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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In Prosit LLC

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Serial No. 78539801

Serial No. 78539762

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Joseph M. Konieczny, Sr. of Joseph M. Konieczny, P.C. for Prosit LLC.

Brendan Regan, Trademark Examining Attorney, Law Office 113  
(Odette Bonnet, Managing Attorney).

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Before Holtzman, Kuhlke and Walsh, Administrative Trademark Judges.

Opinion by Holtzman, Administrative Trademark Judge:

Applicant, Prosit LLC, has filed two applications to register the mark PROSIT PRINT SOLUTIONS (both in standard character form) for goods ultimately identified as follows:

Commercial copying services, namely duplicating of, photocopying of, and compiling of documents for others; compiling and mailing of documents and items to recipients on a mailing list (in Class 35).<sup>1</sup>

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<sup>1</sup> Serial No. 78539801, filed December 29, 2004, alleging a date of first use in June 2002 and first use in commerce on October 26, 2002.

Commercial printing services, namely printing of, laminating of, and collating of documents, advertising materials, brochures, pamphlets, labels, stationary, business cards, folders, envelopes, binders, business tabs, photographs, signs, banners and certificates; desktop publishing for others; digital printing of documents; customized printing of company names and logos on the goods of others for promotional and advertising purposes; assembling and binding of documents and booklets; electronic imaging, scanning, digitizing, altering and retouching photographic images, artwork, paintings and mementos; duplicating CD's and DVD's (in Class 40).<sup>2</sup>

As to each application, the trademark examining attorney has refused registration in view of applicant's failure to comply with the requirement for a disclaimer of PRINT SOLUTIONS under Section 6 of the Trademark Act based on the ground that the wording is merely descriptive of applicant's services under Section 2(e)(1) of the Act.

When the refusal was made final, applicant appealed. Applicant and the examining attorney have filed briefs. Because the marks and issues in both cases are the same, the appeals are hereby consolidated.

As a preliminary matter, we note that applicant acknowledged that the word PRINT is descriptive in connection with the services in Class 40 in the '762 application, and accordingly agreed to disclaim the term in that application. Applicant declined to enter a disclaimer of PRINT in the '801 application

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<sup>2</sup> Serial No. 78539762, filed December 29, 2004, alleging a date of first use in June 2002 and first use in commerce on October 26, 2002.

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for the Class 35 services, asserting that the term is not descriptive of those services.<sup>3</sup> Notwithstanding that applicant has disclaimed PRINT in one application and not in the other, the issue in both cases is whether the entire phrase PRINT SOLUTIONS is merely descriptive of applicant's services.

The examining attorney argues that PRINT SOLUTIONS in the context of applicant's services describes the purpose of such services to resolve a problem. The examining attorney relies on a dictionary definition of "copy" to show the descriptive meaning of PRINT in relation to applicant's Class 35 services; a dictionary definition of "solutions" supplied by applicant; the use of PRINT SOLUTIONS or variants of that phrase in applicant's specimen and website materials; and a number of third-party registrations in the same or related fields wherein "solutions" is disclaimed or registered under 2(f) or on the Supplemental register.

Applicant contends that the word "solutions" is too broad and vague to describe applicant's services with the requisite degree of particularity, arguing that the term therefore fails to immediately convey the idea of "commercial copying services" or "commercial printing services." Applicant points to the dictionary definition of "solution," arguing that the definition

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<sup>3</sup> Applicant, in its brief in the '801 application, incorrectly states that "the "sole issue" on appeal is whether the word SOLUTIONS is merely descriptive.

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"is devoid of any reference or suggestion to applicant's particular services." Applicant also relies on *In re Hutchinson Technology*, 852 F.2d 552, 7 USPQ2d 1490 (Fed. Cir. 1988); and two non-precedential Board cases involving the term SOLUTIONS, *In re Acquisition Solutions, Inc.*, WL 363389 (TTAB 2005) and *In re Idatech*, WL 1090651 (TTAB 2004). In addition, applicant submitted 226 third-party pending applications and registrations for services involving or related to copying or printing services claiming that in "roughly 80% of records" the word "solutions" is not disclaimed, and speculating that "the remaining 20% elected to disclaim the wording 'solutions' rather than spend the time or money to traverse the disclaimer requirement." Applicant concludes from this evidence that the "prevailing view" of the Office supports registration of the phrase without a disclaimer of SOLUTIONS.

