ESTTA Tracking number: **ESTTA665218**

Filing date: **04/06/2015**

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

Proceeding	91197762
Party	Defendant Delphix Corp.
Correspondence Address	ERIC BALL FENWICK WEST LLP 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041 UNITED STATES EBall@fenwick.com, trademarks@fenwick.com, csakurai@fenwick.com
Submission	Other Motions/Papers
Filer's Name	Eric Ball
Filer's e-mail	trademarks@fenwick.com, eball@fenwick.com, mmiller@fenwick.com
Signature	/Eric Ball/
Date	04/06/2015
Attachments	Reply MSJ_REDACTED.pdf(49365 bytes) Ball Reply MSJ Declaration and Exhibits_REDACTED.pdf(2977497 bytes)

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

In the matter of
Trademark Application No. 77/944,256
Mark: DELPHIX
Trademark Registration No. 3,768,914
Mark: DELPHIX (Logo)

Embarcadero Technologies, Inc., Opposer and Petitioner, v. Delphix Corp., Applicant and Registrant.	Opposition No.: 91197762 Cancellation No.: 92055153

APPLICANT AND REGISTRANT DELPHIX CORP.'S REPLY MEMORANDUM IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT ON EMBARCADERO'S FRAUD CLAIM

I. INTRODUCTION

On March 30, 2010, the PTO issued United States Trademark Registration No. 3,768,914 to Delphix[1] for its DELPHIX mark. Embarcadero alleges that Delphix committed fraud on the PTO in declaring that it used the DELPHIX mark in commerce. Delphix moved for summary judgment, citing to declarations and deposition testimony to illustrate that Embarcadero could not prove the essential elements of its fraud claim.[2] Specifically, there is no dispute of fact that: (1) Delphix accurately declared that it used its DELPHIX mark in commerce before its February 2010 Statement of Use; (2) Delphix lacked the intent to defraud the PTO; and (3) Delphix's February 2010 Statement of Use was the material statement of use for the Examiner's decision to grant registration of the DELPHIX mark.

In response to Delphix's motion, Embarcadero's opposition brief fails to raise a genuine issue regarding any material facts. First, Embarcadero concedes that Delphix used its mark in commerce before February 2010 by acknowledging that Delphix had at least two customers—REDACTED and REDACTED—in late 2009. Rather than dispute the existence of these customers, Embarcadero erroneously argues that Delphix's shipments to and installations of the DELPHIX-branded software at these global companies was not a use in commerce. But arguments are not evidence, and they cannot establish a genuine dispute of a material fact.

Second, Embarcadero raises no credible evidence regarding Delphix's intent to commit fraud. Instead, Embarcadero relies on two facts about Delphix's CEO, Mr. Jedidiah Yueh—that

[1] Despite multiple corrections by Delphix, Embarcadero continues to incorrectly refer to Delphix as "DelphiX." Delphix has never used "DelphiX" as its trade name or trademark.

[2] Embarcadero objects to Delphix's use of Mr. Yueh's deposition testimony. Opposition at 1 n.3. But Delphix's arguments are entirely supported by Mr. Yueh's declaration, which reiterates and incorporates statements Mr. Yueh previously made during his sworn deposition testimony. Additionally, since Embarcadero has now used Mr. Yueh's deposition testimony in its opposition brief, Delphix's citations to Mr. Yueh's testimony are necessary for a complete and accurate presentation of his testimony.

he went to Harvard and that he had a general awareness of trademarks—to infer that Delphix intended to defraud the PTO. Delphix disputes neither of these facts. These facts, however, cannot support an inference regarding Mr. Yueh's subjective intent—an indispensable element of fraud.

Third, Embarcadero mistakenly argues that Delphix's August 12, 2009 Statement of Use was material to the Examiner's decision to grant registration of the DELPHIX mark. But the Examiner explicitly rejected the August 12, 2009 Statement of Use and instead relied on Delphix's February 3, 2010 Statement of Use.

Embarcadero's opposition brief does not rely on a single witness declaration or document. Without any contrary evidence, there are no disputes of fact and Embarcadero's claim cannot survive summary judgment. Delphix requests that the Board grant its motion for summary judgment and dismiss Embarcadero's fraud claim.

II. EMBARCADERO HAS NOT MET ITS BURDEN TO RAISE A DISPUTE OF MATERIAL FACT REGARDING MISREPRENTATION, INTENT, OR MATERIALITY IN SUPPORT OF ITS FRAUD CLAIM.

Delphix has met its burden on summary judgment by showing that Embarcadero lacks evidence sufficient to establish essential elements of Embarcadero's fraud claim. *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986) ("[A] complete failure of proof concerning an essential element of the nonmoving party's case necessarily renders all other facts immaterial."). The burden now shifts to Embarcadero to affirmatively show that the facts support every essential element of its claim. *Id*. at 324; *see also* Motion at 5.

Here, Embarcadero has failed to offer any evidence supporting the misrepresentation, intent to defraud, and materiality elements of its fraud claim. This failure is consistent with Embarcadero's inability to name a single witness or identify a single document supporting its claim in either its initial or pre-trial disclosures. *See* Declaration of Eric Ball ISO Delphix's MSJ

("Ball Decl.") ¶¶ 2–3, Exs. 1–2. It is also consistent with Embarcadero's failure to produce a single document in response to Delphix's discovery requests—regarding its fraud claims or *any other issue*.[3] Because Embarcadero's opposition to summary judgment is devoid of any evidence substantiating its fraud claims, let alone evidence raising a dispute of material fact, Embarcadero has failed to meet its summary judgment burden.

A. Embarcadero Raises No Dispute of Material Fact Regarding the Accuracy of Delphix's Statements in its February 2010 Statement of Use.

