

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

TIMELINES, INC.

Plaintiff,

v.

FACEBOOK, INC.

Defendant.

)
)
)
)
)
)
)
)
)
)

Civil Action No.: 11 CV 6867

HONORABLE JOHN W. DARRAH

**MEMORANDUM IN SUPPORT OF DEFENDANT FACEBOOK, INC.'S
MOTION FOR SUMMARY JUDGMENT**

TABLE OF CONTENTS

	PAGE
I. INTRODUCTION	1
II. ARGUMENT	2
A. Summary Judgment Standard.	2
B. Plaintiff Does Not Own Protectable Trademark Rights in “Timelines.”	3
1. “Timelines” Is Generic and Cannot Function as a Trademark.	4
a. Numerous Dictionaries Define the Term “Timeline(s).”	5
b. Plaintiff Uses “Timeline(s)” Generically.	6
c. Third Party Competitors Use “Timeline(s)” Generically.	7
d. The Media Regularly Uses “Timeline(s)” Generically.	9
e. Survey Evidence Demonstrates That the Significant Majority of Relevant Consumers Believe That “Timeline” and “Timelines” Are Generic Terms, Not Trademarks.	10
2. Alternatively, Plaintiff Does Not Own Rights in “Timelines” Because It Is Merely Descriptive and Has Not Acquired Secondary Meaning.	12
C. Facebook Makes Descriptive Fair Use of the Term “Timeline” and Thus Cannot Be Liable for Infringement as a Matter of Law.	13
1. Facebook Does Not Use “Timeline” As a Trademark; Instead, It Uses the Term Fairly to Describe the Feature of Facebook’s User Interface that Allows Users to Display Their Content in a Timeline.	14
2. Facebook Uses “Timeline” in Good Faith.	15
III. CONCLUSION.....	16

TABLE OF AUTHORITIES

	PAGE(S)
CASES	
<i>Anderson v. Liberty Lobby, Inc.</i> , 477 U.S. 242 (1986).....	3
<i>Best Vacuum, Inc. v. Ian Design, Inc.</i> , No. 04-C-2249, 2005 WL 1185817 (N.D. Ill. Jan. 18, 2005).....	12
<i>Blau Plumbing, Inc. v. S.O.S. Fix-It, Inc.</i> , 781 F.2d 604 (7th Cir. 1986)	4, 5
<i>Boston Duck Tours, LP v. Super Duck Tours, LLC</i> , 531 F.3d 1 (1st Cir. 2008).....	7
<i>Brown v. Advocate S. Suburban Hosp. & Advocate Health & Hosps. Corp.</i> , 700 F.3d 1101 (7th Cir. 2012)	3
<i>Celotex Corp. v. Catrett</i> , 477 U.S. 317 (1986).....	3
<i>Custom Vehicles, Inc. v. Forest River, Inc.</i> , 476 F.3d 481 (7th Cir. 2007)	14, 15
<i>Donchez v. Coors Brewing Co.</i> , 392 F.3d 1211 (10th Cir. 2004)	10
<i>Door Sys., Inc. v. Pro-Line Door Sys., Inc.</i> , 83 F.3d 169 (7th Cir. 1996)	3, 5
<i>E. Air Lines, Inc. v. N.Y. Air Lines, Inc.</i> , 559 F.Supp. 1270 (S.D.N.Y. 1983).....	4
<i>E. I. Du Pont de Nemours & Co. v. Yoshida International, Inc.</i> , 393 F. Supp. 502 (E.D.N.Y. 1975)	10
<i>Echo Travel, Inc. v. Travel Assoc., Inc.</i> , 870 F.2d 1264 (7th Cir. 1989)	11
<i>Gimix, Inc. v. JS & A Grp., Inc.</i> , 699 F.2d 901 (7th Cir. 1983)	4
<i>H-D Mich., Inc. v. Top Quality Serv., Inc.</i> , 496 F.3d 755 (7th Cir. 2007)	3, 4, 11, 12

TABLE OF AUTHORITIES
(CONTINUED)

