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

TIMELINES, INC.	)	
	)	
Plaintiff,	)	
	)	
v.	)	Civil Action No.: 11 CV 6867
	)	
FACEBOOK, INC.	)	HONORABLE JOHN W. DARRAH
	)	
Defendant.	)	

DEFENDANT FACEBOOK, INC.'S OPPOSITION TO PLAINTIFF'S MOTION *IN LIMINE* NO. 2 TO EXCLUDE FACEBOOK FROM MENTIONING AT TRIAL THAT FACEBOOK IS SEEKING CANCELLATION OF THE TIMELINES MARKS

I. INTRODUCTION

Facebook's claim that Plaintiff's alleged trademarks are invalid because they are generic, or at a minimum descriptive, is fundamental to this case. Plaintiff's Motion *in Limine* No. 2 ("Motion") asks this Court to take the extraordinary and unprecedented measure of preventing Facebook from even mentioning to the jury that it filed a counterclaim seeking cancellation of the trademark registrations that Plaintiff has asserted against Facebook in this litigation.

Plaintiff's arguments lack merit. Facebook's cancellation counterclaim alleges that Plaintiff's registrations should be cancelled because the "marks" are generic. This Court has held that the genericness of Plaintiff's "Timelines" marks involves a question of fact to be decided by the jury, and it is obviously essential that the jury know the effect of its decision. Nor is the mere mention of Facebook's claim prejudicial. Upon hearing that Facebook has a counterclaim against Plaintiff, the jury will not automatically assume Facebook must prevail, any more than it will assume Plaintiff must prevail when the jury learns that Plaintiff is suing Facebook. Plaintiff's request that the Court exclude the mere mention of Facebook's

counterclaim is nothing more than an attempt to conceal from the jury anything that might support Facebook's case.

II. ARGUMENT

A. The Court Should Deny Plaintiff's Motion Because the Fact that Facebook Has Asserted a Counterclaim Against Plaintiff in this Action is Relevant, Admissible and Probative Information for the Jury.

Plaintiff argues that the Court should prevent Facebook from telling the jury that it filed a counterclaim against Plaintiff that seeks cancellation of the registrations at issue because Facebook's counterclaim is "not relevant" to this case, "will not [be] decid[ed]" by the jury, and is inadmissible under Rule 401 of the Federal Rules of Evidence. (Pl. Br., p. 2) Plaintiff is wrong on all points and cites no law that supports this novel argument. In fact, Facebook is unaware of any case where a court prevented a defendant from telling the jury it has asserted a counterclaim against the plaintiff.

The Court has broad discretion to rule on motions *in limine*. *Jenkins v. Chrysler Motors Corp*., 316 F.3d 663, 664 (7th Cir. 2002). The purpose of a motion *in limine* is to prevent the jury from hearing evidence that is "clearly inadmissible on ***all possible grounds***." *Anglin v. Sears, Roebuck & Co.*, 139 F. Supp. 2d 914, 917 (N.D. Ill. 2001) (emphasis added).

Under Rule 401, evidence is admissible if it has a tendency to make a fact more or less probable than it would be without the evidence and the fact is of consequence in determining the action. Fed. R. Evid. 401. Thus, facts concerning central issues in the case are undoubtedly relevant and admissible. *See id.* Even if a fact is not determinative of an issue in the case, however, it may still be admissible to provide the jury with helpful background information or provide context for the parties' dispute. Fed. R. Evid. 401, advisory committee's note ("Evidence which is essentially background in nature . . . is universally offered and admitted as an aid to understanding."). This includes, for example, telling the jury what remedy each party is

seeking in the case. *E.g.*, *Telewizja Polska USA, Inc. v. Echostar Satellite Corp.*, 2004 WL 2367740, *9 (N.D. Ill. Oct 15, 2004) (denying motion *in limine* to prevent party from mentioning that it sought disgorgement damages for unjust enrichment claim because unjust enrichment claim was at issue in case). Evidence is also relevant under Rule 401 if its exclusion would fill a "conceptual void" for the jury or permits the jury to better understand the context of a case. *Wilson v. Groaning*, 25 F.3d 581, 584 (7th Cir. 1994); *United States v. Vretta*, 790 F.2d 651, 655 (7th Cir. 1986); *see also Union Carbide Corp. v. Montell N.W.*, 28 F. Supp. 2d 833 (S.D.N.Y. 1998) (denying motion to exclude evidence because the evidence would "provide the jury with context and information necessary to understand the case").

