

# Chapter 1300 Service Marks, Collective Marks, and Certification Marks

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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 §§1301.01–1301.01\(b\)\(vi\)](#).

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 registration on the Principal Register is §§1, 2, 3, and 45 of the Trademark Act, [15 U.S.C. §§1051–1053](#), [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. §§1051–1053](#), [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 Pac. Ltd.*, 754 F.2d 992, 224 USPQ 971 (Fed. Cir. 1985); *In re Betz Paperchem, Inc.*, 222 USPQ 89 (TTAB 1984); *In re Integrated Res., Inc.*, 218 USPQ 829 (TTAB 1983); *In re Landmark Commc'ns, 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 Prods. 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 & Co.*, 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.

#### **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 Chems., 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 Assocs.*, 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); *City Nat'l Bank v. OPGI Mgmt. GP Inc./Gestion OPGI Inc.*, 106 USPQ2d 1668, 1676 (TTAB 2013) (finding that intranet website was used solely for internal purposes and that respondent was primary beneficiary); *In re Alaska Nw. Publ'g Co.*, 212 USPQ 316, 317 (TTAB 1981) (stating that “[t]he fact that the activities and operations associated with the production, advertising or sale of the product may be indirectly beneficial to purchasers of the product is immaterial to the question of registrability of the mark as a service mark”).

Performing research and development, or other routine or expected activities, in the production or sale of one's own goods, and not for the benefit of others, are not services for purposes of service-mark registration.

*See In re Dr. Pepper Co.*, 836 F.2d at 509, 5 USPQ2d at 1208 (“[I]t has become a settled principle that the rendering of a service which is normally ‘expected or routine’ in connection with the sale of one's own goods is not a registrable service whether denominated by the same or a different name from the trademark for its product. This interpretation is a refinement of the basic principle that the service for which registration is sought must be rendered to others.”); *In re Florists' Transworld Delivery, Inc.*, 119 USPQ2d 1056, 1063 (TTAB2016) (finding applicant's provision of information regarding flowers and conducting promotional events to promote the sale of its flowers did not constitute a separately registrable service, but were merely incidental to the production or sale of the goods).

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. *Am. Int'l Reins. Co. v. Airco, Inc.*, 570 F.2d 941, 197 USPQ 69 (C.C.P.A. 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).

*See* [TMEP §1301.01\(b\)\(vi\)](#) regarding conducting clinical trials.

### **1301.01(a)(iii) Sufficiently Distinct from Activities Involved in Provision 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 must first ascertain the nature of the applicant's principal activity under the mark in question (i.e., the performance of a service or the provision 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 service normally provides. *In re Landmark Commc'ns, Inc.*, 204 USPQ 692, 695 (TTAB 1979). The identification of

goods/services, specimen of use, or other information in the application record may indicate whether the activity identified in the application is a separately registrable service. If necessary, the examining attorney should request additional information, pursuant to [37 C.F.R. §2.61\(b\)](#), to determine if the activity constitutes a service as contemplated by the Trademark Act. See [TMEP §814](#).

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 clinical trials for one's own pharmaceuticals is generally considered to be a normally expected and routine activity that is not separately registrable from the principal activity of providing the goods themselves because the U.S. Food and Drug Administration legally requires clinical trials as a prerequisite of pharmaceutical approval. See [TMEP §1301.01\(b\)\(vi\)](#).

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 generally does not constitute a separate service, because that activity is ancillary to the principal activity of providing the goods 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. Fin. 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 Tex.*, 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).

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 Eng'g 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.*, 136 USPQ at 95 (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 Ass'n 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 Am. Inc.*, 11 USPQ2d 1312, 1314-15 (TTAB 1989) ; *In re Universal Press Syndicate*, 229 USPQ at 640; *In re Congoleum Corp.*, 222 USPQ at 453-54; *In re C.I.T. Fin. Corp.*, 201 USPQ at 126. 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 Am.*, 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.*, 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 Publ'g Co.*, 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 Am. 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 Am., 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 Eng'g Corp.*, 217 USPQ 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).

Providing warranties to consumers and retailers on power-operated outdoor products was held to be a registrable service where the warranty covered goods manufactured by applicant but sold under the marks of third-party retailers. Noting that none of applicant's trademarks appeared on the goods or identified applicant as the source of the goods, the Board found that the third-party retailers rather than applicant would be regarded as the manufacturer of the products. Because purchasers would make a distinction between the provider of the warranty and the provider of the goods, applicant's warranty service would not be regarded as merely an inducement to purchase its own goods. The Board also noted that applicant's activities constitute a service to the third-party retailers, because applicant's provision of warranties avoids the need of the retailer itself to provide a warranty. *In re Husqvarna Aktiebolag*, 91 USPQ2d 1436 (TTAB 2009).

When an applicant offers a warranty on its own goods or services, the identification of services must include the word "extended," or similar wording, to indicate that the warranty is "qualitatively different" from a warranty normally provided ancillary to the sale of the applicant's goods/services. When an applicant offers a warranty on third-party goods, the identification of services must so indicate. See *In re Omega SA*, 494 F.3d 1362, 83 USPQ2d 1541 (Fed. Cir. 2007) (affirming that the USPTO has the discretion to determine whether and how a trademark registration should include a more particularized identification of the goods for which a mark is used).

The identification of services must also specify the item(s) that the extended warranty covers, e.g., "providing extended warranties on television sets." *Id.*

Extended warranty services are classified in Class 36.

### **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 Int'l 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 Nw. Publ'g 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 Commc'ns, 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 Ass'n 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 Pac. Ltd.*, 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 Res., 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 Assocs.*, 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 Int'l Reinsurance Co., v. Airco, Inc.*, 570 F.2d 941, 197 USPQ 69 (C.C.P.A. 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 Bus. 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 Chems., 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 Elec. 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).

### **1301.01(b)(vi) Clinical Trials**

Because conducting clinical trials necessary for governmental approval of one’s own pharmaceuticals generally is a normally expected, routine, and legally required activity in connection with the sale of pharmaceuticals, it is not a separate registrable service done primarily for the benefit of others. *Cf. In re Dr Pepper Co.*, 836 F.2d 508, 509, 5 USPQ2d 1207, 1208 (Fed. Cir. 1987) (“[I]t has become a settled principle that the rendering of a service which is normally ‘expected or routine’ in connection with the sale of one’s own goods is not a registrable service whether denominated by the same or a different name from the trademark for its product.”); *In re Landmark Commc’ns, Inc.*, 204 USPQ 692, 695 (TTAB 1979) (noting that “to be separately recognizable, as services, an applicant’s activity must be qualitatively different from anything necessarily done in connection with the sale of goods”).

Pharmaceutical companies are legally required to conduct clinical trials before pharmaceutical preparations can be approved for human use. See U.S. Food & Drug Admin., *Development & Approval Process / Drugs*, <https://www.fda.gov/drugs/development-approval-process-drugs> (accessed Dec. 19, 2019); *see also* 21 C.F.R. §312.21 (explaining the three phases of clinical trials for a previously untested drug). An activity or process that is necessary or legally required for an applicant to be able to provide the main product or service is not separable from the main product or service. *See In re Orion Research, Inc.*, 523 F.2d 1398, 1400, 187 USPQ 485, 486-87 (C.C.P.A. 1975) (holding a warranty to repair or replace one’s own merchandise to be a normally expected and legally required duty of a merchandiser and not a separate and registrable service); *In re Television Digest, Inc.*, 169 USPQ 505, 508 (TTAB 1971) (noting that providing a schedule of advertising rates is necessary for publishing a directory or magazine and is not a separate service). Therefore, since conducting a clinical trial is a legally required prerequisite to pharmaceutical sales, when this service is conducted by a pharmaceutical company for its own goods, it is an expected and mandated activity not separately registrable from the principal activity of providing the pharmaceutical preparations themselves.

Accordingly, when registration is sought for a mark used in connection with the conducting of pharmaceutical clinical trials, the examining attorney must ascertain whether the services are provided for the pharmaceuticals of others. If the record is unclear, the examining attorney should request additional information, pursuant to [37 C.F.R. §2.61\(b\)](#), to clarify whether the pharmaceutical clinical trials are registrable services as contemplated by the Trademark Act. *See* [TMEP §814](#).

### **1301.02 What Is a Service Mark?**

Not every word, combination of words, or other designation used in the performance or advertising of services performs a service mark function. *See In re The Ride, LLC*, 2020 USPQ2d 39644, at \*6 (TTAB 2020) (quoting *Am. Velcro, Inc. v. Charles Mayer Studios, Inc.*, 177 USPQ 149, 154 (TTAB 1973)) (citing *Roux Labs., Inc. v. Clairol, Inc.*, 427 F.2d 823, 828, 166 USPQ 34, 39 (C.C.P.A. 1970)). To function as a

service 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 §§1301.01–1301.01\(b\)\(vi\)](#)), the record must show that the asserted mark actually identifies and distinguishes the source of the service recited in the application. *In re Adver. & Mktg. Dev. Inc.*, 821 F.2d 614, 621, 2 USPQ2d 2010, 2015 (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 specimen must show a direct association between the mark and the services identified in the application. *See* [37 C.F.R. §2.56\(b\)\(2\)](#); *In re Universal Oil Prods. Co.*, 476 F.2d 653, 655, 177 USPQ 456, 457 (C.C.P.A. 1973) (term that identifies only a process did not show direct association with services, even where services were advertised in the same specimen brochure in which the name of the process was used; “[t]he minimum requirement [was] some direct association between the offer of services and the mark sought to be registered”); *In re Graystone Consulting Assocs.*, 115 USPQ2d 2035 (TTAB 2015) (specimen did not show a direct association between the mark WALK-IN SHOPPER and the identified business training consultancy services, but instead showed the mark being used to identify a particular type of customer that was the focus of the consulting services); *In re Duratech Indus. Inc.*, 13 USPQ2d 2052 (TTAB 1989) (term used on bumper sticker with no reference to the services did not function as a mark); *Peopleware Sys., Inc. v. Peopleware, Inc.*, 226 USPQ 320 (TTAB 1985) (term PEOPLEWARE used within a byline on calling card specimen did not constitute service mark usage of that term, even if specimen elsewhere showed that applicant provided the recited services); *In re J.F. Pritchard & Co.*, 201 USPQ 951 (TTAB 1979) (proposed mark was used only to identify a liquefaction process in brochure advertising the services and did not function as a mark because there was no direct association between the mark and the offering of services); [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 Vox Populi Registry Ltd.*, 25 F.4th 1348, 1351, 2022 USPQ2d 115, at \*2-3 (Fed. Cir. 2022) (“The [Trademark Trial and Appeal] Board looks to ‘the [Applicant's] specimens and other evidence of record showing how the designation is actually used in the marketplace’” (quoting *In re Eagle Crest, Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010))); *In re Morganroth*, 208 USPQ 284 (TTAB 1980); *In re Republic of Austria Spanische Reitschule*, 197 USPQ 494 (TTAB 1977); *see In re Keep A Breast Found.*, 123 USPQ2d 1869, 1879 (TTAB 2017). It is the perception of the relevant public that determines whether the asserted mark functions as a service mark, not the applicant’s intent, hope, or expectation that it do so. *See In re Vox Populi Registry*, 25 F.4th at 1351, 2022 USPQ2d 115, at \*2 (“In analyzing whether a proposed mark functions as a source identifier, the Board focuses on consumer perception.”) (citing *In re AC Webconnecting Holding B.V.*, 2020 USPQ2d 11048, at \*3 (TTAB 2020)); *In re Standard Oil Co.*, 275 F.2d 945, 947, 125 USPQ 227, 229 (C.C.P.A. 1960); *In re The Ride, LLC*, 2020 USPQ2d 39644, at \*6 (“The critical inquiry in determining whether a designation functions as a mark is how the designation would be perceived by the relevant public.”) (quoting *In re Eagle Crest, Inc.*, 96 USPQ2d at 1229). 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 such wording is displayed in capital letters or enclosed in quotation marks, and the manner in which such wording 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 prospective purchasers as a source identifier. *In re C.R. Anthony Co.*, 3 USPQ2d 1894 (TTAB 1987); *In*

*re Post Props., Inc.*, 227 USPQ 334 (TTAB 1985). The proposed mark must not blend so well with other matter on the 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*, 197 USPQ at 494; *Ex parte Nat'l Geographic Soc'y*, 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 “TM” or “SM” on the specimen cannot transform an unregistrable designation into a registrable mark. *Univ. of Ky. v. 40-0, LLC*, 2021 USPQ2d 253, at \*32-33 (TTAB 2021) (citing *In re Eagle Crest, Inc.*, 96 USPQ2d at 1231); *In re Brit. Caledonian Airways Ltd.*, 218 USPQ 737, 739 (TTAB 1983); [TMEP §1202](#).

See [TMEP §1301.02\(a\)](#) for further information about matter that does not function as a service mark, [§§1301.01–1301.01\(b\)\(vi\)](#) regarding what constitutes a service, and [§§1301.04–1301.04\(j\)](#) 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. See *In re Keep A Breast Found.*, 123 USPQ2d 1869, 1882 (TTAB 2017) (finding that three-dimensional cast of female breast and torso would be perceived as something that applicant assists in making as part of applicant’s associational and educational services, rather than as a mark designating the source of the services).

Use of a designation or slogan to merely convey advertising or promotional information, rather than to identify and indicate the source of the services, is not service mark use. See, e.g., *In re Standard Oil Co.*, 275 F.2d 945, 946-47, 125 USPQ 227, 228-29 (C.C.P.A. 1960) (GUARANTEED STARTING found to merely convey information about applicant’s services of “winterizing” motor vehicles); *In re TracFone Wireless, Inc.*, 2019 USPQ2d 222983, at \*3 (TTAB 2019) (UNLIMITED CARRYOVER held to be merely informational and not source identifying for telecommunication services because it merely informs consumers that they can carry over unlimited data from one billing cycle to the next); *In re Wal-Mart Stores, Inc.*, 129 USPQ2d 1148, 1159 (TTAB 2019) (INVESTING IN AMERICAN JOBS held to be merely informational and not source identifying for various retail, convenience, and grocery store services because it merely informs consumers that applicant promotes American-made goods by investing in American jobs); *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 European-American Bank & Trust Co.*, 201 USPQ 788 (TTAB 1979) (slogan THINK ABOUT IT found to be an informational or instructional phrase that would not be perceived as a mark for banking services). See [TMEP §1202.04](#) regarding informational matter that does not function as a mark.

A term 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 Serv. 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 Servs., 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 Prods., 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.*, 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). *Cf. In re Griffin Pollution Control Corp.*, 517 F.2d 1356 (C.C.P.A. 1975) (OXINITE does not serve as a trademark for mixture of gasses produced by waste treatment process because applicant did not sell the gasses separately but only the waste treatment process).

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\(e\)](#) regarding terms used only to refer to a process, style, method, or system.

A term that only identifies a menu item does not function as a mark for restaurant services. *In re El Torito Rest. 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\(b\)](#) regarding names of characters or personal names as service marks.

A term used only as a trade name is not registrable as a service mark. See *In re Signal Cos.*, 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](#) regarding matter used solely as a trade name.

If a service mark would be perceived only as decoration or ornamentation when used in connection with the identified services, it must be refused as nondistinctive trade dress under 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 §§1202.02\(b\)–1202.02\(b\)\(ii\)](#) regarding product design and product packaging trade dress and [§1301.02\(c\)](#) regarding three-dimensional service marks.

See [TMEP §1202.02\(a\)\(vii\)](#) regarding trade dress functionality and service marks, [§1215.02\(d\)](#) regarding refusing marks comprised solely of gTLDs for a domain registry operator and domain name registrar services for a failure to function, and [§1301.04\(g\)\(ii\)](#) regarding refusing marks that do not function as service marks.

### **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 Inv. Co. of Del.*, 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 Sys., 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 Enters.*, 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 Prods., 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 Fla. 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) (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\(a\)–1202.09\(a\)\(iii\)](#) regarding names and pseudonyms of authors and performing artists, [§1202.09\(b\)](#) regarding names of artists used on original works of art, and [§1202.10](#) regarding names and designs of characters.

### **1301.02(c) Three-Dimensional Trade Dress Service Marks**

The three-dimensional trade dress 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. See *In re Seminole Tribe of Fla.*, 2023 USPQ2d 631, at \*7-8 (TTAB 2023); *In re Palacio Del Rio, Inc.*, 2023 USPQ2d 630, at \*7-8 (TTAB 2023); *In re Frankish Enters.*, 113 USPQ2d 1964, 1973 (TTAB 2015). Evidence of use might include menus or letterhead that show promotion of the building's design, or configuration, as a mark. See, e.g., *In re Seminole Tribe of Fla.*, 2023 USPQ2d 631, at \*1-2; *In re Frankish Enters.*, 113 USPQ2d at 1966-67; *In re Lean-To Barbecue, Inc.*, 172 USPQ 151, 153 (TTAB 1971); *In re Griffs of Am., Inc.*, 157 USPQ 592, 592-93 (TTAB 1968).

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

However, the Board has held that a mark consisting of a three-dimensional cylindrical cast of female breasts and torso did not function as a mark for applicant's association, charitable fundraising, and educational services in the field of breast cancer. *In re Keep A Breast Found.*, 123 USPQ2d 1869, 1880 (TTAB 2017). The evidence indicated that the mark was being used as part of applicant's services to assist women to make

such casts. Thus, the cast would be perceived as part of the services, rather than as a mark designating the source of the services. *Id.* Further, the Board has held that a motion mark consisting of the live visual and motion elements of a guided bus tour in which an entertainer stops in view of the bus to perform a tap dance routine at a predetermined location did not function as a mark, because the evidence showed that the tap dance would be perceived as part of the bus tour services rather than a mark designating the source of the services. *In re The Ride, LLC*, 2020 USPQ2d 39644, at \*10 (TTAB 2020).

Generally, a photograph is a proper specimen of use for a three-dimensional trade dress 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. *E.g.*, *In re Seminole Tribe of Fla.*, 2023 USPQ2d 631, at \*5-8 (specimen comprised an advertisement with a photograph showing the guitar-shaped building trade dress mark with text identifying the building as “the first-ever Guitar Hotel” and referencing the various services applicant provided); *In re Frankish Enters. Ltd.*, 113 USPQ2d at 1966-67, 1973 (specimens comprised an advertisement of an exhibition poster with a photograph showing applicant’s monster truck design, as well as photographs of the monster truck while performing in exhibitions).

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\(b\)\(ii\)](#). Trade dress for services, which is analogous to product packaging, can be inherently distinctive. See *In re Palacio Del Rio, Inc.*, 2023 USPQ2d 630, at \*5 (“[T]he [marks comprising] hotel building designs are akin to the packaging of what is being rendered and sold inside, namely, hotel services; thus constituting trade dress for the services.”); *In re Frankish Enters. Ltd.*, 113 USPQ2d at 1970 (citing *In re Chippendales USA, Inc.*, 622 F.3d 1346, 1351, 96 USPQ2d 1681, 1684 (Fed. Cir. 2010)) (applicant’s mark comprising a “‘fanciful, prehistoric animal’ design [on its monster truck] is akin to the packaging of what is being sold, in this case [a]pplicant’s monster truck services”); see also *In re Chippendales USA, Inc.*, 622 F.2d at 1351, 96 USPQ2d at 1684 (applicant’s mark comprising a “Cuffs & Collars [costume] worn by Chippendales dancers constitutes ‘trade dress’ because it is part of the ‘packaging’ of the product, which is ‘[a]dult entertainment services, namely exotic dancing for women’). A mark is inherently distinctive if “[its] intrinsic nature serves to identify a particular source.” *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 210, 54 USPQ2d 1065, 1068 (2000) (quoting *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768, 23 USPQ2d 1081, 1083 (1992)).

“In determining whether service mark trade dress is inherently distinctive, the ultimate focus is on whether a consumer will immediately rely on it as an indicator of source of origin, even if that source (provider) is unknown, and to differentiate the services from those of competing providers.” *In re Palacio Del Rio, Inc.*, 2023 USPQ2d 630, at \*5 (citing *In re Chippendales USA, Inc.*, 622 F.3d at 1352, 96 USPQ2d at 1685). The test for determining inherent distinctiveness set forth in *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342, 1344, 196 USPQ 289, 291 (C.C.P.A. 1977) is applied to trade dress for services. See [TMEP §1202.02\(b\)\(ii\)](#). The examining attorney should consider the following *Seabrook factors* – whether the proposed mark is:

- (1) a "common" basic shape or design;
- (2) unique or unusual in a particular field;
- (3) a mere refinement of a commonly adopted and well-known form of ornamentation for a particular class of services viewed by the public as a dress or ornamentation for the services; or
- (4) capable of creating a commercial impression distinct from the accompanying words.

[TMEP §1202.02\(b\)\(ii\)](#); see, e.g., *In re Chippendales USA, Inc.*, 622 F.3d at 1351, 96 USPQ2d at 1684; *In re Seminole Tribe of Fla.*, 2023 USPQ2d 631, at \*7; *In re Palacio Del Rio, Inc.*, 2023 USPQ2d 630, at \*5; *In re Frankish Enters. Ltd.*, 113 USPQ2d at 1970; *In re Chevron Intell. Prop. Grp. LLC*, 96 USPQ2d 2026, 2027 (TTAB 2010); *In re Brouwerij Bosteels*, 96 USPQ2d 1414, 1421 (TTAB 2010); *In re File*, 48 USPQ2d 1363, 1365 (TTAB 1998); *In re Hudson News Co.*, 39 USPQ2d 1915, 1922 (TTAB 1996), *aff'd per curiam*, 114 F.3d 1207 (Fed. Cir. 1997).

For §1(a), §44, and §66(a) applications for trade dress marks for services that are not inherently distinctive, based on the analysis of the *Seabrook* factors and supporting evidence, and for which acquired distinctiveness has not been established, registration must be refused according to the procedures in [TMEP §1202.02\(b\)\(ii\)](#). For a §1(b) application for such trade dress, unless the drawing, the description of the mark, and the examining attorney's search results are dispositive of the lack of distinctiveness without the need to consider a specimen, these applications generally will not be refused registration until the applicant has filed an allegation of use in accordance with the procedures in [TMEP §1202.02\(b\)\(ii\)](#).

In certain cases, trade dress for services may be generic and incapable of functioning as an indicator of source. See [TMEP §1202.02\(b\)\(ii\)](#). In such case, the examining attorney must follow the procedures in [TMEP §1202.02\(b\)\(ii\)](#) for generic product packaging.

### **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 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 §§1202.08–1202.08\(f\)](#) 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 Prods. 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 HSB Solomon Assoc.*, 102 USPQ2d 1269, 1274 (TTAB 2012) (finding that the specimens show CEI identifying only a process and do not show a direct association between CEI

and the applied-for services); *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 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.*, 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 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 Indus., 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 §§1301.01–1301.01\(b\)\(vi\)](#)); 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 Prods. 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 for a separate service activity, 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 Info. 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); *In re DSM Pharms., Inc.*, 87 USPQ2d 1623 (TTAB 2008) (term that merely identifies computer software used in rendering services does not function as a mark to identify custom manufacturing of pharmaceuticals).

If the applicant's services are provided through software, it is possible for a mark to serve as a source indicator for the services provided and not just for the software itself. *See In re JobDiva Inc.*, 843 F.3d 936, 941, 121 USPQ2d 1122, 1126 (Fed. Cir. 2016) ("Even though a service may be performed by a company's software, the company may well be rendering a service."). Therefore the examining attorney must review all the information of record to determine how the mark is used and how it is likely to be perceived by potential consumers. *See In re JobDiva*, 843 F.3d at 941, 121 USPQ2d at 1126 ("To determine whether a mark is used in connection with the services . . . a key consideration is the perception of the user."); *In re Ancor Holdings*, 79 USPQ2d 1218, 1221 (TTAB 2006).

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 at 1221 (INFOMINDER found to identify reminder and scheduling services provided via the Internet, and not just software used in rendering the services); *see also In re JobDiva*, 121 USPQ2d at 1126843 F.3d at 941, (noting that the question of whether consumers would associate registrant's mark with the identified services, when each step of the services is performed by software, is a factual determination involving case-specific factors).

### **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 must 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, including an advance reservation for or advance purchase of the service, does not constitute use as a service mark. *Aycock Eng'g, Inc. v. Airflite, Inc.*, 560 F.3d 1350, 90 USPQ2d 1301 (Fed. Cir. 2009) (holding that actual use of the mark in commerce in connection with an existing service is required and that mere preparations to use a mark sometime in the future does not constitute use in commerce); *CBC Mortg. Agency v. TMRR, LLC*, 2022 USPQ2d 748, at \*24 n.15 (TTAB 2022) (finding registration of domain names comprising the mark did not constitute use of the mark in commerce); *In re Port Auth. of N. Y.*, 3 USPQ2d 1453 (TTAB 1987) (finding advertising and promoting telecommunications services before the services were available insufficient to support registration); *In re Cedar Point, Inc.*, 220 USPQ 533 (TTAB 1983) (holding that advertising of a marine entertainment park, which was not yet open, was not a valid basis for registration); *In re Nationwide Mutual Ins. Co.*, 124 USPQ 465 (TTAB 1960) (holding that stickers placed on policies, bills, and letters announcing prospective name change is mere adoption, not service mark use).

Sometimes a service-mark specimen may show the wording "beta" being used in connection with the relevant services. This term is commonly used to describe a preliminary version of a product or service. Although some beta services may not be made available to consumers, others are. For example, a beta version of online non-downloadable software may be made available to the public for use even though the final version has not been released. Thus, the appearance of this term on a service-mark specimen does not, by itself, necessarily mean that the relevant services are not in actual use in commerce or that the specimen is unacceptable. However, if examination of the specimen indicates that the beta version is not in actual use in commerce, the examining attorney must refuse registration because applicant has not provided evidence of use of the applied-for mark in commerce. The statutory basis for refusal is [15 U.S.C. §§1051](#) and [1127](#). See [TMEP §904.03\(e\)](#) and [§904.03\(i\)\(D\)](#) regarding trademark specimens containing the term "beta."

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; [§1104.11](#) regarding withdrawal of an amendment to allege use, and [§§1109.16-1109.16\(e\)](#) 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 the rendering of the services in commerce before a registration may be granted. *Couture v. Playdom, Inc.*, 778 F.3d 1379, 1380-82, 113 USPQ2d 2042, 2043-44 (Fed. Cir. 2015) (holding that appellant’s use of the mark on a webpage, which included the notice “website under construction,” was not sufficient to show use in commerce where evidence showed appellant advertised his readiness to render the services but did not actually provide them on or before the use-based application filing date); *In re Suuberg*, 2021 USPQ2d 1209, \*5-8 (TTAB 2021) (holding that applicant’s preparatory measures to commence use of her mark for charitable services, such as incorporating and applying for tax-exempt status, registering her domain name, and building her website were not sufficient to show applicant actually used the mark in commerce to provide services on or before the use-based application filing date).

Section 45, [15 U.S.C. §1127](#), defines “commerce” as “all commerce which may lawfully be regulated by Congress.” See [TMEP §§901.01, 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

#### 37 CFR 2.56

(a) An application under section 1(a) of the Act, an amendment to allege use under §2.76, a statement of use under §2.88, an affidavit or declaration of continued use or excusable nonuse under §2.160, or an affidavit or declaration of use or excusable nonuse under §7.36 must include one specimen per class showing the mark as actually used in commerce on or in connection with the goods or services identified. When requested by the Office as reasonably necessary to proper examination, additional specimens must be provided.

\* \* \*

(b)(2). A service mark specimen must show the mark as used in the sale of the services, including use in the performance or rendering of the services, or in the advertising of the services. The specimen must show a direct association between the mark and the services.

\* \* \*

(c) A clear and legible photocopy, photograph, web page printout, or other similar type of reproduction of an actual specimen that meets the requirements of paragraphs (a) and (b) of this section is acceptable. The reproduction must show the entire specimen or enough of the specimen that the nature of the specimen, the mark, and the good or service with which the mark is used are identifiable. A web page must include the URL and access or print date. An artist’s rendering, a printer’s proof, a computer illustration, digital image, or similar mockup of how the mark may be displayed, or a photocopy of the drawing required by §2.51, are not proper specimens.

(d) The specimen must be submitted through TEAS in a file format designated as acceptable by the Office unless:

\* \* \*

(2) Submission on paper is permitted under § 2.23(c) or is accepted on petition pursuant to § 2.147.

A service mark specimen must show the mark as actually used in the sale of the services, which includes use in the performance or rendering of the services, or in the advertising of the services recited in the

application. [37 C.F.R. §2.56\(b\)\(2\)](#). “[B]ecause by its very nature a service mark can be used in a wide variety of ways, the types of specimens which may be submitted as evidence of use are varied.” *In re Metriplex, Inc.*, 23 USPQ2d 1315, 1316 (TTAB 1992) . Whatever type of specimen is submitted, it must show proper use in commerce of the mark, which may be established by (1) showing the mark used or displayed as a service mark in the sale of the services, which includes use in the course of rendering or performing the services, or (2) showing the mark used or displayed in *advertising* the services, which encompasses marketing and promotional materials. See [37 C.F.R. §2.56\(b\)\(2\)](#); *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1088, 56 USPQ2d 1471, 1476-77 (Fed. Cir. 2000) (indicating that an online menu item bearing the mark ONLINE TODAY was proper service mark use in connection with “providing access to online computer services offering computer-industry news, commentary and product reviews” because, inter alia, the “menu items are the mechanisms by which users obtained access to a particular online service”); *In re Metriplex, Inc.*, 23 USPQ2d at 1316 (indicating that a specimen that does not explicitly refer to the services may be acceptable if it “show[s] use of the mark in the rendering, i.e., sale, of the services”); *In re Red Robin Enters.*, 222 USPQ 911, 914 (TTAB 1984) (stating that “rendition” of services is properly viewed as an element of the “sale” of services).

The type of specimen submitted will often be apparent without the need for additional information regarding how the mark is used on the specimen. However, a specimen description submitted by the applicant typically helps clarify the manner in which the mark is used in commerce, and the more explanation the applicant provides initially, the more helpful it is to the examining attorney’s analysis. Thus, applicants are encouraged to provide a specimen description and explain how the applicant renders or provides the services and, if relevant, how marks are commonly used in the particular industry for such services. For instance, a description stating that a specimen comprises a title screen bearing the mark and showing the mark used in rendering the identified services is helpful for determining the nature and acceptability of the specimen.

If it is not readily apparent that the specimen shows the mark as used in the sale or advertising of the services, and any specimen description does not provide adequate clarification, the specimen must be refused for failure to show use of the mark in commerce. See [TMEP §1301.04\(g\)](#) regarding the grounds for refusal. If further clarification regarding the nature of the specimen or the manner in which the mark is used may easily overcome the refusal (e.g., an explanation that the specimen is a title screen displaying the mark at the start of the provision of the identified services), an advisory to that effect may be included with the refusal. Under Trademark Rule 2.61(b), [37 C.F.R. §2.61\(b\)](#), an examining attorney may also require the applicant to submit additional information about the specimen or the mark’s manner of use.

Regardless of whether the specimen shows the mark used in the sale or advertising of the services, the examining attorney should consider the following when determining whether a service-mark specimen is acceptable.

### **1301.04(a) Whether the Specimen Shows the Mark as Actually Used in Commerce by the Applicant in the Sale or Advertising of the Services**

The specimen must show the mark as actually used by the applicant in the sale or advertising of the services. [37 C.F.R. §2.56\(b\)\(2\)](#). Acceptable specimens include newspaper and magazine advertisements, brochures, billboards, handbills, direct-mail leaflets, menus (for restaurants), press releases that are publicly available (e.g., on the applicant’s website), and the like. Business documents such as letterhead and invoices may be acceptable service-mark specimens if they show the mark and a direct association between the mark and the relevant services. *Id.*

A clear and legible photocopy, photograph, web page printout, or other similar type of reproduction of an otherwise acceptable specimen is sufficient. See [37 C.F.R. §2.56\(c\)](#). The reproduction must show the entire

specimen or enough of the specimen that the nature of the specimen, the mark, and the service with which the mark is used are identifiable. *Id.* A web page submitted as a web page specimen must include the URL and access or print date. *Id.* See [TMEP §1301.04\(h\)\(iv\)\(C\)](#) regarding web page specimens for services. However, artist renderings, printer's proofs, computer illustrations, digitally created images, or similar mock-ups of how the mark may be used, press releases sent exclusively to news media, or printed articles resulting from such releases are not acceptable because they do not demonstrate the required use of the mark by the applicant. See *id.*; [TMEP §1301.04\(f\)](#). See [TMEP §904.04\(a\)](#) regarding digitally created or altered or mockup specimens. In some instances, a specimen or the specimen description may indicate that a specimen is not yet in use in commerce by inclusion of wording such as "internal only," "printer's proof," "website coming soon," or "under construction."

