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 18 MOBILITY HOLDINGS, INC.

19 **UNITED STATES DISTRICT COURT**
 20 **FOR THE NORTHERN DISTRICT OF CALIFORNIA**
 21 **SAN FRANCISCO DIVISION**

22 XOOM CORPORATION, a California corporation,
 23 Plaintiff,
 24 vs.
 25 MOTOROLA TRADEMARK HOLDINGS, LLC, a
 Delaware limited liability company, MOTOROLA
 26 MOBILITY, INC., a Delaware corporation,
 MOTOROLA MOBILITY HOLDINGS, INC., a
 27 Delaware corporation, and DOES 1 through 10,
 28 Defendants.

§ Case No: 11-CV-00848 CRB
 §
 § **JOINT CASE MANAGEMENT**
 § **CONFERENCE STATEMENT**
 § **(N.D. Cal. Civil L.R. 16-9)**
 §
 § **DATE: December 16, 2011**
 § **TIME: 8:30 a.m.**
 § **LOCATION: Courtroom 8, 19th Floor**
 §

1 Pursuant to Civil L.R. 16-9, the Court’s Standing Order regarding case management
2 conferences, as well as the Court’s April 26, 2011 Order (Dkt. No. 10) and the Court’s November
3 15, 2011 Order (Dkt. No. 34) setting the case management conference, Plaintiff, Xoom Corporation
4 (hereinafter, “Xoom” or “Plaintiff”) and Defendants, Motorola Trademark Holdings, LLC,
5 Motorola Mobility, Inc. and Motorola Mobility Holdings, Inc. (collectively, “Motorola” or
6 “Defendants”), jointly file this Case Management Conference Statement.

7 1. Jurisdiction and Service: Xoom’s claims arise under the Lanham Act, 15 U.S.C. §§ 1114(1)
8 and 1125(a)(1), for trademark infringement and unfair competition, as well as California statutory
9 and common law. This Court has subject matter jurisdiction over Xoom’s claims pursuant to 15
10 U.S.C. §1121 and 28 U.S.C. §§1331, 1338, and 1367(a). Venue is proper in this court under 28
11 U.S.C. §§ 1391(b) and 1400(b). Xoom timely served Motorola with the Complaint on October 28,
12 2011. Motorola timely answered Xoom’s Complaint on November 18, 2011 and did not contest
13 jurisdiction, venue or service.

14 2. Facts:

15 (a) Xoom’s Factual Allegations:

16 Xoom is the owner of an incontestable, federal trademark registration for the XOOM® mark:
17 U.S. Trademark Registration No. 2909931 for XOOM® issued December 14, 2004 covering
18 “providing business information, namely, on money transfer services,” and “money transfer services;
19 electronic funds transfer services; bill payment remittance services; electronic payment, namely,
20 electronic processing and transmission of bill payment data.” Xoom also owns a registration for
21 XOOM, U.S. Trademark Registration No. 4012377, which registered on August 16, 2011 for
22 “providing a web site featuring temporary use of non-downloadable software for providing
23 information on money transfers, and for facilitating money transfers, electronic funds transfers, bill
24 payment remittances and electronic processing and transmission of bill payment data.” Xoom also
25 owns an allowed application, Serial No. 85/225,008, for XOOM for “computer software for
26 facilitating money transfer services, electronic funds transfer services, bill payment remittance
27 services, electronic processing and transmission of payments and payment data.” No other XOOM
28 mark is federally registered for Internet services or mobile services or devices.

1 Xoom has used its XOOM® mark and its Xoom trade name in commerce since at least as
2 early as 2003 in connection with its remittance services, which allow users to transmit monies
3 through the company’s xoom.com website to more than 30 different countries, as well as its
4 provision of online access to XOOM® product offerings. Xoom’s XOOM® remittance services are
5 accessible via computers and mobile devices and are available in special formats for users of mobile
6 devices such as cellular phones and mobile computers, including Motorola’s mobile devices and
7 tablet computers. For example, an image of the screen of a mobile phone accessing Xoom’s
8 XOOM® remittance services is set forth below:



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16 Xoom contends that Motorola has used a similar depiction of its product on its website (see
17 Complaint ¶ 18).

