

This is in response to the Office Action transmitted on October 3, 2019, in connection



with the application to register the mark

(Ser. No. 88/582,261).


The Office Action seeks disclaimer of the wording AMERICAN MANAGEMENT ASSOCIATION and CERTIFIED PROFESSIONAL IN MANAGEMENT apart from the mark as shown. Applicant submits that such disclaimers are not necessary in connection with this application.

**Argument**

**A. The AMERICAN MANAGEMENT ASSOCIATION Portion of the Mark Has Achieved Acquired Distinctiveness**

Applicant has been using the AMERICAN MANAGEMENT ASSOCIATION trademark and service mark continuously in commerce since at least as early as 1923. As such, Applicant's AMERICAN MANAGEMENT ASSOCIATION mark has become distinctive of Applicant's goods and services through Applicant's substantially exclusive and continuous use of its mark in commerce for nearly a century. Moreover, Applicant owns several registrations for the AMERICAN MANAGEMENT ASSOCIATION mark for related goods and services, including the following:

Mark	Reg. No.	Reg. Date	Goods/Services
The logo consists of the letters 'AMA' in a bold, sans-serif font, followed by a vertical bar and the word 'GLOBAL' in a bold, sans-serif font. Below this, the text 'American Management Association' is written in a smaller, regular, sans-serif font.	5241799	July 11, 2017	Class 16: Educational books, printed informational materials in the form of brochures, pamphlets and catalogs in the field of business management;

			<p>seminar program materials, namely, course outlines and notebooks containing instructional programs, question and answer sheets, teaching and training materials, and factual material for teaching devices all for use in the field of business management</p> <p>Class 35: Providing information in the field of business management via websites on a global computer network</p> <p>Class 41: Educational services, namely, providing courses and workshops in the field of business management and the distribution of training materials in connection therewith; conducting seminars in the field of business management and the distribution of training materials in connection therewith; providing online courses in the field of business management via the Internet; educational services, namely, providing live and prerecorded online audio and video programs in the field of business management via the Internet; online electronic publishing of books, periodicals, articles, and journals in the field of business management.</p>
	2948665	May 10, 2005	<p>Class 16: Educational books, printed informational materials in the form of brochures, pamphlets and catalogs, seminar program materials; namely, course outlines and notebooks containing instructional programs, question and answer sheets and teaching and training materials, all for use in the field of business management</p> <p>Class 41: Educational services; namely, providing courses and workshops, live and on video, in business management</p>

AMERICAN MANAGEMENT ASSOCIATION	2069326	June 10, 1997	Class 41: educational services, namely, providing courses and seminars in the field of management education
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Copies of the registration certificates for these marks are attached hereto as Exhibit A.

Accordingly, Applicant submits that the AMERICAN MANAGEMENT ASSOCIATION portion of the mark has become distinctive of Applicant's goods and services under Section 2(f).

As with the Applicant's other registrations for AMERICAN MANAGEMENT ASSOCIATION, Applicant submits the following disclaimer statement:

**No claim is made to the exclusive right to use "ASSOCIATION" apart from the mark as shown.**

**B. The CERTIFIED PROFESSIONAL IN MANAGEMENT Portion of the Mark Need Not Be Disclaimed**

The Office Action also requests that Applicant disclaim the wording "CERTIFIED PROFESSIONAL IN MANAGEMENT" apart from the mark as shown. Applicant respectfully submits that this wording is not merely descriptive when applied to the goods and services to which the mark is applied.

The Office Action states that "[t]his wording is, at best, merely descriptive of an ingredient, quality, characteristic, function, feature, purpose, or use of applicant's goods and services . . . ." Applicant respectfully disagrees, and submits that the wording "CERTIFIED PROFESSIONAL IN MANAGEMENT" is at least suggestive and not merely descriptive of the goods and services offered under the mark, and, therefore, a disclaimer of the wording pursuant to Trademark Act Section 6 is not necessary.

The purpose of a disclaimer is to permit registration of a mark that is registrable as a whole, but contains matter which would not be registrable standing alone. TMEP § 1213 et seq.; see also Horlick's Malted Milk Co. v. Borden Co., 295 F. 232, 234, 1924 C.D. 197, 199 (D.C. Cir. 1924). A disclaimer ensures that one will not be able to monopolize particular wording that is commonly used to describe particular goods or services. See, e.g., TMEP § 1213 (“The purpose of a disclaimer is to permit the registration of a mark that is registrable as a whole but contains matter that would not be registrable standing alone, *without creating a false impression of the extent of the registrant's right with respect to certain elements in the mark.*” (emphasis added)).

