

CERTIFICATION MARK PITFALLS: MANAGING
PROBLEMS OF GENERICNESS, DESCRIPTIVENESS, AND
CONSUMER PERCEPTION*

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I. INTRODUCTION

Today's consumers often want independent verification that the products and services that they purchase are safe, environmentally friendly, high quality, geographically authentic, or otherwise possess a characteristic that the consumer desires. To meet this consumer expectation, some individuals and businesses seek to have their products and services certified by a testing laboratory, trade association, or authoritative body (collectively, "certifiers") to verify that they have that desired characteristic. Such certifiers typically use certification marks to verify that the goods or services they have tested meet the consumers' desired characteristics.

To show consumers that their products and services have been so verified, businesses are licensed by the certifier to display the certifier's certification mark on the products, packaging for the products, and in advertising. In other words, the certification mark functions as a special type of trademark that is used not to identify the source (i.e., the brand) of a product or service, but rather to show consumers that the products and services, or their providers, have met certain standards or have the desired characteristics.¹

Because consumers trust, rely upon, and may even prefer products or services with certification marks, certifiers often invest significantly in their certification programs. Thus, it is critical that certifiers ensure that they have full and exclusive control over the use of their certification marks. To do this, the certifier should register its certification mark with the U.S. Patent and Trademark Office ("USPTO"). However, certifier applicants often face difficult challenges at the USPTO that are less likely to be encountered by applicants for traditional trademarks. Specifically, because certification marks are designed to communicate to consumers a characteristic of the product that was verified by the certifier, the certification mark often contains generic wording that states or describes that characteristic (e.g., "green" for goods proven to be safe for the environment or "flame resistant" for goods that have been proven not catch fire easily). U.S. trademark law completely denies exclusivity (and hence registration) to marks that consist solely of generic terms, and allows exclusivity for descriptive terms only after consumers have been shown to associate those terms with a specific owner, or a single source. Further, the certification mark must be used in a way that demonstrates to relevant consumers that it performs a *verification* function and is not simply an assertion of the desired characteristic. Many certification marks are refused registration, in whole or in part, because they consist largely of generic or descriptive wording, or otherwise fail to indicate a verification function to consumers.

¹ Certification mark applications, USPTO, <https://www.uspto.gov/trademarks/apply/certification-mark-applications> (last visited Aug. 22, 2025).

Nevertheless, certifiers can implement a number of strategies to assist them in overcoming these obstacles. This article analyzes recent cases and provides insight into the use of these strategies at the USPTO and in U.S. courts.

II. THE PERILS OF GENERICNESS

A generic term is used to identify the genus or category of a product or service itself² (e.g., “car” is generic for ROLLS ROYCE and “beverage” is generic for COKE). Because everyone needs to be free to use generic terms, they are ineligible for registration at the USPTO, both as normal trademarks and certification marks.³ The test for whether a given term is generic is determined by “whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question.”⁴

Oftentimes, the certifier is essentially verifying that the product is actually what it claims to be. However, there is a very fine distinction between whether the certifier is verifying a characteristic of the product, or whether the certifier is attempting to verify the genus of the product itself. The former is protectable as a certification mark, while the latter is not. Two recent cases involving cheeses and liquor illustrate how the certifier’s ability to establish exclusive rights to its certification mark turns on this fine distinction.

A. What Is Gruyere Cheese?

Historically, gruyere (or Gruyère or Gruyere) cheese has been produced in specific regions of Switzerland and France and has been defined by being made “from the unpasteurized milk of cows that graze on alpine grasses,” and the resulting cheese then “goes through a rigorous aging and production process.”⁵ Although both Switzerland and France have designated “Gruyère” as a protected geographic designation and restricted its use to cheeses originating from the specific Swiss and French Gruyere regions, the United States has no such geographic restriction on the term “gruyere.”⁶ Indeed, the U.S. Food and Drug Administration’s (“FDA”) simply defines “gruyere” as “a cheese containing ‘small holes or eyes,’ ‘a

² USPTO v. Booking.com B.V., 591 U.S. 549, 554-57 (2020).

³ 5 U.S.C. § 1054; see CES Publishing Corp. v. St. Regis Publications, Inc., 531 F.2d 11, 13 (2d Cir. 1975) (allowing trademark protection for a generic term would enable one to monopolize the term since competitors could not describe their goods as what they are).

⁴ Interprofession du Gruyère et al. v. U.S. Dairy Export Council, 61 F.4th 407, 412 (4th Cir. 2023) (quoting H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc., 782 F.2d 987, 989-90 (Fed. Cir. 1986)).

