

Oral Hearing:  
May 8, 1997

Paper No. 29  
GDH/gdh

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FEB. 24, 98

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Michael W. Wyckoff  
v.  
Rick E. Briggs

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Concurrent Use No. 1,007

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James C. Wray and Paul J. Riley, Esqs. for Michael W. Wyckoff.  
Thomas A Briggs of Jones, Day, Reavis & Pogue for Rick E. Briggs.

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Before Quinn, Hohein and Hairston, Administrative Trademark  
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Michael W. Wyckoff has filed an application for concurrent use registration of the mark "RENT-A-NERD" for "temporary employment services for computer specialists".<sup>1</sup> The application, which seeks registration for the geographical area consisting of all of the United States except for the State of Ohio, sets forth registrant, Rick E. Briggs, doing business as Rent-A-Nerd, as the exception to applicant's claim of the

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<sup>1</sup> Ser. No. 74/119,509, filed on November 30, 1990, which alleges dates of first use of March 15, 1989. The application was amended to one seeking a concurrent use registration on April 14, 1993.

exclusive right to use his mark in commerce. Registrant presently is the owner of a territorially unrestricted registration on the Principal Register for the mark "RENT-A-NERD" and design, as reproduced below,



the use and

sponse to the notice

995, has alleged

only contact between

was a telephone

contact initiated by applicant in late summer-early fall 1989, in which applicant asked registrant for permission to use the mark RENT-A-NERD, which was denied," and has denied that applicant is entitled to a concurrent use registration.

The record consists of registrant's statement; the application and registration files; the testimony, with exhibits, of applicant's witnesses Michael Wyckoff, Sharon Harshbarger and Gerry Datlow, all of which were submitted as applicant's case-in-chief;<sup>3</sup> and the testimony, with exhibits, of registrant's

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<sup>2</sup> Reg. No. 1,603,102, issued on June 19, 1990 on the basis of an application filed on September 12, 1989, which sets forth dates of first use of April 15, 1989; affidavit §8 accepted.

<sup>3</sup> It is noted that while applicant's counsel, at the conclusion of Mr. Wyckoff's deposition, "offer[ed] into evidence Exhibits 1 through 49" (Wyckoff dep. at 39), exhibits 45 through 49 thereof were never identified or otherwise testified to by the witness. Nevertheless, inasmuch as registrant, in his brief, has specifically referred to and treated applicant's exhibits 48 and 49 as being of record, we deem such exhibits to have been stipulated into the record pursuant to Trademark Rule 2.123(b). Accordingly, we have considered all of the exhibits offered by applicant with the exception of exhibits 45, 46 and 47. We hasten to add, however, that even if exhibits 45, 46 and

witness, Rick Eugene Briggs,<sup>4</sup> together with applicant's responses to certain of registrant's discovery requests, all of which were

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47 were considered to form part of record, our ultimate decision in this proceeding would be the same.

<sup>4</sup> Applicant, in his initial brief, has reiterated the request, which he first raised in a motion to strike filed on March 6, 1996, that "[t]he entire Briggs Deposition Transcript and Exhibits ... be disregarded." While the Board, in its April 19, 1996 order partially granting the motion to strike, did indeed find that providing notice of only two and one half days (essentially two business days) of Mr. Briggs' deposition was not reasonable, the Board allowed applicant until May 20, 1996 to request recall of the witness, at registrant's expense, for the purpose of cross-examination and redirect, thereby rectifying any prejudice to applicant as the result of the inadequate notice. With respect to specific objections raised by applicant, in his motion to strike, to the direct examination of Mr. Briggs, the Board's order stated that "[i]f Wyckoff still believes that any questions put to the witness during direct [examination] were objectionable, he may assert those objections on the record at the commencement of the rescheduled deposition." However, due to an obstinate dispute by the parties over who was to bear the expenses associated with recalling the witness for completion of his deposition as so ordered, the Board in an order issued on June 25, 1996 extended the period for such deposition, stating among other things that:

Accordingly, Wyckoff is allowed until July 25, 1996 in which to [request] recall [of] the witness for the purpose of cross-examination and redirect. Wyckoff's objections to Briggs' direct examination (filed March 6, 1996) are [again] noted. If Wyckoff still believes that any questions put to the witness during direct examination were objectionable, it must reassert those objections on the record at the commencement of the rescheduled deposition. Objections to the cross-examination or redirect examination must be asserted on the record at the proper time. The Board will rule on all objections at final hearing.

Applicant, in a communication received on July 3, 1996, asserted (but without requesting reconsideration) that "[t]he solution proposed by the ... Board was simply not a fair or workable solution" and that, "[a]s a consequence[,] Wyckoff has elected not to notice or take the continued Briggs deposition ... because Briggs would not agree to limit the redirect testimony to the scope of cross-examination." Applicant's mere speculation, however, that "[t]he net result of ... cross-examining Briggs ... would have been Wyckoff paving the way for Briggs to introduce new, albeit objectionable, testimony beyond the scope of cross-examination" not only appears to be unfounded, but, in any event, would have been easily remedied by applicant simply asserting an objection to any redirect testimony which improperly exceeded the scope of cross-examination. Consequently, in light of applicant's failure to avail himself of the full and fair opportunity provided by the Board to raise on the deposition record any objections to the direct examination of the witness and/or to cross-examine Mr. Briggs, the reiterated request in applicant's initial brief to strike

submitted as registrant's case-in-chief. Briefs have been filed and an oral hearing, attended by counsel for the parties, was held.

The principal issues to be determined herein are whether applicant, as the party having the burden of proof,<sup>5</sup> has met the jurisdictional requirement for a concurrent use proceeding;<sup>6</sup> and, if so, whether applicant, in order to be entitled to a concurrent use registration and a restriction of

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such deposition and the exhibits thereto is denied and the specific objections reasserted in such brief will not be given further consideration. Furthermore, and in any event, we agree with registrant that most of such objections are meritless and, even if we were to sustain the few remaining objections, our ultimate decision in this proceeding would be the same.

<sup>5</sup> Contrary to the contentions in applicant's initial brief, Trademark Rule 2.99(e) plainly provides that "[t]he applicant for a concurrent use registration has the burden of proving entitlement thereto" and that "[a] person specified as an excepted user in a concurrent use application but who has not filed an application shall be considered a party senior to every party that has an application involved in the proceeding." Trademark Rule 2.116(b) further provides that "[a] party that is a junior party ... in a concurrent use registration proceeding shall be in the position of plaintiff against every party that is senior, and the party that is a senior party ... in a concurrent use registration proceeding shall be a defendant against every party that is junior." Thus, inasmuch as applicant is the only party herein who has filed a concurrent use application, and since such application names registrant as an excepted user, it is clear that applicant is the junior party and, as the plaintiff, has the burden of proof, while registrant is the senior party and is in the position of defendant. See TBMP §1107.

