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

Proceeding no.	91288844
Party	Plaintiff MaxLinear, Inc.
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Attachments	OPPOSERS OPPOSITION TO APPLICANTS MOTION TO AMEND DESCRIPTION OF MAR K.pdf(174871 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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MaxLinear, Inc. <div style="text-align:right">Opposer,</div> <div style="text-align:center">v.</div> Amber Semiconductor, Inc., <div style="text-align:right">Applicant.</div>	Opposition No.: 91288844 Serial No.: 97/451335 Mark: 
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OPPOSER'S OPPOSITION TO APPLICANT'S
MOTION TO AMEND DESCRIPTION OF MARK AND TO INCLUDE A DISCLAIMER

Opposer, MaxLinear, Inc. ("Opposer"), pursuant to TBMP §514.03 and CFR §2.133(a), hereby timely files this Response to Applicant's Motion to Amend Description of Mark and to include a Disclaimer. Opposer notes that this Response is a preliminary response given that Applicant has also filed a Motion for Summary Judgment. Opposer will further discuss the impropriety of Applicant's Motion to Amend in its Opposition to Applicant's Motion for Summary Judgment, which will be filed separately. Opposer requests that pursuant to TBMP §514.01, any ruling on Applicant's motion to amend be deferred until final decision or until the case is decided on summary judgment.

I. Background Information

On December 19, 2023, Opposer filed its Notice of Opposition against Applicant's Mark on the basis that the design element, specifically the ribbon element of Applicant's Mark, is

confusingly similar to Opposer's marks as set forth in Application Serial Nos. 97/657383, 97/657389, 98/265391 and 98/265383.

On January 22, 2024, Applicant filed its Answer to the Notice of Opposition and also filed its own Notice of Opposition "as a counterclaim opposing registration of MaxLinear, Inc.'s plead trademark applications..." Opposition No. 91289345, TTABVue 1, page 3. On February 22, 2024, Opposer filed a Motion to Dismiss in connection with Opposition No. 91289345. On March 18, 2024, the Trademark Trial and Appeal Board issued a decision dismissing the opposition with prejudice in favor of Opposer.

In connection with the subject opposition, Applicant filed a joint "Motion to Dismiss Fraud on the USPTO" and a "Motion for Summary Judgment" on February 18, 2024 and filed a further "Motion to Dismiss Fraud upon the USPTO, Motion for Summary Judgment" on February 26, 2024. Opposed filed a Response to both Motions on March 13, 2024.

On June 18, 2024, the Trademark Trial and Appeal Board issued an order denying Applicant's Motions and stating that Applicant's counterclaim is procedurally improper. The Board then reset the dates in the proceeding.

On September 2, 2024, Applicant filed a "Motion to Amend Description of Mark and to include a Disclaimer." Applicant is attempting to amend the description of its mark to provide further detail and is also attempting to include a disclaimer of the "sine wave shaped ribbons." In addition, Applicant wants to include the following language in its disclaimer:

- In particular, Applicant expressly disclaims any rights to sine wave shaped ribbons as they appear in U.S. trademark applications 97657383, 97657389, 98265391 and 98265383 and as used in the IEEE Standard 315-1975, Graphic Symbols for Electrical and Electronics Diagrams as shown in the Quick Reference Guide, in particular, item 2.7, shown below

Apart from the fact that the above-mentioned disclaimer language is not acceptable, Applicant should not be allowed to amend its mark, description or enter a disclaimer based on the arguments as set forth below. Opposer is not providing its consent to the amendment.

II. **Argument and Authorities**

A. **Applicant's Requested Amendment is Contrary to the Trademark Rules and Should be Denied**

Applicant's Requested Amendment is contrary to both the Code of Federal Regulations and the Trademark Trial and Appeal Board Manual of Procedure, which expressly states:

[A]n application that is the subject of a Board inter partes proceeding may not be amended in substance, except with the consent of the other party or parties and the approval of the Board, or except under motion granted by the Board....A proposed amendment to any application or registration that is the subject of an inter partes proceeding must also comply with all other applicable rules and statutory provisions.

TMEP §514.01.

First, Opposer notes that Applicant's proposed amendment does not comply with the applicable Trademark Rules. Applicant's proposed amendment is not in the Trademark Office's standardized disclaimer text as set forth in TMEP §1213.08(a)(i). Applicant cannot disclaim "any rights to the sine wave shaped ribbons as they appear" in Opposer's marks. This is an unacceptable limitation and cannot be included in the application record as an effort by Applicant to avoid confusion with Opposer's Marks.

Second, Applicant's inclusion of a reference to the IEEE standard is also unacceptable as it is outside of the scope of the standardized disclaimer language. Not only is the language not

standard, the reference is irrelevant in the current context. In addition, the design as it appears in IEEE Standard 315-1975 is different than the subject marks at issue in this proceeding.

Third, Applicant is attempting to amend its mark in an effort to state that the design element of Applicant's mark is somehow descriptive of the goods so that Applicant can disclaim such element and avoid a likelihood of confusion finding. Opposer notes that this attempt by Applicant is futile. The sine wave, when used in connection with Applicant's goods, specifically "Solid state power supplies and switches comprising solid state AC to DC converters and solid state bidirectional switches in the form of integrated circuits and excluding non-integrated devices specifically capacitors," is not descriptive. Applicant has not shown how the sine wave, a design element, can describe Applicant's goods. This is due to the fact that the sine wave is not descriptive of such goods. Where the design element is not descriptive, a disclaimer is improper and should not be entered.

Given that the proposed amendments are not in the standardized Trademark format, include an improper disclaimer for an element of a mark that is not descriptive of the goods, and for the other reasons set forth above, Applicant's Motion should be denied.

B. Amendment is Requested Solely to Defeat the Opposition

It is clear that Applicant's goal in attempting to amend the description of goods and enter the disclaimer is to defeat the Opposition. Applicant cannot enter an improper disclaimer for a design element that is not descriptive of the goods. Applicant also cannot "disclaim" the design elements in Opposer's marks to avoid confusion. It is clear that the design element that Applicant uses does not describe its goods and that the design element is clearly similar to that of Opposer. Applicant understands that its design element is similar to that of Opposer and is

now attempting to claim that the design is descriptive and disclaim the same in an effort to avoid a finding of confusion.

In addition, Applicant's inclusion of information regarding the IEEE standards does nothing to alleviate the likelihood of confusion in this instance. The design marks as used by both Applicant and Opposer are not a "standard" sine wave. Rather, Applicant has chosen a design element that is nearly identical to that of Opposer and is now trying to avoid confusion by arguing that the design is descriptive and disclaiming the same. Applicant's sole purpose in amending the mark and entering the disclaimer is to defeat the Opposition. This is improper.

C. Opposer Does not Provide Consent

Applicant did not request Opposer's consent prior to filing the Motion but states in the motion that "Applicant, through service, requests approval of this change from Opposer." Opposer does **not** provide its consent to this amendment.

III. CONCLUSION

Based on the above, Opposer respectfully requests that the Board deny Applicant's Motion to Amend.

Dated: September 20, 2024

Respectfully Submitted for Opposer

MaxLinear, Inc.

By: /fbhatti/

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO AMEND DESCRIPTION OF MARK AND TO INCLUDE A DISCLAIMER has been served on counsel for Applicant by forwarding said copy on September 20, 2024, via email, to the correspondence address of record for Applicant at the following address:

mark@wisnoskylaw.com

_____/fbhatti/

Farah P. Bhatti