

ESTTA Tracking number: **ESTTA60862**

Filing date: **01/09/2006**

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

Proceeding	91167540
Party	Plaintiff Mintek Corporation Mintek Corporation Unit A 1022 Main Street Dunedin, FL 34698
Correspondence Address	Thomas E. Toner SMITH & HOPEN, P.A. 15950 BAY VISTA DR STE 220 CLEARWATER, FL 33760-3118
Submission	Motion for Default Judgment
Filer's Name	Thomas E. Toner
Filer's e-mail	tom.toner@smithhopen.com
Signature	/thomas e toner/
Date	01/09/2006
Attachments	Motion for Default.pdf ( 10 pages )

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

In re Application Serial No. : 78/490,643  
For the Mark : MINATEK  
Filed : September 28, 2004  
Published in the Trademark  
Official Gazette on : September 13, 2005

**Mintek Corporation**

Opposer,

v.

**Samuel Bouter,  
D.B.A. Minatek Solutions**

Applicant.

Opposition No. 91167540

**MOTION FOR DEFAULT JUDGMENT**

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3514

Sir:

Mintek Corporation (hereinafter "Opposer") hereby moves for the entry of default judgment against Samuel Bouter, D.B.A. Minatek Solutions (hereinafter "Applicant") for Applicant's failure to timely answer Opposer's Notice of Opposition, filed on November 11, 2005. The Trademark Trial and Appeal Board ("TTAB") mailed its notice of the institution of Opposition No. 91167540 on November 14, 2005, setting a deadline for Applicant's answer no later than 40 days from November 11, 2005. The date to timely file an answer was December 24, 2005, not only a Saturday but Christmas Eve, and it is believed that the following Monday, December 26, 2005 was a federal holiday. Accordingly, Applicant was required to file an answer by Tuesday, December 27, 2005, to comply with the Board's order.

On December 13, 2005, Applicant submitted its Motion For an Extension of Time to file its answer. Applicant's motion was not served upon Opposer, nor was it otherwise transmitted to Opposer in any respect. In fact, Opposer only became aware of Applicant's Motion for an Extension of Time while preparing this motion for default judgment. The deficiencies of Applicant's motion are both numerous and apparent.

Shortly after filing its Motion for Extension of Time, Applicant contacted counsel for Opposer to request a consent agreement. On December 20, 2005, counsel for Opposer left a voicemail message for Sam Bouter, acting *pro se* and as representative of Minatek Solutions, indicating that after careful consideration Opposer cannot agree to a consent agreement as the marks and goods are nearly identical. Opposer's counsel also indicated in that voicemail that Opposer would, in good faith, consider consenting to an extension of time for Applicant's answer to accommodate the four (4) days between Applicant's request and Opposer's response.

On December 21, 2005, counsel for Opposer received a phone call from Applicant. Opposer's counsel reiterated the offer to extend the time to answer. In that conversation it became apparent that Applicant planned on proceeding without representation and operating under a misunderstanding of the necessary TTAB procedures. Specifically, Applicant refused the offer for consent to an extension of time and informed Opposer's counsel that Applicant would email the answer before the deadline. At this point Opposer's counsel strongly urged Applicant that TTAB proceedings closely paralleled litigation and that all submissions made must meet requirements set forth in the TTAB rules and Rules of Civil Procedure. Opposer's counsel felt an ethical duty to Applicant and the Board to sincerely urge Applicant to acquire representation experienced in TTAB proceedings. Applicant assured Opposer's counsel that he had contacted TTAB, was aware of the necessary rules, and that email would be sufficient.

Opposer received an email from Applicant, attached hereto as EXHIBIT A, on December 23, 2005 at 7:37 EST. The email had Applicant's Answer, attached hereto as EXHIBIT B, and a "digital signature" attached thereto. As shown in EXHIBIT B, Applicant's Answer consists of nothing more than the allegations raised in the Notice of Opposition and a one-word AGREE or DENY corresponding thereto. Applicant's denials failed to meet the substance of the allegations denied, including Applicant's denial that Opposer is the owner of U.S. Trademark Application Serial No. 78/507,466 for MINTEK. The "digital signature" referenced in Applicant's email does not comply with the electronic signature requirement set forth in TBMP§ 106.02, TBMP

§311.01(b), and 37 C.F.R. §2.193(c)(1)(iii).

In addition to any identifying information, Applicant's Answer was not properly served upon the Board or Opposer. An answer must bear the required proof of service before the paper will be considered by the Board per TBMP §311.01(c). As can be plainly seen by the Board's records and the exhibits attached hereto, Applicant's Answer did not contain a certificate of service as required by TBMP §113, TBMP §311.01(c), and 37 C.F.R. §2.119. Moreover, Applicant's email of December 23, 2005 does not comply with 37 C.F.R. §2.119(b). Accordingly, Applicant's Answer cannot be deemed "timely filed."

Trademark Rule of Practice 2.106 provides that "[i]f no answer is filed within the time set, the opposition may be decided as in the case of default." 37 C.F.R. §2.106. While the TTAB will normally issue a notice of default, allowing the respondent twenty (20) days from the mailing date of the notice in which to show good cause why default judgment should not be entered against him, the TBMP also provides that "plaintiff, realizing the defendant is in default, may file a motion for default judgment (in which case the motion may serve as a substitute for the Board's issuance of a notice of default)." TBMP §317.01 (parenthetical in original).

