

**THIS OPINION IS NOT A
PRECEDENT OF
THE T.T.A.B.**

Mailed: March 4, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Computer Geeks, Inc.
v.
Compgeeks.com
—————

Opposition No. 91167886
Opposition No. 91170726
Cancellation No. 92046567
—————

Jane Shay Wald of Irell & Manella, LLP, for Computer Geeks, Inc.

Lisa Greenwald-Swire of Fish & Richardson P.C., for Compgeeks.com.

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Before Hairston, Zervas and Ritchie, Administrative Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

The opposer and petitioner in this case is Computer Geeks, Inc. ("Plaintiff"). The applicant and respondent is Compgeeks.com ("Defendant"). Defendant's mark at issue in the **opposition** proceedings is COMPUTER GEEKS for:

1. "Retail store services featuring computer-related items, including hardware, software

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and computer peripherals", in International
Class 35;¹

2. "Computer consulting services primarily focusing on computer repairs, teaching individuals and small businesses to effectively utilize computer resources at hand," in International Class 42;²
3. "Computer hardware, computer software for making computer hardware, namely, drivers, mouseports, printer drivers compatible with computer applications," in International Class 9,³ and
4. "On-line retail and wholesale store services featuring computer hardware, computer software and computer peripherals," in International Class 35.⁴

Defendant's mark at issue in the **cancellation**
proceeding is COMPGEEKS.COM for:

¹ Application Serial No. 78380877, filed March 9, 2004, claiming a date of first use anywhere and first use in commerce on April 8, 1995, in both classes, and disclaiming the exclusive right to the term "COMPUTER" apart from the mark as shown.

² *Id.*

³ Application Serial No. 78258431, filed June 4, 2003, claiming first use anywhere and first use in commerce on February 1, 1996 for both classes, and claiming Section 2(f) acquired distinctiveness as to the entire mark.

⁴ *Id.*

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1. "Computerized on-line ordering services in the field of computer software, computer hardware, computer peripherals and accessories," in International Class 35, and
2. "Computer services, namely, providing search engines for obtaining data on global computer network," in International Class 42.⁵

The cases involve the same parties and common questions of law and fact. Upon consented motion by the parties, the three cases were consolidated via an order of the Board dated August 3, 2006. However, as the order noted, each case maintains its independent identity.

In its notices of opposition, Plaintiff asserts priority based on continuous use of the mark COMPUTER GEEKS in commerce in connection with the services listed in its pending trademark application "for a wide variety of computer-related goods and services" and likelihood of confusion. (Notices at Para. 1, 5 - 7). Defendant denied the salient allegations in its answers and set forth various affirmative defenses.⁶

In its petition for cancellation, Plaintiff alleges priority based on its common law use of the mark COMPUTER

⁵ Registration No. 2499396, issued October 23, 2001, claiming first use anywhere and first use in commerce on February 1, 1996 for both classes. Section 8 affidavit accepted.

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GEEKS for various computer goods and services since prior to Defendant's alleged date of first use of its mark (para. 7); and the following: "Insofar as the subject Reg. No. 2499396 is asserted by the Registrant (who is also the owner of Applications Ser. No. 78/380,877 and 78/258,431) as a defense to the pending Consolidated Opposition, then Petitioner believes it will be damaged by the continued registration of the mark of 2499396." (Petition at Para. 6). (*Id.* at Para. 7). We do not recognize this allegation as raising a legally sufficient claim, and likelihood of confusion is neither mentioned in the petition itself nor in Plaintiff's trial brief (with regard to the registration). Defendant denied the salient allegations in its answer to the petition and set forth various affirmative defenses, including that Plaintiff "fails to state a claim on which relief can be granted." We agree.

In its brief, Plaintiff argues that Defendant's registration for the COMPGEEKS.COM mark should be cancelled on the grounds of genericness and mere descriptiveness. Defendant timely objected to these grounds as unpleaded. Plaintiff in reply urges us to consider the pleadings amended under the provisions of Section 15(b) of the Federal Rules of Civil Procedure. In support of its argument for

⁶ Defendant did not pursue its *Morehouse* affirmative defense to the oppositions on brief. Thus we deem it to be waived.

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adding the grounds, Plaintiff referenced the following testimony by Mr. Kusel, Defendant's witness (Plaintiff's brief at 13-15):

Q: Would you explain to us what Computer Geeks means to you?

A: People that play with computers, live with computers, their life is computers; are computers geeks. So it's a - a geek.
(*Id.* at 14, citing Kusel May 23 Depo at 159).