<sup>6</sup> Section 2(d) of the Trademark Act states, in relevant part, that (**emphasis added**):

*Provided*, That if the Commissioner determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, **concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to (1) the earliest of the filing dates of the applications pending or of any registration issued under this Act ....**

registrant's registration, has satisfied his burden of showing that there will be no likelihood of confusion as a result of contemporaneous use by the parties of their respective marks for their respective services in their respective geographical areas.

According to the record, applicant is the self-described "[h]ead nerd of a company" which he owns "called 'Rent-A-Nerd'." (Wyckoff dep. at 3.) Such company, through which applicant and his staff of so-called "nerds"<sup>7</sup> currently provide computer consulting services on a temporary basis under the service mark "RENT-A-NERD," has been in existence since January 1989.<sup>8</sup> Formerly located in Falls Church, Virginia, applicant's company is presently based in Vienna, Virginia.

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<sup>7</sup> The Board, we note, may properly take judicial notice of dictionary definitions. See, e.g., *Hancock v. American Steel & Wire Co. of New Jersey*, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953) and *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). In this regard, we judicially notice that the term "nerd" is defined, for example, in The Random House Dictionary of the English Language (2d ed. 1987) at 1289 as slang meaning: "1. a stupid, irritating, ineffectual, or unattractive person. 2. an intelligent but single-minded person obsessed with an nonsocial hobby or pursuit: a *computer nerd*." Thus, while principally used as a pejorative or self-deprecating term, both applicant and registrant use the word "nerd" in the sense of its latter definition in an effort to convey an image of a person with a high degree of computer expertise.

<sup>8</sup> Although applicant testified that he operated his business as a sole proprietorship until sometime in 1990 and further indicated, among other things, that on June 20, 1989 he "registered a trading as Rent-A-Nerd [with the Arlington County, Virginia, Circuit Court] to change the county records from Michael Wyckoff to trading as Rent-A-Nerd" (Wyckoff dep. at 17) and that within a month later he had had an attorney register such name with the Virginia State Corporation Commission, it appears from a June 12, 1991 newspaper article that an increase in business brought about by the change of name from Michael Wyckoff Consulting to Rent-A-Nerd "led the small company to become incorporated as a temporary agency." (Applicant's Ex. 42.) In view thereof, and provided that applicant ultimately prevails herein, the application is remanded to the Examining Attorney for determination of how applicant maintains control over the nature and quality of the

Applicant claims to have first used the mark "RENT-A-NERD" on March 14, 1989, which is after he adopted the mark<sup>9</sup> and the day on which he began distribution of a computer-printed brochure he had just finished creating to provide prospective customers with information regarding the nature of his consulting business. Such marketing literature, which listed two telephone numbers (one in Virginia and the other in Maryland) covering the Washington, D.C. metropolitan area, basically advertised the availability of applicant's "new concept" in consulting services on an "as-needed basis." (Applicant's Ex. 5.)

In particular, applicant insists that he first used the brochure when he handed a copy thereof to Alex Kosorukov, "a man who was a *potential* client" (*emphasis added*), during a luncheon meeting at a restaurant on March 14, 1989 for the purpose of "discussing his needs and requirements." (Wyckoff dep. at 10.) Applicant's testimony, however, is silent as to the particulars of his discussion with Mr. Kosorukov, including whether any computer consulting services were actually rendered by applicant,

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services rendered under the mark and/or is otherwise the owner thereof. Trademark Rule 2.131.

<sup>9</sup> One of applicant's witnesses, Sharon Harshbarger, testified with respect to applicant's adoption of his mark that, in the early Spring of 1989, she was dating applicant, who she had met while "doing ballroom dancing"; that they "had volunteered to be in the Fairfax dance program"; that, during the course of "putting together a routine," they "were discussing Mike's company"; that, in particular, "he asked me to look over some text" for his original brochure; and that "the dance program was on the 14th of March and this [brochure] would have preceded it." (Harshbarger dep. at 4.) Specifically, and while plainly hearsay in part, Ms. Harshbarger further testified that "[w]e were working on the dance program and I remember being surprised prior to that day when Mike told me he had chosen the name Rent-A-Nerd and he insisted that was what he wanted to call it." (*Id.* at 4-5.)

and further testimony by applicant regarding subsequent meetings on March 21 and 27, 1989 likewise fails to disclose the substance of the conversations, other than the vague indication that "RENT-A-NERD" was discussed. Instead, as evidenced by a copy of an invoice introduced by applicant, the record shows that the earliest *documented* date on which applicant actually *rendered* any computer consulting services was May 21, 1989,<sup>10</sup> when for a fee of \$60.00 he provided Alex Kosorukov with a one-hour consultation concerning the selection of a personal computer.<sup>11</sup> Other invoices introduced by applicant demonstrate sales of computer consulting services in 1989 to Mr. Kosorukov on May 28, November 21 and

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<sup>10</sup> Applicant, ostensibly to substantiate the first use of his original brochure, offered the following testimony by Gerry Datlow:

Q. Are you familiar with Rent-A-Nerd and Michael Wyckoff?

A. Yes.

Q. Under what occasion did you first become aware of Rent-A-Nerd?

A. To the best on my recollection[,] sometime in March or early April of 1989 I was having computer problems and I bumped into a fellow I knew and I asked him does he know anyone that could help me and he showed me a brochure and it said Rent-A-Nerd and I looked at it and I wrote down the phone number. I called and the person who answered was Michael Wyckoff and he fixed my problem over the phone and that was late March or early April of 1989.

I remember the time because I was working on my income tax and I had just gotten a new computer at the end of that last year and I had that note in my file.

(Datlow dep. at 3-4.) We observe, however, that neither the "note" referred to by the witness as refreshing his recall, nor any other documents--such as a sales invoice--pertaining to the time frame in which the witness assertedly received assistance from applicant, were introduced by applicant in connection with Mr. Datlow's testimony.

<sup>11</sup> Counsel for registrant, at the oral hearing, conceded that May 21, 1989 is the earliest date proven by applicant with respect to an actual sale of applicant's services under the "RENT-A-NERD" mark.

