

ESTTA Tracking number: **ESTTA455617**

Filing date: **02/09/2012**

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

**Petition for Cancellation**

Notice is hereby given that the following party requests to cancel indicated registration.

**Petitioner Information**

Name	Embarcadero Technologies, Inc.		
Entity	Corporation	Citizenship	Delaware
Address	100 California Street, 12th Floor San Francisco, CA 94111 UNITED STATES		

Attorney information	Martin R. Greenstein TechMark a Law Corporation 4820 Harwood Road, 2nd Floor San Jose, CA 95124 UNITED STATES MRG@TechMark.com, MPV@TechMark.com, LZH@TechMark.com , AMR@TechMark.com Phone:408-266-4700
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**Registration Subject to Cancellation**

Registration No	3768914	Registration date	03/30/2010
Registrant	Delphix Corp. 960 San Antonio Road, 2nd Fl. Palo Alto, CA 94303 UNITED STATES		

**Goods/Services Subject to Cancellation**

Class 009. First Use: 2009/01/31 First Use In Commerce: 2009/12/03 All goods and services in the class are cancelled, namely: Computer software for use in database management; Database management software for managing database storage and provisioning functions
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**Grounds for Cancellation**

False suggestion of a connection	Trademark Act section 2(a)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Priority and likelihood of confusion	Trademark Act section 2(d)

Related Proceedings	US Opposition #91197762
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**Marks Cited by Petitioner as Basis for Cancellation**

U.S. Registration No.	2873025	Application Date	06/09/1994
Registration Date	08/17/2004	Foreign Priority	NONE

		Date	
Word Mark	DELPHI		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1994/10/05 First Use In Commerce: 1994/10/05 computer programs for use in the filed of compilers, assemblers, application development, tools and utilities, database implementation reporting and connectivity, user interfaces, visual development tools and programming tools and utilities and instructional manuals sold therewith		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	DELPHI		
Goods/Services	Computer software		

Attachments	DELPHIX-3768914-PetCancel-Final.pdf ( 7 pages )(73894 bytes ) DELPHI-2873025-TARR & Assignment Records.pdf ( 7 pages )(121963 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	/Mariela P Vidolova/
Name	Mariela P. Vidolova
Date	02/09/2012

**CERTIFICATE OF ELECTRONIC FILING AND  
STANDBY AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT**

I hereby certify that this Petition to Cancel is being filed with the TTAB via ESTTA on the date set forth below, and the \$300 (per class) statutory filing fee paid. Please charge any deficiency or any additional fees in connection with this Petition to Cancel to TechMark's PTO Deposit Account No. 20-0330.

Date: February 9, 2012

/Mariela P Vidolova/

Mariela P. Vidolova

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

IN THE MATTER OF:

Reg. No. 3,768,914 for **DELPHIX (Logo)**, Class 09, registered March 30, 2010

<p><b>EMBARCADERO TECHNOLOGIES, INC.</b></p>
--------------------------------------------------

**Petitioner**

v.

<p><b>DELPHIX CORP.,</b></p>
------------------------------

**Registrant.**

**Cancellation No.:**

**Reg. No.: 3,768,914**

**TM: DELPHIX (Logo)**

**PETITION TO CANCEL**

EMBARCADERO TECHNOLOGIES, INC., a Delaware corporation located at 100 California St., 12 Floor, San Francisco, CA 94111 (hereafter "Embarcadero" or "Petitioner") believes it is or will be damaged by continued registration on the Principal Register of the mark **DELPHIX (Logo)** of Reg. No. 3,768,914 and hereby petitions to cancel the same.

As grounds of cancellation it is alleged that:

1. Petitioner Embarcadero, and its predecessors in title and interest are now and have for many years been engaged in the development, marketing, advertising, distribution and sale of various computer software products, including, among others, computer software for database modeling, creation and management, for virtualization, and for software applications development, *inter alia*, and for related services.

2. Petitioner Embarcadero, through its wholly owned subsidiary CodeGear LLC, is the owner of the trade name and trademark **DELPHI**, having used said name and mark continuously in interstate commerce on and in connection with computer software and programs since long prior to the January 14, 2009 filing date of Registrant 's U.S. Reg. No. 3,768,914, which is the subject of the instant petition to cancel.

3. Petitioner Embarcadero, through its wholly owned subsidiary CodeGear LLC, is also the owner of U.S. Reg. No. 2,873,025 for the mark **DELPHI**, issued August 17, 2004 on the Principal Register of the U.S. Patent and Trademark Office. Printouts of the PTO TARR and Assignment databases are attached hereto pursuant to Rule 2.122(d) as Exhibit A, and the registration is placed in evidence.

