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File Entry
No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Think Computer Corporation
v.
H. Co. Computer Products, Inc.

Opposition No. 91125553
to application Serial No. 76201442
filed on January 29, 2001

John Pickerill and Molly O'Brien Loussaert of Fredrikson & Byron, P.A. for Think Computer Corporation.

Thomas M. Small and J. Alison Grabell of Birch, Stewart, Kolasch & Birch, LLP for H. Co. Computer Products, Inc.

Before Simms, Rogers and Drost,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

H. Co. Computer Products, Inc. [applicant] has applied to register the mark below for various computer products.¹



¹ The goods are identified as "computers, computer hard disks, computer video cards, computer fax/modems, computer motherboards, computer disk drives, computer cables, computer drive disc drive controllers, computer monitors, computer cases, computer keyboards, computer mice, computer speakers," in Class 9.

Opposition No. 91125553

The application is based on applicant's claim of first use of the mark, and first use of the mark in commerce, as of February 18, 2000. The application includes a disclaimer of any exclusive right to use "computer products" apart from the mark as shown.

Registration of the mark has been opposed by Think Computer Corporation [opposer], on a claim that it "is the owner of the common law trademark THINK COMPUTER for computer programs, computers, computer peripherals and personal digital assistants for business, entertainment, scientific, technical, commercial, educational and personal uses, in the fields of operating systems, database systems, word processing, scheduling, electronic mail, spreadsheets, presentations, network browsing and instructional manuals distributed therewith"; that it has "extensively and continuously" used the trademark THINK COMPUTER since long prior to the date of first use claimed by applicant in the opposed application, specifically, "since at least as early as May 2, 1997"; that it has filed an application for registration of its mark²; and that there is a likelihood of confusion among consumers, or that they will be mistaken or

² The application was filed January 2, 2002, has been assigned serial no. 78100628, and asserts May 2, 1997 as the date of first use and first use in commerce of opposer's mark. The mark in the application includes a design element and a disclaimer of exclusive rights in the term "computer." The application is currently in suspension.

deceived, in view of the contemporaneous use of the marks of applicant and opposer. Opposer also asserts that, by virtue of its advertising and promotion of its mark, "the public has come to recognize Opposer's mark as signifying Opposer's goods and Opposer," and that use by applicant of its mark would "lessen the capacity of Opposer's THINK COMPUTER mark to identify and distinguish goods made by opposer."

Applicant denied, expressly or effectively, the critical allegations in the notice of opposition. Further, in denying opposer's allegation of prior use, applicant also denied that the date of first use it claimed in its application "is the first use date of the words THINK! COMPUTER PRODUCTS."³ Answer, ¶ 3. Also relevant to the issue of priority, applicant asserted the following as an affirmative defense: "Applicant has used the name and mark THINK COMPUTER for products in International Class 9 since long prior to Opposer's claimed first use of THINK COMPUTER on May 2, 1997. Applicant has superior rights to any rights that Opposer could have in a THINK COMPUTER mark." Answer, ¶ 9.

Discovery and trial was followed by briefing of the issues. Neither party requested an oral hearing.

³ While the words in applicant's mark could be read as THINK COMPUTER PRODUCTS! (exclamation point at the end) or THINK! COMPUTER PRODUCTS (exclamation point following THINK), applicant refers to the mark in the latter form. So have we.

Opposition No. 91125553

The record includes the involved application, each party's responses to the other's interrogatories, opposer's responses to applicant's requests for admissions, and the trial testimony with exhibits from two witnesses. Aaron Greenspan, opposer's president and chief executive officer testified for opposer; Saed Hojreh, applicant's secretary, testified for applicant.

In each party's description of the record, it states that opposer's pending application is a part of the record. Neither party put in by notice of reliance a copy of the application file's contents, certified by the USPTO, and we presume the parties are referring to the copy introduced as an exhibit to the testimony of opposer's witness. Also, in its description of the record, applicant lists copies of two registrations assertedly owned by applicant for marks similar to that in the involved application. We have not, however, found these among the exhibits to applicant's testimony or submitted by notice of reliance. To the extent applicant intended to pursue a Morehouse⁴ defense based on its ownership of these registrations, it did not place opposer on proper notice thereof through its answer⁵, and

⁴ Morehouse Manufacturing Corporation v. J. Strickland and Company, 407 F2d 881, 160 USPQ 715 (CCPA 1969).