### **1301.04(b) Whether the Identified Services Are Registrable Services**

A service-mark specimen must show the mark used or displayed in connection with a registrable service offered for the benefit of others. For information regarding activities that constitute registrable services, see [TMEP §§1301.01–1301.01\(b\)\(vi\)](#).

### **1301.04(c) Whether the Specimen Shows Use in Connection with All Classes in a Multiple-Class Application**

The same specimen may be acceptable for multiple classes if the specimen shows direct association between the mark and at least one of the identified services in each class. See [37 C.F.R. §2.56\(b\)\(2\)](#); [TMEP §1301.04\(f\)\(ii\)](#). If the applicant intends for a submitted specimen to support multiple classes, the applicant should include a statement to that effect and indicate the classes supported by the specimen, but the applicant need not submit multiple copies of the same specimen. See [TMEP §904.01\(b\)](#).

### **1301.04(d) Whether the Mark Is Used in Connection With the Identified Services**

The specimen must demonstrate the mark serving as a source indicator for the identified services. Therefore, registration must be refused if the specimen shows the mark is used only to promote goods rather than the identified services, or the mark is used as a service mark but not for the identified services (i.e., the applicant misidentified the services). See [TMEP §§1301.02\(a\), 1301.02\(e\)–1301.02\(f\)](#). See [TMEP §1301.04\(g\)\(i\)](#) regarding failure to show use in commerce and [§1301.04\(h\)\(iii\)](#) regarding misidentified services.

### **1301.04(e) Whether the Mark Functions as a Service Mark**

The proposed mark must actually function as a source-indicating service mark for the services identified in the application to be registrable. Thus, registration must be refused if, for example, the specimen shows the mark serves *solely* as a trade name (see [TMEP §1202.01](#)), *only* as the name of a downloadable or recorded computer software program or application (see [TMEP §1301.02\(f\)](#)), *exclusively* as the name of a method, process, or system (see [TMEP §1301.02\(e\)](#)), or *merely* as informational matter (see [TMEP §§1202.04, 1301.02\(a\)](#)).

The presence of the "TM" or "SM" symbol on the specimen cannot transform an unregistrable designation into a registrable mark. *Univ. of Ky. v. 40-0, LLC*, 2021 USPQ2d 253, at \*32-33 (TTAB 2021) (citing *In re Eagle Crest, Inc.*, 96 USPQ2d 1227, 1231 (TTAB 2010)); *In re British Caledonian Airways Ltd.*, 218 USPQ 737, 739 (TTAB 1983); [TMEP §1202.04](#).

See [37 C.F.R. §2.59](#) and [TMEP §904.05](#) and [§904.07–904.07\(b\)\(i\)](#) regarding substitute specimens.

### 1301.04(f) Elements of an Acceptable Service-Mark Specimen

To be acceptable, a service-mark specimen must show the mark sought to be registered used in a manner that demonstrates a direct association between the mark and the services. [37 C.F.R. §2.56\(b\)\(2\)](#). Specimens need not explicitly refer to the services to establish the requisite direct association between the mark and the services, but “there must be something which creates in the mind of the purchaser an association between the mark and the service activity.” *In re Cardio Grp., LLC*, 2019 USPQ2d 227232, at \*1 (TTAB 2019) (quoting *In re Way Media*, 118 USPQ2d 1697, 1698 (TTAB 2016)); see *In re JobDiva, Inc.*, 843 F.3d 936, 942, 121 USPQ2d 1122, 1126 (Fed. Cir.2016) (quoting *In re Ancor Holdings, LLC*, 79 USPQ2d 1218, 1220 (TTAB 2006) ) (“[T]he question is whether the evidence of JobDiva's use of its marks ‘sufficiently creates in the minds of purchasers an association between the mark[s] and [JobDiva's personnel placement and recruitment] services.’”).

The acceptability of a specimen is determined based on the facts and evidence of record, and viewed in the context of the relevant commercial environment. See *In re Ancor Holdings, LLC*, 79 USPQ2d at 1220 (“[W]e must base our determination of public perception of applicant's mark on the manner of use of [the mark] in the advertising which has been submitted as a specimen. Further, we must make that determination within the current commercial context, and, in doing so, we may consider any other evidence of record ‘bearing on the question of what impact applicant's use is likely to have on purchasers and potential purchasers.’” (quoting *In re Safariland Hunting Corp.*, 24 USPQ2d 1380, 1381 (TTAB 1992)). Thus, the information provided by the specimen itself, any explanations offered by the applicant clarifying the nature, content, or context of use of the specimen, and any other information in the record should be considered in the analysis. *In re Cardio Grp., LLC*, 2019 USPQ2d 227232, at \*2 (citing *In re Pitney Bowes, Inc.*, 125 USPQ2d 1417, 1420 (TTAB 2018); *In re DSM Pharms., Inc.*, 87 USPQ2d 1623, 1626 (TTAB 2008) (“In determining whether a specimen is acceptable evidence of service mark use, we 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.”).

When the identified services involve newer technology, the examining attorney must follow the appropriate examination policies and procedures, but also should employ a practical approach in analyzing the submitted specimen. See *In re Ralph Mantia Inc.*, 54 USPQ2d 1284, 1286 (TTAB 2000) (finding a business card and stationery displaying the mark and the word “design” were acceptable specimens of use for applicant’s mark in connection with commercial art design services, noting that “[i]t is not necessary that the specific field of design, i.e., commercial art, also appear thereon” and that “the word ‘design’ alone is sufficient to create in the minds of purchasers an association between the mark and applicant's commercial art services”); *In re Metriplex, Inc.*, 23 USPQ2d 1315, 1316 (TTAB 1992) (finding the submitted specimens acceptable to show use of applicant’s mark in connection with data transmission services because the specimens showed “the mark as it appears on a computer terminal in the course of applicant's rendering of the service” and noting that “purchasers and users of the service would recognize [applicant’s mark], as it appears on the computer screen specimens, as a mark identifying the data transmission services which are accessed via the computer terminal”). This may entail reviewing all the information of record to understand both how the mark is used and how it will be perceived by consumers. See *In re JobDiva*, 121 USPQ2d at 1126; *In re Ancor Holdings, LLC*, 79 USPQ2d at 1221. Additionally, if the examining attorney elects to conduct research regarding the mark, the services, or practices in the particular industry, it may be helpful to consider any information uncovered regarding how the applicant and others in the industry typically advertise and render the identified services in the relevant marketplace, as well as the manner in which service marks are normally used in connection with those services. See [TMEP §1301.04\(h\)\(iii\)](#) for a discussion of issues surrounding technology-related services.

### 1301.04(f)(i) Show the Mark

The mark on the drawing must be a substantially exact representation of the mark shown on the specimen. See [TMEP §§807.12–807.12\(a\)\(iii\)](#) and [§§807.12\(d\)–807.12\(e\)](#) regarding agreement of the mark on the drawing and on the specimen. Furthermore, the designation must appear sufficiently prominent on the specimen (e.g., placement, size, or stylization) so that it will be perceived by consumers as a mark. See *In re Dell Inc.*, 71 USPQ2d 1725, 1729 (TTAB 2004) (finding a mark “sufficiently prominent” even though it was “shown in a smaller type size than other words appearing on the webpage,” given that it appeared “in a bullet listing of information about the product,” and was placed “at the beginning of a line and [was] followed by the ‘TM’ trademark indicator”); [TMEP §904.03\(i\)\(B\)\(1\)](#). Compare *In re Quantum Foods, Inc.*, 94 USPQ2d 1375, 1378 (TTAB 2010) (describing a mark as “prominently displayed” on the specimen when the mark appeared by itself above pictures relating to applicant’s goods in relatively large font and in a different color than some of the other text on the page) with *In re Osterberg*, 83 USPQ2d 1220, 1223 (TTAB 2007) (finding the mark not prominently displayed because it was buried in text describing the mark and, while the mark was shown in bold font, so was other matter). For instance, if shown in the same font, size, and color as the surrounding text on the specimen, the designation may not be perceived as a source indicator. See *In re Osterberg*, 83 USPQ2d at 1223.

### 1301.04(f)(ii) Direct Association Between the Mark and the Services

The specimen must show the mark used in a manner that creates in the minds of potential consumers a direct association between the mark and the services. [37 C.F.R. §2.56\(b\)\(2\)](#); See generally *In re JobDiva, Inc.*, 843 F.3d 936, 941, 121 USPQ2d 1122, 1126 (Fed. Cir. 2016) (quoting *In re Ancor Holdings, LLC*, 79 USPQ2d 1218, 1221 (TTAB 2006)) (“[T]he question is whether the evidence of JobDiva’s use of its marks ‘sufficiently creates in the minds of purchasers an association between the mark[s] and [JobDiva’s personnel placement and recruitment] services.’”); *In re Adver. & Mktg. Dev., Inc.*, 821 F.2d 614, 620, 2 USPQ2d 2010, 2014 (Fed. Cir. 1987) (“The ‘direct association’ test does not create an additional or more stringent requirement for registration; it is implicit in the statutory definition of ‘a mark used \* \* \* to identify and distinguish the services of one person \* \* \* from the services of others and to indicate the source of the services.’”); *In re Universal Oil Prods. Co.*, 476 F.2d 653, 655, 177 USPQ 456, 457 (C.C.P.A. 1973) (“The minimum requirement is some direct association between the offer of services and the mark sought to be registered therefor.”); *In re Cardio Grp., LLC*, 2019 USPQ2d 227232, at \*1 (TTAB 2019) (quoting *In re Way Media*, 118 USPQ2d 1697, 1698 (TTAB 2016) (“A specimen that shows only the mark with no reference to, or association with, the services does not show service mark usage.”)).

Direct association is the minimum the specimen must show, and it may be established textually, contextually, or logically. *In re Universal Oil Prods. Co.*, 476 F.2d 653, 655, 177 USPQ 456, 457 (C.C.P.A. 1973). What is necessary to establish direct association differs depending on the type of specimen submitted, that is, whether it is an advertising specimen or a rendering specimen.

*Mark Used in Sales or Advertising of Services:* For specimens showing the mark used in advertising the identified services, to establish the requisite direct association the specimen must contain a reference to the services and the mark must be used on the specimen to identify the services and their source. *In re Cardio Grp., LLC*, 2019 USPQ2d 227232, at \*2 (citing *In re WAY Media, Inc.*, 118 USPQ2d at 1698; ); *In re Osmotica Holdings Corp.*, 95 USPQ2d 1666, 1668 (TTAB 2010) (finding that, although the submitted specimens referenced the identified consulting services, the applied-for mark, as used on the specimens, would be perceived by the relevant public as identifying only applicant’s drug technology and thus the specimens failed to establish the required association between the mark and the identified services). While the services need not be stated word for word, a sufficient reference to the services themselves or a general reference to the trade, industry, or field of use is required. See *In re Pitney Bowes, Inc.*, 125 USPQ2d 1417,

1419-20 (TTAB 2018) (reversing the specimen refusal since the wording “outsourced mailing services” appeared directly below the mark on the webpage advertising and was a sufficient reference to applicant’s mailing, shipping, and delivery services); *In re Florists’ Transworld Delivery, Inc.*, 119 USPQ2d 1056, 1062-63 (TTAB 2016); *In re Ralph Mantia Inc.*, 54 USPQ2d 1284, 1286 (TTAB 2008); *see also* [TMPEP §1301.04\(h\)](#). However, if the alleged reference to the services is so vague that the services cannot be discerned, the specimen will not be acceptable. *In re Chengdu AOBi Info. Tech. Co.*, 111 USPQ2d 2080, 2082 (TTAB 2011); *see In re Monograms Am., Inc.*, 51 USPQ2d at 1318. *See* [TMPEP §1301.04\(i\)](#) regarding examples of acceptable service-mark specimens.

*Mark Used in Rendering of Services:* For specimens showing the mark used in rendering the identified services, the services need not be explicitly referenced to establish the requisite direct association. *See In re Metriplex, Inc.*, 23 USPQ2d 1315, 1316-17 (TTAB 1992) (noting that “the requirements specific to specimens which are advertising are not applicable” and finding the submitted specimens acceptable to show use of applicant’s mark in connection with data transmission services because the specimens showed “the mark as it appears on a computer terminal in the course of applicant’s rendering of the service” and noting that “purchasers and users of the service would recognize [applicant’s mark], as it appears on the computer screen specimens, as a mark identifying the data transmission services which are accessed via the computer terminal”). Rather, direct association may be indicated by the context or environment in which the services are rendered, or may be inferred based on the consumer’s general knowledge of how certain services are provided or from the consumer’s prior experience in receiving the services. *Id.*; *see In re WAY Media, Inc.*, 118 USPQ2d at 1698. In other words, the context in which the services are provided and consumer knowledge and experience create an inference of the services without an explicit textual reference to the services. *See* [TMPEP §1301.04\(i\)](#), Example 17 (CASHFLOW UNITS).

The applicant may respond to a specimen refusal for failing to show direct association by explaining the nature of the mark’s use or the manner in which the services are advertised or rendered. *In re Metriplex, Inc.*, 23 USPQ2d at 1316 (finding the submitted specimens acceptable based, in part, on applicant’s explanation that the specimens showed the mark as it appeared on a computer terminal in the course of rendering the services). With respect to a particular industry’s typical use of marks in relation to specific services, it may also be helpful for the applicant to provide an explanation regarding industry practice concerning the use of the mark during the rendering of such services and how the applicant’s use comports with such practice. *See* [TMPEP §1301.04\(i\)](#), Example 19 (design of speech bubbles).

The mere fact that the mark is displayed and the services are explicitly referenced or can be inferred from the context of the specimen does not automatically result in direct association between the mark and the services. *See In re Johnson Controls, Inc.*, 33 USPQ2d 1318, 1320 (TTAB 1994). The specimen must associate the mark with the services such that the mark serves as a source identifier for those particular services. *See In re WAY Media, Inc.*, 118 USPQ2d at 1698; *cf. In re Sones*, 590 F.3d 1282, 1288, 93 USPQ2d 1118, 1123 (Fed. Cir. 2009) (“[T]he test for an acceptable website-based specimen, *just as any other specimen*, is simply that it must in some way evince that the mark is ‘associated’ with the goods and serves as an indicator of source.” (emphasis added)). The requisite direct mark-services association is present when the specimen makes a direct link or connection between the mark and the identified services. *See* [TMPEP §1301.04\(i\)](#), Example 17 (CASHFLOW UNITS) and Example 18 (RIDE 411).

Thus, a specimen is unacceptable if it fails to convey a proper nexus between the mark and the services, or if the services are too attenuated from the proposed mark, either in terms of proximity or logical connection. *See, e.g., In re Monograms Am., Inc.*, 51 USPQ2d at 1319; *In re Metriplex, Inc.*, 23 USPQ2d at 1316. The mere fact that wording from the identification of services appears somewhere on the specimen may not necessarily suffice for the mark-services association or nexus, if there is nothing else to connect that wording to the mark, such as proximity or additional text that establishes the connection.

In assessing whether there is a direct association between the mark and services, the examining attorney should consider the specimen's content, layout, and overall look and feel, as well as any description of the specimen and industry practice relating to service-mark usage in advertising and rendering the services.

### **1301.04(g) Grounds for Refusal**

#### **1301.04(g)(i) Failure to Show the Mark Used in Commerce**

Trademark Act Sections 1 and 45, 15 U.S.C. §§ 1051, 1127, are the statutory bases for refusing a specimen that does not meet the requirements of an acceptable service-mark specimen; such specimen is not acceptable because it does not show the mark in "use in commerce." For instance, if the mark does not appear on the specimen or the specimen shows use of the mark in connection with goods rather than the identified services, the specimen must be refused for failure to show service-mark use in commerce in connection with the identified services.

The applicant's response options include submitting an acceptable substitute specimen or, if appropriate, amending the application to a §1(b) filing basis. See [TMEP §806.03\(c\)](#) regarding amending filing basis from §1(a) to §1(b), and [§904.07](#) regarding requirements for substitute specimens. In some cases, the applicant may respond by providing clarification of the nature of the original specimen submitted, or an explanation of the content of the original specimen, to justify its acceptability.

The examining attorney may consider any of the following facts and evidence properly made of record:

- declarations from persons with firsthand knowledge of the facts, with a sufficiently detailed explanation of how the mark is used in advertising or rendering the services or how the services are advertised or rendered;
- clarification of the specimen of record, such as an explanation of the nature, content, or context of use of the specimen (this explanation need not be verified with a declaration);
- evidence, such as declarations or industry-related periodicals, regarding industry practice with respect to how marks and services are promoted in advertising or how the services are rendered;
- additional background materials, such as printouts showing information on subsequent webpages from the applicant's website or subsequent screenshots of an electronic device on which the services may be accessed, rendered, and experienced (this matter generally need not be verified with a declaration); and/or
- responses to any Trademark Rule 2.61(b) request for information.

If the specimen of record, the specimen description, the applicant's response and explanations, and any additional proffered evidence are unpersuasive, a final refusal must issue, if the application is otherwise in condition for final. See [37 C.F.R. §2.63\(b\)](#); [TMEP §714.03](#).

#### **1301.04(g)(ii) Failure to Show the Mark Functioning as a Service Mark**

A specimen may show the mark used as something other than a service mark for the identified services. For instance, it may show the mark used *solely* as a trade name, *only* as the name of a downloadable or recorded computer software program or application, *exclusively* as the name of a method, process, or system, or *merely* as informational or ornamental matter. See [TMEP §§1202.01, 1202.03–1202.04, 1301.02\(a\), \(e\), \(f\)](#). In such cases, the mark does not function as a service mark to identify and distinguish the applicant's services and indicate their source. Thus, a failure-to-function refusal should issue under Trademark Act Sections 1, 2, 3, and 45 for marks seeking registration on the Principal Register. 15 U.S.C. §§1051 1053,

1127. For marks seeking registration on the Supplemental Register, the statutory basis for the failure-to-function refusal is Trademark Act Sections 23 and 45. 15 U.S.C. §§1091, 1127. However, if the mark identifies, for example, both a process and the identified services and the requisite mark-services association is present, no failure-to-function refusal should issue. See [TMEP §§1301.02\(e\), 1301.04\(j\)](#) (Example 21 (LEADING EDGE TONERS)).

As stated above, the issue of whether a designation functions as a mark usually is tied to the use of the mark, as evidenced by the specimen. Therefore, unless the drawing and description of the mark are dispositive of the failure to function without the need to consider a specimen, generally no refusal on this basis will be issued in an intent-to-use application under §1(b) of the Trademark Act, 15 U.S.C. §1051(b), until the applicant has submitted a specimen(s) with an allegation of use (i.e., either an amendment to allege use under 15 U.S.C. §1051(c) or a statement of use under 15 U.S.C. §1051(d)). However, in a §1(b) application for which no specimen has been submitted, if the examining attorney anticipates that a refusal will be made on the ground that the matter presented for registration does not function as a mark, the potential refusal should be brought to the applicant's attention in the first Office action. This is done strictly as a courtesy. If information regarding this possible ground for refusal is not provided to the applicant before the allegation of use is filed, the USPTO is not precluded from refusing registration on this basis.

In an application under §44 or §66(a), where a specimen of use is not required prior to registration, it is appropriate for the examining attorney to issue a failure-to-function refusal where the mark on its face, as shown on the drawing and described in the description, reflects a failure to function. See *In re AC Webconnecting Holding B.V.*, 2020 USPQ2d 11048, at \*7 (TTAB 2020) (holding an application for registration filed pursuant to §44(e) subject to the requirement that the applied-for mark function as a mark); *In re Right-On Co.*, 87 USPQ2d 1152, 1156-57 (TTAB 2008) (noting the propriety of and affirming an ornamentation refusal in a §66(a) application).

See [TMEP §1202](#) regarding use of subject matter as a trademark; [§§1302–1305](#) regarding use of subject matter as a collective mark; and [§§1306–1306.06\(c\)](#) regarding use of subject matter as a certification mark.

## **1301.04(h) Considerations and Common Issues when Examining Certain Specimens**

### **1301.04(h)(i) Letterhead**

Letterhead stationery, business cards, or invoices bearing the mark may be accepted if they create a direct association between the mark and the services. See [37 C.F.R. §2.56\(b\)\(2\)](#). To create a direct association between the mark and 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 Sw. 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 Am., 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(h)(ii) 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 personal names as service marks, and [§§1202.09\(a\)–1202.09\(a\)\(iii\)](#) regarding the registrability of names and pseudonyms of performing artists.

### **1301.04(h)(iii) Specimens for Technology-Related Services**

Proper specimen analysis requires consideration of the nature of the identified services. Modern computer and technology-related services present special challenges because these services, and the terminology used to describe them, are continually evolving. In addition, any online activity entails the use of computer software, making it difficult to differentiate the various services provided online from the underlying technology used to provide them. As the Board has noted, “[a]lthough it may well be software that is generating the [services], in 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.” *In re Ancor Holdings, LLC*, 79 USPQ2d 1218, 1221 (TTAB 2006); see also *In re JobDiva, Inc.*, 843 F.3d. 936, 121 USPQ2d 1122 (Fed. Cir. 2016). (“[I]f the software is hosted on JobDiva’s website such that the user perceives direct interaction with JobDiva during operation of the software, a user might well associate JobDiva’s marks with personnel ‘placement and recruitment’ services performed by JobDiva”).

It may be unclear, based on the submitted specimen, whether the applicant is providing non-software services in a given field or subject matter (e.g., “financial retirement plan consulting services” in Class 36), or offering computer software or application services involving that same field or subject matter (e.g., “providing temporary use of on-line non-downloadable software for retirement planning” in Class 42), or both. Sometimes, an applicant that is actually providing on-line non-downloadable software services (e.g., “providing temporary use of on-line non-downloadable software for medical billing” in Class 42) misidentifies the services as the underlying function of the software (e.g., “medical billing” in Class 35). Similarly, the applicant may be using social networking websites to advertise non-social networking services (e.g., retail pet stores) and communicate with customers, leading the applicant to misidentify the services as “online social networking services” in Class 45.

Thus, a primary consideration in these instances is whether the specimen indicates that the applicant is actually performing the relevant service activities for others, or, for instance, merely providing software that allows users of the software to perform those activities themselves, or only offering an online game that

is accessed via a social networking website. See [TMEP §1301.04\(i\)](#), Example 5 (ATHENACoordinator), Example 7 (CLINICANYWHERE), and Example 14 (OUTERNAUTS).

Furthermore, some traditional services, and the associated terminology, may require fresh understanding and broader interpretation in the modern commercial environment. More and more traditional services are now offered online and, increasingly, multiple services are seamlessly integrated, creating difficulty in distinguishing the source of the services. For instance, television programs that were once provided only by broadcast television and cable outlets are now also accessible via streaming services like Netflix®, Hulu®, or YouTube®. Thus, typical service identification terms like “broadcasting,” “distribution,” and “transmission” have taken on new meaning in the modern marketplace. Thinking of traditional and other services more broadly and being cognizant of the current marketplace realities will also help the examining attorney determine whether the specimen properly shows use of the mark in direct association with the identified services.

When the nature of the services is not readily apparent from the information of record, such as the identification and specimen, the examining attorney may consult several resources for research and guidance, including: the notices and notes in the U.S. Acceptable Identification of Goods and Services Manual (ID Manual); the applicant’s and third-party websites; technology dictionaries, encyclopedias, and trade and industry publications; and the Office of Trademark Classification Policy & Practice. Finally, the examining attorney may require the applicant to provide further information about the services, pursuant to Trademark Rule 2.61(b), [37 C.F.R. §2.61\(b\)](#).

### **1301.04(h)(iv) Common Forms of Specimens for Modern Technology-Related Services**

As noted above, an applicant may submit a specimen that shows the mark as used in rendering the services. See [37 C.F.R. §2.56\(b\)\(2\)](#). These specimens are often submitted in connection with modern technology-related services, and common types are discussed below.

For specimens showing use of the mark in rendering the services, an explicit, textual reference to the services or their trade, industry, or field of use is not necessary, but an indication of the services sufficient to establish direct association between the mark and the services is required. The examining attorney must refuse the specimen if neither the specimen itself nor the description of the specimen provides sufficient information to decipher the nature of the services, determine the manner of use, and assess whether the necessary direct mark-services association exists. See [TMEP §1301.04\(g\)\(i\)](#).

#### **1301.04(h)(iv)(A) Sign-In Screens**

Applicants often submit screenshots of sign-in screens as specimens for online services, such as non-downloadable software services and application-service-provider services. Sign-in screens show that the services are available and the context indicates that they are accessed by inputting credentials, which is a generally known and accepted means of accessing many online services. *In re Metriplex, Inc.*, 23 USPQ2d 1315, 1317 (TTAB 1992) (finding the submitted specimens acceptable to show use of applicant’s mark in connection with data transmission services because “we have a situation where the service are rendered through the means of a tangible item, namely, a computer terminal, so that the mark can appear on the computer screen, and the specimens show such use”).

Some sign-in screens may include a reference to the services and effectively function as an advertisement. See [TMEP §1301.04\(i\)](#), Example 6 (MYFITAGE). Other sign-in screens may contain no reference to the services, but may nonetheless be acceptable if the overall content of the specimen sufficiently indicates the

services. Or, the specimen description may explain the context of the services by stating the specimen is a sign-in screen for accessing the services and that applicant is offering the type of services being applied for. Such an explanation may provide a sufficient basis for accepting the sign-in screen specimen, as long as there is no contradictory information in the record indicating that the mark is not associated with the identified services. See [TMEP §1301.04\(i\)](#), Example 4 (STAFFTAP).

### **1301.04(h)(iv)(B) Title or Launch Screens**

A title or launch screen is an on-screen graphic typically displayed at the beginning of entertainment content, such as video games or ongoing television programs, often with other information about the content featured. For services such as Class 41 entertainment services involving the provision, production, or distribution of entertainment content, screenshots of title or launch screens from the content may create the requisite direct association between the mark and the services. Thus, title or launch screens may be acceptable specimens as long as their nature as such is clear either from the overall look and feel of the specimen or from the applicant's description of the specimen.

While showing the title or launch screen being displayed on any particular electronic device (e.g., television, computer, or smartphone) is not required, a specimen showing an electronic device bearing the title or launch screen may be acceptable without further explanation because it places the mark in the context of how the services are rendered. See [TMEP § 1301.04\(i\)](#), Example 14 (OUTERNAUTS). A title or launch-screen specimen showing only the mark but not the electronic device, with no specimen description or an insufficient description, may require a specimen description identifying the specimen as a title or launch screen and placing the mark in the context of the services. See [TMEP §1301.04\(i\)](#), Example 13 (DELICIOSO).

While title or launch-screen specimens may be acceptable to show service-mark use, the mark must be refused if the specimen shows that the mark is the title of a single creative work (e.g., the title or name of one episode of a television or radio program, one movie, or one show presented as a single event). See [TMEP §§1202.08–1202.08\(f\)](#) regarding titles of single creative works and [§1301.02\(d\)](#) regarding titles of radio and television programs.

### **1301.04(h)(iv)(C) Web Pages**

Web pages from an applicant's or a third-party's website may be submitted as *advertising*. This type of specimen is acceptable if it shows the mark used in advertising the identified services and creates the required direct association by referring to the services and by showing the mark being used to identify and distinguish the services and their source. See [37 C.F.R. §2.56\(b\)\(2\)](#); *In re Florists' Transworld Delivery, Inc.*, 119 USPQ2d 1056, 1062 (TTAB 2016).

Web pages lacking a reference to the services may be acceptable if they show use of the mark in rendering the services. See [37 C.F.R. §2.56\(b\)\(2\)](#); [TMEP §1301.04\(i\)](#), Example 14 (OUTERNAUTS).

Web pages from social-networking websites should be scrutinized to ensure that the mark is properly directly associated with the identified services. Some applicants may mistakenly mischaracterize their services as "social networking" because they assume that advertising or promoting their non-social-networking services via a social-networking website means they are providing social-networking services. For instance, an applicant may mistakenly file an application for "online social-networking services" and provide a Facebook® webpage as a specimen when, in fact, they operate a pet store and are only using the Facebook® website to advertise the pet store and communicate information to and messages with actual and potential customers. Such a specimen is not acceptable for the social-networking services since it does not demonstrate that the

applicant is providing these services. See *In re Florists' Transworld Delivery, Inc.*, 119 USPQ2d at 1057 (“[A]n applicant generally will not be able to rely on use of its social media account to support an application for registration of a mark for [the service of creating an online community for users.]”).

*URL and Date Accessed/Printed Required for Web Pages* . Due to the transitory nature of Internet postings, the URL for the web page of the specimen and the date the page was accessed or printed must both be provided to enable verification. [37 C.F.R. §2.56\(c\)](#). Trademark owners can submit the URL and date directly on the specimen webpage itself, appearing anywhere on the page within the TEAS form that submits the specimen, or in a verified statement under [37 C.F.R. §2.20](#) or 28 U.S.C. §1746 in a later-filed response. This information may not be entered via examiner’s amendment. In rare situations, if the web page includes a photograph of the applied-for mark that directly associates the mark with the identified services (e.g., a picture showing a mark for restaurant services on a restaurant building) and that would otherwise be acceptable as a specimen of use for services, it need not include the URL and access or print date.

Specimens in applications and post-registration filings submitted prior to February 15, 2020 are “grandfathered” under the prior rules, until the application registers or is abandoned and cannot be revived or reinstated pursuant to [37 C.F.R. §§2.64](#), [2.66](#), or [2.146](#), or until the acceptance or final rejection of the post-registration filing. Specimens and substitute specimens submitted on or after February 15, 2020, including those submitted in connection with applications and post-registration filings that were filed prior to February 15, 2020, are not grandfathered and must comply with the current specimen rules.

### **1301.04(h)(iv)(D) Services Rendered by Means of Software Applications (Apps)**

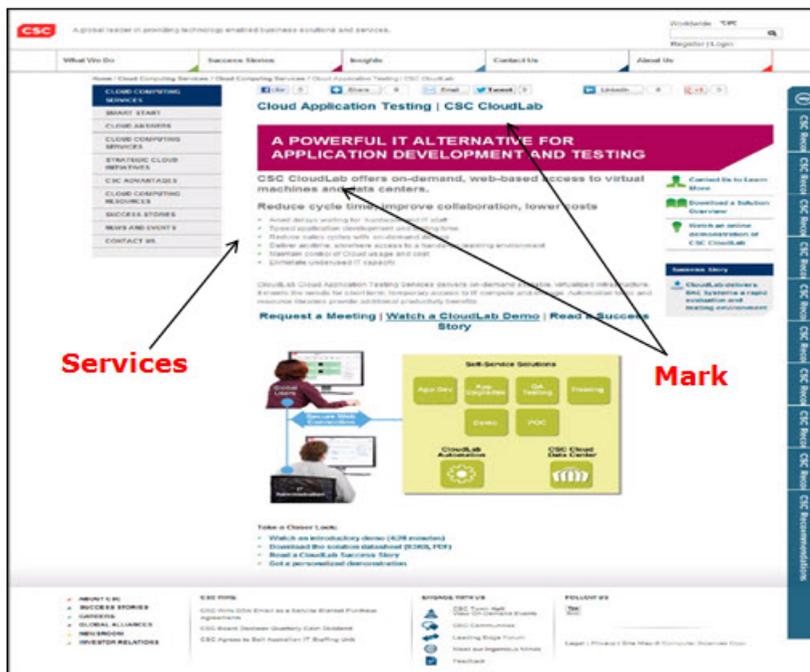
Software applications (apps) for smartphones and computer tablets are now commonly used to provide online services. Apps are simply the interface that enables the providers of the services to reach the users and render the services, and the users to access those services. Common specimens for services rendered by means of such apps are usually screenshots of electronic devices showing the apps rendering the services. Such a specimen will not always depict proper service-mark use of the mark in connection with the identified services unless the displayed screenshot clearly and legibly shows the mark directly associated with the identified services as the services are rendered or performed via the app. Mere depiction of the mark in the screenshot without sufficient depiction of the activity identified in the services does not establish service mark use within the definition of “use in commerce” under Trademark Act Section 45. [15 U.S.C. §1127](#) (“For purposes of this chapter, a mark shall be deemed to be in use in commerce – (2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce[.]”) See [TMEP §1301.04\(i\)](#), Example 15 (KURBKARMA).

### **1301.04(i) Examples of Acceptable Service-mark Specimens**

**The following examples in this section** would only be accepted by the USPTO if they included the required URL and date accessed or printed. See [37 C.F.R. §2.56\(c\)](#).

#### *Cloud-Computing Services*

#### **EXAMPLE 1**



**Mark:** CSC CLOUDLAB

**Relevant Services:** Infrastructure as a Service (IAAS) services, namely, providing web-based use of virtualized computer hardware, networking, and storage equipment on a utility computing basis, namely, providing virtual computer systems and virtual computer environments through cloud computing, in Class 42.