Facebook's cancellation counterclaim alleges that the registrations of Plaintiff's purported trademark should be cancelled. To prevail on a claim for cancellation, a party must prove there are valid grounds why the registration should not continue to be registered, such as a mark being generic. 3 J. Thomas McCarthy, *McCarthy on Trademarks* § 20:41 (4th ed. 2013). This Court has held that there is a question of fact as to whether Plaintiff's alleged marks are generic. (Mem. Op. and Order, Dkt. 116, Apr. 1, 2013, pp. 15-16 ("[t]he classification of Plaintiff's marks is a question of fact . . . .")). *See also Packman v. Chicago Tribune Co.*, 267 F.3d 628, 637 (7th Cir. 2001); *Texas Pig Stands, Inc. v. Hard Rock Café Int'l, Inc.*, 951 F.2d 684, 692 (5th Cir. 1992). Thus, unless the Court rules in Facebook's favor on a motion for a directed verdict or a motion for judgment as a matter of law, the *jury* in this case will determine whether Plaintiff's mark is protectable or requires cancellation. It would be nonsensical for the Court to prevent Facebook from informing the jury that Facebook seeks cancellation when the jury may ultimately decide whether Facebook prevails on that claim.

Accordingly, the Court should deny Plaintiff's Motion.

B. The Court Should Deny Plaintiff's Motion Because the Fact that Facebook Has Asserted a Counterclaim Against Plaintiff in this Action is Not Unfairly Prejudicial or Confusing.

Plaintiff also argues that mention of Facebook's counterclaim should be excluded as prejudicial and confusing under Rule 403 because, if the jury learns that Facebook is suing Plaintiff for cancellation of the mark, it might think Facebook's claim has merit (*i.e.*, that the "marks are generic and not protectable"). (Pl. Br., p. 3) Plaintiff again cites no law in support of this argument.

There is nothing prejudicial or confusing about the mere fact that Facebook has asserted a counterclaim against Plaintiff, just as there is nothing prejudicial or confusing about the mere fact that the Plaintiff has filed this action against Facebook. This is because simply informing the jury of the parties' claims – the reason why they are at trial – does not instantly cause the jury to think that one party or the other will prevail. If it did, then no court would ever permit the jury to learn which party is suing which party, and juries would have no context in which to view the evidence. In fact, it would be confusing ***not*** to tell the jury that they will be deciding Plaintiff's claims ***and*** Facebook's counterclaims. These are basic facts about the case that frame the issues for the jury and help members of the jury understand what they are tasked with deciding. It strains credulity for Plaintiffs to suggest that the Court should tell the jury that Plaintiff is suing Facebook, but not that Facebook has asserted a counterclaim against Plaintiff.

If anything, explaining that Facebook seeks cancellation of Plaintiff's trademark registrations will assist the jury in understanding the issues in the case. The trademark registration process is not within the everyday understanding of a jury. Without knowing that Facebook is suing for cancellation, for example, the jury might presume that a trademark is valid simply because it is registered, a grant of registration is final and cannot be challenged, or there is no mechanism by which Plaintiff's mark can be shown to be invalid and unregistered – none

of which are true. The Court should refuse Plaintiff's attempt to keep that information from the jury.

III. CONCLUSION

For the reasons stated above, Facebook respectfully requests that the Court deny Plaintiff's Motion *in Limine* No. 2 to Exclude Facebook from Mentioning at Trial that Facebook is Seeking Cancellation of the Timelines Mark.

Dated: April 15, 2013

Respectfully submitted,

COOLEY LLP

By: */s/ Peter J. Willsey*

Peter J. Willsey (*pro hac vice*)
Brendan J. Hughes (*pro hac vice*)
COOLEY LLP
1299 Pennsylvania Ave., NW, Ste 700
Washington, DC 20004-2400
Tel: (202) 842-7800
Fax: (202) 842-7899
Email: pwillsey@cooley.com
bhughes@cooley.com

Michael G. Rhodes (*pro hac vice*)
101 California Street, 5th Floor
San Francisco, CA 94111-5800
Tel: (415) 693-2000
Fax: (415) 693-2222
Email: rhodesmg@cooley.com

Steven D. McCormick (#1824260)
KIRKLAND & ELLIS LLP
300 North LaSalle
Chicago, IL 60654-3406
Tel: (312) 862-2000
Fax: (312) 862-2200
Email: smccormick@kirkland.com

Counsel for Facebook, Inc.

CERTIFICATE OF SERVICE

The undersigned, an attorney, hereby certifies that he served the foregoing **DEFENDANT FACEBOOK, INC.'S OPPOSITION TO PLAINTIFF'S MOTION *IN LIMINE* NO. 2 TO EXCLUDE FACEBOOK FROM MENTIONING AT TRIAL THAT FACEBOOK IS SEEKING CANCELLATION OF THE TIMELINES MARKS** by means of the Court's CM/ECF System, which causes a true and correct copy of the same to be served electronically on all CM/ECF registered counsel of record, on April 15, 2013.

Dated: April 15, 2013

/s/ Brendan J. Hughes

Brendan J. Hughes (*pro hac vice*)
COOLEY LLP
1299 Pennsylvania Ave., NW, Ste 700
Washington, DC 20004-2400
Tel: (202) 842-7800
Fax: (202) 842-7899
Email: bhughes@cooley.com

190168 /DC