

Submission of the United States of America Certification and Collective Marks Formalities

I. The Examination of Certification Mark Applications

In the United States, the Lanham Act provides for the registration of certification marks.¹ A “certification mark” is defined 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.²

There are three types of certification marks: (1) marks used to indicate regional or other origin of the goods or services, (2) marks used to indicate material, mode of manufacture, quality, accuracy or other characteristics of the goods or services, and/or (3) marks used to indicate that the work or labor on the goods or services was performed by a member of a union or other type of organization. These types are not mutually exclusive. All are used in commerce by a person other than the owner of the mark. Clearly, certification marks are not trademarks or service marks in the traditional sense.

Certification mark applications require different and additional allegations and supporting documents than trademark and service mark applications and are therefore subject to more procedural requirements. However, the standards used in considering the procedural requirements and potential statutory refusals in the examination of any trademark or service mark are applicable in certification mark applications, with the exception of refusals based on primarily geographic terms.

¹ U.S. Trademark Act of 1946, 15 United States Code (U.S.C.) §1054 (Section 4 of the Lanham Act)

² 15 U.S.C. §1127

A. The Drawing Page Showing the Certification Mark, Comparison of the Certification Mark on the Drawing and the Specimen, and the Examining Attorney’s Search of Office Records

1. The Drawing Page Showing the Certification Mark

The drawing of the mark in a certification mark application is subject to the same standards used in relation to the examination of trademark and service mark drawings.³ These standards include, *inter alia*, a requirement for a standard character claim or, for marks in “Special Form,” requirements for a clear image of the mark, a written and accurate description of the design elements and/or words in the mark, as well as a claim of any colors that appear in the mark.

The Lanham Act does not require that a certification mark appear in any particular format or include any specific wording. Certification marks can consist of wording only, design only, or a combination of wording and design. The drawing in the certification mark application must include the entire certification mark and should not include any matter that is not part of the certification mark.

2. Comparison of the Mark on the Drawing and the Specimen

The examining attorney will also refer to the specimen of use⁴ and compare the certification mark on the specimen to the mark shown on the drawing.

For an application based on use in U.S. commerce, the mark on the drawing must be a substantially exact representation of the mark as used on or in connection with the goods and/or services certified, as shown by the specimen. If the examining attorney finds the two differ, minor amendments to the drawing page are acceptable. However, material alterations to the drawing of the mark to make it conform with the mark on the specimen are not permitted. The applicant can file substitute specimens or amend the application from a use in commerce basis to an intent to use basis. Ultimately, the applicant must provide a specimen showing a substantially exact representation of the mark shown on the drawing used on or in connection with the goods and/or services certified in order to receive a registration.

For an application filed under Paris Article 6quinquies⁵, the drawing of the mark in a United States application must be a substantially exact representation of the mark that appears in the foreign registration. This is a stricter standard than the standard used to determine whether a specimen supports use of a mark in an application based on use in U.S. commerce. When the mark on the drawing does not agree with the mark on the

³ Trademark Manual of Examining Procedure (TMEP) §§807 et seq.

⁴ 15 U.S.C. §1051(a)(1) (specimens of use in U.S. commerce are required prior to issuing a registration, in the case of use-based and intent-to-use based applications. Specimens of use are required for maintenance of registrations issued under Paris Convention provisions.)

⁵ 15 U.S.C. §1126(e)

foreign registration, the applicant cannot amend the drawing of the mark if the amendment would materially alter the mark on the original drawing.

The drawing of the certification mark, compared to the application documents and evidence obtained by the examining attorney may raise other issues as well, such as the meaning of a particular term in the certification mark to a particular industry or as applied to the certified goods/services, the translation of a foreign term, the transliteration and translation of non-English characters, the improper use of a registration symbol or the use of the wording TM or SM on the drawing itself, etc. If supported by evidence, the examining attorney will require a disclaimer of any portion of a mark which is merely descriptive or generic of the goods and/or services certified or the certification program itself. The examining attorney will inquire as to these issues, as applicable, in an Office Action.

3. The Examining Attorney's Search of Office Records

The examining attorney will search the Office records for any similar registered or pending marks which would bar registration.⁶ The examining attorney will provide a statement regarding the results of this search in an Office Action or Examiner's Amendment.

By its very nature, this search of the Office records will include a search to determine if the applicant has also registered, or applied to register, the certification mark as a trademark or service mark. The ramifications of the results of this search are discussed below.

B. Ownership Issues

The examining attorney will look to see if the owner of the certification mark filed the application. This information is obtained from the application itself. An application to register a mark must be filed by the owner of the mark or, in the case of an intent-to-use application by the person who is entitled to use the mark in commerce.⁷ In the United States, the owner of a mark can be any person, nation, state, municipality or any other legal entity who exercises legitimate control over the use of the mark.⁸ If the application is filed in the name of a party who had no basis for asserting ownership as of the filing date, the application is void, and the examining attorney will refuse registration.

As defined in the statute, the owner of a certification mark is *not* the end-user of the certification mark. Instead, the owner is that party responsible for the certification, or seal of approval, that is ultimately conveyed to consumers by the mark. In other words, the owner of a certification mark is the certifier, be they a person, nation, state, municipality or any other legal entity exercising legitimate control over the use of the

⁶15 U.S.C. §1052(d)

⁷ 15 U.S.C. §1051(b)

⁸ 15 USC § 1054

certification mark regardless of the *type* of certification mark. Therefore, the application must indicate the name of the certifier as the owner of the certification mark.

