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

In the matter of Application Serial No. 76/216,493
Filed on February 27, 2001
For the Mark SYNTEL
Published in the Official Gazette on June 18, 2002



SYNTELSOFT, INC.,)
)
)
Opposer,)
)
v.)
)
SYNTEL, INC.,)
)
)
Applicant.)
)

Opposition No. 91152909

06-05-2003
U.S. Patent & TMO/c/TM Mail Rcpt Dt. #22

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Trademark Trial and Appeal Board
Box TTAB NO FEE
2900 Crystal Drive
Arlington, Virginia 22202-3513

**MOTION FOR SUMMARY JUDGMENT
AND FOR SUSPENSION OF PROCEEDINGS**

Applicant, Syntel, Inc. ("Syntel") hereby moves the Trademark Trial and Appeal Board pursuant to Rule 56 of the Federal Rules of Civil Procedure for summary judgment dismissing Opposition No. 91152909 brought by Opposer, SyntelSoft, Inc.

Applicant also requests that, pursuant to Rule 2.127(d), 37 C.F.R. § 2.127(d), the Board suspend this proceeding pending determination of its Motion for Summary Judgment as of the date of submission of this Motion. In the event the Board denies Applicant's Motion for Summary Judgment, Applicant hereby requests that the remaining testimony periods be reset.

The facts and grounds for Applicant's Motion for Summary Judgment, set forth more fully in the Memorandum of Law in Support of Applicant's Motion for Summary Judgment submitted herewith.

Respectfully submitted,

Bodman, Longley & Dahling LLP

Dated: June 5, 2003

By: *Susan M. Kornfield*
Susan M. Kornfield
Alan N. Harris
Angela Alvarez Sujek
Attorneys for Applicant, Syntel, Inc.
110 Miller, Suite 300
Ann Arbor, Michigan 48104
(734) 761-3780

EU 043052138 US

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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In the matter of Application Serial No. 76/216,493
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SYNTELSOFT, INC.,)
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Opposition No. 91152909

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Susan M. Kornfield
Bodman, Longley & Dahling LLP
110 Miller, Suite 300
Ann Arbor, Michigan 48104
(734) 930-2488
Attorneys for Applicant Syntel, Inc.

**MEMORANDUM OF LAW IN SUPPORT OF APPLICANT'S
MOTION FOR SUMMARY JUDGMENT**

Table of Authorities

Federal Cases

Celotex Corp. v. Catrett, 477 U.S. 317, 106 S. Ct. 2548 (1986) 4, 5
Levi Strauss & Co. v. Genesco, Inc., 742 F.2d 1401, 1404 (Fed. Cir. 1984)..... 5

Federal Statutes

15 U.S.C. § 1127..... 5

Applicant, Syntel, Inc. (“Syntel”), provides this Memorandum in Support of its Motion for Summary Judgment. Syntel owns an incontestable U.S. registration for the mark SYNTEL (the “Mark”). Syntel has used the Mark for nearly twenty years. By the pending application, Syntel seeks to secure a registration that identifies services (business and computer consulting) beyond those identified in its current registration for the Mark, and which have been offered in connection with the Mark since at least 1999. Opposer uses the word “syntel” to describe a computer programming language and in its URL, but not in connection with consultation services. Syntel requests that the Opposition be dismissed and its application proceed to registration.

I. UNDISPUTED FACTS

Syntel is a publicly traded, leading technology services firm. It owns numerous service mark registrations, including an incontestable registration of the mark SYNTEL (the “Mark”), for “custom designing of computer software and computer programming services.” *See attached Exhibit A - Schedule of Syntel’s federally registered marks.* Since at least as early as June 30, 1999, in connection with its Mark, Syntel has provided the following services:

“business consulting services, namely, consultation relating to business strategy, including assessing a company’s existing operations, and advising on the development of technology-related methodologies in the field of project management; consultation relating to outsourcing of computerized business functions; business consultation relating to the fields of electronic commerce and electronic business; business consultation relating to the field of on-line business transactions, namely, marketing, order processing, and order fulfillment; customer relationship management; and employee leasing services, namely, providing information technology professionals to others,” in International Class 35; and

“computer consultation services in the fields of web site design, web site development, web site maintenance, web site upgrading, web site hosting, web site privacy, web site security, database design, selection of operating environment, development of operating environment, development and integration of interactive content and design; and in the fields of computer

software applications, computer software maintenance, and computer software development; technical support services via telephone, email, facsimile, pager, and in person; and enabling legacy applications for use on the world wide web,” in International Class 42.

