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Filing date: **11/16/2020**

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

Proceeding	91241866
Party	Defendant Alibaba Group Holding Limited
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Submission	Motion to Suspend for Settlement Discussions
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Date	11/16/2020
Attachments	Consented motion to suspend - 031226-98.pdf(296577 bytes)

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

In the Matter of:

Application Serial Nos. 86/171,229 and 86/171,237

Mark: SESAME and 芝麻 (SESAME in Chinese characters)

Published in the Official Gazette: December 19, 2017 and January 9, 2018

_____)	
Credit Sesame, Inc.)	
)	
Opposer,)	
)	
v.)	Opposition No. 91241866
)	Appln. Serial Nos.: 86/171,229
Advanced New Technologies Co., Ltd.,))	86/171,237
Alibaba Group Holding Limited)	
)	
Applicant.)	
)	

CONSENTED MOTION TO SUSPEND

Applicant, Advanced New Technologies Co., Ltd., and joined co-defendant Alibaba Group Holding Limited (collectively, “Applicant”), upon the written consent of Opposer’s counsel obtained via email on November 5, 2020, hereby moves the Board to suspend the above-captioned proceedings for sixty (60) days. This suspension is requested on the grounds that the

parties are engaged in settlement discussions. As the purpose of this suspension is to facilitate good faith settlement negotiations, this request is not filed for the purpose of improper delay.

Good cause exists. The Parties have informally come to an understanding about broad settlement terms, have exchanged drafts of a final Agreement, and have discussed particular provisions of the drafts. COVID-19 has led to delays in addressing settlement. The Parties believe that they will be able to work toward the final stages of settlement and final terms of the Agreement within the 60-day suspension period. Any further suspensions or extensions requested will be to finalize terms, execute the Agreement, and act on any obligations of the Agreement before concluding the proceedings. In light of the Parties' belief that an agreement can be reached and executed and the matter resolved shortly thereafter, it is in the interest of judicial efficiency to grant the Parties' suspension request.

As required by the Board's September 21, 2020 Board Order requiring the Parties to set forth a progress report, the Parties set forth the following efforts which have been made toward settlement:

(1) all dates on which the Parties communicated, and the method of each communication (e.g. telephone conferences, emails, in-person meetings): The Parties have continuously corresponded via phone, email, and in person dating back to at least March 6, 2018 to work toward resolution of this matter. Among other correspondence via email and phone, Parties' counsel met in person to discuss the matter on May 22, 2019, and continued to correspond via email on July 16 and July 17, 2019 where the Parties discussed proposed settlement terms and confirmed a general alignment between the Parties on the terms, and that a draft written Agreement from Opposer would be forthcoming. On September 26, 2019, Opponent forwarded a draft Agreement, and the Parties corresponded via email throughout the rest of 2019 as the foreign-based Applicant considered the terms and the holidays (both U.S. and

Asian) approached. Applicant forwarded comments and proposed revisions on February 6, 2020, and the Parties' counsel discussed the same over the phone on February 10, 2020. The parties continued to correspond in February to address extensions and progress reports needed and then again in April when the Opponent forwarded proposed revisions to the Agreement and comments on the same on April 7, 2020, and corresponded on June 15, 16, and 17, 2020 regarding COVID-related delays and consent suspensions. The parties' counsel most recently had a substantive phone call on October 2, 2020 to discuss certain terms in the current draft of the Agreement. In view of the COVID-19 pandemic and the Hong Kong location of Applicant's core personnel related to this matter, Applicant has needed additional time to consider terms of the draft Agreement.

(2) **the general nature of each communication:** As discussed above, the Parties have discussed intended amicable resolution of the matter, the nature of each Party's goods and services and use of the respective marks, settlement terms, alignment on particular terms, and now continue to negotiate specific provisions of an Agreement.

(3) **the issues that have been resolved:** The Parties have informally agreed upon general settlement terms, the intricacies and wording of which are still being worked through in the current draft Agreement. The Parties continue to remain optimistic that the dispute can be resolved without further Board proceedings;

(4) **the issues that remain to be resolved or that remain for trial:** The Parties are still working through settlement terms, but expect that the matter will be able to be resolved via terms outside of Board proceedings; and

(5) **a proposed timetable for resolution of the remaining issues:** The Parties hope that the settlement terms should be resolved within the requested 60-day suspension period, with

possible further delays in view of the pandemic. Any further suspensions or extensions requested would be to finalize all terms and act on any obligations of the ultimate Agreement before concluding the proceedings.

Opposer has specifically consented to the suspension requested herein. In light of the expected settlement, the requested suspension will allow the Parties the opportunity to conclude this matter without further proceedings.

In the event that this Motion is not granted, Applicant respectfully requests additional time to file its Answer.

Dated: November 16, 2020

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on November 16, 2020 I caused to be served via electronic mail a true and correct copy of the foregoing Consented Motion to Suspend, upon the following:

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