

TTAB

CERTIFICATE OF MAILING
37 C.F.R. 1.8

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail in an envelope addressed to: BOX TTAB - FEE, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3514, on the date below:

NOV. 19, 2003
Date

Michelle Poston
Signature

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

In the matter of Application Serial No.: 78/105,031
by David Scott Cooper for the Mark: **RENT A GEEK**
Filed: January 26, 2002


11-24-2003
U.S. Patent & TMO/TM Mail Rcpt Dt. #22

Published in the Official Gazette
at TM 286 on July 22, 2003

GEEK SQUAD, INC.
Opposer,

v.

DAVID SCOTT COOPER,
Applicant.

Opposition No. _____

NOTICE OF OPPOSITION

BOX TTAB - FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3514

Opposer, GEEK SQUAD, INC. ("Geek Squad"), a Minnesota corporation, having its principal place of business at 1213 Washington Avenue North, Minneapolis, MN 55401, believes that it will be damaged by registration of the mark shown in Application Serial No. 78/105,031 in Class 35 for the mark RENT A GEEK and hereby opposes the same under the provisions of 15 U.S.C. § 1063.

11/26/2003 K6IBBONS 00000202 502516 78105031
01 FC:6402 300.00 DA

As grounds of opposition, Geek Squad asserts that:

1. Geek Squad is the owner of the mark and trade name GEEK SQUAD (collectively, “the GEEK SQUAD mark”). Geek Squad adopted and began using the GEEK SQUAD mark at least as early as 1994 in connection with computer installation and repair, installation of computer systems, maintenance and repair of computer hardware, maintenance and repair of computer networks, upgrade of computer hardware, design of computers, computer software and computer networks, technical support services, namely troubleshooting and computer hardware and software problems, consulting services in the field of design, selection, implementation and use of computer hardware and software systems for others, computer network design, computer services, namely data recovery services, creating and maintaining web sites for others, and installation of computer software. Geek Squad has continuously used the GEEK SQUAD mark since that time.

2. Geek Squad is the owner of U.S. Trademark Registration Nos. 1,943,643 and 2,023,380 for mark GEEK SQUAD and Design. These registrations are valid, subsisting, enforceable, and incontestable pursuant to 15 U.S.C. § 1065. Copies of these registrations are attached as Exhibits A and B. Geek Squad is the owner of U.S. Trademark Registration No. 2,744,658 for mark GEEK SQUAD; this registration is also valid, subsisting and enforceable. A copy of this registration is attached as Exhibit C. Geek Squad is also the owner of U.S. Trademark Application Serial No. 78/187,717 for the mark GEEKMOBILE, and U.S. Trademark Application Serial No. 78/189,713 for the mark GEEK SQUAD 24 HOUR COMPUTER SUPPORT TASK FORCE. Together with the GEEK SQUAD mark, these marks are collectively referred to herein as “the Geek Squad marks.” Geek Squad has used each of these marks since at least as early as 1994.

3. Geek Squad has continuously promoted its services under the Geek Squad marks through numerous media channels, including in brochures and print ads, and on television, radio, and the Internet (including web-based advertising and on its own website, located at www.geeksquad.com).

4. Geek Squad has expended considerable effort and expense in promoting the Geek Squad marks and the goods and services offered under those marks and name with the result that the purchasing public has come to know, rely upon and recognize the products and services of Geek Squad by such marks. Geek Squad has established valuable goodwill in its Geek Squad marks.

5. As a result of Geek Squad's efforts, the Geek Squad marks have become famous.

6. The Geek Squad marks are inherently distinctive.

7. Applicant David Scott Cooper ("Applicant") seeks to register the mark RENT A GEEK ("Applicant's mark") for "retail computer hardware store services" in International Class 35 ("Applicant's services").

8. Applicant asserts that it began using Applicant's mark in commerce in May 2001. In contrast, Geek Squad has continuously used the Geek Squad marks in commerce since 1994 and such marks became famous prior to Applicant's claimed first use.

