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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Northwest Tire Factory Group, L.P.

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Serial No. 75/649,509

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Ronald T. Adams of Black Helterline LLP for Northwest Tire  
Factory Group, L.P.

C. Dionne Clyburn, Trademark Examining Attorney, Law Office  
107 (Thomas Lamone, Managing Attorney).

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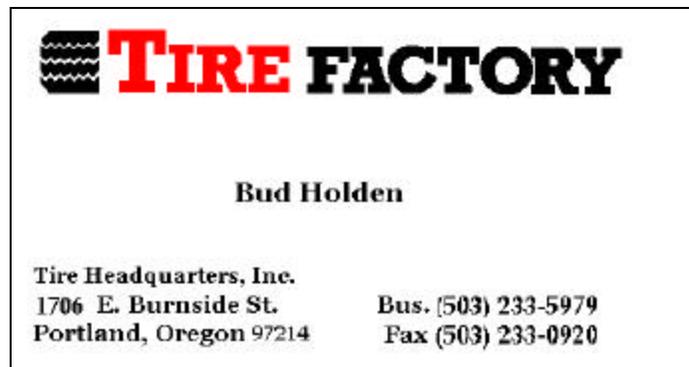
Before Hanak, Bucher and Rogers, Administrative Trademark  
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Northwest Tire Factory Group, L.P. seeks to register  
on the Principal Register TIRE FACTORY as a collective  
membership mark to indicate "membership in an association  
of retail service stores featuring products obtained  
through applicant, namely automotive and truck tires,

wheels, brakes, shocks, struts, batteries, and related accessories," in Class 200.<sup>1</sup>

At the time of filing this application, applicant submitted as the requisite specimens of record two different business cards (of Portland, Oregon colleagues Spencer Holden and Bud Holden) and a color photograph showing the outdoor signage of another one of applicant's member entities. The business card of one Bud Holden, of Tire Headquarters, Inc., is reproduced below:



The second type of usage of the TIRE FACTORY mark was contained within the signage of a business known as Canaga Tire Factory in Lebanon, Oregon:

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<sup>1</sup> Application Serial No. 75/649,509, filed on March 1, 1999, was based upon applicant's claimed first use anywhere at least as early as December 31, 1970 and on use in interstate commerce at least as early as December 31, 1987. Applicant voluntarily disclaimed the word TIRE apart from the composite mark as shown.



According to applicant's cover letter dated February 24, 1999, "... [T]he name of the entity that appears on the business card [Tire Headquarters, Inc.] and on the signage [Canaga Tire Factory], for example, is the name of one (sic) of the member entities, i.e., one of the limited partners... ."

The only question before us in this appeal is whether or not these specimens of record are sufficient to indicate membership in a collective organization. We hold that they are not, and affirm the refusal made by the Trademark Examining Attorney.

The United States Patent and Trademark Office derives its authority to register collective membership marks from

Section 4 of the Lanham Act, as amended.<sup>2</sup> The definition of a collective mark is contained in Section 45 of the Trademark Act of 1946, as amended.<sup>3</sup> A collective membership mark is an indication of membership in the collective group or organization that owns the mark. Such a mark indicates that the member organization conforms to the standards and goals of the parent organization and derives collective benefits from such membership.

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<sup>2</sup> §4 (15 U.S.C. §1054) [(Amended Nov. 16, 1988, 102 Stat. 3938.). **Collective marks and certification marks registrable**

Subject to the provisions relating to the registration of trademarks, so far as they are applicable, collective and certification marks, including indications of regional origin, shall be registrable under this Act, in the same manner and with the same effect as are trademarks, by persons, and nations, States, municipalities, and the like, exercising legitimate control over the use of the marks sought to be registered, even though not possessing an industrial or commercial establishment, and when registered they shall be entitled to the protection provided herein in the case of trademarks... . Applications and procedure under this section shall conform as nearly as practicable to those prescribed for the registration of trademarks.

<sup>3</sup> §45 (15 U.S.C. §1127). Collective mark.

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.

