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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	77938432
Applicant	Healthy Children Project, Inc. DBA Academy of Lactation Policy and Practice
Applied for Mark	CLC
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE
THE TRADEMARK TRIAL AND APPEAL BOARD**

In re:

Serial Number: 77/938432

Mark: CLC

Applicant: Healthy Children Project, Inc.

Examining Attorney: Ingrid C. Eulin
Law Office 111

EX PARTE APPEAL

APPLICANT'S REPLY BRIEF

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In the Examining Attorney's Appeal Brief, the Examining Attorney withdrew her Section 2(d) refusal to register the Applicant's CLC mark, but maintains her refusal on failure to function grounds. Thus, the only issue on appeal is whether the application record demonstrates that the CLC functions as certification mark rather than designating a title or degree. The Applicant, Healthy Children Project, Inc. ("Healthy Children"), pursuant to 37 C.F.R. § 2.142(b)(1), hereby submits its Reply Brief in support of its appeal.

ARGUMENT

The application record demonstrates that the CLC mark is used as a certification mark and is perceived by the relevant public as a certification mark. Accordingly, Healthy Children's CLC mark functions as a certification mark and registration of the mark is warranted.

In her brief, the Examining Attorney states that she has submitted evidence that "establishes that the circumstances surrounding the use and promotion of the mark, as presented in the specimen and perceived by service recipients, merely indicates an educational certification and professional qualification awarded to the displaying recipient". This evidence includes extensive material showing that post-nominal letters can be used as a degree or a title¹ as well as use of the CLC mark in various materials.²

While the evidence submitted by the Examining Attorney does show that post-nominal letters can be used as a degree or title, that evidence does not establish that only

¹ See, e.g. Attachments 3-53 to the July 27, 2011 Office Action.

² See, e.g. Attachments 4-27 to the May 11, 2010 Office Action.

use of post-nominal letters is for a degree or a title.³ The more fundamental flaw in the Examining Attorney's reliance on this evidence is that it does not show "the significance which the designation is likely to have to members of the relevant public ...". *In re Council of Council on Certification of Nurse Anesthetists*, ("CRNA") 85 U.S.P.Q. 2d 1403, 1406 (TTAB 2007) (reversing refusal to register CRNA mark on function grounds).

The evidence of use submitted by the Examining Attorney is ambiguous and unpersuasive. For example, the Examiner cites Attachment 3 to the May 11, 2010 Office Action as evidence that the CLC mark is used as a title while ignoring later pages to the same material which show certification significance by identifying the skills that a CLC certificant possesses.⁴ Similarly, Attachment 19 to the same Office Action is a list of what is described as professional credentials. CLC is listed and described as a Certified Lactation Counselor/Consultant. Also listed in Attachment 19, is IBCLC, which is described as an International Board Certified Lactation Consultant. The IBCLC mark is a registered certification mark.⁵ The fact that the IBCLC mark is used in an identical fashion to the CLC mark⁶ undermines the Examining Attorney's interpretation of this evidence.

In short, the evidence submitted by the Examining Attorney fails to establish that the CLC mark functions as a title or professional degree.

³ Nor, as Healthy Children demonstrated in its Appeal Brief, could these articles establish that proposition since there are numerous certification marks that consist of post-nominal letters.

⁴ Attachments 7-8.

⁵ See Registration Number 2,042,667 submitted in connection with Healthy Children's June 15, 2011 Response to Office Action.

⁶ Both marks are used in comparable manner in other pages in the evidence submitted by the Examining Attorney. See Attachments 27 and 29.

In contrast, Healthy Children submitted the only direct evidence showing how the relevant public actually perceives the CLC mark. Specifically, Healthy Children has submitted five declarations from health care professionals involved in the provision of breastfeeding support that demonstrate that the relevant public itself has come to recognize Healthy Children's mark as a certification mark rather than as a title or degree. The Examining Attorney states that these declarations "only indicate that the declarant is aware of the applicant's efforts to establish use as a certification mark". That statement is contradicted by explicit statements by the declarants indicating that they understand the CLC mark to be a certification mark and rely on the CLC certification mark.⁷ The Examining Attorney also states that "the declarations do not show how the mark is perceived by service recipients, namely breastfeeding women".⁸ This statement is also inaccurate. The declarations, by health professionals from around the country, do refer to breastfeeding women, stating in pertinent part, that "I believe that our clients, hospital staff and local community services recognize these certification marks ...".