⁵ *Id.*

⁶ *Id.*

mild flavor, due in part to the growth of surface-curing agents,' that is aged a minimum of ninety days, and has a 'minimum milkfat content [of] 45 percent by weight of the solids and [a] maximum moisture content [of] 39 percent by weight.'" ⁷ Due to this, cheese can be labeled as "gruyere" in the United States, regardless from where it was originally produced. ⁸

Unhappy with the FDA's approach to the term "gruyere," the Interprofession du Gruyère ("IDG"), a Swiss consortium, and Syndicat Interprofessionnel du Gruyère ("SIG"), a French consortium (together, "the Consortiums"), sought to impose the European geographic restrictions on the term "gruyere" (or preferably "Gruyere") within the U.S. marketplace. In 2015, the Consortiums filed an application with the USPTO to register the word "GRUYERE" as a certification mark. ⁹ The U.S. Dairy Export Council, Atalanta Corporation, and Intercibus, Inc. (collectively "the opposers"), opposed this application, in part on the basis that American consumers view the term "gruyere" as a type or genus of cheese, rather than as a reference to a particular geographic location where the cheese is produced. ¹⁰

Ultimately, the USPTO's Trademark Trial and Appeal Board ("TTAB" or "Board") and, subsequently, the U.S. federal courts, determined as a matter of U.S. law that the term "gruyere" is generic and cannot be registered by the Consortiums. ¹¹

In determining how the relevant U.S. public understands the term "gruyere," the Board and the courts relied upon several critical types of evidence that together supported a finding of genericness. The FDA standard for "gruyere," while insufficient standing alone to establish genericness, informed the analysis because it has governed the U.S. labelling of gruyere cheese since 1977 and impacts U.S. customers' expectations about gruyere cheese. ¹² Further, the opposers demonstrated that, beyond domestic production, "hundreds of thousands of pounds of cheese produced outside the Gruyère region of Switzerland and France [were] imported into the United States and sold in the United States labeled as GRUYERE." ¹³

Finally, although the dictionary definitions of "gruyere" were deemed inconclusive, a large volume of media and other public references showed that "gruyere" was a type of cheese and not a

⁷ *Id.* at 417 (quoting 21 C.F.R. § 133.149).

⁸ *Id.* at 412.

⁹ *Id.* at 411.

¹⁰ *Id.* at 414.

¹¹ *Id.* at 414-15, 425-26.

¹² *Id.* at 418-19.

¹³ *Id.* at 420-22 (internal quotations omitted).

geographic region of origin for such cheese, thus supporting a conclusion that that “gruyere” is generic in the United States.¹⁴

B. What Is Tequila?

Tequila is a spirit historically produced in Mexico made by fermenting agave. To protect this association, Consejo Regulador del Tequila, A.C. (“Consejo”), a non-profit civil association that is the “only body accredited and approved to evaluate the NOM [Mexican official Standard] of the tequila,”¹⁵ sought to register “tequila” as a certification mark for “distilled spirits; specifically, spirits distilled from the blue tequilana weber variety of agave plant.”¹⁶ Consejo’s certification states that “(1) the goods are manufactured in Mexico from a specific variety of the blue agave plant grown in certain regions of Mexico as defined by Mexican law and standards; (2) the goods are manufactured in Mexico in compliance with Mexican law and standards including fermentation, distillation, aging, the percentage of blue agave sugars, and physical-chemical specifications; and (3) the finished product is or contains within it the goods manufactured in accordance with (1) and (2) above.”¹⁷

Luxco, Inc. (“Luxco”) imported a spirit called “tequila” into the United States from Mexico in bulk and sold a finished product to other distributors.¹⁸ Luxco opposed the registration of Consejo’s certification mark on several grounds, including the ground that “tequila” is generic.¹⁹

The Board determined that “tequila” is not generic after reviewing several different types of evidence provided by Consejo.

First, the Board considered the federal regulations governing tequila. Of particular importance, in 1973, the U.S. Bureau of Alcohol, Tobacco and Firearms (now the Alcohol and Tobacco Tax and Trade Bureau (“TTB”)) “recognized Tequila as a distinctive product of Mexico.”²⁰ The amendment stated that “Tequila” “may not be used commercially in the United States to describe any product not manufactured in Mexico in compliance with the applicable laws of that country.”²¹ The Board deemed it probative,

¹⁴ *Id.* at 423-25.

¹⁵ *Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 U.S.P.Q.2d 1477, 1480 (T.T.A.B. 2017).

¹⁶ *Id.* at 1479.

¹⁷ *Id.*

¹⁸ *Id.* at 1480.