	PAGE(S)
<i>Hickory Farms, Inc. v. Snackmasters, Inc.</i> , 500 F.Supp. 2d 789 (N.D. Ill. 2007)	5, 9
<i>Igloo Prods. Corp. v. Brantex, Inc.</i> , 202 F.3d 814 (5th Cir. 2000)	5
<i>Intel Corp. v. Advanced Micro Devices, Inc.</i> , 756 F. Supp. 1292 (N.D. Cal. 1991)	10
<i>Liquid Controls Corp. v. Liquid Control Corp.</i> , 802 F.2d 934 (7th Cir. 1986)	3, 5, 11
<i>M.B.H. Enters., Inc. v. WOKY, Inc.</i> , 633 F.2d 50, 54 (7th Cir.1980)	15
<i>Marvellous Day Elec. (S.Z.) Co., Ltd. v. Ace Hardware Corp.</i> , Case Nos. 11 C 8756, 11 C 8768, 2012 WL 4579511 (N.D. Ill. Oct. 12, 2012)	4
<i>Matsushita Elec. Indus. Co. v. Zenith Radio Corp.</i> , 475 U.S. 574 (1986).....	3
<i>Mil-Mar Shoe Co., Inc. v. Shonac Corp.</i> , 75 F.3d 1153 (7th Cir. 1996)	7
<i>Murphy Door Bed Co., Inc. v. Interior Sleep Sys., Inc.</i> , 874 F.2d 95 (2d Cir. 1989).....	9
<i>Packman v. Chicago Tribune Co.</i> , 267 F.3d 628 (7th Cir. 2001)	3, 4, 14
<i>Retail Serv., Inc. v. Freebies Pub.</i> , 364 F.3d 535 (4th Cir. 2004)	6
<i>Sunmark, Inc. v. Ocean Spray Cranberries, Inc.</i> , 64 F.3d 1055 (7th Cir. 1995)	14
<i>Ty, Inc. v. The Jones Grp., Inc.</i> , 98 F.Supp.2d 988 (N.D. Ill. 2000)	6
<i>Ty, Inc. v. Softbelly's Inc.</i> , 353 F.3d 528 (7th Cir. 2003)	10
<i>Windsurfing Int'l, Inc. v. Fred Ostermann GMBH</i> , 613 F. Supp. 933 (S.D.N.Y. 1985).....	10, 11

TABLE OF AUTHORITIES
(CONTINUED)

	PAGE(S)
STATUTES	
15 U.S.C. §1115(b)(4)	13
OTHER AUTHORITIES	
1 McCarthy, TRADEMARKS AND UNFAIR COMPETITION, § 15:1 at 657 (2d ed. 1984).....	11
2 Thomas J. McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION ("McCarthy") § 12:1 (4th ed. 2012)	passim
Fed.R.Civ.P. 56(c)	3
Oxford Dictionary, the American Heritage Dictionary, Merriam Webster's Collegiate Dictionary, and Wikipedia	5
Restatement (Third) of Unfair Competition §28 (1995).....	14

I. INTRODUCTION

Plaintiff Timelines, Inc. (“Plaintiff”) seeks to appropriate for its exclusive use the common English word “timeline(s)” under the guise of trademark protection. The noun “timeline” refers to an arrangement of events or other information in chronological order. As such, “timeline” readily conveys to consumers that a product or service associated with the term will be, or enable a consumer to create, a chronological listing of facts or other information.

Not surprisingly, Plaintiff and a host of other companies use the term “timeline(s)” to identify or describe aspects of products and services that consist of or relate to timelines. Plaintiff has admitted to using the term “timeline(s)” generically in connection with the services it provides to users of its website at lifesnapz.com and through its third party timeline creation service, “Timelines SE.” On its website at timelines.com, Plaintiff explains that the services it renders under the term “timelines” allow users to “record the details of events, connect them in space and through time to other related events, and contribute to a better collective understanding of what occurred at a particular place and time.” Plaintiff’s description of its services reflects the common understanding of the term “timeline” in the English language.

Facebook uses the term “timeline” to describe a feature of its current user interface that allows users to graphically display the events of their personal lives in chronological order. Below is a depiction of Facebook’s use of the term on its user interface.



Despite an abundance of senior users of the noun “timeline,” and Facebook’s limited and generic use of the term in its user interface, Plaintiff claims that Facebook’s use of “timeline” infringes Plaintiff’s alleged trademark rights in “timelines.” Plaintiff’s claims are fatally flawed as a matter of law, however, for the following reasons: (1) Plaintiff does not actually own any trademark rights in “timelines” because of the inherently generic or, at most, merely descriptive nature of the term; and (2) even if “timelines” were protectable as a trademark, Facebook makes non-infringing use of “timeline” to fairly and accurately describe a feature of its user interface.

While Facebook can demonstrate at trial that there is no likelihood of confusion between the parties’ respective uses of “timelines” and “timeline,” it would be a waste of judicial and party resources to conduct a full trial on the issue of likelihood of confusion when the Court can and should rule as a matter of law that Plaintiff has no basis to assert its claims.

