

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

AUDIBLE MAGIC CORPORATION,

Petitioner,

v.

GOOGLE INC.,

Respondent.

Cancellation No. _____

Registration No. 4651405

Mark: CONTENT ID

Registered: December 9, 2014

PETITION FOR CANCELLATION

Petitioner, Audible Magic Corporation ("Audible Magic"), a corporation organized and existing under the laws of the state of Delaware, having an address at 985 University Avenue, Suite 35, Los Gatos, California 95032, believes it will be damaged by the continued registration of the mark CONTENT ID shown in Registration No. 4651405 for services in International Classes 35 and 42, registered December 9, 2014, by Respondent, Google Inc. ("Google"), a corporation organized and existing under the laws of the state of Delaware and having an address listed at 1600 Amphitheatre Parkway, Mountain View, California 94043, and hereby petitions to cancel the same.

As grounds for cancellation, Petitioner alleges that:

1. Audible Magic is the leader in automated identification of audio and visual content for web media platforms and social networks. Audible Magic was founded in 1999 to enable a radically new user experience with a breakthrough audio identification technology. Audible Magic pioneered the use of automatic content recognition in a range of applications. From content identification to media synchronization, Audible Magic's technology is used by the

biggest names in the broadcasting, social media, consumer electronics and apps industries, including Facebook, Vimeo, Verizon Wireless, NBCU, Fox, Viacom/MTV, Warner Bros, Sony Pictures, and Disney/ABC. From 2006-2009, YouTube (acquired and controlled by Google since 2006) was also one of Audible Magic's major customers.

2. Since at least as early as March 2006, Audible Magic has continuously used the mark CONTENT ID to identify its audio and video content detection and recognition services. Under the mark CONTENT ID, Audible Magic registers music, TV content, motion pictures, and other audio and video materials and then monitors any third-party upload or use of the content. The CONTENT ID system is highly useful in protecting music, TV content, motion pictures, and other audio and video materials from copyright infringement and on-line pirating.

3. Upon information and belief, in 2006, YouTube, an on-line service for third parties to upload and stream video and audio entertainment, was facing sharp accusations that it was a prime enabler of copyright infringement and pirating. The television and movie industries were complaining that YouTube was allowing third-parties to upload copyrighted materials from television and movies and was not instituting any controls or checks on third-party content. This negative publicity was particularly damaging to YouTube in 2006 when Google was considering acquiring YouTube for over one billion dollars.

4. Upon information and belief, to rectify its pirating problem and mollify the entertainment industries, YouTube turned to Audible Magic and its cutting edge CONTENT ID content recognition systems. On October 4, 2006, YouTube and Audible Magic signed an agreement granting YouTube a license to use Audible Magic's CONTENT ID services for detecting registered audio and video files, verifying content identities and ownership, and alerting any unauthorized uses of such content. Shortly thereafter, YouTube was purchased by

Google and the agreement with Audible Magic was formally transferred to Google. The license agreement between Google and Audible Magic terminated on December 31, 2009 and all intellectual property rights in CONTENT ID reverted to Audible Magic.

5. Audible Magic has continuously used the mark CONTENT ID in interstate commerce throughout the United States since March 2006 in connection with its audio and video content detection and recognition services and intends to continue so using CONTENT ID in the future. Audible Magic has therefore obtained common law rights in the CONTENT ID trademark dating back to 2006.

6. Google is now attempting to gain ownership of Audible Magic's CONTENT ID mark by registering it with the USPTO and claiming exclusive use. Audible Magic, however, has priority over Google with respect to the CONTENT ID mark. As explained above, Audible Magic introduced Google to the CONTENT ID mark (which Audible Magic was and continues to use) and the underlying technology and services. According to the date of first use claimed in Google's registration, Google asserts that it first used the mark CONTENT ID mark in connection with its services on August 27, 2008. Audible Magic's date of first use of CONTENT ID in March 2006 is thus well before the claimed first use of the mark by Google (as it should be since Google sourced the mark and related services from Audible Magic), and Audible Magic's use of CONTENT ID therefore has priority over Google's use and registration.

7. Audible Magic has offered and provided services under the CONTENT ID mark throughout the United States and have built up valuable goodwill in connection with the CONTENT ID mark.

8. By virtue of the excellence of its services, Audible Magic has gained for the CONTENT ID mark a valuable reputation.

9. Google adopted the CONTENT ID mark which is identical to Audible Magic's mark and is now attempting to claim it as its own exclusive mark.

