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Mailed: March 31, 2004
Paper No. 30
PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Sharp Kabushiki Kaisha, a/t/a Sharp Corporation

v.

ThinkSharp, Inc.

Opposition No. 91118745
to application Serial No. 75652878
filed on February 26, 1999

Robert W. Adams and Duane M. Byers of Nixon & Vanderhye P.C.
for Sharp Kabushiki Kaisha a/t/a Sharp Corporation.

Sherry H. Flax of Saul Ewing LLP for ThinkSharp, Inc.

Before Seeherman, Hairston and Chapman, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

An application has been filed by ThinkSharp, Inc. to register the mark THINKSHARP (in typed form) for "computer software for use as education programs in the fields of problem solving and critical thinking, pre-recorded videocassette tapes featuring education programs in the field of problem solving and critical thinking; and CD-ROMS containing education programs" in class 16; and "educational

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services, namely providing information, conducting educational seminars and distributing education materials via classroom instruction, the global computer information network and satellite transmission, in the fields of problem solving and critical thinking" in class 41.¹

Registration has been opposed by Sharp Kabushiki Kaisha, a/t/a Sharp Corporation (Sharp). Sharp alleges that it is the owner of the previously used and registered mark SHARP, and a family of SHARP marks; that it has continuously used its marks in connection with "an extremely wide variety of electrical and/or electronic products in the computer field and in connection with related educational services"; that by virtue of its extensive use and advertisement of its mark SHARP and its family of SHARP marks, these marks have become famous; and that applicant's mark, when used on or in connection with applicant's goods and services, so resembles

¹ Serial No. 75652878, filed February 26, 1999, alleging first use anywhere and first use in commerce as early as December 1998.

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opposer's previously used and registered mark SHARP and SHARP family of marks, as to be likely to cause confusion.²

Opposer pled ownership of eighteen registrations, the most pertinent of which is Registration No. 1,405,542 for the mark SHARP for "electrical and electronic goods, namely, copiers; printers; computers; cash registers; calculators; radios; television sets; solar cells; video cassette recorders; video cassette players; video cameras; combined television, radio and/or stereo sound players and recorders; closed circuit television recorders and players; audio sound amplifiers; tuners; tape and cassette decks; disc players; turntables and speakers; audio cassette tape recorders; combined radio and audio cassette tape recorders and players; car radios, tuners, amplifiers, speakers and audio cassette decks; vacuum cleaners for domestic and commercial use, and electronic translators, and parts therefor." (This registration issued August 19, 1986; Section 8 affidavit accepted; Section 15 affidavit acknowledged.)

² The notice of opposition also includes an allegation that "the registration of the mark THINKSHARP by applicant is likely to injure and/or dilute the strength of opposer's aforesaid trademarks and its related goodwill." (Par. 8). Such an allegation is insufficient to state a claim of dilution under the Federal Trademark Dilution Act, 15 U.S.C. §1125(c), because opposer failed to plead that its marks became famous in connection with its goods and services prior to applicant's use of its mark. *Toro Co. v. ToroHead, Inc.*, 61 USPQ2d 1164 (TTAB 2001). Except for a concluding sentence in its brief on the case, opposer did not argue or discuss dilution. Thus, to the extent that it could even be considered a valid claim, which it is not, we deem it waived.

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Applicant, in its answer, denied the salient allegations in the notice of opposition.

The record consists of the pleadings; the file of the opposed application; and opposer's notice of reliance on photocopies of its pleaded registrations³, the file contents of Opposition No. 91123480 which involved the parties, and applicant's responses to opposer's requests for admissions, submitted during opposer's testimony-in-chief. In addition, applicant submitted under notice of reliance, excerpts from the testimony deposition (with exhibits) of its president Michael Navin; third-party registrations of marks which include the word "SHARP"; opposer's responses to applicant's interrogatories; applicant's responses to opposer's

³ Trademark Rule 2.122(d)(2) permits a party to make a registration it owns of record "by appropriate identification and introduction during the taking of testimony or by filing a notice of reliance, which shall be accompanied by a copy (original or photocopy) of the registration prepared and issued by the [USPTO] showing both the current status and title to the registration." The documents are not status and title copies required by Trademark Rule 2.122(d). Although we note opposer's statement that it placed an order with the USPTO for such copies, the Board's rules of practice no longer allow a party to make a registration of record in this manner. However, we have considered the testimony of opposer's witness and determined that the pleaded registrations are owned by opposer and are valid and subsisting.

