

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Baxley

Mailed: December 12, 2011

Opposition No. 91202575

Xoom Corporation

v.

Motorola Trademark Holdings,
LLC

Andrew P. Baxley, Interlocutory Attorney:

On November 18, 2011, two days after the commencement and institution of this proceeding, applicant filed a motion to suspend this proceeding pending final disposition of a civil action styled *Xoom Corp. v. Motorola Trademark Holdings, LLC*, Case No. CV11-0848-JCS, filed in the United States District Court for the Northern District of California. Opposer filed a brief in opposition thereto.

In opposition to applicant's motion, opposer contends that the civil action is not dispositive of this proceeding because the civil action will be decided under a different standard than this proceeding and that the civil action involves additional parties. Opposer further contends that applicant has yet to file an answer herein.

The Board's general practice is to suspend proceedings before it when any party to a pending Board proceeding is

involved in a civil action which may have a bearing on the Board case.¹ See Trademark Rule 2.117(a). Although the USPTO has expertise in determining trademark registrability, such determinations are is not within the USPTO's exclusive jurisdiction. See *American Bakeries Co. v. Pan-O-Gold Baking Co.*, 2 USPQ2d 1208 (D.C. Minn. 1986). To the extent that a civil action in a Federal district court involves issues in common with those in a Board proceeding, the district court's findings are binding on the Board, whereas the Board's findings are merely advisory to the district court. See *id.*; TBMP Section 510.02(a) (3d ed. 2011). The Board does not require that an answer be filed before it will consider a motion to suspend pending resolution of a civil action. See TBMP Section 510.02(a).

In the above-captioned opposition proceeding, opposer has opposed registration of applicant's involved mark under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). In the civil action, opposer's claims include trademark infringement, false designation of origin, unfair competition, and false advertising. Opposer correctly notes that the civil action is not necessarily dispositive of this proceeding. See, e.g., *Jet Inc. v. Sewage Aeration Systems*, 223 F3d 1360, 55 USPQ2d 1854, 1857 (Fed. Cir. 2000) (civil

¹ Rule 2.117(a) clearly indicates that the parties to the other case and the Board proceeding at issue need not be completely identical.

actions for trademark infringement and cancellation proceedings involve different transactional facts). Nonetheless, the district court's findings with regard to opposer's claims therein clearly may have a bearing upon opposer's Section 2(d) claim in this proceeding and would be binding upon the Board.

In addition, opposer asks in its complaint in the civil action that applicant be permanently enjoined from using any confusingly similar designation to opposer's pleaded XOOM mark. If applicant is enjoined from using its involved MOTOROLA XOOM mark, any such injunction may have a bearing upon whether or not applicant can properly assert, as it does in its involved application, that, "to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive."

Accordingly, in the interests of judicial economy and of avoiding potentially inconsistent results, the Board finds that the civil action may have a bearing upon this proceeding and that suspension of this case pending final disposition, including any appeals or remands, of Case No. CV11-0848-JCS is warranted, and applicant's motion to

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suspend is granted. Proceedings are suspended pending final determination, including any appeals or remands, of Case No. CV11-0848-JCS.

The Board will make annual inquiry as to the status of Case No. CV11-0848-JCS. Within twenty days after the final determination thereof, applicant should notify the Board so that this case may be called up for appropriate action.

During the suspension period, the Board should be notified of any address changes for the parties or their attorneys.