addition of parties, but that is the part that I think is
4 not --

5 THE COURT: Well, the motion for briefing additional
6 parties is fully briefed, as far as I am concerned. I mean, I
7 am aware of the issues. Now the only question is whether or
8 not I legally can rule on it.

9 MR. HARRIS: There is one issue, Judge, that came up,
10 besides the delay and the representations that were being made
11 up, and the fact that this information has been known over a
12 year, that all of a sudden now it justifies things.

13 There was a transcript that was attached to the
14 motion we received last night, and with the Court's
15 permission, I would like to give the Court the entire segment
16 of the transcript as opposed to the one that was simply
17 paraphrased in the brief that was filed last night.

18 May I approach, your Honor?

19 THE COURT: Yes.

20 MR. HARRIS: Now, this particular transcript, and I
21 believe it is from February 23rd, I happened to be there that
22 day, and there is mention of the fact that there is a
23 reference that --

24 MR. FLEMING: Your Honor, we are now arguing the
25 motion that your Honor has indicated we will have an

1 opportunity to file something on.

2 I don't think this makes sense.

3 THE COURT: I don't need anything else to --

4 MR. FLEMING: We are not arguing enjoinder or arguing
5 discovery.

6 THE COURT: The only issue before me that I need is
7 that I think I should obtain input from you on whether or not

8 I legally have to recuse myself because you filed a motion to
9 bring in a party which, if I allow in, will require me to
10 recuse myself.

11 MR. HARRIS: I understand that, Judge.

12 I thought you were asking is there anything else that
13 either of the parties wanted to say with regard to the motion
14 to amend the complaints now for a third time before we address
15 deferring that issue until the Court addresses the concern of
16 recusal.

17 THE COURT: What I said is I thought I had sufficient
18 information from the briefing, particularly, the one that you
19 filed, the motion you filed with the brief, and then the brief
20 -- the 2 briefs, actually, they had the motion to amend, and
21 their brief that was filed -- I received a copy this morning
22 when I came in, and I have read it, but it is plaintiff's
23 memorandum in support of their motion for leave to file a
24 third party complaint in opposition of the motion to strike
25 the same and so on.

1 Now, you wanted to supplement what they -- one of
2 their exhibits, is that what you are saying?

3 MR. HARRIS: Yes, Judge.

4 I just wanted to add, because we were not aware that
5 they would be relying on the transcript of February 23, 2010,
6 but skip the first page where the Court specifically says --
7 and says it to Mr. Fleming, no less, that it will allow

8 Mr. Fleming to amend the pleadings up to July 15th, but not to
9 join new parties.

10 THE COURT: I think they did have that in here,
11 didn't they?

12 MR. HARRIS: I don't believe they had that page.

13 They had the reference a page or two later that
14 suggests if they want to come in with new parties, they would
15 have to file a motion that justifies it.

16 THE COURT: Yes, yes.

17 It was clear that I took that position that it would
18 require a motion, they couldn't do that on their own, but the
19 amendments contemplated would be clean up amendments, so to
20 speak, and that type of thing.

21 MR. HARRIS: That is correct, your Honor.

22 With that, that is all we have to add to supplement
23 then.

24 THE COURT: All right.

25 As far as the motion then to -- the other motion that

1 Google filed to compel the depositions, I am going to grant
2 that. It seems to me that there was an agreement reached, and
3 I am just looking through all the E-mails back and forth, that
4 the depositions would be taken within the Court imposed
5 discovery closure, and that they should have been, unless by
6 agreement of parties, gone through.

7 So, I will order that, that they be completed by the
8 discovery close.

9 MR. HARRIS: Thank you, your Honor.

10 THE COURT: So, that motion is granted.

11 MR. HARRIS: Thank you.

12 MR. SHONKWILER: Your Honor, tomorrow is the deadline
13 for briefing, any additional briefing, in support of the
14 pending motion extending discovery, the discovery deadline.
15 As I said before, we will be filing a brief to extend what
16 impact, if any, that will have on the ruling your Honor just
17 made.

18 THE COURT: None, none.

19 It seems to me there was an agreement reached to
20 produce witnesses at particular times, and if plaintiff -- I
21 assume Google knows that if they wish to depose the parties
22 again, they would have to seek leave of Court to do so.

23 MR. HARRIS: That is understood, your Honor.

24 MR. ANDALMAN: It is not Google, your Honor, it is
25 the other parties.

1 MR. MURPHY: We wanted to avoid the --

2 THE COURT: I am saying Google, if they wish to
3 depose your witnesses a second time because, if I grant -- or
4 if some Judge grants leave to bring in new parties, that they
5 would have to seek leave of Court to depose your people again,
6 not to say that the new parties wouldn't have an opportunity
7 to depose them, but that --

8 MR. SHONKWILER: That was our only concern, that the
9 new parties would, and we are not refusing to produce these
10 parties for deposition.

11 THE COURT: If I allow the amendment, that is the
12 problem you run into this late in the game by amending.

13 So, we will put the motion to amend the third amended
14 complaint over to next week, and you should file something by
15 the end of this week, just simultaneously file something by
16 the end of the week as to whether or not legally I can rule
17 on the motion.

18 You can also put in your arguments why perhaps I
19 shouldn't rule on it, and/or if you conclude I legally should
20 do it, I won't limit you to that, you can put anything you
21 want in there, whether I should recuse myself now, because you
22 have raised the specter of adding a party which would force me
23 to recuse myself, or whether I can rule on that legally, but
24 perhaps I shouldn't, because of whatever reason you can think
25 of.

1 MR. HARRIS: Very well.

2 You would like that filed by Friday?

3 THE COURT: Yes, so we can review it.

4 And we will continue the motion over until next
5 Tuesday.

6 MR. HARRIS: Okay.

7 THE CLERK: Tuesday, the 27th, at 9:00.

8 THE COURT: Okay.

9 MR. FLEMING: Can we have also until Friday to file
10 our brief in support of the extension for discovery?

11 THE COURT: Is the motion for extension up?

12 MR. FLEMING: It is up next Tuesday.

13 MR. FINN: Your Honor ordered that tomorrow the
14 plaintiffs file a supplemental brief, if necessary, for the
15 continued motion to extend discovery.

16 MR. FLEMING: It is due tomorrow, yes, but we will
17 obviously be in Mr. Specht's deposition tomorrow.

18 THE COURT: Wait a minute.

19 What is up tomorrow before me, anything?

20 MR. FLEMING: No, but we are supposed to file a
21 further brief tomorrow, your Honor, in support of our motion
22 to extend the discovery cut off. Your Honor wanted to see
23 what happened at the 30(b)(6) depositions and wanted us to
24 come and file supplemental briefs.

25 THE COURT: Okay.

1 MR. FLEMING: And so what I am suggesting is that
2 we file that on Friday as well, and that will be up next
3 Tuesday as well.

4 THE COURT: You can file it on Friday.

5 MR. FLEMING: Thank you, your Honor.

6 MR. HARRIS: Thank you.

7 THE COURT: All right.

8 (Proceedings concluded.)

9

10

11

12

C E R T I F I C A T E

13

14

15

I certify that the foregoing is a correct transcript
from the record of proceedings in the above-entitled matter.

16

17

/s/Krista Burgeson, CSR, RMR, CRR
Federal Official Court Reporter

July 20, 2010
Date

18

19

20

21

22

23

24

25

**IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION**

ERICH SPECHT, an individual and doing
business as ANDROID DATA CORPORATION,
and THE ANDROID'S DUNGEON
INCORPORATED,

Plaintiffs,

v.

GOOGLE INC., T-MOBILE USA, INC.,
SPRINT NEXTEL CORPORATION,
CELLCO PARTNERSHIP d/b/a VERIZON
WIRELESS, and AT&T MOBILITY LLC,

Defendants.

Civil Action No. 09-cv-2572

Judge Harry D. Leinenweber

Magistrate Judge Jeffrey Cole

GOOGLE, INC.,

Defendant/Counterplaintiff,

v.

ERICH SPECHT, an individual and doing
business as ANDROID DATA CORPORATION,
and THE ANDROID'S DUNGEON
INCORPORATED,

Plaintiffs/Counterdefendants.

THIRD AMENDED COMPLAINT

Plaintiffs Erich Specht ("Specht"), an individual and doing business as Android Data Corporation ("ADC") and The Android's Dungeon Incorporated ("ADI") (collectively referred to herein as "Plaintiffs"), by and through their attorneys, as and for their Third Amended Complaint against Defendants Google, Inc. ("Google"), T-Mobile USA, Inc. ("T-Mobile"), Sprint Nextel Corporation ("Sprint"), Cellco Partnership d/b/a Verizon Wireless ("Verizon") and AT&T Mobility LLC ("AT&T") allege as follows.

THE PARTIES

1. Plaintiff Specht is a resident of the Village of Palatine, Illinois. ADC and ADI are Illinois domestic corporations organized and existing under the laws of the State of Illinois and having a principal place of business in the Village of Palatine, Illinois.

2. Defendant Google is a Delaware corporation registered to do business as a foreign corporation, and doing business, in Illinois.

3. Defendant T-Mobile is a Delaware corporation registered to do business as a foreign corporation, and doing business, in Illinois.

4. Defendant Sprint is a Kansas corporation doing business in Illinois.

5. Defendant Verizon is a Delaware general partnership doing business in Illinois.

6. Defendant AT&T is a Delaware limited liability company doing business in Illinois.

7. Defendants T-Mobile, Sprint, Verizon and AT&T will be collectively referred to herein as the "Carrier Defendants."

JURISDICTION AND VENUE

8. This is a civil action alleging trademark infringement and unfair competition arising under §§32 and 43 of the Lanham Act, 15 U.S.C. §§1114(1) (trademark infringement), 1125(a) (unfair competition), as well as a violation of the Illinois Deceptive Trade Practices Act, 815 ILCS 510/2, common law trademark infringement and contributory infringement.

9. This Court has original subject matter jurisdiction over this action pursuant to 28 U.S.C. §1338(a), 28 U.S.C. §1338(b) and supplemental jurisdiction over the state law claims alleged herein under 28 U.S.C. §1367(a). The court also has subject matter jurisdiction pursuant to

28 U.S.C.A. § 1332, because this action is between citizens of different States and the amount in controversy exceeds \$75,000.00, exclusive of interest and costs.

10. This Court has personal jurisdiction over Google because it maintains an office in Chicago, Illinois, has transacted business in this State, and it is registered to do business in Illinois. The Court also has jurisdiction over Google pursuant to the Illinois long arm statute, 735 ILCS 5/2-209(a)(2).

~~11. This Court has personal jurisdiction over T-Mobile because it has transacted~~
business in this State, and it is registered to do business in Illinois. The Court also has jurisdiction over T-Mobile pursuant to the Illinois long arm statute, 735 ILCS 5/2-209(a)(2).

12. This Court has personal jurisdiction over Sprint because it has transacted business in Illinois. The Court also has jurisdiction over Sprint pursuant to the Illinois long arm statute, 735 ILCS 5/2-209(a)(2).

13. This Court has personal jurisdiction over Verizon because it has transacted business in Illinois. The Court also has jurisdiction over Verizon pursuant to the Illinois long arm statute, 735 ILCS 5/2-209(a)(2).

14. This Court has personal jurisdiction over AT&T because it has transacted business in Illinois. The Court also has jurisdiction over AT&T pursuant to the Illinois long arm statute, 735 ILCS 5/2-209(a)(2).

15. Venue is proper in this district under 28 U.S.C. §1391(b) and (c).

FACTS COMMON TO ALL COUNTS

16. Plaintiff ADC is an Illinois corporation in good standing. It was incorporated on December 30, 1998, by Specht, its sole officer, director and shareholder. At all relevant times, Specht has been an officer of ADC.

17. Plaintiff ADI is an Illinois corporation in good standing. It was incorporated on March 5, 2001, by Specht, its sole shareholder. At all relevant times, Specht has been an officer of ADI.

18. Plaintiff Specht is a software developer and internet application service provider.

19. Since at least 1999, Specht has developed and offered for sale computer software and hardware related products and services under the trademarks "Android Data," "Android Server," "Android Data Web Editor" and "Android's Dungeon" (collectively, the "Android Marks"). Plaintiffs hold copyrights filed with the United States Copyright Office on Android Server software and Android Data Web Editor software, which are versions of Specht's Android Data software suite, as well as Android Data - Version 5, the current version of the Android Data software product line. Specht's Android Data software suite (the "Android Software") enables the remote administration of websites including secure data transfer, management and categorization of products, image processing, online surveys, email campaigns, document transformation, and the like. Computer hardware and software services offered by Plaintiffs include web page design, custom software application development, and consulting on software and hardware issues.

20. Plaintiff Specht, through his wholly owned corporation ADI, continues to use, develop and offer for sale the Android Software and related services under the Android Marks.

21. The Android Software implements advanced caching algorithms that allow for greater efficiency of web and database servers, and integrates on-line and off-line database servers.

22. Beginning in 1999, the Android Software was intended to and has been used in commerce by customers who transact hundreds of millions of dollars in worldwide transactions, including tens of millions in e-commerce over the world wide web using the Android Software.

23. Specht chose the word "Android" for the Android Marks to communicate the seamless, almost robotic-like, bi-directional communication of data between a client and a data center in a remote location.

24. "Android Data" and the other Android Marks are inherently distinctive and/or have acquired distinctiveness through use.

25. Specht is and has been further developing the Android Software as well as preparing to release additional software products in the near future under one or more of the Android Marks.

26. On June 4, 2000, Specht, on behalf of ADC, filed an application with the United States Patent and Trademark Office (the "PTO") for the mark "Android Data" (Serial No. 78011167). A copy of the application is attached hereto as Exhibit A.

27. On October 22, 2002, the PTO granted ADC's registration of the mark "Android Data" on the Principal Register, Registration No. 2,639,556. Registration No. 2,639,556 is *prima facie* evidence of the validity and ownership of, and is constructive notice of ownership of, the Android Data mark as provided by 15 U.S.C. §§1057(b) and 1072. As a condition of approval, the PTO required that the following language be inserted into the application: "No claim is made to the exclusive right to use 'Data,' apart from the mark as shown." This language indicates that the dominant word in the mark is "Android" with "Data" being a descriptive or non-dominant word. As stated in Registration No. 2,639,556, the Android Data mark identifies "computer e-commerce software to allow users to perform electronic business transactions via global computer network," in International Class 9 (U.S. Classes 21, 23, 26, 36, and 38). A copy of Registration No. 2,639,556 is attached hereto as Exhibit B.

28. Effective on or about December 26, 2002, ADC transferred ownership of the Android Software and Android Marks to ADI.

29. On December 1, 2003, thirteen months after the PTO granted Registration No. 2,639,556 for the Android Data mark, Andy Rubin ("Rubin") founded a company called Fotofarm, Inc., for the purpose of creating a digital camera. On February 12, 2004, Fotofarm, Inc. registered to do business in the State of California. Unable to secure venture capital funding, Rubin tabled the digital camera idea and went to work on an open source platform for mobile phone devices which he called Android (the "Android Platform").

30. In 2004, Rubin assembled a group of engineers including Andrew McFadden ("McFadden") and Chris White ("White"), whom Rubin had worked with at Web TV, and product planners including Nick Sears ("Sears") and Rich Miner ("Miner"), whom Rubin had worked with while he was at Danger, Inc. (the foregoing individuals are collectively referred to herein as the "Android cofounders"). On or about June 18, 2004, Fotofarm, Inc. changed its name to Android Research, Inc. On or about April 6, 2005, Android Research, Inc. changed its name to Android, Inc. At all times, Rubin was the Chief Executive Officer of Android, Inc. and its predecessor companies (hereinafter, "Android, Inc.").

31. Beginning in 2004, Android Research, Inc. began using the Android name in commerce when it solicited funding in the form of venture capital for Android, including \$100,000 invested by Steve Perlman, whom Rubin, White and McFadden had previously worked with at Web TV; negotiated a partnership deal with Clearwire, a wireless broadband internet service provider, and its CEO, Craig McCaw; and negotiated a sale of the Android Platform to Google.

32. Prior to using the mark "Android" in commerce, Rubin, Sears, Miner and White did not conduct a thorough trademark search.

33. In or about July, 2005, Google acquired Android, Inc. and, thereafter, the Android cofounders went to work for Google.

34. In addition to their share of the sale price and the employment given to them at Google, the Android cofounders were able to continue their work on the Android Platform.

35. As part of its purchase of Android Inc., Google acquired assets and liabilities from Android, Inc. including, without limitation, its software source code, goodwill, internet domain names, intellectual property rights and liabilities and key employees, including engineers and product planners.

36. Google has since used these same assets in violation of Plaintiffs' rights.

37. At Google, Rubin is responsible for managing the development of the Android Platform. Rubin has overseen and has personal knowledge regarding all aspects of the development of the Android Platform by Google, including the acquisition of Android, Inc. and the creation of the Android Platform.

38. Sears is responsible for Google's business development concerning the Android Platform.

39. Miner is a group manager for Google, with duties concerning the Android Platform.

40. McFadden is a senior software architect for the Android Platform.

41. White left the employ of Google in October 2006. While at Google, his duties were primarily those of a software engineer in the development of the Android Platform.

42. In or about October 2007, and before it filed its trademark application for the mark "Android," Google hired a private contractor to perform a trademark search. The search result disclosed Plaintiffs' ownership of the Android Data mark and Plaintiffs' contact information.

43. On October 31, 2007, Google filed an application with the PTO for the mark “Android,” Serial No. 77318565 (the “Google Application”). A copy of the Google Application is attached hereto as Exhibit C. The goods and services identified under the Google Application were International Class 9, computer hardware and software. The Google Application asserted an “intent to use” the mark “Android” as follows: “The applicant has a bona fide intention to use through the applicant’s related company or licensee the mark in commerce or in connection with the identified goods and/or services.” Thus, Google was seeking the exclusive right to use and license the mark “Android” in commerce or in connection with any software or hardware use or product.

44. Prior to filing the Google Application, Google did not conduct a thorough trademark search.

45. On November 5, 2007, Google announced the formation of the Open Handset Alliance (the “OHA”), a partnership or business alliance consisting of dozens of firms. As of the date of this Third Amended Complaint, the OHA had approximately 76 members, including, among others, Acer, Dell, eBay, Inc., Garmin International, Inc., Google, Inc., HTC Corporation (“HTC”), Intel Corporation, LG Electronics, Inc. (“LG”), Motorola, Inc. (“Motorola”), NEC Corporation, Samsung Electronics (“Samsung”), Sharp Corporation, Sony Ericsson, Sprint Nextel, Texas Instruments Incorporated, T-Mobile, Toshiba Corporation and Vodafone (a minority partner in Verizon).

46. Since 2005, the OHA members have been working together on products relating to the Android Platform and on November 12, 2007, the OHA released the Android Software Development Kit (“SDK”) as an early look to enable developers to create innovative and compelling applications for the platform. The early look also provided developers with the

opportunity to participate in the evolution of the Android Platform by providing feedback throughout the development.

47. Beginning at some point in 2008 and continuing to the present, without permission from Plaintiffs, Google, the Carrier Defendants and other OHA members have been releasing software and selling products and services in association with the mark "Android."

48. Wikipedia, the free online encyclopedia, reports that "Android is the brain child of Google and the flagship software of the OHA, is based on an open source license and will compete against other mobile platforms from Apple Inc., Microsoft, Nokia, Palm, Research In Motion and Symbia."

49. On February 14, 2008, the PTO issued an Office Action letter refusing the Google Application for registration of the trademark "Android," citing likelihood of confusion with Plaintiffs' "Android Data" mark (the "February 14 Office Action"). A copy of the February 14 Office Action is attached hereto as Exhibit D.

50. On August 14, 2008, Google filed a response to the February 14 Office Action. A copy of the response is attached hereto as Exhibit E.

51. On August 20, 2008, the PTO issued a second Office Action making the refusal of the Google Application final (the "Final Office Action"). A copy of the Final Office Action is attached hereto as Exhibit F.

52. In the Final Office Action, the PTO explained, among other things, that Google's use of Android encompasses a broad range of goods and/or services, including "providing e-commerce software" that can be used on mobile devices, computers, computer networks, and global communication networks. The PTO cited likelihood of confusion with Plaintiffs' mark "Android Data," determining that the marks are similar in "sound, appearance, and commercial

impression” and share the dominant term, Android, and “the applicant’s [Google] goods are closely related to the registrant’s [Plaintiffs] goods and commonly emanate from the same source as the registrant’s goods.”

53. On September 23, 2008, one month after the PTO issued its Final Office Action refusing the Google Application, Google issued a press release announcing the release of the “Android 1.0 SDK” product.

54. The following month, on October 21, 2008, Google released portions of the source code for the Android software to developers and encouraged and gave developers the ability to use the infringing Android operating system to create infringing Android applications for use with Google’s infringing products.

55. On November 20, 2008, Google filed with the PTO a Request For Reconsideration After Final Action which requested reconsideration of the Final Office Action or, in the alternative, suspension of all further action on the Google Application. A copy of the request is attached hereto as Exhibit G.

56. On November 20, 2008, Google also filed a Notice of Appeal to the PTO Trademark Trial and Appeal Board. A copy of the Notice of Appeal is attached hereto as Exhibit H.

57. On November 21, 2008, the PTO’s Trademark Trial and Appeal Board issued an order suspending Google’s appeal pending its request for reconsideration. A copy of the order is attached hereto as Exhibit I.

58. On November 24, 2008, per Google’s request, the PTO issued its Notice of Suspension. A copy of the Notice of Suspension is attached hereto as Exhibit J.

59. Despite the fact that the Google Application was refused, and despite the fact that Google requested that all action on the Application be suspended, Google has not taken any action to curtail its infringing activities.

60. There are millions of products on the market that specifically say "Powered by Android" or otherwise mention Google's Android products and/or services.

61. In certain promotional materials, Google, the Carrier Defendants and/or other OHA members have identified "Android" as a trademark and/or registered trademark of Google.

62. To date, Google has collected millions of dollars in developer registration fees.

63. Google, the Carrier Defendants and other OHA members have sold over one billion dollars worth of equipment bearing the mark "Android," containing Android applications, or running on the Android operating system.

64. Google and the OHA have released over one million copies of their SDKs and several versions of the Android Platform to over one million software developers, and have participated in the creation of "Android Market," which provides Android phone users with access to tens of thousands of applications to download and install on their phones, often for a fee.

65. On December 5, 2008, Google and the OHA released "Android 2.0 SDK."

66. In October 2008, T-Mobile launched its first Google-branded phone, known as the G1, after spending more than \$10 million and almost three years in development. The mobile device is manufactured by HTC, features Qualcomm's dual-core MSM7201A semiconductor with integrated processing, multimedia, graphics capabilities and multi-mode 3G mobile broadband connectivity and operates on the Android Platform.

67. In July 2009, T-Mobile launched the myTouch 3G, its second Android mobile device, manufactured by HTC. In November 2009, T-Mobile launched its third Android handset,

the Motorola CLIQ. Since then, several other Android mobile devices have been released for sale for which T-Mobile is the wireless voice and data service provider, including the Samsung Behold, Motorola CLIQ XT and HTC myTouch 3G Slide.

68. The HTC-manufactured "Hero" phone was released for sale to the general public in or around October 2009, and it has been sold ever since. The Hero is a mobile device that operates on the Android Platform and has wireless service provided by Sprint.

69. The Samsung-manufactured "Moment" phone was released for sale to the general public in or around November 2009, and it has been sold ever since. The Moment is a mobile device that operates on the Android Platform and has wireless service provided by Sprint.

70. The HTC-manufactured "Evo" phone was released for sale to the general public in or around June 2010, and it has been sold ever since. The Evo is a mobile device that operates on the Android Platform and has wireless service provided by Sprint.

71. The HTC-manufactured "DROID Eris" phone was released for sale to the general public in or around November 2009, and it has been sold ever since. The DROID Eris is a mobile device that operates on the Android Platform and has wireless service provided by Verizon.

72. The Motorola-manufactured "DROID" phone was released for sale to the general public in or around November 2009, and it has been sold ever since. The DROID is a mobile device that operates on the Android Platform and has wireless service provided by Verizon.

73. The Motorola-manufactured "Devour" phone was released for sale to the general public in or around February 2010, and it has been sold ever since. The Devour is a mobile device that operates on the Android Platform and has wireless service provided by Verizon.

74. The Motorola-manufactured "DROID Incredible" phone was released for sale to the general public in or around April 2010, and it has been sold ever since. The DROID Incredible

is a mobile device that operates on the Android Platform and has wireless service provided by Verizon.

75. The LG-manufactured "Ally" phone was released for sale to the general public in or around May 2010, and it has been sold ever since. The Ally is a mobile device that operates on the Android Platform and has wireless service provided by Verizon.

76. The Motorola-manufactured "Backflip" phone was released for sale to the general public in or around March 2010, and it has been sold ever since. The Backflip is a mobile device that operates on the Android Platform and has wireless service provided by AT&T.

77. The HTC-manufactured "Aria" phone was released for sale to the general public in or around June 2010, and it has been sold ever since. The Aria is a mobile device that operates on the Android Platform and has wireless service provided by AT&T.

78. The HTC and Google-manufactured "Nexus One" phone was released for sale to the general public in or around January 2010, and it has been sold ever since. The Nexus One is a mobile device that operates on the Android Platform and has wireless service provided by various carriers.