However, Mr. Kusel's testimony arose in the course of discussing Defendant's policing efforts. Furthermore, the testimony referenced the mark COMPUTER GEEKS, not COMPGEEKS.COM. At no point during trial were Defendant or its counsel put on notice that Plaintiff intended to argue that Defendant's COMPGEEKS.COM mark is generic or merely descriptive. Accordingly, Defendant's objection is sustained.⁷

We find that Plaintiff has not coupled its claim of priority with one of likelihood of confusion in its petition to cancel. We find further that the issue of likelihood of confusion regarding Defendant's registered mark has not been tried by the consent of the parties. Accordingly, we find that there is no legally recognizable claim in Plaintiff's

⁷ The objection is sustained as to the oppositions as well, to the extent that Plaintiff asserted genericness and mere descriptiveness in the brief. We consider the oppositions only on the claims of priority and likelihood of confusion. Since there are no counterclaims pending, and no other claims beyond priority and likelihood of confusion, we will only consider those

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petition for cancellation. Therefore, the cancellation is dismissed.

We turn then to the single ground pleaded and argued in the oppositions, namely, that of priority and likelihood of confusion.

The Record and Evidentiary Issues

The record in the oppositions includes the pleadings and the file of the involved applications. In addition, both parties filed Notices of Reliance during their assigned testimony periods, submitting, among other things, various discovery depositions which were stipulated into the record.⁸ Additionally, the record includes the following testimonial depositions:

1. Stephen A. Lonn, President of Computer Geeks, Inc., by Plaintiff, on September 11, 2008.
2. Compgeeks.com, Genica Corporation, and Scott E. Kusel, by Plaintiff, on January 30, 2009.⁹

claims and defenses to priority and likelihood of confusion that were validly pleaded and argued, as discussed in this decision.

⁸ Although the record only contains a reference to a stipulation by the parties to the entry of the discovery deposition of witnesses Scott E. Kusel and Frank Segler (as read into the Lonn September 11 Depo. at 8), it is clear that both parties acceded to the entry of the discovery depositions via Notice of Reliance and waived any objections thereto by treating them in their briefs as being of record and by referencing them as well.

⁹ Mr. Kusel had been the Fed. R. Civ. P. 30(b)(6) witness for Defendant. The parties then agreed by stipulation for him to continue to testify both in his individual capacity as well as on behalf of the corporations at trial. (Kusel January 30 Depo. at 7-8 and Exs. 1 and 2.)

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3. Scott E. Kusel, President of Compgeeks.com, by
Defendant, on March 26, 2009.

Plaintiff objected to Exhibits 3 and 4 of Defendant's Notice of Reliance, stating in its brief that they appear to "rely only on documents 'produced in discovery by Applicant' as their evidentiary basis." (Plaintiff's brief at 4). The exhibits referred to by Plaintiff are indeed referred to by Defendant as its own "Documents Numbers AP 644-660" and "AP 694-717," respectively. Plaintiff is correct that this is not a basis for submitting documents under a Notice of Reliance. See Trademark Rule 2.120(j)((3)(ii) and TBMP § 704.11 (2d ed. rev. 2004). However, they are all admissible under Trademark Rule 2.122(e) as official records of the USPTO, except for Document No. 644, which is Defendant's own Registration No. 2087121 for the mark COMPUTER GEEKS.¹⁰ As a registration owned by a party, this registration must be submitted in accordance with Trademark Rule 2.122(d)(2). Thus, with the exception of Doc. no. 644, Plaintiff's objection to these documents is overruled. As for Document No. 644, this document was not properly submitted into evidence as a status and title copy as required by Rule 2.122(d)(2).

¹⁰ Our decision in this case would not be any different if we sustained Plaintiff's objection because a different version of the same registration was entered into the record as Exhibit 3 to

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For its part, Defendant objected to Plaintiff's testimonial depositions as not having been properly made of record in a timely fashion. Defendant did not complain of prejudice, nor that it had not received the deposition transcripts in a timely manner, but only that they had not been properly made of record. The relevant rule states:

All depositions which are taken must be duly filed in the Patent and Trademark Office. On refusal to file, the Office at its discretion will not further hear or consider the contestant with whom the refusal lies; and the Office may, at its discretion, receive and consider a copy of the withheld deposition, attested by such evidence as is procurable.

37 C.F.R. §2.123(h)

Since Plaintiff did ultimately file the depositions with the Board, and since Defendant did not apparently suffer any cognizable prejudice, Defendant's objection is overruled.

Finally, we note that a good portion of the record, including entire depositions, Defendant's entire Notice of Reliance with six exhibits, and the trial briefs (as a result), were designated "Confidential." In rendering a decision in this proceeding, we will not be hamstrung by the parties' designation of testimony and evidence as "Confidential." We will treat only testimony and evidence that is truly confidential and commercially sensitive as confidential. In short, where necessary and useful to our

the Kusel March 26 Deposition, and the assignment of the Pagano registration to Defendant was discussed therein.