“Whether a given mark is suggestive or merely descriptive depends on whether the mark ‘immediately conveys . . . knowledge of the ingredients, qualities, or characteristics of the goods . . . with which it is used’, or whether ‘imagination, thought, or perception is required to reach a conclusion on the nature of the goods.’” In re Gyulay, 3 U.S.P.Q.2d 1009 (Fed. Cir. 1987) quoting In re Quik-Print Copy Shops, Inc., 205 U.S.P.Q. 505, 507 (C.C.P.A. 1980). The categories are in actuality “central tones in a spectrum . . . and are frequently difficult to apply.” Gyulay, 3 U.S.P.Q.2d at 1010 citing Soweco, Inc. v. Shell Oil, Co., 617 F.2d 1178, 1183, 207 U.S.P.Q. 278, 282 (5th Cir. 1980) (citation omitted). If, however, when the goods or services are encountered under a mark, a multistage reasoning process, or resort to imagination, is required in order to determine the attributes or characteristics of the product or services, the mark is suggestive rather than merely descriptive. See In re Abcor Development Corp., 588 F.2d 811, 814, 200 U.S.P.Q. 215, 218 (C.C.P.A. 1978); In re Atavio, 25 U.S.P.Q.2d 1361, 1362 (T.T.A.B. 1992).

Applicant submits, when applied to the goods and services in question, the wording fails to describe Applicant's goods and services in a direct or immediate manner but functions as an identifier of the source of the goods and services offered by Applicant. See In re Remacle, 66 U.S.P.Q.2d 1222, 1224 (T.T.A.B. 2002) (reversing refusal of registration under Section 2(e)(1) of the mark BIO-CD for compact discs that are used to test biological matter). Indeed, a mental step is required to move from the combined terms "CERTIFIED PROFESSIONAL IN MANAGEMENT" to an understanding of the nature of Applicant's goods and services.

The Office Action merely recites the dictionary definitions for the words "certified," "professional," and "management," and states that "Applicant's educational products and services are specifically directed at management professionals, as indicated by applicant's identification of goods and services. Thus, this terminology immediately communicates the intended audience of applicant's goods and services and must be disclaimed." Aside from reciting the definition, the Office Action did not discuss at all the manner in which the term "certified" is descriptive of the goods and services.

At most, these dictionary definitions may indicate that each term individually may suggest information about the goods and services. Mere recitation of the meanings of these terms does not, however, lead to the conclusion that "CERTIFIED PROFESSIONAL IN MANAGEMENT" merely describes the goods and services. The combination and sequence of the terms together creates a distinct impression beyond the individual impressions of the mere dictionary definitions of those words individually. The prepositional phrase "CERTIFIED PROFESSIONAL IN MANAGEMENT" as a whole creates a distinct commercial impression that is greater than the sum of its parts. See, e.g., TMEP § 1213.05(b)(ii)(B) (the prepositional

phrases “MENTORS FOR COMPLETE TEACHING,” “DEPARTMENT OF THE NAVY,” and “A DIVISION OF XYZ INDUSTRIES” are unitary and do not require disclaimer).

Further, Applicant submits that CERTIFIED PROFESSIONAL IN MANAGEMENT does not immediately convey the characteristics of Applicant’s goods and services to be offered under the mark, but rather requires a logical step. Applicant’s goods and services, as amended herein, are:

Class 16: Educational books, printed informational materials in the form of brochures, pamphlets and catalogs in the field of business management; seminar program materials, namely, course outlines and notebooks containing instructional programs, question and answer sheets, teaching and training materials, and factual material for teaching devices all for use in the field of business management;

Class 41: Educational services, namely, providing courses and workshops in the field of business management and the distribution of training materials in connection therewith; conducting seminars in the field of business management and the distribution of training materials in connection therewith; providing online courses in the field of business management via the Internet; providing live and non-downloadable prerecorded online audio and video programs in the field of business management via the Internet; providing on-line discussion forums in the field of business management; online electronic publishing of books, periodicals, articles, and journals in the field of business management; educational services, namely, the development and offering of educational programs and exams in the field of business management; and

Class 42: Testing, analysis, and evaluation of the knowledge, skills and abilities of others for the purpose of identifying and recognizing those individuals who have acquired qualifications and expertise in the field of business management.

