



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2011 TMOB 171
Date of Decision: 2011-09-12

**IN THE MATTER OF TWO
OPPOSITIONS by Rent-A-Nerd
Computer Services Inc. to
application Nos. 1,353,539 and
1,353,538 for the trade-marks
RENT-A-GEEK and RENT-A-
GEEK & Design in the name of
Rent-A-Geek Computer Services
Ltd.**

APPLICATION NO. 1,353,539

FILE RECORD

[1] On June 27, 2007, Rent-A-Geek Computer Services Ltd. filed an application to register the trade-mark RENT-A-GEEK, based on use in Canada since at least as early as December 13, 1998, in association with the following services:

- (1) The operation of a computer services business, namely, installation of computers and software programs, maintenance and repair services, consulting and troubleshooting services, upgrading computers.
- (2) The operation of a computer services business, namely, remote computer diagnostic services involving installation, repair, maintenance, updating and troubleshooting, computer network design and administration, and analysis of information technology

systems, virus removal and protection, installation of software and hardware and related training, synchronization and consolidation of system function and network and computer optimization.

[2] The application was subsequently amended to name Keith Schiehl doing business as Rent-A-Geek and as Rent-A-Geek, a Partnership as the applicant's predecessor in title of the applied for mark.

[3] The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated February 6, 2008 and was opposed by Rent-A-Nerd Computer Services Inc. on April 3, 2008.

[4] The Registrar forwarded a copy of the statement of opposition to the applicant on May 6, 2008 as required by s.38(5) of the *Trade-marks Act*, R.S.C. 1985, c. T-13. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition.

[5] The opponent's evidence consists of the affidavit of Michael E. Romaniuk. The applicant's evidence consists of the affidavit of Keith Schiehl. Only the opponent submitted a written argument. Neither party requested an oral hearing.

STATEMENT OF OPPOSITION

[6] 1. The first ground of opposition, pursuant to s.30(i) of the *Act*, alleges that the applicant cannot be satisfied that it is entitled to use the applied for mark owing to the opponent's prior use and registration of its marks RENT-A-NERD and RENT-A-NERD COMPUTER SERVICES.

2. The second ground, pursuant to s.12(1)(d), alleges that the applied for mark RENT-A-GEEK is confusing with the opponent's above mentioned registered marks covering, among other things, services relating to

“computer, computer peripheral and computer network, consulting, installation, repair, troubleshooting, programming and training.”

3. The third ground, pursuant to s.16(1)(a), alleges that at the date of first use of the applied for mark RENT-A-GEEK it was confusing with the opponent's marks RENT-

A-NERD and RENT-A-NERD COMPUTER SERVICES previously used or made known in Canada in association with the opponent's above mentioned services.

4. The fourth ground, pursuant to s.16(1)(c), alleges that at the date of first use of the applied for mark RENT-A-GEEK it was confusing with the opponent's trade-names Mike Romaniuk doing business as Rent-A-Nerd Computer Services and Rent-A-Nerd Computer Services Inc.

5. The fifth ground alleges that the applied for mark RENT-A-GEEK is not distinctive in view of the wares and services sold by the opponent under its above mentioned trade-marks and trade-names.

OPPONENT'S EVIDENCE

Michael E. Romaniuk

[7] Mr. Romaniuk identifies himself as an Officer and Director of the opponent company and formerly the sole proprietor of the opponent's predecessor in title Rent-A-Nerd Computer Services. Exhibit A of his affidavit confirms that the business name Rent-A-Nerd Computer Services was registered in the province of British Columbia in 1997. Exhibit B confirms that the company Rent-A-Nerd Computer Services Inc. was incorporated in British Columbia in 1999. Mr. Romaniuk adopted the name and mark RENT-A-NERD in 1994 and it has appeared on invoices, advertising handouts and other material since 1995. Exhibit C confirms the use of the trade-name Rent-A-Nerd and trade-mark RENT-A-NERD on invoices in 1995. The opponent's business of servicing computers grew steadily and in 1997 the opponent began to use the mark RENT-A-NERD in association with "computer consulting services."