Embarcadero does not and cannot dispute the evidence showing use of the DELPHIX mark before Delphix's February 2010 Statement of Use. Embarcadero cannot challenge the fact that on December 3, 2009, Delphix installed its software at the global headquarters of its customer REDACTED. Declaration of Jedidiah Yueh ISO Delphix's MSJ ("Yueh Decl.") ¶ 5. Embarcadero cannot challenge the fact of Delphix's 2009 shipment to and installation at REDACTED in Australia. *Id.* And Embarcadero cannot challenge the fact that Delphix used the DELPHIX mark in connection with its shipments to and installations at these customers. Yueh Decl. ¶¶ 5–6.[4] Instead of challenging these facts, Embarcadero presents imaginative arguments about what they mean. But an argument regarding the *interpretation* of undisputed facts does not require a trial. *Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 1404 (Fed.

[3] The only prior hint of Embarcadero's contrived basis for its fraud claim was its allegation in the cancellation petition that Delphix's September 2010 press release announcing multiple existing customers and prior awards was somehow evidence that Delphix did not use the DELPHIX mark before September 2010. Petition ¶¶ 19–20. Of course, the September 2010 press release actually confirms that Delphix had used its mark long before September 2010. *See* Motion at 9–10. Conceding the weakness of this argument, Embarcadero has completely dropped the allegation regarding the September 2010 press release in opposing Delphix's motion for summary judgment. The entire basis for Embarcadero's original fraud claim is *gone*.

[4] Embarcadero's characterization of Mr. Yueh's deposition testimony as vague or uncertain falls far short of raising a dispute of material fact, especially in the absence of any rebuttal evidence. *Celotex*, 477 U.S. at 324. Indeed, in his declaration Mr. Yueh reaffirmed his prior statements about Delphix's use of the mark. Yueh Decl. ¶¶ 5–6. To avoid summary judgment, Embarcadero must do more than baselessly question Mr. Yueh's testimony.

Cir. 1984) ("Argument and assertion of counsel cannot substitute for factual statements under oath that establish a genuine material issue of fact."). And each of Embarcadero's interpretations fails to raise a dispute of material fact about the accuracy of Delphix's February 2010 Statement of Use.

1. Delphix's Shipments of its Software to REDACTED in Australia are a Use in Commerce of the DELPHIX mark.

Embarcadero first resorts to misstatements of law regarding Delphix's evidence of use with its customer REDACTED Embarcadero erroneously argues that Delphix's December 2009 shipment of software, from the United States to REDACTED in Australia, is not a use in commerce. *See* Opposition at 7. Embarcadero cites no authority for its argument. This is not surprising since the shipment of goods from the United States to foreign customers is an axiomatic use in commerce covered by the Lanham Act. 3 McCarthy on Trademarks and Unfair Competition §19:108 (4th ed. 2015) ("Commerce means either interstate or United States foreign commerce") (internal quotation omitted); *Barnhardt Mfg. Co. v. Wildwood Gin, Inc.*, Cancellation No. 92053237 at 9–10 (TTAB June 17, 2013) (not precedential) (holding that a sale to a single international customer was sufficient to establish use of a mark in commerce (citing *Person's Co. Ltd. v. Chistman,* 14 USPQ2d 1477, 1479 (Fed. Cir. 1990))).

Next, Embarcadero invents a hypothetical fact: a shipment of Delphix's software from Asia to REDACTED in Australia. Opposition at 7 n.30, 8. It is not clear where this reference to a shipment from Asia comes from. At the time, Delphix did not have an office or even any employees in Asia, and Embarcadero provides no citation to the record regarding a shipment from Asia. Regardless, this hypothetical does not contradict the undisputed fact that Delphix had multiple customers in 2009. Embarcadero's invented law and facts regarding Delphix's Statement of Use fail to meet its burden to survive summary judgment.

2. Delphix's Delivery of its Software to the Global Headquarters of REDACTED is a Use in Commerce of its DELPHIX Mark.

Embarcadero also gets creative in its arguments about Delphix's first U.S. customer, REDACTED Embarcadero attacks Delphix's installation at REDACTED by manufacturing a distinction between "shipment" and "installation" of software. But the difference between shipment and installation is purely semantic. Embarcadero does not explain how an installation of DELPHIX-branded software could occur without implicating a shipment or transportation in commerce. The product does not arrive at the customer's location by teleportation or magical intervention. It must be transported to the install location, which qualifies as a use of the mark in commerce. *See* 15 U.S.C. § 1127 ("[A] mark shall be deemed to be in use in commerce on goods when … the goods are sold or transported in commerce ….").

Embarcadero then tries to cabin Delphix's delivery of its software to REDACTED as merely intrastate commerce.[5] This argument is likewise inconsistent with established law and fails to address the realities of modern commerce. The delivery of a product from Delphix to REDACTED a national and public company with thousands of shareholders and customers around the nation, affects interstate commerce. *See* Yueh Decl. ¶ 5, Ex. 2 at 176:6-7; *Corn Prods. Ref. Co. v. FTC*, 324 U.S. 726, 744–45 (1945) (finding an effect on interstate commerce based on "the interstate and national character of the [purchaser's] business"). This is true even if the delivery happens to occur between two California offices. *Gonzales v. Raich*, 545 U.S. 1, 17 (2005) (Congress may "regulate purely local activities that are part of an economic 'class of activities' that have a substantial effect on interstate commerce").[6] Even more, REDACTED

[5] Embarcadero makes no argument that Delphix's delivery of its software to REDACTED in Australia is an intrastate sale. Even if the delivery to REDACTED was intrastate commerce, Delphix's delivery to REDACTED supports Delphix's February 2010 Statement of Use.

[6] *See also In re G.J. Sherrard Co.*, 150 USPQ 311 (TTAB 1966) (concluding that a hotel's nation-wide customer base and office locations were sufficient to establish that its mark was used

uses the DELPHIX-branded software in its offices throughout the United States and around the world to assist in the manufacturing of computer chips for use in computers, medical devices, and countless other technologies that affect interstate commerce. *See* Yueh Decl. ¶ 5, Ex. 2 at 175:25-176:7; *Gonzales*, 545 U.S. at 17; *Nat'l Fed'n of Indep. Bus. v. Sebelius*, 132 S. Ct. 2566, 2617 (2012) (describing "goods [] produced, sold, and delivered largely by national and regional companies who routinely transact business across state lines" as affecting interstate commerce). Delphix's delivery of its software to REDACTED global headquarters is therefore quintessential use in interstate commerce.