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interrogatories, documents produced by opposer; and documents produced by applicant.⁴ Finally, opposer submitted the rebuttal testimony deposition (with exhibits) of its vice president and general counsel Donald P. Mossman; and a rebuttal notice of reliance on documents from Opposition No. 91123480 and excerpts from the testimony deposition of applicant's witness Mr. Navin.⁵ The parties have briefed the case, but did not request an oral hearing.

Before turning to the record herein, we note that opposer, for the first time in its brief on the case, argues that registration of applicant's application is

⁴ We note that applicant's notice of reliance was technically untimely. Further, certain of the materials accompanying applicant's notice of reliance are not proper subject matter therefor. Also, applicant should have filed the entire testimony deposition of its witness, Mr. Navin. See Trademark Rule 2.123(h). In any event, in its brief on the case opposer lists in its description of the record, "documents and information submitted by applicant with its notice of reliance." Thus, we consider opposer to have stipulated applicant's notice of reliance into the record.

⁵ Opposer's request for an extension of its rebuttal testimony period is granted and its rebuttal testimony deposition and rebuttal notice of reliance are considered timely filed. We note that much of the testimony of opposer's witness, Mr. Mossman, was more appropriate for its testimony-in-chief. Although applicant's counsel objected during the deposition to certain aspects of the testimony on the ground that it was not in the nature of rebuttal testimony, applicant did not renew the objection in its brief. Thus, we consider applicant's objection to be waived.

Finally, with respect to the excerpts of the Navin deposition submitted under opposer's rebuttal notice of reliance, because applicant failed to submit the entire deposition, we will treat these excerpts of record although trial testimony is generally not proper subject matter for a notice of reliance.

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barred by res judicata (claim preclusion) in view of Opposition No. 91123480 which also involved the parties to the present proceeding. Opposition No. 91123480 involved applicant's application Serial No. 75721542 to register the mark THINKSHARP and design for goods and services which are identical to those in the application involved herein. Default judgment was entered against applicant for failure to file an answer therein. It is opposer's position that the judgment in Opposition No. 91123480 operates as res judicata herein because the marks are virtually identical and the goods and services are the same.

Under the doctrine of res judicata or claim preclusion, the entry of a final judgment on the merits of a claim in a proceeding serves to preclude the relitigation of the same claim in a subsequent proceeding between the parties or their privies, even in those cases where the prior judgment was the result of default. One of the purposes of res judicata is to promote judicial economy by preventing repetitive litigation. Clearly, this purpose was not served here because at the time opposer first raised this argument, i.e., in its brief on the case, the trial had been completed. In view thereof, and inasmuch as opposer failed to put applicant on notice that it intended to rely on the asserted res judicata effect of the prior proceeding,

opposer is considered to have waived any right to assert res judicata.

We turn then to the record of this case. Donald Mossman, opposer's vice president and general counsel, testified that opposer sells between 30 and 40 different product lines in the United States, including a full range of video and audio equipment, under the mark SHARP. Among the products opposer sells are computers, monitors, multifunction printer/copiers, duplicating equipment, projectors, PDA's, microwaves, televisions, and electrical components for use in finished products. According to Mr. Mossman, opposer has also used the SHARP mark on computer software which is used in connection with training dealers and service technicians. This particular software is not for consumer use. Mr. Mossman testified that opposer has also used the marks SHARPVISION, BE SHARP, and FROM SHARP MINDS COME SHARP PRODUCTS, but the latter slogan is no longer actively used.⁶ Opposer sells its products to individual consumers and businesses.

According to Mr. Mossman, studies have shown that opposer's SHARP mark has a high level of consumer recognition and Forbes magazine has ranked opposer 17th in

⁶ Although the record shows that opposer owns a registration for the mark SHARPVISION, there is no evidence that the marks BE SHARP and FROM SHARP MINDS COME SHARP PRODUCTS are registered.

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brand recognition in the broad field of electronics and electrical equipment based on worldwide sales.

Over the past seven years, opposer's U.S. sales have amounted to approximately \$3 billion annually and its advertising expenditures have been approximately \$60,000,000 annually.

Further, opposer actively polices its SHARP mark by filing oppositions and other legal proceedings.

Applicant's president, Michael Navin, testified that as of March 2003, applicant had used its THINKSHARP mark for approximately four years. According to Mr. Navin applicant's products and educational services are designed to develop individuals who are problem solvers and critical thinkers. Applicant's goods and services are sold to teachers and administrators, from the middle school level through college. Applicant offers a limited number of courses to corporations. Applicant sells its goods and services through independent sales representatives and by mailings to individuals in the education field. Applicant promotes its goods and services at trade shows. According to Mr. Navin, applicant first marketed its goods and services under the mark "ThinkSmart", but as the result of a legal challenge," applicant changed its mark to THINKSHARP.