Syntel filed the Application at issue on February 27, 2001. The Application was published for opposition on June 18, 2002 and opposed on August 2, 2002. Opposer’s claim that Syntel’s Mark is likely to cause confusion with Opposer’s superior rights in the mark “syntel” for business and consulting services is based upon the contention that Opposer uses the word “syntel” in connection with various business and computer consulting services (*Opp.* ¶ 2).

Opposer has produced the following evidence in support of its use of the word “syntel” as a service mark: (1) the text of U.S. Patent No. 4,866,634 (*Opp.* ¶ 4), article from 1988 which references a programming language called “syntel;” (*Opp.* ¶ 5), and use within its Internet domain name (*Opp.* ¶ 5).

In response to Syntel’s discovery requests, Opposer responded that its only uses of the word “syntel” are: as its Internet domain name and the computer programming language it uses to develop its products. *See Exhibit B, Response to Interrogatory Number 4.* Opposer submitted, as the total universe of uses of the word “syntel,” its URL, the text of Patent No. 4,866,634, an article attached to its Notice of Opposition, an invoice, and a license agreement. *See Exhibit C, Response to Document Request Number 1.*

II. ARGUMENT

A party is entitled to summary judgment when it has demonstrated that there are no genuine issues as to any material fact, and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c); *see Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S. Ct. 2548 (1986). In appropriate cases, the movant may discharge its burden by showing the absence of any evidence

to support the adverse party's claim. *Celotex, supra*. More particularly, when the moving party has carried its initial burden as the movant, the nonmovant may not rest on mere denials or conclusory statements and must show an evidentiary conflict created on the records, so that trial is necessary to resolve the conflict. *Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 1404 (Fed. Cir. 1984).

A. Opposer Does Not Use “syntel” as a Mark.

Opposer claims damage to its superior rights in the Mark SYNTEL for business and computer consulting services. Opposer, however, does use “syntel” as a mark in connection with business and computer consulting services. A trademark functions to identify the products of the trademark owner and to distinguish them from the products of others. 15 U.S.C. § 1127. A mark is used in commerce “on goods when it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto . . . and on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce . . .” 15 U.S.C. § 1127. Opposer does not use the Mark to identify any services. Opposer merely uses the word “syntel” as a part of its web site address. That is not use of the Mark in connection with consultation services.

Examination of Opposer's website and current and past use as produced by Opposer, evidences no use of the Mark to identify business and computer consulting services, but solely to identify the proprietary language used to write Opposer's computer programs. The word “syntel” is not used to identify any of the programs written in Opposer's programming language.

Opposer asserts, as its sole basis for the opposition, that it will be harmed by Syntel's registration of the Mark because Opposer claims to provide business and computer consulting services in connection with the word “syntel.” Opposer does not contend that Syntel's

registration of the Mark will interfere with Opposer's use of the word "syntel" as a part of its programming language. Thus, the tangible materials provided by Opposer, namely, the patent, the article, the invoice, and the license are irrelevant.

Because Opposer does not have any rights in the Mark SYNTEL for business and computer consulting services, it cannot sustain a claim of damage in this Opposition.

For the foregoing reasons, Applicant respectfully requests that its Motion for Summary Judgment be granted and that the Opposition filed herein be dismissed.

Respectfully submitted,

Bodman, Longley & Dahling LLP

Dated: June 5, 2003

By: 
Susan M. Kornfield
Alan N. Harris
Angela Alvarez Sujek
Attorneys for Applicant, Syntel, Inc.
110 Miller, Suite 300
Ann Arbor, Michigan 48104
(734) 761-3780

Certificate of Mailing

I hereby certify that on June 5, 2003, I sent the enclosed Motion for Summary Judgment and Suspension of Proceedings, Memorandum Of Law In Support Of Applicant's Motion For Summary Judgment, and this Certificate of Mailing, regarding SyntelSoft, Inc. v. Syntel, Inc., Opposition No. 91152909, via U.S. Postal Service Express Mail (No. EU043052138US) to:

Box TTAB NO FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3514

with a copy sent by fax (650) 322-3736, and by U.S. Postal Service First Class Mail to:

Mr. Jonathan Seder
SyntelSoft, Inc.
P.O. Box 680
Palo Alto, California 94302

Name of person certifying mailing: Lisa Charlebois

Signature: 

