

of showing that the use by related companies inures to the benefit of the applicant and does not affect the validity of the mark.

(Sec. 5, 60 Stat. 429; 15 U.S.C. 1055)

[30 FR 13193, Oct. 16, 1965, as amended at 54 FR 37589, Sept. 11, 1989; 64 FR 48920, Sept. 8, 1999; 80 FR 2310, Jan. 16, 2015]

§ 2.39 [Reserved]

§ 2.41 Proof of distinctiveness under section 2(f).

(a) *For a trademark or service mark*—(1) *Ownership of prior registration(s)*. In appropriate cases, ownership of one or more active prior registrations on the Principal Register or under the Trademark Act of 1905 of the same mark may be accepted as prima facie evidence of distinctiveness if the goods or services are sufficiently similar to the goods or services in the application; however, further evidence may be required.

(2) *Five years substantially exclusive and continuous use in commerce*. In appropriate cases, if a trademark or service mark is said to have become distinctive of the applicant's goods or services by reason of the applicant's substantially exclusive and continuous use of the mark in commerce for the five years before the date on which the claim of distinctiveness is made, a showing by way of verified statements in the application may be accepted as prima facie evidence of distinctiveness; however, further evidence may be required.

(3) *Other evidence*. In appropriate cases, where the applicant claims that a mark has become distinctive in commerce of the applicant's goods or services, the applicant may, in support of registrability, submit with the application, or in response to a request for evidence or to a refusal to register, verified statements, depositions, or other appropriate evidence showing duration, extent, and nature of the use in commerce and advertising expenditures in connection therewith (identifying types of media and attaching typical advertisements), and verified statements, letters or statements from the trade or public, or both, or other appropriate evidence of distinctiveness.

(b) *For a collective trademark or collective service mark*—(1) *Ownership of prior*

registration(s). See the requirements of paragraph (a)(1) of this section.

(2) *Five years substantially exclusive and continuous use in commerce*. In appropriate cases, if a collective trademark or collective service mark is said to have become distinctive of the members' goods or services by reason of the members' substantially exclusive and continuous use of the mark in commerce for the five years before the date on which the claim of distinctiveness is made, a showing by way of verified statements in the application may be accepted as prima facie evidence of distinctiveness; however, further evidence may be required.

(3) *Other evidence*. In appropriate cases, where the applicant claims that a mark has become distinctive in commerce of the members' goods or services, the applicant may, in support of registrability, submit with the application, or in response to a request for evidence or to a refusal to register, verified statements, depositions, or other appropriate evidence showing duration, extent, and nature of the use in commerce, and advertising expenditures in connection therewith (identifying types of media and attaching typical advertisements), and verified statements, letters or statements from the trade or public, or both, or other appropriate evidence of distinctiveness.

(c) *For a collective membership mark*—(1) *Ownership of prior registration(s)*. In appropriate cases, ownership of one or more active prior registrations on the Principal Register or under the Act of 1905 of the same mark may be accepted as prima facie evidence of distinctiveness if the goods, services, or nature of the collective membership organization are sufficiently similar to the collective membership organization in the application; however, further evidence may be required.

(2) *Five years substantially exclusive and continuous use in commerce*. In appropriate cases, if a collective membership mark is said to have become distinctive of indicating membership in the applicant's collective membership organization by reason of the members' substantially exclusive and continuous use of the mark in commerce for the five years before the date on which the claim of distinctiveness is made, a

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showing by way of verified statements in the application may be accepted as prima facie evidence of distinctiveness; however, further evidence may be required.

(3) *Other evidence.* In appropriate cases, where the applicant claims that a mark has become distinctive in commerce of indicating membership in the applicant's collective membership organization, the applicant may, in support of registrability, submit with the application, or in response to a request for evidence or to a refusal to register, verified statements, depositions, or other appropriate evidence showing duration, extent, and nature of the members' use in commerce, and advertising expenditures in connection therewith (identifying types of media and attaching typical advertisements), and verified statements, letters or statements from the trade or public, or both, or other appropriate evidence of distinctiveness.

(d) *For a certification mark—(1) Ownership of prior certification mark registration(s).* In appropriate cases, ownership of one or more active prior certification mark registrations on the Principal Register or under the Act of 1905 of the same mark may be accepted as prima facie evidence of distinctiveness if the authorized users' goods or services are sufficiently similar to the goods or services certified in the application, subject to the limitations of the statement set forth in § 2.45(a)(4)(i)(C); however, further evidence may be required.

(2) *Five years substantially exclusive and continuous use in commerce.* In appropriate cases, if a certification mark is said to have become distinctive of the certified goods or services by reason of the authorized users' substantially exclusive and continuous use of the mark in commerce for the five years before the date on which the claim of distinctiveness is made, a showing by way of verified statements in the application may be accepted as prima facie evidence of distinctiveness; however, further evidence may be required.

(3) *Other evidence.* In appropriate cases, where the applicant claims that a mark has become distinctive of the certified goods or services program, the

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applicant may, in support of registrability, submit with the application, or in response to a request for evidence or to a refusal to register, verified statements, depositions, or other appropriate evidence showing duration, extent, and nature of the authorized users' use in commerce and advertising expenditures in connection therewith (identifying types of media and attaching typical advertisements), and verified statements, letters or statements from the trade or public, or both, or other appropriate evidence of distinctiveness.

(e) *Certification marks with geographical matter.* Paragraph (d) of this section does not apply to geographical matter in a certification mark certifying regional origin because section 2(e)(2) of the Act does not apply to certification marks that are indications of regional origin.

[80 FR 33180, June 11, 2015]

§ 2.42 Concurrent use.

(a) Prior to seeking concurrent use, an application for registration on the Principal Register under the Act must assert use in commerce and include all the application elements required by the preceding sections, in addition to § 2.44 or § 2.45, if applicable.

(b) The applicant must also include a verified statement that indicates the following, to the extent of the applicant's knowledge:

(1) For a trademark or service mark, the geographic area in which the applicant is using the mark in commerce; for a collective mark or certification mark, the geographic area in which the applicant's members or authorized users are using the mark in commerce;

(2) For a trademark or service mark, the applicant's goods or services; for a collective trademark, collective service mark, or certification mark, the applicant's members' or authorized users' goods or services; for a collective membership mark, the nature of the applicant's collective membership organization;

(3) The mode of use for which the applicant seeks registration;

(4) The concurrent users' names and addresses;