

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB

FEB 5, 98

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Moore Business Forms, Inc.  
v.  
Richard A. Harder, Jr.

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Opposition No. 91,991  
to application Serial No. 74/323,847  
filed on October 19, 1992

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Robert A. Vanderhye of Nixon & Vanderhye for opposer

Erwin J. Keup, Esq. for applicant

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Before Hanak, Quinn and Walters, Administrative Trademark  
Judges.

Opinion by Walters, Administrative Trademark Judge:

Moore Business Forms, Inc. filed its opposition to the  
application of Richard A. Harder, Jr. to register the mark  
MCP for "business management and consulting services to  
dentists."<sup>1</sup>

As grounds for opposition, opposer asserts that  
applicant's mark, when applied to applicant's goods, so

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<sup>1</sup> Application Serial No. 74/323,847, filed October 19, 1992, in  
International Class 35, based upon an allegation of a bona fide  
intention to use the mark in commerce in connection with the identified  
services.

resembles opposer's previously used and registered mark MCP for "paper business forms"<sup>2</sup> as to be likely to cause confusion under Section 2(d) of the Trademark Act. Opposer asserts that it has so used its mark in commerce since 1971; that opposer has advertised and sold its MCP business forms to health care professionals, including the dental community; that opposer's mark is "strong" and "widely used"; and that the parties' goods and services travel in the same channels of trade.

Applicant, in its answer, denies the salient allegations of the likelihood of confusion claim and asserts affirmatively that opposer has failed to allege grounds sufficient to establish standing herein<sup>3</sup>; and that the parties' goods and services travel in "entirely different" channels of trade.

*The Record*

The record consists of the pleadings; the file of the involved application; a title and status copy of opposer's pleaded Registration No. 965,147; and various specified responses of applicant to opposer's interrogatories and requests for admissions, all made of record by opposer's notice of reliance; and the testimony depositions by opposer

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<sup>2</sup> Registration No. 965,147, issued July 31, 1973, in International Class 16 and renewed for a term of 10 years from July 31, 1993. [Sections 8 and 15 affidavits accepted and acknowledged, respectively.]

of Robert M. Reinbold, Jr., opposer's Portfolio Manager for core products, and Richard A. Harder, Jr., applicant, both with accompanying exhibits.<sup>4</sup> Both parties filed briefs on the case.

*The Parties*

Opposer is a manufacturer and distributor of business forms, referred to by its Portfolios Manager, Robert M. Reinbold, Jr., as "the largest business forms manufacturer in the world." The mark MCP, which appears to be an acronym for Moore Clean Print, is used on some of opposer's carbonless business forms. Mr. Reinbold testified that he is aware of the continuous use of MCP in connection with such forms since at least 1975, when Mr. Reinbold first joined opposer's sales force. These business forms are sold to all segments of the market, including small and large businesses and including health services, which comprise 18% of opposer's "carbonless sales." Opposer's forms bearing the MCP mark are marketed in various ways including, among others, by a direct sales force and through telemarketing, direct mail, catalogs, distributors and referrals. Confidential business information submitted by opposer under the protective order herein establishes that opposer has

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<sup>3</sup> We consider this allegation to have been waived as applicant filed no motion to dismiss or for summary judgment on this basis; nor did applicant otherwise address this issue at trial or in its brief.

<sup>4</sup> Portions of both witness' testimony and exhibits are filed pursuant to a protective order which was agreed to by the parties and approved by the Board.

made substantial annual sales of its MCP products; that opposer has a significant share of the U.S. market among major carbonless paper manufacturers; and that opposer has, and continues to make, significant sales of its carbonless paper products to the health care community including, specifically, dental customers.

Opposer's evidence includes promotional packages and several copies of its forms. For example, Reinhold exhibit 2 is a promotional brochure for Moore's Ultra-Image MCP carbonless paper, for which Reinhold exhibit 6 is a demo form used by opposer's sales force. The cover page of Reinhold exhibit 2 contains the statement "Improve Your Image With Ultra-Image™ MCP® paper" and the inside copy includes the following:

That's the idea behind our **Ultra-Image™** Moore Clean Print line of carbonless paper products.

Ultra-Image™ MCP® carbonless paper - for all your business communications - is everything you've been waiting for in a high-quality paper product.

Reinhold exhibits 3-5 are demo forms used by opposer's sales force of, respectively, the Moore Speediply® Form, the Moore Continuous Form, and the Moore Speediweb®. While not using the mark MCP, the promotional copy on each demo form states that the form is made of Moore Clean Print® carbonless paper.

