ESTTA Tracking number: **ESTTA605149**
Filing date: **05/19/2014**

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

Proceeding	91213605
Party	Defendant Applied Micro Circuits Corporation
Correspondence Address	Paulo A. de Almeida Patel & Almeida, P.C. 16830 VENTURA BLVD., SUITE 360 ENCINO, CA 91436 UNITED STATES Paulo@PatelAlmeida.com
Submission	Motion to Amend/Amended Answer or Counterclaim
Filer's Name	Paulo A. de Almeida
Filer's e-mail	Paulo@PatelAlmeida.com
Signature	/Paulo A. de Almeida/
Date	05/19/2014
Attachments	X-Gene_Applicant's Consented or in the Alternative Unconsented Motion to Amend Answer.pdf(4423494 bytes)

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

US Trademark Application Serial No. 85/442,829 for X-Gene
Filed: October 8, 2011
Published: July 29, 2013

Spec Research, Inc.,	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No. 91213605
	)	
Applied Micro Circuits Corporation, A/K/A APM	)	
	)	
Applicant	)	
	)	

APPLICANT'S CONSENTED MOTION, OR IN THE ALTERNATIVE, UNCONSENTED MOTION FOR LEAVE TO AMEND ANSWER

Statement of Facts

On November 20, 2013, Opposer, Spec Research, Inc. ("Opposer"), filed a Notice of Opposition against Application Serial No. 85/442,829 for the mark X-gene, as filed by Applied Micro Circuits Corporation ("Applicant"), to which the Trademark Trial and Appeal Board ("Board") assigned Opposition No. 91213605. On December 30, 2013, Applicant filed its Answer to the Notice of Opposition. On January 29, 2014, the parties held their mandatory discovery conference under the supervision of Board Interlocutory Attorney Wendy Cohen. During the discovery conference, the Board *sua sponte* struck various affirmative defenses from Applicant's Answer. On the same day, the Board issued an order memorializing the discovery conference.

Consented Motion for Leave to Amend Answer

Pursuant to TBMP § 507.02, Applicant hereby requests leave to amend its Answer to (1) remove all affirmative defenses with the exception of those based on abandonment, laches, and unclean hands; (2) specifically and properly plead its affirmative defenses of abandonment, laches, and unclean hands, all of which were previously stricken for insufficient pleading; and (3) include some minor changes to its admissions and denials. Applicant has submitted herewith its Amended Answer and respectfully requests that it be included as part of the opposition record.

Applicant submits that Opposer's counsel, Lisa A. Karczewski, Esq., consented to Applicant's submission of this Amended Answer in an email message dated May 12, 2014, in accordance with T.B.M.P. § 507.02. *See* Exhibit A. Specifically, on May 9, 2014, Applicant's undersigned counsel sent Ms. Karczewski an email requesting Opposer's consent to file an amended answer which conforms to the Board's order striking Applicant's affirmative defenses, some of which were insufficiently pleaded. In an email response dated May 12, 2014, at 3:25 p.m. PST, Ms. Karczewski wrote:

> [T]his will confirm that our client Spec Research, Inc. consents to Applicant's request to file an amended Answer which conforms to the Board's January 29, 2014 Order provided that Applicant does not include any new grounds/affirmative defenses from that set forth in its original Answer filed December 30, 2013.

Id.

Applicant's Amended Answer, submitted herewith, is within the scope of Opposer's consent because it conforms to the Board's order and does not include any new "grounds/affirmative defenses from that set forth in its original Answer filed December 30, 2013". In fact, the Amended Answer omits all but three affirmative defenses raised in the

original Answer, although they are now sufficiently pleaded. The minor amendments to Applicant's admissions and denials do not constitute new grounds/affirmative defenses and are also within the scope of Opposer's consent.

Immediately upon receiving Ms. Karczewski's consent, Applicant's counsel took Applicant's filing instructions and began preparing this consented motion and the Amended Answer. Nearly four hours later, at 7:16 p.m. PST, Ms. Karczewski's co-counsel, Thomas T. Chan, attempted to withdraw the consent which Applicant already relied upon to prepare this motion:

> "That was not what we have consented to. All we consented to was for you to remove the stricken defenses. "

See Exhibit B. In subsequent emails between counsel, Ms. Karczewski characterized the matter as one of "confusion" and argued that the withdrawal of consent "supersedes" Opposer's prior consent. The Board should not entertain Opposer's suggestion that it can withdraw or "supersede" its express consent any time it pleases -- particularly after Applicant has relied upon such consent by expending time and resources to prepare this motion and Amended Answer. Further, Opposer had three days to consider Applicant's request for consent and carefully granted the consent under specific conditions that Applicant has met (i.e., not adding any new grounds/affirmative defenses). Accordingly, Opposer has consented to the filing of Applicant's Amended Answer.

