

ESTTA Tracking number: **ESTTA441418**

Filing date: **11/16/2011**

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

**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

Name	Xoom Corporation
Granted to Date of previous extension	11/16/2011
Address	100 Bush Street San Francisco, CA 94104 UNITED STATES

Attorney information	Rochelle D. Alpert Morgan, Lewis & Bockius LLP One Market, Spear Street Tower San Francisco, CA 94105 UNITED STATES ralpert@morganlewis.com, lweinberg@morganlewis.com, sfrademarks@morganlewis.com Phone:415-442-1326
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**Applicant Information**

Application No	85257238	Publication date	07/19/2011
Opposition Filing Date	11/16/2011	Opposition Period Ends	11/16/2011
Applicant	Motorola Trademark Holdings, LLC 600 N. U.S. Highway 45 Libertyville, IL 60048 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 009. First Use: 2011/02/15 First Use In Commerce: 2011/02/15 All goods and services in the class are opposed, namely: Mobile computers and related accessories, namely, mobile computer docking stations, carrying cases 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
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**Grounds for Opposition**

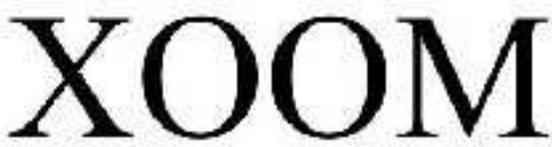
Priority and likelihood of confusion	Trademark Act section 2(d)
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**Marks Cited by Opposer as Basis for Opposition**

U.S. Registration No.	2909931	Application Date	09/15/2003
Registration Date	12/14/2004	Foreign Priority Date	NONE

Word Mark	XOOM
Design Mark	
Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 2003/05/07 First Use In Commerce: 2003/05/07 Providing business information, namely on, money transfer services Class 036. First use: First Use: 2003/05/07 First Use In Commerce: 2003/05/07 Money transfer services; electronic funds transfer services; bill payment remittance services; electronic payment, namely, electronic processing and transmission of bill payment data

U.S. Registration No.	4012377	Application Date	01/24/2011
Registration Date	08/16/2011	Foreign Priority Date	NONE

Word Mark	XOOM
Design Mark	
Description of Mark	NONE
Goods/Services	Class 042. First use: First Use: 2003/05/07 First Use In Commerce: 2003/05/07 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

U.S. Application No.	85225008	Application Date	01/24/2011
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	XOOM		

Design Mark	<h1>XOOM</h1>
Description of Mark	NONE
Goods/Services	Class 009. First use: Computer software for facilitating money transfer services, electronic funds transfer services, bill payment remittance services, electronic processing and transmission of payments and payment data

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	XOOM		
Goods/Services	As specified in the attached Notice of Opposition.		

Attachments	76544640#TMSN.gif ( 1 page )( bytes ) 85225023#TMSN.jpeg ( 1 page )( bytes ) 85225008#TMSN.jpeg ( 1 page )( bytes ) Notice of Opposition (Exs A-C).pdf ( 21 pages )(546093 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/LEW/
Name	Leigha E. Weinberg
Date	11/16/2011

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

In the matter of application Serial No. 85/257,238  
Filed March 3, 2011  
For the mark **MOTOROLA XOOM**  
Published in the OFFICIAL GAZETTE on July 19, 2011

XOOM CORPORATION,

Opposer,

v.

MOTOROLA TRADEMARK HOLDINGS, LLC,

Applicant.

Opposition No.:

**NOTICE OF OPPOSITION**

Xoom Corporation, a California corporation, having its principal place of business at 100 Bush Street, San Francisco, California 94104 (“Xoom”), believes that it will be damaged by the registration of the designation in the application shown in Serial No. 85/257,238, and hereby opposes same.

As grounds for the opposition, Xoom alleges as follows:

1. Xoom has long offered online products and services under its trade name and incontestable federally registered XOOM<sup>®</sup> mark. Products and services offered under the Xoom name and XOOM<sup>®</sup> 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.

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.