¹⁹ *Id.*

²⁰ *Id.* at 1484.

²¹ *Id.*; see also 27 C.F.R. § 5.148 (“Tequila must be made in Mexico, in compliance with the laws and regulations of Mexico governing the manufacture of Tequila for consumption in that country.”).

though not dispositive, that “TTB has classified Tequila as a distinctive product of Mexico.”²²

The Board also looked at dictionary definitions of “tequila” and third-party registrations of “TEQUILA,” where it determined seven of the eight definitions in the record specifically referred to Mexico.²³ Additionally, though the third-party registrations were required to disclaim the exclusive right to use the term “Tequila” on the ground that it was generic, all the registrants for marks consisting of the word “Tequila” were approved by Consejo as “selling authentic Tequila.”²⁴

Next, the Board analyzed the advertising and marketing of “Tequila,” much of which “deliberately creates an association with Mexico.”²⁵ The Board also noted that while some advertising may not stress the significance of geographic origin, this fact is not probative of whether consumers view a liquor called “tequila” as a beverage that comes from Mexico.²⁶

After considering the vast amount of evidence, the Board reasoned that “a term that identifies a category of spirit would not be generic if it also serves to identify geographic origin.”²⁷ Based on the evidence, including the advertising and brand names establishing an association with Mexico, the requirement that every bottle’s label includes the statement “Product of Mexico” or “Hecho in Mexico,” and Consejo’s survey results that demonstrated 55.4% of respondents believe that “Tequila” is made in Mexico, there was a strong showing that “Tequila has significance as a designation of geographic origin.”²⁸ Thus, the Board dismissed the opposition and held that the opposer had not sustained its burden to show that “tequila” is generic.²⁹

C. The Importance of Evidence in Genericness Cases

The above cases demonstrate the importance of the types of evidence a certifier should introduce at the TTAB. Not only is the type of evidence important, but also the amount of evidence that should be produced. The two above cases demonstrate the highly factual nature of determining whether a purported certification mark is generic. In both cases, the parties submitted evidence from dictionaries, consumer surveys, FDA standards of identity, USDA

²² *Luxco*, 121 U.S.P.Q.2d at 1485.

²³ *Id.* at 1486.

²⁴ *Id.* at 1487.

²⁵ *Id.* at 1489.

²⁶ *Id.*

²⁷ *Id.* at 1497.

²⁸ *Id.*

²⁹ *Id.*

tables, and extensive third-party evidence of use. All of this evidence was weighed by the Board (and in one case, the courts) to determine how the relevant public views the certification mark, and whether those consumers view the mark as identifying a specific geographic origin. While the Consortiums' evidence failed to convince the Board that "gruyere" was a protectable certification mark, Consejo successfully demonstrated through various types of evidence that its certification mark was an identifier of geographic source.

Additionally, a survey can help a certifier demonstrate how the relevant public views the certification mark. This evidence can bolster the certifier's argument that its mark is not generic by providing concrete proof that the public associates the mark with a specific geographic region. Consejo was able to demonstrate through the survey that the relevant public did not view its certification mark as generic, while the Consortiums' lack of survey evidence impaired its ability to show how the public viewed "gruyere." This evidence can be used in conjunction with the dictionary definitions and representations in the media to highlight the consumer perception of the mark.

One way for a certifier to protect its mark is to register a certification mark for a logo. While the Consortiums' word mark GRUYERE was held to be generic when presented in standard typeface, the Interprofession du Gruyère previously was able to register a logo version of the certification mark, with graphical elements shown below:



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In this registration, "SWITZERLAND" and "AOC" are disclaimed; however, because of this registration, only cheese that originates in the Gruyère region of Switzerland can use the above certification mark. Thus, although the Consortiums failed to register a certification mark for all Gruyère-type cheeses in the United States, one of the Consortiums is empowered to designate cheeses sold in the United States that originate in Switzerland by way of the above logo version of the certification mark.

Finally, the cases demonstrate that evidence introduced relating to third parties using the alleged certification mark can have an important impact on the genericness analysis by the TTAB. Of course, control of the certification mark is an independent factor to

³⁰ LE GRUYÈRE SWITZERLAND AOC, Registration No. 4,398,395.

be considered, but depending on the usage, it can also reveal how the consuming public views the certification mark. When comparing the third-party uses of “gruyere” and “tequila,” the important analysis for both the Board and the court was whether the owner of the certification mark controlled those uses. Specifically, though Luxco alleged many third-party uses of “tequila,” Consejo was able to prove that it approved each of these uses, and that the users adhered to its guidelines. On the other hand, the U.S. Dairy was able to provide evidence of third-party uses of “gruyere” that the Consortiums were unable to control or prevent. Evidence of control over the use of the mark was an important element in demonstrating whether the consuming public identifies the certification mark with a singular source (in these instances, a particular geographic region).