Date of Signing: June 5, 2003



**Syntel, Inc.
Registered Service Marks**

Mark	Int. Class	Description	Next Action Date Period	Next Action
CONSIDER IT DONE	35 and 42	<p>Business consultation services, namely consultation relating to business strategy, including assessing a company's existing operations, and advising on the development of technology-related methodologies in the field of project management; consultation relating to outsourcing of computerized business functions; business consultation relating to the fields of electronic commerce and electronic business; business consultation relating to the field of on-line business transactions, namely marketing, order processing, and order fulfillment; customer relationship management; and employee leasing services, namely, providing information technology professionals to others (International Class 35).</p> <p>Computer consultation services in the fields of web site design, web site development, web site maintenance, web site upgrading, web site hosting, web site privacy, web site security, database design, selection of operating environment, development of operating environment, development and integration of interactive content and design; and in the fields of computer software applications, computer software maintenance, and computer software development; technical support services, namely computer troubleshooting, via telephone, email, facsimile, pager, and in person; and enabling legacy computer applications for use on the world wide web (International Class 42).</p>	5/27/08-5/27/09	File Affidavit of Continued Use

June 4, 2003

**Syntel, Inc.
Registered Service Marks**

Mark	Int. Class	Description	Next Action Date Period	Next Action
CONSIDER IT DONE	42	Consulting services in the field of computer software applications, computer software maintenance, and computer software development.	11/24/03-11/24/04	File Affidavit of Continued Use
DIGITAL BLUEPRINTING - BUILD - OPTIMIZE	35 and 42	Business consulting services, namely assessing a company's existing operations, and developing, recommending, and integrating technology-related methodologies and computing systems to support a company's business strategy (International Class 35). Custom software development, computer consulting services, and technical support services, namely, troubleshooting of computer hardware and software problems in person, and via telephone and email (International Class 42).	10/15/07-10/15/08	File Affidavit of Continued Use
INTELLICAPTURE	35	Business consulting services for others in the field of project management.	2/14/03-8/14/03	File Statement of Use or Fourth Request for Extension of Time
INTELLISOURCING	42	Consulting services in the field of computer software applications, computer software maintenance, and computer software development.	2/28/05-2/28/06	File Affidavit of Continued Use
INTELLITRANSFER	35	Business services in connection with outsourcing of computerized business functions.	8/3/04-8/3/05	File Affidavit of Continued Use
METHOD 2000	42	Computer programming services in the field of reprogramming date fields of existing software systems.	10/7/02-10/7/03	File Affidavit of Continued Use

June 4, 2003

**Syntel, Inc.
Registered Service Marks**

Mark	Int. Class	Description	Next Action Date Period	Next Action
NEW2USA.COM	42	Providing online information and data pertaining to the United States of America for use by visitors, immigrants, and new citizens via a global computer network; and providing electronic links to third parties, namely, individuals, corporations, businesses, agencies, and organizations, that offer services and resources to visitors, immigrants, and new citizens.	6/11/07-6/11/08	File Affidavit of Continued Use
SYNTEL	42	Custom designing of computer software and computer programming services.	12/9/11-6/9/12	File Renewal
SYNTEL Y2K CONSULTANT ONLINE	35	Business consulting, namely, providing cost estimates for millennium year data conversion of computer programs.	11/10/03-11/10/04	File Affidavit of Continued Use
TEAMSOURCING	35	Employee leasing services, namely, providing information technology professionals to others.	3/9/04-3/9/05	File Affidavit of Continued Use

June 4, 2003

B

In the matter of Application Serial No. 76/216,493
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SYNTELSOFT, INC.)
Opposer,)
v.)
SYNTEL, INC.)
Applicant)
_____)

Opposition No.91152909

**OPPOSER'S RESPONSE TO
APPLICANT'S FIRST SET OF INTERROGATORIES,
REQUESTS FOR ADMISSIONS, AND REQUESTS
FOR PRODUCTION OF DOCUMENTS TO OPPOSER**

Opposer, SyntelSoft Inc., hereby responds to Applicant's first set of interrogatories, requests for admissions, and requests for production of documents to opposer" dated November 22, 2002.

Opposer continues to pursue its investigation of the facts and law relating to this case. The responses set forth below are given without prejudice to Opposer's right to produce subsequently discovered items, or to add or modify the responses herein. The information set forth herein is correct to the best knowledge of Opposer as of this date but may contain inadvertent errors, mistakes, or omissions.

Inadvertent identification or production of privileged writings or information by Opposer is not a waiver of any applicable privilege. Production of writings or material does not waive any objection to the admission of such writings as evidence.

Response to Interrogatory Number 1

The Syntel mark was first used to identify this company's goods and services in 1983, namely a non-procedural computer language and related software products and customization services.

