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

Proceeding	91166346
Party	Plaintiff TomTom B.V
Correspondence Address	Jess M. Collen COLLEN IP Holyoke-Manhattan Bldg.; 80 S Highland Ave. Ossining, NY 10562 breilly@collenIP.com
Submission	Stipulated/Consent Motion to Extend
Filer's Name	Brendan J. Reilly
Filer's e-mail	breilly@collenip.com,pmulhern@collenip.com
Signature	/s/Brendan J. Reilly
Date	03/30/2006
Attachments	95095.joint inquiry_20060330173435.pdf (7 pages)

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

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TOMTOM B.V.

Opposer,

vs.

OPPOSITION N0.: 91166346
SERIAL NO.: 76125536
MARK: TOMTOM

TOMTOM LICENSING GMBH LLC,

Applicant.

----------X

JOINT MOTION FOR SUSPENSION AND INQUIRY REGARDING THE STATUS OF THE AMENDMENT TO THE APPLICATION IN DISPUTE

Now come the Opposer, Tomtom B.V., and the Applicant, TomTom Licensing GMBH LLC, by and through their undersigned attorneys, and hereby submit this Joint Motion for Suspension and Inquiry Regarding the Status of the Amendment to the Application in Dispute. As the basis hereof, the parties represent the following:

1. United States Trademark Application No. 76125536 (the "'536 Application") was published for opposition on April 26, 2005;
2. On May 12, 2005, Opposer filed an request for an extension of time to oppose the '536 Application;
3. On May 13, 2005 the Board granted Opposer's request to extend the time to oppose the '536 Application up to and including August 24, 2005;
4. On August 18, 2005, Applicant filed an amendment to the '536 Application, a copy of which is attached hereto as Exhibit A. The amendment sought to delete all goods listed in class 30 from the '536 Application;

5. On August 24, 2005, Opposer commenced an opposition proceeding against all six classes listed in the '536 Application;
6. Opposer paid an opposition fee of $1,800 ($300 for each opposed class)[1];
7. Due to the pending amendment, both parties anticipated that the Board would suspend this proceeding pending consideration of the amendment by the Examiner as set forth in TMBP Sections 212.03 and 212.04. No order of suspension has yet issued;
8. The parties are concerned that the Board is not aware of the amendment;
9. In addition, a review of the TARR system reveals that the Examiner entered the amendment on October 11, 2005. Applicant has not yet received any correspondence from the Examiner regarding this activity and the Examiner's action is not posted on the TDR system;
10. If action was taken on the amendment, the Examiner should have informed the Board pursuant to TBMP§ 212.04;
11. In addition, if the amendment was entered which deleted a class of goods, Opposed should be entitled to a refund for the $300 opposition fee for that class.

For the foregoing reasons, the parties jointly (1) request a suspension of these proceedings until further order from the Board; (2) inquire as to the status of the amendment to the '536 Application; (3) request that the discovery period be extended at least 60 days from the date that the suspension ends; and (4) request that all subsequent

[1] The Notice of Opposition calculated that a fee of $1500 was enclosed. However, $1800 was rightfully charged to Opposer's counsel credit card on August 24, 2005. Indeed, the Board would not have accepted the Notice of Opposition without the proper fee, which at the time was $1800.

trial periods be reset. In addition, the Opposer requests that any excess opposition fees be refunded.

Respectfully Submitted,

/s/ Robert S. Pierce
Robert S. Pierce, Attorney for Applicant

March 30, 2006

Jacobson Holman PLLC
400 7th Street NW, Suite 600
Washington, DC 20004-2218
tel: (202) 638-6666
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/s/ Brendan J. Reilly
Brendan J. Reilly, Attorney for Opposer

March 30, 2006

COLLEN *IP*
80 South Highland Ave.
Ossining, NY 10562
Tel: (914) 941-5668
Fax: (914) 941-6091

CERTIFICATE OF SERVICE

I, Brendan J. Reilly, hereby certify that I served a true and correct copy of the foregoing JOINT MOTION FOR SUSPENSION AND INQUIRY REGARDING THE STATUS OF THE AMENDMENT TO THE APPLICATION IN DISPUTE to be served upon the following via first-class mail, postage pre-paid:

ROBERT S. PIERCE
JACOBSON HOLMAN PLLC
400 SEVENTH STREET, N.W.
WASHINGTON, DC 20004

Said service having taken place March 30, 2006

/s/Brendan J. Reilly
Brendan J. Reilly

JMC:BJR
COLLEN *IP*
INTELLECTUAL PROPERTY LAW
THE HOLYOKE-MANHATTAN BUILDING
80 SOUTH HIGHLAND AVENUE
TOWN OF OSSINING
WESTCHESTER COUNTY, NEW YORK 10562

SHOULD ANY OTHER FEE BE REQUIRED, THE PATENT AND TRADEMARK OFFICE IS HEREBY REQUESTED TO CHARGE SUCH FEE TO OUR DEPOSIT ACCOUNT 03-2465.

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING FILED ELECTRONICALLY WITH THE UNITED STATES PATENT AND TRADEMARK OFFICE ON March 30, 2006

COLLEN *IP*

BY: /s/Brendan J. Reilly DATE: March 30, 2006

EXHIBIT A

JC76
AUG 18 2005
PATENT & TRADEMARK OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: TomTom Licensing GmbH

Serial No.: 76/125536

TM Attorney: Zhaleh Sybil Delaney

Filed: September 11, 2000

Law Office: 116

Mark: TOMTOM

Box Response-No Fee

AMENDMENT AFTER PUBLICATION

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22215-1451

Sir:

IN THE STATEMENT

Please cancel the identification of goods in International Class 30.

REMARKS

Applicant requests that the Trademark Trial and Appeal Board return this application to the Examining Attorney for approval of an Amendment After Publication. This application was published in the Trademark Official Gazette for opposition April 26, 2005. A Request for an Extension of Time to Oppose was filed May 12, 2005, but no Notice of Opposition has been filed. Therefore, this application is not subject to an *inter partes* proceeding and return to the Examining Attorney for consideration of the proposed amendment is proper.

The proposed amendment is also proper because it restricts the scope of the identification of goods identified in the Official Gazette. That identification specified "sugar; rice; tapioca; flour and cereal-based products, namely, breakfast cereal, snack-foods, and other processed cereals; candy; honey, treacle; yeast and baking

08-18-2005
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #77

powder; vinegar; salt" in International Class 30, and this proposed amendment seeks to delete this entire class of goods. Because the amended identification would be more restrictive, republication of the mark is not required.

Therefore, early notice that this amendment was accepted is appreciated.

Respectfully submitted,

By: _____

John C. Holman
JACOBSON HOLMAN PLLC
400 Seventh Street, Northwest
Washington, District of Columbia 20004
(202) 638-6666

Date: August 18, 2005
ID: JCH/RSP
Atty. Dkt. No.: T35127US0