In the recent case of *USPTO v. Booking.com B.V.*, the Supreme Court determined that “[a] term styled ‘generic.com’ is a generic name for a class of goods or services only if the term has that meaning to consumers.”³¹ The Supreme Court disagreed with the Board’s and the appellate court’s decision denying registration on the basis that “Booking.com” is necessarily generic merely because “booking” relates to making travel reservations and “.com” signifies a commercial website.³² Instead, the Supreme Court determined that the genericness analysis hinges on “whether that term, taken as a whole” identifies a source for the product to the consumers.³³ *Booking.com* demonstrates that a mark composed entirely of generic terms might be non-generic as a whole if consumers recognize it as functioning as a source identifier, or—of importance here—as a verification of certification. This analysis would likely require the certifier to conduct a survey of the relevant purchasers.

III. MANAGING DESCRIPTIVENESS ISSUES

A second issue that often confronts certifiers when trying to register their certification marks is the refusal to register due to the marks being merely descriptive of the goods or services. A merely descriptive trademark is one that “immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used.”³⁴ Of course, since many certification marks are designed to indicate a quality standard or a unique geographic origin, certifiers must be mindful of this obstacle and be intentional in their applications.

³¹ *USPTO v. Booking.com B. V.*, 591 U.S. 549, 551 (2020).

³² *Id.* at 554-60.

³³ *Id.* at 557.

³⁴ *In re Nat’l Ass’n of Veterinary Technicians in Am.*, 2019 U.S.P.Q.2d 269108, *2 (T.T.A.B. July 19, 2019) (precedential).

As demonstrated by the cases analyzed below, certifiers can attempt to avoid these problems by submitting sufficient evidence that the applied-for mark is not merely descriptive, by proving acquired distinctiveness, or by adding a design or disclaimer to the certification mark.

A. Describing Professional Qualifications

A particular challenge for certifiers seeking to register a mark related to professional qualifications is that they use phrases that are merely descriptive of the services they provide. The National Association of Veterinary Technicians in America, Inc. (the “applicant”) sought registration as a certification mark of “VETERINARY TECHNICIAN SPECIALIST” for “veterinary medicine services.”³⁵ The certification mark was intended to certify that “an individual has completed the required curriculum of a defined body of veterinary technology knowledge pertinent to that particular specialty.”³⁶

The examining attorney refused registration of the mark under Section 2(e)(1), finding the mark “merely descriptive of the identified services, and included an advisory that the mark appears to be generic.”³⁷ Specifically, the Board determined that “VETERINARY TECHNICIAN” is descriptive of the services, as a “veterinary technician” is “the recognized name of a type of professional who participates in such services.”³⁸ The applicant’s own materials also referred to “veterinary technicians” in a generic or descriptive way, by stating that “Veterinary Technician Specialists (VTS) are expert level veterinary technicians.”³⁹ Moreover, various third parties also descriptively or generically refer to “veterinary technician.”⁴⁰ For example, there are scholarly programs that offer a veterinary technician program or job search websites that offer veterinary technician positions.⁴¹ Then, when looking to “SPECIALIST,” the Board once again determined that the applicant’s own certification statement uses “specialty” in a descriptive manner to mean “one who specializes in a particular occupation, practice, or branch of learning.”⁴² The examining attorney also included third-party registrations that included

³⁵ *Id.* at *1.

³⁶ *Id.*

³⁷ *Id.* at *2. Note that the genericness refusal was never added, even though the examining attorney gave the advisory.

³⁸ *Id.* at *3.

³⁹ *Id.*

⁴⁰ *Id.*

⁴¹ *Id.*

⁴² *Id.* at *3.

