

ESTTA Tracking number: **ESTTA579433**

Filing date: **12/30/2013**

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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Date	12/30/2013
Attachments	X-Gene Opposition - Answer to Notice of Opposition - Final.pdf(56502 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)	
_____)	

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” for goods and services identified in US Trademark Application Serial No. 85/442,829 (the “Application”), hereby ANSWERS the NOTICE OF OPPOSITION to the Application filed on November 20, 2013 (the “Opposition Notice”) by Spec Research Inc., a California Corporation with a business address at 19433 San Jose Ave, City of Industry, CA 91748 (“Opposer”), 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 , for goods

identified as “computer cursor control devices, namely, computer mouse”.

Opposer’s registration was cancelled by the USPTO on June 28, 2013, more than six months after Opposer failed to file the requisite 6th-year Section 8 declaration of continued use or excusable non-use (“Section 8 Affidavit”) or Section 9 renewal application (“Section 9 Renewal”), and failed to pay requisite renewal fees.

Applicant denies that Opposer’s registration was “inadvertently cancelled” or that Opposer’s failure to maintain the registration was “unbeknownst to Opposer”.

3. Denied.

4. Denied.

5. Denied.

6. Denied.

7. Denied.

8. Denied.

9. Denied.

10. Denied.

11. Denied.

12. Denied.

13. Applicant admits that registration of its X-Gene mark would confer on Applicant at least *prima facie* exclusive right to 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'S DEFENSES AND AMPLIFICATION OF ITS

ANSWER

FIRST AFFIRMATIVE DEFENSE

14. As a First and Separate Affirmative Defense, Applicant alleges that since (i) Opposer's Registration No. 3,173,778 was cancelled by the USPTO due to Opposer's failure to file a Section 8 Affidavit or a Section 9 Renewal and (ii) Opposer abandoned its common law XGENE mark more than three years prior to the Application filing date, therefore Opposer has no standing to oppose the Application.

15. Opposer's reliance on cancelled Registration No. 3,173,778 to oppose the Application is groundless since a registration cancelled due to the failure to file a Section 8 Affidavit and a Section 9 renewal is deemed null and void and cannot be revived or reinstated.

16. Opposer's alleged common law basis for opposing the Application is also groundless since Opposer abandoned its XGENE mark for at least three years, as evidenced by the unavailability in commerce in the US of a computer mouse with the XGENE mark since at least July 19, 2010.

SECOND AFFIRMATIVE DEFENSE

17. As a Second and Separate Affirmative Defense, Applicant alleges that Opposer's  mark is not confusingly similar to Applicant's X-Gene mark in appearance.

18. Opposer's mark is not confusingly similar to Applicant's X-Gene mark because Opposer's mark as depicted in cancelled Registration No. 3,173,778 and formerly used on its packaging was a stylized blue design mark consisting of an encircled lower case "x", with serifs and non-bold, and separated from the word "Gene", which was sans serif and bold. Opposer specifically claimed the color blue as a feature of its mark. In contrast, in Applicant's mark, the "X" is an uppercase "X" that is not encircled or stylized. Further, in Applicant's mark, the "X" is hyphenated with the word "Gene". Unlike Opposer's mark, Applicant's mark does not combine bold and non-bold elements nor does it combine separate fonts. Thus the commercial impressions of the marks are sufficiently different that they are not likely as to cause confusion as to the source of their goods.

THIRD AFFIRMATIVE DEFENSE

19. As a Third and Separate Affirmative Defense, Applicant alleges that there is no likelihood of confusion because Applicant's mark is applied to goods

and services that are distinctly different from those claimed under Opposer's mark.

20. Applicant's mark is not applied to goods and/or services that are the same or similar to those covered by Opposer's claimed mark. By its own admission, Opposer's claimed mark (both the registered and common law versions) was limited to "computer cursor control devices, namely, computer mouse." In sharp contrast, Applicant's mark is applied to "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", goods that do not encompass, and would not be mistaken for, a computer mouse. Similarly, Applicant's services -- identified as "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" -- do not encompass, and would not be mistaken for, service for a computer mouse.

FOURTH AFFIRMATIVE DEFENSE

21. As a Fourth and Separate Affirmative Defense, Applicant alleges that purchasers and the trade are not likely to consider Applicant's goods and/or services sold under Applicant's X-Gene mark as emanating from Opposer.

22. There is no likelihood of confusion as to the source or sponsorship of Applicant's goods and Opposer's goods attributable to use of their respective marks, due to the pronounced differences between their prospective purchasers and channels of trade. Prospective purchasers of microprocessors, systems-on-a-chip (SOCs), semiconductors and related goods identified in the Application (hereinafter, collectively, "Microprocessor Chips") are highly skilled, technical engineers and executives typically employed by Original Equipment Manufacturers ("OEMs"), Original Design Manufacturers ("ODMs") and other large high-tech companies that purchase Microprocessor Chips only after evaluating their inner workings and detailed design specifications. In sharp contrast, prospective purchasers and the trade for Opposer's goods are non-technical end-users of a computer mouse who do not evaluate the inner workings or detailed design specifications of the mouse before making a purchase. Neither group of purchasers are capable of being sufficiently confused as to consider a computer mouse to be a Microprocessor Chip, or a Microprocessor Chip to be a computer mouse.