Further, the Examining Attorney's statement suggests that breastfeeding mothers constitute the only relevant public for determining the certification significance of the marks. While breastfeeding mothers constitute an important part of the relevant public,

⁷ Declaration of Ann M. Twiggs, Declaration of Rosemary Mason, Declaration of Karin Moore, Declaration of Debra Hamilton, Declaration of Janet L. Tolley. ¶¶ 3, 7. These declarations were submitted in support of Healthy Children's November 11, 2010 Response to Office Action.

⁸In its Appeal Brief, Healthy Children referred to two declarations from breastfeeding mothers to demonstrate that breastfeeding mothers perceive the CLC mark. These were submitted with the Applicants Supplemental Response to Office Action on December 10, 2010 and quoted in Healthy Children's June 15, 2011 Response to Office Action at pages 5-6. Although the Supplemental Response is in the record of this proceeding, the Declarations that were submitted with the Supplemental Response misfiled by the USPTO. Healthy Children became aware that the declarations had been misfiled after this appeal was filed, but anticipated that the record could be corrected. This could not be accomplished and the Examining Attorney declined Healthy Children's request, pursuant to Rule 1207.03 of the TMMP to allow the declarations to be added to the record without the necessity of a remand.

the relevant public includes health professionals who work with and hire lactation counselors. *See CRNA, supra* at 1410 (relevant public for services rendered by individuals with CRNA certification included “surgical patients, and doctors, and hospital administrators”). That being the case, the declarations of Karen Moore, of the Poudre Valley Hospital in Fort Collins, Colorado and Rosemary Mason, owner and director of the North County Doula in San Diego, California are particularly probative. Ms. Moore states in her declaration that “[W]e require all of our Lactation Nurses, Patient Care Coordinators and Clinical Educators from Pediatrics, Neonatal Intensive Care, Birthing Center and Women’s Care (mom-baby/postpartum) to be certified by Healthy Children’s Certified Lactation Counselor Course so that they can be both a role model and support to our staff and patients”.⁹ Similarly, in her declaration, Ms. Mason states that she “encourages all of my students and postpartum doulas to become Certified Lactation Counselor-CLC”.¹⁰ As individuals who hire Healthy Children’s certificants, Ms. Moore and Ms. Mason are certainly part of the relevant public and perceive the CLC mark as a certification mark.

The Examining Attorney’s statement that the declarations support refusal to register because the “declarations indicate that the mark is awarded to individuals upon satisfaction of a credentialing examination, thus demonstrating the perception that the mark merely identifies qualifications of the user” is only accurate if one does not read the entire sentence to which the Examining Attorney refers. In fact, the declarants state “I am aware that only qualified individuals *who meet Healthy Children’s eligibility requirements*, pass Healthy Children’s credentialing examination, *and continue to meet*

⁹ Moore Declaration, ¶2.

Healthy Children's requirements, are permitted to use the "CERTIFIED LACTATION COUNSELOR" and "CLC" *certification marks*".¹¹ Contrary to the Examining Attorney's contention, the declarations demonstrate that the declarants understand that Healthy Children operates a certification program. *See In re National Institute for Automotive Service Excellence*, 218 U.S.P.Q. 744 (TTAB 1983). (stating that a mechanic who wishes to use the mark "must meet certain standards set by applicant as to experience and training and must pass a test conducted by applicant for each area of automotive mechanics ... in which he desires to be certified as competent. In order to maintain his certification, he must retake and pass the test or tests every five years thereafter").

In her brief, the Examining Attorney has made the disturbing suggestion that the record "seems to contradict the veracity of some of the assertions contained in the declaration as the record shows that other groups also award lactation counseling certifications". It is true that other programs award lactation counseling certifications. In fact, Healthy Children submitted evidence related to the certification mark "IBCLC" which is offered by the International Board of Lactation Consultant Examiners, an organization that competes with Healthy Children.¹² However, the fact that competing certification programs for lactation counseling services exist has no bearing on the veracity of any of the declarations submitted by Healthy Children. While the declarants state that they not are aware of other lactation certification programs that offer the CLC

¹⁰ Declaration of Rosemary Mason, ¶ 1.