1 Response to Interrogatory Number 2

2 The mark was created for this use in 1983.
3

4
5 Response to Interrogatory Number 3

6 Opposer objects to this Interrogatory as it demands
7 information of which Opposer may have no knowledge, such as the
8 names of all those who have read the company's literature or
9 advertising or visited the company's Web site. It is impossible
10 for Opposer to produce a list of "all persons" who may have been
11 exposed to these materials in the past twenty years. However,
12 certain current and past employees of Opposer, and certain
13 customers of Opposer can testify to Opposer's continuous use of
14 the Mark.
15

16
17 Response to Interrogatory Number 4

18 Opposer has used the "syntel.com" Internet domain name since
19 1986 or 1987.
20

21 Opposer has used the "Syntel" mark to refer to the non-
22 procedural computer programming language in which its products
23 are developed. These products were initially offered for sale
24 in 1984. The annual unit and dollar sales have never been
25 disclosed; Opposer objects to disclosure of sales information,
26 as Opposer competes directly with Applicant and disclosure of
27 this information would damage Opposer's business activities.
28

29 Products based on the Syntel Language have been licensed to
30 companies in the United States (including California, Illinois,
31 New York, North Carolina, Minnesota), and other countries,
32 including Australia, the United Kingdom, and Germany.
33

34 Response to Interrogatory Number 5

35
36 Several such investigations have been conducted. In the early
37 1980s, Opposer asked its then legal counsel assist in
38 registering the Mark. A search identified several hundred
39 conflicting uses of the Mark within the subject Classifications.
40 Opposer was advised by its then legal counsel that registration
41 would not be possible. Opposer having searched diligently is
42 not able to locate any paper record of this.
43

44 Opposer has since periodically investigated the use of the Mark
45 on the Internet, to verify that there are still too many
46 conflicting users of the Syntel mark International Classes 035
47 and 042 to permit a good-faith application for trademark
48 registration, and also to ensure that Internet users are able to
49 identify the appropriate "Syntel" among the many dozens of
50 "Syntel" entities. Opposer is aware of many active users of

1 this mark which maintain active Internet presence in
2 International Classes 035 and 042, including at least one which
3 has used the Mark continuously since 1983.
4

5 Response to Interrogatory Number 6

6
7 Opposer first learned of Syntel, Inc in 1996 when telephone
8 callers were inadvertently directed to our company by telephone
9 directory assistance. Opposer telephoned Syntel Inc in San
10 Ramon, California, and requested that they list their company in
11 the "Silicon Valley" area codes (at that time 415 and 408) to
12 avoid confusing callers, but to Opposer's best knowledge Syntel,
13 Inc never did so. Opposer cannot identify the person at Syntel
14 Inc who took the call.
15

16 Response to Interrogatory Number 7

17
18 Opposer has never before entered into any legal action with
19 respect to this Mark.
20

21 Response to Interrogatory Number 8

22
23 Opposed objects that this interrogatory seeks information which
24 is by its nature irrelevant or privileged.
25

26 Response to Interrogatory Number 9

27 It is not possible to identify all marketing materials related
28 to Opposer's use of the Mark. Opposer's primary vehicle is the
29 Internet; Opposer has not archived past editions of its Web
30 site, but some may be found at <http://web.archive.org> .
31

32 A sample of Opposer's hardcopy marketing materials was attached
33 to Opposer's original Opposition.
34

35 Response to Interrogatory Number 10

36 Jonathan Seder, general information; René Reboh, general
37 information; Robert Ridder, specific information as to
38 Opposer's first use of the "syntel" name on the Internet.
39
40

41 Response to Interrogatory Number 11

42 Our goods and services are now marketed primarily through the
43 Internet, using the syntel.com Internet domain.
44

45 Response to Interrogatory Number 12

46
47 A national advertising campaign was undertaken for Opposer's
48 products in the late 1980s and early 1990s in various financial
49 industry trade publications. These publications were
50 distributed throughout North America, in particular to all of

1 the United States. No precise records of this campaign still
2 exist. After reviewing this campaign, it was determined that
3 the Internet was a far more effective vehicle for our sales.
4

5 Response to Interrogatory Number 13
6

7 Opposer objects that this information would be of competitive
8 information to Applicant. Without waiving that objection.
9 Opposer states that to its best knowledge all records regarding
10 any print advertising were destroyed many years ago.
11

12 Response to Interrogatory Number 14
13

14 Since 1995, Opposer's goods and services have been promoted
15 primarily through the Internet domain "syntel.com".
16

17 Response to Interrogatory Number 15
18

19 Inasmuch as Opposer competes directly with Application, any such
20 agreements - if they exist - would provide competitive
21 intelligence to Applicant, and Opposer objects to this
22 Interrogatory. Without waiving that objection, Opposer notes
23 that if any such licensing agreements did exist, they would in
24 all probability refer broadly to the parties' intellectual
25 property and not identify any specific marks.
26