3. Delphix's February 2010 Specimen of Use Shows Use of its DELPHIX Mark in Commerce.

Finally, Embarcadero questions whether Delphix's evidence of its use of the DELPHIX mark, including its February 2010 Statement of Use specimen, is sufficient to show a use in commerce. But the Examiner has already found that Delphix's specimen, which includes screenshots of the software using the DELPHIX mark, is sufficient to show use in commerce. Embarcadero cannot challenge the Examiner's finding. It can only challenge whether Delphix ever used the mark in the specimen. *See Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1355, 1358–59 (TTAB 1989) (the insufficiency of the specimens, *per se*, does not constitute grounds for cancellation; the proper ground for cancellation is that the term has not been used as a mark). Thus, provided that Delphix used the specimen, it is sufficient to show use in commerce. Here, Mr. Yueh's declaration confirms that Delphix used the accepted specimen with its customers REDACTED and REDACTED in 2009. Yueh Decl. ¶¶ 5–6. Embarcadero has offered no evidence to the contrary. Since the specimen of use was enough for

---

in commerce even though the hotel was located in only one state).

the Examiner, the specimen is likewise sufficient at summary judgment.[7]

Delphix has introduced evidence that it used its DELPHIX mark in commerce with its customers REDACTED and REDACTED before filing its February 2010 Statement of Use. Embarcadero's hodgepodge of *arguments* about these undisputed facts is not enough to survive summary judgment. *Barmag Barmer Maschinenfabrik AG v. Murata Mach., Ltd.*, 731 F.2d 831, 836 (Fed. Cir. 1984) ("The party opposing the motion [for summary judgment] must point to an evidentiary conflict created on the record at least by a counter statement of a fact or facts set forth in detail in an affidavit by a knowledgeable affiant."). Without a dispute of material fact regarding use and the truthfulness of Delphix's representations to the Trademark Office, Embarcadero cannot prove an essential element of its fraud claim, and summary judgment is proper.

B. Embarcadero Raises No Dispute of Material Fact Regarding Intent.

On at least three occasions, Mr. Yueh has confirmed his belief that Delphix used the DELPHIX mark in commerce before he filed the February 2010 Statement of Use. Embarcadero points to no evidence that undermines Mr. Yueh's two declarations or his deposition testimony explaining that he acted in good faith and with an honest belief of Delphix's use in commerce. Instead, Embarcadero rests its argument that Mr. Yueh intended to defraud on two irrelevant

[7] Embarcadero's demand for additional examples of use is irrelevant to deciding this motion. Beyond the documents relied on by the Trademark Examiner, Delphix produced numerous documents sufficient to show use of its mark before its February 2010 Statement of Use, including user manuals, customer presentations, press releases, and screenshots of the software's use of the DELPHIX mark provided to customers. Delphix explicitly offered to meet and confer during the discovery period if Embarcadero believed additional documents were necessary. *See* Declaration of Eric Ball ISO Reply to MSJ ("Ball Reply Decl.") ¶¶ 3, 5; Exs. 1, 2 (Delphix's Supplemental Objections and Responses to Opposer's First Request for Production of Documents, and Delphix's Objections and Responses to Embarcadero's Second Request for Production of Documents). Embarcadero never responded to Delphix's offer, nor did Embarcadero file a motion under Rule 56(d) for further discovery. What was good enough for the Examiner should be good enough for Embarcadero.

facts regarding Mr. Yueh's background.

First, Embarcadero argues that Mr. Yueh should have known better merely because he went to Harvard as an undergraduate. *See* Opposition at 10. Beyond this bare assertion, Embarcadero provides no reasoning to explain how Mr. Yueh's undergraduate education could possibly support a finding that he intended to defraud the Trademark Office.

Second, Embarcadero argues that Mr. Yueh's experience with trademarks in the workplace supports an intent to defraud. *See id.* But Mr. Yueh's experience is minimal and consistent with countless small-business owners. At a prior company, Mr. Yueh was involved in general marketing and trademark issues like participating in the brainstorming process of choosing company and product names. *See* Ball Reply Decl. ¶6, Ex. 3 at 26:17-23; 27:5-28:11 ("I made up the name Avamar and we trademarked it …. I just brainstormed."). Mr. Yueh also recalled that this prior company filed a trademark application. *Id.* at 28:17-22. But *outside counsel*, not Mr. Yueh, filed the trademark application at the prior company. *See, e.g.,* U.S. Trademark Application Serial No. 78140288 (filed July 1, 2002). Nothing in Mr. Yueh's deposition suggests he was familiar with the requirements of trademark filings. *See* Ball Reply Decl. ¶6, Ex. 3 at 247:13-22. And there is no evidence that Mr. Yueh ever filed a trademark application before seeking registration of the DELPHIX mark. Mr. Yueh's passing familiarity with marketing and trademarks does not mean that he is familiar with trademark law, nor does it rise to the level of material evidence showing an *intent* to commit fraud. *See Maids to Order of Ohio, Inc. v. Maid-to-Order, Inc*., 78 USPQ2d 1899, 1907 (TTAB 2006) (finding no intent and dismissing a fraud claim because "[i]t was not unreasonable for Ms. Kern, as a layperson, to believe that the . . . activities constituted use of the MAID TO ORDER mark in interstate commerce"); *see also* Motion at 12–13.