The words CERTIFIED PROFESSIONAL IN MANAGEMENT do not immediately convey the nature of Applicant’s goods and services, specifically that Applicant provides educational materials and services, seminars, courses, and webinars, along with testing, analysis, and evaluation services, all in the field of business management. The words also do not convey the subject matter of such goods and services. Notably, the first definition of “management” in the dictionary attached to the Office Action indicates that “management” relates to “factory

workers.” The wording further does not directly convey who a “professional” would be, i.e., whether Applicant would provide the services of an undefined “professional” or to such “professional.” Moreover, the description of goods and services does not use the words “certified” or “professional” or indicate how one would achieve this status.

An ordinary consumer encountering the words CERTIFIED PROFESSIONAL IN MANAGEMENT would not directly conclude that such words refer to the goods and services to be provided by Applicant. There is sufficient ambiguity in CERTIFIED PROFESSIONAL IN MANAGEMENT that the words as a whole do not forthwith convey an immediate idea of applicant’s various goods and services listed above or the subject matter of those goods and services.

To be registrable on the Principal Register, a mark does not have to be devoid of all meaning relative to the goods or services. It is not prohibited that a mark has the capacity to draw attention to what the product is or what its characteristics are. TMEP § 1209.01(a). The suggestive nature of Applicant’s mark is supported by decisions of the Federal Circuit (and its predecessor, the Court of Customs and Patent Appeals) and the Trademark Trial and Appeal Board. See e.g., In re Scrum Alliance, Inc., 2009 TTAB LEXIS 582 (T.T.A.B. Sept. 4, 2009) (CERTIFIED SCRUMMASTER not merely descriptive of training and educational services); Bose Corp. v. International Jensen, Inc., 22 U.S.P.Q.2d 1704 (Fed. Cir. 1992) (ACOUSTIC RESEARCH held to be suggestive for loudspeakers); In re Majestic Distilling Co., 164 U.S.P.Q. 386 (C.C.P.A. 1970) (CHARRED KEG held to be suggestive for whiskey); In re On Technology Corp., 41 U.S.P.Q.2d 1475 (T.T.A.B. 1996) (AUDITTRACK held to be suggestive for computer software for monitoring activity on a computer network); Levi Strauss & Co. v. R. Josephs Sportswear, 28 U.S.P.Q.2d 1464 (T.T.A.B. 1993) (ACTION SLACKS held to be suggestive for

pants); In re Shop-Vac Corp., 219 U.S.P.Q. 470 (T.T.A.B. 1983) (WET/DRY BROOM held to be suggestive for electric vacuum cleaners); Manpower, Inc. v. Driving Force, Inc., 212 U.S.P.Q. 961 (T.T.A.B. 1981) (THE DRIVING FORCE held to be suggestive for supplying truck drivers); In re Polytop Corp., 167 U.S.P.Q. 383 (T.T.A.B. 1970) (LOC-TOP held to be suggestive for bottle closure caps); In re Colgate-Palmolive Co., 149 U.S.P.Q. 793 (T.T.A.B. 1966) (HANDI WIPES held to be suggestive for dusting cloths); and Colgate-Palmolive Co. v. House for Men, Inc., 143 U.S.P.Q. 159 (T.T.A.B. 1964) (RAPID –SHAVE held to be suggestive for shaving cream).

It has long been held that “there is a very thin line of demarcation between a term that is merely descriptive and hence unregistrable in the absence of a showing of secondary meaning, and one that is suggestive, and hence registrable, and it is often difficult to determine whether a particular term is on one side of the line or the other.” In re Aid Laboratories, Inc., 221 U.S.P.Q. 1215, 1216 (T.T.A.B. 1983); citing In re TMS Corporation of America, 200 U.S.P.Q. 57 (T.T.A.B. 1978). However, “where there is doubt on the matter, the doubt should be resolved in applicant's behalf and the mark should be published in accordance with Section 12(c) of the Statute for purposes of opposition.” Aid Laboratories, 221 U.S.P.Q. at 1216. Applicant respectfully requests that the disclaimer request for “CERTIFIED PROFESSIONAL IN MANAGEMENT” be withdrawn.

### **Conclusion**

Based upon the foregoing, Applicant requests that the application for AMA AMERICAN MANAGEMENT ASSOCIATION CERTIFIED PROFESSIONAL IN MANAGEMENT CPM (stylized) be approved for publication with the amendments included herein.