

**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,	)	Civil Action No. 09-cv-2572
	)	
v.	)	Judge Harry D. Leinenweber
	)	
GOOGLE INC.,	)	Magistrate Judge Jeffrey Cole
	)	
Defendant/Counter-Plaintiff.	)	

**PLAINTIFFS’ ANSWER AND AFFIRMATIVE DEFENSES  
TO GOOGLE’S AFFIRMATIVE DEFENSES AND COUNTERCLAIM**

Plaintiffs ERICH SPECHT (“Specht”), an individual, and doing business as ANDROID DATA CORPORATION (“ADC”), and THE ANDROID’S DUNGEON INCORPORATED (“ADI”) (collectively, “Plaintiffs”) as and for their Answer and Affirmative Defenses To Google’s Affirmative Defenses And Counterclaim, state as follows.

**ANSWER TO AFFIRMATIVE DEFENSES**

**First Affirmative Defense**

Plaintiffs’ claims are barred under the doctrines of laches and/or acquiescence, arising out of Plaintiffs’ knowledge of Google’s open and notorious use of its ANDROID mark long before filing suit, coupled with Plaintiffs’ failure to take any actions to protect any of their purported rights.

**ANSWER:** Plaintiffs deny the allegations of the First Affirmative Defense.

**Second Affirmative Defense**

Plaintiffs’ claims are barred under the doctrines of unclean hands, arising out of Plaintiffs’ commission of fraud before the USPTO and engaging in acts of unfair competition directed at Google, as more fully set forth in Paragraphs 26 through 49 of Google’s Counterclaim.

**ANSWER:** Plaintiffs deny the allegations of the Second Affirmative Defense.

### **Third Affirmative Defense**

Plaintiffs' claims are barred due to the commission of fraud before the United States Patent and Trademark Office (USPTO) by Plaintiff ADI, by intentionally filing a false Declaration with the USPTO on April 21, 2009 in connection with U.S. Trademark Registration 2,639,556. In that Declaration, Megan Specht, purported President of ADI, falsely stated under oath that the registered ANDROID DATA mark was "in use in commerce on or in connection with all goods or services listed in the existing registration for this specific class," when Ms. Specht and ADI knew that the statement was false, as more fully set forth in Paragraphs 26 through 49 of Google's Counterclaim. The aforementioned false statement was made with the intent to deceive the USPTO, and the USPTO relied solely upon the aforementioned false statement in maintaining that Registration on the Principal Register. U.S. Trademark Registration 2,639,556 is accordingly subject to cancellation under 15 U.S.C. §1064.

**ANSWER:** Plaintiffs deny the allegations of the Third Affirmative Defense.

### **Fourth Affirmative Defense**

Plaintiffs' claims are barred due to the fact that Plaintiffs do not hold any valid or enforceable rights to the ANDROID DATA mark or any purported Android Marks.

**ANSWER:** Plaintiffs deny the allegations of the Fourth Affirmative Defense.

### **Fifth Affirmative Defense**

Plaintiffs' claims are barred due to the fact that Plaintiffs' purported ANDROID DATA mark and purported Android Marks are invalid and/or unenforceable.

**ANSWER:** Plaintiffs deny the allegations of the First Affirmative Defense.

### **Sixth Affirmative Defense**

Plaintiffs' claims are barred due to the fact that Plaintiffs have abandoned any rights they may have had in the ANDROID DATA mark and purported Android Marks.

**ANSWER:** Plaintiffs deny the allegations of the Sixth Affirmative Defense.

### **Seventh Affirmative Defense**

Plaintiffs' claims are barred due to the fact that U.S. Trademark Registration 2,639,556 is subject to cancellation under 15 U.S.C. § 1064 as a result of Plaintiffs' abandonment of the ANDROID DATA mark.

**ANSWER:** Plaintiffs deny the allegations of the Seventh Affirmative Defense.

**Eighth Affirmative Defense**

Plaintiffs' claims are barred due to the fact that U.S. Trademark Registration 2,639,556 is subject to cancellation under 15 U.S.C. §1058 because the §8 Declaration referred to hereinabove was not filed by the actual owner of that registration, and the time for filing a §8 Declaration has since expired.

**ANSWER:** Plaintiffs deny the allegations of the Eighth Affirmative Defense.

**Ninth Affirmative Defense**

Plaintiffs cannot demonstrate that their rights in their purported ANDROID DATA mark or Android Marks have been damaged or harmed.

**ANSWER:** Plaintiffs deny the allegations of the Ninth Affirmative Defense.

**Tenth Affirmative Defense**

Plaintiffs fail to state a claim upon which relief may be granted.

**ANSWER:** Plaintiffs deny the allegations of the Tenth Affirmative Defense.

**ANSWER TO COUNTERCLAIM**

**PARTIES**

1. Google is a Delaware corporation with its principal place of business located in Mountain View, California.

**ANSWER:** Plaintiffs lack knowledge sufficient to form a belief as to the truth of the allegations of this Paragraph.

2. Specht is an individual, on information and belief, residing in Palatine, Illinois.

**ANSWER:** Plaintiffs admit the allegations of this Paragraph.

3. ADC is an Illinois corporation having a mailing address in Palatine, Illinois.

**ANSWER:** Plaintiffs admit the allegations of this Paragraph.

4. ADI is an Illinois corporation having a mailing address in Palatine, Illinois.

**ANSWER:** Plaintiffs admit the allegations of this Paragraph.

### **JURISDICTION AND VENUE**

5. This counterclaim arises under the Declaratory Judgment Act, 28 U.S.C. §2201, the Lanham Act, 15 U.S.C. §§1051 *et seq.*, and the common law of the State of Illinois.