79. T-Mobile has infringed Plaintiffs' marks by, among other things, marketing and selling mobile phones and related services that use Google's Android software platform, and by using the mark "Android" on or in connection with such products, services and marketing materials. For example, T-Mobile's webpage uses the mark "Android" in connection with each and every Android mobile device offered by T-Mobile for use with its wireless services. Google has induced T-Mobile to engage in such infringing conduct and, despite knowing that T-Mobile was engaging in such infringing conduct, Google has continued to supply the goods, services and/or resources necessary to support such infringing conduct by T-Mobile.

80. Sprint has infringed Plaintiffs' marks by, among other things, marketing and selling mobile phones and related services that use the Google Android software platform, and by using the mark "Android" on or in connection with such products, services and marketing materials. For example, Sprint's webpage uses the mark "Android" in connection with each and every Android mobile device offered by Sprint for use with its wireless services. Google has induced Sprint to engage in such infringing conduct and, despite knowing that Sprint was engaging in such infringing conduct, Google has continued to supply the goods, services and/or resources necessary to support such infringing conduct by Sprint.

81. Verizon has infringed Plaintiffs' marks by, among other things, marketing and selling mobile phones and related services that use the Google Android software platform, and by using the mark "Android" on or in connection with such products, services and marketing materials. For example, Verizon's webpage uses the mark "Android" in connection with each and every Android mobile device offered by Verizon for use with its wireless services. Google has induced Verizon to engage in such infringing conduct and, despite knowing that Verizon was engaging in such infringing conduct, Google has continued to supply the goods, services and/or resources necessary to support such infringing conduct by Verizon.

82. AT&T has infringed Plaintiffs' marks by, among other things, marketing and selling mobile phones and related services that use the Google Android software platform, and by using the mark "Android" on or in connection with such products, services and marketing materials. For example, AT&T's webpage uses the mark "Android" in connection with each and every Android mobile device offered by AT&T for use with its wireless services. Google has induced AT&T to engage in such infringing conduct and, despite knowing that AT&T was

engaging in such infringing conduct, Google has continued to supply the goods, services and/or resources necessary to support such infringing conduct by AT&T.

83. Motorola has infringed Plaintiffs' marks by, among other things, marketing and selling mobile phones and related services that use the Google Android software platform, and by using the mark "Android" on or in connection with such products, services and marketing materials. Google has induced Motorola to engage in such infringing conduct and, despite knowing that Motorola was engaging in such infringing conduct, Google has continued to supply the goods, services and/or resources necessary to support such infringing conduct by Motorola.

84. HTC has infringed Plaintiffs' marks by, among other things, marketing and selling mobile phones and related services that use the Google Android software platform, and by using the mark "Android" on or in connection with such products, services and marketing materials. Google has induced HTC to engage in such infringing conduct and, despite knowing that HTC was engaging in such infringing conduct, Google has continued to supply the goods, services and/or resources necessary to support such infringing conduct by HTC.

85. LG has infringed Plaintiffs' marks by, among other things, marketing and selling mobile phones and related services that use the Google Android software platform, and by using the mark "Android" on or in connection with such products, services and marketing materials. Google has induced LG to engage in such infringing conduct and, despite knowing that LG was engaging in such infringing conduct, Google has continued to supply the goods, services and/or resources necessary to support such infringing conduct by LG.

86. Samsung has infringed Plaintiffs' marks by, among other things, marketing and selling mobile phones and related services that use the Google Android software platform, and by using the mark "Android" on or in connection with such products, services and marketing

materials. Google has induced Samsung to engage in such infringing conduct and, despite knowing that Samsung was engaging in such infringing conduct, Google has continued to supply the goods, services and/or resources necessary to support such infringing conduct by Samsung.

87. On April 29, 2009, Plaintiffs received a Notice Of Acceptance Of § 8 Declaration informing them that Registration No. 2,639,556 remains in force. A copy of the notice is attached hereto as Exhibit K.

88. At no time prior to Plaintiffs' filing this infringement action did any of the Defendants seek to have Plaintiffs' Registration No. 2,639,556 canceled.

89. None of the Defendants has ever asked Plaintiffs whether they intended to continue using the Android Data mark or any other Android Marks.

90. None of the Defendants has ever requested or received Plaintiffs' permission to use the mark "Android."

91. Fully aware of Plaintiffs' rights to the Android Marks, Defendants Google, T-Mobile, Sprint, Verizon and AT&T have intentionally, openly, notoriously, and without Plaintiffs' authority used the infringing mark "Android" in commerce, including in connection with the sale and marketing of the mobile devices, as described herein.

92. Google, and all other Defendants with Google's encouragement and assistance, are continuing to use the mark "Android" on products and in advertising, promotional materials and press releases without disclosing ADI's ownership of the Android Marks and without Plaintiffs' permission.

93. Defendants' use of the mark "Android" on their products, and in their product promotion and advertising in print and on the internet, as described herein, constitutes the use in

commerce of a colorable imitation, copy and reproduction of one or more of Plaintiffs' Android Marks.

94. For the reasons set forth above, Defendants' uses of the mark "Android" were and are deceptive, confusingly similar to the Android Marks and likely to cause confusion, mistake, or deception in the minds of the public as to the source of Plaintiffs' and/or Defendants' goods and services.

95. Despite that ADI had Android Data registered on the PTO Principal Register, and without authorization from ADI or any other Plaintiff, each of the Defendants has in the past and is continuing to advertise, manufacture, distribute, sell, offer to sell an ever increasing line of products and services bearing the infringing mark "Android."

96. This is a reverse confusion case where Defendants are saturating the market with infringing products and services which will undoubtedly lead to deception, confusion and mistake among the consuming public and trade creating the erroneous impression that the goods and/or services offered by Plaintiffs come from the same origin, or are some type of knockoff of goods and/or services offered or sold by Defendants and other members of the OHA.

97. These actions and deception by Defendants have and will continue to deprive ADI and the other Plaintiffs of the ability to control the nature and quality of the products and services they offer, the ability to license any of the Android Marks; and the ability to enter into new and emerging markets under the Android Data mark or other Android Marks, causing irreparable harm to ADI and the other Plaintiffs for which there is no adequate remedy at law.

98. Defendants' infringement constitutes a willful and malicious violation of Plaintiffs' trademark rights.

99. Upon learning of the infringing conduct alleged herein, Plaintiffs have moved as expeditiously as possible to protect the Android Marks.

COUNT I

**Trademark Infringement Under Lanham Act § 3231
(By ADI Against Google)**

100. The allegations of paragraphs 1 through 99 above are incorporated herein by reference as and for paragraph 100 of this Count I.

101. As determined by the PTO, Google's proposed mark "Android" is identical to the dominant portion of the Plaintiffs' registered mark "Android Data" in sound, appearance, and commercial impression.

102. Android Data and the other Android Marks are distinctive, protectable marks.

103. The contemporaneous use by Plaintiffs and Google of the mark "Android" in commerce is likely to cause confusion among the consuming public concerning the source of any goods or services identified therewith.

104. The PTO refused Google's application to register the mark "Android" for computer hardware and software "because of a likelihood of confusion with the mark in U.S. Registration No. 2639556."

105. Both Google's mark "Android" and Plaintiffs' Android Marks may be used to identify computer hardware, software and related products and services. The hardware and software products and services may be used in e-commerce and marketed by all parties in commercial settings and over the internet.

106. To enable use of Google's Android Platform and applications that run on the platform subscribers will need to have a "data plan" with their carrier.

107. It has been estimated that Google's search engine accounts for approximately 75% of all computer internet searches; Google controls how information is ranked and disseminated through its search engine.

108. Plaintiffs have expended considerable resources marketing, advertising and promoting goods and services under the Android Data mark and other Android Marks.

109. Google, as successor in interest to Android, Inc.'s intellectual property assets, rights and liabilities, is liable for Android, Inc.'s infringing conduct that occurred as a result of Android, Inc.'s use in commerce of the mark "Android" relating to the Android software platform.

110. By reason of the foregoing acts, Google is liable to ADI for trademark infringement under 15 U.S.C. § 1114.

COUNT II

Unfair Competition Under Lanham Act § 4334 (By Plaintiffs Against Google)

111. The allegations of paragraphs 1 through 99 above are incorporated herein by reference as and for paragraph 111 of this Count II.

112. The use of the mark "Android" by Google as alleged herein to promote, market, or sell products or services constitutes unfair competition in violation of 15 U.S.C. § 1125(a). Google's use of the mark "Android" is likely to cause confusion, mistake, and deception among consumers. Google's unfair competition has caused, and will continue to cause, damage to Plaintiffs and is causing irreparable harm to Plaintiffs for which there is no adequate remedy at law.

COUNT III

**Violation of Illinois Deceptive Trade Practices Act, 815 ILCS 510/2
(By Plaintiffs Against Google)**

113. The allegations of paragraphs 1 through 99 above are incorporated herein by reference as and for paragraph 113 of this Count III.

114. The use of the mark “Android” by Google as alleged herein to promote, market, or sell products or services constitutes deceptive practices in violation of 815 ILCS 510/2. Google’s use of the mark “Android” in the course of its business or occupation is likely to cause confusion or misunderstanding as to affiliation, connection, or association with Plaintiffs’ Android Data mark or other Android Marks. Google’s deceptive practices have caused, and will continue to cause, damage to the Plaintiffs and are causing Plaintiffs irreparable harm for which there is no adequate remedy at law.

COUNT IV

**Common Law Trademark Infringement
(By Plaintiffs Against Google)**

115. The allegations of paragraphs 1 through 99 above are incorporated herein by reference as and for paragraph 115 of this Count IV.

116. The Android Marks are distinctive, protectable marks.

117. Plaintiffs are entitled to protect the Android Marks against Google’s infringing activities alleged herein because Plaintiffs’ use in commerce of the Android Marks preceded Google’s use in commerce of the mark “Android.”

118. Google’s use of the mark “Android” as alleged herein to promote, market and sell products or services infringes Plaintiffs’ rights under common law because Google’s use of the mark “Android” caused, and is likely to cause, confusion among consumers as to affiliation,

connection or association with the Android Marks. Google's infringing conduct has caused, and will continue to cause, damage to Plaintiffs and is causing Plaintiffs irreparable harm for which there is no adequate remedy at law.

COUNT V

**Contributory Infringement
(By Plaintiffs Against Google)**

119. The allegations of paragraphs 1 through 99 above are incorporated herein by reference as and for paragraph 119 of this Count V.

120. Google has provided T-Mobile, Sprint, Verizon, AT&T, Motorola, HTC, LG, Samsung and other OHA members with goods or services necessary to the commission of the violations described herein, with the intent that the recipient of the goods or services would put the goods or services to use in committing the violations. Among other things, Google intentionally induced T-Mobile, Sprint, Verizon, AT&T, Motorola, HTC, LG, Samsung and other OHA members to infringe Plaintiffs' Android Data mark and/or the other Android marks by: encouraging and supporting their sales and marketing efforts relating to "Android" based products; and continuing to supply them with Android products and resources despite knowing that they were engaging in infringing activities.

121. By reason thereof, Google is contributorily responsible for the harm that has resulted to Plaintiffs from the infringing activities of T-Mobile, Sprint, Verizon, AT&T, Motorola, HTC, LG, Samsung and other OHA members.

COUNT VI

**Trademark Infringement Under Lanham Act § 3231
(By ADI Against The Carrier Defendants)**

122. The allegations of paragraphs 1 through 99 above are incorporated herein by reference as and for paragraph 122 of this Count VI.

123. As determined by the PTO, Google's proposed mark "Android" is identical to the dominant portion of the Plaintiffs' registered mark "Android Data" in sound, appearance, and commercial impression.

124. Android Data and the other Android Marks are distinctive, protectable marks.

125. The contemporaneous use by Plaintiffs and each of the Carrier Defendants of the mark "Android" in commerce is likely to cause confusion among the consuming public concerning the source of any goods or services identified therewith.

126. The PTO refused Google's application to register the mark "Android" for computer hardware and software "because of a likelihood of confusion with the mark in U.S. Registration No. 2639556."

127. Both Google's mark "Android" as used by the Carrier Defendants and Plaintiffs' Android Marks may be used to identify computer hardware, software and related products and services. The hardware and software products and services may be used in e-commerce and marketed by all parties in commercial settings and over the internet.

128. Plaintiffs have expended considerable resources marketing, advertising and promoting goods and services under the Android Data mark and other Android Marks.

129. By reason of the foregoing acts, each and every one of the Carrier Defendants is liable to ADI for trademark infringement under 15 U.S.C. § 1114.

COUNT VII

**Unfair Competition Under Lanham Act § 4334
(By Plaintiffs Against The Carrier Defendants)**

130. The allegations of paragraphs 1 through 99 above are incorporated herein by reference as and for paragraph 130 of this Count VII.

131. The use of the mark “Android” by each and every one of the Carrier Defendants as alleged herein to promote, market, or sell products or services constitutes unfair competition in violation of 15 U.S.C. § 1125(a). The Carrier Defendants’ use of the mark “Android” is likely to cause confusion, mistake, and deception among consumers. The Carrier Defendants’ unfair competition has caused, and will continue to cause, damage to Plaintiffs and is causing irreparable harm to Plaintiffs for which there is no adequate remedy at law.

COUNT VIII

**Violation of Illinois Deceptive Trade Practices Act, 815 ILCS 510/2
(By Plaintiffs Against The Carrier Defendants)**

132. The allegations of paragraphs 1 through 99 above are incorporated herein by reference as and for paragraph 132 of this Count VIII.

133. The use of the mark “Android” by each and every one of the Carrier Defendants as alleged herein to promote, market, or sell products or services constitutes deceptive practices in violation of 815 ILCS 510/2. The Carrier Defendants’ use of the mark “Android” in the course of their business or occupation is likely to cause confusion or misunderstanding as to affiliation, connection, or association with Plaintiffs’ Android Data mark or other Android Marks. The Carrier Defendants’ deceptive practices have caused, and will continue to cause, damage to the Plaintiffs and are causing Plaintiffs irreparable harm for which there is no adequate remedy at law.

COUNT IX

**Common Law Trademark Infringement
(By Plaintiffs Against The Carrier Defendants)**

134. The allegations of paragraphs 1 through 99 above are incorporated herein by reference as and for paragraph 134 of this Count IX.

135. The Android Marks are distinctive, protectable marks.

136. Plaintiffs are entitled to protect the Android Marks against the Carrier Defendants' infringing activities alleged herein because Plaintiffs' use in commerce of the Android Marks preceded each of the Carrier Defendants' uses in commerce of the mark "Android."

137. The Carrier Defendants' use of the mark "Android" as alleged herein to promote, market and sell products or services infringes Plaintiffs' rights under common law because the Carrier Defendants' use of the mark "Android" caused, and is likely to cause, confusion among consumers as to affiliation, connection or association with the Android Marks. The Carrier Defendants' infringing conduct has caused, and will continue to cause, damage to Plaintiffs and is causing Plaintiffs irreparable harm for which there is adequate remedy at law.

* * *

WHEREFORE, Plaintiffs respectfully request that judgment be entered in their favor and against Defendants as follows:

A. Ordering that each and every one of the Defendants be permanently enjoined from:

- (i) using the mark "Android" or any trademark that imitates or is confusingly similar to Plaintiffs' Android Data mark or other Android Marks; and (ii) supplying OHA members or others with products, services or other resources sufficient to enable infringing activities, or otherwise inducing such infringing activities;

B. Ordering each and every one of the Defendants to file with the Court and serve on Plaintiffs within thirty (30) days after entry of any injunction herein, a report in writing under oath setting forth in detail the manner and form in which it has complied with the Court's injunction order;

C. Ordering each and every one of the Defendants to account to Plaintiffs for any and all revenues and profits derived from its infringing conduct complained of herein;

D. Ordering each and every one of the Defendants to deliver to Plaintiffs, or destroy, all articles bearing the infringing "Android" mark;

E. Awarding Plaintiffs compensatory damages, including reasonable license fees, in an amount to be determined at trial;

F. Awarding Plaintiffs treble damages;

G. Awarding Plaintiffs punitive damages;

H. Ordering disgorgement of Defendants' profits earned as a result of the infringing conduct;

I. Awarding Plaintiffs their costs of suit and attorneys' fees; and

J. Granting such further relief as the Court deems just.

**PLAINTIFFS DEMAND TRIAL BY JURY
ON ALL ISSUES TRIABLE TO A JURY**

Respectfully submitted,

ERICH SPECHT, individually and doing business
as ANDROID DATA CORPORATION, and THE
ANDROID'S DUNGEON INCORPORATED

By: /s/ John F. Shonkwiler
One of Their Attorneys

P. Andrew Fleming
John F. Shonkwiler
~~John B. Haarlow, Jr.~~
NOVACK AND MACEY LLP
100 North Riverside Plaza
Chicago, IL 60606
(312) 419-6900
Doc. #370687

Martin Murphy
2811 RFD
Long Grove, IL 60047
(312) 933-3200

CERTIFICATE OF SERVICE

John F. Shonkwiler, an attorney, certifies that he caused copies of the foregoing Third Amended Complaint to be served by electronically filing the document with the Clerk of Court using the ECF system this 13th day of July, 2010.

/s/ John F. Shonkwiler

EXHIBIT A

Drawing Page

Serial Number:

78011167

Applicant:

Android Data Corporation
114 North Ashland Avenue
Palatine IL USA 60067



Date of First Use:

01/01/1999

Date of First Use in Commerce:

01/01/1999

Goods and Services:

Computer software and internet services.

Mark:

ANDROID DATA



NO OCR



06-04-2000

Internet Transmission Date:

2000/06/04

Serial Number:

78011167

Filing Date:

2000/06/04



TRADEMARK APPLICATION

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE
FEE RECORD SHEET

TOTAL FEES PAID: \$325

RAM SALE NUMBER: 132
RAM ACCOUNTING DATE: 20000605



NO OCR



06-04-2000

eTeas Trademark/Service Mark Application

78011167

<SERIAL NUMBER> 78011167
<FILING DATE> 06/04/2000

<DOCUMENT INFORMATION>
<TRADEMARK/SERVICEMARK APPLICATION>
<VERSION 1.2>

<APPLICANT INFORMATION>
<NAME> Android Data Corporation
<STREET> 114 North Ashland Avenue
<CITY> Palatine
<STATE> IL
<COUNTRY> USA
<ZIP/POSTAL CODE> 60067
<TELEPHONE NUMBER> 847-991-3307
<FAX NUMBER> 847-991-3394
<E-MAIL ADDRESS> erich@androiddata.com

<APPLICANT ENTITY INFORMATION>
<CORPORATION: STATE/COUNTRY OF INCORPORATION> Illinois

<TRADEMARK/SERVICEMARK INFORMATION>
<MARK> Android Data
<TYPED FORM> Yes
* 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. §1051 et seq., as amended). *

<BASIS FOR FILING AND GOODS/SERVICES INFORMATION>
<USE IN COMMERCE: SECTION 1(a)> Yes
* Applicant is using or is using through a related company the mark in commerce on or in connection with the below-identified goods/services. (15 U.S.C. §1051(a), as amended.). Applicant attaches one SPECIMEN for each class showing the mark as used in commerce on or in connection with any item in the class of listed goods and/or services. *
<SPECIMEN> Yes
<SPECIMEN DESCRIPTION> Portion of brochure describing Android Data's services which has been distributed to potential customers.
<INTERNATIONAL CLASS NUMBER> 038
<LISTING OF GOODS AND/OR SERVICES> Computer software and internet services.
<FIRST USE ANYWHERE DATE> 01/01/1999
<FIRST USE IN COMMERCE DATE> 01/01/1999

<FEE INFORMATION>
<TOTAL FEES PAID> 325
<NUMBER OF CLASSES> 1

78011167

06/07/2000 2:15 PM

eTeas Trademark/Service Mark Application

78011167

<SIGNATURE AND OTHER INFORMATION>

* PTO-Application Declaration: 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. §1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application 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 application is being filed under 15 U.S.C. §1051(b), 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. *

<SIGNATURE> /Erich Specht/
<DATE> 06/04/2000
<NAME> Erich Specht
<TITLE> President

<MAILING ADDRESS>

<LINE> Android Data Corporation
<LINE> 114 North Ashland Avenue
<LINE> Palatine IL 60067

<CREDIT CARD INFORMATION>

<RAM SALE NUMBER> 132
<RAM ACCOUNTING DATE> 20000605

<SERIAL NUMBER INFORMATION>

<SERIAL NUMBER> 78/011167
<INTERNET TRANSMISSION DATE> Sunday, 06-04-2000 22:52:05 EDT
<TEAS STAMP>
USPTO-24131183202-20000604225223469-78/011167-
1217469046de932bed0c55975e80f5f0369-CC-132-20000604224923469
469

78011167

ORIGINAL SPECIMEN

Internet Transmission Date:

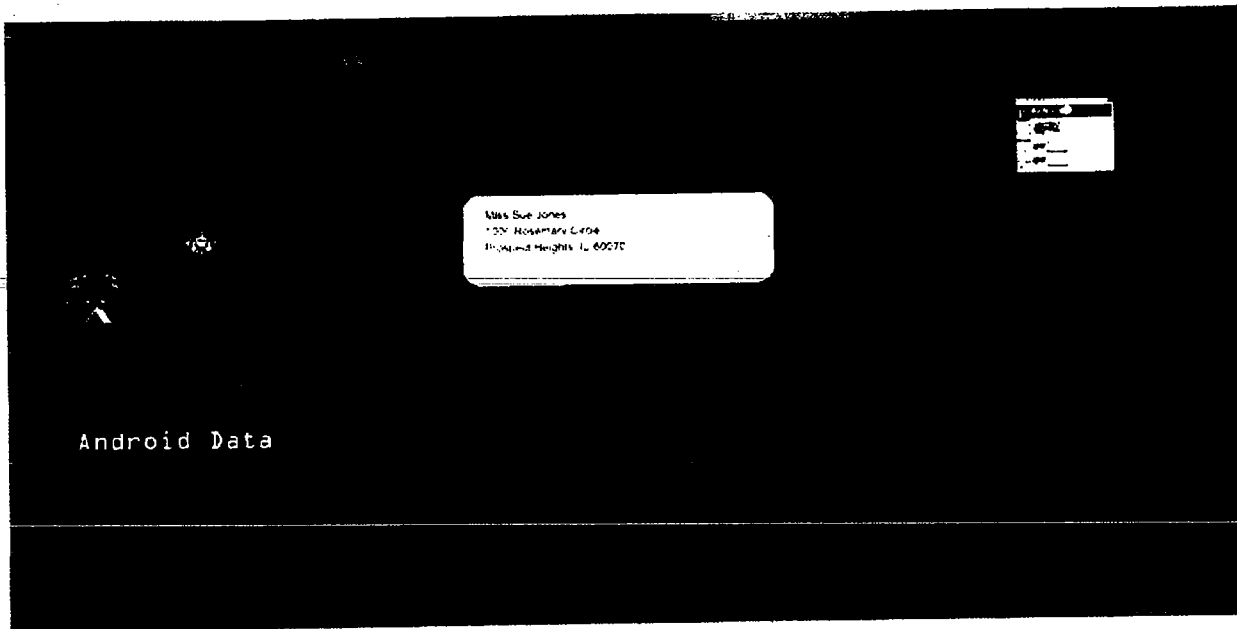
2000/06/04

Serial Number:

78011167

Filing Date:

2000/06/04



The applicant has submitted required color specimen.
The USPTO has printed only one copy of the specimen,
and extra copies can be produced in-house as needed.

EXHIBIT B

Int. Cl.: 9

Prior U.S. Cls.: 21, 23, 26, 36 and 38

United States Patent and Trademark Office

Reg. No. 2,639,556

Registered Oct. 22, 2002

**TRADEMARK
PRINCIPAL REGISTER**

ANDROID DATA

**ANDROID DATA CORPORATION (ILLINOIS
CORPORATION)
114 NORTH ASHLAND AVENUE
PALATINE, IL 60067**

FIRST USE 1-1-1999; IN COMMERCE 1-1-1999.

**NO CLAIM IS MADE TO THE EXCLUSIVE
RIGHT TO USE "DATA", APART FROM THE
MARK AS SHOWN.**

**FOR: COMPUTER E-COMMERCE SOFTWARE
TO ALLOW USERS TO PERFORM ELECTRONIC
BUSINESS TRANSACTIONS VIA A GLOBAL COM-
PUTER NETWORK, IN CLASS 9 (U.S. CLS. 21, 23, 26,
36 AND 38).**

SER. NO. 78-011,167, FILED 6-4-2000.

