ESTTA Tracking number: **ESTTA155370**
Filing date: **08/07/2007**

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

Proceeding	91167540
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Date	08/07/2007
Attachments	Trial Brief.pdf (21 pages)(693672 bytes)

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

Mintek Corporation, Opposer, v. **Samuel Bouter, dba Minatek Solutions,** Applicant.	In re Serial No. For the mark Filed Opposition No.	**78/490,643** **MINATEK** **September 28, 2004** **91167540**

TRIAL BRIEF OF OPPOSER

TABLE OF CONTENTS

TABLE OF AUTHORITIES 4

I. INTRODUCTION..... 6

A. Recitation of the Facts..... 6

B. Statement of the Issues..... 8

1. Whether use of MINATEK for the services recited in Application No. 78/490,643 is likely to cause confusion with Opposer's use of the mark MINTEK for similar services..... 8

2. Whether Applicant's registration of the mark MINATEK in a foreign country supersedes the rights of a senior user of a confusingly similar mark in the United States..... 8

C. Statement of the Record..... 9

II. ARGUMENT..... 10

A. Use of MINATEK for the services recited in Application No. 78/490,643 is likely to cause confusion with Opposer's use of the mark MINTEK for similar services..... 10

1. The marks MINTEK and MINATEK are nearly identical in appearance, sound and connotation..... 11

2. The goods and services recited in the application are strongly related to the services offered by Opposer..... 12

3. The trade channels through which the respective goods are offered are indistinguishable..... 14

4. MINTEK is Opposer's house mark and is used on a wide variety of services..... 15

5. Opposer has the right to exclude Applicant from the use of a nearly identical mark on strongly related goods..... 16

B. Applicant's registration of the mark MINATEK in a foreign country does not

supersede the rights of a senior user of a confusingly similar mark in the United States..... 16

IV. CONCLUSION..... 20

TABLE OF AUTHORITIES

15 U.S.C. 1052(d) 16

15 U.S.C.A. § 1126(e) 17

Alfred Electronics v. Alford Mfg. Co., 333 F.2d 912, 142 U.S.P.Q. 168 (C.C.P.A. 1964) 16

Amcor, Inc. v. Amcor Industries, Inc., 210 U.S.P.Q. 70, 78 (TTAB 1981) 14

Arrow Distilleries, Inc. v. Globe Brewing Co., 117 F.2d 347, 48 U.S.P.Q. 157 (4th Cir. 1941) 12

Aveda Corp. v. Evita Marketing, Inc., 706 F. Supp. 1419, 12 U.S.P.Q.2d 1091, 1098 (D. Minn. 1989) 11

Champion Corp. v. Champion, Inc., 160 U.S.P.Q. 755 (T.T.A.B. 1969) 17

Cyber-Tronics, Inc. v. Johnson Service Co., 156 U.S.P.Q. 583 (T.T.A.B. 1967) 17

Dynamet Technology, Inc. v. Dynamet, Inc., 593 F.2d 1007, 201 U.S.P.Q. 129 (C.C.P.A. 1979) 17

E.I. du Pont de Nemours & Co. v. Sunlyra Int'l, Inc., 35 U.S.P.Q.2d (BNA) 1787 (T.T.A.B. 1995) 11

Holiday, Inc. v. Holiday Magic, Inc., 167 U.S.P.Q. 118 (T.T.A.B. 1970), aff'd, 476 F.2d 1376, 177 U.S.P.Q. 572 (C.C.P.A. 1973)) 17

In re Corning Glass Works, 229 USPQ 65 (TTAB 1985)..... 13

In re Dixie Restaurants, Inc., 105 F.3d 1405, 1406-07, 41 USPQ2d 1531, 1533 (Fed. Cir. 199)..... 10

In re Karlovarske Sklo, Narodni Podnik, 122 U.S.P.Q. 583 (T.T.A.B. 1959) 18

In re Majestic Distilling Co., 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003) 10