**ANSWER:** Plaintiffs admit that the counterclaim purports to assert claims under the Declaratory Judgment Act, the Lanham Act and Illinois common law, but Plaintiffs deny that any of the asserted claims has merit.

6. This Court has subject matter jurisdiction over this counterclaim under 15 U.S.C. § 1121 and 28 U.S.C. §§ 1331, 1338 and 1367.

**ANSWER:** Plaintiffs admit the allegations of this Paragraph.

7. This Court has personal jurisdiction over Counterclaim Defendants by virtue of, among other bases, their residence within the State of Illinois and their commission of wrongful acts within the State of Illinois, all commensurate with the United States and Illinois Constitutions, and by virtue of their having filed their Complaint and First and Second Amended Complaints in this Court, so as to submit themselves to the jurisdiction and process of this Court.

**ANSWER:** Plaintiffs admit that this Court has personal jurisdiction over Plaintiffs, but deny that they have committed any “wrongful acts.” The remaining allegations of this Paragraph state legal conclusions of the pleader, to which no answer is required.

### **RELEVANT FACTUAL BACKGROUND**

#### **A. Google’s Use of the ANDROID Mark**

8. Google, among other things, develops and maintains an Internet search engine that bears its name.

**ANSWER:** Plaintiffs admit the allegations of this Paragraph.

9. In July 2005, Google acquired a start-up company known as Android, Inc., which was engaged in the development of an open-source operating system software directed to mobile devices. As of the date of acquisition, Android, Inc. had not publicly released any software, or otherwise made any mark use of the term “Android.”

**ANSWER:** Plaintiffs admit the allegations of the first sentence of this Paragraph, except that Plaintiffs lack knowledge sufficient to form a belief as to the truth of the allegation that Android, Inc. was a “start-up company.” Plaintiffs lack knowledge sufficient to form a belief as to the truth of the allegation that as of the date of acquisition, Android, Inc. had not publicly released any software. Plaintiffs deny the remaining allegations of this Paragraph.

10. After acquiring Android, Inc., Google continued developing the aforementioned operating system software. In 2007, as Google prepared for the public release of its operating system software platform, Google conducted a thorough trademark search to determine whether the mark ANDROID was available for use in association with an operating system.

**ANSWER:** Plaintiffs lack knowledge sufficient to form a belief as to the truth of the allegations of the first sentence of this Paragraph. Plaintiffs deny the allegations of the second sentence of this Paragraph.

11. As part of that investigation, Google discovered U.S. Trademark Registration No. 2,639,556, for the mark ANDROID DATA alleged to be used in association with “computer e-commerce software to allow users to perform electronic business transactions via a global computer network,” which had been issued to ADC by the United States Patent and Trademark Office (“USPTO”) on October 22, 2002 (the “556 Registration”).

**ANSWER:** Plaintiffs lack knowledge sufficient to form a belief as to the truth of the allegations of this Paragraph.

12. Google continued its investigation to determine whether the registered ANDROID DATA mark was in fact being used in commerce. Google’s investigation found no usage whatsoever of the ANDROID DATA mark regardless of whether it was by ADC or any other entity or licensee. Moreover, Google’s investigation revealed that (i) ADC remained the owner of record of the ‘556 Registration, (ii) ADC was out of business, having been dissolved by the Illinois Secretary of State on May 1, 2004, (iii) ADC’s former website located at [www.androiddata.com](http://www.androiddata.com) had been inactive since at least March 2005, (iv) ADC

had no current website, (v) ADC had no listed business address or telephone number, and (vi) the ANDROID DATA mark was not used anywhere on the Internet. Based on the results of that investigation, Google rightfully concluded that ADC had abandoned the ANDROID DATA mark.

**ANSWER:** Plaintiffs deny that Google rightfully concluded that ADC had abandoned the Android Data mark. Plaintiffs lack knowledge sufficient to form a belief as to the truth of the remaining allegations of this Paragraph.

13. On October 31, 2007, Google filed an intent-to-use application to register the ANDROID mark, for use in association with computer hardware and software. That application was accorded Serial No. 77/318,565 by the USPTO.

**ANSWER:** Plaintiffs admit that on October 31, 2007, Google filed an intent-to-use application to register the Android mark. The application speaks for itself and Plaintiffs deny any allegations of this Paragraph inconsistent therewith.

14. On November 5, 2007, Google made its first public disclosure of the ANDROID mark in association with a press release announcing the development and release of the ANDROID OS platform. Since that date, Google has widely, openly and notoriously used its ANDROID mark in commerce in association with its ANDROID OS platform.

**ANSWER:** Plaintiffs lack knowledge sufficient to form a belief as to the truth of the allegation of the first sentence of this Paragraph. Plaintiffs deny the remaining allegations of this Paragraph.

**B. Counterclaim Defendants' Abandonment of the ANDROID DATA Mark**

15. Specht, ADC and ADI allege rights in the purported marks ANDROID DATA, ANDROID SERVER and ANDROID DATA WEB EDITOR (collectively, the "Asserted Marks") for use in association with computer hardware and software products and services.

**ANSWER:** Plaintiffs admit that they own rights in the marks Android Data, Android Server and Android Data Web Editor for use, among other things, in association with computer

hardware and software products and services. Except as so admitted, Plaintiffs deny the allegations of this Paragraph.

16. On June 4, 2000, ADC filed an application with the USPTO for registration of the mark ANDROID DATA in association with “computer software and internet services.” That application was assigned Serial No. 78/011,167. On January 30, 2001, after reviving the application from abandonment, ADC amended the Identification of Goods in its application to read “computer e-commerce software to allow users to perform electronic business transactions via a global computer network.”