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decision, we quote passages from the depositions or briefs (almost all of which were designated "CONFIDENTIAL," in their entireties) although, of course, in doing so, we are careful not to reveal any truly confidential or commercially sensitive information.

Standing

A party has standing to oppose a registration under Section 13 of the Trademark Act of 1946, 15 U.S.C. §1063 if that party can demonstrate that it has a real interest in the proceeding (*i.e.*, a direct and personal stake in the outcome of the proceeding). *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025-1026 (Fed. Cir. 1999); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). As discussed below in the section headed "Priority," we find that Plaintiff has used the mark COMPUTER GEEKS in connection with its own business. Furthermore, Plaintiff has attempted to register the mark COMPUTER GEEKS for computer-related goods and services, which has been suspended, with an advisement that when the applications mature into registrations, a refusal would be forthcoming. Finally, Defendant has sent Plaintiff cease and desist letters on two occasions, in 2000 and 2005, demanding that Plaintiff cease its use of the mark COMPUTER GEEKS in its business. *See Ipco. Corp. v. Blessings Corp.*,

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5 USPQ2d 1974 (TTAB 1988) (standing found where applicant had sent opposer cease and desist letters). Accordingly, we find that Plaintiff has established its standing to bring this action.

Priority

Each party claims that it has priority over the other, with each claiming use as early as approximately November 1995. To establish priority on a likelihood of confusion claim brought under Trademark Act §2(d), a party must prove that, vis-à-vis the other party, it owns "a mark or trade name previously used in the United States and not abandoned. . . ." Trademark Act Section 2, 15 U.S.C. §1052. A party may establish its own prior proprietary rights in a mark through ownership of a prior registration, actual use or through use analogous to trademark use, such as use in advertising brochures, trade publications, catalogues, newspaper advertisements and Internet websites which create a public awareness of the designation as a trademark identifying the party as a source. See Trademark Act §§2(d) and 45, 15 U.S.C. §§1052(d) and 1127. See also *T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879 (Fed. Cir. 1996). There must be "regular or recurring activity" such as to constitute source identification in the

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eyes of consumers. *Giersch v. Scripps*, 90 USPQ2d 1020, 1023 (TTAB 2009).

Plaintiff's Earliest Use Date

Inasmuch as Plaintiff has not pleaded ownership of any registered trademark, Plaintiff must rely on its common-law use of COMPUTER GEEKS as a trademark to prove priority. In order for a Plaintiff to prevail on a claim of likelihood of confusion based on its ownership of common-law rights in a mark, the mark must be distinctive, inherently or otherwise, and Plaintiff must show priority of use. *Id*; see also *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981). Defendant has not challenged the distinctiveness of Plaintiff's mark or otherwise put Plaintiff on notice of this defense, and therefore we deem the mark distinctive. See *Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, 1634 (TTAB 2007) (absent argument or evidence from applicant, opposer's mark deemed distinctive).

In a case involving common-law rights, "the decision as to priority is made in accordance with the preponderance of the evidence." *Hydro-Dynamics Inc. v. George Putnam & Company Inc.*, 811 F.2d 1470, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987). To establish its first use date, Plaintiff offered the testimony of its founder and president, Stephen A. Lonn:

Q: When did you start using the name Computer Geeks in your business?

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A: It was around 1995 that I can recall. It might have been a little before but I think I've got documented use of the name as early as '95. (Lonn September 11 Depo. at 11).

Plaintiff seeks through Mr. Lonn's testimony to capture at least a November 1995 priority date for use of the mark COMPUTER GEEKS. As Mr. Lonn explained, as of mid to late 1995, he worked out of his home, and of the homes and businesses of clients, performing computer-related services (as more fully described below) under the COMPUTER GEEKS name and mark. (*Id.* at 13-14).

Q: What is the earliest date that you believe that you conducted business, the computer business in connection with the Computer Geeks name?

A: Well, I'm certain that I was doing business before acquiring all the paperwork by probably at least three to four months.¹¹ The paperwork certainly came after my first course of business. I was doing business prior to some of this paperwork, like the fictitious business statement and the business license. The documentation that we have available here came a little bit afterwards."
(*Id.* at 140).

Mr. Lonn described the services that he offered under the COMPUTER GEEKS name and mark as of 1995:

Q: Would you describe the services that you offered under the name when you first commenced your business?

¹¹ Although not establishing trademark use, Mr. Lonn attested to having obtained a fictitious business name statement with the County of Los Angeles, California, for the name "COMPUTER GEEKS," filed on September 11, 1995, and published soon thereafter. (*Id.* at 37 and Ex. 7).

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A: Services included but weren't limited to computer consulting, computer repair, computer building. I sold computers at the time as well.

