

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

Mailed: December 27, 2011

Opposition No. 91202009

Xoom Corporation

v.

Motorola Trademark Holdings, LLC

**Robert H. Coggins,  
Interlocutory Attorney:**

This case comes up on applicant's motion (filed November 14, 2011) to suspend proceedings pending disposition of a civil action between the parties, and opposer's motion (filed December 8, 2011) to strike applicant's affirmative defenses.

On December 22, 2011, at approximately 12:00 p.m. EST, the Board exercised its discretion to conduct a telephone conference to determine the outstanding motions. Participating in the conference were Leigha Weinberg, counsel for opposer; Cathay Smith, and Kristin Achterhof, counsel for applicant; and the above-signed Board attorney responsible for resolving interlocutory matters in this

case.<sup>1</sup> During the conference opposer was given the opportunity to provide an oral reply brief in support of the motion to strike.

The Board presumes familiarity with the issues, and for the sake of efficiency this order does not summarize the parties' arguments raised in the motions, briefs, or during the telephone conference. Instead, this order summarizes the decisions of the Board.

Motion to Suspend

The motion to suspend proceedings pending final disposition of the civil action between the parties was granted.<sup>2</sup> It is the policy of the Board to suspend proceedings when the parties are involved in a civil action which may be dispositive of or have a bearing on the Board case. See Trademark Rule 2.117(a).

Motion to Strike

The motion to strike was denied as to applicant's first affirmative defense. The Board noted that this defense was not construed as a motion to dismiss under Fed. R. Civ. P. 12(b)(6), as no motion to dismiss was filed by applicant and applicant did not brief this defense as such. The Board

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<sup>1</sup> The Board appreciates applicant's help in initiating the conference call to overcome a technical issue with the Board's telephone.

<sup>2</sup> Civil Action No. 11-CV-00848-CRB, styled *Xoom Corp. v. Motorola Trademark Holdings, LLC, et al.*, filed in the United States District Court for the Northern District of California.

stated that inasmuch as standing and a valid ground for opposing registration of the involved mark must be proved at trial by opposer, opposer will not be prejudiced by the inclusion of this defense in the answer.

The motion to strike was granted as to applicant's second affirmative defense. Applicant provided no allegations to support this defense. However, applicant will be allowed time in which to properly replead the second affirmative defense upon resumption of this proceeding, if appropriate.

The motion to strike was denied as to applicant's third affirmative defense. Matter will not be stricken unless it clearly has no bearing upon the issues of the case, and this defense gives fair notice to opposer as to one of the ways in which applicant will defend against the opposition. See TBMP § 506.01 (3d ed. 2011).

#### Suspension

Proceedings were suspended pending disposition of the civil action.

Within thirty days after the final determination of the civil action, the parties shall so notify the Board so that this case may be called up for appropriate action (including, if appropriate, allowing applicant time in which to file a first amended answer that properly pleads an affirmative defense of unclean hands).

During the suspension period, the parties shall notify the Board of any address changes for the parties or their attorneys. Should any new and related cases within the meaning of Fed. R. Civ. P. 42 be filed with the Board or any court, the parties are instructed to promptly inform the Board thereof.<sup>3</sup>

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<sup>3</sup> As discussed in the conference, the Board is aware of Opposition No. 91202575; however, inasmuch as the Board has suspended proceedings for Opposition No. 91202009, Opposition No. 91202575 was previously suspended for the same civil action, no answer has been filed in Opposition No. 91202575, and the answer is not yet settled in Opposition No. 91202575, the Board did not consolidate Opposition Nos. 91202009 and 91202575. The Board may revisit the issue of consolidation once proceedings are resumed and the answers are filed and settled.