

ESTTA Tracking number: **ESTTA376509**

Filing date: **11/02/2010**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	CaseWare International Inc.		
Entity	Corporation	Citizenship	Canada
Address	469 King Street West 2nd Floor Toronto, ON M5V 1K4 CANADA		

Attorney information	S. Wynton Semple Zammit Semple LLP 130 Bloor Street West Suite 601 Toronto, ON M5S 1N5 CANADA wsemple@zds.on.ca Phone:(416) 923-2601		
----------------------	---	--	--

Applicant Information

Application No	85028392	Publication date	10/05/2010
Opposition Filing Date	11/02/2010	Opposition Period Ends	11/04/2010
Applicant	Idea Express, Inc. Suite 400 2711 Centerville Road Wilmington, DE 19808 UNITED STATES		

Goods/Services Affected by Opposition

Class 009. First Use: 1999/11/00 First Use In Commerce: 2006/01/00 Opposed goods and services in the class: Computer software, namely, software for use in business transactions and order processing, accounting, invoice printing, customer relationship management, inventory management and supplier interactions
--

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Other	The Opponent submits that registration of the Applicant's Mark would be in contravention of Section 1052 (d) of the Trademark Act of 1946 as amended. The Applicant's Mark is almost identical to the Opponent's Mark, and is furthermore to be registered for goods sold and to be sold under the Opponent's Mark, which is likely to cause confusion, mistake or deception.

Mark Cited by Opposer as Basis for Opposition

U.S. Registration	2423582	Application Date	05/26/1994
-------------------	---------	------------------	------------

No.			
Registration Date	01/23/2001	Foreign Priority Date	NONE
Word Mark	IDEA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1987/09/00 First Use In Commerce: 1987/09/00 computer software for auditing and statistical sampling and user manuals therefor		

Attachments	74530121#TMSN.gif (1 page)(bytes) 10oct26r.dr1.pdf (4 pages)(797217 bytes)
-------------	--

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/s. wynton semple/
Name	S. Wynton Semple
Date	11/02/2010

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

In the matter of trademark application Serial No.: **85-028,392**

For the mark: **IDEA EXPRESS** in International Class 9

Published in the Official Gazette on: October 5, 2010

Opponent: **CaseWare International Inc.**

v.

Applicant: **Idea Express, Inc.**

NOTICE OF OPPOSITION

CASEWARE INTERNATIONAL INC.

469 King Street West
2nd Floor
Toronto, ON
M5V 1K4
Canada

Jurisdiction of Incorporation: Ontario, Canada

The above-identified Opponent believes that it will be damaged by registration of the mark shown in the application noted above (referred to herein after as the "Applicant's Mark") and hereby opposes same.

The grounds for opposition are as follows:

1. The Opponent is the current registered owner of the trademark IDEA, which was registered on the principal register of the United States Patent and Trademark Office as No. 2,423,582 on January 23, 2001 by The Canadian Institute of Chartered Accountants as Registrant pursuant to an application accorded a filing date of May 26, 1994. The trademark was first advertised under application serial number 74-530,121 in the Official Gazette on June 13, 2000. The registration covers the following wares in International Class 9 (US Classes 21, 23, 26, 36 and 38):

Computer software for auditing and statistical sampling and
user manuals therefor.

The entire interest and goodwill in IDEA (No. 2,423,582) was assigned by The Canadian

Institute of Chartered Accountants as Assignor to the Opponent as Assignee, by way of an Assignment recorded in the United States Patent and Trademark Office on February 6, 2001.

The Opponent's trademark IDEA is hereinafter referred to as the "Opponent's Mark".

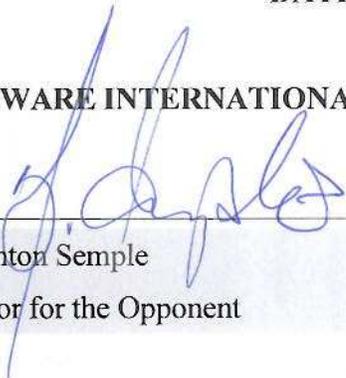
2. The Opponent and its predecessor in title have used the Opponent's Mark as a trademark directly and through their licensees in commerce in the United States since as early as September, 1987. Furthermore, the Opponent's Mark has been registered and used by the Opponent and its predecessor in title directly and through their licensees in various other jurisdictions, including Canada, (in use since as early as January 1, 1987), Australia (in use since as early as May 26, 1994), the United Kingdom (in use since as early as November 26, 1993), the Benelux (in use since as early as March 30, 1994) and the European Community. It is considered that the Opponent has established significant reputation and goodwill in the Opponent's Mark since the date of first use in the United States and that by virtue of its reputation and goodwill established on a world wide basis, the Opponent's Mark is a well known trademark. The Applicant has shown no evidence of use of the Applicant's Mark prior to November 1999, being the date of first use claimed in the Application.
3. Since prior to the filing date of the opposed Application **85-028,392** and prior to any date of first use upon which the Applicant can rely, the Opponent and its predecessor in title adopted and continuously used the Opponent's Mark in connection with computer software covered by its registration number 2,423,582 for auditing and statistical sampling in the fields of business transactions, order processing, accounting, invoicing and inventory management.
4. The Opponent's goods associated with the Opponent's Mark are marketed and sold and intended to be marketed and sold to a wide variety of customers and the goods associated with the Applicant's Mark are sold or intended to be sold to the same types of customers.
5. The Opponent submits that registration of the Applicant's Mark would be in contravention of Section 1052 (d) of the Trademark Act of 1946 as amended. The Applicant's Mark is almost identical to the Opponent's Mark, and is furthermore to be registered for goods sold and to be sold under the Opponent's Mark, which is likely to cause confusion, mistake or deception.
6. The Opponent's goods listed in paragraph 1 above are clearly computer software of relevance to software for use in business transactions and order processing, accounting, invoice printing and inventory management. The Applicant's Mark covers computer software, namely, software for use in business transactions and order processing, accounting, invoice printing, customer relationship management, inventory management and supplier interactions. The Opponent's Mark has already been established in the software industry for the market sector to which the goods associated with the Applicant's Mark are directed. The Opponent has established a reputation in the Opponent's Mark in the United States and it is asserted that there is a likelihood of confusion, mistake or deception between the Applicant's Mark, when used on or in connection with the goods of the Applicant and the Opponent's Mark, as a result of which the Opponent would suffer damage.

7. It is further submitted that, by virtue of the goodwill and reputation which have been established generally in the software industry by the Opponent in the Opponent's Mark, the use of the Applicant's Mark by the Applicant in those same industry areas would take unfair advantage of or would be detrimental to the distinctive character and/or repute of the Opponent's Mark.
8. It is therefore respectfully requested that the registration of the Applicant's Mark be refused.

DATED this 2nd day of November, 2010

CASEWARE INTERNATIONAL INC.

By:


_____ c/s
S. Wynton Semple

Solicitor for the Opponent

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing OPPOSER'S NOTICE OF OPPOSITION, was served by registered mail on November 2, 2010, upon Applicant's Attorney, pursuant to Rule § 2.119(b)(5) of 37 C.F.R. Part 2 - Rules Of Practice In Trademark Cases, at this address:

MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C.
3580 Carmel Mountain Road, Suite 300
SAN DIEGO, CA 92130-6768

Attention: Andrew D. Skale



S. Wynton Semple