

THIS OPINION IS NOT A  
PRECEDENT OF THE  
TTAB

Hearing:  
14 October 2008

Mailed:  
22 December 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Certified Printers, Inc.  
v.  
Crouser & Associates, Inc.

Opposition No. 91167709  
to application Serial No. 78365504

John Joseph Hall, Esq. for Certified Printers, Inc.

Harvey Freedenberg of McNeese Wallace & Nurick LLC for  
Crouser & Associates, Inc.

Before Holtzman, Drost, and Kuhlke, Administrative Trademark  
Judges.

Opinion by Drost, Administrative Trademark Judge:

On February 10, 2004, Crouser & Associates, Inc.  
(applicant) filed an application to register the mark shown  
below on the Principal Register for the following goods and  
services.



Computer software for creating searchable databases of information and data in the field of printing in Class 9

Paper goods and printed matter, namely, guides, pricing guides, instructional and training manuals and materials, books, reports, teaching and educational materials, publication paper, survey answer sheet, study guides, all in the field of printing in Class 16

Conduct marketing, advertising and public relations on behalf of participants; arranging and conducting business meetings, conferences, conventions for participants; group purchasing, namely buying clubs and functioning as purchasing agents, and conducting business research; market and sales research for and about small printers; providing on-line retail store services through an Internet web site featuring multimedia materials resources in the nature of surveys, studies, videos, CD's, DVD's and interactive computer programs in the field of printing in Class 35

Providing Internet web site featuring printing information for customers, potential customers, workers and potential workers in Class 40

Publication of books, magazines, surveys, plans, programs, and studies in the field of printing; electronic publishing services, namely, publication of text and graphic works of others on videos, CD's and DVD's in the field of printing; training services in the field of printing and distributing course materials, books and reports in connection therewith; educational services, namely, conducting seminars and courses in the field of printing; provide training to workers and customers in the field of printing for small printers in Class 41.<sup>1</sup>

The application is based on applicant's allegation of a bona fide intention to use the mark in commerce. Serial No.

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<sup>1</sup> With its notice of opposition, opposer's attorney submitted a cover sheet that explained that it was enclosing a "check for the filing fee of \$1,200 for the following 4 classes: 016, 035, 040, and 041." Therefore, the opposition does not extend to the goods in Class 9, and that class will issue regardless of the outcome for the other classes.

78365504. Applicant has disclaimed the words "Certified Printers International."

On November 4, 2005, Certified Printers, Inc. (opposer) filed an opposition to the registration of applicant's mark. In the notice (pp. 2 and 4), opposer alleges that:

[F]or many years and since long prior to any date of first use or intended use upon which Applicant can rely, [opposer] has adopted and continuously used the term CERTIFIED PRINTERS as a service mark for copying of documents for others, in class 035, and print shop services, namely printing, binding, embossing, foil stamping, and design printing for others in Class 040, and these services have been offered to customers and used by customers throughout the United States, and has also for many years and since long prior to any date of first use or intended use upon which Applicant can rely, has adopted and has continuously used the trade name CERTIFIED PRINTERS for its printing business...

On March 15, 2004, Opposer filed an application to register the service mark CERTIFIED PRINTERS on the principal register of the U.S. Patent and Trademark Office under Serial Number 76/581663 for the services stated in Paragraph 1 above based on Section 1(a) of the Trademark Act. Although in the office action of April 21, 2005, the examiner of Opposer's application has accepted Opposer's claim of acquired distinctiveness of its mark CERTIFIED PRINTERS under Section 2(f) of the Trademark Act, on October 21, 2005, the examiner suspended Opposer's application pending the disposition of Applicant's application under Serial Number 78365504 based on a potential conflict between the relevant applications according to the examiner.

Applicant has denied the salient allegations of opposer's notice of opposition. An oral hearing was held on October 14, 2008.

The Record

The record consists of the file of the opposition; the testimonial deposition of opposer's Vice-President, Michael Druyen, with exhibits; opposer's six testimonial depositions of its customers (Nita Alvarez, Russell Friedman, Leron Gubler, Richard A. Jolson, Howard Kack, and Eugene Montanez); opposer's notices of reliance on applicant's responses to its interrogatories and requests for admissions and its application; applicant's testimonial deposition of Thomas P. Crouser, applicant's President and Chief Executive Officer, with exhibits; and applicant's notice of reliance on various USPTO records<sup>2</sup> and on opposer's discovery responses.