27 Response to Interrogatory Number 16
28

29 Opposer has no knowledge of such agreements.
30

31 Response to Interrogatory Number 17
32

33 Inasmuch as Opposer competes directly with Application, the
34 identities of any such purchasers would provide valuable
35 competitive intelligence to Applicant, and Opposer objects to
36 this Interrogatory. Without waiving that objection, Opposer
37 states that actual sales of the Syntel Language processor and
38 related goods and services have been made to financial services
39 organizations, such as commercial banks, and commercial property
40 and casualty insurance companies, in various States.
41

42 Response to Interrogatory Number 18
43

44 Surely a very large number of such communications have occurred
45 through Opposer's Web site, which refers syntel.com visitors to
46 dozens of other "syntel"-named Web sites including
47 syntelinc.com. Opposer is not aware of most such
48 communications, as visitors to our Web site review the list of
49 Syntel-named companies and never notify Opposer of this.
50 Opposer believes that in terms of the number and importance of

1 communications Opposer has made regarding Syntel, Inc, this is
2 by far the dominant channel.
3

4 Response to Interrogatory Number 19
5

6 As a result of our continuous use of the syntel.com domain name,
7 and our continuous marketing of the Syntel programming language,
8 and a very substantial investment of money and effort in related
9 products and services, we have developed substantial goodwill
10 among financial services companies and their information
11 technology officers.
12

13 Response to Interrogatory Number 20
14

15 Opposer has done business on the Internet since 1986 using the
16 "syntel.com" domain name. "syntel.com" is the commercial
17 embodiment of the mark on the Internet.
18

19 Response to Interrogatory Number 21
20

21 Opposer has not objected to Applicant's use of the Mark in
22 International Classification 042, for the custom designing of
23 computer software and computer programming services.
24

25 Response to Interrogatory Number 22
26

27 Opposer believes that this Application is a step in Applicant's
28 efforts to take the syntel.com domain name from Opposer.
29 Applicant has demanded that Opposer hand over the syntel.com
30 domain name, in spite of Opposer's documented use of this domain
31 name before Applicant's first use of the Mark. Furthermore,
32 Applicant registered Opposer's company name as a domain name and
33 attempted to exchange that for the syntel.com domain, an act
34 forbidden by ICANN rules and prohibited by the Anti-
35 Cybersquatting Consumer Protection Act. These improper acts by
36 Applicant have already caused Opposer financial harm.
37

38 Response to Document Request Number 1
39

40 No documents were identified in this Response.
41

42 Response to Document Request Number 2
43

44 Opposer's only correspondence with the U.S. Patent and Trademark
45 Office was its Opposition.
46

47 Response to Document Request Number 3
48

49 Samples of those documents were submitted with the Opposition.
50

Response to Document Request Number 4

No such documents have survived the past twenty years.

1 Response to Document Request Number 5

2
3 Opposer believes that the documents relating to the first
4 shipment were destroyed around 1991.

5
6 Response to Document Request Number 6

7 A copy of a written agreement between Daniel M. Moore and
8 Jonathan Seder is attached. Opposer believes that this
9 agreement remains in effect, and applies to this document.
10

11 Response to Document Request Number 7

12
13 Opposer's use of the mark is in a plaintext form.
14

15 Response to Document Request Number 8

16 No such documents exist.
17

18 Response to Document Request Number 9

19
20 No such documents exist. However, Opposer's continuing use of
21 the Internet gives it a worldwide marketing exposure, and in
22 particular allows it to sell its products in all fifty States.
23

24 Response to Document Request Number 10

25
26 Opposer competes with Applicant and objects to this Request
27 because it would provide valuable competitive information, and
28 could violate third party privacy rights. However, without
29 waiving that objection, Opposer notes that products based on the
30 Syntel non-procedural programming language have been licensed to
31 more than five the fifty largest commercial banks in the United
32 States, and to more than five of the fifty largest commercial
33 property and casualty insurance companies in the United States.
34

35 Response to Document Request Number 11

36
37 Opposer objects to this demand because it violates privacy
38 rights of opposer and of third parties, and would provide to
39 Applicant valuable competitive information.
40

41 Response to Document Request Number 12

42
43 Opposer competes with Applicant and objects to this Request
44 because it would provide valuable competitive information.
45 Without waiving that objection, Opposer notes that records prior
46 to 1995 are not available, and that Opposer's current marketing
47 expense on the Internet is approximately \$250 per year.
48