Motion for Leave to Amend Answer Without Opposer's Consent

In the event the Board does not find consent, Applicant alternatively moves the Board for leave to amend its answer without Opposer's consent. TBMP § 507.02. A party to an inter partes proceeding before the Board may amend its pleading once as a matter of course within 21 days after serving it. TBMP § 507.02. After the period of 21 days after service of a pleading, a

party may amend its pleading only by written consent of every adverse party or by leave of the Board; and leave must be freely given when justice so requires. *Id.* In view thereof, the Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties. *Id.*

Here, Applicant seeks to amend its Answer to (1) delete various affirmative defenses which were stricken by the Board; (2) specifically and properly plead its affirmative defenses of abandonment, laches, and unclean hands; and (3) include some minor changes to its admissions and denials. None of the amendments would violate settled law or be prejudicial to the rights of Opposer.

First, Opposer was already on notice of Applicant's affirmative defenses of abandonment, laches, and unclean hands because they were included in Applicant's original Answer. Merely amending the underlying facts to bring the Answer into compliance with federal pleading standards does not surprise or prejudice the Opposer in any way. Second, Applicant appointed new counsel on May 9, 2014, and there is currently a pending motion to withdraw Applicant's prior counsel. Any delay in filing this motion and Amended Answer should be excused because Applicant changed attorneys during the proceeding and only recently had an opportunity to discuss filing an amended answer with new counsel. Last, the end of the discovery period is more than two months away (July 28, 2014), and the parties still have ample opportunity to conduct discovery. This motion does not disrupt the proceeding or prejudice the Opposer in any way, and justice requires leave to amend so that Applicant can plead and prove its affirmative defenses at trial. Accordingly, if the Board does not find consent, leave to amend should be

granted without consent, and Applicant's Answer should be accepted as part of the opposition record in accordance with TBMP § 507.02.

Respectfully submitted,

Dated as of: May 19, 2014

By: /Paulo A. de Almeida/

Paulo A. de Almeida
Alex D. Patel
Michael W. Schroeder
Patel & Almeida, P.C.
16830 Ventura Blvd., Suite 360
Encino, CA 91436
(818) 380-1900

Attorneys for Applicant,
Applied Micro Circuits Corporation

CERTIFICATE OF SERVICE

I hereby certify that In the Matter of Trademark opposition proceeding for Application Serial No. 85/442,829 a true and accurate copy of **APPLICANT'S CONSENTED MOTION, OR IN THE ALTERNATIVE, UNCONSENTED MOTION FOR LEAVE TO AMEND ANSWER** has been served on the following by delivering said copy on May 19, 2014, via First Class Mail, postage prepaid, with a courtesy copy by electronic mail, to counsel for Opposer at the following address:

Thomas T. Chan. Esq.
Fox Rothschild LLP
1055 West 7th St, Suite 1880
Los Angeles, CA 90017
United States

By: ___/Paulo A. de Almeida_____

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

US Trademark Application Serial No. 85/442,829 for X-Gene
Filed: October 8, 2011
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Spec Research, Inc.,	)	
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	)	
v.	)	Opposition No. 91213605
	)	
Applied Micro Circuits Corporation, A/K/A APM	)	
	)	
Applicant	)	
	)	

FIRST AMENDED ANSWER TO NOTICE OF OPPOSITION

Applied Micro Circuits Corporation, a Delaware corporation with a business address at 215 Moffett Park Drive, Sunnyvale, CA 95125 ("Applicant") and owner of the trademark X-GENE ("X-GENE Mark") for goods and services identified in US Trademark Application Serial No. 85/442,829, hereby ANSWERS the NOTICE OF OPPOSITION filed by Spec Research Inc., a California corporation with a business address at 19433 San Jose Avenue, City of Industry, CA 91748 ("Opposer"), with respect to each numbered paragraph of the Notice of Opposition as follows:

1. Admitted.

2. Applicant admits that Opposer previously owned Registration No. 3,173,778, now cancelled, for a stylized design mark depicted as ⓧGene with the color blue claimed ("XGENE and Design" or "Opposer's Mark"), for goods identified as "computer cursor control devices, namely, computer mouse." Applicant further admits that Opposer failed to file the requisite 6th-year

Section 8 declaration of continued use or excusable non-use (the "Section 8 Declaration") for Opposer's Mark; admits that Opposer's registration rights in such mark lapsed on May 21, 2013, the date on which the 6-month grace period for filing the Section 8 Declaration expired; admits that the USPTO thereafter cancelled Opposer's Mark on June 28, 2013; and admits that Exhibit A reflects status information as of November 18, 2013 with respect to Opposer's cancelled registration. Applicant avers that, based on the failure to file the Section 8 Declaration, the USPTO properly cancelled the Opposer's registration and that the cancellation was not "inadvertent." Applicant further lacks knowledge or information sufficient to form a belief as to the truth of the balance of the allegations made or alleged in or by Paragraph 2, and therefore denies them.

3. Denied.

4. Denied.

5. Denied.

6. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations made or alleged in or by Paragraph 6 and therefore denies them.

7. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations made or alleged in or by Paragraph 7 and therefore denies them.

8. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations made or alleged in or by Paragraph 8 and therefore denies them.

9. Denied. Applicant further avers that the marks are not confusingly similar because Opposer's Mark is a highly-stylized design mark, with a single color claimed. Thus, the scope of rights, if any, relate to a mark that forms a very different commercial impression from that of Applicant's X-GENE Mark. Moreover, Applicant further avers that the Applicant's goods

(microprocessor chips) and Opposer's goods (computer mice) are vastly different from each other, as further set forth herein.

10. Denied. Applicant further avers that prospective purchasers and the trade will not consider the goods and services of Applicant as emanating from Opposer because such goods and services are not only vastly different from Opposer's goods, but also because the prospective purchasers of Applicant's and Opposer's goods and the channels of trade for the parties' respective goods are vastly different. Whereas Applicant's microprocessor chip products are directed to a highly-skilled corporate technology purchaser audience, for integration into each purchaser's highly-sophisticated data center equipment products, Opposer's computer mouse products are directed to end-user lay person consumers, for immediate use as a finished good. Whereas sales of Applicant's products generally are the result of complex evaluation and deliberation processes requiring extensive interaction and communication between Applicant and each purchaser over multiple months or years, Opposer's products were generally sold through over-the-counter retail outlets or the Internet, with little or no communication between Opposer and the purchaser. In addition, Applicant further avers that, based on these differences, as well as the vast differences between Applicant's and Opposer's goods in terms of function, use, specifications, size, appearance, price-point, number of units sold per contract, contract terms and conditions, and other factors, Opposer could not have a genuine belief that the sale of Applicant's goods and services under the X-GENE Mark would result in any lost sales of Opposer's goods.

11. Denied.

12. Denied.

13. Applicant admits that registration of the X-GENE Mark as reflected in Application Serial No. 85/442,829 would confer on Applicant at least *prima facie* exclusive right to use of such mark for the goods and services identified in the Application, but denies that such registration would be a source of damage and injury to Opposer. Applicant otherwise denies each and every allegation made or alleged in or by Paragraph 13.

AFFIRMATIVE DEFENSES

FIRST AFFIRMATIVE DEFENSE – ABANDONMENT

14. Opposer never filed a Section 8 Declaration for XGENE and Design, Reg. No. 3,173,778. The six year maintenance period for the mark ended on November 21, 2012 and the six month grace period for such filing expired on May 21, 2013. Consequently, Opposer's registration rights in XGENE and Design lapsed on May 21, 2013 and the mark was thereafter shown as cancelled by the USPTO on June 28, 2013.

15. On information and belief, none of Opposer's products bearing the XGENE and Design mark have been available for sale in United States commerce for more than three consecutive years prior to filing of the Notice of Opposition.

16. On information and belief, for at least three consecutive years prior to filing of the Notice of Opposition, Opposer had ceased and not made use of Opposer's XGENE and Design mark in the United States in connection with all of the goods identified in Registration No. 3,173,778.

