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The Trademark Act of 1946 provides for registration of trademarks, service marks, collective trademarks and service marks, collective membership marks and certification marks. 15 U.S.C. §§1051, 1053, and 1054. The language of this Manual is generally directed to trademarks. Procedures for trademarks usually apply to other types of marks, unless otherwise stated. This chapter is devoted to special circumstances relating to service marks, collective marks, collective membership marks, and certification marks.

1301 Service Marks

Section 45 of the Trademark Act, 15 U.S.C. §1127, defines “service mark” as follows:

The term “service mark” means any word, name, symbol, or device, or any combination thereof--

- (1) used by a person, or
- (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this Act,

to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown. Titles, character names, and other distinctive features of radio or television programs may be registered as service marks notwithstanding that they, or the programs, may advertise the goods of the sponsor.

Therefore, to be registrable as a service mark, the asserted mark must function both to *identify* the services recited in the application *and distinguish* them from the services of others, and to *indicate the source of* the recited services, even if that source is unknown. The activities recited in the identification must constitute services as contemplated by the Trademark Act. See TMEP §§1301.01 *et seq.*

If a proposed mark does not function as a service mark for the services recited, or if the applicant is not rendering a registrable service, the statutory basis for refusal of

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registration on the Principal Register is §§1, 2, 3 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, 1053 and 1127.

See TMEP §1303 concerning collective service marks.

1301.01 What Is a Service

A service mark can only be registered for activities that constitute services as contemplated by the Trademark Act. 15 U.S.C. §§1051, 1052, 1053 and 1127. The Trademark Act defines the term “service mark,” but it does not define what constitutes a service. Many activities are obviously services (*e.g.*, dry cleaning, banking, shoe repairing, transportation, and house painting).

1301.01(a) Criteria for Determining What Constitutes a Service

The following criteria have evolved for determining what constitutes a service: (1) a service must be a real activity; (2) a service must be performed to the order of, or for the benefit of, someone other than the applicant; and (3) the activity performed must be qualitatively different from anything necessarily done in connection with the sale of the applicant’s goods or the performance of another service. *In re Canadian Pacific Limited*, 754 F.2d 992, 224 USPQ 971 (Fed. Cir. 1985); *In re Betz Paperchem, Inc.*, 222 USPQ 89 (TTAB 1984); *In re Integrated Resources, Inc.*, 218 USPQ 829 (TTAB 1983); *In re Landmark Communications, Inc.*, 204 USPQ 692 (TTAB 1979).

1301.01(a)(i) Performance of a Real Activity

A service must be a real activity. A mere idea or concept, *e.g.*, an idea for an accounting organizational format or a recipe for a baked item, is not a service. Similarly, a system, process or method is not a service. *In re Universal Oil Products Co.*, 476 F.2d 653, 177 USPQ 456 (C.C.P.A. 1973); *In re Citibank, N.A.*, 225 USPQ 612 (TTAB 1985); *In re Scientific Methods, Inc.*, 201 USPQ 917 (TTAB 1979); *In re McCormick & Company, Inc.*, 179 USPQ 317 (TTAB 1973). See TMEP §1301.02(e) regarding marks that identify a system or process.

The commercial context must be considered in determining whether a real service is being performed. For example, at one time the activities of grocery stores, department stores, and similar retail stores were not considered to be services. However, it has long been recognized that gathering various products together, making a place available for purchasers to select goods, and providing any other necessary means for consummating purchases constitutes the performance of a service.

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1301.01(a)(ii) For the Benefit of Others

To be a service, an activity must be primarily for the benefit of someone other than the applicant. While an advertising agency provides a service when it promotes the goods or services of its clients, a company that promotes the sale of its own goods or services is doing so for its own benefit rather than rendering a service for others. *In re Reichhold Chemicals, Inc.*, 167 USPQ 376 (TTAB 1970). See TMEP §1301.01(b)(i). Similarly, a company that sets up a personnel department to employ workers for itself is merely facilitating the conduct of its own business, while a company whose business is to recruit and place workers for other companies is performing employment agency services.

The controlling question is who *primarily* benefits from the activity for which registration is sought. If the activity is done primarily for the benefit of others, the fact that applicant derives an incidental benefit is not fatal. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). On the other hand, if the activity primarily benefits applicant, it is not a registrable service even if others derive an incidental benefit. *In re Dr. Pepper Co.*, 836 F.2d 508, 5 USPQ2d 1207 (Fed. Cir. 1987) (contest promoting applicant's goods not a service, even though benefits accrue to winners of contest); *In re Alaska Northwest Publishing Co.*, 212 USPQ 316 (TTAB 1981).

Collecting information for the purpose of publishing one's own periodical is not a service, because it is done primarily for the applicant's benefit rather than for the benefit of others. See TMEP §1301.01(b)(iii).

Offering shares of one's own stock for investment is not a service, because these are routine corporate activities that primarily benefit the applicant. See TMEP §1301.01(b)(iv). On the other hand, offering a retirement income plan to applicant's employees was found to be a service, because it primarily benefits the employees. *American International Reinsurance Co., Inc. v. Airco, Inc.*, 570 F.2d 941, 197 USPQ 69 (C.C.P.A. 1978), *cert. denied* 439 U.S. 866, 200 USPQ 64 (1978).

Licensing intangible property has been recognized as a separate service, analogous to leasing or renting tangible property, that primarily benefits the licensee. *In re Universal Press Syndicate*, 229 USPQ 638 (TTAB 1986).

1301.01(a)(iii) Sufficiently Distinct from Activities Involved in Sale of Goods or Performance of Other Services

In determining whether an activity is sufficiently separate from an applicant's principal activity to constitute a service, the examining attorney should first ascertain what is the applicant's principal activity under the mark in question (*i.e.*, the sale of a service or the sale of a tangible product). The examining attorney must then determine whether the activity identified in the application is in any material way a different kind of economic activity than what any provider of that particular product or

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service normally provides. *In re Landmark Communications, Inc.*, 204 USPQ 692, 695 (TTAB 1979).

For example, operating a grocery store is clearly a service. Bagging groceries for customers is not considered a separately registrable service, because this activity is normally provided to and expected by grocery store customers, and is, therefore, merely ancillary to the primary service.

Providing general information or instructions as to the purpose and uses of applicant's goods is merely incidental to the sale of goods, not a separate consulting service. See TMEP §1301.01(b)(v).

Conducting a contest to promote the sale of one's own goods or services is usually not considered a service, because it is an ordinary and routine promotional activity. See TMEP §1301.01(b)(i).

While the repair of the goods of others is a recognized service, an applicant's guarantee of repair of its own goods normally does not constitute a separate service, because that activity is ancillary to and normally expected in the trade. See TMEP §1301.01(b)(ii).

However, the fact that an activity is ancillary to a principal service or to the sale of goods does not in itself mean that it is not a separately registrable service. The statute makes no distinction between primary, incidental or ancillary services. *In re Universal Press Syndicate*, 229 USPQ 638 (TTAB 1986) (licensing cartoon character found to be a separate service that was not merely incidental or necessary to larger business of magazine and newspaper cartoon strip); *In re Betz Paperchem, Inc.*, 222 USPQ 89 (TTAB 1984) (chemical manufacturer's feed, delivery and storage of liquid chemical products held to constitute separate service, because applicant's activities extend beyond routine sale of chemicals); *In re Congoleum Corp.*, 222 USPQ 452 (TTAB 1984) (awarding prizes to retailers for purchasing applicant's goods from distributors held to be sufficiently separate from the sale of goods to constitute a service rendered to distributors, because it confers a benefit on distributors that is not normally expected by distributors in the relevant industry); *In re C.I.T. Financial Corp.*, 201 USPQ 124 (TTAB 1978) (computerized financial data processing services rendered to applicant's loan customers held to be a registrable service, since it provides benefits that were not previously available, and is separate and distinct from the primary service of making consumer loans); *In re U.S. Home Corp. of Texas*, 199 USPQ 698 (TTAB 1978) (planning and laying out residential communities for others was found to be a service, because it goes above and beyond what the average individual would do in constructing and selling a home on a piece of land that he or she has purchased); *In re John Breuner Co.*, 136 USPQ 94 (TTAB 1963) (credit services provided by a retail store constitute a separate service, since extension of credit is neither mandatory nor required in the operation of a retail establishment).

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The fact that the activities are offered only to purchasers of the applicant's primary product or service does not necessarily mean that the activity is not a service. *In re Otis Engineering Corp.*, 217 USPQ 278 (TTAB 1982) (quality control and quality assurance services held to constitute a registrable service even though the services were limited to applicant's own equipment); *In re John Breuner Co.*, *supra* (credit services offered only to customers of applicant's retail store found to be a service).

The fact that the services for which registration is sought are offered to a different class of purchasers than the purchasers of applicant's primary product or service is also a factor to be considered. *In re Forbes Inc.*, 31 USPQ2d 1315 (TTAB 1994); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990).

Another factor to be considered in determining whether an activity is a registrable service is the use of a mark different from the mark used on or in connection with the applicant's principal product or service. See *In re Mitsubishi Motor Sales of America Inc.*, 11 USPQ2d 1312 (TTAB 1989); *In re Universal Press Syndicate*, *supra*; *In re Congoleum Corp.*, *supra*; *In re C.I.T. Financial Corp.*, *supra*. However, an activity that is normally expected or routinely done in connection with sale of a product or another service is not a registrable service even if it is identified by a different mark. *In re Dr. Pepper Co.*, 836 F.2d 508, 5 USPQ2d 1207 (Fed. Cir. 1987); *In re Television Digest, Inc.*, 169 USPQ 505 (TTAB 1971). Moreover, the mark identifying the ancillary service does not have to be different from the mark identifying the applicant's goods or primary service. *Ex parte Handmacher-Vogel, Inc.*, 98 USPQ 413 (Comm'r Pats. 1953).

1301.01(b) Whether Particular Activities Constitute "Services"

1301.01(b)(i) Contests and Promotional Activities

It is well settled that the promotion of one's own goods is not a service. *In re Radio Corp. of America*, 205 F.2d 180, 98 USPQ 157 (C.C.P.A. 1953) (record manufacturer who prepares radio programs primarily designed to advertise and sell records is not rendering a service); *In re SCM Corp.*, 209 USPQ 278 (TTAB 1980) (supplying merchandising aids and store displays to retailers does not constitute separate service); *Ex parte Wembley, Inc.*, 111 USPQ 386 (Comm'r Pats. 1956) (national advertising program designed to sell manufacturer's goods to ultimate purchasers is not service to wholesalers and retailers, because national product advertising is normally expected of manufacturers of nationally distributed products, and is done in furtherance of the sale of the advertised products).

However, an activity that goes above and beyond what is normally expected of a manufacturer in the relevant industry may be a registrable service, even if it also serves to promote the applicant's primary product or service. *In re U.S. Tobacco Co.*, 1 USPQ2d 1502 (TTAB 1986) (tobacco company's participating in auto race held to constitute an entertainment service, because participating in an auto race is not an activity that a seller of tobacco normally does); *In re Heavenly Creations, Inc.*,

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168 USPQ 317 (TTAB 1971) (applicant's free hairstyling instructional parties found to be a service separate from the applicant's sale of wigs, because it goes beyond what a seller of wigs would normally do in promoting its goods); *Ex parte Handmacher-Vogel, Inc.*, 98 USPQ 413 (Comm'r Pats. 1953) (clothing manufacturer's conducting women's golf tournaments held to be a service, because it is not an activity normally expected in promoting the sale of women's clothing).

Conducting a contest to promote the sale of one's own goods is usually not considered a service, even though benefits may accrue to the winners of the contest. Such a contest is usually ancillary to the sale of goods or services, and is nothing more than a device to advertise the applicant's products or services. *In re Dr. Pepper Co.*, 836 F.2d 508, 5 USPQ2d 1207 (Fed. Cir. 1987); *In re Loew's Theatres, Inc.*, 179 USPQ 126 (TTAB 1973); *In re Johnson Publishing Co., Inc.*, 130 USPQ 185 (TTAB 1961). However, a contest that serves to promote the sale of the applicant's goods may be registrable if it operates in a way that confers a benefit unrelated to the sale of the goods, and the benefit is not one that is normally expected of a manufacturer in that field. *In re Congoleum Corp.*, 222 USPQ 452 (TTAB 1984).

A mark identifying a beauty contest is registrable either as a promotional service, rendered by the organizer of the contest to the businesses or groups that sponsor the contest, or as an entertainment service. *In re Miss American Teen-Ager, Inc.*, 137 USPQ 82 (TTAB 1963). See TMEP §1402.11.

See TMEP §1301.01(b)(iii) regarding the providing of advertising space in a periodical.

1301.01(b)(ii) Warranty or Guarantee of Repair

While the repair of the goods of others is a recognized service, an applicant's guarantee of repair of its own goods does not normally constitute a separate service, because that activity is ancillary to and normally expected in the trade. *In re Orion Research Inc.*, 669 F.2d 689, 205 USPQ 688 (C.C.P.A. 1980) (guarantee of repair or replacement of applicant's goods that is not separately offered, promoted or charged for is not a service); *In re Lenox, Inc.*, 228 USPQ 966 (TTAB 1986) (lifetime warranty that is not separately offered, promoted or charged for is not a service). However, a warranty that is offered or charged for separately from the goods, or is sufficiently above and beyond what is normally expected in the industry, may constitute a service. *In re Mitsubishi Motor Sales of America, Inc.*, 11 USPQ2d 1312 (TTAB 1989) (comprehensive automobile vehicle preparation, sales and service program held to be a service, where applicant's package included features that were unique and would not normally be expected in the industry); *In re Sun Valley Waterbeds Inc.*, 7 USPQ2d 1825 (TTAB 1988) (retailer's extended warranty for goods manufactured by others held to be a service, where the warranty is considerably more extensive than that offered by others); *In re Otis Engineering Corp.*, 217 USPQ

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278 (TTAB 1982) (non-mandatory quality control and quality assurance services held to constitute a registrable service even though the services were limited to applicant's own equipment, where the services were separately charged for, the goods were offered for sale without services, and the services were not merely a time limited manufacturer's guarantee).