The application must also indicate the type of entity that is applying, for example, an individual, partnership, corporation, joint venture, or association. Note that the word “company” is acceptable to identify entities organized under the laws of certain foreign countries that are equivalent or analogous to United States corporations or associations. For foreign applicants, the Office will accept the identification of an applicant’s entity type if that entity type is recognized by the applicant’s state/country of domicile.

The application must also indicate the applicant’s state (or country if outside the United States of America) of citizenship for individuals, or the state (or country if outside the United States of America) under whose laws it was formed.

The applicant must provide its mailing address which will be included on the registration certificate should the certification mark be registered.

Finally, for marks used to certify geographic origin, it is important to note that the statute does *not* prohibit an individual or private organization from owning and registering such marks. While a governmental entity is often in the best position to establish and regulate standards for certification for marks used to indicate geographic origin, to control the use of the mark, etc., the statute does not require that a governmental entity be the owner of marks used to indicate geographic origin. The statute permits trade associations, individuals or other private entities to register such marks provided they comply with all of the certification mark application requirements. Nevertheless, when a certification mark consists solely, or essentially, of a geographical term, the examining attorney will inquire as to the authority of the applicant to control the use of the term, if such authority is not obvious from the application record.

C. Identification of Goods and Services, Classification of Goods and Services, and Filing Fees in Certification Mark Applications

1. Identifications of Goods and Services

The examining attorney will determine if the identification of the certified goods and/or services meets the USPTO’s requirements for identifications. For certification mark applications, the applicant must indicate the general kinds of goods and services that are certified, such as food, agricultural commodities, electrical products, textile materials, printed material, or insurance agency services, machinery repair, restaurant services. While the level of specificity required in certification mark applications is not as high as identifications in trademark or service mark applications, if the applicant’s certification program is limited to specific goods or services, for example, wine, wood, doors, bakery machinery, etc., then the identification in the application should be more specific and be limited to these specific goods or services. If the examining attorney determines that the identification of the certified goods or services is deficient, the examining attorney will require an amendment and offer suggestions in an Office Action issued to the applicant.

2. Classification of Goods and Services

When classifying the goods or services, the USPTO recognizes that certification marks are commonly used on a great variety of goods and services, and the specialized purpose of certification marks makes it unrealistic to divide the goods and services into the competitive groups that the regular International Classes represent. Therefore, for certification mark applications in the United States, all goods are classified in Class A and all services are classified in Class B. Both Classes A and B may be included in one application. No other International Classifications are permitted in certification mark applications, with the exception of applications designating the United States under the Madrid Protocol.

For certification mark applications designating the United States via the Madrid Protocol, classification is determined by the International Bureau of the World Intellectual Property Organization (IB), in accordance with the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice Agreement). Classes A and B are not included in the international classification system. As with any Madrid application, the international classification of goods/services cannot be changed from the classification given to the goods/services by the IB.⁹ Accordingly, if the mark in a Madrid application appears to be certification mark, it will be examined as such. Nevertheless, the applicant must comply with all other requirements for certification marks filed in the United States.

3. Filing Fees

The USPTO will determine if the applicant paid the appropriate minimum filing fee (at least one class) at the time of filing. Fees can be paid by credit card, check, money order, electronic funds transfer (EFT), or by an authorization to charge a deposit account. If an application does not include a filing fee or if the filing fee is returned to the Office as unpaid, the USPTO will deny the filing date and provide notice to the applicant that the application will not be processed. For applications that include *both* Classes A and B, at least one fee must be paid before an application can be given a filing date.

In the case of an intent-to-use application, additional filing fees will be due at the time of filing of an Amendment to Allege Use or a Statement of Use.

If any additional filing fees are due during the examination of a certification mark application, the examining attorney will contact the applicant to obtain the authorization to deduct the additional fees from the applicant's deposit account or issue the requirement in an Office Action. All filing fees must be paid before the examining attorney will approve an application for publication (or registration).

However, in a Madrid application, the examining attorney will not require additional fees during examination because the filing fee(s) for the application will be sent to the USPTO by the IB, pursuant to Article 8 of the Madrid Protocol.

⁹ TMEP §1401.03(d)

D. Statement of What the Mark Certifies

A certification mark application must contain a separate statement of the characteristics, standards, or other features of the goods or services that are certified or intended to be certified by the mark. All of the characteristics or features, whatever they might be, that the mark certifies should be included in the statement and explained in reasonable detail, so that they are clear. This statement identifies the type of certification mark in the application. How specific the statement should be depends in part on the narrowness or breadth of the certification. The actual standards do not have to be identified in the statement but broad terms, such as “quality,” “material,” “mode of manufacture,” will be rejected because these terms, by themselves do not accurately reveal the nature of the certification. The applicant must identify those specific qualities or characteristics of the goods or services that are certified under the mark.¹⁰

The statement should be written as follows:

The certification mark, as used by persons authorized by the certifier, certifies that the goods and/or services provided have _____ (e.g., that the products come or originate from Argentina, the authorized persons are raising bulls and heifers using certifier's vaccines and following certifier's protocols, that a residential structure has met the certifier's quality standards for water and air purification through the use and installation of certain water and air purification products, the purity of a strain of seed, etc.)

