

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Oral Hearing: September 19, 2023

Mailed: September 29, 2023

**UNITED STATES PATENT AND TRADEMARK OFFICE**  
**Trademark Trial and Appeal Board**

---

*In re Panini America, Inc.*

---

Serial No. 88927178

---

Norman H. Zivin and Kira McCarthy of Wolf, Greenfield & Sacks P.C.,  
for Panini America, Inc.

Mary Kate O'Neill, Trademark Examining Attorney, Law Office 120,  
Joshua Toy, Managing Attorney.

---

Before Greenbaum, Heasley, and Pologeorgis,  
Administrative Trademark Judges.

Opinion by Pologeorgis, Administrative Trademark Judge:

Panini America, Inc. ("Applicant") seeks registration under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), of the designation CERTIFIED (in standard characters) for "Collectible trading cards; Sports trading cards" in International Class 16.<sup>1</sup>

The Trademark Examining Attorney refused registration on the following

---

<sup>1</sup> Application Serial No. 88927178, filed on May 21, 2020, based on an allegation of use in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming November 14, 1995 as both the date of first use and the date of first use in commerce.

grounds: (1) failure to function as a mark under Sections 1, 2, and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052, 1127; (2) genericness under Sections 23(c) and 45 of the Trademark Act, 15 U.S.C. §§ 1091(c) and 1127; (3) mere descriptiveness under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), without acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f); and (4) deceptive misdescriptiveness under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1). Applicant, in the alternative, seeks to amend its application to register its proposed mark on the Supplemental Register. The Examining Attorney did not enter the amendment during prosecution in light of the pending genericness and failure to function refusals.

When the refusals were made final, Applicant appealed and requested reconsideration. When the request for reconsideration was denied, the appeal resumed. The appeal is fully briefed. An oral hearing was held on September 19, 2023. For the reasons explained below, we affirm the refusal to register on the ground of genericness and, therefore, do not reach the other grounds for refusal.<sup>2</sup> *CBC Mortg. Agency v. TMRR, LLC*, 2022 USPQ2d 748, at \*29 n.22 (TTAB 2022).

## **I. Preliminary Evidentiary Matter**

In its January 15, 2021 Response to Office Action, Applicant submitted, as Exhibit B, a chart identifying 653 registered marks including the term CERTIFIED to demonstrate purportedly that the Office has allowed marks to register with the word

---

<sup>2</sup> All TTABVUE and Trademark Status and Document Retrieval (“TSDR”) citations refer to the electronic file database for the involved application. All citations to the TSDR database are to the downloadable .pdf version of the documents.

CERTIFIED. In her February 8, 2021 Office Action and her appeal brief, the Examining Attorney objected to this evidence on the ground that a chart listing registrations does not make those listed registrations properly of record.

We agree with the Examining Attorney and sustain her objection. “To make a third-party registration of record, a copy of the registration, either a copy of the paper Office record, or a copy taken from the electronic records of the Office, should be submitted during prosecution/examination of the application.” *In re Star Belly Stitcher, Inc.*, 107 USPQ2d 2059, 2064 (TTAB 2013); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) §1208.02 (2023); TRADEMARK MANUAL OF EXAMINATION PROCEDURE (“TMEP”) §710.03 (July 2022). Mere listings of registrations are not sufficient to make the registrations of record. *In re Hoefflin*, 97 USPQ2d 1174, 1177 (TTAB 2010). Accordingly, we have given no consideration to this chart in our analysis herein.

## **II. Genericness - Applicable Law**

“Generic terms ‘cannot be registered as trademarks.’” *Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1373 (Fed. Cir. 2018) (citation omitted). “A generic term ‘is the common descriptive name of a class of goods or services.’ [citation omitted]. A generic mark, being the ‘ultimate in descriptiveness,’ cannot acquire distinctiveness.” *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1045 (Fed. Cir. 2018) (quoting *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986)); *see also USPTO v. Booking.com B.V.*, 591 U.S. \_\_\_, 140 S. Ct. 2298, 2020 USPQ2d 10729, at \*1 (2020).

Whether a proposed mark is generic rests on its primary significance to the relevant public. *In re Am. Fertility Soc’y*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991). Making this determination “involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered ... understood by the relevant public primarily to refer to that genus of goods or services?” *Marvin Ginn*, 228 USPQ at 530; *see also Royal Crown*, 127 USPQ2d at 1046. A term also can be considered generic if the public “understands the term to refer to a key aspect of that genus,” or part of the genus, “even if the public does not understand the term to refer to the broad genus as a whole.” *In re Cordua Rests., Inc.*, 823 F.3d 594, 118 USPQ2d 1632, 1637-38 (Fed. Cir. 2016). The relevant public is the purchasing or consuming public for the identified goods or services. *Magic Wand*, 19 USPQ2d at 1553.

The Examining Attorney must establish that the proposed mark is generic. *In re Hotels.com, L.P.*, 573 F.3d 1300, 91 USPQ2d 1532, 1533 (Fed. Cir. 2009); *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). “Evidence of the public’s understanding of the term may be obtained from any competent source, such as purchaser testimony, consumer surveys, listings in dictionaries, trade journals, newspapers and other publications.” *Merrill Lynch*, 4 USPQ2d at 1143; *see also USPTO v. Booking.com B.V.*, 2020 USPQ2d 10729, at \*7 n.6 (2021) (“Evidence informing [a genericness] inquiry can include not only consumer surveys, but also dictionaries, usage by consumers and competitors, and

any other source of evidence bearing on how consumers perceive a term's meaning."); *Cordua Rests.*, 118 USPQ2d at 1634. "These sources may include [w]ebsites, ... and use 'in labels, packages, or in advertising material directed to the goods.'" *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1710 (Fed. Cir. 2017) (citations omitted). In some cases, dictionary definitions and an applicant's own description of its goods may suffice to show genericness. *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110, 1112 (Fed. Cir. 1987); *see also Am. Fertility Soc'y*, 51 USPQ2d at 1836.