4. A Declaration under Section 15 was filed and acknowledged for U.S. Reg. No. 2,873,025 for the mark **DELPHI**, and Reg. No. 2,873,025 is incontestible and conclusive evidence of Petitioner's exclusive rights therein as provided under the Lanham Act.

5. Registrant Delphix Corp. ("Delphix" or "Registrant"), who is listed as a Delaware corporation and whose address is given as 960 San Antonio Road, 2 Floor, Palo Alto, CA 94303, obtained Reg. No. 3,768,914 on March 30, 2010, claiming use of the mark **DELPHIX (Logo)** on "computer software for use in database management; database management software for managing database storage and provisioning functions" in Int. Class 09.

6. Registrant claims first use of the mark **DELPHIX (Logo)** since January 31, 2009 and first use in commerce since December 03, 2009.

7. On information and belief, Registrant did not make any actual commercial or bona

fide trademark use of the mark **DELPHIX (Logo)** in commerce or otherwise prior to the January 31, 2009 first use date for Reg. No. 3,768,914 on the goods set forth therein, or on or in connection with closely related goods or services.

8. The goods in connection with which Registrant claims to use the mark **DELPHIX (Logo)** are identical or very similar to, used for the same or similar purposes, and/or are or will be advertised and promoted to and directed at the same trade channels, the same purchasers, and are or will be used in the same environment as Petitioner Embarcadero's software products and related goods or services.

9. Simultaneous use by Registrant of the mark **DELPHIX (Logo)** on the goods set forth in Reg. No. 3,768,914, and Petitioner Embarcadero's **DELPHI** mark on its goods as set forth above is likely to cause confusion, mistake or deception among purchasers, users and the public, thereby damaging Petitioner.

10. Use by Registrant of the alleged mark **DELPHIX (Logo)** on the goods set forth in Reg. No. 3,768,914 is likely to lead to the mistaken belief that Registrant's goods are sponsored by, affiliated with, approved by or otherwise emanate from Petitioner Embarcadero, thereby damaging Petitioner.

11. Registrant claims to have chosen the mark **DELPHIX (Logo)** as a reference to the legendary Greek oracle at Delphi, and then, for reasons not explained, added an "X" to the end of DELPHI, stating on its website:

**Virtualizing Database Infrastructure**

**About the name: the most important oracle in the classical Greek world was located in the town of Delphi.**

12. The letter or Roman numeral "X" is often used in the computer and software industry to designate or identify a version number, e.g., Version X or 10 as in Adobe's Acrobat X

or Apple's Mac OS X, or to designate an eXtended or enhanced version of a product, e.g. Microsoft's DirectX. As such, the mark **DELPHIX (Logo)** is likely to be seen or understood to be **DelphiX** or **Delphi-X**, and to be pronounced as **Delphi X**, further exacerbating the likelihood of confusion with Petitioner Embarcadero's **DELPHI** mark.

13. Upon information and belief, Registrant knew or should have known of Petitioner's prior adoption and use of Petitioner's **DELPHI** mark and Petitioner's ownership of U.S. Reg. No. 2,873,025, and therefore could not have formed the requisite good faith belief that Registrant is the owner of the mark sought to be registered, and that no other person, firm, corporation or association has the right to use said mark in commerce, and consequently knew that such use is and would be in derogation and violation of Petitioner Embarcadero's rights.

14. On information and belief, Registrant did not have at the time of filing or at any time thereafter the requisite bona fide intent to use the mark **DELPHIX (Logo)** in commerce or otherwise on or in connection with all of the goods set forth in U.S. Reg. No. 3,768,914.

15. On information, belief, and the facts as laid out in paragraphs 16-23, based on due investigation, Registrant knowingly made false, material representations to the US PTO with the intent to deceive, when it filed the Statement of Use for the mark **DELPHIX (Logo)** and the subsequent substitute specimen of use for said mark along with the requisite Declarations accompanying such submissions. Accordingly, the mark of Reg. No. 3,768,914 should be cancelled on the grounds of fraud.

16. On August 12, 2009, Jedidiah Yueh, in his stated capacity as CEO of Delphix, signed electronically and caused to be filed with the US PTO a Statement of Use for the mark **DELPHIX (Logo)**. In said Statement of Use Registrant declared under oath that: "the mark was first used by the applicant, or the applicant's related company, licensee, or predecessor in interest at least as early as 01/31/2009, and first used in commerce at least as early as 03/01/2009, and is now in use in such commerce" on the Class 9 goods.

