

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)	Examining Attorney:
ACT, Inc.)	Kyle Aurand
Serial No.: 88/693,022)	Trademark Law Office 126
Filed: November 14, 2019)	
For: BRONZE)	

RESPONSE TO OFFICE ACTION

Hon. Asst. Comm. For Trademarks
United States Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451

Sir:

Applicant hereby responds to the Office Action of November 02, 2020.

I. INTRODUCTION

The Examining Attorney has issued an Office Action refusing to register on the Principal Register the certification Mark “BRONZE” for use in association with “the rendering and performance of workplace services in the nature of business management services, business administration services, financial operations services, architecture, construction and engineering services, Information technology services, agriculture services, namely, contract farming for others; natural resource services, namely, natural resource management and research in the field of natural resources; food preparation and serving services; arts services, namely, graphic art

design;, entertainment services, namely, media production services for film, television and theatrical performances;, media services, namely, media relations and media production services; communications services namely, telecommunications services; education and training services, government relation services; public administration services; health science services; hospitality and tourism services; human resource services; legal services; public safety services in the nature of firefighting, police and civil protection services; corrections penal services, namely, providing correctional facilities and security services; contract manufacturing services; marketing and sales promotion for others; transportation services; logistics management services; community and social services in the nature of education courses at the primary and secondary level, public housing services and public medical clinic services; and installation, maintenance and repair services in the field of automobiles, electronics, appliances and residential and commercial buildings provided to an employer by individual employees or prospective employees who possess the necessary foundational skills in core disciplines, namely, reading, math and graphic literacy” in International Class B (“Applicant’s Mark”), on the grounds that the activities recited in the identification of services are not registrable services as contemplated by the Trademark Act under Trademark Act Section 1 ,2, 3 and 45.

On the same basis, the Examining Attorney has refused to accept the specimen as not demonstrating certification mark use.

Applicant will demonstrate that the services identified in the Application are registrable as contemplated by the Trademark Act and that the specimens demonstrates certification mark use. Applicant respectfully requests that Applicant’s Mark be passed to publication in the Official Gazette for registration on the Principal Register.

II. USE OF APPLICANT’S CERTIFICATION MARK .

Certification marks are “(1) used by a person *other than its owner . . . to certify . . .* quality, accuracy, or other *characteristics of such person’s goods or services . . .*” TMEP §1306.01 (citing Section 4 of the Trademark Act, 15 U.S.C. §1054). “A certification mark ‘is a special creature *created for a purpose uniquely different* from that of an ordinary service mark or trademark . . .” TMEP §1306.01 (quoting *In re Florida Citrus Commission*, 160 USPQ 495, 499 (TTAB 1968)). Here, Applicant’s Mark is used by third parties to certify that the authorized users will perform their job duties with a certain level of skill and competency in an implicated service area. And here, the certification is made to a prospective employer or provider of the service implicated.

The Examining Attorney has focused on the language *provided to an employer by individual employees or prospective employees* to negate the registrability of the services proffering that employers who have come to recognize and trust Applicant’s certifications at 4 different levels including “BRONZE” are *not* consumers or purchasers of the services certified. This is not a conclusion supported by the trademark law.

A. Authorized Users of Applicant’s Mark Certify to Their Consumers Levels of Competency in Job Performance

Applicant ACT, Inc. (“ACT”) is a trusted leader in college and career readiness, providing high-quality assessments grounded in nearly 60 years of research. ACT provides more than a hundred assessments and research, information, and program management services in the broad areas of education and workforce development.

Pertinent here is a workforce development assessment ACT developed and administers called “WorkKeys.” WorkKeys assessments are a collection of proctored tests that measure the most necessary and in demand workplace skills relating to an individual’s workplace skillset