#### **A. What is the Genus of the Goods at Issue?**

Our first task is to determine the proper genus. In defining the genus, we commonly look to the identification of goods or services in the application. *See Reed Elsevier*, 82 USPQ2d at 1380; *Magic Wand v. RDB*, 19 USPQ2d at 1552 (a proper genericness inquiry focuses on the identification set forth in the application or certificate of registration); *In re Serial Podcast, LLC*, 126 USPQ2d 1061, 1063 (TTAB 2018) (proper genus generally is "set forth by the recitation of services in each subject application."). Applicant has identified its goods as "Collectible trading cards; Sports trading cards." Applicant contends that Applicant's identification of goods appropriately defines the genus of Applicant's goods.<sup>3</sup> We agree with Applicant and find that the identification of goods adequately defines the genus.

#### **B. Who are the Relevant Purchasers?**

The second part of the *Marvin Ginn* test is whether the term sought to be registered is understood by the relevant public primarily to refer to that genus of

---

<sup>3</sup> Applicant's Appeal Brief, p. 10; 8 TTABVUE 11.

goods or services. “The relevant public for a genericness determination is the purchasing or consuming public for the identified goods.” *Frito-Lay N. Am., Inc. v. Princeton Vanguard LLC*, 124 USPQ2d 1184, 1187 (TTAB 2017) (citing *Magic Wand*, 19 USPQ2d at 1552); *Sheetz of Del., Inc. v. Doctor’s Assocs. Inc.*, 108 USPQ2d 1341, 1351 (TTAB 2013). Because there are no restrictions or limitations to the channels of trade or classes of consumers for Applicant’s identified goods, the relevant consumers consist of the general U.S. public who are interested in purchasing collectible trading cards or sports trading cards.

### **C. How does the Relevant Public Perceive the Wording CERTIFIED?**

In support of the genericness refusal, the Examining Attorney submitted evidence obtained from the Internet to demonstrate that relevant consumers view the wording CERTIFIED as the generic name for Applicant’s identified goods. The evidence submitted by the Examining Attorney is summarized below (emphasis added by the Board):

- Collectible website, Made the Grade, which has "**Certified Trading Cards**" as a category of cards under the shop drop down menu.<sup>4</sup>
- Beckett information page, explaining that their authentication services feature “cards that have autographs which have been **certified** directly.”<sup>5</sup>
- Trading card manufacturer Topps information page for its Garbage Pail Kids cards, describing the cards as “**certified authentic**.”<sup>6</sup>

---

<sup>4</sup> February 8, 2021 Nonfinal Office Action, TSDR pp. 18-20.

<sup>5</sup> July 23, 2020 Nonfinal Office Action, TSDR p. 24.

<sup>6</sup> July 15, 2021 Final Office Action, TSDR p. 35-37.

- An article from the ebay website discussing how trading card organizations **certify** the authenticity of their trading cards.<sup>7</sup>
- Trading card manufacturer Leaf's press release for its 201 Leaf Best of Hockey, describing the set as featuring "**certified autograph cards**."<sup>8</sup>
- Baseball card seller Brandywine information page, explaining "we stock baseball cards that have been professionally **certified** by the grading companies...Buy our **certified baseball cards** with confidence."<sup>9</sup>
- Article from Auction Report "CertifiedLink Wants Your Consignments for Our Next Auction," explaining that their "**March Certified Collectibles Auction**" will feature "**certified trading cards**."<sup>10</sup>
- Auction website Cold Card Auctions article "1997 Pinacclle Baseball Cards - Most Valuable and Pinnacle Certified Checklist," which **describes various cards as being certified**, e.g. "1997 Derek Jeter Pinnacle **Certified** #141."<sup>11</sup>
- Collectible website COMC, where consumers can buy and sell "**Manufacturer-Certified**" **trading cards**.<sup>12</sup>
- Point of sale pages from Sports Collectibles, showing various "**Certified Authentic**" **trading cards** from manufacturers Topps, Action Superstars, Donruss, and Fleer.<sup>13</sup>
- Glossary of trading cards terms from Upper Deck, which utilizes the phrases "**certified autograph**" and "**certified signature**" to describe trading card terminology.<sup>14</sup>

---

<sup>7</sup> February 8, 2021 Nonfinal Office Action, TDSR pp. 13-14.

<sup>8</sup> July 15, 2021 Final Office Action, TSDR pp. 24-25.

<sup>9</sup> *Id.*, TSDR p. 8.

<sup>10</sup> September 15, 2022 Subsequent Final Office Action, TSDR p. 5.

<sup>11</sup> July 15, 2021 Final Office Action, TSDR pp. 16-23.

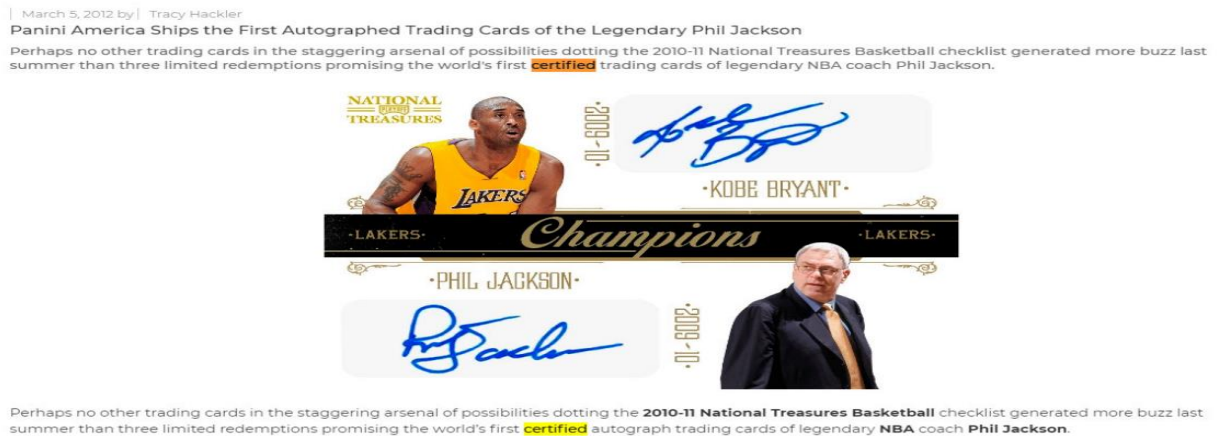
<sup>12</sup> July 23, 2020 Nonfinal Office Action, TSDR pp. 17-19.

