

**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. 1 TO EXCLUDE THE SURVEY AND
TESTIMONY OF DR. DEBORAH JAY AT TRIAL**

I. INTRODUCTION

In an effort to avoid facing irrefutable survey evidence at trial proving that its alleged “Timelines” mark is generic and thus incapable of functioning as a trademark, Plaintiff Timelines, Inc. (“Plaintiff”) moves the Court to exclude the survey and testimony of Dr. Deborah Jay on faulty challenges to her survey methodology and analysis. Specifically, Plaintiff alleges that Dr. Jay departed “from generally-accepted principles of survey research” because she (a) conducted the genericness survey telephonically (rather than over the internet), (b) did not randomize the tested terms “timeline” and “timelines” with the six control terms, (c) combined the “have not heard of a name or term” and “don’t know what it refers to” survey response options into a single answer, and (d) did not account for the “life cycle” of Plaintiff’s product.

Plaintiff’s attack on Dr. Jay’s survey methodology and analysis demonstrates a fundamental misunderstanding by Plaintiff and its expert, Dr. Eli Seggev, of the way in which genericness surveys should be (and are typically) conducted. First, genericness surveys, unlike likelihood of confusion surveys, do not need to replicate market conditions and thus are routinely conducted over the telephone. Second, genericness surveys often ask questions relating to the

test terms after questions about the control terms in order to ensure that the respondents have the same frame of reference before being asked to classify the test term as a brand or a common name. Third, there is no support for Plaintiff's contention that combining the "have not heard" and "don't know" survey response options into a single answer biased the survey or the analysis of the same in any manner. Fourth, the supposed "life cycle" of a product has no bearing on a genericness survey because a generic term, like Plaintiff's alleged mark "Timelines," can never function as a trademark no matter how long it is used by a party.

Finally, neither Plaintiff nor its expert dispute that Dr. Jay's survey squarely comported with the generally-accepted *Teflon* survey model for testing genericness; identified the proper universe of respondents; relied upon the appropriate selection of a sample population that accurately represents that universe; used clear, precise, and unbiased questions; incorporated filter questions and a double-blind research methodology; and utilized consistent and accurate data collection procedures. Therefore, at most, Plaintiff's alleged "biases" may be argued to the jury and cannot result in the exclusion of Dr. Jay's survey.

Facebook thus respectfully requests that the Court deny Plaintiff's motion.

II. BACKGROUND

Dr. Jay is a renowned expert in the field of market research with over thirty years experience conducting large-scale surveys of all types, including genericness surveys. (Pl.'s Mem. in Support of MIL No. 1, Ex. A, Dkt. 124-1, ("Jay Report") at pp. 3-5.) Numerous courts, including this one, have admitted and relied upon her telephone surveys. (Declaration of Dr. Deborah Jay ("Jay Decl.") ¶ 2.) See *TY Inc. v. Softbelly's Inc.*, 2006 U.S. Dist. LEXIS 100736, at *37 (N.D. Ill. Apr. 7, 2006); *UGG Holdings, Inc. v. Severn*, 2005 WL 5887187, at *5 (C.D. Cal. Feb. 23, 2005); *Auto. Club of S. Cal. v. The Auto Club, Ltd.*, 2007 WL 704892, at *4 (C.D. Cal. Mar. 15, 2007); *Great Am. Rest.*, 2008 WL 1808532, at *3 (E.D. Tex. Apr. 21, 2008).

Dr. Jay conducted a *Teflon* model survey to determine the primary significance of the terms “timeline” and “timelines” to relevant consumers. (*Id.*, p. 1.) The *Teflon* model, named for the genericness survey endorsed in the seminal case, *E. I. Du Pont de Nemours & Co. v. Yoshida International, Inc.*, 393 F. Supp. 502 (E.D.N.Y. 1975), is one of two preferred survey models approved by courts for determining genericness. 2 J. Thomas McCarthy, Trademarks and Unfair Competition (“McCarthy”) § 12:16 (4th ed. 2011). *See also*, *Premier Nutrition Inc. v. Organic Food Bar Inc.*, 86 U.S.P.Q. 2d 1344 (C.D. Cal. 2008) (court accepted *Teflon*-style survey in support of summary judgment that the term “Organic Food Bar” was generic); *March Madness Athletic Ass’n, L.L.C. v. Netfire, Inc.*, 310 F. Supp. 2d 786, 803-804 (N.D. Tex. 2003), *aff’d*, 120 Fed. Appx. 540 (5th Cir. 2005) (court accepted *Teflon*-style survey in support of a finding that MARCH MADNESS was not generic). The model is “essentially a mini-course in the generic versus trademark distinction, followed by a test” of other marks and generic names in a list constructed and tailored to the facts of a particular case. McCarthy at § 12:14.