⁵ Of three paragraphs listed under the heading "Affirmative Defense" in applicant's answer, the one mentioning these registrations states only "Applicant is the owner of Registrations No. 2,558,495, issued April 9, 2002, for THINK!"

did not discuss such a defense in its brief. Accordingly, any inchoate Morehouse defense has been waived.

Applicant "concedes for the purposes of this proceeding that there is a likelihood of confusion between the name THINK COMPUTER and the mark THINK! COMPUTER PRODUCTS based on the similarities between the marks and the relatedness of the respective goods." Brief, p. 12.⁶ Opposer agrees with applicant. Reply brief, p. 1. We view applicant's concession as essentially acknowledging the very similar nature of the involved marks and that, when both are used on computer goods, there will be a likelihood of confusion.

We agree that there can be no serious dispute about likelihood of confusion under such circumstances. Moreover, as revealed by our discussion, *infra*, about the nature and extent of opposer's use of its mark, much of opposer's commercial activity has been focused on computer repair and consulting services. We conclude that there would be a likelihood of confusion even if use of opposer's mark were limited to these services. In fact, opposer has put into the record evidence of actual confusion. In view of

NETWORKING PRODUCTS and No. 2,561,585 for THINK! MEMORY PRODUCTS for related products."

⁶ In regard to similarity of the marks, applicant appears to have changed its position since it filed its answer. In its answer, applicant asserted, under the heading "Affirmative Defense," that "Applicant's mark here sought to be registered is a composite mark including distinctive design components that warrant the registration of Applicant's mark."

applicant's concession and our conclusion that the marks are so similar that their use on or in connection with competitive computer products, or with such products and related computer services, would be likely to cause confusion, we now turn to the central issue in this case. That is the issue of priority.

While the parties, in essence, agree that there is a likelihood of confusion, they disagree as to precisely what mark or marks should be the focus of our priority analysis. In its main brief, opposer argues that it "began using its mark THINK COMPUTER more than three years before Applicant began using its design mark THINK! COMPUTER PRODUCTS in connection with the same goods and services." Brief, p. 13. Applicant, in its main brief, asserts, "[t]he record shows that the parties have disregarded the design portion of Applicant's mark because the 'THINK' word portion of the parties' respective marks is dominant." Brief, p. 4. In support of its argument, applicant cites to a section of opposer's main brief that involves a discussion of likelihood of confusion and argues that confusion is likely in large part because the term THINK is a dominant element of each party's mark. We do not believe that opposer's discussion of the involved marks, in the context of its presentation of arguments on likelihood of confusion and prior to applicant having conceded that issue, amounts to a

Opposition No. 91125553

concession that whichever party can show first use of the term THINK alone should prevail on the issue of priority. In this regard, we note opposer's focus, on pages 13-14 of its main brief, on applicant's "design mark THINK! COMPUTER PRODUCTS" and "THINK! COMPUTER PRODUCTS mark in Application Serial No. 76/201442." We also note opposer's reply brief, which asserts, "Opposer agrees that the remaining issue is one of priority but that this inquiry depends upon the Applicant's use of the THINK! COMPUTER PRODUCTS design mark..." Reply brief, p. 1.

In essence, opposer disagrees that, in terms of priority, applicant can attempt to tack the involved THINK! COMPUTER PRODUCTS design mark onto earlier use by applicant of THINK or THINK COMPUTER without the "Thinker" and stylized exclamation point design elements for the same or similar goods. We agree with opposer that the case law is clear on this point. Even when marks may be confusingly similar--and we accept for the purposes of this discussion that THINK or THINK COMPUTER without a design and applicant's involved THINK! COMPUTER PRODUCTS design mark would be likely to cause confusion when used on the same or very similar goods or services--it does not necessarily follow that they are legal equivalents that can be tacked one onto the other. See Lincoln Logs Ltd. v. Lincoln Pre-Cut Log Homes Inc., 971 F2d 732, 23 USPQ2d 1701, 1704 (Fed.

