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.	)	

PLAINTIFFS' MOTION FOR RECONSIDERATION OF THE COURTS MEMORANDUM OPINION AND ORDER GRANTING SUMMARY JUDGMENT [ECF 296]

Plaintiffs Erich Specht, an individual and doing business as Android Data Corporation and The Android's Dungeon Incorporated (collectively, "Plaintiffs"), by and through their attorney, respectfully moves this Court to reconsider its Memorandum and Opinion [ECF 296]. In support hereof, Plaintiffs state as follows:

I. THE COURT MAY REVISE ITS ORDER AT ANYTIME BEFORE THE ENTRY OF A FINAL JUDGMENT

Under Federal Rule of Civil Procedure 54, "any order . . . that adjudicates fewer than all the claims or the rights and liabilities of fewer than all the parties … may be revised at any time before the entry of a judgment adjudicating all the claims and all the parties' rights and liabilities." Fed. R. Civ. Proc. 54(b).

II. THE COURT DID NOT HAVE JURISDICTION TO ENTER JUDGMENT ON COUNT I OF GOOGLE'S COUNTERCLAIM UNDER 15 U.S.C. 1064 (3).

1. Count I of Google's counterclaim asks the Court to cancel Plaintiffs Android Data Registration pursuant to 15 U.S.C. 1064 (3).

2. In its opinion, the Court granted Google summary judgment stating that "a party that believes it may suffer harm because of a trademark that has been abandoned by its owner may move to have the registration cancelled. See 15 U.S.C. § 1064(3)."

3. The Court erred in its ruling and misstated the section. The cited section actually permits the party upon payment of the prescribed fee to petition the Trademark Trial and Appeal Board for cancellation. 15 U.S.C. § 1064(3).

4. Section 1064 provides as follows:

> §1064. Cancelation of registration
>
> **A petition** to cancel a registration of a mark, stating the grounds relied upon, **may, upon payment of the prescribed fee, be filed** as follows by any person who believes that he is or will be damaged, including as a result of dilution under section 43(c) [15 USC 1125(c)], by the registration of a mark on the principal register established by this Act, or under the Act of March 3, 1881, or the Act of February 20, 1905: [emphasis added]
>
> * * *
>
> (3) At any time if the registered mark … has been abandoned

U.S.C § 1064(3).

5. A petition to cancel a registration owned by another party may be filed with the Trademark Trial and Appeal Board under §14 of the Trademark Act. *See* overall category "TRADEMARK TRIAL AND APPEAL BOARD FORMS" on the TEAS front page. (http://www.uspto.gov/trademarks/teas/petition_forms.jsp)

6. Accordingly, Plaintiffs respectfully move this Court to reconsider its Order and dismiss Count I of Google's Counterclaim pursuant to FRCP 12(b) (1).

III. GOOGLE MISLED THE COURT REGARDING ANDROID DATA SCREEN SHOTS FROM ARCHIVE.ORG BECAUSE GOOGLE PRODUCED THEM TO PLAINTIFFS

7. In its Memorandum and Order, the Court states that "It [Google] alleges that the late production [of the androiddata.com screenshots from archive.org] deprived them of the opportunity to explore the reliability of the Internet Archive's files, or ask Specht about them at his deposition. [ECF 296 at Page 18.]

8. Prior to its ANDROID announcement, Google retained the services of Investigative Network, Inc. ("IN"), a private investigator located in Arizona to investigate the use of the ANDROID DATA mark by Android Data Corporation ("ADC") and Erich M. Specht. [Exhibit 1, IN000001.]

9. On October 18, 2007, thirteen days before Google filed its 1b, intent to use, application with the PTO, IN produced a report along with exhibits to Google's trademark counsel Terri Y. Chen. *Id.*

10. As part of its investigation for Google, IN conducted "Internet Archive Searches" and reported to Google that:

> We conducted archived Internet searches on Android Data Corporation and located a URL address of **http://www.androiddata.com** and located several URL hyperlinks for our subject, dated between February 2, 2001 through March 10, 2005, see **Exhibit A.** We printed several of the company's archived WebPages from 2001 through 2003, see **Exhibit B** through **Exhibit D.**

Id at IN000004.

11. Exhibit A of the IN report is titled "Internet Archive Wayback Machine" and lists search results for **http://www.androiddata.com** from January 1, 1996 to October 18, 2007. [Exhibit 1, IN00009.]

12. Exhibits B, C and D of the IN report include various screen shots from the **http://www.androiddata.com** web pages. [Exhibit 1, IN000011 through IN000026.]