FLORENTINA BLANDU, EXAMINING ATTORNEY

EXHIBIT C

PTO Form 1473 (Rev. 3/2004)
OMB No. 0551-0700 (EAB) (2-2152-105)

Trademark/Service Mark Application, Principal Register

Serial Number: 77318565

Filing Date: 10/31/2007

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77318565
MARK INFORMATION	
*MARK	ANDROID
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	ANDROID
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font, style, size, or color.
REGISTER	Principal
APPLICANT INFORMATION	
*OWNER OF MARK	Google Inc.
*STREET	1600 Amphitheatre Parkway
*CITY	Mountain View
*STATE (Required for U.S. applicants)	California
*COUNTRY	United States
*ZIP/POSTAL CODE (Required for U.S. applicants only)	94043
PHONE	650-253-0000
FAX	650-618-8571
LEGAL ENTITY INFORMATION	
TYPE	corporation

STATE/COUNTRY OF INCORPORATION	Delaware
GOODS AND/OR SERVICES AND BASIS INFORMATION	
*INTERNATIONAL CLASS	009
*IDENTIFICATION	hardware; software
FILING BASIS	SECTION 1(b)
CORRESPONDENCE INFORMATION	
NAME	Google Inc.
FIRM NAME	Google Inc.
STREET	1600 Amphitheatre Parkway
CITY	Mountain View
STATE	California
COUNTRY	United States
ZIP/POSTAL CODE	94043
PHONE	650-253-0000
FAX	650-618-8571
EMAIL ADDRESS	trademarks@google.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
FEE INFORMATION	
NUMBER OF CLASSES	1
FEE PER CLASS	325
*TOTAL FEE DUE	325
*TOTAL FEE PAID	325
SIGNATURE INFORMATION	
SIGNATURE	/Terri Y. Chen/
SIGNATORY'S NAME	Terri Y. Chen
SIGNATORY'S POSITION	Trademark Counsel
DATE SIGNED	10/31/2007

PTO Form 470 (Rev. 02/2000)
USPTO Form 470 (Rev. 12/2000)

Trademark/Service Mark Application, Principal Register

Serial Number: 77318565

Filing Date: 10/31/2007

To the Commissioner for Trademarks:

MARK: ANDROID (Standard Characters, see mark)

The literal element of the mark consists of ANDROID.

The mark consists of standard characters, without claim to any particular font, style, size, or color.

The applicant, Google Inc., a corporation of Delaware, having an address of
1600 Amphitheatre Parkway
Mountain View, California 94043
United States

requests registration of the trademark/service mark identified above 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.

International Class 009: hardware; software

Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services. (15 U.S.C. Section 1051(b)).

Correspondence Information: Google Inc.

1600 Amphitheatre Parkway
Mountain View, California 94043
650-253-0000(phone)
650-618-8571(fax)
trademarks@google.com (authorized)

A fee payment in the amount of \$325 has been submitted with the application, representing payment for 1 class(es).

Declaration

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, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application 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 application is being filed under 15 U.S.C. Section 1051(b), 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.

Signature: /Terri Y. Chen/ Date Signed: 10/31/2007

Signatory's Name: Terri Y. Chen

Signatory's Position: Trademark Counsel

RAM Sale Number: 5859

RAM Accounting Date: 11/01/2007

Serial Number: 77318565

Internet Transmission Date: Wed Oct 31 19:55:30 EDT 2007

TEAS Stamp: USPTO/BAS-67.188.142.108-200710311955304

68224-77318565-4006f0298ba1af20267ecb8fc

c72b4ebe-DA-5859-20071031193745890740

ANDROID

EXHIBIT D

To: Google Inc. (trademarks@google.com)
Subject: TRADEMARK APPLICATION NO. 77318565 - ANDROID - N/A
Sent: 2/14/2008 10:04:35 AM
Sent As: ECOM103@USPTO.GOV
Attachments: Attachment - 1
Attachment - 2

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/318565

MARK: ANDROID

77318565

CORRESPONDENT ADDRESS:

GOOGLE INC.
GOOGLE INC.
1600 AMPHITHEATRE PKWY
MOUNTAIN VIEW, CA 94043-1351

RESPOND TO THIS ACTION:

<http://www.uspto.gov/teas/eTEASpageD.htm>

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

APPLICANT: Google Inc.

CORRESPONDENT'S REFERENCE/DOCKET

NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

trademarks@google.com

OFFICE ACTION

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

ISSUE/MAILING DATE: 2/14/2008

The assigned trademark examining attorney has reviewed the referenced application and has determined the following:

Refusal: Section 2(d) - Likelihood of Confusion Refusal

Registration of the proposed mark is refused because of a likelihood of confusion with the mark in U.S.

Registration No. 2639556. Trademark Act Section 2(d), 15 U.S.C. §1052(d); TMEP §§1207.01 *et seq.* See the enclosed registration.

Taking into account the relevant *du Pont* factors, a likelihood of confusion determination in this case involves a two-part analysis. First, the marks are compared for similarities in appearance, sound, connotation and commercial impression. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Second, the goods or services are compared to determine whether they are similar or related or whether the activities surrounding their marketing are such that confusion as to origin is likely. *In re National Novice Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984); *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re Int'l Tel. and Tel. Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Prods. Co. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); TMEP §§1207.01 *et seq.*

In the case at hand, the applicant seeks registration of ANDROID in standard character form for "hardware; software." The cited registered mark is ANDROID DATA in typed form for "computer e-commerce software to allow users to perform electronic business transactions via a global computer network."

Regarding the first prong of the test, disclaimed matter is typically less significant or less dominant when comparing marks. Although a disclaimed portion of a mark certainly cannot be ignored, and the marks must be compared in their entireties, one feature of a mark may be more significant in creating a commercial impression. *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); *In re National Data Corporation*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); and *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553 (TTAB 1987). See also *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ 2d 1001 (Fed. Cir. 2002); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (C.C.P.A. 1976); *In re El Torito Rests. Inc.*, 9 USPQ2d 2002 (TTAB 1988); *In re Equitable Bancorporation*, 229 USPQ 709 (TTAB 1986). The registrant has disclaimed the descriptive wording DATA apart from the mark as shown. Therefore, the examining attorney must closely examine the dominant portion of the registered mark against the applicant's mark.

The dominant portion of the registrant's mark is the term ANDROID, which is identical in sound, appearance, and commercial impression to the cited registered mark. Marks may be confusingly similar in appearance where there are similar terms or phrases or similar parts of terms or phrases appearing in both applicant's and registrant's mark. See e.g., *Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689 (TTAB 1986), *aff'd* 1 USPQ2d 1813 (Fed. Cir. 1987) (COMMCASH and COMMUNICASH); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (21 CLUB and "21" CLUB (stylized)); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re Collegian Sportswear Inc.*, 224 USPQ 174 (TTAB 1984) (COLLEGIAN OF CALIFORNIA and COLLEGIENNE); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983) (MILTRON and MILLTRONICS); *In re BASF A.G.*, 189 USPQ 424 (TTAB 1975) (LUTEXAL and LUTEX); TMEP §§1207.01(b)(ii) and (b)(iii).

Regarding the issue of likelihood of confusion, the question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 175 USPQ 558 (C.C.P.A. 1972). For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. *Recot, Inc. v. M.C. Becton*, 214 F.2d 1322, 54 USPQ2d 1894, 1890 (Fed. Cir. 2000); *Visual Information Inst., Inc. v.*

Vicon Indus. Inc., 209 USPQ 179 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975); TMEP §1207.01(b). Considering the above, the marks are sufficiently similar to cause a likelihood of confusion under Trademark Act Section 2(d).

Turning to the second prong of the test, the goods of the parties need not be identical or directly competitive to find a likelihood of confusion. Instead, they need only be related in some manner, or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods come from a common source. *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Prods. Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re Int'l Tel. & Tel. Corp.*, 197 USPQ 910 (TTAB 1978); TMEP §1207.01(a)(i).

Both the applicant and the registrant are providing software. The registrant has more narrowly stated its goods as "computer e-commerce software to allow users to perform electronic business transactions via a global computer network." Likelihood of confusion is determined on the basis of the goods or services as they are identified in the application and the registration. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993); *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990). Since the identification of the applicant's goods is very broad, it is presumed that the application encompasses all goods and/or services of the type described, including those in the registrant's more specific identification, that they move in all normal channels of trade and that they are available to all potential customers. TMEP §1207.01(a)(iii).

Therefore, with the contemporaneous use of highly similar marks that share the dominant term ANDROID, consumers are likely to conclude that the goods are related and originate from a single source. As such, registration must be refused under Trademark Act Section 2(d).

Any doubt regarding a likelihood of confusion is resolved in favor of the prior registrant. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); TMEP §§1207.01(d)(i).

Although the trademark examining attorney has refused registration, applicant may respond to the refusal to register by submitting evidence and arguments in support of registration. If applicant chooses to respond to the refusal to register, then applicant must also respond to the following requirements.

Requirement: Identification of Goods

The identification of goods is indefinite and must be clarified because it is too broad. Applicant may adopt the following identification, if accurate:

International Class 009: Computer hardware; Computer software for {specify the function of the programs, e.g., use in database management, use as a spreadsheet, word processing, etc. and, if software is content- or field-specific, the content or field of use}.

TMEP §1402.01.

Please note that, while the identification of goods may be amended to clarify or limit the goods, adding to the goods or broadening the scope of the goods is not permitted. 37 C.F.R. §2.71(a); TMEP §1402.06. Therefore, applicant may not amend the identification to include goods that are not within the scope of the goods set forth in the present identification.

For assistance with identifying and classifying goods and/or services in trademark applications, please see the online searchable *Manual of Acceptable Identifications of Goods and Services* at <http://tess2.uspto.gov/netahtml/tidm.html>.

Requirement: Significance of Mark

Applicant must specify whether "ANDROID" has any significance in the computer hardware and software trade or industry, any geographical significance, or any meaning in a foreign language. 37 C.F.R. §2.61(b).

Response Guidelines

Applicant should include the following information on all correspondence with the Office: (1) the name and law office number of the trademark examining attorney; (2) the serial number of this application; (3) the mailing date of this Office action; and, (4) applicant's telephone number. 37 C.F.R. §2.194(b)(1); TMEP §302.03(a).

To expedite prosecution of this application, applicant is encouraged to file its response to this Office action through the Trademark Electronic Application System (TEAS), available at <http://www.uspto.gov/teas/index.html>.

If applicant has questions about its application or needs assistance in responding to this Office action, please telephone the assigned trademark examining attorney directly at the number below.

/Seth A. Rappaport/
Seth A. Rappaport
Trademark Examining Attorney
Law Office 103
Phone: (571) 270-1508
Fax: (571) 270-2508

RESPOND TO THIS ACTION: If there are any questions about the Office action, please contact the assigned examining attorney. A response to this Office action should be filed using the form available at <http://www.uspto.gov/teas/eTEASpageD.htm>. If notification of this Office action was received via e-mail, no response using this form may be filed for 72 hours after receipt of the notification. **Do not attempt to respond by e-mail as the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

STATUS CHECK: Check the status of the application at least once every six months from the initial

filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

Print: Feb 14, 2008

78011167

DESIGN MARK

Serial Number

78011167

Status

REGISTERED

Word Mark

ANDROID DATA

Standard Character Mark

No

Registration Number

2639556

Date Registered

2002/10/22

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(1) TYPED DRAWING

Owner

Android Data Corporation CORPORATION ILLINOIS 114 North Ashland Avenue
Palatine ILLINOIS 60067

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S:
Computer e-commerce software to allow users to perform electronic
business transactions via a global computer network. First Use:
1999/01/01. First Use In Commerce: 1999/01/01.

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "DATA" APART FROM THE
MARK AS SHOWN.

Filing Date

2000/06/04

Examining Attorney

BLANDU, FLORENTINA

ANDROID DATA

To: Google Inc. (trademarks@google.com)
Subject: TRADEMARK APPLICATION NO. 77318565 - ANDROID - N/A
Sent: 2/14/2008 10:04:37 AM
Sent As: ECOM103@USPTO.GOV
Attachments:

IMPORTANT NOTICE
USPTO OFFICE ACTION HAS ISSUED ON 2/14/2008 FOR
APPLICATION SERIAL NO. 77318565

Please follow the instructions below to continue the prosecution of your application:

VIEW OFFICE ACTION: Click on this link
http://tmpportal.uspto.gov/external/portal/tow?DDA=Y&serial_number=77318565&doc_type=OOA&
(or copy and paste this URL into the address field of your browser), or visit
<http://tmpportal.uspto.gov/external/portal/tow> and enter the application serial number to access the Office action.

PLEASE NOTE: The Office action may not be immediately available but will be viewable within 24 hours of this notification.

RESPONSE MAY BE REQUIRED: You should carefully review the Office action to determine (1) if a response is required; (2) how to respond; and (3) the applicable response time period. Your response deadline will be calculated from 2/14/2008.

Do NOT hit "Reply" to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System response form at <http://www.uspto.gov/teas/eTEASpageD.htm>.

HELP: For *technical* assistance in accessing the Office action, please e-mail TDR@uspto.gov. Please contact the assigned examining attorney with questions about the Office action.

WARNING

- 1. The USPTO will NOT send a separate e-mail with the Office action attached.**
- 2. Failure to file any required response by the applicable deadline will result in the ABANDONMENT of your application.**

EXHIBIT E

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77318565
LAW OFFICE ASSIGNED	LAW OFFICE 103
MARK SECTION (no change)	
ARGUMENT(S)	
<p>The Examining Attorney refused registration of our ANDROID mark because of the concern that "contemporaneous use" of ANDROID and the cited registration, ANDROID DATA (Reg. No. 2639556) owned by Android Data Corporation, will result in a likelihood of confusion. However, there is no contemporaneous use of ANDROID and ANDROID DATA because ANDROID DATA is not in use and has not been in use for years. According to Archive.org, the last possible commercial use of ANDROID DATA on androiddata.com, the website of the registrant, was on March 10, 2005 (http://web.archive.org/web/20050310015150/http://www.androiddata.com/). Subsequent entries show the site as a parked page, with no commercial use of ANDROID DATA (see attached exhibits). Today, the androiddata.com domain still is a parked page, without any commercial use of ANDROID DATA, and the domain is, in fact, owned by someone else other than the registrant, Android Data Corporation (see attached exhibits). Web results find no evidence of other commercial use of ANDROID DATA. Furthermore, secretary of state records (see attached exhibits) show that the registrant, Android Data Corporation, was involuntarily dissolved on May 1, 2004, and no longer exists as an entity. Because there has been no commercial use of ANDROID DATA for over three years and the company has been dissolved for over four years, we must presume that the company has abandoned the ANDROID DATA mark per TMEP section 1604.11. The company no longer exists as a valid entity, so it cannot file an Affidavit of Use to maintain its registration. Thus, the registration is not valid, and should not be considered as a possible grounds for refusal of our registration of ANDROID. For this reason, we humbly request that the Examining Attorney withdraw this refusal.</p> <p>In addition to the 2(d) citation, the Examining Attorney has asked us that we amend the application. We have done so. He has also asked that we confirm that ANDROID has no significance in the computer hardware and software trade or industry, any geographical significance, or any meaning in a foreign language, and we do so. ANDROID is a arbitrary term we chose as a brand for our products.</p> <p>Because the conflicting registration is not an issue, and we have dealt with the other issues raised by the Examining Attorney in his office action, we ask that the Examining Attorney approve this application for registration.</p>	
EVIDENCE SECTION	

EVIDENCE FILE NAME(S)	\\TICRS\EXPORT3\IMAGEOUT3 \\773\185\77318565\xml1\RO A0002.JPG
	\\TICRS\EXPORT3\IMAGEOUT3 \\773\185\77318565\xml1\RO A0003.JPG
	\\TICRS\EXPORT3\IMAGEOUT3 \\773\185\77318565\xml1\RO A0004.JPG
DESCRIPTION OF EVIDENCE FILE	Current WHOIS data for androiddata.com, Archive.org results for androiddata.com, and an Illinois Secretary of State record showing the involuntary dissolution of Android Data Corporation.
GOODS AND/OR SERVICES SECTION (current)	
INTERNATIONAL CLASS	009
DESCRIPTION	hardware; software
FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (proposed)	
INTERNATIONAL CLASS	009
DESCRIPTION	mobile device hardware and peripherals; operating system software; software for use in developing, executing, and running other software on mobile devices, computers, computer networks, and global communication networks; computer software development tools; computer software for use in transmitting and receiving data over computer networks and global communication networks; computer software for managing communications and data exchange among and between mobile devices and desktop computers; computer middleware, namely, software that mediates between the operating system of a mobile device and the application software of a mobile device; computer application software for mobile devices
FILING BASIS	Section 1(b)
SIGNATURE SECTION	
DECLARATION SIGNATURE	/t/t/
SIGNATORY'S NAME	Tu T. Tsao
SIGNATORY'S POSITION	Trademark Counsel
DATE SIGNED	08/14/2008
RESPONSE SIGNATURE	/t/t/
SIGNATORY'S NAME	Tu T. Tsao
SIGNATORY'S POSITION	Trademark Counsel

DATE SIGNED	08/14/2008
AUTHORIZED SIGNATORY	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Thu Aug 14 20:43:08 EDT 2008
TEAS STAMP	USPTO/ROA-65.57.245.11-20 080814204308115561-773185 65-430526c8f39c42290315fa 55e1a18c95-N/A-N/A-200808 14190559097132

PTO Form 1057 (Rev. 03/2005)
 CSRS-00 0001-0000 (Exp. 04/2010)

Response to Office Action To the Commissioner for Trademarks:

Application serial no. 77318565 has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

The Examining Attorney refused registration of our ANDROID mark because of the concern that "contemporaneous use" of ANDROID and the cited registration, ANDROID DATA (Reg. No. 2639556) owned by Android Data Corporation, will result in a likelihood of confusion. However, there is no contemporaneous use of ANDROID and ANDROID DATA because ANDROID DATA is not in use and has not been in use for years. According to Archive.org, the last possible commercial use of ANDROID DATA on androiddata.com, the website of the registrant, was on March 10, 2005 (<http://web.archive.org/web/20050310015150/http://www.androiddata.com/>). Subsequent entries show the site as a parked page, with no commercial use of ANDROID DATA (see attached exhibits). Today, the androiddata.com domain still is a parked page, without any commercial use of ANDROID DATA, and the domain is, in fact, owned by someone else other than the registrant, Android Data Corporation (see attached exhibits). Web results find no evidence of other commercial use of ANDROID DATA. Furthermore, secretary of state records (see attached exhibits) show that the registrant, Android Data Corporation, was involuntarily dissolved on May 1, 2004, and no longer exists as an entity. Because there has been no commercial use of ANDROID DATA for over three years and the company has been dissolved for over four years, we must presume that the company has abandoned the ANDROID DATA mark per TMEP section 1604.11. The company no longer exists as a valid entity, so it cannot file an Affidavit of Use to maintain its registration. Thus, the registration is not valid, and should not be considered as a possible grounds for refusal of our registration of ANDROID. For this reason, we humbly request that the Examining Attorney withdraw this refusal.

In addition to the 2(d) citation, the Examining Attorney has asked us that we amend the application. We have done so. He has also asked that we confirm that ANDROID has no significance in the computer hardware and software trade or industry, any geographical significance, or any meaning in a foreign language, and we do so. ANDROID is a arbitrary term we chose as a brand for our products.

Because the conflicting registration is not an issue, and we have dealt with the other issues raised by the Examining Attorney in his office action, we ask that the Examining Attorney approve this application for registration.

EVIDENCE

Evidence in the nature of Current WHOIS data for androiddata.com, Archive.org results for androiddata.com, and an Illinois Secretary of State record showing the involuntary dissolution of Android Data Corporation. has been attached.

Evidence-1

Evidence-2

Evidence-3

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 009 for hardware; software

Original Filing Basis:

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Proposed: Class 009 for mobile device hardware and peripherals; operating system software; software for use in developing, executing, and running other software on mobile devices, computers, computer networks, and global communication networks; computer software development tools; computer software for use in transmitting and receiving data over computer networks and global communication networks; computer software for managing communications and data exchange among and between mobile devices and desktop computers; computer middleware, namely, software that mediates between the operating system of a mobile device and the application software of a mobile device; computer application software for mobile devices

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

SIGNATURE(S)

Declaration Signature

If the applicant is seeking registration under Section 1(b) and/or Section 44 of the Trademark Act, the applicant had a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. 37 C.F.R. Secs. 2.34(a)(2)(i); 2.34 (a)(3)(i); and 2.34(a)(4)(ii). If the applicant is seeking registration under Section 1(a) of the Trademark Act, the mark was in use in commerce on or in connection with the goods or services listed in the application as of the application filing date. 37 C.F.R. Secs. 2.34(a)(1)(i). 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. §1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application 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 application is being filed under 15 U.S.C. §1051(b), 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; that if the original application was submitted unsigned, that all statements in the original application and this submission made of the declaration signer's knowledge are true; and all statements in the original application and this submission made on information and belief are believed to be true.

Signature: /ttt/ Date: 08/14/2008

Signatory's Name: Tu T. Tsao

Signatory's Position: Trademark Counsel

Response Signature

Signature: /ttt/ Date: 08/14/2008

Signatory's Name: Tu T. Tsao

Signatory's Position: Trademark Counsel

The signatory has confirmed that he/she is not represented by either an authorized attorney or Canadian attorney/agent, and that he/she is either (1) the applicant or (2) a person(s) with legal authority to bind the applicant; and if an authorized U.S. attorney or Canadian attorney/agent previously represented him/her in this matter, either he/she has filed a signed revocation of power of attorney with the USPTO or the USPTO has granted the request of his/her prior representative to withdraw.

Serial Number: 77318565

Internet Transmission Date: Thu Aug 14 20:43:08 EDT 2008

TEAS Stamp: USPTO/ROA-65.57.245.11-20080814204308115

561-77318565-430526c8f39c42290315fa55e1a

18c95-N/A-N/A-20080814190559097132

[Querying whois.fabulous.com]

[whois.fabulous.com]

Domain androiddata.com:

819 Bocage Lane
Mandeville, Louisiana 70471 US

Administrative contact

Technical contact

Billing contact

Dana Daste
dcdaste@aol.com
819 Bocage Lane
Mandeville, Louisiana 70471 US
Phone: +1.9858458185
Fax:

Record dates:

Record created on: 2007-05-09 18:38:33 UTC

Record modified on: 2007-09-05 04:21:54 UTC

Record expires on: 2009-05-09 UTC

Nameservers:

ns2.dsredirection.com:

ns1.dsredirection.com:

Note: Automated collection of data from this database is strictly prohibited.

CYBERDRIVEILLINOISJESSE WHITE
SECRETARY OF STATE

SERVICES

PROGRAMS

PRESS

PUBLICATIONS

DEPARTMENTS

CONTACT

CORPORATION FILE DETAIL REPORT

Entity Name	ANDROID DATA CORPORATION	File Number	60277885
Status	DISSOLVED		
Entity Type	CORPORATION	Type of Corp	DOMESTIC BCA
Incorporation Date (Domestic)	12/30/1998	State	ILLINOIS
Agent Name	ERICH M SPECHT	Agent Change Date	12/30/1998
Agent Street Address	114 N ASHLAND AVE	President Name & Address	ERICH SPECHT 114 N ASHLAND AVE PALATINE 60067
Agent City	PALATINE	Secretary Name & Address	INVOLUNTARY DISSOLUTION 05 01 04
Agent Zip	60067	Duration Date	PERPETUAL
Annual Report Filing Date	00/00/0000	For Year	2003

[Return to the Search Screen](#)[BACK TO CYBERDRIVEILLINOIS.COM HOME PAGE](#)

INTERNET ARCHIVE
Wayback Machine

Enter Web Address:

All

Take Me Back

Get the Wayback Machine

Searched for <http://www.andcolddata.com>

58 Results

Some duplicated are not shown. See all
denotes when site was updated.
Material typically becomes available here 6 months after collection. See FAQ.

Search Results for Jan 01, 1996 - Feb 16, 2008

1996	1997	1998	1999	2000	2001	2002	2003	2004	2005	2006	2007	2008
0 pages	0 pages	0 pages	0 pages	0 pages	10 pages	15 pages	15 pages	13 pages	3 pages	1 pages	0 pages	0 pages
				Feb 02, 2001 *	Jan 15, 2002	Jan 15, 2002	Jan 23, 2003 *	Jan 02, 2004	Feb 07, 2005	Feb 26, 2005 *		
				Mar 05, 2001 *	Jan 19, 2002	Jan 19, 2002	Feb 14, 2003	Mar 21, 2004	Feb 13, 2005			
				Mar 26, 2001	Feb 16, 2002	Feb 16, 2002	Mar 31, 2003	Mar 28, 2004	Mar 10, 2005			
				Mar 31, 2001	Mar 28, 2002	Mar 28, 2002	Apr 05, 2003	May 26, 2004				
				Apr 05, 2001 *	Jun 02, 2002	Jun 02, 2002	Apr 16, 2003	Jun 08, 2004				
				Apr 22, 2001 *	Jun 06, 2002	Jun 06, 2002	Apr 16, 2003	Jun 15, 2004				
				May 16, 2001	Jul 23, 2002	Jul 23, 2002	Jun 26, 2003	Aug 26, 2004				
				Sep 27, 2001	Aug 05, 2002	Aug 05, 2002	Aug 06, 2003	Aug 30, 2004				
				Oct 20, 2001	Aug 08, 2002	Aug 08, 2002	Aug 09, 2003	Sep 05, 2004				
				Nov 28, 2001	Sep 24, 2002 *	Sep 24, 2002	Sep 26, 2003	Sep 24, 2004				
					Sep 24, 2002	Sep 24, 2002	Oct 03, 2003	Sep 25, 2004				
					Nov 21, 2002 *	Nov 21, 2002	Nov 26, 2003	Dec 10, 2004				
					Nov 27, 2002	Nov 27, 2002	Dec 02, 2003	Dec 12, 2004				
					Nov 28, 2002	Nov 28, 2002	Dec 26, 2003					
					Dec 07, 2002 *	Dec 07, 2002	Dec 29, 2003					

[Home](#) | [Help](#)

[Internet Archive](#) | [Terms of Use](#) | [Privacy Policy](#)

EXHIBIT F

To: Google Inc. (trademarks@google.com)
Subject: TRADEMARK APPLICATION NO. 77318565 - ANDROID - N/A
Sent: 8/20/2008 5:35:12 PM
Sent As: ECOM103@USPTO.GOV
Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/318565

MARK: ANDROID

77318565

CORRESPONDENT ADDRESS:

GOOGLE INC.
GOOGLE INC.
1600 AMPHITHEATRE PKWY
MOUNTAIN VIEW, CA 94043-1351

RESPOND TO THIS ACTION:

<http://www.uspto.gov/teas/eTEASpageD.htm>

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

APPLICANT: Google Inc.