**Analysis:**

Specimen is described as “web page screenshot” and appears to be advertising. Mark is displayed near the top center of the webpage in large, color font, and in the middle center of the webpage at the beginning of a statement shown in bold font. Services are referenced in the following statements:

- “CSC CloudLab offers on-demand, web-based access to virtual machines and data centers.”
- “CloudLab Cloud Application Testing Services delivers on-demand scalable, virtualized infrastructure.”

Direct mark-services association is present because the mark is used directly in connection with the services in textual statements describing the services, and is placed immediately above explicit/textual references to the services.

Specimen is described as “web page screenshot” and appears to be advertising.

Mark is displayed near the top center of the webpage in large, color font, and in the middle center of the webpage at the beginning of a statement shown in bold font.

Services are referenced in the following statements:

“CSC CloudLab offers on-demand, web-based access to virtual machines and data centers.”

“CloudLab Cloud Application Testing Services delivers on-demand scalable, virtualized infrastructure.”

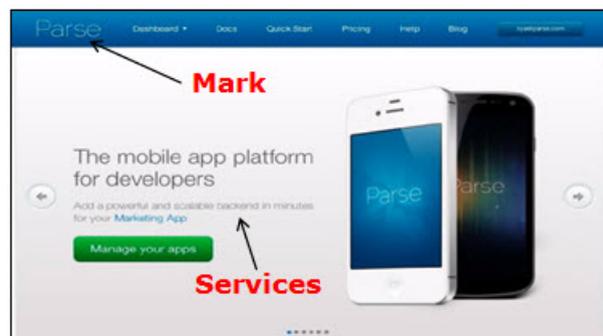
Direct mark-services association is present because the mark is used directly in connection with the services in textual statements describing the services, and is placed immediately above explicit/textual references to the services.

## EXAMPLE 2

### *Original Specimen*



### *Substitute Specimen*



**Mark:** PARSE

Services: Platform as a service (PAAS) featuring computer software platforms offering server-side functionality to provide backend services, namely, data storage, push notifications and user management, all for mobile applications, in Class 42.

**Analysis:**

Original specimen is described as “website offering purchase and download of Parse software”; the substitute specimen is described as “website advertising.”

On the substitute specimen, the mark is presented in large font on the top of the webpage and on the screen of an electronic device.

Original specimen was refused because the specimen and its description indicated the mark is used in association with software goods rather than PAAS services.

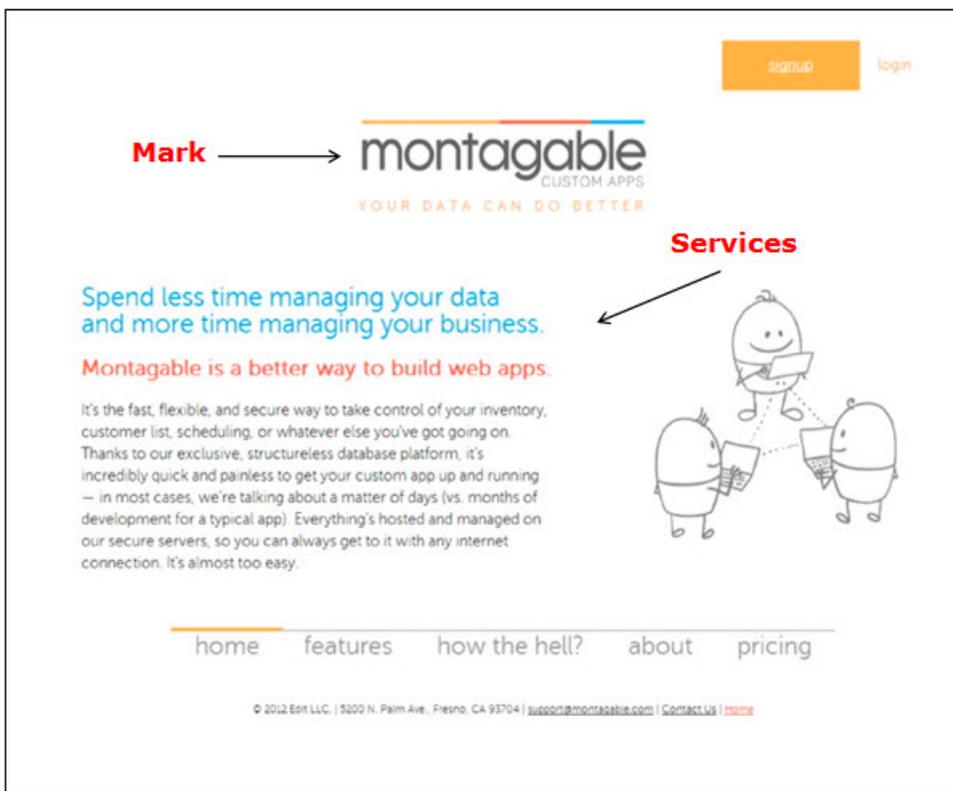
Substitute specimen is acceptable due to the following statements referencing the services and the following indicia of the context in which the services are rendered:

The wording “The mobile app platform for developers” and “Add a powerful and scalable backend in minutes for your Marketing App” describes the nature of the services.

The “Manage your apps” button indicating that the services are accessed by clicking on the button.

Direct mark-services association is present because it is customary to display service marks near the top of the webpages on which the services are advertised or through which they are accessed, rendered, and experienced. Here, the mark is in close proximity to explicit textual references to the services and the “Manage your apps” button, thus creating the mark-services connection.

**EXAMPLE 3**



**Mark:** MONTAGABLE

**Services:** Computer software platform as a service (PAAS) featuring computer software platforms for application building, in Class 42.

**Analysis:**

Specimen is described as “screenshots” from applicant’s website and appears to be advertising. Mark is prominently shown in large font on the top of the webpage.

Services are referenced in the following statements:

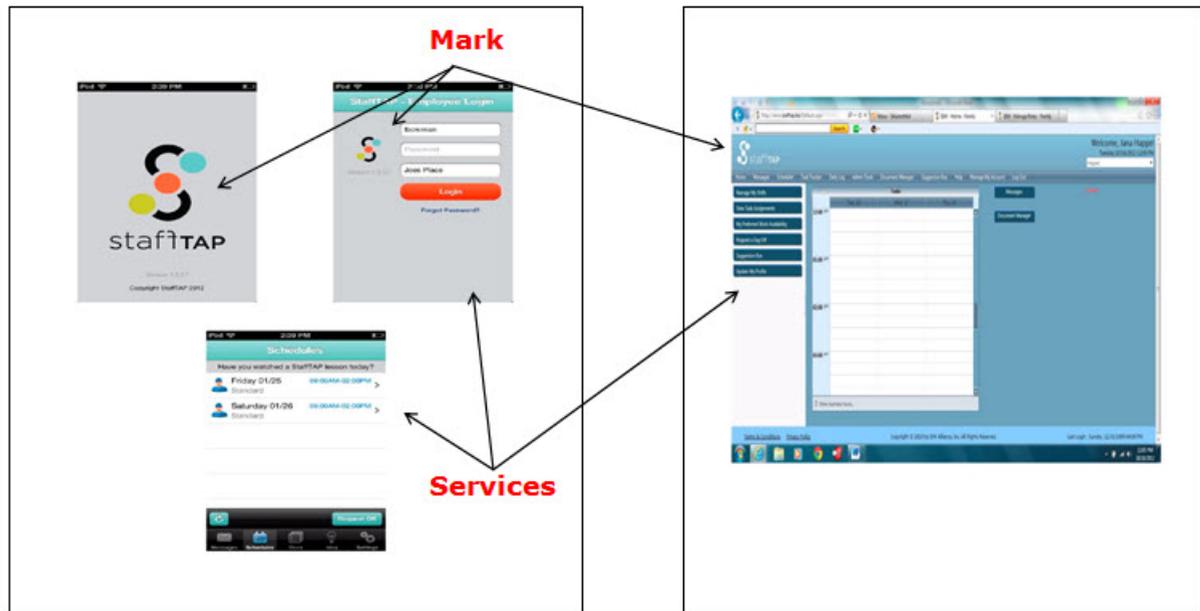
“Montagable is a better way to build web apps.”

“Thanks to our exclusive, structureless database platform, it’s incredibly quick and painless to get your custom app up and running . . . .”

“Everything’s hosted and managed on our secure services, so you can always get to it with any internet connection.”

Direct mark-services association is present because the mark is used directly in connection with the services in textual statements describing the services, and is placed immediately above explicit textual references to the services as well as in statements referencing the services.

## EXAMPLE 4



**Mark:** STAFFTAP

**Services:** Software as a service (SAAS) services featuring software for use in staff management and related scheduling tasks, in Class 42.

**Analysis:**

Specimen is described as “screenshot capture of a representative online portal” and appears to show the mark used in rendering the services.

Mark appears prominently in large font on a launch screen, on the sign-in screen, and on the top of a screen displaying the software services in use.

Services are indicated by the context in which they are rendered, as follows:

A launch screen with the wording “Version 1.0.27” indicates the version of the online software services being rendered.

The “Employee Login” screen indicates that one must log in to access the software services and the subsequent screen shows the schedule for Friday and Saturday.

A screen showing a date and time grid for scheduling tasks and the menu on the left containing options, including “Manage My Shifts” and “View Task Assignments,” indicates the staff management functions of the software services.

Direct mark-services association is present because the mark appears on the launch screen where it is customary in such industry to place the mark under which the services are offered and such

placement is recognized as the introduction of the online services; and the mark also appears on the sign-in screen where it is customary to input credentials to gain access to online services. The context in which the mark is used, i.e., on the title and sign-in screens, creates the mark-services connection (since using such screens is common practice for rendering such services) and implies that the services are available and rendered once the user initiates access to the services by logging in. The launch screen alone is acceptable because it is generally known that such screens are used to initiate the start up of or access to online services. The sign-in screen is also acceptable on its own since it is a generally known means of accessing online services. The mark is also displayed on another screen which shows the mark while the services are being performed and, thus, the proximity of the mark to the services conveys a connection.

## EXAMPLE 5

**athenahealth**  
there is a better way

**athenaCoordinator<sup>SM</sup>**

**The athenaCoordinator Advantage**

**For hospitals:**

- Streamlined order workflow
- Increased up-line utilization of self-pay patients
- Streamlined to prevent due to missing clinical documentation or lack of pre-certification
- Elimination of duplicate pre-certification work
- Pre-processor and patient payment collection completed by the doctor's office
- Increased patient satisfaction due to streamlined registration process

**For medical practices:**

- Reduce time spent reviewing lab orders, obtaining pre-certification, scheduling patients, and other work with clinical documentation
- Increased revenue from lab test details
- Create continuity for transmission and scheduling

**Mark**

**Services**

With the health care system, care coordination remains inefficient due to redundancies, manual inputs, and errors. athenaCoordinator addresses these systemic bottlenecks and improves care coordination among hospitals, physicians and other supply chain partners. Through software and service, we deploy critical knowledge to support effective and efficient care coordination. athenaCoordinator facilitates a streamlined order workflow between physicians and their partners including hospitals, surgical centers, imaging centers and other physicians. Over time we plan to expand to other health care entities like independent labs, pharmacies, medical equipment companies, ambulance services, and more.

**How is the service delivered?**  
athenaCoordinator is comprised of three service components.

**Order specialization**  
This web-based platform facilitates easy order entry and status for physicians, enables our pre-certification and pre-registration services and delivers a "clean" order to the hospital.

**Pre-certification**  
A dedicated team of remote specialists with essential clinical and payer knowledge verifies eligibility and benefits. They also obtain required insurance pre-certifications to ensure claims get paid the first time.

**Pre-registration**  
A dedicated team of specialists delivers pre-registration services to ensure order fulfillment, registering patients in the hospital system and collecting self-pay balances. Patients and physicians benefit from an efficient registration process.

**The athenaCoordinator workflow**

- Physicians enter test or procedure order information into athenaCoordinator.
- athenahealth staff handle scheduling requests, if needed, verify insurance information.
- athenahealth staff contact payers to obtain the required pre-certifications.
- Hospital staff receive a clean order with appropriate clinical information and required pre-certifications.
- athenahealth staff handle patient pre-registration, gather clinical information and follow-up on self-pay collections.

To find out how athenaCoordinator can help, contact us at  
→ 866.875.5738 or  
athenahealth.com

**Mark:** ATHENACORDINATOR

**Services:** Physician order support services and medical practice management services relating to medical tests and procedures, namely, verifying patient eligibility and benefits, handling scheduling requests, obtaining insurance pre-certifications, handling patient pre-registrations, and collecting self-pay balances from patients, in Class 35; and Software as a service (SAAS) services featuring software for use in communications between physicians and other participants in the health care system with respect to orders for medical tests and procedures, in Class 42.

**Analysis:**

Specimen is described as a “brochure” and appears to be advertising.  
Mark appears prominently in large font on the top of the brochure.  
Class 35 services are referenced in the following statements:

“Through software and service, we deploy critical knowledge to support effective and efficient care coordination.”

“A dedicated team of remote specialists with essential clinical and payer knowledge verifies eligibility and benefits. They also obtain required insurance pre-certifications to ensure claims get paid the first time.”

“A dedicated team of specialists delivers pre-registration services to ensure order fulfillment, registering patients in the hospital system and collecting self-pay balances. Patients and physicians benefit from an efficient registration process.”

Class 42 services are referenced in the following statements:

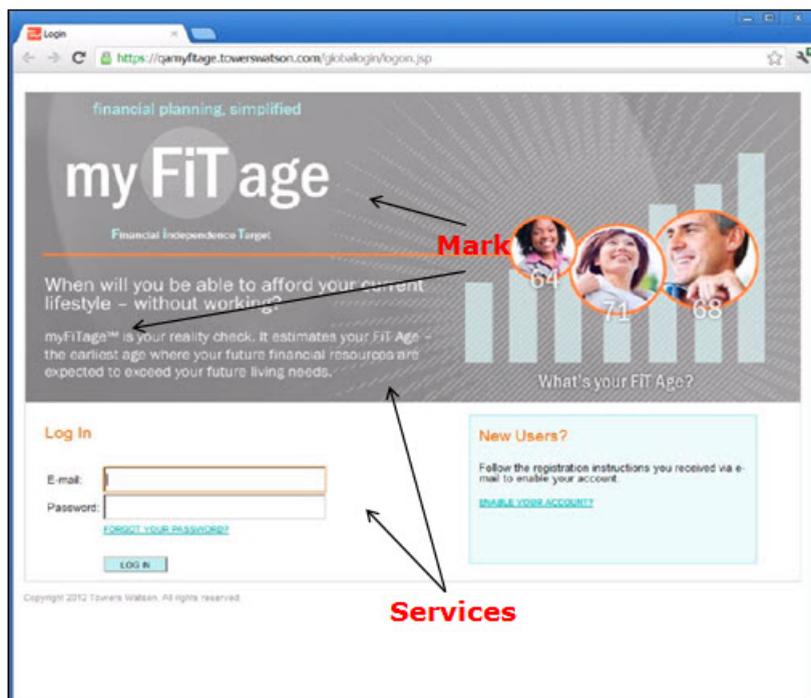
“Through software and service, we deploy critical knowledge to support effective and efficient care coordination.”

“The web-based platform facilitates easy order entry and status for physician, enables our pre-certification and pre-registration services and delivers a “clean” order to the hospital.”

Direct mark-services association is present because the mark is used directly in connection with the services in textual statements describing the services, and is placed immediately above explicit textual references to the services.

### *Non-Downloadable Software Services*

#### **EXAMPLE 6**



**Mark:** MYFITAGE

**Services:** Providing temporary use of non-downloadable computer software for retirement planning, in Class 42.

**Analysis:**

Specimen is described as “web printout” and appears to show the mark used in rendering the services. Mark is shown in large font at the top of the webpage and in the middle of the webpage. Services are referenced in the following statements and indicated by the context in which they are rendered, as follows:

The wording “financial planning simplified” appears above the mark.

The wording “Financial Independence Target” appears below the mark.

“myFiTage is your reality check. It estimates your FiT Age – the earliest age where your future financial resources are expected to exceed your future living needs.”

“Log in” fields are provided for accessing the non-downloadable software.

Direct mark-services association is present because the mark appears on the sign-in screen where it is customary in such industry to input credentials to gain access to online services. The context in which the mark is used, i.e., during the sign-in process, creates the connection with the services since sign-in screens are common practice and imply that the services are available and rendered once the user logs in. Additionally, the mark is used directly in connection with the services in

textual statements describing the services, and is placed above and below statements referencing the services, further conveying the direct mark-services connection. The sign-in screen alone would also be acceptable even if the services were not textually referenced since it is a generally known means of accessing online services. The specimen is acceptable both as an advertisement and as showing the mark in rendering the services.

**EXAMPLE 7**

## Leading the Way

*How Mercy is raising the national bar on telemedicine*

By LYNNE JETER

The groundbreak was held at community roundtables, held in various Mercy markets in the Greater St. Louis area and beyond.

Over the last few years, and confined at nearby hotel roundtables, residents in rural areas voiced a common theme: they wanted to stay close to home to receive care from specialists and subspecialists in larger communities for their families. With feedback in hand, hospital administrators made the decision early on: even if roundtable turnout wasn't forthcoming, Mercy would invest heavily in telemedicine.

"It started with us thoughtfully looking around to ask 'what can Mercy do for you?' and then to see if we were in a position to match what we were able to do with what residents wanted," said Tamara Smith, MD, vice president of research for Mercy's Center for Innovative Care (CIC), who also treats migrant patients via telemedicine from the Mercy Clinic Headache Center in St. Louis. "Telemedicine is an obvious solution, and a range of options became an automatic success story for us."

Smith helped Mercy, which serves 3 million patients annually, land roughly \$2.5 million in grants to launch the telemedicine pilot project, with the bulk coming from USDA's Distance Learning and Telemedicine grants for Mercy's most rural communities in Arkansas, Kansas, Missouri and Oklahoma.

"Mercy is the ideal health system for



employing telemedicine technology because we have a large geographic footprint and an interesting mix of large metro hospitals with subspecialists and rural health clinics and small critical care hospitals in remote areas," said Smith.

SafeWatch, an electronic ICU (e-ICU) monitoring program started in 2006, is Mercy's most mature telemedicine operation. From one center, 450 ICU beds are monitored throughout four states.

"It wasn't the first program of its kind, but it's the largest in the country," said Smith.

Mercy now operates 72 distinct telemedicine pilot programs, projects and fully developed operations. Among them: cardiology, dermatology, neurology, ophthalmology, pathology, pulmonology, psychiatry, radiology, and stroke.

"And we haven't even built the Virtual Care Center yet," said Smith. "That's how ambitious this project is ... to improve service delivery through telemedicine."

**Difference-Maker**

Tom Hale, MD, director of Mercy's CIC, pointed to the early and sustained success of SafeWatch for the impetus of hospital leaders deciding to invest heavily in telemedicine.

"The real testament to the program's success is that we're 12 percent below the anticipated APACHE (Acute Physiology and Chronic Health Evaluation) score for hospital mortality for critically ill patients by putting this program in place," he said.

Hale also noted that Massachusetts, which enacted its own healthcare reform law in 2006, has experienced such positive response for its e-ICU monitoring pilot programs that the state plans to expand it statewide.

"It's not there yet, but our hope is that this type of program will expand significantly," Hale said.

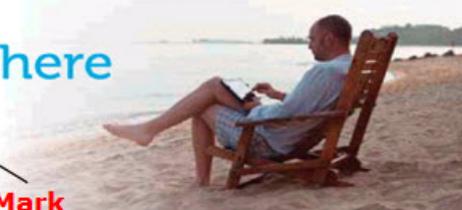
**Challenges and Benefits**

Sufficient bandwidth remains one of few limitations to aggressive expansion of telemedicine.

"We'd like to not have any limits on what we can deliver," said Smith. "For example, we want to extend mental health

Cloud-based Practice Management and EHR Solution.  
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Any device. Any time.  
Anywhere.....ClinicAnywhere.



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Services

Mark

Biospectrum Medical News JULY 2012 • 27

**Mark:**

## Clinic)Anywhere

**Services:** Medical Billing Support, in Class 35; and Providing on-line, non-downloadable, Internet-based software application for medical billing for physicians and health care institutions, in Class 42.

### **Analysis:**

Specimen is described as an advertisement.

Mark is prominently displayed in large, color font in the middle of the advertisement.

Class 35 services are referenced in the following statement:

“Top-notch Medical Billing Services.”

Class 42 services are referenced in the following statements:

“Cloud-based Practice Management and EHR Solutions.”

“Any device. Any time. Anywhere.....ClinicAnywhere.”

Direct mark-services association is present because the mark is used directly in connection with the services in textual statements describing the services, and is placed immediately below explicit textual references to the services.

### ***Application-Service-Provider (ASP) Services***

#### **EXAMPLE 8**



**Mark:** INSITE TICKETING

**Services:** Application service provider (ASP), namely, hosting computer software applications for others in the field of ticketing and related ticketing services, in Class 42.

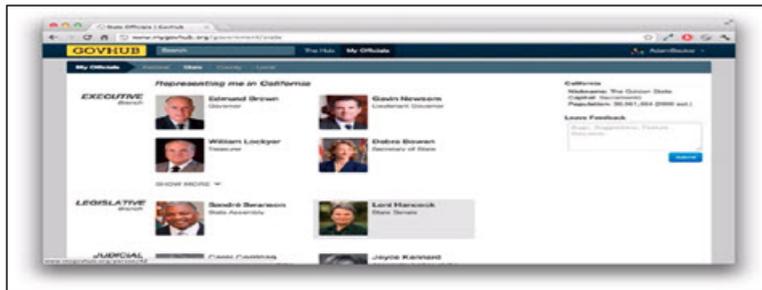
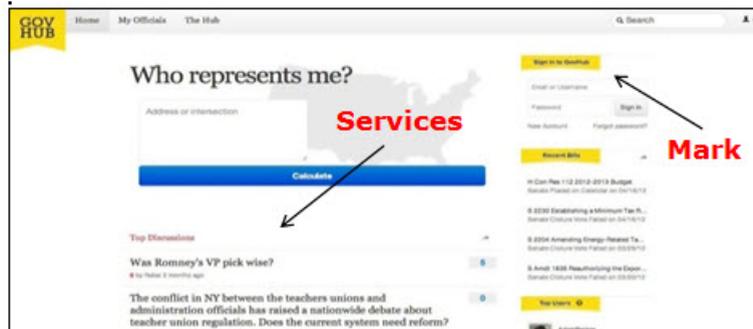
**Analysis:**

Specimen is described as a “screen shot” and appears to show the mark used in rendering the services. Mark is prominently displayed on the bottom of the screenshot.

Services are indicated by the context in which they are rendered, as follows:

The mark is displayed directly below the area where customers purchase tickets, thereby indicating that the ASP hosting or providing the software services is INSITE TICKETING. The wording “Technology by” placed next to the mark, implies that the software technology services that are operating the website are provided by the applicant.

Direct mark-services association is present because the mark is displayed on the screen where the services are rendered and experienced. While another mark, “Ticket Central,” is shown on the top left of the webpage, it appears to be associated only with ticket-purchasing services, not ASP services, and thus does not detract from associating the applied-for mark with the identified services.

*Telecommunications Services***EXAMPLE 9***Original Specimen**Substitute Specimen*

**Mark:** GOVHUB

**Services:** Providing on-line forums for transmission of messages among computer users, in Class 38.

**Analysis:**

Original specimen is described as “website screen-shot” and the substitute specimen is described as “screenshot of the homepage of the website.”

Mark is presented on the substitute specimen at the top right of the webpage.

Original specimen was refused because it failed to reference the services.

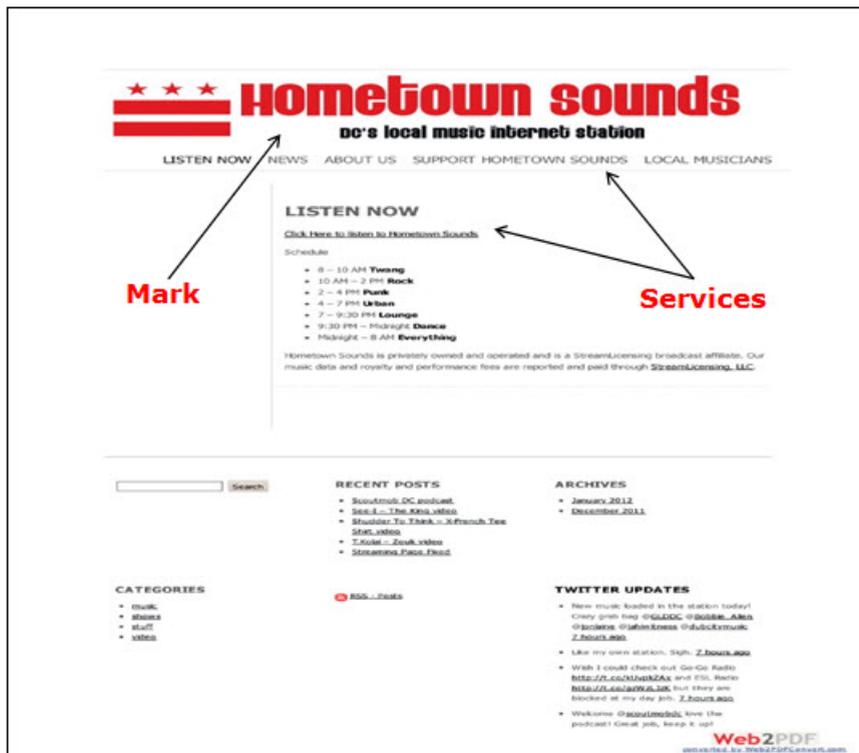
Substitute specimen is acceptable because the services are indicated by the following:

“Sign in to GovHub” indicates that a user may log in to use the services, i.e., read and send messages.

“Top Discussions” shows two discussion topics in progress, and the “5” and “0” shown in the color blue specify that there are 5 messages posted for the first discussion and 0 for the second discussion, indicating that the services involve on-line forums for transmission of messages.

Direct mark-services association is present on the substitute specimen because it is customary to display service marks near the top of the webpage on which the services are advertised or through which they are accessed, rendered, and experienced. Here, the mark is in proximity to indicia implying the services and no other marks appear to negate the mark-services connection. While the services are not explicitly textually referenced, when viewing the heading “Top Discussions,” the two discussion topics below it, and the “5” and “0” messages posted about the discussion topics – all these factors together indicate that applicant is offering online forum services.

**EXAMPLE 10**



**Mark:** HOMETOWN SOUNDS

**Services:** Electronic transmission and streaming of digital media content for others via global and local computer networks; Streaming of audio material on the Internet; Transmission services via the Internet, featuring MP3 files and music videos, in Class 38.

**Analysis:**

Specimen is described as “website for Hometown Sounds” and appears to show the mark used in rendering the services.

Mark is presented in large font on the top of the webpage.

Services are referenced in the following statements and indicated by the context in which they are rendered, as follows:

The wording “DC’s local music internet station” describes the services.

The wording “Listen Now” indicates that the website may be used to stream audio content.

The link “Click Here to listen to Hometown Sounds” indicates that the services are accessed by clicking on the link.

Direct mark-services association is present because it is customary to display service marks near the top of the webpage on which the services are advertised or through which they are accessed, rendered, and experienced. Here, the mark is physically close to indicia implying the services and no other marks appear to negate the mark-services connection. The mark appears above textual references to the services as well as in textual instructions for accessing the services, which further conveys the mark-services connection. The specimen is acceptable both as an advertisement and as showing the mark in rendering the services.

**EXAMPLE 11**



**Mark:**



**Services:** Broadcasting of video and audio programming over the Internet, in Class 38.

**Analysis:**

Specimen is described as “web page” and appears to show the mark used in rendering the services. Mark is shown in large font on the top of the webpage. Services are indicated by the following:

A freeze-frame of a video featuring a play button is displayed, indicating the services are accessed by clicking the play button.

The wording “Join Now! Get the latest feel-good videos, news and events” conveys the different content that is available for broadcast.

The wording “Latest Videos” and the images of several videos appear near the bottom, implying that other videos are available for broadcast.

Direct mark-services association is present because it is customary to display service marks near the top of the webpages on which the services are advertised or through which they are accessed, rendered, and experienced. Here, the mark is sufficiently near indicia implying the services and no other marks appear to negate the mark-services connection. While the nature of the services is not explicitly textually referenced, the display of the play button and “Latest Videos” indicate that applicant is offering broadcasting services.

### *Entertainment Services*

#### EXAMPLE 12



**Mark:** CINEMAX

**Services:** Entertainment services in the nature of providing entertainment programming and content, namely, on-going television programs, and related clips and graphics and information relating to television programming and content in the fields of comedy, drama, action, adventure via television, cable and satellite systems, the Internet, electronic communications networks, computer networks and wireless communications networks, in Class 41.

**Analysis:**

Specimen is described as “mark as used in commerce on specified goods and services” and appears to be a webpage advertising some of the identified services and rendering other identified services. Mark is displayed prominently at the top of the webpage.

Services are referenced in the following wording and statements:

The navigation tabs at the top “VIDEOS,” “SCHEDULE,” “ORIGINAL SERIES,” “MOVIES,” and “AFTER DARK” indicate the entertainment content available.

The play button next to “WATCH PREVIEW” indicates that a clip of the show “ASYLUM BLACKOUT” may be viewed.

The reference to “BANSHEE” states “From the creator of ‘True Blood’ comes a Cinemax original series about a small town where nothing is as it seems . . .,” advertising another on-going television program.

Direct mark-services association is present because it is customary to display service marks near the top of the webpage on which the services are advertised or through which they are accessed, rendered, and experienced. Here, the mark is sufficiently near textual references to the services, thus indicating the direct mark-services connection.

**EXAMPLE 13**



**Mark:** DELICIOSO

**Services:** Entertainment and education services, namely, ongoing television program concerning cooking and nutrition, in Class 41.

**Analysis:**

Specimen is described as a “photo of opening title of applicant's television program” and appears to show the mark used in rendering the services.

Mark is prominently shown in large font on the title screen of an electronic device that is displaying the ongoing television program.

Direct mark-services association is present because the mark appears on the title screen where it is customary in such industry to place the mark under which the services are promoted. It is common practice for a title screen bearing the mark to appear at the start of entertainment content and indicate the launch of the services. While the nature of the services is not textually referenced, it is sufficient that the overall content of the specimen implies that applicant is offering entertainment services.

The specimen would be unacceptable without the specimen description, which clarifies that the specimen is an “opening title” and places the mark in the context of providing the services. Since the specimen could possibly be print advertising, a specimen description is necessary to clarify the nature of the specimen. The top right corner of the specimen shows some wording that suggests that the title screen is displayed on an electronic device. However, since that wording is not legible and

the context of the title screen is not visible, the nature of the specimen is unclear and, thus, a specimen description is required clarifying that it is a title screen.

#### EXAMPLE 14



**Mark:** OUTERNAUTS

**Services:** Entertainment services, namely, providing online video games, in Class 41.

#### Analysis:

Specimen is described as a “screenshot of the page on Facebook.com, an Internet website, from which the services are provided to users” and appears to show the mark used in rendering the services. Mark is prominently shown in large font near the top of the webpage.

Services are referenced in the following statements and indicated by the following:

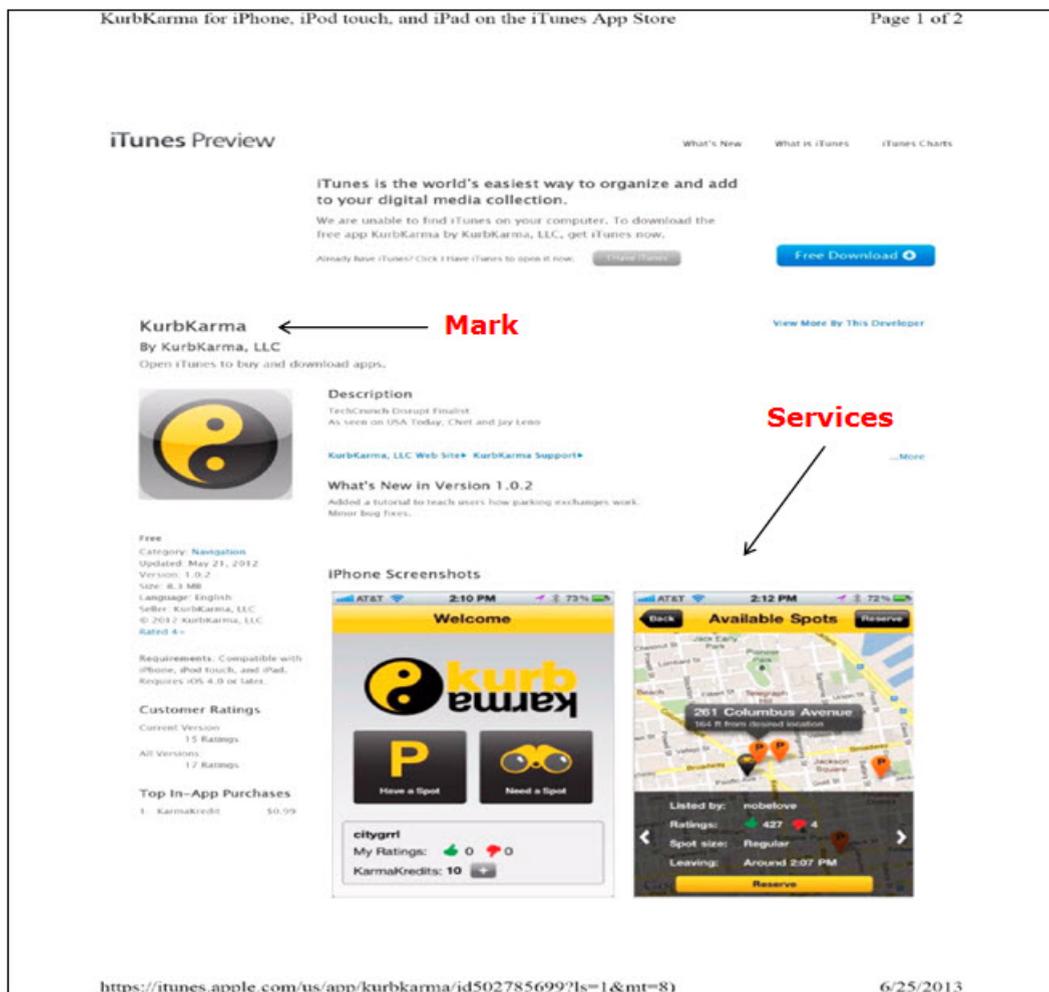
The mark appears near video game information “Get Star Gems,” “Leaderboard,” and “loading Outernauts.”

