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Filing date: **10/17/2014**

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

Proceeding	91218626
Party	Defendant Google Inc.
Correspondence Address	Emily Burns Google Inc. Attn.: Trademarks Dept. 1600 Amphitheatre Parkway Mountain View, CA 94043 tmdocketing@google.com;pamrolph@google.
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Signature	/Morgan Champion/
Date	10/17/2014
Attachments	Google--Consented Motion to Suspend CHROMEBOOK PIXEL Opposi- tion.pdf(1142342 bytes)

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

In the matter of Application Serial Nos. 85/856,305 and 85/856,307
For the Trademarks CHROMEBOOK PIXEL and GOOGLE CHROMEBOOK PIXEL
Published in the Official Gazette on June 3, 2014

VIA TECHNOLOGIES, INC.)	
)	
Opposer,)	
)	Opposition No. 91218626
v.)	
)	
GOOGLE INC.)	
.)	
)	
Applicant.)	
)	
_____)	

CONSENT MOTION TO SUSPEND PROCEEDING

Pursuant to 37 CFR § 2.117(a) and TBMP § 510.02, Applicant Google Inc. (“Google”), with the consent of Opposer VIA Technologies, Inc. (“Opposer”), hereby moves for an order to suspend this opposition proceeding pending the disposition of *Google Inc. v. VIA Technologies, Inc.* (Cancellation No. 92056816), currently pending before the Trademark Trial and Appeal Board (the “Cancellation Action”).

On February 19, 2013, Google initiated the above-referenced Cancellation Action seeking to cancel Opposer’s registrations for the CHROME mark. A true and correct copy of Google’s petition for cancellation in that proceeding is attached hereto as Exhibit A.

In accordance with 37 CFR § 2.117(a) and TBMP § 510.02, suspension is appropriate where, as here, another Board action is pending that “may have a bearing on the issues before the Board” in the instant proceeding. *See also, The Tamarkin Co. v. Seaway Food Town Inc.*, 34

USPQ2d 1587, 1592 (TTAB 1995) (holding suspension appropriate pending outcome of *ex parte* prosecution of opposer's application).

In the instant proceeding, Opposer is challenging the registration of Google's CHROMEBOOK PIXEL and GOOGLE CHROMEBOOK PIXEL marks on the ground that the marks are likely to cause consumer confusion with Opposer's registered CHROME and DELTACHROME (stylized) marks. In the Cancellation Action, Google is seeking to cancel Opposer's CHROME registrations, which constitute two of the three registrations on which Opposer bases this opposition. Accordingly, the outcome of the Cancellation Action would likely have a significant bearing on the issues before the Board in this proceeding.

Suspension of this opposition is further warranted given the advanced nature of the Cancellation Action. The parties have been actively litigating the Cancellation Action for over a year and a half. As such, litigating a separate and potentially unnecessary opposition proceeding that would require the parties to engage in new and distinct discovery would be an inefficient use of both the parties' and the Board's resources.

In light of the foregoing, Google, with the consent of Opposer, respectfully requests that the Board suspend the instant proceeding immediately pending disposition of the Cancellation Action.

Respectfully submitted,

Dated: October 17, 2014

COOLEY LLP

/Morgan A. Champion/

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Counsel for Applicant Google Inc.

CERTIFICATE OF SERVICE

I hereby certify that on the date indicated below, a true and correct copy of the foregoing
CONSENTED MOTION TO SUSPEND PROCEEDING was served by electronic mail on October 17,
2014, upon counsel for Opposer:

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Date: October 17, 2014

By: /Morgan Champion/
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Counsel for Applicant Google Inc.

EXHIBIT A

ESTTA Tracking number: **ESTTA522380**Filing date: **02/19/2013**

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

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Google Inc.		
Entity	Corporation	Citizenship	Delaware
Address	1600 Amphitheatre Parkway Mountain View, CA 94043 UNITED STATES		

Correspondence information	Janet L. Cullum Cooley LLP Suite 700, 1299 Pennsylvania Avenue NW Washington, DC 20004 UNITED STATES jcullum@cooley.com,apeck@cooley.com,trademarks@cooley.com,tmdocketing@google.com,tm-enf@google.com Phone:(212) 479-6500
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Registrations Subject to Cancellation

