

ESTTA Tracking number: **ESTTA7808**

Filing date: **04/20/2004**

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

<b>Proceeding</b>	91159770
<b>Party</b>	Defendant Zarlink Semiconductor Inc. Zarlink Semiconductor Inc. 400 March Road CAX Ottawa, Ontario, K2K 3H4
<b>Correspondence Address</b>	JANICE W. HOUSEY ROBERTS MLOTKOWSKI & HOBBS PC Suite 850 8270 Greensboro Drive McLean, VA 22102
<b>Submission</b>	Answer
<b>Filer's Name</b>	Janice W. Housey
<b>Filer's e-mail</b>	jhousey@rmhlaw.com
<b>Signature</b>	/Janice W. Housey/
<b>Date</b>	04/20/2004
<b>Attachments</b>	EMULEX ANSWER FINAL.txt ( 3 pages )

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Emulex Corporation	:	
Opposer,	:	
	:	
v.	:	
Opposition No. 91159770	:	
	:	
Zarlink Semiconductor Inc.	:	Ser. No.
78/084440	:	
	:	Mark: De
sign	:	
	:	
Applicant.	:	

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ANSWER and COUNTERCLAIM

Applicant, Zarlink Semiconductor Inc., hereby answers the Notice of

Opposition filed by Emulex Corporation ("Opposer") as follows:

1. Applicant admits that many of Opposer's generic statements describing computer technology are accurate. However, Applicant does not have sufficient knowledge regarding the statements regarding Opposer's business and Opposer's use of its alleged mark and therefore, denies the same.
2. Applicant is without sufficient knowledge to admit or deny the statement in this paragraph and therefore, denies the same.
3. Applicant is without sufficient knowledge to admit or deny the statement in this paragraph and therefore, denies the same.
4. Applicant is without sufficient knowledge to admit or deny the statement in this paragraph and therefore, denies the same.
5. Applicant denies that Opposer obtained a registration as described.
6. Applicant is without sufficient knowledge to admit or deny the statement in this paragraph regarding common law rights to the EXE Design mark alone and therefore, denies the same. Applicant further denies that Exhibit B displays use of the EXE Design mark alone.
7. Applicant is without sufficient knowledge to admit or deny the statement in this paragraph and therefore, denies the same.
8. Applicant admits with the exception that Applicant denies that its mark consists of an EXE design.
9. Applicant admits.
10. Applicant denies.
11. Applicant admits that many of Opposer's generic statements describing computer technology are accurate. However, Applicant does not have sufficient knowledge regarding the statements regarding Opposer's business and its use of its alleged trademarks and therefore, denies the same. Applicant denies that its goods are complementary or related to Opposer's goods.
12. Applicant is without sufficient knowledge to admit or deny the statement in this paragraph and therefore, denies the same.
13. Applicant denies.

14. Applicant denies.

COUNTERCLAIM

1. Registration Number 1,261,502 claimed by Opposer as a basis for the subject opposition was filed for EMULEX and the EXE design. However, the issued registration in error showed just the EXE design. In the more than 20 year term of the alleged registration, Opposer has made no attempt to correct this inaccuracy at any time, including when Opposer filed its Section 8 & 15 Declaration, when it filed its renewal documentation and when it filed the subject opposition.

2. The documents submitted by Opposer in connection with its alleged registration included statements referring to the registered mark but made no reference to the contradiction between the mark as filed and the mark as registered. The relevant declarations indicated that all statements were true.

3. Upon information and belief, Opposer made no attempt to correct the PTO error because the registration, as granted, provided Opposer with broader protection for the design element of its mark than the protection to which Opposer was entitled.

4. Opposer has intentionally, willfully and fraudulently misstated the scope of its trademark registration rights to maintain a registration that is broader than the protection that would be rightfully afforded to it.

5. Such misstatements of scope were done with the intention of deceiving and/or defrauding the Trademark Office and other parties which rely on the accuracy of Trademark Office records.

6. Such misstatements constitute an abuse of the trademark registration system and the rights derived therefrom.

WHEREFORE, Applicant prays that:

(1) The subject opposition be dismissed and that its application be processed for registration; and

(2) Opposer's Reg. No. 1,261,502 be cancelled.

Respectfully submitted,

Zarlink Semiconductor In

c.

Date: April 20, 2004 /Janice W. Housey/

Janice W. Housey

Michael J. Mlotkowski

Counsel for Applicant

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CERTIFICATE OF MAILING

On this 20th day of April, 2004, a true and correct copy of the foregoing Answer was sent via first class mail, postage prepaid and addressed as follows:

Jennifer Lee Taylor

Morrison & Foerster LLP

425 Market Street

San Francisco, CA 94105-2482

y/

/Janice W. House

Janice W. Housey