Reinhold exhibits 7 and 8 are advertisements that, according to Mr. Reinhold, appeared during the 1980's in magazines such as *Fortune*, *Business Week* and *Industry Week*. These ads feature prominently the mark MOORE and design and the mark MOORE BUSINESS FORMS. The copy in these two advertisements is the same and includes the following:

New MCP Bold Image can make important contributions to healthcare managers' efforts to contain costs. Because this advanced carbonless paper with the new bold image is priced the same as ordinary carbonless paper.

Reinhold exhibits 9-15 are sample forms used in dental programs or practices. Except for Reinhold exhibit 13, each form is custom-printed with the name, address and, in some cases, logo of the purchasing dental program or practice. The name "Moore Business Forms" and the mark MCP appears in very small print on the perforated top or side edge, *i.e.*, the detachable computer feed strip, of each form.

Applicant, Richard A. Harder, Jr., is a dentist who is an employee of Western Dental Services, Incorporated and an owner and consultant to five group dental practices. Dr. Harder testified that he has been using the mark MCP since 1991; that it is an acronym for Managed Care Process; and that he often uses MCP in conjunction with the phrase Managed Care Process. Dr. Harder describes his services rendered in connection with the mark MCP as follows:

MCP, or Managed Care Process, involves a method by which a practitioner or a health care delivery

system is able to optimize, improve and provide care for patients, considering the technology available, considering the resources that are available and the needs of the people, the type of care they need, and it involves an element of strategic planning and continuous quality improvement and quality assurance.

Applicant offers his services to individual and group dental practices. His marketing of his services includes speaking appearances at dental association meetings and seminars; articles and interviews in professional publications; a newsletter; and direct mail to colleagues.

In response to questioning by his counsel, Dr. Harder described the extent to which his services include the development of business forms, as follows:

*Ques.* I just have one question, Dr. Harder. Isn't it true, regarding trade channels, isn't it true that you do not sell forms to dentists but rather sell consulting advice on what they should put into their own forms?

*Ans.* That's correct. I have never marketed or sold any type of form, and the development of forms for an office would be incidental or a small part of what I do in my consulting services.

*Ques.* So if I were a dentist and a customer of yours, you would come in and analyze my practice and then advise me of what you thought I should put into the forms, such as not only the questions but what language that would be put in and things like that?

*Ans.* Yes, that particular role would be secondary to an overall assessment of the goals and objectives of the practice, looking at strategy for the practice in terms of systems management and then once those components were determined, if there was a need for the staff and the doctors to have better record keeping or a different way of tracking what they do, those

types of forms are generally custom made versus being purchased or sold.

*Ques.* And the forms that you identified today are generally forms that you adapted to your own practice and used as samples when you are advising or consulting with a dentist so that he can come up with his own forms?

*Ans.* That's correct, and when I ever do show examples, they are almost always modified or altered to meet the needs of that particular practice. I really can't think of a situation where someone used the same form.

Applicant stated that he creates forms for his dental offices and consulting clients using both office word processing programs and other software; that his forms are developed from personal experience and by combining features of forms found on the market and sample forms recommended by dental associations; that the mark MCP does not routinely appear on these forms; that he has never maintained or sold a proprietary interest in the forms he develops; and that forms developed for a client reside on the client's computer system.

Applicant admits that he is aware of opposer's business as a manufacturer of forms and that, as a result of the trademark search in connection with his mark, he learned of opposer's ownership of the mark MCP for such forms.

Applicant asserts, however, that he did not adopt the mark MCP with any intent to trade on opposer's goodwill in its mark, as he believes the parties' goods and services are

very different.<sup>5</sup> Applicant states that his practice purchases business forms from vendors, although he has not seen opposer's forms in use by his practice nor has he adapted his forms from any of opposer's forms. Applicant acknowledges that opposer's forms could be sold to the same dentists to whom he markets his services.

*Analysis*

Inasmuch as a certified copy of opposer's registration is of record, there is no issue with respect to opposer's priority.<sup>6</sup> *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Our determination of likelihood of confusion under Section 2(d) must be based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E.I. duPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Key considerations in this case are the similarities between the marks, the similarities between the goods and services, the channels of trade, and the class of

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<sup>5</sup> Opposer does not allege bad faith in applicant's adoption of the mark herein and, in view of our decision that the parties' goods and services are significantly different, we find no intent to copy opposer's mark on the part of applicant.

