

Nerds On Call, Inc. (Indiana) v. Nerds On Call, Inc. (California), Case No.: 1:07-cv-0535-DFH-TAB

# **EXHIBIT**

# **A**

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF INDIANA  
INDIANAPOLIS DIVISION

NERDS ON CALL, INC. (INDIANA),

Plaintiff,

vs.

NERDS ON CALL, INC. (CALIFORNIA)  
and RYAN ELDRIDGE,

Defendants.

Case No.: 1:07-cv-0535-DFH-TAB

**STIPULATED UNDISPUTED FACTS**

All the Parties in this action have conferred and have agreed that the following facts are true and accurate for the sole purpose of the Court resolving any and all dispositive motions that may be timely filed by any Party. All facts relied upon by the Court in any such motion to finally resolve any claim or defense in this action will be deemed admitted for all purposes. All other facts will be deemed disputed and reserved for adjudication at trial.

Nerds/Indiana

1. Nerds/Indiana is an Indiana corporation that maintains its principal office in Fishers, Indiana. Nerds/Indiana maintains no other offices.

2. Since January 1995 Nerds/Indiana has continuously used, and attempted to protect from misuse, the trademark NERDS ON CALL to promote and offer its computer-related services to consumers and to provide those services within the homes and businesses of its customers.

3. Nerds/Indiana promotes its computer-related services on a website it publishes at nerdsoncall.com, which is accessible to consumers and/or potential consumers of Nerds/Indiana's computer related services throughout the United States, and through other

advertising means, including but not limited to Internet advertising, has advertised in the State of Indiana via print advertisements and advertisements in the Yellow Pages.

4. Nerds/Indiana has attempted to protect NERDS ON CALL from the unauthorized commercial misuses of NERDS ON CALL, to which Nerds/Indiana claims ownership. Nerds/Indiana's enforcement of its claimed rights to NERDS ON CALL led to the express abandonment on October 26, 2004 of a trademark application for NERDS ON CALL by Griehban Industries, Inc., an Iowa based company. Griebahn Industries was the first to actually file a federal trademark application to register NERDS ON CALL. Nerds/Indiana has likewise claimed that Premier Consulting in Peoria, Illinois has unlawfully used NERDS ON CALL.

5. Nerds/Indiana owns the exclusive right to use NERDS ON CALL to promote, offer, and provide its computer-related services within the geographic region(s) of the United States where it has developed trademark rights in the mark. The parties dispute whether those region(s) include an area greater than Indianapolis, Indiana (specifically the 50 mile area surrounding Indianapolis).

6. Nerds/Indiana does not own a federal trademark registration for its NERDS ON CALL mark but does own a State of Indiana trademark registration for NERDS ON CALL. Nerds/Indiana has two currently pending federal trademark applications to register NERDS ON CALL in International Classes 037 and 042.

#### Nerds/California

7. Nerds/California is a California corporation that maintains its principal office in Redding, California. Nerds/California also maintains Northern California offices in Chico, Vacaville, Sacramento, Yuba City, and Stockton, maintains Central California offices in Fresno and Bakersfield, and maintains an office in Medford, Oregon.

8. Since March 2004 Nerds/California has used the trademark NERDS ON CALL to promote and offer its computer-related services to consumers and to provide those services within the homes and businesses of its customers.

9. Nerds/California promotes its computer-related services on a website that it publishes at callnerds.com, which is accessible to consumers and/or potential consumers of Nerds/California's computer related services throughout the United States, and through newspaper, radio and television, and yellow pages advertising within Northern California (since March 2004), Central California (since March 2006), and Southern Oregon (since August 2008).

10. Nerds/California does not own a federal trademark registration for its NERDS ON CALL mark but does own a State of California trademark registration for NERDS ON CALL. Nerds/California has filed a currently pending concurrent use application to federally register NERDS ON CALL in International Class 041 and Nerds/Indiana is a party in that proceeding.

11. Other than with regard to Nerds/California's contact with Brock Peterson, as described herein below, Nerds/California has not had the occasion to engage in any active enforcement and/or protection of its claimed rights to NERDS ON CALL.

#### Summary of the Dispute

12. The only intellectual property in dispute in this action is related to the NERDS ON CALL trademark.

13. Nerds/Indiana contends that Nerds/California's use of NERDS ON CALL and its attempted registration of NERDS ON CALL is unlawful and that Nerds/Indiana is the rightful owner to the trademark rights in and to the mark NERDS ON CALL.