In re the Matter of E. I. du Pont de Nemours & Co., 476 F. 2d 1357, 1361, 177 U.S.P.Q. (BNA) 563 (C.C.P.A. 1973) 10

In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984) 13

In re National Novice Hockey League, Inc., 222 USPQ 638, 640 (TTAB 1984) 10

In re Rath , 402 F.3d 1207 , 74 USPQ2d 1174, 1179 (Fed. Cir. 2005) 18

In re Shell Oil Co., 992 F.2d. 1204, 26 U.S.P.Q.2d 1687, 1689 (Fed. Cir. 1993) 14

In re Societe D'Exploitation de la Marque Le Fouquet's, 67 U.S.P.Q.2d 1784, 2003 WL 22021944 (T.T.A.B. 2003) 18

J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 29:13 (4th ed.2004) 18

Jim Dandy Co. v. Martha White Foods, Inc., 458 F.2d 1397, 173 U.S.P.Q. 673 (C.C.P.A. 1972) 16

Krim-Ko Corp. v. Coca-Cola Bottling Co., 390 F.2d 728, 156 U.SP.Q. (BNA) 523, 526 (C.C.P.A. 1968) 11

Olde Tyme Foods, Inc. v. Roundy's Inc., 961 F.2d 200, 22 U.S.P.Q. (BNA) 1542, 1544 (Fed. Cir. 1992) 15

Sheraton Corp. of America v. Sheffield Watch, Inc., 480 F.2d 1400, 178 U.S.P.Q. 468 (C.C.P.A. 1973) 17

Stork Restaurant v. Sahati, 166 F.2d 348, 76 U.S.P.Q. 374 (9th Cir. 1948) 11

The All England Lawn Tennis Club (Wimbledon) Ltd. V. Creations Aromatiques, Inc., 220 U.S.P.Q. (BNA) 1069 (T.T.A.B. 1983) 14

TuTorTape Laboratories, Inc. v. Halvorson, 155 U.S.P.Q. 268 (T.T.A.B. 1967) 17

I. INTRODUCTION

Opposer, Mintek Associates, Inc. (hereinafter "Opposer") hereby submits its trial brief in opposition of the registration of the mark MINATEK, U.S. Trademark Serial No. 78/490,643 (hereinafter "the Application) by Samuel Bouter, DBA Minatek Solutions (hereinafter "Applicant").

A. Recitation of the Facts

Opposer was founded in 1987 as Mintek Associates, Inc. (Declaration of Linda Hutton, Para. 1). Opposer began using the term MINTEK as a trade name at least as early as 1987 and as a trademark at least as early as 1990 and has continued to use the mark MINTEK, both as the word and associated with various logos and designs, since 1990. (Declaration of Linda Hutton, Para. 6 and 7).

Opposer filed an in-use application on October 28, 2004 for the mark MINTEK in connection with computer software development for integrating mobile devices, billings systems, and other databases in the cable and hospitality industries. The Examining Attorney found no similar registered marks which would bar registration under Section 2(d) of the Lanham Act, but suspended further action on the application pending the disposition of application for the mark MINATEK, serial number 78-480643, by Applicant, Minatek Solutions. (Notice of Suspension, June 3, 2005). Opposer first became aware of Applicant's use of the mark MINATEK upon receiving the Notice of Suspension (Grounds for Opposition, Para. 3).

Applicant filed an intent-to-use application based on a foreign registration on September 28, 2004 for the mark MINATEK in connection with computer software

designed to manage a business' customers, known as customer relationship management or CRM software, by keeping track of their interactions with the business and providing reports and reminders to the sales team and management; product and billing management, known as point-of-sale or POS software, e-commerce, and electronic client invoicing, designed to allow a business through the complete retail cycle of listing, selling, invoicing, payment collection, and shipping of products both on Internet and a traditional retail outlet; notification software to e-mail or phone a client letting them know a product or service they subscribe to is ready or available. The Application is based on prior Canadian Registration TMA616130 which has a filing date of September 6, 2002 and claims use of the mark in Canada since January 1, 2000. The Canadian Registration issued on August 2, 2004.