Cir. 1992) and Van Dyne-Crotty, Inc. v. Wear-Guard Corp., 926 F.2d 1156, 17 USPQ2d 1866, 1868 (Fed. Cir. 1991) ("[F]or the purposes of 'tacking,' even if the two marks are confusingly similar, they still may not be legal equivalents. Instead, the marks must create 'the same, continuing commercial impression.'"); see also, Pro-Cuts v. Schilz-Price Enterprises Inc., 27 USPQ2d 1224, 1227 (TTAB 1993) ("In short, although we agree that these marks are confusingly similar, they clearly are not legal equivalents. Under the circumstances, applicant cannot tack onto its use of the mark 'PRO-CUTS' and design the earlier use of the mark 'PRO-KUT' and design.") (footnote in quoted material omitted) and Baroid Drilling Fluids Inc. v. Sun Drilling Products, 24 USPQ2d 1048, 1053 (TTAB 1992) ("For purposes of tacking, two marks are not necessarily legal equivalents merely because they are considered to be confusingly similar.").

The standard for tacking is strict and has been met only in rare instances. See Brookfield Communications Inc. v. West Coast Entertainment Corp., 174 F3d 1036, 50 USPQ2d 1545, 1552 (9th Cir. 1999) *citing* Van Dyne-Crotty, supra, and Baroid, supra.

Moreover, in this case, because applicant is attempting not only to tack but also to prove use long prior to the date of first use asserted in its involved application, any

evidence of use of a mark that would meet the strict requirements for tacking would have to be clear and convincing. See Hydro-Dynamics Inc. v. George Putnam & Co., 811 F.2d 1470, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987). Clear and convincing evidence, when provided through oral testimony, cannot be characterized by contradictions, inconsistencies or indefiniteness and "should carry with it conviction of its accuracy and reliability." Elder Mfg. Co. v. International Shoe Co., 194 F.2d 114, 92 USPQ 330, 332 (CCPA 1952).

Applicant's brief is not particularly clear and definite on its use of the applied for THINK! COMPUTER PRODUCTS (and design) mark. See, for example, pages 4-5, which discuss the evidence regarding use of THINK! NETWORKING PRODUCTS, THINK! MEMORY PRODUCTS, "the THINK mark," and "Applicant's THINK COMPUTER mark," but does not discuss what the evidence shows in regard to THINK! COMPUTER PRODUCTS (and design). The inconsistency and indefiniteness in the brief may be a byproduct of the indefiniteness of the testimony, and exhibits introduced thereby, of its witness.

Saed Hojreh, applicant's secretary, testified that "1993" was when applicant first used "the 'Think Computer' mark" on computers and that applicant has been using that mark continuously since then. Hojreh dep. pp. 8-9. He also testified that it is applicant's business practice to place

a label on its computers, that the label says "Think Computer Products," that a photograph showing a version of the applied for mark (the design element is shifted in position, appearing below THINK! and above COMPUTER PRODUCTS) depicts the label applicant uses, that applicant started placing labels on computers in 1993 and has continued to do so to this time. Id. p. 13.

During cross-examination, the witness acknowledged applicant's response to opposer's interrogatory no. 5, which states that applicant "claims rights in its 'Think' mark from at least as early as January 1995." Mr. Hojreh was the individual who attested to the accuracy of applicant's interrogatory responses. Also during cross-examination, Mr. Hojreh acknowledged what appeared to him to be "a letter that was written to the US PTO" by Gary Richardson of applicant⁷, and which lists April 28, 1998 as the date of first use of the applied for mark. Mr. Hojreh also acknowledged a printout showing a record regarding applicant's registration of the domain name "Thinkcomputerproducts.com" created on February 18, 2000, (the date of first use recited in applicant's application when filed). Finally, Mr. Hojreh acknowledged that the photographs of computer products bearing a version of the

⁷ Mr. Richardson is identified as applicant's director of marketing in applicant's response to opposer's interrogatory no. 2.

applied for mark are photographs of current products, not products produced in 1993.

During redirect examination, Mr. Hojreh testified that the interrogatory response he signed, which stated that applicant claimed rights in "its THINK marks from at least as early as January 1995," "means that we started at least as early as 1995, therefore, 1993, '92, '91. It's much earlier than 1995." Hojreh dep. p. 53. Also on redirect, Mr. Hojreh testified that the photographs of computer products showing a version of the applied for mark are current examples of a continuing business practice. Id. at 60-61.

We do not find the testimony of applicant's witness clear and convincing evidence that applicant used any particular version of the THINK! COMPUTER PRODUCTS (and design) mark on any particular date prior to the filing of its application. When filed, the application listed February 18, 2000 as the date of first use of the mark; this appears to be the date applicant obtained a domain name registration for Thinkcomputerproducts.com. At one point, applicant's director of marketing apparently prepared a filing for the USPTO that would have amended the date to April 28, 1998. Mr. Hojreh signed an interrogatory response (no. 5(b)) attesting to first use of "THINK" marks in 1995, without being specific as to a precise date or a precise

mark; and in response to an interrogatory (no. 8) that specifically requested the date of first use for each mark, merely referred back to the earlier response. Moreover, in his testimony concerning these responses, he testified vaguely as to use in "1993, '92, '91."