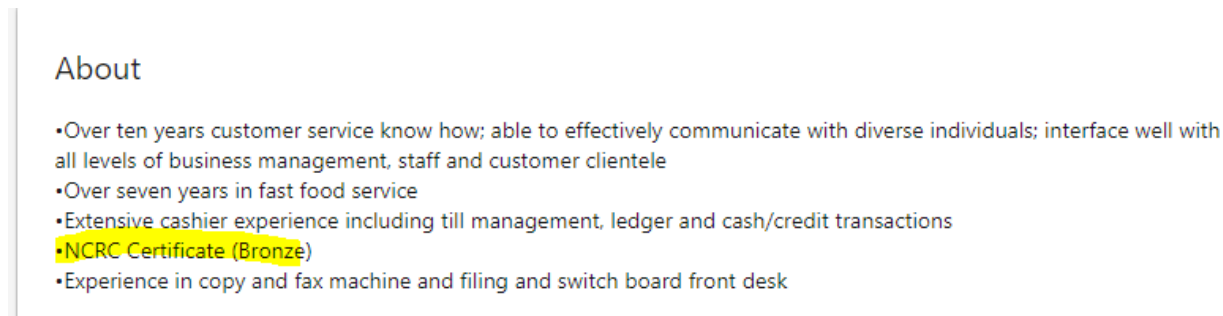
and job performance. WorkKeys assessments measure competency in math, reading and writing, and indicate a range of hard and soft skills relevant to any occupation, at any level, across multiple industries. WorkKeys assessments are a first step toward closing skills gaps and improving workforce quality, and are the basis for the National Career Readiness Certificate® (NCRC®)—the nation's most recognized work readiness credential that is recommended by tens of thousands of employers.

The NCRC certifies essential skills and competencies for workplace success, and serves as the basis of state and county-level workforce and economic development initiatives. The NCRC is awarded at four different levels: BRONZE, SILVER, GOLD and PLATINUM, based on a test-taker's performance on three specific WorkKeys assessments—Applied Math (previously, Applied Mathematics), Graphic Literacy (previously, Locating Information), and Workplace Documents (previously, Reading for Information). These assessments are designed to measure and certify fundamental employability skills.

Applicant grants third party prospective employees the right to use the subject Certification Mark, BRONZE, if they score a three (3) or above across all three assessments. Specifically, Applicant's "BRONZE" Certification Mark indicates that an individual possesses the essential foundational skills required for at least 15% of jobs profiled—or surveyed—by the Applicant. *See Exhibit A* at 2. This cut-off score is set by Applicant based on extensive research and psychometric evaluation, including research correlating the WorkKeys assessments to fundamental workplace skills and job performance.

Applicant's Mark is used by current or prospective employees to certify to current or prospective employers that they will perform their duties (or perform their workplace services) at a particular level of quality or competency. Applicant has issued over 1,173,300 Bronze level

certificates to date bearing Applicant's Mark. **Exhibit B** at 2. Authorized users (job applicants) advertise to employers (the consumer) that they are BRONZE certified. For example, below is a screenshot of a portion of resume on LinkedIn that advertises the job applicant's services are BRONZE certified:



Many individuals advertise their certified services by posting their resumes on LinkedIn, Indeed and similar recruiting services; they may also upload their resumes to ACT's work ready communities sites, where employers can access them. The authorized users of Applicant's Mark use the Mark to gain a competitive advantage in the recruiting process in which they are marketing the quality of their employment services.

B. The Relevant Consumers of Services Offered Under Applicant's Mark Are Employers

The relevant purchasers for the services offered under Applicant's Mark are employers looking to fill an open position. More specifically, employers who participate in the ACT Work Ready Communities program engage ACT-trained job profilers to study the skills and competencies that are required to adequately perform the desired job duties, and then match such requirements to the level scores on the WorkKeys assessments. For example, a job profile will indicate that a BRONZE certified applicant (as opposed to an uncertified applicant) will be able to perform the required duties for the job with a certain level of competency and quality. Based on this, employers can be confident that a person who is authorized by ACT to use a BRONZE

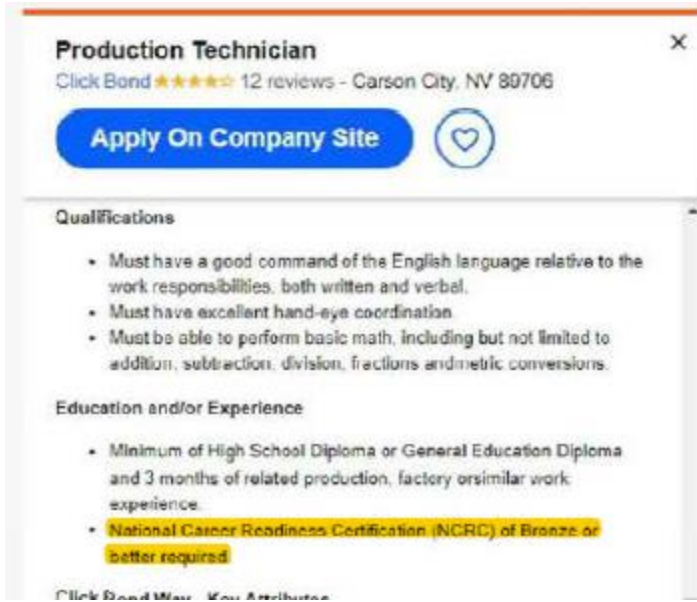
certification, is certifying that their services will be performed with the skill and competency level that the employer expects for that particular job.

