

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

<p>J.T.COLBY & COMPANY, INC., D/B/A BRICK TOWER PRESS, J. BOYLSTON & COMPANY, PUBLISHERS LLC AND IPICTUREBOOKS LLC,</p> <p style="text-align: center;">Plaintiffs,</p> <p style="text-align: center;">-against-</p> <p>APPLE INC.</p> <p style="text-align: center;">Defendant.</p>

Civil Case No.: 11-civ-4060 (DLC)

ATTORNEY DECLARATION

Partha P. Chatteraj, hereby declares pursuant to 28 U.S.C. § 1746 that:

1. I am a member in good standing of the Bar of this Court and New York State and am a member of the law firm Allegaert Berger & Vogel LLP, co-counsel for Plaintiffs in the above referenced matter.

2. Attached hereto are full documents and, pursuant to Rule 5.2 of the ECF Rules & Instructions for the United States District Court for the Southern District of New York, April 4, 2011 Edition, relevant excerpts of more voluminous documents. The full versions of all excerpted documents have either been produced in full in this litigation, made available to opposing counsel for inspection, or are publically available. Full versions of any excerpted documents will be made available to the Court upon request.

3. Attached hereto as Exhibit 1 is a true and correct copy of the Amended and Supplemental Complaint without exhibits, filed in the case on May 11, 2012. A courtesy copy of the same, inclusive of all exhibits, was previously provided to the Court.

4. Attached hereto as Exhibit 2 is a true and correct copy of the Intent to Use Application filed by Family Systems Ltd. (“FS”) on October 8, 1996 with the United States Patent and Trademark Office (the “PTO”) for the mark “IBOOK” in connection with “computer hardware and software used to create interactive, user modifiable electronic books” in International Class 9. Exhibit 2 was produced by Defendant in this litigation and bears Bates numbers APPLE-IBOOKS0000035-42.

5. Attached hereto as Exhibit 3 is a true and correct copy of Trademark Registration No. 2,446,634 (the “634 Registration”) as published by the PTO on April 24, 2001. Exhibit 3 was produced by Defendant in this litigation and bears Bates number APPLE-IBOOKS0000006.

6. Attached hereto as Exhibit 4 is a true and correct copy of U.S. Patent No. 7,447,748.

7. Attached hereto as Exhibit 5 is a true and correct copy of pages 1 and 20 from the transcript of the deposition of Richard S. Goldhor, taken in this matter on January 31, 2012.

8. Attached hereto as Exhibit 6 is a true and correct copy of pages 1, 113, and 114 of Exhibit 5 from the deposition of Richard S. Goldhor, taken in this matter on January 31, 2012. The excerpt at pages 113-114 is a press release, dated March 12, 2002, titled *Family Systems launches the ibook® Family of Software Products for a Better Way of Working Together*.

9. Attached hereto as Exhibit 7 is a true and correct copy of pages 1, 44, and 45 from the transcript of the deposition of Richard S. Goldhor, taken in this matter on January 31, 2012.

10. Attached hereto as Exhibit 8 is a true and correct copy of a press release, dated January 27, 2010, titled *Apple Launces iPad*. Exhibit 8 was produced by Defendant in this litigation and it bears Bates numbers APPLE-IBOOKS0021840-42.

11. Attached hereto as Exhibit 9 is a true and correct copy of pages 1, 45, 46, and 48 from the transcript of the deposition of Thomas La Perle in this matter, taken on September 19, 2012.

12. Attached hereto as Exhibit 12 is a true and correct copy of pages 1, 110, and 111 of the transcript of the deposition of Steve Gedikian in this matter, taken September 27, 2012.

13. Attached hereto as Exhibit 11 is a true and correct copy of the 1999 Consent agreement between Apple and FS, as filed with the PTO as Response to Office Action with regard to Serial No. 75/584,233, dated July 22, 1999, including the Consent Agreement between Apple and FS, dated as of May 7, 1999. Exhibit 11 was produced by Defendant in this litigation and it bears Bates numbers APPLE-IBOOKS0000123-31.