A term is merely descriptive within the meaning of Section 2(e)(1) if it immediately conveys knowledge of a quality, characteristic, function, feature, purpose or use of the goods or services with which it is used or intended to be used. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). Moreover, the question of whether a particular term is merely descriptive must be determined not in the abstract, but in relation to the goods or services for which registration is

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sought. See *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986).

Applicant is providing "commercial printing services" and "commercial copying services" under the mark PROSIT PRINT SOLUTIONS. We agree with the examining attorney that in the context of those services the phrase PRINT SOLUTIONS immediately describes a significant function, purpose or intended result of the services.

We take judicial notice of relevant definitions of "print" from *Microsoft Encarta College Dictionary* (2001) as "1 MAKE SOMETHING WITH PRINTING MACHINE to make a copy, document or publication using a printing press or a computer printer - *These books were printed in Canada.* 2 PUBLISH to publish information or a publication - *The company prints several news magazines in addition to books.*"<sup>4</sup> The dictionary listing submitted by the examining attorney from *The American Heritage Dictionary of the English Language* (3rd ed. 1992) (electronic version) defines "copy" as "One specimen or example of a printed text or picture." Thus, the descriptive meaning of the term PRINT in relation to printing services is clear, and it encompasses the service of copying documents.

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<sup>4</sup> The Board may take judicial notice of dictionary definitions. See, e.g., *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

In the dictionary listing supplied by applicant, "solution" is defined as "3. The method or process of solving a problem. 4. The answer to or disposition of a problem."<sup>5</sup> Thus, the phrase PRINT SOLUTIONS as a whole, directly informs applicant's customers that applicant can solve their problems concerning print projects (which would include copying documents), and the results they can expect to achieve from applicant's printing and copying services. The fact that applicant's particular services are not mentioned in the definition of "solution" is irrelevant. There is no requirement that the definition identify every conceivable example of a solution in order to find the term descriptive. The issue is not the descriptive meaning of SOLUTIONS alone, but rather whether PRINT when combined with SOLUTIONS is descriptive. See *In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537 (TTAB 1998) (finding applicant's contention that the term "services" in the phrase PATENT & TRADEMARK SERVICES, INC. is so broad that the phrase cannot be held merely descriptive unpersuasive "because the term 'services' in the phrase does not stand alone but rather is *modified* and defined by the words 'patent & trademark.'" *Emphasis in original*). There is no question that the ordinary meaning of the word "solutions"

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<sup>5</sup> Applicant identified the source of this listing as "*The American Heritage Dictionary* (2d Col. ed.) at 1164." A copy of the entry itself has not been provided and we were unable to locate that source. However, we note that the same definition appears in *The American Heritage Dictionary of the English Language* (2003) (xreferplus.com) and we take judicial notice of its content.

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would be well understood in the context of the phrase PRINT SOLUTIONS, for printing and copying services.

The meaning of PRINT SOLUTIONS is also made clear from the descriptive references to that phrase in the brochure submitted as a specimen submitted with the application. The brochure informs applicant's customers that applicant is a "FULL SERVICE PRINT PROVIDER" that "CAN SOLVE ALL YOUR PROBLEMS" and, as noted earlier, "solution" is defined as the method or process of "solving a problem." In addition, the wording "print solutions" is depicted throughout the brochure in much smaller, lower case letters beneath the large capital letters of "PROSIT," clearly conveying the impression of informational matter. The page from applicant's website (prositweb.com) submitted by the examining attorney states "...Let Prosit be your printing solution." As used and referred to in applicant's promotional materials, the wording PRINT SOLUTIONS would clearly be perceived by applicant's customers as a descriptive term. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978) ("Evidence of the context in which a mark is used ... in advertising material ... is probative of the reaction of prospective purchasers to the mark"); and *In re Educational Communications, Inc.*, 231 USPQ 787, 790 (TTAB 1986) ("applicant's own highly descriptive usages of the components of its asserted mark ... is strong evidence of its generic nature").