If the Board were to hold otherwise, it would turn the issue of intent on its head. Nearly everyone who has chosen a company name could be said to have the requisite knowledge of trademark law and therefore an intent to defraud. Under *Bose*, however, Embarcadero must provide evidence of fraudulent intent to deceive, as distinguished from "a misunderstanding, an inadvertence, a mere negligent omission, or the like." *In re Bose Corp.*, 91 USPQ2d 1938, 1940 (Fed. Cir. 2009) (quoting *Kemin Indus. v. Watkins Prods., Inc.*, 192 USPQ 327, 329 (TTAB 1976)). "Subjective intent to deceive, however difficult it may be to prove, is an indispensable element in the [fraud] analysis." *Id*. at 1941. This specific evidence of deceptive intent "must still be clear and convincing, and inferences drawn from lesser evidence cannot satisfy the deceptive intent requirement." *Id*. (citation omitted). Such evidence requires more than a mere citation to the applicant's resume.

Even assuming Mr. Yueh's background was relevant to the issue of fraudulent intent, those facts fail to support Embarcadero's logical leap that Mr. Yueh had the requisite subjective and deceptive intent to defraud the Trademark Office. Because Embarcadero has failed to raise a dispute of material fact on intent, summary judgment is proper.

C. Embarcadero Does Not Show How the Alleged False Statement is Material to the Registrability of the DELPHIX mark.

Embarcadero must show that alleged false statement to the Trademark Office is material to the registrability of the DELPHIX mark. Here, Embarcadero's arguments about materiality reflect a misunderstanding of the timeline of this case. Embarcadero claims that the August 12, 2009 Statement of Use governs the DELPHIX mark, but Embarcadero's assertion that the Examiner relied on the August 12, 2009 Statement of Use is incorrect. *See* Opposition at 4–6.

For starters, the Examiner rejected Delphix's August 12, 2009 Statement of Use as insufficient. In other words, the Examiner *explicitly chose not to rely on that Statement of Use*,

so it cannot be material to the registrability of the DELPHIX mark. On February 3, 2010, in response to the Examiner's rejection, Delphix submitted a second Statement of Use, accompanied by a new specimen dated November 2009—a specimen that did not exist when Delphix filed its first Statement of Use in August of 2009. *See* Motion at 4. Delphix also provided the Examiner with a new date of first use in commerce (December 3, 2009) and a new declaration of use. Delphix's new specimen, date of first use, and declaration of use each postdate the rejected August 2009 Statement of Use. Thus, only the February 2010 Statement of Use could serve as the material basis for the Examiner's acceptance of Delphix's use of the DELPHIX mark in commerce and approval of the registration. Because Embarcadero has no support for its claim that any allegedly false statement in the August 2009 Statement of Use is material to the registrability of the DELPHIX mark, summary judgment is proper.

III. CONCLUSION

Despite its best attempts to obscure the real issue with misstatements of law and counterfactual hypotheticals, Embarcadero has failed to provide any *evidence* to substantiate its fraud claim. There is, therefore, no dispute of fact about: (1) Delphix's accurate statement that it used its DELPHIX mark in commerce; (2) Delphix's lack of intent to defraud the PTO; and (3) the materiality of Delphix's February 2010 Statement of Use. Accordingly, the Board should grant summary judgment on Embarcadero's fraud claim.

Dated: April 6, 2015

By: */Eric J. Ball/*

Eric Ball
eball@fenwick.com
Fenwick & West LLP
Silicon Valley Center
801 California Street
Mountain View, CA 94041
trademarks@fenwick.com
Telephone: 650.988.8500

PROOF OF SERVICE

I declare that:

I am employed in the County of Santa Clara, California.

I am over the age of eighteen years and not a party to the within cause; my business address is Silicon Valley Center, 801 California Street, Mountain View, California 94041. On the date indicated below, I served **APPLICANT AND REGISTRANT DELPHIX CORP.'S REPLY MEMORANDUM IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT ON EMBARCADERO'S FRAUD CLAIM** on the interested parties in said cause, by mailing a true copy thereof as indicated below, addressed as follows:

Martin R. Greenstein
Techmark a Law Corporation
4820 Harwood Road, 2nd Floor
San Jose, CA 95124-5273

☐ **BY PERSONAL SERVICE**: I caused such envelope(s) to be delivered by hand on the office(s) of the addressee(s).

☐ **BY OVERNIGHT COURIER:** by placing the document(s) listed above in a sealed envelope with a prepaid shipping label for express delivery and causing such envelope to be transmitted to an overnight delivery service for delivery by the next business day in the ordinary course of business.

☒ **BY US MAIL:** by placing the document(s) listed above in a sealed envelope for collection and mailing following our ordinary business practices. I am readily familiar with our ordinary business practices for collecting and processing mail for the United States Postal Service, and mail that I place for collection and processing is regularly deposited with the United States Postal Service that same day with postage prepaid.

I declare under penalty of perjury that the foregoing is true and correct, and that this declaration was executed at Mountain View, California, this 6th day of April, 2015.

/*Deborah A. Shaw*/
Deborah A. Shaw

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

In the matter of
Trademark Application No. 77/944,256
Mark: DELPHIX
Trademark Registration No. 3,768,914
Mark: DELPHIX (Logo)

Embarcadero Technologies, Inc., Opposer and Petitioner, v. Delphix Corp., Applicant and Registrant.	Opposition No.: 91197762 Cancellation No.: 92055153

REPLY DECLARATION OF ERIC BALL IN SUPPORT OF APPLICANT AND REGISTRANT DELPHIX CORP.'SMOTION FOR SUMMARY JUDGMENT ON EMBARCADERO'S FRAUD CLAIM

I, Eric Ball, hereby declare:

1. I am an attorney duly admitted to practice in California and before the Trademark Trial and Appeal Board. I am an associate at the law firm of Fenwick & West LLP, counsel of record for Applicant and Registrant Delphix Corp. in this action. I make this declaration in support of Delphix's Motion for Summary Judgment based on my own personal knowledge, and, if called as a witness, I could and would testify competently to the facts in this declaration.

2. Attached as **Exhibit 1** is a true and correct copy of excerpts from Delphix's June 24, 2013 Supplemental Objections and Responses to Embarcadero's First Request for Production of Documents and Things. Delphix offers these discovery response excerpts as counter-designations to Embarcadero's excerpts of Delphix's discovery responses to provide an accurate and more complete record of Delphix's discovery responses.