In *E. I. Du Pont de Nemours & Co.*, the admitted *Teflon* survey was conducted telephonically. *E. I. Du Pont de Nemours & Co.*, 393 F. Supp. at 526. The survey interviewers read eight terms to the respondents. *Id.* For each term, the interviewers asked the respondents the following: “Now, would you say (TERM) is a brand name or a common name?” *Id.*; McCarthy § 12:16.

Dr. Jay’s interviewers asked respondents virtually the identical question during telephone interviews, except the interviewers not only read the terms aloud, but also spelled out each term to the respondents. (Jay Report, p. 7-13.) In addition, the order of the response categories was rotated. (*Id.* ¶ 12, n. 7.) In other words, approximately half of the survey respondents were asked “Do you think (TERM), which is spelled ... is a common name or brand name?” and half were asked “Do you think (TERM), which is spelled ... is a brand name or common name?”

(*Id.*) The interviewers also randomized the order in which the control terms were read to respondents, and then posed the question pertaining to either “timeline” or “timelines.” (*Id.*, p. 12.) Interviewers also were monitored throughout data collection to ensure they pronounced the terms correctly. (*Id.* ¶ 8.)

When a survey respondent finished answering a question, Dr. Jay’s interviewers recorded the survey respondent’s answer in a computer database by selecting one of the following five response categories: brand name, common name, other (specify), haven’t heard/don’t know, and refused. (*Id.*, pp. 8-9.) The “other (specify)” category was provided so that interviewers could record the verbatim response for answers that did not match one of the other response categories. (*Id.*, p. 9, Appendix C & F.)

Dr. Jay’s survey provides ample support for a finding that Plaintiff’s alleged “Timelines” mark is generic. When asked whether “timeline” or “timelines” was a common or brand name when used in connection with a website or website feature, a significant majority of respondents expressed their belief that the terms “timeline” (69% of respondents) and “timelines” (68% of respondents) are generic – not brand names. (*Id.*, pp. 24-25.)

III. ARGUMENT

The Seventh Circuit has developed a three-step approach for assessing the admissibility of expert testimony under Federal Rule of Evidence 702:

First, “the witness must be qualified ‘as an expert by knowledge, skill, experience, training, or education.’” Second, “the expert’s reasoning or methodologies underlying the testimony must be scientifically reliable.” Third, the expert’s testimony must be relevant, that is, it must “assist the trier of fact to understand the evidence or to determine a fact in issue.”

Competitive Edge, Inc. v. Staples, Inc., 763 F. Supp. 2d 997, 1007 (N.D. Ill. 2010) (citing *Ervin v. Johnson & Johnson, Inc.*, 492 F.3d 901, 904 (7th Cir. 2009) (internal citations omitted)).

In its motion, Plaintiff does not challenge Dr. Jay’s credentials as an expert. Instead,

Plaintiff contends that the Court should exclude Dr. Jay's survey and testimony on the grounds that her survey methodology and analysis are unsound because she: (a) conducted the genericness survey telephonically, (b) did not randomize the tested terms "timeline" and "timelines" with the six control terms, (c) combined the "have not heard of a name or term" and "don't know what it refers to" survey response options into a single answer, and (d) did not account for the "life cycle" of Plaintiff's product. Plaintiff's arguments lack merit.

A. The Court Should Deny Plaintiff's Motion Because the Methodology Employed by Dr. Jay When Conducting the Survey Was Sound.

1. Surveys Testing Genericness May and Routinely Are Conducted Telephonically.

Plaintiff challenges the admissibility of Dr. Jay's survey because it "failed to replicate market conditions." (Pl.'s Br., pp. 4-6.) Specifically, Plaintiff argues that because Dr. Jay conducted the survey telephonically, it resulted in an "auditory bias." (*Id.*, p. 5.)

A genericness survey tests whether respondents believe that a term has trademark significance; it is not based on how the term appears in the marketplace. Thus, genericness surveys are routinely conducted over the telephone. *See, e.g., Ty Inc. v. Softbelly's Inc.*, 353 F.3d 528, 530 (7th Cir. 2003) (phone survey conducted on the genericness of "Beanies"); *March Madness Athletic Ass'n, L.L.C. v. Netfire, Inc.*, 310 F. Supp. 2d 786, 803 (N.D. Tex. 2003) ("Approximately 700 adults were contacted by phone . . ."); *SportsChannel Assocs. v. Comm'r of Patents and Trademarks*, 903 F. Supp. 418, 421 (E.D.N.Y. 1995) ("This survey was a random-digit dial telephone survey conducted in a defined twenty-nine county market area surrounding and including New York City."); *Intel Corp. v. Advanced Micro Devices, Inc.*, 756 F. Supp. 1292, 1296 (N.D. Cal. 1991) ("The method of conducting the survey consisted of computer assisted telephone interviews."); *Schmidt v. Quigg*, 609 F. Supp. 227, 230 (E.D. Mich. 1985) ("The survey was conducted by telephone . . ."). In fact, the *Teflon* survey itself in the *E. I. Du*

Pont de Nemours case was conducted telephonically. *E. I. Du Pont de Nemours*, 393 F. Supp. at 526.