1301.01(b)(iii) Publishing One's Own Periodical

The publication of one's own periodical is not a service, because it is done primarily for applicant's own benefit and not for the benefit of others. *In re Billfish International Corp.*, 229 USPQ 152 (TTAB 1986) (activities of collecting, distributing and soliciting information relating to billfishing tournaments for a periodical publication not a separate service, because these are necessary preliminary activities that a publisher must perform prior to publication and sale of publication); *In re Alaska Northwest Publishing Co.*, 212 USPQ 316 (TTAB 1981) (title of magazine section not registrable for magazine publishing services, because the activities and operations associated with designing, producing and promoting applicant's own product are ancillary activities that would be expected by purchasers and readers of any magazine); *In re Landmark Communications, Inc.*, 204 USPQ 692 (TTAB 1979) (title of newspaper section not registrable as service mark for educational or entertainment service, because collected articles, stories, reports, comics, advertising and illustrations are indispensable components of newspapers without which newspapers would not be sold); *In re Television Digest, Inc.*, 169 USPQ 505 (TTAB 1971) (calculating advertising rates for a trade publication not a registrable service, because this is an integral part of the production or operation of any publication).

However, providing advertising space in one's own periodical may be a registrable service, if the advertising activities are sufficiently separate from the applicant's publishing activities. *In re Forbes Inc.*, 31 USPQ2d 1315 (TTAB 1994) ("providing advertising space in a periodical" held to be a registrable service, where the advertising services were rendered to a different segment of the public under a different mark than the mark used to identify applicant's magazines); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990) (real estate advertising services rendered by soliciting advertisements and publishing a guide comprising the advertisements of others held to be a registrable service, where advertising was found to be the applicant's primary activity, and the customers who received the publication were not the same as those to whom the advertising services were rendered).

1301.01(b)(iv) Soliciting Investors

Offering shares of one's own stock for investment and reinvestment, and publication of reports to one's own shareholders, are not services, because these are routine corporate activities that primarily benefit the applicant. *In re Canadian Pacific Ltd.*,

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754 F.2d 992, 224 USPQ 971 (Fed. Cir. 1985). Similarly, soliciting investors in applicant's own partnership is not a registrable service. *In re Integrated Resources, Inc.*, 218 USPQ 829 (TTAB 1983) (syndicating investment partnerships did not constitute a service within the meaning of the Trademark Act, because there was no evidence that the applicant was in the business of syndicating the investment partnerships of others; rather, the applicant partnership was engaged only in syndication of interests in its own organization). On the other hand, investing the funds of others is a registrable service that primarily benefits others. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985) (investment of funds of institutional investors and providing capital for management found to be a registrable service).

In *Canadian Pacific*, 224 USPQ at 974, the court noted that since shareholders are owners of the corporation, an applicant who offers a reinvestment plan to its stockholders is essentially offering the plan to itself and not to a segment of the buying public. The court distinguished *American International Reinsurance Co., Inc. v. Airco, Inc.*, 570 F.2d 941, 197 USPQ 69 (C.C.P.A. 1978), *cert. denied* 439 U.S. 866, 200 USPQ 64 (1978), in which offering an optional retirement plan to applicant's employees was found to be a registrable service that primarily benefits the employees.

1301.01(b)(v) Informational Services Ancillary to the Sale of Goods

Providing general information or instructions as to the purpose and uses of applicant's goods is merely incidental to the sale of goods, not a separate informational service. *In re Moore Business Forms Inc.*, 24 USPQ2d 1638 (TTAB 1992) (paper manufacturer who rates the recycled content and recyclability of its own products is merely providing information about its goods, not rendering a service to others); *In re Reichhold Chemicals, Inc.*, 167 USPQ 376 (TTAB 1970) ("promoting the sale and use of chemicals" is not a registrable service, where applicant is merely providing "technical bulletins" that contain information about its own products); *Ex parte Armco Steel Corp.*, 102 USPQ 124 (Comm'r Pats. 1954) (analyzing the needs of customers is not registrable as a consulting service, because it is an ordinary activity that is normally expected of a manufacturer selling goods); *Ex parte Elwell-Parker Electric Co.*, 93 USPQ 229 (Comm'r Pats. 1952) (providing incidental instructions on the efficient use of applicant's goods not a service). However, an applicant's free hairstyling instructional "parties" were found to be a service, because conducting parties goes beyond what a seller of wigs would normally do in promoting its goods. *In re Heavenly Creations, Inc.*, 168 USPQ 317 (TTAB 1971).

1301.02 What Is a Service Mark

Not every word, combination of words, or other designation used in the sale or advertising of services is registrable as a service mark. To function as a service

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mark, the asserted mark must be used in a way that identifies and distinguishes the source of the services recited in the application. Even if it is clear that the applicant is rendering a service (see TMEP §§1301.01 *et seq.*), the record must show that the asserted mark actually identifies and distinguishes the source of the service recited in the application. *In re Advertising and Marketing Development Inc.*, 821 F.2d 614, 2 USPQ2d 2010 (Fed. Cir. 1987) (stationery specimen showed use of THE NOW GENERATION as a mark for applicant's advertising or promotional services as well as to identify a licensed advertising campaign, where the recited services were specified in a byline appearing immediately beneath the mark).

The fact that the proposed mark appears in an advertisement or brochure in which the services are advertised does not in itself show use as a mark. The record must show that there is a direct association between the mark and the service. See *In re Universal Oil Products Co.*, 476 F.2d 653, 177 USPQ 456 (C.C.P.A. 1973) (term that identifies only a process does not function as a service mark, even where services are advertised in the same specimen brochure in which the name of the process is used); *In re Duratech Industries Inc.*, 13 USPQ2d 2052 (TTAB 1989) (term used on bumper sticker with no reference to the services does not function as a mark); *Peopleware Systems, Inc. v. Peopleware, Inc.*, 226 USPQ 320 (TTAB 1985) (term PEOPLEWARE used within a byline on calling card specimen does not constitute service mark usage of that term, even if specimen elsewhere shows that applicant provides the recited services); *In re J.F. Pritchard & Co. and Kobe Steel, Ltd.*, 201 USPQ 951 (TTAB 1979) (proposed mark used only to identify a liquefaction process in brochure advertising the services does not function as a mark, because there is no direct association between the mark and the offering of services). See TMEP §1301.04(b).

The question of whether a designation functions as a mark that identifies and distinguishes the recited services is determined by examining the specimen(s) and any other evidence in the record that shows how the designation is used. *In re Morganroth*, 208 USPQ 284 (TTAB 1980); *In re Republic of Austria Spanische Reitschule*, 197 USPQ 494 (TTAB 1977). It is the perception of the ordinary customer that determines whether the asserted mark functions as a service mark, not the applicant's intent, hope or expectation that it do so. *In re Standard Oil Co.*, 275 F.2d 945, 125 USPQ 227 (C.C.P.A. 1960). Factors that the examining attorney should consider in determining whether the asserted mark functions as a service mark include whether the wording claimed as a mark is physically separate from textual matter, whether a term is displayed in capital letters or enclosed in quotation marks, and the manner in which a term is used in relation to other material on the specimen.

While a service mark does not have to be displayed in any particular size or degree of prominence, it must be used in a way that makes a commercial impression separate and apart from the other elements of the advertising matter or other material upon which it is used, such that the designation will be recognized by

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prospective purchasers as a source identifier. *In re C.R. Anthony Co.*, 3 USPQ2d 1894 (TTAB 1987); *In re Post Properties, Inc.*, 227 USPQ 334 (TTAB 1985). The proposed mark must not blend so well with other matter on specimen that it is difficult or impossible to discern what the mark is. *In re McDonald's Corp.*, 229 USPQ 555 (TTAB 1985); *In re Royal Viking Line A/S*, 216 USPQ 795 (TTAB 1982); *In re Republic of Austria Spanische Reitschule, supra*; *Ex parte National Geographic Society*, 83 USPQ 260 (Comm'r Pats. 1949). On the other hand, the fact that the proposed mark is prominently displayed does not in and of itself make it registrable, if it is not used in a manner that would be perceived by consumers as an indicator of source. *In re Wakefern Food Corp.*, 222 USPQ 76 (TTAB 1984). The important question is not how readily a mark will be noticed but whether, when noticed, it will be understood as identifying and indicating the origin of the services. *In re Singer Mfg. Co.*, 255 F.2d 939, 118 USPQ 310 (C.C.P.A. 1958).

The presence of the "SM" symbol is not dispositive of the issue of whether matter sought to be registered is used as a service mark. *In re British Caledonian Airways Ltd.*, 218 USPQ 737 (TTAB 1983).

See TMEP §1301.02(a) for further information about matter that does not function as a service mark, TMEP §§1301.01 *et seq.* regarding what constitutes a service, and TMEP §§1301.04 *et seq.* regarding service mark specimens.

1301.02(a) Matter That Does Not Function as a Service Mark

To function as a service mark, a designation must be used in a manner that would be perceived by purchasers as identifying and distinguishing the source of the services recited in the application.

Use of a designation or slogan to convey advertising or promotional information, rather than to identify and indicate the source of the services, is not service mark use. See *In re Standard Oil Co.*, 275 F.2d 945, 125 USPQ 227 (C.C.P.A. 1960) (GUARANTEED STARTING found to be ordinary words that convey information about the services, not a service mark for the services of "winterizing" motor vehicles); *In re Melville Corp.*, 228 USPQ 970 (TTAB 1986) (BRAND NAMES FOR LESS found to be informational phrase that does not function as a mark for retail store services); *In re Brock Residence Inns, Inc.*, 222 USPQ 920 (TTAB 1984) (FOR A DAY, A WEEK, A MONTH OR MORE so highly descriptive and informational in nature that purchasers would be unlikely to perceive it as an indicator of the source of hotel services); *In re Wakefern Food Corp.*, 222 USPQ 76 (TTAB 1984) (WHY PAY MORE found to be a common commercial phrase that does not serve to identify grocery store services); *In re Gilbert Eiseman, P.C.*, 220 USPQ 89 (TTAB 1983) (IN ONE DAY not used as source identifier but merely as a component of advertising matter that conveyed a characteristic of applicant's plastic surgery services); *In re European-American Bank & Trust Co.*, 201 USPQ 788 (TTAB 1979) (slogan THINK ABOUT IT found to be an informational or instructional phrase that

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would not be perceived as a mark for banking services); *In re Restonic Corp.*, 189 USPQ 248 (TTAB 1975) (phrase used merely to advertise goods manufactured and sold by applicant's franchisees does not serve to identify franchising services). Cf. *In re Post Properties, Inc.*, 227 USPQ 334 (TTAB 1985) (the designation QUALITY SHOWS, set off from text of advertising copy in extremely large typeface and reiterated at the conclusion of the narrative portion of the ad, held to be a registrable service mark for applicant's real estate management and leasing services, because it was used in a way that made a commercial impression separate from that of the other elements of advertising material upon which it was used, such that the designation would be recognized by prospective customers as a source identifier). See also TMEP §1202.04 regarding informational matter that does not function as a trademark.

A term that is used only to identify a product, device or instrument sold or used in the performance of a service rather than to identify the service itself does not function as a service mark. See *In re Moody's Investors Service Inc.*, 13 USPQ2d 2043 (TTAB 1989) ("Aaa," as used on the specimen, found to identify the applicant's ratings instead of its rating services); *In re Niagara Frontier Services, Inc.*, 221 USPQ 284 (TTAB 1983) (WE MAKE IT, YOU BAKE IT only identifies pizza, and does not function as a service mark to identify grocery store services); *In re British Caledonian Airways Ltd.*, 218 USPQ 737 (TTAB 1983) (term that identifies a seat in the first class section of an airplane does not function as mark for air transportation services); *In re Editel Productions, Inc.*, 189 USPQ 111 (TTAB 1975) (MINI-MOBILE identifies only a vehicle used in rendering services and does not serve to identify the production of television videotapes for others); *In re Oscar Mayer & Co. Inc.*, 171 USPQ 571 (TTAB 1971) (WIENERMOBILE does not function as mark for advertising and promoting the sale of wieners, where it is used only to identify a vehicle used in rendering claimed services).

Similarly, a term that only identifies a process, style, method, or system used in rendering the services is not registrable as a service mark unless it is also used to identify and distinguish the service. See TMEP §1301.02(e) and cases cited therein.

A term that only identifies a menu item does not function as a mark for restaurant services. *In re El Torito Restaurant Inc.*, 9 USPQ2d 2002 (TTAB 1988).

The name or design of a character or person does not function as a service mark, unless it identifies and distinguishes the services in addition to identifying the character or person. See TMEP §1301.02(b) and cases cited therein.

A term used only as a trade name is not registrable as a service mark. See *In re The Signal Companies, Inc.*, 228 USPQ 956 (TTAB 1986) (journal advertisement submitted as specimen showed use of ONE OF THE SIGNAL COMPANIES merely as an informational slogan, where words appeared only in small, subdued typeface underneath the address and telephone number of applicant's subsidiary). See TMEP §1202.01 for additional information about matter used solely as a trade name.

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Matter that is merely ornamental in nature does not function as a service mark. See *In re Tad's Wholesale, Inc.*, 132 USPQ 648 (TTAB 1962) (wallpaper design not registrable as a service mark for restaurant services). See TMEP §§1202.03 *et seq.* for additional information about ornamentation.

