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**THIS DISPOSITION
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Paper No. 20
BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Commission on Accreditation for Law Enforcement
Agencies, Inc.

Serial No. 75/195,865

Thomas J. Moore of Bacon & Thomas, PLLC for Commission on
Accreditation for Law Enforcement Agencies, Inc.

Barney L. Charlon, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney).

Before Chapman, Bottorff and Holtzman, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Commission on Accreditation for Law Enforcement
Agencies, Inc. (CALEA) has filed an application to register
the mark shown below

for "setting and reviewing standards and practices in the field of law enforcement; and inspections to determine compliance with standards and practices in the field of law enforcement" in International Class 42.¹ Applicant's specimen of record is a seven-page typed document about "The Accreditation Process," the first page of which is applicant's letterhead stationery.

In the first Office action, the Examining Attorney required a disclaimer of the descriptive words "law enforcement accreditation" pursuant to Section 6(a), 15 U.S.C. §1056(a), of the Trademark Act. In response thereto, applicant requested registration under Section 2(f), 15 U.S.C. §1052(f), and submitted the January 5, 1998 declaration of James D. Brown, associate director of applicant.

The Examining Attorney then refused registration on the basis that the wording "law enforcement accreditation" is highly descriptive, if not generic,² and also because applicant's evidence is insufficient to establish acquired

¹ Application Serial No. 75/195,865, filed November 12, 1996, based on Section 1(a) of the Trademark Act. The claimed date of first use is 1980.

² The Examining Attorney utilized the term "generic" in this Office action, but did not issue a separate refusal to register on that basis. Genericness is not an issue before the Board.

distinctiveness.³ In response to this Office action, applicant argued that its claim of substantially exclusive and continuous use for 18 years, coupled with its showing that 182 law enforcement agencies have been accredited by applicant is sufficient to allow publication. Applicant submitted a supplemental response to the second Office action consisting of 16 declarations from various law enforcement officers.

The Examining Attorney issued a final Office action on his requirement for a disclaimer of the merely descriptive words "law enforcement accreditation," attaching printouts of several excerpted stories retrieved from the Nexis database; and again rejecting applicant's evidence of acquired distinctiveness as insufficient.

Applicant filed a notice of appeal, and included therewith the declaration of William Miller, applicant's chairman. The Board remanded the application to the Examining Attorney for consideration of the new evidence, who treated the declaration as a request for

³ The Examining Attorney referred to the burden of proving acquired distinctiveness by "clear and convincing" evidence. Applicant contends, correctly, that the requirement for "clear and convincing evidence" is unsupported. However, perhaps the Examining Attorney meant only that because of the highly descriptive nature of the involved words, a higher quantum of evidence is required to establish a prima facie showing of acquired distinctiveness. The burden of proof will be fully discussed later in this decision.

reconsideration, and denied same, attaching thereto further excerpted stories retrieved from Nexis, and printouts of pages from applicant's website.

Both applicant and the Examining Attorney have filed briefs. An oral hearing was held before this Board on June 21, 2001.

The issue before the Board is whether applicant has submitted sufficient evidence that the words "law enforcement accreditation" have acquired distinctiveness under Section 2(f) of the **Trademark Act** thereby overcoming the Examining Attorney's requirement that the words be disclaimed pursuant to Section 6(a).⁴

The Examining Attorney essentially contends that the words "law enforcement accreditation" are highly descriptive of "a process by which prescribed managerial and organizational standards are adopted by law enforcement agencies," and the record shows that the words are not used to identify applicant as the source of such services, but rather are "used simply to describe the process by which

⁴ The issue of mere descriptiveness of the words "law enforcement accreditation" is not before the Board. Applicant stated the following in its brief (p. 14):

"There is no dispute that the term 'law enforcement accreditation' in the abstract is descriptive of the present services; otherwise, Applicant would not have asserted Section 2(f)."