<sup>13</sup> *Id.*, TSDR pp. 20-23.

<sup>14</sup> February 8, 2021 Nonfinal Office Action, TSDR p. 15.

- PSA information page, explaining their “**certification**” process for their “**PSA-certified trading cards.**”<sup>15</sup>
- CGC information page, showing “**CGC-certified trading cards.**”<sup>16</sup>
- Collectible website Made the Grade which has “**Certified Trading Cards**” as a category of cards under the shop drop-down menu. February 8, 2021, Nonfinal Office Action, TSDR pp. 14-16.
- Wikipedia encyclopedia entry for "Trading Cards," which explains that autographed cards are commonly referred to in the industry as “**Certified Autograph Inserts.**”<sup>17</sup>
- An online article from the Business Observer website discussing the company CGC Trading cards and on how they **certify** their collectibles.<sup>18</sup>

The Examining Attorney also submitted a screenshot of an article from Applicant’s online blog showing that Applicant has “certified” the authenticity of signatures featured in some of its trading cards.<sup>19</sup> The screenshot is displayed below:



<sup>15</sup> July 23, 2020, Nonfinal Office Action, TSDR pp. 5-9.

<sup>16</sup> *Id.*, TSDR pp. 10-14.

<sup>17</sup> February 8, 2021 Nonfinal Office Action, TSDR p. 16.

<sup>18</sup> July 23, 2020 Nonfinal Office Action, TSDR pp. 15-18.

<sup>19</sup> February 8, 2021 Nonfinal Office Action, TSDR p. 17.



Finally, the Examining Attorney submitted the dictionary definition of the term “certified” which is an adjective defined as “1. Having earned certification, and 2. genuine, authentic.”<sup>20</sup>

The Examining Attorney concludes that the foregoing evidence establishes that the word “certified” would be perceived as the generic name of Applicant’s goods by relevant consumers who seek to purchase authentic or genuine collectible trading cards or sports trading cards.<sup>21</sup>

In challenging the refusal, Applicant maintains that its proposed CERTIFIED mark would not be understood by the relevant consumers as referring to collectible or sporting trading cards because Applicant is not selling “certifieds.”<sup>22</sup> Applicant further contends that customers, publishers, and third parties understand and recognize Applicant’s CERTIFIED mark as a source indicator. In support of this argument, Applicant submitted the following:

- An article from a popular collector’s site, Beckett, which allegedly refers to CERTIFIED several times as a source indicator for

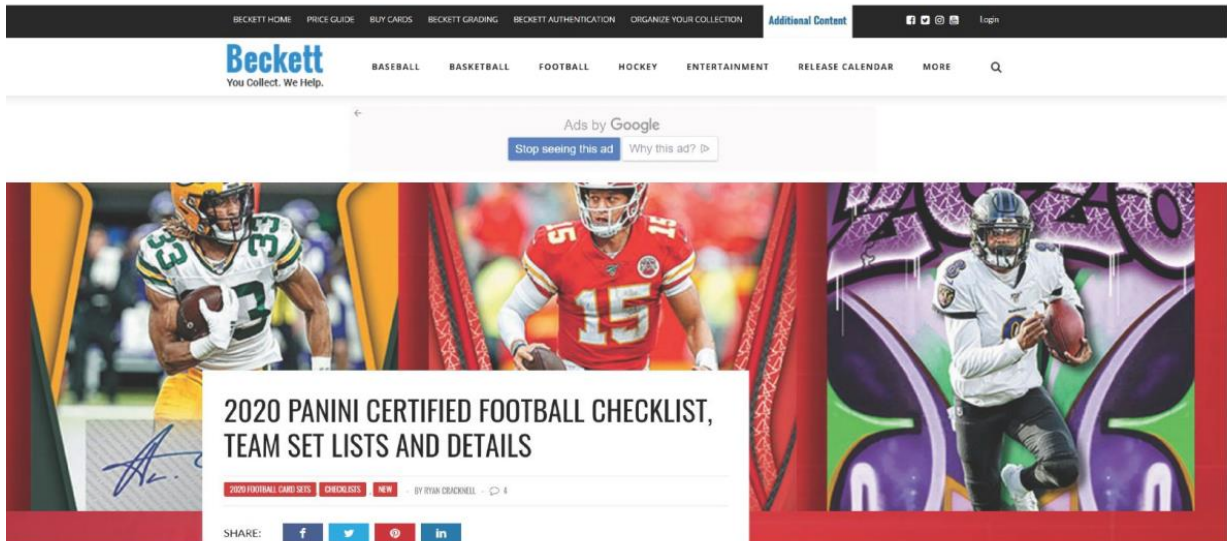
---

<sup>20</sup> July 15, 2021 Office Action, TSDR p. 38. Applicant also submitted a dictionary definition of the term “certified” defined as “1. Having or proved by a certificate, 2. Guaranteed; reliably endorsed, 3. Legally declared insane, and 4. Committed to a mental institution.” See June 7, 2021 Response to Office Action, TSDR p. 40. We also take judicial notice of the dictionary definition of word “certify” which is defined as “to attest authoritatively: such as a: CONFIRM, b: to present in formal communication, c: to attest as being true or as represented or as meeting a standard.” (accessed from [www.merriam-webster.com](http://www.merriam-webster.com) on September 28, 2023). The Board may take judicial notice of dictionary definitions, including definitions in technical dictionaries, translation dictionaries and online dictionaries which exist in printed format or that have regular fixed editions. *In re White Jasmine LLC*, 106 USPQ2d 1385, 1392 n.23 (TTAB 2013) (Board may take judicial notice of online dictionaries that exist in printed format or have regular fixed editions).