3. As part of its supplemental objections, Delphix offered to meet and confer with Embarcadero regarding its First Requests for Production. *See* Ex. 2 at 11.

4. Attached as **Exhibit 2** is a true and correct copy of excerpts from Delphix's July 24, 2013 Objections and Responses to Embarcadero's Second Request for Production of Documents and Things. Delphix offers these discovery response excerpts as counter-designations to Embarcadero's excerpts of Delphix's discovery responses to provide an accurate and more complete record of Delphix's discovery responses.

5. As part of its response, Delphix again offered to meet and confer with Embarcadero regarding its Second Requests for Production. *See* Ex. 3 at 11.

6. Attached as **Exhibit 3** is a true and correct copy of excerpts from Jedidiah Yueh's October 3, 2013 deposition. Delphix offers these deposition excerpts as counter-designations to Embarcadero's excerpts of Mr. Yueh's deposition to provide an accurate and more complete record of Mr. Yueh's testimony.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct and that this declaration was executed on April 6, 2015, in Mountain View, California.

Eric Ball

Attorney for Applicant and Registrant Delphix Corp.

PROOF OF SERVICE

I declare that:

I am employed in the County of Santa Clara, California.

I am over the age of eighteen years and not a party to the within cause; my business address is Silicon Valley Center, 801 California Street, Mountain View, California 94041. On the date indicated below, I served the **DECLARATION OF ERIC BALL IN SUPPORT OF APPLICANT AND REGISTRANT DELPHIX CORP.'S MOTION FOR SUMMARY JUDGMENT ON EMBARCADERO'S FRAUD CLAIM** on the interested parties in said cause, by mailing a true copy thereof as indicated below, addressed as follows:

Martin R. Greenstein Techmark A Law Corporation 4820 Harwood Road, 2nd Floor San Jose, CA 95124-5273

☐ **BY PERSONAL SERVICE**: I caused such envelope(s) to be delivered by hand on the office(s) of the addressee(s).

☐ **BY OVERNIGHT COURIER:** by placing the document(s) listed above in a sealed envelope with a prepaid shipping label for express delivery and causing such envelope to be transmitted to an overnight delivery service for delivery by the next business day in the ordinary course of business.

☒ **BY US MAIL:** by placing the document(s) listed above in a sealed envelope for collection and mailing following our ordinary business practices. I am readily familiar with our ordinary business practices for collecting and processing mail for the United States Postal Service, and mail that I place for collection and processing is regularly deposited with the United States Postal Service that same day with postage prepaid.

☐ **BY E-MAIL:** by mutual agreement between the parties, causing to be transmitted via e- mail the document(s) listed above to the addressee(s) at the e-mail address(es) listed above.

I declare under penalty of perjury that the foregoing is true and correct, and that this declaration was executed at Mountain View, California, this 6th day of April, 2015.

/Deborah A. Shaw/
Deborah A. Shaw

Exhibit 1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of
Trademark Application No. 77/944,256
Filed: February 24, 2010
Published: August 10, 2010
Mark: DELPHIX

Embarcadero Technologies, Inc., Opposer, v. Delphix Corp., Applicant.	)	Opposition No. 91197762

APPLICANT'S SUPPLEMENTAL OBJECTIONS AND RESPONSES TO OPPOSER'S FIRST REQUEST FOR PRODUCTION OF DOCUMENTS AND THINGS

PROPOUNDING PARTY: Opposer Embarcadero Technologies, Inc.

RESPONDING PARTY: Applicant Delphix Corp.

SET NO.: One (Nos. 1 – 43)

Pursuant to Federal Rules of Civil Procedure (FRCP) 34 and 26(e) and the Trademark Rules of Practice, Delphix Corp. ("Delphix" or "Applicant") hereby supplements its objections and responses to Opposer Embarcadero Technologies, Inc.'s First Request for Production of Documents and Things.

discovery of the requested information. Opposer claims that this Opposition (and the consolidated Cancellation proceeding) are straightforward since the relevant marks and goods and services are identical or nearly identical. In light of Opposer's claims – before any discovery has occurred – Opposer's extensive discovery requests create an unnecessary burden on Delphix. To the extent Opposer stands behind its allegations, there is no need, for example, for all advertising materials. There is likewise no need, for example, for all documents *relating to* any sales or marketing meeting the Company has ever had. Opposer has provided no reason for why it believes it needs discovery beyond the parties' respective registrations, applications, representative advertising and promotional materials, representative use of the parties' marks in commerce, and Delphix's website. Instead, Opposer's requests are a fishing expedition, which serves only to unduly burden a startup company with limited resources.

Delphix further responds that under TBMP 402.02 and 414, where complete compliance with a particular request for discovery would be unduly burdensome, the Board may permit Delphix to comply by providing a representative sampling of the information sought, or some other reduced amount of information which is nevertheless sufficient to meet the propounding party's discovery needs.

Subject to Delphix's general and specific objections and preliminary statement, and subject to Embarcadero's narrowing of its requests in its June 21, 2013 email, Delphix responds that it will produce for inspection non-privileged, relevant and responsive documents within its possession, custody or control, under an appropriate protective order, sufficient to show:

1. Delphix's rights in its DELPHIX trademark registration (Registration No. 3,768,914) and intent to use trademark application (Application No. 77/944,256), collectively the "Delphix Marks";

2. Delphix's applications for the Delphix Marks;
3. Delphix's creation, selection, registration and adoption of the Delphix Marks, including changes to the Delphix Marks, if any;
4. Representative samples of the Delphix Marks used in commerce;
5. Delphix's use and promotion of the Delphix Marks in commerce;
6. Delphix's use in commerce of the DELPHIX registration by February 3, 2010;
7. Delphix's continued use of the Delphix Marks since their respective adoptions;
8. The goods or services offered or intended to be offered in connection with the Delphix Marks;
9. The channels of trade in which the Delphix Marks are used or promoted;
10. The use of the Delphix Marks and the goods and services offered therewith on www.delphix.com;
11. Representative customers of Delphix's goods and services offered in connection with the Delphix marks;
12. Delphix's distributors or sellers of Delphix's goods and services offered in connection with the Delphix marks, if any;
13. Delphix's intent to use the Delphix Marks for computer software for use in database management;
14. Delphix's intent to use the Delphix Marks for database management software for managing database storage and provisioning functions and instruction manuals sold therewith;
15. Videos and webcasts related to Delphix's use and promotion of the Delphix marks;