[8] The opponent's marks RENT-A-NERD, registration No. TMA602,344, and RENT-A-NERD COMPUTER SERVICES, registration No. TMA602,065, cover the following:

wares

(1) computers, computer peripherals and parts, namely batteries, cables, chassis, keyboards, mice, power supplies, printers, speakers, memory, motherboards, processors, sound cards, video cards, hard drives, removable storage drives, scanners, modems, network hubs and switches, network interface cards, printers and monitors.

services

(1) computer, computer peripheral and computer network, consulting, installation, repair, troubleshooting, programming and training.

[9] Mr. Romaniuk states that he became aware of the present applications for the marks RENT-A-GEEK and RENT-A-GEEK COMPUTER SERVICES & Design in August 2007 by monitoring an online trade-mark database. He contacted the applicant and advised the applicant of the opponent's registered marks. He later instructed his agent to commence opposition proceedings.

[10] Exhibits L to JJ of Mr. Romaniuk's affidavit corroborate his assertions of continuous use and promotion of the opponent's marks and trade-name since at least as early as May 5, 1997 on invoices, letterhead, advertisements, company vehicles and clothing, on radio and the like. As of September, 2008, the main source of advertising for the opponent's marks was through its website at www.rent-a-nerd.ca. In 2002 the opponent began running Google advertisements which linked computer users to its above-mentioned website. From 2002 to September 2008, the opponent's advertisement appeared on third party computer screens about 3.9 million times. The opponent began its operations in British Columbia but as of September 2008 was serving clients in Alberta, Saskatchewan and Ontario. The opponent's sales doubled from 1997 to 1999, increased three fold from 1999 to 2000 and increased five fold from 2001 to 2007.

[11] Mr. Romaniuk referenced a standard dictionary, dated 1996, wherein the definition of a "geek" is "... a person who is socially inept or tediously conventional" and wherein the definition of a "nerd" is "... a foolish, feeble or uninteresting person." Mr. Romaniuk further notes that by 2008 the words "nerd" and "geek" had become somewhat synonymous with one another in the second and third reference dictionary definitions. In this regard, both words refer to a person who is accomplished in a technical or scientific field but lacking in social skills: see paragraphs 22 and 23 of his affidavit.

APPLICANT'S EVIDENCE

Keith Schiehl

[12] Mr. Schiehl identifies himself as the president and founder of the applicant company which began as a sole proprietorship, in Vernon, British Columbia, in late 1998. The present applicant was incorporated as a successor to the original sole proprietorship and later partnerships. The applicant specializes in fixing computers and meeting other technology challenges as set out in the subject application. The applicant offers its services on-site, in-store and online. Since the launch of the applicant's website (www.rentageek.ca) in 2005, the number of visits have averaged about 24,000 annually from Canada, the United States and internationally. As of March 2009 the applicant's clientele numbered 6,300 of which 95% are located in British Columbia.

[13] Exhibits F to K of Mr. Schiehl's affidavit corroborate his assertions of continuous use and promotion of the applicant's marks and trade-name since December 13, 1998 in newspapers, telephone directories, invoices, company vehicles, radio and by other means. The cost for advertising since December 13, 1998 has exceeded \$250,000.

[14] Mr. Schiehl also notes that the opponent's website dated April 2005 (see Exhibit Z of Mr. Schiehl's affidavit) differentiated "nerds" from "geeks" as follows:

Don't confuse nerds & geeks! We're proud to be nerds for a reason!

Nerd (n&rd), Noun: One who is considered intellectual or slavishly devoted to intellectual or academic pursuits.

Geek (gEk), Noun: A carnival performer often billed as a wild man whose act usually includes biting the head off a live chicken or snake.

[15] Mr. Schiehl is not aware of any instances of actual confusion between the parties' marks in the ten year period of coexistence in the marketplace between 1998 and the date of his affidavit March 19, 2009.

[16] Further, Mr. Schiehl asserts that the opponent was aware of the applied for marks at least as early as July 2004 as "the Opponent had embedded in its website the words

‘Rent-a-Geek’ in its meta tags.” The applicant therefore maintains that the opponent has acquiesced to the applicant’s use of the applied for marks.