December 12 as well as additional sales, commencing in mid-August and prior to December 9, of such services to various individuals and businesses located in Washington, D.C., the northern Virginia localities of Alexandria, Annandale, Arlington, Fairfax and Falls Church, and the suburban Maryland areas of Bethesda, Laurel and Rockville.

Applicant's first newspaper advertising of his computer consulting services began on July 6, 1989, when applicant ran an ad, prominently featuring the mark "RENT-A-NERD," under the listing of "Consulting" in the "Computer Services Directory" of the business section of the Washington Post. Since that time, applicant has continuously run the same or a substantially identical ad, which typically appears in the "Washington Business" section of such newspaper, on a weekly basis. Applicant has also advertised his "RENT-A-NERD" computer consulting services in other metropolitan Washington newspapers, including display ads in the October 16, 1989 issue of the Legal Times, the January 29, 1990 edition of the Washington Times, the November 25, 1990 issue of the Arlington Sun Gazette and the December 5 through 26, 1990 editions of the Sentinel. In addition, on October 3, 1989, applicant engaged the services of a commercial printer to produce a brochure for his "RENT-A-NERD" services. Like the graphic elements comprising registrant's mark, applicant's brochure, which is still in use, displays the term "RENT-A-NERD" adjacent to a drawing of a "nerd" figure, wearing eyeglasses and a pocket protector, who stands next to a computer terminal. Other promotional activity by applicant under

the "RENT-A-NERD" mark has consisted of running a full-page advertisement for his computer consulting services in the program for the Arlington Dance Theatre's production of The Nutcracker on December 16, 17 and 18, 1994.

Applicant and his "RENT-A-NERD" computer consulting services have received free publicity due, primarily, to the stereotypically humorous and catchy nature of the name. Besides an acknowledgment of "special thanks" to "Michael Wyckoff, our computer expert of Rent-A-Nerd in Vienna," which appeared in the program for a June 2 and 3, 1995 production by the Arlington Dance Theatre (applicant's Ex. 28), applicant and his business received nationwide publicity when they were mentioned in an article in the April 10, 1991 issue of the Wall Street Journal on the importance to a small company of selecting a memorable name for the business. Additional exposure for the "RENT-A-NERD" name beyond the Washington, D.C. metropolitan area was received during the period of October 8 through 10, 1992, when an Associated Press story on applicant and his "RENT-A-NERD" computer consulting business<sup>12</sup> appeared in such newspapers as the Lock Haven, Pennsylvania Express, the Baltimore, Maryland Evening Sun, the Saginaw, Michigan News, the State College, Pennsylvania Centre Daily Times and the Wilmington, North Carolina Morning Star, and was broadcast on radio station KPIX.

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<sup>12</sup> According to Mr. Wyckoff, the story was written by a reporter who contacted applicant after having seen applicant's display ad for his "RENT-A-NERD" services in the Washington Post.

In the Washington, D.C. metropolitan area, the same Associated Press story ran in the October 9, 1992 edition of the Washington Times. Prior thereto, articles about applicant and his "RENT-A-NERD" computer consulting services had appeared in the business section of the Journal newspaper on both June 12, 1991 and June 2, 1992, while other stories ran in such regional publications as the March 23, 1992 issue of the Montgomery County Business Record and the September 1992 edition of Virginia Business. Applicant and the name of his business have also been mentioned in connection with an advertising testimonial distributed by the Washington Post and in local newspaper stories appearing in the September 12, 1991 issue of the Arlington Sun Gazette and the December 1992 edition of Computer Digest.

Applicant, as shown by copies of additional invoices which he submitted as an exhibit, has expanded his business under the "RENT-A-NERD" mark to include customers outside of the Washington, D.C. metropolitan area in which he initially rendered his services. Specifically, in late 1991, applicant had sales to customers in California and South Carolina. Applicant's sales in 1993 encompassed customers in Arkansas, California, Colorado, Connecticut, Illinois, Kentucky, Maine, New York, Pennsylvania, Tennessee, Texas, the U.S. Virgin Islands and West Virginia. During 1994, applicant's sales included customers in California, Connecticut, Illinois, Missouri, New Hampshire, New Jersey, New York, Ohio, Oregon and Vermont.<sup>13</sup> In particular, as to the

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<sup>13</sup> Applicant's August 28, 1995 response to registrant's Interrogatory No. 1, however, lists only the following as "other states" (besides

services rendered by applicant in Ohio, it is notable that while applicant, on April 14, 1993, amended his application from a territorially unrestricted one to one in which he acknowledged registrant to have the exclusive right to use of the registered mark in Ohio, applicant nevertheless billed a customer in Toledo, Ohio for computer consulting services which he provided in the amount of \$10.00 on November 1, 1994 and received payment therefor on November 14, 1994. Applicant, however, clearly had not only constructive notice of registrant's rights in the "RENT-A-NERD" and design mark as of the June 19, 1990 date of issuance of the registration involved herein,<sup>14</sup> but also had actual knowledge of registrant's rights in the "RENT-A-NERD" designation as a result of both a December 9, 1989 search of a commercial

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Virginia, Maryland and the territory of the District of Columbia) in which applicant has used the "RENT-A-NERD" mark: North Carolina, New York, Massachusetts, Connecticut, Texas, California, Arizona, Alaska and the U.S. Virgin Islands. Although, for each of such geographic areas, the date and manner of first use, as also requested, was not indicated, applicant's response to registrant's Interrogatory No. 14, which requested the identification of "each separate geographic area in which Applicant has used the mark 'RENT-A-NERD' related to Applicant's services before [registrant applied for registration on] September 12, 1989," simply states "see number one above". There is, however, no documentary or other evidentiary support in the record for applicant's stated use of his mark in North Carolina, Massachusetts and Alaska, and there is no such evidence which shows that, prior to September 12, 1989, applicant had ever expanded use of his mark beyond the Virginia and Maryland suburban areas of Washington, D.C. Specifically, and since no address was indicated with respect to any of the instances in which services were rendered to Mr. Kosorukov, the sequential invoices furnished by applicant establish only that, as of September 12, 1989, applicant had rendered his services under his mark to an individual in Alexandria, Virginia on August 12, 1989 and to a firm in Rockville, Maryland on August 17, 1989. The earliest documented sale of such services in Washington, D.C. is an invoice to a firm which is dated November 16, 1989.

<sup>14</sup> Section 22 of the Trademark Act provides in pertinent part that "[r]egistration of a mark on the principal register ... shall be constructive notice of the registrant's claim of ownership thereof."