14. Attached hereto as Exhibit 12 is a true and correct copy of pages 1 and 20 of the transcript of the deposition of Anthony Lupo in this matter, taken on September 26, 2012.

15. Attached hereto as Exhibit 13 is a true and correct copy of pages 1 and 68-71 from the transcript of the deposition of Richard S. Goldhor, taken in this matter on January 31, 2012.

16. Attached hereto as Exhibit 14 is a true and correct copy of an email from Brian Reynolds ("Reynolds") to Ross Panko, sent at 4:01 PM on October 1, 2008. Exhibit 14 was produced by Defendant in this litigation and bears Bates numbers APPLE-IBOOKS0020321-22.

17. Attached hereto as Exhibit 15 is a true and correct copy of pages 1, 108, and 109 from the transcript of the deposition of Thomas La Perle in this matter, taken on September 19, 2012.

18. Attached hereto as Exhibit 16 is a true and correct copy of an email conversation between Reynolds, Brewster Taylor (“Taylor”), and Anthony Lupo (“Lupo”) which took place between January 13 and January 23, 2010. Exhibit 16 was produced by Defendant in this litigation and bears Bates numbers APPLE-IBOOKS0022057-69.

19. Attached hereto as Exhibit 17 is a true and correct copy of an email from Reynolds to Lupo, et al., sent at 5:13 AM on January 24, 2010. Exhibit 17 was produced by Defendant in this litigation and bears Bates number APPLE-IBOOKS0023745.

20. Attached hereto as Exhibit 18 is a true and correct copy of an email from Lupo to Reynolds, et al., sent at 11:14 PM on January 25, 2010. Exhibit 18 was produced by Defendant in this litigation and bears Bates number APPLE-IBOOKS0023658.

21. Attached hereto as Exhibit 19 is a true and correct copy of pages 1 and 117-119 of the transcript of the deposition of Lupo in this matter, taken on September 26, 2012.

22. Attached hereto as Exhibit 20 is a true and correct copy of pages 1 and 153 of the transcript of the deposition of Glenn A. Gundersen in this matter, taken on October 3, 2012.

23. Attached hereto as Exhibit 21 is a true and correct copy of the Trademark and Domain Name Assignment Agreement made between Apple and FS and dated as of January 26, 2010 along with an internal invoice from Apple. Exhibit 21 was produced by Defendant in this litigation and bears Bates numbers APPLE-IBOOKS0033421-32.

24. Attached hereto as Exhibit 22 is a true and correct copy of an email conversation between Reynolds, Taylor, Lupo, and Grace Applefeld which took place between

January 27 and February 5, 2010. Exhibit 22 was produced by Defendant in this litigation and bears Bates numbers APPLE-IBOOKS0023912-15.

25. Attached hereto as Exhibit 23 is a true and correct copy of pages 1, 125, and 126 from the transcript of the deposition of Thomas La Perle in this matter, taken on September 19, 2012.

26. Attached hereto as Exhibit 24 is a true and correct copy of the page displayed when one types in the following URLs: www.ibook.com; www.ibook.net; www.ibook.org; www.i-book.com; www.i-book.net; www.i-book.org. The actual page attached hereto was reached by typing in the URL www.ibook.com.

27. Attached hereto as Exhibit 25 is a true and correct copy of Application No. 85/008,412, filed by Apple on April 7, 2010. Exhibit 25 was produced by Defendant in this litigation and bears Bates numbers APPLE-IBOOKS0000159-64.

28. Attached hereto as Exhibit 26 is a true and correct copy of an email from Thomas Morrison to Dale Cendali, et al., sent at 10:17AM on March 6, 2012.