<sup>21</sup> Examining Attorney’s Brief, 10 TTABVUE 9.

<sup>22</sup> Applicant’s Appeal Brief, pp. 10-11; 8 TTABVUE 11-12.

Applicant's product. Representative screenshots from the article are reproduced below.<sup>23</sup>

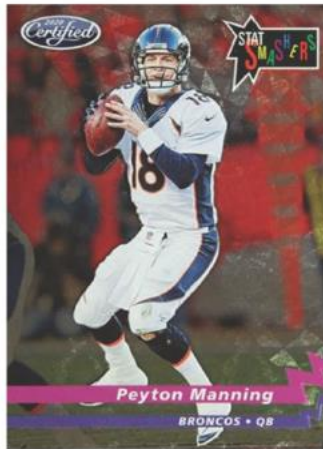


Autographs, memorabilia and foil designs come together once again for 2020 Panini Certified Football. The product follows a similar path as previous years, although there are new spins among the inserts. Hobby boxes come with four hits.



The 2020 Panini Certified Football checklist has some other inserts as well. 2020 brings a graffiti-inspired design to highlight some of the top names in the NFL. Six levels of parallels max out at 75 copies each.

Other inserts include Majestic Rookies, Majestic Stars and Scoring Machines. There's also Stat Smashers, tough short print set that highlights record-breaking performances.

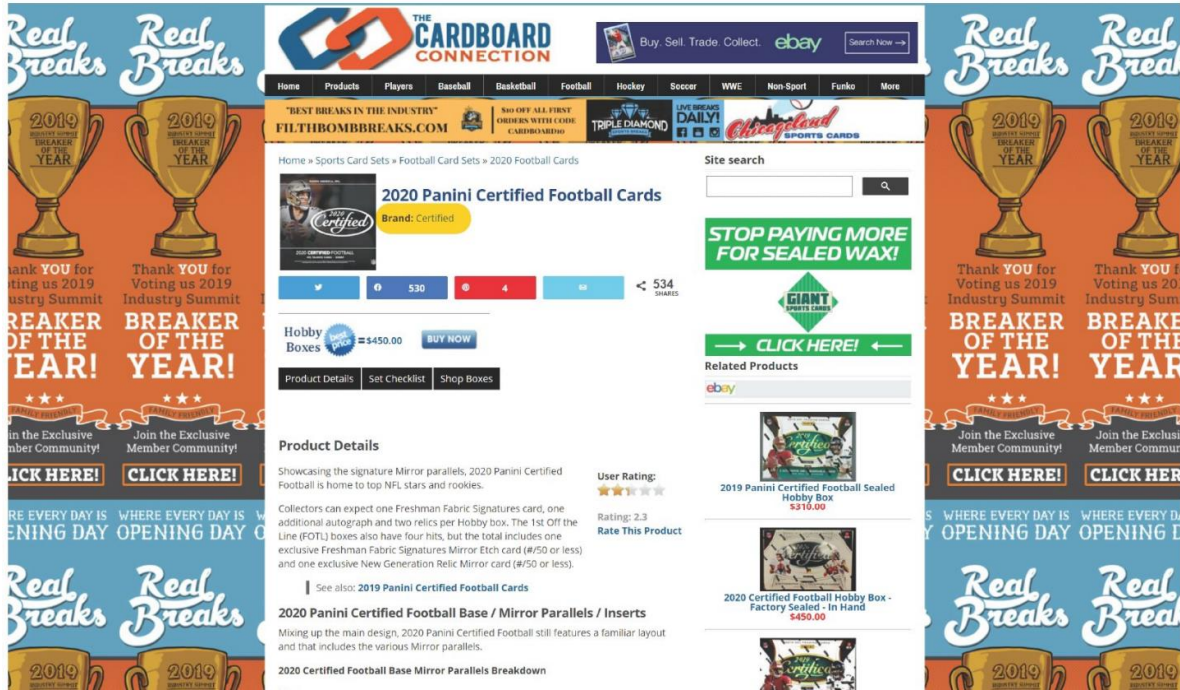


### 2020 Panini Certified Football cards at a glance:

Cards per pack: 5  
Packs per box: 10  
Boxes per case: 24  
Set size: 242 cards.

<sup>23</sup> June 7, 2021 Response to Office Action, Ex. A, TSDR pp. 15-23.

- An article from another purported leading online resource for card collectors, namely, Cardboard Connection, allegedly discussing Applicant’s CERTIFIED mark as a source indicator.<sup>24</sup> The relevant part of the article is reproduced below:



- An advertisement for Applicant’s goods from the website www.groupbreakchecklists.com.<sup>25</sup> The advertisement is reproduced below:



<sup>24</sup> *Id.*, Ex. B, TSDR pp. 24-38.

<sup>25</sup> *Id.*, Ex. H, TSDR pp. 56-59.

- An article from the website [www.sportscollectorsdaily.com](http://www.sportscollectorsdaily.com) discussing Applicant's product.<sup>26</sup>



<sup>26</sup> *Id.*, Ex. I, TSDR pp. 60-65.

## 2020-21 Panini Certified Configuration and Base Set



Carrying an SRP of around \$100, Certified hobby boxes will carry 10 packs with five cards per pack. Each case will contain 12 boxes.

Look for two autographs per box, with one featuring a 2020-21 rookie. The rest of the box will contain an average of ten parallels along with eight inserts or insert parallels and a stack of base cards.



### Base Set

Certified delivers a 200-card checklist with 150 veterans and 50 rookies with parallel versions that include Mirror versions numbered all the way down to 1/1.