17. The specimen submitted along with the Statement of Use filing for the mark **DELPHIX (Logo)**, described as Delphix Data sheet, has the following notation at the bottom of the page: “© 2009 Delphix Corp. All rights reserved. Delphix is not currently GA. Draft specifications subject to change without notice. All information in this data sheet is strictly confidential. Please do not copy or distribute to other parties.”

18. On February 3, 2010, Jedidiah Yueh, in his stated capacity as President and CEO of Delphix, signed electronically and caused to be filed with the US PTO substitute/new specimen of use for the mark **DELPHIX (Logo)** in a Response to Office Action to overcome the refusal of the initial specimen. In this Response Registrant declared under oath that: “In International Class 009, the mark was first used at least as early as 01/31/2009. and first used in commerce at least as early as 12/03/2009”.

19. Based on the results of due investigation and public notices regarding the release date of the actual product under the **DELPHIX (Logo)** mark, such product was launched and became generally and widely available only on or after September 14, 2010.

20. Based on the results of due investigation, the physical appearance of the specimen documents available for Reg. No. 3,768,914 and the public notices regarding the launch date of the actual product under the **DELPHIX (Logo)** mark, such mark was not in bona fide commercial use in commerce at the time of filing the Statement of Use and/or at the time of filing the substitute/new specimen of use as the product was launched and/or released only on or after September 14, 2010 and Registrant had specific knowledge of this at the time of filing. As such, the Statement of Use and the subsequent filing of substitute/new specimen of use are material representations that are knowingly false and made with the intent to deceive the US PTO into believing the mark was in bona fide commercial use in commerce, with the sole purpose of obtaining registration for the mark **DELPHIX (Logo)** on the US PTO register.

21. Based on the results of due investigation, the above-mentioned physical appearance of the specimen documents available for Reg. No. 3,768,914, and the public notices regarding the release date of the actual product under the **DELPHIX (Logo)** mark, Registrant had knowledge at the time of submitting the specimen in connection with its Statement of Use and the substitute/new specimen filed along with the response to office action that the mark was not in bona fide commercial use, and knowingly and intentionally made a material misrepresentation to the US PTO by signing and causing to be submitted said specimens and false and fraudulent Statement of Use declarations anyway in a conscious effort to deceive the PTO into issuing the registration.

22. Based on the results of due investigation and the above facts, the declarations accompanying the Statement of Use and Response to Office Action submissions to the effect that the subject mark was in use in commerce were knowingly fraudulent statements given solely with the intent to deceive the PTO.

23. The material misrepresentations described herein were made with the intent to deceive the US PTO with the express purpose of causing the US PTO to accept the filing of a Statement of Use and a substitute/new specimen that should not have been submitted and to issue on the register a registration which was not yet in commercial use. The USPTO reasonably relied upon the truth of said fraudulent statements in granting the registration.

Wherefore, Petitioner requests that U.S. Reg. No. 3,768,914, be canceled and that this Petition to Cancel be sustained.

The sum of \$300 for the statutory fee for this Petition to Cancel has been paid at the time of filing. Any deficiency or shortfall, or any additional fees in connection with this cancellation at any time should be charged to TechMark's PTO Deposit Account No. 20-0330.

Please recognize Martin R. Greenstein, Neil D. Greenstein, Mariela P. Vidolova, Leah Z. Halpert and Lee D. Green, members in good standing of the Bar of the State of California, c/o TechMark, 4820 Harwood Road, 2 Floor, San Jose, California 95124-5273, Tel: 408-266-4700, as Petitioner Embarcadero's attorneys in connection with this cancellation proceeding. All correspondence should be directed to Martin R. Greenstein.

EMBARCADERO TECHNOLOGIES, INC.  
By /Martin R Greenstein/  
Martin R. Greenstein  
Mariela P. Vidolova  
Leah Z. Halpert  
TechMark a Law Corporation  
4820 Harwood Road, 2<sup>nd</sup> Floor  
San Jose, CA 95124-5273  
Tel: 408- 266-4700 Fax: 408-850-1955  
E-Mail: MRG@TechMark.com  
Attorneys for Petitioner Embarcadero Technologies, Inc.