CORRESPONDENT'S REFERENCE/DOCKET

NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

trademarks@google.com

OFFICE ACTION

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

ISSUE/MAILING DATE: 8/20/2008

THIS IS A FINAL ACTION.

This letter responds to the applicant's communication filed on August 14, 2008. The applicant (1) argued against the refusal to register the mark under Section 2(d), (2) amended the identification of goods, and (3) stated that the term ANDROID has no meaning other than as a trademark.

The following requirement has been satisfied: (1) Significance of the Mark. TMEP §§713.02, 714.04.

For the reasons set forth below, the refusal under Trademark Act Section 2(d) is now made **FINAL** with respect to U.S. Registration No. 2639556. *See* 15 U.S.C. §1052(d); 37 C.F.R. §2.64(a). In addition, the following requirement is now made **FINAL**: (1) Identification of Goods. *See* 37 C.F.R. §2.64(a).

Refusal: Section 2(d) – Likelihood of Confusion Refusal

Registration was refused under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), because the mark for which registration is sought so resembles the mark shown in U.S. Registration No. 2639556 as to be likely, when used in connection with the identified goods, to cause confusion, or to cause mistake, or to deceive.

The examining attorney has considered the applicant's arguments carefully but has found them unpersuasive. For the reasons below, the refusal under Section 2(d) is maintained and is now made **FINAL**.

The applicant applied to register the mark ANDROID in standard character form for "mobile device hardware and peripherals; operating system software; software for use in developing, executing, and running other software on mobile devices, computers, computer networks, and global communication networks; computer software development tools; computer software for use in transmitting and receiving data over computer networks and global communication networks; computer software for managing communications and data exchange among and between mobile devices and desktop computers; computer middleware, namely, software that mediates between the operating system of a mobile device and the application software of a mobile device; computer application software for mobile devices." The registered mark is ANDROID DATA in typed form for "computer e-commerce software to allow users to perform electronic business transactions via a global computer network."

Taking into account the relevant *du Pont* factors, a likelihood of confusion determination in this case involves a two-part analysis. The marks are compared for similarities in their appearance, sound, connotation and commercial impression. TMEP §§1207.01, 1207.01(b). The goods and/or services are compared to determine whether they are similar or commercially related or travel in the same trade channels. *See Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002); *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1336, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001); TMEP §§1207.01, 1207.01(a)(vi).

Comparison of the Marks

Regarding the first prong of the test, although a disclaimed portion of a mark certainly cannot be ignored, and the marks must be compared in their entireties, one feature of a mark may be more significant in creating a commercial impression. Disclaimed matter is typically less significant or less dominant when comparing marks. *See In re Dixie Rests. Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1060, 224 USPQ 749, 752 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Here, the registrant has disclaimed the wording DATA. Therefore, the examining attorney must closely examine the dominant portion of the registrant's mark against the applicant's mark.

The dominant portion of the registrant's mark and the applicant's mark are the identical term ANDROID. Thus, the dominant portion of the registrant's mark and the applicant's mark are identical with respect to

sound, appearance, and commercial impression. Marks may be confusingly similar in appearance where there are similar terms or phrases or similar parts of terms or phrases appearing in both applicant's and registrant's mark. See *Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987) (COMMCASH and COMMUNICASH); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (21 CLUB and "21" CLUB (stylized)); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re Collegian Sportswear Inc.*, 224 USPQ 174 (TTAB 1984) (COLLEGIAN OF CALIFORNIA and COLLEGIENNE); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983) (MILTRON and MILLTRONICS); *In re BASF A.G.*, 189 USPQ 424 (TTAB 1975) (LUTEXAL and LUTEX); TMEP §1207.01(b)(ii)-(iii).

The question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 201, 175 USPQ 558, 558-59 (C.C.P.A. 1972); TMEP §1207.01(b). For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. See *Recot, Inc. v. M.C. Becton*, 214 F.2d 1322, 1329-30, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000); *Visual Info. Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179, 189 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537, 540-41 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); TMEP §1207.01(b).

Considering the above, the marks are sufficiently similar to cause a likelihood of confusion under Trademark Act Section 2(d).

Comparison of the Goods

Turning to the second prong of the test, the goods of the parties need not be identical or directly competitive to find a likelihood of confusion. See *Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, they need only be related in some manner, or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods come from a common source. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999); TMEP §1207.01(a)(i); see, e.g., *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086-87, 56 USPQ2d 1471, 1475-76 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

The registrant is providing e-commerce software. This software can be used on the applicant's mobile device hardware and peripherals. Furthermore, the registrant's software may be executed by the applicant's "software for use in developing, executing, and running other software on mobile devices, computers, computer networks, and global communication networks." Thus, the goods are related and conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods come from a common source.

Furthermore, the applicant's "computer software for use in transmitting and receiving data over computer networks and global communication networks" is broad enough to include the applicant's e-commerce

software. Likelihood of confusion is determined on the basis of the goods and/or services as they are identified in the application and registration. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267-68, 62 USPQ2d 1001, 1004-05 (Fed. Cir. 2002); *In re Shell Oil Co.*, 992 F.2d 1204, 1207 n.4, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993); TMEP §1207.01(a)(iii). In this case, applicant's goods are identified broadly. Therefore, it is presumed that the application encompasses all goods of the type described, including those in the registrant's more specific identification, that they move in all normal channels of trade, and that they are available to all potential customers. See TMEP §1207.01(a)(iii); see, e.g., *In re Americor Health Servs.*, 1 USPQ2d 1670, 1670-71 (TTAB 1986); *In re Equitable Bancorporation*, 229 USPQ 709, 710 (TTAB 1986).

Finally, the Trademark Trial and Appeal Board has held that computer hardware products are related to computer software products, such that their marketing under the same or similar marks may be likely to cause source confusion. See *In re Emulex Corp.*, 6 USPQ2d 1312 (TTAB 1987) (holding JAVELIN for computer peripheral software storage unit likely to be confused with JAVELIN for "prerecorded computer programs in machine readable form"); *In re TIE/Commc'ns, Inc.*, 5 USPQ2d 1457 (TTAB 1987) (holding DATA STAR likely to cause confusion when used in connection with both registrant's "computer programs recorded on magnetic media" and applicant's "voice/data communications terminals and parts thereof"); *In re Digital Research Inc.*, 4 USPQ2d 1242 (TTAB 1987) (holding CONCURRENT PC-DOS likely to be confused with CONCURRENT TECHNOLOGIES CORPORATION for "printed electronic circuit boards"); *In re Epic Sys. Corp.*, 228 USPQ 213 (TTAB 1985) (holding EPIC for computer software for use in health care facilities likely to be confused with EPIC DATA for "electronic data collection terminals and electronic data collection units"); *In re Teradata Corp.*, 223 USPQ 361 (TTAB 1984) (holding Y NET for computer hardware likely to be confused with XYNET for computer software); *In re Compagnie Internationale Pour L'Informatique-Cii Honeywell Bull*, 223 USPQ 363 (TTAB 1984) (holding QUESTAR for computer hardware likely to be confused with QUESTAN for computer programs); *In re Graphics Tech. Corp.*, 222 USPQ 179 (TTAB 1984) (holding AGILE for computer programs likely to be confused with AGILE for computer data terminals); *Alpha Indus., Inc. v. Alpha Microsystems*, 220 USPQ 67 (TTAB 1983) (holding ALPHA MICRO for digital computer equipment and programs likely to be confused with ALPHA MICROWAVE for microwave components and sub assemblies); see also *Octocom Sys. Inc. v. Houston Computer Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990) (affirming TTAB decision on summary judgment that found computer modems and computer programs highly related); cf. *In re Quadram Corp.*, 228 USPQ 863 (TTAB 1985).

Applicant's Arguments

The applicant argues that no likelihood of confusion exists because the registrant is no longer using the mark as evidenced by their lack of presence currently on the Internet. Furthermore, the applicant has provided documents showing that the registrant's corporate entity was involuntarily dissolved in May, 2004.

However, while these statements may be true, a trademark or service mark registration on the Principal Register is prima facie evidence of the validity of the registration and the registrant's exclusive right to use the mark in commerce in connection with the specified goods and/or services. See 15 U.S.C. §1057(b); TMEP §1207.01(d)(iv). Evidence that constitutes a collateral attack on a cited registration, such as statements about a registrant's nonuse of its mark, is not relevant to a likelihood of confusion determination in ex parte examination. See *In re Dixie Rests.*, 105 F.3d 1405, 1408, 41 USPQ2d 1531, 1534-35 (Fed. Cir. 1997); *In re Peebles Inc.*, 23 USPQ2d 1795, 1797 n.5 (TTAB 1992); TMEP §1207.01(d)(iv). Such evidence may, however, be pertinent to a formal proceeding before the Trademark

Trial and Appeal Board to cancel the cited registration.

Conclusion

The applicant's mark must be refused registration under Trademark Act Section 2(d). The applicant's mark is highly similar to the registrant's mark with respect to sound, appearance, and commercial impression. Both marks share the dominant term ANDROID. Furthermore, the applicant's goods are closely related to the registrant's goods and commonly emanate from the same source as the registrant's goods. As such, the refusal is maintained and is now made **FINAL**.

Requirement: Identification of Goods

The examining attorney informed the applicant that the identification of goods was indefinite and must be clarified because it was too broad. It was noted that applicant may adopt the following identification, if accurate:

International Class 009: *Computer hardware; Computer software for {specify the function of the programs, e.g., use in database management, use as a spreadsheet, word processing, etc. and, if software is content- or field-specific, the content or field of use}.*

The applicant responded and amended the identification to the following:

International Class 009: Mobile device hardware and peripherals; operating system software; software for use in developing, executing, and running other software on mobile devices, computers, computer networks, and global communication networks; computer software development tools; computer software for use in transmitting and receiving data over computer networks and global communication networks; computer software for managing communications and data exchange among and between mobile devices and desktop computers; computer middleware, namely, software that mediates between the operating system of a mobile device and the application software of a mobile device; computer application software for mobile devices.

However, the identification of goods remains indefinite because portions of the identification are too broad. Applicant may adopt the following identification of goods, if accurate:

International Class 009: Mobile device hardware and peripherals, *namely, {state the specific hardware and peripherals, i.e. devices for hands-free use of mobile phones, mobile phones, etc.}*; operating system software; software for use in developing, executing, and running other software on mobile devices, computers, computer networks, and global communication networks; computer software development tools; computer software for use in transmitting and receiving data over computer networks and global communication networks; computer software for managing communications and data exchange among and between mobile devices and desktop computers; computer middleware, namely, software that mediates between the operating system of a mobile device and the application software of a mobile device; computer application software for mobile devices, *namely mobile phones*.

Identifications of goods can be amended only to clarify or limit the goods; adding to or broadening the scope of the goods is not permitted. 37 C.F.R. §2.71(a); see TMEP §§1402.06 *et seq.*, 1402.07.

Therefore, applicant may not amend the identification to include goods that are not within the scope of the goods set forth in the present identification.

For assistance with identifying and classifying goods and/or services in trademark applications, please see the online searchable *Manual of Acceptable Identifications of Goods and Services* at <http://tess2.uspto.gov/netathtml/tidm.html>. See TMEP §1402.04.

Since the applicant failed to provide an acceptable identification of goods, this requirement is maintained and is now made **FINAL**.

Response Guidelines

If applicant does not respond within six months of the mailing date of this final Office action, the application will be abandoned. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). Applicant may respond to this final Office action by:

- (1) Submitting a response that fully satisfies all outstanding requirements, if feasible; and/or
- (2) Filing an appeal to the Trademark Trial and Appeal Board, with an appeal fee of \$100 per class.

37 C.F.R. §§2.6(a)(18), 2.64(a); TBMP ch. 1200; TMEP §714.04.

In certain rare circumstances, a petition to the Director may be filed pursuant to 37 C.F.R. §2.63(b)(2) to review a final Office action that is limited to procedural issues. 37 C.F.R. §2.64(a); TMEP §714.04; *see* 37 C.F.R. §2.146(b); TBMP §1201.05; TMEP §1704 (explaining petitionable matters). The petition fee is \$100. 37 C.F.R. §2.6(a)(15).

If applicant has questions about its application, please telephone the assigned trademark examining attorney directly at the number below.

/Seth A. Rappaport/
Seth A. Rappaport
Trademark Examining Attorney
Law Office 103
Phone: (571) 270-1508
Fax: (571) 270-2508

RESPOND TO THIS ACTION: Applicant should file a response to this Office action online using the form at <http://www.uspto.gov/teas/eTEASpageD.htm>, waiting 48-72 hours if applicant received notification of the Office action via e-mail. For *technical* assistance with the form, please e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned examining attorney. **Do not respond to this Office action by e-mail; the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

STATUS CHECK: Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

To: Google Inc. (trademarks@google.com)
Subject: TRADEMARK APPLICATION NO. 77318565 - ANDROID - N/A
Sent: 8/20/2008 5:35:14 PM
Sent As: ECOM103@USPTO.GOV
Attachments:

IMPORTANT NOTICE
USPTO OFFICE ACTION HAS ISSUED ON 8/20/2008 FOR
APPLICATION SERIAL NO. 77318565

Please follow the instructions below to continue the prosecution of your application:

VIEW OFFICE ACTION: Click on this link
http://tportal.uspto.gov/external/portal/tow?DDA=Y&serial_number=77318565&doc_type=OOA&
(or copy and paste this URL into the address field of your browser), or visit
<http://tportal.uspto.gov/external/portal/tow> and enter the application serial number to access the
Office action.

PLEASE NOTE: The Office action may not be immediately available but will be viewable within 24 hours of this notification.

RESPONSE MAY BE REQUIRED: You should carefully review the Office action to determine (1) if a response is required; (2) how to respond; and (3) the applicable response time period. Your response deadline will be calculated from 8/20/2008.

Do NOT hit "Reply" to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System response form at <http://www.uspto.gov/teas/eTEASpageD.htm>.

HELP: For technical assistance in accessing the Office action, please e-mail TDR@uspto.gov. Please contact the assigned examining attorney with questions about the Office action.

WARNING

1. The USPTO will NOT send a separate e-mail with the Office action attached.
2. Failure to file any required response by the applicable deadline will result in the ABANDONMENT of your application.

EXHIBIT G

PTO Form 1950 (Rev. 12/2007)
 PTO Form 1950 (Rev. 12/2007) (Page 4/5)

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77318565
LAW OFFICE ASSIGNED	LAW OFFICE 103
MARK SECTION (no change)	
ARGUMENT(S)	
<p>As requested by the Examining Attorney, we have again amended the description to further clarify the goods.</p> <p>In response to the Examining Attorney's continued 2(d) refusal, we would like to note, in addition to the arguments we made previously, that the deadline for filing a section 8 affidavit for Reg. No. 2639556 has passed, and there is no record that such an affidavit has been timely filed. Because the registration is (or will soon be) no longer valid, we again ask that the Examining Attorney to withdraw the refusal. If the Examining Attorney cannot at this time withdraw the refusal, we kindly request that the Examining Attorney consider suspending the examination of our application pending the final disposition of Reg. No. 2639556.</p>	
GOODS AND/OR SERVICES SECTION (current)	
INTERNATIONAL CLASS	009
DESCRIPTION	
<p>mobile device hardware and peripherals; operating system software; software for use in developing, executing, and running other software on mobile devices, computers, computer networks, and global communication networks; computer software development tools; computer software for use in transmitting and receiving data over computer networks and global communication networks; computer software for managing communications and data exchange among and between mobile devices and desktop computers; computer middleware, namely, software that mediates between the operating system of a mobile device and the application software of a mobile device; computer application software for mobile devices</p>	
FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (proposed)	
INTERNATIONAL CLASS	009
DESCRIPTION	

mobile phones; operating system software; software for use in developing, executing, and running other software on mobile devices, computers, computer networks, and global communication networks; computer software development tools; computer software for use in transmitting and receiving data over computer networks and global communication networks; computer software for managing communications and data exchange among and between mobile devices and desktop computers; computer middleware, namely, software that mediates between the operating system of a mobile device and the application software of a mobile device; computer application software for mobile phones

FILING BASIS	Section 1(b)
SIGNATURE SECTION	
DECLARATION SIGNATURE	/ttt/
SIGNATORY'S NAME	Tu T. Tsao
SIGNATORY'S POSITION	Trademark Counsel
DATE SIGNED	11/20/2008
RESPONSE SIGNATURE	/ttt/
SIGNATORY'S NAME	Tu T. Tsao
SIGNATORY'S POSITION	Trademark Counsel
DATE SIGNED	11/20/2008
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Thu Nov 20 20:25:56 EST 2008
TEAS STAMP	USPTO/RFR-65.57.245.11-20 081120202556717742-773185 65-43094e1d4f7a428d59f826 13f14196fdc-N/A-N/A-20081 120195637689134

Request for Reconsideration after Final Action
To the Commissioner for Trademarks:

Application serial no. **77318565** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

As requested by the Examining Attorney, we have again amended the description to further clarify the goods.

In response to the Examining Attorney's continued 2(d) refusal, we would like to note, in addition to the arguments we made previously, that the deadline for filing a section 8 affidavit for Reg. No. 2639556 has passed, and there is no record that such an affidavit has been timely filed. Because the registration is (or will soon be) no longer valid, we again ask that the Examining Attorney to withdraw the refusal. If the Examining Attorney cannot at this time withdraw the refusal, we kindly request that the Examining Attorney consider suspending the examination of our application pending the final disposition of Reg. No. 2639556.

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 009 for mobile device hardware and peripherals; operating system software; software for use in developing, executing, and running other software on mobile devices, computers, computer networks, and global communication networks; computer software development tools; computer software for use in transmitting and receiving data over computer networks and global communication networks; computer software for managing communications and data exchange among and between mobile devices and desktop computers; computer middleware, namely, software that mediates between the operating system of a mobile device and the application software of a mobile device; computer application software for mobile devices

Original Filing Basis:

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Proposed: Class 009 for mobile phones; operating system software; software for use in developing, executing, and running other software on mobile devices, computers, computer networks, and global communication networks; computer software development tools; computer software for use in transmitting and receiving data over computer networks and global communication networks; computer software for managing communications and data exchange among and between mobile devices and desktop computers; computer middleware, namely, software that mediates between the operating system of a mobile device and the application software of a mobile device; computer application software for mobile phones

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

SIGNATURE(S)

Declaration Signature

If the applicant is seeking registration under Section 1(b) and/or Section 44 of the Trademark Act, the applicant had a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. 37 C.F.R. Secs. 2.34(a)(2)(i); 2.34 (a)(3)(i); and 2.34(a)(4)(ii). If the applicant is seeking registration under Section 1(a) of the Trademark Act, the mark was in use in commerce on or in connection with the goods or services listed in the application as of the application filing date. 37 C.F.R. Secs. 2.34(a)(1)(i). 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. §1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application 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 application is being filed under 15 U.S.C. §1051(b), 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; that if the original application was submitted unsigned, that all statements in the original application and this submission made of the declaration signer's knowledge are true; and all statements in the original application and this submission made on information and belief are believed to be true.

Signature: /ttt/ Date: 11/20/2008
Signatory's Name: Tu T. Tsao
Signatory's Position: Trademark Counsel

Request for Reconsideration Signature

Signature: /ttt/ Date: 11/20/2008
Signatory's Name: Tu T. Tsao
Signatory's Position: Trademark Counsel

The signatory has confirmed that he/she is not represented by either an authorized attorney or Canadian attorney/agent, and that he/she is either (1) the applicant or (2) a person(s) with legal authority to bind the applicant; and if an authorized U.S. attorney or Canadian attorney/agent previously represented him/her in this matter, either he/she has filed a signed revocation of power of attorney with the USPTO or the USPTO has granted the request of his/her prior representative to withdraw.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 77318565
Internet Transmission Date: Thu Nov 20 20:25:56 EST 2008
TEAS Stamp: USPTO/RFR-65.57.245.11-20081120202556717
742-77318565-43094e1d4f7a428d59f82613f14
196fdc-N/A-N/A-20081120195637689134

EXHIBIT H

Trademark Trial and Appeal Board Electronic Filing System. <http://estta.uspto.gov>

ESTTA Tracking number: **ESTTA250394**

Filing date: **11/20/2008**

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

Application Serial No.	77318565
Applicant	Google Inc.

Notice of Appeal

Notice is hereby given that Google Inc. appeals to the Trademark Trial and Appeal Board the refusal to register the mark depicted in Application Serial No. 77318565.

Applicant has filed a request for reconsideration of the refusal to register, and requests suspension of the appeal pending consideration of the request by the Examining Attorney.

The refusal to register has been appealed as to the following class of goods/services:

- Class 009.

All goods and services in the class are appealed, namely: mobile device hardware and peripherals; operating system software; software for use in developing, executing, and running other software on mobile devices, computers, computer networks, and global communication networks; computer software development tools; computer software for use in transmitting and receiving data over computer networks and global communication networks; computer software for managing communications and data exchange among and between mobile devices and desktop computers; computer middleware, namely, software that mediates between the operating system of a mobile device and the application software of a mobile device; computer application software for mobile devices

Respectfully submitted,

/ttt/

11/20/2008

GOOGLE INC.

GOOGLE INC.

1600 AMPHITHEATRE PKWY

MOUNTAIN VIEW, CA 94043-1351

UNITED STATES

trademarks@google.com

650-253-0000

EXHIBIT I

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

MAILED: November 21, 2008

IN RE:
Google Inc.

SERIAL NO. 77318565

APPEAL RECEIVED: 11/20/2008

BRIEF DUE: n/a

GOOGLE INC.
GOOGLE INC.
1600 AMPHITHEATRE PKWY
MOUNTAIN VIEW CA 94043-1351

ESTTA250394

The appeal and appeal fee in the above-entitled application were received on the date indicated above. Applicant indicated that it has filed or is filing today a request for reconsideration of the final refusal to register.¹

¹ A timely request for reconsideration must be filed with the Trademark Examining Operation, and may be filed via TEAS, using the Response to Office Action form. (To maintain their status, TEAS Plus applicants must use TEAS for filing a request for reconsideration.) Applicant should notify the Board immediately if it has not filed a timely request for reconsideration and does not intend to do so.

Accordingly, the appeal is hereby instituted, but action on the appeal is suspended pending the Examining Attorney's consideration of the request for reconsideration.

In the event the refusal of registration is maintained, proceedings will be resumed and applicant will be allowed time in which to file a brief on its appeal.

New Developments at the Trademark Trial and Appeal Board

TTAB forms for electronic filing of extensions of time to oppose, notices of opposition, petition for cancellation, notice of ex parte appeal, and inter partes filings are now available at <http://estta.uspto.gov>. Images of TTAB proceeding files can be viewed using TTABVue at <http://ttabvue.uspto.gov>.

Parties should also be aware of changes in the rules affecting trademark matters, including rules of practice before the TTAB. See Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act, 68 Fed. R. 55,748 (September 26, 2003) (effective November 2, 2003) Reorganization of Correspondence and Other Provisions, 68 Fed. Reg. 48,286 (August 13, 2003) (effective September 12, 2003). Notices concerning the rules changes are available at www.uspto.gov.

EXHIBIT J

To: Google Inc. (trademarks@google.com)
Subject: TRADEMARK APPLICATION NO. 77318565 - ANDROID - N/A
Sent: 11/24/2008 5:06:20 PM
Sent As: ECOM103@USPTO.GOV
Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77318565

MARK: ANDROID

77318565

CORRESPONDENT ADDRESS:

GOOGLE INC.
GOOGLE INC.
1600 AMPHITHEATRE PKWY
MOUNTAIN VIEW, CA 94043-1351

GENERAL TRADEMARK INFORMATION:
<http://www.uspto.gov/main/trademarks.htm>

APPLICANT: Google Inc.

**CORRESPONDENT'S REFERENCE/DOCKET
NO:**

N/A

CORRESPONDENT E-MAIL ADDRESS:

trademarks@google.com

NOTICE OF SUSPENSION

ISSUE/MAILING DATE: 11/24/2008

This letter responds to the applicant's communication filed on November 20, 2008. The applicant (1) argued against the Section 2(d) refusal and requested that this mark be placed in suspension pending the determination of whether the cited registration will be canceled or expire and (2) amended the identification of goods.

The following requirement has been satisfied: (1) Identification of Goods. TMEP §§713.02, 714.04.

The following refusal is maintained: (1) Section 2(d) – Likelihood of Confusion Refusal.

SUSPENSION PROCEDURE: This suspension notice serves to suspend action on the application for the

reason specified below. No response is needed. However, if you wish to respond to this notice, you should use the "Response to Letter of Suspension" form found at <http://teasroa.uspto.gov/rsi/rsi>. The Office will conduct periodic status checks to determine if suspension remains appropriate.

Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), based on the cited registration. However, registration maintenance documents are due to be filed for the cited registration. If these registration maintenance documents are not timely filed, the cited registration will be canceled under §8 or expire under §9 and will no longer present a bar to registration under Section 2(d). 15 U.S.C. §§1058, 1059. Therefore, action on this application is suspended for 6 months until the examining attorney can determine whether the cited registration will be canceled under §8 or expire under §9. 37 C.F.R. §2.67; TMEP §716.02(e).