“SPECIALIST” in the medical context, including some certification marks.⁴³ However, most of these marks that included “SPECIALIST” disclaimed the word and were on the Supplemental Register, further providing evidence that “SPECIALIST” is generic.⁴⁴ The Board concluded that “VETERINARY TECHNICIAN” and “SPECIALIST” are not inherently distinctive in this context, and even when combined, still do not evoke a different, distinctive commercial impression.⁴⁵

The applicant disagreed with the examining attorney’s findings, and claimed that its mark had acquired distinctiveness.⁴⁶ To support its claim, the applicant relied on a declaration by its Executive Director, as well as one article, another publication, and various third-party websites.⁴⁷ The Board considered the issue of secondary meaning, stating that, for certification marks, the focus “is on whether the evidence shows that in the minds of consumers of the applied-for goods or services, the primary significance of the designation is to indicate certification of the goods or services, *i.e.*, that the goods or services meets certain standards set by the applicant.”⁴⁸ In this instance, the applicant bore a high evidentiary burden because the proposed certification mark was highly descriptive.⁴⁹ The applicant included evidence of (apparently exclusive) use since 1995, the existence of sixteen users who are certified by the applicant, and examples of their webpages and promotional materials.⁵⁰ The Board determined that the applicant had not met its burden to show that “users of veterinary medicine services have come to recognize the applied[] for mark as indicating that the person performing the services has met certain standards set by Applicant . . . in connection with the services.”⁵¹ Notably, the Board remarked that the existence of certified users was insufficient to show acquired distinctiveness, and the Board could not assume that the webpages and promotional materials had been widely disseminated to consumers.⁵²

Thus, the Board affirmed the refusal to register the certification mark “VETERINARY TECHNICIAN SPECIALISTS” for being merely descriptive of the applicant’s services.

⁴³ *Id.* at *4.

⁴⁴ *Id.*

⁴⁵ *Id.* at *5.

⁴⁶ *Id.* at *1, 5.

⁴⁷ *Id.* at *1.

⁴⁸ *Id.* at *5.

⁴⁹ *Id.* at *6.

⁵⁰ *Id.*

⁵¹ *Id.*

⁵² *Id.*

B. Describing Positive Characteristics

Certification marks are also commonly used to describe a positive characteristic of a good or service. This could include a product being eco-friendly, or claims that the product or service avoids certain chemicals. In one case, the would-be certifier was promoting the mark “CERTIFIED GORILLA FRIENDLY” “to certify that the goods and services will be grown, rendered, handled, delivered and processed in accordance with ecological and conservation farming and sustainable tourism guidelines and standards,” and it would be used, for example, on various field crops, handicrafts, hotel services, travel agencies, and recreational parks.⁵³



The examining attorney refused registration on the grounds that the applicant failed to disclaim “CERTIFIED GORILLA FRIENDLY” because the wording is merely descriptive of the identified goods and services in relation to the applicant’s certification activities.⁵⁴

The applicant made four arguments that the wording was not merely descriptive: (1) “GORILLA FRIENDLY” does not have a meaning that is understood by the public; (2) “GORILLA FRIENDLY” is “ambiguous” when applied to the applicant’s goods and services; (3) “GORILLA” and “FRIENDLY” are incongruous and therefore cannot be merely descriptive; and (4) other third-party marks with “FRIENDLY” have been registered without a disclaimer.⁵⁵

The Board addressed each of the applicant’s arguments in turn. First, the Board determined that “a term may be merely descriptive even if Applicant is the first or only user of it.”⁵⁶ Second, the Board determined that, in light of the applicable definitions, “consumers would immediately understand GORILLA FRIENDLY to convey that the goods and services subject to Applicant’s certification mark

⁵³ In re Wildlife Friendly Enter. Network, 2017 WL 1476294, *1 (T.T.A.B. Mar. 23, 2017) (non-precedential).

⁵⁴ *Id.*

⁵⁵ *Id.* at *5.

⁵⁶ *Id.*

are deemed to be beneficial to, compatible with, or accommodating of gorillas.”⁵⁷ Third, the Board was unpersuaded by the incongruity argument. The Board noted that, regardless of the way gorillas are portrayed in media, the descriptive terms “gorilla” and “friendly” retain their descriptive significance in relation to the applicant’s certification activities.⁵⁸ As to the final argument, the Board noted that while “friendly”-formative marks have often been treated by the TTAB as merely descriptive, “third-party registrations do not determine the outcome here.”⁵⁹

The Board affirmed the refusal to register “CERTIFIED GORILLA FRIENDLY” under Section 2(e)(1). The Board did note, however, that the decision would be set aside if, within thirty days of the order, the applicant submitted a disclaimer stating that “[n]o claim is made to the exclusive right to use ‘CERTIFIED GORILLA FRIENDLY’ apart from the mark shown.”⁶⁰ The applicant ultimately complied with the Board’s requirement to disclaim “CERTIFIED GORILLA FRIENDLY,” and the mark was published in the Official Gazette.⁶¹ The application has since been abandoned, as the applicant failed to file its statement of use.⁶²

C. Avoiding Descriptiveness Refusals

The descriptiveness of a certification mark, as related to the certified goods and services, is yet another pitfall that certifiers should seek to avoid. However, though the marks in the above cases failed to avoid this trap, there are several tactics that can be used to help bolster an applicant’s certification mark. The sections below discuss possible avenues to avoid a descriptiveness refusal or rebut the presumption that the certification mark is descriptive.