Background

Michael Druyen, opposer's vice president, bought a "company called Certified Printers. I bought that in 1981 and it had a facility on Melrose Avenue in Los Angeles and they specialized in selling Fannie Mae and Freddie Mac mortgages and appraisal forms and general printing." Druyen test. dep. at 12. The business was using the "service mark Certified Printers on its printing jobs" at the time Mr. Druyen bought the business. *Id.* at 12. Opposer has continued to use the service mark and trade name CERTIFIED

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<sup>2</sup> We have not considered applicant's registration (No. 3127605) because it was not submitted in accordance with TBMP § 704.03(b)(1)(A) (2d ed. rev. 2004).

PRINTERS to the present time. Druyen test. dep. at 15 and Exhibits 5 and 21. See also Druyen Ex. 22 (County of Los Angeles Public Health Licenses (1992 and 1993) to "Certified Printers") and Ex. 24 (City of Los Angeles Business Tax Registration Certificate dated October 1, 1981, issued to Michael Druyen of Certified Printers).

Thomas Crouser, applicant's president, testified that he is one of fifteen people employed by Crouser & Associates. Crouser test. dep. at 7-8. Applicant has "a franchise in printing business ... with 115 affiliates in the US and Canada." Crouser test. dep. at 9. Applicant "began using the mark in January of 2004." Crouser test. dep. at 15. "Applicant permits its franchisees to use its trademarks, operational marketing, and selling systems in the operation of their commercial printing companies." Brief at 2.

#### Standing

Opposer has submitted testimony and evidence that it has operated a printing company called "Certified Printers" since before applicant's filing date. See also Applicant's Brief at 3 (Applicant admits that "[s]ince 1981, Opposer Certified Printers, Inc. has operated a Los Angeles company called Certified Printers that specializes in selling Fannie Mae and Freddie Mac mortgage and appraisal forms and general printing under the service mark CERTIFIED PRINTERS"). Also,

opposer has submitted evidence that its application (No. 76581663) for the mark CERTIFIED PRINTERS has been suspended in view of application No. 78365504. See Druyen Exhibits 40 and 41. This evidence establishes opposer's standing to oppose the application at issue in this proceeding. *Tri-Star Marketing LLC v. Nino Franco Spumanti S.R.L.*, 84 USPQ2d 1912, 1914 (TTAB 2007).

#### Issues

The following issues have been tried by the parties:

Whether applicant's mark CPRINT CERTIFIED PRINTERS INTERNATIONAL and design for the applied-for goods and services is confusingly similar to opposer's services identified by the service mark or trade name CERTIFIED PRINTERS?

Is applicant's mark CPRINT CERTIFIED PRINTERS INTERNATIONAL and design merely descriptive?

Has opposer's CERTIFIED PRINTERS mark acquired distinctiveness?

#### Priority and Descriptiveness

We will now look at the question of priority and the related issue of descriptiveness of the marks.

Applicant's application was filed on February 10, 2004. An applicant can rely on the filing date of an intent-to-use application as its priority date. *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542, 1544 (TTAB

1991) (“[T]here can be no doubt but that the right to rely upon the constructive use date comes into existence with the filing of the intent-to-use application and that an intent-to-use applicant can rely upon this date in an opposition brought by a third party asserting common law rights”). While applicant’s witness testified that it began using the mark in January 2004, even if we accepted this date, it would not change our priority determination.<sup>3</sup>

We next look at opposer’s priority date. Opposer alleges use as both a trade mark (service mark) and as a trade name. To the extent that it is relying on the trade name use, we note that Court of Customs and Patent Appeals addressed this issue in *Alfred Electronics v. Alford Mfg. Co.*, 333 F.2d 912, 142 USPQ 168, 172 (CCPA 1964), where it held:

Under Section 2(d), a trademark is not entitled to registration where it so resembles a mark or trade name previously used by another as to be likely to cause confusion, or to cause mistake, or to deceive. That section does not specify that a trade name must be inherently distinctive or that it must have acquired a secondary meaning to be effective as a bar to registration and we find no basis for adopting an interpretation imposing such a requirement.