Q: When you say computer building, would you describe what you mean by that?

A: Custom-building computers means that people had different needs for computers at the time, as they still do today, so we would build computers to the custom-tailored needs of the customer.

Q: And this was the case in 1995?

A: Yes.

Q: Where did you get the parts that you built the computers from?

A: Different vendors. It could be retail stores such as Fry's Electronics, it could be off the Internet, just wholesalers.

Q: Did you resell part?

A: Yes, there were times that we resold parts as a service.
(*Id.* at 13-14).

Plaintiff's testimony was confirmed by advertisements and invoices dating from the fall of 1995. In particular, Exhibit 9 to Mr. Lonn's September 11 deposition was authenticated as the earliest of several sales order books produced by Plaintiff in this proceeding. Although Mr. Lonn testified that he may even have made sales before those, it is clear from the book he produced that at least as early as November 28, 1995, he provided services regularly and continuously under the mark COMPUTER GEEKS. Indeed, the records themselves show sales slips, all labeled with the

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COMPUTER GEEKS name, and showing the services rendered. The services themselves range from "diagnostics" and "consulting" to "assembly." Accordingly, we find that Plaintiff has established a first use date of November 28, 1995 for "computer services in the nature of diagnostics, consulting, and custom assembly of computers." We note that this is not the full identification of goods and services for which Plaintiff seeks registration currently via its pending application. However, it is the identification of services for which we find Plaintiff has established use as of November 28, 1995.

Defendant's Earliest Use Date

Since Plaintiff has established a first use date of November 28, 1995 for the mark COMPUTER GEEKS for "computer services in the nature of diagnostics, consulting, and custom assembly of computers," Defendant must show that it was using COMPUTER GEEKS prior to that date for its goods and services in order to establish priority in this proceeding.

Defendant has two applications at issue in this proceeding. For Serial No. 78380877, Defendant asserted a first use date for both classes of April 8, 1995. This date is earlier than the November 1995 date that Defendant seeks to establish in this proceeding. (Defendant's brief at 6).

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Accordingly, for the goods and services identified in Serial No. 78380877, Defendant need only establish its November 1995 date by a preponderance of the evidence standard.

Hydro-Dynamics, Inc. v. George Putnam & Co., 811 F.2d 1470, 1473 (Fed. Cir. 1987), 1 USPQ2d 1772, 1773 (Fed Cir. 1987).

For Serial No. 78258431, however, Defendant asserted a first use date for both classes of February 1, 1996. Since this post-dates the November 1995 date, for Defendant to succeed, it would have to establish prior use for that application by clear and convincing evidence. *Id.* "Where an applicant seeks to prove a date earlier than the date alleged in its application, a heavier burden has been imposed on the applicant than the common-law burden of preponderance of the evidence." [citations omitted].¹²

In order to establish a priority date, Defendant offered the testimony of Scott E. Kusel, President of Genica Corp., Computer Geeks, and Evertek. With regard to Defendant's corporate structure, he testified "Genica is the

¹² We note again that Defendant filed its application Serial No. 78258431 under Section 2(f) of the Trademark Act, alleging that it had "acquired distinctiveness." Accordingly, "the mark's descriptiveness is a nonissue." *Cold War Museum Inc. v. Cold War Air Museum Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009). Nevertheless, Plaintiff has not argued the descriptiveness of this mark. Because "[i]f [an] opposer does not provide sufficient grounds to at least place the matter in issue, the situation is indistinguishable from one in which no opposition was filed," *Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988). Thus, mere descriptiveness of Defendant's mark is outside the scope of this proceeding.

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parent company that owns and operates Compgeeks." (Kusel
March 26 Depo. at 9)

Q: Could you walk me through this, either with or without the organizational chart, whichever is easier for you?

A: Genica is the parent company. We operate two divisions: A wholesale and a resale side. Computer Geeks is the resale division. Evertek is our wholesale division, which also operates an auction site called Wholesale Auction."

Q: Is Computer Geeks a corporation as well as a division?

A: Yes.

Q: What's the name of the corporation?

A: Compgeeks.com.

Q: What is Computer Geeks relative to Compgeeks.com?

A: It's the name that we associate with it. Compgeeks.com was the URL. Computer Geeks was the company name.

Q: Was Computer Geeks called Computer Geeks in 2000?

A: We were always Computer Geeks.

Q: Were you Computer Geeks Discount Outlet?

A: That's a permutation of the name, yes.
(*Id.* at 15)

Mr. Kusel further described Compgeeks.com/Computer Geeks as "primarily an online retailer of excess liquidation, new, used, refurbished, hard-to-find, high-demand computer equipment, peripherals, consumer electronics." (*Id.* at 10). According to Mr. Kusel, back in

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1995, Computer Geeks Discount Outlet was a dba of Evertek Discount Trading (Kusel March 26 Depo. at 10). He testified that the founder, Frank Segler, started a second company "for a retail division. Evertek was a wholesale-only division, and he wanted to have a retail side only, and that was his idea to form Computer Geeks." (*Id.* at 11).