Exhibits to Mr. Hojreh's testimony show sales of what he testified were computer products as early as the months of January through March of 1993, with the invoices listing the designations THINK or THINK COMPUTER, and he testified that applicant's computer products have carried a THINK COMPUTER PRODUCTS label since 1993. On the other hand, there is no direct testimony that any such labels, other than those shown on current products, included the design elements included in the mark in the involved application, i.e., the figure of the "Thinker" and the stylized exclamation point. In short, there is no clear and convincing evidence of use of a mark, prior to the asserted date of first use, that is the legal equivalent of the applied for mark, and which the applied for mark can therefore be tacked onto for priority purposes.

Contrary to applicant's apparent conclusion otherwise, its burden as an applicant attempting to prove use earlier than its filing date is not discharged by providing evidence tending to show use merely of THINK or THINK COMPUTER by a preponderance of the evidence. If it were in the position

of an opposer challenging Think Computer Corporation's application to register THINK COMPUTER (and design) it might be sufficient to show, by a preponderance of the evidence, prior use of THINK or THINK COMPUTER, but that is not applicant's position in this case.⁸

On the record in this case, we cannot say precisely when applicant began use of its THINK! COMPUTER PRODUCTS and design mark, and counsel taking the testimony of applicant's witness never asked the witness that specific question. The totality of the evidence suggests applicant likely adopted and first used that specific mark sometime in 2000. We need not determine exactly when, however, for it is clear from the record that opposer used its THINK COMPUTER mark prior to any possible date in 2000 on which applicant might be able to rely.

In reviewing evidence of opposer's use, we are mindful that opposer pleaded in its notice of opposition that it "is the owner of the common law trademark THINK COMPUTER." Thus, in attempting to prove its priority, opposer may rely

⁸ In footnote two of its main brief, applicant asserts that opposer's suspended application "should be finally refused registration." That is not a question before us in this proceeding. If opposer is ultimately successful in this opposition, and applicant is refused registration of the specific mark in the involved application, and if the examining attorney does not finally refuse registration to opposer, applicant will have the option of opposing opposer's application. In such a case, applicant will bear a burden of proving, by a preponderance of the evidence, any claim why opposer's mark should not be registered.

on, and we have reviewed the record for, opposer's earliest use of THINK COMPUTER, regardless of whether it was used in conjunction with the design element that is included in the mark in opposer's suspended application.⁹

We also note that opposer asserted in its pleading that it used its common law mark prior to applicant for certain specified products, primarily items of computer hardware, but also for computer software. Opposer did not plead that it used its mark prior to applicant for any services in the computer field, for example, for repair services, consulting services, web page design services, or the like.

Nonetheless, the testimony and exhibits of opposer's witness are replete with discussion of opposer's business as a service business and as involved in the sale of computer products as a reseller, not a manufacturer. Applicant, in its brief, acknowledged that the evidence shows that "Opposer primarily provides services under the Think Computer name." Brief, p. 7. We find it clear from the record that evidence of opposer's use of THINK COMPUTER as a

⁹ We have not, however, given any weight to evidence of record showing opposer's use of THINK! TECHNOLOGIES or THINK! INTERNATIONAL. Just as applicant cannot tack its applied for THINK! COMPUTER PRODUCTS and design mark onto earlier use of THINK or THINK COMPUTER, because the latter are not legal equivalents of the former, opposer cannot rely on its prior use of THINK! TECHNOLOGIES or THINK! INTERNATIONAL. Opposer did not plead them in its notice of opposition and, to the extent opposer believes it could tack them onto THINK COMPUTER, we disagree. Neither would be the legal equivalent of the pleaded common law mark THINK COMPUTER.

mark for various computer services was offered in support of opposer's case in chief, that applicant did not object thereto, and that the issue was tried by the implied consent of the parties.¹⁰ The fact that no motion has been made to amend the pleadings to conform to the evidence presented at trial does not preclude our consideration of the issues as tried. Accordingly, we deem the pleadings to have been amended to assert prior use by opposer of the THINK COMPUTER mark for various computer services, in addition to the express pleading of prior use of the designation as a mark for various computer products. See Fed. R. Civ. P. 15(b) and authorities collected in TBMP Section 507.03(b) (2d ed. June 2003).

