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Filing date: **04/05/2013**

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

Proceeding	91203399
Party	Plaintiff iCourier Software Systems Ltd.
Correspondence Address	ALEX MATEESCO ICOURIER SOFTWARE SYSTEMS LTD 155 288 EAST GEORGIA STREET VANCOUVER, BC V6A4H8 CANADA info@techandgo.com
Submission	Motion for Summary Judgment
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Date	04/05/2013
Attachments	TechandGoMotionforSummaryJudgment.pdf (17 pages)(677981 bytes)

APRIL 04 2013

ICOURIER SOFTWARE SYSTEMS LTD.)
)
Opposer)
)
v.)
) Opposition No. <u>91203399</u>
E-filliate, Inc.)
)
Applicant)
_____)

OPPOSERS MOTION FOR SUMMARY JUDGMENT

ICOURIER SOFTWARE SYSTEMS brings the present Motion for Summary Judgment regarding the opposition filed by Opposer, ICOURIER SOFTWARE SYSTEMS LTD.

INTRODUCTION AND CONTEXT

Opposer is the owner and user of the common law trademark TECH AND GO which it began to use at least as early as the year 2009.

Opposer is also the owner of the TECH AND GO trademark, including, inter alia, Canadian application APPLICATION NUMBER: 1510862 filed on January 12th, 2011 for similar goods and services.

Opposer, ICOURIER SOFTWARE SYSTEMS LTD. filed its trademark application 85402345 on August 19, 2011 with a first use date preceding that of the Applicant.

A True and Correct copy of Applicant's trademark application as shown in the Trademark Electronic Search System (TESS) is attached hereto as **EXHIBIT A**.

Applicant filed an application, on March 31, 2011, to register the mark TECH & GO for " USB cables, USB hubs, electronic card readers, electric patch cables, computer mice, mouse pads, keyboards; battery chargers, namely, wall chargers, car chargers, and USB chargers; AC/DC converters, USB adapters, earbuds, headphones, audio speakers; blank CDs and DVDs; CD and DVD cases; flash media, namely, flash memory cards; power cables; audio and video cables and adapters, batteries and battery chargers; MP3 players

and smart phone accessories, namely, headphones, signal splitters, speakers, electronic cables for syncing and charging MP3 players and smart phones, battery chargers, electronic docking stations, adapters, USB converters, and audio and video cables; cases, bags, stands, holsters, belt clips, straps, screen protectors, stylus, specially adapted for holding MP3 players and smart phones; camera accessories, namely, tripods, battery chargers, electronic cables for syncing and charging cameras, USB adapters, straps specially adapted for cameras, and adapters; cases and bags specially adapted for holding cameras."in International Class 009 . This application was assigned serial no. 85282926 and was published for opposition in the official gazette of July 19, 2011. A True and Correct copy of Applicant's trademark application as shown in the Trademark Electronic Search System (TESS) is attached hereto as **EXHIBIT B**.

Opposer owns and operates the website (www.techandgo.com) where it promotes various goods and services, and also provides information on its TECH AND GO services and products as shown in **EXHIBIT C**.

The evidence provided with this motion aims to establish that Opposer owns the common law trademark rights in TECH AND GO and had priority before Applicant applied to register the mark TECH&GO. As a result, no genuine issue of material fact exists on Opposer's priority of rights to the trademark.

Moreover, there is a strong likelihood of confusion between the marks. Applicant's mark is for all intents and purposes identical to the Opposer's mark. The likelihood of confusion is so clear that there is no genuine issue of material fact.

Applicant's use of the mark TECH & GO is likely "to cause mistake, confusion and to deceive within the meaning of 15 U.S.C. §1052(d).

Furthermore opposer believes that Applicant acted in bad faith when it chose to adopt Opposer's mark and now attempts to capitalize on the mistake Opposer made in missing its foreign priority deadline leading to Opposer's mark being held back and Opposer having to undergo these proceedings.

Under Rule 56 c and 56 a of the Federal Rules of Civil Procedure, a party is allowed to move for summary judgment in its favour if it can show the absence of any genuine issues of material fact, and that judgment in its favour is available to it as a matter of law. See Fed. R. Civ. P. 56(a), (c); Celotex Corp. v. Catrett, 477 U.S. 317 (1986); Copelands' Enters., Inc. v. CNV, Inc., 20 USPQ2d 1295 (Fed. Cir. 1991); and See Copelands' Enters., 20 USPQ2d at 1298.

