

**THIS DISPOSITION
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EWH/CV

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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Research and Education Association

Serial No. 75/362,650

Max Fogiel, President of Research and Education Association
for applicant.

Rebecca Gilbert, Trademark Examining Attorney, Law Office
113 (Meryl Hershkowitz, Managing Attorney).

Before Simms, Hanak, and Wendel, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Research and Education Association (applicant) seeks
to register THE BEST PREPARATION FOR THE AP ADVANCE
PLACEMENT EXAMINATION in typed drawing form for "a series
of educational books featuring college entrance test
preparation materials." The application was filed on
September 12, 1997 with a claimed first use date of May 7,
1991.

Citing Section 2(d) of the Trademark Act, the Examining Attorney refused registration on the basis that applicant's mark, as applied to applicant's goods, is likely to cause confusion with the mark AP, previously registered in typed drawing form for "educational testing services; namely, preparing and providing curricular materials and course descriptions, and conducting related examinations for secondary schools." Registration No. 1,816,226.¹

Both applicant and the Examining Attorney filed briefs. Applicant did not request a hearing.

In any likelihood of confusion analysis, two key considerations are the similarity of the goods and services and the similarity of the marks. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [and services] and differences in the marks.").

Considering first the goods and services, the evidence

¹ The Examining Attorney also cited Registration No. 1,069,138 for the mark ADVANCED PLACEMENT PROGRAM. However, because we are affirming the refusal based on the AP registration, we need not consider the ADVANCED PLACEMENT PROGRAM registration, which is also owned by the same registrant (College Entrance Examination Board).

of record establishes that they are closely related. Registrant's services are educational testing services, and applicant's goods are educational books featuring test preparation materials. Indeed, as applicant's specimens of use make clear, its educational books are specifically designed to assist students in preparing for registrant's AP tests. In addition, the Examining Attorney has made of record ten third-party registrations demonstrating that the same marks have been registered for both testing services and educational books.

Applicant does not dispute the foregoing. Indeed, applicant concedes that "applicant provides books (goods, not services) to help students in preparing to take the AP examination." (Applicant's brief page 2). However, applicant argues that because the "registrant's services/goods [the AP tests] are not available on the market to be compared with applicant's goods, there can be no confusion between the goods." (Applicant's brief page 4). Two comments are in order. First, applicant has provided no evidentiary support of any kind to establish that registrant's past tests are not available "on the market." It could well be the case that registrant makes available to students copies of its old AP tests. Second, if we assume for the sake of argument that registrant does

not make available copies of its old AP tests, a student or his/her parents could easily assume that the entity which prepares the test (registrant) is the same entity which makes available educational books to study for the test. Indeed, the aforementioned third-party registrations demonstrate that it is a common practice for the same entity to offer both tests and test preparation materials.

As for applicant's argument that a number of other companies market educational books with titles which incorporate registrant's mark AP, we simply note that there is nothing in the record to indicate whether registrant has given its approval to these other companies. Moreover, even if we assume for the sake of argument that registrant has not acted to prevent applicant and others from using its mark AP in the titles of their books, this does not mean that registrant has agreed to allow applicant and others to register titles of a series of books containing registrant's mark AP.

One additional comment is in order. We would be remiss if we did not note that after the AP in applicant's mark on some of applicant's specimens there appears an asterisk, which then makes reference to the following statement: "AP is a registered trademark of the College Entrance Examination Board [registrant] which does not

endorse this book." If there was no likelihood of confusion resulting from the contemporaneous use of applicant's mark for educational books and registrant's AP for testing services, then presumably there would be no need for the disclaimer which applicant has placed on the front cover of some of its books (specimens).

Turning to a consideration of the marks, it would appear at first blush that applicant's ten word mark and registrant's one word mark are quite dissimilar. However, it must be remembered that applicant seeks to register its mark in typed drawing form. Thus, in our likelihood of confusion analysis, we must consider all reasonable manners in which applicant could depict its mark, and in particular, we must consider all manners in which applicant has actually depicted its mark. Phillips Petroleum v. C.J. Webb, 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971); INB National Bank v. Metrohost, 22 USPQ2d 1585, 1588 (TTAB 1992). Reproduced below is the top portion of the cover of applicant's educational book showing how applicant actually depicts its mark.

As is readily apparent, the manner in which applicant actually depicts its mark clearly emphasizes the AP portion of applicant's mark. The words THE BEST TEST PREPARATION FOR THE ... ADVANCED PLACEMENT EXAMINATION are depicted in an extraordinarily subordinate fashion. A student viewing applicant's educational book would readily see the word AP, and may not even notice the remaining wording of applicant's mark. Moreover, if the student did notice this very subordinate wording, said wording may only increase the likelihood of confusion because the student may be under the assumption that this particular educational book is the "official" study book for the AP tests endorsed by registrant. The wording THE BEST TEST PREPARATION FOR THE is laudatory and may be taken to indicate that this educational book is the best because it is the official book.

In short, we find that there exists a likelihood of confusion resulting from the contemporaneous use of applicant's mark on educational books and registrant's mark AP for testing services.

Three final comments are in order. First, during the prosecution of this application and at page six of her brief, the Examining Attorney argued that registrant may wish to expand its activities to include a series of

educational books. The Examining Attorney has referred to her argument as "the expansion of trade doctrine." To be perfectly clear, we find that the evidence demonstrates that registrant's services as described in its AP registration and applicant's goods as described in its application are close enough such there is a likelihood of confusion resulting from the contemporaneous use of registrant's mark and applicant's mark. In other words, we have not relied upon the "expansion of trade doctrine" in finding that there exists a likelihood of confusion.

Second, in the course of this proceeding, applicant has argued that there can be no confusion because it provides goods whereas the registrant provides services. We find this argument to be without merit. As has been previously noted, at least ten other entities have registered the identical mark for both testing services and educational books (goods). Indeed, applicant, as previously noted, has conceded that its educational books are designed specifically "to help students in preparing to take AP examination." (Applicant's brief page 2). Moreover, while registrant offers educational testing services, such services must, of course, involve tangible items such as materials explaining the nature of the test; applications to take the test; and, obviously, the tests

themselves. Applicant has admitted the foregoing when at page four of its brief it refers to "registrant's services/goods." (emphasis added).

Finally, at pages four and five of its brief and at page two of its reply brief, applicant argues that it is entirely permissible for the marks of various owners to appear on the same product. Continuing, applicant concludes that it is "permissible, therefore, that applicant's mark appears simultaneously with the registrant's mark on applicant's product." (Applicant's brief page 5). To cut to the quick, the fact that under certain circumstances the marks of two different companies may appear on the same product does not mean that a junior party can appropriate the senior party's mark in its entirety and avoid a finding of likelihood of confusion simply by adding thereto additional wording which is depicted in lettering of decidedly smaller proportions. The cases which involve the use on a single product of different marks owned by different entities involve situations where the different entities have agreed to such use, or they involve situations where the junior user (usually a distributor) is affixing his mark to the senior user's product (usually a manufacturer) in a manner where the two marks remain distinct and where the public clearly

Ser No. 75/362,650

understands that one mark functions to indicate the entity which manufactures the product and the second mark functions to indicate the entity which distributes the product.

Decision: The refusal to register is affirmed.

R. L. Simms

E. W. Hanak

H. R. Wendel
Administrative Trademark
Judges, Trademark Trial
and Appeal