When asked directly about Defendant's first use of the mark COMPUTER GEEKS, Mr. Kusel testified:

Q: "When did your company first directly, not through a license, use the Computer Geeks mark in commerce?"

A: Well, there is a dba that states that it was used in September of 1995; marketingwise, I used it in November of 1995."
(*Id.* at 19).

In the 1995-1996 timeframe, the sole use of the mark COMPUTER GEEKS was as the retail arm of the company Evertek, another division of parent Genica. (Kusel January 30 Depo. at 60). Mr. Kusel's testimony regarding that use of the COMPUTER GEEKS mark in the 1995-1996 timeframe clarified that "Yes, it would be on the boxes. On the actual shipping boxes, yes. We would ship it back with Computer Geeks' material around it, but the actual product is not branded. The products going out, yes, would be packaged in Computer Geeks paraphernalia." (Kusel March 26 Depo. at 24). However, he was not able to point to any documentary evidence to back up that testimony.

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Mr. Kusel further testified, upon questioning, that the mark "would have been on advertisements" in 1995, "Probably November of '95, the end of the year." (*Id.* at 29). However, again he was not able to point to any documentary evidence to back up that testimony either.

The only document in the record from late 1995 containing the term "computer geeks" is the fictitious business name statement filed with the County Recorder's Office in San Diego California, on September 18, 1995, registering "Evertek I.C. Trading Computer Geeks Discount Outlet" as a dba for Evertek Computer Corp. (Kusel March 26 Depo., Ex. 9). However, this fictitious business name registration is not trademark use.

Defendant further points to testimony regarding its tax filings as evidence of use of the mark COMPUTER GEEKS in the 1995-1996 timeframe. Specifically, Mr. Kusel testified that Defendant reported \$1 million in total sales in the timeframe between "July of '95 through June of '96" for sales made by Defendant. The 1995 - 1996 tax return was introduced as Exhibit 6 to Mr. Kusel's deposition testimony. However, the tax return itself does not contain mention of the name or mark "Computer Geeks." Rather, Mr. Kusel testified:

Q: And in 1995, what name would all retail sales have been under?

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A: Computer Geeks, Computer Geeks Discount Outlet,
d.b.a. of Evertek.

Q: Why is that?

A: Evertek was purely a wholesale company, so any
transactions that took place that had retail tax
would have been only on the Computer Geeks d.b.a.
side.

(Kusel March 26 Depo. at 23-25 and Exhibit 6).

As Mr. Kusel testified, the tax return covered a one
year period ending June 30, 1996. Yet, within that one year
period, Mr. Kusel was not able to identify a particular date
when Defendant had begun use of the mark COMPUTER GEEKS.
Instead, he testified to a general recollection that it was
in or around November 1995:

Q: Well, for the moment, let's talk about Genica.
In what way was the Computer Geeks term used in
1995 by Genica?

A: It would have been on advertisements.

Q: Do you know the month in 1995?

A: Probably November of '95, the end of the year.

Q: Why does that stick in your head?

A: Because that was - it was right before I
remember the year ending and probably a month
prior to it. So I'm saying November.

(Kusel May 23 Depo. at 29).

However, due to the lack of any other documentary
evidence, and the unconvincing nature of the oral testimony
(Mr. Kusel himself could not be certain of at what point in
the 1995-1996 timeframe Defendant began use of the mark
COMPUTER GEEKS), for the mark of Serial No. 78258431,

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Defendant has not met its burden of proving by clear and convincing evidence a date earlier than November 28, 1995, the date of priority established by Plaintiff.

Our consideration of Defendant's evidence is consistent with the Board's consideration of respondent's evidence in *Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.*, 89 USPQ2d 1844 (TTAB 2008), which stated:

Respondent's June 15, 1995 date of first use is clearly subsequent to March 1, 1995, petitioner's date of first use. Moreover, even if we used the February/March, 1995 date of respondent's first use of the term "Sportsman's Warehouse," we would still find that petitioner had priority because respondent's testimony is not clear and convincing. See *National Bank Book Co. v. Leather Crafted Products, Inc.*, 218 USPQ 826, 828 (TTAB 1993) (oral testimony may be sufficient to prove the first use of a party's mark when it is based on personal knowledge, it is clear and convincing, and it has not been contradicted); *Liqwacon Corp. v. Browning-Ferris Industries, Inc.*, 203 USPQ 305, 316 (TTAB 1979) (oral testimony may be sufficient to establish both prior use and continuous use when the testimony is proffered by a witness with knowledge of the facts and the testimony is clear, convincing, consistent, and sufficiently circumstantial to convince the Board of its probative value); *GAF Corp. v. Anatox Analytical Services, Inc.*, 192 USPQ 576, 577 (TTAB 1976) (oral testimony may establish prior use when the testimony is clear, consistent, convincing, and uncontradicted). In view of the uncertainty of respondent's testimony and lack of documentation, we conclude that respondent's date of first use can be no earlier than March 31, 1995, the last day of the specified time period identified in Mr. Utgaard's testimony. *EZ Loader Boat Trailers, Inc. v. Cox Trailers, Inc.*, 213 USPQ 597, 598 n.5 (TTAB 1982) (documentary evidence showed first use in 1977, the month and day were unknown, therefore, the Board could not presume any date earlier than the last day of the proved period). See also *Osage Oil & Transportation, Inc. v. Standard Oil Co.*, 226 USPQ 905, 911 n.22 (TTAB

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1985) (evidence established first use in 1968-1969, therefore December 31, 1969 is date of first use).
Id. at 1856.

Accordingly, here, as well, due to the uncertainty of the Defendant's testimony on exact dates, as well as the lack of documentary evidence attesting to use of the mark in 1995, we conclude that Defendant cannot prove by "clear and convincing evidence" first use of the mark for Serial No. 78258431 prior to November 28, 1996, Plaintiff's priority date. Therefore, Defendant does not beat Plaintiff's earliest use date.¹³

Defendant is not held to the "clear and convincing" evidence standard to prove a priority date in 1995 for Application No. 78380877, but rather is held to a "preponderance of the evidence" standard. However, Defendant has simply not offered sufficient proof of its use as of the date claimed on that application either. We find that Defendant has not sufficiently established a first use date of the "November 1995" that it argues on brief, for the goods and services listed in either application.

Next, Defendant attempts to claim priority based on an assignment of rights from an individual named Timothy J.

¹³ Were we to find under an argument of 2(f) that Defendant is indeed entitled to a priority date no earlier than its application filing date for the goods and services covered by Serial No. 78258431, that still would not change our decision, since in either case, Plaintiff has the earlier priority date.

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Pagano. (Kusel March 26 Depo. at 11-12 and Ex. 1). The assigned registration has been cancelled on the Principal Register and cannot be relied upon for priority. (*Id.* at 75-78). As testified by Mr. Kusel and demonstrated by the assignment itself, the document does assign "the goodwill of the business in which the mark is used" as well as the (now cancelled) trademark registration (*Id.*, Ex. 1). However, although Mr. Kusel testified that Mr. Pagano has been the owner of the Computer Geeks' trademark "Since October 10, 1989," (*Id.*, at 12), there is nothing in the assignment, the registration, or otherwise of record to corroborate his testimony. Indeed, Mr. Kusel himself admitted on cross-examination that his sole knowledge of Mr. Pagano's business, including of any goodwill that may have been transferred via the assignment, was as stated in the "the trademark office filings or the license agreement." (*Id.* at 44). Accordingly, with only a cancelled registration to rely upon, and without any documentary evidence of goodwill, Defendant cannot rely on the Pagano assignment for priority of use.

Finally, Defendant attempts to claim priority based on an assignment of rights from an individual named Joseph Kissell. (*Id.* at 26-29 and Ex. 7). However, Ex. 7, the assignment, appears to be no more than an assignment of a

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domain name registration. Furthermore, Mr. Kusel was unable in this instance again to attest to any proof of actual goodwill transferred with the assignment. Accordingly, again without any documentary evidence of goodwill, Defendant cannot rely on the Kissell assignment for priority of use.

Accordingly, we find that Defendant is not able to predate in either application Plaintiff's established first use date of November 28, 1995. Thus, we award priority to Plaintiff and proceed with an analysis of the likelihood of confusion.

Likelihood of Confusion

This case is a bit unusual in that neither party in its brief actually points to evidence or presents arguments regarding the *du Pont* factors. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Rather both parties urge that we are bound by the other's admissions. Plaintiff essentially argues that once we have determined priority for Plaintiff, Defendant is bound to accept a likelihood of confusion, since (1) the examining attorney for Plaintiff's pending application thinks there is a likelihood of confusion; and (2) Defendant sent Plaintiff two cease and desist letters. Specifically, Plaintiff's brief states the following:

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Opposer has made no allegation of similarities of the marks, relatedness of the goods and services, or likelihood of confusion. Instead, this key element to the Opposition [sic] was supplied by the Examining Attorney, which is a proper basis for Opposition [sic]. T.M.B.P. [sic] §309.03 (c)B. It was confirmed by the cease and desist letters sent by an entity under which Applicant now purports to claim rights. These letters are admissions that Applicant perceives a likelihood of confusion, since Applicant twice threatened to sue Oposer over the mark. *Ultra Electronics, Inc. v. Workman Electronics Products, Inc.*, 192 U.S.P.Q. 497 (T.T.A.B. 1976). (Plaintiff's Brief at 17-18).