**ANSWER:** Plaintiffs admit that on June 4, 2000, ADC filed an application with the USPTO for registration of the mark Android Data. Plaintiffs state that the application speaks for itself and deny any allegations of this Paragraph inconsistent therewith. Plaintiffs deny the remaining allegations of this Paragraph.

17. On October 22, 2002, the USPTO issued the ‘556 Registration to ADC.

**ANSWER:** Plaintiffs admit the allegations of this Paragraph.

18. By the Fall of 2002, however, Specht and ADC had ceased doing business and ADC was no longer using the ANDROID DATA mark or any of the Asserted Marks, and Specht was actively seeking to sell off the remaining assets of ADC, which consisted primarily of software source code and related copyrights.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

19. By the end of 2002, if not well earlier, Counterclaim Defendants had ceased all use in commerce of the ANDROID DATA mark and all other Asserted Marks, and neither Specht, ADC, ADI nor any other related entity had any intent to resume the commercial use of any of the Asserted Marks.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

20. During 2003, Specht continued his efforts to sell off the remaining assets of ADC. None of the Counterclaim Defendants used the Asserted Marks in commerce in association with the sale or license of any hardware or software products or services during 2003.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

21. Specht and ADC purposefully and intentionally failed to file an annual report with the Illinois Secretary of State for the year 2003, as a result of which ADC was dissolved by the Illinois Secretary of State on May 1, 2004. Copies of relevant Illinois Secretary of State records relating to ADC are attached as Exhibit 1 hereto.

**ANSWER:** Plaintiffs admit that Specht and ADC did not timely file an annual report with the Illinois Secretary of State for the year 2003, as a result of which ADC was involuntarily dissolved by the Illinois Secretary of State on May 1, 2004. Plaintiffs deny the remaining allegations of this Paragraph.

22. ADI was formed by Specht in 2001 for the purpose of carrying out other business endeavors in which Specht and/or his wife, Megan Specht, have been involved, particularly in the areas of Specht's music career and Megan Specht's real estate career. On information and belief, at no time has ADI ever been involved in any *bona fide* sale or marketing of computer e-commerce software or any other computer hardware or software products or services. Copies of relevant Illinois Secretary of State records relating to ADI are attached as Exhibit 2 hereto.

**ANSWER:** Plaintiffs admit that ADI was formed by Specht in 2001. The purposes of ADI are set forth in the Articles of Incorporation of ADI. That document speaks for itself and Plaintiffs deny any allegations of this Paragraph inconsistent therewith. Plaintiffs deny the remaining allegations of this Paragraph.

23. Neither Specht, ADC, ADI nor any other related entity or licensee has used any of the Asserted Marks in commerce in association with the sale of any software products or related services during the period from January 1, 2003 through March 2009.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

24. Neither Specht, ADC, ADI nor any other related entity or licensee had any *bona fide* intent to resume the commercial use of any of the Asserted Marks after January 1, 2003.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

25. Moreover, to the extent that Specht, ADC, ADI or any other related entity ever acquired any common law trademark, service mark or trade name rights in association with any of the Asserted Marks, based on business activities occurring prior to the time

ADC ceased all *bona fide* commercial use of the ANDROID DATA mark, any such rights were abandoned as a result of the non-use of the Asserted Marks after 2002, coupled with an intent not to resume use thereof.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

**C. Counterclaim Defendants' Unlawful Conduct**

26. Under §8 of the Lanham Act, 15 U.S.C. § 1058, the '556 Registration was subject to cancellation on April 22, 2009 by the USPTO due to non-use, unless ADC filed an affidavit attesting either that the ANDROID DATA mark was in use in commerce in association with the goods identified in the '556 Registration, or that the mark was not in use in commerce due to circumstances which excused such nonuse. Such an affidavit is often referred to as a "§8 Declaration."

**ANSWER:** Plaintiffs lack knowledge sufficient to form a belief as to the truth of the allegation that an affidavit provided under 15 U.S.C. §1058 is often referred to as a "§8 Declaration." The remaining allegations of this Paragraph state the legal conclusions of the pleader, to which no response is required. To the extent a response is required, Plaintiffs deny the same.

27. On information and belief, prior to April 20, 2009, while Counterclaim Defendants were aware of Google's use of the ANDROID mark, Counterclaim Defendants understood that none of them had any rights in any of the Asserted Marks, let alone the ANDROID DATA mark, and therefore Counterclaim Defendants had no intention of filing a §8 Declaration for the '556 Registration.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

28. On information and belief, on or about April 20, 2009, Specht received a telephone call from an individual named Kenneth Robblee ("Robblee"), who informed Specht that he had an interest in purchasing certain assets of ADC, including the '556 Registration.

**ANSWER:** Plaintiffs admit that on or about April 20, 2009, Specht received a telephone call from an individual identifying himself as Kenneth Robblee. Plaintiffs deny the remaining allegations of this Paragraph.

29. On information and belief, Specht and Robblee had several telephonic discussions on April 20 and 21, 2009, during which Robblee and Specht discussed (i) that Counterclaim Defendants had abandoned the ANDROID DATA mark well prior to 2005, (ii) that Specht believed that none of the Counterclaim Defendants had retained any rights in that mark, (iii) that the '556 Registration would be cancelled if Counterclaim Defendants did not file a §8 Declaration by April 22, 2009, the last day of the grace period, and (iv) that Google's use of the mark ANDROID in association with its Android OS platform would provide a vehicle for Counterclaim Defendants and/or Robblee to obtain considerable money.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

30. In addition, on or about April 21, 2009, Robblee called Google's legal department and left a voicemail stating that he was "working with Erich Specht," that he understood "that Google has an interest in obtaining that [trademark]," and that an agreement with Google "will determine whether or not he [Specht] renews it [the '556 Registration] or not."