The Examining Attorney issued a rejection under Section 2(d) of the Lanham Act citing a likelihood of confusion with mark MINETEK, U.S. Registration No. 2,530,496 to MineTech, Inc., used in connection with computer software and documentation sold as a unit therewith for use in data mining; in data modeling, namely creating models that predict and describe patterns of behavior; in campaign management integration, namely integrating data models into marketing, promotional or sales campaigns; in data base management for general use with data models; and in data base enhancement, namely supplementing data bases with additional data and consulting and computer services in the fields of data mining, data modeling, campaign management integration, data base management and data base enhancement. (Office Action, May 13, 2005). The Examining Attorney also requested information relating to whether the term MINATEK had any meaning in a foreign language or any significance in the relevant trade or

industry or as applied to the goods and/or services. (Office Action, May 13, 2005). The Examining Attorney found the identification of goods and recitation of services unacceptable because they both included wording that did not identify any goods or services and further requested applicant list the goods and/or services by international class and submit the proper filing fee for each should it wish to continue with multiple class prosecution. (Office Action, May 13, 2005).

Applicant responded to the rejection on May 18, 2005 by citing the differences in pronunciation, spelling, and the goods and services, specifically, that Minatek does not provide mining services. (Response to Office Action, May 18, 2005). Applicants also pointed out that both companies appear to offer products and services in business-to-business relationships making the consumer less likely to be confused because they have a specific purpose in mind. (Response to Office Action, May 18, 2005). Applicant amended the goods and services and stated that the term MINATEK has no foreign meaning. (Response to Office Action, May 18, 2005).

The application was published for opposition on September 13, 2005. On October 12, 2005, Opposer submitted a request for an extension of time to oppose and on November 14, 2005, Opposer instituted this action.

B. <u>Statement of the Issues</u>

1. Whether use of MINATEK for the services recited in Application No. 78/490,643 is likely to cause confusion with Opposer's use of the mark MINTEK for similar services.

2. Whether Applicant's registration of the mark MINATEK in a foreign country supersedes the rights of a senior user of a confusingly similar mark in the United States.

C. The Record

The record consists of:

The prosecution history of U.S. Serial No. 78/490,643 for MINATEK;

The notice of opposition filed by Mintek;

The answer filed by Minatek;

The declaration testimony of Samual Bouter, along with Exhibits 1 through 5;

The declaration testimony of Lind E. Hutton, along with Exhibits 1 through 5;

Mintek's Notice of Reliance on the official records of the certified articles of incorporation and annual reports for Mintek;

Mintek's Notice of Reliance on Minatek's responses to Mintek's requests for admissions;

Mintek's Notice of Reliance on the answers to interrogatories; and

Mintek's Notice of Reliance on Minatek's responses to Mintek's requests for production.

III. ARGUMENT

A. Use of MINATEK for the services recited in Application No. 78/490,643 is likely to cause confusion with Opposer's use of the mark MINTEK for similar services.

A finding of a likelihood of confusion is reached after analyzing the elements set forth in *In re the Matter of E. I. du Pont de Nemours & Co.,* 476 F. 2d 1357, 1361, 177 U.S.P.Q. (BNA) 563 (C.C.P.A. 1973). Not all factors are relevant to a determination of likelihood of confusion. For example, the issue of likelihood of confusion typically revolves around the similarity or dissimilarity of the marks and the relatedness of the goods or services. The other factors listed in *du Pont* may be considered only if relevant evidence is contained in the record. (see *In re Majestic Distilling Co.,* 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003) ("Not all of the *DuPont* factors may be relevant or of equal weight in a given case, and 'any one of the factors may control a particular case,'" quoting *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 1406-07, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997)); *In re National Novice Hockey League, Inc.*, 222 USPQ 638, 640 (TTAB 1984).

