

7/12/01

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 19
BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Society of Certified Insurance Counselors

Serial No. 75/284,182

H. Dale Langley, Jr. of The Law Firm of H. Dale Langley, Jr., P.C. for The Society of Certified Insurance Counselors.

Craig D. Taylor, Managing Attorney, Law Office 111.

Before Seeherman, Chapman and Holtzman, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

The Society of Certified Insurance Counselors has filed an application to register CERTIFIED RISK MANAGER on the Principal Register as a collective membership mark "to indicate membership in an association of certified risk managers" in International Class 200.¹ The method-of-use clause reads "the collective membership mark is used on

¹ Application Serial No. 75/284,182, filed April 30, 1997. Applicant claims first use by a member of applicant on October 30, 1995, and first use in interstate commerce of October 30, 1995.

decals, plaques and signs displayed on the premises of applicant's members and on its members' letterheads."

The original specimens of record are photocopies of a news release by Certified Risk Managers International titled "National Alliance² Names Director of Certified Risk Manager Program."³ In response to the Examining Attorney's request for specimens which show use by members, applicant submitted three substitute specimens, each of which is a certificate indicating that an individual has met the requirements and has been granted the degree or designation "Certified Risk Manager." (In the final Office action, the Examining Attorney accepted the substitute specimens.)

Registration has been finally refused on the basis that, when used as a collective membership mark, the applied-for mark is merely descriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1); that applicant's alternative claim of distinctiveness under

² "National Alliance" is identified within the news release as The National Alliance for Insurance Education & Research.

³ The Examining Attorney never questioned the relationship between either The National Alliance for Insurance Education & Research or Certified Risk Managers International and applicant. While there is information in the Nexis stories of record indicating that The National Alliance for Insurance Education & Research includes several member organizations, including The Society of Certified Insurance Counselors (applicant), The Society of Certified Insurance Service Representatives, Certified Risk Managers International, and The Academy of Producer Insurance Studies, there is no indication of the legal relationship between these entities.

Section 2(f), 15 U.S.C. §1052(f), is insufficiently supported; and on the basis that the applied-for mark does not function as a collective membership mark under Sections 4 and 45 of the Trademark Act, 15 U.S.C. §§1054 and 1127.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

The issues before the Board are (1) whether applicant's applied-for mark CERTIFIED RISK MANAGER is merely descriptive as a collective membership mark; (2) if it is merely descriptive, whether applicant has submitted sufficient evidence of acquired distinctiveness under Section 2(f) to overcome the refusal to register under Section 2(e)(1); and (3) whether applicant's applied-for mark functions as a collective membership mark.

Turning first to the refusal to register on the ground of mere descriptiveness, we note that the analysis regarding mere descriptiveness of a collective membership mark is the same as that with respect to a trademark or service mark. See *Racine Industries Inc. v. Bane-Clene Corp.*, 35 USPQ2d 1832, 1837 (TTAB 1994). Thus, a collective membership mark is merely descriptive, and therefore unregistrable pursuant to Section 2(e)(1), if it immediately conveys knowledge or information about a

significant attribute or aspect or a meaningful idea or information about the organization or association, such as its composition or membership. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); and *Racine Industries Inc. v. Bane-Clene Corp.*, supra. Of course, whether a term or phrase is merely descriptive as a collective membership mark is determined not in the abstract, but in relation to the organization or association involved, the context in which the term or phrase is being used by the group's members, and the possible significance that the term or phrase would have to the average person because of the manner of its use by members of the group. See *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); and *In re Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995). That is, the question is not whether someone presented with only the mark could guess exactly what the member organization is or does. Rather, the question is whether someone who knows what the member organization is will understand the mark to convey information about it. See *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990); and *In re American Greetings Corp.*, 226 USPQ 365 (TTAB 1985).

Applicant acknowledges that the term "certified" connotes "some degree of capability, experience, expertise,

or achievement" (brief, p. 3). However, applicant contends that the term "risk manager" does not immediately inform the average consumer "of the exact subject matter and scope of the membership organization or the member's certified endeavors" (brief, p. 2), and could relate to a number of businesses, for example, safety, quality control, financial analysis or human resources; and that while CERTIFIED RISK MANAGER suggests something about the member's proficiency and general field of endeavor, it does not describe any specific meaning about a particular field of endeavor.