II. ARGUMENT

A. Summary Judgment Standard.

Summary judgment is appropriate when the “pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, demonstrate that there

is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law.” Fed.R.Civ.P. 56(c); *Celotex Corp. v. Catrett*, 477 U.S. 317, 322–23 (1986). The moving party bears the initial burden of demonstrating that there is no genuine issue of material fact, and that judgment as a matter of law should be granted in its favor. Fed.R.Civ.P. 56(c). Once the moving party has met its initial burden, the nonmoving party must then “go beyond the pleadings” and “designate specific facts showing that there is a genuine [material] issue for trial.” *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986).

Although evidence is viewed in a light most favorable to the nonmoving party, a court’s “favor toward the nonmoving party does not extend to drawing inferences that are supported by only speculation or conjecture.” *Brown v. Advocate S. Suburban Hosp. & Advocate Health & Hosps. Corp.*, 700 F.3d 1101, 1104 (7th Cir. 2012) (citation omitted). Neither metaphysical doubt nor evidence that is not significantly probative will suffice. *Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 586 (1986); *Anderson*, 477 U.S. 242, 249-50. “Rather, a genuine issue of material fact exists only if there is enough evidence that a reasonable jury could return a verdict in favor of the nonmoving party.” *Brown*, 700 F.3d at 1104.

B. Plaintiff Does Not Own Protectable Trademark Rights in “Timelines.”

Summary judgment on the issue of whether a term is generic or merely descriptive should be granted where the evidence is so one-sided that there is no doubt as to how the question should be answered. *Door Sys., Inc. v. Pro-Line Door Sys., Inc.*, 83 F.3d 169, 171 (7th Cir. 1996); *Packman v. Chicago Tribune Co.*, 267 F.3d 628, 635 (7th Cir. 2001). The evidence in this case demonstrates that Plaintiff’s alleged mark “timelines” does not merit protection because it is either generic or merely descriptive without any secondary meaning. *Liquid Controls Corp. v. Liquid Control Corp.*, 802 F.2d 934, 935 (7th Cir. 1986) (generic terms “designate the products themselves rather than any particular maker” and can never function as trademarks); *H-*

D Mich., Inc. v. Top Quality Serv., Inc., 496 F.3d 755, 759 (7th Cir. 2007) (descriptive terms may not receive trademark protection unless they acquire secondary meaning). Without a protectable trademark, each of Plaintiff's claims fail.¹

1. "Timelines" Is Generic and Cannot Function as a Trademark.

A generic term is one that is commonly used as the name of a kind of good or service. *H-D Mich., Inc.*, 496 F.3d at 759-760 (7th Cir. 2007); *E. Air Lines, Inc. v. N.Y. Air Lines, Inc.*, 559 F.Supp. 1270 (S.D.N.Y. 1983) (holding that "shuttle" is a generic term for air service between certain cities); *see also* 2 Thomas J. McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION ("McCarthy") § 12:1 (4th ed. 2012) ("The name of a product or service itself – what it is – is the very antithesis of a mark" (citations omitted)). If the user of a generic term were able to secure a monopoly over the use of that word, the owner could prevent competitors from informing consumers about the most basic nature of the competitors' goods or services. *Blau Plumbing, Inc. v. S.O.S. Fix-It, Inc.*, 781 F.2d 604, 610 (7th Cir. 1986).

Although Plaintiff owns three contestable U.S. registrations for variations of "timelines" with application service provider and web site hosting services, the registrations merely create a rebuttable presumption of the validity of "timelines" as a trademark in connection with those particular services. In the Seventh Circuit, "the presumption of validity that accompanies a contestable registered trademark merely serves to shift to the defendant the burden of producing evidence of invalidity; the presumption evaporates once the defendant presents evidence sufficient to put validity at issue, a decision to be made by the court." Federal Jury Instructions

¹ *See Packman*, 267 F.3d at 638 (proof of a protectable mark is required for claims of federal trademark infringement and unfair competition); *see also Gimix, Inc. v. JS & A Grp., Inc.*, 699 F.2d 901, 908 (7th Cir. 1983) (proof of a protectable mark is required for the federal claim of false designation of origin); *Marvellous Day Elec. (S.Z.) Co., Ltd. v. Ace Hardware Corp.*, Case Nos. 11 C 8756, 11 C 8768, 2012 WL 4579511, *5 (N.D. Ill. Oct. 12, 2012) (if the Lanham Act claims fail, so do state claims under the UDTPA and Consumer Fraud Act).

of the Seventh Circuit § 13.1.2, Comment 5 (citing *Liquid Controls Corp.*, 802 F.2d at 937 n.2, 938; *Door Sys., Inc.*, 83 F.3d at 172; *Igloo Prods. Corp. v. Brantex, Inc.*, 202 F.3d 814, 819 (5th Cir. 2000)). The presumption also “evaporates when the opposing party introduces evidence of genericness, leaving the trademark holder with the ultimate burden of persuasion on the issue of validity.” *Id.* at § 13.1.2.2.5, Comment 2 (citing *Liquid Controls Corp.*, 802 F.2d at 936-937).

