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

Proceeding	91202009
Party	Defendant Motorola Trademark Holdings, LLC
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

XOOM CORPORATION, Opposer, v. MOTOROLA TRADEMARK HOLDINGS, LLC, Applicant.	Opposition No.: 91202009

ANSWER TO NOTICE OF OPPOSITION

Applicant Motorola Trademark Holdings, LLC ("Motorola"), by and through its undersigned counsel, for its Answer and Affirmative Defenses to Opposer Xoom Corporation's ("Opposer") Notice of Opposition, states as follows:

Opposition No. 1

> Xoom has long offered online products and services under its trade name and incontestable federally registered XOOM® mark. Products and services offered under the Xoom name and XOOM® marks include computer accessible remittance products and services, which allow users to transmit monies through the xoom.com web site to more than 30 different countries. Such products and services are available for use through computers and mobile devices, including mobile or tablet computers.

Answer No. 1

Motorola denies that Opposer offers "products" under the Xoom name or marks. Motorola is without sufficient knowledge or information to form a belief as to the truth of the remaining allegations in Paragraph 1 and, therefore, denies each and every allegation in Paragraph 1.

Opposition No. 2

> Since at least as early as 2003, Xoom has offered consumers access to its remittance software products and services through its www.xoom.com web site

using its distinctive XOOM® mark and trade name. Through this long online use accessible via computer and mobile devices, Xoom's trade name and the XOOM® products and services have become associated among consumers exclusively with Xoom.

Answer No. 2

Motorola denies that Opposer offers "products" under the XOOM mark. Motorola is without sufficient knowledge or information to form a belief as to the truth of the remaining allegations in Paragraph 2 and, therefore, denies each and every allegation in Paragraph 2.

Opposition No. 3

Xoom owns the following valid, subsisting, uncancelled and unrevoked federal trademark registrations for the XOOM® mark:

(a) An incontestable United States trademark registration for XOOM®, Federal Registration No. 2,909,931, covering "providing business information, namely, on money transfer services," in International Class 35 and "money transfer services; electronic funds transfer services; bill payment remittance services; electronic payment, namely, electronic processing and transmission of bill payment data" in International Class 36. The mark has been in use in commerce by Xoom since at least as early as May 7, 2003, registered on December 14, 2004 and became incontestable with the filing (and acceptance) of Xoom's Section 8 and 15 affidavits demonstrating continuous use of the XOOM® mark for five years after registration. A true and correct copy of the TARR and Assign Status pages for this mark from the USPTO web site are attached hereto as Exhibit A.

(b) A United States trademark registration for XOOM® (U.S. Reg. No. 4,012,377) covering "providing a web site featuring temporary use of non-downloadable software for providing information on money transfers, and for facilitating money transfers, electronic funds transfers, bill payment remittances and electronic processing and transmission of bill payment data," in International Class 42. The mark has been in use in commerce by Xoom since at least as early as May 7, 2003 and registered on August 16, 2011. A true and correct copy of the TARR and Assign Status pages for this mark from the USPTO web site are attached hereto as Exhibit B.

Answer No. 3

Motorola admits that Opposer owns two trademark registrations for the mark XOOM. Motorola is without sufficient knowledge or information to form a belief as to the truth of the remaining allegations in Paragraph 3 and, therefore, denies each and every allegation in Paragraph 3.

Opposition No. 4

Xoom also has long owned and used the xoom.com domain name.

Answer No. 4

Motorola is without sufficient knowledge or information to form a belief as to the truth of the allegations in Paragraph 4 and, therefore, denies each and every allegation in Paragraph 4.

Opposition No. 5

> Xoom promotes and offers its products and services under its XOOM® marks and name to customers throughout the United States.

Answer No. 5

Motorola denies that Opposer promotes or offers "products." Motorola is without sufficient knowledge or information to form a belief as to the truth of the remaining allegations in Paragraph 5 and, therefore, denies each and every allegation in Paragraph 5.

Opposition No. 6

> At the website, xoom.com, and elsewhere on the Internet, Xoom features and promotes Xoom's computer accessible, secure, fast and inexpensive remittance products and services, which allow users to transmit monies through the xoom.com web site to more than 30 different countries.

Answer No. 6

Motorola denies that Opposer features and promotes "products." Motorola is without sufficient knowledge or information to form a belief as to the truth of the remaining allegations in Paragraph 6 and, therefore, denies each and every allegation in Paragraph 6.