There is no dispute as to opposer's priority in view of the testimony of opposer's vice president and general

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counsel, Mr. Mossman, that the pleaded registrations are owned by opposer and are valid and subsisting. *King Candy Co. v. Eunice King's Kitchen, Inc.* 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

We turn first to opposer's contention that it owns a family of marks characterized by the term SHARP. The "family" of marks doctrine has applicability in those situations where the plaintiff had established a family of marks characterized by a particular feature, so that the defendant's subsequent use of its mark containing the feature will cause the relevant purchasing public to assume that defendant's mark is yet another member of the plaintiff's family. See *Blansett Pharmaceutical Co. Inc. v. Camrick Laboratories Inc.*, 25 USPQ2d 1473 (TTAB 1992); *Econo-Travel Motor Hotel Corp. v. Econ-O-Tel of America, Inc.*, 199 USPQ 307 (TTAB 1978); and *Porta-Tool, Inc. v. DND Corp.*, 196 USPQ 643 (TTAB 1977).

It is well settled that merely adopting, using and registering a group of marks having a feature in common for similar goods or related goods or services is insufficient to establish, as against a defendant, a claim of ownership of a family of marks characterized by the feature. Rather, it must be demonstrated that prior to defendant's first use of its challenged mark, the various marks said to constitute the family, or at least a good number of them, were used and

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promoted together in such a manner as to create among purchasers an association of common ownership based upon the family characteristic. See *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *Hester Industries Inc. v. Tyson Foods Inc.*, 2 USPQ2d 1646 (TTAB 1987); and *Cambridge Filter Corp. v. Sensodyne Corp.*, 189 USPQ 99 (TTAB 1975).

In the present case, opposer's claim that it owns a family of SHARP marks has not been proved. The evidence introduced by opposer consists of copies of its registrations for the marks SHARP, SHARP CORPORATION and SHARPVISION; printouts from the Sharp USA website; photographs of individual SHARP products, and a large number of promotional materials for individual SHARP products. Several of the promotional materials bear the mark SHARP along with the phrase FROM SHARP MINDS COME SHARP PRODUCTS. There is insufficient evidence relating to opposer's use and advertising of its marks together such that we can conclude that the relevant purchasing public has come to identify SHARP as the "surname" of a family of marks. The mere fact that opposer uses marks that consist of or include SHARP does not in itself prove that a family of marks exists. Thus, at least on the record before us, opposer has failed to establish purchaser recognition of a family of marks owned by it.

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This brings us to the issue of likelihood of confusion. The most pertinent of opposer's marks is the mark SHARP, the strongest of opposer's marks by reason of opposer's extensive use and promotion thereof, and the mark to which most of opposer's evidentiary record is devoted. Although opposer's registrations for the mark SHARP cover a wide range of electrical and electronic products, in its brief on the case opposer focused its arguments on the relationship between its computers, videocassette players, and CD-ROM players and the goods and services in applicant's application. Thus, we focus our likelihood of confusion determination on whether applicant's use of the mark THINKSHARP for the goods and services identified in applicant's application is likely to cause confusion with opposer's mark SHARP for computers, videocassette players, and CD-ROM players.

Our likelihood of confusion determination is based on an analysis of all of the probative facts in evidence that are relevant to the likelihood of confusion factors set forth in *In re E. I. duPont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

At the outset, we acknowledge that the substantial sales and advertising by opposer of its SHARP brand products, and the many years opposer has continuously used such marks for a variety of electrical and electronic

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products, establish the fame of the mark.⁷ The fame of opposer's mark entitles it to a broad scope of protection against competing marks. See *Nina Ricci S.A.R.L. v. E.T.F. Enterprises*, 889 F.2d 1070, 1074, 12 USPQ2d 1901, 1904 (Fed. Cir. 1989). Thus, this *duPont* factor favors opposer.

Nonetheless, based upon careful consideration of the record and arguments before us, we find that the marks SHARP and THINKSHARP, when considered in their entireties, are not similar in appearance, pronunciation, connotation or commercial impression and that opposer's goods are not commercially related to the goods and services set forth in applicant's application such that the use of these marks in connection with the respective goods and services would be likely to cause confusion.

We consider first the marks in terms of appearance and sound. We find that applicant's mark THINKSHARP and opposer's mark SHARP obviously are similar to the extent that they both consist of or include the word SHARP. However, the marks look and sound dissimilar to the extent that applicant's mark includes the word THINK while opposer's mark does not. In terms of connotation, we find that the word SHARP in opposer's mark, as applied to opposer's goods, would be understood to mean, or refer to

⁷ Also, we note that applicant admits in response to opposer's Request For Admission No. 37 that "opposer is a well known

opposer itself. We base this conclusion on the fact that opposer's trade name is Sharp Corporation.