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trademark database<sup>15</sup> and a December 11, 1989 telephone call placed to registrant's Akron, Ohio business number.<sup>16</sup>

Registrant, on the other hand, testified that he "created the concept of Rent-A-Nerd back in the late '80s." (Briggs dep. at 6.) As of his February 1, 1996 deposition, however, Mr. Briggs' involvement therewith was limited to being the owner of the registered "RENT-A-NERD" mark, which he licenses to the user thereof,<sup>17</sup> and the preparation of a uniform franchise offering circular and franchise agreement for use in connection with his plans for a national franchise offering.

Registrant's current occupation consists of being the owner of three small businesses: (i) Briggs Gift Company (hereinafter "BGC"), which is a manufacturer of novelty gifts and party supplies; (ii) Focus One Marketing Group, which does graphic design work; and (iii) Stellar Private Cable TV Systems, which builds and sells communications products, satellite dishes and other commercial installations. Although the latter business

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<sup>15</sup> Specifically, applicant's response to registrant's Interrogatory No. 18 refers to applicant's first becoming aware of registrant's use thereof through a "12.9.89 Trademark Scan on Compuserve".

<sup>16</sup> The 216 633-8545 number which is listed on applicant's long distance telephone bill (see Applicant's Ex. 49) is the same number which appears on registrant's early advertising and promotional materials (see Registrant's Exs. B, G, L, M and N) and his initial yellow pages ad for the computer consulting business (see Registrant's Ex. S). Applicant's response to respondent's Interrogatory No. 24, however, further indicates that the telephone call to respondent was the sole communication between the parties prior to the commencement of this proceeding.

<sup>17</sup> Although applicant makes much of the fact that a *written* license agreement was never produced and offered into evidence by registrant, we note that the lack thereof is not dispositive since it is settled that a written license agreement is not required. See, e.g., Nestle Co. Inc. v. Nash-Finch Co., 4 USPQ2d 1085, 1089 (TTAB 1987) and Basic Inc. v. Rex, 167 USPQ 696, 697 (TTAB 1970).

presently is his primary one, it is the other two businesses, as originally operated, which are relevant to the issues in this proceeding.

Specifically, Mr. Briggs indicated that Focus One Marketing Group was formed sometime around 1990 following the dissolution of the advertising agency business of MarTech Marketing (hereinafter "MarTech"), a partnership which registrant and his wife started in 1983 and which later took in another partner prior to dissolving. While MarTech was in operation, registrant was also operating his BGC business. Both businesses were based in Akron, Ohio. Sometime during the late 1980s, registrant decided to computerize the bookkeeping for BGC and hired a consultant to assist with such task, including buying the necessary computer hardware. Registrant, however, was not pleased with the cost and services of the consultant he had hired and, as a result, subsequently hired Don Abbott, "a high school student who was a computer whiz[,] to come in and help us, and he was the nerd, and through that effort ... we learned about computerization of accounting functions and felt [that] there was a need to offer this for other small businesses that wanted to do it on a low cost basis, and that's how the idea for Rent-A-Nerd started." (Id. at 7.) Although "not clear" as to the exact date on which he hired Mr. Abbott, registrant "guess[ed] [that] it would have been summer of 1988, probably July or August [thereof]." (Id. at 7-8.) Mr. Briggs testified that he conceived the idea of "RENT-A-NERD" as the name for a computer consulting service "in the fall of 1988," which he indicated was

approximately three to four months after Mr. Abbott started working for BGC and got its "situation squared away." (Id. at 8.)

Registrant further testified that, initially, he was actively involved in the day-to-day business of his new venture. Through MarTech, which also did the design work for registrant's promotional materials, a commercial printer was engaged on October 25, 1988 to print 2,000 "RENT-A-NERD" fliers and 300 "RENT-A-NERD" statement stuffers for use in advertising registrant's computer consulting business. According to Mr. Briggs, MarTech "was kind of operating as the umbrella for Rent-A-Nerd at the time because it was really not a full-fledged business, so the billing for the Rent-A-Nerd fliers came to MarTech because we had credit and so forth ...." (Id. at 9-10.) Both MarTech and BGC, at that time, were located in the same offices and shared the same employees.<sup>18</sup>

To test the market for his computer consulting services, registrant began distributing his "RENT-A-NERD" fliers in November 1988 by placing one in each package of gifts shipped by BGC and including one with each invoice sent by BGC. Registrant utilized such distribution methods, which covered "the greater portion of the country," since no additional marketing

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<sup>18</sup> Applicant contends that registrant is not the owner of the "RENT-A-NERD" and design mark since the evidence presented by registrant shows MarTech and BGC to have been initially using such mark. However, not only has registrant presented an explanation in his testimony for such use, but in any event applicant, while he could have done so, did not pay the required fee and timely petition to cancel the registration on the ground of registrant's alleged lack of ownership of the mark. In consequence thereof, applicant's assertion that registrant is not the owner of the registered mark will not be given further consideration.

costs were involved. (Id. at 18.) Additional advertising and promotional items utilized in connection with publicizing the new venture included a dozen T-shirts imprinted with the "RENT-A-NERD" designation, which registrant ordered through MarTech on November 20, 1988. Such shirts were worn by "[s]ome of the office staff" and "a few" may have been "given to customers." (Id. at 19-20.) Again, through MarTech, 3,000 two-color "RENT-A-NERD" brochures were ordered from a commercial printer on January 20, 1989. The brochures were "handed out informally" and, like the earlier fliers, "some" were mailed to BGC customers with their orders. (Id. at 22-23.) During "the same time frame as the two-color brochure," registrant also utilized, as a promotional item, "a very high quality Rent-A-Nerd official pocket protector," which according to Mr. Briggs "was passed out at random to anybody that we thought would be a candidate for our services," including mailings of such an item to the accounting departments of BGC customers. (Id. at 23.) Registrant, by December 1988, also had arranged to have listed the 633-8545 telephone number for the "RENT-A-NERD" business, which listing subsequently appeared in the business section of the 1989 Akron, Ohio telephone directory and set forth the same address (920 E. Tallmadge) as that for MarTech.