Opposer respectfully requests the Board render judgment in favour on the basis of its claims, because it has priority over the Applicant by virtue of its first use as shown in Exhibit C, Opposer's date of first use for the Mark TECH AND GO predates the filing

date of the Application for TECH & GO mark filed by applicant. As a result, registration of the Opposed Mark would be inconsistent with Opposer's senior rights at common law.

Opposer respectfully submits this motion for summary judgment be granted in its favour in order to save the board, the Applicant, and Opposer time and resources .

RATIONALE

Priority and Seniority

Opposer's rights are senior, and superior to those of Applicant because Opposer began use of the mark on its website at least as early as DECEMBER 28 2009 which is long before the March 31 2011 filing date of applicant.

Opposer thus believes it has seniority and priority over Applicant. A screen capture of the mark is provided for reference, as it is displayed on Opposer's website predating Applicant's date of application. It is attached as Exhibit C where we see Opposer's mark as it appeared on or around February 2011, predating applicant's filing date.

It is perfectly clear from this evidence provided in **Exhibit C** that Opposer has priority of rights. Opposer has also continuously promoted its mark , services, and products through its website at www.techandgo.com since the year 2009.

Because opposer have the right to priority over intent to use applications by providing evidence of use we can clearly ascertain that the Opposer has the right to priority based on the dates and evidence provided. *See McCarthy on Trademarks and Unfair Competition*, §§ 20:17 (4th ed. 2006). Under the Lanham Act, under section 45, a mark is defined as being used once placed on goods, sold or transported. *See 15 U.S.C. §1127 (2006)*. Moreover, priority can be established by use under conditions such as advertising, use on website, business contacts, and other activities. *See McCarthy at § 20:16; Shalom Children's Wear, Inc. v. In-Wear A/S*, 26 USPQ2d 1516, 1519 (TTAB 1993); *KMC Semiconductor Corp. v. Kelvin Mfg. Co.*, 153 USPQ 683 (TTAB 1967).

In this case, based on the evidence provided, it is very simple to see that by having the TECH AND GO mark displayed clearly on its website, in conjunction with its wares and services, prior to Applicant's filing date, Opposer provides the evidence necessary for trademark use before Applicants filing date. *See ; Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1736 (TTAB 2001)

Because the Opposer's mark was used before Applicant' filing date through its website , this use is sufficient on its own to provide Opposer the right to use the mark and priority over Applicant and there is no issue of material fact with respect to priority.

Marks are Virtually identical.

Applicant's application must be denied because registration of the TECH & GO Mark will result in damage to Opposer under the provisions of section 2(d) of the Lanham Act. This opposition and motion should be sustained section 2(d) of the Lanham Act because Applicant is attempting to register a mark which is practically identical to Opposer's senior TECH AND GO Mark, which would lead to confusion once applied to its services. Here again, there is no genuine issue with respect to the similarity of the marks as based on the obviousness of the similarity in appearance, sound, connotation and commercial impression. It is obvious and genuinely clear that Opposer's Mark and Applicant's Mark are confusingly similar. As such it is clear that there is no genuine issue of material fact at least with respect to the similarity of the marks . *See Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992)

Opposer also moves the board in favour on the basis of its' claims, because there is no issue of material fact regarding similarity in commercial impression . In this case Applicant's mark is clearly likely to cause confusion because both marks are used in connection with the same kind of goods. Buyers seeing the two marks will likely come to the conclusion that the goods or services provided under the respective marks originate from the same source. For this reason the board should grant summary

judgment in favour of Opposer based on Section 2d of the trademark act. See *In re Acosta v. Narmar*; See *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); See also *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); See *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); See also TMEP §1207.01(b).

Applicant's mark being clearly confusingly similar to Opposer's "TECH AND GO" mark as they are virtually identical means that the request for judgment be granted in favour of Opposer. Also See *DuPont*, 177 USPQ at 567.

Goods and Services are Similar.

In this case Opposer's goods as listed in its Application will be encountered by customers in situations that would lead them to mistakenly believe the source of the goods and services is the same. Should someone encounter the Applicant's TECH & GO brand in any situation in the market, whether online or not, they may be confused that the goods or services originate with the Opposer due to their similarity.

With respect to the similarity of goods and services, it is not necessary for the parties wares to be exactly identical for likelihood of confusion to take place. See *Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A.