49 Response to Document Request Number 13

50 Applicant has never attempted to register the mark.

1 Response to Document Request Number 14
2 Applicant has never licensed the Mark to any third party.
3
4 Response to Document Request Number 15
5 Applicant does not allow Licensees to use the Mark.
6
7 Response to Document Request Number 16
8 No specific references to the Mark would be made in any of
9 Opposer's agreements.
10
11 Response to Document Request Number 17
12 Opposer has never objected to any other party's use of the Mark.
13
14 Response to Document Request Number 18
15 Opposer has never objected to any other party's use of the Mark.
16
17 Response to Document Request Number 19
18 No third party has ever objected to Opposer's use of the Mark.
19 Syntel, Inc. has demanded that Opposer hand over the syntel.com
20 domain, and entered into a coercive scheme to attempt to compel
21 Opposer to comply.
22
23 Response to Document Request Number 20
24 The present proceeding related to the Mark is the only one in
25 which Opposer has ever been a party.
26
27 Response to Document Request Number 21
28 Opposer objects that this information is irrelevant or
29 privileged.
30
31 Response to Document Request Number 22
32 Opposer attempts to deal with confusion between its use of the
33 Mark and others' use by directing Website visitors to a table
34 listing the many dozens of users of the Mark. Opposer is not
35 aware of individual instances.
36
37 Approximately ten times per year, Opposer receives telephone
38 calls intended for Syntel, Inc.; Opposer politely explains that
39 Opposer is not Syntel, Inc., and advises the telephone caller on
40 how to find Syntel, Inc.
41
42 Response to Document Request Number 23
43 Opposer sells its products and services directly from its
44 headquarters location in Palo alto, California.
45
46
47
48
49
50

1 Response to Document Request Number 24

2
3 Opposer has searched diligently and has not been able to find
4 any such documents.

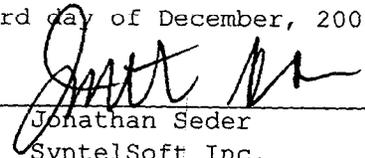
5
6 Response to Request for Admission Number 1

7 No. Opposer uses the syntel.com domain to market all its goods
8 and services, including diverse computer services and management
9 consulting services.
10

11 Response to Request for Admission Number 2

12
13 Opposer has acquiesced in Applicant's use of the Mark in
14 International Classification 042, for the custom designing of
15 computer software and computer programming services.
16
17
18
19
20

21 Dated this 23rd day of December, 2002

22
23
24 
25 _____
26 Jonathan Seder
27 SyntelSoft Inc.
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SYNTEL

Daniel M. Moore
Chief Administrative Officer

248/619-3508
248/619-2894 fax

November 8, 2001

SyntelSoft, Inc.
Jonathan Seder, President
PO Box 680
Palo Alto CA 94302-0680

Dear Mr. Seder:

Thank you for your letter dated October 31, 2001. Without agreeing or disagreeing with anything else in your letter, I am happy to agree that from this day forward, until withdrawn by either party, all communications between SyntelSoft Inc. and Syntel, Inc. and their employees, agents, attorneys, officers, and directors concerning the domain name, syntel.com, will be deemed privileged as provided by the California Evidence Code 1152 and Rule 408 of the Federal Rules of Evidence, and will not be admissible in any hearing, court, tribunal, arbitration, or other proceeding. If you are in agreement with this letter, please so indicate by signing below.

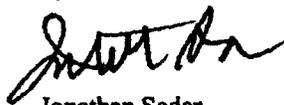
Please give me a call at your convenience.

Sincerely,



Daniel M. Moore

Agreed:
SyntelSoft, Inc.



Jonathan Seder
President



1 In the matter of Application Serial No. 76/216,493
 2 Filed on February 27, 2001
 3 For the mark SYNTEL
 4 Published in the Official Gazette on June 18, 2002
 5
 6
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8 _____)
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 10 SYNTELSOFT, INC.)
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 12 Opposer,)
 13)
 14 v.)
 15) Opposition No.91152909
 16)
 17 SYNTEL, INC.)
 18)
 19 Applicant)
 20 _____)
 21)
 22)

23 **OPPOSER'S RESPONSE TO**
 24 **APPLICANT'S SECOND REQUEST FOR**
 25 **PRODUCTION OF DOCUMENTS TO OPPOSER**
 26

27
 28 Opposer, SyntelSoft Inc., hereby responds to "Applicant's Second
 29 Request for Production of Documents to Opposer" dated April 7,
 30 2003.
 31

32 Opposer incorporates by reference the objections and caveats set
 33 forth in its previous Response. In particular, Opposer objects
 34 that the demand that production of "all documents evidencing
 35 each and every use of the mark SYNTEL..." is burdensome and would
 36 violate Opposer's reasonable privacy rights, particular given
 37 that Opposer and Applicant compete in the same International
 38 Classifications.
 39

