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Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **The Piano Technicians Guild, Inc.**

Serial No. 75675996

Dianne M. Smith-Misemer of Spencer Fane Britt & Browne LLP
for **The Piano Technicians Guild, Inc.**

Dominick J. Salemi, Trademark Examining Attorney, Law
Office 106 (**Mary Sparrow**, Managing Attorney).

Before **Bottorff, Holtzman and Rogers**, Administrative
Trademark Judges.

Opinion by **Bottorff**, Administrative Trademark Judge:

Applicant seeks registration on the Supplemental
Register¹ of the mark REGISTERED PIANO TECHNICIAN as a

¹ Applicant originally sought registration of the mark on the Principal Register. Applicant amended to the Supplemental Register after the Trademark Examining Attorney made final his Section 2(e)(1) mere descriptiveness refusal to register the mark on the Principal Register. See Trademark Act Section 23, 15 U.S.C. §1091; Trademark Rule 2.75, 37 C.F.R. §2.75.

certification mark used in connection with a "certification program for identifying persons with experience, skill, and knowledge in the field of piano tuning, repair, and maintenance," in International Class B.² See Trademark Act Sections 1(a) and 4, 15 U.S.C. §§1051(a) and 1054.

The Trademark Examining Attorney has refused registration of the mark on the Supplemental Register, on the ground that it is generic for the recited certification services and therefore is incapable of distinguishing applicant's certification services from those of others. Trademark Act Section 23. Applicant has appealed that final refusal. Applicant and the Trademark Examining Attorney have filed main appeal briefs. Applicant did not file a reply brief, and did not request an oral hearing. We reverse the refusal to register.

Initially, we reject applicant's contention that genericness is not a proper basis for refusing registration of a certification mark on the Supplemental Register. It is settled that "[i]n view of the specific language in Section 4 [of the Trademark Act] that certification marks are subject to the same provisions as trademarks and

² Serial No. 75675996, filed April 6, 1999. In the application, July 22, 1992 is alleged as the date of first use of the mark anywhere by an authorized person and as the date of first use of the mark in commerce by an authorized person.

service marks, the prohibitions of Section 2 are equally applicable when considering registrability of certification marks." *In re Professional Photographers of Ohio, Inc.*, 149 USPQ 857, 859 (TTAB 1966); TMEP §1306.06(a). See also *In re National Association of Legal Secretaries*, 221 USPQ 50 (TTAB 1983); cf. *In re International Association for Enterostomal Therapy, Inc.*, 218 USPQ 343 (TTAB 1983).

"A generic term is the common descriptive name of a class of goods or services..." *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 989, 228 USPQ 528, 530 (Fed. Cir. 1986).

The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question. Determining whether a mark is generic therefore involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services?

Id. (Citations omitted.) The burden of proving genericness falls on the Trademark Examining Attorney, who must present "clear evidence of generic use." See *In re Merrill Lynch, Pierce, Fenner, and Smith, Inc.*, 828 F.2d 1567, 1571, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987).

We find that the genus of services at issue in this case is the one identified in the application, i.e., "certification program for identifying persons with experience, skill, and knowledge in the field of piano tuning, repair, and maintenance." Thus, the issue to be determined is whether the matter sought to be registered, REGISTERED PIANO TECHNICIAN, is understood by the relevant public to refer to this genus of services.

The Trademark Examining Attorney has presented dictionary evidence in support of his argument that the word REGISTERED is generic for certification services, and has submitted NEXIS article excerpts and has cited to applicant's own literature to support his argument that the words PIANO TECHNICIAN generically refer to the class of persons applicant certifies. However, where the matter sought to be registered consists of a phrase (rather than a compound word), as is the case here, genericness will be found only where there is evidence of generic use of the phrase as a whole. *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999). Evidence that the components of the phrase, considered separately, are generic does not suffice, nor does it suffice that the phrase might be considered an apt name for the services. *Id.*, 51 USPQ2d at 1836.

The phrase REGISTERED PIANO TECHNICIAN appears in the record in only one of the eleven NEXIS article excerpts submitted by the Trademark Examining Attorney: "...Finding a piano from that era isn't easy, but pianos often are handed down from generation to generation. A registered piano technician in Greensboro, Evelyn Smith, sees - and hears - her share." (News & Record (Greensboro, NC), June 23, 2000.) Applicant, however, has presented evidence establishing that the person to whom this article refers in fact has been certified by applicant and thus is entitled to use the designation REGISTERED PIANO TECHNICIAN in rendering her services. (Applicant's October 12, 2001 response, Exhibit 1.) In these circumstances, we cannot conclude that this single newspaper article reference suffices to carry the Trademark Examining Attorney's burden of establishing with "clear evidence" that REGISTERED PIANO TECHNICIAN is generic.

In summary, we find that applicant's mark REGISTERED PIANO TECHNICIAN has not been shown to be generic for applicant's certification services, and that it thus is registrable on the Supplemental Register.

Decision: The refusal to register is reversed. The application shall proceed to registration on the Supplemental Register.