Ten years after enactment of the Lanham Act, the somewhat unusual indicator known as the *collective membership mark* was distinguished from *collective trademarks* and *collective service marks*; and such marks were subsequently assigned their current United States Patent and Trademark Office categorization of "Class 200." Their niche in the marketplace was then explained as follows:

It seems obvious that the effect of the change in the legislation [i.e., passage of The Lanham Act of 1946] was to permit fraternal societies and other organizations to register their names and insignia so that the registration could be used to prevent registration of such names or insignia to others who might use them commercially ...

Such marks are not trademarks in the ordinary sense of the term, but they are nevertheless identifying and distinguishing marks which are registrable under the specific terms of the statute.

Ex parte The Supreme Shrine of the Order of the White Shrine of Jerusalem, 109 USPQ 248 (Comr.Pats. 1956).

Not surprisingly, the overwhelming majority of collective membership marks currently listed on the federal register are owned by voluntary, not-for-profit groups. As described by the Trademark Manual of Examining Procedure:

Membership marks are not trademarks or service marks in the ordinary sense; they are not used in business or trade, and they do not indicate commercial origin of goods

or services. Registration of these marks fills the need of collective organizations which do not use the symbols of their organizations on goods or services but which wish to protect their marks to prevent their use by others.

See TMEP §1304.01 - History of Membership Marks.

Accordingly, a small percentage of all collective membership marks comprise the marks of commercial collectives. However, applicant highlights the example of one well-known, commercial mark on the federal trademark register, i.e., TRUE VALUE hardware stores. Indeed, there are several such marks that represent the narrow intersection of large commercial interests and federal collective membership marks. Applicant would have us view its TIRE FACTORY mark in the context of national collectives such as the TRUE VALUE hardware association (or IGA food stores, BEST WESTERN hotels, etc.). In this vein, applicant argues as follows:

... Most of us have probably gone to a "True Value" hardware store and recognized that the store we entered was a member of the True Value Association of hardware stores, even though the signs do not incorporate the word "member."

(applicant's appeal brief, p. 5).

However, we have no way of knowing what kind of specimens were relied upon by registrants who own collective membership marks such as TRUE VALUE, IGA and

BEST WESTERN. Moreover, there is nothing in the record that would help us to determine whether the average consumer knows the difference between (1) the mark of a collective membership group displayed by a merchant who happens to be a local member of the collective, and (2) a mark displayed by a merchant who happens to be a local franchisee of a national chain. Finally, nothing in this record permits us judicially to notice alleged wide-spread knowledge by members of the public of nationwide collective membership marks (like TRUE VALUE, IGA and BEST WESTERN), or to then presume that consumers, the very first time they encounter applicant's TIRE FACTORY mark on a business card or exterior signage of a tire retailer in Oregon, will perceive the mark as indicating membership in a collective, rather than as a mark of the individual establishment.

While there is nothing in the record to suggest that applicant is not the owner of a collective membership mark as claimed, the specimens shown above are the only evidence in the file showing how this alleged mark is being used.

Perhaps applicant's appeal herein is not that different from the unsuccessful complaint of the applicant in Triangle Club of Princeton University:

Applicant contends that the examiner has taken too strict an interpretation of the Act in his requirement for a showing of use

by members of the organization .... Aside from the fact that the language of Section 45 of the Act explicitly states that collective marks are marks used by members of a collective group, [USPTO] Form 4.8, which supplements [Trademark] Rule 2.44, clearly specifies that the use of the mark must be by "members of applicant."

In light of all of the material submitted, applicant has not shown that it is using the term in question as a collective membership mark.

In re Triangle Club of Princeton University, 138 USPQ 332 (TTAB 1963). This Board has had occasion to reaffirm this holding in Enterostomal Therapy, a decision having facts quite similar to the situation in the instant case:

It is well settled that **proper specimens** to support registration of a collective membership mark **must show the mark sought to be registered used by members to indicate membership**. In re Triangle Club of Princeton University, 138 USPQ 332 (TTAB 1963). (emphasis supplied).

In re International Association for Enterostomal Therapy, Inc., 218 USPQ 343 (TTAB 1983).