We must disagree with Plaintiff's legal conclusions. First, Defendant does dispute likelihood of confusion in its pleadings as well as its trial brief. Second, we are not bound by the determinations of examining attorneys in pending applications (and indeed, we note that the application is merely suspended; there has not yet been a final refusal on the merits). *In re Nett Designs*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001). Accordingly, as we have often stated in response to such arguments, the office action in question has no bearing on our decision. Finally, the decision in *Ultra Electronics* does not state that cease and desist letters are admissions of likelihood of confusion. Rather, the Board in that case specifically stated the following:

As urged by respondent, a letter of infringement in which one party expresses the view that there is likelihood of confusion between its mark and that of the adverse party is not necessarily controlling on the question of likelihood of confusion. However, the admission contained in

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the letter may be a persuasive factor in resolving any doubts which may exist concerning the likelihood of confusion.
Ultra Electronics, at 498.

Defendant, for its part, urges us to accept Mr. Lonn's testimony as determinative that there is no likelihood of confusion between the businesses of Plaintiff and Defendant. Defendant cites the following testimony from Mr. Lonn's deposition:

Q: Do you believe that compgeeks.com has the right to sue Computer Geeks for trademark infringement?

A: No.

Q: Why not?

A: Because it's my understanding that Compgeeks.com and Computer Geeks are different as far as the names go. The branding of the names are different to me.
(Lonn September 11 Depo. at 105)

As well as the following excerpts:

Q: Is it your belief now that your business and the business of Mr. Kusel are more similar than they were back in 1997?

A: No.

. . .
There are some things that we may share, but on a whole, I think our business models are different.

. . .
I think we share the opinion that we each have rights to the name.

Q: What else is it - or what else is there that you believe you now share with Mr. Kusel's business that you did not share with his business in 1997?

A: Nothing.

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Q: Would it be fair to say, then, that in all other respects, you believe your business is different from Mr. Kusel's business?

A: Yes.

(Defendant's brief at 10-11, quoting Lon March 17 Depo. at 135-136).

We do not consider Mr. Lon's comments to be admissions of a lack of a likelihood of confusion between all goods and services offered between Plaintiff and Defendant under the COMPUTER GEEKS mark. However, we do consider his testimony to be a statement against interest. Accordingly, the cease and desist letters on the one hand, and the testimony of Mr. Lon on the other, somewhat balance each other out in our analysis.

Overall, our determination under Section 2(d) must be based on an analysis of all of the facts in evidence that are relevant to a likelihood of confusion. *See In re E. I. du Pont de Nemours & Co., supra*, 177 USPQ 563; *See also Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See Federated Foods, Inc. v.*

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Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks").

The Marks

The first *du Pont* factor asks us to consider whether Plaintiff's and Defendant's marks are similar or dissimilar when viewed in their entireties in terms of appearance, sound, connotation and overall commercial impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot, supra*. Plaintiff's and Defendant's COMPUTER GEEKS marks are identical in all respects. Accordingly, this *du Pont* factor favors Plaintiff.

The Goods and Services and the Channels of Trade

With respect to the goods and services, it is well-established that the goods or services of the parties need not be similar or competitive, or even offered through the same channels of trade, to support a holding of likelihood of confusion. It is sufficient that the respective goods or services of the parties are related in some manner. The issue, of course, is not whether purchasers would confuse the goods or services, but rather whether there is a likelihood of confusion as to the source thereof. Furthermore, where, as here, the marks are identical, there

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need only be a viable relationship between the respective goods and services for a likelihood of confusion to result. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Opus One Inc.*, 60 USPQ2d 1812 (TTAB 2001). It also bears mentioning that if we find one service or good in the identifications to be related, the whole class falls.

We have found that Plaintiff has established priority for "computer services in the nature of diagnostics, consulting, and custom assembly of computers." Meanwhile Defendant seeks to register the same mark for various computer-related goods and services, specifically:

1. "Retail store services featuring computer-related items, including hardware, software and computer peripherals", in International Class 35,
2. "Computer consulting services primarily focusing on computer repairs, teaching individuals and small businesses to effectively utilize computer resources at hand," in International Class 42;
3. "Computer hardware, computer software for making computer hardware, namely, drivers, mouseports, printer drivers compatible with computer applications," in International Class 9, and

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4. "On-line retail and wholesale store services featuring computer hardware, computer software and computer peripherals," in International Class 35.