The earliest *documented* instance, however, as to when registrant first actually *rendered* computer consulting services to a client under the mark "RENT-A-NERD" is a barter invoice, in the amount of \$285.00, sent by MarTech to John Kordic Co. of St. Augustine, Florida, on April 15, 1989 concerning the creation of

a spreadsheet to track an Akron, Ohio automobile dealership's sales and inventory in exchange for a credit with respect to landscaping design services.<sup>19</sup> According to registrant, the services were billed by MarTech because, as testified to earlier, "Rent-A-Nerd ... was operating under the umbrella" of MarTech since "it really wasn't a full-fledged company".<sup>20</sup> (Id. at 25.) Moreover, as to the status of his "RENT-A-NERD" business during the initial stages thereof in 1989, registrant gave the following testimony:

Q. The April, May, 1989 time period, what was the state of the Rent-A-Nerd business?

A. We were operating in the same office as MarTech Marketing and Briggs Gift Company, had the same office staff. .... [I]t was basically part of that company. It wasn't its own entity.

Q. When did that change as far as how the business was operated?

A. In early July of '89 we felt that there was a market for this service and that it could be expanded and that it was something to pursue, so we decided to create its own entity, its own checking account and so forth.

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<sup>19</sup> A copy of a January 31, 1996 letter faxed to Mr. Briggs from a John Kordic or Kordick of Florida Landscape and Nursery Co. in St. Augustine, Florida, which registrant introduced as part of his Exhibit I, states that the writer "couldn't locate any of the Rent-A-Nerd things you guys did for me when I was selling cars, but I did manage to find the barter invoice stuck inside my tax return papers."

<sup>20</sup> Mr. Briggs added that he claimed April 15, 1989 as the stated date of first use in the application which matured into his registration because "that was the first time that we had billed for services that was [sic] out of the state of Ohio." (Briggs dep. at 25.) Such services, Mr. Briggs further noted, were not only paid for, but were provided under the mark in the form of "a disk that had the information on it and the disk had our logo on it." (Id. at 27.)

So I would say that the business of Rent-A-Nerd as a consulting service began in July with, you know, operating itself. We had been doing the consulting servicing all along, but in July we really made an effort to promote it.

(Id. at 27.)

Registrant and his "RENT-A-NERD" computer consulting services first received publicity through a newspaper article in the Akron, Ohio Beacon Journal on July 24, 1989. As was the case with applicant, the article reports, among other things, that registrant's computer consulting business "is catching on ... because people seem to associate the self-deprecating name with the kind of service it suggests: computer wizardry from people completely lacking in social skills, much less marketing savvy; the kind of experts who'll work all night to get a computer or program running right, then neglect to put on fresh shirts in the morning." (Registrant's Ex. K.) Registrant has publicized his computer consulting business by distributing brochures, bearing his registered mark, during trade shows, which were held in such cities as New York, Atlanta and Kansas City, at which BGC exhibited products to retailers in the novelty gift trade.<sup>21</sup> At such shows, registrant also sold "RENT-A-NERD" pocket protectors for a quarter each.

In addition, at trade shows known as "computer fairs," registrant has advertised his computer consulting services by passing out copies of a "Federal Nerd Note" handbill. (Id. at

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<sup>21</sup> As was the case with the sending of "RENT-A-NERD" advertising fliers to customers of BGC, registrant distributed "RENT-A-NERD" brochures at

31.) The handbill, created by MarTech in July 1989 as an obvious take-off on a two dollar bill, refers to "Head Nerd: Don Abbott" and offers the bearer thereof a two-hour computer training session from "RENT-A-NERD" for \$25.00. (Registrant's Ex. M.) Registrant, as of July 1989, has also advertised his registered mark by using it on a catalog for software compatible accounting forms and on advertising literature for computer furniture. Such products were offered through the "RENT-A-NERD" business as adjuncts to the computer consulting services. Moreover, by 1990, the Akron, Ohio business section of the Ohio Bell telephone directory, along with a 1990 yellow pages listing, listed the "RENT-A-NERD" business under a new number, 896-1534, although a different address from that formerly used is set forth in each instance.<sup>22</sup>

The arrangement whereby registrant basically supervised the operation of the "RENT-A-NERD" business while Don Abbott did the actual "on-site work" of "handling the computer end of it" lasted until about July 1990. (Briggs dep. at 34.) Mr. Briggs testified, however, that "because of my involvement with the other businesses, I wasn't able to spend as much time with this as I would like, so I licensed the use of the trademark to Don Abbott and he operated the company independently as a licensee" until he graduated from college. (Id.) Although registrant did

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trade shows attended by BGC since no additional marketing costs were incurred.

<sup>22</sup> While the differences in business address were not explained, Mr. Briggs stated that the reason for the change in telephone number was that "at this time the business was run by a licensee." (Briggs dep. at 42.)

not recall exactly when Don Abbott graduated, registrant indicated that, upon graduation, Mr. Abbott was offered a job opportunity at another company and "opted to take that job of full-time employment instead of remaining self-employed as the Rent-A-Nerd licensee operating the office." (Id.) With respect to the status of such business thereafter, registrant gave the following testimony:

Q. Who continued the Rent-A-Nerd business after Don Abbott left?

A. Don Abbott sold the business to one of the Nerds that worked for him called Brian Bobo.

Q. Did you give him consent to do that?

A. Yes, we had a meeting and determined all that, and the license was transferred.

Q. And Brian Bobo is now licensed to operate the Rent-A-Nerd business?

A. Yes.

(Id. at 35.)

As to his plans for expanding the "RENT-A-NERD" business, registrant noted that:

For the past few years, I have been working on a uniform franchise offering; in particular, a franchise agreement. I feel that it is a concept and a marketing advantage ... that can go on a national basis, so all of my efforts have been concentrating on putting together a franchise offering.

(Id.) Although, in view of the pendency of this proceeding, no franchises have yet been offered, registrant, as of December

1993, had completed a draft copy of a uniform franchise offering circular for use in connection therewith and intended to form a corporation for his franchising activities. During the last quarter of 1993, registrant, in conjunction with his plans for franchising, contacted an insurance agency regarding language for insurance requirements for franchisees to be included in the franchise agreements and had run newspaper ads, for which responses had been received, seeking experienced individuals to develop and market the "RENT-A-NERD" franchising program.