See TMEP §1202.02(a)(vii) regarding functionality and service marks, and TMEP §1202.02(b)(ii) regarding trade dress.

1301.02(b) Names of Characters or Personal Names as Service Marks

Under 15 U.S.C. §1127, a name or design of a character does not function as a service mark, unless it identifies and distinguishes services in addition to identifying the character. If the name or design is used only to identify the character, it is not registrable as a service mark. *In re Hechinger Investment Co. of Delaware Inc.*, 24 USPQ2d 1053 (TTAB 1991) (design of dog appearing in advertisement does not function as mark for retail hardware and housewares services); *In re McDonald's Corp.*, 229 USPQ 555 (TTAB 1985) (APPLE PIE TREE does not function as mark for restaurant services, where the specimen shows use of mark only to identify one character in a procession of characters); *In re Whataburger Systems, Inc.*, 209 USPQ 429 (TTAB 1980) (design of zoo animal character distributed to restaurant customers in the form of an iron-on patch not used in a manner that would be perceived as an indicator of source); *In re Burger King Corp.*, 183 USPQ 698 (TTAB 1974) (fanciful design of king does not serve to identify and distinguish restaurant services). See TMEP §1202.10 regarding the registrability of the names and designs of characters in creative works.

Similarly, personal names (actual names and pseudonyms) of individuals or groups function as marks only if they identify and distinguish the services recited and not merely the individual or group. *In re Mancino*, 219 USPQ 1047 (TTAB 1983) (holding that BOOM BOOM would be viewed by the public solely as applicant's professional boxing nickname and not as an identifier of the service of conducting professional boxing exhibitions); *In re Lee Trevino Enterprises, Inc.*, 182 USPQ 253 (TTAB 1974) (LEE TREVINO used merely to identify a famous professional golfer rather than as a mark to identify and distinguish any services rendered by him); *In re Generation Gap Products, Inc.*, 170 USPQ 423 (TTAB 1971) (GORDON ROSE used only to identify a particular individual and not as a service mark to identify the services of a singing group).

The name of a character or person *is* registrable as a service mark if the record shows that it is used in a manner that would be perceived by purchasers as identifying the services in addition to the character or person. *In re Florida Cypress Gardens Inc.*, 208 USPQ 288 (TTAB 1980) (name CORKY THE CLOWN used on handbills found to function as a mark to identify live performances by a clown, where the mark was used to identify not just the character but also the act or entertainment service performed by the character); *In re Carson*, 197 USPQ 554 (TTAB 1977)

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(individual's name held to function as mark, where specimen showed use of the name in conjunction with a reference to services and information as to the location and times of performances, costs of tickets, and places where tickets could be purchased); *In re Ames*, 160 USPQ 214 (TTAB 1968) (name of musical group functions as mark, where name was used on advertisements that prominently featured a photograph of the group and gave the name, address and telephone number of the group's booking agent); *In re Folk*, 160 USPQ 213 (TTAB 1968) (THE LOLLIPOP PRINCESS functions as a service mark for entertainment services, namely, telling children's stories by radio broadcasting and personal appearances).

See TMEP §§1202.09(a) *et seq.* regarding the registrability of the names and pseudonyms of authors and performing artists, and TMEP §1202.09(b) regarding the registrability of the names of artists used on original works of art.

1301.02(c) Three-Dimensional Service Marks

The three-dimensional configuration of a building is registrable as a service mark only if it is used in such a way that it is or could be perceived as a mark. Evidence of use might include menus or letterhead that shows promotion of the building's design, or configuration, as a mark. See *In re Lean-To Barbecue, Inc.*, 172 USPQ 151 (TTAB 1971); *In re Master Kleens of America, Inc.*, 171 USPQ 438 (TTAB 1971); *In re Griffs of America, Inc.*, 157 USPQ 592 (TTAB 1968). Cf. *Fotomat Corp. v. Cochran*, 437 F. Supp. 1231, 194 USPQ 128 (D. Kan. 1977); *Fotomat Corp. v. Photo Drive-Thru, Inc.*, 425 F. Supp. 693, 193 USPQ 342 (D.N.J. 1977).

A three-dimensional costume design may function as a mark for entertainment services. See *In re Red Robin Enterprises, Inc.*, 222 USPQ 911 (TTAB 1984).

Generally, a photograph is a proper specimen of use for a three-dimensional mark. However, photographs of a building are not sufficient to show use of the building design as a mark for services performed in the building if they only show the building in which the services are performed. The specimen must show that the proposed mark is used in a way that would be perceived as a mark.

See 37 C.F.R. §2.52(b)(2) and TMEP §807.10 regarding drawings of three-dimensional marks.

When examining a three-dimensional mark, the examining attorney must determine whether the proposed mark is inherently distinctive. See TMEP §1202.02(b)(ii).

1301.02(d) Titles of Radio and Television Programs

The title of a continuing series of presentations (e.g., a television or movie "series," a series of live performances, or a continuing radio program), may constitute a mark for either entertainment services or educational services. However, the title of a single creative work, that is, the title of one episode or event presented as one

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program, does not function as a service mark. *In re Posthuma*, 45 USPQ2d 2011 (TTAB 1998) (term that identifies title of a play not registrable as service mark for entertainment services). The record must show that the matter sought to be registered is more than the title of one presentation, performance or recording. See TMEP §§1202.08 *et seq.* and cases cited therein for further information regarding the registrability of the title of a single creative work.

Specimens that show use of a service mark in relation to television programs or a movie series may be in the nature of a photograph of the video or film frame when the mark is used in the program.

Service marks in the nature of titles of entertainment programs may be owned by the producer of the show, by the broadcasting system or station, or by the author or creator of the show, depending upon the circumstances. Normally, an applicant's statement that the applicant owns the mark is sufficient; the examining attorney should not inquire about ownership unless information in the record clearly contradicts the applicant's verified statement that it is the owner of the mark.

1301.02(e) Process, System or Method

A term that only identifies a process, style, method, system, or the like is not registrable as a service mark. A system or process is only a way of doing something, not a service. The name of a system or process does not become a service mark unless it is also used to identify and distinguish the service. *In re Universal Oil Products Co.*, 476 F.2d 653, 177 USPQ 456 (C.C.P.A. 1973) (term not registrable as service mark where the specimen shows use of the term only as the name of a process, even though applicant is in the business of rendering services generally and the services are advertised in the same specimen brochure in which the name of the process is used); *In re Hughes Aircraft Co.*, 222 USPQ 263 (TTAB 1984) (term does not function as service mark where it only identifies a photochemical process used in rendering service); *In re Turbine Metal Technology, Inc.*, 219 USPQ 1132 (TTAB 1983) (term that merely identifies a coating material does not function as mark for repair and reconstruction services); *In re Vsesoyuzny Ordena Trudovogo Krasnogo Znameni Nauchnoissledovatel'skiy Gorno-Metallurgicheskiy Institut Tsvetnykh Metallov "Vnitsvetmet"*, 219 USPQ 69 (TTAB 1983) (KIVCET identifies only a process and plant configuration, not engineering services); *In re Scientific Methods, Inc.*, 201 USPQ 917 (TTAB 1979) (term that merely identifies educational technique does not function as mark to identify educational services); *In re J.F. Pritchard & Co. and Kobe Steel, Ltd.*, 201 USPQ 951 (TTAB 1979) (term used only to identify liquefaction process does not function as mark to identify design and engineering services); *In re Produits Chimiques Ugine Kuhlmann Societe Anonyme*, 190 USPQ 305 (TTAB 1976) (term that merely identifies a process used in rendering the service does not function as service mark); *In re Lurgi Gesellschaft Fur Mineraloltechnik m.b.H.*, 175 USPQ 736 (TTAB 1972) (term that merely identifies process for recovery of high purity aromatics from

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hydrocarbon mixtures does not function as service mark for consulting, designing and construction services); *Ex parte Phillips Petroleum Co.*, 100 USPQ 25 (Comm'r Pats. 1953) (although used in advertising of applicant's engineering services, CYCLOVERSION was only used in the advertisements to identify a catalytic treating and conversion process).

If the term is used to identify *both* the system or process *and* the services rendered by means of the system or process, the designation may be registrable as a service mark. See *Liqwacon Corp. v. Browning-Ferris Industries, Inc.*, 203 USPQ 305 (TTAB 1979), in which the Board found that the mark LIQWACON identified both a waste treatment and disposal service and a chemical solidification process.

The name of a system or process is registrable only if: (1) the applicant is performing a service (see TMEP §§1301.01 *et seq.*); and (2) the designation identifies and indicates the source of the service. In determining eligibility for registration, the examining attorney must carefully review the specimen, together with any other information in the record, to see how the applicant uses the proposed mark. The mere advertising of the recited services in a brochure that refers to the process does not establish that a designation functions as a service mark; there must be some association between the offer of services and the matter sought to be registered. *In re Universal Oil Products Co.*, *supra*; *In re J.F. Pritchard & Co.*, *supra*.

1301.02(f) Computer Software

A term that only identifies a computer program does not become a service mark unless it is also used to identify and distinguish the service. *In re Walker Research, Inc.*, 228 USPQ 691 (TTAB 1986) (term that merely identifies computer program used in rendering services does not function as a mark to identify market analysis services); *In re Information Builders Inc.*, 213 USPQ 593 (TTAB 1982) (term identifies only a computer program, not the service of installing and providing access to a computer program). However, it is important to review the record carefully to determine the manner of use of the mark and the impression it is likely to make on purchasers. The Trademark Trial and Appeal Board has noted that:

[I]n today's commercial context if a customer goes to a company's website and accesses the company's software to conduct some type of business, the company may be rendering a service, even though the service utilizes software. Because of the ... blurring between services and products that has occurred with the development and growth of web-based products and services, it is important to review all the information in the record to understand both how the mark is used and how it will be perceived by potential customers.

In re Ancor Holdings, 79 USPQ2d 1218, 1221 (TTAB 2006) (INFOMINDER found to identify reminder and scheduling services provided via the Internet, and not just software used in rendering the services).

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1301.03 Use of Service Mark in Commerce

1301.03(a) Use of Service Mark in Advertising to Identify Services

In examining an application under 15 U.S.C. §1051(a), an amendment to allege use under 15 U.S.C. §1051(c), or a statement of use under 15 U.S.C. §1051(d), the examining attorney ordinarily should refuse registration if the record shows that the services advertised have not been rendered. For example, the use of a mark in the announcement of a future service does not constitute use as a service mark. *In re Port Authority of New York*, 3 USPQ2d 1453 (TTAB 1987) (advertising and promoting telecommunications services before the services were available insufficient to support registration); *In re Cedar Point, Inc.*, 220 USPQ 533 (TTAB 1983) (advertising of OCEANA marine entertainment park, which was not yet open, held not a valid basis for registration); *In re Nationwide Mutual Ins. Co.*, 124 USPQ 465 (TTAB 1960) (stickers placed on policies, bills and letters announcing prospective name change is mere adoption, not service mark use).

See TMEP §806.03(c) regarding amendment of the basis to intent-to-use under 15 U.S.C. §1051(b) when a §1(a) basis fails; TMEP §1104.10 regarding withdrawal of an amendment to allege use, and TMEP §§1109.16 *et seq.* regarding the time limits for correcting deficiencies in a statement of use.

1301.03(b) Rendering of Service in Commerce Regulable by Congress

In an application under §1(a) or §1(b) of the Trademark Act, 15 U.S.C. §1051(a) or §1051(b), the applicant must use the mark in commerce before a registration may be granted. Section 45 of the Act, 15 U.S.C. §1127, defines “commerce” as “all commerce which may lawfully be regulated by Congress.” See TMEP §§901.01 and 901.03.

The following are three examples of how a service may be rendered in commerce: (1) the applicant’s services are rendered across state lines; (2) customers come across state lines in response to advertising for the services; and (3) the applicant’s licensees or franchisees who use the mark are located in more than one state. See TMEP §901.03 and cases cited therein.

1301.04 Specimens of Use for Service Marks

A service mark specimen must show the mark as actually used in the sale or advertising of the services recited in the application. 37 C.F.R. §2.56(b)(2). Acceptable specimens may include newspaper and magazine advertisements, brochures, billboards, handbills, direct-mail leaflets, menus (for restaurants), and the like. However, printer’s proofs for advertisements, publicity releases to news media, or printed articles resulting from such releases, are not accepted because they do not show use of the mark by the applicant in the sale or advertising of the services. Business documents such as letterhead and invoices may be acceptable service

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mark specimens if they show the mark and refer to the relevant services. See TMEP §1301.04(b).

See 37 C.F.R. §2.59 and TMEP §904.05 regarding substitute specimens.