Here, the relevant elements of the *du Pont* test that are supported by the evidence are:

1. The similarity, or dissimilarity, of the marks in their entireties as to appearance, sound, connotation, and commercial impression.
2. The similarity, or dissimilarity, and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.

3. The similarity, or dissimilarity, or established and likely-to-continue trade channels.

4. The variety of goods on which a mark is, or is not, used (house mark, family mark, product mark).

5. The extent to which a senior user has a right to exclude other from use of its mark.

1. <u>The marks MINTEK and MINATEK are nearly identical in appearance, sound, and connotation.</u>

MINTEK and MINATEK are nearly identical in appearance, sound, and connotation, which support a finding of a likelihood of confusion between the marks. A mark should be refused registration where "the similarity in form, spelling, or sound alone is likely to cause confusion." (*E.I. du Pont de Nemours & Co. v. Sunlyra Int'l, Inc.*, 35 U.S.P.Q.2d (BNA) 1787 (T.T.A.B. 1995) (citing *Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 U.SP.Q. (BNA) 523, 526 (C.C.P.A. 1968)).

The term MINTEK is a fanciful term that has no significance in the industry, other than Opposer's use, and is, therefore, inherently distinctive. Given that the term MINTEK is a fanciful term, it is entitled to broader protection to suggestive marks or descriptive marks which have acquired distinctiveness. (see *Stork Restaurant v. Sahati*, 166 F.2d 348, 76 U.S.P.Q. 374 (9th Cir. 1948) (greater degree of protection given to fanciful marks than to names in common use); *Aveda Corp. v. Evita Marketing, Inc.,* 706 F. Supp. 1419, 12 U.S.P.Q.2d 1091, 1098 (D. Minn. 1989) (Quoting treatise: "Fanciful

marks, if adopted in a bona fide first use, are considered the strongest of marks because their inherent novelty creates a substantial impact on the buyer's mind.").

As a "strong" mark, the mark MINTEK is to be given an expansive scope of protection into different product or geographical markets and as to more variations of format. Consequently, the likelihood of confusion of a "strong" mark with similar marks will be more readily inferred. (*Arrow Distilleries, Inc. v. Globe Brewing Co.,* 117 F.2d 347, 48 U.S.P.Q. 157 (4th Cir. 1941). (The more distinctive the trademark is, the greater its influence in stimulating sales, its hold on the memory of the purchaser and the likelihood of associating similar designations on other goods with the same source. If the trademark is a coined word it is more possible that all goods on which a similar designation is used will be regarded as emanating from the same source than when the trademark is one in common use on a variety of goods, such as "Gold Seal" or "Excelsior.")).

Since the MINATEK mark should be compared to the MINTEK mark as if it is used in the same font since the mark in the Application is not shown in any particular form. As it can be seen, MINTEK and MINATEK differ by only a single letter. The *de minimis* alteration in spelling does little to distinguish the appearance, sound, or meaning of the mark.

Therefore, this *du Pont* factor weighs heavily in supporting a finding of a likelihood of confusion between MINTEK and MINATEK.

2. <u>The goods and services recited in the application are strongly related to the services offered by Opposer.</u>

The services of the respective parties need not be identical or directly competitive to find a likelihood of confusion. The services need only be related in some manner, or the conditions surrounding their marketing be such, that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods/services come from a common source. (*In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); and *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985)). "Related" does not require a physical relationship between the goods or services identified by the conflicting marks. (*Id.*). Rather, it means that the marks as used are "related" in the mind of the consuming public. (*Id.*). Services are "related" if customers are likely to mistakenly think that the infringer's goods come from the same source as the senior user's goods or are sponsored by, affiliated with, or connected with the senior user.