*Accord Books on Tape Inc. v. The Booktape Corp.*, 836 F.2d 519, 5 USPQ2d 1301, 1303 (Fed. Cir. 1987) (“The statute does not require the anomalous result that a junior user is

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<sup>3</sup> Applicant points to its third set of supplemental answers as alleging a January 21, 2004, date. Again, this would not change our determination.

entitled to keep its Supplemental Registration for a descriptive term in which it has not established secondary meaning (as evidenced by registration on the Supplemental Register) because a prior user cannot show secondary meaning in that term either... [O]nce the issue of genericness is out of the case, the evidence of record here amply supports petitioner's claim that it has established a trade identity in 'Books on Tape' as its company name").

Therefore, regarding opposer's trade name CERTIFIED PRINTERS, we find that it began using the trade name in the early 1980's and its priority date would be well before applicant's priority date.

Regarding opposer's service mark in the same term, in order for it to prevail on a claim of likelihood of confusion based on its ownership of common law rights in a mark, opposer must prove that its trademark is distinctive, inherently or otherwise, and plaintiff must show priority of use. See *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 44 (CCPA 1981) ("[I]t is equally clear that if an opposer's alleged means of trade designation is not distinctive -- does not identify source -- then there is no basis upon which to compare such a thing with the applicant's mark to determine whether confusion as to source is likely").

Under the rule of *Otto Roth*, a party opposing registration of a trademark due to a likelihood of

confusion with his own unregistered term cannot prevail unless he shows that his term is distinctive of his goods, whether inherently or through the acquisition of secondary meaning or through "whatever other type of use may have developed a trade identity." *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d at 1320, 209 USPQ at 43. The *Otto Roth* rule is applicable to trademark registration cancellation proceedings as well.

*Towers v. Advent Software Inc.*, 913 F.2d 942, 16 USPQ2d 1039, 1041 (Fed. Cir. 1990).

We begin by looking at whether the term CERTIFIED PRINTER is inherently distinctive. The word "Certified" has often been held to be at least a merely descriptive term in connection with a variety of goods and services. *American Angus Association v. Sysco Corp.*, 829 F. Supp. 807, 27 USPQ2d 1921, 1925 (W.D.N.C. 1993) (The "word 'certified' describes the words 'angus beef,' which, of course, identify the product. Thus, while the 'angus beef' portion of the term may indeed be generic, the phrase as a whole is descriptive of the product"); *In re 88Open Consortium Ltd.*, 28 USPQ2d 1314, 1316 (TTAB 1993) ("[T]he words COMPATIBILITY CERTIFIED are descriptive"); *In re Eden Foods Inc.*, 24 USPQ2d 1757, 1761 (TTAB 1992) ("Accordingly, because the term 'DOUBLE CERTIFIED ORGANIC' conveys forthwith the notion that its goods are doubly certified as an organic food product, applicant's mark is merely descriptive of pasta"); *In re Mortgage Bankers Association of America*, 226 USPQ 954, 956 (TTAB 1985) ("[A]pplicant's services comprise

an examination and testing procedure for mortgage banker[s], the successful completion of which 'certifies' that is, that he or she has achieved a certain level of quality of fitness in the mortgage banking field. In our view, the designation sought to be registered [CERTIFIED MORTGAGE BANKER] is so highly descriptive of applicant's services, which essentially are the providing of a certification program for mortgage bankers, as to be incapable of identifying the source of those services"); and *In re Professional Photographers of Ohio, Inc.*, 149 USPQ 857, 859) (TTAB 1966) ("[W]e believe that the designation 'CERTIFIED PROFESSIONAL PHOTOGRAPHER' is highly descriptive if not incapable of distinguishing a professional photographer certified to by applicant from professional photographers that may be certified to by other organizations or associations").