Opposition No. 7

As a result of its exclusive use since at least as early as 2003, the XOOM® mark has become exclusively associated by consumers as a designation of source for Xoom's products and services, including its provision of online access to XOOM® product offerings.

Answer No. 7

Motorola denies each and every allegation in Paragraph 7.

Opposition No. 8

By way of the opposed application, Applicant Motorola Trademark Holdings, LLC seeks to register the XOOM mark for "mobile computers and related accessories, namely, mobile computer docking stations, cradles for holding mobile computers, mounts for holding mobile computers, holders for holding mobile computers, stands for mobile computers, carrying cases for mobile computers, stands for mobile computers, protective covers for mobile computers, protective or decorative skins, namely, fitted or plastic films known as skins for covering and protecting mobile computers, batteries, power adaptors, computer cables, cable connectors, headsets and speakers for use with mobile computers" in International Class 9.

Answer No. 8

Motorola admits the allegations in Paragraph 8.

Opposition No. 9

The opposed intent-to-use application was filed on October 26, 2010, years after Xoom filed and obtained a United States trademark registrations for its XOOM® mark, and years after Xoom first commenced use of its XOOM® marks, name and domain names.

Answer No. 9

Motorola admits that the opposed intent-to-use application was filed on October 26, 2010. Motorola is without sufficient knowledge or information to form a belief as to the truth of the remaining allegations in Paragraph 9 and, therefore, denies each and every allegation in Paragraph 9.

FIRST GROUND FOR OPPOSITION
(Likelihood of Confusion)

Opposition No. 10

Xoom realleges the allegations contained in paragraphs 1 through 9 of this Notice of Opposition as if fully set out herein.

Answer No. 10

Motorola repeats and incorporates by reference its responses to Paragraphs 1 through 9 as its response to Paragraph 10.

Opposition No. 11

The designation for which Applicant seeks registration by way of the opposed application for XOOM, is identical in sight, sound and meaning to Xoom's incontestable XOOM® mark and names. The applied-for designation consists of the identical wording XOOM, which is a coined term with no established meaning.

Answer No. 11

Motorola admits that it has applied for registration of the mark XOOM. Motorola denies each and every remaining allegation in Paragraph 11.

Opposition No. 12

On information and belief, Xoom alleges that the goods for which Applicant seeks to register the opposed XOOM designation are related to and/or complementary to Xoom's products and services. Moreover, on information and belief, Xoom alleges that Applicant intends to direct its products under the confusingly similar Xoom designation to the same and/or overlapping consumers that use Xoom's products and services or to whom Xoom promotes and offers its products and services bearing its XOOM® marks. Further, on information and belief, Xoom alleges that Applicant and Xoom use or will use the same or overlapping channels of trade to target the same or overlapping prospective customers.

Answer No. 12

Motorola denies each and every allegation in Paragraph 12.

Opposition No. 13

Since Xoom's XOOM® marks and name are identical in sight, sound and meaning to the word portion of the applied-for designation and because the goods identified in the opposed application and the apparent channels of trade for those goods are related and/or complimentary to those offered by Xoom, Applicant's application for the XOOM designation is likely to cause confusion, or to cause mistake, or to deceive or disparage by falsely suggesting a connection with Xoom, when no such connection exists. As a result, Xoom will be damaged by the registration of the designation sought to be protected in Applicant's application and requests that the opposed application be denied.

Answer No. 13

Motorola denies each and every allegation in Paragraph 13.

AFFIRMATIVE DEFENESE

First Affirmative Defense

Opposer has failed to state a claim upon which relief can be granted.

Second Affirmative Defense

Opposer's requested relief should be denied as its claims are barred due to unclean hands on the part of Opposer.

Third Affirmative Defense

Any rights owned by Opposer are extremely weak, as the term XOOM is highly-diluted because it has been registered and used for many years by many third-parties. As such, any rights owned by Plaintiff are too narrow to oppose Motorola's application.

Date: November 18, 2011

Respectfully submitted,

Attorney for Applicant Motorola Trademark Holdings, LLC

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CERTIFICATE OF SERVICE

I hereby certify that I have caused a true and correct copy of the Answer to Notice of Opposition to be served upon:

Rochelle D. Alpert
Morgan Lewis & Bockius LLP
One Market, Spear Street Tower
San Francisco, CA 94105

by First Class Mail, postage prepaid, this 18th day of November, 2011.

Cathay Y. N. Smith