1. Selecting an Arbitrary or Suggestive Certification Mark

Of course, the best way to avoid the pitfalls relating to secondary meaning or a refusal based on the mark being merely descriptive is to choose a mark whose wording is arbitrary or suggestive. Because certification marks face the same requirements as normal trademarks, selecting words that are fanciful, arbitrary, or suggestive will help streamline the registration process. Certifiers

⁵⁷ *Id.*

⁵⁸ *Id.*

⁵⁹ *Id.* at *6.

⁶⁰ *Id.* at *8.

⁶¹ Publication & Issue Review Complete, CERTIFIED GORILLA FRIENDLY, U.S. Trademark Application Serial No. 86/694,394 (Apr. 26, 2017).

⁶² Notice of Abandonment, CERTIFIED GORILLA FRIENDLY, U.S. Trademark Application Serial No. 86/694,394 (Aug. 31, 2020).

have successfully registered marks such as LEED GOLD for building environmental standards,⁶³ ETL INTERTEK for product safety standards,⁶⁴ or ENERGY STAR for energy efficiency standards.⁶⁵ Though some of the words in the above marks have been disclaimed, such as “gold” and “energy,” the certifiers were able to successfully register the certification mark by selecting words that were not necessarily associated with the qualities or characteristics being certified. Thus, a certifier can avoid many, if not all, of the issues of genericness and descriptiveness simply by being creative with the selection of the words and images used and avoiding wording and images that immediately convey what has been certified.

2. Proving Acquired Distinctiveness Under Section 2(f)

An alternative way to overcome descriptiveness, which was attempted by the applicant for “VETERINARY TECHNICIAN SPECIALIST,” is to provide evidence that demonstrates acquired distinctiveness under Section 2(f).⁶⁶ By providing evidence of acquired distinctiveness, an applicant may register an otherwise descriptive mark. When arguing that the proposed certification mark has acquired distinctiveness, the applicant needs to take into account the strength of its mark and the quantity of evidence needed to prove its case. Evidence demonstrating secondary meaning can include (a) evidence of longstanding use as part of the certification service, (b) advertising and promotion figures, (c) unsolicited press coverage and recognition in the trade, (d) evidence of employer expectations, and (e) consumer surveys.⁶⁷ Thus, the certifier should ensure that the evidence submitted to the USPTO demonstrates a clear picture that the public does associate the mark with the certifier.

3. The Use of Graphics and Disclaimers of Descriptive Wording

Another way to avoid a Section 2(e)⁶⁸ merely descriptive refusal is to add a design to the certification mark and/or a disclaimer of the merely descriptive matter. As discussed above in connection with *In re Wildlife Friendly Enterprise Network*, if the applicant disclaimed “CERTIFIED GORILLA FRIENDLY,” the Board was willing to set

⁶³ LEED GOLD, U.S. Registration. No. 3,953,334.

⁶⁴ ETL INTERTEK, Registration No. 6,216,885).

⁶⁵ ENERGY STAR, Registration No. 6,406,228.

⁶⁶ 15 U.S.C. § 1052(f).

⁶⁷ TMEP §§ 1212.06 (a)–(d).

⁶⁸ 15 U.S.C. 1052(e).

aside the refusal to register. A disclaimer can be used when a portion of the mark is merely descriptive of the goods or services at issue, but the mark contains otherwise registrable subject matter.⁶⁹ Thus, the certification mark could issue as a registration with “CERTIFIED GORILLA FRIENDLY” disclaimed, even without a finding of acquired distinctiveness.

Additionally, the drawing used in the “CERTIFIED GORILLA FRIENDLY” mark helped distinguish the certification mark. By adding a drawing and/or a disclaimer, an applicant can sufficiently distinguish its mark from others in the field. However, using a drawing consisting of a generic symbol for the goods or services (such as the universal chasing arrow symbol for recyclable goods) will not avoid a descriptiveness or genericness problem.⁷⁰

Many certification marks face the issue of being merely descriptive of their goods or services. Because of this, applicants need to be cognizant of the type and quantity of evidence needed to rebut this presumption. Moreover, an applicant should consider whether its mark has acquired distinctiveness under Section 2(f), or if that avenue is unavailable, an applicant should consider adding a drawing and/or a disclaimer to its certification mark.