29. Attached hereto as Exhibit 27 is a true and correct copy of an Amendment to Allege Use pursuant to 15 U.S.C. § 1051(c) filed by Apple on March 13, 2012. Exhibit 27 was produced by Defendant in this litigation and bears Bates numbers APPLE-IBOOKS0000185, APPLE-IBOOKS0000205-231.

30. Attached hereto as Exhibit 28 is a true and correct copy of an email from Bonnie L. Jarrett to Thomas Morrison, sent at 2:23 PM on March 14, 2012.

31. Attached hereto as Exhibit 29 is a true and correct copy of the Section 7 Request form filed by Apple in connection with the 634 Registration on May 17, 2010. Exhibit 29

was produced by Defendant in this litigation and bears Bates numbers APPLE-IBOOKS0000066-74.

32. Attached hereto as Exhibit 30 is a true and correct copy of the Combined Declaration of Use and Excusable Nonuse/Application for Renewal of Registration of a Mark under §§ 8 & 9 that Apple filed with the PTO in connection with the 634 Registration on June 7, 2010. Exhibit 30 was produced by Defendant in this litigation and bears Bates numbers APPLE-IBOOKS0000080-87.

33. Attached hereto as Exhibit 31 is a true and correct copy of a press release, dated June 7, 2010 and titled, *Apple Presents iPhone 4*. Exhibit 31 was produced by Defendant in this litigation and bears Bates numbers APPLE-IBOOKS0021100-03.

34. Attached hereto as Exhibit 32 is a true and correct copy of pages 1 and 110 of the transcript of the deposition of Steve Gedikian in this matter, taken on September 27, 2012.

35. Attached hereto as Exhibit 33 is a true and correct copy of pages 1 and 106-109 of the transcript of the deposition of Steve Gedikian in this matter, taken on September 27, 2012.

36. Attached hereto as Exhibit 34 is a true and correct copy of pages 1 and 109 of the transcript of the deposition of Steve Gedikian in this matter, taken on September 27, 2012.

37. Attached hereto as Exhibit 35 is a true and correct copy of pages 1 and 114-115 of the transcript of the deposition of Steve Gedikian in this matter, taken on September 27, 2012.

38. Attached hereto as Exhibit 36 is a true and correct copy of pages 1 and 221 of the transcript of the deposition of Steve Gedikian in this matter, taken on September 27, 2012.

39. Attached hereto as Exhibit 37 is a true and correct copy of pages 1 and 219-220 of the transcript of the deposition of Steve Gedikian in this matter, taken on September 27, 2012.

40. Attached hereto as Exhibit 38 is a true and correct copy of the iBooks Software License Agreement currently available through Apple via their website at <http://images.apple.com/legal/sla/docs/iBooks.pdf>.

41. Attached hereto as Exhibit 39 is a true and correct copy of pages 1 and 105 of the transcript of the deposition of Richard Freese in this matter, taken September 25, 2012.

42. Attached hereto as Exhibit 40 is a true and correct copy of a press release dated August 18, 1999 titled, *ibooks: The best of the future---the best of the past*. Exhibit 40 was produced by Plaintiffs in this litigation and bears Bates number COLBYHD0458339.

43. Attached hereto at Exhibit 41 is a true and correct summary, pursuant to Federal Rule of Evidence 1006, of Plaintiffs' voluminous sales data relating to their iBooks imprint originally provided in full to Defendant on August 20, 2012. The full document will be provided to the Court upon request.

44. Attached hereto as Exhibit 42 is a true and correct copy of pages 1, 23, and 24 of the transcript of John Colby's 30(b)(6) deposition in this matter, taken on July 18, 2012.