17. On information and belief, at the time of filing of the Notice of Opposition, Opposer had no genuine intent to use or to resume use of the trademark XGENE and Design in the United States in connection with any of the goods identified in Reg. No. 3,173,778.

18. Accordingly, Opposer's claims for relief are barred by virtue of abandonment of the mark XGENE and Design.

SECOND AFFIRMATIVE DEFENSE – LACHES

19. Applicant first announced its plans to use the X-GENE Mark in October 2011 and applied to register X-GENE Mark on October 8, 2011. Opposer therefore had actual and/or constructive knowledge of Applicant's intended use of the X-GENE Mark from such date.

20. Since the initial public announcement of its launch of products marketed under the X-GENE Mark in October 2011, Applicant's X-GENE microprocessor product line has received considerable media attention in the trade press and pursuant to Applicant's numerous press releases and SEC filings referencing the mark.

21. Opposer never advised Applicant by cease and desist letter that it demanded cessation of use of Applicant's X-GENE Mark or withdrawal of its application for registration. Opposer's counsel first contacted Applicant by telephone in or about May 2013 and threatened to oppose the pending application. By that date, Applicant had expended substantial sums in development and marketing of the X-GENE product, and had extensively promoted the product under the mark.

22. Opposer's delay in raising an objection to Applicant's use or registration of its X-GENE Mark was unreasonable and would cause material and undue prejudice to Applicant should registration of Applicant's mark be barred on account of this opposition. Accordingly, Opposer's claims for relief are barred by the doctrine of laches.

THIRD AFFIRMATIVE DEFENSE – UNCLEAN HANDS

23. Upon information and belief, Opposer lodged two letters of protest with the USPTO, the first on May 9, 2012 and the second on March 12, 2013 in which Opposer sought to

make the examining attorney aware of its then-active registration for XGENE and Design, Reg. No. 3,173,778. These letters of protest were made during the regular 6 year and 6-month maintenance and grace periods when Opposer's Section 8 Declaration was due. Yet, while actively filing letters of protest, Opposer did not file the Section 8 Declaration for its own XGENE and Design mark. Upon information and belief, Opposer expressly did not file its Section 8 Declaration because its XGENE and Design mark was not in use and it had no grounds to assert excused non-use of the mark.

24. The filings of the letters of protest further delayed publication of Applicant's application for the X-GENE Mark, to Applicant's prejudice.

25. In or about May 2013, through its counsel, Opposer contacted Applicant seeking -- based upon Opposer's pre-exisitng XGENE and Design mark -- a monetary payment in exchange for Opposer's agreement not to oppose Applicant's application (but not offered in exchange for an assignment of any asserted existing rights to the mark or for a consent arising out of the differences in the parties' respective goods). Yet at that time, Opposer provided no evidence of its continued use of its XGENE and Design mark. Moreover, at that time Opposer made no mention to Applicant that it would not be filing a Section 8 Declaration or that its registration rights in the mark would be expiring shortly thereafter.

26. On November 20, 2013, several months after the deadline for filing the Section 8 Declaration had passed and Opposer's Mark had been cancelled, Opposer again (through its counsel) contacted Applicant to seek -- based upon Opposer's pre-existing XGENE and Design mark -- a monetary payment in exchange for Opposer's agreement not to oppose Applicant's application. Opposer did not initially disclose to Applicant that, subsequent to their last conversation, its rights to the XGENE and Design registration had terminated and the mark had

been cancelled by the USPTO. This time, however, Opposer demanded a payment amount eight times higher than the prior demand (but likewise did not offer any assignment of Opposer's asserted rights to the mark nor any consent arising out of the differences in the parties' respective goods). Applicant's counsel stated that Opposer's registration had been cancelled. Opposer's counsel told Applicant's counsel for the first time that its opposition (not yet filed) would be based on alleged common law rights. As before, Opposer provided no evidence of its continued use at that time of its XGENE and Design mark.

27. Additionally, Opposer based its opposition in this proceeding on its common law rights in the XGENE and Design mark, when, upon information and belief, Opposer knew that, as of the date of filing the Notice of Opposition, its XGENE and Design mark had not been in use for over three consecutive years and thus would be *prima facie* deemed abandoned.

28. Opposer's entire above-described course of conduct in seeking to delay or defeat Applicant's application from publication and registration, or alternatively extract compensation for no consideration, while all the time knowing that Opposer had ceased use of its XGENE and Design mark for over three consecutive years, has not been made in good faith or with any genuine belief that Opposer would be damaged by Applicant's registration.