1975); See TMEP §1207.01(a)(i); The only need to be encountered by similar customers in situations that would lead customers to mistakenly believe the source of the goods and services is the same See *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999); TMEP §1207.01(a)(i); See, e.g., *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086-87, 56 USPQ2d 1471, 1475-76 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 22 USPQ 1289, 1290 (Fed. Cir. 1984).

Clients are ordinary consumers and as such not very sophisticated.

In the current case confusion likely because customers shopping for services and products respectively offered by Opposer and Applicant are not very sophisticated and as such the two marks will likely be confused with one another when a customer shopping for computer goods or services encounters the Applicant's brands, leading to confusion with the brand of Opposer. See *Centraz Industries, Inc. v. Spartan Chemical Co., Inc.*, 77 USPQ2d 1698 (TTAB 2006).

Trade Channel similarity leads to likelihood of confusion

In this case, because the marks of Opposer and Applicant don't currently have limitations on trade channels then it can be ascertained that there is a strong likelihood of confusion. See *Kangol Ltd. v. KangaROOS U.S.A., Inc.*, 974 F.2d 161, 164 (Fed. Cir. 1992) . Because goods and services are similar, and will be encountered by similar customers, in identical trade channels, the likelihood for confusion is sufficiently strong to warrant judgment in the favour of Opposer. See *Board of Trustees of the Univ. of Alabama v. BAMA-Werke Curt Baumann*, 231 USPQ 408, 411 n.7 (TTAB 1986) ;See *CBS Inc. v. Morrow*, 218 USPQ 198, 199 (Fed. Cir. 1983); See *Hewlett-Packard Co. v. Packard Press Inc.*, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002) ;

Prohibition of the use of false designations and representations in the advertising of goods.

The opposed Mark so closely resembles Opposers previously used mark that its use, in connection with the goods listed in the Application, is likely to cause confusion, or to cause mistake or deceive, in violation Section 43(a) of the Trademark Act of 1946, 15 U.S.C. § 1125(a). This section of the trademark act prohibits false designations of origin and false representations in the advertising of goods . See *Smith v. Montoro*, 648 F2d 602, 603(9th Cir 1981). Purchasers may likely assume that Opposer is affiliated

with, endorses, or licenses, Applicant's use of the Opposed Mark, when Opposer is not connected to the Applicant or the use of the Opposed Mark.

Because of the similarity of the wares and services offered by Opposer and Applicant respectively there is clear likelihood of customer confusion between their marks as both offer the technology products to computer , computer parts, and computer services consumers under what is ostensibly the same brand. See *Ross Bicycles, Inc.v.Cycles USA, Inc*,756 F.2d1502(11th Cir.1985).

There is no doubt that the types of wares sold under the TECH AND GO , and TECH & GO brands are similar as are the marks. They are all computer related, and aimed at computer shoppers. As a result, Applicant's proposed TECH & GO mark resembles Opposer's TECH AND GO mark to such an extent that it is likely, when applied to the proposed goods of Applicant, to cause confusion or mistake or to deceive purchasers resulting in damage to Opposer and Opposer's reputation.

In Conclusion

The opposed mark Mark so closely resembles Opposer's previously used mark that its use, in connection with the goods listed in the Application, is likely to cause confusion, or to cause mistake or deceive, in violation Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d). Purchasers may likely assume that Opposer is affiliated with, endorses, or licenses, Applicant's use of the Opposed Mark, when Opposer is not connected to the Applicant or the use of the Opposed Mark. The Opposed Mark so

closely resembles iCourier Software Systems Ltd.'s previously used common-law mark that its use, in connection with the goods aforementioned, is likely to cause confusion, or to cause mistake or deceive, in violation Section 43(a) of the Trademark Act of 1946, 15 U.S.C. § 1125(a). In Amstar, 615 F.2d at 263 we see that bad faith means efforts a party makes to pass off a product as related to another. Opposer believes that applicant acted in bad faith when it adopted its mark and it believes applicant should have known full well it was not the senior owner of the rights in the mark. Applicant is believed to have acted in bad faith by ignoring the very simple and visible fact that Opposer had a website actively displaying its mark. Applicant and it's lawyers should know that Under U.S. law, an attempt must be made to discover common law rights . See [bit law.com/trademark/common.html](http://bitlaw.com/trademark/common.html)

Thus, in this situation the facts are simple, opposer believes has senior rights to the mark as evidenced by the Exhibit it has provided, and there is no doubt that customer confusion is likely based on the arguments presented herein. Also See *warner Bros. v. American Broadcasting, Cos.*, 720 F.2d 231,246 (2d Cir.1983)

For the aforementioned reasons , Opposer respectfully requests that its Motion be granted , and that summary judgment be entered in its favour.