45. Attached hereto as Exhibit 43 is a true and correct copy of a Letter from John Colby to Lisa Barelli, dated May 11, 2007, attaching the Bill of Sale, dated December 13, 2006, signed by Kenneth P. Silverman as Chapter 7 Trustee of the jointly administered debtors Byron Preiss Visual Publications, Inc., and Ibooks, Inc. and the Amended Terms and Conditions relating to Purchase and Sale of the Assets of Byron Preiss Visual and Ibooks, dated November

29, 2006 Exhibit 43 was produced by Plaintiffs in this litigation and bears Bates number COLBYHD0233074

46. Attached hereto as Exhibit 44 is a true and correct copy of pages 1 and 14 from the transcript of the deposition of Richard S. Goldhor, taken in this matter on January 31, 2012.

47. Attached hereto as Exhibit 45 is a true and correct copy of pages 1, 117, 118, 119, and 120 of Exhibit 5 from the deposition of Richard S. Goldhor, taken in this matter on January 31, 2012. The excerpt at pages 117-118 is a press release, dated August 21, 2001, titled, *Family Systems and Tong McCandless Group Sign Business Development Agreement: Silicon Valley Consultants to Provide Marketing and Sales Services for International Web-Based Collaboration Tools Developer*. The excerpt at pages 119-120 is a press release titled dated June 4, 2001, *Family Systems Offers Radiant Communications Hosting Services for ibooks®*

48. Attached hereto as Exhibit 46 is a true and correct copy of pages 1, 115, and 116 of Exhibit 5 from the deposition of Richard S. Goldhor, taken in this matter on January 31, 2012. The excerpt at pages 115-116 is a press release, dated August 21, 2001, titled, *Norton Practice Launches ibook®-Based Client Website Using Family Systems Technology, Consulting Services*.

49. Attached hereto as Exhibit 47 is a true and correct copy of pages 1 and 31 of the transcript of the deposition of Anthony Lupo in this matter, taken on September 26, 2012.

50. Attached hereto as Exhibit 48 is a true and correct copy of the Intent to Use Application for the mark IBOOKS filed on August 25, 1999 on behalf of Ibooks, Inc. with the PTO ("Serial No. 75/786,491"). Exhibit 48 was obtained from the PTO's Trademark Status & Document Retrieval System ("TSDRS") on December 17, 2012.

51. Attached hereto as Exhibit 49 is a true and correct copy of a Response to Office Action, dated September 4, 2002, submitted in connection with Serial No. 75/786,491. Exhibit 49 was obtained from the TSDRS on December 17, 2012.

52. Attached hereto as Exhibit 50 is a true and correct copy of a Notice of Abandonment, issued on July 21, 2003 in connection with Serial No. 75/786,491. Exhibit 50 was obtained from the TSDRS on December 17, 2012.

53. Attached hereto as Exhibit 51 is a true and correct copy of an email conversation between Taylor, Lupo, and Reynolds taking place on January 26, 2010. Exhibit 51 was produced by Defendant in this litigation and bears Bates numbers APPLE-IBOOKS0023639-41

54. Attached hereto as Exhibit 52 is a true and correct copy of pages 1 and 148 of the transcript of the deposition of Glenn A. Gundersen in this matter, taken on October 3, 2012.

55. Attached hereto as Exhibit 53 is a true and correct copy of pages 1, 136, and 137 of the transcript of the deposition of Hal E. Borden in this matter, taken on October 2, 2012.

56. Attached hereto as Exhibit 54 is a true and correct copy of an email conversation between Taylor, Lupo, and Reynolds taking place on January 29, 2010. Exhibit 54 was produced by Defendant in this litigation and bears Bates number APPLE-IBOOKS0022179.

57. Attached hereto as Exhibit 55 is a true and correct copy of an email sent by John Colby to Steve Dowling, and forwarded to Kevin Saul, Thomas La Perle, Glenn Gundersen, and Hal Borden, all on January 29, 2010. Exhibit 55 was produced by Defendant in this litigation and bears Bates numbers APPLE-IBOOKS0024021-22.

58. Attached hereto as Exhibit 56 is a true and correct copy of a Notice of Publication Under § 12(a) setting the publication date for the IBOOKS mark under Serial No. 85/008,412 as December 18, 2012. Exhibit 56 was obtained from TSDRS on December 17, 2012.