Although it appears that nothing further has since happened with such program, the "RENT-A-NERD" and design mark, and the services offered in connection therewith, continue to be advertised and promoted. By 1994, a display ad in the Ohio yellow pages lists both a "NATIONAL 1-800-800-NERD" and a "LOCAL (216) 785-040" as telephone numbers for the computer consulting services offered by registrant's licensee, due to an expansion of the geographical area served by the business.<sup>23</sup> (Registrant's Ex. V.) Registrant, in particular, indicated that telephone calls are received from all over the United States on the 800-number. Moreover, registrant's licensee has received publicity by being mentioned in a May 1994 article in the nationally circulated publication CashSaver, which states that Brian Bobo and Don Abbott are "business partners" and "the owners of Rent-A-Nerd". (Registrant's Ex. W.) Registrant, when asked if "Rent-A-Nerd

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<sup>23</sup> Curiously, despite the changes in telephone numbers and address which have taken place, Mr. Briggs also testified that the "RENT-A-NERD" business continues to distribute the same brochure which was first utilized in November 1988.

[is] still active today," replied "[y]es, very much so," and further indicated that:

The licensee operates his own business, and I'm not familiar with every promotional activity or what business they are doing because ... I am not affiliated in this business, it is a separate entity. They do promote nationally, [and] I know they do business ... [in] Chicago, they have clients up there, [and] they have clients down in Texas.

(Briggs dep. at 44-45.)

Turning to the threshold issue of whether applicant, as the party having the burden of proof in this case, has met the jurisdictional requirement for a concurrent use proceeding, we find that, as evidenced by the earliest of the invoices to Mr. Kosorukov (and as conceded by registrant's counsel at the oral hearing), applicant's concurrent lawful use in commerce of the mark "RENT-A-NERD" in connection with the actual rendering of "temporary employment services for computer specialists," in the form of computer consulting services provided on a temporary basis,<sup>24</sup> first occurred on May 21, 1989. Such date plainly is prior to the September 12, 1989 filing date of the application which matured into registrant's registration, although we further find that, as proven by the invoice sent by MarTech to the John Kordic Co., it is subsequent to registrant's first use of the mark "RENT-A-NERD" in conjunction with the actual rendering of his "consulting services ... regarding the use and application of

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<sup>24</sup> It is clear from the record that any difference between applicant's services as described in the application and those which he actually renders is essentially one of semantics and not substance.

computers," which took place on April 15, 1989.<sup>25</sup> Nevertheless, as stated by the Board in Pagan-Lewis Motors, Inc. v. Superior Pontiac, Inc., 216 USPQ 897, 899 (TTAB 1982):

It is well-settled that concurrent rights arise where a party, in good faith and without knowledge of a prior party's use in another area of the country, adopts and uses the same or a similar mark for the same or like goods or services within its own geographical area with a measure of commercial success and public recognition and without any confusion as to source. See: Weiner King, Inc. v. Wiener King Corp., 201

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<sup>25</sup> Both parties assert that, for priority purposes, they are entitled to rely upon their earlier advertising uses of their respective "RENT-A-NERD" marks. Specifically, applicant in effect seeks to tack the March 14, 1989 use of his "RENT-A-NERD" mark on brochures which he printed and began distributing to the date upon which he actually started rendering his services under the mark. Likewise, registrant essentially seeks to defeat the earliest date asserted by applicant by tacking the use on fliers of the "RENT-A-NERD" and design mark, which registrant commenced in November 1988, to the proven date of the first sale of his services under such mark. However, in order for a party to rely upon advertising or other analogous service mark use for purposes of tacking such usage to the date of its actual or technical service mark use, a party must establish that its advertising or other analogous use was "of such a nature and extent as to create public identification of the ... term with the . . . [party's] service." T.A.B. Systems v. PacTel Teletrac, 77 F.3d 1372, 37 USPQ2d 1879, 1881 (Fed. Cir. 1996). Here, the evidence presented by applicant utterly fails to support the necessary inference of the creation of a public identification of the mark "RENT-A-NERD" with the services offered by applicant, since the evidence shows that applicant's initial brochure was distributed, as of May 21, 1989, to only two potential customers (Mr. Kosorukov and Mr. Datlow). Plainly, no showing has been made from which it can be inferred that a substantial share of the consuming public for applicant's services had been reached. Similarly, while registrant's efforts at advertising appear to be considerably more extensive, it still seems problematic at best to infer that, as of April 15, 1989 (or even as late as May 20, 1989), the distribution of fliers inside packages sent to BGC customers constituted anything more than a negligible portion of the relevant market for computer consulting services or that the consuming public had come to identify the "RENT-A-NERD" and design mark with the provision of such services by registrant. Accordingly, because, under PacTel, "activities claimed to constitute analogous use must have [had] substantial impact on the purchasing public," 37 USPQ2d at 1882, neither applicant nor registrant has presented legally sufficient evidence to support his claim that he is entitled to rely on analogous service mark use to establish priority.

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USPQ 894 (TTAB 1979), *modified*, 204 USPQ 820  
(CCPA 1980); and Tie Rack Enterprises, Inc.  
v. Tie Rak Stores, 168 USPQ 441 (TTAB 1970).

Here, nothing indicates that applicant's adoption and actual

first use of the "RENT-A-NERD" mark for his services in the Washington, D.C. metropolitan area, prior to September 12, 1989, was anything other than in good faith and without knowledge of registrant's prior use of basically the same mark for essentially the same services in Akron, Ohio. In view thereof, and since applicant's earliest actual use of his mark clearly was followed by a measure of commercial success and public recognition in his localized trading area, with no indication of any instances of actual confusion, we hold that applicant has met the jurisdictional requirement for a concurrent use registration as set forth in Section 2(d) of the Trademark Act.<sup>26</sup>

This brings us to consideration of whether applicant, in order to be entitled to a concurrent use registration and a restriction of registrant's registration, has satisfied his burden of showing that there will be no likelihood of confusion from contemporaneous use by the parties of their respective marks in their respective geographical areas. Plainly, in light of the substantial similarity between such marks in appearance, their identity in sound, meaning and commercial impression, and the virtual identity of the computer consulting services provided in connection therewith, confusion as to source or sponsorship would be likely if the parties were to render their services under their marks in the same territory.

As our principal reviewing court, citing *In re Beatrice Foods Co.*, 429 F.2d 466, 166 USPQ 431 (CCPA 1970), indicated in *Gray v. Daffy Dan's Bargaintown*, 823 F.2d 522, 3 USPQ2d 1306,

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<sup>26</sup> See footnote 6.

