

ESTTA Tracking number: **ESTTA623929**

Filing date: **08/27/2014**

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

Proceeding	91213605
Party	Defendant Applied Micro Circuits Corporation
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Submission	Motion to Amend Application
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Date	08/27/2014
Attachments	X-Gene_Motion to Amend Application Without Consent.pdf(239773 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
	)	Serial No. 85/442,829; X-Gene
	)	
Applied Micro Circuits Corporation,	)	
A/K/A APM	)	
	)	
Applicant	)	
_____	)	

**APPLICANT'S MOTION TO AMEND APPLICATION WITHOUT CONSENT**

Applicant hereby moves the Trademark Trial and Appeal Board ("Board") to amend Applicant's identification of goods and services pursuant to 37 CFR §2.133(a). Applicant has sought Opposer's consent to file this motion, but Opposer's counsel, Lisa Karczewski, refused consent without any explanation in an email to Applicant's counsel on August 25, 2014, stating:

Our client cannot consent to APM's proposed motion to amend its identification of goods and services." Accordingly, APM's proposed motion will need to be revised and filed as an unconsented motion with the Board.

Accordingly, Applicant submits this motion without Opposer's consent.

For its amendment, Applicant proposes to change the identified goods and services in App. Ser. No. 85/442,829 from the following:

**IC**      **Goods/Services**

9      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

- 42 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 service

to the following:

**IC Goods/Services**

- 9 **Microprocessors and systems on a chip (SoCs) for implementation in servers and data centers, all of the foregoing provided specifically to designers and manufacturers of servers and data centers.**
- 42 **design, development, and integration services in the field of microprocessors and systems on a chip (SoCs) specifically used for servers and data centers; all of the foregoing specifically provided to designers and manufacturers of servers and data centers.**

In making these changes, Applicant has (1) deleted certain listed goods and services, (2) specified the limited nature and purpose of the remaining goods and services, namely, that they are implemented in and used specifically for "servers and data centers"; and (3) included a limitation on the class of consumers, namely, that they are provided to "designers and manufacturers of servers and data centers". Applicant submits that the proposed amendments comply with all applicable rules and should be accepted as the operative identification of goods and services in the opposed Application Serial No. 85/442,829. Accordingly, this case should proceed to trial on the amended identification.

**Legal Standard**

An application which is the subject of an opposition may not be amended except with the consent of the opposer and the approval of the Board or except upon a motion granted by the Board. Trademark Rule 2.133(a). An unconsented motion to amend an application should be

made prior to trial, in order to give the other party fair notice thereof. *Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1435 (TTAB 2007). In determining whether to accept a proposed amendment to an identification that, while contested, is otherwise acceptable, the Board looks to see whether the following circumstances are present:

- 1) the proposed amendment must serve to limit the broader identification of goods or services;
- 2) applicant must consent to the entry of judgment on the grounds for opposition with respect to the broader identification of goods or services present at publication;
- 3) if the applicant wishes to avoid the possibility of a res judicata effect by the entry of judgment on the original identification, the applicant must make a prima facie showing that the proposed amendment serves to change the nature and character of the goods or services or restrict their channels of trade and customers so as to introduce a substantially different issue for trial; and
- 4) where required to support the basis of the subject application, any specimens of record must support the goods or services as amended; and applicant must then introduce evidence during its testimony period to prove use of its mark with the remaining goods or services prior to the relevant date as determined by the application's filing basis.

*Johnson & Johnson v. Stryker Corp.*, 109 USPQ2d 1077, 1078-79 (TTAB 2013).

### **Argument**

Applicant is at least entitled to the registration of the opposed mark for the goods and services as amended herein. First, the amendments are appropriate in that they are clearly limiting in nature under 37 C.F.R. § 2.71(a) and would not require re-publication. Specifically, Applicant's amendments consist of (1) deletions of certain specific goods and services, (2) further narrowing of the remaining items by specifying that they are "implemented" in and "used" specifically for "servers and data centers", and (3) even further narrowing by specifying the class of consumers as "designers and manufacturers of servers and data centers".

Second, Applicant consents to the entry of judgment on the grounds for opposition with respect to the broader identification of goods or services present at publication, but asserts that Applicant's use and registration of its mark for the goods and services as amended herein is not likely to cause confusion with Opposer's alleged mark for its alleged goods. The Board should decide the issue of likelihood of confusion at trial based on the amended identification.

Third, the proposed amendment serves to change the nature and character of the goods and services and restrict their channels of trade and customers so as to introduce a substantially different issue for trial. Specifically, Applicant's proposed amendment narrows the nature and purpose of the goods and services by specifying that they are implemented in and used for "servers and data centers". Opposer's alleged computer mice are not implemented in servers and data centers and are not otherwise related to Applicant's goods as amended. Applicant's proposed amendments also narrow the category of users by specifying that the goods and services are provided to "designers and manufacturers of servers and data centers". This amendment has the effect of restricting the channels of trade and prospective customers of the goods so as to introduce a substantially different issue for trial, as Opposer's alleged computer mice are not purchased by designers and manufacturers of servers and data centers. *See Int'l Harvester*, 208 USPQ at 941 (applicant's proposed amendment found to permissibly restrict the scope of the goods to the extent that it narrowed the category of users and, therefore, the function for which the goods may normally be used).

Fourth, the specimens of record support the goods and services as amended. Specifically, Applicant's specimens of record consist of excerpts from a manual and data sheets describing Applicant's microprocessors and systems on a chip (SoCs) in class 9, as amended. Applicant's customers rely on this manual and data sheet to select and use Applicant's goods. Applicant's design, development, and integration services in class 42 are provided along with Applicant's goods which are sold to Applicant's customers. Applicant's customers rely on the same materials

as shown in the specimens to select and use Applicant's services. In addition, Applicant will introduce evidence during its testimony period to prove use of its mark with the remaining goods and services (as amended) prior to the filing date of the opposed application, which was filed based on use in commerce.

Based on the foregoing, Applicant requests that the Board accept its amended goods and services identification as soon as possible in order to allow any potential follow up discovery prior to trial.

Respectfully submitted,

Dated as of: August 27, 2014

By:           /Paulo A. de Almeida/          

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**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 MOTION TO AMEND APPLICATION WITHOUT CONSENT** has been served on the following by delivering said copy on August 27, 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.  
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By:           /Paulo A. de Almeida