

ESTTA Tracking number: **ESTTA514294**

Filing date: **01/04/2013**

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.
Granted to Date of previous extension	01/06/2013
Address	469 King Street West, 2nd Floor Toronto, Ontario, M5V 1K4 CANADA

Correspondence information	A. Yates Dowell, III Dowell & Dowell, P.C. 103 Oronoco St. Suite 220 Alexandria, VA 22314 UNITED STATES yates@dowellpc.com, dowell@dowellpc.com, wseuple@zds.on.ca Phone:703 739 9888
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**Applicant Information**

Application No	85189570	Publication date	07/10/2012
Opposition Filing Date	01/04/2013	Opposition Period Ends	01/06/2013
Applicant	OPENIDEA, TECNOLOGIAS DE TELECOMUNICAÇÕES E SISTEMAS DE INFORMAÇÃO S.A. Rua Engenheiro José Ferreira Pinto Basto 3810-106 Aveiro, PORTUGAL		

**Goods/Services Affected by Opposition**

Class 042. Opposed goods and services in the class: Computer software development; computer software technological consultancy;
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**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)
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**Marks Cited by Opposer as Basis for Opposition**

U.S. Registration No.	2423582	Application Date	05/26/1994
Registration Date	01/23/2001	Foreign Priority Date	NONE
Word Mark	IDEA		

Design Mark	<b>IDEA</b>
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

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	IDEA		
Goods/Services	data analysis computer software; training and help services in connection with the data analysis computer software		

Attachments	74530121#TMSN.gif ( 1 page )( bytes ) 13.01.04 IDEA opp.pdf ( 9 pages )(12947143 bytes )
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### 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	/AYD/
Name	A. Yates Dowell, III
Date	01/04/2013

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

In re Application 85/189,570  
Filed: Dec. 2, 2010  
Mark: OPEN IDEA and design  
Applicant: Openidea, Tecnologias de  
Telecomunicacoes e Sistemas de  
Informacao S.A..  
Class: 9,35,38,41,42  
Published: July 10, 2012

CaseWare International Inc.  
Opposer

vs

Openidea, Tecnologias de  
Telecomunicacoes e Sistemas de  
Informacao S.A.  
Applicant

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) Opposition No. \_\_\_\_\_  
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**NOTICE OF OPPOSITION**

CaseWare International, Inc., a corporation of Ontario, Canada with a business address at 469 King Street West, 2<sup>nd</sup> Floor, Toronto, Ontario, Canada M5V 1K4 (hereinafter "Opposer"), believes it will be damaged by registration of the mark OPEN IDEA and design of Application No. 85/189,570 and hereby opposes registration.

The grounds for opposition are as follows:

1. Opposer is the owner of Registration No. 2,423,582, issued on January 23, 2001, for the trademark IDEA for products identified as "computer software for auditing and statistical sampling and user manuals therefor", with a claim of first use in commerce of September 1987. Opposer owns the registration as a result of an assignment recorded at the U.S. Patent and Trademark Office on February 6, 2001 at reel 2237 beginning at frame 0133. In accordance

with 37 CFR §2.122(d)(1), attached are a copy of the registration showing status and title, printed from the U.S. Patent and Trademark Office's TESS database, and a copy of the assignment information for the registration, printed from the U.S. Patent and Trademark Office's USPTO Assignment database.

2. Opposer's Registration No. 2,423,582 is valid and subsisting on the Principal Register and is conclusive evidence of the validity of the registered mark IDEA, of the registration of the mark, and of Opposer's ownership and exclusive right to use the mark in commerce in connection with the goods specified in the registration as provided by Sections 15 and 33(b) of the Federal Trademark Act as amended. In addition, the registration provides constructive notice of Opposer's ownership of its IDEA mark in accordance with Section 22 of the Federal Trademark Act as amended.

3. Since long prior to the filing date of application 85/189,570 and any date of first use of OPEN IDEA by Applicant, Opposer and its related companies and distributors have used the trademark IDEA alone and next to a circular design, in commerce in connection with data analysis computer software, including computer software for auditing and statistical sampling provided to many different types of customers, including corporations in a wide range of industry sectors, governments, universities, accounting firms and others, and Opposer and its related companies and distributors still are using the trademark IDEA alone and next to a circular design, in commerce in connection with such data analysis software provided to such customers.

4. As a result of extensive advertising, promotion, training services, help services, and sales over many years involving Opposer's IDEA mark alone and next to a circular design and also involving the computer software sold in connection with the mark, the mark has become a

valuable asset with significant reputation and goodwill and wide recognition as an indication of a single source.

5. In the application being opposed, Applicant seeks registration of the service mark OPEN IDEA and a circular design for “computer software development” and for “computer software technological consultancy” in class 42. The application was filed by Applicant on December 2, 2010 based on a bona fide intention to use and to date neither an allegation of use nor a statement of use has been submitted.

6. Upon information and belief, Applicant has not used its mark for computer software development or for computer software technological consultancy services. The earliest date upon which Applicant may rely to support its claim of rights in the mark is the filing date of its application, December 2, 2010.

7. Upon information and belief, neither Applicant nor any predecessor or entity related to Applicant has any constructive or actual right in the mark OPEN IDEA and circular design prior to December 2, 2010, the filing date of the opposed application.

8. There is no stated limitation on the “computer software development” services in the opposed application and such services could include development of computer software for data analysis, auditing and statistical sampling.

9. There is no stated limitation on the “computer software technological consultancy” services in the opposed application and such services could include technological consultancy involving computer software for data analysis, auditing and statistical sampling.

10. Applicant’s computer software development and computer software technological consultancy services identified in the opposed application are at least closely related to Opposer’s goods and services associated with Opposer’s IDEA mark.