Courts routinely accept the following types of evidence in support of a finding that a term is generic: (1) dictionary definitions; (2) the plaintiff’s own generic use of the term; (3) competitors’ generic uses of the term; (4) media usage of the term; (5) testimony of persons in the trade; and (6) survey evidence. *See e.g.*, *Liquid Controls*, 802 F.2d at 936 (court relied on dictionary definitions and absence of alternative generic names in affirming a finding that “liquid controls” was generic); *Hickory Farms, Inc. v. Snackmasters, Inc.*, 500 F.Supp. 2d 789 (N.D. Ill. 2007) (court found that the term “beef stick” was generic after reviewing competitors’ use of the term and several newspaper articles); *see also* McCarthy at § 12:13.

a. Numerous Dictionaries Define the Term “Timeline(s).”

If a term is defined in a dictionary, it is “powerful evidence that the term [is] generic, because nouns and other nominatives listed in dictionaries, save for the occasional proper name, denote kinds rather than specific entities (‘dog,’ not ‘Fido’).” *Door Sys., Inc.*, 83 F.3d at 171. Numerous dictionaries define the term “timeline,” including the Oxford Dictionary, the American Heritage Dictionary, Merriam Webster’s Collegiate Dictionary, and Wikipedia. (Statement of Undisputed Materials Facts (“SUMF”) ¶ 12.) Consistently in each, “timeline” is defined as an arrangement of events or other information in chronological order. Given that Plaintiff uses the term “timelines” to refer to services that allow users to “record the details of events, [and] connect them in space and through time to other related events,” Plaintiff’s alleged mark is nothing more than the generic name for its services. (*Id.* ¶ 5.)

b. Plaintiff Uses “Timeline(s)” Generically.

“Evidence of the owner’s generic use, in particular, ‘is strong evidence of genericness.’” *Retail Serv., Inc. v. Freebies Pub.*, 364 F.3d 535, 545 (4th Cir. 2004) (quoting McCarthy at § 12:13); *see also Ty, Inc. v. The Jones Grp., Inc.*, 98 F.Supp.2d 988, 994 (N.D. Ill. 2000). Plaintiff has repeatedly used “timelines” in a generic manner to describe its services offered on its timelines.com and lifesnapz.com websites, and for its Timelines SE service. (SUMF ¶¶ 8-10, 16, 18.) For example, until shortly after Plaintiff initiated this lawsuit, timelines.com featured a link entitled “Popular Timelines,” which not surprisingly took users to Plaintiff’s most popular chronologies. (*Id.* ¶ 16.) Plaintiff also offered over 13 different categories of “timelines,” such as “Timelines of War and Conflicts” and “Religious Timelines.” The names of Plaintiff’s individual timelines often included the term “timeline,” such as “Battle of Bull Run Timeline,” “Amelia Earhart Timeline,” and “Al Capone Timeline.” (*Id.*) Further, Plaintiff’s timelines.com blog was replete with entries that used the term “timeline(s)” in a generic manner. (*Id.* ¶ 19.)

Plaintiff also uses the term generically to refer to services offered on Plaintiff’s lifesnapz.com website. (*Id.* ¶¶ 8-9.) Specifically, Plaintiff explains that its LifeSnapz website allows users to “contribute text, photos, and video to describe these events, share them with self-designated groups (like family members, colleagues, schoolmates or youth sports teams) and explore these events using dynamic *timelines*, maps, and lists.” (*Id.* ¶¶ 8 (emphasis added).) If a user clicks the tab at the top of the LifeSnapz webpage entitled “Timeline,” Plaintiff displays the user’s content in a chronological sequence similar to Facebook’s timeline feature. (*Id.* ¶ 9.)

Plaintiff’s Timelines SE service is “a 100% outsourced, custom branded service, [that] helps news websites organize, present and monetize past content.” (*Id.* ¶ 10.) Plaintiff touts that a key benefit of Timelines SE is that “[f]or readers, the service makes past content more readily available and presents it in an intuitive, easy-to-navigate manner using *timelines*, maps and lists.”

(*Id.* (emphasis added).) Naturally, customers of Plaintiff’s Timelines SE service use the term “timeline” to identify the service, such as Boston.com’s “2010 Massachusetts Gubernatorial Election Timeline” and the “Celtics Timeline.” (*Id.* ¶ 21.)

