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Filing date: **03/19/2008**

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

Proceeding	91159770
Party	Defendant Zarlink Semiconductor Inc.
Correspondence Address	Janice W. Housey Roberts Mlotkowski & Hobbes P.O. Box 10064 McLean, VA 22102 UNITED STATES
Submission	Opposition/Response to Motion
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Date	03/19/2008
Attachments	Applicant's Response to Opposer's Motion to take deps.pdf (4 pages)(20285 bytes)

denied and Applicant's depositions upon written questions of Peter Burke and Mike McGinn as noted in Applicant's Notices of Deposition upon Written Questions should be allowed to proceed.

Opposer has stated in its Motion that the importance of the proposed witnesses testimony and the fact that the witnesses are in Canada are outweighed by the perceived benefits of oral testimony. However, none of the allegations made by Opposer in its Motion are any different than the circumstances surrounding any typical opposition or cancellation proceeding involving a foreign party. That is, the foreign parties' witnesses are likely to be located in a foreign country and thus, the provisions for depositions upon written questions would be invoked.

Opposer argues that the number of questions in the written questions attached to the subject Notices of Deposition is indicative that the subject matter is too complex for written questions. However, as Opposer's counsel, and this honorable Board, will appreciate, the very nature of written question depositions are such that counsel posing the questions must ensure that the record (including the answers to counsel's questions) is clear and thus, a significant number of questions are required. Similarly, in oral depositions, a large number of questions are frequently asked as a deponent's answer to any particular question often raises other questions. Thus, the number of questions put forth in the subject Notices of Deposition is not relevant to an inquiry as to whether Opposer has met its burden in showing good cause that the subject depositions proceed orally.

Despite Opposer's contentions that the nature of the subject matter is unduly complex, Opposer has summarized the subject matter of Applicant's direct questions as

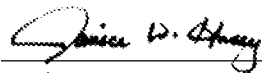
“whether Emulex’s use of its mark on products such as integrated circuits (or semiconductors), host bus adapters, and peripheral controllers is sufficiently related to semiconductors (the goods covered by Zarlink’s application.” Opposer’s Motion p. 4. Thus, based upon Opposer’s own summary of “the heart of [the] overarching question” raised in the deposition questions, it appears clear that the issues are not so complex as to be incapable of being fully addressed through written question depositions.

In light of the foregoing, Applicant respectfully requests that Applicant be allowed to proceed with its depositions upon written questions of Peter Burke and Mike McGinn as noted in its Notices of Deposition. Applicant further reiterates its prior request that Applicant’s testimony period be reset to end 30 days beyond the date of the Board’s decision on Emulex’s Motion to Require Applicant Zarlink Semiconductor Inc. to Take Foreign Depositions of Peter Burke and Mike McGinn Orally, and that all other trial dates be reset accordingly.

Respectfully submitted,

Roberts Mlotkowski & Hobbes
Counsel for Applicant

Date: March 19, 2008



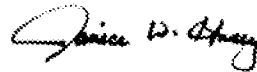
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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing APPLICANT'S RESPONSE TO OPPOSER'S MOTION TO REQUIRE APPLICANT TO TAKE FOREIGN DEPOSITIONS OF PETER BURKE AND MIKE MCGINN ORALLY is being sent via First Class Mail this 19th day of March 2008, postage prepaid and addressed as follows:

Jennifer Lee Taylor
Morrison & Foerster LLP
425 Market Street
San Francisco, CA 94105



Janice Housey