59. Attached hereto as Exhibit 57 is a true and correct copy of the Apple iBooks software license agreement. Exhibit 57 is an excerpt containing only the English version of the iBooks software license agreement obtained from Apple's website at <http://images.apple.com/legal/sla/docs/iBooks.pdf>, accessed on December 17, 2012.

60. Attached hereto as Exhibit 58 is a true and correct copy of pages 1, 62, and 63 of the transcript of the deposition of Grace Kvamme in this matter, taken on September 25, 2012.

61. Attached hereto as Exhibit 59 is a true and correct copy of pages 1 and 45 of the transcript of the deposition of Grace Kvamme in this matter, taken on September 25, 2012.

62. Attached hereto as Exhibit 60 is a true and correct copy of pages 1, 30, and 204 of the transcript of the deposition of Steve Gedikian in this matter, taken September 27, 2012.

63. Attached hereto as Exhibit 61 is a true and correct copy of pages 1, 246, 164, and 168 of the transcript of the deposition of Thomas La Perle in this matter, taken on September 19, 2012.

64. Attached hereto as Exhibit 62 is a true and correct copy of pages 1, 72, and 73 of the transcript of the deposition of Lisa Widup in this matter, taken on September 21, 2012.

65. Attached hereto as Exhibit 63 is a true and correct copy of pages 1 and 15 of the transcript of the deposition of Linda Taylor in this matter, taken October 9, 2012.

66. Attached hereto as Exhibit 64 is a true and correct copy of pages 1 and 60 of the transcript of the deposition of Linda Taylor in this matter, taken October 9, 2012.

67. Attached hereto as Exhibit 65 is a true and correct copy of pages 1, 61, and 62 of the transcript of the deposition of Grace Kvamme in this matter, taken on September 25, 2012.

68. Attached hereto as Exhibit 66 is a true and correct copy of pages 1, 140, and 141 of the transcript of the deposition of Hal E. Borden in this matter, taken October 2, 2012.

69. Attached hereto as Exhibit 67 is a true and correct copy of pages 1, 144, and 145 of the transcript of Glenn A. Gundersen in this matter, taken on October 3, 2012.

70. Attached hereto as Exhibit 68 is a true and correct copy of U.S. Patent No, 7,571, 212, awarded August 4, 2009 to Reynolds and Mark J. Conway.

71. Attached hereto as Exhibit 69 is a true and correct copy of pages 1 and 370 of the transcript of the 30(b)(6) deposition of John T. Coly in this matter, taken July 18, 2012.

72. Attached hereto as Exhibit 70 is a true and correct copy of pages 1 and 158 of the transcript of the deposition of Thomas La Perle in this matter, taken on September 19, 2012.

73. Attached hereto as Exhibit 71 is a true and correct copy of a Revocation of Attorney/Domestic Representative and/or Appointment of Attorney/Domestic Representative filed on February 5, 2010 with regard to the 634 Registration. Exhibit 71 was produced by Defendant in this litigation and bears Bates numbers APPLE-IBOOKS0000060-64.

74. Attached hereto as Exhibit 72 is a true and correct copy of a Combined Declaration of Use and Incontestability Under Sections 8 & 15 filed on April 27, 2007 with regard to the 634 Registration. Exhibit 72 was produced by Defendant in this litigation and bears Bates numbers APPLE-IBOOKS0000053-55.

75. Attached hereto as Exhibit 73 is a true and correct copy of the Trademark Assignment filed by Apple and Recorded by the PTO on February 4, 2010.

76. Attached hereto as Exhibit 74 is a true and correct copy of the Arguments in Response to Office Action on IBOOKS submitted by Apple (Serial No. 85/008,412). Exhibit 74 was produced by Defendant in this litigation and bears Bates numbers APPLE-IBOOKS0000232-35.