/Seth A. Rappaport/
Seth A. Rappaport
Trademark Examining Attorney
Law Office 103
Phone: (571) 270-1508
Fax: (571) 270-2508

STATUS CHECK: Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

To: Google Inc. (trademarks@google.com)
Subject: TRADEMARK APPLICATION NO. 77318565 - ANDROID - N/A
Sent: 11/24/2008 5:06:22 PM
Sent As: ECOM103@USPTO.GOV
Attachments:

IMPORTANT NOTICE
USPTO OFFICE ACTION HAS ISSUED ON 11/24/2008 FOR
APPLICATION SERIAL NO. 77318565

Please follow the instructions below to continue the prosecution of your application:

VIEW OFFICE ACTION: Click on this link
http://tmportal.uspto.gov/external/portal/tow?DDA=Y&serial_number=77318565&doc_type=SUL&...
(or copy and paste this URL into the address field of your browser), or visit
<http://tmportal.uspto.gov/external/portal/tow> and enter the application serial number to access the Office action.

PLEASE NOTE: The Office action may not be immediately available but will be viewable within 24 hours of this notification.

RESPONSE MAY BE REQUIRED: You should carefully review the Office action to determine (1) if a response is required; (2) how to respond; and (3) the applicable response time period. Your response deadline will be calculated from 11/24/2008.

Do NOT hit "Reply" to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System response form at <http://www.uspto.gov/teas/eTEASpageD.htm>.

HELP: For *technical* assistance in accessing the Office action, please e-mail TDR@uspto.gov. Please contact the assigned examining attorney with questions about the Office action.

WARNING

- 1. The USPTO will NOT send a separate e-mail with the Office action attached.**
- 2. Failure to file any required response by the applicable deadline will result in the ABANDONMENT of your application.**

EXHIBIT K

Side - 1



**NOTICE OF ACCEPTANCE OF §8
DECLARATION**
MAILING DATE: Apr 29, 2009

The declaration filed in connection with the registration identified below meets the requirements of Section 8 of the Trademark Act, 15 U.S.C. §1058. The declaration is accepted and the registration remains in force. For further information about this notice, visit our website at: <http://www.uspto.gov>. To review information regarding the referenced registration, go to <http://tarr.uspto.gov>.

REG NUMBER: 2639556
MARK: ANDROID DATA
OWNER: Android Data Corporation

Side - 2

UNITED STATES PATENT AND TRADEMARK OFFICE
COMMISSIONER FOR TRADEMARKS
P.O. BOX 1451
ALEXANDRIA, VA 22313-1451

FIRST-CLASS
MAIL
U.S POSTAGE
PAID

ERICH SPECHT
ANDROID DATA CORPORATION
114 N ASHLAND AVE
PALATINE, IL 60067

**UNITED STATES DISTRICT COURT
FOR THE Northern District of Illinois – CM/ECF LIVE, Ver 4.0.3
Eastern Division**

The Android's Dungeon Incorporated, et al.

Plaintiff,

v.

Case No.:
1:09-cv-02572
Honorable Harry D.
Leinenweber

SiRF Technology Holdings Inc, et al.

Defendant.

NOTIFICATION OF DOCKET ENTRY

This docket entry was made by the Clerk on Tuesday, February 23, 2010:

MINUTE entry before Honorable Harry D. Leinenweber: For the reasons stated in open court, Motorola's Motion to quash [154] is granted in part and denied in part. Motorola is ordered to respond to Plaintiffs' request 12 through 15. Plaintiffs' Motion to strike or in the alternative, to file sur-reply [170] is denied as moot. Defendant's response to Plaintiffs' Motion to Compel [172] to be filed by 3/9/2010. Plaintiffs' reply brief due by 3/16/2010. The Court will rule orally on 4/14/2010 at 09:00 AM. Oral discovery to close 7/30/2010. Parties to file amended pleadings by 7/15/2010. Dispositive motions due by 7/30/2010. Status hearing stricken. Mailed notice(wp,)

ATTENTION: This notice is being sent pursuant to Rule 77(d) of the Federal Rules of Civil Procedure or Rule 49(c) of the Federal Rules of Criminal Procedure. It was generated by CM/ECF, the automated docketing system used to maintain the civil and criminal dockets of this District. If a minute order or other document is enclosed, please refer to it for additional information.

For scheduled events, motion practices, recent opinions and other information, visit our web site at www.ilnd.uscourts.gov.

**IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION**

ERICH SPECHT, an individual and doing business)	
as ANDROID DATA CORPORATION, and THE)	
ANDROID'S DUNGEON INCORPORATED,)	
)	
Plaintiffs/Counter-Defendants,)	
v.)	Civil Action No. 09-cv-2572
)	
GOOGLE INC.,)	Judge Harry D. Leinenweber
)	
Defendant/Counter-Plaintiff.)	

MOTION FOR LEAVE TO FILE THIRD AMENDED COMPLAINT

Plaintiffs Erich Specht, an individual and doing business as Android Data Corporation and The Android's Dungeon Incorporated, by and through their attorneys, hereby move this Court, pursuant to Fed. R. Civ. P. 15(a) and 20(a)(2), for leave to file the Third Amended Complaint a copy of which is attached hereto as Exhibit A, without exhibits. In support hereof, Plaintiffs state as follows:

1. On April 28, 2009, Plaintiffs filed their Complaint for Trademark Infringement naming Google and numerous other defendants. On June 4, 2009, Plaintiffs filed their First Amended Complaint ("FAC") again naming Google and numerous other defendants. On August 3, 2009, the Court dismissed the FAC as to all defendants other than Google without prejudice and granted Plaintiffs leave to file a second amended complaint. Among other things, the Court found that Plaintiffs needed to allege more factual detail concerning the nature of the other defendants' involvement in the alleged infringing activity. The Court did not set a deadline for Plaintiffs to file the second amended complaint.

2. On October 6, 2009, Plaintiffs filed their Second Amended Complaint ("SAC"), which asserted five claims against Google: (a) trademark infringement under the Lanham Act

(Count I); (b) unfair competition under the Lanham Act (Count II); (c) violation of the Illinois Deceptive Trade Practices Act (Count III); (d) common law trademark infringement (Count IV); and (e) contributory infringement (Count V).

3. On February 23, 2010, the Court ordered that: "Parties to file amended pleadings by 7/15/2010." (Dkt. 174.)

4. Plaintiffs filed a Third Amended Complaint on July 13, 2010 (the "TAC"), believing such amendment to be in compliance with the Court's February 23, 2010 Order. The TAC asserted the same five claims against Google as in the SAC in Counts I-V. The TAC also added four new defendants to the case -- T-Mobile USA, Inc., Sprint Nextel Corporation, Cellco Partnership d/b/a Verizon Wireless and AT&T Mobility LLC (together, the "Carrier Defendants") -- and asserted against them in Counts VI-IX the same causes of action asserted against Google in Counts I-IV.

5. Plaintiffs added the Carrier Defendants to the TAC because of information learned in discovery. On July 9, 2010, at the deposition of Andy Rubin, the manager of the Android Platform for Google, Rubin identified the four Carrier Defendants as the principal wireless carriers who sell Android mobile devices and provide wireless service for those devices. One of those carriers, AT&T Mobility LLC, only began selling Android mobile devices and associated wireless services within the past several months.

6. Plaintiffs have no choice but to pursue their claims against the Carrier Defendants because Google has taken the surprising position in discovery -- critically, in the Rule 30(b)(6) depositions taken within the past week -- that it earns essentially no revenue from the Android Platform. Google likewise is refusing to provide Plaintiffs with any information concerning its

advertising revenues earned from the use of Android mobile devices, even though its own employees account for such revenues on “Android P&L” statements.

7. At the outset of this case, Google attorneys boasted that with regard to the Android Platform, there was “somewhere between . . . \$400 to \$650, \$700 million dollars [sic] worth of products and systems . . . out there utilizing this protocol.” (May 7, 2009 Tr. at 11.) Nevertheless, Google’s own corporate representative witnesses are asserting under oath the dubious position that Google does not share in any revenue associated with these products and systems and that the revenue is earned, instead, by the Carrier Defendants and others who distribute products and services utilizing the Android Platform.

8. Plaintiffs believe they acted properly by filing the TAC within the time frame set forth in the Court’s February 23, 2010 Order, which granted the parties leave to amend the pleadings by July 15, 2010. Plaintiffs have since discussed the matter with counsel for Google, who has asserted that the TAC is improper and a “nullity” because Plaintiffs did not move for leave to file it. Accordingly, Plaintiffs file this motion in an abundance of caution, and ask the Court to grant leave to the extent such leave is required.

9. Rule 15(a) of the Federal Rules of Civil Procedure states that requests to amend pleadings should be liberally granted. Under Rule 15(a), leave to amend pleadings is freely given, unless there is undue delay, undue prejudice to the opposing party, or the amendment would be futile. See, e.g., Oil Express Nat’l, Inc. v. Burgstone, No. 96 Civ. 4816, 1998 WL 677250, at * 1 (N.D. Ill. Sept. 22, 1998).

10. Here, the proposed amendment will not result in undue prejudice or delay or for any other improper purpose. Plaintiffs are reacting promptly to information learned from Google in discovery in this case. The Court will recall that Plaintiffs filed a motion to compel Google to

provide 30(b)(6) deposition testimony in June, because Google was preventing such discovery from proceeding until the second and third weeks of July, mere days before the deadline to amend and the close of discovery.

11. Under Rule 20(a)(2) joinder of the additional Defendants in this action is proper because Plaintiffs assert a right to relief against them that arises out of and concerns the same transactions, occurrences or series of transactions or occurrences and questions of law or fact common to all Defendants will arise in this action. Moreover, it would be wasteful and inefficient for Plaintiffs to litigate their claims against the Carrier Defendants in a separate action given the prevalent common questions of law and fact.

WHEREFORE, Plaintiffs respectfully request that this Court enter an order granting Plaintiffs leave to file the Third Amended Complaint.

Respectfully submitted,

ERICH SPECHT, an individual and doing
business as ANDROID DATA
CORPORATION, and THE ANDROID'S
DUNGEON INCORPORATED

By: /s/ John F. Shonkwiler
One of Their Attorneys

P. Andrew Fleming
John F. Shonkwiler
John B. Haarlow, Jr.
NOVACK AND MACEY LLP
100 North Riverside Plaza
Chicago, IL 60606
(312) 419-6900

Martin Murphy
2811 RFD
Long Grove, IL 60047
(312) 933-3200

CERTIFICATE OF SERVICE

John F. Shonkwiler, an attorney, certifies that he caused copies of the foregoing Motion for Leave to File Third Amended Complaint to be served by electronically filing the document with the Clerk of Court using the ECF system this 15th day of July, 2010.

/s/ John F. Shonkwiler

IN THE UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

ERICH SPECHT, et al.)	
)	C.A. No. 09-cv-2572
Plaintiffs,)	
)	Judge Leinenweber
v.)	
)	Magistrate Judge Cole
GOOGLE INC.,)	
)	
Defendant.)	

GOOGLE'S BRIEF REGARDING PLAINTIFFS' REQUEST FOR RECUSAL
(REDACTED)

On July 20, 2010, the parties appeared before the Court with regard to Plaintiffs' pending Motion for Leave to File their Third Amended Complaint. In addition to adding new trademarks and causes of action, the proposed Third Amended Complaint seeks to add four "new" defendants, including two who had already been dismissed from the case nine months ago. Upon introducing its Motion to the Court, and after the Court noted that the Third Amended Complaint, if accepted, would cause the Court to recuse itself,¹ Plaintiffs orally requested that the Court recuse itself from deciding Plaintiffs' Motion for Leave to File. The Court requested briefing on that issue, and Plaintiffs' resulting brief expands the original request for recusal even further. Plaintiffs now contend that the mere possibility that AT&T might some day have to defend against Plaintiffs' frivolous infringement claims requires this Court to immediately recuse itself in this case -- whether or not AT&T is actually a party in this case.

As set forth below, the Court is not required to recuse itself. Since AT&T is not currently a party, none of the mandatory recusal provisions of 28 U.S.C. §455(b) apply. Nor is recusal

¹ The Judge's wife serves on the Board of Directors of AT&T Inc., of which proposed defendant AT&T Mobility, LLC is a wholly-owned subsidiary, and the Judge owns shares of AT&T, Inc.'s stock.

under the “catchall” provision of 28 U.S.C. §455(a) appropriate given Plaintiffs’ substantial delay and apparent bad faith in raising this issue.

A. Background

Plaintiffs seek leave to file a Third Amended Complaint, which attempts to add four defendants: T-Mobile, Sprint, Verizon and AT&T Mobility. The Third Amended Complaint also contains new substantive allegations, such as a new allegedly infringed trademark -- despite the fact that written discovery closed months ago on March 31st and oral discovery is just days from the closing on July 30th. This is Plaintiffs’ fourth attempt to bring defendants other than Google into this lawsuit. Two of the four “new” defendants that Plaintiffs are now attempting to add were long ago dismissed from this case. Apparently realizing the frailty of their attempts to add parties at this extremely late date, Plaintiffs claim that they intend to file a separate lawsuit against these potential defendants if the Court denies their Motion for Leave. (July 20, 2010 Transcript, Ex. A, p. 5.) Accordingly, if this Court does not permit these defendants to be added to *this* case, Plaintiffs may still assert their new claims in a separate case.

The procedural context of Plaintiffs’ Motion is telling. Google asserts not only that Plaintiffs abandoned their asserted trademarks years ago, around the end of 2002, but also that Plaintiffs knowingly committed fraud in renewing their trademark registration just prior to filing this lawsuit. Google also contends that Plaintiffs’ repeated, meritless attempts to add defendants to this lawsuit are merely part of a strategy to secure “nuisance value” settlements, rather than being based on any legitimate legal theories. Indeed, at one point Plaintiffs even lodged meritless allegations of “counterfeiting” and “incontestability.” (First Amended Compl., Dkt. No. 38.) Noting the long list of defendants in the initial and First Amended Complaints, the Court apprised the parties of a potential conflict with AT&T at least a year ago. (Dkt. No. 46, June 4, 2009 Transcript, Ex. B, pp. 4-7; Finn Decl., Ex. C.) Since then, Plaintiffs have made no

suggestion that AT&T might be a potential defendant or that rulings in this case might affect the Judge's or his spouse's interest in AT&T. Despite Plaintiffs concession that AT&T Mobility has been publicly selling phones with Google's Android operating system for several months (Dkt No. 216, Proposed Third Amended Complaint, ¶¶ 76-77), Plaintiffs have never raised any issues with the Court when that public announcement was made.

Google has diligently sought discovery from Plaintiffs and has been forced to file a number of motions to compel due to Plaintiffs' unwillingness to provide even the most basic of answers to interrogatories. (Dkt. Nos. 145, 148, 186, 191, 192, 199, 205, 214, 215, 219, 225.) One such motion involved sanctionable, obstructive behavior by Plaintiffs' counsels at a deposition. (Dkt. No. 215.) Plaintiffs, on the other hand, have been engaged in a campaign of motions designed to avoid Google's impending summary judgment motions. In early June, 2010, Plaintiffs moved to extend discovery beyond the current July 30th close, but failed to offer any support for their motion and were ordered to supplement their motion later. (Dkt. Nos. 206, 213.) Failing that, Plaintiffs then attempted to unilaterally cancel all remaining depositions once they had completed their depositions of Google's corporate witnesses. (Dkt. Nos. 219, 225.) After that delay tactic failed, Plaintiffs expanded their prior oral request for recusal so as to now seek the Court to recuse itself not just from hearing Plaintiffs' pending Motion for Leave, but instead seeking a complete recusal..

Plaintiffs' attempt to add these "new" defendants together with their Motion for recusal is just more of a calculated strategy to delay the case and attempt to obtain a more favorable Judge. Though Plaintiffs now argue that any ruling in this case will "affect" AT&T, and thereby affect the Judge's financial interests, Plaintiffs made no such argument in March, April, May, or June of this year -- when they admit they knew AT&T was selling accused products. Plaintiffs only

named AT&T as a potential defendant on the eve of dispositive motions -- and only **after** they were sanctioned for deposition conduct, their attempts to extend discovery failed, and their plan to unilaterally cancel depositions was rejected.² [REDACTED]

[REDACTED]

[REDACTED]³

B. Recusal Must Not Be Done Needlessly.

“Judges have an obligation to litigants and their colleagues not to remove themselves needlessly.” *Stewart v. GNP Commodities, Inc.*, 1992 WL 121545, *3 (N.D.Ill. May 26, 1992) (citing *In re Nat’l Union Fire Ins. Co. of Pittsburgh*, 839 F.2d 1226, 1229 (7th Cir. 1988)). Recusal “benefits . . . the litigant who sought this outcome, but it may injure the judge who must take over the case and the litigant aggrieved by the substitution.” *New York City Housing Development Corp. v. Hart*, 796 F.2d 976, 981 (7th Cir. 1986). A district judge is “obligated **not** to recuse himself without reason just as he is obligated to recuse himself when there is reason.” *Id.*; *Nat’l Rifle Ass’n of America, Inc. v. City of Evanston*, 2008 WL 3978293, *1 (N.D.Ill. Aug. 22, 2008) (emphasis added). *See also U.S. v. Baskes*, 687 F.2d 165, 170 (7th Cir. 1981) (“a judge is under as much obligation not to recuse himself when facts do not show prejudice as he is to recuse himself if they do”). The statute governing recusal, 28 U.S.C. §455, “must not be so broadly construed that it becomes, in effect, presumptive, so that recusal is mandated upon the merest unsubstantiated suggestion of personal bias or prejudice,” nor is it “intended to ‘bestow veto power over judges or to be used as a judge shopping device.’” *Eppley v. Iacovelli*, 2009 WL 1033391, *3 (S.D.Ind. Apr. 16, 2009) (citation omitted).

² To the extent that Plaintiffs may argue that they waited to add these new defendants until after Google’s Rule 30(b)(6) depositions, that argument is unavailing. Indeed, the deposition testimony reflects that the only carrier provider with which Google did **not** have a relationship at the time of Plaintiffs’ Motion to Leave was AT&T Mobility. (Flannery Dep. pp. 64-65, Ex. D).

³ [REDACTED]

There are two provisions of 28 U.S.C. §455⁴ which could potentially apply -- §455(a) and §455(b). The relevant sections of §455 are as follows:

(a) Any justice, judge or magistrate of the United States shall disqualify himself in any proceeding in which his impartiality might reasonably be questioned.

(b) He shall also disqualify himself in the following circumstances:

... (4) He ... or his spouse ... has a financial interest in the subject matter in controversy *or in a party to the proceeding*, or any other interest that could be substantially affected by the outcome of the proceeding ...

(5) He or his spouse ... is a party to the proceeding, or an officer, director, or trustee of a party.

Section 455(b) provides specific instances where recusal is mandatory, while §455(a) serves as a “catchall” provision. *Schmude v. Sheahan*, 312 F.Supp.2d 1047, 1062 (N.D.Ill. 2004). Neither of these sections require the Court to recuse itself from ruling on Plaintiffs’ Motion. Google first addresses § 455(b) below, and then addresses the “catchall” provision of §455(a).

C. § 455(b) Does Not Apply Because AT&T Mobility is Not Currently a Party to This Lawsuit

The relevant portion of Section 455(b)(4) requires disqualification where a judge or his spouse “has a financial interest *in a party* to the proceeding” (emphasis added). Similarly, §455(b)(5) requires disqualification where a judge or his spouse is “an officer, director, or trustee *of a party*” (emphasis added). These provisions are to be interpreted strictly; the legislative history for §455 notes that the purpose of enacting the section was to “set[] specific standards [and] eliminate the uncertainty and ambiguity arising from the language in the existing statute.”

⁴ While 28 U.S.C. §144 governs disqualification of a judge for actual bias or prejudice, that section applies only where a party “files a timely and sufficient affidavit that the judge before whom the matter is pending has a personal bias or prejudice either against him or in favor of any adverse party,” and is clearly not applicable here since no party has filed such an affidavit.

H.R. REP. 93-1453 (1974), 93rd Cong., 2nd Sess., *reprinted in* 1974 U.S.C.C.A.N. 6351, 6355.

By their plain language, §§455(b)(4) and (5) apply only to **actual parties** to a case.

Thus, while it is clear that recusal would be mandatory *if* AT&T were a party to this case, § 455(b) does *not* require recusal simply because AT&T *could be* or *might* be a party to this case. If the Court's purported interest in the outcome "is not direct, but is remote, *contingent*, or speculative, it is not the kind of interest which reasonably brings into question a judge's impartiality." *Hook v. McDade*, 89 F.3d 350, 356 (7th Cir. 1996) (citations omitted, emphasis added). Because the Court's purported interest in the outcome is clearly only *contingent* on the Motion for Leave, recusal is not required.

Plaintiffs argue that their declared intent to sue AT&T means the Court must recuse itself under §455(b), because any judgment for or against Google may affect a judgment for or against AT&T. But Plaintiffs' reliance on *In re Aetna Casualty And Surety Co.*, 929 F.2d 1136 (6th Cir. 1990) is misplaced. *Aetna* involved §455(b)(5)(ii) -- the judge's daughter was acting as a lawyer in the proceeding, with "proceeding" being cases that were, at one point, consolidated together. In contrast, Plaintiffs are seeking recusal under §455(b)(5)(i) -- solely due to the judge's financial interest. However, a judge's close relative being counsel in a "proceeding" presided over by that same judge is a much different analysis of when a judge may have a financial interest in the outcome of the case.⁵ For example, the 8th Circuit has rejected the precise "collateral estoppel" arguments that Plaintiffs are now advocating. *In re Kansas Public Employees Retirement System (KPERS)*, 85 F.3d 1353 (8th Cir. 1996). "[W]e are reluctant to fashion a rule requiring judges to recuse themselves from all cases that might remotely affect

⁵ *Aetna* is further distinguishable in that it is an extremely unusual situation where the Judge recognized the conflict and actually recused himself -- only to reinsert himself as Judge months later, after he believed the conflict to have been resolved.

nonparty companies in which they own stock. We believe such a rule would paint with too broad a stroke.” *Id.* at 1362. In fact, the 8th Circuit explicitly rejected an attempt to analogize and apply the reasoning of *Aetna* in the relative-as-attorney context to the dissimilar potential for financial-interest context which is before this Court. Rather than find a party’s request for recusal was appropriate, in view of the parties knowing of the potential issue for a year, the 8th Circuit noted that an “informed person might instead reasonably question the sincerity of [the moving party’s] belated concern.” *Id.* Plaintiffs’ “belated concern” raise the same doubts of sincerity here.

Furthermore, the 7th Circuit has consistently found that under §455(b) tenuous and speculative “financial interests” are simply not sufficient bases for disqualification:

The value of many assets, even the performance of the economy as a whole (and hence all assets), may depend on rules of law. It could be said that no judge who owns a house should render a decision that potentially affects the value of real estate in general, that no judge who owns stock should decide a case under the securities or antitrust laws, and so on. Effects of this sort are both ubiquitous and too indirect to require disqualification. Cf. *Union Carbide Corp. v. U.S. Cutting Service, Inc.*, 782 F.2d 710, 714-15 (7th Cir. 1986). The effects are small, and almost every judge will have some remote interest of this sort. Moreover, the effects may have offsets that are difficult to predict. A decision under the securities laws that diminishes somewhat the value of bonds may increase somewhat the value of stocks; no judge with a diversified portfolio will be able to predict the effect on his wealth, and therefore there is little risk of either actual bias or the appearance of impropriety.

New York City Development Corp. v. Hart, 796 F.2d 976, 979 -980 (7th Cir. 1986.) This kind of over-expansive reading of §455(b)(4) is exactly what Plaintiffs are now proposing. Plaintiffs’ position that §455(b)(4) requires a judge to recuse himself simply because a judgment might affect the rights of a corporation in which he owns stock simply has no basis in the statutory language of § 455(b)(4).

D. § 455(a) Does Not Apply Because The Court's Impartiality Cannot Reasonably Be Questioned

The primary reason Plaintiffs try so hard to stretch the meaning of §455(b)(4) is because under §455(a), their substantial delay in raising a purported conflict of interest becomes extremely relevant. *KPERS*, 85 F.3d at 1362-1363. The "catchall" provision of §455(a) does not apply, because under these circumstances a reasonable observer would not question the Court's impartiality. Indeed, Plaintiffs themselves did not question the Court's impartiality until they ran out of ideas to stall the close of discovery.

A judge must recuse himself "in any proceeding in which his impartiality might reasonably be questioned." 28 U.S.C. §455(a). However, this is an objective standard that asks if a reasonable observer would perceive "a significant risk that the judge will resolve the case on a basis other than the merits." *Hook v. McDade*, 89 F.3d 350, 354 (7th Cir. 1996). In evaluating whether a judge's impartiality might reasonably be questioned, the relevant inquiry is "from the perspective of a *reasonable* observer who is *informed of all the surrounding facts and circumstances*." *In re Sherwin-Williams Co.*, 607 F.3d 474, 477 (7th Cir. 2010) (citation omitted, emphasis in original). In addition to being well-informed about the surrounding facts and circumstances, a reasonable person is a "thoughtful observer rather than . . . a hyper-sensitive or unduly suspicious person." *Id.* at 478; *O'Regan v. Arbitration Forums, Inc.*, 246 F.3d 975, 988 (7th Cir. 2001). *See also Te-Ta-Ma Truth Foundation-Family of URI, Inc. v. World Church of the Creator*, 246 F.Supp.2d 980, 987 (N.D.Ill. 2003) (noting that an inquiry under §455(a) is made based on a reasonable person standard, as opposed to a "hypersensitive or unduly suspicious person," so as to avoid "a system of peremptory strikes and judge shopping").

