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

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|------------------------|--|
| Proceeding | 91202009 |
| Party | Plaintiff Xoom Corporation |
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| Attachments | 91202009 - Opposer's Response to Applicant's Motion to Suspend Proceedings.pdf (4 pages)(116764 bytes) |

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

In the matter of application Serial No. 85/161,358
Filed October 26, 2010
For the mark **XOOM**
Published in the OFFICIAL GAZETTE on April 12, 2011

XOOM CORPORATION,

Opposer,

v.

MOTOROLA TRADEMARK HOLDINGS, LLC,

Applicant.

Opposition No.: 91,202,009

OPPOSER'S RESPONSE TO APPLICANT'S MOTION TO SUSPEND PROCEEDINGS

Opposer Xoom Corporation ("Xoom") hereby responds to the motion by Applicant Motorola Trademark Holdings, LLC ("Applicant") to suspend these proceedings under 37 C.F.R. § 2.117(a) and T.B.M.P. § 510.

As background, Applicant filed its intent-to-use application for the XOOM designation for mobile computers and related accessories on October 26, 2010 well after Xoom began using its incontestable, federally registered XOOM® mark and its Xoom trade name in commerce in 2003 in connection with its remittance services. Xoom's XOOM® remittance services are accessible via computers, and are available in special formats for all types of mobile devices, including tablet computers and cell phones. An image of the screen of a mobile phone accessing Xoom's XOOM® remittance services is juxtaposed below next to an image of Motorola's use of XOOM on the screen of Motorola's XOOM device:



Nonetheless, Applicant's XOOM application was filed more than six years after the federal trademark registration for XOOM® issued and well after its initial XOOM® registration became incontestable.

Under these circumstances, suspension may *not* be the appropriate outcome for this proceeding. It is in the Board's sole discretion to determine whether to suspend a proceeding pending the outcome of another proceeding. 37 C.F.R. § 2.117(a); T.B.M.P. 510.02(A). Suspension is not required, nor is it appropriate in all cases. *Boyd's Collection Ltd. v. Herrington & Co.*, 65 U.S.P.Q.2d 2017, 2018 (TTAB 2003) ("...suspension is not the necessary result in all cases."). Significantly, the federal litigation between Xoom and Applicant is not necessarily dispositive of this proceeding, depending on its outcome. Moreover, the litigation proceeding involves additional parties, and will be decided under a different standard than the trademark proceeding. *See* T.B.M.P. § 101 (T.T.A.B. has modified rules of procedure, modified evidentiary standards, and a different body of precedential case law than federal court proceedings).

Indeed, Applicant has raised invalid affirmative defenses in the trademark proceeding that should be addressed by the Board. Applicant's affirmative defenses of failure to state a claim, unclean hands and that Xoom's mark is "highly diluted" are not properly alleged

affirmative defenses. The Board has stated on multiple occasions that the failure to state a claim affirmative defense does not lie, so long as an opposer alleges facts that, if proven, would establish that (1) opposer has standing to maintain the proceeding, and (2) a valid ground exists for denying the registration to overcome an allegation of failure to state a claim for relief. *Order of Sons of Italy in Am. v. Profumi Fratelli Nostra AG*, 36 U.S.P.Q.2d 1221, 1222 (T.T.A.B. 1995); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 1026 (C.C.P.A. 1982). Both elements are clearly present here where Applicant seeks to register a mark that is identical to Xoom's incontestable registration for XOOM® for related and/or complementary products. Applicant's remaining affirmative defenses of unclean hands and that XOOM is "highly diluted" also fail as a matter of law for, among other reasons, failing to include sufficient detail to give fair notice of the basis for each defense, presumably because such detail does not exist. *Cf. McDonnell Douglas Corp. v. National Data Corp.*, 228 U.S.P.Q. 45, 47 (T.T.A.B. 1985) (affirmative defenses must include sufficient detail to provide notice for basis of each defense).

It is not surprising that Applicant would prefer not to have the Board reach a decision in this opposition proceeding given the Board's plain standards for determining likelihood of confusion among identical marks offered for related and/or complementary products and services. However, Applicant's desire to delay the opposition proceeding should not control the Board's decision. Rather, the Board should exercise its discretion.

Dated: December 8, 2011

Respectfully submitted,

By: /s/ LEIGHA E. WEINBERG

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CERTIFICATE OF SERVICE

I am a resident of the State of California and over the age of eighteen years, and not a party to the within action; my business address is One Market, Spear Street Tower, **San Francisco, CA 94105**.

On **December 8, 2011**, I served the within documents:

OPPOSER'S RESPONSE TO APPLICANT'S MOTION TO SUSPEND PROCEEDINGS



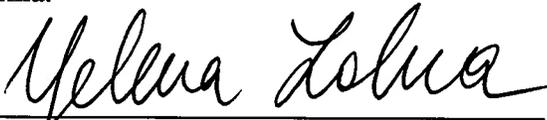
(BY MAIL) by placing the document(s) listed above in a sealed envelope with postage thereon fully prepaid, in the United States mail at **San Francisco, California** addressed as set forth below. I am readily familiar with the firm's practice of collection and processing correspondence for mailing. Under that practice it would be deposited with the U.S. Postal Service on that same day with postage thereon fully prepaid in the ordinary course of business. I am aware that on motion of the party served, service is presumed invalid if postal cancellation date or postage meter date is more than one day after date of deposit for mailing in affidavit.



(BY FEDERAL EXPRESS) I placed the sealed envelope(s) or package(s) designated by the express service carrier for collection and delivery to the party/ies listed below:

Kristin J. Achterhof
Katten Muchin Rosenman LLP
525 W. Monroe Street
Chicago, IL 60661

I declare under penalty of perjury under the laws of the State of California and the United States of America that the foregoing is true and correct, and that this declaration was executed on **December 8, 2011**, at **San Francisco, California**.



Yelena Lolua