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Battle of the ANDROIDS

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In a decision that provides useful guidance on what constitutes abandonment, the U.S. Court of Appeals for the Seventh Circuit upheld a district court ruling that Google did not infringe on a **third party's alleged right**s in the mark **ANDROID DATA** after the mark had been abandoned based on non-use. ***Erich Specht, et al., v. Google, Inc.,*** Case No. 11-3317 (7th Cir., Apr 4, 2014) (Rovner, J.).

In 1998, Erich Specht started using the ANDROID DATA trademark in connection with a business that licensed his e-commerce software and offered website hosting and design services, as well as computer consulting services. He filed a trademark application for the ANDROID DATA trademark, and the registration issued in 2002—just as Specht's business started winding down. After 2002, his use of the ANDROID DATA trademark was extremely limited. Specht kept his phone service for the company until 2003, he kept his website at androiddata.com until 2005, and he only made a handful of attempts to use of the mark after 2005.

During this time, another company, Android, Inc., started developing the Android operating system. Google purchased Android, Inc., in 2005 and released a public beta of the Android software in 2007. After this beta release, use of the Android platform grew, and Google filed an application to register the ANDROID trademark. The U.S. Patent and Trademark Office rejected Google's application, based on Specht's prior registration for ANDROID DATA.

Specht then sued Google for federal trademark infringement, federal unfair competition, common law trademark infringement and violation of the Illinois Deceptive Trade Practices Act, all based on Google's use of the ANDROID trademark. Google responded with counterclaims seeking a declaration that Specht had abandoned the ANDROID DATA mark and asking the district court to cancel the ANDROID DATA trademark registration. On summary judgment decision, the district court found that the ANDROID DATA mark had been abandoned based on non-use without any intent to resume use and cancelled Specht's trademark registration. Specht appealed.

In affirming the district court, the 7th Circuit explained that use of a trademark is discontinued with no intent to resume use, a trademark owner forfeits its rights and the trademark is considered abandoned. According to the Lanham Act, "[n]onuse for three consecutive years shall be prima facie evidence of abandonment." Here, the court agreed that Specht's sporadic use of the ANDROID DATA mark after 2002 did not constitute bona fide trademark use of the mark, and Specht had already abandoned the ANDROID DATA trademark when Google started using ANDROID in

commerce in 2007.

The appellate court also confirmed that the district court had the authority to cancel a trademark registration, explaining that where “a registrant’s asserted rights to a mark are shown to be invalid, cancellation is not merely appropriate, it is the best course.”

Practice Note: The decision includes a useful discussion of certain acts that will not constitute trademark use. In particular, Specht’s efforts to sell the assets of his business, his operation of a website bearing the ANDROID DATA trademark (without providing any goods or services) and his “sporadic attempts to solicit business” through an unsuccessful mass mailing and a failed bid to license software to a third party were all insufficient to show continued use of the mark.

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