The mark appears near the word “Games,” generally referencing the services.

Direct mark-services association is present because it is customary to display service marks near the top of the webpage on which the services are advertised or through which they are accessed, rendered, and experienced. Here, the mark is near indicia implying the services and other marks appear to cloud the mark-services connection. While the specimen shows the webpage is from a

third-party website, i.e., Facebook®, this does not diminish the requisite direct association due to the proximity of the applied-for mark to the matter indicating the online services, which appear to be directly launched from the website. The screenshot also appears to be of the title or launch screen of the online video game, where it is common practice in such industry to place the mark under which the services are promoted and where such placement is recognized as the introduction of the online services. The screenshot here implies, and it is generally known, that access to and performance of the services begins with this screen. The specimen description combined with the wording “loading Outernauts” further supports the direct mark-services connection. The specimen is also acceptable as an advertisement since the word “Games” appears on the lower left corner as part of a third-party mark “Insomniac Games.” It may be inferred that the combination of the applied-for mark OUTERNAUTS with the reference to “Games” and to “EA” sufficiently and textually references the online video game services.

**EXAMPLE 15**



**Mark:** KURBKARMA

**Services:** On-line matching services for connecting automobile drivers with other drivers who are, respectively, searching for or departing from parking spaces accessible via a mobile application, in Class 35.

**Analysis:**

Specimen is described as “screenshot of the iTunes store which features Applicant's mark and describes Applicant's services.”

Mark is displayed in bold font in the middle left of the webpage.

Services are indicated by the following:

The iPhone® screen images clearly and legibly show the wording “Have a Spot,” “Need a Spot,” and “Available Spots,” indicating the services being performed by the applicant via the app.

Direct mark-services association is present because the mark is placed in sufficiently close proximity to the iPhone® screenshots, which show the services as they are accessed and rendered via the device.

**EXAMPLE 16**



**Mark:** VTECH DIRECT

**Services:** Providing a web site for online business-to-business store services featuring wireline telephony products and wireless fidelity streaming music devices; online business-to-business store featuring wireline telephony products and wireless fidelity streaming music devices, in Class 35.

**Analysis:**

Specimen is described as “pages from website” and appears to show the mark being used in both the advertising and rendering of the services.

Mark is displayed prominently in bold font on the top left of each webpage.

Services are referenced and indicated by the following:

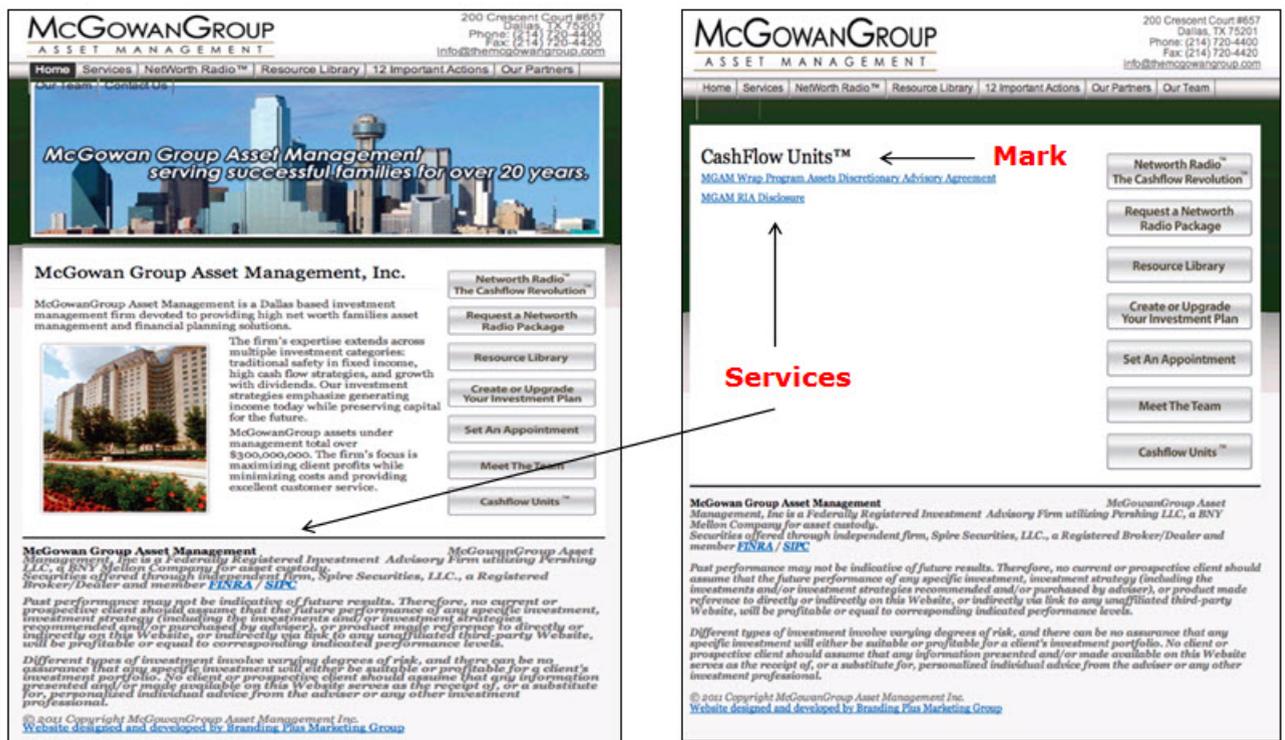
“Sign In” fields are provided for accessing the online business-to-business store services, indicating that one may access the services by logging in.

“Tune in over 11,000 stations around the globe using wireless Internet access. Listen to music, sports, talk radio and more.”

Image of an electronic streaming music device described as “IS9181 – (80-6569-02) Stream internet radio stations Stream digital music files stored on your PC or Mac Connect to your MP3 or CD player.”

Direct mark-services association is present because it is customary to display service marks near the top of the webpage on which the services are advertised or through which they are accessed, rendered, and experienced. Here, the mark is near explicit textual references to the services, thus conveying the direct mark-services connection. The webpage showing the sign-in fields is an acceptable specimen since signing-in is a generally known means of accessing online services. Thus, the specimen is acceptable both as an advertisement and as showing the mark in rendering the services.

**EXAMPLE 17**



**Mark:** CASHFLOW UNITS

**Services:** Investment products, namely, wealth management and performance tracking, and providing financial advisory and financial portfolio management services, in Class 36.

**Analysis:**

Specimens are described as “webpages.”  
 Mark is placed below “the McGowanGroup Asset Management banner.”  
 The Board held the specimen acceptable as showing use of the mark in rendering the services based on the following findings:

“The disclosures at the bottom of one webpage inform the viewer that applicant is a ‘Federally Registered Investment Advisory Firm.’”

The mark “appears under the McGowanGroup Asset Management banner, thus informing the viewer that CASHFLOW UNITS are part of an asset management service.”

Directly below the mark are links to two documents: (1) the “MGAM Wrap Program Assets Discretionary Advisory Agreement”; and (2) the “MGAM RIA Disclosure”. The Board noted that the first document is the applicant’s contract and an offer to enter into an agreement for advisory services, and the second document is the applicant’s notice of compliance with the conflict of interest rules.

The mark on the webpage is placed “in close proximity to links for documents used by applicant in rendering those services” and “the links to these documents create an association between the mark and the offered service activity.”

## EXAMPLE 18



**Mark:** RIDE 411

**Relevant Services:** Providing an online search engine service for new and used automobile listings and automobile related information; Providing specific information as requested by customers via the Internet; Provision of Internet search engines; Provision of search engines for the Internet, in Class 42.

**Analysis:**

Specimen is described as “screen shot of our website” and appears to be a webpage advertising some of the identified services and rendering other identified services.

Mark is displayed in large, color font on the top of the webpage.

Services are referenced in the following statements and indicated by the context in which they are rendered, as follows:

“Simply type any keyword(s) into our search engine to find a group of suppliers for exactly what you are looking for, or select from a category and drill down from there.”

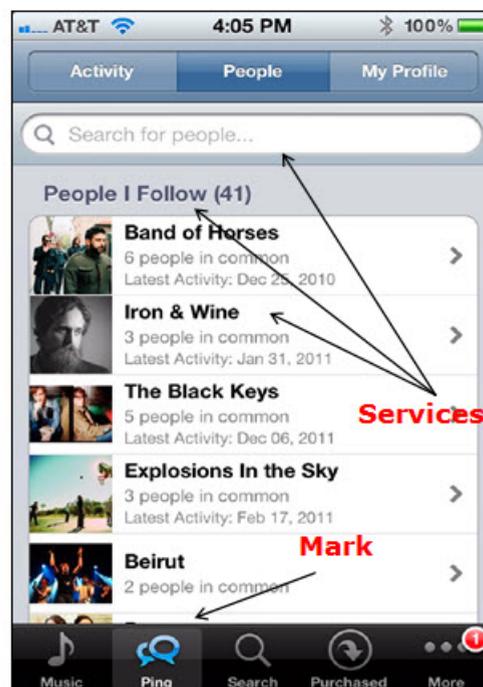
The wording “Your destination for hard to find classic car parts, services, events & more” and “FIND ... How can I find hard to locate parts for my classic car?” indicates the nature of the services provided.

Hyperlinks appear under “Locate Parts,” “Locate Services,” and “Search By Category.”

Services are provided primarily for the benefit of others, i.e., the users are able to view the search results from a variety of sources from the Internet in one list.

Direct mark-services association is present because it is customary to display service marks near the top of the webpage on which the services are advertised or through which they are accessed, rendered, and experienced. Here, the mark is near textual references to the services, thus indicating the mark-services connection. The mark is also near indicia of the services, i.e., searchable links and categories for locating automobile parts and services, which is also sufficient to show a direct mark-services association. Thus, the specimen is acceptable both as an advertisement and as showing the mark in rendering the services.

## EXAMPLE 19



**Mark:** (stylized speech bubbles)



**Services:** Online social networking services, in Class 45.

**Analysis:**

Specimen is described as “screenshot of applicant’s software” and appears to show the mark used in rendering the services.

Mark is displayed in the color blue at the bottom of the screen of an electronic device.

Services are indicated by the following:

A highlighted “People” tab appears at the top of the screen, as does a search bar containing the wording “Search for people.”

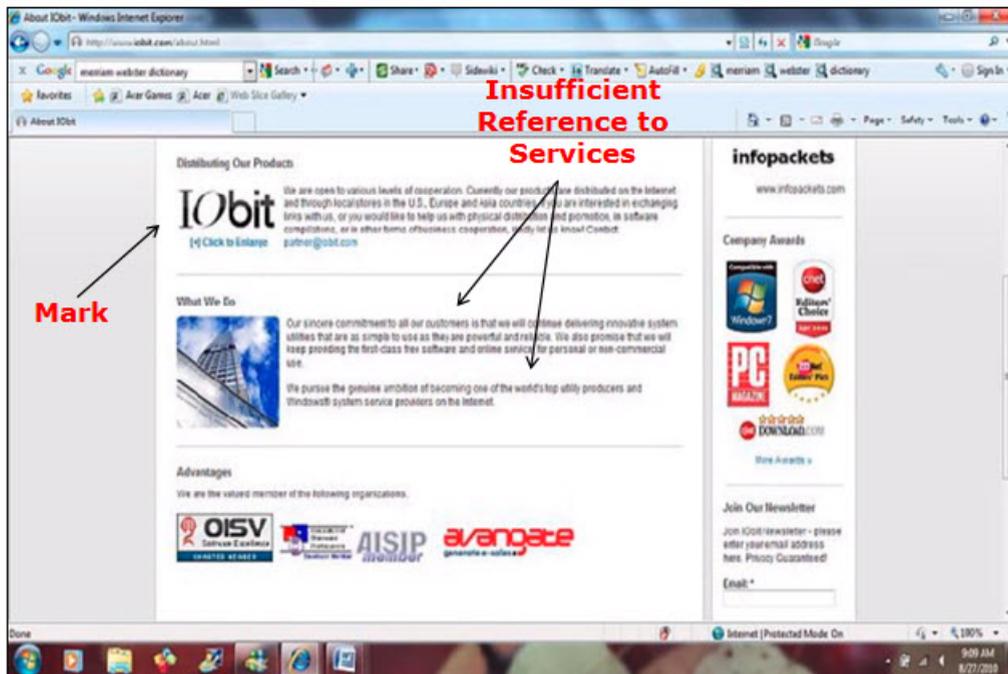
The wording “People I Follow (41)” indicates that the user follows 41 people and the screen shows a list of people being followed, each specifying the number of “people in common.”

Applicant explained that the specimen is a screenshot from an Apple® handheld mobile device showing the mark used in rendering the services.

Direct mark-services association is present because the mark appears on the screen of an electronic device via which the online services are accessed, rendered, and experienced. Additionally, the mark is displayed on the screen below indicia implying the services as well as showing the services as they are accessed and rendered via the device. The context in which the mark is used, i.e., while the services are being performed and experienced, creates the direct association with the services. The presence of a third-party mark (AT&T®) displayed on the top left of the screenshot does not detract from the applicant’s mark being associated with the services. The AT&T® mark denotes the telecommunication company that provides the connection to the Internet, but it appears that the applicant’s services enable online social networking.

## **1301.04(j) Examples of Unacceptable Service-mark Specimens**

### **EXAMPLE 20**



**Mark:** IObit

**Services:** Computer programming; Computer software design; Conversion of data or documents from physical to electronic media; Data conversion of computer programs and data, not physical conversion; Duplication of computer programs; Hosting of web sites; Installation of computer software; Maintenance of computer software; Research and development for new products for others; Research and development of computer software; Updating and maintenance of computer software, in Class 42.

**Analysis:**

Specimen is a “screenshot from applicant’s website.”

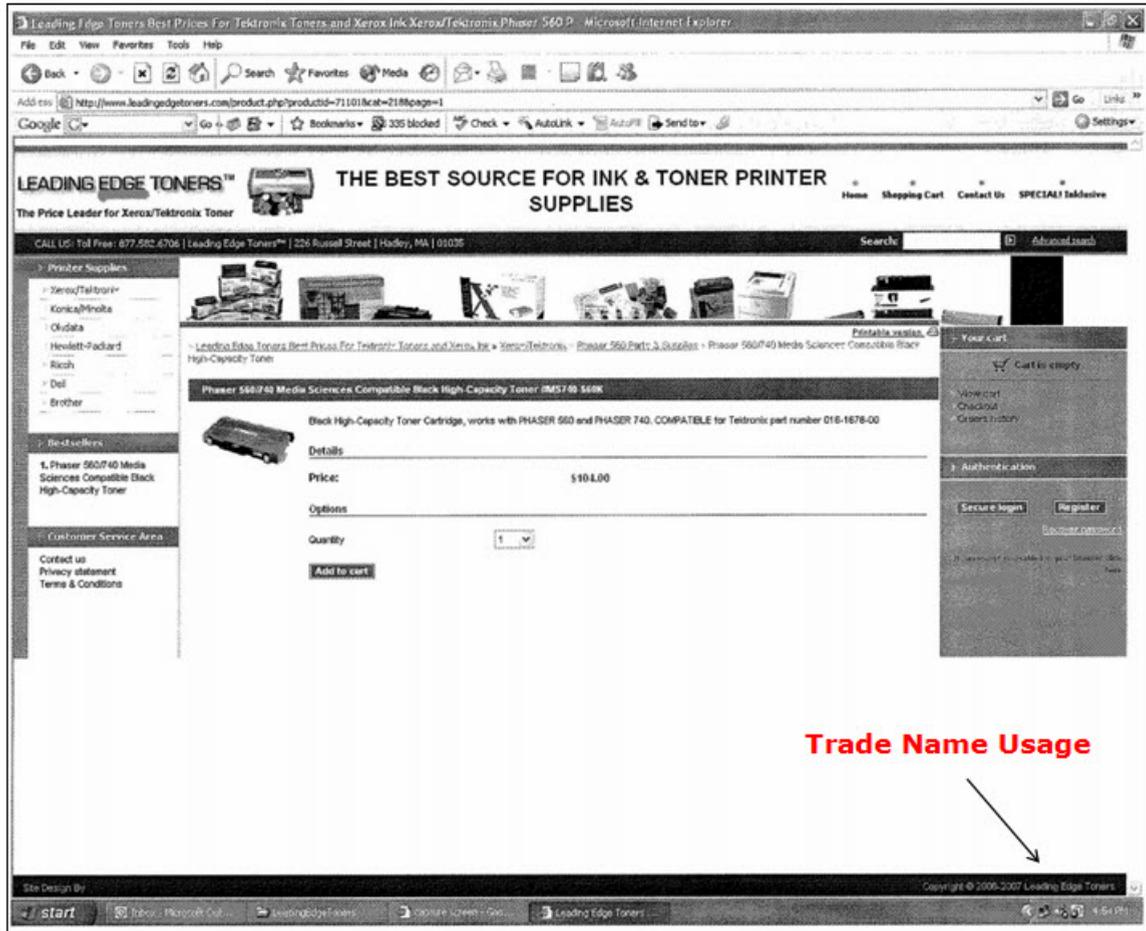
The Board found the following statements were vague and did not sufficiently reference the services:

“Our sincere commitment to all our customers is that we will continue delivering innovative system utilities that are as simple to use as they are powerful and reliable. We also promise that we will keep providing the first-class free software and online service, for personal or non-commercial use.”

“We pursue the genuine ambition of becoming one of the world's top utility producers and Windows system service providers on the Internet.”

It is unclear whether the reference to “online service” is to a separate service or part of the free software goods. The textual reference to becoming a top utility producer and Windows system service provider is not sufficient to indicate being a provider of the identified services.

## EXAMPLE 21



**Mark:** LEADING EDGE TONERS

**Goods:** Numerous goods including toner; toner cartridges, in Class 2; components for laser toner cartridges; and printer parts, in Class 9; and Ink sticks, in Class 16.

**Analysis:**

Specimen is described as a “web page.”

Mark is displayed in several places, including at the bottom right corner next to the copyright notice. The Board noted that “where the mark is used with the copyright notice . . ., applicant assumed ‘without admitting’ that the use was solely as a trade name.”

While the specimen is not acceptable for the identified goods, had the mark been used in connection with retail store or distributorship services, the specimen would likely have been acceptable due to

the placement of the mark on the upper left corner of the webpage where service marks normally appear.

### 1301.05 Identification and Classification of Services

See [TMEP §§1402.11–1402.11\(k\)](#) regarding identifications of services, and [TMEP §1401](#) 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 is *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 Labs., Inc. v. Am. Soc’y 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.

*See also In re Int’l Inst. of Valuers*, 223 USPQ 350 (TTAB 1984) . See [TMEP §1303](#) concerning collective trademarks and service marks; [§1304.01](#) concerning collective membership marks; and [§1305](#) concerning the distinction between collective trademarks or service marks from trademarks and service marks used by collective organizations.

#### 1302.01 Brief History of Collective Marks

Under the Trademark Act of 1905, registration could be based only on a person’s own use of a mark. The Act did not permit for registration of collective and certification marks because such marks are generally

used by a member of a collective organization or an authorized user, while the owner of the mark exercises legitimate control over this use by others. However, the June 10, 1938 amendment to the Act of 1905, out of which §4 and the accompanying definitions in §45 grew, changed this limitation on use and provided 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 in the federal statute until implementation of Section 45 of the Act of 1946.

Section 4 of the Trademark Act of 1946 provides the authority for the registration of collective and certification marks by persons exercising legitimate control over their use, even in the absence of an industrial or commercial establishment. [15 U.S.C. §1054](#). Section 45 defines collective marks and certification marks separately, as distinctly different types of marks. [15 U.S.C. §§1054, 1127](#). Additionally, the definition of collective mark in §45 encompasses collective trademarks and collective service marks, as well as collective membership marks, which indicate membership in a union, association, or other organization. [15 U.S.C. §1054](#). See [TMEP §§1306.01–1306.01\(b\)](#) regarding certification marks.

### 1303 Collective Trademarks and Collective Service Marks Generally

Although collective trademarks and collective service marks indicate the commercial origin of goods or services, they also indicate that the party providing the goods or services is a member of a certain group and meets the group's standards for admission. A collective mark is used by all members of the collective 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. In comparison, a trademark or service mark is used by the owner of the mark to indicate the commercial source or origin of the goods/services in the owner.

The collective organization itself neither sells the goods nor renders the services provided under the mark, but may advertise so as to publicize the mark and promote the goods or services sold by its members under the mark. For example, a collective organization of real-estate professionals does not render real-estate services, but rather promotes the real-estate services offered by its members. See *Zimmerman v. Nat'l Assoc. of Realtors*, 70 USPQ2d 1425, 1428 (TTAB 2004).

Compared with a specimen for a trademark or service mark, which generally shows use of the mark by the owner, a specimen of use for a collective trademark or collective service mark must show use of the mark by a member of the collective organization. [37 C.F.R. §2.44\(a\)\(4\)\(i\)\(C\)](#); [TMEP §1303.01\(a\)\(i\)\(C\)](#). Such use must be on the member's goods/packaging or in the sale, advertising, or rendering of the member's services. See [37 C.F.R. §2.56\(b\)\(3\)](#); [TMEP §1303.01\(a\)\(i\)\(C\)](#).

#### 1303.01 Application Requirements for a Collective Trademark or Collective Service Mark

Under [37 C.F.R. §2.44](#), a complete application for a collective trademark or collective service mark must include the following:

- (1) the legal name and physical address of the applicant (see [TMEP §§803.02, 803.05](#));
- (2) the applicant's legal entity type (see [TMEP §803.03](#));
- (3) the applicant's citizenship or the jurisdiction under whose laws the applicant is organized, and if the applicant is a domestic partnership or joint venture, the names and citizenship of the general partners or active members of the joint venture (see [TMEP §§803.03\(b\), 803.04](#)), or if the applicant is a sole proprietorship, the U.S. state or foreign country of its organization and the name and citizenship of the sole proprietor ([37 C.F.R. §2.32\(a\)\(3\)\(v\)](#), [TMEP §§803.03\(a\), 803.04](#));
- (4) a description of the mark if the mark is not in standard characters (see [TMEP §808](#));

- (5) a translation/transliteration of any foreign wording in the mark (*see* [TMEP §809](#));
- (6) a drawing of the mark sought to be registered (*see* [TMEP §807](#));
- (7) a filing fee (*see* [TMEP §810](#));
- (8) a list of the particular goods or services on or in connection with which the applicant's members use or intend to use the mark (*see* [TMEP §§805, 1402–1402.15](#));
- (9) the international classification of the goods or services (*see* [TMEP §§805, 1401](#)); and
- (10) a filing basis (*see* [TMEP §§1303.01\(a\)–1303.01\(a\)\(vi\)](#)), including verification of certain statements signed by the applicant or a person properly authorized to sign on behalf of the applicant (*see* [TMEP §§1303.01\(b\)–1301.01\(b\)\(ii\)](#)).

[37 C.F.R. §§2.44\(a\)\(1\), \(a\)\(2\)\(i\), \(a\)\(3\)\(i\), \(a\)\(4\), \(a\)\(4\)\(B\)](#).

*Requirements that differ in form from those in trademark or service mark applications*. Most application requirements for collective trademarks and collective service marks are the same as those for regular trademarks and service marks. *See* [37 C.F.R. §2.44\(a\)\(1\)](#). However, the filing basis and verification requirements for collective trademark and collective service mark applications differ in form from other trademark and service mark applications because of the difference between who owns and uses collective trademarks and collective service marks. *See* [TMEP §§1303.01\(a\)–1303.01\(a\)\(vi\)](#) for information regarding filing-basis requirements for collective trademarks and collective service marks and [TMEP §§1303.01\(b\)–1301.01\(b\)\(ii\)](#) for information regarding the verification of certain statements in collective trademark and collective service mark applications.

See TMEP [Chapter 1600](#) for requirements post registration.

### **1303.01(a) Filing Basis**

All applications for registration must include a filing basis, regardless of the type of mark, because this is the statutory basis for filing an application for registration of a mark in the United States. [TMEP §806](#). There are five filing bases: (1) use of a mark in commerce under §1(a) of the Act; (2) bona fide intention to use a mark in commerce under §1(b) of the Act; (3) a claim of priority, based on an earlier-filed foreign application under §44(d) of the Act; (4) ownership of a registration of the mark in the applicant's country of origin under §44(e) of the Act; and (5) extension of protection of an international registration to the United States under §66(a) of the Act. [15 U.S.C. §§1051\(a\)-\(b\), 1126\(d\)-\(e\), 1141f\(a\)](#); [37 C.F.R. §2.44\(a\)\(4\)](#).

An applicant is not required to specify or otherwise satisfy the requirements for a filing basis to receive a filing date. *See Kraft Grp. LLC v. Harpole*, 90 USPQ2d 1837, 1840 (TTAB 2009). If a §1 or §44 application does not specify a basis, the examining attorney must require in the first Office action that the applicant specify the basis for filing and submit all the elements required for that basis. If the applicant timely responds to the first Office action, but fails to specify a basis for filing, or fails to submit all the elements required for a particular basis, the examining attorney will issue a final Office action, if the application is otherwise in condition for final action.

In a §66(a) application, the basis for filing will have been established in the international registration on file at the IB.

See [37 C.F.R. §2.44\(a\)\(4\)](#) and [TMEP §1303.01\(a\)\(i\)-\(a\)\(v\)](#) for a list of the requirements for each basis.

### 1303.01(a)(i) Use in Commerce – §1(a)

Under [15 U.S.C. §1051\(a\)](#), [§1054](#), and [37 C.F.R. §2.44\(a\)\(4\)\(i\)](#), to establish a basis under §1(a) of the Trademark Act, the applicant must:

- (1) Submit a statement specifying the nature of the applicant’s control over the use of the mark by the members ([37 C.F.R. §2.44\(a\)\(4\)\(i\)\(A\)](#));
- (2) Specify the date of the applicant’s member’s first use of the mark anywhere on or in connection with the goods or services ([37 C.F.R. §2.44\(a\)\(4\)\(i\)\(B\)](#));
- (3) Specify the date of the applicant’s member’s first use of the mark in commerce (*Id.*);
- (4) Submit one specimen for each class, showing how a member uses the mark in commerce on the member's goods or in the sale of the services, including use in the performance or rendering of the services, or advertising of the member's services ([37 C.F.R. §§2.44\(a\)\(4\)\(i\)\(C\)](#), [2.56\(b\)\(3\)](#)); and
- (5) Submit a verified statement that the applicant believes the applicant is the owner of the mark; that the mark is in use in commerce; that the applicant is exercising legitimate control over the use of the mark in commerce; that to the best of the signatory’s knowledge and belief, no other persons except members have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods or services of such other persons to cause confusion or mistake, or to deceive; that the specimen shows the mark as used in commerce by the applicant’s members; and that the facts set forth in the application are true ([15 U.S.C. §§1051\(a\)\(3\)\(C\)](#), [1054](#); [37 C.F.R. §2.44\(a\)\(4\)\(i\)\(D\)](#)). See TMEP §1303.01(b)(i) for additional information regarding the requirements for the verified statement in applications under §1(a) of the Trademark Act.

The Trademark Act defines “commerce” as commerce that may lawfully be regulated by the U.S. Congress, and “use in commerce” as the bona fide use of a mark in the ordinary course of trade. [15 U.S.C. §1127](#); see [TMEP §§901–901.04](#).

An applicant may claim both use in commerce under §1(a) of the Act and intent-to-use under §1(b) of the Act as a filing basis in the same application, but may not assert both §1(a) and §1(b) for the identical goods or services in the same application. [37 C.F.R. §2.44\(c\)](#); see [TMEP §806.02\(b\)](#).

An applicant may not claim a §1(a) basis unless the mark was in use in commerce on or in connection with all the goods or services covered by the §1(a) basis as of the application filing date. *Cf. E.I. du Pont de Nemours & Co. v. Sunlyra Int’l, Inc.*, 35 USPQ2d 1787, 1791 (TTAB 1995) .

If the applicant claims use in commerce in addition to another filing basis, but does not specify which goods or services are covered by which basis, the USPTO may defer examination of the specimen(s) until the applicant identifies the goods or services for which use is claimed. [TMEP §806.02\(c\)](#).

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 or service mark for the goods or services covered by the collective trademark or collective service mark registration. See [TMEP §1305](#). The “anti-use-by-owner rule” of §4 of the Trademark Act does not apply to collective marks. See [15 U.S.C. §1054](#). 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 only to certification marks. *Cf. Roush Bakery Prods. 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) (stating that the Board no longer believes that the anti-use-by-owner rule is applicable to trademarks).

The same mark may not be used both as a collective trademark or collective service mark and as a certification mark for the same goods or services. [37 C.F.R. §2.45\(f\)](#); [TMEP § 1306.04\(f\)](#).

### **1303.01(a)(i)(A) Manner/Method of Control**

An applicant must specify the class of persons entitled to use the mark (i.e., the applicant's members), 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\(a\)\(4\)\(i\)\(A\)](#). A statement that the applicant's bylaws or other written provisions specify the manner of control is sufficient to satisfy this requirement. This statement does not have to be verified and, therefore, may be entered by examiner's amendment.

The following language may be used for the above purpose:

Applicant controls the members' use of the mark in the following manner: [specify, e.g., the applicant's bylaws specify the manner of control].

### **1303.01(a)(i)(B) Dates of Use**

When setting out the dates of use for a collective trademark on goods or collective service mark in connection with services, the applicant must state that the mark was first used by a member of the applicant rather than by the applicant. [37 C.F.R. §2.44\(a\)\(4\)\(i\)\(B\)](#).

The date of first use anywhere for a collective trademark application is the date when an applicant's member's goods were first sold or transported or, for a collective service mark application, when an applicant's member's services were first rendered, under the mark, if such use is bona fide and in the ordinary course of trade. See [15 U.S.C. §1127](#) (definition of "use" within the definition of "abandonment of mark"). For every applicant, whether foreign or domestic, the date of first use of a mark is the date of the first use anywhere, in the United States or elsewhere, regardless of whether the nature of the use was local or national, intrastate or interstate, or of another type.

The date of first use in commerce for a collective trademark application is the date when an applicant's member's goods were first sold or transported or, for a collective service mark application, when an applicant's member's services were first rendered, under the mark in a type of commerce that may be lawfully regulated by the U.S. Congress, if such use is bona fide and in the ordinary course of trade. See [15 U.S.C. §1127](#) (definition of "use" within the definition of "abandonment of mark"). See [TMEP §901.01](#) for definitions of "commerce" and "use in commerce," and [§901.03](#) regarding types of commerce.

In a §1(a) application, the applicant may not specify a date of use that is later than the filing date of the application. If an applicant who filed under §1(a) cannot show that a member used the mark in commerce on or before the application filing date, the applicant may amend the basis to §1(b). See [37 C.F.R. §2.35\(b\)\(1\)](#). See [TMEP §806.03](#) regarding amendments to the basis.

Neither a date of first use nor a date of first use in commerce is required to receive a filing date in an application based on use in commerce under §1(a) of the Act. If the application does not include a date of first use and/or a date of first use in commerce, the examining attorney must require that the applicant specify

the date of first use and/or date of first use in commerce. See [37 C.F.R. §2.44\(a\)\(4\)\(i\)\(B\)](#). The dates must be supported by an affidavit or declaration under [37 C.F.R. §2.20](#). See [37 C.F.R. §§2.44\(a\)\(4\)\(i\)\(B\)](#), [2.71\(c\)](#).