29. Opposer's claims for relief are accordingly barred by the doctrine of unclean hands.

WHEREFORE, Applicant respectfully requests that the opposition be dismissed.

Respectfully submitted,

Dated as of: May 19, 2014

By: /Paulo A. de Almeida/

Paulo A. de Almeida
Alex D. Patel
Michael W. Schroeder
Patel & Almeida, P.C.
16830 Ventura Blvd., Suite 360
Encino, CA 91436
(818) 380-1900

Attorneys for Applicant,
Applied Micro Circuits Corporation

CERTIFICATE OF SERVICE

I hereby certify that In the Matter of Trademark opposition proceeding for Application Serial No. 85/442,829 a true and accurate copy of Applicant's **FIRST AMENDED ANSWER TO NOTICE OF OPPOSITION** has been served on the following by delivering said copy on May 19, 2014, via First Class Mail, postage prepaid, with a courtesy copy by electronic mail, to counsel for Opposer at the following address:

Thomas T. Chan. Esq.
Fox Rothschild LLP
1055 West 7th St, Suite 1880
Los Angeles, CA 90017
United States

By: ___/Paulo A. de Almeida_____

EXHIBIT A

Patel & Almeida, P.C.

From: "Karczewski, Lisa A." <LKarczewski@foxrothschild.com>
Date: Monday, May 12, 2014 3:25 PM
To: "Patel & Almeida, P.C." <paulo@patelalmeida.com>
Cc: "Alex Patel" <alex@patelalmeida.com>; "michael schroeder" <michael@paiplaw.com>; "Nikki Steen" <nikki@patelalmeida.com>; "Chan, Thomas T." <TChan@foxrothschild.com>; "IPDocket" <IPDocket@foxrothschild.com>
Subject: RE: X-gene opposition; Proceeding No. 91213605

Dear Mr. de Almeida,

Thank you for your e-mail and accompanying attachments in connection with the above subject proceeding. We note your firm's contact information.

Regarding the parties' meet and confer to discuss Applicant's recent discovery responses, I am available this Friday, May 16th, from 1:30 p.m. onward. Please kindly confirm whether such date/time would work with your schedule.

Further, this will confirm that our client Spec Research, Inc. consents to Applicant's request to file an amended Answer which conforms to the Board's January 29, 2014 Order provided that Applicant does not include any new grounds/affirmative defenses from that set forth in its original Answer filed December 30, 2013.

Thank you and we look forward to working with you as well.

Regards,

Lisa A. Karczewski
Attorney At Law
Fox Rothschild LLP
1055 W. 7th Street
Suite 1880
Los Angeles, CA 90017
(213) 225-2602 - direct
(310) 556-9828 - fax
LKarczewski@foxrothschild.com
www.foxrothschild.com

From: Patel & Almeida, P.C. [mailto:paulo@patelalmeida.com]
Sent: Friday, May 09, 2014 5:17 PM
To: Karczewski, Lisa A.
Cc: Alex Patel; michael schroeder; Nikki Steen
Subject: X-gene opposition; Proceeding No. 91213605

Dear Ms. Karczewski:

Please see the attached courtesy copies of the (1) Appearance of Counsel and (2) Change of

Correspondence filed at the TTAB today. Hard copies will follow by mail.

I will be serving as lead counsel for the Applicant, and my full contact information is below.

We are in receipt of your letter of May 6, 2014, alleging deficiencies in Applicant's discovery responses. I am available for a telephone conference anytime next week. Please let me know what dates/times work best for you.

In addition, as you may recall, the Board *sua sponte* struck various affirmative defenses from Applicant's Answer during the discovery conference. Applicant intends to file an amended answer which conforms to the Board's order. May Applicant have your consent to file an amended answer?

Thank you, and I look forward to working with you.

Very truly yours,

Paulo A. de Almeida
Attorney at Law
Patel & Almeida, P.C.
paulo@patelalmeida.com
www.patelalmeida.com
tel: 818.380.1900
fax: 818.380.1908

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EXHIBIT B

Patel & Almeida, P.C.