1301.04(a) Specimens Must Show Use as a Service Mark

To show service mark usage, the specimen must show use of the mark in a manner that would be perceived by potential purchasers as identifying the applicant's services and indicating their source. *In re Universal Oil Products Co.*, 476 F.2d 653, 177 USPQ 456 (C.C.P.A. 1973) (term that identified only a process held not registrable as service mark, even though applicant was rendering services and the name of the process appeared in the same brochure in which the services were advertised); *In re A La Vieille Russie, Inc.*, 60 USPQ2d 1895 (TTAB 2001) (RUSSIANART perceived as informational matter rather than as service mark for art dealership services, where the term was displayed inconspicuously in the specimen brochure, in the same size and font as other informational matter); *In re Moody's Investors Service Inc.*, 13 USPQ2d 2043 (TTAB 1989) ("Aaa," as used on the specimen, found to identify the applicant's ratings instead of its rating services); *In re McDonald's Corp.*, 229 USPQ 555 (TTAB 1985) (APPLE PIE TREE did not function as mark for restaurant services, where the specimen showed use of mark only to identify one character in a procession of characters, and the proposed mark was no more prominent than anything else on specimen); *In re Signal Companies, Inc.*, 228 USPQ 956 (TTAB 1986) (journal advertisement submitted as specimen showed use of ONE OF THE SIGNAL COMPANIES merely as an informational slogan, where the words appeared only in small, subdued typeface underneath the address and telephone number of applicant's subsidiary); *In re Republic of Austria Spanische Reitschule*, 197 USPQ 494 (TTAB 1977) (use of mark as one of many pictures in applicant's brochure would not be perceived as an indication of the source of the services); *Intermed Communications, Inc. v. Chaney*, 197 USPQ 501 (TTAB 1977) (business progress reports directed to potential investors do not show service mark use for medical services); *In re Restonic Corp.*, 189 USPQ 248 (TTAB 1975) (phrase used merely to advertise goods manufactured and sold by applicant's franchisees does not identify franchising services); *In re Reichhold Chemicals, Inc.*, 167 USPQ 376 (TTAB 1970) (technical bulletins and data sheets on which mark was used merely to advertise chemicals do not show use as a service mark for consulting services).

See TMEP §1301.02(a) regarding matter that does not function as a service mark.

1301.04(b) Association Between Mark and Services

Where the mark is used in advertising the services, the specimen must show an association between the mark and the services for which registration is sought. A specimen that shows only the mark, with no reference to the services, does not

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show service mark usage. *In re Adair*, 45 USPQ2d 1211 (TTAB 1997) (tags affixed to decorated Christmas tree that bear the mark “TREE ARTS CO. and design” and the applicant’s location, but make no reference to services, fail to show use for “design services in the nature of designing handcrafted, permanently decorated Christmas and designer trees”); *In re Johnson Controls, Inc.*, 33 USPQ2d 1318 (TTAB 1994) (labels affixed to packaging of valves do not show use of mark for custom manufacture of valves); *In re Duratech Industries Inc.*, 13 USPQ2d 2052 (TTAB 1989) (bumper stickers showing only the mark do not show use to identify “association services, namely promoting the interests of individuals who censor the practice of drinking and driving”); *In re Riddle*, 225 USPQ 630 (TTAB 1985) (cutouts showing mark with no reference to the services held unacceptable for automotive service center); *In re Whataburger Systems, Inc.*, 209 USPQ 429 (TTAB 1980) (iron-on transfer clothing patches in the form and shape of a cartoon animal mark, distributed as free promotional items to restaurant customers at counters, held insufficient to identify restaurant services). See also TMEP §1301.04(c) and cases cited therein.

A specimen that shows the mark as used in the course of performing the services is generally acceptable. Where the record shows that the mark is used in performing (as opposed to advertising) the services, a reference to the services on the specimen itself may not be necessary. *In re Metriplex Inc.*, 23 USPQ2d 1315 (TTAB 1992) (computer printouts showing mark GLOBAL GATEWAY found acceptable to show use of mark to identify data transmission services accessed via computer, because they show use of mark as it appears on computer terminal in the course of rendering the services); *In re Eagle Fence Rentals, Inc.*, 231 USPQ 228 (TTAB 1986) (photograph of rented fence held acceptable for rental of chain link fences, since it shows use of distinctive color scheme in the rendering services); *In re Red Robin Enterprises, Inc.*, 222 USPQ 911 (TTAB 1984) (photograph of costume worn by performer during performance of entertainment services held to be an acceptable specimen). In *Johnson Controls*, 33 USPQ2d at 1320, the Board distinguished *Metriplex* and *Eagle Fence*, noting that the labels were not used in the rendering of the services, as the custom manufacturing services were complete before purchasers ever see the mark.

In determining whether a specimen is acceptable evidence of service mark use, the examining attorney may consider applicant’s explanations as to how the specimen is used, along with any other available evidence in the record that shows how the mark is actually used. See *In re International Environmental Corp.*, 230 USPQ 688 (TTAB 1986), in which a survey distributed to potential customers of applicant’s heating and air conditioning distributorship services was held to be an acceptable specimen even though it did not specifically refer to the services, where the applicant stated that the sale of its services involved ascertaining the needs of customers serviced, and the record showed that the surveys were directed to potential customers and were the means by which applicant offered its distributorship services to the public.

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1301.04(c) Letterhead

Letterhead stationery, business cards or invoices bearing the mark may be accepted if they create an association between the mark and the services. To create an association between the mark and the services, the specimen does not have to spell out the specific nature or type of services. A general reference to the industry may be acceptable. *In re Ralph Mantia Inc.*, 54 USPQ2d 1284 (TTAB 2000) (letterhead and business cards showing the word “Design” are acceptable evidence of use of mark for commercial art design services); *In re Southwest Petro-Chem, Inc.*, 183 USPQ 371 (TTAB 1974) (use of mark on letterhead next to the name SOUTHWEST PETRO-CHEM, INC. found to be sufficient to show use of the mark for “consulting and advisory services relating to the making and using of lubricating oils and greases,” when used for letters in correspondence with customers).

Letterhead or business cards that bear only the mark and a company name and address are not adequate specimens (unless the mark itself has a descriptive portion that refers to the service), because they do not show that the mark is used in the sale or advertising of the particular services recited in the application. *In re Monograms America, Inc.*, 51 USPQ2d 1317 (TTAB 1999) (letterhead specimen showing the mark MONOGRAMS AMERICA and the wording “A Nationwide Network of Embroidery Stores” held insufficient to support registration for consulting services for embroidery stores).

If the letterhead itself does not include a reference to the services, a copy of an actual letter on letterhead stationery bearing the mark is an acceptable specimen of use if the content of the letter indicates the field or service area in which the mark is used. In *Monograms America*, the Board indicated that the letterhead specimen might have been accepted if the applicant had submitted a copy of a letter to a store owner describing the services. 51 USPQ2d at 1319.

1301.04(d) Specimens for Entertainment Services

For live entertainment services, acceptable specimens include a photograph of the group or individual in performance with the name displayed, *e.g.*, the name printed on the drum of a band. For any entertainment service, advertisements or radio or television listings showing the mark may be submitted, but the specimen must show that the mark is used to identify and distinguish the services recited in the application, not just the performer. See *In re Ames*, 160 USPQ 214 (TTAB 1968) (advertisements for records show use of the mark for entertainment services rendered by a musical group, where the advertisements prominently feature a photograph of musical group and give the name, address and telephone number of a booking agent).

A designation that identifies only the performer is not registrable as a service mark. See TMEP §1301.02(b) regarding the registrability of names of characters or

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personal names as service marks, and TMEP §§1202.09(a) *et seq.* regarding the registrability of names and pseudonyms of performing artists.

1301.05 Identification and Classification of Services

See TMEP §§1402.11 *et seq.* regarding identification of services, and TMEP §§1401 *et seq.* regarding classification.

1302 Collective Marks Generally

Section 45 of the Trademark Act, 15 U.S.C. §1127, defines “collective mark” as follows:

The term “collective mark” means a trademark or service mark--

- (1) used by the members of a cooperative, an association, or other collective group or organization, or
- (2) which such cooperative, association, or other collective group or organization has a bona fide intention to use in commerce and applies to register on the principal register established by this Act, and includes marks indicating membership in a union, an association or other organization.

Under the Trademark Act, a collective mark must be *owned by* a collective entity even though the mark is *used by* the members of the collective. There are basically two types of collective marks: (1) collective trademarks or collective service marks; and (2) collective membership marks. The distinction between these types of collective marks is explained in *Aloe Creme Laboratories, Inc. v. American Society for Aesthetic Plastic Surgery, Inc.*, 192 USPQ 170, 173 (TTAB 1976), as follows:

A collective trademark or collective service mark is a mark adopted by a “collective” (*i.e.*, an association, union, cooperative, fraternal organization, or other organized collective group) for use only by its members, who in turn use the mark to identify their goods or services and distinguish them from those of nonmembers. The “collective” itself neither sells goods nor performs services under a collective trademark or collective service mark, but the collective may advertise or otherwise promote the goods or services sold or rendered by its members under the mark. *A collective membership mark* is a mark adopted for the purpose of indicating membership in an organized collective group, such as a union, an association, or other organization. Neither the collective nor its members uses the collective membership mark to identify and distinguish goods or services; rather, the sole function of such a mark is to indicate that the person displaying the mark is a member of the organized collective group.

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See also *In re International Institute of Valuers*, 223 USPQ 350 (TTAB 1984). See TMEP §1303 concerning collective trademarks and service marks; TMEP §1304 concerning collective membership marks; and TMEP §1305, which distinguishes collective trademarks or service marks from trademarks and service marks used by collective organizations.

1302.01 History of Collective Marks

Section 4 of the Trademark Act of 1946, 15 U.S.C. §1054, provides for registration of both collective marks and certification marks, without distinguishing between them, but §45 of the Act, 15 U.S.C. §1127, defines collective marks and certification marks separately, as distinctly different types of marks. (See TMEP §§1306 *et seq.* regarding certification marks.)

A brief history will serve to put these sections in perspective. The earlier statutory provision, out of which §4 and the accompanying definitions in §45 grew, was the June 10, 1938, amendment of the Trademark Act of 1905. Under the Act of 1905, registration could be based only on a person's own use of a mark. The purpose of the 1938 amendment was to provide for registration of a mark by an owner who "exercises legitimate control over the use of a collective mark." "Collective marks," however, were not defined under the Act of 1905, as amended. Section 45 of the Act of 1946 defined the separate types of marks.

See TMEP §1304.01 for additional history relating to collective membership marks.

1303 Collective Trademarks and Collective Service Marks

Collective trademarks and collective service marks indicate commercial origin of goods or services, but as *collective* marks they indicate that the party providing the goods or services is a member of a certain group and meets its standards for admission. The mark is used by all members of the group; therefore, no one member can own the mark, and the collective organization holds the title to the collectively used mark for the benefit of all members of the group.

The collective organization itself neither sells goods nor performs services under the mark, but may advertise to publicize the mark and promote the goods or services sold by its members under the mark. For example, an agricultural cooperative of produce sellers does not sell its own goods or render services, but promotes the goods and services of its members.

A specimen of use of a collective trademark or service mark must show use of the mark by a member on the member's goods or in the sale or advertising of the member's services. 37 C.F.R. §2.56(b)(3); TMEP §1303.02(b).

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1303.01 Use of Collective Trademark and Collective Service Marks By Members

Applications for registration of collective trademarks and collective service marks are different in form from applications for registration of other trademarks and service marks, because of the difference in ownership and use of collective marks.

Under the definition of “collective mark” in §45 of the Trademark Act, 15 U.S.C. §1127, a collective mark must be owned by a collective entity. The use of a collective trademark or collective service mark is by members of the collective. Therefore, in an application based on use in commerce under §1(a) of the Trademark Act, 15 U.S.C. §1051(a), the applicant must assert that the applicant is exercising legitimate control over the use of the mark in commerce by its members.

In an application based on §1(b), §44 or §66(a) of the Act, 15 U.S.C. §1051(b), 15 U.S.C. §1126 or 15 U.S.C. §1141f(a), the applicant must assert that the applicant has a bona fide intention to exercise legitimate control over the use of the mark in commerce by its members. In a §1(b) application, before the mark can register, the applicant must file an amendment to allege use under 15 U.S.C. §1051(c) or a statement of use under 15 U.S.C. §1051(d) alleging that the applicant is exercising legitimate control over the use of the mark in commerce by its members.

In certain situations, notwithstanding the use of a collective trademark or collective service mark by the members of the collective, the collective itself may also use the same mark as a trademark for the goods covered by the collective trademark or service mark registration. See TMEP §1305. The “anti-use-by-owner rule” of §4 of the Trademark Act, 15 U.S.C. §1054, does not apply to collective marks. See *Roush Bakery Products Co. v. F.R. Lepage Bakery Inc.*, 4 USPQ2d 1401 (TTAB 1987), *aff'd*, 851 F.2d 351, 7 USPQ2d 1395 (Fed. Cir. 1988), *withdrawn, vacated and remanded*, 863 F.2d 43, 9 USPQ2d 1335 (Fed. Cir. 1988), *vacated and modified*, 13 USPQ2d 1045 (TTAB 1989). The Trademark Law Revision Act of 1988, which became effective on November 16, 1989, amended §4 to indicate that the “anti-use-by-owner rule” in that section applies specifically to certification marks.

1303.02 Examination of Collective Trademark and Collective Service Mark Applications

The examination of applications to register collective trademarks and collective service marks is conducted in a manner similar to the examination of applications to register regular trademarks and service marks, using most of the same criteria of registrability. Thus, the same standards generally applicable to trademarks and service marks are used in considering issues such as descriptiveness or disclaimers. However, use and ownership requirements are slightly different due to the nature of collective marks. See TMEP §§1303.02(c) *et seq.* See TMEP §§1304 *et seq.* regarding examination of applications to register collective membership marks.

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1303.02(a) Classification of Goods and Services in Collective Trademark and Collective Service Mark Applications

The goods and services recited in collective trademark and collective service mark applications are assigned to the same classes that are appropriate for those goods and services in general, according to the classification schedules set forth in 37 C.F.R. §§6.1 and 6.2. See TMEP §§1401 *et seq.* regarding classification.

1303.02(b) Specimens of Use for Collective Trademark and Collective Service Mark Applications

A specimen of use of a collective trademark or service mark should show use of the mark by a member on the member's goods or in the sale or advertising of the member's services. 37 C.F.R. §2.56(b)(3).

The specimen should show use of the mark to indicate that the party providing the goods or services is a member of a certain group. The manner of use required is similar to trademark or service mark use. For example, collective trademark specimens should show the mark used on the goods, or packaging for the goods; collective service mark specimens should show the mark used in advertising for the services, or in the rendering of the services.