Shortly after this lawsuit was filed, Plaintiff revised its site at timelines.com to remove clearly generic references to “timelines,” replacing the term with words such as “topics” and “events.” (*Id.* ¶ 17.) Plaintiff, however, cannot unring the bell that it and many others have rung for years, clearly signaling that the term “timeline” generically identifies the timeline products and services offered in connection with the word. Indeed, Plaintiff’s changes to its website are essentially a concession that for years it has used “timelines” in a purely generic manner.

c. Third Party Competitors Use “Timeline(s)” Generically.

Widespread generic use of the term “timeline(s)” by Plaintiff’s competitors further demonstrates the genericness of the term. “The more members of the public see a term used by competitors in the field, the less likely they will be to identify the term with one particular producer.” *Boston Duck Tours, LP v. Super Duck Tours, LLC*, 531 F.3d 1, 19 (1st Cir. 2008) (citations omitted) (relying on widespread generic use of “duck” and “duck tours” by other companies that provide amphibious sight-seeing services to find “duck tours” generic for such services); *see also Mil-Mar Shoe Co., Inc. v. Shonac Corp.*, 75 F.3d 1153, 1159 (7th Cir. 1996).

Since well before Plaintiff’s existence, third parties have used “timeline(s)” to name and describe products and services that enable users to create and share chronologies of events in history and their personal lives, or any other subject matters of their choosing. For example:

- **TimelineIndex.com** – Since 2003, TimelineIndex.com has “offer[ed] historical information and other content in the form of various timelines, as well as timeline creation services.” (SUMF ¶ 24.) The banner at the top of the home page states prominently: “Timelines, Who, What, Where, When ...” (*Id.*)

- **XTimeline** – Famento, Inc. launched its XTimeline website in 2007, described as “a place for you to create, share and discuss interesting timelines.” (*Id.* ¶ 25.) On its website, Famento repeatedly describes its products as “timelines.” (*Id.*) For example, it includes a prominent graphic at the top of its home page that states: “Create a timeline!” (*Id.*)
- **Dipity** – Underlying, Inc. launched a “free digital timeline website” under the DIPITY mark in 2008. (*Id.* ¶ 26.) Users can select the “Create a Timeline” tab to “create, share, embed and collaborate on interactive, visually engaging timelines.” (*Id.*) Underlying owns a U.S. registration for the DIPITY mark covering services including “providing on-line . . . software for the creation of *timelines* . . . “. (*Id.*) (emphasis added.)
- **TimelineSoftware.com** – Since 2002, Kidasa Software has operated the website at timelinesoftware.com, which provides information about timelines, promotes timeline-creation software, and features “timelines” prominently at the top of the site. (*Id.* ¶ 29.)
- **Twitter** – Users of the popular Twitter social network are also undoubtedly familiar with the term “timeline,” which Twitter has been using since 2006. (*Id.* ¶ 27.) Twitter’s “Timeline” feature enables users to review “a collected stream of [posts] listed in real-time chronological order.” (*Id.*)

In addition, websites such as Ztimeline, Ourtimelines.com, HistoricalTimeline.com, and Timeline Maker, among others, offer timelines and/or timeline-creation goods and services. (*Id.* ¶ 23.) Millions of U.S. consumers have encountered these generic uses of the term “timeline(s).” Twitter alone claims over 200 million registered users. (*Id.* ¶ 27, Hughes Decl. ¶ 44, Ex. 43.) The vast majority of these third party uses of “timeline(s)” predate Plaintiff’s first use of “timelines” in 2009. (*Id.* ¶ 23.)

Many third parties have provided testimony that (1) the term “timeline” is the generic or descriptive term for their products and services; (2) they are not aware of any instances of confusion arising from their use of the term “timeline(s)” in connection with their timeline services; (3) neither Plaintiff nor any other third party has challenged their use of the term “timeline(s)”; and (4) they would be placed at a competitive disadvantage in the marketplace if they were not allowed to use “timeline” to accurately identify or describe their services. (*Id.* ¶¶ 35-37.) Cursory Internet searches reveal numerous other entities making generic uses of the term “timeline(s)” including, notably, the U.S. Patent and Trademark Office (to identify “timelines” that “provide an overview of the process steps and time frames for filing a trademark application . . . and for maintaining a trademark registration.”) (*Id.* ¶¶ 13, 15.)

d. The Media Regularly Uses “Timeline(s)” Generically.

Media use of an alleged mark “in a generic sense is a ‘strong indicator of the general public’s perception’ that the term is a generic name.” McCarthy at § 12:13 (quoting *Murphy Door Bed Co., Inc. v. Interior Sleep Sys., Inc.*, 874 F.2d 95, 101 (2d Cir. 1989)); *see also Hickory Farms, Inc. v. Snackmasters, Inc.*, 500 F.Supp.2d 789, 800-801 (N.D. Ill 2007) (finding “beef stick” and “turkey stick” generic based, in part, on evidence of media use of the terms).