From: "Chan, Thomas T." <TChan@foxrothschild.com>
Date: Monday, May 12, 2014 7:15 PM
To: "Patel & Almeida, P.C." <paulo@patelalmeida.com>
Cc: "Karczewski, Lisa A." <LKarczewski@foxrothschild.com>; "Alex Patel" <alex@patelalmeida.com>; "michael schroeder" <michael@paiplaw.com>; "Nikki Steen" <nikki@patelalmeida.com>; "IPDocket" <IPDocket@foxrothschild.com>
Subject: Re: X-gene opposition; Proceeding No. 91213605

Paulo,

That was not what we have consented to. All we consented to was for you to remove the stricken defenses.

Tom 213-842-2443

From iPhone pardon my typos

On May 13, 2014, at 9:42 AM, "Patel & Almeida, P.C." <paulo@patelalmeida.com> wrote:

> Dear Ms. Karczewski:
>
> We are available for a meet and confer this Friday, May 16, at 1:30 p.m. Kindly confirm the time, and I will call your direct line on Friday.
>
> Thank you for providing your consent to Applicant's filing of an amended answer. The amended answer contains sufficiently pleaded affirmative defenses of abandonment, laches, and unclean hands, but no new grounds/affirmative defenses.
>
> Very truly yours,
>
> Paulo A. de Almeida
> Attorney at Law
> Patel & Almeida, P.C.
> paulo@patelalmeida.com
> www.patelalmeida.com
> tel: 818.380.1900
> fax: 818.380.1908
>
> ** CONFIDENTIALITY NOTICE: This e-mail message may contain legally privileged and confidential information exempt or prohibited from disclosure under applicable law. If you are not the intended recipient of this e-mail, please notify this sender immediately and do not deliver, distribute or copy this e-mail, or disclose its contents or take any action in

reliance on the information it contains.

From: Karczewski, Lisa A.
Sent: Monday, May 12, 2014 3:25 PM
To: Patel & Almeida, P.C.
Cc: Alex Patel ; michael schroeder ; Nikki Steen ; Chan, Thomas T. ; IPDocket
Subject: RE: X-gene opposition; Proceeding No. 91213605

Dear Mr. de Almeida,

Thank you for your e-mail and accompanying attachments in connection with the above subject proceeding. We note your firm's contact information.

Regarding the parties' meet and confer to discuss Applicant's recent discovery responses, I am available this Friday, May 16th, from 1:30 p.m. onward. Please kindly confirm whether such date/time would work with your schedule.

Further, this will confirm that our client Spec Research, Inc. consents to Applicant's request to file an amended Answer which conforms to the Board's January 29, 2014 Order provided that Applicant does not include any new grounds/affirmative defenses from that set forth in its original Answer filed December 30, 2013.

Thank you and we look forward to working with you as well.

Regards,

Lisa A. Karczewski
Attorney At Law
Fox Rothschild LLP
1055 W. 7th Street
Suite 1880
Los Angeles, CA 90017
(213) 225-2602 - direct
(310) 556-9828 - fax
LKarczewski@foxrothschild.com
www.foxrothschild.com

From: Patel & Almeida, P.C. [mailto:paulo@patelalmeida.com]
Sent: Friday, May 09, 2014 5:17 PM
To: Karczewski, Lisa A.
Cc: Alex Patel; michael schroeder; Nikki Steen
Subject: X-gene opposition; Proceeding No. 91213605

Dear Ms. Karczewski:

Please see the attached courtesy copies of the (1) Appearance of Counsel and (2) Change of Correspondence filed at the TTAB today. Hard copies will follow by mail.

EXHIBIT C

Patel & Almeida, P.C.

From: "Karczewski, Lisa A." <LKarczewski@foxrothschild.com>
Date: Tuesday, May 13, 2014 1:40 PM
To: "Patel & Almeida, P.C." <paulo@patelalmeida.com>; "Chan, Thomas T." <TChan@foxrothschild.com>
Cc: "Alex Patel" <alex@patelalmeida.com>; "michael schroeder" <michael@paiplaw.com>; "Nikki Steen" <nikki@patelalmeida.com>; "IPDocket" <IPDocket@foxrothschild.com>
Subject: RE: X-gene opposition; Proceeding No. 91213605

Paulo,

With all due respect, it is certainly not our intent to make things difficult for either side. There was some apparent confusion regarding the extent of Opposer's consent in my e-mail to you yesterday and my colleague Tom Chan promptly clarified to you yesterday evening the extent of same in view of Applicant's request to file an amended answer that conforms to the Board's January 29, 2014 Order. Accordingly, this is clearly not a case of Opposer giving consent and withdrawing consent as it pleases.