Opposer does not contest that its mark is merely descriptive. See Brief at 11 ("Whether Incorporation by Applicant of Opposer's Entire Acquired Distinctive Mark Certified Printers into Applicant's Mark Causes Applicant's Mark to be Substantially similar to Opposer's Mark...") and Reply Brief at 16 ("Opposer's Service Mark CERTIFIED PRINTERS Has Acquired Distinctiveness Under Section 2(f)"). In its application for the mark CERTIFIED PRINTER, which helps to provide opposer's standing, opposer has amended its application to seek registration under Section 2(f), which

is an admission that the mark is merely descriptive. *Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988) ("Where, as here, an applicant seeks a registration based on acquired distinctiveness under Section 2(f), the statute accepts a lack of inherent distinctiveness as an established fact"). Previously, the Commissioner, now Director, and the board relied on the following definition of "certified" in holding that the term "certified" was at least merely descriptive: "in Webster's New International Dictionary, which is the same as the definition in Webster's Third New International Dictionary (G. & C. Merriam Co., 1965) at page 367: 'certified: guaranteed or attested as to quality, qualifications, fitness, or validity.'" *In re Certified Burglar Alarm Systems*, 191 USPQ 47, 49 (TTAB 1976), quoting, *Ex parte William B. Ogush, Inc.*, 83 USPQ 400 (Comm'r Pat. 1949). We agree that the term "certified" would have a similar laudatory meaning for opposer's printing-related services and therefore, in order for it to have priority for its service mark use opposer must establish the date that its mark has acquired distinctiveness.

Despite the examining attorney's acceptance of the claim for acquired distinctiveness in the opposer's application, we must still determine whether opposer's common law mark CERTIFIED PRINTERS has acquired

distinctiveness. We point out that opposer, as the party asserting that its mark has acquired distinctiveness, has the burden of demonstrating secondary meaning. *Tone Brothers Inc. v. Sysco Corp.*, 28 F.3d 1192, 31 USPQ2d 1321, 1327 (Fed. Cir. 1994) (Opposer, "as the party attempting to establish legal protection for its unregistered trade dress, has the burden of proving secondary meaning by a preponderance of the evidence"). See also *Perma Ceram Enterprises Inc. v. Preco Industries Ltd.*, 23 USPQ2d 1134, 1136 (TTAB 1992) ("[W]here the mark relied upon by a plaintiff in support of its priority of use and likelihood of confusion claim is merely descriptive (or deceptively misdescriptive), then the plaintiff must establish priority of acquired distinctiveness"). Opposer must demonstrate that the term has acquired distinctiveness prior to applicant's priority date of February 10, 2004. *Id.*

Various types of evidence can be considered to determine if a mark has acquired distinctiveness. *Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc.*, 973 F.2d 1033, 24 USPQ2d 1161, 1166 (2d Cir. 1992) ("Among the factors that we have found relevant to this inquiry in the past are advertising expenditures, consumer studies, sales success, unsolicited media coverage, attempts to plagiarize and length and exclusivity of use. ... There are undoubtedly other types of

evidence that would also be relevant to a claim of secondary meaning." ).

Opposer argues that it has been using its mark for more than twenty years. Regarding opposer's evidence of secondary meaning, we quote from opposer's publicly-available Reply Brief, p. 15<sup>4</sup> for the facts regarding its use:

The invoices show interstate sales of Opposer's services from 1992 to 2006 under its service mark and trade name in 37 states of the U.S. Exhibit 46, PP. 4 and 5. MD CON Depo [Michael Druyen confidential testimony deposition], vol. 2, P. 193, LL. 1-19.

Opposer's gross receipts from sales of its services for the years 2001-2006 totaled over \$5 million. MD CON Depo, vol. 2, P. 139, LL. 3-24.

Opposer's advertising expenditures during 1989-2005 were over \$120,000. MD CON Depo, vol. 1, P. 114.

Opposer has also submitted six depositions of its customers (Nita Alvarez, Russell Friedman, LeRon Gubler, Richard A. Jolson, Howard Kack, and Eugene Montanez). These witnesses testified to opposer's long use of the mark CERTIFIED PRINTERS and their experience with opposer. See, e.g., Kack dep. at 7:

Q. Do you know of any other printer that uses the mark Certified Printers than the one of Hollywood?

A. No...

Q. When you see or hear the mark Certified Printers, to whom do you think it goes to?

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<sup>4</sup> See TTAB's TTABVUE database for Opp. No. 91167709, Entry No. 39.

A. I think of Certified Printers in Hollywood, California, Michael Druyen and Nureet [Michael Druyen's wife] as the proprietors.