Applicant and Opposer's goods and services are strongly related. Applicant's description of services includes: providing computer software designed to manage a business customers, known as customer relationship management or CRM software, by keeping track of their interaction with the business and providing reports and reminders to the sales team and management; product and billing management, known as point-of-sale or POS software, e-commerce, and electronic client invoicing, designed to allow a business through the complete retail cycle of listing, selling, invoicing, payment collection, and shipping of products both on Internet and a traditional retail outlet; notification software to e-mail or phone a client letting them know a product or service they subscribe to is ready or available.

Opposer provides computer software development services for integrating mobile devices, billings systems, and other databases. In addition to both users providing related services, namely providing computer software services to aid businesses in the management of their clientele, "the relationship between the goods on which the parties use their marks need not be as great or as close as in the situation where the marks are not identical or strikingly similar." (*Amcor, Inc. v. Amcor Industries, Inc.,* 210 U.S.P.Q. 70, 78 (TTAB 1981); see also *In re Shell Oil Co.*, 992 F.2d. 1204, 26 U.S.P.Q.2d 1687, 1689 (Fed. Cir. 1993) ("Even when goods or services are not competitive or intrinsically related, the use of identical marks can lead to an assumption that there is a common source.")).

This *du Pont* factor also weighs heavily in supporting a finding of a likelihood of confusion between MINTEK and MINATEK.

3. <u>The trade channels through which the respective goods are offered are indistinguishable.</u>

Applicant's description of goods and services does not contain any limitation with regard to the channels of distribution. It would therefore be improper to limit the channels of trade and it should be presumed that services offered under the MINATEK mark are advertised and performed through all customary trade channels for such services and that they are provided to all the customary purchasers for those types of services. (*The All England Lawn Tennis Club (Wimbledon) Ltd. V. Creations Aromatiques, Inc.*, 220 U.S.P.Q. (BNA) 1069 (T.T.A.B. 1983) (when goods in an application are not restricted as to trade channels, they must be presumed to travel though the normal

channels of trade associated with such goods); *Olde Tyme Foods, Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 U.S.P.Q. (BNA) 1542, 1544 (Fed. Cir. 1992) (when the registrations do not place restrictions on trade channels and classes of purchasers, the Board presumes that the goods reach all classes of purchasers through all customary trade channels.)). Accordingly, the marks should be compared as though they are advertised and/or provided in juxtaposition. There is no evidence of record to support a finding that the trade channels of the parties differ or will diverge in the future.

This *du Pont* supports a finding of likelihood of confusion because there is no difference between the established, likely-to-continue trade channels used by Opposer and Applicant.

4. <u>MINTEK is Opposer's house mark and is used on a wide variety of services.</u>

The evidence shows that Opposer has used MINTEK as a house mark since its inception. (Declaration of Lind Hutton, Para. 2; Articles of Incorporation for Mintek Corporation, Exhibit 6). The evidence also shows that Applicant intends to use the nearly identical term, MINATEK, as a house mark on strongly related services.

Opposer uses its mark on a wide variety of goods and services as a provider of software solutions as well as a value-added reseller, providing labels, scanners, printers and other devices utilizing barcode technology. (Testimony of Lind Hutton, Page 1). The use of the mark on this wide range of products makes it more likely that customers would expect the services offered by Applicant under a nearly identical mark to come from the

same source. It is therefore likely that potential customers will assume that Applicant's services are actually offered by Opposer.

This *du Pont* factor weighs in favor of a likelihood of confusion as well.

5. <u>Opposer has the right to exclude Applicant from the use of a nearly identical mark on strongly related goods.</u>

The record shows that Opposer adopted MINTEK as a trade name as early as 1990 and used MINTEK as a trademark at least as early as 1990 (Testimony of Lind Hutton, Page 1). Therefore, Opposer has a right to exclude others from use of MINTEK, as well as confusingly similar marks, on related goods. (15 U.S.C. 1052(d))

Therefore, this *du Pont* factor also supports the finding of a likelihood of confusion.

