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

Proceeding	91202575
Party	Plaintiff Xoom Corporation
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Date	12/08/2011
Attachments	91202575 - Opposer's Response to Applicant's Motion to Suspend Proceedings.pdf (4 pages)(110932 bytes)

**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.: 91,202,575

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 application for the MOTOROLA XOOM designation for mobile computers and related accessories on March 3, 2011, 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 MOTOROLA 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 yet to even file its Answer in this proceeding, so it is unclear whether Applicant intends to raise claims or affirmative defenses that are unfounded and/or unrelated to the litigation proceeding.

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