There is simply no basis in this case on which to conclude that a reasonable, well-informed observer, fully apprised of the relevant facts, would perceive any risk, much less

significant risk, that this Court would resolve the case between the current parties on any basis other than its merits -- and Plaintiffs have pointed to none. A well-informed observer would understand that Plaintiff's claims against AT&T are speculative at best, and filed in bad faith for the purposes of disqualification at worst. Any complaint filed by Plaintiffs against AT&T Mobility will be challenged in its sufficiency, and moreover whether AT&T itself has an interest in the case depends in great part on whether Google chooses to indemnify AT&T.

With regard to the Motion for Leave specifically, a well informed observer would understand that there is no risk to AT&T since Plaintiffs have asserted that they will file separate suit against AT&T anyway; this Court cannot affect the ultimate outcome one way or another.

Finally, while a reasonable observer would not have any basis to question the Court's impartiality, it would have ample basis to question Plaintiffs' motives behind their fourth attempt to add defendants (two of which were dismissed almost a year ago) and issues to this case. Because Plaintiffs' claims against these "new" defendants, at least in part, rise or fall on the strength of their claims against Google, a reasonable, fully apprised observer would understand that the presence or absence of these potential defendants in this case is essentially irrelevant to any outcome. A reasonable observer would note that Plaintiffs could have attempted to add AT&T Mobility as a new defendant in this case at least as early as March, when it publicly announced AT&T Mobility's sale of phones using Google's Android operating system. However, they purposefully chose not to. A reasonable observer would further note that Plaintiffs have long been aware that adding AT&T Mobility as a defendant could create a potential recusal issue. And a reasonable observer would certainly note that Plaintiffs made no attempt to add AT&T Mobility as a defendant until the eve of the close of discovery and the filing of dispositive motions -- *after* Plaintiffs were recently sanctioned for their behavior in this

case. It would be clear to a reasonable observer that Plaintiffs are using the guise of an amended complaint to stall Google's forthcoming summary judgment motion, as well as to attempt to obtain a different judge who would be less familiar with Plaintiffs' unfounded allegations and vexatious litigation tactics.

Because a reasonable person would not question this Court's impartiality in ruling on the Motion for Leave, disqualification is not required under §455(a).

E. The Court *Should* Deny Plaintiffs' Motion for Leave

Google has addressed at length in its Response to Plaintiffs' Motion for Leave (Dkt. No. 222) and during the hearing of July 20th, the fact that the Court should deny Plaintiffs' Motion for Leave because (i) Plaintiffs have unduly delayed in seeking to add claims against parties whose alleged infringement Plaintiffs have been aware of for at least months, if not well in excess of a year, (ii) Plaintiffs' eleventh hour Motion for Leave is nothing more than a dilatory, bad faith tactic calculated to delay the resolution of this case, and (iii) the proposed amendment would result in significant prejudice to Google, inasmuch as it would delay the resolution of this case by months, if not years, all while Google continues to incur substantial costs and fees associated with defending the case. Because the Court is not legally precluded from ruling on Plaintiffs' Motion for Leave under 28 U.S.C. §455, there is simply no reason for this Court to refrain from doing so. Indeed, as the 7th Circuit has noted, a district judge is "obligated not to recuse himself without reason just as he is obligated to recuse himself when there is reason." *New York City Housing Development Corp.*, 796 F.2d at 981.

As such, the fundamental notions of judicial economy and fairness weigh in favor of denying Plaintiffs' Motion for Leave in a prompt fashion. This Court has invested significant time and effort in familiarizing itself with the facts and issues involved in this case -- time and effort which will have been for naught in the event that the Court were to recuse itself.

Moreover, if the Court were to grant Plaintiffs' Motion for Leave, the delay and resulting prejudice would be magnified even further while a new Judge gets up to speed on the facts and issues involved here.

As Google has advised the Court, Google intends to soon file its motion for summary judgment, on at least the basis that the Plaintiffs' alleged trademark rights are illusory and non-existent -- a motion that will fully dispose of all of Plaintiffs' claims against both Google and any other potential defendants. If the Court were to permit the requested eleventh hour amendment and then enter a recusal, this would result in a significant delay while a new Judge entertains a summary judgment motion in a case with which it has no familiarity. In contrast, if this Court denies the Motion for Leave, Plaintiffs suffer absolutely no prejudice and the Court is in position to promptly rule on Google's forthcoming summary judgment motion.

F. Conclusion

The Court should not recuse itself from either this case or from ruling on Plaintiffs' Motion for Leave to File their Third Amended Complaint. The Court should deny the Motion for Leave, for the reasons set out in Google's earlier briefing, and the Court should continue to move the case forward as expeditiously and fairly as it has throughout the pendency of this case.

Respectfully submitted,

Dated: July 23, 2010

/s/ Cameron M. Nelson
Herbert H. Finn
Richard D. Harris
Jeffrey P. Dunning
Cameron M. Nelson
GREENBERG TRAURIG, LLP
77 W. Wacker Drive, Suite 3100
Chicago, IL 60601

(312) 456-8400

Counsel for Google Inc.

CERTIFICATE OF SERVICE

I hereby certify that on the date set forth below, I electronically filed the foregoing and GOOGLE'S BRIEF REGARDING PLAINTIFFS' REQUEST FOR RECUSAL (REDACTED) with the Clerk of Court using the CM/ECF system, which will provide a copy to counsel of record.

Dated: July 23, 2010

s/ Cameron M. Nelson

EXHIBIT A

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

ERICH SPECHT, et al.,

Plaintiffs,

vs.

GOOGLE, INC., et al.,

Defendants.

No. 09 C 2572

Chicago, Illinois

July 20, 2010

9:30 o'clock a.m.

TRANSCRIPT OF PROCEEDINGS - MOTIONS
BEFORE THE HONORABLE HARRY D. LEINENWEBER

APPEARANCES:

For the Plaintiff:

NOVACK & MACEY
MR. P. ANDREW FLEMING
MR. JOHN F. SHONKWILER
100 North Riverside Plaza
Chicago, Illinois 60606
312-419-6900
and
MR. MARTIN J. MURPHY

For the Defendants,
Google, Inc.:

GREENBERG TRAURIG, LLP
MR. HERBERT H. FINN
MR. RICHARD D. HARRIS
77 West Wacker Drive
Chicago, Illinois 60601
312-456-8400

For the Defendant,
T-Mobile:

LOEB & LOEB, LLP
MR. ROBERT M. ANDALMAN
321 North Clark Street
Chicago, Illinois 60610
312-464-3100

Court Reporter:

**FEDERAL OFFICIAL COURT REPORTER
MS. KRISTA FLYNN BURGESSON
219 South Dearborn Street
Chicago, Illinois 60604
312-435-5567**

1

2

3

4

5

6

7

8

9

10

11

12

13

14

15

16

17

18

19

20

21

22

23

24

25

1 THE CLERK: 09 C 2572, Specht versus Google.

2 MR. FLEMING: Good morning, your Honor. Andrew
3 Fleming, John Shonkwiler, and Martin Murphy appearing on
4 behalf of the plaintiffs.

5 MR. SHONKWILER: Good morning, your Honor.

6 MR. MURPHY: Good morning.

7 MR. HARRIS: Good morning, your Honor. Richard
8 Harris and Herb Finn on behalf of defendant Google.

9 MR. FINN: Good morning, your Honor.

10 MR. ANDALMAN: Good morning, your Honor. Robert
11 Andelman for T-Mobile. We were a party previously. That is
12 spelled A-n-d-a-l-m-a-n.

13 THE COURT: All right.

14 MR. FLEMING: Your Honor, there are 3 motions up this
15 morning.

16 There is a motion for leave to amend the complaint
17 filed by the plaintiffs, which includes the joinder of 4
18 defendants, Sprint, T-Mobile, AT&T Mobility, and Verizon.

19 There is a motion to strike that motion filed by
20 Google, and --

21 THE COURT: I think it is a motion to strike the
22 complaint that was filed.

23 MR. FINN: Yes.

24 MR. HARRIS: Yes, that is correct. We filed a motion
25 originally and --

1 THE COURT: And you responded this morning or last
2 night to their motion?

3 MR. FLEMING: Yes, your Honor.

4 THE COURT: And then there is a motion to compel that
5 position.

6 MR. HARRIS: That is correct, Judge.

7 THE COURT: And you responded to that?

8 MR. FLEMING: We have not filed a written response to
9 that motion.

10 THE COURT: Yes, you did.

11 I read it this morning.

12 MR. FLEMING: Yes, okay, yes, we did address that in
13 the --

14 THE COURT: You did address that, okay. So I have
15 read everything you have written.

16 Now, does anybody want to say anything?

17 Actually, first, what I should say, and it is not the
18 basis for my ruling, but in full disclosure, if I did allow
19 the amendment, and AT&T came into the case, I would have to
20 recuse myself. My wife is a board member of the parent
21 company, AT&T, and we have an ownership interest. Obviously
22 we have many shares of AT&T.

23 MR. HARRIS: That is understood, your Honor.

24 I would like to respond with the Court's permission
25 on just a few points.

1 THE COURT: Okay.

2 MR. FLEMING: Could I just address that comment your
3 Honor has made?

4 THE COURT: Yes.

5 MR. FLEMING: Does your Honor feel that that would
6 effect your Honor's position in terms of ruling on the
7 motion?

8 THE COURT: I don't think so, because they are not a
9 party to the case, but I really didn't think about it.
10 Obviously if I let them in, I would have to get out
11 immediately.

12 MR. FLEMING: I mean, there will be a case filed
13 against them, your Honor, it is not --

14 THE COURT: If there is, obviously I would have to
15 recuse myself under whatever the statute is.

16 MR. FLEMING: I think even in ruling on it then --

17 We have not looked at the issue, your Honor, but we
18 would like to be able to look at the issue.

19 THE COURT: Let's ask Google.

20 What is your view of that?

21 MR. HARRIS: Your Honor, we have been before this
22 Court so many times over the years, we have no doubts
23 whatsoever that this Court can rule fairly and equitably.

24 THE COURT: The question is whether it can do so
25 legally.

1 I think I can rule fairly.

2 MR. HARRIS: Yes.

3 THE COURT: But legally whether I can rule, that is
4 the issue.

5 If it is a motion to bring in a party -- if it
6 brought in, I would have to recuse myself.

7 MR. HARRIS: Well, thanks to plaintiff, your Honor,
8 that is really not a problem. It was just stated on the
9 record that they are going to go after AT&T no matter what the
10 Court rules.

11 So, in essence, regardless of how the Court rules,
12 AT&T eventually, according to what we have just heard, will be
13 a party in some case, probably assigned to some other Judge,
14 and I don't believe it effects at all this Court's ability to
15 rule on the motion.

16 MR. FINN: Moreover, your Honor, AT&T stands with the
17 other 3 potential defendants, or at least in the similar
18 position of the other potential defendants, and we assume you
19 have no issue with that, and that the ruling would be based
20 more on --

21 THE COURT: I have no issue with any of the other
22 defendants.

23 MR. FINN: Right.

24 And since they are similarly situated, it would
25 appear logical that you should be able to rule on the

1 entirety.

2 MR. FLEMING: Well, we do have a concern, your Honor,
3 and we would like to present something in writing to the
4 Court. We would like to look at this issue and present
5 something in writing.

6 We certainly are not going to --

7 THE COURT: Well, if I continue that motion --

8 I can rule on the motion for depositions, I believe.

9 MR. HARRIS: Very well, your Honor.

10 And also, certainly you can rule on the motion --

11 THE COURT: I can give a time and --

12 This is more for my own concern. I mean, I don't
13 want to do something illegal. I don't think it would be
14 illegal for me to rule on the motion, but --

15 MR. HARRIS: Understood.

16 MR. FLEMING: We can certainly get something on file
17 very quickly, your Honor.

18 THE COURT: That is what I am thinking of.

19 MR. FLEMING: We would certainly do that.

20 And we are back in court next Tuesday on the
21 continued motion to --

22 THE COURT: I am concerned about the motion because
23 of the discovery deadline, the other motion, which there is no
24 question I can rule on, having not taken up the issue of
25 bringing in any other additional defendants.

1 MR. HARRIS: Your Honor, could the Court rule on the
2 other 3 named parties, 2 of which were named in one of the
3 early amended complaints or one of the original complaints
4 over a year ago? Could the Court address just the 3, and
5 remove for now the issue of AT&T, so that this Court can
6 fairly and equitably address a motion for leave to amend a
7 complaint that is being brought ten days, in essence, before
8 the close of discovery in this case, while a separate motion
9 for extending discovery is still pending?

10 This is another approach, and I should mention to the
11 Court that there are 4 depositions scheduled over the next ten
12 days, one of which is the court ordered deposition --

13 THE COURT: That is what I was thinking of ruling on,
14 a motion --

15 MR. HARRIS: (Continuing) -- which was the subject of
16 a sanction order.

17 THE COURT: (Continuing) -- a motion to compel
18 depositions.

19 Now, that I can put off say until next week for
20 ruling on the motion to amend. They have tied them together,
21 but I don't see the basis for not ordering the depositions to
22 go forward.

23 It was agreed -- as I understood from looking at all
24 the E-mails back and forth, they were agreed to, the dates, up
25 to a few days ago, a week ago. I don't have it in my mind

1 exactly what the date was when Mr. Shonkwiler, I think,
2 notified Google's attorneys that the depositions would not go
3 forward because of the plan to file the third amended
4 complaint, bringing in new parties.

5 MR. SHONKWILER: Judge, this all happened rather
6 fast, and the one part of this that I think needs a little
7 clarifying is we don't want to postpone dispositive briefing
8 and we don't want to postpone discovery any more than we have
9 to if no new defendants were added.

10 There is some extension of the discovery deadline
11 that is necessary, and we will file a brief tomorrow if that
12 deadline stays on the calendar for filing a brief for the
13 defendant motion to extend discovery, just because discovery
14 is not complete between Google and the plaintiffs.

15 But apart from the extension that is needed for that
16 purpose, we don't want to postpone dispositive briefing, any
17 summary judgment briefing, in this case.

18 If we can add the new parties, and get that briefing
19 schedule on the same track, it would be otherwise. None of
20 this needs to be cause for delay or expense, and no party here
21 wants to delay this trial or this summary judgment briefing,
22 and no party here wants to add expense.

23 I think that is the part where we missed each other
24 apparently on the phone, and at the briefing.

25 I talked to counsel outside of the courtroom this

1 morning, but just very briefly, and I don't know whether we
2 will be able to agree to a schedule for briefing and/or for
3 the addition of parties, but that is the part that I think is
4 not --

5 THE COURT: Well, the motion for briefing additional
6 parties is fully briefed, as far as I am concerned. I mean, I
7 am aware of the issues. Now the only question is whether or
8 not I legally can rule on it.

9 MR. HARRIS: There is one issue, Judge, that came up,
10 besides the delay and the representations that were being made
11 up, and the fact that this information has been known over a
12 year, that all of a sudden now it justifies things.

13 There was a transcript that was attached to the
14 motion we received last night, and with the Court's
15 permission, I would like to give the Court the entire segment
16 of the transcript as opposed to the one that was simply
17 paraphrased in the brief that was filed last night.

18 May I approach, your Honor?

19 THE COURT: Yes.

20 MR. HARRIS: Now, this particular transcript, and I
21 believe it is from February 23rd, I happened to be there that
22 day, and there is mention of the fact that there is a
23 reference that --

24 MR. FLEMING: Your Honor, we are now arguing the
25 motion that your Honor has indicated we will have an

1 opportunity to file something on.

2 I don't think this makes sense.

3 THE COURT: I don't need anything else to --

4 MR. FLEMING: We are not arguing enjoinder or arguing
5 discovery.

6 THE COURT: The only issue before me that I need is
7 that I think I should obtain input from you on whether or not
8 I legally have to recuse myself because you filed a motion to
9 bring in a party which, if I allow in, will require me to
10 recuse myself.

11 MR. HARRIS: I understand that, Judge.

12 I thought you were asking is there anything else that
13 either of the parties wanted to say with regard to the motion
14 to amend the complaints now for a third time before we address
15 deferring that issue until the Court addresses the concern of
16 recusal.

17 THE COURT: What I said is I thought I had sufficient
18 information from the briefing, particularly, the one that you
19 filed, the motion you filed with the brief, and then the brief
20 -- the 2 briefs, actually, they had the motion to amend, and
21 their brief that was filed -- I received a copy this morning
22 when I came in, and I have read it, but it is plaintiff's
23 memorandum in support of their motion for leave to file a
24 third party complaint in opposition of the motion to strike
25 the same and so on.

1 Now, you wanted to supplement what they -- one of
2 their exhibits, is that what you are saying?

3 MR. HARRIS: Yes, Judge.

4 I just wanted to add, because we were not aware that
5 they would be relying on the transcript of February 23, 2010,
6 but skip the first page where the Court specifically says --
7 and says it to Mr. Fleming, no less, that it will allow
8 Mr. Fleming to amend the pleadings up to July 15th, but not to
9 join new parties.

10 THE COURT: I think they did have that in here,
11 didn't they?

12 MR. HARRIS: I don't believe they had that page.

13 They had the reference a page or two later that
14 suggests if they want to come in with new parties, they would
15 have to file a motion that justifies it.

16 THE COURT: Yes, yes.

17 It was clear that I took that position that it would
18 require a motion, they couldn't do that on their own, but the
19 amendments contemplated would be clean up amendments, so to
20 speak, and that type of thing.

21 MR. HARRIS: That is correct, your Honor.

22 With that, that is all we have to add to supplement
23 then.

24 THE COURT: All right.

25 As far as the motion then to -- the other motion that

1 Google filed to compel the depositions, I am going to grant
2 that. It seems to me that there was an agreement reached, and
3 I am just looking through all the E-mails back and forth, that
4 the depositions would be taken within the Court imposed
5 discovery closure, and that they should have been, unless by
6 agreement of parties, gone through.

7 So, I will order that, that they be completed by the
8 discovery close.

9 MR. HARRIS: Thank you, your Honor.

10 THE COURT: So, that motion is granted.

11 MR. HARRIS: Thank you.

12 MR. SHONKWILER: Your Honor, tomorrow is the deadline
13 for briefing, any additional briefing, in support of the
14 pending motion extending discovery, the discovery deadline.
15 As I said before, we will be filing a brief to extend what
16 impact, if any, that will have on the ruling your Honor just
17 made.

18 THE COURT: None, none.

19 It seems to me there was an agreement reached to
20 produce witnesses at particular times, and if plaintiff -- I
21 assume Google knows that if they wish to depose the parties
22 again, they would have to seek leave of Court to do so.

23 MR. HARRIS: That is understood, your Honor.

24 MR. ANDALMAN: It is not Google, your Honor, it is
25 the other parties.

1 MR. MURPHY: We wanted to avoid the --

2 THE COURT: I am saying Google, if they wish to
3 depose your witnesses a second time because, if I grant -- or
4 if some Judge grants leave to bring in new parties, that they
5 would have to seek leave of Court to depose your people again,
6 not to say that the new parties wouldn't have an opportunity
7 to depose them, but that --

8 MR. SHONKWILER: That was our only concern, that the
9 new parties would, and we are not refusing to produce these
10 parties for deposition.

11 THE COURT: If I allow the amendment, that is the
12 problem you run into this late in the game by amending.

13 So, we will put the motion to amend the third amended
14 complaint over to next week, and you should file something by
15 the end of this week, just simultaneously file something by
16 the end of the week as to whether or not legally I can rule
17 on the motion.

18 You can also put in your arguments why perhaps I
19 shouldn't rule on it, and/or if you conclude I legally should
20 do it, I won't limit you to that, you can put anything you
21 want in there, whether I should recuse myself now, because you
22 have raised the specter of adding a party which would force me
23 to recuse myself, or whether I can rule on that legally, but
24 perhaps I shouldn't, because of whatever reason you can think
25 of.

1 MR. HARRIS: Very well.

2 You would like that filed by Friday?

3 THE COURT: Yes, so we can review it.

4 And we will continue the motion over until next
5 Tuesday.

6 MR. HARRIS: Okay.

7 THE CLERK: Tuesday, the 27th, at 9:00.

8 THE COURT: Okay.

9 MR. FLEMING: Can we have also until Friday to file
10 our brief in support of the extension for discovery?

11 THE COURT: Is the motion for extension up?

12 MR. FLEMING: It is up next Tuesday.

13 MR. FINN: Your Honor ordered that tomorrow the
14 plaintiffs file a supplemental brief, if necessary, for the
15 continued motion to extend discovery.

16 MR. FLEMING: It is due tomorrow, yes, but we will
17 obviously be in Mr. Specht's deposition tomorrow.

18 THE COURT: Wait a minute.

19 What is up tomorrow before me, anything?

20 MR. FLEMING: No, but we are supposed to file a
21 further brief tomorrow, your Honor, in support of our motion
22 to extend the discovery cut off. Your Honor wanted to see
23 what happened at the 30(b)(6) depositions and wanted us to
24 come and file supplemental briefs.

25 THE COURT: Okay.

1 MR. FLEMING: And so what I am suggesting is that
2 we file that on Friday as well, and that will be up next
3 Tuesday as well.

4 THE COURT: You can file it on Friday.

5 MR. FLEMING: Thank you, your Honor.

6 MR. HARRIS: Thank you.

7 THE COURT: All right.

8 (Proceedings concluded.)

9

10

11

12

C E R T I F I C A T E

13

14 I certify that the foregoing is a correct transcript
15 from the record of proceedings in the above-entitled matter.

16

17 /s/Krista Burgeson, CSR, RMR, CRR July 20, 2010
18 Federal Official Court Reporter Date

19

20

21

22

23

24

25

EXHIBIT B

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

ERICH SPECHT, et al.,
Plaintiffs,

vs.

GOOGLE, INC., et al.,
Defendants.

No. 09 C 2572

Chicago, Illinois
June 4, 2009
9:00 o'clock a.m.

TRANSCRIPT OF PROCEEDINGS - STATUS AND MOTION
BEFORE THE HONORABLE HARRY D. LEINENWEBER

APPEARANCES:

For the Plaintiffs:

LAW OFFICE OF MARTIN J. MURPHY
MR. MARTIN J. MURPHY
2811 RFD
Long Grove, Illinois 60047
847-540-8899

For the Defendant,
Google, Inc.:

GREENBERG TRAURIG, LLP
MR. HERBERT H. FINN
MR. RICHARD D. HARRIS
77 West Wacker Drive
Chicago, Illinois 60601
312-456-8400

For the Defendant,
T-Mobile:

LOEB & LOEB
MR. ROBERT M. ANDALMAN
MS. EMILY R. HAUS
321 North Clark Street
Chicago, Illinois 60610
312-464-3100

1 Court Reporter:

FEDERAL OFFICIAL COURT REPORTER

MS. KRISTA BURGESSON

219 South Dearborn Street

Chicago, Illinois 60604

312-435-5567

Krista_Burgesson@ilnd.uscourts.gov

2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25

1 THE CLERK: 09 C 2572, Specht versus Google.

2 MR. MURPHY: Good morning, your Honor. Martin Murphy
3 on behalf of the plaintiffs.

4 MR. HARRIS: Good morning, your Honor. Richard
5 Harris and Herb Finn on behalf of Google.

6 MR. FINN: Good morning.

7 MR. ANDALMAN: Good morning, your Honor. Robert
8 Andelman and Emily Haus for T-Mobile.

9 MS. HAUS: Good morning.

10 THE COURT: Status today?

11 MR. MURPHY: Your Honor, at this point the
12 plaintiffs have decided to withdraw their motion for the
13 preliminary injunction at this time and rather get all the
14 pleadings in order, get everybody in, and perhaps proceed at
15 that point.

16 THE COURT: So, the motion for the preliminary --
17 for the TRO and the preliminary injunction are withdrawn?

18 MR. MURPHY: Yes.

19 MR. HARRIS: They are done. That is correct, your
20 Honor.

21 THE COURT: Okay.

22 MR. HARRIS: Before addressing plaintiff's motion to
23 amend the complaint under plaintiff's interpretation of Rule
24 15, Judge, I did want to mention that after the Court opened
25 up the opportunity to take some discovery, and we put together

1 a schedule, we identified 4 witnesses that we were going to be
2 taking here and in California, came in with briefing dates and
3 things like that, and right after that -- oh, and we started
4 exchanging some documents as well, and right after that, the
5 motion was withdrawn.

6 Here we are now, and instead of subtracting
7 defendants from the complaint, apparently we are going to be
8 adding some new defendants to the amended complaint.

9 THE COURT: Let me see.

10 Who have you got in here? Is AT&T in here?

11 MR. MURPHY: No, AT&T is not.

12 THE COURT: Okay.

13 MR. MURPHY: I have added 5 defendants, your Honor,
14 4 of them are employees of Google, and one is Android Inc.,
15 which is a subsidiary of Google, and Android Inc. was actually
16 incorporated by the 4 employees of Google. They purchased
17 Android Inc. from these individuals.