The statement will be printed on any registration certificate that may ultimately issue from the USPTO.

The examining attorney will examine the certification statement to make sure it is accurate and clear, given the information in the record. If the examining attorney determines that more detailed specifications about the characteristics, standards, or other features of the goods or services certified are required from the applicant to ensure clarity for interested third parties, the requirement will be made in an Office Action.

E. Bases for Filing a Certification Mark Application

There are five application filing bases in the United States: (1) use of a mark in commerce¹¹; (2) bona fide intention to use a mark in commerce¹²; (3) a claim of priority, based on an earlier-filed foreign application¹³; (4) ownership of a registration for the

¹⁰ 37 Code of Federal Regulations (C.F.R.) §2.45

¹¹ 15 U.S.C. §1051(a) (Section 1(a) of the Lanham Act)

¹² 15 U.S.C. §1051(b) (Section 1(b) of the Lanham Act) (For a Section 1(b) application, before the mark can register, the applicant must file an amendment to allege use under 15 U.S.C. §1051(c) or a statement of use under 15 U.S.C. §1051(d), and include a statement alleging that the applicant is exercising legitimate control over the use of the certification mark in commerce.)

¹³ 15 U.S.C. §1126(d) (Section 44(d) of the Lanham Act)

mark in the applicant's country of origin¹⁴; and (5) extension of protection of an international registration to the United States.¹⁵

An applicant is not required to specify a basis for filing to receive a filing date. Where an application does not specify a basis at the time of filing, the examining attorney will require in the first Office Action that the applicant specify the basis for filing and submit all the elements required for that basis. The applicant must specify and meet the requirements of one or more filing bases before the mark will be approved for publication for opposition or registration on the Supplemental Register.¹⁶ In a Madrid application, the basis for filing will have been established in the international registration on file at the IB.

F. Statement that the Owner is Exercising Legitimate Control

In an application based on use in commerce, the applicant must assert in a statement in the application that as the owner of the certification mark, it is exercising legitimate control over the use of the certification mark in commerce.¹⁷ In applications based on intent to use, the applicant must assert that the applicant has a bona fide intention to exercise legitimate control over the use of the certification mark in commerce.¹⁸ This statement usually appears in the filing basis section of the application and may appear again in the declaration.

Since certifying organizations grant authority to others to use their certification marks, statements such as "applicant is using the mark" or "applicant intends to use the mark" are improper and fail to show that the applicant is exercising or will exercise legitimate control over the use of the certification mark in commerce by others.

Where the statement is lacking or omitted the examining attorney will require that the statement be written in the proper form. Where the record is unclear as to whether or not the applicant actually exercises legitimate control over the use of the certification mark in commerce, the examining attorney will require an explanation and sufficient disclosure of facts and/or evidence to support the applicant's statement regarding the exercise of control over the use of the mark.¹⁹

¹⁴ 15 U.S.C. §1126(e) (Section 44(e) of the Lanham Act)

¹⁵ 15 U.S.C. §1141f(a); 37 C.F.R. §2.34 (Section 66(a) of the Lanham Act)

¹⁶ 37 C.F.R. §2.32(a)(5)

¹⁷ 37 C.F.R. §2.45(a)

¹⁸ 37 C.F.R. §2.45(b) (For a Section 1(b) application, before the mark can register, the applicant must file an amendment to allege use under 15 U.S.C. §1051(c) or a statement of use under 15 U.S.C. §1051(d), and include a statement alleging that the applicant is exercising legitimate control over the use of the certification mark in commerce.)

¹⁹ 37 C.F.R. §2.61(b)

G. Use by Others Indicated in Dates-of-Use Clause

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

The suggested format for this statement is as follows:

Applicant is exercising (or “has a bona fide intention to exercise”) legitimate control over the use of the certification mark in commerce and has been exercising(or “has a bona fide intention to exercise”) legitimate control over the use of the mark in commerce since the filing date of the application.

If the dates of use in the application refer to use *by the applicant* rather than use by the parties authorized to use the certification mark, the examining attorney will require that the applicant amend the dates of use to refer to use *by the parties authorized by applicant to use the mark*. Applicant must verify this amendment with an affidavit or a signed declaration.²⁰

H. Statement That the Mark is Not Used by Applicant

A trademark or service mark is used by the owner of the mark on his or her goods or services to indicate the source of the goods/services, whereas a certification mark is used by persons other than the owner of the mark to certify 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. Therefore, the certification mark application should contain a separate statement that the applicant is not engaged in or will not engage in the production or marketing of the goods or services to which the mark is applied.²¹

The suggested format for this statement is as follows:

Applicant is not engaged (or will not engage) in the production or marketing of the goods or services to which the mark is applied.