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We note, in addition, the 13 use-based, third-party registrations submitted by the examining attorney for marks in similar fields containing disclaimers of SOLUTIONS or where the marks are registered under Section 2(f) or on the Supplemental Register. For example, in Registration No. 2475166 for the mark OUTPUT TECHNOLOGY SOLUTIONS for commercial printing services, "Technology Solutions" is disclaimed; in Registration No. 2303416 for the mark CREATIVE AUTOMATION SOLUTIONS for desktop publishing for others, "Automation Solutions" disclaimed; in Registration No. 2786687 for the mark IKON OFFICE SOLUTIONS for copying, finishing and binding documents, "Office Solutions" disclaimed; and Registration No. 2619924 for the mark LANDMARK COLOUR COMMUNICATIONS INTEGRATED PRINTING SOLUTIONS for color printing of brochures, "Colour Communications Integrated Printing Solutions" is disclaimed. While not conclusive, this evidence clearly suggests that when used in certain contexts, the term has a descriptive meaning and would be perceived by purchasers as a descriptive term. "Such third party registrations show the sense in which the word is used in ordinary parlance and may show that a particular term has descriptive significance as applied to certain goods or services." *Institut National Des Appellations D'Origine v. Vintners International Co.*, 958 F.2d 1574, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992). See also *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006) ("Third-party registrations can

be used in the manner of a dictionary definition to illustrate how a term is perceived in the trade or industry").

Applicant's evidence of the third-party registrations and applications, on the other hand, is not particularly useful to the analysis.<sup>6</sup> First, the records are incomplete. They do not indicate whether the mark is registered on the Principal or Supplemental Register, or whether the mark is registered under Section 2(f). Thus, these records are of no probative value. We also point out that the third-party applications and cancelled registrations, which together constitute a substantial portion of the records submitted by applicant, have no probative value on the issue of registrability. They are evidence only of the fact that the application/registration was filed on a certain date.

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<sup>6</sup> Applicant did not properly introduce these applications and registrations. They are not official records of the USPTO but rather were obtained from a private company's database (trademark.com) and there is nothing to indicate the accuracy or reliability of the information contained the database. Nevertheless, because the examining attorney did not object to this evidence and in fact has treated it on the merits we have considered it as stipulated into the record. On the other hand, Applicant attached over 400 pages of evidence to its brief which we have not considered. Applicant makes no reference to the evidence in its brief, but it appears to consist of full document printouts of third-party applications and registrations which may or may not have been previously submitted. The examining attorney's objection to this evidence is well taken. Applicant should have submitted this evidence prior to appeal. The evidence was filed after the record in this case was closed and it is therefore untimely. See Trademark Rule 2.142(d). Even if we had considered this evidence, as discussed infra, it would not change our decision in this case. We also point out that the listing of third-party applications and registrations accompanying applicant's response to the first Office action which was obtained from the USPTO's TESS database, is of no probative value for what applicant is attempting to show because in addition to lack of information about the register, the list fails to include the goods or services.

Furthermore, even assuming that all of the third-party registrations are registered on the Principal Register with no Section 2(f) claim, the evidence would still not be persuasive. It is well settled that each case must be decided on its own facts, based on the particular mark, the particular goods or services, and the particular record in each application. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); and *In re Scholastic Testing Services, Inc.*, 196 USPQ 517 (TTAB 1977). We are not privy to the records in those cases or what went into the determination that the marks were registrable. Moreover, the fact that SOLUTIONS was not disclaimed or found descriptive in those third-party marks does not compel a finding that SOLUTIONS is not descriptive in the context of this mark. See *In re Nett Designs*, *supra* at 1566, observing that a term "may tilt toward suggestiveness or descriptiveness depending on context and any other factor affecting public perception." We note, for example, that in a number of the registrations, the combination of SOLUTIONS with another term results in a mark which is, in its entirety, a nondescriptive or unitary term that simply has no direct meaning in relation to the identified services. For example, Registration No. 2895452 for the mark MILLIONS OF PAGES. ONE SOLUTION; Registration No. 2872641 for the mark BUNDLED SOLUTION; Registration No. 2818765 SOLUTIONS FOR YOUR SCIENCE; Registration