LEGAL ONUS AND EVIDENTIAL BURDEN

[17] The legal onus is on the applicant to show that the application does not contravene the provisions of the *Trade-marks Act* as alleged by the opponent in the statement of opposition. However, there is also, in accordance with the usual rules of evidence, an evidential burden on the opponent to prove the facts inherent in its allegations pleaded in the statement of opposition: see *John Labatt Limited v. The Molson Companies Limited*, 30 C.P.R. (3d) 293 at 298 (F.C.T.D.). The presence of an evidential burden on the opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist.

First Ground of Opposition

[18] With respect to the first ground of opposition, s.30(i) applies if fraud is alleged on the part of the applicant or if specific federal statutory provisions prevent the registration of the mark applied for: see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) and *Canada Post Corporation v. Registrar of Trade-marks* (1991), 40 C.P.R. (3d) 221(F.C.T.D.). In the instant case the pleadings do not support a ground of opposition based on s.30(i) and it is therefore rejected.

Remaining Grounds & Material Dates

[19] The determinative issue in this proceeding with respect to the remaining grounds of opposition is whether the applied for mark RENT-A-GEEK is confusing with the opponent’s mark RENT-A-NERD. The legal onus is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of s.6(2) of the *Act*, shown below:

The use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services . . . associated with those trade-marks are manufactured . . . or performed by the

same person, whether or not the wares or services . . . are of the same general class.

[20] Thus, s.6(2) does not concern the confusion of the marks themselves, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by s.6(2) is whether there would be confusion of computer services provided by the applicant as being provided, licensed or endorsed by the opponent.

[21] The material dates to assess the issue of confusion are (i) the date of decision, with respect to the second ground of opposition alleging non-registrability: see *Andres Wines Ltd. and E & J Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.) and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 at 424 (F.C.A.); (ii) the date of first use of the mark, in this case December 13, 1998, with respect to the third ground of opposition alleging non-entitlement: see s.16(1)(a) of the *Trade-marks Act*; (iii) the date of opposition, in this case, April 3, 2008, in respect of the fifth ground alleging non-distinctiveness: see *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.) and *Clarco Communications Ltd. v. Sassy Publishers Inc.* (1994), 54 C.P.R.(3d) 418 (F.C.T.D.).

TEST FOR CONFUSION

[22] The test for confusion is one of first impression and imperfect recollection, as noted by Mr. Justice Denault in *Pernod Ricard v. Molson Breweries* (1992) 44 C.P.R. (3d) 359 at 369 (F.C.T.D.):

The test of confusion is one of first impression. The trade marks should be examined from the point of view of the average consumer having a general and not a precise recollection of the earlier mark. Consequently, the marks should not be dissected or subjected to a microscopic analysis with a view to assessing their similarities and differences. Rather, they should be looked at in their totality and assessed for their effect on the average consumer as a whole.

[23] Factors to be considered, in making an assessment as to whether two marks are confusing, are set out in s.6(5) of the *Act*: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the

nature of the wares, services or business; the nature of the trade; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered. All factors do not necessarily have equal weight. The weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R.(3d) 308 (F.C.T.D.).

CONSIDERATION OF S.6(5) FACTORS

Inherent and Acquired Distinctiveness

[24] The opponent's mark RENT-A-NERD possesses a fair degree of inherent distinctiveness because it is a humorous and unexpected phrase for the marketing of computer wares and services. Similarly, the applied for mark RENT-A-GEEK possesses a fair degree of inherent distinctiveness. The applied for mark would not have acquired any distinctiveness (through use or advertising) at the earliest material date December 13, 1998. It is difficult to come to any definite conclusions regarding the acquired distinctiveness of the parties' marks at the later material dates owing to a lack of informative quantitative data regarding sales under the marks. However, on a fair reading of Mr. Schiehl's affidavit, I am prepared to infer that the applied for mark RENT-A-GEEK had acquired a fair reputation, at least in the province of British Columbia, by the later material date April 3, 2008. Similarly, on a fair reading of Mr. Romaniuk's affidavit, I infer a minimal reputation for the opponent's mark until about the year 2000 and a fair reputation for its mark RENT-A-NERD, at least in the province of British Columbia, by the later material date April 3, 2008. Thus, the inherent and acquired distinctiveness of the marks in issue are factors that do not favour either party to any significant extent.