law enforcement agencies are accredited." (Final Office action, p. 2.) Further, in light of the highly descriptive nature of the words, the Examining Attorney contends that applicant has not met its burden of establishing a prima facie showing that the words "law enforcement accreditation" have acquired distinctiveness as a source indicator for applicant's services. Specifically, the Examining Attorney contends that in view of the highly descriptive nature of the words involved herein applicant's lengthy use of the words is not sufficient to show acquired distinctiveness; that there is demonstrated widespread highly descriptive use of the words "law enforcement accreditation" by others; that applicant itself has used the words descriptively in material appearing on its website; and that the declarations from 16 law enforcement personnel are not persuasive because (brief, pp. 6-7):

"... all but one of the declarations submitted by applicant were executed by personnel of law enforcement agencies that have been accredited by applicant. (citation to record omitted) The testimony of such individuals, therefore, is of little probative value since it is limited to those who have already availed themselves of applicant's services and hence may be biased and not necessarily reflective of the views of consumers as a whole. See *In re Paint Products Company*, 8 USPQ2d 1863,1866 (TTAB 1988)(affidavits collected by applicant from

longstanding customers are not persuasive on the issue of how the average customer perceives the term at issue). This is all the more so in the present case where the declarants at issue are likely to depend upon their ongoing relationship with applicant in order to retain their accreditation."

Applicant, in urging reversal of the refusal, contends that the words "law enforcement accreditation" have acquired distinctiveness in the relevant market as shown by the evidence of record; that the relevant market in this case, that is, applicant's customers and potential customers, consists of "law enforcement agencies and departments" (brief, p. 7); and that fair, good faith descriptive uses of the words "law enforcement accreditation," including such use by applicant, do not detract from and are not in conflict with applicant's showing of acquired distinctiveness.

I. The Burden of Proof

Applicant has the burden of establishing that the words "law enforcement accreditation" have acquired distinctiveness in relation to applicant's identified services. See *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988). An application may be published for opposition when

the applicant has established a prima facie case of acquired distinctiveness. See *Yamaha International v. Hoshino Gakki*, supra, at 1004. In order to establish acquired distinctiveness, "an applicant must show that 'in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself.'" In *re Dial-A-Mattress Operating Corporation*, 240 F.3d 1341, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001), quoting from the case of *Inwood Labs, Inc. v. Ives Labs.*, 456 U.S. 844, at footnote 11 (1982). The relevant public consists of potential as well as actual purchasers.⁵

The issue of acquired distinctiveness is a question of fact. See *In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865, 869 (Fed. Cir. 1985). There is no specific rule as to the exact amount or type of evidence necessary at a minimum to prove acquired distinctiveness, but generally, the more descriptive the term or phrase, the greater the evidentiary burden to establish acquired distinctiveness. That is, the less distinctive the term or phrase, the

⁵ Therefore, applicant's argument that "[i]t seems reasonable to assume that there are some law enforcement personnel that have only recently become aware of Applicant's service mark and, therefore, the words LAW ENFORCEMENT ACCREDITATION in the service mark do not yet have an acquired distinctiveness or secondary meaning to these personnel" (reply brief, p. 3) is meritless.

greater the quantity and quality of evidence is needed to prove acquired distinctiveness. See *In re Bongrain International (American) Corp.*, 894 F.2d 1316, 13 USPQ2d 1727 (Fed. Cir. 1990); and *Yamaha International v. Hoshino Gakki*, supra at 1008. See also, 2 J. McCarthy, McCarthy on Trademarks and Unfair Competition, §15:28 (4th ed. 1999).

II. The Evidence

As evidence in support of the Examining Attorney's position that the words are highly descriptive and that applicant's acquired distinctiveness evidence is insufficient, the Examining Attorney made of record the following material: (i) dictionary definitions of the words "law," "enforce," (with "enforcement" as a noun) and "accreditation";⁶ (ii) several excerpted stories retrieved from the Nexis database; and (iii) a few different items printed out from applicant's website.