As discussed above, the examining attorney’s search of the Office records includes a search to determine if the applicant registered, or filed a pending application to register, the certification mark as a trademark or service mark. If the examining attorney finds that the applicant is engaged in the production or marketing of any goods or services to which the certification mark is applied, registration will be refused.²² To proceed with the registration of the certification mark application, the examining attorney will require

²⁰ 37 C.F.R. §2.20; 37 C.F.R. §2.71(c); TMEP §903.05

²¹ 37 C.F.R. §2.45

²² 15 U.S.C. §§1054 and 1064(5)(B) (Sections 4 and 14(5)(B) of the Lanham Act)

the applicant to surrender its registration (or abandon its pending application) for the same mark for goods or services.²³ In this situation, the record must be clear and uncontradicted that the certification mark is no longer registered *or* used as a trademark or service mark.

I. Standards

The applicant must also submit an actual copy of the written standards established to determine whether others may use the certification mark on their goods and/or in connection with their services.²⁴ In the case of an intent-to-use application, the standards are submitted with the amendment to allege use or the statement of use.²⁵ These standards will become a part of the application record.

The standards do not have to originate from the owner and may be established by another party, such as specifications promulgated by a government agency, or standards developed through research of a private research organization.

The examining attorney will review the copy of the written standards to determine if the applicant is engaged in a certification program. If the standards are not provided or do not support the conclusion that the applicant is engaged in a certification program, the examining attorney will issue a requirement that the applicant provide a copy of standards showing a certification program in an Office Action.

The examining attorney will not perform any other additional investigation into the applicant's administration of its certification program standards, other than an examination of the applicant's written certification program standards. In other words, the examining attorney will not require any governmental or other outside verification of the applicant's certification standards. Such additional information and evidence is not required to demonstrate the certification program. The standards are provided under declaration and presumed valid, if they show that the applicant is engaged in a certification program. If any person seeking certification meets the standards and is refused use of the certification mark, they may file a petition for cancellation of that certification mark.²⁶

J. Specimens of Use for Certification Marks

The same standards used to evaluate trademark and service mark specimens also apply to certification marks.²⁷ In addition to comparing the mark as it appears on the drawing page and the specimen, as discussed above, the examining attorney also will examine the certification mark specimens to see if and how they show the certification mark used in commerce by a person other than the owner of the mark to indicate (1) regional or other

²³ 15 U.S.C. §1057(e) (Section 7(e) of the Lanham Act)

²⁴ 37 C.F.R. §2.45

²⁵ 37 C.F.R. §2.45(b)

²⁶ 15 U.S.C. §1064 (Section 14(5) of the Lanham Act)

²⁷ TMEP §§904 et seq.

origin of the goods or service, (2) material, mode of manufacture, quality, accuracy or other characteristics of the goods or services, and/or (3) that the work or labor on the goods or services was performed by a member of a union or other type of organization.

Generally, materials that bear the mark, and are actually attached or applied to the goods or used in relation to the services by the persons authorized to use the mark, constitute proper specimens. Common examples of specimens for certified goods include labels, tags, packaging or other indicia used on or in connection with the goods, showing the certification mark displayed in a manner that indicates that the goods have been certified. Note that tags or labels prepared by the certifier and supplied to authorized users to attach to their goods or use in relation to their services are acceptable specimens. Common examples of specimens for certified services include advertisements, promotional materials, business cards, patches or pins, or other matter showing the certification mark in a manner that indicates that the services have been certified.²⁸

If the examining attorney determines that the specimen(s) fails to show use of the applied-for mark as a certification mark, the examining attorney will issue an Office Action refusing registration.²⁹ Moreover, if the specimens do not indicate use as a certification mark, it is possible for the applicant to amend the application to a trademark application.

The Office Action will explain the specific reasons why the specimen is deficient and require the applicant to submit:

(1) A substitute specimen that shows proper certification mark use for the goods and/or services in the application; and

(2) One of the following statements, as appropriate to the circumstances, verified with an affidavit or signed declaration³⁰: “The specimen was in use in commerce at least as early as the filing date of the application.”³¹; “The substitute specimen was in use in commerce prior to the filing of the amendment to allege use.”³²; or “The substitute specimen was in use in commerce prior to the expiration of the time allowed applicant for filing a statement of use.”³³ Note that if the submission of a substitute specimen requires an amendment to the dates of use, the applicant must also verify the amended dates of use.³⁴

For use-based applications, if the applicant cannot satisfy these requirements, the examining attorney will accept the applicant’s properly verified amendment of the filing

²⁸ TMEP §1306.06(c)

²⁹ 15 U.S.C. §§1051-1052, 1054, 1127

³⁰ 37 C.F.R. §2.20

³¹ 37 C.F.R. §2.59(a)

³² 37 C.F.R. §2.59(b)(1)

³³ 37 C.F.R. §2.59(b)(2); TMEP §904.05

³⁴ 37 C.F.R. §2.71(c)

basis to intent to use. Where this issue arises from the specimens provided in an Amendment to Allege Use, the applicant may withdraw the Amendment to Allege Use. However, at no point may an applicant withdraw a Statement of Use.³⁵

K. Signed Verification

An application must also include a statement that is verified by the applicant or by someone who is authorized to verify facts on behalf of an applicant.³⁶ The format of the verification in an application may be: (1) the classical form for verifying, which includes an oath (jurat)³⁷; or (2) a declaration instead of an oath.³⁸

Declarations are the most common forms of verifications used by applicants.³⁹ For certification mark applications, the typical declaration would appear in the application as follows:

The undersigned being hereby warned that willful false statements and the like are made punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that s/he is properly authorized to execute this application on behalf of applicant; that s/he believes applicant to be the owner of the certification mark sought to be registered, or if the application is filed under 15 U.S.C. §1051(b) or §1126, that s/he believes applicant has been exercising legitimate control or has been entitled to exercise legitimate control over the use of the mark in commerce as of the filing date of the application; that, to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the above identified mark in commerce, 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, to cause confusion, or to cause mistake, or to deceive; and that all statements are made of his/her own knowledge are true and that all statements made on information and believe are believe to be true.

