

ESTTA Tracking number: **ESTTA572118**

Filing date: **11/20/2013**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Spec Research, Inc.
Granted to Date of previous extension	11/20/2013
Address	19433 San Jose Avenue City of industry, CA 91748 UNITED STATES

Attorney information	Thomas T. Chan Fox Rothschild LLP 1055 West 7th Street, Suite 1880 Los Angeles, CA 90017 UNITED STATES tchan@foxrothschild.com, ipdocket@foxrothschild.com, twang@foxrothschild.com Phone:213 624 6560
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Applicant Information

Application No	85442829	Publication date	07/23/2013
Opposition Filing Date	11/20/2013	Opposition Period Ends	11/20/2013
Applicant	Applied Micro Circuits Corporation 215 Moffett Park Drive Sunnyvale, CA 94089 GERMANY		

Goods/Services Affected by Opposition

<p>Class 009. First Use: 2013/01/15 First Use In Commerce: 2013/01/15 All goods and services in the class are opposed, namely: microprocessors, systems on a chip (SoCs), semiconductors and integrated circuits, computer software and firmware for implementation in telecommunications equipment, data centers, networking equipment, data processing equipment, servers, enterprise equipment, and small and medium size businesses (SMBs); and user manuals and data books for use and sold therewith</p>
<p>Class 042. First Use: 2013/01/15 First Use In Commerce: 2013/01/15 All goods and services in the class are opposed, namely: design, development, and integration services in the field of microprocessors, semiconductors, integrated circuits, systems on a chip (SoCs), and circuit boards, including related computer software and firmware; maintenance services in the field of computer software; technical support services, namely, troubleshooting of computer software and help desk services</p>

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	3173778	Application Date	12/06/2005
Registration Date	11/21/2006	Foreign Priority Date	NONE
Word Mark	XGENE		
Design Mark			
Description of Mark	The mark consists of the letter "x" with the word "Gene".		
Goods/Services	Class 009. First use: First Use: 2005/11/01 First Use In Commerce: 2005/11/01 Computer cursor control devices, namely, computer mouse		

Attachments	78767817#TMSN.jpeg(bytes) Notice of Opposition.PDF(748049 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	/Tina Wang/
Name	Tina Wang
Date	11/20/2013

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

In the Matter of Trademark Application Serial No. 85/442,829
Filed on October 8, 2011
For the mark X-GENE
Published in the *Official Gazette* on July 23, 2013

SPEC RESEARCH, INC.,)	
)	
Opposer,)	
)	
v.)	Opposition No.
)	
APPLIED MICRO CIRCUITS CORP.)	
A/K/A APM,)	
)	
Applicant.)	
)	

NOTICE OF OPPOSITION

SPEC RESEARCH, INC. (“Opposer”), a California Corporation having its business address at 19433 San Jose Avenue, City of Industry, California 91748, believes it will be damaged by APPLIED MICRO CIRCUITS CORP. A/K/A APM’S (“Applicant”) application for trademark registration of the mark X-GENE (“Applicant’s Mark”), shown in Trademark Application Serial No. 85/442,829, and opposes same.

As grounds of opposition, it is alleged that:

The Opposed Application For The Mark: X-GENE

1. Applicant has requested registration of the X-GENE mark for “microprocessors, systems on a chip (SoCs), semiconductors and integrated circuits, computer software and firmware for implementation in telecommunications equipment, data centers, networking equipment, data processing equipment, servers, enterprise equipment, and small and medium

size businesses (SMBs); and user manuals and data books for use and sold therewith,” in International Class 009; and “design, development, and integration services in the field of microprocessors, semiconductors, integrated circuits, systems on a chip (SoCs), and circuit boards, including related computer software and firmware; maintenance services in the field of computer software; technical support services, namely, troubleshooting of computer software and help desk services,” in International Class 042. Applicant’s application was filed on October 8, 2011 under Section 1(a) and was published in the *Official Gazette* on July 23, 2013.

Opposer’s Prior Use Of The Mark: XGENE [and Design]

2. Opposer previously owned a registration for the mark XGENE [and Design] (Reg. No. 3,173,778) for “Computer cursor control devices, namely, computer mouse,” in International Class 009. This application was filed December 6, 2005 based on use in commerce since at least as early as November 1, 2005, and later matured to registration on November 21, 2006. This registration was inadvertently canceled on June 28, 2013 when, unbeknownst to Opposer, Opposer’s prior counsel failed to file the requisite Section 8 declaration in order to maintain the registration. A printout of the status information for this previous registration setting forth Opposer’s first use date, downloaded from the United States Patent and Trademark Office TSDR system, is attached hereto as **Exhibit A**.

3. Notwithstanding the cancelation of the XGENE [and Design] registration, Opposer, at all times since November 1, 2005, exclusively and continuously used the XGENE [and Design] mark (“Opposer’s Mark) in commerce in connection with computer cursor control devices, namely, computer mice. Accordingly, regardless of its canceled registration, Opposer owns common law rights in the XGENE [and Design] mark, which dates back prior to any date on which the Applicant can rely.

