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Mailed:
Dec. 17, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Mintek Corporation
v.
Samuel Bouter dba Minatek Solutions

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Opposition No. 91167540
to application Serial No. 78490643
filed on September 28, 2004

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Thomas E. Toner of Smith & Hopen, P.A. for Mintek Corporation.

Samuel Bouter dba Minatek Solutions, pro se.

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Before Grendel, Drost and Zervas, Administrative Trademark Judges.

Opinion by Grendel, Administrative Trademark Judge:

Samuel Bouter dba Minatek Solutions, a Canadian sole proprietorship and applicant herein, seeks registration on the Principal Register of the mark MINATEK (in standard character form) for Class 9 goods identified in the application as:

> 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 [sic – follow?] 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 was filed on September 28, 2004, based on applicant's ownership of Canadian Registration No. TMA616130. Trademark Act Section 44(e), 15 U.S.C. §1126(e).

Mintek Corporation, opposer herein, has filed a timely notice of opposition to registration of applicant's mark. As its ground of opposition, opposer alleges that it is the prior user of the trade name and service mark MINTEK in connection with computer software development for integrating mobile devices, billings systems and other databases, and that applicant's mark as used on applicant's goods so resembles opposer's trade name and service mark as to be likely to cause confusion, to cause mistake, or to deceive. Trademark Act Section 2(d), 15 U.S.C. §1052(d).

Applicant filed an answer denying the salient allegations of the notice of opposition.

Both parties presented evidence at trial. Opposer filed a brief, but applicant did not.

The evidence of record consists of the pleadings; the file of applicant's involved application; the testimony declaration of opposer's officer Lind E. Hutton and opposer's Exh. Nos. 1-5 thereto (submitted pursuant to the parties' Rule 2.123(b) stipulation); opposer's notices of reliance on official records (opposer's Exh. Nos. 6-8) and on applicant's discovery responses (opposer's Exh. Nos. 9-11); and the testimony declaration of applicant's principal Samuel Bouter and applicant's Exh. Nos. 1-5 thereto (submitted pursuant to the parties' Rule 2.123(b) stipulation).

The undisputed evidence of record establishes that opposer "is a value-added reseller providing computer software development for integrating mobile devices, billings systems and other databases." (Hutton Decl. ¶ 5.) Opposer uses the designation MINTEK as a trade name and a service mark in connection with its services. (Hutton Decl. at ¶¶ 2, 6-8.) Based on this evidence, we find that opposer has standing to oppose registration of applicant's mark. *See Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); *see also Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000).

We find that the earliest date upon which applicant can rely for priority purposes is his application filing date,

September 28, 2004.[1] The undisputed evidence of record establishes that opposer began using MINTEK as a trade name and a service mark in connection with its services prior to any date upon which applicant can rely. See Hutton Decl. at ¶¶ 6-7 (averring opposer's continuous use of MINTEK since 1990), and Exh. Nos. 1-5 (showing opposer's use of MINTEK on a 1998 advertisement, in 1996 and 1999 license agreements with third-party licensees, and in a 2002 PowerPoint presentation made to potential customer). Based on this evidence, we find that opposer has Section 2(d) priority.

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue (the *du Pont* factors). *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d

[1] There is no date of first use alleged in applicant's Section 44(e) application. In his testimony declaration, applicant, a Canadian citizen, states that "Minatek and Minatek Solutions has been used since 2000 in the products and services offered both in Canada, the United States of America, The Netherlands, Germany, and due to the nature of some of the products and services to other countries. See Exhibits 3, 4, and 5." Those exhibits consist of printouts of WHOIS search results in which applicant is named as the "contact" for "humarbo.com" of The Netherlands, "betonexport.de" of Germany, and "djcmatzone" of the United States. We find that these WHOIS records, which merely identify applicant as a "contact" for what on this record appear to be unrelated third-party domain name registrants, fail to persuasively establish applicant's claimed 2000 date of first use. In any event, opposer's proven use of its mark prior to 2000 gives opposer Section 2(d) priority.

1689 (Fed. Cir. 2005); *In re Majestic Distilling Co.,* 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

The first *du Pont* factor requires us to determine the similarity or dissimilarity of the parties' marks when viewed in their entireties in terms of appearance, sound, connotation and overall commercial impression. *Palm Bay Imports, Inc., supra*. The test, under the first *du Pont* factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Opposer's mark is MINTEK. Applicant's mark is MINATEK. But for the presence of the additional letter and syllable "a" in the middle of applicant's mark, applicant's mark is identical to opposer's mark in terms of appearance and sound. Certainly, the marks look and sound highly similar. To the extent that these apparently coined marks have connotations, the connotation would be similar in both

marks. In terms of overall commercial impression, the marks are highly similar, each appearing as a coined word which begins with the letters "MIN" and ends with the letters "TEK." The additional single letter "A" inserted in the middle of applicant's mark does not suffice to distinguish the overall commercial impressions created by the marks. In short, we find that applicant's mark is highly similar to opposer's mark in terms of appearance, sound, connotation and overall commercial impression. The first *du Pont* factor weighs in favor of a finding of likelihood of confusion.

The second *du Pont* factor requires us to determine the similarity or dissimilarity of opposer's services and applicant's goods as identified in the application. It is settled that it is not necessary that the goods and services be identical or even competitive in order to find that they are related under the second *du Pont* factor. That is, the issue is not whether consumers would confuse the goods and services themselves, but rather whether they would be confused as to the source of the goods and services. *See In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984). It is sufficient that the goods and services be related in some manner, or that the circumstances surrounding their use be such, that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from

or are in some way associated with the same source or that there is an association or connection between the sources of the respective goods and services. *See In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

Opposer develops software for integrating mobile devices, billings systems and other databases. These software development services are related to applicant's computer software as identified in the application, especially to the extent that applicant's software is used for "billing management" and opposer is engaged in developing software for "billings systems." Opposer's services and applicant's goods are likely to be marketed to and used by the same purchasers, including businesses seeking software to assist them in managing their relationships with their customers. We find that the second *du Pont* factor weighs in favor of a finding of likelihood of confusion.

To summarize, we find that opposer's mark is coined and therefore strong, and that applicant's mark is essentially identical or at least highly similar to opposer's mark. We also find that applicant's goods are sufficiently related to opposer's services that confusion is likely to result from

the parties' use of these highly similar marks on or in connection with such goods and services. For these reasons, we conclude that a likelihood of confusion exists. To the extent that any doubts might exist as to the correctness of this conclusion, we resolve such doubts against applicant. *See In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc., supra.*

In conclusion, we find that opposer has standing, that opposer has Section 2(d) priority, and that a likelihood of confusion exists. Opposer therefore is entitled to prevail in this proceeding.

Decision: The opposition is sustained.