10. Google has registered the CONTENT ID mark in connection with services that are highly related to the services offered by Audible Magic under CONTENT ID and is likely to cause confusion, to cause mistake, and to deceive customers, potential customers, and others as to the source of the services offered under the CONTENT ID mark. Such confusion may cause harm to Audible Magic and the consuming public and jeopardize the valuable goodwill and reputation Audible Magic has built up in connection with CONTENT ID and its services. Furthermore, any defect, objection or fault found with Google's services marketed under the CONTENT ID mark may be linked back to Audible Magic by the public and reflect upon and injure the reputation that has been established for the services offered by Audible Magic under CONTENT ID. Accordingly, Audible Magic requests that the CONTENT ID registration be cancelled based on priority and likelihood of confusion.

11. In addition, Audible Magic believes the CONTENT ID registration should be cancelled on the grounds that Google committed fraud in the prosecution of the application and in the procurement of the registration for the mark. On September 9, 2013, Google filed the subject application for CONTENT ID at Serial No. 86059654 and provided a declaration signed by the Senior Trademark Counsel of Google declaring that it is the owner of the mark subject to be registered and that to the best of its knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce. By the declaration's own terms, any false statements in the declaration are punishable by fine or imprisonment and may jeopardize the validity of the application or any resulting registration. Upon information and belief, at the time Google submitted its declaration and made these statements, they knew they were false.

Google had first-hand knowledge that the first use of the CONTENT ID trademark was made by Audible Magic and that Audible Magic was the rightful owner since they learned of and adopted the mark directly from Audible Magic. They also knew that Audible Magic had the right to use and was using CONTENT ID in commerce. Google had a formal agreement with Audible Magic regarding the CONTENT ID services through the end of 2009 and its group product manager and head of its YouTube content identification and licensing division had several exchanges with Audible Magic regarding Audible Magic's CONTENT ID services.

Accordingly, Google's declaration included willful false statements that were fraudulently submitted which should jeopardize the validity of the resulting registration, namely, cancel it.

12. In addition, on December 20, 2013, the subject application for CONTENT ID at Serial No. 86059654 was issued an Office Action by the USPTO and was refused under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1) on the grounds that CONTENT ID is merely descriptive of Google's services. On June 12, 2014, Google filed a response to the Office Action claiming that CONTENT ID had acquired distinctiveness based upon a declaration that "[t]he mark has become distinctive of the goods/services through [Google's] substantially exclusive and continuous use in commerce that the U.S. Congress may lawfully regulate for at least the five years immediately before the date of this statement." Upon information and belief, Google knew this declaration was false when it submitted it to the USPTO. As explained above, Google was well aware of Audible Magic's substantial use of the identical mark. Accordingly, Google's claim that it had made substantially exclusive use of CONTENT ID was fraudulent when it submitted the declaration to the USPTO in order to obtain its CONTENT ID registration and the registration should therefore be cancelled.

13. Accordingly, for each and every reason stated above, Audible Magic believes that it will be damaged by the continued registration of CONTENT ID by Google and petitions to cancel Registration No. 4651405.

WHEREFORE, Audible Magic prays that this cancellation be sustained and that Registration No. 4651405 be cancelled.

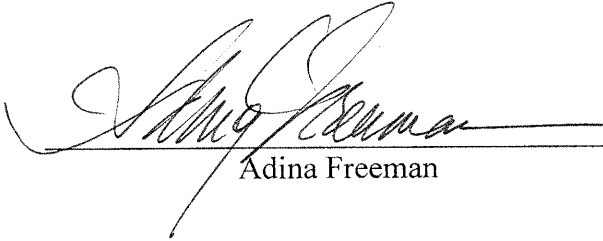
January 10, 2017	
	Respectfully submitted, SHEPPARD, MULLIN, RICHTER & HAMPTON LLP By: <u>Harold Milstein</u> Harold J. Milstein Chelseaa Bush Attorneys for Petitioner Audible Magic Corporation

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CERTIFICATE OF SERVICE

This is to certify that a copy of the foregoing Petition for Cancellation was served by Federal Express on January 10, 2017 upon Respondent at its address of record at:

Emily Burns
Google Inc.
1600 Amphitheatre Parkway
Mountain View, CA 94043



Adina Freeman