9. The mark that Applicant seeks to register so resembles Geek Squad's Geek Squad marks as to be likely, when used on or in connection with Applicant's services, to cause confusion, or to cause mistake, or to deceive. Customers and prospective customers are likely to falsely believe that Applicant's services offered under the RENT A GEEK mark are sponsored,

endorsed, or approved by Geek Squad, or are in some way affiliated, connected, or associated with Geek Squad. Registration therefore should be refused under 15 U.S.C. § 1052(d).

10. The mark that Applicant seeks to register so resembles the Geek Squad marks as to be likely, when used on or in connection with Applicant's services, to dilute the distinctive quality of the Geek Squad marks, in violation of 15 U.S.C. § 1125(c).

11. Registration of the Applicant's mark would be a source of damage to Geek Squad because purchasers are likely to attribute the source or sponsorship of Applicant's services to Geek Squad.

12. Registration of the Applicant's mark would be a further source of damage to Geek Squad because it would confer upon Applicant various statutory presumptions to which it is not entitled in view of Geek Squad's long prior use of its Geek Squad marks.

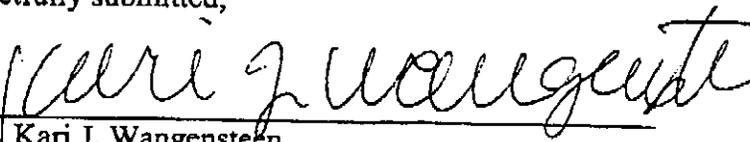
WHEREFORE, Geek Squad prays that Application Serial No. 78/188,087 be rejected, and that registration of the mark therein be refused.

A duplicate copy of this Opposition is being filed herewith. Please deduct the filing fee in the amount of \$300.00 as required by 37 C.F.R. § 2.6 from our deposit account (No. 50-2516). Please return the enclosed postcard to evidence receipt of this Notice of Opposition.

Respectfully submitted,

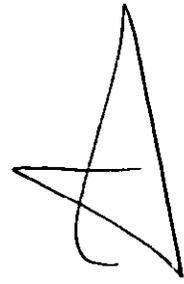
Dated: 19 November, 2003

By:



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ATTORNEY FOR GEEK SQUAD, INC.



Int. Cls.: 37 and 42

Prior U.S. Cls.: 100, 101, 103 and 106

United States Patent and Trademark Office

Reg. No. 1,943,643

Registered Dec. 26, 1995

**SERVICE MARK
PRINCIPAL REGISTER**



GEEK SQUAD, INC. (MINNESOTA CORPORATION)
411 N. WASHINGTON AVENUE, SUITE 108
MINNEAPOLIS, MN 55401

FOR: COMPUTER INSTALLATION AND
REPAIR, IN CLASS 37 (U.S. CLS. 100, 103 AND
106).

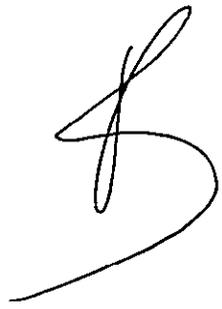
FIRST USE 5-20-1994; IN COMMERCE
5-20-1994.

FOR: DESIGN OF COMPUTERS, COMPUTER
SOFTWARE AND COMPUTER NETWORKS ,
IN CLASS 42 (U.S. CLS. 100 AND 101).

FIRST USE 5-20-1994; IN COMMERCE
5-20-1994.

SER. NO. 74-545,054, FILED 6-30-1994.

ZHALEH DELANEY, EXAMINING ATTOR-
NEY

A handwritten mark or signature consisting of a single continuous line. It starts with a long horizontal stroke at the bottom, curves upwards and to the right, then loops back to the left, crossing itself, and finally curves downwards and to the right to end.

Int. Cl.: 25

Prior U.S. Cls.: 22 and 39

Reg. No. 2,023,380

United States Patent and Trademark Office

Registered Dec. 17, 1996

TRADEMARK
PRINCIPAL REGISTER



GEEK SQUAD, INC. (MINNESOTA CORPORATION)
212 THIRD AVE NORTH
SUITE 579
MINNEAPOLIS, MN 55401

FIRST USE 8-1-1994; IN COMMERCE
9-0-1994.

OWNER OF U.S. REG. NO. 1,943,643.

SER. NO. 74-726,207, FILED 9-7-1995.