The purpose of the mark must be to indicate that the product or service is provided by a member of a collective group. However, the specimen itself does not have to state that purpose explicitly. The examining attorney should accept the specimen if the mark is used on the specimen to indicate the source of the product or service, and there is no information in the record that is inconsistent with the applicant's averments that the mark is a collective mark owned by a collective group and used by members of the group to indicate membership.

1303.02(c) Special Elements of Collective Trademark and Collective Service Mark Applications

1303.02(c)(i) Manner of Control

In addition to specifying and containing all elements that are applicable for trademarks, an application for registration of a collective mark under §1(a) of the Act must specify the class of persons entitled to use the mark, indicating their relationship to the applicant and the nature of the applicant's control over the use of the mark. 37 C.F.R. §2.44(a).

In addition to specifying and containing all elements that are applicable for trademarks, an application for registration of a collective mark under §1(b), §44, or §66(a) of the Act must specify the class of persons intended to be entitled to use the mark, indicating what their relationship to the applicant will be, and the nature of the

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control the applicant intends to exercise over the use of the mark. See 37 C.F.R. §2.44(b).

The following language may be used for the above purpose:

Applicant controls (or, if the application is being filed under §1(b), §44, or §66(a), applicant intends to control) the use of the mark by the members in the following manner: [specify].

A statement that the applicant's bylaws or other written provisions specify the manner of control, or intended manner of control will be sufficient.

1303.02(c)(ii) Use by Members Indicated in Dates-of-Use Clause

When setting out dates of use of a collective mark on goods or in connection with services, in either a §1(a) application or an allegation of use filed in connection with a §1(b) application, the applicant must state that the mark was first used by members (or a member) of the applicant.

1304 Collective Membership Marks

1304.01 History of Membership Marks

Section 4 of the Trademark Act of 1946, 15 U.S.C. §1054, provides that collective marks shall be registrable by persons exercising legitimate control over their use, even though not possessing an industrial or commercial establishment, and the definition of a collective mark in §45, 15 U.S.C. §1127, encompasses marks that indicate membership in a union, association or other organization.

The Trademark Act of 1905 prohibited registration by anyone of symbols of collective groups. The Act of 1946, however, contains no prohibition and thus permits registration by the owners of collective marks, including those used to indicate membership.

Membership marks are not trademarks or service marks in the ordinary sense; they are not used in business or trade, and they do not indicate commercial origin of goods or services. Registration of these marks fills the need of collective organizations who do not use the symbols of their organizations on goods or services but who wish to protect their marks to prevent their use by others. See *Ex parte Supreme Shrine of the Order of the White Shrine of Jerusalem*, 109 USPQ 248 (Comm'r Pats. 1956), regarding the rationale for registration of collective membership marks.

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1304.02 Purpose of Membership Mark

The sole purpose of a collective membership mark is to indicate that the user of the mark is a member of a particular organization.

1304.03 Use of Membership Mark Is by Members

Registration of a membership mark is based on actual use of the mark by the members of a collective organization. The owner of the mark exercises control over the use of the mark; however, because the sole purpose of a membership mark is to indicate membership, use of the mark is by members. See *In re Triangle Club of Princeton University*, 138 USPQ 332 (TTAB 1963) (collective membership mark registration denied because specimen did not show use of mark by members). See also TMEP §1304.09(c).

Nothing in the Trademark Act prohibits the use of the same mark as a membership mark by members and, also, as a trademark or a service mark by the parent organization (see TMEP §1303.01), but the same mark may not be used both as a membership mark and as a certification mark. TMEP §1306.05(a).

1304.04 Who May Apply to Register Membership Mark

Application to register a membership mark must be made by the organization that controls or intends to control the use of the mark and, therefore, owns or is entitled to use the mark. Application may not be made by a member. Before a registration may be issued, however, the mark must have been used by members. See *American Speech-Language-Hearing Association v. National Hearing Aid Society*, 224 USPQ 798 (TTAB 1984); *Constitution Party of Texas v. Constitution Association USA*, 152 USPQ 443 (TTAB 1966).

1304.05 Who May Own Membership Mark

The owner of a collective membership mark is normally the collective organization whose members use the mark. The organization is usually an association, either incorporated or unincorporated, but is not limited to being an association and may have some other form.

A collective membership mark may be owned by someone other than the collective organization whose members use the mark, and the owner might not itself be a collective organization. An example is a business corporation who forms a club for persons meeting certain qualifications, and arranges to retain control of the group and of the mark used by the members of the group. The corporation that has retained control over the use of the mark is the owner of the mark, and is entitled to apply to register the mark. *In re Stencel Aero Engineering Corp.*, 170 USPQ 292 (TTAB 1971).

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1304.06 Nature of the Collective Group

Under the definition of “collective mark” in §45 of the Trademark Act, 15 U.S.C. §1127, only a “cooperative, an association or other collective group or organization” can become the owner of a collective mark. However, there is great variety in the organizational form of collective groups whose members use membership marks. The terms “group” and “organization” are broad enough to cover all groups of persons who are brought together in an organized manner such as to justify their being called “collective.”

In order to apply to register a collective membership mark, the collective organization who owns the mark must be a person capable of suing and being sued in a court of law. See 15 U.S.C. §1127. See TMEP §§803.01 *et seq.*

The persons who compose a collective group may be either natural or juristic persons.

1304.07 Character of the Mark

A collective membership mark may be a letter or letters, a word or words, a design alone, a name or nickname, or other matter that identifies the collective organization or indicates its purpose. A membership mark may, but need not, include the term “member” or the equivalent.

In addition to being printed (the most common form), a membership mark may consist of an object, such as a flag, or may be a part of articles of jewelry, such as pins or rings. See TMEP §§1304.03 and 1304.09(c) regarding use of membership marks and acceptable specimens.

1304.08 Refusal to Register Membership Mark

An application to register a collective membership mark on the Principal Register must meet all the criteria for registration of other marks on the Principal Register. 15 U.S.C. §1054. See 37 C.F.R. §2.46. Likewise, when determining the registrability of a collective membership mark on the Supplemental Register, the same standards are used as are applied to other types of marks. See 37 C.F.R. §2.47. Thus, the same standards generally applicable to trademarks and service marks are used in considering issues such as descriptiveness or disclaimers. *Racine Industries Inc. v. Bane-Clene Corp.*, 35 USPQ2d 1832, 1837 (TTAB 1994); *In re Association of Energy Engineers, Inc.*, 227 USPQ 76, 77 (TTAB 1985).

1304.08(a) Matter That Does Not Function as a Membership Mark

Whether or not matter functions as a collective membership mark is determined by the specimen and evidence of record. It is the use of the mark to indicate membership, rather than the character of the matter composing the mark, that

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determines whether a term or other designation is a collective membership mark. See *Ex parte Grand Chapter of Phi Sigma Kappa*, 118 USPQ 467 (Comm'r Pats. 1958), which held that Greek letter abbreviations are not collective membership marks indicating membership in Greek letter societies simply because some people apply them to athletic jerseys, and *In re Mountain Fuel Supply Co.*, 154 USPQ 384 (TTAB 1967), which held that the design on a jewelry pin indicated longevity rather than membership in an organization. If a proposed mark does not function as a mark indicating membership, the examining attorney should refuse registration under §§1, 2, 4, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, 1054, and 1127. See TMEP §1304.08(c) as to degrees or titles.

1304.08(b) Likelihood of Confusion

Likelihood of confusion may arise from the contemporaneous use of a collective membership mark on the one hand and a trademark or service mark on the other. The same standards used to determine likelihood of confusion between trademarks and service marks also apply to collective membership marks. See 15 U.S.C. §1052(d); *In re National Novice Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984); *Allstate Life Ins. Co. v. Cuna International, Inc.*, 169 USPQ 313 (TTAB 1971), *aff'd*, 487 F.2d 1407, 180 USPQ 48 (C.C.P.A. 1973); *Boise Cascade Corp. v. Mississippi Pine Manufacturers Assn.*, 164 USPQ 364 (TTAB 1969).

The finding of likelihood of confusion between a collective membership mark and a trademark or service mark is not based on confusion as to the source of any goods or services which happen to be provided by the members of the collective organization. Rather, the question is whether relevant persons are likely to believe that the trademark owner's goods or services emanate from, are endorsed by, or are in some way associated with the collective organization. *In re Code Consultants Inc.*, 60 USPQ2d 1699, 1701 (TTAB 2001).

1304.08(c) Degree or Title Designations Contrasted to Membership Marks

Professional, technical, educational, and similar organizations often adopt letters or similar designations to be used by persons to indicate that the persons have passed certain tests or completed certain courses of instruction that are specified by the organization, or have demonstrated a degree of proficiency to the satisfaction of the organization. When such a symbol is used solely as a personal title or degree for an individual (*i.e.*, it is used in a manner that identifies only a title or degree conferred on this individual), then it does not serve to indicate membership in an organization, and registration as a membership mark must be refused. *In re International Institute of Valuers*, 223 USPQ 350 (TTAB 1984) (registration properly refused where use of the mark on specimen indicated award of a degree or title, and not membership in collective entity). See also *In re National Society of Cardiopulmonary Technologists, Inc.*, 173 USPQ 511 (TTAB 1972). Cf. *In re Thacker*, 228 USPQ 961 (TTAB 1986);

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In re National Association of Purchasing Management, 228 USPQ 768 (TTAB 1986);
In re Mortgage Bankers Association of America, 226 USPQ 954 (TTAB 1985).

If the proposed mark functions simply as a degree or title, the examining attorney should refuse registration under §§1, 2, 4, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, 1054, and 1127, on the ground that the matter does not function as a membership mark. See TMEP §1304.08(a).

1304.09 Examination of Collective Membership Mark Applications

The examination of collective membership mark applications is conducted in the same manner as the examination of applications to register trademarks and service marks, using the same criteria of registrability. Thus, the same standards generally applicable to trademarks and service marks are used in considering issues such as descriptiveness or disclaimers. However, use and ownership requirements are slightly different due to the nature of collective membership marks.

1304.09(a) Classification in Membership Mark Applications

Section 1 and §44 Applications. In applications under §§1 and 44 of the Trademark Act, collective membership marks are classified in Class 200. 37 C.F.R. §6.4. Class 200 was established as a result of the decision in *Ex parte Supreme Shrine of the Order of the White Shrine of Jerusalem*, 109 USPQ 248 (Comm'r Pats. 1956). Before this decision, there was no registration of membership insignia as such on the theory that all collective marks were either collective trademarks or collective service marks. Some marks that were actually membership marks were registered under the Act of 1946 as collective service marks, and a few were registered as collective trademarks. That practice was discontinued upon the clarification of the basis for registration of membership marks and the creation of Class 200.

Section 66(a) Applications. In a §66(a) application (*i.e.*, a request for extension of protection of an international registration to the United States under the Madrid Protocol), classification is determined by the International Bureau of the World Intellectual Property Organization ("IB"), in accordance with the *Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks* ("*Nice Agreement*"). Class 200 comes from the old United States classification system (see TMEP §1401.02) and is not included in the international classification system. In a §66(a) application, the international classification of goods/services cannot be changed from the classification given to the goods/services by the IB. See TMEP §1401.03(d). Accordingly, if the mark in a §66(a) application appears to be a collective membership mark, the United States Patent and Trademark Office ("USPTO") **will not** reclassify it into Class 200. However, the applicant must comply with all other United States requirements for collective membership marks, regardless of the classification chosen by the IB.

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1304.09(b) Identifications in Membership Mark Applications

An identification of goods or services is not appropriate in connection with a collective membership mark. The purpose of a collective membership mark is to indicate membership in an organization. Appropriate identification language would be, “to indicate membership in an organization (association, club or the like) ...,” followed by a phrase indicating the nature of the organization or association, e.g., “to indicate membership in an organization of computer professionals.”

The nature of an organization can be indicated by specifying the area of activity of its members (e.g., they may sell lumber, or cosmetics, or food, or may deal in chemical products or household goods, or provide services as fashion designers or engineers or accountants). If goods or services are not directly involved, the nature of an organization can be indicated by specifying the organization's type or purpose (such as a service or social club, a political society, a trade association, a beneficial fraternal organization, or the like). Detailed descriptions of an organization's objectives or activities are not necessary. It is sufficient if the identification indicates broadly either the field of activity as related to the goods or services, or the general type or purpose of the organization.

1304.09(c) Specimens of Use for Membership Marks

The owner of a collective membership mark exercises control over the use of the mark but does not itself use the mark to indicate membership. A specimen of use of a collective membership mark must show use by members to indicate membership in the collective organization. 37 C.F.R. §2.56(b)(4). *In re International Association for Enterostomal Therapy, Inc.*, 218 USPQ 343 (TTAB 1983); *In re Triangle Club of Princeton University*, 138 USPQ 332 (TTAB 1963). See also TMEP §1304.03.

The most common type of specimen is a membership card. Membership certificates are also acceptable. The applicant may submit a blank or voided membership card or certificate.

For trade or professional associations, decals bearing the mark for use by members on doors or windows in their establishments, wall plaques bearing the mark, or decals or plates for use, e.g., on members' vehicles, are satisfactory specimens. If the members are in business and place the mark on their business stationery to show their membership, pieces of such stationery are acceptable. Flags, pennants, and banners of various types used in connection with political parties, club groups, or the like could be satisfactory specimens.

Many associations, particularly fraternal societies, use jewelry such as pins, rings or charms to indicate membership. See *In re Triangle Club of Princeton University*, *supra*. However, not every ornamental design on jewelry is necessarily an indication of membership. The record must show that the design on a piece of jewelry is actually an indication of membership before the jewelry can be accepted as a

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specimen of use. See *In re Institute for Certification of Computer Professionals*, 219 USPQ 372 (TTAB 1983) (in view of contradictory evidence in record, lapel pin with nothing more than CCP thereon was not considered evidence of membership); *In re Mountain Fuel Supply Co.*, 154 USPQ 384 (TTAB 1967) (design on pin did not indicate membership in organization, but merely showed length of service).

