

ESTTA Tracking number: **ESTTA395249**

Filing date: **02/25/2011**

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

Proceeding	91193491
Party	Defendant Telefonica, S.A.
Correspondence Address	CHARLES P. LaPOLLA OSTROLENK, FABER, GERB & SOFFEN, LLP 1180 AVENUE OF THE AMERICAS , FLOOR 7 NEW YORK, NY 10036-8443 UNITED STATES CLaPolla@ostrolenk.com
Submission	Answer and Counterclaim
Filer's Name	Charles P. LaPolla
Filer's e-mail	clapolla@ostrolenk.com, smcmahon@ostrolenk.com, receipts@ostrolenk.com
Signature	/CPL/
Date	02/25/2011
Attachments	IMAGENIO ANSWER.PDF ( 5 pages )(149799 bytes )

Registration Subject to the filing

Registration No	2865458	Registration date	07/20/2004
Registrant	ATI TECHNOLOGIES ULC 700 2nd Street SW, Suite 1200 Calgary, Alberta, T2P 4V5, CANADA		
Grounds for filing	The registered mark has been abandoned.		

Goods/Services Subject to the filing

Class 009. First Use: 2003/04/11 First Use In Commerce: 2003/04/11 All goods and services in the class are requested, namely: graphics and multi-media co-processors to enable 2D and 3D graphics and video
--

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

-----X		
ATI TECHNOLOGIES ULC.		
	Opposer,	Opposition No.: 91193491
v.		Application No.: 78/812,301
TELEFONICA, S.A.		Mark: IMAGENIO
	Applicant	
-----X		

**ANSWER, AFFIRMATIVE DEFENSE AND COUNTERCLAIM**

Applicant, TELEFONICA, S.A., for its Answer, Affirmative Defense and Counterclaim to the Notice of Opposition, avers as follows:

1. Applicant is without knowledge or information sufficient to form a belief as the truth of the allegations contained in paragraph 1 of the Notice of Opposition and, therefore, denies same.

2. Applicant is without knowledge or information sufficient to form a belief as the truth of the allegations contained in paragraph 2 of the Notice of Opposition and, therefore, denies same.

3. Applicant admits that Opposer is listed with the U.S. Patent and Trademark Office (“PTO”) as the record owner of Registration No. 2,865,458 which has an issue date of July 20, 2004 and a statement of goods which reads “graphics and multi-media co-processors to enable 2D and 3D graphics and video”, but denies the validity of said registration and is without knowledge or information sufficient to a belief as the truth of each and every other allegation contained in paragraph 3 of the Notice of Opposition and, therefore, denies same.

4. Applicant denies the allegations contained in paragraph 4 of the Notice of Opposition.

5. Applicant denies the allegations contained in paragraph 5 of the Notice of Opposition.

6. Applicant denies the allegations contained in paragraph 6 of the Notice of Opposition.

7. Applicant admits that it has not sought or received opposers consent to Applicants' use, proposed use and/or application to register the IMAGENIO mark, but denies that there is any need for Applicant to do so.

#### **AFFIRMATIVE DEFENSE**

8. Upon information and belief, Opposer has discontinued use as a trademark of the designation IMAGEON as set forth in Registration No. 2,865,458 for all of the registered goods for a period of at least three years.

9. Upon information and belief, Opposer's discontinuance of use as a trademark of the designation IMAGEON for all of the registered goods has been intentional and without intent to resume use as a trademark in connection with any of the registered goods.

10. Based on the foregoing, Opposer has abandoned any and all rights in and to the trademark IMAGEON for the goods set forth in Registration No. 2,865,458 pursuant to §§14 and 45 of the Lanham Act, 15 U.S.C. §§1064 and 1127.

#### **COUNTERCLAIM**

11. Applicant, Telefonica, S.A., is a Spanish corporation, having an office and place of business at Gran Via 28, Madrid 28013, Spain.

12. Upon information and belief, Opposer ATI Technologies ULC, is an Alberta Canada Unlimited Liability Corporation, having an office and place of business at 700 2<sup>nd</sup> Street SW, Suite 1200, Calgary, Alberta T2P 4V5, Canada.

13. Applicant is the owner of application Serial No. 78/812,301 for the mark IMAGEON for goods and services in International Classes 9, 38 and 41 which is pending before the PTO.

14. Opposer has filed pending Opposition No. 91193491 with the PTO Trademark Trial and Appeal Board against Applicant's application Serial No. 78/812,301 for the mark IMAGENIO for all of the goods set forth therein in International Classes 9, 38, and 41 on the asserted grounds of likelihood of confusion under §2(d) of the Lanham Act, 15 U.S.C. §1052(d), on the basis of Opposer's alleged prior use of and ownership of U.S. Registration No. 2,865,458 for the designation IMAGEON for goods in International Class 9.

15. Applicant repeats and reasserts the allegations which it has made in the Affirmative Defense set forth in paragraphs 8-9 of this pleading as if fully set forth herein again at length.

16. Applicant will be damaged by Opposer's continued registration of the designation IMAGEON as set forth in Registration No. 2,865,458.

17. In view of the foregoing, Registration No. 2,865,458 should be cancelled with respect to all of the goods set forth therein.

WHEREFORE, Applicant prays for the following relief: 1) that the Notice of Opposition be dismissed in its entirety with prejudice; and 2) that U.S. Registration No. 2,865,458 be cancelled with respect to all of the goods set forth therein.

In the event the actual fee is greater than the payment submitted or is inadvertently not enclosed or if any additional fee during the prosecution of the above-identified application is not paid, the Commissioner is authorized to charge the underpayment to our Deposit Account No. 15-0700.

Dated: New York, New York  
February 25, 2011

Respectfully submitted,




---

Charles P. LaPolla  
Sean P. McMahon  
OSTROLENK FABER LLP  
1180 Avenue of the Americas  
New York, New York 10036-8403  
Tel: (212) 382-0700  
Fax: (212) 382-0888  
Email: [clapolla@ostrolenk.com](mailto:clapolla@ostrolenk.com)  
[smcmahon@ostrolenk.com](mailto:smcmahon@ostrolenk.com)  
Attorneys for Applicant  
TELEFONICA, S.A.

**CERTIFICATE OF SERVICE**

I hereby certify that on this 25<sup>th</sup> day of February, 2011, a true copy of the foregoing **ANSWER, AFFIRMATIVE DEFENSE AND COUNTERCLAIM** have been served upon counsel for Opposer via first class mail with sufficient postage addressed to:

Raymond I. Geraldson, Esq.  
Teresa D. Tambolas, Esq.  
PATTISHALL, McAULIFFE, NEWBURY,  
HILLIARD & GERALDSON LLP  
311 South Wacker Drive  
Suite 5000  
Chicago, Illinois 60606

  
\_\_\_\_\_  
Charles P. LaPolla