13. The IN report also indicated that IN identified the Android's Dungeon Incorporated and could conduct a more indepth investigation if Google so desired. There is no indication that Google ever explored that option until 2009. [Exhibit 1, IN000003.]

14. On May 6, 2009, per Google's request, IN submitted it's Supplemental Report1 ("SR1") to Google's trademark counsel, Adam Barea and TU Tsao. [Exhibit 2.]

15. In the SR1, IN states that:

> As previously noted in our overview, Erich M. Specht recently registered the URL address of **www.android-data.com** on April 20, 2009, see **Exhibit A**. Our review of the new website found that the website contains the same WebPages, which we previously found through our 2007 Internet Archive searches…Additionally, we reran the archived WebPages of Android Data Corporation's prior URL address of **androiddata.com,** and reconfirmed our webpage findings referenced in our 2007 report, see **Exhibit E**.

[Exhibit 2, IN000089, IN000110-IN000118, IN000156-60.]

16. The IN reports were tendered by Google's current counsel to Plaintiffs as part of their representation of IN. [Exhibit 1, Certification by Counsel.] Google also produced the same reports in its paper production [Google 2102-2127 and 2128-2262.] Thus, Google's argument that any late production of the androiddata .com screenshots from archive.org deprived them of the opportunity to explore the reliability of the Internet Archive's files is a deliberate misrepresentation of a material fact aimed at misleading this Court.

17. Google had all of the web pages in question and could have done side by side comparisons. Yet, it pointed out no material difference in the content of its pages versus those produced by Plaintiffs.

18. Accordingly, Plaintiffs ask that the Court reverse its previous order and consider the Internet Archives printouts from Plaintiffs' Summary Judgment Exhibits in evidence.

IV. GOOGLE MISLED THE COURT REGARDING ANDROID DATA SCREEN SHOTS FROM ARCHIVE.ORG BECAUSE GOOGLE SPECIFICALLY USED THEM IN THEIR PTO ARGUMENT TO CLAIM THAT ANDROID DATA WAS ABANDONED AFTER MARCH 5, 2005

19. In addition to having the screenshots in its possession, Google also used information it obtained from archive.org in a sworn statement to the PTO for reconsideration

20. In its Response to Office Action dated August 14, 2008, signed under oath by Google's counsel, Tu T. Tsao, Google argued that:

> According to Archive.org, the last possible commercial use of ANDROID DATA on androiddata.com, the website of registrant, was on March 10, 2005 (http://web.archive.org/web/20050310015150/http://www.androiddata.com/).

[ECF 38-6 at p.1 and ECF 134-2 at p. 27.)

21. As admitted by Google, at paragraph 38 of the SAC, a true and correct copy of Google's Response cited above is attached as Exhibit E to the SAC.

22. Again Google's argument to the PTO contradicts its statements to this Court and demonstrates that it had the exact pages in its possession which it is asking the Court to disallow.

23. Google was not prejudiced and was never deprived of an opportunity to explore the reliability of the Internet Archive's files.

24. Thus, Google's argument that it was deprived of the opportunity to explore the reliability of the Internet Archive's files is without merit and a deliberate misrepresentation to this Court.

25. Accordingly, Plaintiffs ask that the Court reverse its previous order and consider the Internet Archive printouts from Plaintiffs' Summary Judgment Exhibits in evidence.

V. GOOGLE MISLED THE COURT REGARDING ANDROID DATA SCREEN SHOTS FROM ARCHIVE.ORG BECAUSE GOOGLE USED THEM TO ARGUE SIMILARITIES BETWEEN PLAINTIFFS WEB SITES

26. In almost every motion filed before the Court, Google has argued that the content in <androiddata.com> is almost identical to the content in <android-data.com>.

27. Even in it's summary judgment memorandum, Google argued that :

> Mr. Specht…registered a new domain name…and immediately posted a near-identical copy of the old Android Data Corporation website…

[ECF 254 p. 14.]

28. The Court even mentions Google's argument in its Memorandum and Order granting Google Summary Judgment:

> On April 20, 2009, Specht registered the domain name www.android-data.com and launched a website at the domain with similar content to that which allegedly existed at androiddata.com

29. In addition to having the screenshots in their possession, Google and its investigators have demonstrated that they have relied heavily upon the Internet archive site archive.org to investigate information concerning websites.