18 Xoom asserts that, in an effort to exploit and improperly trade on Xoom’s goodwill, to
19 otherwise diminish the value of the Xoom trade name and the federally registered, incontestable
20 XOOM® mark, and to confuse and mislead consumers, Motorola, without authorization
21 intentionally and unlawfully appropriated Xoom’s trade name and trademark rights through: (1) its
22 adoption and use of XOOM designations to promote a mobile computer and related products and
23 services; (2) its purchase of the XOOM keyword on online search engines; (3) its Internet
24 advertisements that Motorola’s site is the Xoom “Official Site”; and (4) its filing of applications to
25 register the XOOM and MOTOROLA XOOM designations for mobile computers and related
26 accessories (U.S. App. Nos. 85161358 and 85257238, respectively).

27 (b) Motorola’s Factual Allegations:

28 Motorola is a leader in the design and manufacture of a variety of communication inventions

1 and innovations around the world, including, without limitation, mobile phones and mobile devices.
2 The “MOTOROLA” brand is widely known and famous for its consumer mobile technologies.

3 In early 2011, Motorola began marketing and selling its MOTOROLA XOOM tablet
4 computer. The MOTOROLA XOOM is a touch screen tablet computer, which is a wireless,
5 portable personal computer with a touch screen interface. Tablet computers are typically smaller
6 than a notebook or laptop computer, but larger than a smart phone. The MOTOROLA XOOM is
7 similar to other tablet computers that have been marketed by some of Motorola’s competitors,
8 including Apple (iPad), HP (TouchPad), Samsung (Galaxy Tab), and Blackberry (Playbook).
9 Motorola’s MOTOROLA XOOM tablet computer is entirely different from the money transfer
10 services that Plaintiff provides under its XOOM mark. Indeed, Motorola does not offer any services
11 under the MOTOROLA XOOM mark, and certainly does not offer any services similar to Plaintiff’s
12 money transfer services. Similarly, upon information and belief, Plaintiff does not offer any goods
13 or products under its XOOM mark.

14 The term “Xoom” and phonetic equivalents thereof are highly-diluted because such terms
15 have been used for many years by many third-parties. As such, any rights owned by Plaintiff are
16 extremely weak and too narrow to stop Motorola’s complained of use in this case. Additionally,
17 Motorola does not use or advertise its MOTOROLA XOOM product without its famous house mark,
18 MOTOROLA, which diminishes the likelihood of consumer confusion. In fact, Motorola’s
19 MOTOROLA mark is prominently displayed on the tablet computer itself, on all of the packaging
20 for the MOTOROLA XOOM, and in all advertisements and marketing materials. Furthermore, the
21 MOTOROLA XOOM tablet computer is relatively expensive, having launched at around \$599 to
22 \$799, depending on whether a consumer also purchases a monthly wireless data plan, and consumers
23 are likely to be aware of the source of such an expensive product. Finally, Motorola had no intent to
24 trade on Plaintiff’s alleged “goodwill,” and it is not credible or logical to assume that Motorola
25 named its MOTOROLA XOOM tablet computer in order to intentionally confuse consumers into
26 thinking that Motorola’s product is in some way sponsored by, or associated or connected with
27 Plaintiff or Plaintiff’s money transfer services.

28 Motorola is not aware of any instances in which a consumer has confused Plaintiff’s XOOM

1 on-line money transfer services with Motorola's MOTOROLA XOOM tablet computer, and all of
2 the factors used in determining "likelihood of confusion" in this Circuit favor Motorola.
3 Additionally, absent evidence of consumer confusion sufficient to unjustly enrich Motorola, and
4 absent any bad faith on Motorola's behalf to trade on Plaintiff's mark, Plaintiff is not entitled to
5 damages even if liability exists, which it does not. Motorola believes that Plaintiff's claims are
6 meritless, and Motorola intends to seek its attorneys' fees and costs as the prevailing party pursuant
7 to 15 U.S.C. § 1117.

8 3. Legal Issues:

9 Xoom's Complaint asserts claims for federal trademark infringement (15 U.S.C. §1114(1))
10 and unfair competition (15 U.S.C. §1125(a)(1)), as well as state unfair business practices (Cal. Bus.
11 & Prof. Code §§17200 *et seq.*), trademark infringement (Cal. Bus. & Prof. Code §14335), and
12 common law unfair competition.

13 In Motorola's answer, Motorola denies all liability and asserts the following affirmative
14 defenses: Plaintiff's Complaint fails to state a claim; any rights owned by Plaintiff are extremely
15 weak and too narrow to stop Motorola's complained of use in this case; Motorola always uses its
16 famous house mark MOTOROLA to promote and advertise Motorola's products and, therefore,
17 there is no likelihood that consumers would be confused; Plaintiff's claims are barred under the
18 equitable doctrine of laches, estoppel, waiver and acquiescence; and Plaintiff's claims are barred by
19 unclean hands. Xoom contends that Motorola's affirmative defenses are invalid as a matter of law.