In addition, these customers testified that they recognize the name of the party with which they have done business and they have confirmed opposer's long term use of its service mark. See, e.g., Alvarez dep. at 5 (15 or 16 years) and Gubler dep. at 6 (at least 15 years). This testimony is not insignificant.

Although those twenty-one companies all have a business relationship with appellant and the form which the responses took were conceived by appellant, there is no reason for us to believe that the officers of those companies failed to tell the truth in order to help appellant prove its case... When we follow that course here we can only conclude that appellant has satisfactorily shown that its mark has acquired secondary meaning within the purview of section 2(f) of the Lanham Act. Even though the number of questionnaires and letters is not great, since there is no evidence to the contrary and the results of the survey do not seem unlikely when the design itself and the length of time it has been used by appellant are considered, we are satisfied that appellant has shown secondary meaning and as such is entitled to have its design registered upon the principal register.

*In re Schenectady Varnish Co.*, 280 F.2d 169, 126 USPQ 395, 397 (CCPA 1960).

When we consider the evidence of record, we conclude that opposer has shown that its mark CERTIFIED PRINTERS has acquired distinctiveness for its printing shop services. We first note that opposer's "burden of showing acquired distinctiveness increases with the level of descriptiveness; a more descriptive term requires more evidence of secondary

meaning. *In re Bongrain Intern. (Am.) Corp.*, 894 F.2d 1316, 1317, [13 USPQ2d 1727] (Fed. Cir. 1990) ('the greater the degree of descriptiveness the term has, the heavier the burden to prove it has attained secondary meaning')."

*In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005). In this case, there is little evidence that the term "Certified Printers" is highly descriptive for opposer's services, so we do not place a very heavy evidentiary burden on opposer. Section 2(f) of the Trademark Act (15 U.S.C. § 1052)) provides that the "Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made"). Here, opposer has been using the mark for more than twenty years and there is little evidence that any other entity uses the term for similar services.<sup>5</sup> This lack of evidence reinforces the conclusion that opposer's mark is not highly descriptive. As we discussed above, we have also considered the testimony of opposer's long use of the mark in

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<sup>5</sup> See, e.g., *Druyen* test. dep. at 168-69 ("I typed in Google Certified Printers, and there were two individual companies that came up under the name Certified Printers. The first one I clicked on was my company name. The second one I clicked on was

association with opposer's services. In addition, while opposer operates primarily in Southern California, it advertises on a broader scale. Druyen test. dep. at 33 (The "[m]ajority went to Southern California, but we had sent copies of these [marketing brochures] to customers throughout the United States"). See also Druyen test. dep. at 34 ("some go throughout the United States wherever our clients are"). It has customers throughout the United States. Druyen Exhibits 48 and 49. In addition, in the years prior to applicant's filing date, its revenues have approached about \$1 million per year and it has spent thousands of dollars on advertising that has resulted in thousands of customers. The evidence convinces us that opposer has met its burden of showing that its mark CERTIFIED PRINTERS has acquired distinctiveness for its printing shop services. Specifically, we find that opposer's mark has acquired distinctiveness at least as early as December 2003, prior to any actual or constructive priority date of applicant.

We also briefly consider opposer's argument that applicant's term CPRINT is merely descriptive. Opposer points to the statement of applicant's witness that:

CPRINT is the trademark and Certified Printers International is merely a description of that word so that people will have a better understanding of it...

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Goodcopy Printing Center [using CPRINT Certified Printers International]). See also Druyen test. dep. at 174-75.

If you take it all apart, C stands for Certified, P-R stands for Printers, and the I-N-T stands for International, CPRINT Certified Printers International, the contraction is the acronym CPRINT.

Reply Brief at 2, *quoting*, Crouser dep. at 35.

Opposer argues that the "above testimony is undisputed and constitutes an admission that the CPRINT portion of Applicant's mark is merely descriptive and has the same meaning as the CERTIFIED PRINTERS INTERNATIONAL portion of Applicant's mark... [T]his admission alone establishes the descriptive meaning of the CPRINT portion of Applicant's mark in the printing business." Reply Brief at 2.