An applicant may not file an application on the basis of use of a mark in commerce if such use has been discontinued.

### **1303.01(a)(i)(C) Specimens**

A specimen of use for a collective trademark or collective service mark must show how a member uses the mark 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 must show use of the mark to indicate that the party providing the goods or services is a member of a certain group. 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 the sale or advertising of the services. See [37 C.F.R. §2.56\(b\)\(3\)](#).

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.

See [TMEP §§904–904.07\(b\)\(i\)](#) regarding specimens for trademarks and [§§1301.04–1301.04\(j\)](#) regarding specimens for service marks.

See [TMEP §904.07\(a\)](#) regarding whether a trademark or service mark specimen shows the mark as actually used in commerce.

### **1303.01(a)(ii) Intent to Use – §1(b)**

In an application based on intent to use, the applicant must submit a verified statement that the applicant has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce; that to the best of the signatory's knowledge and belief, no other persons, except members, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods or services of such other persons, to cause confusion or mistake, or to deceive; and that the facts set forth in the application are true. [37 C.F.R. §2.44\(a\)\(4\)\(ii\)](#); see [15 U.S.C. §§1051\(b\)\(3\)\(B\)](#), [1054](#). See TMEP §1303.01(b)(i) for additional information regarding the requirements for the verified statement in applications under §1(b) of the Trademark Act.

Prior to registration, the applicant must file an allegation of use (i.e., either an amendment to allege use under [15 U.S.C. §1051\(c\)](#) or a statement of use under [15 U.S.C. §1051\(d\)](#), which states that (a) the mark is in use in commerce and (b) the applicant is exercising legitimate control over the use of the mark in commerce, and includes dates of use, the filing fee for each class, and one specimen evidencing use of the mark for each class. See [37 C.F.R. §§2.76\(b\)](#), [2.88\(b\)](#). See [37 C.F.R. §2.76](#) and [TMEP §§1104–1104.11](#) regarding amendments to allege use and [37 C.F.R. §2.88](#) and [TMEP §§1109–1109.18](#) regarding statements of use.

Once an applicant claims a §1(b) basis for any or all the goods or services, the applicant may not amend the application to seek registration under §1(a) of the Act for those goods or services unless the applicant files an allegation of use under §1(c) or §1(d) of the Act. [37 C.F.R. §2.35\(b\)\(8\)](#).

See [TMEP Chapter 1100](#) for additional information about intent-to-use applications.

### **1303.01(a)(iii) Foreign Priority – §44(d)**

Section 44(d) of the Act provides a basis for receipt of a priority filing date, but not a basis for publication or registration. Before the application can be approved for publication, or for registration on the Supplemental Register, the applicant must establish a basis under §1(a), §1(b), or §44(e) of the Act. [37 C.F.R. §2.44\(a\)\(4\)\(iv\)\(A\)](#); [TMEP §1003.03](#). If the applicant claims a §1(b) basis, the applicant must file an allegation of use before the mark can be registered. See [TMEP §1303.01\(a\)\(ii\)](#) regarding the requirements for a §1(b) basis.

Under [15 U.S.C. §§1054, 1126\(d\)](#), and [37 C.F.R. §2.44\(a\)\(4\)\(iv\)](#), the requirements for receipt of a priority filing date based on a previously filed foreign application are:

- (1) The applicant must file a claim of priority within six months of the filing date of the foreign application ([37 C.F.R. §2.44\(a\)\(4\)\(iv\)\(A\)](#));
- (2) The applicant must: (a) specify the filing date, serial number, and country of the first regularly filed foreign application; or (b) state that the application is based upon a subsequent regularly filed application in the same foreign country, and that any prior-filed application has been withdrawn, abandoned, or otherwise disposed of, without having been laid open to public inspection and without having any rights outstanding, and has not served as a basis for claiming a right of priority ([37 C.F.R. §2.44\(a\)\(4\)\(iv\)\(A\)](#); *see also* Paris Convention Article 4(D)); and
- (3) The applicant must submit a verified statement that the applicant has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce; that to the best of the signatory's knowledge and belief, no other persons, except members, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods or services of such other persons, to cause confusion or mistake, or to deceive; and that the facts set forth in the application are true ([37 C.F.R. §2.44\(a\)\(4\)\(iv\)\(B\)](#); *see* [15 U.S.C. §§1051\(b\)\(3\)\(B\), 1054](#)). This allegation is required even if use in commerce is asserted in the application ( [TMEP §806.02\(e\)](#)). See [TMEP § 1303.01\(b\)\(i\)](#) for additional information regarding the requirements for the verified statement in applications under §44 of the Trademark Act.

The scope of the goods/services covered by the §44 basis in the U.S. application may not exceed the scope of the goods/services in the foreign application or registration. [37 C.F.R. §2.44\(a\)\(2\)\(iii\)](#); [TMEP §1402.01\(b\)](#).

If an applicant properly claims a §44(d) basis in addition to another basis, the applicant may retain the priority filing date without perfecting the §44(e) basis. [37 C.F.R. §2.35\(b\)\(3\), \(b\)\(4\)](#). See [TMEP §806.04\(b\)](#) regarding processing an amendment electing not to perfect a §44(e) basis and [§806.02\(f\)](#) regarding the examination of applications that claim §44(d) in addition to another basis. See [TMEP §§1003–1003.08](#) for further information about §44(d) applications.

### 1303.01(a)(iv) Foreign Registration – §44(e)

Under [15 U.S.C. §§1054, 1126\(e\)](#), and [37 C.F.R. §2.44\(a\)\(4\)\(iii\)](#), the requirements for establishing a basis for registration under §44(e), relying on a registration granted by the applicant's country of origin, are:

- (1) The applicant must submit a true copy, a photocopy, a certification, or a certified copy of the registration in the applicant's country of origin. If the foreign registration or other certification is not in English, the applicant must provide a translation of the document. If the record indicates that the foreign registration will expire before the U.S. registration will issue, the applicant must submit a true copy, a photocopy, a certification, or a certified copy of a proof of renewal from the applicant's country of origin to establish that the foreign registration has been renewed and will be in full force and effect at the time the U.S. registration will issue. If the proof of renewal is not in the English language, the applicant must submit a translation ([37 C.F.R. §2.44\(a\)\(4\)\(iii\)\(A\)](#); [TMEP §§1004.01, 1004.01\(b\)](#));
- (2) The applicant must submit a verified statement that the applicant has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce; that to the best of the signatory's knowledge and belief, no other persons, except members, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods or services of such other persons, to cause confusion or mistake, or to deceive; and that the facts set forth in the application are true ([37 C.F.R. §2.44\(a\)\(4\)\(iii\)\(B\)](#); *see* [15 U.S.C. §§1051\(b\)\(3\)\(B\), 1054](#)). This allegation is required even if use in commerce is asserted in the application ([TMEP §806.02\(e\)](#)). *See* [TMEP §1303.01\(b\)\(i\)](#) for additional information regarding the requirements for the verified statement in applications under §44 of the Trademark Act; and
- (3) The applicant's country of origin must either be a party to a convention or treaty relating to trademarks to which the United States is also a party, or extend reciprocal registration rights to nationals of the United States by law (15 U.S.C. §1026(b), *see* [TMEP § 1002.03](#)).

If the applicant does not submit a certification or a certified copy of the registration from its country of origin, the applicant must submit a true copy or photocopy of a document that has been issued to the applicant by, or certified by, the intellectual property office in the applicant's country of origin. A photocopy of an entry in the intellectual property office's gazette (or other official publication) or a printout from the intellectual property office's website is not, by itself, sufficient to establish that the mark has been registered in that country and that the registration is in full force and effect. *See* [TMEP §1004.01](#).

The scope of the goods/services covered by the §44 basis in the United States application may not exceed the scope of the goods/services in the foreign registration. [37 C.F.R. §2.44\(a\)\(2\)\(iii\)](#); [TMEP §1402.01\(b\)](#).

An application may be based on more than one foreign registration. If the applicant amends an application to rely on a different foreign registration, this is not considered a change in basis; however, the application must be republished. [TMEP §1004.02](#). *See* [TMEP §806.03](#) regarding amendments to add or substitute a basis.

*See* [TMEP §§1004–1004.02](#) for further information about §44(e) applications.

### 1303.01(a)(iv)(A) Scope of Foreign Registration

A registration as a collective trademark or collective service mark in the United States may not be based on a foreign registration that is actually a trademark registration. *See In re Löwenbräu München*, 175 USPQ 178 (TTAB 1972) (noting that the U.S. registration cannot exceed the breadth or scope of the foreign

registration on which it is based); [TMEP §1402.01\(b\)](#). 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 is not always immediately apparent from a foreign registration certificate. Foreign registration certificates may not always clearly identify whether the mark is a trademark, service mark, collective mark, or certification mark and even when they indicate the type, the significance of the term used for the type 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.

If a foreign registration certificate has a heading that designates the mark as a collective trademark or collective service mark, or if the body of the foreign certificate contains language indicating that the registration is for a collective trademark or collective service mark, the foreign registration normally may be accepted to support registration in the United States as a collective trademark or collective service mark.

If a foreign registration certificate has a heading that designates the mark as a collective mark, or if the body of the foreign certificate contains language indicating that the registration is for a collective mark, this could indicate that the foreign registration is for a collective trademark, collective service mark, or collective membership mark. See [TMEP §1302](#). In such a situation, the examining attorney must review the foreign registration to determine if there is a reference to goods or services such that the registration is for a collective trademark or collective service mark, or a reference indicating membership only such that the registration is for a collective membership mark. *Id.*

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, pursuant to [37 C.F.R. §2.61](#).

### **1303.01(a)(v) Extension of Protection of International Registration – §66(a)**

Section 66(a) of the Act, [15 U.S.C. §1141f\(a\)](#), provides for a request for extension of protection of an international registration to the United States. See [37 C.F.R. §2.44\(a\)\(4\)\(v\)](#). The request must include a verified statement alleging that the applicant has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce that the U.S. Congress can regulate on or in connection with the goods or services specified in the international application/subsequent designation; that the signatory is properly authorized to execute the declaration on behalf of the applicant/holder; and that to the best of his/her knowledge and belief, no other person, firm, corporation, association, or other legal entity, except members, has the right to use the mark in commerce that the U.S. Congress can regulate either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods or services of such other person, firm, corporation, association, or other legal entity, to cause confusion, or to cause mistake, or to deceive. [37 C.F.R. §2.44\(a\)\(4\)\(v\)](#); see [15 U.S.C. §§1051\(b\)\(3\)\(B\)](#), [1054](#). For a collective trademark or collective service mark application, the required verified statement is not part of the international registration on file at the International Bureau of the World Intellectual Property Organization (“IB”); therefore, the examining attorney must require the verified statement during examination. See [37 C.F.R. §2.44\(b\)\(2\)](#).

See [TMEP § 1303.01\(b\)\(ii\)](#) for additional information regarding the requirements for the verified statement in applications under §66(a) of the Trademark Act.

A §66(a) applicant may not change the basis or claim more than one basis unless the applicant meets the requirements for transformation under §70(c) of the Act. [37 C.F.R. §§2.35\(a\), 2.44\(c\)](#). See [TMEP §§1904.09–1904.09\(b\)](#) regarding the limited circumstances under which a §66(a) application may be transformed into an application under §1 or §44.

Section 66(a) requires transmission of a request for extension of protection by the IB to the USPTO. Such basis may not be added or substituted as a basis in an application originally filed under §1 or §44.

Under [15 U.S.C. §1141g](#), Madrid Protocol Article 4(2), and [37 C.F.R. §7.27](#), the §66(a) applicant may claim a right of priority within the meaning of Article 4 of the Paris Convention if:

- (1) The request for extension of protection contains a claim of priority;
- (2) The request for extension of protection specifies the filing date, serial number, and the country of the application that forms the basis for the claim of priority; *and*
- (3) The date of international registration or the date of the recordal of the subsequent designation requesting an extension of protection to the United States is not later than six months after the date of the first regular national filing (within the meaning of Article 4(A)(3) of the Paris Convention) or a subsequent application (within the meaning of Article 4(C)(4) of the Paris Convention).

*See* Regs. Rule 9(4)(a)(iv).

### **1303.01(a)(vi) Multiple Bases, Amending/Deleting the Basis, Review of Basis Prior to Publication/Issue**

The procedures for examining an application with multiple bases, amending or deleting a basis, and reviewing the basis information prior to publication or issuance of a registration are the same as for trademark and service mark applications. See [TMEP §806.02](#) for information about multiple bases, [§806.03](#) regarding amending the basis, [§806.04](#) regarding deleting a basis, and [§806.05](#) regarding review of a basis prior to publication or issue.

### **1303.01(b) Verification of Certain Statements**

An application must include certain statements that are verified by the applicant or by someone who is authorized to verify facts on behalf of an applicant. See [15 U.S.C. §1051\(a\)\(3\), \(b\)\(3\)](#); [37 C.F.R. §§2.44\(a\)\(4\)\(i\)\(D\), \(a\)\(4\)\(ii\), \(a\)\(4\)\(iii\)\(B\), \(a\)\(4\)\(iv\)\(B\), \(a\)\(4\)\(v\), 2.193\(e\)\(1\)](#); [TMEP §1303.01\(b\)\(i\) - \(b\)\(ii\)](#).

In an application under §1 or §44 of the Trademark Act, a signed verification is not required for receipt of an application filing date under [37 C.F.R. §2.21\(a\)](#). If the initial application does not include a proper verified statement, the examining attorney must require the applicant to submit a verified statement that relates back to the original filing date. See [TMEP §§804.01–804.01\(b\)](#) regarding the form of the oath or declaration, [TMEP §1303.01\(b\)\(i\)](#) regarding the essential allegations required to verify an application for registration of a mark, and [TMEP §804.04](#) regarding persons properly authorized to sign a verification on behalf of an applicant.

In §66(a) applications, the verified statement is *not* part of the international registration on file at the IB; therefore the examining attorney must require the verified statement during examination. See [37 C.F.R. §2.44\(a\)\(4\)\(v\), TMEP §§804.05, 1303.01\(b\)\(ii\), 1904.01\(c\)](#).

### **1303.01(b)(i) Statements Required in Verification of Application for Registration - §1 or §44 Application**

The requirements for the verified statement in applications under §1 or §44 of the Trademark Act are set forth in [37 C.F.R. §§2.44\(a\)\(4\)\(i\)–\(iv\)](#). See [15 U.S.C. §§1051\(a\)\(3\)](#), [1051\(b\)\(3\)](#), [1054](#), [1126](#). These allegations are required regardless of whether the verification is in the form of an oath ([TMEP §804.01\(a\)](#)) or a declaration ([TMEP §804.01\(b\)](#)). See [TMEP §1303.01\(b\)\(ii\)](#) regarding the requirements for verification of a §66(a) application. See [TMEP §§1303.01\(a\)–\(a\)\(iv\)](#) for further information regarding filing-basis requirements, including the verified statement.

*Truth of Facts Recited* . Under [15 U.S.C. §§1051\(a\)\(3\)\(B\)](#) and [1051\(b\)\(3\)\(C\)](#), verification of an application for registration must include an allegation that “to the best of the verifier’s knowledge and belief, the facts recited in the application are accurate.” The language in [37 C.F.R. §2.20](#) that “all statements made of [the signatory’s] own knowledge are true and all statements made on information and belief are believed to be true” satisfies this requirement. See [37 C.F.R. §§2.44\(a\)\(4\)\(i\)\(D\)](#), [\(a\)\(4\)\(ii\)](#), [\(a\)\(4\)\(iii\)\(B\)](#), [\(a\)\(4\)\(iv\)\(B\)](#).

*Use in Commerce and Exercising Legitimate Control* . If the filing basis is §1(a), the applicant must submit a verified statement that the mark is in use in commerce and that the applicant is exercising legitimate control over the use of the mark in commerce. [37 C.F.R. §2.44\(a\)\(4\)\(i\)\(D\)](#). If this verified statement is not filed with the original application, it must also allege that, *as of the application filing date* , the mark was in use in commerce and the applicant was exercising legitimate control over the use of the mark in commerce. [37 C.F.R. §2.44\(b\)\(2\)](#).

*Bona Fide Intention and Entitlement to Exercise Legitimate Control* . If the filing basis is §1(b), §44(d), or §44(e), the applicant must submit a verified statement that the applicant has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce, and that to the best of the signatory’s knowledge and belief, no other persons, except members, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods or services of such other persons to cause confusion or mistake, or to deceive. [37 C.F.R. §2.44\(a\)\(4\)\(ii\)](#), [\(a\)\(4\)\(iii\)\(B\)](#), [\(a\)\(4\)\(iv\)\(B\)](#). If this verified statement is not filed with the original application, it must also allege that, *as of the application filing date* , the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce. [37 C.F.R. §2.44\(b\)\(2\)](#).

*Ownership* . In an application based on §1(a), the verified statement must allege that the applicant *believes the applicant is the owner of the mark* , and that to the best of the signatory’s knowledge and belief, no other persons, except members, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods or services of such other persons to cause confusion or mistake, or to deceive. [37 C.F.R. §2.44\(a\)\(4\)\(i\)\(D\)](#); see [15 U.S.C. §1051\(a\)\(3\)\(A\)](#), [\(a\)\(3\)\(D\)](#).

*Concurrent Use* . The verification for concurrent use should be modified to indicate an exception that no other persons *except members and the concurrent user(s)* as specified in the application have the right to use the mark in commerce. [37 C.F.R. §2.44\(d\)](#); see [15 U.S.C. §1051\(a\)\(3\)\(D\)](#). See TMEP §1207.04(d)(ii) for concurrent use application requirements for a collective mark.

*Affirmative, Unequivocal Averments Based on Personal Knowledge Required*. The verification must include affirmative, unequivocal averments that meet the requirements of the Act and the rules. Statements such as “the undersigned [person signing the declaration] has been informed that the mark is in use in commerce [or has been informed that applicant has a bona fide intention, and is entitled, to exercise legitimate control

over the use of the mark in commerce] . . .,” or wording that disavows the substance of the declaration, are unacceptable.

*Verification Not Filed Within Reasonable Time* . If the verified statement is not filed within a reasonable time after it is signed, the examining attorney will require the applicant to submit a substitute verified statement attesting that, as of the application filing date, the mark was in use in commerce and the applicant was exercising legitimate control over the use of the mark in commerce (in an application based on §1(a)); or, as of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce (in an application based on §1(b) or §44). [37 C.F.R. §2.44\(b\)\(1\)](#). See [TMEP §804.03](#) for information regarding time between execution and filing of documents.

*Substitute Verification* . If the verified statement does not include all the necessary averments, the examining attorney will require a substitute or supplemental affidavit or declaration under [37 C.F.R. §2.20](#).

### **1303.01(b)(ii) Statements Required in Verification of Application for Registration - §66(a) Application**

For a collective trademark or collective service mark in a §66(a) application, the verified statement is not part of the international registration on file at the IB; therefore, the examining attorney must require the verified statement during examination. See [37 C.F.R. §2.44\(b\)\(2\)](#).

Thus, in applications under §66(a) of the Act, the applicant must supplement the request for extension of protection to the United States to include a declaration that the applicant has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce that the U.S. Congress can regulate on or in connection with the goods or services specified in the international application/subsequent designation. [37 C.F.R. §2.44\(a\)\(4\)\(v\)](#). The declaration must include a statement that the signatory is properly authorized to execute the declaration on behalf of the applicant and that to the best of his/her knowledge and belief, no other person, firm, corporation, association, or other legal entity, except members, has the right to use the mark in commerce that the U.S. Congress can regulate, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, firm, corporation, association, or other legal entity, to cause confusion, or to cause mistake, or to deceive. [37 C.F.R. 2.44\(a\)\(4\)\(v\)](#); see [15 U.S.C. §1141\(f\)\(a\)](#).

Additionally, because the verified statement is not included with the initial application, the verified statement must also allege that, *as of the application filing date* , the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce. [37 C.F.R. §2.44\(b\)\(2\)](#).

See [TMEP § 1303.01\(a\)\(v\)](#) for further information regarding filing basis requirements, including the verified statement.

### **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. See [15 U.S.C. §1054](#). Thus, the same standards generally applicable to trademarks and service marks are used in considering issues such as descriptiveness, disclaimers, likelihood of confusion, and deceptiveness. However, use (specimens) and ownership requirements are slightly different due to the nature of collective marks. See [TMEP §§1303.01\(a\)\(i\)–\(a\)\(v\)](#). See [TMEP](#)

[§1303.01\(a\)\(i\)\(C\)](#) regarding specimens for collective marks. See [TMEP §1207.04](#) for information regarding a concurrent use registration.

### **1303.02(a) Ownership Considerations**

Under the definition of “collective mark” in §45 of the Trademark Act, a collective mark must be owned by a collective entity. [15 U.S.C. §1127](#). The use of a collective trademark or collective service mark is by members of the collective, but no member may own the collective mark. That is, application may not be made by a mere member. 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.

### **1303.02(b) Likelihood of Confusion**

Likelihood of confusion may arise from the contemporaneous use, by one party, of a collective trademark or collective service 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 marks. See [15 U.S.C. §1052\(d\)](#); cf. *In re Nat’l Novice Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984); *Allstate Life Ins. Co. v. Cuna Int’l, Inc.*, 169 USPQ 313 (TTAB 1971), aff’d, 487 F.2d 1407, 180 USPQ 48 (C.C.P.A. 1973).

The finding of likelihood of confusion between a collective trademark or collective service mark and a trademark or service mark is not based on confusion as to the source of any goods or services 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. Cf. *In re Code Consultants Inc.*, 60 USPQ2d 1699, 1701 (TTAB 2001).

## **1304 Collective Membership Marks**

### **1304.01 Collective Membership Marks Generally**

The sole purpose of a collective membership mark is to indicate that the user of the mark is a member of a particular organization. See *Constitution Party of Tex. v. Constitution Ass’n USA*, 152 USPQ 443 (TTAB 1966) (holding cancellation of collective membership mark registration proper since mark was not being used to indicate membership in registrant).

Thus, 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 still wish to protect their marks from 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.

A collective membership mark may comprise an individual letter or combination of letters, a single word or combination of 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 the mark 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 lapel pins or rings. See [TMEP §1304.02\(a\)\(i\)](#) and [§1304.02\(a\)\(i\)\(C\)](#) regarding use of membership marks and acceptable specimens.

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, but the same mark may not be used both as a membership mark and as a certification mark for the same goods or services. [37 C.F.R. §2.45\(f\)](#); [TMEP §1306.04\(f\)](#).

See [TMEP §1302.01](#) regarding the history of collective membership marks.

## 1304.02 Application Requirements for Collective Membership Marks

Under [37 C.F.R. §2.44](#), a complete application for a collective membership mark must include the following:

- (1) the legal name and physical address of the applicant (*see* [TMEP §§803.02, 803.05](#));
- (2) the applicant's legal entity type (*see* [TMEP §803.03](#));
- (3) the applicant's citizenship or the jurisdiction under whose laws the applicant is organized, and if the applicant is a domestic partnership or joint venture, the names and citizenship of the general partners or active members of the joint venture (*see* [TMEP §§803.03\(b\), 803.04](#)), or if applicant is a sole proprietorship, the U.S. state or foreign country of its organization and the name and citizenship of the sole proprietor ([37 C.F.R. §2.32\(a\)\(3\)\(v\)](#), [TMEP §§803.03\(a\), 803.04](#));
- (4) a description of the mark if the mark is not in standard characters (*see* [TMEP §808](#));
- (5) a translation/transliteration of any foreign wording in the mark (*see* [TMEP §809](#));
- (6) a drawing of the mark sought to be registered (*see* [TMEP §807](#));
- (7) a filing fee (*see* [TMEP §810](#));
- (8) a description of the nature of the membership organization such as by type, purpose, or area of activity of the members (*see* [TMEP §1304.02\(c\)](#));
- (9) classification in U.S. Class 200 for a §1 or §44 application, or the classification assigned by the IB for a §66(a) application (*see* [TMEP §1304.02\(d\)](#)); and
- (10) a filing basis (*see* [TMEP §§1304.02\(a\)-\(a\)\(vi\)](#)), including verification of certain statements signed by the applicant or a person properly authorized to sign on behalf of the applicant (*see* [TMEP §§1304.02\(b\)-\(b\)\(ii\)](#)).

[37 C.F.R. §2.44\(a\)\(1\), \(a\)\(2\)\(ii\), \(a\)\(3\)\(ii\), \(a\)\(4\)](#).

*Requirements that differ in form from those in trademark or service mark applications.* Most application requirements for collective membership marks are the same as those for regular trademarks and service marks. However, the filing basis, verification, identification, and classification requirements for collective membership mark applications differ in form from other trademark and service mark applications because of the difference between who owns and uses collective membership marks. See [TMEP §§1304.02\(a\)-\(a\)\(v\)](#) for information regarding filing basis requirements, [§§1304.02\(b\)-\(b\)\(ii\)](#) for information regarding the verification of certain statements, [§1304.02\(c\)](#) for identification requirements, and [§1304.02\(d\)](#) for classification requirements in collective membership mark applications.

See [TMEP Chapter 1600](#) for post-registration requirements.

## 1304.02(a) Filing Basis

See [TMEP §1303.01\(a\)](#) for information regarding an application filing basis for a collective trademark or collective service mark. These requirements apply similarly to collective membership marks.

For a list of the requirements pertaining to each filing basis, see [37 C.F.R. §2.44\(a\)\(4\)](#) and [TMEP §§1304.02\(a\)\(i\)–\(v\)](#).

### 1304.02(a)(i) Use in Commerce – §1(a)

Registration of a collective membership mark under Trademark Act §1(a) 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 its members. See *In re Mission Am. Coal.*, 2023 USPQ2d 228, at \*12 (TTAB 2023) (collective membership mark refused because specimen showed use of the mark by applicant’s officer and not its members); *In re Triangle Club of Princeton Univ.*, 138 USPQ 332, 332-33 (TTAB 1963) (collective membership mark refused because specimen did not show use of the mark by its members).

Under [15 U.S.C. §1051\(a\)](#), [§1054](#), and [37 C.F.R. §2.44\(a\)\(4\)\(i\)](#), to establish a basis under §1(a), the applicant must:

- (1) Submit a statement specifying the nature of the applicant’s control over the use of the mark by the members ([37 C.F.R. §2.44\(a\)\(4\)\(i\)\(A\)](#));
- (2) Specify the date of the applicant’s members’ first use of the mark anywhere to indicate membership in the collective organization ([37 C.F.R. §2.44\(a\)\(4\)\(i\)\(B\)](#));
- (3) Specify the date of the applicant’s members’ first use of the mark in commerce (*Id.*);
- (4) Submit one specimen for each class, showing how a member uses the mark in commerce to indicate membership in the collective organization ([37 C.F.R. §§2.44\(a\)\(4\)\(i\)\(C\)](#), [2.56\(b\)\(4\)](#)); and
- (5) Submit a verified statement that the applicant believes the applicant is the owner of the mark; that the mark is in use in commerce; that the applicant is exercising legitimate control over the use of the mark in commerce; that to the best of the signatory’s knowledge and belief, no other persons except members have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the collective membership organization of such other persons, to cause confusion or mistake, or to deceive; that the specimen shows the mark as used in commerce by the applicant’s members; and that the facts set forth in the application are true ([15 U.S.C. §§1051\(a\)\(3\)\(C\)](#), [1054](#); [37 C.F.R. §2.44\(a\)\(4\)\(i\)\(D\)](#)). See [TMEP §1304.02\(b\)\(i\)](#) for additional information regarding the requirements for the verified statement in applications under §1(a).

The Trademark Act defines “commerce” as commerce that may lawfully be regulated by the U.S. Congress, and “use in commerce” as the bona fide use of a mark in the ordinary course of trade. [15 U.S.C. §1127](#); see [TMEP §§901–901.04](#).

An applicant may not assert both §1(a) and §1(b) for the same collective membership organization in the same application. [37 C.F.R. §2.44\(c\)](#); see [TMEP §806.02\(b\)](#).

Nothing in the Trademark Act prohibits the use of the same mark as a collective membership mark by members and, also, as a trademark or service mark by the parent organization (see [TMEP §1303.01](#)), but

the same mark may not be used both as a collective membership mark and as a certification mark for the same goods or services. [37 C.F.R. §2.45\(f\)](#); [TMEP §1306.04\(f\)](#).

### **1304.02(a)(i)(A) Manner/Method of Control**

See [TMEP § 1303.01\(a\)\(i\)\(A\)](#) for information regarding the requirement for a Manner/Method of Control statement for a collective trademark or collective service mark. This requirement applies similarly to collective membership marks.

### **1304.02(a)(i)(B) Dates of Use**

When setting out dates of use of a collective membership mark, the applicant must state that the mark was first used by a member 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.

The date of first use anywhere is the date when an applicant's member first indicates membership in the collective organization under the mark, if such use is bona fide and in the ordinary course of trade. See [15 U.S.C. §1127](#) (definition of "use" within the definition of "abandonment of mark"). For every applicant, whether foreign or domestic, the date of first use of a mark is the date of the first use anywhere, in the United States or elsewhere, regardless of whether the nature of the use was local or national, intrastate or interstate, or of another type.

The date of first use in commerce is the date when an applicant's member first indicates membership in the collective organization under the mark in a type of commerce that may be lawfully regulated by the U.S. Congress, if such use is bona fide and in the ordinary course of trade. See [15 U.S.C. §1127](#) (definition of "use" within the definition of "abandonment of mark"). See [TMEP §901.01](#) for definitions of "commerce" and "use in commerce," and [§901.03](#) regarding types of commerce.

In a §1(a) application, the applicant may not specify a date of use that is later than the filing date of the application. If an applicant who filed under §1(a) cannot show that a member used the mark in commerce on or before the application filing date, the applicant may amend the basis to §1(b). See [37 C.F.R. §2.35\(b\)\(1\)](#). See [TMEP §806.03](#) regarding amendments to the basis.

Neither a date of first use nor a date of first use in commerce is required to receive a filing date in an application based on use in commerce under §1(a) of the Act. If the application does not include a date of first use and/or a date of first use in commerce, the examining attorney must require that the applicant specify the date of first use and/or date of first use in commerce. See [37 C.F.R. §2.44\(a\)\(4\)\(i\)\(B\)](#). The dates must be supported by an affidavit or declaration under [37 C.F.R. §2.20](#). See [37 C.F.R. §§2.44\(a\)\(4\)\(i\)\(B\), 2.71\(c\)](#).

An applicant may not file an application on the basis of use of a mark in commerce if such use has been discontinued.

### **1304.02(a)(i)(C) Specimens**

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. Therefore, a proper 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 Mission Am. Coal.*, 2023 USPQ2d 228, at \*4, \*12 (TTAB 2023); *In re Int'l Ass'n for Enterostomal*

*Therapy, Inc.*, 218 USPQ 343, 345 (TTAB 1983); *In re Triangle Club of Princeton Univ.*, 138 USPQ 332, 332-33 (TTAB 1963).

The most common types of specimens are membership cards and certificates. The applicant may submit as a specimen 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 Univ.*, 138 USPQ at 332. 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 specimen of use. See *In re Inst. for Certification of Comput. Pros.*, 219 USPQ 372, 373 (TTAB 1983) (in view of contradictory evidence in record, specimen with nothing more than CCP on it was not considered evidence of membership); *In re Mountain Fuel Supply Co.*, 154 USPQ 384, 384 (TTAB 1967) (design on specimen did not indicate membership in organization, but merely showed length of service).

Shoulder, sleeve, pocket, or similar patches, or lapel pins, 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. See *In re Mission Am. Coal.*, 2023 USPQ2d 228, at \*4, \*12 (collective membership mark refused because specimen showed use of the mark by applicant's officer and not its members). Collective organizations often publish various kinds of printed material, such as catalogs, directories, bulletins, newsletters, magazines, programs, and the like. Placement of 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.

See [TMEP §904.07\(a\)](#) regarding whether a trademark or service mark specimen shows the mark used in commerce.

See [TMEP §1304.03\(b\)](#) regarding specimen refusals specific to collective membership marks.

### **1304.02(a)(ii) Intent to Use – §1(b)**

See [TMEP §1303.01\(a\)\(ii\)](#) for information regarding an intent-to-use filing basis for a collective trademark or collective service mark. These requirements apply similarly to collective membership marks, with the only difference being that the verified statement refers to a collective membership organization rather than goods or services.

**1304.02(a)(iii) Foreign Priority – §44(d)**

See [TMEP §1303.01\(a\)\(iii\)](#) for information regarding a §44(d) filing basis for a collective trademark or collective service mark. These requirements apply similarly to collective membership marks, with the only difference being that the verified statement refers to a collective membership organization rather than goods or services.