20 The principal legal issues in this case appear to be:

- 21 • Whether, as Xoom alleges, Motorola infringed Xoom's incontestable, federally
22 registered XOOM® mark and Xoom's common law rights in its XOOM trade name;
- 23 • Whether, as Xoom alleges, the mark XOOM and/or MOTOROLA XOOM is likely
24 to cause confusion under the Ninth Circuit's *Sleekcraft* test for likelihood of confusion;
- 25 • Whether, as Motorola alleges, Motorola's use of its famous house mark
26 MOTOROLA with the word XOOM diminishes the likelihood of consumer confusion, or whether,
27 as Xoom alleges, it adds to the likelihood of confusion under this Circuit's case law;
- 28 • Whether, as Motorola alleges, Plaintiff's XOOM mark is weak and too narrow to

1 stop Motorola’s complained of use in this case, or whether, as Xoom alleges, the federally
2 registered XOOM® mark and trade name are protectable and not weak for the goods and services at
3 issue;

4 • Whether, as Motorola alleges, Plaintiff’s claims are barred by unclean hands based
5 on Plaintiff’s conduct of applying for an intent-to-use trademark application for XOOM for the sole
6 purpose of interfering with Motorola, without a bona fide intent to use the mark for goods;

7 • Whether, as Motorola alleges, Plaintiff’s claims are barred by unclean hands for its
8 false claims that it offers “products” under the XOOM mark, even though it offers no products, but
9 only money transfer services;

10 • Whether, as Xoom alleges, Motorola intentionally infringed Xoom’s XOOM® mark
11 and trade name;

12 • Whether Motorola’s affirmative defenses are valid or invalid as a matter of law;

13 • Whether, as Xoom alleges, Xoom is entitled to injunctive relief;

14 • Whether, as Xoom alleges, Xoom is entitled to its actual damages and/or Motorola’s
15 profits; and

16 • Whether, as Motorola alleges, Motorola is entitled to its attorneys’ fees and costs
17 under 15 U.S.C. § 1117.

18 4. Motions: The parties have filed four consented motions to extend the service deadline and
19 related deadlines in this proceeding and the parties have each filed ex parte motions for extension of
20 the case management conference date and related deadlines, all of which were granted by the Court.
21 Depending on the results of discovery, each party may file a motion for summary judgment or
22 partial summary judgment.

23 5. Amendment of Pleadings: The parties do not presently expect to add additional parties or
24 amend the pleadings based on currently available information.

25 6. Evidence Preservation: Both parties represent that they have taken appropriate measures to
26 preserve documents relevant to the claims and counterclaims in this action and to preserve all
27 electronic evidence relating thereto.

28

1 7. Disclosures: The parties expect to exchange initial disclosures pursuant to Fed. R. Civ. P.
2 26(a) on or before December 21, 2011.

3 8. Discovery: No discovery has yet been taken. The parties anticipate discovery on Xoom's
4 causes of action for trademark infringement and unfair competition, and Motorola's affirmative
5 defenses. The parties propose that the discovery rules in the Federal Rules of Civil Procedure
6 remain unmodified.

7 The Parties propose the following discovery plan pursuant to Fed. R. Civ. P 26(f)(3):

8 (A) Rule 26(a) disclosures: The parties will serve initial disclosures by December 21,
9 2011.

10 (B) Discovery is expected to cover the factual and legal issues identified above. The
11 parties' proposed discovery schedule is set forth below.

12 (C) Production of ESI: The parties will participate in full discovery, working together
13 to avoid the complications and costs of e-discovery given the nature of the claims and affirmative
14 defenses.

15 (D) Privilege and trial-preparation material: The parties are working together to propose
16 a protective order based on the Model Stipulated Protective Order that will provide for designation
17 of confidential and highly confidential documents, and post-production assertion of privilege or of
18 production as trial-preparation material. The parties will also exchange privilege logs in accordance
19 with Rule 26(b)(5); the parties agree that privileged communications and/or work product relating
20 to this case and created after Plaintiff's initiation of this case need not be logged.