Opposer asserts in its brief that testimony shows it has used the THINK COMPUTER mark since November 17, 1996, but counsel misstates the import of the Greenspan testimony about what happened on that date. All the witness testified to was that, on that date, he discussed with his aunt her recommendation that he change his mark from THINK! INTERNATIONAL to something else. There is no evidence that

¹⁰ There is no question that applicant was fairly apprised of the issue of opposer's use of the THINK COMPUTER mark for services, both through opposer's direct testimony and on cross examination. See, for example, page 54 of the Greenspan deposition, where, during cross examination on the subject of opposer's mark clearance search, the witness testified that he requested that his counsel "check both for a service mark and trademark - existing one - on Think Computer; that he look first for a service mark, since I would primarily be providing services related to computers to my customers."

Opposition No. 91125553

opposer first used its pleaded mark on that date, notwithstanding opposer's claim to that date in its responses to applicant's interrogatories.

Opposer's application to register a THINK COMPUTER (and design) mark claims May 2, 1997 as the date of first use and first use of that mark in commerce. However, during cross-examination on this topic, Mr. Greenspan testified that that date was incorrect and admitted "I do not know the correct date because I do not recall exactly when I began using the name Think Computer or even Think; though, I do know that it was in October, or even late September, of 1995." Greenspan dep. p. 61. The record is clear that the references in this testimony to "October, or even late September, of 1995," are references to use of THINK in some form, but not THINK COMPUTER.

One of the exhibits introduced during the Greenspan testimony (during direct examination) is a cease and desist letter sent to applicant by Mr. Greenspan. In that letter, opposer asserts "We began using the name 'Think Computer' in interstate commerce in 1997. Think Computer Corporation was incorporated on April 29, 1998. We processed our first purchase order for custom-built personal computers on July 19, 1998." Greenspan dep. exh. 8 (opposer's production number TCC 00365).

Opposition No. 91125553

Exhibit 3 to the Greenspan deposition includes reprints of numerous articles written about opposer's president, as a young entrepreneur. There are articles dated in 1998, 1999 and 2000, and they generally identify Mr. Greenspan's company as THINK COMPUTER. For example, the company received coverage in the Christian Science Monitor in July 1999 and Crain's Cleveland Business in January 2000.

Exhibit 7 to the Greenspan deposition includes two invoices on THINK COMPUTER forms, showing the THINK COMPUTER mark with a "TM" designation (opposer's production numbers TCC 00229 and 00230). These invoices are dated December 6, 1997 and December 7, 1997, respectively. Exhibit 7 also includes invoices dated in September 1998 and February 1999 for work done by opposer for Keene Advertising, a copy of a December 17, 1998 purchase order for products from Gateway Business, and a subsequent bill to Think Computer from Gateway Business for products apparently resold by opposer as part of its work for Keene Advertising. All these documents bear the THINK COMPUTER mark. There are also numerous other bills and invoices bearing the THINK COMPUTER mark evidencing work performed at various times in 1998, 1999 and 2000.

Exhibit 9 to the Greenspan deposition includes correspondence and forms relating to a donation of computer network consulting services to a fund-raising silent

Opposition No. 91125553

auction, made under the THINK COMPUTER mark. Opposer's production number TCC 00392 is a copy of a letter after the auction, dated April 20, 1998, addressed to opposer and thanking opposer for the donation. There is also a rate sheet with the THINK COMPUTER mark, listing various services offered by opposer and comparing opposer's rates to those of a competitor; the sheet reads, in part, "Rates effective as of August 1, 1998." Exhibit 9 also includes various letters dated in 1998 and 1999 and addressed to THINK COMPUTER or THINK COMPUTER CORP, and which recount delivery of services by opposer.

Considering all the foregoing as a whole, these pieces of evidence fit together to establish opposer's use of THINK COMPUTER for various computer related services and reselling of computer hardware and software items, from at least as early as December 6 and 7, 1997, i.e., a point well prior to the filing date of applicant's application and well prior to any date in the year 2000 on which applicant might be able to prove adoption and use of the applied for mark. West Florida Seafood Inc. v. Jet Restaurants Inc., 31 F.3d 1122, 31 USPQ2d 1660, 1663 (Fed. Cir. 1994).

Decision: The opposition is sustained and registration to applicant is refused.