Shoulder, sleeve, pocket, or similar patches, whose design constitutes a membership mark and which are authorized by the parent organization for use by members on garments to indicate membership, are normally acceptable as specimens. Clothing authorized by the parent organization to be worn by members may also be an acceptable specimen.

A specimen that shows use of the mark by the collective organization itself, rather than by a member, is not acceptable. Collective organizations often publish various kinds of printed material, such as catalogs, directories, bulletins, newsletters, magazines, programs, and the like. Placing the mark on these items by the collective organization represents use of the mark as a trademark or service mark to indicate that the collective organization is the source of the material. The mark is not placed on these items by the parent organization to indicate membership of a person in the organization.

1304.09(d) Special Elements of Applications for Collective Membership Marks

1304.09(d)(i) Exercise of Control

An application to register a collective membership mark must accurately convey the use or intended use of the mark with appropriate language, as follows.

In an application based on use in commerce under §1(a) of the Trademark Act, the applicant must assert that the applicant is exercising legitimate control over the use of the mark in commerce by its members.

In an application based on §1(b), §44 or §66(a) of the Act, the applicant must assert that the applicant has a bona fide intention to exercise legitimate control over the use of the mark in commerce by its members. In a §1(b) application, before the mark can register, the applicant must file an amendment to allege use under 15 U.S.C. §1051(c) or a statement of use under 15 U.S.C. §1051(d) alleging that the applicant is exercising legitimate control over the use of the mark in commerce by its members.

1304.09(d)(ii) Manner of Control

In addition to specifying and containing all elements that are applicable for trademarks, an application for registration of a collective mark under §1(a) of the Act must specify the class of persons entitled to use the mark, indicating their

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relationship to the applicant and the nature of the applicant's control over the use of the mark. 37 C.F.R. §2.44(a).

In addition to specifying and containing all elements that are applicable for trademarks, an application for registration of a collective mark under §1(b), §44, or §66(a) of the Act must specify the class of persons intended to be entitled to use the mark, indicating what their relationship to the applicant will be, and the nature of the control the applicant intends to exercise over the use of the mark. *Cf.* 37 C.F.R. §2.44(b).

The following language may be used for the above purpose:

Applicant controls (or, if the application is being filed under §1(b), §44, or §66(a), applicant intends to control) the use of the mark by the members in the following manner: [specify].

A statement that the applicant's bylaws or other written provisions specify the manner of control, or intended manner of control will be sufficient.

1304.09(d)(iii) Use by Members Indicated in Dates-of-Use Clause

When setting out dates of use of a collective membership mark, the application or allegation of use must state that the mark was first used by members of the applicant rather than by the applicant, and that the mark was first used on a specified date to indicate membership rather than first used on goods or in connection with services.

1305 Trademarks and Service Marks Used by Collective Organizations

A collective organization may itself use trademarks and service marks to identify its goods and services, as opposed to collective trademarks and service marks or collective membership marks used by the collective's members. *See B.F. Goodrich Company v. National Cooperatives, Inc.*, 114 USPQ 406 (Comm'r Pats. 1957) (mark used to identify tires made for applicant cooperative and sold by its distributors is a trademark, not a collective mark that identifies goods of applicant's associated organizations; applicant alone provides specifications and other instructions and applicant alone is responsible for faulty tires).

The examination of applications to register trademarks and service marks used or intended to be used by collective organizations is conducted in the same manner as for other trademarks and service marks, using the same criteria of registrability.

The form of the application used by collective organizations is the same as for those used or intended to be used by other applicants. The collective organization should be listed as the applicant, because it uses or intends to use the mark itself. The

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specimen submitted must be material applied by the collective organization to its goods or used in connection with its services.

1306 Certification Marks

1306.01 Definition of Certification Mark

Section 4 of the Trademark Act, 15 U.S.C. §1054, provides for the registration of “certification marks, including indications of regional origin.” Section 45 of the Trademark Act, 15 U.S.C. §1127, defines “certification mark” as follows:

The term “certification mark” means any word, name, symbol, or device, or any combination thereof--

- (1) used by a person other than its owner, or
- (2) which its owner has a bona fide intention to permit a person other than the owner to use in commerce and files an application to register on the principal register established by this Act,

to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of such person’s goods or services or that the work or labor on the goods or services was performed by members of a union or other organization.

A certification mark “is a special creature created for a purpose uniquely different from that of an ordinary service mark or trademark...” *In re Florida Citrus Commission*, 160 USPQ 495, 499 (TTAB 1968).

There are generally three types of certification marks. First, there are certification marks that certify that goods or services originate in a specific geographic region (e.g., ROQUEFORT for cheese). See *Community of Roquefort v. William Faehndrich, Inc.*, 303 F.2d 494, 133 USPQ 633 (2d Cir. 1962); *State of Florida, Department of Citrus v. Real Juices, Inc.*, 330 F. Supp. 428, 171 USPQ 66 (M.D. Fla. 1971) (SUNSHINE TREE for citrus from Florida); *Bureau National Interprofessionnel Du Cognac v. International Better Drinks Corp.*, 6 USPQ2d 1610 (TTAB 1988) (COGNAC for distilled brandy from a region in France). See TMEP §§1306.02 *et seq.*

Second, there are certification marks that certify that the goods or services meet certain standards in relation to quality, materials, or mode of manufacture (e.g., approval by Underwriters Laboratories). See *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 906 F.2d 1568, 15 USPQ2d 1359 (Fed. Cir. 1990) (UL certifies, among other things, representative samplings of electrical equipment meeting certain safety standards); *In re Celanese Corporation of America*, 136 USPQ 86 (TTAB 1962) (CELANESE certifies plastic toys meeting certifier’s safety standards).

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Third, certification marks may certify that the work or labor on the products or services was performed by a member of a union or other organization, or that the performer meets certain standards. See TMEP §1306.03 and cases cited therein for further information.

There are two characteristics that differentiate certification marks from trademarks or service marks. First, a certification mark is not used by its owner and, second, a certification mark does not indicate commercial source nor distinguish the goods or services of one person from those of another person. See TMEP §1306.09(a) for a discussion of the distinction between a certification mark and a collective trademark, collective service mark or collective membership mark.

See Holtzman, *Certification Marks: An Overview*, 81 Trademark Rep. 180 (1991).

1306.01(a) Use Is by Person Other than Owner

A certification mark may not be used, in the trademark sense of “used,” by the owner of the mark; it may be used only by a person or persons other than the owner of the mark. That is, the owner of a certification mark does not apply the mark to his or her goods or services and, in fact, usually does not attach or apply the mark at all. The mark is generally applied by other persons to their goods or services, with authorization from the owner of the mark.

The owner of a certification mark does not produce the goods or perform the services in connection with which the mark is used, and thus does not control their nature and quality. Therefore, it is not appropriate to inquire about control over the nature and quality of the goods or services. What the owner of the certification mark does control is use of the mark by others on their goods or services. This control consists of taking steps to ensure that the mark is applied only to goods or services that contain the characteristics or meet the requirements that the certifier/owner has established or adopted for the certification. See TMEP §1306.06(g)(ii) regarding submission of the standards established by the certifier to determine whether the certification mark may be used in relation to the goods and/or services of others.

1306.01(b) Purpose Is to Certify, Not to Indicate Source

The purpose of a certification mark is to inform purchasers that the goods or services of a person possess certain characteristics or meet certain qualifications or standards established by another person. A certification mark does not indicate origin in a single commercial or proprietary source. In certifying, the same mark is used on the goods or services of many different producers.

The message conveyed by a certification mark is that the goods or services have been examined, tested, inspected, or in some way checked by a person who is not their producer, by methods determined by the certifier/owner. The placing of the mark on goods or its use in connection with services thus constitutes a certification

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by someone other than the producer that the prescribed characteristics or qualifications of the certifier for those goods or services have been met.

1306.02 Certification Marks That Are Indications of Regional Origin

A geographical term may be used, either alone or as a portion of a composite mark, to certify that the goods originate in the particular geographical region identified by the term. As noted in *Community of Roquefort v. William Faehndrich, Inc.*, 303 F.2d 494, 497, 133 USPQ 633, 635 (2d Cir. 1962):

A geographical name does not require a secondary meaning in order to qualify for registration as a certification mark. It is true that section 1054 provides that certification marks are “subject to the provisions relating to the registration of trademarks, so far as they are applicable....” But section 1052(e)(2), which prohibits registration of names primarily geographically descriptive, specifically excepts “indications of regional origin” registrable under section 1054. Therefore, a geographical name may be registered as a certification mark even though it is primarily geographically descriptive.

When a geographical term is used in a composite certification mark to certify regional origin, the examining attorney should not require a disclaimer or refuse registration of the composite mark on the ground that the mark is primarily geographically descriptive. However, when a geographical term used in a composite certification mark is not used to certify regional origin (e.g., “California” used to certify that fruit is organically grown), the examining attorney should refuse registration or require a disclaimer, as appropriate.

Marks that may be used to certify regional origin are not necessarily limited to terms that comprise precise geographical terminology. A distortion of a geographical term, an abbreviation of a geographical term, or a combination of geographical terms can be used as, or in, a certification mark indicating regional origin. It is also possible for a term that is not technically geographical to have significance as an indication of origin solely in a particular region.

The issue in determining whether a designation is registrable as a regional certification mark is whether the public understands that goods bearing the mark come only from the region named in the mark, not whether the public is expressly aware of the certification function of the mark per se. If use of the designation in fact is controlled by the certifier and limited to products meeting the certifier’s standards of regional origin, and if purchasers understand the designation to refer only to products produced in the particular region and not to products produced elsewhere, then the designation functions as a regional certification mark. *Institut National Des Appellations D’Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875 (TTAB 1998).

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A mark that is geographically deceptive may not be registered as a certification mark of regional origin. See TMEP §§1210.05 *et seq.* regarding geographically deceptive marks.

1306.02(a) Indicating the Region

The examining attorney should examine the specimen of use and evidence in the record to determine whether the geographical term is being used as a certification mark to indicate the regional origin of the goods upon which it is used. If the record or other evidence available to the examining attorney indicates that the proposed mark has a principal significance as a generic term denoting a type of goods, registration should be refused. *In re Cooperativa Produttori Latte E Fontina Valle D'Acosta*, 230 USPQ 131 (TTAB 1986) (FONTINA held a generic name of a type of cheese rather than a certification mark indicating regional origin, in view of the fact that non-certified producers outside that region use the term to identify non-certified cheeses). However, a certification mark used to certify regional origin will be deemed to have become a generic term as applied to particular goods only if it has lost its significance as an indication of regional origin of those goods. See *Tea Board of India v. The Republic of Tea, Inc.*, 80 USPQ2d 1881 (TTAB 2006) (applicant failed to establish that the term DARJEELING had become generic due to opposer's alleged failure to control the use of the mark to certify origin in the Darjeeling region of India), and cases cited therein. The basis for refusal of registration on the Principal Register is 15 U.S.C. §§1052(e)(1), 1054, and 1127, and the basis for refusal of registration on the Supplemental Register is 15 U.S.C. §§1054, 1091 and 1127 (see TMEP §1209.02).

When a geographic term is being used as a certification mark to indicate regional origin, the application should define the regional origin that the mark certifies.

1306.02(b) Authority to Control a Geographical Term

When a certification mark consists solely, or essentially, of a geographical term, the examining attorney should inquire as to the authority of the applicant to control the use of the term, if the authority is not obvious. Normally, the entity that has authority to exercise control over the use of a geographical term as a certification mark is a governmental body or a body operating with governmental authorization. The right that a private person can acquire in a geographical term is usually a trademark right, on the basis of exclusive use resulting in the term becoming distinctive of that person's goods. When, however, circumstances make it desirable or necessary for many or all persons in a region to use the name of the region to indicate the origin of their goods, there would be no opportunity for the name to become distinctive for only one person. The term would be used by all persons in the region, not as a trademark indicating commercial origin, but as a certification mark indicating regional origin.

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When a geographical term is used as a certification mark, two elements are of basic concern: first, preserving the freedom of all persons in the region to use the term and; second, preventing abuses or illegal uses of the mark that would be detrimental to all those entitled to use the mark. Normally, a private individual is not in the best position to fulfill these objectives. The government of a region would be the logical authority to control the use of the name of the region. The government, either directly or through a body to which it has given authority, would have power to preserve the right of all persons and to prevent abuse or illegal use of the mark.

1306.02(c) The Government as Applicant for a Geographical Certification Mark

The applicant may be the government itself (such as the government of the United States, a state or a city), one of the departments of a government, or a body operating with governmental authorization that is not formally a part of the government. There may be an interrelationship between bodies in more than one of these categories and the decision as to which is the appropriate body to apply depends on which body actually conducts the certification program or is most directly associated with it. The determination may be made by the applicant, provided the examining attorney does not find any inconsistency between the selection and the facts indicated in the record.

1306.03 Certification Marks Certifying that Labor Was Performed by Specific Group or Individual

A certification mark may be used to certify that the work or labor on the goods or services was performed by a member of a union or other organization, or by a person who meets certain standards and tests of competency set by the certifier. 15 U.S.C. §1127. The certifier does not certify the quality of the work being performed, but only that the work was performed by a member of the union or group, or by someone who meets certain standards. *In re National Institute for Automotive Service Excellence*, 218 USPQ 744, 747 (TTAB 1983). *See also American Speech-Language-Hearing Association v. National Hearing Aid Society*, 224 USPQ 798 (TTAB 1984). Used in this manner, the mark certifies a characteristic of the goods or services. Whether or not specific matter functions as a certification mark depends on whether the matter is used in connection with the goods or services in such a manner that the purchasing public will recognize it, either consciously or otherwise, as a certification mark.