As an example, an overview of ACT’s Alaska Career Ready program, which includes a list of the Marks and sample correlated occupations, states: “thousands of Alaskans have earned certificates and *lots of businesses* of all sizes, in a variety of industries, are supporting the certificate by *recognizing or requesting the NCRC in their hiring process*. Some employers are *requiring the NCRC at specific levels* in their hiring after getting key positions *analyzed by an ACT authorized WorkKeys job profiler*.” **Exhibit C**. Below is an excerpt from a job posting for a “Maintenance Technician II – 2nd shift” from Brendix Commercial Vehicle Systems, LLC which seeks a BRONZE-certified applicant:



The full job posting is attached hereto as **Exhibit D**.

As another example, below is an excerpt from a job posting for a “Production Technician” from Click Bond, which seeks a Bronze-certified applicant:



The full job posting is attached hereto as **Exhibit E**.

These job postings cover different services, but the employers have determined that a BRONZE-certified service level is desirable from a job applicant. This is because, as discussed above, the consumer of Applicant's Mark perceives the mark as a certification of job performance quality. Employers who seek out Applicant's Mark on job applications and resumes are seeking an employee candidate who has been certified by ACT as possessing fundamental employability skills of a certain quality that apply to the job that the employer is seeking to fill. See **Exhibit A** at 2.

C. Employers and Prospective Employers Are Legitimate Consumers of Certified Services

The Applicant's Mark certifies the quality of services that are provided by an employee to an employer—*the relevant consumers are prospective employers* and the marketing channel is the hiring process.. The Examining Attorney has cited no authority which states or even suggests that employers or prospective employers cannot be consumers or purchasers of

services. Indeed, cases which have considered the issue have come to a contrary conclusion.

In *In re Nat'l Council for Therapeutic Rec. Certification, Inc.*, the Trademark Trial and Appeal Board (TTAB) found that the relevant public for applicant's services included employers of the therapeutic recreation specialists that were using the applicant's certification mark. *In re Nat'l Council for Therapeutic Rec. Certification, Inc.*, 2006 TTAB LEXIS 411, *36 (TTAB 2006). In that case, the application was filed by the National Council for Therapeutic Recreation Certification, Inc. to register CERTIFIED THERAPEUTIC RECREATION SPECIALIST as a certification mark for "recreational therapy and recreational therapy counseling" and certified that "the designated person meets the certifier's standards of competence in the field of recreation therapy and recreational therapy counseling, as indicated by experience and educational and training requirements, and the passage of a written examination." *Id.* at *1-2. . In reversing the examining attorney's refusal of registration of the certification mark, the Board stated that:

"the relevant public consists of persons in the recreational therapy field, i.e., recreational therapists who are candidates for applicant's certification, recreational therapists certified by applicant and who may use CERTIFIED THERAPEUTIC RECREATION SPECIALIST in listing their professional qualifications, **persons involved in the hiring of recreational therapists**, and coordinators of academic programs in the recreational therapy field..."(emphasis added)

Id. at 36. Similarly, here the relevant public for Applicant's Mark includes those companies and individuals involved in the hiring of personnel in a broad range of industries.

Another case supporting registrability of the services here is *In re Council on Certification of Nurse Anesthetists* where the TTAB found that the mark at issue, CRNA, functioned as a certification mark. *In re Council on Certification of Nurse Anesthetists*, 2007 TTAB LEXIS 49, *23-24 (TTAB 2007). There, applicant's materials showed that "in order to qualify to use the CRNA designation, a nurse anesthetist must meet certain standards and take

and pass a test. The Board found that the ultimate consumers of the nurse anesthesia services being certified included doctors and hospital administrators, those that would employ the nurses *Id.* at *24. Doctors and hospital administrators are employers (prospective or current) of nurse employees providing anesthesia services, which are the individuals that are being certified using the certification mark. This is analogous to the present situation, and thus, prospective employers should be regarded as part of the consuming public for purposes of the registrability of the services and the registration of Applicant's certification mark.