IV. CERTIFICATION MARKS MUST FUNCTION TO VERIFY DESIRED CHARACTERISTICS

A third way that certification mark applications often meet their end is because the “certification mark” functions more as a title or degree of individual achievement. In many of these cases, the standards that the certifier supplies to the USPTO must be more than a curriculum, and failure to supply the USPTO with appropriate standards results in the mark’s refusal. The following cases demonstrate instances in which the certifier failed to meet the USPTO’s standards.

A. Specimens Indicating a Title

The phrase “certified software manager” does not mean much to the average person beyond its role as a title of employment. However, in 1994, the Software Publishers Association sought to register “CERTIFIED SOFTWARE MANAGER” as a certification mark for “software asset and licensing management,” which was to be used to certify that individuals passed an examination and met the certifier’s standards for software asset and licensing management.⁷¹ The examining attorney refused to register the

⁶⁹ In re Wildlife Friendly Enter. Network, 2017 WL 1476294, *8 (T.T.A.B. 2017).

⁷⁰ U.S. examining attorneys often require disclaimer of such universal symbols. E.g., U.S. Reg. Nos. 5719264, 6596462, 4992504, 6939848, and 3582571.

⁷¹ In re Software Publishers Ass’n, 69 U.S.P.Q.2d 2009, *1 (T.T.A.B. 2003).

proposed mark as a certification mark because “software manager” is “commonly used to refer to someone who manages the use of software for a company.”⁷²

In 1999, the applicant sought to amend “CERTIFIED SOFTWARE MANAGER” to the Supplemental Register,⁷³ and included three specimens (all of which were photocopies of a certificate).⁷⁴



This application was also refused by the examining attorney, notably because the proposed mark “merely designates a title or degree and does not function as a certification mark.”⁷⁵ The examining attorney also raised several issues with the specimens, namely, that the specimen (1) does not show examples of use by a party authorized by the certifier, and (2) the specimens do not show certification services, but instead only show the proposed certification mark for educational or training services.⁷⁶

The applicant then submitted a photocopy of the Board’s decision in a related application, which included specimens of decals and blank certificates.⁷⁷ The applicant argued that these specimens were accepted by the Board in that instance, and should therefore be accepted in the present case.⁷⁸ The examining attorney disagreed, refused registration, and determined that “the specimens [did] not show use of CERTIFIED SOFTWARE MANAGER as a

⁷² *Id.*

⁷³ A descriptive mark may be registered on the Supplemental Register without having acquired distinctiveness, provided it is “capable of distinguishing applicant’s goods or services.” 15 U.S.C. § 1091.

⁷⁴ *In re Software Publishers Ass’n*, 69 U.S.P.Q.2d 2009 at *2.

⁷⁵ *Id.*

⁷⁶ *Id.*

⁷⁷ *Id.* at *4.

⁷⁸ *Id.*

certification mark, but instead it is only used to identify a title or degree on the certificate.”⁷⁹

The Board reasoned that “[i]n order for an applicant to obtain registration of a certification mark it should be clear from the record that the circumstances surrounding the use and promotion of the mark will give certification significance to the mark in the marketplace.”⁸⁰ The Board determined that the only evidence demonstrating the use of “CERTIFIED SOFTWARE MANAGER” is the specimen that was submitted by the applicant.⁸¹ Thus, the only way to determine if the mark is being used as the applicant contends is based on how purchasers or potential purchasers would view the use as demonstrated by the specimen.⁸² The Board agreed with the examining attorney that the language on the specimen *Software Publishers* discussed “merely indicates that the holder has been awarded the title or degree of ‘Certified Software Manager’ and is not likely to be perceived by the relevant purchasers as a certification mark.”⁸³ As such, the Board affirmed the examining attorney’s refusal to register “CERTIFIED SOFTWARE MANAGER” because it was used as a title instead of a certification mark.

B. Specimens Successfully Demonstrating Function as a Certification Mark

In contrast to *Software Publishers* discussed above, The Council on Certification Anesthetists successfully demonstrated that CRNA functioned as a certification mark.⁸⁴ The Council sought to authorize “that the person is a registered nurse who has met certain predetermined and objective standards and requirements for providing such nurse anesthesia services.”⁸⁵

The examining attorney refused registration on the ground that the “use of the designation CRNA on the specimens of record conveys only the commercial impression of a title or degree and,

⁷⁹ *Id.*

⁸⁰ *Id.* at *6.

⁸¹ *Id.* at *7. The Board also noted that the applicant did not submit a copy of its standards, as required. Thus, the record did not indicate whether people using the certification mark met any sort of standard.