Applicant's decision to proceed without the benefit of counsel cannot provide good cause for the numerous procedural and substantive failings of its Motion for Extension of Time and Answer. While the entry of default judgment against applicant may seem a harsh remedy, a party to TTAB proceedings who chooses not to acquire counsel cannot rely on that decision as an excuse for failing to comply with the TTAB rules. The Trademark Rules of Practice are reasonably straightforward, and Applicant's failure to familiarize himself with the pertinent rules and/or his failure to follow them are no excuse, and are at his own peril.<sup>1</sup> This point is particularly relevant where counsel for Opposer made several sincere attempts in good faith to urge Applicant to seek counsel and even provided direction as to where the relevant rules are located.

Entry of a notice of default is proper in these circumstances given that the delay was a result of Applicant's willful decision to act without the assistance of counsel and exercised gross

---

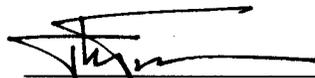
<sup>1</sup> Hewlett-Packard Co. v. Olympus Corp., 931 F.2d 551, 18 USPQ2d 17170 (Fed. Cir 1991); Plantronics Inc. v. Starcom Inc., 213 USPO 699 (TTAB 1982); Acme Boot Co., Inc. v. Tony and Susan Alamo Foundation, Inc., 213 USPO 591 (TTAB 1980); and W.R. Grace & Co. v. Red Owl Stores, Inc., 181 USPO 118 (TTAB 1973).

neglect in learning the necessary procedures. Opposer will be substantially prejudiced not only by the continued suspension of its application but the inexcusably drawn-out process arising from Applicant's unwillingness to comply with the rules. Applicant's actions require responses which incur additional expenses to Opposer resulting from legal expenses and delay. Opposer should not be penalized by electing to be represented by counsel. Finally, Applicant has not raised any indication of a meritorious defense or counterclaims.

The Trademark Rules of Practice, promulgated to allow the Board to ensure the orderly litigation of cases before it, have not been followed. Petitioner respectfully requests that the present Motion for Default Judgment, having been served on Applicant on the date indicated in the attached Certificate of Service, serve as a substitute for the Board's issuance of a Notice of Default, and begin the running of Applicant's twenty (20) day time period in which to demonstrate good cause why default judgment should not be entered.<sup>2</sup>

Very respectfully,  
SMITH & HOPEN, P.A.

Date: December 28, 2005



---

Thomas E. Toner  
SMITH & HOPEN, P.A.  
Suite 220  
15950 Bay Vista Drive  
Clearwater, FL 33760  
(727) 507-8558  
Attorneys for Applicant

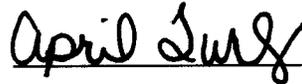
---

<sup>2</sup> See Fed. R. Civ. P. 55(c), see also Paolo's Assocs. Ltd. P'ship v. Paolo Bodo, 21 U.S.P.Q.2d 1899 (Comm'r 1990)

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the foregoing OPPOSER'S MOTION FOR DEFAULT JUDGMENT, and duly signed by attorneys for Opposer, has been served upon Applicant this **January 9, 2006** via email to sbouter@minateksolutions.com followed by mailing a copy by U.S. Express Mail Postage Label No. **EV 770341819 US** to the following: 9049 Commercial St., Suit 260, New Minas, NS B4N 5A4, CAX-Canada.

January 9, 2006



April Turley

**EXHIBIT**

**A**

**Thomas Toner**

---

**From:** Samuel Bouter [sbouter@minateksolutions.com]  
**Sent:** Friday, December 23, 2005 7:37 PM  
**To:** Thomas Toner  
**Subject:** Answer to Opposition  
**Signed By:** sbouter@minateksolutions.com

Attached are my answers to the opposition you filed. It was recently filed. The USPTO allows and encourages electronic communication. You will find this in many of their trademark rules and laws and by contacting other attorneys and the USPTO itself.

This not only speeds up a process, but is also a legal form specifically when included with digital signatures (such as this e-mail)—check out laws specifically relating to e-mail communications passed during William Clinton's time in office.

Regards,

Samuel Bouter  
Minatek® Solutions  
<http://www.minateksolutions.com>

**EXHIBIT**

**B**

**ANSWER TO GROUNDS FOR OPPOSITION**

Answer to opposition shall proceed opposition. Further responses and explanations may follow.

DENY

(1) Opposer is the owner of U.S. Trademark Serial No. 78/507,466 for MINTEK, for use in conjunction computer software development for integrating mobile devices. billings systems and other databases in the cable and hospitality industries.

AGREE

(2) Applicant is owner of U.S. Trademark Serial No. 78/490,643 for MINATEK for use in conjunction 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 pcnnt-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 in e-mail or phone a client letting them know a product or service they subscribe to is ready or available.

AGREE

(3) Opposer became aware of Applicant's use of the mark MINATEK upon receiving a Notice of Suspension for Opposer's mark pending the disposition of Applicant's mark.

DENY

(4) Both Opposer and Applicant's use the marks in association with similar computer software. The marks and goods are substantially identical. Therefore, confusion is likely.

DENY

(5) Opposer will further be harmed should a well-informed trademark attorney refuse registration of U.S. Trademark Application Serial No. 78/507,466 for Opposer's mark based

on the earlier filed U.S. Trademark Application Serial No. 78/490,643.

DENY

(6) Opposer has been using the mark in commerce as early as November 30, 1985 and will be banned by the registration of Applicant's mark as it is nearly identical to Opposer's mark.

DENY

(7) Opposer is the senior user of the mark in association with computer software.