3. Xoom owns the following valid, subsisting, uncanceled 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.

(c) An allowed United States trademark application for XOOM (U.S. App. Serial No. 85/225,008) covering “computer software for facilitating money transfer services, electronic funds transfer services, bill payment remittance services, electronic processing and transmission of payments and payment data,” in International Class 9. 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 C.

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

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

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.

7. As a result of its exclusive use since at least as early as 2003, the XOOM<sup>®</sup> 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<sup>®</sup> product offerings.

8. By way of the opposed application, Applicant Motorola Trademark Holdings, LLC seeks to register the MOTOROLA XOOM mark for “Mobile computers and related accessories, namely, mobile computer docking stations, carrying cases 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” in International Class 9.

9. The opposed intent-to-use application was filed on March 3, 2011, years after Xoom filed and obtained a United States trademark registrations for its XOOM<sup>®</sup> mark, and years after Xoom first commenced use of its XOOM<sup>®</sup> marks, name and domain names.

**FIRST GROUND FOR OPPOSITION  
(Likelihood of Confusion)**

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

11. The designation for which Applicant seeks registration by way of the opposed application for MOTOROLA XOOM, is highly similar in sight, sound and meaning to Xoom’s incontestable XOOM<sup>®</sup> mark and names. The applied-for designation contains the identical wording XOOM, which is a coined term with no established meaning.

12. On information and belief, Xoom alleges that the goods for which Applicant seeks to register the opposed MOTOROLA 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 MOTOROLA 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<sup>®</sup> 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.

13. Since Xoom’s XOOM<sup>®</sup> marks and name are virtually identical in sight, sound and meaning to the dominant XOOM 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 MOTOROLA 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.

WHEREFORE, Xoom prays that application Serial No. 85/257,238 be rejected, that no registration be issued thereon to Applicant, that this opposition be sustained in favor of Xoom, and that such other appropriate and proper relief be entered.

Dated: November 16, 2011

Respectfully submitted,

By: /s/ LEIGHA E. WEINBERG  
Leigha E. Weinberg  
Attorney for Opposer Xoom Corporation

Rochelle D. Alpert  
Leigha E. Weinberg  
Morgan, Lewis & Bockius LLP  
One Market, Spear Street Tower  
San Francisco, CA 94105  
Telephone: (415) 442-1326  
Facsimile: (415) 442-1001

**EXHIBIT A**  
**to Notice of Opposition**

DB2/ 22774970.1

**XOOM CORPORATION v. MOTOROLA TRADEMARK HOLDINGS, LLC**

**Serial No. 85/257,238**

**Submitted by: XOOM CORPORATION (Opposer)**

**Thank you for your request. Here are the latest results from the TARR web server.**

**This page was generated by the TARR system on 2011-11-15 11:57:43 ET**

**Serial Number:** 76544640 [Assignment Information](#)      [Trademark Document Retrieval](#)

**Registration Number:** 2909931

**Mark (words only):** XOOM

**Standard Character claim:** No

**Current Status:** A Sections 8 and 15 combined declaration has been accepted and acknowledged.

**Date of Status:** 2009-12-22

**Filing Date:** 2003-09-15

**Transformed into a National Application:** No

**Registration Date:** 2004-12-14

**Register:** Principal

**Law Office Assigned:** LAW OFFICE 105

**If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov)**

**Current Location:** L50 -TMEG Law Office 105

**Date In Location:** 2009-12-22

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**LAST APPLICANT(S)/OWNER(S) OF RECORD**

---

1. Xoom Corporation

**Address:**

Xoom Corporation  
100 Bush Street  
San Francisco, CA 94104  
United States

**Legal Entity Type:** Corporation

**State or Country of Incorporation:** California

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**GOODS AND/OR SERVICES**

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**International Class:** 035

**Class Status:** Active

Providing business information, namely on, money transfer services

**Basis:** 1(a)

**First Use Date:** 2003-05-07

**First Use in Commerce Date:** 2003-05-07

**International Class:** 036

**Class Status:** Active

Money transfer services; electronic funds transfer services; bill payment remittance services; electronic payment, namely, electronic processing and transmission of bill payment data