Date:

Signature:

Print or Type Name and Position of Signatory

The examining attorney will review the entire declaration and confirm that it is in fact one that refers to certification marks and the owner's exercise of legitimate control.

³⁵ 37 C.F.R. §2.88(g); TMEP §1109.17

³⁶ 15 U.S.C. §§1051(a)(3) and 1051(b)(3); 37 C.F.R. §§2.32(b) and 2.33(a)

³⁷ TMEP §804.01(a)

³⁸ 37 C.F.R. §2.20 or 28 U.S.C. §1746

³⁹ 37 C.F.R. §2.20 or 28 U.S.C. §1746

Regarding the signatory, the definition of a “person properly authorized to sign on behalf of an applicant” is set forth in regulations, but the Lanham Act does not specify the appropriate person to verify facts on behalf of an applicant.⁴⁰ Generally, the Office presumes that the verification or declaration is properly signed and does not question the authority of the person who signs a verification, unless there is an inconsistency in the record as to the signatory’s authority to sign.

An application can be filed unsigned since a signed verification is not required for receipt of an application filing date.⁴¹ However, if the initial application does not include a properly verified statement, the examining attorney will require the applicant to submit a verified statement that relates back to the original filing date.

In applications under Madrid, the verified statement is part of the international registration on file at the IB.⁴²

L. Typical Bars to Registration

Generally, the same standards applicable to the examination of any trademark or service mark are used in considering issues such as likelihood of confusion, descriptiveness, ornamentation, configuration, functionality, surnames, etc., with the exception of primarily geographic terms in certification marks.

Primarily geographic terms are registrable as complete or part of a certification mark *without* a disclaimer or a resort to secondary meaning when they are used to certify regional origin and the application record shows that the public understands that goods bearing the mark come only from the region named in the mark.⁴³ Marks that are geographically *deceptive* may not be registered as a certification mark of regional origin.

M. Other Registration Issues Particular to Certification Marks

In addition, the following grounds for cancellation of a certification mark are applicable to *ex parte* examination:⁴⁴

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

⁴⁰ 37 C.F.R. §2.33(a)

⁴¹ 37 C.F.R. §2.21(a)

⁴² 37 C.F.R. §2.33(e)

⁴³See Section 2(e)(2), 15 U.S.C. §1052 (e)(2), which prohibits registration of primarily geographically descriptive terms (or symbols) and *but specifically excepts* “indications of regional origin” registrable under Section 4 of the Lanham Act, 15 U.S.C. §1054. See also *Institut National Des Appellations D’Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875 (TTAB 1998).

⁴⁴ 15 U.S.C. §1064 (Section 14(5) of the Lanham Act)

...

(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.

Thus, in *ex parte* examination, certification mark applications are *also* subject to refusal on any or all of the grounds set forth as grounds for cancellation of an existing registration. As a practical matter, in *ex parte* examination the examining attorney will examine these issues as follows:

1. 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 of the certification mark.⁴⁵ Such statement is accepted unless the examining attorney has knowledge of facts indicating that it should not be accepted.

2. Applicant is not engaged 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.⁴⁶ Such statement is accepted unless the examining attorney has knowledge of facts indicating the contrary, such as the applicant's registration or pending application for the same mark.

⁴⁵ TMEP §1306.06(g)(iii)

⁴⁶ TMEP §1306.06(g)(v)

3. Applicant does not permit use of the certification mark for purposes other than to certify

A certifier may not permit the 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 an examining attorney's province and cannot be used as a basis for a refusal to register, provided that use authorized by the applicant, as supported by the record, shows proper certification use.

4. Applicant does not discriminately refuse to certify

The certification mark owner cannot discriminately refuse to certify. The Office has never undertaken to evaluate, in *ex parte* examination, whether the standards or characteristics which the mark certifies, as set out by the applicant, are discriminatory *per se*; nor is it in the province of *ex parte* procedure to investigate or police how the certification is practiced. Instead, if a party seeks to use a certification mark on its goods or in connection with its services, and the party's goods and/or services meets the certifier's standards, and the certifier refuses the party's use of the certification mark, the party may petition to cancel the registration of the certification mark on the grounds that the mark owner discriminately refuse to certify.