14. Nerds/California contends that its current use of NERDS ON CALL is lawful and that, moreover, it has the right to use NERDS ON CALL in every part of the United States where

Nerds/Indiana has not developed trademark rights in the mark

Chronology of the Dispute

15. On November 15, 2004, through its counsel, Nerds/Indiana informed Nerds/California that its use of NERDS ON CALL was not authorized and that such use was unlawful when used to promote, offer, and provide computer-related services.

16. On November 22, 2004 Nerds/California, after having received the November 15, 2004 correspondence from counsel for Nerds/Indiana and with knowledge of Nerds Indiana's prior claimed rights to use the mark NERDS ON CALL, filed an application to federally register NERDS ON CALL as a trademark as used on the "installation, maintenance, and repair of computers for homes and businesses." Nerds/California was likewise aware that Griehban Industries, Inc. had expressly abandoned its prior filed trademark application for NERDS ON CALL in the same class and for the same services for which Nerds/California sought registration of NERDS ON CALL.

17. On January 15, 2005, through its counsel, Nerds/Indiana once again informed Nerds/California that its use of NERDS ON CALL was not authorized and that such use was unlawful when used to promote, offer, and provide computer-related services and that its attempt to federally register NERDS ON CALL was fraudulent and otherwise improper.

18. On January 31, 2005 counsel for Nerds/California sent a letter to Nerds/Indiana's counsel in response to his preceding two letters. In that response, Nerds/California's counsel rejected the contention that Nerds/California's use of NERDS ON CALL was unlawful, asserted that Nerds/Indiana trademark rights were geographically limited to Indianapolis, Indiana, and suggested that the parties agree to peacefully coexist in their respective geographic regions of the country through a concurrent use agreement. Nerds/Indiana was unwilling to consider Nerds

California's offer and, accordingly, no negotiation for any such agreement took place.

19. On December 28, 2006 Nerds/Indiana initiated an opposition proceeding in the Trademark Office to challenge Nerds/California's registration of NERDS ON CALL. Nerds/California chose not to appear in that proceeding and a default was entered by the Trademark Trial and Appeal Board resulting in an abandonment of Nerds/California's application to federally register NERDS ON CALL.

20. Since March 2004 Nerds/California has continuously used NERDS ON CALL to promote, offer, and provide computer-related services.

21. On July 17, 2007 Nerds/California filed a "concurrent use application" to federally register NERDS ON CALL as a trademark as used on the installation, maintenance, and repair of computers for homes and businesses. In that application, Nerds/California admitted that Nerds/Indiana was the senior user of the mark and that Nerds/Indiana owned the exclusive right to use the mark in Indianapolis, Indiana and a fifty mile area around that city. Nerds/California sought registration, therefore, in all parts of the country except Indianapolis, Indiana and a fifty mile area around the city (and except Washington D.C. and Maryland where another user of NERDS ON CALL developed senior rights in the mark.) Nerds/Indiana contends that Nerds/California is not entitled to a concurrent use registration for NERDS ON CALL.

22. On April 27, 2007 Nerds/Indiana filed the instant lawsuit in the Southern District of Indiana alleging trademark infringement and various other business torts. Nerds/Indiana served the complaint on or about August 16, 2007.

23. On October 15, 2007 Nerds/California moved to dismiss the complaint for lack of personal jurisdiction. On May 27, 2008 this Court denied the motion. On June 24, 2008

Nerds/California moved for reconsideration of its motion to dismiss or, alternatively, to certify the decision for interlocutory appeal. All briefing has been completed and the Court's decision is pending.

24. The parties have agreed that these Undisputed Facts are true and accurate solely for the purpose of evaluating and resolving any and all dispositive motions.

Nerds/California's Relationship with Indiana

25. While Nerds/California's website at callnerds.com may be accessed by Indiana residents it does not particularly offer services to, nor solicits business from, Indiana residents. Indiana residents may, without contacting Nerds/California, freely download software programs and printed information about computers and their operation from the callnerds.com website and may contact Nerds/California by using the toll free telephone number listed on the website. Indiana residents may also request service from Nerds/California via the callnerds.com website but to do so the person must provide a false telephone number because the area code menu on the service request screen does not offer as options any area codes used outside California or Oregon. The callnerds.com website lists on a page entitled "Contact Us" the nine office locations where Nerds/California does business.

