Trademark or certification mark? The standards body's dilemma

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When standards bodies look to protect the marks associated with their standards, they are faced with a dilemma: should they use trademarks or certification marks? One may think the answer is obvious: “certification” seems to be what standards bodies do, and therefore a standards body should always use certification marks. But the obvious answer is not always the right one. Some standards bodies find that trademarks better fit their needs.

A standards body develops criteria for products or services provided by others. Standards bodies also devise instructional materials, such as booklets, programming interfaces or other software. If the standard is met, then the standards body licenses a mark to the product or service provider to indicate compliance. The question faced by a standards body is what kind of mark it should establish and license to others.

Most people are familiar with trademarks in their typical role, to indicate the source of goods and services. People know that JetBlue online reservations are provided by JetBlue Airlines and that a can of Coca-Cola comes from The Coca-Cola Company. In contrast, a certification mark, such as the EnergyStar logo on appliances, indicates a product or service meets an established standard. Trademarks, however, can also be used to indicate qualities of a product or service – for example, the Oprah’s Book Club logo suggests Oprah Winfrey approves a book; the Council of Better Business Bureaus BBB logo shows a company follows set business practice standards. Why do two regimes exist for what seems to be a similar function?

Two regimes

The trademark and certification mark regimes are different. The USPTO defines a trademark as identifying “the source of the goods of one party” and a certification mark as a mark “owned by one party who certifies the goods and services of others when they meet certain standards.” Importantly, the USPTO stresses that the “owner of the [certification] mark exercises control over the use of the mark; however…use of the mark is by others.” Based on these definitions, standards bodies' first choice may be certification marks, particularly if the standards body does not provide any goods or services. A number of standards bodies have chosen this regime. But others have chosen trademarks to protect the goods and services they provide.

Pros and cons of trademarks

One advantage of trademarks is the complete control the owner can exercise over its trademarks. Owners can license a trademark to whomever they wish. And, although trademarks are subject to certain forms of attack, they cannot be attacked for discriminating against particular licensees. This results in broad and complete control over a mark’s use. Another advantage is that trademarks are far more common than certification marks and are thus
more familiar. The trademark application process includes fewer requirements than the certification mark process. Additionally, trademarks are recognized in nearly all countries around the world, while certification marks are not.

Possible drawbacks do exist: the licensor may appear more involved in the commercial aspects of licensing and can appear less of an altruistic administrator of the standard. Also, a trademark must be used in connection with and identify some type of goods or services. Thus, there may be instances when a trademark is not a feasible option.

Pros and cons of certification marks

Certification marks afford the appearance of detached altruism. A certification mark licensor cannot attach the mark to its own manufactured goods. Thus, it is perceived as operating above the fray of commercial self-promotion.

However, obtaining a certification mark is more arduous. Applicants must submit the details of the certification standard to the USPTO. Some standards, such as those for software, may be quite complex and may periodically change. Certification mark owners are also vulnerable to injured third parties who can attempt to cancel the mark on specific, stringent grounds, such as failure of the owner to license the mark to a person who maintains the standards or conditions the mark certifies. The owner of a certification mark is not free to decide whether and to whom to license use of a certification mark. Also, because certification marks are not globally recognized (with some countries recognizing them but not others), owners may face obstacles trying to protect a certification mark in some countries outside of the United States.

Making the choice

The choice of regime for standards organizations becomes a question of practical realities as well as organizational goals. The certification mark regime may be preferred if the owner organization places great importance on being perceived as an independent, unbiased standards-setter. The trademark regime may be preferred if an organization desires ease of administration and greater flexibility and control over use of its mark and will use the mark itself in connection with a product or service it offers to third parties. To identify the best regime, assess your activities, materials, services and market, and consider how you and your constituents will use the mark.

When it comes time for your standards body to choose a regime to protect its marks, the call should be carefully considered, and it may be a close one.

For more information, please contact Heather Dunn or Blake W. Jackson.

1. (February 29, 2012). See also 15 USC § 1127. A certification mark is not used by its owner and does not indicate the source of goods. See TMEP §1306.09(a).

2. See TMEP §1306.06(f)(i) and (ii).


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