II. The Examination of Collective Mark Applications

In the United States, 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.⁴⁷

There are two types of collective marks: (1) collective trademarks or collective service marks; and (2) collective membership marks. For collective trademarks or collective service marks, members of a collective organization use the mark to identify their own goods and/or services and distinguish them from those of non-members. On the other hand, a collective membership mark is used *only* to indicate membership in the collective organization, and is not used to identify and distinguish any goods or services.⁴⁸

⁴⁷ 15 U.S.C. §1127 (Section 45 of the Lanham Act)

⁴⁸ *In re Int'l Institute of Valuers*, 223 USPQ 350 (TTAB 1984)

Note that collective marks are distinguished from certification marks. A cooperative, *i.e.*, an association or other collective group or organization, holds title to a collective mark on behalf of its members. The members of the cooperative use the mark to either identify and distinguish their goods and/or services from those of non-members or to indicate membership in the collective organization.⁴⁹ A certification mark *certifies* the characteristics or quality of goods and/or services but may not necessarily serve to identify the source of the goods and/or services provided by members of an organization or to indicate membership in the collective organization.⁵⁰ Unlike for certification marks for regional origin, applications for collective marks consisting entirely of geographically descriptive matter must demonstrate acquired distinctiveness in order to be registered.

For collective mark applications, generally, the same standards for the examination of trademark and service mark applications are used in considering standard procedural requirements and statutory refusals. However, since ownership and use requirements are slightly different due to the nature of collective marks, these applications require different and additional allegations and supporting documents than regular trademark and services mark applications. Those ownership requirements, use requirements, and additional application elements are reviewed during the examination process as discussed below.

A. Collective Trademarks and Collective Service Marks

1. Ownership of Collective Trademarks and Collective Service Marks and Use

A collective mark must be owned by a collective entity even though the mark is used by the *members* of the collective. As with traditional trademark and service mark applications, the examining attorney will look to the application to determine the name of the applicant, its type, its citizenship, and address. The examining attorney will review the complete application record to ensure that the correct party is identified as the owner of the application.

2. Identification and Classification of Goods and Services in Collective Trademark and Collective Service Mark Applications and Filing Fees

a. Identification of Goods and Services

An applicant is required to list the goods and/or services of the members of the collective. The same standards for identification of goods and services in trademark and service mark applications apply to identifications in collective trademark and service mark applications. If the examining attorney finds the identification indefinite or incomplete, the examining attorney will require that the identification be amended and may offer suggestions to correct the deficiencies.

⁴⁹ 15 U.S.C. §1127 (Section 45 of the Lanham Act); TMEP §§1303 and 1306

⁵⁰ *In re Safe Electrical Cord Committee*, 125 USPQ 310 (TTAB 1960)

b. Classification of Goods and Services

The goods and services recited in collective trademark and collective service mark applications are assigned to the same classes that are appropriate for those goods and services when identified in a trademark or service mark application.

c. Filing Fees

The examining attorney will determine if the applicant paid the appropriate minimum filing fees (at least one class) at the time of filing. Fees can be paid by credit card, check, money order, EFT, or by an authorization to charge a deposit account. If any additional filing fees are due during examination, the examining attorney will contact the applicant to obtain the authorization to deduct the additional fees from the applicant's deposit account or make the requirement in an Office Action. In the case of an intent-to-use application, additional filing fees will be due at the time of filing of an Amendment to Allege Use or a Statement of Use. All filing fees must be paid before the examining attorney approves an application for publication (or registration).

In a Madrid application, the examining attorney will not require additional fees during examination because the filing fee(s) for an application will be sent to the USPTO by the IB, pursuant to Article 8 of the Madrid Protocol.

3. Special Elements of Collective Trademarks and Collective Service Marks Applications

a. Manner of Control of the Collective Mark

In addition to specifying and containing the elements that are applicable for trademark and service mark applications, an application for registration of a collective mark must specify for the record how the applicant controls (or intends to control) the use of the mark by the members of the organization.⁵¹

If the applicant's bylaws or other written provisions specify the manner of control, then the applicant should simply state so for the record. If there are no written provisions governing the control, then the applicant should explain in writing how it controls use of the mark by the members.⁵² The following format is acceptable:

Applicant controls (or applicant intends to control) the use of the mark by the members in the following manner: _____.

If the applicant fails to provide this information, or if the information is confusing or found lacking, the examining attorney will require that the applicant provide a clear statement.

⁵¹ 37 C.F.R. §2.44(a) and (b)

⁵² TMEP §1303.02(c)(i)

b. Basis Asserted Must Include a Statement that the Owner is Exercising Legitimate Control

Like trademarks and services marks, collective trademarks and collective service marks indicate the commercial origin of goods or services; but, as collective marks they indicate that the party *providing* the goods or services is a member of a certain group and meets its standards for admission to the group. Therefore, in collective trademark and collective service mark applications, it is inaccurate for the applicant to assert that it “has adopted the mark and is using the mark in commerce” or that the applicant “has a bona fide intention to use the mark in commerce.” Rather, applicant must assert that it is exercising, or has a bona fide intention to exercise, legitimate control over the use of the mark.

The suggested format is as follows:

Applicant is exercising (or “has a bona fide intention to exercise”) legitimate control over use of the mark in commerce by its members, and has been exercising (or “has had a bona fide intention to exercise”) legitimate control over use of the mark in commerce as of the filing date of the application.