**Basis:** 1(a)

**First Use Date:** 2003-05-07

**First Use in Commerce Date:** 2003-05-07

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#### ADDITIONAL INFORMATION

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(NOT AVAILABLE)

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#### MADRID PROTOCOL INFORMATION

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(NOT AVAILABLE)

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#### PROSECUTION HISTORY

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**NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.**

2011-07-14 - Notice Of Suit

2009-12-22 - Section 8 (6-year) accepted & Section 15 acknowledged

2009-12-22 - Case Assigned To Post Registration Paralegal

2009-12-14 - TEAS Section 8 & 15 Received

2009-07-29 - Applicant/Correspondence Changes (Non-Responsive) Entered

2009-07-29 - TEAS Change Of Owner Address Received

2005-06-08 - TEAS Change Of Owner Address Received

2004-12-14 - Registered - Principal Register

2004-09-21 - Published for opposition

2004-09-01 - Notice of publication

2004-07-18 - Approved for Pub - Principal Register (Initial exam)

2004-05-20 - Communication received from applicant

2004-05-20 - TEAS Response to Office Action Received

2003-09-15 - Unresponsive/Duplicate Paper Received

2004-04-21 - FAX RECEIVED

2004-04-16 - Non-final action e-mailed

2004-04-05 - Assigned To Examiner

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**ATTORNEY/CORRESPONDENT INFORMATION**

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**Attorney of Record**

Rochelle D Alpert

**Correspondent**

Rochelle D Alpert

MORGAN, LEWIS & BOCKIUS LLP

ONE MARKET, SPEAR STREET TOWER

SAN FRANCISCO CA 94105

Phone Number: 415-442-1326

Fax Number: 415-442-1001

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**For Serial Number: 76544640**

If you have any comments or questions concerning the data displayed, contact PRD / Assignments at 571-272-3350. v.2.2  
Web interface last modified: July 25, 2011 v.2.2

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**EXHIBIT B**  
**to Notice of Opposition**

DB2/ 22774970.1

**XOOM CORPORATION v. MOTOROLA TRADEMARK HOLDINGS, LLC**

**Serial No. 85/257,238**

**Submitted by: XOOM CORPORATION (Opposer)**

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**This page was generated by the TARR system on 2011-11-15 12:10:15 ET**

**Serial Number:** 85225023 [Assignment Information](#)      [Trademark Document Retrieval](#)

**Registration Number:** 4012377

**Mark**

**XOOM**

**(words only):** XOOM

**Standard Character claim:** Yes

**Current Status:** Registered. The registration date is used to determine when post-registration maintenance documents are due.

**Date of Status:** 2011-08-16

**Filing Date:** 2011-01-24

**Filed as TEAS Plus Application:** Yes

**Currently TEAS Plus Application:** Yes

**Transformed into a National Application:** No

**Registration Date:** 2011-08-16

**Register:** Principal

**Law Office Assigned:** LAW OFFICE 116

**If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov)**

**Current Location:** 650 -Publication And Issue Section

**Date In Location:** 2011-08-16

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**LAST APPLICANT(S)/OWNER(S) OF RECORD**

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1. Xoom Corporation

**Address:**

Xoom Corporation  
100 Bush Street  
San Francisco, CA 94104  
United States

**Legal Entity Type:** Corporation  
**State or Country of Incorporation:** California

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**GOODS AND/OR SERVICES**

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**International Class:** 042

**Class Status:** Active

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

**Basis:** 1(a)

**First Use Date:** 2003-05-07

**First Use in Commerce Date:** 2003-05-07

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**ADDITIONAL INFORMATION**

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**Prior Registration Number(s):**

2909931

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**MADRID PROTOCOL INFORMATION**

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(NOT AVAILABLE)

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**PROSECUTION HISTORY**

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**NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.**

2011-08-16 - Registered - Principal Register

2011-05-31 - Notice Of Actual Publication E-Mailed

2011-05-31 - Published for opposition

2011-04-19 - Approved for Pub - Principal Register (Initial exam)

2011-04-18 - Assigned To Examiner

2011-01-28 - New Application Office Supplied Data Entered In Tram

2011-01-27 - New Application Entered In Tram

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**ATTORNEY/CORRESPONDENT INFORMATION**