16. Representative samples of advertising and promotional documents using the Delphix Marks;

17. Whitepapers, success stories, testimonials, interviews, data sheets and case studies regarding Delphix's use and promotion of the Delphix Marks;

18. Analysts reports regarding Delphix's use and promotion of the Delphix Marks;

19. The use of the Delphix Marks in connection with social media;

20. Delphix's investigations or surveys regarding the Delphix Marks or Opposer's purported mark, if any;

21. Delphix's assignments, licenses or transfers of the Delphix Marks, if any;

22. Delphix's knowledge, if any, of Opposer or Opposer's purported mark before the Opposition;

23. The absence of a likelihood of or actual confusion between the Delphix Marks and Opposer's purported mark;

24. Delphix's denial of Opposer's claims; and

25. Delphix's affirmative defenses.

With respect to each of the categories described above, and in particular category (25), Delphix notes that discovery relating to Opposer's claims and Delphix's defenses has recently commenced (and Opposer has produced no documents to date); thus, its formal fact-gathering for this proceeding is in its earliest stages. Delphix responds to these requests based upon its current understanding and reserves the right to supplement its responses if any additional information is identified at a later time and to make any additional objections that may become apparent. Delphix's counsel is willing to meet and confer with Opposer's counsel about Opposer's requests should Opposer wish to do so.

this early stage of the proceedings. Delphix objects to this request to the extent that it seeks disclosure of information protected by the attorney-client privilege, the work product doctrine, or any other applicable privilege. Delphix objects to this request as duplicative and redundant of Opposer's Request for Production No. 42. Delphix objects to this request to the extent that it seeks information that is equally available to Opposer from other sources that are more convenient, less burdensome and/or less expensive, particularly to the extent the information sought is publicly available. *See e.g.,* 402.02.

Subject to the foregoing general and specific objections and preliminary statement, Delphix responds that it will produce for inspection non-privileged, relevant and responsive documents within its possession, custody or control, under an appropriate protective order, that Delphix intends to rely upon in this proceeding.

Respectfully submitted,

Dated: June 24, 2013

Eric Ball, Esq.
Attorneys for Applicant Delphix Corp.
FENWICK & WEST LLP
Silicon Valley Center
801 California Street
Mountain View, CA 94041
(650) 988-8500
eball@fenwick.com
trademarks@fenwick.com

Exhibit 2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of
Trademark Application No. 77/944,256
Mark: DELPHIX
Trademark Registration No. 3,768,914
Mark: DELPHIX (Logo)

Embarcadero Technologies, Inc., Opposer and Petitioner, v. Delphix Corp., Applicant and Registrant.	Opposition No.: 91197762 Cancellation No.: 92055153

APPLICANT'S OBJECTIONS AND RESPONSES TO EMBARCADERO TECHNOLOGIES, INC.'S SECOND REQUEST FOR PRODUCTION OF DOCUMENTS AND THINGS

PROPOUNDING PARTY: Opposer and Petitioner Embarcadero Technologies, Inc.

RESPONDING PARTY: Applicant and Registrant Delphix Corp.

SET NO.: Two (Nos. 1 – 25)

Pursuant to Federal Rules of Civil Procedure (FRCP) 34 and the Trademark Rules of Practice, Delphix Corp. ("Delphix," "Applicant" or "Registrant") hereby responds to Opposer Embarcadero Technologies, Inc.'s Second Request for Production of Documents and Things.

Delphix further responds that under TBMP § 402.02, the harm to Delphix caused by Opposer's overbroad and burdensome requests outweighs the need of Opposer in seeking discovery of the requested information. Opposer claims that this consolidated proceeding is straightforward and that the relevant marks and goods and services are identical or nearly identical. In light of Opposer's claims – before any discovery has occurred – Opposer's extensive discovery requests create an unnecessary burden on Delphix. Opposer has provided no reason for why it believes it needs discovery beyond the parties' respective registrations, applications, representative advertising and promotional materials, representative use of the parties' marks in commerce, and Delphix's website.

Delphix further responds that under TBMP §§ 402.02 and 414, where complete compliance with a particular request for discovery would be unduly burdensome, the Board may permit Delphix to comply by providing a representative sampling of the information sought, or some other reduced amount of information which is nevertheless sufficient to meet the propounding party's discovery needs.

Subject to Delphix's general and specific objections and preliminary statement, Delphix responds that it will produce for inspection non-privileged, relevant and responsive documents within its possession, custody or control, under an appropriate protective order, sufficient to show:

1. Delphix's rights in its DELPHIX trademark registration (Registration No. 3,768,914) and intent to use trademark application (Application No. 77/944,256), collectively the "Delphix Marks";
2. Delphix's applications for the Delphix Marks;

3. Delphix's creation, selection, registration and adoption of the Delphix Marks, including changes to the Delphix Marks, if any;
4. Representative samples of the Delphix Marks used in commerce;
5. Delphix's use and promotion of the Delphix Marks in commerce;
6. Delphix's use in commerce of the DELPHIX registration by February 3, 2010;
7. Delphix's continued use of the Delphix Marks since their respective adoptions;
8. The goods or services offered or intended to be offered in connection with the Delphix Marks;
9. The channels of trade in which the Delphix Marks are used or promoted;
10. The use of the Delphix Marks and the goods and services offered therewith on www.delphix.com;
11. Representative customers of Delphix's goods and services offered in connection with the Delphix marks;
12. Delphix's distributors or sellers of Delphix's goods and services offered in connection with the Delphix marks, if any;
13. Delphix's intent to use the Delphix Marks for computer software for use in database management;
14. Delphix's intent to use the Delphix Marks for database management software for managing database storage and provisioning functions and instruction manuals sold therewith;
15. Videos and webcasts related to Delphix's use and promotion of the Delphix marks;
16. Representative samples of advertising and promotional documents using the Delphix Marks;