Neither Plaintiff nor its expert can point to any specific evidence demonstrating the manifestation of the alleged “auditory bias” in Dr. Jay’s survey. (*Id.*) Further, each case cited by Plaintiff in support of its contention that it was inappropriate for Dr. Jay to conduct a telephonic survey either involved or discussed surveys testing *consumer confusion or secondary meaning* – not genericness – and thus are irrelevant. See e.g., *Competitive Edge, Inc.*, 763 F. Supp. 2d at 1009 (“surveys testing consumer confusion should mimic market conditions, including the context in which purchases are made”); *Sears, Roebuck and Co. v. Menard, Inc.*, No. 01-cv-9843, 2003 WL 168642, at * 2 (N.D. Ill. Jan. 24, 2003) (surveys testing consumer confusion relating to television and radio commercials); *Spraying Sys. Co.*, 975 F.2d, 387, 396 (7th Cir. 1992) (surveys testing likelihood of confusion in trademarks and secondary meaning in trade dress); *Quill Natural Spring Water, Ltd. v. Quill Corp.*, No. 91-C-8071, 1994 WL 559237, at *9 (N.D. Ill. Oct. 7, 1994) (survey testing trademark infringement). Unlike with genericness surveys, it is critical for a survey that is testing for *infringement* to replicate market conditions because the only actionable confusion occurs at the point of purchase. See *Packman v. Chicago Tribune Co.*, 267 F.3d 628, 645 (7th Cir. 2001).

Plaintiff’s suggestion that leading authorities, such as Professor J. Thomas McCarthy, Professor Shari Diamond, and Dr. Jay herself, support Plaintiff’s position is incorrect. In his treatise on trademarks and unfair competition, Professor McCarthy states that “[s]urveys taken by telephone should not be discounted or denigrated, but accepted as probative evidence if properly conducted.” McCarthy § 32:163. In her guide on survey research, Professor Diamond states that “[t]elephone surveys...are particularly useful when the population is large and geographically dispersed.” Shari S. Diamond, REFERENCE GUIDE ON SURVEY RESEARCH IN THE

REFERENCE MANUAL ON SCIENTIFIC EVIDENCE, 3rd Edition 359, 403 (2011). Finally, while Plaintiff quotes an article in which Dr. Jay states that “visual stimuli *may* be appropriate in a genericness dispute” (emphasis added), Plaintiff neglects to mention that Dr. Jay also found in her research that “genericness surveys often are conducted with probability samples over the telephone.” E. Deborah Jay, *Genericness Surveys in Trademark Disputes: Evolution of Species*, 99 TMR 1118, 1156 (2009).

There is simply no support for Plaintiff’s contention that Dr. Jay’s genericness survey is somehow unreliable because it was conducted over the phone.

2. Dr. Jay’s Survey Properly Randomized The Questions.

Plaintiff also argues that Dr. Jay’s survey is not reliable because she did not have the interviewers rotate when they posed the final question relating to the tested terms “timeline” and “timelines” to the survey respondents. Plaintiff acknowledges that Dr. Jay rotated the order of all of the other questions relating to the control terms.

Dr. Jay randomized the questions relating to the control terms in order to minimize the influence of any particular control term on the responses to the tested term. (Jay Decl. ¶ 3.) By reading the control terms first, Dr. Jay ensured that all respondents had the same frame of reference before being asked to classify the test term as a brand or common name. (*Id.*) This approach is often used in *Teflon* surveys. (*Id.*)

Plaintiff fails to cite a single case holding that a survey is unreliable if the questions relating to the control terms are rotated randomly, but not the questions relating to the test terms. Nor has Plaintiff identified any particular responses to Dr. Jay’s survey as evidence of the alleged bias caused by not rotating the final questions relating to the test terms. Finally, other than its own expert testimony, Plaintiff is not able to point to any treatises or other authority

indicating that a genericness survey is unreliable if the questions relating to the test terms are asked last.

Regardless, even if the Court were to find that Dr. Jay should have included the questions relating to the test terms in the randomized rotation, such a minor issue does not make Dr. Jay's survey unreliable as a whole. If anything, the issue of whether the questions were properly randomized goes to the weight of the survey evidence, not its admissibility. *See, e.g., J & J Snack Foods Corp. v. Nestle USA, Inc.*, 149 F. Supp. 2d 136, 153, n.12 (D.N.J. 2001) (finding that failing to rotate the terms in defendant's *Teflon* survey did not make the survey unreliable).