DATED this 4th day of April , 2013

Respectfully submitted,

/Alex Mateesco/

President for Opposer

iCourier Software Systems Ltd.

155-288 East Georgia Street

Vancouver, BC, V6A4H8 CANADA

Telephone: (800) 969-7119

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Motion for Summary Judgment is being served on E-filliate, Inc., and the Attorney of Record, Mark R Leonard, by e-mailing said copy on April 04 2013 via e-mail to: mleonard@davisandleonard.com

E-filliate, Inc.

11321 White Rock Road

Burbank California

91502

/Alex Mateesco/

Alex Mateesco

President for

Opposer 04/04/2013

EXHIBIT A

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TECH AND GO

Word Mark TECH AND GO
Goods and Services IC 042, US 100 101, G & S: Installation and Technical support services; Consultation services; Technical support services, namely, troubleshooting in the nature of diagnosing computer hardware and consulting services; Rental of computer hardware and computer software; Installation, repair and maintenance of computers and computer peripherals; Installation and repair of business and office machinery; Software Development; Website Design; Computer Recycling; IT Support; Computer Repairs and Upgrades; Data Backup services; Security and Networking; Wireless Setup; Virus and Spyware Removal; Home theaters; Sales of Software Development, Website Design; Computer software installation and maintenance; Leasing, financing and sales of computers, televisions, home theaters, electronics, smartphones, monitors; Providing a website offering tech support, IT support, repair and installation services, computer leasing, financing and sales of computers, televisions, home theaters, electronics, smartphones, monitors; Providing a website offering tech support, IT support, repair and installation services, computer services, virus and spyware removal services, automotive electronics installations, and home electronics installation; Providing a website offering computer recycling services; Providing a website offering and interactive app, featuring an online retail store; Retail store services featuring technology, computers, repair services, electronic and automotive repair and instruction manuals, home electronics, audio peripherals; Design and development of computer hardware; Automotive diagnostic services featuring computer software for use by independent automotive repair personnel. Installation, maintenance, mobile performance of such services on customer premises; Providing environmentally friendly automation solutions, namely, site evaluations, control design analysis, and integrated installation services devices within a designated area; Installation and replacement service for water heaters; Installation, replacement, and repair of heating, ventilating and air conditioning equipment; Installation of electrical energy systems and alternative energy products for residential and commercial use; Installation of theft prevention systems and devices; Electrical repairs, maintenance, and installation of electrical wiring installation and repair; General contractor services provided to the cellular communications industry for installation of cellular communications equipment; Furnace installation and repair; Installation of an systems; Installation, repair, and maintenance of vehicles; Security inspection services for others; Technology supervision and inspection; Inspection services for new and used vehicles for persons buying Inspection services, namely, detection of plumbing and roof leaks, termites, and electrical conditions in the inaccessible areas of an existing structure or home and/or wall(s) and void(s) by means of infra-red, namely, promoting the goods and services of others; Automotive diagnostic services featuring computer software for use by independent automotive repair personnel. Providing an Internet website, so automotive maintenance and repair service, and which allows users to order service from local providers; Providing a website, software, and mobile app featuring a search engine for support, repairs, and mobile app, that gives users the ability to rate their IT consultants, computer technicians, mechanics, electricians, and other service providers; Providing a members-only website featuring technology websites and industry services for the purpose of conducting purchase and sale transactions; Providing an interactive web site and software that enables users to enter, access, track, manage, monitor in-house tech support, computer maintenance, building maintenance and repair programs; Providing an online website for creating and hosting micro websites for businesses; Automotive maintenance computer software for use by independent automotive repair personnel; On-line system management services that allow users to remotely view, monitor, program, operate and control large and small air homes, offices and vehicles; Hosting an online community website featuring shared communications between community members interested in personal and small business computer information, secure interactive web site that allows users to upload, store and maintain automotive repair records, manage online records of services performed on their vehicles, and receive automated service reminders; Computer services, namely, hosting an interactive web site that allows users to upload, store and maintain home and building maintenance records, manage online records of services performed, and alerts, and special discount offers; Accreditation services, namely, developing and administering standards and procedures for certifying professionals in the field of computer support, IT support, computer electrical, and home services; Application service provider (ASP), namely, hosting computer software applications of others; Computer services, namely, hosting an interactive web site that allows consumers to rate others; Computer services, namely, remote management of the information technology (IT) systems of others; Computer virus protection services; Computer antivirus software; Computer software providing invoices; Computer software providing order summaries, employee performance, client invoices; Creating an on-line community for tech support staff, IT consultants, mechanics, maintenance and repair customers, businesses, and the general public; Computer services, namely, creating an on-line community for users to participate in discussions, get feedback from their peers, form virtual communities, IT, computing, software, technology, repair, maintenance, and home services; Development of new technology for others in the field of retail store services; Engineering services for building and proper the field of maintenance, repair and installation of solar installations and photovoltaic installations; Remote monitoring services of security, heating, ventilating and air conditioning apparatus; Remote monitoring equipment; PROVIDING ON-LINE DIRECTORY INFORMATION SERVICES ALSO FEATURING HYPERLINKS TO OTHER WEB SITES; ON-LINE TRADING SERVICES IN WHICH SELLER POSTS PRO BIDDING IS DONE VIA THE INTERNET; PROVIDING AN ON-LINE SHOWROOM FOR THE GOODS AND SERVICES OF OTHERS; PROMOTING THE GOODS AND SERVICES OF OTHERS BY PRESENTING A WEBSITE ACCESSED THROUGH A GLOBAL COMPUTER NETWORK; DISSEMINATION OF ADVERTISING MATTER, FIRST USE: Advertising the services and wares of others through all communication marketing concepts for others; Marketing services in the field of arranging for the distribution of the products and services of others; Marketing services in the field of evaluating markets for existing wares of others; Sale of cars, motorcycles, bicycles, scooters; Dissemination of advertising for others via an online communications network on the internet; Publication of magazines; Publishing of books, magazines, rooms, bulletin boards and community forums for the transmission of messages among computer users. FIRST USE: 20091204, FIRST USE IN COMMERCE: 20091204