Representative examples of the excerpted stories retrieved from Nexis follow (emphasis added):

Headline: Reinventing or repackaging public service? The case of community-oriented policing.
...community policing is to endow large agencies with some of the benefits of small agencies, and

⁶ The Examining Attorney submitted these dictionary definitions with his brief and requested that the Board take judicial notice thereof. The Examining Attorney's request is granted. See TBMP §712.01 and the rules and cases cited therein.

this would require greater structural change in the former. The **law enforcement accreditation** process prescribes the adoption of specific managerial processes and organizational mechanisms. . . ., "Public Administration Review," November/December 1998;

Headline: Russell Thanks Voters
...enforcement and public safety issues are important to every citizen. The campaign provided an ideal opportunity to discuss some of them, including **law enforcement accreditation**, poor morale, jail security, as well as response time and crime statistics reporting and more aggressive domestic violence policies. . . ., "News & Record (Greensboro, NC)," December 21, 1998;

Headline: Ex-police chief pleads guilty to larcenies
...Mr. Cowan also was ordered to reimburse the victims' money, perform at least 100 hours of community service, and turn in his **law enforcement accreditation** from the town of Atkinson. . . ., "Morning Star (Wilmington, NC)," September 15, 1999;

Headline: Creative Negotiations Pay Off
...Received notice that the Sheriff's Department had been accredited by the state's **law enforcement accreditation** commission. Officials said Hanover's was one of only eight police and sheriff's departments that have received the accreditation, "The Richmond Times Dispatch," February 18, 1998;

Headline: 'Probably one of the worst moments of my life'; Jackie Barrett had a fairly calm tenure a Fulton County sheriff - until one of her deputies was killed
...She worked for 10 years for the Georgia Police Officers Standards and Training Council, the state's **law enforcement accreditation** agency, before coming to Fulton County as then-Sheriff Richard Lankford's administrative assistant...., "The Atlanta Journal and Constitution," March 23, 2000;

Headline: Team Gives Accreditation to Daytona Beach Police

...Small announced Friday that the city department has been awarded accreditation by a nonprofit accreditation commission. The Commission for **Florida Law Enforcement Accreditation** recently presented Small with a certificate of accreditation, "The Orlando Sentinel," February 27, 1999; and

Headline: Hearing Next Week on Police Accreditation

...Citizens interested in submitting written comments are instructed to write to the **Wisconsin Law Enforcement Accreditation** Group at 4760 Schneider Dr., Oregon, WI 53575, "Capital Times, (Madison, WI.)," December 30, 1998.

A few quotations from the material printed out from applicant's website (www.calea.org) on April 13, 2000 are reproduced below (emphasis added):

Time to Take Another Look at **Law Enforcement Accreditation**, By Chief Sylvester Daughtry, Jr., Greensboro Police Department, North Carolina, President, Commission on Accreditation for Law Enforcement Agencies, Inc.,

...Just as accreditation was part of the answer to problems of the past generation, so also is **accreditation** part of the solution to issues confronting **law enforcement** today. ...;

ACCREDITATION - Celebrating 20 Years of Excellence, By Margaret J. Levine, [formerly Associate Director of Commission on Accreditation for Law Enforcement Agencies, Inc., currently with Mobil Oil Corporation]...,

...they [four leading law enforcement executive organizations] joined together to provide the research and technical expertise, management and administrative staff, and office accommodations to develop and implement a **law enforcement accreditation** program.

The idea for a **law enforcement accreditation** program had actually originated years earlier in

the Police Management and Operations Division of IACP [International Association of Chiefs of Police].

...

At their 1984-1985 annual meetings, the memberships of IACP, NOBLE [National Organization of Black Enforcement Executives], NSA [National Sheriff's Association], and the National Association of Counties adopted resolutions supporting **law enforcement accreditation**.

...

The Commission's [applicant's] continuing commitment to excellence also led to the formation of its communications accreditation program. ... Like the **law enforcement accreditation** program, participation is voluntary, and standards applicability is based on an agency's size and functional responsibilities.

There is no question that this record establishes that the word portion of applicant's mark is highly descriptive. Thus, a greater quantity and quality of evidence is required in order for applicant to prove prima facie that the words have acquired distinctiveness as indicating source in applicant. We agree with applicant that the relevant purchasers for applicant's involved services ("setting and reviewing standards and practices in the field of law enforcement; and inspections to determine compliance with standards and practices in the field of law enforcement") are law enforcement agencies and departments.