The media and the public frequently use “timeline” in its generic sense – as the name for a listing of events in a chronological manner. (SUMF ¶¶ 13-14.) A Google search of the term “timeline” returns over 485 million hits, including thousands of image results depicting a variety of timelines. (*Id.* ¶ 13.) News media regularly use the term “timeline” in the title for articles that list events in chronological order. (*Id.* ¶ 14.) For example, the Chicago Tribune has articles entitled “TIMELINE-U.S. policy shifts on Syria in Obama administration” and “Timeline of the Blagojevich investigation”; and CNNMoney has articles entitled “TIMELINE-Gulf of Mexico oil spill” and “Firestone recall timeline.” (*Id.*, Hughes Decl. ¶¶ 19-20, Exs. 18-19.)

e. Survey Evidence Demonstrates That the Significant Majority of Relevant Consumers Believe That “Timeline” and “Timelines” Are Generic Terms, Not Trademarks.

Because a term is generic if it is commonly understood by the relevant public to be a product or service, consumer surveys are given significant weight in cases involving the issue of genericness. McCarthy § 12:14. The “*Teflon*” survey model, named for the genericness survey endorsed in the seminal *Teflon* 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. McCarthy § 12:14. A *Teflon* survey 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. *Id.* at § 12:14.

The standard in determining whether a term is a generic name or is a brand “is not whether the term has some significance to the public as the generic name of an article, but whether its generic meaning is its primary significance.” *Id.* at §12:6. “The result of the primary significance rule [is] that majority usage controls.” *Id.* Accordingly, a survey showing that 60% or more of survey respondents believed a term to be common or a brand name serves as proof of the term’s primary significance. *See Ty Inc. v. Softbelly’s Inc.*, 353 F.3d 528, 530 (7th Cir. 2003); *Windsurfing Int’l, Inc. v. Fred Ostermann GMBH*, 613 F. Supp. 933, 959 (S.D.N.Y. 1985) (aff’d in part, rev’d in part, 782 F.2d 995 (Fed. Cir. 1986) (finding “windsurfer” generic after 61.4% of survey respondents recognized the term as the name of a type of product rather than a brand); *Intel Corp. v. Advanced Micro Devices, Inc.*, 756 F. Supp. 1292, 1297 (N.D. Cal. 1991) (finding “386” generic for microprocessors after 72% of survey respondents expressed belief that it was generic); *Donchez v. Coors Brewing Co.*, 392 F.3d 1211, 1218 (10th Cir. 2004) (“beerman” generic after recognized as a common name by 75.9% of survey respondents).

Facebook’s expert witness, Dr. Deborah Jay, conducted a *Teflon* model survey to determine the primary significance of the terms “timeline” and “timelines” to relevant consumers. (SUMF ¶¶ 38-39.) Survey respondents consisted of individuals who had accessed or were likely to access a social networking website or a website where a user could record events and contribute descriptions, photos, videos and links to related events. Only respondents who demonstrated an understanding of the difference between a brand name and a common name were then administered the substantive portion of the survey questionnaire. (*Id.* ¶ 38.)

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.* ¶ 39). Only 24% of the respondents believed the terms “timeline” and “timelines” were brand names. (*Id.*) Dr. Jay’s survey therefore provides ample support for a finding that Plaintiff’s alleged mark is generic and does not have trademark significance. *See Windsurfing Int’l, Inc.*, 613 F. Supp. at 959 (S.D.N.Y. 1985).

2. Alternatively, Plaintiff Does Not Own Rights in “Timelines” Because It Is Merely Descriptive and Has Not Acquired Secondary Meaning.

A term is merely descriptive if it specifically describes a characteristic or an ingredient of a product. *Liquid Controls*, 802 F.2d at 936. A merely descriptive mark is not protectable as a trademark if it has not acquired secondary meaning. *See Echo Travel, Inc. v. Travel Assoc., Inc.*, 870 F.2d 1264, 1266 (7th Cir. 1989) (quoting 1 McCarthy, *Trademarks and Unfair Competition*, § 15:1 at 657 (2d ed. 1984)). If not generic, the term “timeline(s)” is merely descriptive of Plaintiff’s services, which allow users to create chronologies of events and facts, and therefore cannot function as a trademark unless it has acquired secondary meaning. *H-D Mich.*, 496 F.3d at 759; *see also Echo Travel, Inc.*, 870 F.2d at 1266 (quoting McCarthy at § 15:1). That is,

Plaintiff bears the burden of showing that it has made long-term, exclusive use of “timelines” such that most consumers, when confronted with the term “timelines,” uniquely associate it with Plaintiff or its services. *H-D Mich.*, 496 F.3d at 760 (“A descriptive mark acquires secondary meaning if the product name comes ‘to be uniquely associated with the original seller’”) (citation omitted); *Best Vacuum, Inc. v. Ian Design, Inc.*, No. 04-C-2249, 2005 WL 1185817, at *3 (N.D. Ill. Jan. 18, 2005) (“A mark acquires secondary meaning when *most consumers* associate it with the producer rather than the product.”) (emphasis added).