We find that the word SHARP, as used in applicant's mark and as applied to applicant's goods and services would be understood to have the meaning set forth in The American Heritage Dictionary of the English Language (4th ed. 2000) as entry number 1, i.e., "intellectually penetrating, astute."⁸ Considering applicant's mark THINKSHARP in its entirety as applied to applicant's goods and services, we find that the mark connotes sharp or clear thinking. We disagree with opposer's conclusory argument that the mark connotes "think of Sharp," i.e., opposer.

We find that the differences in the marks' connotation clearly and significantly weighs against a finding that the marks are confusingly similar. See, e.g., *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459 (Fed. Cir. 1998)[CRYSTAL CREEK for wine has different connotation from CRISTAL for champagne; marks found to be dissimilar]. Having considered the marks in their entireties in terms of appearance, sound and connotation, we find that they are dissimilar in their

company in the United States to consumers of electronic products."

⁸ The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 584, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

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overall commercial impressions. The mere presence of the word SHARP in both marks is not sufficient to render the marks similar, especially in view of the fact that the word presents a different meaning and commercial impression in each mark, as applied to the respective goods and services. In view of the foregoing, this *duPont* factor favors applicant.

We turn next to a consideration of the parties' goods and services. Opposer argues that they are related because they travel in the same channels of trade to the same class of purchasers; and that applicant's computer software, videocassettes and CD-ROMS may be used in opposer's computers, videocassette players, and CD-ROM players.

Inasmuch as applicant's application contains no limitations with respect to channels of trade and classes of purchasers for the goods therein, we must presume that applicant's goods are sold in all the normal channels of trade to all of the usual purchasers. Thus, for purposes of our likelihood of confusion analysis, we must assume that both parties' goods (i.e., opposer's computers, videocassette players, and CD ROM players and applicant's educational computer software, videocassette tapes, and CD-ROMS) are sold in mass merchandisers and electronic stores, and through the Internet to ordinary consumers. Nonetheless, this record does not contain evidence or

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testimony upon which we could base the conclusion that consumers would assume that computers, videocassette players and CD-ROM players, on the one hand, and educational computer software, videocassettes featuring educational programs, and CD-ROMS containing educational programs, on the other hand, are offered by the same entity. Simply because applicant's goods may be used in opposer's goods is not a sufficient basis to find that the goods are related. Opposer's goods are hardware, while applicant's goods are bought for the content contained in the physical object. There is no evidence that these kinds of goods commonly emanate from the same sources.

Similarly, opposer has failed to establish on this record any relationship between its computers, videocassette players and CD-ROM players, and applicant's educational services in the field of problem solving and critical thinking. We note that because applicant's application contains specific limitations as to channels of trade with respect to the services therein, i.e., classroom instruction, the global computer network, and satellite transmission), the only overlapping trade channel for opposer's goods and applicant's services is the Internet. However, inasmuch as thousands of goods and services are offered through the Internet, the mere fact that both opposer's goods and applicant's services are offered through

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the Internet to ordinary consumers is certainly not a basis to find that they are related within the meaning of the Trademark Act. Simply put, opposer had the burden of proving that its goods and the goods and services set forth in applicant's application are related, but opposer has not met this burden. This *duPont* factor favors applicant.

We should point out that applicant's argument concerning the existence of third-party registrations of SHARP marks is not a reason we are ruling in applicant's favor. Applicant has submitted copies of third-party registrations of marks which include the word SHARP for goods and services in the computer and/or electronics field. Third-party registrations may, in appropriate circumstances, show the meaning of a mark or a portion of a mark in the same way that dictionaries are employed. See *Tektronix, Inc. v. Daktronics, Inc.*, 187 USPQ 588, 592 (TTAB 1975), *aff'd*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976). However, the third-party registrations submitted by applicant are not particularly probative of the meaning of opposer's SHARP mark because, as we have indicated, opposer's mark would be understood to mean or refer to opposer. Thus, we do not view the third-party registrations as indicating that opposer's SHARP mark has a suggestive connotation or is otherwise weak. Moreover, any asserted weakness in

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opposer's mark is overcome because opposer's SHARP mark is famous.

Although we have given opposer's mark the significant weight that must be accorded to famous marks, in view of the cumulative differences in the marks SHARP and THINKSHARP and the parties' respective goods and services, confusion is not likely.

Decision: The opposition is dismissed.