Turning then to the evidence submitted by applicant in its attempt to prove acquired distinctiveness under Section 2(f) of the **Trademark Act**, we list same as follows:

(1) the January 5, 1998 declaration of James D. Brown, applicant's "associate director," in which he avers that applicant has had substantially exclusive and continuous use of the mark since 1980; that by September 1991, applicant had accredited over 182 law enforcement agencies, with an additional 914 agencies in some stage of the accreditation process; and that as of May 1997, 10% of Canadian police officers at the provincial and local levels were in agencies accredited by applicant (the latter two statements were also supported by photocopies of certain pages from applicant's September 1991 and May 1997 newsletters⁷, respectively);

(2) the May 20, 1999 declaration of William Miller, applicant's chairman, in which he verifies the facts set forth in the application (which had been signed by James D. Brown); and he avers that the mark has been in substantially exclusive and continuous use as a trademark on newsletters in the field of setting reviewing standards and practices in the field of law enforcement since 1980; and that the mark has been in substantially exclusive and continuous use as a service mark in connection with the services recited in this application since 1980; and

(3) sixteen signed declarations from law enforcement officers each including a copy of the declarant's resume; and attesting to his or her familiarity with applicant; and that when he or she hears "law enforcement accreditation" he or she thinks of applicant; and that he or she has used "law enforcement accreditation" to distinguish applicant's goods and services from those of competitors.

III. Analysis

Applicant's September 1991 newsletter includes the following statements: "The total number of accredited law

⁷ The statement regarding Canadian police officers appearing in applicant's May 1997 newsletter is unreadable in the photocopy which was submitted to the Board.

enforcement agencies in the U.S. and Canada now is 182" (p.1); and "The new total of accredited agencies in the U.S. and Canada is 182. Meanwhile, the total number of agencies in some stage of the accreditation process is now 914, with 416 of them in self-assessment." (p. 2). The main problem with the foregoing information is that applicant has not provided a breakdown of its use of this mark on the involved services in the United States per se. That is, there is no breakdown of what part of the 182 accredited agencies and the 914 in-process agencies are law enforcement agencies in the United States. Moreover, the additional statement in Mr. James D. Brown's declaration that 10% of Canadian provincial and local police officers are accredited, emphasizes applicant's use in Canada, rather than its use in the United States. Without information on the nature and extent of applicant's use of the mark specifically in the United States, this evidence is of limited value in proving that the words "law enforcement accreditation" have acquired distinctiveness in the United States.

In addition, the 182 accredited agencies and 914 agencies in-process are statistics about applicant's business in 1991, but were filed in this case over six

years later, and there are no more current numbers regarding applicant's business of record herein.

Turning to a consideration of the 16 declarations from law enforcement personnel (some retired), they are all in a similar form, giving the person's current employment; followed by a statement that the person is "familiar with the Commission on Accreditation for Law Enforcement Agencies, Inc.," and a reference to an attached resume of some type; followed by a statement that upon hearing the words "law enforcement accreditation," the person "immediately think[s] of CALEA"; and finally a statement that the person has "used 'law enforcement accreditation' for at least the past ___ years, to distinguish CALEA'S goods and services from those of any competitors." Even though applicant's attorney presumably drafted the form declaration used, we have no reason to believe the individuals who signed the declarations failed to tell the truth. However, these declarations must be viewed against the background of the other evidence of record. See *In re Schenectady Varnish Co.*, 280 F.2d 169, 126 USPQ 395 (CCPA 1960). As explained below, their probative weight is somewhat limited.