If the applicant fails to provide this statement, the examining attorney will include in an Office Action a requirement that the applicant provide this statement.

c. Dates of Use Clause Must Refer to Use by Members

The dates-of-use clause can not refer to use by the applicant. As a collective mark, the members are the actual users of the mark, not the applicant.⁵³ Therefore, applicant must provide a dates-of-use clause asserting dates of use of the mark *by the members*. If the applicant fails to provide this information, the examining attorney will require that applicant amend the dates-of-use clause to indicate use by the applicant’s members, verified with an affidavit or a signed declaration.⁵⁴

The following format is acceptable for the dates-of-use clause in a collective trademark or collective service mark application:

The date of first use by the members is __/__/____; and the date of first use in commerce by the members is __/__/____.

4. Specimens of Use in Collective Trademark and Collective Service Mark Applications

The examining attorney will review the specimens of record to determine if the collective trademark or collective service mark is used by a member on the member’s goods or in

⁵³ TMEP §§1303.01 and 1303.02(c)(ii)

⁵⁴ 37 C.F.R. §2.20. 37 C.F.R. §2.71(c)

the sale or advertising of the member's services, as opposed to use of the mark by the applicant or an improper use as a certification mark. A specimen for a collective trademark or service mark should show use of the mark by a member on the member's goods or in the sale or advertising of the member's services.⁵⁵

Common examples of specimens for goods include tags, labels, packaging, and photographs showing the collective trademark on members' goods or packaging for the goods. Common examples of specimens for services include brochures, advertisements, or website printouts showing the mark used in the sale or advertising of members' services.

If the examining attorney determines that the specimens of record fail to show proper collective trademark or collective service mark use, the examining attorney will issue an Office Action refusing registration.⁵⁶ The examining attorney will explain the specific reasons why the specimen is deficient and require the applicant to submit:

(1) A substitute specimen that shows proper collective mark use for the goods and/or services in the application; and

(2) One of the following statements, as appropriate to the circumstances, verified with an affidavit or signed declaration: "The substitute specimen was in use in commerce at least as early as the filing date of the application."⁵⁷; "The substitute specimen was in use in commerce prior to the filing of the amendment to allege use."⁵⁸; or "The substitute specimen was in use in commerce prior to the expiration of the time allowed applicant for filing a statement of use."⁵⁹ If submitting a specimen requires an amendment to the dates of use, applicant must also verify the amended dates.⁶⁰

If the applicant cannot satisfy these requirements for a use-based application, the examining attorney will accept the applicant's properly verified amendment of the filing basis to intent to use. Where this issue arises from the specimens provided in an Amendment to Allege Use, the applicant may withdraw the Amendment to Allege Use. However, at no point may an applicant withdraw a Statement of Use.⁶¹

B. Collective Membership Marks

The sole purpose of a collective membership mark is to indicate that the user of the mark is a member of a particular organization. Collective membership marks are not trademarks or service marks in the ordinary sense since they are not used in business or

⁵⁵ 37 C.F.R. §2.56(b)(3); TMEP §1303.02(b)

⁵⁶ 15 U.S.C. §§1051-1052, 1054, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56

⁵⁷ 37 C.F.R. §2.59(a)

⁵⁸ 37 C.F.R. §2.59(b)(1)

⁵⁹ 37 C.F.R. §2.59(b)(2); TMEP §904.05

⁶⁰ 37 C.F.R. §2.71(c)

⁶¹ 37 C.F.R. §2.88(g); TMEP §1109.17

trade and do not indicate commercial origin of goods or services. However, registration of these marks fills the need of collective organizations who do not use the symbols of their organizations on goods or services but who wish to protect their marks to prevent their use by others.

1. Ownership of Collective Trademarks and Collective Service Marks

Under the definition of “collective mark”, only a “cooperative, an association or other collective group or organization” can become the owner of a collective mark.⁶² However, there is great variety in the organizational form of collective groups whose members use membership marks. The terms “group” and “organization” are broad enough to cover all groups of persons who are brought together in an organized manner such as to justify their being called “collective.”

In order to apply to register a collective membership mark, the collective organization who owns the mark must be a person capable of suing and being sued in a court of law.⁶³ The persons who compose a collective group may be either natural or juristic persons. In the application, the collective organization must indicate its name, state of citizenship or organizational formation, and its business entity type, or if it does not have a business entity type, its nature, e.g., a social club, labor union, political party, association of real estate brokers, etc.

2. Identification of Membership Services

An identification of goods or services is not appropriate in connection with a collective membership mark. The purpose of a collective membership mark is to indicate membership in an organization. Use of the mark is by members of a particular organization/applicant. When identifying the membership services, the examining attorney will ensure that the applicant uses specific language to describe the type of membership (e.g., “to indicate membership in an association of automobile dealers,” “to indicate membership in a social club,” etc.)

3. Classification of Membership Services

In the United States, applications for collective membership marks are classified in Class 200; however, Class 200 is not included in the international classification system. Therefore, in a Madrid application, classification is determined by the IB, in accordance with the Nice Agreement, and cannot be changed from the classification given to the goods/services by the IB.⁶⁴ Accordingly, if the mark in a Madrid application appears to be a collective membership mark, the USPTO will not change the classification given to the goods/services by the IB. Nevertheless, the applicant must comply with all other

⁶² 15 U.S.C. §1127 (Section 45 of the Lanham Act)

⁶³ 15 U.S.C. §1127

⁶⁴ TMEP §1401.03(d)

requirements for collective membership mark applications filed in the United States, regardless of the classification chosen by the IB.