The identification for applicant's collective membership reads "to indicate membership in an association of *certified risk managers*." (Emphasis added.) Moreover, the original specimens, the substitute specimens and applicant's website printout,⁴ all indicate that applicant

⁴ Despite the fact that the Examining Attorney had accepted applicant's substitute specimens in the final Office action dated June 24, 1998, and referred to them in his February 9, 1999 decision on applicant's request for reconsideration; applicant, in its August 9, 1999 response, requested that the Examining Attorney accept the prior substitute specimens. And, in the alternative, applicant submitted a third set of specimens. Applicant describes the newest specimens as being from applicant's website and showing use of CERTIFIED RISK MANAGER in connection with membership in applicant's organization. Inasmuch as the Examining Attorney accepted the substitute specimens, this alternative request is moot. However, this material is still of record, and we have considered the page from this website in making our decision herein. We note that this website is titled "Certified Risk Managers (CRM) International" and begins, "Certified Risk Managers International, a member of The National Alliance for Insurance Education & Research, is a non-profit organization which offers risk management practitioners the

is an organization consisting of certified risk managers who have completed the program referred to in applicant's materials as either the "Certified Risk Management (CRM) Program" or "Certified Risk Manager (CRM) Program." These materials show that "certified risk manager" is a recognized term to describe people involved with risk management. Thus, we agree with the Examining Attorney that this mark immediately and directly conveys information about a significant aspect of the organization, namely that the members are certified risk managers.

The primary question in mere descriptiveness is how relevant consumers perceive the mark, when considered as a whole. In this case the relevant consumers or target audience for applicant's organization would include not only members or potential members of the organization, but also, those people in the public seeking a certified risk manager; and they would readily understand that this mark, as used, merely describes the composition of the membership of the organization. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). Accordingly, we find that applicant's mark is merely descriptive.⁵

premier educational opportunity available today. ..." Although applicant has asserted that the excerpt is from applicant's website, there is no reference to applicant on this website page.⁵ In its reply brief applicant essentially argues that its "mark, as a whole, is not generic, notwithstanding that the Examiner

Turning now to the merits of applicant's alternative position that the mark CERTIFIED RISK MANAGER has acquired distinctiveness, applicant has the burden of establishing that its applied-for mark has become distinctive. See *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988). The question of acquired distinctiveness is one of fact which must be determined based on the evidence of record. As the Board stated in the case of *Hunter Publishing Co. v. Caulfield Publishing Ltd.*, 1 USPQ2d 1996, 1999 (TTAB 1986):

[e]valuation of the evidence requires a subjective judgment as to its sufficiency based on the nature of the mark and the conditions surrounding its use.

There is no specific rule as to the exact amount or type of evidence necessary to prove acquired distinctiveness but, generally, the more descriptive the term, the greater the evidentiary burden to establish acquired distinctiveness. See *In re Bongrain International (American) Corp.*, 894 F.2d 1316, 13 USPQ2d 1727 (Fed. Cir.

considers certain terms, alone, generic" (p. 2); states that the disclaimer required by the Examiner is inappropriate; and cites the then-recent decision of the Court of Appeals for the Federal Circuit of *In re The American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999). In the case now before this Board there is no refusal to register based on genericness, (and there has been no requirement for a disclaimer); accordingly, the American Fertility case is inapposite.

1990); and *Yamaha*, supra at 1008. See also, 2 J. McCarthy, McCarthy on Trademarks and Unfair Competition, §15:28 (4th ed. 2001).

In support of its claim of acquired distinctiveness, applicant asserts that the mark has been in use since October 1995; that some of the articles from Nexis submitted by the Examining Attorney refer to applicant; and that a third-party (The Crider Group, Inc.) website shows use of CERTIFIED RISK MANAGER as indicating membership in applicant's organization. On this basis, applicant concludes that its mark has acquired distinctiveness.