**1304.02(a)(iv) Foreign Registration – §44(e)**

See [TMEP §1303.01\(a\)\(iv\)](#) for information regarding a §44(e) filing basis for a collective trademark or collective service mark. These requirements apply similarly to collective membership marks, with only two differences. First, the verified statement refers to a collective membership organization rather than goods or services. Second, the scope of the nature of the collective membership organization covered by the §44 basis in the U.S. application may not exceed the scope of the nature of the collective membership organization identified in the foreign application or registration. [37 C.F.R. §2.44\(a\)\(2\)\(iii\)](#); [TMEP §1402.01\(b\)](#).

**1304.02(a)(iv)(A) Scope of Foreign Registration**

See [TMEP §1303.01\(a\)\(iv\)\(A\)](#) for information regarding the scope of a foreign registration for a collective trademark or collective service mark. This information applies similarly to collective membership marks.

**1304.02(a)(v) Extension of Protection of International Registration – §66(a)**

See [TMEP §1303.01\(a\)\(v\)](#) for information regarding a §66(a) filing basis for a collective trademark or collective service mark. These requirements apply similarly to collective membership marks, with the only difference being that the verified statement refers to a collective membership organization rather than goods or services.

**1304.02(a)(vi) Multiple Bases, Amending/Deleting the Basis, Review of Basis Prior to Publication/Issue**

The procedures for examining an application with multiple bases, amending or deleting a basis, and reviewing the basis information prior to publication or issuance of a registration are the same as for trademark and service mark applications. See [TMEP §806.02](#) for information about multiple bases, [§806.03](#) regarding amending the basis, [§806.04](#) regarding deleting a basis, and [§806.05](#) regarding review of a basis prior to publication or issue.

**1304.02(b) Verification of Certain Statements**

See [TMEP §1303.01\(b\)](#) for information about the verification of certain statements for a collective trademark or collective service mark. These requirements apply similarly to collective membership marks, except for the statement regarding the applicant's bona fide intent and entitlement to exercise legitimate control and the applicant's ownership statement.

### **1304.02(b)(i) Statements Required in Verification of Application for Registration - §1 or §44 Application**

See [TMEP §1303.01\(b\)\(i\)](#) for information about the requirements for the verified statement in applications under §1 or §44 for a collective trademark or collective service mark. These requirements apply similarly to collective membership marks. The two exceptions are the following requirements, which differ only in form.

*Bona Fide Intention and Entitlement to Exercise Legitimate Control* . If the filing basis is §1(b), §44(d), or §44(e), the applicant must submit a verified statement that the applicant has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce, and that to the best of the signatory's knowledge and belief, no other persons, except members, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used in connection with the collective membership organization of such other persons, to cause confusion or mistake, or to deceive. [37 C.F.R. §2.44\(a\)\(4\)\(ii\)](#), [\(a\)\(4\)\(iii\)\(B\)](#), [\(a\)\(4\)\(iv\)\(B\)](#). If this verified statement is not filed with the original application, it must also allege that, *as of the application filing date* , the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce. [37 C.F.R. §2.44\(b\)\(2\)](#).

*Ownership* . In an application based on §1(a), the verified statement must allege that the applicant *believes the applicant is the owner of the mark* , and that to the best of the signatory's knowledge and belief, no other persons, except members, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used in connection with the collective membership organization of such other persons, to cause confusion or mistake, or to deceive. [37 C.F.R. §2.44\(a\)\(4\)\(i\)\(D\)](#); *see* [15 U.S.C. §§1051\(a\)\(3\)\(A\)](#), [1051\(a\)\(3\)\(D\)](#).

See [TMEP §§1304.02\(a\) - \(a\)\(iv\)](#) for further information regarding filing-basis requirements, including the verified statement.

### **1304.02(b)(ii) Statements Required in Verification of Application for Registration - §66(a) Application**

For a collective membership mark in a §66(a) application, the verified statement is *not* part of the international registration on file at the IB; therefore, the examining attorney must require the verified statement during examination. *See* [37 C.F.R. §2.44\(b\)\(2\)](#).

In applications under §66(a) of the Act, the applicant must supplement the request for extension of protection to the United States to include a declaration that the applicant has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce that the U.S. Congress can regulate to indicate membership in the collective organization. [37 C.F.R. §2.44\(a\)\(4\)\(v\)](#). The declaration must include a statement that the signatory is properly authorized to execute the declaration on behalf of the applicant and that to the best of his/her knowledge and belief, no other person, firm, corporation, association, or other legal entity, except members, has the right to use the mark in commerce that the U.S. Congress can regulate either in the identical form thereof or in such near resemblance thereto as to be likely, when used in connection with the collective membership organization of such other person, firm, association, or other legal entity, to cause confusion, or to cause mistake, or to deceive. [37 C.F.R. 2.44\(a\)\(4\)\(v\)](#); *see* [15 U.S.C. §1141\(f\)\(a\)](#).

Additionally, because the verified statement is not included with the initial application, the verified statement must also allege that, *as of the application filing date*, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce. [37 C.F.R. §2.44\(b\)\(2\)](#).

See [TMEP § 1303.01\(a\)\(v\)](#) for further information regarding filing-basis requirements, including the verified statement.

### **1304.02(c) Identification of Nature of Collective Membership Organization**

The purpose of a collective membership mark is to indicate membership in an organization; therefore, an identification of goods or services would not be appropriate in connection with a collective membership mark. More accurate identification language would be “indicating membership in an organization (association, club, or the like) . . .,” followed by a phrase indicating the nature of the organization or association, for example, “indicating membership in an organization of computer professionals” or “indicating membership in a motorcycle club.”

The nature of an organization can be indicated by specifying the area of activity of its members (e.g., they may sell lumber, cosmetics, or food, or may deal in chemical products or household goods, or provide services as fashion designers, 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.

### **1304.02(d) Classification**

*Section 1 and §44 Applications*. In applications under §1 or §44 of the Trademark Act, collective membership marks are classified in U.S. Class 200. [37 C.F.R. §6.4](#). U.S. 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 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 Trademark 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 U.S. Class 200.

*Section 66(a) Applications*. A §66(a) application may indicate that the mark is a “Collective, Certificate or Guarantee Mark” or the identification may indicate that the mark is intended to indicate membership. In such cases, the examining attorney will require the applicant to clarify for the record the type of mark for which it seeks protection. The examining attorney must also require the applicant to comply with the requirements for the particular type of mark, i.e., collective trademark, collective service mark, collective membership mark, or certification mark. See [TMEP §§1303–1303.02\(b\)](#) regarding collective trademarks and collective service marks, [§§1304–1304.03\(c\)](#) regarding collective membership marks, and [§§1306–1306.06\(c\)](#) regarding certification marks.

If a §66(a) applicant indicates that the mark is a collective membership mark, the USPTO will not reclassify it into U.S. Class 200 because the classification of such applications may not be changed from that assigned by the International Bureau of the World Intellectual Property Organization (IB). [TMEP §§1401.03\(d\)](#),

[1904.02\(b\)](#). However, the examining attorney must ensure that the applicant complies with all other U.S. requirements for collective membership marks. See [TMEP §§1304–1304.03\(c\)](#).

### **1304.03 Examination of Collective Membership Mark Applications**

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](#).

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. See *Racine Indus. Inc. v. Bane-Clene Corp.*, 35 USPQ2d 1832, 1837 (TTAB 1994) ; *In re Ass'n of Energy Eng'rs, Inc.*, 227 USPQ 76, 77 (TTAB 1985) ; *In re Int'l Ass'n for Enterostomal Therapy, Inc.*, 218 USPQ 343 (TTAB 1983) . However, use (specimens) and ownership requirements are slightly different due to the nature of collective membership marks indicating membership rather than commercial origin.

See [TMEP §1207.04](#) for information regarding seeking a concurrent use registration.

#### **1304.03(a) Ownership Considerations**

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.”

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 Eng'g Corp.*, 170 USPQ 292 (TTAB 1971) .

To apply to register a collective membership mark, the collective organization which owns the mark must be a person capable of suing and being sued in a court of law. See [15 U.S.C. §1127](#); [TMEP §803.01](#). The persons who compose a collective group may be either natural or juristic persons.

Application to register a membership mark must be made by the organization or person (including juristic persons) that controls or intends to control the use of the mark by the members and, therefore, owns or is entitled to use the mark. See [15 U.S.C. §1054](#); *In re Stencel Aero Eng'g Corp.*, 170 USPQ 292 (TTAB 1971) . Application may not be made by a mere member.

## 1304.03(b) Specimen Refusals Specific to Collective Membership Marks

### 1304.03(b)(i) Matter that Does Not Function as a Membership Mark

Whether 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 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) (holding that use of Greek letter abbreviations on athletic jerseys did not function as collective membership marks indicating membership in Greek letter societies); *In re Mountain Fuel Supply Co.*, 154 USPQ 384 (TTAB 1967) (holding that the design on a jewelry pin merely indicated longevity of service rather than membership in a collective organization). If a proposed mark does not function as a mark indicating membership, the examining attorney must refuse registration under §§1, 2, 4, and 45 of the Trademark Act, [15 U.S.C. §§1051, 1052, 1054, 1127](#). *See* [TMEP §1304.03\(b\)\(ii\)](#) regarding specimens showing use as degrees or titles. *See* [TMEP §904.07\(b\)](#) for information about matter that fails to function as a trademark or service mark.

### 1304.03(b)(ii) Degree or Title Designations

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 Int'l Inst. 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 organization); *see also In re Nat'l Soc'y of Cardiopulmonary Technologists, Inc.*, 173 USPQ 511 (TTAB 1972); *cf. In re Thacker*, 228 USPQ 961 (TTAB 1986); *In re Nat'l Ass'n of Purchasing Mgmt.*, 228 USPQ 768 (TTAB 1986); *In re Mortg. Bankers Ass'n of Am.*, 226 USPQ 954 (TTAB 1985).

If the proposed mark functions merely as a degree or title, the examining attorney must refuse registration under §§1, 2, 4, and 45 of the Trademark Act, [15 U.S.C. §§1051, 1052, 1054, 1127](#), on the ground that the matter does not function as a collective membership mark. *See* [TMEP §1304.03\(b\)\(i\)](#).

### 1304.03(c) Likelihood of Confusion

Likelihood of confusion may arise from the contemporaneous use, by one party, 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 Nat'l Novice Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984); *Allstate Life Ins. Co. v. Cuna Int'l, Inc.*, 169 USPQ 313 (TTAB 1971), *aff'd*, 487 F.2d 1407, 180 USPQ 48 (C.C.P.A. 1973).

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 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 or are endorsed by or are in some other way associated with the collective organization." *Pierce-Arrow Soc'y v. Spintek Filtration, Inc.*, 2019 USPQ2d 471774, at \*8-9 (TTAB 2019) (quoting *Carefirst of Md., Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492,

1513 (TTAB 2005)); *In re Code Consultants Inc.*, 60 USPQ2d 1699, 1701 (TTAB 2001) . For purposes of Section 2(d), the identification of goods or services is used to determine the relevant consuming public. *Pierce-Arrow Soc’y*, 2019 USPQ2d 471774, at \*9 (citing *In re Gulf Coast Nutritionals, Inc.*, 106 USPQ2d 1243, 1247 (TTAB 2013)). Relevant purchasers for a collective membership mark consist of “those persons or groups of persons for whose benefit the membership mark is displayed.” *Id.* (citing *Carefirst of Md., Inc.*, 77 USPQ2d at 1513).

### **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 Co. v. Nat’l Coops., 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 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 Types of Certification Marks**

Section 4 of the Trademark Act, provides for the registration of “certification marks, including indications of regional origin,” which are defined in Section 45 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.

[15 U.S.C. §§1054, 1127.](#)

Based on the statute, there are generally three types of certification marks, that is, those that certify:

1. *Geographic origin.* Certification marks may be used to certify that authorized users' goods or services originate in a specific geographic region (e.g., ROQUEFORT for cheese). See *Cnty. of Roquefort v. William Faehndrich, Inc.*, 303 F.2d 494, 133 USPQ 633 (2d Cir. 1962) (ROQUEFORT for cheese from a municipality in France); *State of Fla., Dep't of Citrus v. Real Juices, Inc.*, 330 F. Supp. 428, 171 USPQ 66 (M.D. Fla. 1971) (SUNSHINE TREE for citrus from Florida); *Bureau Nat'l Interprofessionnel Du Cognac v. Int'l Better Drinks Corp.*, 6 USPQ2d 1610 (TTAB 1988) (COGNAC for distilled brandy from a region in France); [TMEP §1306.05–1306.05\(j\)](#).
2. *Standards met with respect to quality, materials, or mode of manufacture.* Certification marks may be used to certify that authorized users' 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 Labs. 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 Corp. of Am.*, 136 USPQ 86 (TTAB 1962) (CELANESE certifies plastic toys meeting certifier's safety standards).
3. *Work/labor performed by member or that worker meets certain standards.* Certification marks may also be used to certify that authorized users' 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 §1306.04\(d\)\(ii\)](#) and cases cited therein for further information.

*Differences between certification marks and trademarks or service marks.* Two characteristics differentiate certification marks from trademarks or service marks: first, a certification mark is not used by its owner but rather by authorized users and, second, a certification mark does not indicate commercial source or distinguish the goods or services of one person from those of another person but rather indicates that the goods/services of authorized users are certified as to a particular aspect of the goods/services. See [TMEP §1306.06\(a\)](#) for a discussion of the distinction between a certification mark and a collective trademark, collective service mark, or collective membership mark.

### **1306.01(a) Use Is by Person Other than Owner of Certification Mark**

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 §1306.03\(b\)](#) 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**

A certification mark “is a special creature created for a purpose uniquely different from that of an ordinary service mark or trademark . . .” *In re Fla. Citrus Comm'n*, 160 USPQ 495, 499 (TTAB 1968). That is, 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 the way a trademark or service mark does. Rather, the same certification 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, using methods determined by the certifier/owner. The placing of the mark on goods, or its use in connection with services, thus constitutes a certification by someone other than the producer that the prescribed characteristics or qualifications of the certifier for those goods or services have been met.

### **1306.01(c) Identifying Certification Mark Applications**

If the applicant has used the appropriate application form, the application will clearly indicate that the mark is intended to be a certification mark and should include the required elements. For certification mark applications based on §66(a) of the Trademark Act, the request for extension of protection will include a field indicating that the mark is a “Collective, Certificate or Guarantee Mark.” See [TMEP §1904.02\(d\)](#) regarding requirements for §66(a) applications for certification and collective marks.

The examining attorney may also determine that the mark is a certification mark based on a review of the information in the application, which should include a certification statement or language indicating the mark’s use, or intended use, to certify some aspect of the goods or services, such as certifying regional origin, or that the labor was performed by a certain group, or that the goods or services meet certain safety standards. If the nature of the mark and its intended use are unclear, the examining attorney must seek clarification, through a Trademark Rule 2.61(b) requirement for additional information or, if appropriate, by telephone or email communication. See [37 C.F.R. §2.61\(b\)](#); [TMEP §§1306.04\(b\)\(ii\)](#), [TMEP §1306.06-1306.06\(b\)](#). Any clarification regarding the certification statement that is received by informal communication must be recorded in a Note to the File. In addition, if certain required elements, such as those discussed in [TMEP §1306.03](#), are missing or unacceptable, the applicant will be required to provide or amend them.

### **1306.02 Application Requirements for a Certification Mark**

Under [37 C.F.R. §2.45](#), a complete application for a certification mark must include the following:

- (1) the legal name and physical address of the applicant (see [TMEP §§803.02](#), [803.05](#));
- (2) the applicant’s legal entity type (see [TMEP §803.03](#));
- (3) the applicant’s citizenship or the jurisdiction under whose laws the applicant is organized, and if the applicant is a domestic partnership or joint venture, the names and citizenship of the general partners or active members of the joint venture (see [TMEP §§803.03\(b\)](#), [803.04](#)), or if applicant is a sole proprietorship, the U.S. state or foreign country of its organization and the name and citizenship of the sole proprietor ([37 C.F.R. §2.32\(a\)\(3\)\(v\)](#), [TMEP §§803.03\(a\)](#), [803.04](#));
- (4) a description of the mark if the mark is not in standard characters (see [TMEP §808](#));
- (5) a translation/transliteration of any foreign wording in the mark (see [TMEP §809](#));
- (6) a drawing of the mark sought to be registered (see [TMEP §807](#));
- (7) a filing fee (see [TMEP §810](#));
- (8) a filing basis (see [TMEP §1306.02\(a\)-\(a\)\(vi\)](#)), including:

- (a) verification of certain statements signed by the applicant or a person properly authorized to sign on behalf of the applicant (*see* [TMEP §§1306.02\(b\)-\(b\)\(ii\)](#));
  - (b) a statement specifying what the applicant is (or will be) certifying about the goods or services (*see* [TMEP §1306.03\(a\)](#));
  - (c) a copy of the certification standards governing use of the certification mark on or in connection with the goods or services (*see* [TMEP §1306.03\(b\)](#)) (required for Section 1(a) applicants only); and
  - (d) a statement that the applicant is not engaged (or will not engage) in the production or marketing of the goods or services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods or services that meet the certification standards of the applicant (*see* [TMEP § 1306.03\(c\)](#));
- (9) a list of the particular goods or services on or in connection with which the applicant's authorized users use or intend to use the mark (*see* [TMEP §§805, 1402](#));
  - (10) classification in U.S. Class A for goods or U.S. Class B for services for a §1 or §44 application, or the classification assigned by the International Bureau for a §66(a) application (*see* [TMEP §§805, 1401](#)).

[37 C.F.R. §2.45\(a\)](#).

*Requirements that differ in form from those in trademark or service mark applications.* Most application requirements for certification marks are the same as those for regular trademarks and service marks. However, the filing basis, verification, identification, and classification requirements for certification mark applications differ in form from other trademarks and service mark applications because of the difference between who owns and uses certification marks. See [TMEP §1306.02\(a\)-\(a\)\(v\)](#) for information regarding filing-basis requirements, [§§1306.02\(b\)-\(b\)\(ii\)](#) for information regarding the verification of certain statements, [§1306.02\(c\)](#) for identification requirements, and [§1306.02\(d\)](#) for classification requirements in certification mark applications.

See [TMEP §1306.03](#) for further information regarding the special elements of certification mark applications. See [TMEP Chapter 1600](#) for post-registration requirements.

### **1306.02(a) Filing Basis**

See [TMEP §1303.01\(a\)](#) for information regarding an application filing basis for a collective trademark or collective service mark. These requirements apply similarly to certification marks.

For a list of the requirements pertaining to each filing basis, see [37 C.F.R. §2.45\(a\)\(4\)\(i\)-\(v\)](#) and [TMEP §§1306.02\(a\)\(i\)-\(v\)](#).

### **1306.02(a)(i) Use in Commerce – §1(a)**

Under [15 U.S.C. §1051\(a\)](#), [§1054](#), and [37 C.F.R. §2.45\(a\)\(4\)\(i\)](#), to establish a basis under §1(a) of the Trademark Act, the applicant must:

- (1) Submit a statement specifying what the applicant is certifying about the goods or services in the application ([37 C.F.R. §2.45\(a\)\(4\)\(i\)\(A\)](#));

- (2) Submit a copy of the certification standards governing use of the certification mark on or in connection with the goods or services specified in the application ([37 C.F.R. §2.45\(a\)\(4\)\(i\)\(B\)](#));
- (3) Submit a statement that the applicant is not engaged in the production or marketing of the goods or services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods or services that meet the certification standards of the applicant ([37 C.F.R. §2.45\(a\)\(4\)\(i\)\(C\)](#));
- (4) Specify the date of the applicant's authorized user's first use of the mark anywhere on or in connection with the goods or services ([37 C.F.R. §2.45\(a\)\(4\)\(i\)\(D\)](#));
- (5) Specify the date of the applicant's authorized user's first use of the mark in commerce (*Id.*);
- (6) Submit one specimen for each class, showing how an authorized user uses the mark in commerce to reflect certification of regional or other origin; material, mode of manufacture, quality, accuracy, 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. §§2.45\(a\)\(4\)\(i\)\(E\)](#), [2.56\(b\)\(5\)](#)); and
- (7) Submit a verified statement that the applicant believes the applicant is the owner of the mark; that the mark is in use in commerce; that the applicant is exercising legitimate control over the use of the mark in commerce; that to the best of the signatory's knowledge and belief, no other persons except authorized users have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods or services of such other persons, to cause confusion or mistake, or to deceive; that the specimen shows the mark as used in commerce by the applicant's authorized users; and that the facts set forth in the application are true (*see* [15 U.S.C. §§1051\(a\)\(3\)\(C\)](#), [1054](#); [37 C.F.R. §2.45\(a\)\(4\)\(i\)\(F\)](#)). See [TMEP §1306.02\(b\)\(i\)](#) for additional information regarding the requirements for the verified statement in applications under §1(a) of the Trademark Act.

The Trademark Act defines “commerce” as commerce which may lawfully be regulated by the U.S. Congress, and “use in commerce” as the bona fide use of a mark in the ordinary course of trade. [15 U.S.C. §1127](#); *see* [TMEP §§901–901.04](#).

An applicant may claim both use in commerce under §1(a) of the Act and intent to use under §1(b) of the Act as a filing basis in the same application, but may not assert both §1(a) and §1(b) for the identical goods or services in the same application. [37 C.F.R. §2.45\(c\)](#); *see* [TMEP §806.02\(b\)](#).

An applicant may not claim a §1(a) basis unless the mark was in use in commerce on or in connection with all the goods or services covered by the §1(a) basis as of the application filing date. *Cf. E.I. du Pont de Nemours & Co. v. Sunlyra Int'l, Inc.*, 35 USPQ2d 1787, 1791 (TTAB 1995) .

If the applicant claims use in commerce in addition to another filing basis, but does not specify which goods or services are covered by which basis, the USPTO may defer examination of the specimen(s) until the applicant identifies the goods or services for which use is claimed. [TMEP §806.02\(c\)](#).

See [TMEP §1306.03\(a\)](#) regarding statements specifying what the mark certifies, [§1306.03\(b\)](#) regarding certification standards, and [§1306.03\(c\)](#) regarding a statement that the applicant is not engaged in the production or marketing of the goods/services.

### 1306.02(a)(i)(A) Dates of Use

When specifying the dates of use as a certification mark, the applicant must indicate that the certification mark was first used by the applicant's authorized users because a certification mark is not used by the applicant itself. *See* [37 C.F.R. §2.45\(a\)\(4\)\(i\)\(D\)](#).

The date of first use anywhere is the date when an applicant's authorized user's goods were first sold or transported, or an applicant's authorized user's services were first rendered, under the mark, if such use is bona fide and in the ordinary course of trade. *See* [15 U.S.C. §1127](#) (definition of "use" within the definition of "abandonment of mark"). For every applicant, whether foreign or domestic, the date of first use of a mark is the date of the first use anywhere, in the United States or elsewhere, regardless of whether the nature of the use was local or national, intrastate or interstate, or of another type.

The date of first use in commerce is the date when an applicant's authorized user's goods were first sold or transported, or an applicant's authorized user's services were first rendered, under the mark in a type of commerce that may be lawfully regulated by the U.S. Congress, if such use is bona fide and in the ordinary course of trade. *See* [15 U.S.C. §1127](#) (definition of "use" within the definition of "abandonment of mark"). *See* [TMEP §901.01](#) for definitions of "commerce" and "use in commerce," and [§901.03](#) regarding types of commerce.

In a §1(a) application, the applicant may not specify a date of use that is later than the filing date of the application. If an applicant who filed under §1(a) cannot show that an authorized user used the mark in commerce on or before the application filing date, the applicant may amend the basis to §1(b). *See* [37 C.F.R. §2.35\(b\)\(1\)](#). *See* [TMEP §806.03](#) regarding amendments to the basis.

Neither a date of first use nor a date of first use in commerce is required to receive a filing date in an application based on use in commerce under §1(a) of the Act. If the application does not include a date of first use and/or a date of first use in commerce, the examining attorney must require that the applicant specify the date of first use and/or date of first use in commerce. *See* [37 C.F.R. §2.45\(a\)\(4\)\(i\)\(D\)](#). The dates must be supported by an affidavit or declaration under [37 C.F.R. §2.20](#). *See* [37 C.F.R. §§2.45\(a\)\(4\)\(i\)\(D\)](#), [2.71\(c\)](#).

An applicant may not file an application on the basis of use of a mark in commerce if such use has been discontinued.

### 1306.02(a)(i)(B) Specimens

A certification mark specimen must show how a person other than the owner uses the mark to reflect certification of regional or other origin, material, mode of manufacture, quality, accuracy, 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*, 85 USPQ2d 1403 (TTAB 2007) .

Although a certification mark performs a different function from a trademark or a service mark, users of certification marks typically apply them to goods and services in a manner similar to trademarks and service marks. That is, certification marks appear on labels, tags, or packaging for goods, or on materials used in the sale or advertising of services. Thus, specimens of use in certification mark applications generally are examined using the same standards that apply to specimens for trademarks and service marks. *See* [TMEP §§904-904.07\(b\)\(i\)](#) regarding specimens for trademarks and [TMEP §1301.04-TMEP §1301.04\(j\)](#) regarding specimens for service marks. However, because it is improper for certification marks to be used by their

owners, any specimen of use submitted in support of a certification mark application must show use of the mark as a certification mark by an authorized user. [37 C.F.R. §2.56\(b\)\(5\)](#).

Sometimes, the owner/certifier prepares tags or labels that bear the certification mark and that are supplied to the authorized users to attach to their goods or use in relation to their services. See *Ex parte Porcelain Enamel Inst., Inc.*, 110 USPQ 258 (Comm'r Pats. 1956). These tags or labels are acceptable specimens if they are shown affixed to the certified goods. Cf. [37 C.F.R. §2.56\(b\)\(1\)-\(2\)](#). A label or tag that is not shown physically attached to the goods may be accepted if, on its face, it clearly shows the mark in actual use in commerce. See [TMEP §904.03\(a\)](#) for more information regarding unattached labels or tags.

See [TMEP §1306.04\(c\)](#) for information regarding characteristics of certification marks and specimens that show the mark functions as a certification mark and [§1306.05\(b\)\(iii\)](#) regarding specimens for geographic certification marks.

### **1306.02(a)(ii) Intent-to-Use – §1(b)**

Under [15 U.S.C. §§1051\(b\)](#), [1054](#), and [37 C.F.R. §2.45\(a\)\(4\)\(ii\)](#), to establish a basis under §1(b) of the Trademark Act, the applicant must:

- (1) Submit a statement specifying what the applicant will be certifying about the goods or services in the application ([37 C.F.R. §2.45\(a\)\(4\)\(ii\)\(A\)](#));
- (2) Submit a statement that the applicant will not engage in the production or marketing of the goods or services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods or services that meet the certification standards of the applicant ([37 C.F.R. §2.45\(a\)\(4\)\(ii\)\(B\)](#)); and
- (3) Submit a verified statement that the applicant has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce; that to the best of the signatory's knowledge and belief, no other persons, except authorized users, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods or services of such other persons, to cause confusion or mistake, or to deceive; and that the facts set forth in the application are true ([37 C.F.R. §2.45\(a\)\(4\)\(ii\)\(C\)](#); see [15 U.S.C. §§1051\(b\)\(3\)\(B\)](#), [1054](#)). See [TMEP §1306.02\(b\)\(i\)](#) for additional information regarding the requirements for the verified statement in applications under §1(b) of the Trademark Act.

Prior to registration, the applicant must file an allegation of use (i.e., either an amendment to allege use under [15 U.S.C. §1051\(c\)](#) or a statement of use under [15 U.S.C. §1051\(d\)](#)) that states that (a) the mark is in use in commerce and (b) the applicant is exercising legitimate control over the use of the mark in commerce, includes dates of use and a filing fee for each class, and includes one specimen evidencing such use for each class. See [37 C.F.R. §§2.76](#), [2.88](#). See [37 C.F.R. §2.76](#) and [TMEP §§1104–1104.11](#) regarding amendments to allege use and [37 C.F.R. §2.88](#) and [TMEP §§1109–1109.18](#) regarding statements of use.

Once an applicant claims a §1(b) basis for any or all of the goods or services, the applicant may not amend the application to seek registration under §1(a) of the Act for those goods or services unless the applicant files an allegation of use under §1(c) or §1(d) of the Act. [37 C.F.R. §2.35\(b\)\(8\)](#).

See [TMEP §1306.03\(a\)](#) regarding statements specifying what the mark is intended to certify and [TMEP §1306.03\(c\)](#) regarding statements that the applicant will not engage in the production or marketing of the goods/services.

See [TMEP Chapter 1100](#) for additional information about intent-to-use applications.

### **1306.02(a)(iii) Foreign Priority – §44(d)**

Section 44(d) of the Act provides a basis for receipt of a priority filing date, but not a basis for publication or registration. Before the application can be approved for publication, or for registration on the Supplemental Register, the applicant must establish a basis under §1(a), §1(b), or §44(e) of the Act. See [37 C.F.R. §2.45\(a\)\(4\)](#); [TMEP §1003.03](#). If the applicant claims a §1(b) basis, the applicant must file an allegation of use before the mark can be registered. See [TMEP §1306.02\(a\)\(ii\)](#) regarding the requirements for a §1(b) basis.

Under [15 U.S.C. §§1054, 1126\(d\)](#), and [37 C.F.R. §2.45\(a\)\(4\)\(iv\)](#), to establish a basis under §44(d) of the Trademark Act, the applicant must:

- (1) File a claim of priority within six months of the filing date of the foreign application ([37 C.F.R. §2.45\(a\)\(4\)\(iv\)\(A\)](#));
- (2) Specify the filing date, serial number, and country of the first regularly filed foreign application; or (b) state that the application is based upon a subsequent regularly filed application in the same foreign country, and that any prior-filed application has been withdrawn, abandoned, or otherwise disposed of, without having been laid open to public inspection and without having any rights outstanding, and has not served as a basis for claiming a right of priority ([37 C.F.R. §2.45\(a\)\(4\)\(iv\)\(A\)](#); *see also* Paris Convention Article 4(D));
- (3) Submit a statement specifying what the applicant will be certifying about the goods or services in the application ([37 C.F.R. §2.45\(a\)\(4\)\(iv\)\(B\)](#));
- (4) Submit a statement that the applicant will not engage in the production or marketing of the goods or services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods or services that meet the certification standards of the applicant ([37 C.F.R. §2.45\(a\)\(4\)\(iv\)\(B\)](#)); and
- (5) Submit a verified statement that the applicant has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce; that to the best of the signatory's knowledge and belief, no other persons, except authorized users, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods or services of such other persons, to cause confusion or mistake, or to deceive; and that the facts set forth in the application are true ([37 C.F.R. §2.45\(a\)\(4\)\(iv\)\(C\)](#); *see* [15 U.S.C. §§1051\(b\)\(3\)\(B\)](#), 1054). See [TMEP §1306.02\(b\)\(i\)](#) for additional information regarding the requirements for the verified statement in applications under §44 of the Trademark Act.

The scope of the goods/services covered by the §44 basis in the U.S. application may not exceed the scope of the goods/services in the foreign application or registration. [37 C.F.R. §2.45\(a\)\(2\)](#); [TMEP §1402.01\(b\)](#).

If an applicant properly claims a §44(d) basis in addition to another basis, the applicant may retain the priority filing date without perfecting the §44(e) basis. [37 C.F.R. §2.35\(b\)\(3\)](#), (b)(4). See [TMEP §806.04\(b\)](#) regarding processing an amendment electing not to perfect a §44(e) basis and [§806.02\(f\)](#) regarding the examination of applications that claim §44(d) in addition to another basis.

See [TMEP §1306.03\(a\)](#) regarding statements specifying what the mark is intended to certify and [TMEP §1306.03\(c\)](#) regarding statements that the applicant will not engage in the production or marketing of the goods/services.

See [TMEP §§1003–1003.08](#) for further information about §44(d) applications.