It is worth noting that the present case is no different in practice than, for example, the DIAMOND CERTIFIED program in which the registrant certifies the quality of a host of third party services to prospective employers of the individuals or companies who will provide the service. In the DIAMOND CERTIFIED scenario, as in the present case, the authorized user (the service provider) uses the registrant's mark to certify the quality of the service implicated as being performed under certain standards set by the registrant. The identification of services for DIAMOND CERTIFIED certification mark, U.S. Registration No. 2,768,919, is as follows:

“Home construction, repair, maintenance, and furnishings services, personal care services, health care services, automobile maintenance, repair and parts supply services, transportation services, financial services, namely, banking, financial planning, real estate loan, insurance, stock brokerage, tax preparation, savings and loan, and resume preparation services, employment agency services, professional services, namely, accounting, architectural, and legal services, appliance repair services, carpet and drapery cleaning services, equipment rental services, catering services, dating services, day care services, diaper services, and cemeteries.”

The only difference between the DIAMOND CERTIFIED identification of services and the Applicant's identification of services is the inclusion, in the latter case, of *from and to whom* the certification is made. In practice, however, the certification in each case is made by an authorized user seeking to gain advantage in a hiring process. If the Examining Attorney would prefer that the language--*provided to an employer by individual employees or prospective*

employees-- which was added as an amendment to the identification of services be removed from the amended services, the Applicant is quite amenable to that.

In sum, the exclusive use of Applicant's certification Mark is by *current or prospective employees* who advertise or promote the quality of their workplace services to *current or prospective employers*. There is nothing in the trademark law which exempts such use from functioning as a certification mark as evidenced by the relevant authorities and the DIAMOND CERTIFIED example above .

III. THE SPECIMEN DEMONSTRATES CERTIFICATION MARK USE

The Examining Attorney has refused to accept the specimen as not demonstrating certification mark use. As the Examining Attorney acknowledges, the purpose of a certification mark is to inform *purchasers* that the services of a person possess certain characteristics or meet certain qualifications or standards established by another person. TMEP §1306.01(b). In light of the evidence and arguments above which demonstrate that a certification mark can and does function to certify to a prospective employer that authorized user's services will be performed with a certain level of quality, competence and skill, the specimens submitted do adequately demonstrate certification mark use. If, however, the Examining Attorney requires additional specimens, Applicant will be happy to provide them.

IV. APPLICANT'S IS AMENABLE TO A FURTHER AMENDMENT

In the event the Examining Attorney so prefers, Applicant is amenable to removal of the language *provided to an employer by individual employees or prospective employees* from the current identification of services, and requests a further amendment as set forth below:

Amendment of Services:

“The rendering and performance of workplace services in the nature of business management services, business administration services, financial operations services, architecture, construction and engineering services, Information

technology services, agriculture and natural resource services, food preparation and serving services, arts, entertainment, media and communications services, education and training services, government and public administration services, health science services, hospitality and tourism services, human services, legal services, public safety, corrections and security services, manufacturing services, marketing and sales services, transportation, distribution and logistics services, community and social services, and installation, maintenance and repair services, *by those* who possess the necessary foundational skills in core disciplines, namely reading, math and graphic literacy.”

In that case, Applicant respectfully requests that its application be amended accordingly.

V. REMARKS

Applicant has demonstrated that the services identified in the Application are registrable as contemplated by the Trademark Act and that the specimens demonstrate certification mark use.

Applicant has agreed to further amend the description of services if appropriate and, in that case, respectfully requests that the Examining Attorney amend the application as set forth above.

If the Examining Attorney requires any additional documentation or has any other questions, he is urged to contact the undersigned attorney. Applicant respectfully requests that the mark be passed to publication in the Official Gazette, for registration on the Principal Register, at the Examining Attorney’s earliest convenience.

Dated: May 3, 2021

SHEPPARD, MULLIN, RICHTER & HAMPTON LLP

By _____
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