11. The word IDEA is a major feature of Applicant's mark so that Applicant's mark immediately suggests that Applicant's services of computer software development and computer software technological consultancy arise from, are related to, or have the same source as Opposer's IDEA software and services.

12. When Applicant's mark is spoken, it may be spoken as two words, OPEN IDEA, without any mention of the circular design feature of Applicant's mark.

13. Opposer's IDEA mark alone and next to a circular design on the one hand and Applicant's OPEN IDEA and circular design mark on the other are substantially similar in sound, appearance, and overall commercial impression.

14. Applicant's computer software development and computer software technological consultancy services for use in connection with Applicant's OPEN IDEA and circular design mark likely will be advertised, promoted, provided and rendered to persons or businesses or others also using, considering the use of, or which may consider the use of Opposer's software and services associated with its IDEA mark. Such persons, businesses or others would be likely to believe mistakenly that Applicant's services and Opposer's software and services come from the same source or are sponsored or approved by the same entity, thus damaging Opposer and its rights in its IDEA mark.

15. Applicant's OPEN IDEA and circular design mark should be refused registration for computer software development and computer software technological consultancy services in class 42 because the mark so closely resembles Opposer's IDEA mark as to be likely when applied to Applicant's services to cause confusion, to cause mistake or to deceive within the meaning of §2(d) of the Federal Trademark Act as amended, thus damaging Opposer.

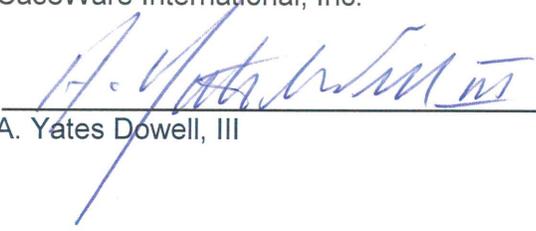
16. The OPEN IDEA and circular design mark is confusingly similar to Opposer's IDEA mark and registration of OPEN IDEA and circular design would be inconsistent with and damaging to Opposer's prior and exclusive rights in its IDEA mark for Opposer's goods and services.

WHEREFORE, Opposer requests that the opposition be sustained and that registration of Applicant's mark be denied for the indicated services of computer software development and computer software technological consultancy in class 42.

The required filing fee for this Notice of Opposition is submitted herewith.

CaseWare International, Inc.

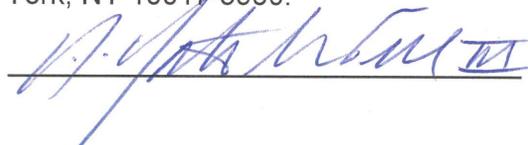
Dated: Jan. 4, 2013

By: 

A. Yates Dowell, III

Certificate of Service

The undersigned attorney for Opposer hereby certifies that a true and correct copy of the foregoing Notice of Opposition was served on January 4, 2013 by first class mail sent to the following correspondence address of record for Applicant: Andrew N Fredbeck, Fross Zelnick Lehrman & Zissu PC, 866 United Nations Plz, New York, NY 10017-5900.



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**Typed Drawing**

**Word Mark** IDEA  
**Goods and Services** IC 009. US 021 023 026 036 038. G & S: computer software for auditing and statistical sampling and user manuals therefor. FIRST USE: 19870900. FIRST USE IN COMMERCE: 19870900  
**Mark Drawing Code** (1) TYPED DRAWING  
**Serial Number** 74530121  
**Filing Date** May 26, 1994  
**Current Basis** 1A;44E  
**Original Filing Basis** 1B;44D  
**Published for Opposition** June 13, 2000  
**Registration Number** 2423582  
**Registration Date** January 23, 2001  
**Owner** (REGISTRANT) Canadian Institute of Chartered Accountants, The CORPORATION CANADA 277 Wellington Street West Toronto, Ontario CANADA M5V 3H2

(LAST LISTED OWNER) CASEWARE INTERNATIONAL INC. CORPORATION CANADA 469 King Street West, 2nd Floor Toronto, Ontario M5V 1K4 CANADA

**Assignment Recorded** ASSIGNMENT RECORDED  
**Attorney of Record** A. Yates Dowell III  
**Priority Date** November 26, 1993  
**Type of Mark** TRADEMARK  
**Register** PRINCIPAL  
**Affidavit Text** SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20110716.  
**Renewal** 1ST RENEWAL 20110716  
**Live/Dead Indicator** LIVE

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## Assignments on the Web &gt; Trademark Query

## Trademark Assignment Abstract of Title

**Total Assignments: 1****Serial #:** [74530121](#)**Filing Dt:** 05/26/1994**Reg #:** [2423582](#)**Reg. Dt:** 01/23/2001**Registrant:** Canadian Institute of Chartered Accountants**Mark:** IDEA**Assignment: 1****Reel/Frame:** [2237/0133](#)**Received:** 02/16/2001**Recorded:** 02/06/2001**Pages:** 5**Conveyance:** ASSIGNS THE ENTIRE INTEREST**Assignor:** [CANADIAN INSTITUTE OF CHARTERED ACCOUNTANTS, THE](#)**Exec Dt:** 09/19/2000**Entity Type:** ASSOCIATION**Citizenship:** NONE**Entity Type:** CORPORATION**Citizenship:** ONTARIO**Assignee:** [CASEWARE INTERNATIONAL INC.](#)145 KING STREET EAST  
TORONTO, ONTARIO, CANADA M5C 2Y8**Correspondent:** COWAN, LIEBOWITZ & LATMAN, P.C.WILLIAM M. BORCHARD, ESQ.  
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NEW YORK, NY 10036-6799

Search Results as of: 01/04/2013 10:25 AM

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