### **1306.02(a)(iv) Foreign Registration – §44(e)**

Under [15 U.S.C. §§1054, 1126\(e\)](#) and [37 C.F.R. §2.45\(a\)\(4\)\(iii\)](#), the requirements for establishing a basis for registration under §44(e), relying on a registration granted by the applicant’s country of origin, are:

- (1) The applicant must submit a true copy, a photocopy, a certification, or a certified copy of the registration in the applicant’s country of origin. If the foreign registration or other certification is not in English, the applicant must provide a translation of the document. If the record indicates that the foreign registration will expire before the U.S. registration will issue, the applicant must submit a true copy, a photocopy, a certification, or a certified copy of a proof of renewal from the applicant’s country of origin to establish that the foreign registration has been renewed and will be in full force and effect at the time the U.S. registration will issue. If the proof of renewal is not in the English language, the applicant must submit a translation ([37 C.F.R. §2.45\(a\)\(4\)\(iii\)\(A\)](#); [TMEP §§1004.01, 1004.01\(b\)](#));
- (2) The applicant must submit a statement specifying what the applicant will be certifying about the goods or services in the application ([37 C.F.R. §2.45\(a\)\(4\)\(iii\)\(B\)](#));
- (3) The applicant must submit a statement that the applicant will not engage in the production or marketing of the goods or services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods or services that meet the certification standards of the applicant ([37 C.F.R. §2.45\(a\)\(4\)\(iii\)\(B\)](#));
- (4) The applicant must submit a verified statement that the applicant has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce; that to the best of the signatory’s knowledge and belief, no other persons, except authorized users, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods or services of such other persons, to cause confusion or mistake, or to deceive; and that the facts set forth in the application are true ([37 C.F.R. §2.45\(a\)\(4\)\(iii\)\(C\)](#); *see* [15 U.S.C. §§1051\(b\)\(3\)\(B\), 1054](#)). *See* [TMEP §1306.02\(b\)\(i\)](#) for additional information regarding the requirements for the verified statement in applications under §44 of the Trademark Act; and
- (5) The applicant’s country of origin must either be a party to a convention or treaty relating to trademarks to which the United States is also a party, or extend reciprocal registration rights to nationals of the United States by law (*see* [15 U.S.C. §1026\(b\)](#), [TMEP §1002.03](#)).

If the applicant does not submit a certification or a certified copy of the registration from its country of origin, the applicant must submit a true copy or photocopy of a document that has been issued to the applicant by, or certified by, the intellectual property office in the applicant’s country of origin. A photocopy of an entry in the intellectual property office’s gazette (or other official publication) or a printout from the intellectual property office’s website is not, by itself, sufficient to establish that the mark has been registered in that country and that the registration is in full force and effect. *See* [TMEP §1004.01](#).

The scope of the goods/services covered by the §44 basis in the U.S. application may not exceed the scope of the goods/services in the foreign registration. [37 C.F.R. §2.45\(a\)\(2\)](#); [TMEP §1402.01\(b\)](#).

An application may be based on more than one foreign registration. If the applicant amends an application to rely on a different foreign registration, this is not considered a change in basis; however, the application must be republished. [TMEP §1004.02](#). *See* [TMEP §806.03](#) regarding amendments to add or substitute a basis.

See [TMEP §1306.03\(a\)](#) regarding statements specifying what the mark is intended to certify and [§1306.03\(c\)](#) regarding statements that the applicant will not engage in the production or marketing of the goods/services.

See [TMEP §§1004–1004.02](#) for further information about §44(e) applications.

### **1306.02(a)(iv)(A) Scope of Foreign Registration**

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. See *In re Löwenbräu München*, 175 USPQ 178 (TTAB 1972) (noting that the U.S. registration cannot exceed the breadth or scope of the foreign registration on which it is based); [TMEP §1402.01\(b\)](#). 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 is not always immediately apparent from a foreign registration certificate. Foreign registration certificates may not always clearly identify whether the mark is a trademark, service mark, collective mark, or certification mark and even when they indicate the type, the significance of the term used for the type 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.

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, pursuant to [37 C.F.R. §2.61\(b\)](#).

### **1306.02(a)(v) Extension of Protection of International Registration – §66(a)**

Section 66(a) of the Trademark Act, [15 U.S.C. §1141f\(a\)](#), provides for a request for extension of protection of an international registration to the United States. See [37 C.F.R. §2.45\(a\)\(4\)\(v\)](#). To establish a basis under §66(a), the applicant must:

- (1) Submit a statement specifying what the applicant will be certifying about the goods or services in the application ([37 C.F.R. §2.45\(a\)\(4\)\(v\)\(A\)](#));
- (2) Submit a statement that the applicant will not engage in the production or marketing of the goods or services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods or services that meet the certification standards of the applicant ([37 C.F.R. §2.45\(a\)\(4\)\(v\)\(A\)](#)); and
- (3) Submit a verified statement that the applicant has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce that the U.S. Congress can regulate on or in connection with the goods or services specified in the international application/subsequent designation; that the signatory is properly authorized to execute the declaration on behalf of the applicant; and that to the best of his/her knowledge and belief, no other person, firm, corporation, association, or other legal entity, except authorized users, has the right to use the mark in commerce that the U.S. Congress can regulate either in the identical form thereof or in such near resemblance

thereto as to be likely, when used on or in connection with the goods or services of such other person, firm, corporation, association, or other legal entity, to cause confusion, or to cause mistake, or to deceive ([37 C.F.R. §2.45\(a\)\(4\)\(v\)\(B\)](#); *see* [15 U.S.C. §§1051\(b\)\(3\)\(B\)](#), 1054). For a certification mark application, the required verified statement is *not* part of the international registration on file at the International Bureau of the World Intellectual Property Organization (“IB”); therefore, the examining attorney must require the verified statement during examination. *See* [37 C.F.R. §2.45\(b\)\(2\)](#).

*See* [TMEP §1306.02\(b\)\(ii\)](#) for additional information regarding the requirements for the verified statement in applications under §66(a) of the Trademark Act.

A §66(a) applicant may not change the basis or claim more than one basis unless the applicant meets the requirements for transformation under §70(c). [37 C.F.R. §§2.35\(a\), 2.45\(c\)](#). *See* [TMEP §1904.09](#) regarding the limited circumstances under which a §66(a) application may be transformed into an application under §1 or §44.

Section 66(a) requires transmission of a request for extension of protection by the IB to the USPTO. It may not be added or substituted as a basis in an application originally filed under §1 or §44.

Under [15 U.S.C. §1141g](#), the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (Madrid Protocol) Article 4(2), and [37 C.F.R. §7.27](#), the §66(a) applicant may claim a right of priority within the meaning of Article 4 of the Paris Convention if:

- (1) The request for extension of protection contains a claim of priority;
- (2) The request for extension of protection specifies the filing date, serial number, and the country of the application that forms the basis for the claim of priority; *and*
- (3) The date of international registration, or the date of the recordal of the subsequent designation requesting an extension of protection to the United States, is not later than six months after the date of the first regular national filing (within the meaning of Article 4(A)(3) of the Paris Convention) or a subsequent application (within the meaning of Article 4(C)(4) of the Paris Convention).

*See* Regs. Rule 9(4)(a)(iv).

### **1306.02(a)(vi) Multiple Bases, Amending/Deleting the Basis, Review of Basis Prior to Publication/Issue**

The procedures for examining an application with multiple bases, amending or deleting a basis, and reviewing the basis information prior to publication or issuance of a registration are the same as for trademark and service mark applications. *See* [TMEP §806.02](#) for information about multiple bases, [§806.03](#) regarding amending the basis, [§806.04](#) regarding deleting a basis, and [§806.05](#) regarding review of a basis prior to publication or issue.

### **1306.02(b) Verification of Certain Statements**

An application must include certain statements that are verified by the applicant or by someone who is authorized to verify facts on behalf of an applicant. [15 U.S.C. §1051\(a\)\(3\)](#), [\(b\)\(3\)](#); [37 C.F.R. §§2.45\(a\)\(4\)\(i\)\(F\)](#), [\(a\)\(4\)\(ii\)\(C\)](#), [\(a\)\(4\)\(iii\)\(C\)](#), [\(a\)\(4\)\(iv\)\(C\)](#), [\(a\)\(4\)\(v\)\(B\)](#), [2.193\(e\)\(1\)](#); *see* [TMEP §1306.02\(b\)\(i\)-\(ii\)](#).

In an application under §1 or §44 of the Trademark Act, a signed verification is not required for receipt of an application filing date under [37 C.F.R. §2.21\(a\)](#). If the initial application does not include a proper verified statement, the examining attorney must require the applicant to submit a verified statement that relates back to the original filing date. See [TMEP §§804.01–804.01\(b\)](#) regarding the form of the oath or declaration, [§1306.02\(b\)\(i\)](#) regarding the essential allegations required to verify an application for registration of a mark, and [§804.04](#) regarding persons properly authorized to sign a verification on behalf of an applicant.

In §66(a) applications, this particular verified statement is not part of the international registration on file at the IB; therefore the examining attorney must require the verified statement during examination. See [37 C.F.R. §2.45\(a\)\(4\)\(v\)\(B\)](#); [TMEP §§804.05](#), [1306.02\(b\)\(ii\)](#), [1904.01\(c\)](#).

### **1306.02(b)(i) Statements Required in Verification of Application for Registration - §1 or §44 Application**

The requirements for the verified statement in applications under §1 or §44 of the Trademark Act are set forth in [37 C.F.R. §2.45\(a\)\(4\)\(i\)–\(iv\)](#). See [15 U.S.C. §§1051\(a\)\(3\)](#), [1051\(b\)\(3\)](#), [1126](#). These allegations are required regardless of whether the verification is in the form of an oath ([TMEP §804.01\(a\)](#)) or a declaration ([TMEP §804.01\(b\)](#)). See [TMEP §1306.02\(b\)\(ii\)](#) regarding the requirements for verification of a §66(a) application. See [TMEP §1306.02\(a\)–\(a\)\(iv\)](#) for further information regarding filing-basis requirements, including the verified statement.

*Truth of Facts Recited* . Under [15 U.S.C. §§1051\(a\)\(3\)\(B\)](#) and [1051\(b\)\(3\)\(C\)](#), verification of an application for registration must include an allegation that “to the best of the verifier’s knowledge and belief, the facts recited in the application are accurate.” The language in [37 C.F.R. §2.20](#) that “all statements made of [the signatory’s] own knowledge are true and all statements made on information and belief are believed to be true” satisfies this requirement. See [37 C.F.R. §2.45\(a\)\(4\)\(i\)\(F\)](#), [\(a\)\(4\)\(ii\)\(C\)](#), [\(a\)\(4\)\(iii\)\(C\)](#), [\(a\)\(4\)\(iv\)\(C\)](#).

*Use in Commerce and Exercising Legitimate Control* . If the filing basis is §1(a), the applicant must submit a verified statement that the mark is in use in commerce and that the applicant is exercising legitimate control over the use of the mark in commerce. [37 C.F.R. §2.45\(a\)\(4\)\(i\)\(F\)](#). If this verified statement is not filed with the original application, it must also allege that, *as of the application filing date* , the mark was in use in commerce and the applicant was exercising legitimate control over the use of the mark in commerce. [37 C.F.R. §2.45\(b\)\(2\)](#).

*Bona Fide Intention and Entitlement to Exercise Legitimate Control* . If the filing basis is §1(b), §44(d), or §44(e), the applicant must submit a verified statement that the applicant has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce, and that to the best of the signatory’s knowledge and belief, no other persons, except authorized users, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods or services of such other persons, to cause confusion or mistake, or to deceive. [37 C.F.R. §2.45\(a\)\(4\)\(ii\)\(C\)](#), [\(a\)\(4\)\(iii\)\(C\)](#), [\(a\)\(4\)\(iv\)\(C\)](#). If this verified statement is not filed with the original application, it must also allege that, *as of the application filing date* , the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce. [37 C.F.R. §2.45\(b\)\(2\)](#).

*Ownership* . In an application based on §1(a), the verified statement must allege that the applicant *believes the applicant is the owner of the mark* , and that to the best of the signatory’s knowledge and belief, no other persons except authorized users have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods or services of such

other persons, to cause confusion or mistake, or to deceive. [37 C.F.R. §2.45\(a\)\(4\)\(i\)\(F\)](#); see [15 U.S.C. §1051\(a\)\(3\)\(A\)](#), [\(a\)\(3\)\(D\)](#).

*Concurrent Use* . The verification for concurrent use should be modified to indicate that no other persons *except authorized users and concurrent users* as specified in the application have the right to use the mark in commerce. [37 C.F.R. §2.45\(d\)](#); see [15 U.S.C. §1051\(a\)\(3\)\(D\)](#). See TMEP §1207.04(d)(ii) for concurrent use application requirements for a certification mark.

*Affirmative, Unequivocal Averments Based on Personal Knowledge Required*. The verification must include affirmative, unequivocal averments that meet the requirements of the Act and the rules. Statements such as “the undersigned [person signing the declaration] has been informed that the mark is in use in commerce [or has been informed that applicant has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce] . . .,” or wording that disavows the substance of the declaration, are unacceptable.

*Verification Not Filed Within Reasonable Time* . If the verified statement is not filed within a reasonable time after it is signed, the examining attorney will require the applicant to submit a substitute verified statement attesting that, as of the application filing date, the mark was in use in commerce and the applicant was exercising legitimate control over the use of the mark in commerce (in an application based on §1(a)); or, as of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce (in an application based on §1(b) or §44). [37 C.F.R. §2.45\(b\)\(1\)](#). See [TMEP §804.03](#) for information regarding time between execution and filing of documents.

*Substitute Verification* . If the verified statement does not include all the necessary averments, the examining attorney will require a substitute or supplemental affidavit or declaration under [37 C.F.R. §2.20](#).

### **1306.02(b)(ii) Statements Required in Verification of Application for Registration - §66(a) Application**

The verified statement for a certification mark in a §66(a) application is *not* part of the international registration on file at the IB; therefore, the examining attorney must require the verified statement during examination. See [37 C.F.R. §2.45\(b\)\(2\)](#).

In applications under §66(a) of the Act, the applicant must amend the request for extension of protection to the United States to include a declaration that the applicant has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce that the U.S. Congress can regulate on or in connection with the goods or services specified in the international application/subsequent designation. [37 C.F.R. §2.45\(a\)\(4\)\(v\)\(B\)](#). The declaration must include a statement that the signatory is properly authorized to execute the declaration on behalf of the applicant and that to the best of his/her knowledge and belief, that no other person, firm, corporation, association, or other legal entity, except authorized users, has the right to use the mark in commerce that the U.S. Congress can regulate, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, firm, corporation, association, or other legal entity, to cause confusion, or to cause mistake, or to deceive. [37 C.F.R. §2.45\(a\)\(4\)\(v\)\(B\)](#); see [15 U.S.C. §1141\(f\)\(a\)](#).

Additionally, because the verified statement cannot be filed with the initial application, the verified statement must also allege that, *as of the application filing date* , the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce. [37 C.F.R. §2.45\(b\)\(2\)](#).

See [TMEP §1306.02\(a\)\(v\)](#) for further information regarding filing-basis requirements, including the verified statement.

### **1306.02(c) Identification of Goods and Services of the Authorized Users**

The identification of goods or services in a certification mark application must describe the goods and/or services of the party who will receive the certification, not the activities of the certifier/owner of the certification mark. This is consistent with the requirement that the owner of a certification mark not produce the goods or perform the services in connection with which the mark is used. See [37 C.F.R. §2.45\(a\)\(4\)\(i\)\(C\), \(a\)\(4\)\(ii\)\(B\), \(a\)\(4\)\(iii\)\(B\), \(a\)\(4\)\(iv\)\(B\), \(a\)\(4\)\(v\)\(A\)](#). The certification activities of the certifier are described in the certification statement, not in the identification of goods/services. For an explanation of the certification statement, see [TMEP § 1306.03\(a\)](#).

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 the general category of goods and services, such as the following: food, agricultural commodities, electrical products, clothing, printed material, insurance services, machinery repair, or restaurant services. However, sufficient information must be provided to enable a comparison of goods/services and analysis of trade channels in regard to possible likelihood-of-confusion scenarios. If the certification program itself is limited to specific items of goods or services, for example, wine, wood doors, or bakery machinery, then the identification in the application must also reflect this level of specificity.

The terms “certification,” “certify,” or “certifies” should not be included in the identification, which should be limited only to the goods or services, as in the following examples:

Building and construction materials and products, in International Class A

Medical services in the field of addiction medicine and treatment, in International Class B

Furthermore, the identification in an application for a geographic certification mark need not refer to the specific geographic origin of the goods or services. For example, the identification of goods for the geographic certification mark WISCONSIN REAL CHEESE is “dairy products, namely, cheese.”

### **1306.02(d) Classification**

#### *Section 1 and Section 44 Applications*

In applications to register certification marks, all goods are classified in U.S. Class A and all services are classified in U.S. Class B. [37 C.F.R. §6.3](#). Both U.S. Classes A and B (but not any other classes) may be included in one application. See [TMEP §§1403–1403.06](#) 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 numbered international 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 to classification in U.S. Classes A and B for certification marks was made by amendment to the Trademark Rules on August 15, 1955.

### *Section 66(a) Applications*

In a §66(a) application, classification is determined by the International Bureau of the World Intellectual Property Organization (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 may not be changed from the classification assigned to the goods/services by the IB. See [TMEP §§1401.03\(d\), 1904.02\(b\)](#). Accordingly, if the mark in a §66(a) application is identified as a certification mark, the USPTO will not reclassify it into U.S. Class A or B. However, the examining attorney must ensure that the applicant complies with all other U.S. requirements for certification marks, regardless of the classification assigned by the IB.

## **1306.03 Special Elements of Certification Mark Applications**

### **1306.03(a) Certification Statement**

The application must contain a statement of the characteristic, standard, or other feature that is certified or intended to be certified by the mark, also known as the certification statement. The certification statement should begin with wording, “The certification mark, as used or intended to be used by persons authorized by the certifier, certifies or is intended to certify that the goods/services provided have . . . .” See [37 C.F.R. §2.45\(a\)\(4\)\(i\)\(A\), \(a\)\(4\)\(ii\)\(A\), \(a\)\(4\)\(iii\)\(B\), \(a\)\(4\)\(iv\)\(B\), \(a\)\(4\)\(v\)\(A\)](#).

The certification statement must be sufficiently detailed to give proper notice of what is being certified. All of the characteristics or features that the mark certifies should be included. A certification mark application is not limited to certifying a single characteristic or feature.

The broad suggestive terms of the statute, 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, indicating that “quality” is being certified does not inform the public of what is being certified where the characteristic being certified is limited, for example, to the strength of a material, or the purity of a strain of seed.

The certification statement 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 part of the application file record.

Amendments that would materially alter the certification statement must not be permitted. [37 C.F.R. §2.71\(e\)](#).

The statement of what the mark certifies is a separate requirement from that of the identification of goods and/or services.

See [TMEP §1306.05\(b\)\(i\)](#) for information regarding the certification statement for geographic certification marks.

### **1306.03(b) Certification Standards – Required for §1(a) Applications and Allegations of Use Only**

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\(a\)\(4\)\(i\)\(B\)](#). For an intent-to-use application, under §1(b) of the Act, [15 U.S.C. §1051\(b\)](#), the standards are submitted with the allegation of use (i.e., either the amendment to allege use or the statement of use). [37 C.F.R. §§2.76\(b\)\(5\), 2.88\(b\)\(5\)](#).

The standards do not have to be originally created by 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.

The standards must cover the full scope of the goods/services identified in the application. For example, if the goods are “olive oil,” but the standards are only for “extra virgin olive oil,” the examining attorney must require the applicant to submit standards that cover all types of olive oil or to amend the identification to “extra virgin olive oil.”

In the rare circumstance when it is impracticable to provide a copy of the standards, the USPTO may accept a permanent link or permanent URL to the applicant’s standards with a synopsis of those standards. This provision is not intended as a general alternative to providing a copy of the standards; it applies only to situations when the nature of the standards makes providing a copy impracticable. For example, it may be impracticable to include a copy of the standards if the standards exceed 1,000 or more pages.

### **1306.03(c) Statement that Applicant Is Not Engaged in (or Will not Engage in) Production or Marketing of the Goods/Services**

For applications based on §1(a) of the Act, the application must contain a statement that the applicant is not engaged in the production or marketing of the goods or services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods or services that meet the certification standards of the applicant. [37 C.F.R. §2.45\(a\)\(4\)\(i\)\(C\)](#). For applications based on §1(b), §44, or §66(a) of the Act, the application must contain a statement that the applicant will not engage in the production or marketing of the goods or services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods or services that meet the certification standards of the applicant. [37 C.F.R. §2.45\(a\)\(4\)\(ii\)\(B\)](#), [\(a\)\(4\)\(iii\)\(B\)](#), [\(a\)\(4\)\(iv\)\(B\)](#), [\(a\)\(4\)\(v\)\(A\)](#). This statement does not have to be verified and, therefore, may be entered by examiner’s amendment.

### **1306.04 Examination of Certification Mark Applications**

Except where specified otherwise, the same procedures 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 §1306.05](#) regarding certification marks indicating regional origin only.

Certification marks are subject to the same qualifications and bar to registration under §2(e) of the Trademark Act, [15 U.S.C. §1052\(e\)](#) for mere descriptiveness as other marks. *In re Nat’l Ass’n of Veterinary Technicians in Am., Inc.*, 2019 USPQ2d 269108, at \*1 (TTAB 2019) (citing *In re Council on Certification of Nurse Anesthetists*, 85 USPQ2d 1403, 1411-15 (TTAB 2007); *In re Nat’l Ass’n of Legal Sec’y’s (Int’l)*, 221 USPQ 50, 52 (TTAB 1983)); *In re Univ. of Miss.*, 1 USPQ2d 1909, 1911 (TTAB 1987) (citing [15 U.S.C §1054](#);

*In re Pro. Photographers of Ohio, Inc.*, 149 USPQ 857, 859 (TTAB 1966)); *see Cmty. of Roquefort v. Santo*, 443 F.2d 1196, 1199, 170 USPQ 205, 208 (C.C.P.A. 1971). When assessing the descriptiveness of a certification mark under §2(e) of the Act, “the identified goods or services are those provided by the certified users.” *In re Nat’l Ass’n of Veterinary Technicians in Am. Inc.*, 2019 USPQ2d 269108, at \*2 (citing *Council on Certification of Nurse Anesthetists*, 85 USPQ2d at 1411 (considering whether the certification mark “refer[s] to anesthesia services rendered and administered by certified registered nurse anesthetists”). See [TMEP §§1209.03–1209.03\(u\)](#) regarding factors that often arise in determining whether a mark is merely descriptive or generic, [§§1213–1213.11](#) concerning disclaimer of merely descriptive matter within a mark, [§1303.02](#) and [§1304.03](#) regarding assessing descriptiveness in collective marks.

Further, certification marks are subject to the same bar to registration under §2(d) of the Act, [15 U.S.C. §1052\(d\)](#), as other marks, and the same *du Pont* analysis for determining likelihood of confusion is applied. *In re Accelerate s.a.l.*, 101 USPQ2d 2047, 2049 (TTAB 2012) (quoting *Motion Picture Ass’n of Am., Inc. v. Respect Sportswear, Inc.*, 83 USPQ2d 1555, 1559-60 (TTAB 2007) ); *see In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) ; *see also Procter & Gamble Co. v. Cohen*, 375 F.2d 494, 153 USPQ 188 (C.C.P.A. 1967) ; *Tea Bd. of India v. Republic of Tea, Inc.*, 80 USPQ2d 1881 (TTAB 2006) .

However, because a certification mark owner does not use the mark itself, the likelihood-of-confusion analysis is based on a comparison of the mark as applied to the goods and/or services of the certification mark users, including the channels of trade and classes of purchasers. *In re Accelerate s.a.l.*, 101 USPQ2d at 2049 (quoting *Motion Picture Ass’n of Am. Inc.*, 83 USPQ2d at 1559-60); *see also Jos. S. Cohen & Sons Co. v. Hearst Mags., Inc.*, 220 F.2d 763, 765, 105 USPQ 269, 271 (C.C.P.A. 1955) .

A refusal to register because the specimen fails to show the applied-for mark functioning as a certification mark is predicated on §§1, 2, 4, and 45 of the Act, [15 U.S.C. §§1051, 1052, 1054, 1127](#). For example, registration should be refused on this basis where the specimen shows use only as an educational or other degree or title awarded to individuals, and not use as a certification mark. Titles and degrees indicate qualifications or attainments of a person; they do not pertain to or certify services that have been performed by the person. *See* [TMEP §1306.04\(d\)\(ii\)](#).

See [TMEP §1207.04](#) for information regarding seeking a concurrent use registration.

See [TMEP §1306.05](#) regarding the examination of geographic certification mark applications.

### **1306.04(a) Compare the Mark on the Drawing to the Specimen for §1(a)**

In evaluating the drawing, the same standards used in relation to trademark and service mark drawings apply to certification marks (*see* [TMEP §§807–807.18](#)). For §1(a) applications, the examining attorney must refer to the specimen to determine what constitutes the mark. *See In re Nat’l Inst. for Auto. Serv. Excellence*, 218 USPQ 744 (TTAB 1983) . The drawing in the application must include the entire certification mark, but it should not include matter that is not part of the mark.

### **1306.04(b) Ownership**

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 Elec. Cord Comm.*, 125 USPQ 310 (TTAB 1960) .

Certification is often the sole purpose 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 the same goods or services. *See* [37 C.F.R. §2.45\(f\)](#); [TMEP §1306.04\(f\)](#).

Examples of organizations that 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 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.

A magazine publisher may also 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 created by 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 §1306.03\(b\)](#) regarding the standards for certification. However, 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\(b\)](#)).

*See* [TMEP §1306.04\(d\)\(i\)](#) regarding appearance of a trademark or service mark in a certification mark or on a specimen, and [§1306.05\(b\)\(ii\)](#) regarding the authority to control a geographic certification mark.

### **1306.04(b)(i) Exercise of Control**

As stated in the application requirements, an application based on use in commerce under §1(a) of the Trademark Act, and an allegation of use under [15 U.S.C. §1051\(c\)](#) or [15 U.S.C. §1051\(d\)](#) filed in connection with a §1(b) application, must include a verified statement that the applicant is exercising legitimate control over the use of the certification mark in commerce. [37 C.F.R. §§2.45\(a\)\(4\)\(i\)\(F\), 2.76\(b\)\(1\)\(v\), 2.88\(b\)\(1\)\(v\)](#). For an application based on §1(b), §44, or §66(a) of the Act, the verified statement must specify that the applicant has a bona fide intention, and is entitled, to exercise legitimate control over the use of the certification mark in commerce. [37 C.F.R. §§2.45\(a\)\(4\)\(ii\)\(C\), \(a\)\(4\)\(iii\)\(C\), \(a\)\(4\)\(iv\)\(C\), \(a\)\(4\)\(v\)\(B\)](#).

If there is any evidence of record that casts doubt as to the existence or nature of such control by the applicant, the examining attorney must 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\(b\)](#).

### **1306.04(b)(ii) 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 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 Am.*, 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. *In re Monsanto Co.*, 201 USPQ at 870.

### **1306.04(b)(iii) 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. Typically, these marks have been registered as trademarks, on the basis of related-company use, rather than as certification marks. 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.

### **1306.04(c) Characteristics of Certification Marks – Specimen Shows Mark Functions as a Certification Mark**

The Trademark Act does not require that a certification mark be in any specific form or include any specific wording. A certification mark may 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,” “certified,” or similar wording, because 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 lacks this wording can perform the function of certification.

The examining attorney must look to the specimen and any 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 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).

If the specimen shows the proposed mark is not being used by a person other than the applicant or does not function as a certification mark, the examining attorney must refuse registration under §§1, 2, 4, and 45 of the Trademark Act, [15 U.S.C. §§1051](#), [1052](#), [1054](#), [1127](#). The applicant may overcome the refusal by submitting an acceptable substitute specimen or amending the filing basis to §1(b), if appropriate. *See TMEP §§806.03(c)*, [904.05](#). *See TMEP §1306.04(d)(ii)* regarding specimens showing use as degrees or titles. *See TMEP §904.07(b)* for information about matter that fails to function as a trademark or service mark.

*See TMEP §1306.05(b)(iii)* regarding the specimens of use for geographic certification mark applications.

## **1306.04(d) Specimen Refusals Specific to Certification Marks**

### **1306.04(d)(i) Whether Certification Mark and Trademark or Service Mark Appear on Specimen Together**

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 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 under [37 C.F.R. §2.61\(b\)](#) of the circumstances to ascertain whether the mark is a certification mark rather than a trademark or service mark. *See TMEP §1306.06*.

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 the commercial 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(b)*.

Under these circumstances, the trademark or service mark must be owned by the same person who owns the certification mark, and the trademark or service mark may not be identical to the certification mark. *See 37 C.F.R. §§2.45(f)*, [2.86\(d\)](#).

Further, 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 not owned by the applicant, the examining attorney must refuse registration of the certification mark based on Section 2(d), [15 U.S.C. §1052\(d\)](#), or false association under Section 2(a), [15 U.S.C. §1052\(a\)](#), as appropriate.

### **1306.04(d)(ii) Specimen Shows Use as Title or Degree for Certification Mark 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 Nat'l Inst. for Auto. Serv. Excellence*, 218 USPQ 744, 747 (TTAB 1983) ; *see also Am. Speech-Language-Hearing Ass'n v. Nat'l Hearing Aid Soc'y*, 224 USPQ 798 (TTAB1984) . 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 Council on Certification of Nurse Anesthetists*, 85 USPQ2d 1403 (TTAB2007) (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 Ass'n*, 69 USPQ2d 2009 (TTAB2003) (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 Nat'l Ass'n of Purchasing Mgmt.*, 228 USPQ 768 (TTAB 1986) (C.P.M. used merely as title or degree, not as certification mark); *In re Nat'l Ass'n of Legal Secretaries (Int'l)*, 221 USPQ 50 (TTAB 1983) (PROFESSIONAL LEGAL SECRETARY not used on the specimen in such a way as to indicate certification significance); *In re Nat'l Inst. for Auto. Serv. 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 Inst. of Certified Prof'l Bus. Consultants*, 216 USPQ 338 (TTAB1982) (CPBC not used as a certification mark for business consulting services, but only as a title or degree); *In re Prof'l Photographers of Ohio, Inc.*, 149 USPQ 857 (TTAB1966) (CERTIFIED PROFESSIONAL PHOTOGRAPHER used only as the title of a person, not as a certification mark); *cf. In re Univ. of Miss.*, 1 USPQ2d 1909 (TTAB 1987) (use of university seal on diplomas did not represent use as a certification mark).

See [TMEP §1306.06\(a\)](#) regarding the difference between a certification mark and a collective mark.

### **1306.04(e) Relationship of §14 (Cancellation)**

#### **15 U.S.C. §1064. Cancellation. (Extract)**

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 a likelihood of dilution by blurring or dilution by tarnishment under section 1125(c) of this title, 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 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 only subsections in (5) applicable to examination would be (A) and (B), as an analysis of (5)(A)-(D) below shows:

*Subsection A (“exercising legitimate control”)*: 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 in commerce of the certification mark. See [37 C.F.R. §§2.45\(a\)\(4\)\(i\)\(F\), \(a\)\(4\)\(ii\)\(C\), \(a\)\(4\)\(iii\)\(C\), \(a\)\(4\)\(iv\)\(C\), \(a\)\(4\)\(v\)\(B\)](#); [TMEP §1306.04\(b\)\(i\)](#). Such statement is accepted, unless the examining attorney has knowledge of facts indicating that it should not be accepted.

*Subsection B (not engaged in, or will not engage in, the production or marketing of any goods or services to which the certification mark is applied ...)*: 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, except to advertise or promote recognition of the certification program or of the goods or services that meet the certification standards of the applicant. See [37 C.F.R. §2.45\(a\)\(4\)\(i\)\(C\), \(a\)\(4\)\(ii\)\(B\), \(a\)\(4\)\(iii\)\(B\), \(a\)\(4\)\(iv\)\(B\), \(a\)\(4\)\(v\)\(A\)](#); [TMEP §1306.03\(c\)](#). Such statement is accepted, unless the record contains facts to the contrary.

*Subsection C (used for purposes other than to certify)*: 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 (discriminately refusing to certify)*: 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 USPTO does not 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.

### **1306.04(f) Same Mark Not Registrable as Certification Mark and as Any Other Type of Mark**

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.

Thus, registration as a certification mark precludes the same owner from registering the same mark as any other type of mark (e.g., a trademark or a service mark) for the same goods or services.) See [15 U.S.C. §1064\(5\)\(B\)](#) (providing for cancellation of a registered certification mark if the registrant engages in the production or marketing of any goods or services to which the certification mark is applied); *In re Monsanto Co.*, 201 USPQ 864, 868-69 (TTAB 1978) ; [TMEP §1306.04\(f\)](#).

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 §1306.04\(e\)](#) regarding §14(5) of the Act. Thus, if a party attempts to register the same mark as a trademark or service mark for particular goods or services and as a certification mark for those goods or services, the applied-for mark must be refused under Trademark Act §§4 and 14(5)(B). [15 U.S.C. §§1054, 1064\(5\)\(B\)](#); see also [37 C.F.R. §2.45](#); [TMEP §1306.04\(f\)](#).

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. For these purposes, two marks need not be identical, but any differences must be so insignificant that the marks would still be viewed as essentially the same. Even small variations in wording or design, if meaningful, could create different marks that may coexist on the register. 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) (finding the mark 88OPEN COMPATIBILITY CERTIFIED and design 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\(b\), 1306.04\(d\)\(i\), 1306.06](#).