23. There is no likelihood of confusion as to the source or sponsorship of Applicant's and Opposer's goods attributable to the marks, since Microprocessor Chips that are purchased for the purpose of integrating them into another product that is being designed or manufactured by the purchaser. In sharp contrast, a computer mouse is a finished good ready for immediate use.

24. There is no likelihood of confusion as to the source or sponsorship of Applicant's and Opposer's goods because of the marks used thereon, since Microprocessor Chips are sold as a result of prolonged marketing presentations to customers who may take months or years to evaluate and decide on whether to purchase the product, whereas in Opposer's industry the computer mouse is sold through retail outlets where the purchasing decision is impulsive and involves an individual deciding whether to purchase the mouse primarily based on price, external appearance, packaging, etc.

25. There is no likelihood of confusion as to the source or sponsorship of Applicant's and Opposer's goods because of the marks used thereon, since a Microprocessor Chip is comparable in size to a human thumb nail and is awkward to handle manually, whereas a computer mouse is necessarily designed to be large to fit comfortably in a user's hand.

26. There is no likelihood of confusion as to the source or sponsorship of Applicant's and Opposer's goods because of the marks used thereon, since in

Applicant's industry a single purchaser typically will purchase tens of thousands of Microprocessor Chips over a period of several years based on multi-million-dollar, detailed long-term contracts for multiple chip configurations, whereas in Opposer's industry customers typically will purchase the computer mouse over the counter or the Internet and without any purchase contracts, as a single unit or in small quantities, for a retail price of a few dollars, and without comparable deliberation.

FIFTH AFFIRMATIVE DEFENSE

27. As a Fifth and Separate Affirmative Defense, Applicant alleges that use of the X-Gene mark by Applicant and use of the  mark by Opposer are not likely to result in damage to Opposer's reputation or goodwill.

28. As set forth above in paragraphs 17-27, because there is no likelihood of confusion as to the source or sponsorship of Applicant's and Opposer's goods due to the marks used thereon, the use of the X-Gene mark by Applicant is not likely to result in damage to Opposer's reputation or goodwill.

SIXTH AFFIRMATIVE DEFENSE

29. As a Sixth and Separate Affirmative Defense, Applicant alleges that the Notice of Opposition and each allegation contained therein fails to state facts sufficient to constitute a valid opposition to the Application.

SEVENTH AFFIRMATIVE DEFENSE

30. As a Seventh and Separate Affirmative Defense, Applicant is informed and believes, and on such information and belief, alleges that Opposer engaged in conduct that constituted a waiver and release of its rights to oppose the Application.

EIGHT AFFIRMATIVE DEFENSE

31. As an Eight and Separate Affirmative Defense, Applicant is informed and believes, and on such information and belief, alleges that by reason of Opposer's conduct which constitutes laches, Opposer is barred from opposing this Application.

NINTH AFFIRMATIVE DEFENSE

32. As a Ninth and Separate Affirmative Defense, Applicant is informed and believes, and on such information and belief, alleges that by reason of Opposer's conduct which constitutes "unclean hands", Opposer is barred from opposing this Application

TENTH AFFIRMATIVE DEFENSE

33. As a Tenth and Separate Affirmative Defense, Applicant alleges that Opposer's claims and allegations are unclear, uncertain and ambiguous and do

not provide Applicant sufficient information to adequately respond to this Opposition Notice. Applicant is informed and believes, and on such information and belief, alleges that there may be additional defenses available to Applicant, which are not fully known and which Applicant is not now aware. Therefore, Applicant reserves the right to raise and assert such additional defenses once such defenses have been ascertained.

WHEREFORE, Applicant prays that the Trademark Trial and Appeal Board dismisses with prejudice Opposer's Opposition Notice and allows Applicant's mark to be registered in the United States Patent and Trademark Office.

Applicant hereby appoints L. William Caraccio, Vice President and General Counsel of Applied Micro Circuits Corporation and a member of the California and New York State Bars, and Raj Jaipershad, Patent Attorney for Applied Micro Circuits Corporation, US Patent Attorney Reg. No. 44,168 and a member of the New York State Bar, with a correspondence address at:

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to act as its attorneys and to transact all business in connection with this Opposition proceeding.

Respectfully submitted,

/R.Jaipershad/

L. William Caraccio, Esq.

Raj Jaipershad, Esq.

Attorneys for Applicant

Dated: December 30, 2013

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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 ANSWER TO NOTICE OF OPPOSITION has been served on the following by delivering said copy on December 30, 2013, via First Class Mail, postage prepaid, 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: _____

Raj Jaipershad,
Attorney for Applicant