¹¹ Declaration of Ann M. Twiggs, Declaration of Rosemary Mason, Declaration of Karin Moore, Declaration of Debra Hamilton, Declaration of Janet L. Tolley.¶¶ 3 (emphasis supplied).

¹² See Registration Number 2,042,667 submitted in connection with Healthy Children's June 15, 2011 Response to Office Action.

mark, none of those declarations suggest that the Healthy Children certification program is the only certification program for lactation counseling services. In light of the fact that the declarations state that the declarants have been warned that willful false statements are punishable by fine or imprisonment, Healthy Children vigorously objects to the Examining Attorney's gratuitous and unfounded suggestion.

In sum, the declarations submitted by Health Children unequivocally show that the relevant public perceives the CLC mark as a certification mark and are more probative than the ambiguous statements submitted by the Examining Attorney.

The Examining Attorney's criticism of the specimens submitted by Healthy Children is also misplaced. The Examining Attorney criticized the original specimen on the ground that the use of CLC in the specimen was "used merely to convey personal information". As has been previously stated, the use of post-nominal letters is not limited to use as a title and is consistent with use as a certification mark. Further, it should be noted that the CLC mark is used in connection with the words Certified Lactation Counselor, thereby communicating certification significance.

The Examining Attorney also criticized Healthy Children's substitute specimen. That specimen, included as part of the Declaration of Ellen C. Derby, consists of a web-page from the web-site operated by Ellen C. Derby to promote her services and describes the CLC mark as a certification mark as compared to a title or degree.¹³ This is an appropriate use of a certification mark. *See* 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, §19.93 (4th Edition 2012) (footnotes omitted) ("a designation serves as a certification mark for services only if it is clearly used to certify

the characteristics of the services performed and clients and customers are aware of that. For example, use of a certification mark is shown by use in a certificate or brochure which is seen by users of the services”), *See also CRNA*, ¹⁴ *supra*, at 1408 (applicant’s specimens included “a copy of a brochure that includes questions and answers about anesthesia and a health questionnaire for patients undergoing anesthesia”). Thus, contrary to the Examining Attorney’s contention, the specimens submitted demonstrate that the CLC mark functions as a certification mark.

In addition to the specimens and declarations, Healthy Children submitted its Candidate Handbook as evidence of its certification standards¹⁵ and as evidence that Healthy Children operates a certification program with requirements comparable to National Institute of Automotive Service Excellence. *See In Re National Institute for Automotive Service Excellence, supra*. The Examining Attorney discounts the probative value of the Candidate Handbook on several grounds, including the contention that the Handbook is “not viewed by the ultimate consumer”. The record does not support the Examining Attorney’s contention. As is demonstrated by the declaration of Rosemary Mason, a member of the relevant public, has the CLC certification herself and would be familiar with Healthy Children’s certification requirements as would other members of the relevant public who also possess the CLC certification. *See CRNA, supra* at 1410 (including Candidate’s Handbook among evidence demonstrating “that the CRNA

¹³ For the reasons set forth in its Appeal Brief, Healthy Children disputes the Examining Attorney’s claim that the CLC wording is “buried within the text” of the advertisement.

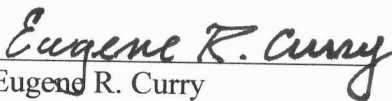
¹⁴ The Examining Attorney attempts to distinguish *CRNA* from the instant application on the ground that in that case the applicant submitted numerous specimens while Healthy Children has only submitted two specimens. However, it is the quality of specimens rather than the number of specimens that is dispositive. *See CRNA, supra* at 1409 (dismissing many of the specimens submitted by the applicant as unpersuasive).

designation would be perceived as a certification mark by the ultimate recipients of the services, namely surgical patients and doctors and hospital administrators”).

CONCLUSION

In light of the foregoing, Healthy Children respectfully requests that the Board grant this Ex Parte Appeal and allow for the registration of the CLC mark.

Respectfully Submitted,
The Applicant,
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By its Attorney,


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¹⁵ In addition to the reasons set forth in Healthy Children’s Appeal Brief, *In re Software Publishers Association*, 69 U.S.P.Q.2d 2009, 2014 (TTAB 2003) is distinguishable on the grounds that in that case the applicant failed to submit a copy of its standards.