40 Notwithstanding those objections and caveats, Opposer attempts
 41 to comply with Applicant's Request as follows:
 42

43 Response to Document Request Number 1

44 Opposer provides four Exhibits in response to Applicant's
 45 Request.
 46

47 Exhibit A is a copy of an April 2003 invoice for a sale of
 48 tangible materials identified with the SYNTEL mark.
 49

50 Exhibit B shows excerpts from a June 1996 license agreement for
 computer software labeled "SynCore SYNTEL Compiler."

1 Exhibit C shows the current home page of SyntelSoft Inc, at the
2 Internet address www.syntel.com, describing clearly its use of
3 the SYNTEL mark at the Internet SYNTEL address.
4

5 Exhibit D shows the home page of SyntelSoft Inc on 11 January
6 1998 - as recorded by the independent Internet Archive, PO Box
7 29244, San Francisco, CA 94129-0244 - proving SyntelSoft's use
8 of the SYNTEL mark before Applicant's claimed first use.
9

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14 Dated this 22nd day of April, 2003

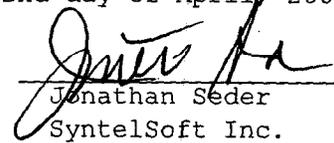
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18 Jonathan Seder
19 SyntelSoft Inc.
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Exhibit A

Exhibit B

SOFTWARE LICENSE AGREEMENT

THIS AGREEMENT is entered into and effective this 1st day of June, 1996

By and Between

SYNTELSOFT, INC.

having offices at 444 Castro, Suite 520, Mountain View, California 94041-2054, U.S.A.
(hereinafter "Syntel")

and

CROWE, CHIZEK AND COMPANY LLP

having offices at 330 E. Jefferson Boulevard, South Bend, Indiana 46601, U.S.A.
(hereinafter "Crowe")

For and in consideration of the mutual promises and obligations set forth below and other good and valuable consideration, Syntel and Crowe affirm and agree as follows:

1. **Language And Definitions.** It is the express desire of the parties that this Agreement and any related documents shall be drawn up, executed, construed and interpreted in the English language. As used in this Agreement, unless the context otherwise requires, the following terms shall have the meanings indicated; and all terms defined in the singular shall have the same meanings when used in the plural and *vice versa*:

- a. "Computing Environment" means the configuration of computer hardware and software described in Supplement B of this Agreement for operation of the Software.
- b. "Crowe" means Crowe, Chizek and Company LLP; an entity that owns a controlling interest in Crowe, Chizek and Company LLP; an entity in which Crowe, Chizek and Company LLP owns a controlling interest; or an entity that is under common control with Crowe, Chizek and Company LLP, and all employees, officers, partners, consultants and contractors who are employed by and working under the direction of these entities.
- c. "Derivative Products" means all things created or developed by Crowe during or derived or resulting from the activities permitted by Section 2.2 of this Agreement that, in their functions and/or operating characteristics, are new or materially different from the Licensed System;
- d. "Documentation" means all user manuals and related technical documents required to install and operate the Software.
- e. "In Use" means that any portion of the Software is either loaded in the memory of a computer ("Loaded") or stored on a hard disk ("Stored"); and the quantity of the Software In Use is the greater of the number of computers on which the

Software is Loaded at any one time or the number of computers on which the Software is Stored.

- f. "Licensed System" means the Software and the Documentation as delivered by Syntel to Crowe in accord with this Agreement and any modifications, updates, enhancements or improvements to either provided to Crowe thereafter by Syntel.
- g. "Scope Of Use" means the specifications in Supplement B of this Agreement of the User Entities and locations authorized to use the Software and quantity of the Software authorized to be In Use.
- h. "Software" means the computer software products specified in Supplement A of this Agreement as licensed products.
- i. "User Entities" means the entities within the business operation of Crowe that are specified in the Scope Of Use as authorized to use the Licensed System.

2. License.

2.1 Subject to all the provisions of this Agreement, Syntel grants to Crowe, and Crowe accepts, a non-exclusive, transferable license to use the Licensed System.

2.2 Crowe is hereby licensed to use the Licensed System in the ordinary course of its business for purposes including, but not limited to, the following:

- a. performing consultancy services;
- b. performing software development;
- c. developing or modifying the Licensed System, and developing new products derivable by Crowe from the Licensed System, whether such products are used or not in conjunction with the Software; and
- d. maintaining the Licensed System.