Dated: February 9, 2012

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing **PETITION TO CANCEL** is being served on February 9, 2012, by deposit of same in the United States Mail, first class postage prepaid, in an envelope addressed to Registrant at the address of record shown on the US PTO website, namely:

Delphix Corp.  
960 San Antonio Road, 2nd Fl.  
Palo Alto, CA 94303  
United States

/Mariela P Vidolova/  
Mariela P. Vidolova

# **EXHIBIT A**

Thank you for your request. Here are the latest results from the [TARR web server](#).

This page was generated by the TARR system on 2012-02-08 20:01:23 ET

Serial Number: 74535376 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 2873025

Mark (words only): DELPHI

Standard Character claim: No

Current Status: A Sections 8 and 15 combined declaration has been accepted and acknowledged.

Date of Status: 2010-09-01

Filing Date: 1994-06-09

Transformed into a National Application: No

Registration Date: 2004-08-17

Register: Principal

Law Office Assigned: LAW OFFICE 102

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov)

Current Location: L20 -TMEG Law Office 102

Date In Location: 2010-09-01

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**LAST APPLICANT(S)/OWNER(S) OF RECORD**

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1. CODEGEAR LLC

**Address:**

CODEGEAR LLC  
100 ENTERPRISE WAY  
SCOTTS VALLEY, CA 95066  
United States

**Legal Entity Type:** Limited Liability Company  
**State or Country Where Organized:** Delaware

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**GOODS AND/OR SERVICES**

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**International Class:** 009

**Class Status:** Active

computer programs for use in the filed of compilers, assemblers, application development, tools and utilities, database implementation reporting and connectivity, user interfaces, visual development tools and programming tools and utilities and instructional manuals sold therewith

**Basis:** 1(a)

**First Use Date:** 1994-10-05

**First Use in Commerce Date:** 1994-10-05

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#### ADDITIONAL INFORMATION

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(NOT AVAILABLE)

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#### MADRID PROTOCOL INFORMATION

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(NOT AVAILABLE)

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#### PROSECUTION HISTORY

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**NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.**

2010-09-01 - Section 8 (6-year) accepted & Section 15 acknowledged

2010-09-01 - Case Assigned To Post Registration Paralegal

2010-08-12 - TEAS Section 8 & 15 Received

2009-07-07 - Case File In TICRS

2009-05-20 - Assignment Of Ownership Not Updated Automatically

2008-07-02 - Automatic Update Of Assignment Of Ownership

2007-01-14 - TEAS Change Of Correspondence Received

2004-08-17 - Registered - Principal Register

2003-01-30 - Opposition terminated for Proceeding

2003-01-30 - Opposition dismissed for Proceeding

2001-05-01 - Opposition terminated for Proceeding

2000-09-12 - Opposition sustained for Proceeding

1996-10-24 - Opposition instituted for Proceeding

1996-07-16 - Extension Of Time To Oppose Received  
1996-07-02 - Published for opposition  
1996-05-31 - Notice of publication  
1995-05-02 - Approved for Pub - Principal Register (Initial exam)  
1995-05-02 - Amendment to Use approved  
1995-05-02 - Amendment To Use Processing Complete  
1994-12-09 - Use Amendment Filed  
1995-05-02 - Previous Allowance Count Withdrawn  
1995-02-21 - Approved for Pub - Principal Register (Initial exam)  
1995-02-14 - Examiner's amendment mailed  
1995-02-13 - Previous Allowance Count Withdrawn  
1995-02-13 - Approved for Pub - Principal Register (Initial exam)  
1995-02-06 - Examiner's amendment mailed  
1995-05-02 - Previous Action Count Withdrawn  
1995-01-17 - Non-final action mailed  
1994-12-29 - Previous Allowance Count Withdrawn  
1994-12-12 - Approved For Pub - Principal Register  
1994-12-07 - Examiner's amendment mailed  
1994-11-18 - Non-final action mailed  
1994-11-07 - Assigned To Examiner  
1994-11-04 - Assigned To Examiner

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**ATTORNEY/CORRESPONDENT INFORMATION**

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**Attorney of Record**

Martin R. Greenstein

**Correspondent**

Martin R. Greenstein

TECHMARK A LAW CORPORATION

4820 HARWOOD ROAD, 2ND FLOOR

SAN JOSE CA 95124-5273

Phone Number: 408-266-4700

Fax Number: 408-850-1955

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## United States Patent and Trademark Office

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Assignments on the Web > [Trademark Query](#)

## Trademark Assignment Abstract of Title

**Total Assignments: 5**Serial #: [74535376](#)

Filing Dt: 06/09/1994

Reg #: [2873025](#)

Reg. Dt: 08/17/2004

Registrant: BORLAND INTERNATIONAL, INC.