**ANSWER:** Plaintiffs lack knowledge sufficient to form a belief as to the truth of the allegations of this Paragraph.

31. On information and belief, Robblee's contacting Google was to facilitate some an agreement between Counterclaim Defendants (and in turn Robblee) and Google where: 1) Google would pay Counterclaim Defendants (and Robblee) for ownership or a license of Counterclaim Defendants' purported rights in the ANDROID DATA mark; or 2) Google would pay Counterclaim Defendants (and Robblee) monetary consideration so that Counterclaim Defendants would not file an §8 Declaration.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

32. Based on Specht's discussions with Robblee, and notwithstanding his knowledge that Counterclaim Defendants did not retain any rights in any of the Asserted Marks, including the ANDROID DATA mark, on information and belief Counterclaim Defendants, aided and abetted by Specht's brother-in-law Martin J. Murphy ("Murphy"), decided to undertake a fraudulent scheme to sell or license their non-existent rights to Google in return for monetary consideration from Google. Counterclaim Defendants and Murphy realized that, in order to carry out this scheme, they needed to take immediate action to prevent the cancellation of the '556 Registration under 15 U.S.C. §1058, and to make it appear that Counterclaim Defendants had used the ANDROID DATA mark in commerce during the period from 2002 through 2009.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

33. On or about April 20, 2009, Specht registered the domain name <[android-data.com](http://android-data.com)>, and posted a new website that was identical to Specht's website from 2002 that had previously been located at the URL [www.androiddata.com](http://www.androiddata.com), which had been "offline" for at least four years. Specht's posting of this new website at [www.android-data.com](http://www.android-data.com) did not constitute a *bona fide* use of the ANDROID DATA mark in commerce in association with any goods or services, much less the goods listed in the '556 Registration.

**ANSWER:** Plaintiffs admit that on or about April 20, 2009, Specht registered the domain name android-data.com. Plaintiffs deny the remaining allegations of this Paragraph.

34. Notably, Counterclaim Defendants made no efforts to publicize or announce the re-launch of the new website, or to otherwise inform the marketplace that any of the "Android Data" hardware or software was once again available. Moreover, on information and belief, Counterclaim Defendants had not made any updates or revisions to the "Android Data" hardware or software, or engaged in any *bona fide* efforts to sell or license that software to any customer, since at least 2002. Thus, the posting of the website at [www.android-data.com](http://www.android-data.com) constituted at most a "token use" of the Asserted Marks, including the ANDROID DATA mark, and did not constitute a *bona fide* use in commerce.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

35. On or about April 21, 2009, Specht submitted a Notice of Recordation to the USPTO, requesting that the USPTO record a purported assignment of the '556 Registration from ADC to ADI. Notably, the purported assignment document that Specht submitted to the USPTO was dated April 28, 2004 -- three (3) days prior to the date on which ADC was formally dissolved by the Illinois Secretary of State. A copy of the Notice of Recordation submitted to the USPTO, including the purported assignment, is attached as Exhibit 3 hereto.

**ANSWER:** Plaintiffs admit that attached as the first page of Exhibit 3 is a document that states, among other things, that annexed is a true copy of a document recorded on April 21, 2009. Plaintiffs state that the documents attached as Exhibit 3 speak for themselves and deny any allegations of this Paragraph inconsistent therewith.

36. On information and belief, the purported assignment dated April 28, 2004 is fraudulent, as evidenced by the fact that it purports to have been executed on behalf of ADI by Megan Specht, as President of ADI. However, according to ADI's annual corporate report filed with the Illinois Secretary of State on or about July 29, 2004 (see Exhibit 5 hereto), as of April 28, 2004 Erich Specht, not Megan Specht, was the President of ADI. Megan Specht did not become President of ADI until sometime later.

**ANSWER:** Plaintiffs deny the allegations of the first and third sentences of this Paragraph. Plaintiffs admit that attached as Exhibit 5 is a portion of the annual report of ADI. Plaintiffs state that the document speaks for itself and Plaintiffs deny any allegations of this Paragraph inconsistent therewith.

37. On information and belief, the purpose of recording the purported assignment was to fabricate a unbroken chain of title for the '556 Registration.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

38. Moreover, even assuming that the purported assignment dated April 28, 2004 is legitimate, and not a fabrication, such an assignment would have been invalid as an assignment in gross, because, amongst other things, as of April 28, 2004 ADI was not involved in the business of selling computer e-commerce software and had no intention of selling computer e-commerce software under any of the Asserted Marks, and ADI did not acquire any assets or goodwill of ADC in association with the purported assignment. Moreover, the purported April 28, 2004 assignment would also have been invalid because, on information and belief, no consideration was provided by ADI in return for the assignment of ADC's rights. Accordingly, the purported April 28, 2004 assignment did not serve to transfer any rights in and to any of the Asserted Marks or the '556 Registration.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

39. On or about April 21, 2009, ADI filed a §8 Declaration for the '556 Registration with the USPTO that purports to have been electronically signed by Megan Specht, President of ADI and wife of Erich Specht (the "'556 §8 Declaration").

**ANSWER:** Plaintiffs admit that on or about April 21, 2009, ADI filed a Declaration for the '556 Registration with the USPTO. Plaintiffs state that the Declaration speaks for itself and deny any allegations of this Paragraph inconsistent therewith.