Inasmuch as the involved mark is highly descriptive, the evidentiary burden on applicant to establish acquired distinctiveness, is concomitantly higher. The use of the collective membership mark for a few years, by itself, is not sufficient. Further, the excerpted Nexis stories to which applicant makes general reference do not use the words "certified risk manager," but rather use the words "Certified Risk Managers International" and, moreover, none of the excerpted stories relates those words to applicant, The Society of Certified Insurance Counselors. The photocopy of a page from the third-party website does not show the words "certified risk manager," but rather the words are "Certified Risk Manager Institute" and "Risk

Management and Insurance," and again there is no information relating those words to applicant's organization. Applicant submitted no direct evidence of the purchasing public's recognition of the applied-for collective membership mark as identifying applicant.

In the instant case, the overall evidence falls far short of establishing a prima facie showing that applicant's merely descriptive mark has acquired distinctiveness as a collective membership mark. See *In re Thacker*, 228 USPQ 961 (TTAB 1986); *In re Mortgage Bankers Association of America*, 226 USPQ 954 (TTAB 1985); and *In re International Association for Enterostomal Therapy, Inc.*, 218 USPQ 343 (TTAB 1983).

Turning now to the refusal to register under Sections 4 and 45 of the Trademark Act, the Examining Attorney contends that as applicant uses the term, CERTIFIED RISK MANAGER merely denotes that an individual has been conferred with a specific title, degree or designation, rather than indicating membership in a specific organization, and thus the applied-for mark fails to function as a collective membership mark.

Applicant contends that a person must complete certain study and examination to become a member; that applicant maintains certain requirements and indicators of

proficiency of its members; and that members of applicant's organization use the applied-for mark to indicate their membership in the organization, and not only as a title or degree.

The sole purpose of a collective membership mark is to indicate that the user is a member of a particular organization, rather than to identify and distinguish any goods or services. See Sections 4 and 45 of the Trademark Act; Daimler-Benz Aktiengesellschaft v. Consulting Engineers Council, 353 F.2d 539, 147 USPQ 528, 530 (CCPA 1965); and In re International Institute of Valuers, 223 USPQ 350 (TTAB 1984). See also, 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §§19:98 and 19:101 (4th ed. 2001).

The question of whether this type of term or phrase serves as a mark must be determined on the basis of the manner and context in which the term or phrase is used, as revealed by the specimens and other literature of record, and the significance the term or phrase is likely to have to the public because of the manner in which it is used. See In re Institute for Certification of Computer Professionals, 219 USPQ 372 (TTAB 1983).

The substitute specimen in this case is a blank certificate which is to be filled in with an individual's

name, and it reads, in relevant part, as follows:

"Certified Risk Managers International, in association with The National Alliance hereby recognizes that all requirements having been fulfilled, grants (blank space for individual's name) the designation Certified Risk Manager and is hereby entitled to all honors, rights, privileges, and responsibilities pertaining thereto." This language indicates that the holder has been awarded the designation of "Certified Risk Manager." It does not indicate membership in any specific organization. In fact, applicant is not named thereon at all. Stated another way, this certificate merely denotes that the individual is the recipient of the award of the designation of Certified Risk Manager and does not refer to membership in any organization, including applicant. See *In re Institute for Certification of Computer Professionals*, supra; and *In re The National Society of Cardiopulmonary Technologists, Inc.*, 173 USPQ 511, (TTAB 1972).

As explained in our discussion of applicant's Section 2(f) claim, the excerpted Nexis stories, the third-party website and applicant's website do not evidence use of the phrase CERTIFIED RISK MANAGER as a collective membership mark indicating membership in applicant. Considering the overall evidence, we agree with the Examining Attorney that

Ser. No. 75/284182

the phrase CERTIFIED RISK MANAGER is a designation and does not function as a collective membership mark indicating membership in applicant organization.

Decision: The refusal to register under Section 2(e)(1) is affirmed (and applicant has failed to prove the applied-for mark has acquired distinctiveness under Section 2(f)); and the refusal to register under Sections 4 and 45 is affirmed.