1308-09 (Fed. Cir. 1987),<sup>27</sup> a concurrent use applicant must not only meet the statutory jurisdictional requirement, but it must also demonstrate that there will be no likelihood of confusion resulting from the parties' contemporaneous use of their respective marks in their respective geographical areas:

In *Beatrice Foods*, the court spoke of the requirement for an applicant's lawful use in commerce outside of the conflicting claimant's area as being "jurisdictional in nature." 429 F.2d at 473; 166 USPQ at 436. Gray construes "jurisdictional" to mean that, by showing such use, his "entitlement" to a concurrent use registration is established. Clearly, that is not the import of the court's statement. A valid application cannot be filed at all for registration of a mark without "lawful use in commerce," and, where a claim is made of concurrent rights, such use must begin prior to the filing date of any application by a conflicting claimant to the mark. In this sense, the requirement is "jurisdictional." 15 U.S.C. §1052(d) .... *Beatrice Foods* itself goes on to recognize that this "jurisdictional" requirement is only one of the "conditions precedent" which must [sic] be satisfied to establish "entitlement" to a concurrent use registration:

The touchstone, however, is the requirement that there be no likelihood of confusion, mistake or deception in the market place as to the source of the goods resulting from the continued concurrent use of the trademark. Only in satisfying this standard, can the Patent Office be sure that both the rights of the individual parties and those of the public are being protected.

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<sup>27</sup> In such case, the junior party and later user, Daniel R. Gray, sought concurrent use registration of a substantially identical mark for identical and closely related services to those of the senior party and prior user, Daffy Dan's Bargaintown (referred to by the court as "DDB").

*Id.* at 473-74, 166 USPQ at 436. Thus, the determination that Gray met the "jurisdictional" requirement does not establish his "entitlement" to a concurrent use registration. Gray was not "entitled" to such registration unless he also satisfied the "touchstone" requirement of no likelihood of confusion with DDB's use. Entitlement here turns on whether the board properly took into consideration the admitted current area of actual use by the parties or whether the board was required, as Gray asserts, to disregard Gray's actual use because Gray does not seek registration for his entire trading area.

*Beatrice Foods* did not address that issue. In *Beatrice Foods*, there had been an overlap in use by the parties. However, there, the parties worked out a settlement under which each agreed to recognize and honor the exclusive rights of the other in separate areas of use. In other words, one party obtained rights in the "overlap" area, and the other party expressly withdrew from that area to avoid confusion of the public. In contrast, the record here shows, not merely that the junior party inadvertently or temporarily entered into the senior party's territory, but that such use was continuing at the time of the board's decision with no agreement between the parties that it would cease.

....

We conclude that the board's interpretation of the statutory provision is correct. The issue of likelihood of confusion in this concurrent use proceeding was properly resolved by looking at the concurrent use applicant's area of actual use, not merely the area "claimed" in his application. Thus, the exclusion of some geographic territory of use from a concurrent use application does not restrict the likelihood of confusion inquiry required by the statute. As this case illustrates, the mere statement by an applicant that a registration is not sought for a particular state or geographic area cannot be equated with a representation that the applicant does

not and will not use its mark in the area. Here, there is no representation by Gray that he will limit the scope of geographic use of his mark or will take steps to prevent confusion of the public. What is attempted here is simply a manipulative use of the registration system to secure to Gray the advantages of registration with no undertaking whatsoever to protect the public from confusion. We see nothing in the statute, nor in the "equities" to be resolved in a concurrent use proceeding, which requires the Commissioner to limit the likelihood of confusion inquiry to the area "claimed" by a concurrent use applicant.

Applying the above legal principles to the facts in this proceeding, we concur with registrant that applicant, by using his "RENT-A-NERD" mark in the State of Ohio in connection with essentially the same services as registrant's licensee provides in the State of Ohio under registrant's "RENT-A-NERD" and design mark, is precluded from establishing his entitlement to a concurrent use registration.<sup>28</sup> Similarly, and aside from registrant's testimony that telephone calls are received from all over the United States on the 800-number used by his licensee, it is plain that the licensee's use of registrant's mark in connection with the business which it does for its clients in Chicago and Texas and applicant's expansion of his sales under his mark to include the States of Illinois and Texas make it

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<sup>28</sup> Registrant, in his brief, raises the additional argument that applicant "has not and cannot meet his burden of proof that no likelihood of confusion exists" because the record shows that applicant "admits that a likelihood of confusion does exist." Specifically, registrant stresses that applicant answered "yes" in response to registrant's Interrogatory No. 11, which asks: "Do you contend that there is a likelihood of confusion among consumers of the services of the Applicant using the Applicant's mark and the Registrant using the Registrant's mark?" Registrant's heavy reliance thereon is devoid of any merit since the interrogatory, in view of its

impossible for applicant to show entitlement to the concurrent use registration he seeks. Applicant, as the party having the burden of proof, has moreover neither demonstrated that his rendering of services under his mark in Toledo, Ohio was an inadvertent or temporary occurrence which will not be repeated, nor has he shown that registrant's licensee, for example, has ceased doing business under registrant's mark in Chicago and Texas. We hold, therefore, that this concurrent use proceeding must be dissolved. See, e.g., My Aching Back Inc. v. Klugman, 6 USPQ2d 1892, 1894 (TTAB 1988) [applicant failed to demonstrate that confusion would not be likely since, among other things, "there is no indication in the record that applicant would not use or advertise the mark in the territory of the registrant and, in fact, the record demonstrates that applicant has made some sales in ... two states that applicant concedes should be reserved for the registrant"].

Nevertheless, in the event that our holding that applicant cannot establish his entitlement to a concurrent use registration as a matter of law is reversed on appeal, we further hold that, at most, applicant would be entitled, as a subsequent user, to a concurrent use registration only for the Washington, D.C. metropolitan area and not, as specified in his application, the entire United States with the exception of the State of Ohio. We recognize, in this regard, that "a subsequent user's rights may not [necessarily] be limited to the area of actual use prior

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lack of any territorial limitations, is clearly ambiguous. Applicant's answer thereto is thus of no probative value whatsoever.

to notice of the senior user's rights (regardless of when that may be deemed to have occurred in this case) and that territorial expansion by the later user even after learning of the senior user is not [necessarily] precluded as a matter of law". Over the Rainbow, Ltd. v. Over the Rainbow, Inc., 227 USPQ 879, 883 (TTAB 1985), *citing* Weiner King, Inc. v. Wiener King Corp., 615 F.2d 512, 204 USPQ 820, 829 (CCPA 1980) and Ole' Taco Inc. v. Tacos Ole, Inc., 221 USPQ 912, 915 (TTAB 1984).