The Trademark Examining Attorney and applicant have both made reference to the Trademark Manual of Examining Procedure (TMEP), which has an entire section entitled "**Specimens of Use for Membership Marks**." See TMEP §1304.09(c). The most apt portion of that section, for the dispute herein, reads as follows:

For trade or professional associations, decals bearing the mark for use by members on doors or windows in their establishments, plaques bearing the mark to be hung on a wall, or decals or plates for use, for example, on members' vehicles are satisfactory as specimens...

We assume, for the moment, that applicant and its members are operating as the prototypical owner and users of a collective membership mark. The TMEP suggests that members of a collective will often display a small decal on the storefront window. For example, in this case, such a specimen might be a small decal (e.g., in a grouping having logo decals of the credit cards the merchant accepts) close to the front door of the Canaga Tire Factory establishment in Lebanon, Oregon, showing that this tire retailer is allied with, a member or an associate of, the TIRE FACTORY association of retail stores selling automotive tires and accessories. During the prosecution of this application, the Trademark Examining Attorney sought from applicant just such an indicator, as it might be used in the context of an average retail tire store. Such a window decal, or the proverbial framed membership plaque hanging on an interior wall of the retail establishment, overshadowed by more prominently presented trade names and/or service marks, would be entirely consistent with the requirements of the Trademark Act. Moreover, such a nuanced presentation

would not be mistaken by the average consumer for the establishment's service mark.

Considering this entire record, we agree with the position of the Trademark Examining Attorney herein that the consumer who is handed Mr. Bud Holden's business card, or who drives down Park Avenue in Lebanon and sees Canaga Tire Factory's large outdoor sign, will view the term TIRE FACTORY as part of a trade name and/or service mark. Unfortunately, as shown herein, this matter in no way "indicates" membership in applicant, as is required by the statute and explained in a clearly stated manner in the Office's manual of examining procedure.

With reference to the TRUE VALUE hardware usages that applicant represents most consumers have seen, it may well be that the TRUE VALUE mark, displayed on a large exterior sign in front of a hardware store would be serving as a collective service mark for that retail establishment; use of TRUE VALUE on the retail packaging of individual hardware items would have this same mark functioning as a collective trademark. These uses would not preclude another use showing that the merchant is affiliated in some way with a larger collective group. Thus, it is possible, for an applicant to demonstrate to the Office that a mark used in various ways as a trademark or service mark can, at

the same time, "indicate" membership in a collective organization.<sup>4</sup> Again, we note however, that we do not have the record supporting the TRUE VALUE registration before us, and therefore, have no way of comparing applicant's use with the use(s) made by that collective.

In support of registration herein, applicant cites to a decision from a District Court in California, where the judge notes correctly that:

"... the location of the mark does not determine its characterization as a collective mark; rather, the message conveyed by the mark is dispositive."

Sebastian International Inc. v. Longs Drug Stores Corp.

29 USPQ2d 1710 (C.D. Cal. 1993). We agree with this general conclusion, and find that the reported decisions and the relevant sections of the TMEP all anticipate that a mark may be used in a variety of valid ways and still be perceived as a collective membership mark. However, we also agree with the Trademark Examining Attorney that the specimens involved herein fail to convey any information about the existence of applicant's collective, or that either of the two entities assertedly represented by the

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<sup>4</sup> In fact, the same result could be achieved with a large exterior sign or billboard with minimal additions to the signage. We do agree with applicant that there is nothing talismanic about the word "Member," but that would certainly appear to be the simplest and surest way to indicate membership in a collective.

specimens would be perceived as a member of such collective. Rather, it would seem to be used in the nature of just another service mark - whether an ordinary service mark or a collective service mark.<sup>5</sup>

*Decision:* Based upon the current specimens of record, the refusal to register this mark as a collective membership mark is affirmed.

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<sup>5</sup> In fact, according to the cover letter accompanying this application and its companion application (Ser. No. 75/649,508), specimens identical to those at issue herein were used, quite correctly, to support the issuance of a *collective service mark* for the mark TIRE FACTORY (Reg. No. 2,314,658, which issued to applicant/registrant on February 1, 2000).