18 MR. HARRIS: Unfortunately, your Honor, we not only
19 don't have a copy of the proposed amended complaint, again,
20 because of what is happening under Rule 15, according to
21 plaintiff, we have no basis whatsoever for the addition now
22 of individual employees of Google, as well as a wholly-owned
23 sub.

24 MR. MURPHY: None of the defendants have answered.
25 None of the defendants' answers are due until at least the

1 29th, because I originally served everybody with notice and
2 request for waivers.

3 So, there are no answers in the file yet. No one has
4 filed. No one's answers are due for another 25 days, at the
5 earliest.

6 THE COURT: When are you going to file the amended
7 complaint?

8 MR. MURPHY: Today. I have to file it
9 electronically, so I will go back to my office, once I have
10 leave, and file it today.

11 THE COURT: And incidentally, what is the Astonishing
12 Tribe?

13 MR. MURPHY: The Astonishing Tribe, Inc.?

14 THE COURT: AB.

15 MR. MURPHY: Yes.

16 THE COURT: What is it?

17 MR. MURPHY: It is a corporation. It is one of the
18 -- there are 47 members of the open handset alliance, and the
19 open handset alliance together with Google are the -- the
20 manufacturers or makers of this Android software.

21 So, these are all members of this open handset
22 alliance.

23 MR. HARRIS: Your Honor, there are 48 or 49 --
24 actually, there will be 52 or 53 co-defendants now. The vast
25 majority of those co-defendants have been sued because they

1 belong to a trade association. There has been no pleading,
2 much less any kind of showing, that they have actually used
3 the mark, much less used that mark in commerce, but because
4 they belong to this handset association, they have been sued.

5 That is where this case is going.

6 THE COURT: Well, I am taking counsel on his word
7 that there is Rule 11.

8 Will you be representing many of them?

9 MR. HARRIS: We expect to, your Honor. Some of them
10 have not been served yet.

11 THE COURT: We will not end up with 47 lawyers?

12 MR. MURPHY: So far we have 6, and only 2 defendants
13 represented.

14 MR. HARRIS: You have the room for it but I don't
15 think that will happen, Judge. That won't be the case.

16 Frankly, by the time the response period comes into
17 play in terms of responding to the allegations in the
18 complaint, I think it will come down in size considerably.

19 THE COURT: Okay.

20 Well, I will grant the motion to file the first
21 amended complaint.

22 That is adding parties, right?

23 MR. MURPHY: It is adding parties. It is correcting
24 typos, because some of the names -- I took all the names off
25 their web site, I was rushing to get this in, some names were

1 abbreviated, and I had to go back and do some research to find
2 their legal names.

3 It was pointed out by some of the attorneys for some
4 of the various defendants that the actual member of the open
5 handset alliance is not the company name, but another company,
6 and so I needed to correct some of the defendants' names, put
7 in the jurisdiction, their residency, and some of the counts
8 were --

9 THE COURT: But AT&T is not a member of the alliance;
10 is that correct?

11 MR. MURPHY: They are not.

12 THE COURT: Okay.

13 MR. HARRIS: We don't represent the alliance, your
14 Honor, so I don't know.

15 I can tell the Court though that in view of the fact
16 that we have already started producing documents, and we had a
17 mini schedule for accommodating the now withdrawn motion for
18 preliminary injunction, that it is really, really important in
19 this case that we start addressing discovery, and we wanted to
20 request in stanter the Court's approval for us to exchange
21 discovery immediately to that purpose.

22 I think it is going to be very, very important in
23 this case to start addressing the facts behind these
24 accusations.

25 MR. MURPHY: Your Honor, with respect to the

1 documents they produced, all they produced so far, is Google's
2 10-K's and 10-Q's, quarterly filings with the SEC, which are
3 not even relevant to this case.

4 I would like to get everybody in and get everybody's
5 pleadings so we can at least form what the case is about,
6 figure out exactly what the issues are, and what positions
7 everybody is taking.

8 Counsel wants to proceed with discovery, yet he has
9 never filed a responsive pleading to my motion, my memorandum,
10 or has ever produced any answer to the complaint.

11 So, I would like to know what exactly -- what are
12 the -- what is the dispute.

13 THE COURT: You have sent out requests to waive
14 service; is that correct?

15 MR. MURPHY: Correct.

16 THE COURT: And do you anticipate that all the
17 parties that you will be representing will waive service? Do
18 you anticipate them to waive service?

19 MR. HARRIS: We expect a lot will, and a good number
20 will not. We don't know right now for sure.

21 I can tell you, Judge, that this is now the third
22 appearance for the motion for preliminary injunction that has
23 now been withdrawn.

24 There was a sense for urgency, and now all of a
25 sudden, the brakes are put on.

1 We want to get to the facts of this case. We need to
2 at least exchange discovery to that purpose, Judge, instead of
3 waiting 60 or 90 days to find out what this case is about.

4 MR. MURPHY: Your Honor, the purpose of the temporary
5 restraining order was to block the developer's conference
6 which took place on May 27th and May 28th, that was the
7 purpose of the TRO, to stop that.

8 When that didn't happen, we were going into the
9 preliminary injunction, and it seemed fruitless to have one
10 defendant preliminarily enjoined as opposed to all the
11 defendants that are actually infringing on the trademark.

12 So, I thought it best, rather than wasting the
13 Court's time and all the attorneys' time, coming in here one
14 at a time seeking preliminary injunctions, to have everybody
15 in here, frame the issues, and then proceed.

16 So, I think it is best that we get answers on file
17 and proceed in the normal fashion.

18 THE COURT: Who is before the Court now, Google?

19 MR. HARRIS: That is correct, your Honor.

20 THE COURT: Who else?

21 MR. ANDALMAN: Your Honor, we filed an appearance on
22 behalf of T-Mobile. There are some service issues that we
23 need to talk to Mr. Murphy about. We received a waiver of
24 service request this week, I am not sure it is the right
25 entity, so we are not technically served, and we haven't

1 waived service at this point, but we have filed an
2 appearance.

3 MR. HARRIS: Your Honor, we were told at the last
4 hearing on the 21st that the preliminary injunction action was
5 not being targeted toward anybody else other than Google.

6 We have just been told now that the purpose, the
7 intent, behind the preliminary injunction was to stop
8 everybody. We are getting frustrated with the little
9 misdirection here.

10 The Court certainly may recall the fact that Google
11 was the target for the preliminary injunction. Now that has
12 been withdrawn. Google would like to know the basis for this
13 complaint.

14 And we are well aware of this Court's position on not
15 only the formal discovery, but the informal exchange of
16 discovery, and anything we can do to get things going as soon
17 as possible to find out if there is, in fact, any basis for
18 this complaint, would sincerely be appreciated.

19 THE COURT: When would you anticipate --

20 I mean, are you going to file an answer or a motion
21 or --

22 MR. FINN: Yes.

23 MR. HARRIS: We are going to be answering, or
24 otherwise responding, probably otherwise responding, certainly
25 well within the period that the waiver request addressed.

1 THE COURT: Which is what?

2 MR. HARRIS: The deadline I think is the 29th of
3 June.

4 MR. FINN: 29th or 30th, based on the current
5 complaint, your Honor.

6 THE COURT: What exactly --

7 Well, what discovery do you want at this point?

8 MR. HARRIS: We want to go into, as this Court knows,
9 the crucial issue of abandonment. We want to simply find out
10 what business this individual did between 2001 and 2009 when,
11 on the day before its trademark was going to go abandoned, it
12 all of a sudden resurrected all of its companies, started
13 filing, doing all sorts of things, and within a day or two
14 after, filed suit.

15 We want to simply find out, take a look, at what
16 business he has been doing, because we --

17 THE COURT: The problem is if you depose -- do you
18 want to depose someone, or is this just written discovery?

19 MR. HARRIS: I'm sorry?

20 THE COURT: Do you want to depose someone or is it
21 written discovery?

22 The problem I see as far as depositions are
23 concerned, you know, we have got a bunch of defendants who
24 aren't in the case, and aren't participating, which would mean
25 duplicating it, and that is why it makes some sense to delay

1 it.

2 ~~I don't have a problem with some written discovery~~
3 ~~targeted for a specific purpose.~~

4 MR. HARRIS: Your Honor, for now, the written
5 discovery would be the limits of what we are looking at.

6 We would like to be able to get some Answers to
7 Interrogatories. We want to see documents, that is what we
8 want to see.

9 We realize we are not in a situation where we need
10 depositions for a preliminary injunction hearing, because
11 conveniently, that has now been withdrawn.

12 MR. MURPHY: Your Honor, every time we have come in
13 here they want to answer, they want to respond, and then every
14 time I try to get a response out of them, they want to do
15 discovery.

16 Counsel has stated that we have got tons of documents
17 that establish abandonment, yet they have never pled
18 abandonment except in here to argue that -- I mean,
19 abandonment is their affirmative defense, or they file a cross
20 complaint for cancellation.

21 They haven't sought to cancel my client's trademark
22 registration ever. They used it. They knew about it since
23 February of 2008 that my client had the registered mark,
24 Android Data, but they took no action. They waited for us to
25 come in on the assumption that we will lose it.

1 THE COURT: Well, I will permit Google, as soon as
2 you file a responsive pleading, to send out written discovery
3 limited to the issue of abandonment.

4 That is what you want; is that correct?

5 MR. HARRIS: Yes, your Honor.

6 MR. MURPHY: And then would I also be allowed
7 discovery with regard to their search, their trademark search,
8 and investigations?

9 THE COURT: Written discovery.

10 You want it as to what, now?

11 MR. MURPHY: Well, what steps they took before using
12 the name Android did they take to ensure that they weren't
13 infringing on my client's trademark.

14 I believe one of the defendants, Android Inc.,
15 actually began the infringement in 2003, one year after my
16 client registered his trademark.

17 So, that is why I am adding Android Inc., which was
18 then purchased by Google, for the purposes of issuing this
19 Android software.

20 THE COURT: You want written discovery on --

21 MR. MURPHY: With respect to the trademark research,
22 as to Google and Android Inc., as to the research they did
23 with respect to the trademark, Android, that they tried to
24 register.

25 MR. HARRIS: Your Honor, that would be discovery on

1 the issue of willfulness. I don't know if that is a crucial
2 substantive issue right now.

3 MR. MURPHY: Well, abandonment -- you are going to
4 allege that we abandoned it at some point in time, and if you
5 started using it before any abandonment, and you have
6 infringed before any abandonment, if there was such a thing of
7 abandonment, which we of course dispute, then certainly there
8 is this timeframe here that we would like to know about.

9 We would like to know when did they start their
10 infringing activities, what was the -- they had a web site,
11 Android Inc., they had -- I'm sorry, a web site, Android.com,
12 they had the corporation, Android Inc., which was registered
13 in California, registered in California and Delaware, and we
14 have these 4 individuals that were --

15 MR. HARRIS: Your Honor, apparently we are going to
16 have some new trademark law that will be generated in this
17 case where, under plaintiff's claim, if someone started using
18 a mark illicitly or unlawfully before it was abandonment, then
19 abandonment is somehow told or stayed along the way, which is
20 --

21 THE COURT: I suppose if it hadn't been abandoned,
22 there would be a period of time prior to abandonment where
23 there might be damages. That is possible.

24 MR. HARRIS: That would be a big if, your Honor, but
25 I don't believe that is the case.

1 We are looking at 7 years of nonuse in this case. We
2 want to see -- we want to see that which was promised to us
3 before the motion was withdrawn.

4 MR. MURPHY: Every time we come in the number
5 changes, 3 years, 4 years, 5 years, and now it is 7 years.
6 This is why I need a response, your Honor. Their information
7 changes.

8 THE COURT: You will get an answer or other pleading
9 at some point.

10 MR. MURPHY: Yes, then we will take it from there, I
11 guess.

12 THE COURT: Right.

13 So, you can take paper discovery limited to the issue
14 of the efforts made to research -- what is it?

15 MR. MURPHY: To investigate the trademark.

16 THE COURT: To investigate the trademark, yes.

17 MR. MURPHY: Also, counsel said he has loads of
18 documents showing their investigation, and I would like to see
19 those documents.

20 THE COURT: I will let you retain those.

21 So, we will have a status in July then, because your
22 answer or other pleading will be in then, or if have you a
23 motion, you will probably come in on it.

24 MR. HARRIS: Very well.

25 THE COURT: All right.

1 Give them a date in July.

2 THE CLERK: July 22 at 9:00.

3 MR. MURPHY: Thank you, your Honor.

4 MR. HARRIS: Thank you.

5 MR. FINN: And your Honor, just so we are clear, the
6 preliminary injunction hearing date of July 8th is gone?

7 THE COURT: It is vacated on the basis of the
8 withdrawal of the motion for both TRO and the preliminary
9 injunction.

10 MR. FINN: Thank you.

11 MR. HARRIS: Thank you, your Honor.

12 MR. MURPHY: Thank you.

13 MR. ANDALMAN: Thank you.

14 (Proceedings concluded.)

15

16

17 C E R T I F I C A T E

18

19 I certify that the foregoing is a correct transcript
20 from the record of proceedings in the above-entitled matter.

21

22 /s/Krista Burgeson, CSR, RMR, CRR June 4, 2009
23 Federal Official Court Reporter Date

24

25

26

EXHIBIT C

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

ERICH SPECHT, et al.,)	
)	Civil Action No. 09-cv-2572
Plaintiffs,)	
v.)	Judge Leinenweber
)	
GOOGLE INC.)	Magistrate Judge Cole
)	
Defendant.)	

DECLARATION OF HERBERT H. FINN

1. My name is Herbert H. Finn. I am a partner with Greenberg Traurig, LLP and counsel to Google Inc. in the above-captioned case.

2. On more than one occasion in this case, the Court has apprised the parties, both on and off the record, that if AT&T was a party to the case the Court may have to consider recusal because of the Court's spouse's relationship with AT&T.

3. I have reviewed the transcripts that are in our possession and located one such hearing in which the Court mentioned AT&T dated June 4, 2009. During that hearing, the Court twice confirmed that AT&T was not a party. (June 4, 2009 Transcript, pp 4-7). While this is the only transcript I have located, I am certain there were other instances where the Court, in the presence of both parties, specifically addressed the potential conflict if AT&T were added as a Defendant.

I declare under penalty of perjury under the laws of the United States that the foregoing information is true and correct to the best of my knowledge, information and belief.

Date: July 23, 2010

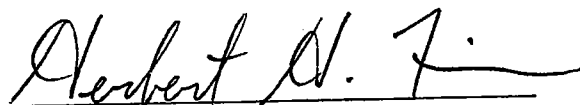

Herbert H. Finn

EXHIBIT D

(Filed Under Seal)

**IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION**

ERICH SPECHT, an individual and doing business
as ANDROID DATA CORPORATION, and THE
ANDROID'S DUNGEON INCORPORATED,

Plaintiffs/Counter-Defendants.

V.

GOOGLE INC.,

~~Defendant/Counter-Plaintiff.~~

Civil Action No. 09-cv-2572

Judge Harry D. Leinenweber

**PLAINTIFFS' REPLY MEMORANDUM IN FURTHER SUPPORT OF
THEIR MOTION FOR DISQUALIFICATION PURSUANT TO 28 U.S.C. §455**

Plaintiffs, by their attorneys, Novack and Macey LLP and Martin J. Murphy, respectfully submit this Reply Memorandum in Further Support of Their Motion for Disqualification Pursuant to 28 U.S.C. §455.

ARGUMENT

This Reply addresses three (3) issues raised by Google’s Brief Regarding Plaintiffs’ Request for Recusal (the “Response” or “Resp. at ”).

First, the Response misidentifies grounds for Plaintiffs’ motion under Section 455(b). Plaintiffs’ Motion for Disqualification Pursuant to 28 U.S.C. §455 (the “Motion”) relies on Section 455(b)(4) and (b)(5)(iii). Section 455(b)(4) requires disqualification in any of three circumstances, namely, where the Judge or his family has: (1) a financial interest in the subject matter in controversy; (2) a financial interest in a party to the proceeding; or (3) any other interest that could be substantially affected by the outcome of the proceeding. 28 U.S.C. §455(b)(4). Additionally, Section 455(b)(5)(iii) provides for disqualification if the Judge’s

family has any interest that could be substantially affected by the outcome of the proceeding, so it, too, is not limited to an interest in a current-party. 28 U.S.C. §455(b)(5)(iii).

Because AT&T is not yet a party to this action, Plaintiffs relied (for now) on the first and third prongs of Section 455(b)(4), and Section 455(b)(5)(iii). Plaintiffs made this point very clear; for instance, they explicitly stated that Section 455(b)(5)(i) does not yet apply because AT&T is not yet a party. (See Plaintiffs' Memorandum in Support of Their Motion for Disqualification Pursuant to 28 U.S.C. §455 [Dkt. No. 228], at 6 n.2.) Nevertheless, the Response addresses only the current-party prong of Section 455(b)(4) and Section 455(b)(5)(i). (Resp. at 5-6.) Because these are not the basis for Plaintiffs' motion, Google's discussion of these sections is irrelevant.

Second, the primary authority cited by Google -- In re Kansas Pub. Employees Ret. Sys. (KPERS), 85 F.3d 1353 (8th Cir. 1996) does not support Google's opposition to disqualification. Instead, KPERS supports Plaintiffs' argument that the Court should not decide the Motion to Amend and, on the collateral estoppel issue, the case is distinguishable.

The judge in KPERS was faced with three motions for intervention, one filed by a bank ("Boatman's") and two by law firms ("Blackwell" and "Shook"). Id. at 1355. The judge "*sua sponte* disqualified himself from presiding over the applications to intervene and had them reassigned to another federal district judge." Id. The judge "recused himself from deciding Boatmen's application because he owned stock in Boatmen's parent company." Id. The judge's decision to disqualify himself from deciding the motion for intervention -- i.e., whether an entity in which he had a financial interest should become a party to the lawsuit pending before him -- is remarkably similar to the situation here, where Plaintiffs maintain that the Court should not

decide whether AT&T should become a party. For this reason, KPERS further supports disqualification here.

When the motions for intervention were filed in KPERS, the judge disclosed his interest in Boatmen's and asked the parties to anonymously submit any objections to his presiding over the case. Id. KPERS did not raise any objection to the judge continuing in the case at that time. Id. at 1355-56. Nevertheless, as noted, the judge disqualified himself from ruling on the motions for intervention, including Boatmen's. When Boatmen's motion to intervene was denied, the judge resumed his involvement in the case. Approximately a year later, KPERS moved to disqualify the judge because, *inter alia*, Boatman's was the plaintiff in a separate action against KPERS. Id. at 1357.

The Eighth Circuit held that the motion to disqualify was untimely. Id. at 1359. This is because the Eighth Circuit -- unlike the Seventh Circuit -- imposes a non-statutory timeliness requirement on motions brought under Section 455. Id. at 1360 ("even though §455 has no express timeliness requirements, claims under §455 will not be considered unless timely made") (citations omitted). Conversely, the Seventh Circuit has explicitly rejected any timeliness requirement for motions under Section 455. E.g. SCA Servs., Inc. v. Morgan, 557 F.2d 110, 117 (7th Cir. 1977). As a result, the KPERS court's decision is based on a requirement that does not exist in the Seventh Circuit. And, the court's discussion of the timeliness of the motion to disqualify, and KPERS' alleged bad faith in waiting to bring the motion, are irrelevant.

Notwithstanding its ruling that the request was untimely, the KPERS court also discussed, in dicta, whether the judge should have been disqualified because of the potential collateral estoppel effect of rulings in the main case on the separate, Boatmen's action. KPERS, 85 F.3d at 1361. The court held that the judge did not need to be disqualified on this basis, but

not for the reasons stated in Google's Response. KPERS did not universally reject the potential for disqualification based on a related case; it just found that the issues raised in the allegedly related cases were not sufficiently similar for collateral estoppel to be applied. Id. The court noted that the claim in the Boatmen's case arose out of "separate and distinct contractual obligations" which were "not presented in the case pending before [the judge]." Id. Based on the lack of overlapping issues, the court concluded "we do not view this case as one involving potential collateral estoppel." Id.; see also Gordon v. Reliant Energy, Inc., 141 F.Supp.2d 1041, 1043 (S.D. Cal. 2001) (recognizing that, in KPERS "the Eighth Circuit declined to consider whether a judge's ruling in one case would have a collateral effect on issues in a separate case because there were no common issues remaining in the two cases") (emphasis added).

Here, the issues raised by Plaintiffs' claims against Google and Plaintiffs' claims against AT&T are identical in virtually every respect. Plaintiffs are asserting the same causes of action against AT&T as they are against Google. (Compare Third Amended Complaint [Dkt. No. 216], Counts I, II, III & IV (against Google) with Counts VI, VII, VIII & IX (against AT&T and others).) The claims are all based on Google and AT&T's use of the mark "Android" in connection with the sale and distribution of mobile devices that run on Google's Android OS. If the sale and distribution of "Android" mobile devices infringes Plaintiffs' marks, then both Google (which supplies the Android OS) and AT&T (which sells the "Android" mobile devices and supplies them wireless service) will be liable for infringement. (Id.) Likewise, the claims are both subject to the same legal defenses -- particularly the defense of abandonment, which Google says it will be presenting to this Court for decision very soon. Because the abandonment defense turns on Plaintiffs' use and intent to use its trademarks, the legal and factual issues raised thereby will be exactly the same whether the abandonment defense is raised by Google or

AT&T. Thus, while there was no commonality between the actions at issue in KPERS, here, the claims and defenses will be exactly the same. As such, KPERS' dicta regarding collateral estoppel is distinguishable.

Third, the Response devotes several pages to attacking Plaintiffs motives for raising the issue of disqualification. Plaintiffs are not seeking to delay the case -- on the contrary, Plaintiffs' believe that the delays associated with this case have been caused by Google's failure to cooperate in discovery. Regardless, Section 455 is addressed to the Court and describes when it is obligated to disqualify itself. Plaintiffs' motives (good or bad) are not relevant to the Court's determination of its obligations under that statute.

CONCLUSION

For the foregoing reasons, Plaintiffs respectfully request that the Court grant their Motion to Disqualify, enter an Order to transfer this case to another Judge of the District Court, and award Plaintiffs any such other and further relief as is appropriate.

Respectfully submitted,

ERICH SPECHT, individually and doing business
as ANDROID DATA CORPORATION, and THE
ANDROID'S DUNGEON INCORPORATED

By: /s/ P. Andrew Fleming
One of Their Attorneys

P. Andrew Fleming
John F. Shonkwiler
John B. Haarlow, Jr.
NOVACK AND MACEY LLP
100 North Riverside Plaza
Chicago, IL 60606
(312) 419-6900
Doc. #374693v3

Martin Murphy
2811 RFD
Long Grove, IL 60047
(312) 933-3200

CERTIFICATE OF SERVICE

P. Andrew Fleming, an attorney, certifies that he caused copies of the foregoing to be served by electronically filing the document with the Clerk of Court using the ECF system this 26th day of July, 2010.

/s/ P. Andrew Fleming

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

ERICH SPECHT, et al.,

Plaintiffs,

vs.

GOOGLE, INC., et al.,

Defendants.

No. 09 C 2572

Chicago, Illinois

July 27, 2010

9:30 o'clock a.m.

TRANSCRIPT OF PROCEEDINGS - MOTIONS
BEFORE THE HONORABLE HARRY D. LEINENWEBER

APPEARANCES:

For the Plaintiffs:

NOVACK & MACEY
MR. RICHARD DOUGLAS
MR. P. ANDREW FLEMING
MR. JOHN F. SHONKWILER
100 North Riverside Plaza
Chicago, Illinois 60606
312-419-6900
and
MR. MARTIN J. MURPHY

For the Defendant,
Google, Inc.:

GREENBERG TRAURIG, LLP
MR. RICHARD D. HARRIS
MR. CAMERON NELSON
77 West Wacker Drive
Chicago, Illinois 60601
312-456-8400

For the Defendant,
T-Mobile:

LOEB & LOEB, LLP
MR. ROBERT M. ANDALMAN
321 North Clark Street
Chicago, Illinois 60610
312-464-3100

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25

Court Reporter:

**FEDERAL OFFICIAL COURT REPORTER
MS. KRISTA FLYNN BURGESSON
219 South Dearborn Street
Chicago, Illinois 60604
312-435-5567**

1 THE CLERK: 09 C 2572, Specht versus Google.

2 MR. FLEMING: Good morning, your Honor. Andrew
3 Fleming, John Shonkwiler, Martin Murphy, and Richard Douglas,
4 on behalf of the plaintiffs.

5 MR. SHONKWILER: Good morning, your Honor.

6 MR. MURPHY: Good morning.

7 MR. DOUGLAS: Good morning, your Honor.

8 MR. HARRIS: Good morning, your Honor. Richard
9 Harris and Cameron Nelson on behalf of the defendant, Google.

10 MR. NELSON: Good morning, your Honor.

11 MR. ANDALMAN: And good morning. Robert Andelman on
12 behalf of T-Mobile.

13 THE COURT: Okay.

14 I received this morning, which I have reviewed, the
15 reply from Mr. Specht. So I am prepared to rule.

16 Yes?

17 MR. HARRIS: Excuse me.

18 Your Honor, if I could ask one thing.

19 We also received that reply from Mr. Specht as well
20 yesterday, but I am pleased to report to the Court that we
21 believe this last minute motion by plaintiffs has been mooted
22 in view of the fact that Google has agreed to indemnify all 4
23 of the defendants named in the third amended complaint,
24 T-Mobile, Sprint, Verizon, and AT&T.