The owner of a certification mark may seek registration of the same mark as a trademark or service mark for goods or services other than those to which the certification mark is applied. However, the application for a certification mark must be filed separately from the application for a trademark or service mark, because the purpose and use of a trademark or service mark differ from those of a certification mark as do the allegations and claims made in support of a certification mark.

### **1306.04(f)(i) 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.

## 1306.05 Geographic Certification Marks

### 1306.05(a) Geographic Certification Marks – Generally

A geographic certification mark is a word, name, symbol, device, or some combination of these elements, used alone or as a portion of a composite mark, to certify that the goods or services originate in the geographical region identified by the term or, in some circumstances, from a broader region that includes the region identified by the term. See [15 U.S.C. §1127](#). As noted in *Cmty 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.

A geographic certification mark may feature a recognized geographic term that identifies the relevant geographic region, as in the marks ROQUEFORT for cheese, DARJEELING for tea, and COLOMBIAN for coffee. Or the mark may contain a variation or abbreviation of a geographic term or a combination of different geographic terms, with or without other matter. Sometimes the mark will include or consist of a designation or figurative element that is not technically geographic, but nonetheless has significance as an indication of geographic origin solely in a particular region. For example, the mark CIAUSCOLO is not the name of a particular place, but it nevertheless certifies that the salami to which it is applied originates in various municipalities of certain Italian provinces. See [TMEP §1306.05\(j\)](#) for additional examples of geographic certification marks.

As with any certification mark, a geographic certification mark is not used by its owner in the same way a trademark or service mark is. Rather, the owner of a geographic certification mark controls use of the mark by other parties. These parties apply the mark to goods or services to indicate to consumers that the goods or services have been certified as meeting the standards set forth by the certifier. Thus, the goods or services to which a geographic certification mark is applied may emanate from a number of sources comprising various certified producers in the relevant region. See [TMEP §§1306.01–1306.01\(b\)](#), [1306.04\(b\)](#).

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 Nat’l Des Appellations D’Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875 (TTAB 1998) .

Regardless of an applicant’s intent, however, consumers may perceive some terms as identifying a type or category of the relevant goods or services, rather than indicating geographic origin. As discussed in [TMEP §1306.05\(c\)](#), these terms do not function as geographic certification marks and may not be registered as such. Not every certification mark that features a geographic designation serves as a geographic certification

mark. See [TMPEP §1306.05\(f\)](#). But, as explained in [TMPEP §1306.05\(d\)](#), those that do are specifically excluded from the provisions of Trademark Act §2(e)(2). Furthermore, for purposes of a §2(d) likelihood-of-confusion analysis, geographic designations that appear in a certification mark and function to certify regional origin should be treated like distinctive terms and should not be considered “weak.” See [TMPEP §1306.05\(g\)](#).

Applications for geographic certification marks must include all of the elements of a certification mark application. See [TMPEP §§1306.02–1306.02\(d\)](#), [1306.03](#). As discussed in [TMPEP §1306.05\(b\)](#), additional considerations apply to some of the elements.

## **1306.05(b) Additional Considerations in Geographic Certification Mark Applications**

### **1306.05(b)(i) Certification Statement**

#### *Indicating the Region*

When a geographic term is being used as a certification mark to indicate regional origin, the application must define the regional origin that the mark certifies. The identified region might be as large as a country or as small as a village, and an applicant may define it in general terms in the certification statement (e.g., “the Darjeeling region in India” or “the community of Roquefort, Department of Aveyron, France”). The certification standards, however, will usually be more specific as to the particular geographic boundaries involved.

If the available evidence indicates that the region identified by a geographic designation in the mark is well known for the identified goods or services, or that the goods or services are principal products of the region, the certification statement must limit the defined region to the region identified by the designation in the mark. When the certification statement is not appropriately limited in these instances, it is possible that the mark will be applied to goods or services that do not originate in the region named in the mark. See *In re St. Julian Wine Co.*, 2020 USPQ2d 10595, at \*3 n.2 (TTAB 2020) (a certification statement to indicate regional origin “must be sufficiently detailed” or the geographic certification mark “could improperly be applied to goods [or services] not originating from that region” and be subject to a geographically deceptive refusal). Thus, the mark is geographically deceptive as to those goods or services and must be refused accordingly. See [TMPEP §1306.05\(e\)](#). The applicant may overcome the refusal by amending the certification statement to limit the defined region to the region identified by the geographic designation in the mark.

If there is insufficient evidence to conclude that the region identified in the mark is known for the goods or services, or that the goods or services are principal products of the region, the region defined in the certification statement may be broader than the region named in the mark. However, the region named in the mark must still be encompassed by the larger region specified in the certification statement.

#### *Other Characteristics*

The certification statement must be sufficiently detailed to give proper notice of what is being certified, which may include other characteristics in addition to geographic origin. See [TMPEP §1306.03\(a\)](#). For example, the registration for ROQUEFORT indicates the mark certifies that the cheese to which it is applied “has been manufactured from sheep’s milk only, and has been cured in the natural caves of the community of Roquefort, Department of Aveyron, France.”

#### *Form of Certification Statement*

The certification statement must start with the following wording or the equivalent: “The certification mark, as used or intended to be used by persons authorized by the certifier, certifies or is intended to certify that the goods/services provided have . . . .” See [TMEP §1306.03\(a\)](#). The following are examples of acceptable certification statements for geographic certification marks:

The certification mark, as used or intended to be used by persons authorized by the certifier, certifies or is intended to certify the regional origin of potatoes grown in the State of Idaho and certifies that those potatoes conform to grade, size, weight, color, shape, cleanliness, variety, internal defect, external defect, maturity and residue level standards promulgated by the certifier.

The certification mark, as used or intended to be used by persons authorized by the certifier, certifies or is intended to certify that the cheese on which the mark is used has been made entirely in the State of California with cow's milk produced entirely within the State of California.

The certification mark, as used or intended to be used by persons authorized by the certifier, certifies or is intended to certify that the agricultural products are aquacultural seafood products from the waters in the Gulf of Mexico off the Florida coast that are determined to be safe from oil.

See [TMEP §1306.03\(a\)](#) for information regarding certification statements in general.

### **1306.05(b)(ii) Authority to Control a Geographic Certification Mark**

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. Sometimes, however, circumstances make it desirable or necessary for various persons in a region to use a geographic designation for that region not as a trademark indicating commercial origin in one particular source, but to certify the regional origin of all the parties' goods. And, when geographic designations are used to certify regional origin, a governmental body or government-authorized entity is usually most able to exert the necessary control to ensure all qualified parties in the region are free to use the designation and to discourage improper or otherwise detrimental uses of the certification mark.

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 entitled to use the mark and to prevent abuse or illegal use of the 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 examining attorney should not question the identity of the applicant, unless the record indicates that the entity identified as the applicant is not the certifier.

If an applicant's authority to control use of a geographic certification mark featuring a geographic designation is not obvious, or is otherwise unclear, such as when the applicant is not a governmental entity, the examining attorney must request clarification, using a Trademark Rule 2.61(b) requirement for information. [37 C.F.R. §2.61\(b\)](#). One acceptable response would be an explanation that the relevant governmental body has granted

the applicant the authority to implement the certification program. *See Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1497-1501 (TTAB 2017) (finding that applicant, a nonprofit civil association accredited under Mexican law to certify tequila and authorized by the Mexican government to apply to register TEQUILA as a certification mark, had the authority to control use of the term).

If the applicant's response does not establish applicant's authority to control the mark, registration may be refused under Trademark Act Sections 4 and 45, [15 U.S.C. §§1054, 1127](#), on the ground that the application does not satisfy all of the statutory requirements for a certification mark because the applicant does not appear to exercise legitimate control over the use of the mark or does not have a bona fide intent to do so.

### **1306.05(b)(iii) Specimens**

Users of certification marks typically apply them to goods and services in a manner similar to trademarks and service marks. That is, certification marks appear on labels, tags, or packaging for goods, or on materials used in the sale or advertising of services. Thus, specimens of use in certification mark applications generally are examined using the same standards that apply to specimens for trademarks and service marks. See [TMEP §§904-904.07\(b\)\(i\)](#) regarding specimens for trademarks and [§§1301.04-1301.04\(j\)](#) regarding specimens for service marks. However, because it is improper for certification marks to be used by their owners, any specimen of use submitted in support of a certification mark application must show use of the mark as a certification mark by an authorized user. [37 C.F.R. §2.56\(b\)\(5\)](#). See [TMEP §1306.02\(a\)\(i\)\(B\)](#) for more information regarding specimens for certification marks.

Because geographic certification marks certify regional origin, and thus often consist primarily of a geographic term, they may appear in an inconspicuous fashion on specimens (*see* [TMEP §1306.05\(j\)](#), Examples 4 and 8) and they may not look the same as other types of certification marks, which typically include wording, such as "certified," or design elements, such as seals or similar matter. In other instances, the geographic certification mark may be the only mark displayed because the authorized user has chosen to market its goods or services without using a trademark or service mark. See [TMEP §1306.05\(j\)](#), Example 2. If the significance of the mark as used on the specimen is not apparent, the examining attorney may require the applicant, pursuant to [37 C.F.R. §2.61\(b\)](#), to explain the circumstances surrounding the use of the mark so that the examining attorney may determine whether the mark truly functions as a certification mark.

If the examining attorney concludes either that the specimen does not show the mark being used by a person other than the applicant or that the specimen does not demonstrate the mark functioning as a certification mark, registration should be refused under Trademark Act §§1, 2, 4, and 45, [15 U.S.C. §§1051, 1052, 1054, 1127](#). The applicant may overcome the refusal by submitting an acceptable substitute specimen or amending the filing basis to §1(b), if appropriate. *See* [TMEP §§806.03\(c\), 904.05](#).

### **1306.05(c) Mark Must Serve to Certify Geographic Origin**

When reviewing an application for a geographic certification mark, the examining attorney must consider the specimen of record and any other available evidence to determine whether the relevant consumers understand the designation as referring only to goods or services produced in the particular region identified by the term and not those produced elsewhere as well. Consumers need not be expressly aware of the certification purpose of a designation. It is sufficient that they would perceive the designation as an indication of a particular regional origin; if so, the designation functions as a geographic certification mark and is registrable. *See Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1483 (TTAB 2017).

However, if the available evidence shows that the relevant purchasing public perceives the primary significance of a term as identifying a type or category of the relevant goods or services, without regard to the origin of the goods or services or the methods and conditions for producing them, then the term is generic and does not serve to certify regional origin. See *Int'l Dairy Foods Ass'n v. Interprofession du Gruyère*, 2020 USPQ2d 10892, at \*21 (TTAB 2020); *Tea Bd. of India v. Republic of Tea, Inc.*, 80 USPQ2d 1881, 1887 (TTAB 2006). For example, the Trademark Trial and Appeal Board found that a mark did not function as a geographic certification mark for cheese because, although the identified cheese was originally produced in a particular part of Italy, the evidence showed that, to American purchasers, the word signifies a type of cheese with particular hardness, texture, and flavor characteristics, regardless of regional origin. *In re Cooperativa Produttori Latte E Fontina Valle D'Acosta [sic]*, 230 USPQ 131, 133-34 (TTAB 1986).

To determine whether the relevant designation in an applied-for geographic certification mark is generic, the examining attorney should undertake the same analysis as would be applied to any potentially generic matter. See [TMEP §1209.01\(c\)\(i\)](#) for further information.

The burden is on the examining attorney to establish a prima facie case that a designation is generic by providing a reasonable predicate (or basis) that the relevant purchasing public would primarily use or understand the matter sought to be registered to refer to genus of goods or services in question. Relevant evidence may include the following:

- product information from the applicant or the producers of the relevant goods or services;
- definitions in dictionaries or other reference materials;
- trade publications, newspapers, magazines, and other periodicals that use the term generically; and
- any other competent evidence of generic use of the term in the marketplace by producers and consumers.

*Int'l Dairy Foods Ass'n*, 2020 USPQ2d 10892, at \*18-22; *Tea Bd. of India*, 80 USPQ2d at 1887; *In re Cooperativa Produttori Latte E Fontina Valle D'Acosta [sic]*, 230 USPQ at 133-34; see also *Luxco, Inc.*, 121 USPQ2d at 1483-97 (holding opposer failed to establish genericness of TEQUILA, based on evidence that included federal regulations, advertising materials, product labels, recipes, news articles, retail-store signage, and consumer surveys). In addition, the fact that the term is commonly used to identify goods or services in third-party registrations may further support the conclusion that it is viewed in the relevant marketplace as generic, rather than as an indication of geographic origin. When considering the available evidence, the examining attorney must take particular care to distinguish evidence that shows true generic use of a designation from evidence that merely shows infringing or otherwise improper use of a certification mark.

When the certification mark consists solely of generic matter, or generic matter and other unregistrable matter, it should be refused under Trademark Act §§2(e)(1), 4, and 45, [15 U.S.C. §§1052\(e\)\(1\)](#), [1054](#), [1127](#), if registration is sought on the Principal Register. If registration is sought on the Supplemental Register, the statutory bases for refusal are §§4, 23, and 45, [15 U.S.C. §§1054](#), [1091](#), [1127](#). If the mark contains registrable matter in addition to the generic matter, the examining attorney must require a disclaimer of the generic matter. See [TMEP §1213.03\(b\)](#).

Even if a proposed mark is not generic, the applicant's specimen of use may fail to demonstrate that the mark functions as a certification mark, in which case registration should be refused under Trademark Act §§1, 2, 4, and 45. [15 U.S.C. §§1051](#), [1052](#), [1054](#), [1127](#). See [TMEP §1306.05\(b\)\(iii\)](#).

In response to a refusal on the ground that the mark is generic or otherwise does not function as a certification mark, an applicant may submit for the examining attorney's consideration any information or evidence that the applicant believes would support registration.

### **1306.05(d) Section 2(e)(2) Does Not Apply to Geographic Certification Marks**

Trademark Act §2(e)(2), [15 U.S.C. §1052\(e\)\(2\)](#), bars registration of primarily geographically descriptive marks, but specifically excludes from this prohibition those marks that serve as indications of regional origin. Thus, when a mark consists of or includes a geographic designation that functions to certify regional origin, the examining attorney must not refuse registration or require a disclaimer on the basis that the designation is primarily geographically descriptive of the goods or services. See *Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1482 (TTAB 2017); [TMEP §1210.09](#). However, a requirement to disclaim other matter in the mark may be appropriate. See [TMEP §1213.03\(b\)](#). For instance, for the geographic certification mark WISCONSIN CHEESE, which certifies that cheese products originate in Wisconsin, a disclaimer of the generic term “CHEESE” is appropriate.

### **1306.05(e) Geographically Deceptive Marks Not Registrable as Geographic Certification Marks**

A geographic certification mark that is geographically deceptive may not be registered on either the Principal or Supplemental Register and must be refused under Trademark Act §2(a), [15 U.S.C. §1052\(a\)](#), or §2(e)(3), [15 U.S.C. §1052\(e\)\(3\)](#), as appropriate. See [TMEP §1210.05](#) regarding geographically deceptive marks.

### **1306.05(f) Geographic Designations that Do Not Certify Regional Origin**

Sometimes, a geographic designation in a certification mark is not used to certify the geographic origin of the goods or services. For example, a certification mark includes the word “California,” but is used to certify that the fruits and vegetables to which it is applied are organically grown. The word “California” may or may not describe the geographic origin of the goods, but, in this instance, it is not being used to certify that the goods originate in California. If a geographic designation in a certification mark is primarily geographically descriptive of the goods or services, and the certification mark's purpose, as indicated by the certification statement, is to certify something other than geographic origin, the examining attorney must refuse registration under Trademark Act §2(e)(2), [15 U.S.C. §1052\(e\)\(2\)](#), or require a disclaimer, as appropriate. If a geographic designation in a non-geographic certification mark is geographically deceptive as applied to the goods or services, the mark must be refused under §2(a) [15 U.S.C. §1052\(a\)](#), or §2(e)(3), [15 U.S.C. §1052\(e\)\(3\)](#), as appropriate.

See [TMEP §§1210–1210.07\(b\)](#) for information on refusals under §§2(a), 2(e)(2), and 2(e)(3), including when it is appropriate to issue refusals in the alternative.

### **1306.05(g) Likelihood-of-Confusion Search and Analysis**

When comparing marks in a typical §2(d) likelihood-of-confusion analysis, terms that are geographically descriptive of the relevant goods or services are sometimes given less weight. See [TMEP §§1207.01\(b\)\(iii\)](#), [1207.01\(b\)\(ix\)](#). However, as indicated in [TMEP §1306.05\(d\)](#), a registered certification mark containing a geographic designation that functions to certify regional origin is not considered geographically descriptive. See [§15 U.S.C. §1052\(e\)\(2\)](#) (barring registration of any mark that is primarily geographically descriptive of goods or services, but providing an exception for indications of regional origin). Rather, it is treated as if it is distinctive because it serves to designate and certify the particular geographic origin of the relevant

goods or services. "Consequently, a registered geographic certification mark should not be considered 'weak' or subject to a narrower scope of protection." *In re St. Julian Wine Co.*, 2020 USPQ2d 10595, at \*5 (TTAB 2020) (citing *Inst. Nat'l Des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875, 1889-91 (TTAB 1998)).

Furthermore, the likelihood-of-confusion analysis is generally the same for certification marks as it is for trademarks or service marks, in that all of the relevant *du Pont* factors should be considered. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361-62, 177 USPQ 563, 567 (C.C.P.A. 1973) ; *In re Accelerate s.a.l.*, 101 USPQ2d 2047, 2049 (TTAB 2012) ; *Motion Picture Ass'n of Am. v. Respect Sportswear, Inc.*, 83 USPQ2d 1555, 1559 (TTAB 2007); *Inst. Nat'l Des Appellations d'Origine*, 47 USPQ2d at 1891; [TMEP §1306.04](#). "The classification as a certification mark 'has very little effect on [a] determination as to whether or not there is a likelihood of confusion.'" *In re St. Julian Wine Co.*, 2020 USPQ2d 10595, at \*3 (citing *In re Accelerate s.a.l.*, 101 USPQ2d at 2049)). However, "because a certification mark may not be used by the owner of the mark, but is instead used by authorized users, the analysis is based on the authorized users' goods [or services]" and their relevant trade channels and classes of consumers. *Id.*; see [TMEP §1306.04](#).

The following guidelines, which focus on the similarity-of-the-marks *du Pont* factor, are provided to aid the examining attorney in considering the issues when a likelihood-of-confusion search and analysis involves a geographic certification mark. The facts and evidence will vary in each application, affecting the relevance and weight of the various *du Pont* factors. But, for the purposes of these guidelines, assume that any other relevant *du Pont* factors, including the relatedness of the parties' goods and services, either support a finding that source confusion is likely or otherwise do not outweigh the factors that support such a finding.

### **1306.05(g)(i) Considerations When the Proposed Mark Is a Geographic Certification Mark**

When the application is for a geographic certification mark, the examining attorney should consider citing not only any prior mark with distinctive elements (e.g., suggestive, arbitrary, or fanciful wording, or distinctive design elements) that are confusingly similar to those in the applied-for geographic certification mark, but also any prior mark of any type that contains a geographic designation (whether disclaimed or not) that is confusingly similar to the designation in the applied-for mark.

Thus, if the geographic certification mark certifies that figs originate in Wyoming, and consists of a stylized cowboy hat above the wording WYOMING CERTIFIED (with CERTIFIED disclaimed), the potential cites may include (i) a geographic certification mark that is applied to Wyoming figs and is composed of the wording WYOMING'S OWN and (ii) a trademark that is applied to figs and consists of a cowboy-hat design that is nearly identical to the design in the applied-for mark.

Or, if the geographic certification mark certifies that pecans originate in Shenandoah County, Virginia, and consists of the wording SHENANDOAH COUNTY, potential cites may include (i) a trademark for roasted mixed nuts, consisting of the wording T.MARKEY'S SHENANDOAH MIXED NUTS (with SHENANDOAH MIXED NUTS disclaimed) and (ii) a trademark for pecans, composed of a stylized depiction of a pecan and the wording PETE'S PRICELESS PECANS OF SHENANDOAH (with PECANS OF SHENANDOAH disclaimed).

If there are numerous registrations and prior applications containing the same geographic designation (whether disclaimed or not) as the geographic certification mark, then, in the absence of the consent of the relevant registrants and applicants, a §2(d) refusal citing all of the relevant registrations and an advisory citing the prior applications may be appropriate. In addition, the examining attorney should consider refusing registration under Trademark Act §§4 and 45, [15 U.S.C. §§1054, 1127](#), on the basis that the application does not satisfy all of the statutory requirements for a certification mark because the applicant does not

appear to exercise legitimate control over the use of the applied-for mark. *See* [15 U.S.C. §1054](#); [37 C.F.R. §2.45](#); [TMEP §1306.04\(b\)\(i\)](#). The applicant may respond to these refusals by submitting information or evidence that supports registration, including information and evidence regarding the relationship between the applicant and the owners of the cited marks.

### **1306.05(g)(ii) Considerations When the Proposed Mark Contains a Geographic Designation but Is Not a Geographic Certification Mark**

When the application is for a mark that contains a geographic designation but is not a geographic certification mark, the examining attorney should consider citing not only any prior mark with distinctive elements (e.g., suggestive, arbitrary, or fanciful wording, or distinctive design elements) that are confusingly similar to those in the applied-for mark, but also any prior geographic certification mark containing a geographic designation that is confusingly similar to the geographic designation in the applied-for mark. Even if the geographic designation in the applied-for mark is not the dominant element, is relatively inconspicuous, or appears with a number of other elements, it may nonetheless be appropriate to cite a prior geographic certification mark that contains the same designation. By contrast, if there are no prior geographic certification marks containing the geographic designation, but there are numerous prior trademarks or service marks that contain and disclaim the designation, then a §2(d) refusal based on the fact that the respective marks share the designation is likely not appropriate.

As an example of the analysis when a prior geographic certification mark is involved, consider an applied-for mark that is used as a trademark for fresh bamboo shoots, consisting of the wording ZZZ BAMBOO in large lettering appearing above EVERGLADES in small lettering (with BAMBOO and EVERGLADES disclaimed). A potential cite might be a geographic certification mark consisting of the wording CERTIFIED EVERGLADES BAMBOO (with CERTIFIED and BAMBOO disclaimed), which certifies that live bamboo plants originate in the Everglades. Citing the prior geographic certification mark, and only that mark, may be appropriate even if there are also a few prior trademarks that contain the word EVERGLADES and are applied to bamboo products.

Of course, "if other matter in the applied-for mark changes the commercial impression of what might otherwise be a geographic designation (e.g., GEORGE WASHINGTON FRUITS vs. WASHINGTON STATE RAISINS), then that factor would weigh against citing prior marks containing the geographic term."

*In re St. Julian Wine Co.*, 2020 USPQ2d 10595, at \*5 (TTAB 2020) (quoting [TMEP §1306.05\(g\)\(ii\)](#) (affirming the guidance in this section); *see* [TMEP §1207.01\(b\)\(iii\)](#)).

Confusion as to sponsorship, affiliation, or connection may be likely even when the applicant's goods or services have been certified by the owner of the certification mark or would otherwise be considered genuine. *See Inst. Nat'l Des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875, 1890-91 (TTAB 1998). Thus, the mere fact that the applied-for mark is, or will be, applied to goods or services that originate in the relevant geographic region covered by a confusingly similar registered certification mark, and otherwise meet the certification standards of the registrant, is not, by itself, sufficient to overcome a §2(d) refusal. *See id.* at 1889-91.

### **1306.05(h) American Viticultural Areas**

American Viticultural Areas (AVA) are defined grape-growing regions in the United States, created on petition by interested parties through the federal rulemaking process. AVA designations appear on wine labels and "allow vintners and consumers to attribute a given quality, reputation, or other characteristic of a wine made from grapes grown in an area to its geographic origin." Thus, these designations facilitate the

accurate description of wine origins and aid consumers in identifying wines. *See* U.S. Dept. of the Treasury, Alcohol and Tobacco Tax and Trade Bureau, *American Viticultural Area (AVA)*, <https://www.ttb.gov/wine/american-viticultural-area-ava> (accessed Dec. 19, 2019). The currently recognized AVA designations can be found at **27 C.F.R. Part 9, Subpart C**. In addition, the Alcohol and Tobacco Tax and Trade Bureau of the U.S. Department of the Treasury provides an up-to-date alphabetical list of the designations at <https://www.ttb.gov/wine/established-avas> (June 3, 2020).

Where a mark is comprised of or contains an AVA designation, or if the specimen or other evidence of record indicates that the goods and/or services originate or are produced in an AVA, the examining attorney must require the applicant to submit an amended identification that references the relevant geographic designation or origin. The amended identification must indicate that the goods are made or produced, or the services feature goods made or produced, in accordance with certain, specific, or adopted standards.

The identification of goods and/or services should only contain the common commercial or generic name of the goods and/or services, using terminology that is generally understood by the average consumers in the United States. *See* [TMEP §1402.01](#). In addition, the identification should not include references to “protected appellation of origin” or other laws, rules, or regulations. *See generally*, [TMEP §1402.01](#). Therefore, if the identification contains the wording “American Viticultural Area,” the term “AVA,” or refers to a defined AVA designation, that wording generally should not be part of the identification of goods and/or services featuring those goods. In such cases, the examining attorney must issue an identification requirement instructing the applicant to submit an amended identification that is definite and complies with the USPTO identification practice. An applicant may not delete the reference to a geographic designation or origin entirely from the identification because such an amendment would impermissibly broaden the scope of the goods and/or services. *See* [TMEP §§1402.06, 1402.07](#). In general, the amended identification must indicate that the goods are made or produced, or the services feature goods made or produced, in accordance with certain, specific, or adopted standards. The language used to describe the goods and/or services should be understandable to the average person and should not require an in-depth knowledge of the relevant field. [TMEP §1402.01](#).

Examples of original identifications and the amended wording that may be recommended include the following:

<b><u>ORIGINAL ID</u></b>	<b><u>RECOMMENDED AMENDMENT</u></b>
Wine	Wines produced in {insert geographic name or region} in accordance with adopted standards
AVA grape wine	Wines made from grapes grown in {insert the geographic name or region} in accordance with specific standards
Wine complying with the characteristics of the Horse Heaven Hills AVA	Wines produced in Horse Heaven Hills, located within the Columbia Valley area of Yakima, Washington in accordance with adopted standards
Retail stores featuring Alexander Valley AVA wines	Retail store services featuring wines from the Alexander Valley area of Sonoma, California made in accordance with adopted standards
Wines derived from grapes grown in the Sta. Rita Hills AVA, labeled and advertised in compliance with U.S. AVA laws	Wines made from grapes from Santa Rita Hills, California in accordance with specific standards

Although AVA designations are similar to geographic certification marks in terms of their purpose and function, these designations raise complex issues when included in applied-for marks of any type. Thus, if an applied-for mark of any type contains an AVA designation, the assigned examining attorney must consult the Office of the Deputy Commissioner for Trademark Examination Policy before taking any action on the application.

### 1306.05(i) Geographic Certification Marks Containing §2(b) Matter

Trademark Act §2(b), [15 U.S.C. §1052\(b\)](#), bars the registration of marks that contain the flag, coat of arms, or other insignia of the United States, any state or municipality, or any foreign nation. If a geographic certification mark includes this matter, it must be refused registration. See [TMEP §§1204–1204.05](#) regarding refusing registration under §2(b).

### 1306.05(j) Examples of Geographic Certification Marks

#### *Example 1*

**Mark:** IDAHO (typed drawing)



#### **Specimen**

**Goods:** Potatoes and potato products, namely, fresh, frozen, refrigerated and dehydrated potatoes

**Certification Statement:** “The Certification mark, as used by authorized persons, certifies that goods identified by the mark are grown in Idaho and that the goods conform to quality, grade and other requirements, pursuant to standards designated by the Applicant.”

#### *Example 2*



### Mark



### Specimen

**Goods:** Potatoes and potato products, namely, fresh, frozen, refrigerated and dehydrated potatoes

**Certification Statement:** “The certification mark, as used by person[s] authorized by the certifier, certifies the regional origin of potatoes grown in the State of Idaho and certifies that those potatoes conform to grade, size, weight, color, shape, cleanliness, variety, internal defect, external defect, maturity and residue level standards promulgated by the certifier.”

*Example 3*

ROQUEFORT

**Mark**



**Specimen**

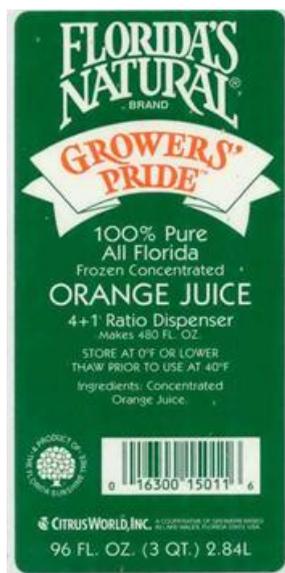
**Goods:** Cheese

**Certification Statement:** “The certification mark is used upon the goods to indicate that the same has been manufactured from sheep’s milk only, and has been cured in the nature caves of the community of Roquefort, Department of Aveyron, France.” See [TMEP §1306.05\(b\)\(i\)](#) regarding the preferred form and content of the certification statement.

*Example 4*



### Mark



### Specimen

**Goods:** Oranges; grapefruit, tangerines, orange juice; grapefruit juice; orange juice concentrate and grapefruit juice concentrate, both frozen and unfrozen; and citrus salad

**Certification Statement:** “The mark certifies that the goods bearing the mark either consist of citrus fruit grown in the state of Florida, under specified standards, or are processed or manufactured from or with such fruit.” See [TMEP §1306.05\(b\)\(i\)](#) regarding the preferred form and content of the certification statement.

*Example 5*

Mark: RECIOTO (standard characters)

**Specimen**

**Goods:** Alcoholic beverages, namely, wine

**Certification Statement:** “The certification mark, as used by persons authorized by the certifier, certifies a wine produced in the Valpolicella region of Italy.”

*Example 6***Mark**



### Specimen

**Goods:** Butter and cheese

**Certification Statement:** “The mark certifies that the goods are produced in Denmark and meet standards and quality established by applicant.” See [TMEP § 1306.05\(b\)\(i\)](#) regarding the preferred form and content of the certification statement

*Example 7*



### Mark



### Specimen

**Services:** “Retirement communities in Texas, development of retirement communities in Texas, and retirement homes in Texas”

**Certification Statement:** “The certification mark, as used or intended to be used by persons authorized by the certifier, certifies that the services provided originate in the State of Texas, and meet community, tax, housing, safety, employment, healthcare, public transportation, educational, leisure, and recreational standards as set by the certifier.”

*Example 8*

**Mark****Specimen****Goods:** Tea

**Certification Statement:** “The certification mark, as used by persons authorized by certifier, certifies that a blend of tea contains at least sixty percent (60%) tea originating in the Darjeeling region of India, and that the blend meets other specifications established by the certifier.” See [TMEP §1306.05\(b\)\(i\)](#) regarding the preferred form and content of the certification statement.

*Example 9***Mark:** VIDALIA (typed drawing)



## Specimen

**Goods:** Fresh onions

**Certification Statement:** “The certification mark is intended to be used by persons authorized by certifier, and will certify that the goods in connection with which it is used are yellow Granex type onions and are grown by authorized growers within the Vidalia onion production area in Georgia as defined in the Georgia Vidalia onion act of 1986.”

## 1306.06 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, pursuant to [37 C.F.R. §2.61\(b\)](#), for further explanation as to the activities in which the mark is or will be used and for the disclosure of facts regarding the mark to enable a proper examination to be made. 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.

### 1306.06(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 *Am. Speech-Language-Hearing Ass’n v. Nat’l Hearing Aid Soc’y*, 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 §1306.04\(d\)\(ii\)](#). 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.

### **1306.06(b) Amendment to Different Type of Mark**

If a certification mark application is filed but the mark is actually another type of mark, or if an application for another type of mark is filed but it is actually a certification mark, the application may be amended to request registration as the proper type of mark. Also, the application should be re-executed because some essential allegations differ for the different types of marks.

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

See [TMEP §1306.04\(d\)\(i\)](#) regarding appearance of a trademark or service mark in a certification mark or on a specimen, [§1306.04\(b\)\(ii\)](#) regarding related company use, and [§1306.04\(b\)\(iii\)](#) regarding use under a patent license.

### **1306.06(c) 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 *Am. Speech-Language-Hearing Ass'n v. Nat'l Hearing Aid Soc'y*, 224 USPQ 798 (TTAB 1984) ; *Nat'l Trailways Bus Sys. v. Trailway Van Lines, Inc.*, 269 F. Supp. 352, 155 USPQ 507 (E.D.N.Y. 1965) .