17. Whitepapers, success stories, testimonials, interviews, data sheets and case studies regarding Delphix's use and promotion of the Delphix Marks;
18. Analysts' reports regarding Delphix's use and promotion of the Delphix Marks;
19. The use of the Delphix Marks in connection with social media;
20. Delphix's investigations or surveys regarding the Delphix Marks or Opposer's purported mark, if any;
21. Delphix's assignments, licenses or transfers of the Delphix Marks, if any;
22. Delphix's knowledge, if any, of Opposer or Opposer's purported mark before the Opposition;
23. The absence of a likelihood of or actual confusion between the Delphix Marks and Opposer's purported mark;
24. Delphix's denial of Opposer's claims; and
25. Delphix's affirmative defenses.

With respect to each of the categories described above, and in particular category (25), Delphix notes that discovery relating to Opposer's claims and Delphix's defenses has recently commenced (and Opposer has produced no documents to date); thus, its formal fact-gathering for this proceeding is in its earliest stages. Delphix responds to these requests based upon its current understanding and reserves the right to supplement its responses if any additional information is identified at a later time and to make any additional objections that may become apparent. Delphix's counsel is willing to meet and confer with Opposer's counsel about Opposer's requests should Opposer wish to do so.

production of information in advance of the dates set by the Federal Rules of Civil Procedure, the Board's Scheduling Order or any other orders of the Board. Delphix objects to this request as overbroad, unduly burdensome and oppressive for Delphix to marshal all of its evidence at this early stage of the proceedings. Delphix objects to this request to the extent that it seeks disclosure of information protected by the attorney-client privilege, the work product doctrine, or any other applicable privilege. Delphix objects to this request as duplicative and redundant of Opposer's Request for Production No. 24. Delphix objects to this request to the extent that it seeks information that is equally available to Opposer from other sources that are more convenient, less burdensome and/or less expensive, particularly to the extent the information sought is publicly available. *See, e.g.*, TBMP § 402.02.

Subject to the foregoing general and specific objections and preliminary statement, Delphix responds that it will produce for inspection non-privileged, relevant and responsive documents within its possession, custody or control, under an appropriate protective order, that Delphix intends to rely upon in this proceeding.

Respectfully submitted,

Dated: July 24, 2013

Eric Ball, Esq.
Attorneys for Applicant Delphix Corp.
FENWICK & WEST LLP
Silicon Valley Center
801 California Street
Mountain View, CA 94041
(650) 988-8500
eball@fenwick.com
trademarks@fenwick.com

PROOF OF SERVICE

I declare that:

I am employed in the County of Santa Clara, California.

I am over the age of eighteen years and not a party to the within cause; my business address is Silicon Valley Center, 801 California Street, Mountain View, California 94041. On the date indicated below, I served **APPLICANT'S OBJECTIONS AND RESPONSES TO EMBARCADERO TECHNOLOGIES, INC.'S SECOND REQUEST FOR PRODUCTION OF DOCUMENTS AND THINGS** on the interested parties in said cause, by mailing a true copy thereof as indicated below, addressed as follows:

Martin R. Greenstein
Techmark a Law Corporation
4820 Harwood Road, 2nd Floor
San Jose, CA 95124-5273

☒ **BY OVERNIGHT COURIER:** by placing the document(s) listed above in a sealed envelope with a prepaid shipping label for express delivery and causing such envelope to be transmitted to an overnight delivery service for delivery by the next business day in the ordinary course of business.

☐ **BY US MAIL:** by placing the document(s) listed above in a sealed envelope for collection and mailing following our ordinary business practices. I am readily familiar with our ordinary business practices for collecting and processing mail for the United States Postal Service, and mail that I place for collection and processing is regularly deposited with the United States Postal Service that same day with postage prepaid.

☐ **BY E-MAIL:** by mutual agreement between the parties, causing to be transmitted via e-mail the document(s) listed above to the addressee(s) at the e-mail address(es) listed above.

I declare under penalty of perjury that the foregoing is true and correct, and that this declaration was executed at Mountain View, California, this 24th day of July, 2013.

Teresa Chow

Teresa Chow

Exhibit 3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

EMBARCADERO TECHNOLOGIES, INC.,	Consolidated Matter 91-197,762
Opposer/Petitioner,	Opposition No. 91-197,762 Cancellation No. 92-055,153
vs.	Trademarks: DELPHIX (#77/944.256) DELPHIX (Logo) #3,768,914)
DELPHIX CORP.,	
Applicant/Registrant.	

DEPOSITION OF JEDIDIAH YUEH

Date: Thursday, October 3, 2013
10:00 a.m.

Place: FENWICK & WEST
801 California St.
Mountain View, CA 94041

Reported by: Linda J. Pugliese, C.S.R.
License No. 4764

CRS, INC.
Certified Court Reporters
111 N. Market St., Suite 930
San Jose, CA 95113
(408) 298-3376
www.computerreporting.com
E-mail: Depos@computerreporting.com

A P P E A R A N C E S

For the Plaintiff:

NEIL D. GREENSTEIN, ESQ.
TECHMARK A LAW CORPORATION
4820 Harwood Road, 2nd Floor
San Jose, Ca 95124-5273
(408) 266-4700

For the Defendant:

ERIC J. BALL, ESQ.
MARION MILLER, Attorney at Law
FENWICK & WEST
801 California St.
Mountain View, CA 94041
(650) 988-8500

REDACTED

Q. Okay. That's fine. And you don't know -- do you know what city he's located in now?

A. I don't. I believe he may live in Palo Alto.

Q. Now, while you were at NTD, did you have any responsibility for any trademark matters of NTD?

A. Not that I recall.

Q. While you were at Avamar, did you have any responsibility for any trademark matters?

A. Yes.

Q. And could you describe for me what those responsibilities were?

A. I was the founding CEO of Avamar, so just the general responsibilities for marketing and trademark.

Q. Did you have any responsibility for selecting trademarks?

MR. BALL: Objection; vague as to "selecting." You mean just choosing the name of a product or --

BY MR. GREENSTEIN:

Q. Selecting particular trademarks. Whether it be the name of the company, the name of a product, did you have any responsibilities in conjunction with that?

