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

Proceeding	92056816
Party	Defendant VIA Technologies, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Google Inc.,

Petitioner,

v.

VIA Technologies, Inc.,

Registrant.

Cancellation No.: 92056816

Registration No.: 3,360,331

Mark: CHROME

Issued: December 25, 2007

Registration No.: 3,951,287

Mark: CHROME

Issued: April 26, 2011

ANSWER AND AFFIRMATIVE DEFENSES

Registrant VIA Technologies, Inc. (“Registrant”) of United States Registration Nos. 3,360,331 for CHROME and 3,951,287 for CHROME (“Subject Registrations”) hereby files the following answer and affirmative defenses in response to Google, Inc. (“Petitioner” or “Google”)’s Consolidated Petition for Cancellation (“Petition for Cancellation”).

Answer to Allegations in Petition for Cancellation

1. Registrant admits that Google is a Delaware corporation having its principal place of business at 1600 Amphitheatre Parkway, Mountain View, California 94043.
2. Registrant admits that it is a Taiwanese corporation having its principal place of business at 533 Chung-Cheng Road, 8th Floor, Hsin-Tien, Taipei, Taiwan.
3. Registrant admits that according to the United States Trademark Office database, Google is identified as the owner and applicant of the following U.S. trademark applications:
 - Serial No. 85/462,997, filed on November 2, 2011, for CHROME;
 - Serial No. 85/463,547, filed on November 3, 2011, for GOOGLE CHROME;
 - Serial No. 85/463,562, filed on November 3, 2011, for CHROMEBOOK;
 - Serial No. 85/463,991, filed on November 3, 2011 for CHROME and Design; and

- Serial No. 85/464,001, filed on November 3, 2011, for CHROMEBOX (collectively, the "Google CHROME Applications").

4. Registrant admits that on or about February 22, 2007, Registrant filed Application Serial No. 77/113,063 for CHROME covering certain goods in Class 9 based on its bona fide intent to use the mark in United States commerce for all goods listed in the application.

Registrant further admits that on or about October 12, 2007, Registrant submitted a Statement of Use in support of Application Serial No. 77/113,063 declaring “[it] is using the mark in commerce on or in connection with the goods/services identified above, as evidenced by the attached specimen(s) showing the mark as used in commerce.” Registrant further admits that on or about December 25, 2007, Registration No. 3,360,331 issued.

5. Registrant denies that Registration No. 3,360,331 covers the goods identified in the Petition for Cancellation as Registrant has submitted a Combined Declaration of Use and Incontestability under Sections 8 and 15 and states that Registration No. 3,360,331 covers the following Class 9 goods: “computers, namely, personal computers, portable computers, notebook computers, microcomputers, desktop computers; computer system components, parts and fittings, namely, motherboards, central processing units (CPUs), base PC modules, computer hardware, namely, semiconductors, microprocessors, graphics processors, integrated circuits, computer chips, computer motherboards, computer graphics boards, computer interface boards, computer accelerator board, circuit boards, computer memory cards, memory chips, computer firmware, namely, computer utility software and other computer software used to maintain and operate computer system all stored in a computer's read only memory or elsewhere in the computer's circuitry, operating system software; printed and electronic instructional manuals, specification sheets, data sheets, computer reference manuals, user guides and documents providing instruction in the use and operation of various electronic digital devices, sold as a unit

therewith the aforesaid good.”

6. Registrant admits that on or about February 14, 2013, Registrant filed a Combined Declaration of Use and Incontestability under Sections 8 and 15 deleting the following goods: “handheld computers, computer housing, computer casing, computer chassis, computer frames, hard drives, disc drives, computer keyboards, computer printers, computer monitors, computer cables, disc and tape controller cards, scanners, computer mice, joysticks, microphones; computer network adapters, networking switches, routers, modems, power adapters for computers; hand-held devices, namely, Personal Digital Assistants (PDAs), electronic personal organizers, MP3 players; BIOS software, pre-recorded computer discs featuring documentary programs, drama, musical entertainment, blank magnetic data carriers, electronic computer locks, computer speakers, computer peripherals, multimedia and digital displays, namely, CRT monitors, DVI displays, LCD panels, HDTV displays, GPS navigational displays and automotive visual displays, input devices, namely, software and hardware for management, storage, communications and network management of digital media and enhancement of graphical and video display; portable computer carry bags; cases to carry CDs and DVDs.” Registrant further admits that in the Combined Declaration of Use and Incontestability under Sections 8 and 15, Registrant submitted a declaration that “the mark has been continuously used in commerce for five (5) consecutive years after the date of registration, or the date of publication under Section 12(c), and is still in use in commerce on or in connection with these goods or services” with respect to the following goods: “computers, namely, personal computers, portable computers, notebook computers, microcomputers, desktop computers; computer system components, parts and fittings, namely, motherboards, central processing units (CPUs), base PC modules, computer hardware, namely, semiconductors, microprocessors, graphics processors, integrated circuits, computer chips, computer motherboards, computer graphics boards, computer interface boards,

computer accelerator board, circuit boards, computer memory cards, memory chips, computer firmware, namely, computer utility software and other computer software used to maintain and operate computer system all stored in a computer's read only memory or elsewhere in the computer's circuitry, operating system software; printed and electronic instructional manuals, specification sheets, data sheets, computer reference manuals, user guides and documents providing instruction in the use and operation of various electronic digital devices, sold as a unit therewith the aforesaid good.”