Length of Time Marks have been in use; Nature of wares and trades

[25] The opponent began to use its mark in May 1997 while the applicant began to use its mark in December 1998. The length of time that the marks have been in use therefore favours the opponent, but only marginally. As far as I am able to determine, the parties' services are essentially the same and in the absence of evidence to the contrary I assume

that the parties' channels of trade are also essentially the same. These factors favour the opponent as the applicant is operating in the same area of commerce as the opponent.

Resemblance

[26] The parties' marks necessarily resemble each other owing to the component RENT-A which is the prefix of both parties' marks. The first component of a mark is often considered more important for the purpose of distinction, however, when the first component is a common, descriptive or suggestive word, the significance of the first component lessens (see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.); *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.*, [1991], 37 C.P.R. (3d) 413 (F.C.A.); *Phantom Industries Inc. v. Sara Lee Corp.* (2000), 8 C.P.R. (4th) 109 (T.M.O.B.)). In the instant case, the first portion of the parties' marks is highly suggestive (if not descriptive) of the type of computer services offered by the parties, that is, indicating a relatively short period of hire. By comparison, the suffix components GEEK and NERD are the more distinctive and dominant components of the parties' marks. The parties' marks suggest similar humorous ideas, that is, engaging competent, albeit socially lacking, computer specialists for a short term. However, in my view, when the marks in issue are compared in their entirety, their visual and auditory differences outweigh the similarities in ideas suggested. Thus, the resemblance between the marks in issue is a factor which favours the applicant.

[27] Further, as stated in *Beverly Bedding & Upholstery Co. v. Regal Bedding & Upholstering Ltd.* (1980), 47 C.P.R. (2d) 145 (F.C.T.D.) at 149:

Realistically appraised it is **the degree of resemblance** between trade marks in appearance, sound or in ideas suggested by them that is the most crucial factor, in most instances, and **is the dominant factor** and other factors play a subservient role in the over-all surrounding circumstances.

(emphasis added)

surrounding circumstance

[28] A surrounding circumstance to be considered is the lack of evidence of actual confusion. Of course, the opponent is under no obligation to submit evidence of instances of actual confusion and the absence of such evidence does not necessarily raise any

presumptions unfavourable to the opponent nor is it determinative of the issue of confusion. Nevertheless, an absence of evidence of actual confusion over a relevant period of time, despite an overlap in the parties' wares and/or services and channels of trade, may lead to a negative inference about the likelihood of confusion: see *Monsport Inc. v. Vetements de Sport Bonnie (1978) Ltée* (1988), 22 C.P.R. (3d) 356 (F.C.T.D.); *Mercedes-Benz A.G. v. Autostock Inc.*, 69 C.P.R. (3d) 518 (TMOB). In the instant case, the evidence indicates that there has been significant concurrent use of the parties' marks RENT-A-NERD and RENT-A-GEEK in British Columbia since 1999 and that the parties' services have been sold through overlapping channels of trade to essentially the same target clientele. If instances of actual confusion have not been evidenced in respect of the marks RENT-A-NERD and RENT-A-GEEK, then there is some implication of no reasonable likelihood of confusion.

CONCLUSION

[29] In view of the foregoing, I find that at all material times the applicant has met the legal onus on it to show, on a balance of probabilities, that there is no reasonable likelihood of confusion between the applied for mark RENT-A-GEEK and the opponent's marks and trade-name.

APPLICATION NO. 1,353,538

[30] Application No.1,353,538 for the mark RENT-A-GEEK & Design, illustrated below, has the same filing date as application No.1,353,539 for the word mark RENT-A-GEEK and is based on use since at least as early as September 2004 in association with the same services covered in the word mark application.



[31] The two applications appeared in the same issue of the *Trade-marks Journal* and both were opposed on April 3, 2008. The pleadings, issues, evidence and considerations are essentially the same in the two oppositions, and the same conclusions follow. That is, I find that at all material times the applicant has met the legal onus on it to show, on a

balance of probabilities, that there is no reasonable likelihood of confusion between the applied for mark RENT-A-GEEK & Design and the opponent's marks and trade-name.

DISPOSITIONS

[32] The oppositions to applications Nos. 1,353,539 and 1,353,538 are therefore rejected. These decisions have been made pursuant to a delegation of authority under s.63(3) of the *Trade-marks Act*.

Myer Herzig
Member
Trade-marks Opposition Board