



Legal News

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Should Certificants Use Trademark Symbols with Their Credential?

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A question was recently asked in the NOCA Forum as to whether those certified should use the ® symbol when they use their credential. The answer is, “it depends,” but it is important to understand the background.

First of all, *trademarks* are images, symbols, words, acronyms, or even an overall “look,” that distinguishes a trademark holder’s *goods* from those of another. Trademarks generally function as identifiers of the source of particular products and, in that role, ensure that consumers are able to obtain goods with a particular standard of quality – this assurance symbolizes the “goodwill” associated with a brand or organization. *Service marks* are essentially the same as trademarks, but refer to *services*. The general term trademarks can refer to both.

The name or acronym of an association or certification body can function as a trademark. For example, NATIONAL BOARD OF FUNNY LAWYERS can be a trademark, though it is fairly descriptive and not as unique as some stronger marks. (NIKE and KODAK are more distinctive and considered stronger marks.) The acronym NBFL also could serve as a trademark. For any trademark or service mark, rights accrue upon use, and registration with the U.S. Patent and Trademark Office is not necessary to secure rights, though additional protections are obtained through registration. For any such mark, it is always permissible to use the symbols TM or SM to signify a claim to ownership rights in the mark. When a mark is *federally registered*, then – and *only* then – may the ® be used. In other

words, it is *not* lawful to use the federal registration symbol ® unless the mark is federally registered.

It is not necessary to use these notices every time the mark is used in text or otherwise, but is generally advisable to use such notices when the marks are used in a “trademark sense” or at least often enough to signify to the public ownership claims to the mark. Use in a trademark sense would mean when the word mark or acronym is used in a distinctive manner at the top of a page or heading of a document, for example. Just think of uses of famous trademarks seen in ads in magazines and on television; when the mark stands out and is used to signify the source of the products or services, that is use in a trademark sense.

Another type of mark is a *certification mark*. These marks differ from trademarks and service marks, in that certification marks indicate that a person or product has been deemed to meet certain standards. A certification mark signifies compliance with those standards. However, while trademarks and service marks are owned and used by the holder of the mark, certification marks are *owned* by the certification body and are *used* by those certified to signify certification status.

In addition, while many associations and certification bodies have their marks registered, there is a fundamental problem in registering certification marks. Specifically, the Trademark Office does not allow registration of titles, such as JD, PhD, MBA, RN, etc. The Office considers use of letters behind a person’s name such as on business cards, letterhead, etc. as being a title and not acceptable for registration. This means that, even though CERTIFIED FUNNY LAWYER, or CFL, would otherwise be a proper certification mark, if used as a title, then such marks would likely not be registrable with the Trademark Office because they are considered to be titles. The only circumstances in which we have been able to obtain federal registrations for certification marks are when we can provide evidence of use of the marks other than on business cards and letterhead like titles, such as on signs, coats, or pins (for example, the designations used by certified chefs on their white uniforms). This means that it will probably be difficult to obtain a federal registration for certification marks, though some organizations do obtain registrations for such marks as trade or service marks.

But back to the original question; should certificant use registration marks such as ™ or ® in connection with their credential? It will first depend on whether the mark is federally registered or not; if it is not, NEVER use the ® symbol. If the mark the certificant use is not registered, it also is less important to use the notice. However, they could use the ™ with their designations on letterhead, Web sites, or signs, but probably not on business cards.

For a federally registered mark, it is more important to use the ® symbol when appropriate. In fact, failure to use the federal trademark symbol at all could result

in limiting damages that might be available for infringement. Again, it would be advisable to use the ® with their designations on letterhead, Web sites, and signs. The symbol does NOT have to be used every time the mark is used in text, but at least periodically to demonstrate ownership rights to the mark.

In fact, each certification body should have terms or guidelines for use of marks by certificants to ensure consistent use. Failure to adequately monitor use may constitute ground for abandonment of the mark and loss of rights. Certification bodies should also use the applicable symbols when using the marks, and it is more likely that such bodies will make use of the marks in a trademark sense on the organization's Web site or publications. Finally, it is advisable for certification bodies to include statements on Web sites, in candidate guides, and in other published materials stating that the particular marks are owned by the organization.

So, the answer to the question above is, it depends. Just be sure that you have the facts and background straight concerning your organization's marks before deciding what to do!

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