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

Proceeding	91198095
Party	Defendant Nimble Storage, Inc.
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Submission	Motion to Suspend for Civil Action
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Date	03/18/2011
Attachments	2011-03-18 - Nimble Motion to Suspend Proceeding.pdf (4 pages)(1243987 bytes)

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

In the matter of Application Serial No. 77/740,539
For the Trademark: NIMBLE STORAGE
Published in the Official Gazette on November 23, 2010

NIMBUS DATA SYSTEMS, INC.,)	
)	
Opposer,)	
)	Opposition No. 91198095
v.)	
)	
NIMBLE STORAGE, INC.,)	
)	
Applicant.)	
)	
)	
)	

**APPLICANT NIMBLE STORAGE, INC.’S MOTION TO SUSPEND PROCEEDING
PENDING OUTCOME OF RELATED CIVIL COURT ACTION**

Pursuant to 37 C.F.R. § 2.117 and TBMP § 510.02(a), Nimble Storage, Inc. (“Applicant”), by and through its attorneys, Cooley LLP, hereby moves to suspend the opposition proceeding initiated by Nimbus Data Systems, Inc. (“Opposer”) against Applicant’s application for NIMBLE STORAGE, Serial No. 77/740,539 (the “Mark”). Suspension is proper in this instance because Opposer has initiated a related civil action in Federal district court, the final determination of which will have a bearing on this proceeding.

The Board may suspend an opposition proceeding “[w]henever it shall come to the attention of the [Board] that a party or parties to a pending case are engaged in a civil action ... which may have a bearing on the case.” 37 C.F.R. § 2.117(a). “To the extent that a civil action in a Federal district court involves issues in common with those in a proceeding before the Board, the decision of the Federal district court is often binding upon the Board, while the decision of the Board is not binding upon the court.” TBMP 510.02(a) (citing *Goya Foods Inc.*

v. Tropicana Products Inc., 846 F.2d 848, 6 USPQ2d 1950, 1954 (2d Cir. 1988); *American Bakeries Co. v. Pan-O-Gold Baking Co.*, 650 F. Supp. 563, 2 USPQ2d 1208 (D. Minn. 1986)).

“Ordinarily, the Board will suspend proceedings in the case before it if the final determination of the other proceeding will have a bearing on the issues before the Board.” TBMP 510.02(a) (citing 37 CFR § 2.117(a); *General Motors Corp v. Cadillac Club Fashions, Inc.*, 22 USPQ 1933 (TTAB 1992) (relief sought in Federal district court included an order directing Office to cancel registration involved in cancellation proceeding); *Other Telephone Co. v. Connecticut National Telephone Co.*, 181 USPQ 125 (TTAB 1974) (decision in civil action for infringement and unfair competition would have bearing on outcome of Section 2(d) claim before Board), *petition denied*, 181 USPQ 779 (Comm'r 1974); *Tokaido v. Honda Associates Inc.*, 179 USPQ 861 (TTAB 1973); *Whopper-Burger, Inc. v. Burger King Corp.*, 171 USPQ 805 (TTAB 1971); *Martin Beverage Co. v. Colita Beverage Corp.*, 169 USPQ 568 (TTAB 1971)).

On March 11, 2011, Opposer filed a civil complaint (the “Complaint”) in the United States District Court for the Northern District of California, Case No. CV11-1214, alleging trademark infringement, false designation of origin and unfair competition and cybersquatting, among other causes of action (the “Civil Action”). A copy of the Complaint is attached hereto as Exhibit A.

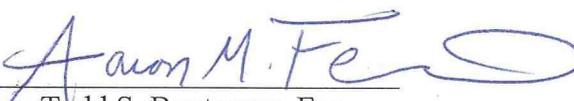
There is no doubt that a decision in the Civil Action would have a bearing on this proceeding. In both the Notice of Opposition and the Complaint, Opposer asserts rights in the NIMBUS and NIMBUS DATA marks (collectively, the “NIMBUS Marks”) through its alleged common law use of the NIMBUS Marks in connection with data storage systems. Notice of Opposition, ¶¶ 5-6; Complaint, ¶¶ 6, 8-15. While the Notice of Opposition in this proceeding challenges Applicant’s application to register the Mark in connection with “[c]omputer

hardware and software for use in the storage, management, and acceleration of data over computer networks within the field of data storage,” the Complaint challenges Applicant’s use of “the NIMBLE Marks as a trade name and trademark in connection with its competing data storage products.” Notice of Opposition, ¶¶ 4, 7-9; Complaint, ¶ 16. Opposer claims in both the Notice of Opposition and the Complaint that Applicant’s use of the Mark in connection with data storage products is likely to cause confusion, mistake, or deception and likely to create the mistaken impression that Opposer and Applicant are somehow related or associated, or that Opposer sponsors or approves Applicant’s products. Notice of Opposition, ¶ 9; Complaint, ¶¶ 6, 62. The outcome of the Civil Action on these issues will thus have a bearing on the outcome of this opposition proceeding.

Therefore, Applicant respectfully requests that this opposition proceeding be suspended pending the outcome of the related Civil Action, in accordance with 37 C.F.R. § 2.117 and TBMP 510.02(a).

COOLEY LLP

Date: March 18, 2011

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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing APPLICANT NIMBLE STORAGE, INC.'S MOTION TO SUSPEND PROCEEDING PENDING OUTCOME OF RELATED CIVIL COURT ACTION was mailed, first-class postage prepaid, to counsel for Opposer at the address listed below, this 18th day of March 2011.

Counsel for **Nimbus Data Systems, Inc.**
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