FOR: CLOTHING, NAMELY, T-SHIRTS, IN
CLASS 25 (U.S. CLS. 22 AND 39).

LESLEY LAMOTHE, EXAMINING ATTORNEY

C

Int. Cls.: 37 and 42

Prior U.S. Cls.: 100, 101, 103, and 106

United States Patent and Trademark Office

Reg. No. 2,744,658

Registered July 29, 2003

**SERVICE MARK
PRINCIPAL REGISTER**

GEEK SQUAD

GEEK SQUAD, INC. (MINNESOTA CORPORATION)
1213 WASHINGTON AVENUE NORTH
MINNEAPOLIS, MN 55401

FOR: COMPUTER INSTALLATION AND REPAIR, IN CLASS 37 (U.S. CLS. 100, 103 AND 106).

FIRST USE 6-16-1994; IN COMMERCE 6-16-1994.

FOR: DESIGN OF COMPUTERS, COMPUTER SOFTWARE AND COMPUTER NETWORKS, IN CLASS 42 (U.S. CLS. 100 AND 101).

FIRST USE 6-16-1994; IN COMMERCE 6-16-1994.

OWNER OF U.S. REG. NOS. 1,943,643 AND 2,023,380.

SN 76-400,952, FILED 4-29-2002.

THEODORE MCBRIDE, EXAMINING ATTORNEY

A

Int. Cls.: 37 and 42

Prior U.S. Cls.: 100, 101, 103 and 106

United States Patent and Trademark Office

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5-20-1994.

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ZHALEH DELANEY, EXAMINING ATTOR-
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B

Int. Cl.: 25

Prior U.S. Cls.: 22 and 39

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Registered Dec. 17, 1996

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CLASS 25 (U.S. CLS. 22 AND 39).

LESLEY LAMOTHE, EXAMINING ATTORNEY

11

2

Int. Cls.: 37 and 42

Prior U.S. Cls.: 100, 101, 103, and 106.

United States Patent and Trademark Office

Reg. No. 2,744,658

Registered July 29, 2003

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PRINCIPAL REGISTER**

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FIRST USE 6-16-1994; IN COMMERCE 6-16-1994.

OWNER OF U.S. REG. NOS. 1,943,643 AND 2,023,380.

SN 76-400,952, FILED 4-29-2002.

THEODORE MCBRIDE, EXAMINING ATTORNEY

Please indicate receipt of the below-identified paper:

<input type="checkbox"/> New TM/SM Appl. As Follows:	<input type="checkbox"/> ITU	<input type="checkbox"/> Use-Based	<input type="checkbox"/> 44	<input type="checkbox"/> Priority
<input type="checkbox"/> Specimens	<input type="checkbox"/> Drawing	Class(es):		<input type="checkbox"/> Check for \$
<input type="checkbox"/> AAU	<input type="checkbox"/> EOT #	<input type="checkbox"/> Stmt of Use	<input type="checkbox"/> Sec. 8 Decl.	<input type="checkbox"/> Sec. 8 & 15 Decl.
<input type="checkbox"/> Assignment FROM:	TO:			
<input type="checkbox"/> Response to Office Action Dated:				
<input checked="" type="checkbox"/> Other: Original and one copy of the following documents: Notice of Opposition and Return Postcard				
<input type="checkbox"/> Hand Delivery	<input checked="" type="checkbox"/> Cert. of Timely Mailing	<input type="checkbox"/> Exp. Mail No.		

IDENTIFICATION OF MATTER

<input checked="" type="checkbox"/> Serial No. 78/105,031	<input type="checkbox"/> Reg. No.	<input type="checkbox"/> Oppos. No.	<input type="checkbox"/> Cancellation No.:
Mark or Case Title: RENT A GEEK			
Applicant or Registrant: David Scott Cooper		Attorney: MET/TMK	
Client: Geek Squad, Inc.		F&J File No.: BBUY:002	
Mailed: 11/19/03	Filed:	Due Date: 11/19/03	



Trademark Docketing
c/o Fulbright & Jaworski L.L.P.
2400 One American Center
600 Congress Avenue
Austin, Texas 78701-3248