B. <u>Applicant's registration of the mark MINATEK in a foreign country does not supersede the rights of a senior user of a confusingly similar mark in the United States.</u>

Opposer has shown evidence of prior use of a confusingly similar designation in a trademark sense. Opposer has also demonstrated its use of MINTEK as a trade name previously used in the United States. (Declaration of Lind Hutton, Paras. 9 through 14; Exhibits 1 through 5). Opposer's use of MINTEK as a business name or as a trade name is a proper ground for opposition to the registration of a MINATEK as a trademark or service mark. (*Alfred Electronics v. Alford Mfg. Co.*, 333 F.2d 912, 142 U.S.P.Q. 168 (C.C.P.A. 1964); *Jim Dandy Co. v. Martha White Foods, Inc.*, 458 F.2d 1397, 173

U.S.P.Q. 673 (C.C.P.A. 1972); *Sheraton Corp. of America v. Sheffield Watch, Inc.*, 480 F.2d 1400, 178 U.S.P.Q. 468 (C.C.P.A. 1973); *Dynamet Technology, Inc. v. Dynamet, Inc.*, 593 F.2d 1007, 201 U.S.P.Q. 129 (C.C.P.A. 1979); see *Cyber-Tronics, Inc. v. Johnson Service Co.*, 156 U.S.P.Q. 583 (T.T.A.B. 1967) (use of CYBER-TRONICS as salient feature of corporate name sufficient to preclude registration of CYBERTRONIC as trademark); *TuTorTape Laboratories, Inc. v. Halvorson*, 155 U.S.P.Q. 268 (T.T.A.B. 1967) (opposer's prior use of TUTOR TAPE as salient feature of corporate name sufficient to preclude registration of TUTOR-TAPE as trademark); *Champion Corp. v. Champion, Inc.*, 160 U.S.P.Q. 755 (T.T.A.B. 1969); *Holiday, Inc. v. Holiday Magic, Inc.*, 167 U.S.P.Q. 118 (T.T.A.B. 1970), aff'd, 476 F.2d 1376, 177 U.S.P.Q. 572 (C.C.P.A. 1973)).

Opposer's prior use of MINTEK as a trade name alone is sufficient to preclude registration of a similar term for related goods or services under section 2(d) even though Applicant has an earlier application by virtue of its foreign registration filed under section 44(e). Under section 44(e), a foreign national may obtain a United States trademark registration even though the foreign national has never used the mark in the United States or in foreign commerce. The Lanham Act therefore permits a mark duly registered in the country of origin of the foreign applicant to be registered on the Principal Register "if eligible" without showing lawful use in commerce, as is required of domestic registrants. (15 U.S.C.A. § 1126(e)).

While section 44-based registrations are given special status with regard to pre-registration use, the Lanham Act allows registration to the mark only "if eligible," meaning that the mark is subject to all the recognized statutory bars to U.S. registration.

Applications filed under section 44(e) must satisfy the conditions set forth in section 2 prior to registration on the Principal Register. (*In re Rath* , 402 F.3d 1207 , 74 USPQ2d 1174, 1179 (Fed. Cir. 2005) ("[I]t is impossible to read section 44(e) to require the registration of foreign marks that fail to meet United States requirements for eligibility. Section 44 applications are subject to the section 2 bars to registration...")). The language of section 44(e) makes it clear that the reference to eligibility pertains to eligibility for registration on the principal register and that the requirement of eligibility necessarily means "that the mark is subject to all the recognized statutory bars to U.S. registration." *(In re Rath*, 402 F.3d 1207, 1213 (citing 4 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 29:13 (4th ed.2004)). For example, an application under section 44 is subject to rejection for being descriptive under section 2(e). (*In re Karlovarske Sklo, Narodni Podnik*, 122 U.S.P.Q. 583 (T.T.A.B. 1959) (GIANT SNIFTER held descriptive)).