40. The '556 §8 Declaration attested under oath, *inter alia*, that the ANDROID DATA mark was "in use in commerce on or in connection with **all** goods or services listed in the existing registration for this specific class; or, the owner is making the listed excusable nonuse claim."

**ANSWER:** Plaintiffs state that the Declaration speaks for itself and deny any allegations of this Paragraph inconsistent therewith.

41. The '556 §8 Declaration purportedly executed by Megan Specht on behalf of ADI included a sworn declaration 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."

**ANSWER:** Plaintiffs state that the Declaration speaks for itself and deny any allegations of this Paragraph inconsistent therewith.

42. The attestation in the '556 §8 Declaration that the ANDROID DATA mark was in use in commerce on or in connection with all goods or services listed in the registration was false, because as of April 21, 2009 neither ADI nor any related company or licensee of ADI was using the ANDROID DATA mark in commerce on or in connection with any, let alone all, of the goods listed in the Registration.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

43. Counterclaim Defendants knew that the aforementioned statement in the §8 Declaration was false, inasmuch as neither ADI nor any related entity had made any *bona fide* use of the ANDROID DATA mark in commerce in association with the sale or promotion of computer e-commerce software in over three years.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

44. On or about April 23, 2009, Specht filed an Application for Reinstatement of the corporate entity ADC with the Illinois Secretary of State, together with annual reports for the past six consecutive years, namely 2003, 2004, 2005, 2006, 2007 and 2008. A copy of Specht's Application for Reinstatement is attached as Exhibit 4 hereto.

**ANSWER:** Plaintiffs admit the allegations of this Paragraph.

45. On or about April 28, 2009, after having taken improper measures to prevent the cancellation of the '556 Registration by the USPTO, Counterclaim Defendants filed a Complaint in this Court, naming as defendants Google, the OHA, and each member of the OHA (although many of the OHA members were not properly identified in the Complaint). That Complaint accused each of the then-named defendants of infringing the '556 Registration through their respective, purported use of the ANDROID mark.

**ANSWER:** Plaintiffs admit that on or about April 28, 2009, they filed a Complaint in this Court, naming as Defendants Google, the OHA and each member of the OHA. Plaintiffs state that the Complaint speaks for itself and deny any allegations of this Paragraph inconsistent therewith. Plaintiffs deny the remaining allegations of this Paragraph.

46. As of the filing of the Complaint on April 28, 2009, Counterclaim Defendants lacked a good faith basis for asserting a claim of trademark infringement against any of the then-named defendants. Any rights which any of the Counterclaim Defendants may have possessed in the ANDROID DATA trademark had been extinguished due to the abandonment of that mark years prior to 2009, and none of the Counterclaim Defendants had made any *bona fide* use of the ANDROID DATA mark in commerce in association with computer e-commerce software for far more than three years prior to filing the Complaint.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

47. On April 29, 2009, the USPTO issued a Notice of Acceptance of §8 Declaration, indicating that the '556 §8 Declaration had been accepted by the USPTO, and therefore the '556 Registration would not be cancelled pursuant to 15 U.S.C. § 1058.

**ANSWER:** Plaintiffs admit that on April 29, 2009, the USPTO issued a Notice of Acceptance of §8 Declaration. Plaintiffs state that the Notice of Acceptance speaks for itself and deny any allegations of this Paragraph inconsistent therewith. Plaintiffs deny the remaining allegations of this Paragraph.

48. On or about August 5, 2009, ADI through Specht submitted a "Corrective Assignment" to the USPTO, asserting that the assignment of the '556 Registration from ADC to ADI purportedly occurred on December 26, 2002, not April 28, 2004 as previously asserted by Counterclaim Defendants and as stated on the face of the assignment which had previously been recorded by Specht. On information and belief, the purpose of recording the purported "Corrective Assignment" was to further Counterclaim Defendants' efforts to fabricate an unbroken chain of title for the '556 Registration.

**ANSWER:** Plaintiffs admit that on or about August 5, 2009, ADI through Specht submitted a "Corrective Assignment" to the USPTO. Plaintiffs state that the Corrective Assignment speaks for itself and deny any allegations of this Paragraph inconsistent therewith. Plaintiffs deny the remaining allegations of this Paragraph.

49. Even assuming that the purported assignment dated December 26, 2002 were legitimate, and not a fabrication, such an assignment is not valid and is an assignment in gross, because as of December 26, 2002 ADI was not then, and is not now, involved in the business of selling computer hardware and software, including e-commerce software and had no intention of selling computer e-commerce software under the ANDROID DATA mark, and ADI did not acquire any assets or goodwill of ADC in association with the purported

assignment. Moreover, the purported December 26, 2002 assignment would also have been invalid because, on information and belief, no consideration was provided by ADI in return for the assignment of ADC's rights in the ANDROID DATA mark to ADI. Accordingly, the purported December 26, 2002 assignment could not have served to transfer any rights in and to the Asserted Marks or the '556 Registration.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

## COUNT I

### **Cancellation of U.S. Trademark Registration No. 2,639,556**

50. Google repeats and realleges the allegations contained in the foregoing ¶1- 49.

**ANSWER:** Plaintiffs restate and reallege their Answers to Paragraphs 1-49 as their Answer to Paragraph 50 of this Count I as if fully restated herein.

51. This is a claim for cancellation of U.S. Trademark Registration No. 2,639,556 (the "'556 Registration") arising under 15 U.S.C. §1064.

**ANSWER:** Plaintiffs admit that Count I purports to assert a claim for cancellation of the '556 Registration under 15 U.S.C. §1064, but Plaintiffs deny that the claim has merit.