One of the declarations is from an officer in Canada, again being of limited value to prove acquired

distinctiveness in the United States. Of the remaining 15, almost all of the declarants were, according to their resumes, either responsible for their department's participation in applicant's (CALEA) law enforcement accreditation program, or worked with or for CALEA as an "Assessor," "Chairman," "Commissioner," "Team Leader," or a member of CALEA's Standards Review Task Force. Inasmuch as these declarants have worked or currently work directly with or for applicant on the very "law enforcement accreditation" program for which applicant seeks to register its composite mark, the probative value of their declarations is somewhat limited. We emphasize that the declarations are not self-serving because the declarants are employed by law enforcement agencies or departments which are accredited by applicant. Rather, the statements by these declarants are of somewhat limited probative value because these individuals worked directly with and/or for applicant on the very "law enforcement accreditation" program identified by applicant's composite word and design mark. Unsolicited letters written individually to applicant about its involved services, or declarations from law enforcement personnel who have not worked directly with or for applicant regarding that person's understanding

and/or recognition of the words "law enforcement accreditation" as a mark, might have been more persuasive.

Further, the record before us includes no indication that a "significant number" of relevant purchasers (law enforcement agencies and departments in the United States) of applicant's services identify the words "law enforcement accreditation" as a service mark, indicating applicant as the source of the services. See Restatement (Third) of Unfair Competition, §13 comment e (1995). Such agencies at the local, state and federal levels surely must number in the hundreds, if not thousands, yet the record before us includes only 15 declarations.

While applicant's use of the applied-for mark since 1980 is clearly a long use, it is but one relevant consideration, which we find unpersuasive in light of the lack of supporting evidence regarding applicant's long use, as well as the strong evidence of record regarding the highly descriptive meaning of the words. The case cited by applicant, *In re Uncle Sam Chemical Co., Inc.*, 229 USPQ 233 (TTAB 1986), is readily distinguishable from the facts before the Board with regard to applicant's application. In the Uncle Sam case, applicant sought to register the mark SPRAYZON for "cleaning preparations and degreasers for industrial and institutional uses." The Board found that

applicant's declaration of substantially exclusive and continuous use for 18 years "together with evidence of considerable sales of products sold under the mark" sufficiently supported applicant's claim of acquired distinctiveness. By contrast, in the case now before us, there is applicant's declaration of substantially exclusive and continuous use, but that statement is otherwise supported by very minimal evidence of use; and this minimal evidence covers both the United States and Canada, and except for the declarations of law enforcement personnel, relates to applicant's use up to 1991.

Finally, applicant strongly contends that the many descriptive uses of the words "law enforcement accreditation," including its own descriptive use in material on its website, is simply appropriate descriptive use which "does not detract from the acquired distinctiveness of record." (Supplemental brief, p. 5). In essence, this is the "fair use" defense that issuance of a registration to applicant would not preclude others from using the words descriptively or generically. There is case law which rather directly rejects the "fair use" defense in ex parte appeals of refusals to register under Section 2(e)(1). See *In re Gray Inc.*, 3 USPQ2d 1558, 1559 (TTAB 1987); and *In re State Chemical Manufacturing Co.*,

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225 USPQ 687, 690 (TTAB 1985). See also, *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056, 1058 (Fed. Cir. 1999). Inasmuch as the record clearly establishes descriptive uses by others of "law enforcement accreditation" in relation to the identified services, we believe competitors would have a competitive need to use and to continue to use these words in their descriptive sense. See 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §11:18 (4th ed. 2000).

In view of the highly descriptive nature of the words "law enforcement accreditation" for applicant's identified services, and the weaknesses of applicant's overall evidence that the words have acquired distinctiveness, we find that applicant has not met its burden to establish a prima facie case of acquired distinctiveness. See *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991); and *In re Redken Laboratories, Inc.*, 170 USPQ 526 (TTAB 1971). (We note that applicant is the owner of Registration No. 2,163,396, issued June 9, 1998, for the identical services for the identical eagle and banner design mark, but with the wording LAW ENFORCEMENT CERTIFICATION. Applicant disclaimed the words "law enforcement certification." The claimed date of first use is June 1996.)

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Decision: The requirement under Section 6 for a disclaimer of the words "law enforcement accreditation" is proper. In the absence of a disclaimer of "law enforcement accreditation," the refusal to register is affirmed. If a disclaimer is entered within thirty days from the mailing date hereof, this decision will be vacated and the mark will then be published for opposition. See Trademark Rule 2.142(g).