**Scoring Machines.**

**Stat Smashers** is a super short print (SSP) that highlights record-breaking talent.



Also new is **2020**, which applies a graffiti-style background for the best players in the NFL.

**2020 Certified Football 2000 Insert Parallels Breakdown**

- Blue - #/75
- Teal - #/50
- Gold - #/25
- Purple - #/10
- Green - #/5
- Black - 1/1

**Set Checklist**

**2020 Panini Certified Football Checklist**

**Base Set Checklist**  
200 cards.  
BASE MIRROR PARALLELS: Base Mirror #/450, Orange #/199, Red #/99, Blue #/75, Teal #/50, Gold #/25, Purple #/10, Green #/5, Black 1/1.  
ROOKIE MIRROR PARALLELS: Base Mirror #/299, Orange #/199, Red #/99, Blue #/75, Teal #/50, Gold #/25, Purple #/10, Green #/5, Black 1/1.  
FOTL ETCH PARALLELS: Purple #/10, Green #/5, Black 1/1.

- An advertisement for Applicant’s goods on the Blowout cards website.<sup>27</sup> The screenshot is reproduced below:

**BLOWOUT CARDS**

Search... Account Wishlist Log In Advanced Search Help Compare Cart

HOME SPORTS NON-SPORTS GAMING SUPPLIES PROMOTIONS LIVE BREAKS BUYING FORUM BUZZ RELEASE CALENDAR

Home → 2020 Panini Certified Football Hobby Box

**2020 Panini Certified Football Hobby Box**

Configuration: 10 packs per box, 5 cards per pack.

**PRODUCT HIGHLIGHTS**

- Back for 2020, Certified Football returns with more incredible hits and great patches. Look for 4 Autographs and Memorabilia cards per box, on average.
- Chase Rookie Patch Autographs of the top rookies from the deep 2020 NFL Draft Class with Freshman Fabric Signatures. Featuring jumbo swatches, Freshman Fabric Signatures is a staple for the hobby.
- Now for 2020, hunt for new inserts Scoring Machines, Majestic Rookies, Majestic Stars and Stat Smashers.
- Chase some of the best veterans in the game with Fabric of the Game Signatures, featuring oversized patches in a newly designed patch autograph card.
- Look for one Freshman Fabric Signature in every box!

**BOX BREAK:**

- 1 Freshman Fabric Signature
- 1 Additional Autograph
- 2 Memorabilia Cards
- 2 Rookies Or Rookie Parallels
- 3 Numbered Parallels

Self-Sheet

Only 2 left

~~\$549.95~~ Availability: In stock  
**Special Price \$469.95**

Add to Cart Qty: 1

**PANINI**

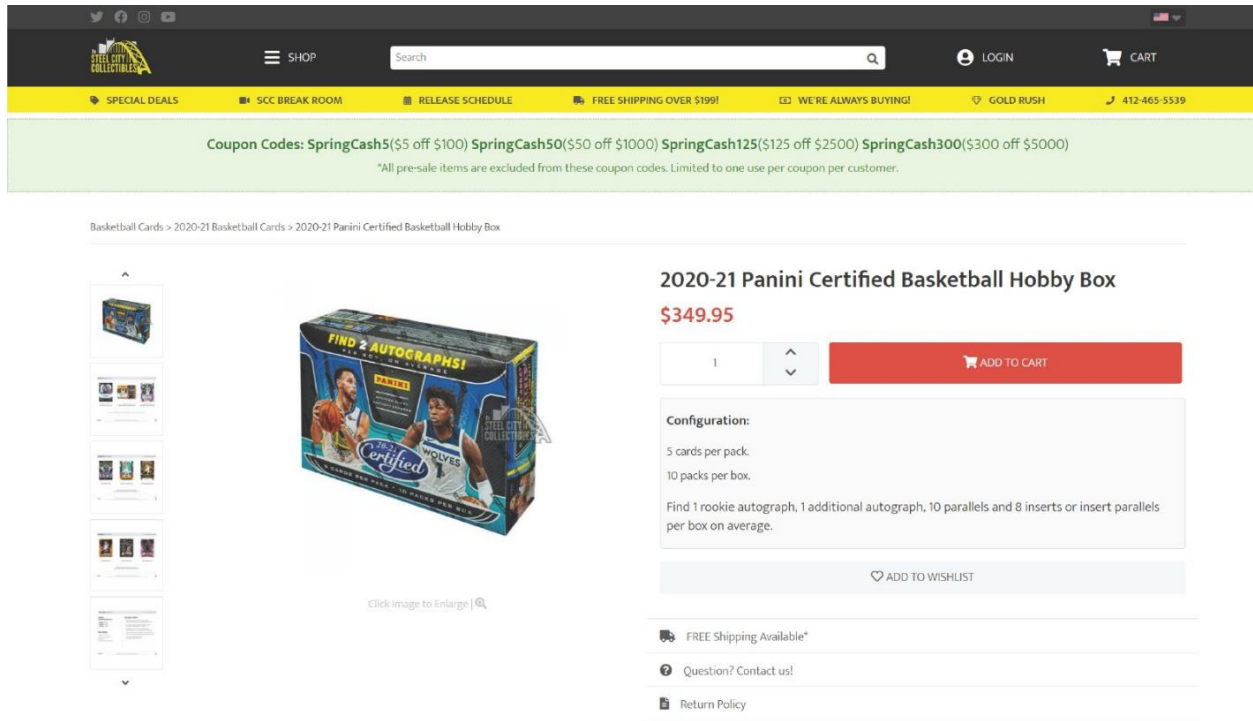
- In stock items ordered before 3:30 PM EST ship the same day (M-F)
- Free Shipping on all orders above \$199 to Continental US.
- Email us now for more info about our products.

Related

- Ultra Pro Card Sleeves - 100ct Pack \$2.99 Add to Wishlist
- Ultra Pro 3x4 Regular Topload Card Holder - 40 Pack Case \$249.99 Add to Wishlist

<sup>27</sup> *Id.*, Ex. F, TSDR pp. 50-52.