Moreover, the Board has observed: "[A]s a result of treaty provisions and Section 44, foreign applicants are given substantial advantages over U.S. citizens, most particularly, the right to obtain U.S. registrations for goods and services for which they have not yet used the marks in commerce… . As a result, the provisions of Section 44 should be construed narrowly." (*In re Societe D'Exploitation de la Marque Le Fouquet's*, 67 U.S.P.Q.2d 1784, 2003 WL 22021944 (T.T.A.B. 2003)).

Applicant is entitled to an application filing date of August 2, 2004, by virtue of its Canadian registration TMA616130. Applicant alleges that the mark MINATEK has been used since 2000 in the United States. (Declaration of Bouter, Page 1). In support of this allegation, Applicant has produced the following documents:

(1) A Network Solution's WHOIS record for www.humarbo.com. The record shows Humbardo, vof to be the registrant, not Applicant. Applicant is merely named as the Administrative and Technical Contact; (*Id.*, Exhibit 3).

(2) A DENIC's WHOIS record for www.betonexport.de. The record shows BetonExport e.K. to be the registrant, not Applicant. The only mention of Applicant is an email address in the contact section (admin@minateksolutions.com); (*Id.*, Exhibit 4).

(3) A Network Solution's WHOIS record for www.djcmatzone.com. The record shows Carapezza, Dennis to be the registrant, not Applicant. Applicant is merely named as the Administrative Contact; (*Id.*, Exhibit 5).

Whether Applicant has used the mark in any foreign jurisdiction is irrelevant, the evidence provided by Applicant does not show trademark use of the term MINATEK in the United States. Even assuming the facts were as Applicant believes, the Solution's WHOIS record for www.djcmatzone.com shows a creation date of September 23, 2004.

In contrast, Opposer has provided substantial evidence of its long and continuous domestic use of the mark MINTEK in connection with computer software development services for integrating mobile devices, billings systems and other databases. (Declaration of Lind Hutton, Paras. 6 through 14; Exhibits 1 through 5). The testimony of Opposer's Executive Vice President and Chief Operating Officer, and the Exhibits filed in support thereof, shows that Opposer has been using the term MINTEK as a trade name as early as 1987 and as a trademark at least as early as 1990. (Declaration of Lind

Hutton, Page 1). Moreover, Opposer has produced Software End-User License Agreements bearing a stylized version of the mark MINTEK, signed by the consumer on December 22, 1996 and December 14, 1999. (Exhibits 2 and 3, respectively). The agreements, which are provided in the course of performing Opposer's services, establish trademark use as they create an association between the mark and the services, which are spelled out in the agreements.

Even assuming all facts alleged by Applicant are true, Opposer has clearly established domestic use of a confusingly similar mark prior to the earliest date alleged by Applicant. Accordingly, Applicant's mark, MINATEK, is not eligible for registration under section 2(d).

IV. CONCLUSION

Opposer respectfully requests that the Board grant the petition to cancel for the following reasons.

1. Registration of the mark MINATEK for the services recited in Application NO. 78/490,643 is likely to cause confusion with Opposer's use of the mark MINTEK for similar services.
2. Opposer's use of the mark MINTEK as both a trade name and as a trademark supersedes Applicant's registration of the mark MINATEK based on a foreign registration under §44(e).

Date: August 7, 2007

Respectfully,

SMITH & HOPEN, P.A.

By: _____

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing TRIAL BRIEF OF OPPOSER MINTEK CORPORATION, and duly signed by attorneys for Opposer, has been served upon Applicant this **August 7, 2007** by email followed by mailing a copy by U.S. Express Mail Postage Label No. **EV 960647012 US** to the following: Samuel Bouter, Minatek Solutions, 9049 Commercial St., Suite 260, New Minas, NS B4N 5A4, CAX – Canada.

Date: August 7, 2007

By: L Reeves

Lauren Reeves