Due to the scant evidence of record, we are effectively left to examine the individual identifications to determine the similarity or dissimilarity of each of the goods or services and the resulting channels of trade.

It is clear that there is an overlap in the services offered by Plaintiff and Defendant as to the consulting services in Class 42 (Application No. 78380877).

Similarly, we find that Plaintiff's "computer services in the nature of diagnostics, consulting, and custom assembly of computers" and Defendant's "computer hardware, computer software for making computer hardware, namely, drivers, mouseports, printer drivers compatible with computer applications," in Class 9 (Application No. 78258431), are related as the computer components used in the custom assembly of computers services are likely the same components identified in Defendant's identification and would likely move in the same channels of trade. *See In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988) (BIGGS (stylized) for retail grocery and general merchandise store services held to be likely to be confused with BIGGS and design for furniture); *In re United Service*

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Distributors, Inc., 229 USPQ 237 (TTAB 1986) (design for distributorship services in the field of health and beauty aids held likely to be confused with design for skin cream); and *Steelcase inc. v. Steelcare Inc.*, 219 USPQ 433 (TTAB 1983) (STEELCARE INC. for refinishing furniture, office furniture, and machinery held likely to be confused with STEELCASE for office furniture and accessories).

However, we have no basis from which we can conclude that Plaintiff's services are related to any of the International Class 35 services. Although we understand that both Plaintiff and Defendant engage in computer-related businesses, that alone does not create a likelihood of confusion. The burden was on Plaintiff to prove by a preponderance of the evidence that the services and channels of trade are similar. We find that as to the "retail store services" in Class 35 (Application No. 78380877) and the "on-line retail and wholesale store services" in Class 35 (Application No. 78258431), Plaintiff has failed to satisfy that burden.

Actual Confusion

The final *du Pont* factor discussed by the parties is the lack of verifiable instances of actual confusion. Although Defendant asserts that the absence of actual confusion suggests no likelihood of confusion, it is not

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necessary to show actual confusion in order to establish likelihood of confusion. See *Weiss Associates Inc. v. HRL Associates Inc.* 902 F.2d 1546, 223 USPQ 1025 (Fed. Cir. 1990). Thus, while evidence of actual confusion, if it exists, would strongly support a finding of likelihood of confusion, the absence thereof does not necessarily overcome a finding of likelihood of confusion.

On the other hand, the parties have coexisted in close proximity, both in Southern California, for well over a decade. This was attested to by Mr. Lonn in his discovery deposition: "I felt we could coexist." (Lonn March 12 Depo. at 37). Accordingly, we find this eighth *du Pont* factor to slightly favor Defendant.

Balancing the Factors

We have carefully considered all of the arguments as well as the evidence of record. We conclude that Plaintiff has established priority of use of an identical mark, but that Plaintiff has not established that applicant's goods and services in International Class 35 are related to Plaintiff's services. Finally, we note that the record does not contain any instances of actual confusion, despite over a decade of coexistence in close proximity in Southern California.

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Plaintiff has not submitted documentary or testimonial evidence to demonstrate a similarity of its "computer services in the nature of diagnostics, consulting, and custom assembly of computers" to Defendant's "retail store services featuring computer-related items, including hardware, software and computer peripherals", services in Class 35 (Application No. 78380877) or "on-line retail and wholesale store services featuring computer hardware, computer software and computer peripherals," in Class 35 (Application No. 78258431) such that consumers would be likely to mistakenly believe that they originate from the same source. Accordingly, and because it is Plaintiff's burden to do so, we find no likelihood of confusion as to the Class 35 services.

We do, however, find a likelihood of confusion as to Plaintiff's "computer services in the nature of diagnostics, consulting, and custom assembly of computers" and Defendant's "computer consulting services primarily focusing on computer repairs, teaching individuals and small businesses to effectively utilize computer resources at hand," in Class 42 (Application No. 78380877) as well as "computer hardware, computer software for making computer hardware, namely, drivers, mouseports, printer drivers compatible with computer applications," in Class 9 (Application No. 78258431) such that consumers would be

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likely to mistakenly believe that the Class 9 and 42 originate from the same source.

DECISION:

1. Application Serial No. 78380877: The Opposition No. 91167886 is sustained as to Class 42 and dismissed as to Class 35. Accordingly, Registration is refused in Application Serial No. 78380877 with respect to the services in International Class 42. The International Class 35 services will proceed to registration.

2. Application Serial No. 78258431: The Opposition No. 91170726 is sustained as to Class 9 and dismissed as to Class 35. Accordingly, Registration is refused in Application Serial No. 78258431 with respect to the services in International Class 9. The International Class 35 services will proceed to registration.

3. Registration No. 2499396: The Petition to Cancel No. 92046567 is dismissed.