

**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. 5 TO BAR ARGUMENTS AND EVIDENCE IN SUPPORT OF
AN ADVICE OF COUNSEL DEFENSE**

Plaintiff’s Motion *in Limine* No. 5 (“Motion”) lacks any basis and is unnecessary. Plaintiff asks the Court to enter an order barring Facebook from “introducing evidence of, or otherwise asserting, either directly or indirectly, an advice of counsel defense” to Plaintiff’s claims that Facebook’s alleged trademark infringement was willful and intentional. (Pl.’s Br., Dkt. No. 134, at p.1.) Yet Facebook has *never* indicated at any point throughout the course of this litigation that it intends to assert an advice of counsel defense. Indeed, Facebook has steadfastly maintained that any legal advice Facebook may have obtained concerning its decision to adopt and use the common word “timeline” to describe or identify its timeline interface feature is protected by the attorney-client privilege, and Facebook has not produced documents or testimony containing any such advice.

There simply is no reasonable basis for Plaintiff’s claim that it “anticipates that Facebook will seek to introduce evidence or arguments that it acted on the advice of counsel in clearing, adopting, and using the ‘Timeline’ term.” (*Id.*) Not surprisingly, Plaintiff’s Motion fails to identify any basis for its belief in this regard. As has been conveyed to Plaintiff on numerous occasions, Facebook does not intend to assert an advice of counsel defense at trial. Facebook is

therefore negotiating with Plaintiff's counsel for an appropriate stipulation that should allay Plaintiff's unfounded concerns.

Nevertheless, Facebook opposes Plaintiff's Motion due to the overreaching and somewhat nebulous relief requested by Plaintiff. Plaintiff not only seeks an order barring Facebook from "asserting" an advice of counsel defense, but asks the Court to preclude Facebook from "introducing evidence of . . ., *either directly or indirectly*," an advice of counsel defense. The inclusion of "or indirectly" in Plaintiff's request for relief renders it impractically vague and overly broad.

For the sake of clarity, Facebook does not intend to introduce into evidence any legal advice Facebook may have obtained when it adopted the term "timeline"; nor will it introduce argument or evidence that Facebook relied upon any such advice. On the other hand, Facebook must be permitted to explain to the jury why it chose to go forward with its plans for "timeline" after learning of Plaintiff's trademark registrations – not by citing legal advice, but by explaining the company's business rationale.

Plaintiff in this action continues to press its trademark infringement claims under theories of both "forward confusion" and "reverse confusion." In cases involving a claim of "forward confusion," a defendant's intent in adopting a mark is one of the factors relied up by courts in this Circuit to assess whether the defendant's mark is likely to cause confusion. *See Packman v. Chicago Tribune Co.*, 267 F.3d 628, 643 (7th Cir. 2001). Plaintiff has made clear that it plans to make Facebook's intent in adopting the term "timeline" an issue in this case. (*See e.g.*, Timelines, Inc.'s Mem. of Law in Opp. to Facebook, Inc.'s Mot. for Sum. Judg., Dkt. No. 95, p. 6 (which contains the wholly unsupported claim that "Facebook knew that its announcement of "Timeline" would have a terrible impact on Timelines' trademarks, . . .").) Accordingly, Facebook must be allowed to offer testimony that, for example, it did not intend to trade on any

goodwill associated with Plaintiff or create confusion; did not view Plaintiff as a competitor; believed (correctly) that “timeline” is a commonly used and readily understood term; and its purpose in choosing “timeline” as the name of its user interface feature was because the term clearly identifies, or at most merely describes an aspect of, the feature.

CONCLUSION

For the reasons stated above, Facebook respectfully requests that the Court deny Plaintiff’s Motion *in Limine* No. 5 to Bar Arguments and Evidence in Support of an Advice of Counsel Defense.

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

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

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

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. 5 TO BAR ARGUMENTS AND EVIDENCE IN SUPPORT OF AN ADVICE OF COUNSEL DEFENSE** 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