21 (E) Limits on Discovery: The parties propose that the discovery rules in the Federal
22 Rules of Civil Procedure remain unmodified. Specifically, each party is limited to not more than 25
23 interrogatories per party (including subparts); unlimited sets of requests for admission per party;
24 unlimited sets of requests for production per party; 10 depositions per party of not more than 7
25 hours each. Xoom believes the term "parties" should be construed to mean Xoom on the one hand
26 and the Motorola parties collectively, on the other hand, such that the collective Motorola parties
27 should be limited to no more than 25 interrogatories and 10 depositions.

28 9. Class Actions: This matter is not a class action.

1 10. Related Cases: Xoom has filed two trademark opposition proceedings against Motorola in
2 the Trademark Trial and Appeal Board (“TTAB”) for Motorola’s trademark applications for
3 XOOM and MOTOROLA XOOM. Motorola has filed a motion in the TTAB to stay the TTAB
4 proceedings pending outcome of this case.

5 11. Relief:

6 (a) Relief Sought By Xoom:

7 Xoom seeks actual damages, Motorola’s profits attributable to the infringement and
8 injunctive relief. Xoom further seeks an order ordering that all labels, packaging, wrappers, signs,
9 prints, banners, posters, brochures, or other advertising, marketing, or other promotional materials
10 bearing a confusingly similar designation to Xoom’s XOOM® mark or name, be disabled, removed
11 and destroyed, along with the means for making the same, and that all Internet websites, online
12 advertising, marketing, promotions or other online materials bearing the XOOM designation in any
13 form or manner by Motorola be disabled, removed and destroyed. Xoom also seeks an order
14 declaring Motorola’s unauthorized use of XOOM and MOTOROLA XOOM in connection with
15 mobile computers and related products and services infringes Xoom’s XOOM® mark and name
16 and that Motorola has engaged in false advertising by buying the keyword “Xoom,” claiming it
17 owns the Xoom Official Site and otherwise misrepresenting Motorola’s and Xoom’s offerings and
18 declaring Motorola’s infringement, unfair competition, and false advertising was knowing,
19 intentional, and willful. To the extent Motorola’s conduct is found to be intentional, Xoom seeks
20 treble damages, punitive and exemplary damages, costs and attorneys’ fees and any other relief the
21 Court deems just and proper. Xoom is unable to identify its complete financial loss at this time, as
22 such damage is in an amount that is ongoing, increasing, and is yet to be fully ascertained. Nor can
23 Xoom determine the value of Motorola’s profits from its infringing activity without discovery.

24 (b) Relief Sought By Motorola:

25 Motorola seeks dismissal of all claims against Motorola, for judgment in Motorola’s favor,
26 and for an award of attorneys’ fees as the prevailing party pursuant to 15 U.S.C. § 1117.

1 12. Settlement and ADR: The parties have had settlement discussions, but no resolution has
2 been reached. The parties agree that mediation in front of a magistrate judge or by a mediator from
3 the Court's mediation panel is the appropriate ADR process in the case.

4 13. Consent to Magistrate Judge For All Purposes: The parties do not consent to have a
5 magistrate judge conduct all further proceedings including trial and entry of judgment.

6 14. Other References: The parties do not believe this case is suitable for reference to binding
7 arbitration, a special master, or the Judicial Panel on Multidistrict Litigation.

8 15. Narrowing of Issues: The parties will attempt to narrow issues by agreement or by motion
9 as they arise.

10 16. Expedited Schedule: This is not the type of case that can be handled on an expedited basis
11 with streamlined procedures.

12 17. Scheduling: The parties agree on, and therefore propose to the Court, the following schedule
13 for the case:

- 14 • Deadline for joinder and amendment of pleadings – January 15, 2012
- 15 • Deadline for completion of factual discovery – July 1, 2012
- 16 • Deadline for expert reports – July 31, 2012
- 17 • Deadline for rebuttal reports – September 4, 2012
- 18 • Deadline for completion of expert discovery – October 4, 2012
- 19 • Deadline for filing dispositive motions – October 29, 2011
- 20 • Pretrial conference and trial – to be set by Court after consideration of dispositive motions

21 18. Trial: Xoom has made a demand for trial by jury. At this juncture, the parties believe the
22 trial should last six (6) days.

23 19. Disclosure of Non-party Interested Entities or Persons: Both parties have filed a
24 Certification of Interested Entities or Persons.

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28 //

1 20. There are no other matters that may facilitate the just, speedy, and inexpensive disposition
2 of this matter.

3 Dated: December 9, 2011

4 /s/ Rochelle D. Alpert

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