Regards,

Lisa A. Karczewski
Attorney At Law
Fox Rothschild LLP
1055 W. 7th Street
Suite 1880
Los Angeles, CA 90017
(213) 225-2602 - direct
(310) 556-9828 - fax
LKarczewski@foxrothschild.com
www.foxrothschild.com

From: Patel & Almeida, P.C. [mailto:paulo@patelalmeida.com]
Sent: Tuesday, May 13, 2014 1:13 PM
To: Karczewski, Lisa A.; Chan, Thomas T.
Cc: Alex Patel; michael schroeder; Nikki Steen; IPDocket
Subject: Re: X-gene opposition; Proceeding No. 91213605

Lisa:

The issue is not *how much* Applicant has incurred in costs. Applicant relied to its detriment on Opposer's consent, and as a result such consent cannot now be withdrawn. What is "improper" is Opposer's suggestion that it can give consent and withdraw when it pleases – and for the express purpose of making things more difficult for the Applicant.

And yes, we will file a copy of the amended answer with our motion.

Very truly yours,

Paulo A. de Almeida
Attorney at Law
Patel & Almeida, P.C.
paulo@patelalmeida.com
www.patelalmeida.com
tel: 818.380.1900
fax: 818.380.1908

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From: Karczewski, Lisa A.
Sent: Tuesday, May 13, 2014 12:25 PM
To: Patel & Almeida, P.C. ; Chan, Thomas T.
Cc: Alex Patel ; michael schroeder ; Nikki Steen ; IPDocket
Subject: RE: X-gene opposition; Proceeding No. 91213605

Paulo,

Applicant should not have incurred significant costs at its end as Tom Chan's 7:16 p.m. e-mail was directed to you within half an hour of your 6:42 p.m. e-mail to our firm. In addition, APM will still need the proposed amended answer for any motion for leave to amend filed with the Board.

As we have already informed you, our client does not consent to the filing of the consented motion and amended answer with the Board other than for APM to conform its answer with the Board's Order by removing the stricken affirmative defenses. It would be improper for Applicant to proceed with the filing of the consented motion and amended answer with the Board, if Applicant does not have Opposer's consent beyond the removal of the stricken affirmative defenses.

Regards,

Lisa A. Karczewski
Attorney At Law
Fox Rothschild LLP
1055 W. 7th Street
Suite 1880
Los Angeles, CA 90017
(213) 225-2602 - direct
(310) 556-9828 - fax
LKarczewski@foxrothschild.com
www.foxrothschild.com

From: Patel & Almeida, P.C. [mailto:paulo@patelalmeida.com]
Sent: Tuesday, May 13, 2014 12:06 PM

To: Karczewski, Lisa A.; Chan, Thomas T.
Cc: Alex Patel; michael schroeder; Nikki Steen; IPDocket
Subject: Re: X-gene opposition; Proceeding No. 91213605

Lisa:

Opposer will not be heard to "withdraw", "clarify", or "supersede" its express written consent after Applicant has relied on such consent (and incurred costs) in preparing the motion and amended answer.

Very truly yours,

Paulo A. de Almeida
Attorney at Law
Patel & Almeida, P.C.
paulo@patelalmeida.com
www.patelalmeida.com
tel: 818.380.1900
fax: 818.380.1908

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From: Karczewski, Lisa A.
Sent: Tuesday, May 13, 2014 11:24 AM
To: Patel & Almeida, P.C. ; Chan, Thomas T.
Cc: Alex Patel ; michael schroeder ; Nikki Steen ; IPDocket
Subject: RE: X-gene opposition; Proceeding No. 91213605

Dear Paulo,

Please be advised that my colleague Partner Tom Chan's clarification e-mail from last night supersedes my e-mail sent shortly before. Accordingly, APM does not effectively have Opposer's consent to file an Amended Answer other than to remove the stricken affirmative defenses.

Should APM wish to add anything further other than to conform its Answer with the Board's Order, it must seek leave to amend with the Board. To be clear, our client does not consent to APM adding its affirmative defenses in any Amended Answer that were previously stricken by the Board.