However, "a party's use in an expanded area after issuance of an existing registration for that area constitutes ... bad faith or unlawful use in the expanded area" and such party "is not entitled, as a matter of law, to registration for the expanded area." Fleming Companies Inc. v. Thriftway Inc., 21 USPQ2d 1451, 1455 (TTAB 1991), *aff'd*, 809 F. Supp. 38, 26 USPQ2d 1551, 1552-53 (S.D. Ohio 1992). Specifically, as pointed out by the district court (*italics in original*):

This case concerns the scope of concurrent registration, and the effect of exclusive rights. The law is clear that once a party obtains federal registration with respect to a given mark, the registrant has the exclusive right to use to the mark throughout the entire United States without regard to the geographic area in which the registrant actually uses the mark. *Old Dutch Foods, Inc. v. Dan Dee Pretzel & Potato Chip Co.*, 477 F.2d 150, 156 [177 USPQ 469] (6th Cir. 1973); *See In re Beatrice Foods Co.*, 429 F.2d 466, 472-73 [166 USPQ 431] (CCPA 1970); *Dawn Donut v. Hart's Food Stores, Inc.*, 267 F.2d 358, 362-63 [121 USPQ 430] (2d Cir. 1959) .... Thus, a registrant has rights to the exclusive use of the mark even in areas where it does not conduct any business. *Old Dutch Foods*, 477 F.2d at 156; *Dawn Donut*, 267 F.2d at 362-63 .... Consequently, a junior user in a territory

subject to another's registration, could not obtain registration for the mark in that area while the registrant's federal registration was in effect. *Action Temporary Services v. Labor Force, Inc.*, 870 F.2d 1563, 1565 [10 USPQ2d 1307] (Fed. Cir. 1989); *Old Dutch Foods*, 477 F.2d at 156, 157; *In re Beatrice Foods Co.*, 429 F.2d 466, 472-73 [166 USPQ 431] (CCPA 1970); *John R. Thompson Co. v. Holloway*, 366 F.2d 108, 114-116 [150 USPQ 728] (5th Cir. 1966); see *Dawn Donut*, 267 F.2d at 362.

Although the registration of a mark grants the registrant nationwide protection, a party who qualifies may obtain concurrent use registration for the same mark under ... Section 2(d) of the Lanham Act .... In applying this section and the applicable precedent to the facts of this case, we must conclude that the Plaintiff is not entitled to registration in the expanded territory.

A party is entitled to concurrent use registration covering a given territory, if that party has "lawfully" used the mark in that territory from a period prior to any other registration of that mark. *Id*; *Action Temporary Services v. Labor Force, Inc.*, 870 F.2d 1563, 1565 [10 USPQ2d 1307] (Fed. Cir. 1989). Thus, unless the Plaintiff has been "lawfully using" the mark in the expanded territories since before the Defendant obtained federal registration covering that area, it is not entitled to concurrent registration there. We conclude that the Plaintiff's use was not a "lawful" use within the meaning of the Lanham Act, and thus, the Plaintiff is not entitled to concurrent registration in the expanded area.

A "lawful use" is the use of a mark in connection with goods or services in a territory not covered by another party's registration. *Id.* at 1566. As the TTAB concluded, the Plaintiff "commenced use in the expanded territory, after issuance of [the Defendant's] registration which included the expanded territory." *Fleming Companies v. Thriftway, Inc.*, 21 U.S.P.Q.2d (BNA) 1451, 1455 (1991). Giving the TTAB due deference on such questions of fact, ... we conclude that the Plaintiff did not use the mark in

the expanded territory at any time prior to the Defendant's registration. The Plaintiff is thus, not a "lawful user" within the meaning of the Lanham Act, and does not qualify for concurrent registration in the expanded territory. ....

The same is likewise true with respect to the parties in this proceeding. Registrant received his registration on June 19, 1990, yet the record shows that applicant did not expand his sales beyond his initial customers in the Washington, D.C. metropolitan area until, at the earliest, late 1991, when his business rendered computer consulting services on a temporary basis to customers in California and South Carolina.

Finally, aside from the above, the equitable considerations in this proceeding strongly favor allowing registrant to retain his registration for all of the United States, with the exception of the Washington, D.C. metropolitan area in which applicant, in good faith and without knowledge of registrant's rights, first used and established a business under the "RENT-A-NERD" mark. Registrant, as shown by the record, was the first to adopt and use the term "RENT-A-NERD" as part of his mark; he was the first to advertise and promote his mark; he was the first to register his mark; he was the first to receive publicity for his business under the mark; he has formulated definite plans to franchise such a business nationally; and his licensee has expanded the use of the mark.

Applicant, by contrast, is not only the subsequent user (although by just slightly over one month) of his "RENT-A-NERD" mark, but he has primarily limited the advertising of his

services under such mark to weekly display ads in the Washington Post and occasional advertisements in other newspapers and publications in the Washington, D.C. metropolitan area. Although applicant, due to the self-deprecating or stereotypically humorous nature of his mark, has fortuitously received national publicity for his business in an article which ran in the Wall Street Journal on April 10, 1991 and has similarly garnered further regional exposure for the "RENT-A-NERD" name beyond the Washington, D.C. metropolitan area as a result of an Associated Press story which appeared in the media during the period from October 8 through 10, 1992, such instances have been isolated and limited occurrences which took place more than six years ago. By comparison, the bulk of the publicity received by applicant for his "RENT-A-NERD" temporary computer consulting services has taken the form of articles which have appeared in newspapers and other publications originating in the Washington, D.C. metropolitan area.

Furthermore, while applicant, like registrant, has also expanded his territory of use, there is virtually no information as to the extent of the parties' sales under their respective marks and, in the absence thereof, there is nothing which indicates that applicant's subsequent expansion of his sales outside of the Washington, D.C. metropolitan area has amounted to anything other than occasional, sporadic or haphazard occurrences. Clearly, nothing has been shown which would tend to establish the existence of a natural area of expansion for applicant's services under his mark. Thus, the equities, as well

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as the law, dictate that applicant, had he otherwise demonstrated that no likelihood of confusion would result from contemporaneous use of the parties' marks for their computer consulting services, would be entitled at most to a concurrent use registration which is limited to the Washington, D.C. metropolitan area, with registrant's registration being correspondingly restricted to all of the United States with the exception of such area.

**Decision:** This concurrent use proceeding is dissolved with prejudice and issuance of a concurrent use registration to applicant is refused.

T. J. Quinn

G. D. Hohein

P. T. Hairston  
Administrative Trademark Judges,  
Trademark Trial and Appeal Board