4. Special Elements of Collective Membership Marks Applications

As with collective trademarks applications, ownership and use requirements are slightly different due to the nature of collective membership marks.

a. Manner of Control of the Collective Mark

In addition to specifying and containing all elements that are applicable for trademarks, an application for registration of a collective membership mark must specify for the record how applicant controls (or intends to control) the use of the collective membership mark by the members of the organization.⁶⁵ If applicant's bylaws or other written provisions specify the manner of control, then applicant should simply state so for the record. If there are no written provisions governing the control, then applicant should explain in writing how it controls use of the collective membership mark by the members.⁶⁶ The following format is suggested:

Applicant controls (or applicant intends to control) the use of the mark by the members in the following manner: [specify].

If the applicant fails to provide this statement, or if the statement is confusing or found lacking, the examining attorney will require that the applicant provide a clear statement.

b. Basis Asserted Must Include a Statement that the Owner is Exercising Legitimate Control

Use of the mark is by members of a particular organization/applicant. Therefore, it is inaccurate for the applicant to assert that it "has adopted the mark and is using the mark" or that the applicant "has a bona fide intention to use the mark in commerce." Again, the sole purpose of a collective membership mark is to indicate that the user of the mark is a member of a particular organization.⁶⁷ The following format is acceptable:

Applicant is exercising (or "has a bona fide intention to exercise") legitimate control over use of the mark in commerce by its members, and has been exercising (or "has had a bona fide intention to exercise") legitimate control over use of the mark in commerce as of the filing date of the application.

If the applicant fails to provide this information, the examining attorney will require that the applicant provide this statement.

⁶⁵ 37 C.F.R. §2.44(a) and (b)

⁶⁶ TMEP §1303.02(c)(i)

⁶⁷ TMEP §§1303 and 1303.01.

c. Dates-of-Use Clause Must Refer to Use by Members

The dates-of-use clause can not refer to use by the applicant. As a collective mark, the members are the actual users of the mark, not the applicant.⁶⁸ Therefore, applicant must provide a dates-of-use clause asserting dates of use of the mark by the members. If the applicant fails to provide this information, the examining attorney will require applicant to amend the dates-of-use clause to indicate use by the applicant's members, and this must be verified in an affidavit or a signed declaration.⁶⁹ The following format is acceptable for the dates-of-use clause in a collective membership mark application:

The date of first use by the members to indicate membership in applicant is __/__/____; and the date of first use in commerce by the members to indicate membership in applicant is __/__/____.

5. Specimens of Use in Collective Trademark and Collective Service Mark Applications

The examining attorney will review the specimens of record to determine if the collective membership mark is used by *members* to indicate membership in the collective organization, as opposed to a use of the mark by the applicant or an improper use of the mark as a certification mark. Common examples of specimens showing use by members to indicate membership in a collective organization are membership cards or certificates, decals, wall plaques, garment patches, and any other item used by a member to indicate membership in applicant's organization.

If the examining attorney determines that the specimens of record fail to show use of the mark by members to indicate membership in the collective organization, the examining attorney will issue an Office Action refusing registration.⁷⁰ The examining attorney will explain the specific reasons why the specimen is deficient and require the applicant to submit:

- (1) A substitute specimen that shows proper collective membership mark use by a member; and
- (2) One of the following statements, as appropriate to the circumstances, verified with an affidavit or signed declaration: "The substitute specimen was in use in commerce at least as early as the filing date of the application."⁷¹; "The substitute specimen was in use in commerce prior to the filing of the amendment to allege use."⁷²; or "The substitute specimen was in use in commerce prior to the expiration of the time allowed

⁶⁸ TMEP §§1303.01 and 1303.02(c)(ii)

⁶⁹ 37 C.F.R. §2.71(c)

⁷⁰ 15 U.S.C. §§1051-1052, 1054, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56

⁷¹ 37 C.F.R. §2.59(a)

⁷² 37 C.F.R. §2.59(b)(1)

applicant for filing a statement of use.”⁷³ If submitting a specimen requires an amendment to the dates of use, applicant must also verify the amended dates.⁷⁴

If the applicant cannot satisfy these requirements in a use-based application, the examining attorney will accept the applicant’s properly verified amendment of the filing basis to intent to use. Where this issue arises from the specimens provided in an Amendment to Allege Use, the applicant may withdraw the Amendment to Allege Use. However, at no point may an applicant withdraw a Statement of Use.⁷⁵

C. Special Note Regarding Trademarks and Service Marks Used by Collective Organizations

A collective organization may itself use trademarks and service marks to identify its own goods and services, as opposed to collective trademarks and service marks or collective membership marks used by the collective organization’s members.

The examination of such 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. All of the criteria of registrability are the same because these applications are simply applications to register trademarks and service marks with a collective organization as the applicant and user of the mark. The specimen submitted must be material applied by the collective organization to its goods or used in connection with its services and not specimens showing a use by members of the collective organization.

⁷³ 37 C.F.R. §2.59(b)(2); TMEP §904.05

⁷⁴ 37 C.F.R. §2.71(c)

⁷⁵ 37 C.F.R. §2.88(g); TMEP §1109.17