The Court of Customs and Patent Appeals, one of the predecessors of our principal reviewing court, has discussed the question of whether letters that correspond to the initial letters of a descriptive combination of words are similarly descriptive in *Modern Optics, Inc. v. Univis Lens Co.*, 234 F.2d 504, 110 USPQ 293, 295 (CCPA 1956) (citations omitted):

The letters "CV" are, of course, the initial letters of the words "continuous vision," and it is possible for initial letters to become so associated with descriptive words as to become descriptive themselves. It does not follow, however, that all initials or combinations of descriptive words are ipso facto unregistrable. While each case must be determined on the basis of the particular facts involved, it would seem that, as a general rule, initials cannot be considered descriptive unless they have become so generally understood as representing descriptive words as to be accepted as substantially synonymous therewith.

*See also Racine Industries Inc. v. Bane-Clene Corp.*, 35 USPQ2d 1832, 1838 (TTAB 1994) ("There is no question that, in the present case, the language 'professional cleaners' association' merely describes, and in fact would be a generic designation for, any organization or association whose membership consists of professional cleaners of any sort, such as professional carpet cleaners. Nevertheless, as pointed out by applicant, the evidence is simply lacking that the acronym 'PCA' is understood by the relevant public ... to refer generally to any of the trade associations or other membership groups in the carpet cleaning industry").

In this case, applicant's witness has indicated that the term CPRINT derived from the words Certified Printers International, however, that is not an admission that the term is merely descriptive. For example in *Racine* (35 USPQ2d at 1836), the term PCA was not merely descriptive even though the applicant "uses the term 'PCA' as an acronym for an organization which is presently known as the Professional Cleaners Association." *See also Modern Optics*, 110 USPQ at 295 ("It does not follow, however, that all initials of combinations of descriptive words are ipso facto unregistrable"). While opposer relies on the case of *Spin Physics, Inc. v. Matsushita Electric Industrial Co.*, 168 USPQ 605 (TTAB 1970), the case is readily distinguishable. In that case, an employee of the applicant wrote a paper in

which he referred to the generic product (hot-pressed ferrite) as HPF as opposed to other types of ferrite such as single-crystal ferrite (SCF). This evidence showed that the term HPF was used as a generic designation. In the present case, there is no evidence that the term CPRINT is used by applicant as anything other than a designation of its services. The fact that applicant acknowledges that the letters in its mark derived from descriptive terms is not enough under *Modern Optics* to establish that the term is merely descriptive.

Therefore, we reject opposer's argument that "the total descriptiveness of Applicant's mark is established." Reply Brief at 6. Instead, we find that applicant's mark, as a whole, is not merely descriptive.

#### Likelihood of Confusion

The final question in this case is whether there is a likelihood of confusion. In these cases, we analyze the facts as they relate to the relevant factors set out in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). See also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003) and *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000).

We begin by looking at the parties' marks. This "DuPont factor requires examination of 'the similarity or

dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.'" *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). Opposer's mark is CERTIFIED PRINTERS, without any distinctive design, while applicant's mark consists of the words CPRINT CERTIFIED PRINTERS INTERNATIONAL and the design shown below.



In this case, the marks contain the identical words CERTIFIED PRINTERS, while applicant also adds the term CPRINT in larger letters as well as the separate word INTERNATIONAL and an oval design. While applicant has disclaimed the words "Certified Printers International," this disclaimer does not remove the words from consideration in our likelihood of confusion analysis. *In re Shell Oil Co.*, 26 USPQ2d 1687, 26 USPQ2d 1687, 1688-89 (Fed. Cir. 1993) ("Shell argues that the words are common dictionary words, and that since Shell filed a disclaimer of the words 'Right-A-Way', the only issue of registration relates to the script and the arrow design. The Board correctly held that the filing of a disclaimer with the Patent and Trademark

Office does not remove the disclaimed matter from the purview of determination of likelihood of confusion"). See also *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ("The technicality of a disclaimer in National's application to register its mark has no legal effect on the issue of likelihood of confusion").

While CPRINT is in larger letters than the other wording in the mark, we have already discussed that applicant explained that it formed the word from the initial letters of the words Certified Printers International. These words are also contained in applicant's mark. Furthermore, the words "Certified Printers" appear prominently at the top of applicant's mark in the oval without any other words on the same line. Indeed, prospective purchasers reading the mark from top down would encounter these words first. The oval itself adds little to the commercial impression of the mark. *B.V.D. Licensing Corp. v. Rodriguez*, 83 USPQ2d 1500, 1508 n.23 (TTAB 2007) ("Plain geometric designs, such as the oval carrier or frame for the design of a man wearing a sombrero would not be seen by consumers as a particularly distinctive element of applicant's mark").