- An advertisement of Applicant's goods from the website [www.streetcitycollectibles.com](http://www.streetcitycollectibles.com).<sup>28</sup> The screenshot is reproduced below:



- An advertisement of Applicant's goods from the website [www.dacardworld.com](http://www.dacardworld.com).<sup>29</sup> The screenshot is reproduced below:

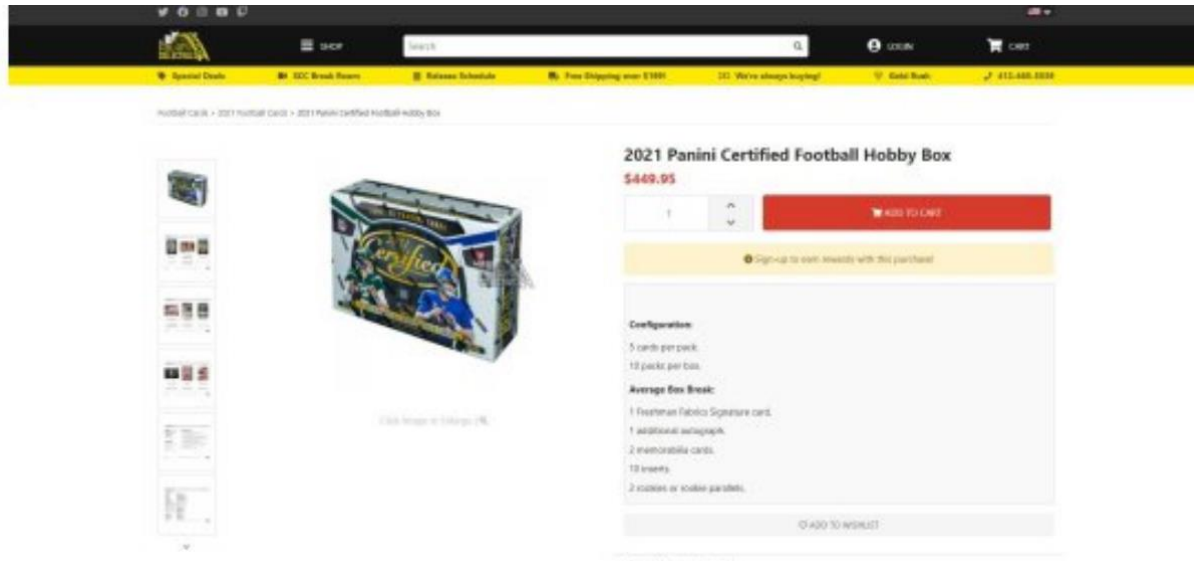


<sup>28</sup> Id., Ex. G, TSDR pp. 53-55.

<sup>29</sup> January 11, 2022 Request for Reconsideration, Ex. C, TSDR pp. 17-20.



- An advertisement of Applicant's goods from the website [www.steelcitycollectacardworld.com](http://www.steelcitycollectacardworld.com).<sup>30</sup> The screenshot is reproduced below:



- An advertisement of Applicant's goods from the website [www.collectorsstore.com](http://www.collectorsstore.com).<sup>31</sup> The screenshot is reproduced below:



<sup>30</sup> *Id.*, Ex. D, TSDR pp. 21-23.

<sup>31</sup> *Id.*, Ex. E, TSDR pp. 24-26.

Applicant argues that the evidence submitted by the Examining Attorney does not provide useful parallels in evaluating whether Applicant's mark is the generic name of Applicant's goods.<sup>32</sup> Applicant maintains that the third parties identified by the Examining Attorney have either used "certified" descriptively in text and/or in conjunction with other wording.<sup>33</sup> In particular, Applicant states:<sup>34</sup>

- The Business Observer article discusses the Certified Collectibles Group that similarly features "certified" as part of its tradename. That article also uses "certified" descriptively: "CGC is a third-party grading service for comic books, magazines, concert posters and related collectibles, with more than 6 million collectibles certified . . . . The CCG companies have certified more than 55 million collectibles since 1987 ...".
- The screenshots from the COMC website similarly feature "certified" descriptively in text in bullets listing: "manufacturer-certified relic/memorabilia cards;" "manufacturer-certified autograph cards. Certified autograph cards with a missing autograph may be declined;" and "manufacturer-certified cut autograph cards."
- Sports Collectibles' website uses the phrase "certified authentic" in conjunction with several autographed baseball cards.
- Beckett's website uses "certified" descriptively in text in the following sentence: "Cards that have autographs which have been certified directly by the manufacturer can be submitted directly by Beckett Grading."
- The eBay evidence does not even use the term "certified" but instead discusses the evaluation of sports card quality and authentication: "These independent organizations evaluate a card for authenticity and quality. Many use a 10-point grade scale. They then secure the card in a sealed, tamper-evident plastic holder complete with a certification tag, grade designation, and other pertinent card information."

---

<sup>32</sup> Applicant's Appeal Brief, p. 6; 8 TTABVUE 7.

<sup>33</sup> *Id.*

<sup>34</sup> *Id.* at pp. 15-16; 8 TTABVUE 17-18.

- Upper Deck’s website uses “certified” to describe its autograph cards: “Autographed Card – A card that has been signed by the player. Also referred to as a ‘certified autograph.’”

