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Filing date: **06/10/2011**

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

Proceeding	91199897
Party	Plaintiff Samsung Electronics, Ltd.
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Submission	Motion to Suspend for Civil Action
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Signature	/s/Michael T. Zeller/jsp
Date	06/10/2011
Attachments	Motion to Stay.pdf ( 4 pages )(21574 bytes ) Zeller Dec.PDF ( 2 pages )(36093 bytes ) Exhibit A Zeller Declaration.PDF ( 39 pages )(3095513 bytes )

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

In re Application Serial No.: 85041463



Filed: May 18, 2010  
Date Published: April 19, 2011

SAMSUNG ELECTRONICS CO., LTD.,

Plaintiff,

APPLE INC. ,

Defendant.

Opposition No. 91199897

**OPPOSER'S MOTION TO STAY**

Opposer, SAMSUNG ELECTRONICS CO., LTD. ("Opposer" or "Samsung"), by its counsel, respectfully moves the Board to stay the instant proceedings pending the resolution of issues raised by Applicant Apple Inc. ("Applicant" or "Apple") that are also currently before the United States District Court for the Northern District of California.

In support of its Motion, Opposer states as follows. In these proceedings, Samsung opposes the registration of a putative design mark that is depicted on the above caption page and that Applicant describes as "a rectangle with rounded corners depicting a stylized musical note in a white circle on a purple background" ("Applicant's Claimed Mark"). Applicant seeks registration for "[c]omputer software for use in searching, browsing, reviewing, sampling, playing, purchasing, and downloading pre-recorded audio and video content."

Opposer and Applicant are parties to litigation in the United States District Court for the Northern District of California. This includes a suit styled as Apple Inc. v. Samsung Electronics Co., Ltd., et al., Case No. 11-1846, filed on April 15, 2011 (the "Civil Action").<sup>1</sup> Because issues raised by the Opposition are also the subject of the Civil Action between the parties, the Board should stay the present opposition proceedings until their resolution by the Courts.

More specifically, in the Civil Action Applicant asserts infringement of a purported mark called "the Purple iTunes Store Trademark." That purported mark is precisely the same as the Applicant's Claimed Mark that is at issue in these opposition proceedings. For example, in paragraph 52 of the Complaint in the Civil Action, Applicant alleges:

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<sup>1</sup> A copy of the Complaint in the action is attached as Exhibit A to the Declaration of Michael T. Zeller ("Zeller Dec."), submitted herewith.

To represent the iTunes application, Apple uses an icon that is purple in color with a white circular band and a silhouette of two eighth-notes superimposed on the white circular band:



Pending U.S. Application Serial No. 85/041,463 covers this icon (the "Purple iTunes Store Trademark"). Attached hereto as Exhibit 20 is a true and correct copy of the TARR status report for U.S. Application Serial No. 85/041,463.<sup>2</sup>

Applicant's Complaint goes on to accuse Samsung of infringing this alleged mark<sup>3</sup> and expressly asks for injunctive relief based on the claimed "Purple iTunes Store Trademark."<sup>4</sup>

Because the Applicant's Claimed Mark in this proceeding and the purported mark in the Civil Action are identical, the issues currently pending before the District Court may — and almost certainly will — have an effect on issues raised in the Opposition.<sup>5</sup> The instant proceedings therefore should be stayed pending resolution of the Civil Action. The Board's usual practice of staying its proceedings pending the outcome of a civil action that may have a bearing on the issues before the Board, as is the situation here, is codified at 37 C.F.R. § 2.117(a):

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<sup>2</sup> Zeller Dec., Exh. A at ¶ 52 (page 16).

<sup>3</sup> Id. at ¶¶ 66, 111-12, 115 & 117-19 (pages 22 & 30-31). In addition to asserting a federal trademark infringement claim, the Complaint alleges that Opposer has engaged in unfair competition under California and federal law for purportedly using "the Purple iTunes Store Trademark." Id. at ¶¶ 123 & 127-29 (pages 32-33).

<sup>4</sup> Id. at Prayer for Relief ¶ 5 (pages 36-37).

<sup>5</sup> The defenses in the Civil Action and the grounds raised in the Opposition here also will overlap. Opposer's Answer in the Civil Action is due on July 5, 2011 and therefore has not yet been filed. When it is filed, Opposer anticipates asserting all of the same grounds against the claimed "Purple iTunes Store Trademark" as those alleged in the Opposition. Zeller Dec. at ¶ 3.

Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or other Board proceeding.

See Trademark Trial and Appeal Board Manual of Procedure § 510.02(a) (“[o]rdinarily, the Board will suspend proceedings in the case before it if the final determination of the other proceeding will have a bearing on the issues before the Board.”). See also The Other Telephone Co. v. Connecticut Nat’l Tel. Co., 181 U.S.P.Q. 779, 781-82 (Comm’r of Patents 1974), petition denied, 181 U.S.P.Q. 779; Townley Clothes, Inc. v. Goldring, Inc., 100 U.S.P.Q. 57, 58 (Comm’r of Patents 1953) (“[I]t is deemed the sounder practice to suspend the [Trademark] Office proceedings pending termination of the Court action.”).

The most logical and efficient course is to suspend these proceedings until the Courts resolve the issues that also are raised here. Samsung respectfully requests that its motion be granted and that the opposition proceedings be suspended pending the completion of the relevant proceedings before the District Court.

DATED: June 9, 2011.

Respectfully submitted,

QUINN EMANUEL URQUHART &  
SULLIVAN, LLP

By: /s/Michael T. Zeller

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