2.3 [REDACTED]

2.4 This license shall remain in effect for the duration of this Agreement.

**SOFTWARE LICENSE AGREEMENT
SUPPLEMENT A**

LICENSED SYSTEM AND FEES

1. LICENSED PRODUCT

Licensed Product

One-Time
License Fee

SynCore/2 Syntel Compiler, with SynCore/KBD R3.7 and its associated source code for use as specified in Supplement B

[REDACTED]

2. PAYMENT TERMS

In addition to the provisions of Section 26 of this Agreement, the parties agree that Syntel shall invoice Crowe in installments for the One-Time License Fees according to the following schedule:

- (1) June 1, 1996
- (2) September 1, 1996
- (3) December 1, 1996
- (4) April 1, 1997

[REDACTED]

Exhibit C

syntel.com is SyntelSoft, Inc, of Palo Alto, California, USA.

Since 1984, the syntel.com domain has belonged to SyntelSoft Inc and its predecessors, Syntelligence Inc. and Syntelligence Systems Inc. These companies created and market the SynCore® programming environment, the Syntel functional programming language, and the Underwriting Advisor® and Lending Advisor® systems.

Since 1984, SyntelSoft and its predecessors Syntelligence and Syntelligence Systems have been in the business of providing software licensing, computer consultation and software development services, principally involving our proprietary "Syntel" language.

The Syntel language was patented - using the name Syntel - in United States Patent 4,866,634, awarded by the United States Patent and Trademark Office on 12 September 1989.

In licensing and supporting users of the Syntel language, SyntelSoft and its predecessors have provided services in the fields of web site design, web site development, web site maintenance, web site upgrading, web site hosting, web site privacy, web site security, database design, selection of operating environment, development of operating environment, development and integration of interactive content and design; and in the fields of computer software applications, computer software maintenance, and computer software development; technical support services via telephone, email, facsimile, pager, and in person; and enabling legacy applications for use on the world wide web.



SyntelSoft Inc of Palo Alto, California USA
www.syntel.com

[Click here for other "Syntels".](#)

	It's never been easier to buy on ibm.com.		
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[Click here for our privacy policy.](#)

Exhibit D

SynCore®
Solutions



SynCore Solutions for Your Business

Platforms and
Components

Syntel™
Language
& SynTools®

User Interface
Features

SynCore
Demonstration

File Cabinet

Underwriting
Advisor®
Knowledge
Bases

Underwriting
Advisor
Benefits

SyntelSoft creates, markets, and supports computer software for capturing and analyzing complex and uncertain information.

SynCore, originally developed by Syntelligence, is a functional programming environment used to create powerful and sophisticated business applications. SyntelSoft is the sole world-wide distributor for SynCore and the Underwriting Advisor system.

Our SynCore solutions include:

- Underwriting Advisor used by insurance underwriters worldwide to understand, analyze, and manage business risk
- SynCore Server for Java, our client/server solution for distributing applications over an intranet or the Internet
- SynCore/2, our workstation-based system
- SynCore/1, our mainframe system

For more information on *Underwriting Advisor*, *SynCore Server for Java*, and other SyntelSoft solutions, please contact sales@syntel.com.

SyntelSoft, Inc.
3977 East Bayshore
Bld. Suite 220
PO BOX 50605
PALO ALTO CA
94303-0605

Phone: 650-691-9521

Fax: 650-691-1789

For information on banking industry solutions based on SynCore technology, please see www.famas.com or contact:

Crowe Chizek

E-mail: famas@crowechizek.com

*Clarendon House, Clarendon 330 East Jefferson
Road Blvd.
Redhill Surrey RH1 1FB UK South Bend, IN 46628
Phone:+44 (1737) 788400 Phone: 800-523-2627
Fax:+44 (1737) 788401 Fax: (219) 236-8612*

Note: Syntel Inc., the Michigan-based provider of professional consulting services, may be found at <http://www.syntelinc.com>.

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Copyright and Trademark Information

Proof of Service By Mail

On the date below, I sent by First Class Mail "OPPOSER'S RESPONSE TO APPLICANT'S SECOND REQUEST FOR PRODUCTION OF DOCUMENTS TO OPPOSER" and this

Proof of Service to:

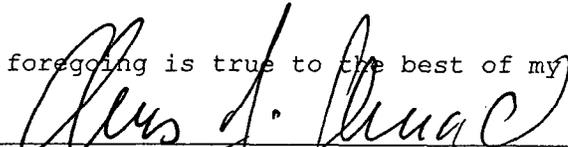
Bodman, Longley, and Dahling LLP
110 Miller Ave Ste 300
Ann Arbor MI 48104-1387.

I declare that the foregoing is true to the best of my knowledge.

Signed

Printed Name

Date


Alex J. Arnad
4/22/07

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