52. On April 21, 2009, ADI submitted a Declaration of Use of Mark in Commerce Under §8 to the USPTO, which stated, *inter alia*, that "the mark is in use in commerce on or in connection with all goods or services listed in the existing registration for this specific class; or, the owner is making the listed excusable nonuse claim."

**ANSWER:** Plaintiffs admit that on April 21, 2009, ADI submitted a Declaration of Use of Mark in Commerce Under §8 to the USPTO. Plaintiffs state that the Declaration of Use speaks for itself and deny any allegations of this Paragraph inconsistent therewith.

53. ADI, through its President, Megan Specht, executed the §8 Declaration, and in so doing swore, under oath, 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."

**ANSWER:** Plaintiffs admit the allegations of this Paragraph.

54. The attestation in the §8 Declaration that the ANDROID DATA mark was in use in commerce on or in connection with all goods or services listed in the registration was false, because neither ADI, nor any related entity or licensee of ADI, was making any *bona fide* use of the ANDROID DATA mark in commerce on or in connection with any of the goods listed in the Registration.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

55. Megan Specht's and ADI's false statement was made with the knowledge that the statement was false, and with the intent to induce the USPTO to maintain the '556 Registration on the Principal Register under §8 of the Trademark Act, 15 U.S.C. §1058.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

56. Reasonably relying upon the truth of that false statement, the USPTO did in fact maintain the '556 Registration on the Principal Register.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

57. In view of the foregoing, the '556 Registration is subject to cancellation under 15 U.S.C. §1064 on the basis that it was obtained or maintained fraudulently.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

58. Moreover, as of April 21, 2009, ADI was not the actual owner of the '556 Registration, because the purported December 26, 2002 and April 28, 2004 assignments of the '556 Registration from ADC to ADI were invalid due to the fact that they (i) constituted assignments in gross, unaccompanied by any assets or goodwill associated with the ANDROID DATA mark, and (ii) lacked any consideration in return for the assignment of rights in the ANDROID DATA mark to ADI.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

59. In view of the foregoing, the '556 Registration is also subject to cancellation under 15 U.S.C. §1058 on the basis that the §8 Declaration was not filed by actual owner of the '556 Registration, and the time for submitting a §8 Declaration to the USPTO has now expired.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

60. Additionally, the ANDROID DATA mark of the '556 Registration was abandoned by Specht, ADC and/or ADI through their having ceased all commercial use of

that mark, coupled with their lack of any *bona fide* intent to resume using that mark commercially.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

61. In view of the foregoing, the '556 Registration is subject to cancellation under 15 U.S.C. § 1064 on the basis that the registered ANDROID DATA mark was abandoned.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

62. Google has been and will continue to be damaged by the continued maintenance of the '556 Registration on the Principal Register, because ownership of the '556 Registration has been asserted as grounds for Specht's, ADC's and/or ADI's unfounded claims of trademark infringement, unfair competition, deceptive trade practices and contributory trademark infringement against Google.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

## COUNT II

### **Fraudulent Procurement of Registration Under 15 U.S.C. §1120**

63. Google repeats and realleges the allegations contained in the foregoing ¶¶1-62.

**ANSWER:** Plaintiffs restate and reallege their Answers to Paragraphs 1-62 as their Answer to Paragraph 63 of this Count II as if fully restated herein.

64. ADI's submission of the false '556 §8 Declaration to the USPTO constituted the procurement of a registration by a false or fraudulent declaration or representation, in violation of 15 U.S.C. §1120.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

65. Google has been damaged by the submission of the false and fraudulent declaration, by at least the following: (i) incurring attorney fees and costs associated with its defense of this litigation, (ii) having its reputation impugned and damaged through widespread coverage of Specht's, ADC's and ADI's allegations in the mainstream and online media and throughout the "blogosphere," and (iii) impairment of its business relationships with members of the OHA and others.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

66. Specht's and ADI's false and fraudulent representations to the USPTO have caused irreparable harm, damage and injury to Google.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

### COUNT III

#### **Declaratory Judgment of Invalidity and Unenforceability of Purported Trademark Rights Due to Abandonment**

67. Google repeats and realleges the allegations contained in the foregoing ¶¶1-66.

**ANSWER:** Plaintiffs restate and reallege their Answers to Paragraphs 1-66 as their Answer to Paragraph 67 of this Count III as if fully restated herein.

68. This is a claim for declaratory judgment arising under the Declaratory Judgment Act, 28 U.S.C. §2201.

**ANSWER:** Plaintiffs admit that this Count purports to assert a claim for declaratory judgment under 28 U.S.C. §2201, but Plaintiffs deny that the claim has merit.

69. An actual and justiciable controversy exists between Google and Counterclaim Defendants Specht, ADC and/or ADI with respect to the alleged direct and contributory infringement of the Asserted Marks and unfair competition by Google.

**ANSWER:** The allegations of this Paragraph state legal conclusions of the pleader, to which no answer is required.

70. ADI purports to own rights in the '556 Registration and has asserted those purported rights as grounds for direct and contributory trademark infringement, unfair competition and deceptive trade practices claims asserted against Google. Specht, ADC and/or ADI also allege ownership of common law trademark, service mark, and/or trade name rights in the Asserted Marks.

**ANSWER:** Plaintiffs admit that ADI owns the rights in the '556 Registration, that Plaintiffs have asserted those and other rights as grounds for, among other things, direct and contributory trademark infringement, unfair competition and deceptive trade practices claims. Plaintiffs further admit that they also allege, among other things, ownership of common law

trademark, service mark and/or trade name rights in the Asserted Marks. Except as so admitted, Plaintiffs deny the allegations of this Paragraph.