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No. 2700802 for the mark OPTIMUS SOLUTIONS; and Registration No.2159274 for the mark SINGLE SOURCE, MULTIPLE SOLUTIONS.

Nevertheless, even to the extent the marks in these prior registrations have some characteristics similar to applicant's application, as our primary reviewing court stated in *In re Nett Designs Inc.*, at 1566, "the PTO's allowance of such prior registrations does not bind the Board or this court."

We also point out that this evidence fails to establish any "prevailing view" of the Office that SOLUTIONS is not descriptive. As stated in *In re First Draft, Inc.*, 76 USPQ2d 1183, 1188 (TTAB 2005) "even proof that various examining attorneys have registered a particular type of mark in the past does not establish that there is an Office practice holding such marks are generally registrable."

Applicant's reliance on *Hutchinson Technology*, and the two non-precedential decisions, *Acquisition Solutions* and *Idatech*, in support of its contention that SOLUTIONS is too broad and vague to be merely descriptive is misplaced. To begin with, decisions not designated as precedential are not binding on the Board. Further, all of the cited cases are distinguishable on their facts. In *Hutchinson Technology* at 1493, the Federal Circuit noted that the Board, in finding "technology" descriptive of applicant's goods, relied solely on applicant's concession that "technology" is used on many goods similar to those in the

application, and that the Board "offered no other evidence to support its findings on the effect of the inclusion of 'technology' in Hutchinson's mark as a whole." In the present case, however, the record includes dictionary definitions and promotional materials demonstrating the meaning and perception of the phrase by the relevant public, as well as third-party registrations wherein the word has been treated as descriptive for similar services. We also note that, notwithstanding the Court's finding in that case, the Court still required applicant to submit a disclaimer of "Technology."

In *Acquisition Solutions*, involving the mark ACQUISITION SOLUTIONS TRAINING INSTITUTE for "training services," the Board stated that applicant was not literally providing "acquisition solutions" but rather "training services," and thus found that the mark was one step removed from describing the services. That extra step does not exist here. In this case, there is an direct and immediate relationship between applicant's mark and its services. Applicant is providing PRINT SOLUTIONS for printing problems.

Finally, unlike *Idatech*, where the Board found that ADVANCED FUEL CELL SOLUTIONS was not descriptive of electrical power generation goods and services because, based on the record, the meaning of SOLUTIONS in the context of a "FUEL CELL" was unclear,

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as explained earlier, the information conveyed by PRINT SOLUTIONS in the context of applicant's services is quite clear.

None of the cited cases compel a finding in this case or in any given case that the word "solutions" is too broad and vague to be found descriptive. In fact, there is at least one reported decision holding that "solutions" is descriptive. See *In re Box Solutions Corp.*, 79 USPQ2d 1953 (TTAB 2006) (finding SOLUTIONS in the mark BOX SOLUTIONS merely descriptive of computer hardware and requiring a disclaimer of the term).

We find that purchasers of applicant's commercial printing and copying services would, without any guesswork or the exercise of any imagination, immediately understand the descriptive meaning of PRINT SOLUTIONS as applied to those services.

**Decision:** The refusal to register in both applications is affirmed. However, in the event that applicant submits the required disclaimer of PRINT SOLUTIONS in each application within thirty days from the mailing date of this decision, the refusal to register will be set aside and the applications will proceed to publication.<sup>7</sup> See Trademark Rule 2.142(g).

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<sup>7</sup> A proper disclaimer would read: "No claim is made to the exclusive right to use PRINT SOLUTIONS apart from the mark as shown."