We trust that APM will not file the consented motion and amended answer with the Board in view of our earlier e-mail communications to you last night and this morning (in which I confirmed Tom Chan's clarification e-mail was indeed correct) in which it was made clear that our client's consent is limited the removal of the stricken affirmative defenses from APM's Answer.

Thank you for your confirmation for this Friday's call.

Regards,

Lisa A. Karczewski
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From: Patel & Almeida, P.C. [mailto:paulo@patelalmeida.com]
Sent: Tuesday, May 13, 2014 11:04 AM
To: Karczewski, Lisa A.; Chan, Thomas T.
Cc: Alex Patel; michael schroeder; Nikki Steen; IPDocket
Subject: Re: X-gene opposition; Proceeding No. 91213605

Dear Lisa and Thomas:

We have already prepared the consented motion and amended answer based on Opposer's written consent to "file an amended Answer which conforms to the Board's January 29, 2014 Order provided that Applicant does not include any new grounds/affirmative defenses from that set forth in its original Answer filed December 30, 2013". The proposed "clarification" in your email below is outside the scope of the consent.

We thank you again for providing the requested consent.

Confirmed re: Friday at 1:30 p.m.

Very truly yours,

Paulo A. de Almeida
Attorney at Law
Patel & Almeida, P.C.
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From: Karczewski, Lisa A.
Sent: Tuesday, May 13, 2014 8:21 AM
To: Patel & Almeida, P.C. ; Chan, Thomas T.

Cc: Alex Patel ; michael schroeder ; Nikki Steen ; IPDocket
Subject: RE: X-gene opposition; Proceeding No. 91213605

Dear Paulo,

To clarify any confusion from yesterday's e-mail exchange on the consent issue, Tom's e-mail from last night below is correct in that our client Spec Research, Inc. will only consent to allow APM to file an Amended Answer to conform to the Board's January 2014 Order (i.e., to remove the stricken Affirmative Defenses).

This will confirm that I am available for a telephone conference on APM's deficient discovery responses this Friday, May 16th, at 1:30 p.m. I look forward to speaking with you then.

Regards,

Lisa A. Karczewski
Attorney At Law
Fox Rothschild LLP
1055 W. 7th Street
Suite 1880
Los Angeles, CA 90017
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(310) 556-9828 - fax
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From: Patel & Almeida, P.C. [mailto:paulo@patelalmeida.com]
Sent: Monday, May 12, 2014 7:39 PM
To: Chan, Thomas T.
Cc: Karczewski, Lisa A.; Alex Patel; michael schroeder; Nikki Steen; IPDocket
Subject: Re: X-gene opposition; Proceeding No. 91213605

Thomas:

We have Opposer's written consent to "file an amended Answer which conforms to the Board's January 29, 2014 Order provided that Applicant does not include any new grounds/affirmative defenses from that set forth in its original Answer filed December 30, 2013". See below.

Inasmuch as the amended answer will not include any new grounds/affirmative defenses not raised in the original answer, the filing is within the scope of Opposer's consent.

If you have any questions, please feel free to call me tomorrow at (818) 380-1900.

Very truly yours,

Paulo A. de Almeida
Attorney at Law
Patel & Almeida, P.C.

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fax: 818.380.1908

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From: Chan, Thomas T.
Sent: Monday, May 12, 2014 7:15 PM
To: Patel & Almeida, P.C.
Cc: Karczewski, Lisa A. ; Alex Patel ; michael schroeder ; Nikki Steen ; IPDocket
Subject: Re: X-gene opposition; Proceeding No. 91213605

Paulo,

That was not what we have consented to. All we consented to was for you to remove the stricken defenses.

Tom 213-842-2443

From iPhone pardon my typos

On May 13, 2014, at 9:42 AM, "Patel & Almeida, P.C." <paulo@patelalmeida.com> wrote:

> Dear Ms. Karczewski:
>
> We are available for a meet and confer this Friday, May 16, at 1:30 p.m. Kindly confirm the time, and I will call your direct line on Friday.
>
> Thank you for providing your consent to Applicant's filing of an amended answer. The amended answer contains sufficiently pleaded affirmative defenses of abandonment, laches, and unclean hands, but no new grounds/affirmative defenses.
>
> Very truly yours,
>
> Paulo A. de Almeida
> Attorney at Law
> Patel & Almeida, P.C.
> paulo@patelalmeida.com
> www.patelalmeida.com
> tel: 818.380.1900
> fax: 818.380.1908