26. Nerds/California has never particularly targeted any advertising to Indiana residents and has never advertised in any newspaper or any radio or television station that publishes or broadcasts in Indiana.

27. Nerds/California has never applied for nor received any Indiana business licenses, has paid no taxes in Indiana, is not qualified to do business in Indiana, and has never attempted to do business in Indiana.

28. Nerds/California has no real property, personal property, bank accounts, or any

other assets located in Indiana nor has any offices, employees, or independent contractors in Indiana.

29. Nerds/California has never attempted to nor has it ever provided any service to any person residing in Indiana.

30. Nerds/California has never entered into a contract in Indiana, with a vendor residing in Indiana, or in which Indiana provided the controlling law.

31. No employee, representative, or agent of Nerds/California has ever traveled to Indiana for the purpose of transacting, soliciting, or otherwise representing Nerds/California.

32. Other than the instant lawsuit, Nerds/California has never appeared in any court in Indiana.

33. Through its concurrent use registration application, Nerds/California seeks to restrict Nerds/Indiana's trademark rights in NERDS ON CALL to Indianapolis, Indiana and an area comprising a 50 mile radius encircling the city. The Southern District of Indiana includes a sizable geographic region that is outside this 50 mile radius that encircles Indianapolis, Indiana.

#### Nerds/Indiana's Alleged Lost Business Opportunities

34. In late March 2007 Nerds/California learned that Brock Peterson, an individual residing in Chico, California, was providing computer-related services to consumers under the fictitious business name "Nerdon." Counsel for Nerds/California sent Peterson a cease and desist letter on the grounds that NERDON was confusingly similar to NERDS ON CALL. Peterson informed counsel for Nerds/California on April 3, 2007 that he would stop using NERDON but on April 16, 2007 asserted that he was seeking legal advice on the matter. On April 17, 2007 counsel for Nerds/California received a letter from counsel for Nerds/Indiana asserting that Nerds/Indiana and Peterson were "in the process of formalizing a license



agreement” for Peterson’s use of NERDS ON CALL and similar marks. On April 19, 2007 counsel for Nerds/California wrote to counsel for Nerds/Indiana informing him that because Nerds/Indiana owned no trademark rights in NERDS ON CALL in California any trademark license with Peterson would be meaningless and that Nerds/California would continue to assert its rights in NERDS ON CALL against Peterson. Peterson was sent a copy of the letter and soon afterwards stopped using NERDON to provide computer-related services. Under Nerds/California’s threat of litigation with regard to the rightful ownership of NERDS ON CALL, Peterson ceased protracted and extensive discussions with Nerds/Indiana with regard to the terms of a license for the use of NERDS ON CALL and, ultimately, therefore did not enter into a license agreement with Nerds/Indiana for the use of NERDS ON CALL.

#### Instances of Alleged Confusion

35. On October 9, 2004 Nerds/Indiana received an e-mail from Lisa Fiorina of Redding, California requesting the telephone number of a technician in her area.

36. On June 15, 2005 Nerds/Indiana received an e-mail from Stephen Sifers of Redding, California inquiring about Nerds/Indiana potentially hiring him as a technician.

37. On January 8, 2007 Nerds/Indiana received an e-mail from Paula Daniel of Redding, California asking about computer service for her mother who lives in Colorado Springs, Colorado.

38. On July 24, 2007 Nerds/Indiana was left a voicemail message from Megan Scally of Sacramento, California inquiring into having a technician set up a computer in her business.

39. On July 29, 2007 Nerds/Indiana received an e-mail from Jack Moby of Redding, California regarding poor service that he received from a Nerds/California technician.

40. On July 19, 2008 Nerds/Indiana received a phone call from a woman named

“Mary” from Sacramento, California who called Nerds/Indiana “to cancel an appointment she had on Wednesday.” Mary did not have an appointment with Nerds/Indiana on that day.

41. The parties dispute whether any of the four alleged instances of “confusion” described in Undisputed Facts Nos. 35 - 38 are related to Nerds/California.

Respectfully submitted,

DATED: December 17, 2008

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DATED: December 17, 2008

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