In contrast, Applicant asserts that it uses CERTIFIED as a standalone trademark. Unlike the companies identified by the Examining Attorney, Applicant states that it places CERTIFIED on the cards themselves, enabling consumers to recognize Applicant as the source of the trading cards.<sup>35</sup> Applicant also argues that, as shown by Applicant’s specimen displayed below, its proposed CERTIFIED mark appears in a separate font style and color, creating a separate impression from the other wording on the card, thereby attesting to proper trademark usage and makes CERTIFIED more likely to be viewed as a trademark.<sup>36</sup>



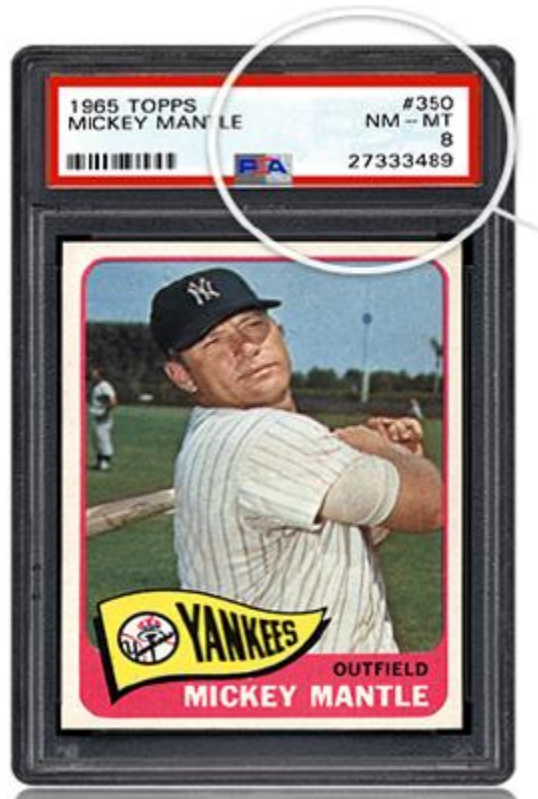
---

<sup>35</sup> *Id.*

<sup>36</sup> *Id.*

As further evidence, Applicant submitted a PSA-certified baseball card, as displayed below,<sup>37</sup> and compared it to its specimen of record.

**PSA trading card**



Applicant points out that the PSA-certified card is placed in a plastic sleeve and a certificate sits separately on top of the card and contains information such as a grade, the year the card was created, and a certification number.<sup>38</sup> On the other hand, as shown in its specimen, Applicant places CERTIFIED directly on the card itself and uses CERTIFIED outside of the authentication and trading card grading context.<sup>39</sup>

---

<sup>37</sup> January 15, 2021 Response to Office Action, TSDR p. 16.

<sup>38</sup> Applicant's Appeal Brief, p. 8, 8 TTABVUE 8.

<sup>39</sup> *Id.*

Applicant concludes that because its use of CERTIFIED is distinct from other manufacturers and authentication companies, consumers will perceive CERTIFIED as a trademark and source indicator.<sup>40</sup>

Applicant also argues that the presence of comparable marks on the Principal and Supplemental Registers shows how Applicant's mark is not generic for its identified goods. In support of its argument, Applicant submitted plain copies of approximately 40 third-party registrations for marks including the term CERTIFIED that have been registered on either the Principal Register under Section 2(f) of the Trademark Act or on the Supplemental Register and where CERTIFIED is not disclaimed.<sup>41</sup> Additionally, Applicant asserts that it previously registered CERTIFIED as a standalone mark for "sports player trading cards"— a registration that was in effect for over twenty years, but was subsequently cancelled due to a maintenance issue.<sup>42</sup> In light of these registrations, including its now-canceled registration for the mark CERTIFIED, Applicant argues that the term CERTIFIED has been found by the Office to function as a source indicator for various goods and services.

### **III Analysis**

The issue is whether the Internet materials and dictionary definitions of the term "certified" submitted by Applicant and the Examining Attorney suffice to demonstrate that the term CERTIFIED is generic for Applicant's identified goods.

---

<sup>40</sup> *Id.*

<sup>41</sup> January 15, 2021 Response to Office Action, Ex. C, TSDR pp. 161-204.

<sup>42</sup> *Id.*, Declaration of Robert Hull, Applicant's Chief Financial Officer, ¶ 7, TSDR p. 206.

We find that they do.

As noted, the Federal Circuit has held that “a term can be generic for a genus of goods or services if the relevant public . . . understands the term to refer to a *key aspect* of that genus.” *Royal Crown*, 127 USPQ2d at 1046 (quoting *In re Cordua Rests. Inc.*, 118 USPQ2d at 1637). The Federal Circuit has also held that “a term is generic if the relevant public understands the term to refer to part of the claimed genus of goods or services, even if the public does not understand the term to refer to the broad genus as a whole.” *In re Cordua Rests. Inc.*, 118 USPQ2d at 1638. We further note that an adjective can be a generic term. *See, e.g., In re Reckitt & Colman, N. Am. Inc.*, 18 USPQ2d 1389 (TTAB 1991) (the expression “generic name for the goods or services” is not limited to noun forms but also includes “generic adjectives,” that is, adjectives that refer to a genus or species, category or class, of goods or services).

When the evidence is viewed in its entirety, it is clear that relevant consumers of collectible or sports trading cards have been exposed to the concept that these types of cards may be certified for their authenticity. As noted above, the record includes dictionary definitions of the term “certified,” which is defined as “having earned certification” and “genuine, authentic.”<sup>43</sup> As such, consumers will perceive the designation CERTIFIED as a subcategory or subgenus of collectible trading cards or sports trading cards, i.e., those that have earned certification, and are genuine or authentic. In other words, relevant consumers perceive the wording CERTIFIED as a key aspect of collectible or sports trading cards. We cannot ignore what may be

---

<sup>43</sup> July 15, 2021 Office Action, TSDR p. 38.

plainly obvious -- a term may be generic if, by its very definition, it will be primarily understood as a reference to part of genus of the identified goods. *Royal Crown*, 127 USPQ2d at 1046 (“[A] term is generic if the relevant public understands the term to refer to part of the claimed genus of goods or services, even if the public does not understand the term to refer to the broad genus as a whole.”).