3. Asking the “Have Not Heard” and “Don’t Know” Questions Together Was Proper and Had No Effect on the Survey Results.

Plaintiff also claims that when recording responses, Dr. Jay's interviewers should have distinguished between those respondents who said that they had not heard of a term and those who said that they were unable to classify the term as a common name or brand name. Plaintiff, however, fails to provide any legitimate rationale as to why it is important to record with more specificity the reason why a survey respondent was not able to classify the term “timeline” or “timelines” as a brand name or common name. Nor does Plaintiff provide any explanation as to why failing to do so somehow renders Dr. Jay's entire survey unreliable.

Most of the respondents to Dr. Jay's survey were able to classify the terms “timeline” (93%) and “timelines” (92%) as either a brand name or common name. More importantly, over two-thirds of all respondents classified the terms “timeline” (69%) and “timelines” (68%) as common names, and approximately three-fourths (74%) of those respondents who expressed an opinion classified these terms as common names.

Furthermore, Dr. Jay's *Teflon* surveys, using the same recordation process for “have not heard” and “don't know” answers, have been found to be admissible by numerous courts and the Trademark Trial and Appeal Board. (Jay Decl. ¶ 2.) *See, e.g., UGG Holdings, Inc.*, 2005 WL

5887187, at *5; *Auto. Club of S. Cal.*, 2007 WL 704892, at *4; *Great Am. Rest.*, 2008 WL 1808532, at *3. For example, in *UGG Holdings, Inc. v. Severn*, Dr. Jay conducted a survey in virtually the same manner as in this case. “After closely examining Jay's report,” the U.S. District court for the Central District of California found that “her survey was fairly and scientifically conducted by impartial interviewers, under the supervision of a qualified expert, that the study used a sample of a relevant portion of potential consumers, that the questions upon which the results relied did not appear to be misleading or biased, and that the *recording of responses and assembly of data was handled in a completely unbiased manner.*” 2005 WL 5887187, fn. 10 at *5 (C.D. Cal. Feb. 23, 2005) (emphasis added).

B. Plaintiff's Baseless “Product Life Cycle” Theory Has No Bearing on the Analysis of a Genericness Survey.

In its motion, Plaintiff reiterates its own expert's argument that Dr. Jay's analysis of the survey results is unreliable because she failed “take into account the Product Life Cycle” of Plaintiff's “Timelines” service. Relying solely on its expert's rebuttal report, Plaintiff contends that Plaintiff's “Timelines” service is “in the beginning stage of the Product Life Cycle” and that “once it grows enough, the relevant consumers may recognize Timelines as a brand name.” Not surprisingly, Plaintiff does not cite any case law or treatises in support of its argument that a generic term can function as a trademark with proper marketing.

Plaintiff's argument disregards the difference between a generic and a descriptive term. While a descriptive term may acquire distinctiveness over time in the marketplace, if “a given term is ‘generic,’ it can never function as a mark to identify and distinguish the products of only one seller.” McCarthy § 12:1. “Unlike a trademark, which identifies the source of a product, a generic term merely identifies the genus of which the particular product is a species.” *Liquid Controls Corp. v. Liquid Control Corp.*, 802 F.2d 934 (7th Cir. 1986). Thus, when testing whether a term is generic, the “life cycle” of a product has no bearing on the analysis of the

survey results. In no way did Dr. Jay’s purported “failure” to “take into account the Product Life Cycle” of Plaintiff’s “Timelines” service have any effect on the reliability of her survey or analysis of the same. The “life cycle” of a product is irrelevant in the context of a genericness survey because generic terms by definition can *never* function as trademarks regardless of the length of time in which they are used.

A significant majority of respondents to Dr. Jay’s survey expressed their belief that the term “timelines” (68% of respondents) is generic – not a brand name – when used in connection with a website or website feature. Based on the survey results, the term “timelines” will therefore never function as a trademark to distinguish the timeline-related services provided by Plaintiff from those offered by others in the marketplace. The reliable results of Dr. Jay’s survey will thus greatly assist the trier of fact in understanding that Plaintiff does not own valid rights in the term “timelines” and should not be able to claim a monopoly over its use.

IV. CONCLUSION

For the reasons stated above, Facebook respectfully requests that the Court deny Plaintiff’s Motion *in Limine* No. 1 to Exclude the Survey and Testimony of Dr. Deborah Jay at Trial.

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Dated: April 15, 2013

Respectfully submitted,

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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. 1 TO EXCLUDE THE SURVEY AND TESTIMONY OF DR. DEBORAH JAY AT TRIAL** 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

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