Occasionally, it is not clear whether a term is being used to certify that work or labor relating to the goods or services was performed by someone meeting certain standards or by members of a union or other organization to indicate membership, or whether the term is merely being used as a title or a degree of the performer to indicate professional qualifications. Matter that might appear to be simply a title or a degree may function as a certification mark if used in the proper manner. *See In re*

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Council on Certification of Nurse Anesthetists, ___ USPQ2d ___, Serial No. 75722091 (TTAB March 22, 2007) (CRNA functions as certification mark used to certify that anesthesia services are being performed by a person who meets certain standards and tests of competency); *In re Software Publishers Association*, 69 USPQ2d 2009 (TTAB 2003) (CERTIFIED SOFTWARE MANAGER used on certificate merely indicates that holder of the certificate has been awarded a title or degree, and is not likely to be perceived as certification mark); *In re National Association of Purchasing Management*, 228 USPQ 768 (TTAB 1986) (C.P.M. used merely as title or degree, not as certification mark); *In re National Association of Legal Secretaries (International)*, 221 USPQ 50 (TTAB 1983) (PROFESSIONAL LEGAL SECRETARY not used on the specimen in such a way as to indicate certification significance); *In re National Institute for Automotive Service Excellence, supra* (design mark not used simply as a degree or title, but to certify that the performer of the services had met certain standards); *In re Institute of Certified Professional Business Consultants*, 216 USPQ 338 (TTAB 1982) (CPBC not used as a certification mark for business consulting services, but only as a title or degree); *In re Professional Photographers of Ohio, Inc.*, 149 USPQ 857 (TTAB 1966) (CERTIFIED PROFESSIONAL PHOTOGRAPHER used only as the title of a person, not as a certification mark). Cf. *In re University of Mississippi*, 1 USPQ2d 1909 (TTAB 1987) (use of university seal on diplomas did not represent use as a certification mark).

See TMEP §1306.09(a) regarding the difference between a certification mark and a collective mark.

1306.04 Ownership of Certification Marks

The owner of a certification mark is the party responsible for the certification that is conveyed by the mark. The party who affixes the mark, with authorization of the certifier, does not own the mark; nor is the mark owned by someone who merely acts as an agent for the certifier, for example, an inspector hired by the certifier. The certifier, as owner, is the only person who may file an application for registration of a certification mark. See *In re Safe Electrical Cord Committee*, 125 USPQ 310 (TTAB 1960).

Certification is often the sole activity for the owner of a certification mark. However, a person is not necessarily precluded from owning a certification mark because he or she also engages in other activities, including the sale of goods or the performance of services. However, the certification mark may not be the same mark that the person uses as a trademark or service mark on goods or services. See TMEP §1306.05(a).

Examples of organizations which conduct both types of activities are trade associations and other membership or “club” types of businesses, such as automobile associations. These organizations may perform services for their

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members, and sell various goods to their members and others, as well as conduct programs in which they certify characteristics or other aspects of goods or services, especially of kinds which relate to the main purpose of the association.

Manufacturing or service companies that do not certify the goods or services of members may nonetheless engage in certification programs under proper circumstances. For example, a manufacturer of chemical wood preservatives might conduct a program certifying certain characteristics of wood or wood products that are treated and sold by others. Among the characteristics or circumstances certified could be the fact that a preservative produced by this manufacturer under a specified trademark was used in the treatment.

As another example, a magazine publisher may conduct a certification program relating to goods or services that are advertised in or have some relevance to the interest area of the magazine.

The certifier/owner determines the requirements for the certification. The standards do not have to be original with the certifier/owner, but may be standards established by another person, such as specifications promulgated by a government agency, or standards developed through research of a private research organization. See TMEP §1306.06(g)(ii) regarding the standards for certification.

If the name of the organization that developed the standards is part of the mark, an issue could arise as to whether the mark is deceptively misdescriptive under 15 U.S.C. §1052(e)(1) (see TMEP §1209.04) or falsely suggests a connection with persons, institutions, beliefs or national symbols under 15 U.S.C. §1052(a) (see TMEP §1203.03(e)).

1306.05 Characteristics of Certification Marks

The Trademark Act does not require that a certification mark be in any specific form or include any specific wording. A certification mark can be wording only, design only, or a combination of wording and design. In other words, there is no particular way that a mark must look in order to be a certification mark.

A certification mark often includes wording such as “approved by,” “inspected,” “conforming to” or “certified,” or similar wording, which is natural since certification (or approval) is practically the only significance the mark is to have when it is used on goods or in connection with services. However, this wording is not required, and a mark that entirely lacks this wording can perform the function of certification.

The examining attorney must look to the facts disclosed in the record to determine whether the mark is used in certification activity and is in fact a certification mark.

It is not necessary to show that the mark is instantly recognizable as a certification mark, or that the mark has already become well known to the public as a certification mark. However, it should be clear from the record that the circumstances

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surrounding the use or promotion of the mark will give certification significance to the mark in the marketplace. See *Ex parte Van Winkle*, 117 USPQ 450 (Comm'r Pats. 1958).

1306.05(a) Same Mark Not Registrable as Certification Mark and as Any Other Type of Mark

Trade or service marks and certification marks are different and distinct types of marks, which serve different purposes. A trademark or service mark is used by the owner of the mark on his or her goods or services, whereas a certification mark is used by persons other than the owner of the mark. A certification mark does not distinguish between producers, but represents a certification regarding some characteristic that is common to the goods or services of many persons. Using the same mark for two contradictory purposes would result in confusion and uncertainty about the meaning of the mark and would invalidate the mark for either purpose.

Section 4 of the Trademark Act, 15 U.S.C. §1054, prohibits the registration of a certification mark “when used so as to represent falsely that the owner or a user thereof makes or sells the goods or performs the services on or in connection with which such mark is used;” and §14(5)(B) of the Act, 15 U.S.C. §1064(5)(B), provides for the cancellation of a registered certification mark where the registrant engages in the production or marketing of any goods or services to which the certification mark is applied. See TMEP §1306.07 regarding §14(5) of the Act. Thus, if a party owns a registration as a trademark or service mark for any goods or services, he or she may not register the same mark as a certification mark for those goods or services. Conversely, a registration as a certification mark precludes registration of the same mark by its owner as a trademark or service mark for any goods or services to which the certification mark applies. See *In re Florida Citrus Commission*, 160 USPQ 495 (TTAB 1968).

The prohibition against registration both as a trademark or service mark and as a certification mark applies to marks that are identical or so similar as to constitute essentially the same mark. Variations in wording or design, even though small, can, if meaningful, create different marks. On the other hand, inconsequential differences, such as the style of lettering or the addition of wording of little importance, normally would not prevent marks from being regarded as the same. See *In re 88Open Consortium Ltd.*, 28 USPQ2d 1314 (TTAB 1993), in which the mark 88OPEN COMPATIBILITY CERTIFIED and design was found registrable as a certification mark even though applicant owned six registrations for the marks 88OPEN in typed and stylized form as trademarks, service marks and collective membership marks. The Board noted that the words COMPATIBILITY CERTIFIED served to inform those seeing the mark that it is functioning as a certification mark, and that the certification mark included a design feature not found in the previously registered marks. See also TMEP §§1306.04, 1306.06(d) and 1306.09.

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1306.05(b) Cancellation of Applicant's Prior Registration Required by Change from Certification Mark Use to Trademark or Service Mark Use, or Vice Versa

The nature of the activity in which the mark is used or intended to be used may change from use to certify characteristics of goods or services to use on the party's own goods or services, or on goods or services produced for the party by related companies. The change might also be the other way around, from trademark or service mark use to certification mark use.

If there is already a registration as one type of mark and the registrant files an application for registration of the mark as the other type, the applicant must surrender the previous registration under §7(e) of the Trademark Act, 15 U.S.C. §1057(e), before the examining attorney approves the new application for publication for opposition or issuance of a registration on the Supplemental Register. See 37 C.F.R. §2.172 and TMEP §1608 regarding surrender. The registration certificate for the new application should not issue until the prior registration actually has been cancelled.

In examining the new application, the examining attorney must carefully review the application to ensure that the facts of record support the new application.

1306.06 Examination of Certification Mark Applications

1306.06(a) Refusal to Register Certification Mark

The same standards are used to determine the registrability of certification marks that are used for other types of marks. Thus, the standards generally applicable to trademarks and service marks are used in considering issues such as descriptiveness, disclaimers, and likelihood of confusion. (*But see* TMEP §§1306.02 *et seq.* regarding certification marks indicating regional origin only.)

Regarding the application of §2(e) of the Trademark Act, 15 U.S.C. §1052(e), to certification marks, see *Community of Roquefort v. Santo*, 443 F.2d 1196, 170 USPQ 205 (C.C.P.A. 1971); *In re National Association of Legal Secretaries (International)*, 221 USPQ 50 (TTAB 1983).

Regarding the application of §2(d), 15 U.S.C. §1052(d), to certification marks, see *Procter & Gamble Co. v. Cohen*, 375 F.2d 494, 153 USPQ 188 (C.C.P.A. 1967); *Tea Board of India v. The Republic of Tea, Inc.*, 80 USPQ2d 1881 (TTAB 2006); *Stabilisierungsfonds für Wein v. Peter Meyer Winery GmbH*, 9 USPQ2d 1073 (TTAB 1988). See also *E.I. duPont de Nemours & Co. v. Yoshida International, Inc.*, 393 F. Supp. 502, 185 USPQ 597 (E.D.N.Y. 1975).

A refusal to register because the subject matter does not function as a certification mark is predicated on §§1, 2, 4, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, 1054, and 1127. Educational or other degrees or titles awarded to individuals,

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and used only as personal titles or degrees, are not certification marks. So used, titles and degrees indicate qualifications or attainments of the person; they do not pertain to or certify services that have been performed by the person. See TMEP §1306.03.

1306.06(b) The Mark on the Drawing

The drawing in the application must include the entire certification mark, but it should not include anything that is not part of the mark. The examining attorney must refer to the specimen to determine what constitutes the mark. See *In re National Institute for Automotive Service Excellence*, 218 USPQ 744 (TTAB 1983). In evaluating the drawing, the same standards used in relation to trademark and service mark drawings apply to certification marks (see TMEP §§807 *et seq.*).

1306.06(c) Specimens of Use for Certification Marks

Certification mark specimens must show use to certify. Although a certification mark performs a different function from a trademark or a service mark, it is used in a manner analogous to that of a trademark or a service mark (*i.e.*, on a label, tag, or container for the goods, a display associated with the goods, or in the sale or advertising of services rendered).

A certification mark specimen must show how a person other than the owner uses the mark to certify regional or other origin, quality, or other characteristics of that person's goods or services; or that members of a union or other organization performed the work or labor on the goods or services. 37 C.F.R. §2.56(b)(5). See *In re Council on Certification of Nurse Anesthetists*, ___ USPQ2d ___, Serial No. 75722091 (TTAB March 22, 2007).

Materials that bear the mark, and are actually attached or applied to the goods or used in relation to the services by the persons authorized to use the mark, constitute proper specimens.

The same standards used to evaluate trademark and service mark specimens also apply to certification marks. See TMEP §§904 *et seq.*

Sometimes, the owner/certifier prepares tags or labels that bear the certification mark that are supplied to the authorized users to attach to their goods or use in relation to their services. See *Ex parte Porcelain Enamel Institute, Inc.*, 110 USPQ 258 (Comm'r Pats. 1956). These tags or labels are acceptable specimens.

1306.06(d) Relation Between Certification Mark and Trademark or Service Mark on Specimens

It is customary for trademarks or service marks to be placed on goods or used with services in conjunction with certification marks. However, it is also possible for a

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certification mark to be the only mark used on goods or with services. Some producers market their goods or services without using a trademark or service mark, yet these producers may be authorized to use a certification mark and, as a result, the certification mark would be the only mark on the goods or services. In these situations, the significance of the mark might not be readily apparent and the examining attorney should request an explanation of the circumstances to ascertain whether the mark is a certification mark rather than a trademark or service mark. See *also* TMEP §1306.09.

When a trademark or a service mark appears on the specimen in addition to a certification mark, the certification mark can be on a separate label, or can be included on a single label along with the user's own trademark or service mark.

A composite certification mark may include a trademark or service mark, provided the composite mark functions to certify, with the trademark or service mark serving only to inform, or to suggest the certification program, rather than to indicate origin of the goods or services with which the mark is used. These situations usually are created when a company that produces goods or performs services wants to develop a program and a mark to certify characteristics of the goods or services of others that are related to the producer's own goods or services. See the examples in TMEP §1306.04.

The trademark or service mark must be owned by the same person who owns the certification mark. A party may not include the trademark or service mark of another in a certification mark, even with a disclaimer. If the examining attorney believes that a trademark or service mark included in a certification mark is owned by another, the examining attorney should refuse registration of the certification mark.

1306.06(e) Classification of Goods and Services in Certification Mark Applications

Section 1 and §44 Applications

In applications to register certification marks, all goods are classified in Class A and all services are classified in Class B. 37 C.F.R. §6.3. Both Classes A and B (but not any other classes) may be included in one application. See TMEP §§1403 *et seq.* regarding multiple class applications.

NOTE: When the Trademark Act of 1946 went into effect, the goods and services for which certification marks were registered were classified in the regular classes for goods and services. It was later concluded that this was not reasonable, because a certification mark is commonly used on a great variety of goods and services, and the specialized purpose of these marks makes it unrealistic to divide the goods and services into the competitive groups that the regular classes represent. The change

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to classification in Classes A and B for certification marks was made by amendment of the Trademark Rules on August 15, 1955.