When we consider the marks CERTIFIED PRINTERS and CPRINT CERTIFIED PRINTERS INTERNATIONAL and design in their entirety, we find that they are more similar than they are

different. The identical nature of the words CERTIFIED PRINTERS portion creates marks that are similar. The additional words in applicant's mark are "International," which simply suggests an international branch or version of CERTIFIED PRINTERS, and CPRINT, which is a compression of the words, would not distinguish the marks. Indeed, the CPRINT portion indeed may suggest to some purchasers that the previous user of the mark CERTIFIED PRINTERS has now collapsed the words into one, especially since the words "Certified Printers" appear separately from the word "International."

Next, we look at the parties' goods and services. Opposer's services are printing shop services and its trade name is used to identify its print shop business. Applicant's goods and services at issue are:

Paper goods and printed matter, namely, guides, pricing guides, instructional and training manuals and materials, books, reports, teaching and educational materials, publication paper, survey answer sheet, study guides, all in the field of printing in Class 16

Conduct marketing, advertising and public relations on behalf of participants; arranging and conducting business meetings, conferences, conventions for participants; group purchasing, namely buying clubs and functioning as purchasing agents, and conducting business research; market and sales research for and about small printers; providing on-line retail store services through an Internet web site featuring multimedia materials resources in the nature of surveys, studies, videos, CD's, DVD's and interactive computer programs in the field of printing in Class 35

Providing Internet web site featuring printing information for customers, potential customers, workers and potential workers in Class 40

Publication of books, magazines, surveys, plans, programs, and studies in the field of printing; electronic publishing services, namely, publication of text and graphic works of others on videos, CD's and DVD's in the field of printing; training services in the field of printing and distributing course materials, books and reports in connection therewith; educational services, namely, conducting seminars and courses in the field of printing; provide training to workers and customers in the field of printing for small printers in Class 41.

Opposer (Brief at 28, citations to record omitted)

argues that applicant's "franchisees are authorized to use Crouser's mark on their own websites and practically 100% of them operate websites for their business. The franchisees are permitted and encouraged to use and display Crouser's mark on their website." Opposer points out that one of applicant's franchisees (Goodcopy) provides the same services (printing, copying, bindery, and graphics) as opposer. *Id.* Applicant makes similar arguments about other printers that are associated with applicant. Brief at 31-32.

We must consider applicant's goods and services as they are set out in the identification of goods and services. *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the

identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed"). Therefore, we are only concerned about the goods and services that applicant has identified in its application and not the services its franchises may be providing.

Opposer also argues that "his printing business uses its service mark and trade name: 1. for services listed in Class 035 ... 2. for services listed in Class 040 ... 3. for services listed in Class 041." Brief at 35.<sup>6</sup> Applicant responds by arguing that "the Board should not be persuaded by Opposer's claim that it performs the services listed in International Classes 35, 40 and 41 of Applicant's application, as the examples Opposer submits refer to personal or internal company activities, not services marketed to consumers, or they merely represent a subset of ordinary printing services it provides to its customers." Brief at 11. Applicant goes on to explain that opposer's marketing, advertising and public relations on behalf of participants "relate to the actual printing of his customers' marketing materials"; its business research

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<sup>6</sup> We note that opposer does not argue that it is using its mark on goods in Class 16, and the record does not support a conclusion that these goods are related to opposer's services.

activity "involves reading business books and publications on printing and business"; and its sales and marketing research activity "involves sending his own brochure to his customers." Brief at 11. In response, opposer reiterated that "his printing business uses its service mark and trade name for services in Classes 035, 040, and 041." Reply Brief at 17.

Applicant's Class 35 services are identified as follows:

Conduct marketing, advertising and public relations on behalf of participants; arranging and conducting business meetings, conferences, conventions for participants; group purchasing, namely buying clubs and functioning as purchasing agents, and conducting business research; market and sales research for and about small printers; providing on-line retail store services through an Internet web site featuring multimedia materials resources in the nature of surveys, studies, videos, CD's, DVD's and interactive computer programs in the field of printing

Opposer explained that it performed those services as follows:

One channel is direct[ed] to my customers and through my employees. The second channel is through the two support groups that I work with. One is called SCAN, Southern California Action Network and the other is PEN. That one is through an association called PIA, and its Printing Executive Network.