Registration No	3360331	Registration date	12/25/2007
Registrant	VIA Technologies, Inc. 8F, 533 Chung-Cheng Road Hsin-Tien, 231 TAIWAN		

Goods/Services Subject to Cancellation

Class 009. First Use: 2001/06/01 First Use In Commerce: 2001/07/01

All goods and services in the class are cancelled, namely: Computers, namely, personal computers, portable computers, handheld computers, notebook computers, microcomputers, desktop computers; computer system components, parts and fittings, namely, motherboards, central processing units (CPUs), base PC modules, computer housing, computer casing, computer chassis, computer frames, computer hardware, namely, semiconductors, microprocessors, graphics processors, integrated circuits, computer chips, computer motherboards, computer graphics boards, computer interface boards, computer accelerator board, circuit boards, computer memory cards, memory chips, blank magnetic data carriers, hard drives, electronic computer locks, computer speakers, disc drives, computer peripherals, computer keyboards, computer printers, computer monitors, multimedia and digital displays, namely, CRT monitors, DVI displays, LCD panels, HDTV displays, GPS navigational displays and automotive visual displays, computer cables, disc and tape controller cards, input devices, namely, scanners, computer mice, joysticks, microphones; computer network adapters, networking switches, routers, modems, power adapters for computers; hand-held devices, namely, Personal Digital Assistants (PDAs), electronic personal organizers, MP3 players; software and hardware for management, storage, communications and network management of digital media and enhancement of graphical and video display; pre-recorded computer discs featuring documentary programs, drama, musical entertainment; portable computer carry bags; cases to carry CDs and DVDs; computer firmware, namely, computer utility software and other computer software used to maintain and operate computer system all stored in a computer's read only memory or elsewhere in the computer's circuitry, operating system software; BIOS software; printed and electronic instructional manuals, specification sheets, data sheets, computer reference manuals, user guides

and documents providing instruction in the use and operation of various electronic digital devices, sold as a unit therewith the aforesaid good

Grounds for Cancellation

Abandonment	Trademark Act section 14		
Registration No	3951287	Registration date	04/26/2011
Registrant	VIA Technologies, Inc. 8F, 533 Chung-Cheng Road Hsin-Tien, 231 TAIWAN		

Goods/Services Subject to Cancellation

Class 042. First Use: 2007/07/19 First Use In Commerce: 2007/07/19

All goods and services in the class are cancelled, namely: computer services, namely, providing on-line information available on computer networks, global information networks and wireless communication networks in the fields of the design, development and customization of computer hardware, computer software, computer graphics software, information technology, wireless communication devices, multimedia technology, robotics, namely, the design and development of new technology in the field of robotics, business computing and environmentally-friendly computing, and specifically excluding computer games and video games, using both an interactive and non-interactive format; technical support services, namely, troubleshooting of computer hardware and software problems in person, by telephone, by electronic, computer and communications networks; provision of computer systems analysis and computer diagnostic services; design of computer hardware, integrated circuits, computer networks and communications hardware and software for others; consultancy in the field of design, development, configuration, installation, updating, upgrading or maintenance of computer software - excluding computer game and video game software; computer programming for others; research and development of 3d content, 3d technology and processes, 3d animation technology, 3d processing power, 3d techniques, and flexible forward projection; creating, designing and maintaining web sites

Grounds for Cancellation

Abandonment	Trademark Act section 14
Other	On information and belief, at the time that Registrant filed the Statements of Use in each of the registrations which are the subject of this Petition, Registrant was not using the mark for all or some of the goods and services claimed in the Statements of Use. On information and belief, at the time that Registrant filed its Declaration under Sections 8 and 15 in Registration No. 3360331, Registrant was not using and had not continually used the mark which Petition seeks to cancel on or in connection with all or some of the goods for which Registrant claimed use.