Standard Characters Claimed Mark
Drawing Code (4) STANDARD CHARACTER MARK
Serial Number 85402345
Filing Date August 19, 2011
Current Basis 1A,1B
Original Filing Basis 1A,1B
Owner (APPLICANT) iCourier Software Systems Ltd. LIMITED LIABILITY COMPANY CANADA 288 georgia street(east) suite 155 vancouver CANADA v6a4h8
Description of Mark Color is not claimed as a feature of the mark.
Type of Mark SERVICE MARK
Register PRINCIPAL
Live/Dead Indicator LIVE

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TSDR ASSIGN STATUS TTAB STATUS (Use the "Back" button of the Internet Browser to return to TESS)

TECH & GO

Word Mark **TECH & GO**
Goods and Services **US 021 023 026 036 038 ; G & S : USB cables, USB hubs, electronic card readers, electric patch cables, computer mice, mouse pads, keyboards, battery chargers, namely, wall chargers, car chargers, and USB chargers; AC/DC converters, USB adapters, earbuds, headphones, audio speakers; blank CDs and DVDs; CD and DVD cases; flash media, namely, flash memory cards; power cables; audio and video cables and adapters, batteries and battery chargers; MP3 players and smart phone accessories, namely, headphones, signal splitters, speakers, electronic cables for syncing and charging MP3 players and smart phones, battery chargers, electronic docking stations, adapters, USB converters, and audio and video cables; cases, bags, stands, holsters, belt clips, straps, screen protectors, stylus, specially adapted for holding MP3 players and smart phones; camera accessories, namely, tripods, battery chargers, electronic cables for syncing and charging cameras, USB adapters, straps specially adapted for cameras, and adapters; cases and bags specially adapted for holding cameras**

Standard Characters Claimed Mark
Drawing Code (4) STANDARD CHARACTER MARK
Serial Number 86282926
Filing Date March 31, 2011
Current Basis 1B
Original Filing Basis 1B
Published for Opposition July 19, 2011
Owner (APPLICANT) E-filiate, Inc. CORPORATION DELAWARE 11321 White Rock Road Rancho Cordova CALIFORNIA 95742
Attorney of Record Bradley P. Heisler
Disclaimer NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "TECH" APART FROM THE MARK AS SHOWN
Type of Mark TRADEMARK
Register PRINCIPAL
Live/Dead Indicator LIVE

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EXHIBIT C

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