Section 66(a) Applications

In a §66(a) application, classification is determined by the IB, in accordance with the *Nice Agreement*. Classes A and B come from the old United States classification system (see TMEP §1401.02) and are not included in the international classification system. In a §66(a) application, the international classification of goods/services cannot be changed from the classification given to the goods/services by the IB. See TMEP §1401.03(d). Accordingly, if the mark in a §66(a) application appears to be a certification mark, the USPTO will not reclassify it into Class A or B. However, the applicant must comply with all other United States requirements for certification marks, regardless of the classification chosen by the IB.

1306.06(f) Identification of Goods and Services in Certification Mark Applications

In a certification mark application, the goods or services that are certified may be identified less specifically than in an application for registration of a trademark or service mark.

Ordinarily, it is only necessary to indicate general kinds of goods and services, such as food, agricultural commodities, electrical products, textile materials, printed material, or insurance agency services, machinery repair, restaurant services. However, if the certification program itself is limited to specific goods or services, for example, wine, wood doors, bakery machinery, then the identification in the application should be more specific.

The identification should be limited to the goods or services. The terms “certification,” “certify,” or “certifies” should not be included.

1306.06(g) Special Elements of Certification Mark Applications

1306.06(g)(i) Statement of What the Mark Certifies

The application must contain a statement of the characteristic, standard, or other feature that is certified or intended to be certified by the mark. The statement should begin with wording, “The certification mark, as used (or intended to be used) by authorized persons, certifies (or is intended to certify)” See 37 C.F.R. §2.45.

All of the characteristics or features that the mark certifies should be included. A mark does not have to be limited to certifying a single characteristic or feature.

The characteristics or features that the mark certifies should be explained in reasonable detail, so that they are clear. The broad suggestive terms of the statute,

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such as quality, material, mode of manufacture, are generally not satisfactory by themselves, because they do not accurately reveal the nature of the certification. How specific the statement should be depends in part on the narrowness or breadth of the certification. For example, “quality” would not inform the public of the meaning of the certification where the characteristic being certified is limited, for example, to the strength of material, or the purity of a strain of seed.

The statement of certification in the application is printed on the registration certificate. For that reason, it should be reasonably specific but does not have to include the details of the specifications of the characteristic being certified. If practicable, however, more detailed specifications should be made of record in the application file.

The statement of what the mark certifies should be separate from the identification of goods and/or services.

1306.06(g)(ii) Standards

The applicant (certifier) must submit a copy of the standards established to determine whether others may use the certification mark on their goods and/or in connection with their services. 37 C.F.R. §2.45. For an intent-to-use application, under §1(b) of the Act, 15 U.S.C. §1051(b), the standards are submitted with the amendment to allege use or the statement of use. 37 C.F.R. §2.45(b).

The standards do not have to be original with the applicant. They may be standards established by another party, such as specifications promulgated by a government agency, or standards developed through research of a private research organization.

1306.06(g)(iii) Exercise of Control

In an application based on use in commerce under §1(a) of the Trademark Act, the applicant must assert that the applicant is exercising legitimate control over the use of the certification mark in commerce. 37 C.F.R. §2.45(a).

In an application based on §1(b), §44, or §66(a) of the Act, the applicant must assert that the applicant has a bona fide intention to exercise legitimate control over the use of the certification mark in commerce. See 37 C.F.R. §2.45(b). In a §1(b) application, before the mark can register, the applicant must file an amendment to allege use under 15 U.S.C. §1051(c) or a statement of use under 15 U.S.C. §1051(d), alleging that the applicant is exercising legitimate control over the use of the certification mark in commerce.

If there is doubt as to the existence or nature of such control by the applicant, the examining attorney should require an explanation and sufficient disclosure of facts or the filing of appropriate documents to support the applicant’s statement regarding the exercise of control over the use of the mark, pursuant to 37 C.F.R. §2.61(b).

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1306.06(g)(iv) Use by Others Indicated in Dates-of-Use Clause

When specifying the dates of first use, the applicant must indicate that the certification mark was first used under the authority of the applicant, or by persons authorized by the applicant, because a certification mark is not used by the applicant itself.

1306.06(g)(v) Statement That Mark is Not Used by Applicant

The application must contain a statement that the applicant is not engaged in (or, if the application is filed under §1(b), §44 or §66(a) of the Act, will not engage in) the production or marketing of the goods or services to which the mark is applied. See 37 C.F.R. §2.45. This statement does not have to be verified, and can, therefore, be entered by examiner's amendment.

1306.06(g)(vi) Amendment to Different Type of Mark

If an application is filed to register a mark as a certification mark and the mark is actually another type of mark, or if an application is filed to register a mark as another type when it is actually a certification mark, the application may be amended to request registration as the proper type of mark. It is preferred that the applicant completely rewrite the application to provide a clean copy, rather than amend the original papers. Also, the application should be re-executed because some essential allegations differ for the different types of marks.

Applications for certification marks, collective marks, collective membership marks cannot be filed using TEAS Plus. 37 C.F.R. §2.22(c). Therefore, in a TEAS Plus application, an additional TEAS Plus processing fee will be required if the mark is amended to a collective, collective membership, or certification mark. See TMEP §819.01(a).

1306.07 Relationship of §14 (Cancellation) to Examination of Certification Mark Applications

Extract from 15 U.S.C. §1064. Cancellation. A petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed as follows by any person who believes that he is or will be damaged, including as a result of dilution under section 43(c), by the registration of a mark on the principal register established by this Act, or under the Act of March 3, 1881, or the Act of February 20, 1905...

...

(5) At any time in the case of a certification mark on the ground that the registrant (A) does not control, or is not able legitimately to exercise control over, the use of such mark, or (B) engages in the production or marketing of any goods or services to which the certification mark is applied, or (C) permits the use of the certification mark for

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purposes other than to certify, or (D) discriminately refuses to certify or to continue to certify the goods or services of any person who maintains the standards or conditions which such mark certifies....

. . .

Nothing in paragraph (5) shall be deemed to prohibit the registrant from using its certification mark in advertising or promoting recognition of the certification program or of the goods or services meeting the certification standards of the registrant. Such uses of the certification mark shall not be grounds for cancellation under paragraph (5), so long as the registrant does not itself produce, manufacture, or sell any of the certified goods or services to which its identical certification mark is applied.

Section 14 of the Trademark Act, 15 U.S.C. §1064, provides for petitions to cancel registrations. Subsection (5) lists specific circumstances when petitions to cancel certification marks may be filed. The provisions of §14(5) are applicable in *ex parte* examination as follows:

Subsection A: In an application, the applicant states under oath or declaration that the applicant is exercising, or has a bona fide intention to exercise, legitimate control over the use of the certification mark. TMEP §1306.06(g)(iii). Such statement is accepted unless the examining attorney has knowledge of facts indicating that it should not be accepted.

Subsection B: The applicant is required to state, as appropriate, that he or she is not engaged in, or will not engage in, the production or marketing of any goods or services to which the certification mark is applied. TMEP §1306.06(g)(v). Such statement is accepted unless the examining attorney has knowledge of facts indicating the contrary.

Subsection C: This subsection concerns whether a party permits use of the certification mark for purposes other than to certify. No statements are required in the application specifically on this point. The existence of unauthorized or illegal uses by others without the applicant's authorization is not within the examining attorney's province and cannot be used as a basis for refusal to register, provided that use authorized by the applicant, as supported by the record, is proper certification use.

Subsection D: This subsection relates to the obligation of the owner not to discriminately refuse to certify. This subject is not mentioned in §§4 or 45, 15 U.S.C. §1054 or §1127. The Office has never undertaken to evaluate, in *ex parte* examination, whether the standards or characteristics which the mark certifies, as set out by the applicant, are discriminatory per se; nor is it in the province of *ex parte* procedure to investigate or police how the certification is practiced.

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1306.08 Registration of Certification Mark on Basis of Foreign Registration

A certification mark may be registered in the United States under §44 of the Trademark Act, on the basis of a foreign registration. However, whether a particular foreign registration is acceptable as the basis for a United States registration depends on the scope of the foreign registration.

A person may not obtain a registration in the United States that is broader in scope than the foreign registration on which the United States application is based. See *In re Löwenbräu München*, 175 USPQ 178 (TTAB 1972); TMEP §1402.01(b). Therefore, a registration as a certification mark in the United States may not be based on a foreign registration that is actually a trademark registration, *i.e.*, a registration that is based on the registrant's placement of the mark on his or her own goods as a trademark. The scope of the registration, *i.e.*, the nature of the registration right, would not be the same.

The scope and nature of the registration right is not always immediately apparent from a foreign registration certificate. Foreign registration certificates are not always labeled as pertaining to a trademark, service mark, collective mark or certification mark and, when they are labeled, the significance of the term is not always clear. For example, the designation "collective" represents a different concept in some foreign countries than it does in the United States. Moreover, while a certificate printed on a standardized form may be headed with the designation "trademark," the body of the certificate might contain language to the contrary.

Since certification is an exception in the larger world of trademarks, an indication of certification in the registration certificate would normally represent a conscious decision that a certification situation exists. Therefore, if a foreign registration certificate has a heading that designates the mark as a certification mark, or if the body of the foreign certificate contains language indicating that the registration is for certification, the foreign registration normally may be accepted to support registration in the United States as a certification mark.

Whenever there is ambiguity about the scope or nature of the foreign registration, or whenever the examining attorney believes that the foreign certificate may not reflect the actual registration right, the examining attorney should inquire regarding the basis of the foreign registration.

1306.09 Uncertainty Regarding Type of Mark

When the facts in the application are insufficient to provide an adequate basis for determining whether the mark is functioning as a trademark or service mark or as a certification mark, the examining attorney should ask for further explanation as to the activities in which the mark is used and should require a sufficient disclosure of the facts to enable a proper examination to be made, pursuant to 37 C.F.R. §2.61(b).

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The manner in which the activities associated with a mark are conducted is the main factor that determines the type of mark. The conduct of parties involved with the mark evidences the relationship between the parties, and the responsibilities of each to the goods or services and to the mark.

1306.09(a) Distinction Between Certification Mark and Collective Mark

A collective trademark or collective service mark indicates origin of goods or services in the members of a group. A collective membership mark indicates membership in an organization. A certification mark certifies characteristics or features of goods or services. See *American Speech-Language-Hearing Association v. National Hearing Aid Society*, 224 USPQ 798, 806-808 (TTAB 1984), for a discussion of the distinction between collective marks and certification marks.

Both collective marks and certification marks are used by more than one person, but only the users of collective marks are related to each other through membership in a collective group. The collective mark is used by all members and the collective organization holds the title to the collective mark for the benefit of all members.

A certification mark may be used to certify that the work or labor on the goods or services was performed by a member of a union or other organization. See TMEP §1306.03. Used in this manner, the certification mark certifies not that the user is a member of an organization but that the labor on the user's goods or services was performed by a member of an organization.

An application to register a mark that is used or intended to be used by members of a collective group must be scrutinized carefully to determine the function of the mark. If the mark is used or intended to be used by the members as a trademark on goods they produce or as a service mark for services they perform, then the mark is a collective trademark or collective service mark. If the mark is used or intended to be used by members to indicate membership in an organization, then the mark is a collective membership mark. However, if use of the mark is or will be authorized only under circumstances designated by the organization to certify characteristics or features of the goods or services, the mark is a certification mark.

1306.09(b) Distinguishing Certification Mark Use from Related-Company Use of Trademark or Service Mark

Sometimes an application requests registration of a certification mark, but there is a contractual relationship in the nature of a franchise or license between the applicant and the user of the mark, whereby the applicant, as the franchisor or licensor, specifies the nature or quality of the goods produced (or of the services performed) under the contract. These situations require care in examination because they usually indicate trademark or service mark use (through related companies) rather

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than certification mark use, because the applicant, as franchisor or licensor, controls the nature of the goods or services and has the responsibility for their quality.

The key distinction between use of subject matter as a certification mark and use as a trademark or service mark through a related company is the purpose and function of the mark in the market place, and the significance that it would have to the relevant purchasing public. A trademark or service mark serves to indicate the origin of goods or services, whereas a certification mark serves to guarantee certain qualities or characteristics. See *In re Monsanto Co.*, 201 USPQ 864, 870 (TTAB 1978); *In re Celanese Corp. of America*, 136 USPQ 86 (TTAB 1962).

Furthermore, the owner of a certification mark must permit use of the mark if the goods or services meet the certifier's standard, whereas a trademark owner may, but is not obligated to, license use of its mark to third parties. *Monsanto*, 201 USPQ at 870.

1306.09(c) Patent Licenses

Sometimes the owner of a patent asserts ownership of the mark that is applied to goods that are manufactured under license from the patent owner, in accordance with the terms and specifications of the patent. In most cases, these marks have been registered as trademarks, on the basis of related-company use. Generally, the patent owner's purpose, in arranging for the application of a mark to the goods manufactured under his or her license, would be to identify and distinguish those goods whose nature and quality the patent owner controls through the terms and specifications of the patent. Therefore, registration as a trademark (on the basis of related-company use) rather than registration as a certification mark would be appropriate.

1307 Registration as Correct Type of Mark

The examining attorney should take care to ascertain the correct type of mark during examination, and to require amendment if necessary. If a registration is issued for the wrong type of mark, it may be subject to cancellation. See *National Trailways Bus System v. Trailway Van Lines, Inc.*, 269 F. Supp. 352, 155 USPQ 507 (E.D.N.Y. 1965); *American Speech-Language-Hearing Association v. National Hearing Aid Society*, 224 USPQ 798 (TTAB 1984).