Attachments	Chromepfcancellation_20130219_15432701.pdf (8 pages)(1173677 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	/anne h. peck/
Name	Anne H. Peck
Date	02/19/2013

As grounds for this Petition, Google alleges that:

1. Google is a Delaware corporation having its principal place of business at 1600 Amphitheatre Parkway, Mountain View, California 94043.
2. On information and belief, Registrant is a Taiwanese corporation having its principal place of business at 8F, 533 Chung-Cheng Road, Hsin-Tien 231, Taiwan.
3. Google is the owner of the following U.S. trademark applications: Serial No. 85/462,997, filed on November 2, 2011, for the mark CHROME; Serial No. 85/463,547, filed on November 3, 2011, for the mark GOOGLE CHROME; Serial No. 85/463,562, filed on November 3, 2011, for the mark CHROMEBOOK; Serial No. 85/463,991, filed on November 3, 2011 for the mark CHROME and Design; and Serial No. 85/464,001, filed on November 3, 2011, for the mark CHROMEBOX (collectively, the "Google CHROME Applications").
4. On or about February 22, 2007, Registrant filed Application Serial No. 77/113,063 for CHROME covering certain goods in Class 9 based on its purported *bona fide* intent to use the mark in United States commerce for all goods listed in the application. On or about October 12, 2007, Registrant submitted a Statement of Use in support of Application Serial No. 77/113,063 declaring under oath that it "is using the mark in commerce on or in connection with the goods/services identified [in the application]...." Thereafter, on December 25, 2007, Application Serial No. 77/113,063 matured to registration as Registration No. 3,360,331.
5. Registration No. 3,360,331 covers the following Class 9 goods: "Computers, namely, personal computers, portable computers, handheld computers, notebook computers, microcomputers, desktop computers; computer system components, parts and fittings, namely, motherboards, central processing units (CPUs), base PC modules, computer housing, computer casing, computer chassis, computer frames, computer hardware, namely, semiconductors, microprocessors, graphics processors, integrated circuits, computer chips, computer motherboards, computer graphics boards, computer interface boards, computer accelerator board, circuit boards, computer memory cards, memory chips, blank magnetic data carriers,

hard drives, electronic computer locks, computer speakers, disc drives, computer peripherals, computer keyboards, computer printers, computer monitors, multimedia and digital displays, namely, CRT monitors, DVI displays, LCD panels, HDTV displays, GPS navigational displays and automotive visual displays, computer cables, disc and tape controller cards, input devices, namely, scanners, computer mice, joysticks, microphones; computer network adapters, networking switches, routers, modems, power adapters for computers; hand-held devices, namely, Personal Digital Assistants (PDAs), electronic personal organizers, MP3 players; software and hardware for management, storage, communications and network management of digital media and enhancement of graphical and video display; pre-recorded computer discs featuring documentary programs, drama, musical entertainment; portable computer carry bags; cases to carry CDs and DVDs; computer firmware, namely, computer utility software and other computer software used to maintain and operate computer system all stored in a computer's read only memory or elsewhere in the computer's circuitry, operating system software; BIOS software; printed and electronic instructional manuals, specification sheets, data sheets, computer reference manuals, user guides and documents providing instruction in the use and operation of various electronic digital devices, sold as a unit therewith the aforesaid goods."

6. On or about February 14, 2013, Registrant filed a combined Declaration of Use and Incontestability under Sections 8 and 15 deleting certain goods from Registration No. 3,360,331 and purporting to declare as to the remaining goods that "the mark has been continuously used in commerce for five (5) consecutive years after the date of registration, or the date of publication under Section 12(c), and is still in use in commerce on or in connection with these goods or services" ("Registrant's Section 8 and 15 Declaration").

7. On or about September 9, 2008, Registrant filed Application Serial No. 77/566,090 for CHROME covering certain services in Class 42 based on its purported *bona fide* intent to use the mark in United States commerce for all services listed in the application. On or about March 1, 2011, Registrant submitted a Statement of Use in support of Application Serial

No. 77/566,090 declaring under oath that it "is using the mark in commerce on or in connection with the goods/services identified [in the application]...." Thereafter, on April 26, 2011, Application Serial No. 77/566,090 matured to registration as Registration No. 3,951,287.

8. Registration No. 3,951,287 covers the following Class 42 services: "Computer services, namely, providing on-line information available on computer networks, global information networks and wireless communication networks in the fields of the design, development and customization of computer hardware, computer software, computer graphics software, information technology, wireless communication devices, multimedia technology, robotics, namely, the design and development of new technology in the field of robotics, business computing and environmentally-friendly computing, and specifically excluding computer games and video games, using both an interactive and non-interactive format; technical support services, namely, troubleshooting of computer hardware and software problems in person, by telephone, by electronic, computer and communications networks; provision of computer systems analysis and computer diagnostic services; design of computer hardware, integrated circuits, computer networks and communications hardware and software for others; consultancy in the field of design, development, configuration, installation, updating, upgrading or maintenance of computer software - excluding computer game and video game software; computer programming for others; research and development of 3d content, 3d technology and processes, 3d animation technology, 3d processing power, 3d techniques, and flexible forward projection; creating, designing and maintaining web sites."