7. Registrant admits that on or about September 9, 2008, Registrant filed Application Serial No. 77/566,090 for CHROME covering certain services in Class 42 based on its bona fide intent to use the mark in United States commerce for all services listed in the application. Registrant further admits that on or about March 1, 2011, Registrant submitted a Statement of Use in support of Application Serial No. 77/566,090 declaring that “[it] is using the mark in commerce on or in connection with the goods/services identified above, as evidenced by the attached specimen(s) showing the mark as used in commerce.” Registrant further admits that on or about April 26, 2011, Registration No. 3,951,287 issued.

8. Registrant admits that Registration No. 3,951,287 covers the following Class 42 services: “computer services, namely, providing on-line information available on computer networks, global information networks and wireless communication networks in the fields of the design, development and customization of computer hardware, computer software, computer graphics software, information technology, wireless communication devices, multimedia technology, robotics, namely, the design and development of new technology in the field of robotics, business computing and environmentally-friendly computing, and specifically excluding computer games and video games, using both an interactive and non-interactive format; technical support services, namely, troubleshooting of computer hardware and software

problems in person, by telephone, by electronic, computer and communications networks; provision of computer systems analysis and computer diagnostic services; design of computer hardware, integrated circuits, computer networks and communications hardware and software for others; consultancy in the field of design, development, configuration, installation, updating, upgrading or maintenance of computer software - excluding computer game and video game software; computer programming for others; research and development of 3d content, 3d technology and processes, 3d animation technology, 3d processing power, 3d techniques, and flexible forward projection; creating, designing and maintaining web sites.”

9. Registrant admits the USPTO has issued Office Actions against each of the Google CHROME Applications and has refused registration based on, among other reasons, the Subject Registrations.

10. Denied.

11. Denied.

12. Denied.

FIRST CLAIM FOR RELIEF:

13. Registrant repeats each and every answer set forth in paragraphs 1 through 12 as if fully set forth herein.

14. Denied.

15. Denied.

16. Denied.

17. Denied.

18. Denied.

SECOND CLAIM FOR RELIEF:

19. Registrant repeats each and every answer set forth in paragraphs 1 through 18 as if fully set forth herein.

20. Denied.

21. Denied.

22. Denied.

23. Denied.

Response to Petitioner’s Prayer for Relief

The allegations in the paragraph requesting relief are in the nature of a prayer. Although no answer is required, Registrant responds to the request for relief as follows: Registrant denies that Petitioner is entitled to the requested relief, and Registrant respectfully requests that this cancellation proceeding be dismissed, with prejudice.

AFFIRMATIVE DEFENSES

Failure to State a Claim for Relief

1. Petitioner has failed to state facts sufficient to constitute a basis for relief as Registrant has used the marks in the Subject Registrations in United States commerce and has not abandoned them.

Unclean Hands and/or Inequitable Conduct

2. As a result of Petitioner’s conduct and/or the conduct of others attributable to it, Petitioner is guilty of unclean hands and/or inequitable conduct, and so is barred from maintaining the claims asserted in the Petition for Cancellation.

Waiver

3. Petitioner’s alleged claims are barred by the doctrine of waiver.

Laches

4. Petitioner's alleged claims are barred by the doctrine of laches.

Estoppel

5. Petitioner's alleged claims are barred by the doctrine of estoppel.
6. Registrant gives notice that it intends to rely on any additional affirmative defenses that become available or apparent through discovery and the factual development in this case or otherwise, and thus reserves the right to amend its answer to assert such additional and/or different defenses.

WHEREFORE, Registrant prays for judgment as follows:

1. That the Petition for Cancellation be dismissed in its entirety with prejudice;
2. That judgment be entered in favor of Registrant and against Petitioner; and
3. For such other and further relief as may be permitted by law and/or as the Board may deem just and proper.

Dated: June 3, 2013

Respectfully submitted,



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CERTIFICATE OF SERVICE

I hereby certify that on June 3, 2013, one (1) true and correct copy of the foregoing document has been served on Petitioner by mailing the same via First Class Mail and electronic mail to:

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Attorneys for Petitioner Google Inc.

Dated: June 3, 2013

/s/ Anne Zivkovic
Anne Zivkovic