The first group, customers, we do training to give us correct working files. We train our staff to do the same thing so they in turn can train the customer. We work with customers on marketing. They come to us for assistance, how to market, who to market to, what to say in the marketing. Same thing holds true for advertising. I put both of those pretty much together.

Marketing is more of a generic term where we deal with corporate log and appearance of the product. Advertising deals with the actual pieces that we send out, whether they be through a salesperson handling our literature, sales sheets they're called, or whether it be through postcards mailed out to get new business or even something as their business or what they do and how they do it on the back of the card.

Public relations is a general ongoing - always doing it; trying to help the clients, our staff is working with them.

Druyen test. dep. at 76-77.

Opposer's testimony makes it clear that they "work with customers on marketing. They come to us for assistance, how to market, who to market to, what to say in the marketing." These services would not necessarily be included in simple printing services. They would be similar to applicant's broadly defined marketing services and we find that these services are related.

Opposer also argues that its services include applicant's Class 40 services of providing Internet web site featuring printing information for customers, potential customers, workers and potential workers. Opposer's witness pointed to its website that features printing information for customers and potential customers and job announcements. Again, we conclude that these services of applicant and opposer are related.

Regarding its Class 41 services of the publication of books and magazines and electronic publishing in the field of printing as well as training and educational services in

the printing field, opposer only points to a "brochure that I put together to send out to my clients." Druyen test. dep. at 82. There is little evidence that opposer performs these services or that its services are related to applicant's.

We also look at opposer's trade name use. Opposer points to evidence of "actual confusion between the marks in question." Reply Brief at 10. In an email opposer received on September 6, 2006, an Irish company "Franchise Direct" asked: "Are Certified Printers International interested in European franchise expansion? ... We can provide Certified Printers International with a cost effective solution to European franchise expansion?" Druyen Ex. 36. See also Ex. 37 (Email from Franchise Direct of Denver, Colorado, to "Franchise Director"). This evidence indicates that even business people, who are interested in applicant's franchise operations and its identified services, may be confused by a similar trade name used in association with opposer's printing shop services. While we cannot conclude that all purchasers of opposer's or applicant's printing-related services would be sophisticated, "even careful purchasers are not immune from source confusion." *In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1477 (TTAB 1999)

Indeed, applicant's services of marketing in the field of printing and providing Internet web site featuring

printing information for customers are related to opposer's print shop business in which it uses its trade name.

In order to be related, goods or services do not have to overlap. It "has often been said that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties' goods or services." *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991). *See also Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1661 (TTAB 2002). If those familiar with opposer's service mark and trade name will also encounter applicant's trademark, there is opportunity for confusion. *See, e.g., Shell Oil*, 26 USPQ2d at 1689 ("[D]istributorship services in the field of automotive parts" related to service station oil change and lubrication services). Goods or services can be related if potential customers will believe that there is a common source for the services. *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1898 (TTAB 1989) ("It is enough if there is a

relationship between them such that persons encountering them under their respective marks are likely to assume that they originate at the same source or that there is some association between their sources"). See also *In re Opus One Inc.*, 60 USPQ2d 1812, 1814-15 (TTAB 2001).

When we look at the evidence of record, we conclude that there is no likelihood of confusion between applicant's and opposer's marks when used on the goods and services in Classes 16 and 41. However, we do hold that some of its services in Classes 35 (marketing services) and 40 (providing Internet web site featuring printing information) are related to opposer's print shop services and its trade name use for its print shop.<sup>7</sup> We conclude that there would be a likelihood of confusion for these services.

Decision: The opposition is sustained as to Classes 35 and 40. The opposition is dismissed as to the goods and services in Classes 16 and 41. A registration will issue in due course for the goods and services in Classes 9, 16, and 41.

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<sup>7</sup> *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) ("[L]ikelihood of confusion must be found if the public, being familiar with appellee's use of MONOPOLY for board games and seeing the mark on any item that comes within the description of goods set forth by appellant in its application, is likely to believe that appellee has expanded its use of the mark, directly or under a license, for such item").