9. The USPTO has issued Office Actions against each of the Google CHROME Applications and has refused registration based on the Subject Registrations.

10. As set forth below, on information and belief, Registrant had not used and was not using the marks in the Subject Registrations in commerce on or in connection with some or all of the goods and services listed in the Subject Registrations when it filed the Statements of Use in support of Application Serial Nos. 77/113,063 and 77/566,090. On information and belief,

Registrant was not using and had not continuously used the mark which is the subject of Registration No. No. 3,360,331 in commerce on or in connection with some or all of the goods listed in Registrant's Section 8 and 15 Declaration when it filed Registrant's Section 8 and 15 Declaration. On information and belief, Registrant has not used the marks in the Subject Registrations in commerce on or in connection with some or all of the goods and services listed in the Subject Registrations.

11. As set forth below, on information and belief, Registrant has abandoned the marks for which the Subject Registrations were issued.

12. Google believes that it is and/or will be damaged by the continued registration of the Subject Registrations.

FIRST CLAIM FOR RELIEF:

**THE MARKS IN THE SUBJECT REGISTRATIONS
HAVE NOT BEEN USED IN U.S. COMMERCE**

13. Google repeats and realleges each and every allegation set forth in Paragraphs 1 through 12 as if fully set forth herein.

14. On information and belief, Registrant was not using the marks in the Subject Registrations in commerce on or in connection with some or all of the goods and services listed in the Subject Registrations when it filed the Statements of Use in support of Application Serial Nos. 77/113,063 and 77/566,090.

15. On information and belief, Registrant was not using and had not continuously used the mark which is the subject of Registration No. 3,360,331 in commerce on or in connection with some or all of the goods listed in Registrant's Section 8 and 15 Declaration when it filed Registrant's Section 8 and 15 Declaration.

16. On information and belief, Registrant has not used the marks in the Subject Registrations in commerce on or in connection with some or all of the goods and services listed in the Subject Registrations.

17. Accordingly, the Subject Registrations should be cancelled.

18. As the Subject Registrations have been cited as a potential block to the registration of the Google CHROME Applications by the USPTO, these registrations are causing damage and injury to Google.

SECOND CLAIM FOR RELIEF:

REGISTRANT HAS ABANDONED THE MARKS IN THE SUBJECT REGISTRATIONS

19. Google repeats and realleges each and every allegation set forth in Paragraphs 1 through 18 as if fully set forth herein.

20. On information and belief, Registrant has abandoned the marks in the Subject Registrations for some or all of the goods and services identified therein.

21. On information and belief, Registrant does not sell some or all of the goods listed in Registration No. 3,360,331 in the United States, and has no intention to sell such goods in the future.

22. On information and belief, Registrant does not render some or all of the services listed in Registration No. 3,951,287 in the United States, and has no intention to render such services in the future.

23. As the Subject Registrations have been cited as a potential block to registration of the Google CHROME Applications by the USPTO, these registrations are causing damage and injury to Google.

WHEREFORE, Google requests that the present Consolidated Petition for Cancellation
be sustained and Registration Nos. 3,360,331 and 3,951,287 be cancelled.

Respectfully submitted,

COOLEY LLP

Date: February 19, 2013

By: /Anne H. Peck/
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Anne H. Peck, Esq.
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Suite 700
Washington, DC 20004
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CERTIFICATE OF SERVICE

I hereby certify that on February 19, 2013, I mailed the foregoing **CONSOLIDATED PETITION FOR CANCELLATION** regarding Google Inc. v. VIA Technologies, Inc. by depositing true and correct copies of the same with the United States Postal Service, postage prepaid, in envelopes addressed to Registrant's attorney of record and Registrant's counsel:

Jonathan Chang
VIA Technologies, Inc.
940 Mission Ct.
Fremont, California 94539-8202

Irene Y. Lee
Russ August & Kabat
12th Floor
12424 Wilshire Boulevard
Los Angeles, California 90025

Date: February 19, 2013


Peggy Bimrose