Courts consider several types of evidence in determining whether a mark has acquired secondary meaning: (1) consumer surveys; (2) direct consumer testimony; (3) exclusivity, length, and manner of use of the alleged mark; (4) amount and manner of advertising; (5) amount of sales and number of customers; (6) recognition in the marketplace; and (7) proof of intentional copying. *Echo Travel, Inc.*, 870 F.2d at 1267. Plaintiff has failed to proffer *any* evidence demonstrating that its alleged mark has acquired secondary meaning. Plaintiff has not conducted a consumer survey or obtained direct consumer testimony relevant to establishing secondary meaning of the term “timelines” (SUMF ¶ 44.); nor has Plaintiff produced any evidence showing that it spent more than a *de minimus* amount of money on advertising or promoting its services offered at timelines.com (*i.e.*, the one venture for which Plaintiff’s CEO alleged that it did not use the term “timelines” generically). (*Id.* ¶ 45.) Instead, the facts show that (1) Plaintiff began using its alleged mark relatively recently in April 2009 (*Id.* ¶ 7); (2) its total sales during the past three years are only approximately \$ [REDACTED] (*Id.* ¶ 46); and (3) there are only 1,209 active users of the website at timelines.com. (*Id.* ¶ 47.) No reasonable trier of fact could find that Plaintiff’s alleged mark “timelines” has acquired secondary meaning.

Not surprisingly, the U.S. Patent & Trademark Office (“PTO”) rejected the trademark

application Plaintiff recently filed for “timelines” in connection with services related to Facebook’s, finding that “timelines” is merely descriptive of those services. (*Id.* ¶¶ 40-42.) The PTO noted the existence of numerous third party descriptive uses of “timeline(s).” (*Id.*) As the PTO indicated, “in this case, the wording ‘timelines’ as applied to the applicant’s web-based software services describes a feature, characteristic and function of those services.” (*Id.* ¶ 42.)

Plaintiff could have attempted to overcome the PTO’s refusal by arguing that “timelines” had acquired distinctiveness in the marketplace. Plaintiff instead chose not to respond to the PTO’s refusal, presumably recognizing that it could not demonstrate that “timelines” had acquired distinctiveness, and the PTO therefore deemed the application abandoned. (*Id.* ¶ 43.)

Plaintiff may attempt to compensate for its lack of evidence of secondary meaning by pointing to instances of purported “actual” confusion. However, evidence of misdirected communications around the time of Facebook’s launch of its “timeline” feature and a handful of communications from acquaintances of employees of Plaintiff falls far short of demonstrating secondary meaning. Such instances reflect nothing more than the logistical mishaps and questions that can arise when multiple parties use a common generic term like “timelines” to name or describe website features that allow users to arrange information in chronological order.

C. Facebook Makes Descriptive Fair Use of the Term “Timeline” and Thus Cannot Be Liable for Infringement as a Matter of Law.

Even if “timeline(s)” were a protectable mark, Facebook’s fair use of the term “timeline” to accurately describe a feature of its user interface serves as a complete defense to Plaintiff’s infringement claims. 15 U.S.C. §1115(b)(4). The “original, descriptive primary meaning [of a term] is always available for use by others to describe their goods, in the interest of free competition.” McCarthy §11.45. If a defendant does not use a term as an indication of source, but instead uses the term fairly and in good faith to describe the defendant’s goods or services,

the owner of even a *registered* mark cannot prevail on any infringement or unfair competition claims. *Id.*; Seventh Circuit Model Jury Instructions 13.5.2 (Trademark, Classic Fair Use); *Packman*, 267 F.3d at 639; Restatement (Third) of Unfair Competition §28 (1995).

1. Facebook Does Not Use “Timeline” As a Trademark; Instead, It Uses the Term Fairly to Describe the Feature of Facebook’s User Interface that Allows Users to Display Their Content in a Timeline.

Facebook’s use of the word “timeline” does not constitute trademark use because the term does not identify the origin or source of Facebook’s services. *Packman*, 267 F.3d at 639-40. Rather, the distinctive FACEBOOK mark and associated trade dress, used consistently and prominently with Facebook’s services, identify the source of those services. (SUMF ¶ 48.)