---

**Attorney of Record**

Rochelle D, Alpert

**Correspondent**

ROCHELLE D, ALPERT  
MORGAN, LEWIS & BOCKIUS, LLP  
1 MARKET SPEAR STREET TOWER  
SAN FRANCISCO, CA 94105  
Phone Number: 415 442-1326  
Fax Number: 415 442-1001

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**For Serial Number: 85225023**

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**EXHIBIT C**  
**to Notice of Opposition**

DB2/ 22774970.1

**XOOM CORPORATION v. MOTOROLA TRADEMARK HOLDINGS, LLC**

**Serial No. 85/257,238**

**Submitted by: XOOM CORPORATION (Opposer)**

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**Serial Number:** 85225008 [Assignment Information](#)      [Trademark Document Retrieval](#)

**Registration Number:** (NOT AVAILABLE)

**Mark**

**XOOM**

**(words only):** XOOM

**Standard Character claim:** Yes

**Current Status:** Notice of Allowance (NOA) sent (issued) to the applicant. Applicant must file a Statement of Use or Extension Request within six months of the NOA issuance date.

**Date of Status:** 2011-07-26

**Filing Date:** 2011-01-24

**Filed as TEAS Plus Application:** Yes

**Currently TEAS Plus Application:** Yes

**The Notice of Allowance Date is:** 2011-07-26

**Transformed into a National Application:** No

**Registration Date:** (DATE NOT AVAILABLE)

**Register:** Principal

**Law Office Assigned:** LAW OFFICE 116

**Attorney Assigned:**  
DWYER JOHN D

**Current Location:** 700 -Intent To Use Section

**Date In Location:** 2011-07-26

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**LAST APPLICANT(S)/OWNER(S) OF RECORD**

---

1. Xoom Corporation

**Address:**

Xoom Corporation  
100 Bush Street  
San Francisco, CA 94104  
United States

**Legal Entity Type:** Corporation**State or Country of Incorporation:** California

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**GOODS AND/OR SERVICES**

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**International Class:** 009**Class Status:** Active

Computer software for facilitating money transfer services, electronic funds transfer services, bill payment remittance services, electronic processing and transmission of payments and payment data

**Basis:** 1(b)**First Use Date:** (DATE NOT AVAILABLE)**First Use in Commerce Date:** (DATE NOT AVAILABLE)

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**ADDITIONAL INFORMATION**

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**Prior Registration Number(s):**

2909931

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**MADRID PROTOCOL INFORMATION**

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(NOT AVAILABLE)

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**PROSECUTION HISTORY**

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2011-07-26 - NOA E-Mailed - SOU Required From Applicant

2011-05-31 - Notice Of Actual Publication E-Mailed

2011-05-31 - Published for opposition

2011-04-19 - Approved For Pub - Principal Register

2011-04-18 - Assigned To Examiner

2011-01-28 - New Application Office Supplied Data Entered In Tram

2011-01-27 - New Application Entered In Tram

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**ATTORNEY/CORRESPONDENT INFORMATION**

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**Attorney of Record**<http://tarr.uspto.gov/servlet/tarr?regser=serial&entry=85225008>

11/15/2011

Rochelle D. Alpert

**Correspondent**

ROCHELLE D. ALPERT

MORGAN, LEWIS & BOCKIUS, LLP

1 MARKET SPEAR STREET TOWER

SAN FRANCISCO, CA 94105

Phone Number: 415 442-1326

Fax Number: 415 442-1001

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**For Serial Number: 85225008**

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Web interface last modified: July 25, 2011 v.2.2

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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 **November 16, 2011**, I served the within documents:

**NOTICE OF OPPOSITION (Exhibits A-C) – Serial No. 85/257,238**



**(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:

---

**WILLIAM R. ANDERSON  
MOTOROLA TRADEMARK HOLDINGS, LLC  
600 N US HIGHWAY 45  
LIBERTYVILLE, IL 60048-5343**

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 **November 16, 2011**, at **San Francisco**, California.

  
\_\_\_\_\_  
Yelena Lolua