Turning to Applicant’s evidence of third-party websites that purportedly demonstrate use of the term CERTIFIED as a source indicator of Applicant’s goods, we find that the vast majority of this evidence does not do so. A careful review of this evidence shows that the term PANINI would be viewed as the source indicator of Applicant’s goods, not CERTIFIED, particularly since relevant consumers have become accustomed to the practice of manufacturers/producers of collectible or sports trading cards certifying the authenticity of such cards. While we acknowledge that some of Applicant’s evidence includes non-generic uses of the term CERTIFIED, the minimal amount of such evidence does not create a mixed record, nor does it outweigh the substantial evidence demonstrating that the wording is generic for Applicant’s goods. *See, e.g., In re Hotels.com LP*, 573 F.3d 1300, 91 USPQ2d 1532 (Fed. Cir. 2009) (affirming Board ruling finding genericness on totality of record despite survey evidence and declarations); *In re Am. Online, Inc.*, 77 USPQ2d 1618, 1623 (TTAB 2006) (“[T]he mere fact that a record includes evidence of both proper trademark use and generic use does not necessarily create a mixed record that would overcome an examining attorney's evidence of genericness.”).

With regard to Applicant’s third-party registration evidence, we find that the

third-party registrations that include the term CERTIFIED are of no probative value. First, none of the third-party registrations are for the same or similar goods identified in Applicant's application. As such, these registrations do not demonstrate whether the term CERTIFIED is generic for Applicant's goods. Second, we are without the benefit of the file histories for any of these third-party registrations. Therefore, we cannot draw any conclusions as to why these CERTIFIED-formative marks registered.

“While we recognize that ‘consistency is highly desirable,’ consistency in examination is not itself a substantive rule of trademark law, and a desire for consistency with the decisions of prior examining attorneys must yield to proper determinations under the Trademark Act and rules.” *In re Ala. Tourism Dep't*, 2020 USPQ2d 10485, at \*11 (TTAB 2020) (quoting *In re Am. Furniture Warehouse Co.*, 126 USPQ2d 1400, 1407 (TTAB 2018) (internal quotations omitted)). We must assess each mark on its own facts and record. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (“Even if some prior registrations had some characteristics similar to [Applicant's] application, the PTO's allowance of such prior registrations does not bind the Board or this court.”).

We also find unpersuasive Applicant's argument that because it does not certify the authenticity of its trading cards, its proposed CERTIFIED mark cannot be the generic designation of its goods. First, the evidence of record demonstrates that Applicant provides certification of the authenticity of signatures of some of its cards, albeit not cards sold under its proposed CERTIFIED mark. Second, as previously



noted, we must look to Applicant's identification of goods when evaluating whether a proposed mark is generic for the applied-for goods. Here, Applicant's identification of goods is written broadly enough to include both certified and non-certified collectible trading cards and sports trading cards. A mark may be found generic where an applicant's identification "is broadly worded and encompasses the narrower category of goods and/or services named in the mark." *In re Greenliant Systems, Ltd.*, 97 USPQ2d 1078, 1082 (TTAB 2010); *In re Wm. B. Coleman Co., Inc.*, 93 USPQ2d 2019, 2024-25 (TTAB 2010); *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1790 (TTAB 2002).

As for Applicant's prior registration (now canceled) for the mark CERTIFIED for "sports player trading cards," we note that "[a] cancelled or expired registration has no probative value other than to show that it once issued and it is not entitled to any of the statutory presumptions of Trademark Act Section 7(b)." *Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at \*26 (TTAB 2022) (citations omitted); *see also Action Temporary Services Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989);. Thus, we have given Applicant's canceled CERTIFIED registration no consideration.

We also find unavailing Applicant's argument that because its proposed CERTIFIED mark appears on the identified collectible trading cards and sports trading cards in a particular font style, size and color, consumers would view it as a source indicator for its goods. Specifically, we note that Applicant is seeking to register the word CERTIFIED in standard characters, and while the evidence of

record shows that Applicant displays its mark in a particular stylization, the application is not so limited. Trademark Rule 2.52(a), 37 C.F.R. § 2.52(a).

Quite simply, the record supports a finding that the primary significance of the designation CERTIFIED in the minds of the relevant consuming public is to identify a good rather than to identify a single source of the good. More specifically, we conclude that the wording CERTIFIED identifies a subgenus and key aspect of collectible trading cards and sports trading cards and, therefore, is the generic name of Applicant's goods. See, e.g., *In re Central Sprinkler Co.*, 49 USPQ2d 1194, 1199 (TTAB 1998) (ATTIC "directly names the most important or central aspect or purpose of applicant's goods, that the sprinklers are used in attics, this term is generic and should be freely available for use by competitors.").

Because we have found that the designation CERTIFIED is generic for Applicant's identified goods, we need not reach the merits of the other grounds for refusal. See, e.g., *In re E5 LLC*, 103 USPQ2d 1578, 1584 (TTAB 2012) (affirmance of refusal on the ground that the mark sought to be registered was deceptive of a feature or ingredient of the identified goods; Board declined to reach merits of requirement for a disclaimer of portion of the mark as being deceptively misdescriptive of the goods); *In re DTI Partnership LLP*, 67 USPQ2d 1699, 1702 (TTAB 2003) (affirmance of requirement for product information was sufficient basis to refuse registration; Board declined to reach merits of refusal based on mere descriptiveness because applicant's failure to submit required information hindered Board's ability to assess the latter refusal).

Additionally, because of our finding that the designation CERTIFIED is generic

Serial No. 88927178

for Applicant's identified goods, Applicant's alternative request to amend its application to seek registration on the Supplemental Register is **denied**. *In re Emergency Alert Sols. Grp., LLC*, 122 USPQ2d 1088, 1089 (TTAB 2017) (generic terms are not registrable on the Supplemental Register); *see also Real Foods*, 128 USPQ2d at 1372 n.3 (citing *In re Am. Fertility Soc'y*, 51 USPQ2d at 1833) (same).

**Decision:** The refusal to register Applicant's proposed CERTIFIED mark on the ground that the designation is generic for the identified goods is affirmed.