71. Years prior to Google's adoption of the ANDROID mark, Counterclaim Defendants abandoned any rights they may have had in the Asserted Marks through express statements to others as to ceasing commercial use of the mark and the associated conduct consistent therewith.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

72. Any rights which Specht, ADC and/or ADI may have possessed in the Asserted Marks are invalid and/or unenforceable as a result of the abandonment of such mark(s). Accordingly, Google is entitled to a declaratory judgment that Specht's, ADC's and/or ADI's prior rights, if any, in the Asserted Marks are invalid and unenforceable as a result of such abandonment.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

#### COUNT IV

**Declaratory Judgment of Invalidity and Unenforceability of  
Purported Trademark Rights Due to Fraudulent Procurement of  
U.S. Registration No. 2,639,556 and the Equitable Doctrine of Unclean Hands**

73. Google repeats and realleges the allegations contained in the foregoing ¶¶1-72.

**ANSWER:** Plaintiffs restate and reallege their Answers to Paragraphs 1-72 as their Answer to Paragraph 73 of this Count IV as if fully restated herein.

74. This is a claim for declaratory judgment arising under the Declaratory Judgment Act, 28 U.S.C. §2201.

**ANSWER:** Plaintiffs admit that this Count purports to state a claim for declaratory judgment under 28 U.S.C. §2201, but Plaintiffs deny the claim has merit.

75. An actual and justiciable controversy exists between Google and Counterclaim Defendants Specht, ADC and/or ADI with respect to the alleged direct and contributory infringement of the Asserted Marks, including the '556 Registration, and unfair competition by Google.

**ANSWER:** The allegations of this Paragraph state legal conclusions of the pleader, to which no answer is required.

76. Specht, ADC and/or ADI purport to own rights in and to the ANDROID DATA trademark, and have asserted those purported rights as grounds for trademark infringement, unfair competition and deceptive trade practices claims asserted against Google.

**ANSWER:** Plaintiffs admit that they own rights in and to the ANDROID DATA trademark, and have, among other things, asserted those rights as grounds for trademark infringement, unfair competition and deceptive trade practices claims asserted against Google. Except as so admitted, Plaintiffs deny the allegations of this Paragraph.

77. Any rights which Specht, ADC and/or ADI may have had in the purported ANDROID DATA trademark are invalid and unenforceable due to the commission of fraud before the USPTO. ADI's statement under oath in the §8 Declaration that the ANDROID DATA mark was in use in commerce as of April 21, 2009 was false, inasmuch as neither ADI nor any other related entity had made any *bona fide* use of the ANDROID DATA trademark in commerce in association with the goods listed in the '556 Registration since at least 2002.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

78. Moreover, Specht, ADC and ADI knew that the aforementioned statement was false, inasmuch as they were aware that neither ADI nor any related entity was making any *bona fide* use of the ANDROID DATA trademark in commerce in association with the goods listed in the '556 Registration at the time said statement was made.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

79. By making said false statement in the §8 Declaration, ADI intended to mislead the USPTO into maintaining the '556 Registration on the Principal Register.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

80. The aforementioned false statement was material in that the USPTO would not have accepted the §8 Declaration, and maintained the '556 Registration on the Principal Register, without a statement that the ANDROID DATA mark was in use in commerce in association with the goods listed in the '556 Registration.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

81. Despite their knowledge of the false statements being made by ADI to the USPTO regarding the ANDROID DATA mark in support of the '556 Registration, Specht and ADC seek to enforce rights under the ANDROID DATA mark.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

82. Accordingly, Google is entitled to a declaratory judgment that Specht's, ADC's and/or ADI's purported ANDROID DATA mark is invalid and unenforceable as a result of ADI's commission of fraud before the USPTO.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

## COUNT V

### **Declaratory Judgment of Non-Infringement of Purported Trademark Rights**

83. Google repeats and realleges the allegations contained in the foregoing ¶¶1-82

**ANSWER:** Plaintiffs restate and reallege their Answers to Paragraphs 1-82 as their Answer to Paragraph 83 of this Count V as if fully restated herein.

84. This is a claim for declaratory judgment arising under the Declaratory Judgment Act, 28 U.S.C. §2201.

**ANSWER:** Plaintiffs admit that this Count purports to state a claim for declaratory judgment under 28 U.S.C. §2201, but Plaintiffs deny the claim has merit.

85. An actual and justiciable controversy exists between Google and Counterclaim Defendants Specht, ADC and/or ADI with respect to the alleged direct and contributory infringement of the Asserted Marks and unfair competition by Google.

**ANSWER:** The allegations of this Paragraph state legal conclusions of the pleader, to which no answer is required.

86. Specht, ADC and/or ADI purport to own rights in and to the Asserted Marks and have asserted those rights as grounds for their allegations of direct and contributory

trademark infringement, unfair competition and deceptive trade practices asserted against Google.

**ANSWER:** Plaintiffs admit that they own rights in and to the Asserted Marks and have asserted, among other things, those rights as grounds for their allegations of direct and contributory trademark infringement, unfair competition and deceptive trade practices asserted against Google. Except as so admitted, Plaintiffs deny the allegations of this Paragraph.

87. Even if Specht, ADC and/or ADI possessed any valid rights in the Asserted Marks at the time of Google's adoption of the ANDROID mark, neither Google's nor any other OHA member's subsequent use of the ANDROID mark constitutes trademark infringement, unfair competition or deceptive trade practices, inasmuch as no likelihood of confusion exists between Google's ANDROID mark and Counterclaim Defendants' Asserted Marks.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

88. Google's ANDROID mark and Counterclaim Defendants' Asserted Marks are different in terms of sight, sound, connotation and/or commercial impression, such that no likelihood of confusion can exist between the two.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

89. Further, the products and/or services offered by Google and other OHA members in association with the ANDROID mark travel in different channels of trade and are encountered by different classes of consumers than any purported products and/or services offered at any time by Specht, ADC and/or ADI under any of the Asserted Marks.