30. Google has demonstrated an awareness and reliance on the archive.org site to investigate businesses and rely on the information in its arguments before the courts and regulatory bodies such as the PTO.

31. Google cannot be allowed to benefit from its misrepresentations to this Court.

32. Accordingly, the Court should consider the screen shots from archive.org in evidence.

VI. GOOGLE'S SWORN STATEMENT TO THE PTO IS A BINDING ADDMISSION AGAINST ITS SELF INTEREST

33. As set forth above, the Court should admit the screenshots from archive.org into evidence.

34. In determining the issue of abandonment, the Court found that the issue came down to whether Plaintiffs' maintenance of its website constituted a use in commerce. Specifically, the Court found that:

> Whether a three year period of nonuse of the ANDROID DATA MARK exists to create a rebuttable presumption of abandonment hinges on if Plaintiffs' maintenance of the website at androiddata.com after ADC ceased operations was a bona fide use in commerce of the mark.

35. Google's admission to the PTO that androiddata.com website constitutes a commercial use of ANDROID DATA is a binding admission against Google. FRE Rule 801(d)(1)(A).

36. In addition to Google's binding admission, the Court should pay deference to the USPTO's decision to accept plaintiffs section 8 filing which included screenshots of its website as evidence of a bona fide use in commerce of its Android Data mark. [Google S.J. Ex. 53.]

37. The acceptance by the PTO should be considered by the Court as prima facie evidence that the website complies with the test established under *In re Dell* and elaborated under *In re Genitope*. *In re Dell Inc.*, 71 U.S.P.Q.2d 1725 (T.T.A.B. 2004) and *In re Genitope Corp*., 78 U.S.P.Q.2d 1819 (T.T.A.B. 2006.)

38. From 2002 through 2005, Plaintiffs androiddata.com site included a "picture" of the goods, the Android Data® mark prominently displayed and the following contact information about the company:

> Main Offices: (847)963-1969
> Android Data Corporation
> 114 North Ashland Avenue
> Palatine, IL 60067

Email links for more information:

> General Information: inquiry@androiddata.com
> Technical Support: support@androiddata.com

Investment Opportunities: bizInquiry@androiddata.com

And order form:

To request a brochure, please supply the following information…

First Name, Last Name, Company Name
Address, City, State, Zip/Postal Code:
Country:
Phone and email address

[Exhibit 1, IN000023-26.]

39. Accordingly, there is no question of fact regarding Plaintiffs use of the ANDROID DATA mark in commerce through at least March 10, 2005.

VII. THROUGHOUT THE PLEADING AND DISCOVERY STAGES, GOOGLE HAS MAINTAINED THAT IT HAS NOT USED ANDROID IN COMMERCE

40. While Plaintiffs agree with the Court's conclusion that Google has used Android in commerce. There is a genuine question of fact regarding how and when that use first occurred.

41. As of April 13, 2008, the Android phone and operating system were not ready for sale or distribution. [Exhibit 4, Google-E-0030446.]

42. The T-Mobile G-1, the first Android powered mobile phone, was not made available to consumers until October 22, 2008. [Def. SJ Ex. 41]

43. However, on April 3, 2009, five months after the T-Mobile G-1 was released to the public, Google admits that "Android unfortunately isn't very consumer-y at the moment. We haven't really marketed it as a consumer brand so I think the awareness level is quite low amongst users." [Exhibit 4, Google-E-0043465.]

44. On June 22, 2009, Google filed its motion and memorandum in support of its motion to dismiss the FAC. [ECF 73, 75.] In its memorandum, Google made the following argument regarding the press release and advertisements referenced in the complaint:

> To the extent not already disregarded by the Court as "naked assertions," Plaintiffs' allegations relating to the purported use of the ANDROID mark in press releases and promotional materials … fail to identify the alleged press releases or advertisements, or describe how any of those materials constitute unlawful use of the ANDROID mark in commerce in the United Sates. Press releases, advertisements and the like do not comprise a use in commerce," as such materials do not evidence use of a trademark in connection with any goods or "documents associated with the goods or their sale." *See Morningside Group Ltd. v. Morningside Capital Group, L.L.C.*., 182 F.3d 133, 138 (2nd Cir. 1999) ("Mere advertising and promotion of a mark in this country are not enough to constitute 'use' of the mark 'in commerce,' so as to bring the activity within the scope of the Lanham Act."); *T.A.B. Sys. v. Pactel Teletrac*, 77 F.3d 1372, 1375-76 (Fed. Cir. 1996) (noting that press releases and promotional materials bearing the mark do not qualify as "use in commerce"). [ECF 75 pp. 12, 13]

