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Filing date: **11/13/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

**Petition for Cancellation**

Notice is hereby given that the following party requests to cancel indicated registration.

**Petitioner Information**

Name	Castle Branch, Inc.		
Entity	Corporation	Citizenship	North Carolina
Address	1845 Sir Tyler Drive Wilmington, NC 28405 UNITED STATES		

Attorney information	Angela P. Doughty Ward & Smith, P.A. 1001 College Court New Bern, NC 28562 UNITED STATES trademarks@wardandsmith.com		
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**Registrations Subject to Cancellation**

Registration No	3244047	Registration date	05/22/2007
Registrant	Certiphi Screening, Inc. 1105 Industrial Boulevard Southampton, PA 18966 GERMANY		

**Goods/Services Subject to Cancellation**

Class 045. First Use: 2000/08/07 First Use In Commerce: 2000/08/07 All goods and services in the class are cancelled, namely: PROVIDING PRE-EMPLOYMENT BACKGROUND SCREENING SERVICES TO THE HEALTHCARE INDUSTRY
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**Grounds for Cancellation**

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)		
Genericness	Trademark Act section 23		
Abandonment	Trademark Act section 14		
Registration No	3370520	Registration date	01/15/2008
Registrant	Certiphi Screening, Inc. 1105 Industrial Boulevard Southampton, PA 18966 GERMANY		

**Goods/Services Subject to Cancellation**

Class 045. First Use: 2000/08/07 First Use In Commerce: 2000/08/07 All goods and services in the class are cancelled, namely: PROVIDING PRE-EMPLOYMENT BACKGROUND SCREENING SERVICES TO THE HEALTHCARE INDUSTRY
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## Grounds for Cancellation

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>		808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)	
Genericness		Trademark Act section 23	
Abandonment		Trademark Act section 14	
Registration No	3508675	Registration date	09/30/2008
Registrant	Certiphi Screening, Inc. 1105 Industrial Boulevard Southampton, PA 18966 GERMANY		

## Goods/Services Subject to Cancellation

Class 035. First Use: 2000/08/07 First Use In Commerce: 2000/08/07  
All goods and services in the class are cancelled, namely: Providing a web-based platform, namely, an on-line interactive computer database featuring pre-employment background screening services for the healthcare industry; providing a website for monitoring and report management of the results of employee background screening for the healthcare industry

## Grounds for Cancellation

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Genericness	Trademark Act section 23
Abandonment	Trademark Act section 14

Related Proceedings	Petitioner is aware of a Complaint filed, but not served, in the U.S. District Court for the Eastern District of Pennsylvania; Certiphi Screening, Inc. v. Castle Branch, Inc.; Civil Action No. 2:13-ev-06315-TJS.
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Attachments	PetitionforCancellation.pdf(28404 bytes ) Exhibits.pdf(780234 bytes )
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## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/APD/
Name	Angela P. Doughty
Date	11/13/2013

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Castle Branch, Inc.,

Petitioner,

v.

Certiphi Screening, Inc.,

Registrant.

Cancellation No.: \_\_\_\_\_

Reg Nos.: 3,244,047;  
3,370,520; and 3,508,675

Marks: CERTIPHI;  
CERTIPHI SCREENING;  
and MYCERTIPHI.COM

**PETITION FOR  
CANCELLATION**

November 13, 2013

**PETITION FOR CANCELLATION**

Petitioner Castle Branch, Inc. ("Petitioner"), a North Carolina corporation, located at 1845 Sir Tyler Drive, Wilmington, NC 28405, is being damaged by each of the Registration Nos. 3,244,047; 3,370,520; and 3,508,675 (collectively, the "Trademarks"), and hereby petitions to cancel same under the provisions of 15 U.S.C. § 1064(3).

As grounds for this Petition, it is alleged that:

**Background**

1. Petitioner is a leading provider of, among other things, public records and background investigation, research, drug testing and other related screening services ("Petitioner's Services").

2. Since at least as early as September 2001, Petitioner has continuously used the domain [www.certifiedbackground.com](http://www.certifiedbackground.com), the trade name CertifiedBackground.com, and

the mark CERTIFIEDBACKGROUND.COM in conjunction with a specialized logo in relation to the Petitioner's Services.

3. Since at least as early as 2001, Petitioner has expended a substantial amount of time, resources, and effort to develop and protect the goodwill associated with its CERTIFIEDBACKGROUND.COM name.

4. Upon information and belief, Certiphi Screening, Inc. ("Registrant") is a corporation organized and existing under the laws of Delaware, doing business at 1105 Industrial Boulevard, Southampton, PA 18966.

5. Registrant is the owner of United States Trademark Registration No. 3,244,047 for CERTIPHI filed on December 19, 2005 in International Class 045 for "providing pre-employment background screening services to the healthcare industry"; claiming first use on August 7, 2000. A true and correct copy of the registration is attached hereto as Exhibit A.

6. Registrant is the owner of United States Trademark Registration No. 3,370,520 for CERTIPHI SCREENING filed on December 22, 2005 in International Class 045 for "providing pre-employment background screening services to the healthcare industry"; claiming first use on August 7, 2000. A true and correct copy of the registration is attached hereto as Exhibit B.

7. Registrant is the owner of United States Trademark Registration No. 3,508,675 for MYCERTIPHI.COM filed on December 22, 2005 in International Class 035 for "providing a web-based platform, namely, an on-line interactive computer database featuring pre-employment background screening services for the healthcare industry; providing a website for monitoring and report management of the results of employee

background screening for the healthcare industry"; claiming first use on August 7, 2000.

A true and correct copy of the registration is attached hereto as Exhibit C.

8. In correspondence dated November 4, 2013, Registrant, based on the Trademarks, demanded that Petitioner cease any and all use of the term "certified" in connection with Petitioner's Services (the "November Demand Letter").

9. Along with the November Demand Letter, Registrant enclosed a copy of a complaint filed in the United States District Court for the Eastern District of Pennsylvania on October 29, 2013 ("Complaint"). A true and correct copy of the Complaint is attached hereto as Exhibit D.

10. The Complaint alleges, among other things, federal and common law trademark infringement. Specifically, the Complaint alleges that Petitioner's use of the term "certified" in relation to Petitioner's Services infringes Registrant's Trademarks.

11. In the November Demand Letter, Registrant stated it had not served the Complaint, but threatened to do so if Petitioner refuses to cease use of the term "certified" in connection with Petitioner's Services.

### **First Basis for Cancellation:**

#### **Genericness**

12. The allegations contained in Paragraphs 1 through 11, inclusive, are incorporated by reference as if fully set forth.

13. The term "CERTIPHI" is phonetically equivalent to "certify."

14. Service providers and consumers widely use the term "certify" in the background screening industry, including but not limited to Registrant's screening services directed to the healthcare industry, to describe, attest, and signify to customers that the

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