Opposer will be Harmed by Registration of the Opposed X-GENE Mark

4. Opposer's Mark is symbolic of the valuable good will and consumer recognition built up by Opposer through time and effort in advertising and promotion.
5. Based on Opposer's earlier first use date of the XGENE [and Design] mark of November 1, 2005, Opposer has superior rights to Applicant's X-GENE mark having a later first use date of January 15, 2013.
6. Opposer has developed extensive goodwill with respect to Opposer's Mark.
7. Opposer has spent substantial sums and effort in the advertisement and promotion of the goods and/or services sold in connection with Opposer's Mark.
8. As a result of the advertisement and promotion of its mark, along with the high quality of the goods and/or services sold in connection with its mark, Opposer has acquired a valuable reputation and goodwill in Opposer's Mark.
9. Applicant's Mark is confusingly similar to Opposer's Mark and is applied to goods and/or services that are the same or similar to those sold by Opposer.
10. Prospective purchasers and the trade are likely to consider the goods and/or services of Applicant sold under the mark X-GENE as emanating from Opposer, and purchase such goods and/or services as those of the Opposer, resulting in loss of sales to Opposer.
11. Concurrent use of the mark by Applicant and Opposer is likely to result in irreparable damage to Opposer's reputation and goodwill if the goods and/or services sold by Applicant are inferior, since purchasers are likely to attribute the source of Applicant's goods and/or services to Opposer.
12. Opposer has been and will continue to be damaged by the registration and use of the X-GENE mark identified in Trademark Application Serial No. 85/442,829 since confusion in

the trade is likely to result from any concurrent use of Opposer's Mark and that of Applicant, all to the great detriment of Opposer.

13. If Applicant were granted the registration of the opposed application for the X-GENE mark, it would obtain at least a *prima facie* exclusive right to the use of Applicant's Mark. Such registration would be a source of damage and injury to Opposer.

WHEREFORE, Opposer prays for an Order sustaining the Opposition and refusing registration of Trademark Application Serial No. 85/442,829.

Opposer hereby appoints Thomas T. Chan, Lena Bacani, and Lisa A. Karczewski (Reg. No. 53,096), attorneys of FOX ROTHSCHILD LLP, with offices at 1055 W. 7th Street, Suite 1880, Los Angeles, CA 90017, as its attorneys in this opposition proceeding, and being authorized to transact all business before the Trademark Trial and Appeal Board of the United States Patent and Trademark Office in connection with this Opposition Proceeding.

Respectfully submitted,

FOX ROTHSCHILD LLP

Dated: November 20, 2013

By:



Thomas T. Chan
Lisa A. Karczewski
Attorneys for Opposer
SPEC RESEARCH, INC.

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CERTIFICATE OF SERVICE

I hereby certify that on November 20, 2013, I served a true copy of the foregoing **NOTICE OF OPPOSITION** upon Applicant's Attorney of Record via U.S. First Class mail, addressed as follows:

Raj Jaipershad
Applied Micro Circuits Corporation
215 Moffett Park Drive
Sunnyvale, California 94089



Tina Wang

EXHIBIT A

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Mark: XGENE



US Serial Number: 78767817 Application Filing Date: Dec. 06, 2005
US Registration Number: 3173778 Registration Date: Nov. 21, 2006
Filed as TEAS Plus: Yes Currently TEAS Plus: Yes
Register: Principal
Mark Type: Trademark
Status: Registration cancelled because registrant did not file an acceptable declaration under Section 8. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.
Status Date: Jun. 28, 2013
Publication Date: Sep. 05, 2006
Date Cancelled: Jun. 28, 2013

Mark Information

Mark Literal Elements: XGENE
Standard Character Claim: No
Mark Drawing Type: 3 - AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)/NUMBER(S)
Description of Mark: The mark consists of the letter "x" with the word "Gene".
Color Drawing: Yes
Color(s) Claimed: The color blue is claimed as a feature of the mark.
Color Location: The mark is blue and appears on a transparent background.
Design Search Code(s): 26.01.11 - Circles comprised of animals; Circles comprised of geometric figures; Circles comprised of humans; Letters, numerals, punctuation, geometric figures, objects, humans, plants or animals comprising a circle; Circles comprised of plants; Circles comprised of punctuation; Circles comprised of letters or numerals

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of
- Asterisks "*" identify additional (new) wording in the goods/services.

For: Computer cursor control devices, namely, computer mouse

International Class(es): 009 - Primary Class

U.S Class(es): 021, 023, 026, 036, 038

Class Status: SECTION 8 - CANCELLED

Basis: 1(a)

First Use: Nov. 01, 2005

Use in Commerce: Nov. 01, 2005

Basis Information (Case Level)

Filed Use: Yes	Currently Use: Yes	Amended Use: No
Filed ITU: No	Currently ITU: No	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: No	Currently 44E: No	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

Current Owner(s) Information

Owner Name: Spec Research, Inc.
Owner Address: 19433 San Jose Ave.
City of Industry, CALIFORNIA 91748
UNITED STATES
Legal Entity Type: CORPORATION State or Country Where: CALIFORNIA

Organized:

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Domino Wang
Attorney Primary Email: dominowang@aol.com
Address:

Attorney Email Yes
Authorized:

Correspondent

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Authorized:

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Jun. 28, 2013	CANCELLED SEC. 8 (6-YR)	
Nov. 21, 2006	REGISTERED-PRINCIPAL REGISTER	
Sep. 05, 2006	PUBLISHED FOR OPPOSITION	
Aug. 16, 2006	NOTICE OF PUBLICATION	
Jul. 11, 2006	LAW OFFICE PUBLICATION REVIEW COMPLETED	77975
Jul. 06, 2006	ASSIGNED TO LIE	77975
Jun. 14, 2006	APPROVED FOR PUB - PRINCIPAL REGISTER	
Jun. 09, 2006	EXAMINER'S AMENDMENT ENTERED	88888
Jun. 09, 2006	EXAMINERS AMENDMENT E-MAILED	6328
Jun. 09, 2006	EXAMINERS AMENDMENT -WRITTEN	77875
Jun. 07, 2006	ASSIGNED TO EXAMINER	77875
Dec. 13, 2005	NOTICE OF DESIGN SEARCH CODE MAILED	
Dec. 12, 2005	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Nov. 21, 2006