Mark: DELPHI

**Assignment: 1**Reel/Frame: [1991/0687](#)

Received: 11/24/1999

Recorded: 11/16/1999

Pages: 5

Conveyance: CHANGE OF NAME

Assignor: [BORLAND INTERNATIONAL, INC.](#)

Exec Dt: 06/05/1998

Entity Type: CORPORATION

Citizenship: DELAWARE

Entity Type: CORPORATION

Citizenship: DELAWARE

Assignee: [INPRISE CORPORATION](#)100 ENTERPRISE WAY  
SCOTTS VALLEY, CALIFORNIA 95066**Correspondent:** TECHMARKMARTIN R. GREENSTEIN, ESQ.  
55 SOUTH MARKET STREET, 16TH FLOOR  
SAN JOSE, CA 95113**Assignment: 2**Reel/Frame: [2316/0893](#)

Received: 06/21/2001

Recorded: 06/11/2001

Pages: 11

Conveyance: MERGER &amp; CHANGE OF NAME

Assignor: [INPRISE CORPORATION](#)

Exec Dt: 01/22/2001

Entity Type: CORPORATION

Citizenship: DELAWARE

Entity Type: CORPORATION

Citizenship: DELAWARE

Assignee: [BORLAND SOFTWARE CORPORATION](#)100 ENTERPRISE WAY  
SCOTTS VALLEY, CALIFORNIA 95066**Correspondent:** TECHMARKMARTIN R. GREENSTEIN  
55 SOUTH MARKET STREET, 16TH FLOOR  
SAN JOSE, CA 95113**Assignment: 3**Reel/Frame: [3805/0406](#)

Received: 06/27/2008

Recorded: 06/27/2008

Pages: 7

Conveyance: ASSIGNS THE ENTIRE INTEREST

Assignor: [BORLAND SOFTWARE CORPORATION](#)

Exec Dt: 06/17/2008

Entity Type: CORPORATION

Citizenship: DELAWARE

Entity Type: LIMITED LIABILITY COMPANY

Citizenship: DELAWARE

Assignee: [CODEGEAR LLC](#)100 ENTERPRISE WAY  
SCOTTS VALLEY, CALIFORNIA 95066**Correspondent:** TECHMARK A LAW CORPORATION4820 HARWOOD ROAD, 2ND FLOOR  
ATTN: MARTIN R. GREENSTEIN  
SAN JOSE, CA 95124-5273**Assignment: 4**Reel/Frame: [3986/0892](#)

Received: 05/13/2009

Recorded: 05/13/2009

Pages: 8

Conveyance: FIRST LIEN TRADEMARK SECURITY AGREEMENT

Assignor: [CODEGEAR LLC](#)

Exec Dt: 09/30/2008

Entity Type: LIMITED LIABILITY COMPANY

Citizenship: DELAWARE

**Assignee:** [WELLS FARGO FOOTHILL, INC., AS AGENT](#)

2450 COLORADO AVENUE  
SUITE 3000W  
SANTA MONICA, CALIFORNIA 90404

**Entity Type:** CORPORATION

**Citizenship:** CALIFORNIA

**Correspondent:** PALAK SHAH

PAUL, HASTINGS, JANOFSKY & WALKER LLP  
515 S. FLOWER STREET, 25TH FLOOR  
LOS ANGELES, CA 90071

**Assignment: 5**

**Reel/Frame:** [3986/0909](#)

**Received:** 05/13/2009

**Recorded:** 05/13/2009

**Pages:** 8

**Conveyance:** SECOND LIEN TRADEMARK SECURITY AGREEMENT

**Assignor:** [CODEGEAR LLC](#)

**Exec Dt:** 09/30/2008

**Entity Type:** LIMITED LIABILITY COMPANY

**Citizenship:** DELAWARE

**Assignee:** [WELLS FARGO FOOTHILL, INC., AS AGENT](#)

2450 COLORADO AVENUE  
SUITE 3000W  
SANTA MONICA, CALIFORNIA 90071

**Entity Type:** CORPORATION

**Citizenship:** CALIFORNIA

**Correspondent:** PALAK SHAH

PAUL, HASTINGS, JANOFSKY & WALKER LLP  
515 S. FLOWER STREET, 25TH FLOOR  
LOS ANGELES, CA 90071

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Web interface last modified: Dec 1, 2011 v2.3

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