⁸² *Id.*

⁸³ *Id.*

⁸⁴ In re The Council on Certification of Nurse Anesthetists, 85 U.S.P.Q.2d 1403, 1404 (T.T.A.B. 2007) (precedential). Note that the refusal to register on the ground that CRNA does not function as a certification mark and is generic was reversed; however, the refusal to register on the ground that the mark is merely descriptive and failed to demonstrate acquired distinctiveness was affirmed.

⁸⁵ *Id.* at 1405.

thus, does not function as a certification mark.”⁸⁶ The applicant’s specimens included copies of literature, including the handbook, as shown below, competency assessment models, and guidelines, and caps, aprons, pins, and promotional sheets bearing the CRNA mark.⁸⁷ Additionally, the applicant submitted a certificate that is awarded to certified registered nurse anesthetists, which states “Jane Doe, CRNA having satisfied the requirements for Certification as prescribed by The Council on Certification of Nurse Anesthetist is now entitled to recognition as a Certified Registered Nurse Anesthetist.”⁸⁸

The Board disagreed with the examining attorney and determined that the sample certificate, brochure, and literature all indicated that CRNA does serve as a certification mark.⁸⁹ The Board remarked that “[t]he CRNA designation, when used by a nurse anesthetist certified by applicant, serves to certify a characteristic of anesthesia services performed by him/her, namely that the services are being performed by a person who meets certain standards and tests of competency set by applicant, an indication that the nurse anesthesia services being performed are of the highest quality.”⁹⁰ The Board noted that the certificate uses the CRNA designation in conjunction with the wording “having satisfied the requirements. . . .”⁹¹ This combination of words is portrayed in a way that the ultimate recipients of the service (i.e., the patients who receive the care of a nurse anesthetist) understand that there are requirements that need to be met in order to use the CRNA phrase.⁹² The Board did note that the baseball cap, apron, badge, pin, and shoelaces merely functioned as evidence of the applicant’s promotion of its mark, but failed to demonstrate how the ultimate recipients of the services would perceive the mark, nor did it indicate what the term identified.⁹³

C. Using Proper Specimens

Specimens in applications to register certification marks are incredibly important. As such, the certifier should be intentional in selecting specimens, to ensure that they provide sufficient documentation to show how the ultimate public will view the certification mark. Of particular importance is submitting evidence

⁸⁶ *Id.*

⁸⁷ *Id.* at 1406-07.

⁸⁸ *Id.* at 1407.

⁸⁹ *Id.* at 1409-1410.

⁹⁰ *Id.* at 1410.

⁹¹ *Id.*

⁹² *Id.*

⁹³ *Id.*

that demonstrates how the ultimate recipient of the services will perceive the certification mark. Software Publishers Association failed to take this step, and also failed to show the certification mark in a way that was used in a manner beyond a title. On the other hand, The Council provided sufficient evidence to show how the public would see the CRNA mark, including certificates and brochures intended to be displayed in a lobby,⁹⁴ and the certification went beyond the title of someone's employment.

In providing sufficient specimens, and specimens that demonstrate how the public views the certification mark, the certifier can streamline the application process and avoid needless complications.

V. CONCLUSION

As shown by the above cases, there are pitfalls that certifiers can avoid, especially when filing their application and during enforcement. Particularly important to the Board's analysis of genericness and descriptiveness is the evidence provided by each party. Thus, whenever a certifier is filing an application, it should be cognizant of the evidence they provide and ensure that it demonstrates that the certification mark is not merely descriptive. Additionally, during the application process, the certifier should provide specimens that demonstrate how the certification mark is ultimately perceived by the relevant consuming public. Moreover, should the application be opposed or eventually litigated, the certifier needs to provide sufficient evidence to demonstrate that the relevant public views the certification mark as an indicator that the goods have been verified by the certifier to meet its standards, rather than simply as a class of goods.

Though the TTAB has been critical of certification marks in recent years, *Booking.com* demonstrates that combining two descriptive or generic words does not necessarily mean that the resulting composite mark is merely descriptive or generic. This further highlights the importance of the evidence provided by the certifier in these cases to demonstrate that, while two words may be merely descriptive or generic standing alone, they can be combined in a way that the public perceives as identifying the certifier as the origin of the certification program.

Overall, the determination of whether a certification mark is generic or descriptive is a highly fact-intensive question. The evidence provided in these instances is often the tipping point in whether the examining attorney, the Board, or a district court views the certification mark as indicating that the goods have been verified or tested by the certifier. As such, the certifier should be

⁹⁴ *Id.* at 1407.

intentional about the evidence submitted to support their position and how to refute a claim of genericness or descriptiveness.