**ANSWER:** The allegations of this Paragraph state the legal conclusions of the pleader to which no response is required. To the extent a response is required, Plaintiffs deny the same.

90. No actual confusion exists or has occurred between Google's or any OHA member's alleged use of the ANDROID mark and any of the Asserted Marks.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

91. Accordingly, no likelihood of confusion exists between Google's or any OHA member's use of the ANDROID mark and Counterclaim Defendants' Asserted Marks. Accordingly, Google is entitled to a declaratory judgment that its use of the

ANDROID mark has not infringed, violated, or contributed to the infringement or violation of any rights which Counterclaim Defendants may have in the Asserted Marks.

**ANSWER:** The allegations of this Paragraph state the legal conclusions of the pleader to which no response is required. To the extent a response is required, Plaintiffs deny the same.

## COUNT VI

### **Unfair Competition - Lanham Act**

92. Google repeats and realleges the allegations contained in the foregoing ¶¶1-91.

**ANSWER:** Plaintiffs restate and reallege their Answers to Paragraphs 1-91 as their Answer to Paragraph 92 of this Count VI as if fully restated herein.

93. Counterclaim Defendants have made false or deceptive representations to the marketplace, including through the media and elsewhere, regarding the scope of Counterclaim Defendants' purported rights in the ANDROID DATA mark. Specifically, Counterclaim Defendants have falsely represented that they enjoy exclusive trademark rights in the ANDROID DATA mark in association with computer software, and that Google's and others' use of the ANDROID mark in association with the Android software platform constitutes an infringement of those rights, when in reality Counterclaim Defendants have no such rights as a consequence of their abandonment of the ANDROID DATA mark.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

94. Said false representations regarding the scope of Counterclaim Defendants' purported rights in the ANDROID DATA mark have deceived or are likely to deceive a substantial segment of the intended audience, which includes present or potential customers and users of mobile devices utilizing the Android software platform, as well as present or potential business partners of Google, into believing that Google's use of the ANDROID mark somehow violates Counterclaim Defendants' purported rights.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

95. Google has been injured by Counterclaim Defendants' false representations in at least the following ways: (i) incurring attorney fees and costs associated with its defense of this litigation, (ii) having its reputation and the goodwill associated with its ANDROID mark impugned and damaged through widespread coverage of Specht's, ADC's and ADI's allegations in the mainstream and online media and throughout the "blogosphere," and (iii) impairment of its business relationships with members of the OHA and others.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

96. Counterclaim Defendants' false representations constitute unfair competition in violation of §43(a) of the Lanham Act, 15 U.S.C. §1125(a).

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

97. The acts complained of hereinabove have caused irreparable harm, damage and injury to Google.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

## COUNT VII

### Unfair Competition - Common Law

98. Google repeats and realleges the allegations contained in the foregoing ¶¶1-97.

**ANSWER:** Plaintiffs restate and reallege their Answers to Paragraphs 1-97 as their Answer to Paragraph 98 of this Count VII as if fully restated herein.

99. Counterclaim Defendants are, and at all relevant times have been, perpetrating a scheme to fraudulently claim trademark rights in the Asserted Marks for the purpose of unfairly competing with and/or obtaining valuable consideration from Google.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

100. Counterclaim Defendants' conduct, statements, and misrepresentations alleged herein were made not for the purpose of protecting or enforcing any legitimate trademark rights, but instead for the bad faith purposes of damaging and interfering with Google's and other OHA members' efforts to commercialize and market products that utilize the Android OS platform, and extracting money from Google in return for Counterclaim Defendants' dropping their claims against Google.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

101. The conduct, statements, and misrepresentations by Counterclaim Defendants, made for such illegitimate reasons, shock judicial sensibilities and violate standards of commercial morality, and therefore constitute acts of unfair competition under the common law.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

102. The acts complained of hereinabove have caused irreparable harm, damage and injury to Google, and Google has no adequate remedy at law.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

103. As a consequence of the foregoing acts of unfair competition by Counterclaim Defendants, Google is also entitled to an award of its actual damages, together with its costs and attorney's fees, and to the disgorgement of Counterclaim Defendants' ill-gotten gains.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

104. Counterclaim Defendants' acts were in bad faith, in conscious disregard of Google's rights, and were performed with the intention of depriving Google of its rights. Accordingly, Counterclaim Defendants' conduct merits, and Google seeks, an award of punitive damages in an amount sufficient to punish Counterclaim Defendants and deter such conduct in the future.

**ANSWER:** Plaintiffs deny the allegations of this Paragraph.

### **AFFIRMATIVE DEFENSES**

Plaintiffs raise the following affirmative defenses to the allegations of the Counterclaim. Plaintiffs incorporate the factual allegations of the Second Amended Complaint as providing, in whole or in part, the factual basis for Plaintiffs' Affirmative Defenses.

#### **First Affirmative Defense**

Google's claims are barred by the doctrine of unclean hands, arising out of Google's willful trademark infringement, unfair competition and deceptive trade practices, as alleged in the Second Amended Complaint, including paragraphs 34 - 52 and 86 - 121.

#### **Second Affirmative Defense**

Google's claims are barred by the fact that it does not any valid or enforceable rights to the Android trademark.



**CERTIFICATE OF SERVICE**

John F. Shonkwiler, 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 9th day of April, 2010.

/s/ John F. Shonkwiler