

THIS DISPOSITION IS NOT CITABLE AS
PRECEDENT OF THE TTAB SEPT. 8, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Software Publishers Association

Serial No. 74/528,311

Mark Harrison of Venable for applicant.

Diane Beth Melnick, Trademark Examining Attorney, Law
Office 108 (David Shallant, Managing Attorney).

Before Hanak, Walters and Bucher, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

Software Publishers Association has filed an
application to register CSM as a certification mark for
"software asset and licensing management."¹ The information
in the application record indicates that applicant offers a
course in the field of software asset and licensing

¹ Serial No. 74/528,311, in Class B, filed May 23, 1994, based on an
allegation of a bona fide intention to exercise legitimate control over
the use of the mark in commerce. Following publication for opposition,
applicant filed a statement of use, and specimens, alleging that it is
exercising legitimate control over the use of the mark in commerce,
alleging first use and use in commerce by parties authorized by
applicant as of May, 1994.

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management; that an individual completing the course may take a certifying exam administered by applicant; and that, upon successful completion of the course and the exam, an individual will receive from applicant a certificate indicating that he or she is a "Certified Software Manager." The mark CSM appears on certificates and decals that have been submitted as specimens of use and that, according to the declaration of applicant, are displayed by the individuals so certified by applicant. The decal and the certificate submitted as specimens are reproduced below.

The Trademark Examining Attorney has finally refused registration on the ground that the specimens of use are unacceptable. The Examining Attorney issued a final requirement for the submission of specimens showing use of the mark by persons other than applicant.

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

The Examining Attorney contends that "the specimens must show use of the mark by parties other than the applicant [and] that they show use of the mark by authorized persons other than the certifier for the goods or services which are recited in the application/Statement of Use."

The Examining Attorney acknowledges that the decal and certificate submitted as specimens "show the name of applicant as well as the mark, together with various indicia of the nature of the services which are certified." She states in her brief that "[t]here is no disagreement that 'the use of a certification mark on decals and certificates by authorized users' could be an acceptable use of the certification mark; [however,] the focus of this

appeal is the last three words of that phrase, namely, 'by authorized users' [and] the specimens of record in this application do not show such use." She goes on to state that "[t]he certificate is blank, which clearly indicates that the specific certificate submitted is not certifying anything to anyone"; that "[i]f these certificates are evidence of anything, they are evidence that applicant is the source of a certification program"; and that "[i]t is a leap indeed to contend that these blank certificates constitute evidence of actual use by any party."

Applicant contends that the certificate submitted includes a space for insertion of the name of the certified party; and that the fact that the space is blank "should not be construed as an indication that these specimens do not show use of the mark by an authorized party [since] [t]hese specimens are samples of the type that are in actual use by parties certified by the applicant."

Applicant characterizes the Examining Attorney's refusal as prohibiting the submission of an unused decal or certificate as a sample, and requiring applicant to submit a certificate that has actually been issued to an individual or a photograph of a decal in use by a certified individual.

It is clear from each of the official actions issued by the Examining Attorney following submission of the Statement of Use, as well as from the Examining Attorney's brief, that the sole issue before us is whether the certificate or the decal are unacceptable specimens of certification mark use in connection with the identified services simply because the certificate is blank and the particular certificate and decal submitted have not, obviously, been used by a third party authorized by applicant.

We find nothing in either the Trademark Act or the Trademark Rules of Practice that would require applicant to submit a certificate or decal that has actually been previously issued to or used by a party authorized by applicant.² Applicant has submitted a verified statement that its mark is used as indicated in the application; that it is used by parties authorized by applicant on decals and certificates issued by applicant; and that the decal and certificate submitted as specimens are samples thereof.

² In the majority of prior cases involving certification marks wherein the specimens are certificates, the question has been whether, as used on the specimens, the applied-for mark would be perceived as a certification mark or as merely a title or degree. The fact that the certificate submitted as a specimen was blank was not an issue. See, *American Speech-Language-Hearing Association v. National Hearing Aid Society*, 224 USPQ 798 (TTAB 1984); and *In re National Association of Legal Secretaries (International)*, 221 USPQ 50 (TTAB 1983).

We find that it is unreasonable to require applicant to submit actual certificates and decals that have been previously issued to qualified individuals and used by them in the course of rendering their services. Further, such a requirement is inconsistent with analogous requirements in applications for trademarks or service marks wherein the tags, labels, packaging or, in the case of service marks, promotional materials and the like do not need to be previously used on goods or services actually sold or rendered in commerce. Applicant must merely verify that the specimens submitted are samples of ones actually used in the sale of goods or rendering of services. Applicant has made the appropriate analogous verifications in this case.

Decision: The refusal on the ground that the specimens of record are unacceptable is reversed.

E. W. Hanak

C. E. Walters

D. E. Bucher
Administrative Trademark Judges,

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