25 So, there is no financial interest any more amongst

1 any of those 4.

2 MR. FLEMING: That is the first I have heard of this,
3 Judge. I am not sure how I would respond to it.

4 MR. HARRIS: Actually, it was in our brief, your
5 Honor, that prospect.

6 THE COURT: You did mention that, yes.

7 And you are definitely indemnifying all 4?

8 MR. HARRIS: That is correct, your Honor.

9 THE COURT: I was prepared to deny the motion for
10 disqualification, and it wouldn't change that. It would
11 change probably what I would state in the record though, based
12 on that.

13 I was also prepared, or am prepared, to deny the
14 motion for leave to amend the complaint today.

15 MR. HARRIS: Thank you, your Honor.

16 THE COURT: I will supplement my ruling with a
17 written ruling so you know exactly what it is, because
18 obviously, I have to make some changes now that it has been
19 announced that you are indemnifying all 4.

20 MR. HARRIS: Thank you, your Honor.

21 THE COURT: Okay.

22 MR. HARRIS: I believe that leaves one motion that
23 was continued to today, and I believe that is plaintiffs'
24 motion to extend discovery.

25 THE COURT: Okay.

1 MR HARRIS: I can report to the Court that of the 3
2 people that were mentioned as the basis for the extension, one
3 of them is being deposed in San Francisco in exactly one hour
4 and 35 minutes. That has been resolved.

5 Then the other 2, I believe, were just served or are
6 in the process of attempting to be served. It has been just
7 over the last 5 to 7 days that this attempt was made, and we
8 believe it was not timely. Accordingly, defendants continue
9 to oppose that motion to extend.

10 This case is set for the close of discovery, I
11 believe, on Friday the 30th of July and, of course, it is
12 defendants' position that we should proceed with that
13 schedule.

14 THE COURT: Is there anybody other than Mr. White
15 that remains to be deposed?

16 MR. SHONKWILER: Your Honor, if I could, I would like
17 to address at least the brief that was filed by Google
18 yesterday on this subject that we have not had an opportunity
19 to respond to yet.

20 Mr. White is being deposed today. The issue of
21 scheduling his deposition is no longer an issue.

22 THE COURT: He is? Okay.

23 I was going to say if he was avoiding service, I
24 would certainly allow discovery to remain open for the purpose
25 of deposing that person but apparently, by agreement, he is

1 giving his deposition.

2 MR. HARRIS: He is appearing voluntarily, but he
3 still hasn't been served. No one was ducking service on that.
4 They are proceeding with the deposition.

5 MR. SHONKWILER: And there are several other issues,
6 as outlined in our brief, that we filed last week, and like I
7 said, I would like to respond to the relevant points, the
8 points I think are most relevant raised in the brief filed by
9 Google yesterday. I will be as brief as I can, however, this
10 is important. So if the Court has a few minutes for me.

11 First of all, in short, the accusation that there
12 were Rule 37 violations is inaccurate. This is not a motion
13 to compel. There is no Rule 37 meet and confer obligation
14 before a motion to extend discovery can be filed.

15 The purpose of this motion is simply to point out to
16 the Court the significant disputes that remain unresolved
17 today so that you can understand and appreciate what the need
18 is to extend, and for what purposes and perhaps limited
19 purposes it would need to be extended for, to accomplish the
20 resolution of these final disputes.

21 We hope that there is no motion to compel necessary,
22 if the Court grants the extension, as we always do.

23 Now, the 811 electronic documents referenced in our
24 filing, I believe that issue also has been resolved. Those
25 documents were produced, and if they were produced in the

1 manner that Google has represented, represented to us that
2 they have been produced, then that issue too has been
3 resolved. We just need an opportunity to look at those and
4 see what they have given us and see that it is, in fact, what
5 they say it is, but I believe that is done.

6 Ms. Tong, who is a brand manager for the Google and
7 Android brands, is no longer with Google. We were informed of
8 this right about the time the parties were scheduling the last
9 several depositions during the last 2 weeks of July.

10 THE COURT: What is the name, Tong, T-o-n-g?

11 MR. SHONKWILER: Linda Tong, right, T-o-n-g.

12 THE COURT: Okay.

13 MR. SHONKWILER: We sent her a deposition notice in
14 June before we were informed that she didn't work for Google
15 anymore. We were given her address on July 12th, and the very
16 next day, I believe it was the day we filed our third amended
17 complaint, the following day, Mr. Finn and I were out in
18 California taking a Google 30(b)(6) dep, and it was
19 immediately the day after that we decided that we had to call
20 plaintiffs' -- I am sorry, Google's attorneys and tell them of
21 our proposal to suspend depositions until we figured out what
22 new parties, if any, would be added and who would be
23 representing those parties to try to avoid duplicative
24 depositions. Our proposal applied to all witnesses, not just
25 the witnesses that Google was seeking to depose, but those

1 that we were interested in deposing.

2 If you recall, we were then in front of the Court on
3 Tuesday, the 20th, and your Honor ordered the depositions to
4 go forward. Later that day, we issued the subpoena and
5 attempted service on Ms. Tong. So there has been no delay at
6 all.

7 THE COURT: You want to take Linda Tong. Fine.
8 Who else is there that you want?

9 MR. SHONKWILER: I don't believe there are any other
10 depositions.

11 THE COURT: That is all you need? Okay.
12 I can leave discovery open for that particular
13 purpose, taking the deposition of Linda Tong.

14 MR. SHONKWILER: The 2 more significant issues, your
15 Honor, which may require a 30(b)(6) deposition unless certain
16 information can be provided by alternative means, the 2 big
17 issues are, frankly, Number 1, the revenues that Google has
18 known since the day we filed this case that we would be
19 seeking damages based on revenues flowing from the Android
20 operating system, the Sands vs. Thirst Aid Case,
21 that we all know very well, says that one of the proper
22 measures of damages in cases like this, reverse confusion
23 cases, is a reasonable royalty, a reasonable royalty based on
24 the revenues made by the alleged infringer.

25 We learned 2 to 3 weeks ago, as a result of these

1 30(b) (6) depositions we had hoped to take sooner, that Google,
2 in fact, has its own records internally in which it
3 specifically tracks and identifies advertising revenues earned
4 as a result of searches on Google Android mobile devices, and
5 it calls these revenues, in its own internal accounting
6 documents, Android revenues on Android profit and loss
7 statements, that it circulates.

8 These documents that disclose the revenues that are
9 maintained have not been shared with us, they have not been
10 produced, we have a couple of samples that slipped through in
11 the discovery somehow that prompted us to ask the questions
12 about what they were, but the documents have not been
13 produced, nor has Google produced its executed agreements that
14 we now know exist with wireless carriers that describe the
15 terms on which Google divides those Android search revenues
16 that it accounts for internally with its mobile carriers on a
17 percentage basis.

18 These revenue numbers, we are entitled to get. We
19 told Mr. Finn at the close of the 30(b) (6) dep that because
20 the witness told us she did not have those numbers with her,
21 and would not be able to rattle them off off the top of her
22 head, that we would sit around and wait, literally, in the
23 deposition room for her to go get them if she could, and if
24 not, we would have to re-visit how these numbers would be
25 produced to us.

1 We are open to alternative suggestions if Google has
2 any that would avoid the need to fly out to California again,
3 but that issue needs to be resolved.

4 And the other issue that needs to be resolved is the
5 production of the documents themselves that show these
6 revenues, and the revenues of -- and how they are divided with
7 the wireless carriers.

8 Now, I would be happy to allow Google an opportunity
9 to respond. I haven't yet addressed the privilege log, which
10 is another issue, your Honor. We have --

11 THE COURT: What about the --

12 MR. SHONKWILER: Would you rather hear --

13 THE COURT: Counsel?

14 MR. HARRIS: Mr. Nelson will be responding on this
15 issue, Judge.

16 MR. NELSON: The characterization of these Android
17 revenues is utterly false, Judge, and the plaintiffs know
18 that.

19 The Android operating system is not sold. Google
20 doesn't sell it. It is an open source operating system.
21 Google's only revenues come from searches.

22 THE COURT: Well, they are apparently going to make
23 an argument that these are actually revenues that come from
24 the Android operating services. That is basically what he
25 said.

1 Now, that is a legal issue, obviously.

2 MR. NELSON: Exactly, it is a legal issue. We
3 haven't had a Rule 37 conference. And if we could understand
4 what they are seeking, we may oppose that. We have to find
5 out what they are seeking, ask the client, this is the revenue
6 that they want, and then --

7 THE COURT: That is a damage issue, anyway.

8 It is my understanding that there is going to be a
9 motion for summary judgment, and if they get by the motion for
10 summary judgment, then that would certainly make that
11 relevant.

12 MR. NELSON: That is correct. That is correct. It
13 is solely a damages issue.

14 THE COURT: What about the privilege?

15 MR. SHONKWILER: Your Honor, the privilege log is --
16 Google produced the privilege log with over 2,000 entries. It
17 is at least the largest I have ever seen, or as large as any I
18 have ever seen. There were at least 100 individuals named on
19 the log, none were identified at first by title, by company
20 affiliation, whether they were an attorney or not.

21 We had a meet and confer and we said, we have to know
22 who these people are before we can begin to determine which of
23 these --

24 THE COURT: Have you done that, met and conferred?

25 MR. SHONKWILER: We did, yes.

1 And what Google did next is they gave us two lists,
2 one of all nonGoogle employees on the privilege log, and one
3 of all attorneys on the privilege log. The problem then that
4 we came back and pointed out to them was their address lists,
5 and there are more than a dozen of them, and they all have
6 different names, and those address lists have members, and we
7 don't know who those members are, we don't know if they are
8 attorneys, Google employees, or who.

9 Eventually, Google did respond to that observation by
10 giving us a general description of two out of the more than a
11 dozen lists, and that general description, for example, was
12 only that one of these lists was comprised of attorneys,
13 another list was comprised of some, but not all, attorneys,
14 and then we never got any responses to the other dozen or so
15 lists. We are still waiting for that.

16 In the meantime, because they asked us for more
17 specifics, which are frankly hard to give when you don't know
18 who the people are who are communicating with each other, we
19 gave them specifics.

20 There is a long letter attached as Exhibit 9 to our
21 brief that we filed, it is a letter dated July 8th, and on the
22 second page we give like 8 paragraphs here, 8, 9, 10
23 paragraphs maybe of -- 9 paragraphs of specific examples of
24 entries on the privilege log that we are, at least, very, very
25 skeptical about the privilege claim because of the

1 circumstances and, from what we can tell, the limited
2 information we have been provided.

3 Rather than reading through each one of those
4 examples, they are spelled out in that letter. We took a lot
5 of time and care to analyze the log the best we could under
6 the circumstances and write that letter, and I think it speaks
7 for itself.

8 But suffice it to say we are left with a long
9 privilege log, and we are left at least as we stand here
10 certain that there are some of those privilege log entries
11 that we will be challenging, and there may be many. And then
12 as soon as we have identified the mysterious members of these
13 address lists, we may have more still.

14 I don't know which of those privilege log entries
15 relate to documents that would be relevant to summary
16 judgment. I don't know if any of them do. I have no way of
17 knowing that, Judge, because I don't know what the documents
18 are. They are not described specifically enough for us to
19 tell whether the subject matter of the documents is something
20 that might be relevant to summary judgment, nor have we seen
21 Google's summary judgment brief.

22 This issue is a problem in terms of, you know, the
23 schedule we have now.

24 The other issues that relate to financial documents
25 and financial numbers, they do not -- probably do not need to

1 hold up summary judgment. Again, we have not seen their
2 brief, but I would be surprised if any brief they filed would
3 implicate these revenue figures, although we want a schedule
4 to get those figures certainly, and we would like to have it
5 today, if we could.

6 THE COURT: What about the privilege matter?

7 MR. NELSON: Well, the problem with the privilege log
8 is twofold.

9 First of all, it is lengthy, and of course the
10 description of the back and forth isn't exactly the way I
11 would have presented it. I think that plaintiffs have really
12 failed to work with us to resolve this issue.

13 The reason it is lengthy is because of the breadth of
14 their request. We have given them a privilege log and we
15 asked them to tell us, help us narrow this down, if you want
16 more detailed descriptions help us narrow it down. They have
17 refused to do that. So, there is a sort of lack of
18 cooperation on that side.

19 As far as naming the lists goes, I don't think there
20 really can be any reasonable dispute that an E-mail list that
21 is called, trademarks, at Google.com, is not privileged. We
22 have told them that the list is comprised of attorneys and
23 people in the control group and high ranking executives who
24 make decisions for the company regarding trademarks. The
25 other list that was all attorneys is naming Google.com, and it

1 was comprised of all attorneys.

2 Then we keep getting these vague requests about,
3 identify these other lists, but they never actually identify
4 which list they are interested in. And we don't really have
5 historical information. The problem with naming the people on
6 these lists is we just don't have information about who was on
7 it 8 months ago or 2 years ago, we can only tell you who is on
8 it at this very instant.

9 They have taken the position that if we don't know,
10 then they must not be privileged, but that is not the case.
11 Everything on this log was hand reviewed by an outside vendor,
12 and the privilege assertions are based on that.

13 So, to the extent that they are seeking further
14 discovery on this, there is clearly some further discussions
15 that we -- I mean, if they want to narrow this down and have
16 some actual questions to ask about the privilege log, we are
17 available to answer, and we remain available to answer,
18 regardless of whether Friday is the close of discovery or
19 not. We will remain available to answer the questions. But
20 we have not received any specific requests for information
21 other than these very broad, re-do the whole thing, requests,
22 which we don't think is appropriate.

23 MR. SHONKWILER: Your Honor, if Mr. Nelson looks at
24 Exhibit 9 to our filing, it is as specific as anyone could
25 ever be under the circumstances.

1 For example, Paragraph 1 on Page 2 of that letter
2 says, according to your log entries numbers, then we read off
3 the specific entry numbers there, our E-mail is requesting
4 information for the purpose of providing legal advice, but you
5 have not identified any attorneys among the senders or
6 recipients of the E-mails. We are asking for an explanation
7 of how communications that are not between or among any
8 attorneys could be privileged.

9 2 or 3 paragraphs down then we have a series of
10 different categories, and we have broken down here where they
11 have described communications between a nonGoogle employee,
12 or a -- actually between -- yes, communications that are at
13 least shared with one nonGoogle employee that they are
14 claiming privilege over, and again, these are not work
15 product privilege claims, they are attorney/client privilege
16 claims.

17 If you read through these, you can see we have been
18 very specific, and we have had no response to this letter. We
19 do need to discuss this to understand the problem of why the
20 claims are being made here.

21 And just quickly, your Honor --

22 THE COURT: Let me ask, why wasn't there a specific
23 response to this letter?

24 MR. NELSON: We just haven't gotten it done yet.

25 THE COURT: Are you close?

1 MR. NELSON: Part of the problem with the letter,
2 and he is pointing to these particular paragraphs, but they
3 always end their letters with, oh, and anything else that is
4 like this, we also want you to respond to, which leads to the
5 discussion of, wait, hold on, guys, do you want us to respond
6 to these categories you raised here or is there something
7 more?

8 This is exactly how Mr. Shonkwiler's statement about
9 these two names -- they initially sent us a letter, please
10 identify who is a member of the naming and the trademarks
11 list, and we did that. Then they came back and said, you
12 didn't identify all the other lists.

13 So, we just need them to work with us to identify
14 their requests, and we can respond to it, but these catch-all
15 provisions of, oh, and give us additional information on
16 anything else that is remotely like this, we just can't
17 respond to it.

18 THE COURT: You can respond specifically to the
19 enumerated paragraphs in the July 8th letter.

20 MR. NELSON: Those paragraphs we can, yes.

21 MR. SHONKWILER: And your Honor, as for our catch-all
22 requests that we include, the reason they must be in there is
23 because Google has still not told us fundamentally whether any
24 of these other address lists --

25 THE COURT: Anyway, respond specifically to that

1 letter.

2 MR. SHONKWILER: Your Honor, we also need to know who
3 is on these address lists, or at least know if they include
4 attorneys or nonGoogle employees, and --

5 THE COURT: That is part of your Number 1.

6 MR. SHONKWILER: As long as that is part of it, and
7 as long as it is clear, okay. That is something we absolutely
8 need.

9 THE COURT: It seems reasonably clear. I don't think
10 these categories are difficult to figure out.

11 MR. SHONKWILER: And finally, your Honor, there is a
12 Lucasfilm deposition that is the subject of a motion to compel
13 out in California, and there is a long story there, but you
14 know that we --

15 THE COURT: Who?

16 MR. SHONKWILER: Lucasfilms.

17 THE COURT: And who is Lucasfilms?

18 MR. NELSON: Star Wars.

19 THE COURT: Star Wars, okay.

20 MR. SHONKWILER: They have a Droid licensing
21 agreement with other companies who still remains anonymous.

22 You may recall we were here seeking --

23 THE COURT: Didn't I address this issue?

24 MR. SHONKWILER: There was a motion to quash from
25 Motorola. The motion was briefed and --

1 THE COURT: Something regarding Star Wars, too, I
2 believe.

3 They don't use Android, they use Droid, or something
4 like that, and they had Droid as their -- well, they own that,
5 don't they?

6 MR. NELSON: Lucasfilms owns the Droid trademark,
7 which is licensed to various companies.

8 THE COURT: Right.

9 So, they wanted to find out what the revenues are
10 for --

11 MR. NELSON: I believe it is for the license
12 agreement, if one exists, for the Droid trademark.

13 THE COURT: And they wanted to measure that one with
14 this.

15 Didn't I rule on that?

16 MR. NELSON: With respect to different parties.

17 MR. MURPHY: Your Honor, you entered an order on
18 Motorola. We filed a motion for reconsideration. Motorola
19 said, we don't have any documents. So, that was moot and the
20 motion for reconsideration was granted.

21 MR. FLEMING: Your Honor did not rule on the
22 relevance of those documents and, in fact, you specifically
23 said you were not ruling on that.

24 MR. SHONKWILER: And the Droid rights that Lucasfilm
25 does have that are acknowledged by the USPTO extends to Star

1 Wars games and toys and such. They are trying to extend it to
2 get into the wireless area, and the USPTO has already told
3 them no, because of the likelihood of confusion.

4 THE COURT: Have you filed a proceeding in
5 California?

6 MR. SHONKWILER: We did 3 months ago, and we are
7 getting stiff resistance, as we have at every turn in this
8 case, from every --

9 THE COURT: Well, if you get the authority from the
10 California court, then I will --

11 MR. NELSON: We have 2 concerns.

12 The original subpoena to Lucasfilms was not issued
13 until after written discovery was closed. Document discovery
14 was closed. They didn't issue the original subpoena until
15 April 28th. That is one of the issues that Lucasfilms is
16 raising in California, and the plaintiffs represented to the
17 California court that that simply wasn't true.

18 THE COURT: Well, this is also an issue though of
19 damages.

20 MR. NELSON: Yes.

21 THE COURT: Which we can take up after we determine
22 if damages are relevant.

23 MR. NELSON: That is correct.

24 MR. HARRIS: Correct, your Honor.

25 THE COURT: Okay.

1 So, Linda Tong, I will allow you to take her
2 deposition. Plaintiffs are willing to -- or defendants are
3 willing to work with you on your letter and respond
4 specifically to the letter.

5 And so at this time, I don't see any specific reason
6 to extend general discovery.

7 MR. HARRIS: Thank you, your Honor.

8 THE COURT: So, that motion is denied.

9 MR. SHONKWILER: Your Honor, how do you propose to
10 handle discovery of financial information?

11 THE COURT: We will take that up -- I won't foreclose
12 discovery on financial issues until after the motion for
13 summary judgment.

14 MR. FLEMING: Your Honor, we wondered whether we
15 would be required to file a motion to compel today to get the
16 search revenues. I guess, as I understand your Honor's
17 ruling, at least with respect to that discovery, your Honor
18 will enter and continue our rights to seek that discovery?

19 THE COURT: Right.

20 I am not just closing discovery as to damages at this
21 particular time. This is as to the liability issues.

22 MR. FLEMING: But we want to be very clear, when we
23 are talking about damages we are talking about the add on
24 search revenues earned by Google that --

25 THE COURT: Assuming you get by summary judgment, it

1 would be whatever would be relevant in determining -- or what
2 would lead to relevant evidence to determine what damages you
3 would be entitled to.

4 MR. FLEMING: Right.

5 THE COURT: And we can take that up at a later date.

6 MR. FLEMING: Which right now, your Honor, we have
7 expressly said that it includes these add on search revenues
8 on Android and --

9 THE COURT: I am not foreclosing anything at this
10 particular point. There might be a legal issue that --

11 Anyway, that will be the ruling of the Court.

12 MR. HARRIS: Thank you, your Honor.

13 MR. NELSON: Thank you.

14 MR. FLEMING: When is your Honor likely to issue your
15 decision on the recusal motion?

16 THE COURT: I will issue it today.

17 MR. FLEMING: We appreciate that.

18 MR. SHONKWILER: Thank you, your Honor.

19 THE COURT: Yes.

20 (Proceedings concluded.)

21

22

23

24

25

C E R T I F I C A T E

I certify that the foregoing is a correct transcript
from the record of proceedings in the above-entitled matter.

/s/Krista Burgeson, CSR, RMR, CRR
Federal Official Court Reporter

July 27, 2010
Date

Order Form (01/2005)

United States District Court, Northern District of Illinois

Name of Assigned Judge or Magistrate Judge	Harry D. Leinenweber	Sitting Judge if Other than Assigned Judge	
CASE NUMBER	09 C 2572	DATE	7/27/2010
CASE TITLE	Specht et al. vs. Google Inc.		

DOCKET ENTRY TEXT

Before the Court are Plaintiffs' motion for leave to file third amended complaint [217] and motion for disqualification [227]. For the reasons stated below, both motions are denied. Defendant's motion to strike the third amended complaint [221] is granted. The third amended complaint [216] is stricken.

■ [For further details see text below.]

*Mail AO 450 form.

STATEMENT

Motion to Disqualify. Plaintiffs filed a motion for leave to file an amended complaint on July 15, 2010 – fifteen days before oral discovery was set to close. In the amended complaint, Plaintiffs added four defendants, T-Mobile, Sprint Nextel, Verizon, and AT&T. The undersigned judge informed the parties that his wife serves on the board of AT&T and that he and his wife own stock in AT&T. It is undisputed that the cause of action against AT&T cannot proceed under this judge. *See* 28 U.S.C. §455(b). Plaintiffs move to entirely disqualify the judge from the case now before him because his decisions in this case could conceivably affect Plaintiffs' contemplated future suit against AT&T before another judge.

Google has stated, however, that it will indemnify AT&T in regard to this case. As this removes any financial liability for AT&T in this case, it resolves any conflict of interest. The motion to disqualify is therefore denied as moot. Even if Google had not offered to indemnify AT&T, the Court would have denied the motion to disqualify. As the Eighth Circuit has pointed out, there is no authority for the proposition that a judge's interest in a nonparty company in a separate case can create a conflict of interest mandating recusal. *In re Kansas Pub. Employees Ret. Sys.*, 85 F.3d 1353, 1362 (8th Cir. 1996).

Motion for Leave to Amend Complaint. Under Rule 15(a)(2), a party at this stage of litigation must have leave of court to amend a complaint. The Court should grant leave when justice requires. In this case, however, Plaintiffs have stated no compelling reason why they submitted their amended complaint adding four new defendants near the eve of the close of oral discovery and just before Google has leave to file a motion for summary judgment. Plaintiffs recently attempted, in fact, to justify their proposed postponements of depositions by the fact that they had just added new parties to their complaint. Plaintiffs allege that T-

STATEMENT

Mobile started selling infringing mobile phones as early as October 2008, that Sprint began as early as October 2009, and Verizon as early as November 2009. Plaintiffs claim that they did not know of these facts until they deposed a Google employee this month. This is difficult to believe because the companies in question do not make a secret of the products they sell. Plaintiffs could have easily learned of this information before they deposed the Google employee. This suggests that the last-minute motion to amend was filed merely for purposes of delaying Google's imminent motion for summary judgment. District courts have broad discretion to deny leave to amend where there is undue delay, dilatory motive, and undue prejudice to the defendants. *Hukic v. Aurora Loan Servs.*, 588 F.3d 420, 432 (7th Cir. 2009). The Court finds that all three exist in this case. For these reasons, the motion for leave to amend is denied.

Motion to Strike Third Amended Complaint. Because the third amended complaint was not filed with leave of court, Google's motion to strike is granted. The third amended complaint [216] is stricken.

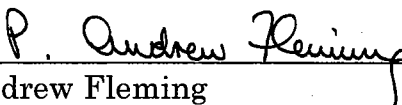
PROOF OF SERVICE

The undersigned hereby certifies that he provided a true and correct copy of the foregoing Petition for Writ of Mandamus to all persons listed below by hand delivery on the 3rd day of August, 2010:

Herbert H. Finn
Cameron M. Nelson
Jeffrey P. Dunning
Richard D. Harris
Greenberg Traurig LLP
77 W. Wacker Drive, Suite 3100
Chicago, IL 60601

and by hand delivery to the chambers of:

The Honorable Harry D. Leinenweber
United States District Court for the
Northern District of Illinois
Everett McKinley Dirksen Building
Room 1946
219 S. Dearborn Street
Chicago, Illinois 60604



P. Andrew Fleming