Facebook does not employ any trademark symbols or other indicia that might create the impression that the term “timeline” is meant to identify Facebook as the source of its user interface. (*Id.* ¶ 52.) Indeed, Facebook uses the word “timeline” in textual sentences in lower-case letters as a generic *noun* to refer to a feature of a user’s profile. (*Id.* ¶ 53.). Facebook’s use of the term is, in fact, often virtually inconspicuous to users of Facebook’s services. For example, the word “timeline” appears on a user’s profile page within various menus relating to display options (such as photos, events, friends, map) and privacy or preferences settings (such as “Hide from Timeline”). (*Id.* ¶¶ 49-50.) Notably, Facebook has never made any claim to exclusive rights in the word “timeline.” *See Sunmark, Inc. v. Ocean Spray Cranberries, Inc.*, 64 F.3d 1055 (7th Cir. 1995) (concluding that defendant had not used the phrase “sweet-tart” in a trademark sense in part because it had not asserted any exclusive rights to the phrase).

Facebook instead uses the term “timeline” in its commonly accepted meaning to describe the feature of its user interface that allows users to display their content (i.e., their photos, status updates, and other activities) in a timeline. A descriptive use serves to “impart information directly” or is “necessary to the description of the goods and services in question.” *Custom*

Vehicles, Inc. v. Forest River, Inc., 476 F.3d 481, 483 (7th Cir. 2007); *M.B.H. Enters., Inc. v. WOKY, Inc.*, 633 F.2d 50, 54 (7th Cir.1980).

The “timeline” on a user’s Facebook page is but one feature of Facebook’s services, which include other features descriptively referred to with terms such as “Map”, “Friends”, “Photos” and “Events.” (SUMF ¶¶ 49-50.) As one would assume, the term “Map” describes a feature that displays the geographic location of events and experiences; the term “Friends” describes a feature that lists a user’s friends on Facebook; the term “Photos” describes a feature that displays photographs; and the term “Events” describes a feature that identifies and provides information regarding specific events. (*Id.* ¶ 50.) Similarly, consistent with this highly logical and descriptive approach to its feature nomenclature, Facebook uses the term “Timeline” to describe the feature that allows users to arrange information in a chronological manner.

2. Facebook Uses “Timeline” in Good Faith.

Good faith can only be judged by evaluating one’s subjective purpose in using the protected mark. *M.B.H. Enters.*, 633 F.2d at 54. Plaintiff has proffered no evidence, nor could it, that Facebook intended to trade on Plaintiff’s goodwill or create confusion. In contrast, Mr. Lessin made clear in his deposition that Facebook “name[s] things what they are. The impact component of this was simply that we were introducing a new product, and the more clearly we named it as the new product, we believed that users would better understand how to use it and what it was.” (SUMF ¶ 51, Hughes Decl. 71, Ex. 69, Lessin Depo. Tr. 312:24-313:3.) Mr. Lessin added, “the point of our names is to make it easy for almost a billion humans to use our service.” (*Id.*, Lessin Depo. Tr. 101:11-12.)

III. CONCLUSION

For the foregoing reasons, Facebook respectfully requests that this Court grant its motion for summary judgment.

In the context of this motion, Facebook has not reasserted its motion to exclude the “likelihood of confusion” survey conducted by Plaintiff’s expert Dr. Eli Seggev and his related testimony. Plaintiff’s claims fail as a matter of law before considering the issue of likelihood of confusion; therefore, there is no need to address Dr. Seggev’s survey in this motion. If Plaintiff seeks summary judgment or otherwise raises the results of Dr. Seggev’s surveys in opposition to this motion, Facebook will seek to exclude any consideration of Dr. Seggev’s flawed survey. Likewise, if the Court denies Facebook’s motion for summary judgment, Facebook respectfully requests the ability to refile its motion to exclude Dr. Seggev’s survey and related testimony.

Dated: January 31, 2013

Respectfully submitted,

COOLEY LLP

By: /s/ Peter J. Willsey

Peter J. Willsey (*pro hac vice*)
Brendan Hughes (*pro hac vice*)
COOLEY LLP
1299 Pennsylvania Ave., NW, Suite 700
Washington, DC 20004
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

Counsel for Facebook, Inc.

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 **MEMORANDUM IN SUPPORT OF DEFENDANT FACEBOOK, INC.'S MOTION FOR SUMMARY JUDGMENT** 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 January 31, 2013.

Dated: January 31, 2013

/s/ Brendan J. Hughes
Brendan J. Hughes (*pro hac vice*)
COOLEY LLP
1299 Pennsylvania Ave., NW
Suite 700
Washington, DC 20001
Tel: (202) 842-7800
Fax: (202) 842-7899
Email: bhughes@cooley.com