45. This Court had the following to say about Google's argument:

> Defendants assert, however, that Plaintiffs have failed to allege the second prong - that Defendants "use" the mark "in commerce." According to Defendants, Plaintiffs have not alleged that Defendants advertised or offered actual infringing products or services.
>
> * * * *
>
> The actual existence and scope of Google's use are questions of fact to be decided after discovery has closed. At the motion to dismiss stage, "Plaintiffs need not prove either defendants' use or likelihood of confusion . . . both are questions of fact to be determined at a later stage." *Id.* at 807-08. [ECF 113, pp. 8, 9, 10]

46. In its answer to paragraph 35 of the SAC, Google denied that it has sold any products or services in association with its ANDROID mark. [ECF 136 p. 11.]

47. In its answer to interrogatories, Google claimed that it did not receive any revenue from the use, sale, licensing or distribution of the Android OS. [Exhibit 5 see for e.g. Resp. to Int. No. 15.]

48. Throughout its interrogatory answers, Google completely disclaims ownership of Android. [Exhibit 5.]

49. In its interrogatory answers, Google did admit that, beginning in Q1 2009, after the release of the T-Mobile G1 smart phone, it began receiving a share of the revenue generated by the sale of applications programs for Android-enabled devices. *Id.*

50. Throughout the pleading and discovery stages Google has maintained that it does not use Android in commerce, because Android is a product of the OHA, not Google, and open sourced. Therefore anyone can use the ANDROID mark.

51. For example, in the 30(b)(6) deposition, Andy Rubin, Director for Mobile Platforms for Google, testified on behalf of Google that after the USPTO rejected Google's ANDROID registration:

> I didn't feel the need for Google to protect it as its mark. I felt that it was an open platform…That name didn't necessarily have to be protected by trademark by Google. [Ex. 3 Rubin Dep. 139:17-140:1]
>
> * * *
>
> We started the Open Handset Alliance, and many members of the Open Handset Alliance also contributed to the Android effort, so from a business perspective I thought it would actually unbalance the nature of openness if Google claimed ownership over the name Android. [Ex. 3 Rubin Dep. 141:3.]

52. Another example of "Android is free for everyone to use" is contained in Google's answer to Interrogatory No. 15 wherein Google admits that it knowingly allows third parties to sell "Android"-themed merchandise without receiving any consideration. [Exhibit 5.]

53. This line of thought is also echoed throughout Google's production. In an e-mail dated November 8, 2009, Google states "please don't call this the Google operating system' – this is from the OHA and not Google." [Exhibit 4, Google-E-0040408.]

54. In an email dated November 17, 2009, from Google to Samsung, Google tells Samsung to "change the line 'the Google operating system' please take that out. It's from the OHA not Google." [Exhibit 4, Google-E-0039985.]

55. Google filed its trademark application under 1b, intent to use, and not under 1a, based on actual use. 15 U.S.C. 1051 (b) (a). It is important to note that Google filed a 1b, intent to use, application for the Android mark, since this would not be considered an admission or allegation of actual use. 15 U.C.C. 1051(b).

56. Although permitted to do so, Google has never filed an affidavit of use or excusable non-use with the PTO. 15 U.S.C. 1051(c). [Exhibit 3.]

57. Accordingly, Google has denied using its Android mark in commerce; claimed that Android is a product of the OHA; and failed to take any steps to protect the mark from third party use.

58. Thus, for the foregoing reasons, there is a genuine issue of fact regarding the actual date and scope of Google's use in commerce which would prevent the Court from entering summary judgment.

59. Plaintiffs respectfully request that the Court reconsider its ruling and deny Google's Motion for Summary Judgment as to all counts.

WHEREFORE, Plaintiffs respectfully request that the Court enter an Order:

A. Granting Plaintiffs Motion for Reconsideration and vacating the Order of December 17, 2010 granting Defendant Google's Motion for Summary Judgment for Counts I-V of Plaintiffs' Second Amended Complaint, and for Counts I and III of Google's Counterclaim;

B. Dismissing Count I of Google's Counterclaim pursuant to FRCP 12(b)(1); and

C. Granting Plaintiffs such other and further relief as is appropriate under the circumstances.

Respectfully submitted,

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

By: /s/Martin J. Murphy

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CERTIFICATE OF SERVICE

Martin J. Murphy, 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 _31st__ day of January, 2011.

/s/ Martin J. Murphy