<sup>6</sup> In view of opposer's incontestable registration for the mark MCP for paper business forms, applicant's contention that opposer uses its mark MCP to identify carbonless paper, not business forms, is an attack on the validity of the registration which must be addressed in a counterclaim to cancel that registration. Since such a counterclaim was not filed herein, we give no consideration to applicant's contention.

purchasers. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Considering, first, the marks, there is no question that the parties' marks are identical.<sup>7</sup>

We consider, next, the goods and services of the parties. As both opposer's and applicant's identifications of goods and services are broadly worded, we presume both parties' goods and services are sold in all of the normal channels of trade to all of the normal purchasers for goods and services of the type identified. *See Canadian Imperial Bank v. Wells Fargo*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). However, even reading the identifications of goods and services herein broadly and considering opposer's evidence of use of its mark, we find that applicant's management and consulting services are quite different from opposer's sale of paper business forms. We do not find on this record either that applicant's identification of services in the application encompasses the sale of business forms, or that opposer's identification of goods in its

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<sup>7</sup> Because the application herein is for registration of the mark MCP alone and there is evidence that opposer owns a registration for the mark MCP and uses its MCP mark alone, the similarity of the parties' marks is not mitigated in any respect by the fact that opposer's mark MCP may be an acronym for Moore Clean Print or that applicant's mark MCP may be an acronym for Managed Care Process.

registration encompasses the distinct service of custom designing business forms.<sup>8</sup>

Further, opposer has not established that the custom design and development of forms by applicant is sufficiently distinct from his business management and consulting services to be considered either a separate service or the sale of such goods. Applicant's statements regarding the development of forms for his clients indicates that such activity is merely ancillary to his business management and consulting services and is not separately identifiable as either a distinct custom designing service or as the sale of goods in the nature of business forms.

Applicant acknowledges that opposer may sell its forms bearing the mark MCP to the same class of purchasers, individual and group dental practices and programs, to whom applicant markets its services under the MCP mark. The record supports the additional conclusion that forms developed by applicant as part of his management and consulting services are for the same range of uses by dental customers as applicant's forms.

However, the fact that the class of purchasers may be the same does not require us to also conclude, as opposer

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<sup>8</sup> While opposer's witness, Mr. Reinhold, indicated that registrant does engage in the custom design of forms, there is no evidence indicating the nature or extent of that service or what mark is used in connection with that service. All of the evidence presented by opposer supports its use of the mark MCP in connection with business forms upon which

seems to urge, that the channels of trade are the same. We find that, in this case, common sense dictates that the channels of trade for business management and consulting services rendered to dental customers are likely to be quite different from the channels of trade for business forms used by such customers. Opposer has presented no evidence to the contrary.

While the record establishes substantial sales of opposer's products under the mark MCP, this evidence alone is insufficient support for opposer's allegation that its trademark is well-known and, thus, entitled to a wide latitude of legal protection. *Kenner Parker Toys Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992), *cert. denied*, 113 S.Ct. 181 (1992). Further, even if opposer had established that its mark is famous, opposer would not be entitled to preclude the subsequent registration of the same or similar mark in connection with any and all goods and services including those completely unrelated to the goods of opposer. To do otherwise would be to bestow upon opposer a right in gross which is contrary to Section 2(d) and to the recognized principle of trademark law that ownership of a mark does not create a "monopoly" therein. *Amica Mutual Insurance Company v. R.H. Cosmetics Corp.*, 204 USPQ 155 (TTAB 1979) and cases

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opposer may print a customer's name and logo, not with services of any

cited therein; *Penthouse International, Ltd. v. Dyn Electronics, Inc.*, 196 USPQ 251 (TTAB 1977).

Therefore, despite the fact that the parties' marks are identical, we find that applicant's services, business management and consulting services to dentists, are significantly different from opposer's goods, paper business forms; that any design and development of forms by applicant is in connection with, or ancillary to, his business management and consulting services and does not, based on the evidence herein, constitute either a distinct service or the sale of goods; that the evidence does not support the conclusion that opposer's registration or its use of the mark MCP encompasses the custom design of business forms; and that, while both applicant's services and opposer's goods may be marketed and sold to the same class of purchasers, dental customers, the channels of trade for applicant's services versus opposer's goods are quite different. In view of the differences between the goods and services and the trade channels therefor, we find that confusion as to the source or sponsorship of applicant's services and opposer's goods is not likely.

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type.

*Decision:* The opposition is dismissed.

E. W. Hanak

T. J. Quinn

C. E. Walters  
Administrative Trademark Judges,  
Trademark Trial and Appeal Board