77. Attached hereto as Exhibit 75 are the cover page and page 10 of the expert Report of Robert T. Scherer, served in this matter on September 17, 2012.

78. Attached hereto as Exhibit 76 is a true and correct copy of the personal blog of Reynolds. Exhibit 76 was captured from the website jaman.blogspot.com on September 12, 2012.

79. Attached hereto as Exhibit 77 is a true and correct copy of Defendant Apple Inc.'s Amended Responses and Objections to Plaintiffs Notice of Deposition of Defendant Apple Inc. Pursuant to Fed. R. Civ. P. 30(b)(6), dated July 16, 2012.

80. Attached hereto as Exhibit 78 is a true and correct copy of pages 1 and 20 of the transcript of the deposition of Thomas La Perle in this matter, taken September 19, 2012.

81. Attached hereto as Exhibit 79 is a true and correct copy of pages 1, 132, and 133 of the transcript of the deposition of Thomas La Perle in this matter, taken September 19, 2012.

82. Attached hereto as Exhibit 80 is a true and correct copy of pages 1 and 43-55 of the transcript of the 30(b)(6) deposition of John T. Colby in this matter, taken July 18, 2012.

83. Attached hereto as Exhibit 81 is a true and correct copy of the Certificate of Assumed Name issued by the New York State Department of State for the name "ibooks," issued to J. Boylston & Company, Publishers LLC, pursuant to a filing on December 12, 2006.

84. Attached hereto as Exhibit 82 is a true and correct copy of the Intent to Use Application for Trademark Ser. No. 75/584,233, for "IBOOK," received by the PTO on November

6, 1998. Exhibit 82 was produced by Defendant in this litigation and bears Bates numbers APPLE-IBOOKS0000132-144.

85. Attached hereto as Exhibit 83 is a true and correct copy of the trademark registration for IBOOK, listed on the Principal Register at Reg. No. 2,470,147, and registered on July 17, 2001.

86. Attached hereto as Exhibit 84 is a true and correct copy of pages 1 and 129 of the transcript of the deposition of Thomas La Perle in this matter, taken September 19, 2012.

87. Attached hereto as Exhibit 85 is a true and correct copy of pages 1 and 150 of the transcript of the deposition of Robert T. Scherer in this matter, taken November 16, 2012.

88. Attached hereto as Exhibit 86 is a true and correct copy of pages 1, 46, and 57 of the transcript of the deposition of Siegrun Kane in this matter, taken November 6, 2012.

89. Attached hereto as Exhibit 87 is a true and correct copy of pages 1, 54, and 29 of the transcript of the deposition of Philip G. Hampton in this matter, taken November 29, 2012.

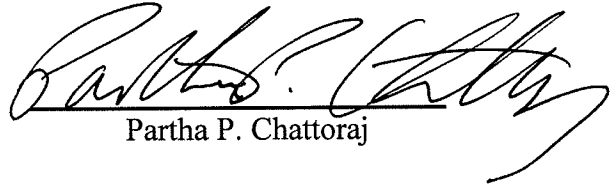
90. Attached hereto as Exhibit 88 is a true and correct copy of Jim Milliot, *Bucking the Odds: Indie Publishers Tap New Channels to Spur Growth*, PUBLISHERS WEEKLY, Mar. 7, 2005, available at <http://www.publishersweekly.com/pw/print/20050307/29773-bucking-the-odds.html>.

91. Attached hereto as Exhibit 89 is a true and correct copy of pages 1 and 171 of the transcript of the 30(b)(6) deposition of John T. Colby in this matter, taken July 18, 2012.

92. Attached hereto as Exhibit 90 is a true and correct copy of pages 1 and 194 of the transcript of the 30(b)(6) deposition of John T. Colby in this matter, taken July 18, 2012.

I declare, under penalty of perjury, that the foregoing is true and correct.

Dated: New York, New York
December 21, 2012



Partha P. Chattoraj