A. I selected -- I made up the name Avamar and we trademarked it.

Q. Were there any product names that you also were involved with at Avamar?

A. Yes.

Q. And what were those?

A. I'm trying to remember the name. We ended up calling the product name the same as the company name. There was an interim name. I think it was Axion. Axion? It was for a short duration. I don't recall.

Q. When you were choosing these names at Avamar, can you describe for me the steps that you went through in developing and choosing a name? Did you use -- I mean did you use a naming company, for example?

A. No.

Q. How is it that you came up with the Avamar name?

A. I generated a long list of names and decided

on one that I liked.

Q. And where did you generate that list from?

A. I just created the list.

Q. Did you use any reference materials or is this just something that you brainstormed about?

A. I just brainstormed.

Q. And is the same true for Axiom?

A. Yes.

Q. Just part of a brainstorming?

A. I brainstormed. I may have solicited product name ideas from other individuals as well.

Q. Were you the one ultimately to make the decision as to whether to use the Avamar name?

A. Yes. I decided to use the name Avamar.

Q. What about the Axiom name?

A. I believe, yes, I decided on that as well.

Q. Did you ever seek any kind of trademark registration protection for either of those terms?

A. Yes, I believe so.

Q. For both or --

A. I know we sought trademark protection for Avamar. I don't recall on the product name.

Q. Prior to seeking trademark protection for Avamar, did you undertake to determine if there would be any conflicts?

Q. Did you remember the total number of both approximately?
A. Roughly eight.
Q. Have you had any experience in your employment at any of these companies with the copyright laws?
MR. BALL: Objection; vague as to experience. But go ahead.
THE WITNESS: I don't remember.
BY MR. GREENSTEIN:
Q. Have you had any training relating to copyright laws and protection under the copyright laws?
A. Not that I remember.
Q. What kind of training have you had, if any, with respect to protection under the trademark laws?
A. I don't recall any specific training.
Q. Have you received any training under the false and misleading advertising laws?
A. I don't recall any specific training on that.
Q. When we talk about training, this could be corporate training. It could be educational training.
A. I don't recall any corporate or educational training.
Q. I hand you what has been previously marked Exhibit 7.
A. Okay.

STATE OF CALIFORNIA)
)
COUNTY OF SANTA CLARA)

I, LINDA J. PUGLIESE, Certified Shorthand Reporter in and for the State of California, do hereby certify that the witness in the foregoing deposition was by me duly sworn to testify to the truth, the whole truth, and nothing but the truth in the within-entitled cause, that the foregoing is a full, complete and true record of said testimony, and that the witness was given an opportunity to read and correct said deposition and to subscribe to the same.

I further certify that I am not interested in the outcome of this action, nor connected with, nor related to any of the parties in said action, nor to their respective counsel.

Date: October 25, 2013.

Linda J. Pugliese
Certified Shorthand Reporter
License No. 4764

Errata Sheet to the Deposition of Jedidiah Yueh
Taken on October 3, 2013

Page	Line	Now Reads	Should Read
8	18	Casey	Caccia
9	11	objection, the objection as argumentative they	objections, the objections that it is argumentative to refer
13	2	objections. Hadn't filed a response	objections that we filed in response
23	12	Molton	Moulton
23	21	[redacted]	REDACTED
24	2	Molten	Moulton
28	7	Axiom	Axion
28	15	Axiom	Axion
29	4	Embarcadero	EMC
32	6	Synovia	Sanofi
39	22	Again, not for	Again, he's not asking for speculation or
41	5	Caccio	Caccia
41	8	Caccio	Caccia
41	25	Caccio	Caccia

46	18	Caccio	Caccia
48	21	Caccio	Caccia
49	5	Caccio	Caccia
49	7	Caccio	Caccia
49	13	Caccio	Caccia
52	14	Hillary	Hilary
52	15	Hillary	Hilary
52	20	him business	him about business
52	22	you're	are you
67	11	employed	deployed
67	24	Solarus	Solaris
73	24	exchange	change
78	4	environmental	virtual
82	24	[redacted]	
83	4	[redacted]	
86	18	[redacted]	
94	7	Hillary	Hilary

94	7	Hillary's	Hilary's
102	24	employee -- when an -- employee offers	employee offers
103	18	Hillary	Hilary
110	3	managing environment	managing in an environment
127	7	go to a	go do a
128	25	what --	what they intend it to mean.
132	8	argumentative in the sales	argumentative in a sense
134	17	company the	company where the
148	17	Caccio	Caccia
148	19	Caccio	Caccia
148	20	Caccio	Caccia
151	17	I'm not aware of it.	I'm not currently aware of it, other than videos.
153	4	Not that I recall or am aware of.	Not that I recall or am aware of, other than videos.
179	21	merged	emerged
180	4	merged	emerged
184	8	[redacted]	
191	11	Hillary	Hilary

193	20	officer companies	officers of the companies
194	20	that's	that there is a
195	24	Caccio	Caccia
195	25	Caccio	Caccia
196	2	Caccio	Caccia
207	22	design	are designed
213	10	collapse at	collapse the
215	7	order get	order to get
234	15	I don't know.	I don't know, other than discussions with counsel.
257	14	I believe	I do not believe
259	7	to	so
268	9	Hillary	Hilary
271	1	REDACTED	
272	21	REDACTED	

Jedidiah Yueh
Deponent

11/25/13
Date