

## Blog Post

# Collective Membership and Preserving the Heritage of Pierce Arrow

September 5, 2019

In a recent decision concerning the scope of protection for collective membership marks, the Trademark Trial and Appeal Board sustained The Pierce-Arrow Society’s opposition to registration of PIERCE-ARROW for “automobiles” by Applicant Spintek Filtration, Inc. *The Pierce-Arrow Society v. Spintek Filtration, Inc.*, Opposition No. 91224343 (August 12, 2019) [precedential]

A “collective membership” indicates that the user of the mark is a member of a particular organization. Fraternities often federally register their marks as collective membership marks. Collective membership marks are not trademarks or service marks in the ordinary sense; they are not used in business or trade, and they do not indicate commercial origin of goods or services. Registration of these marks fills the need of collective organizations who do not use the symbols of their organizations on goods or services, but who still wish to protect their marks from use by others.

Opposer The Pierce-Arrow Society (Opposer) is non-profit organization, founded in 1957 to preserve the heritage of and foster interest in PIERCE-ARROW cars that were produced and sold by The Pierce-Arrow Motor Car Company from 1901 to 1938. In their day, PIERCE-ARROW cars were status symbols, and were regarded as being of the highest quality.

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However, to preserve its interest in its PIERCE-ARROW related mark, Opposer opposed Spintek’s application to register PIERCE-ARROW for cars claiming: (1) false suggestion of a connection under Section 2(a) of the Lanham Act; and (2) likelihood of confusion under Section 2(d) of the Lanham Act.

### **SECTION 2(a) – FALSE SUGGESTION OF A CONNECTION**

While many are familiar with the normal protections afforded the brand names of products and services from likelihood of confusion, fewer are familiar with protections afforded the names of natural persons or institutions that do not necessarily sell products or services. While the traditional trademark law in the United States focuses on the goals of protecting the public from likely source confusion resulting from trade symbols and protecting the trademark owner’s investment in its trademark as property, Section 2(a) of the Lanham Act protects natural persons and institutions from other persons seeking to register marks reflecting their names or identities, even where those names or identities are not used to sell related goods or services, or any goods and services at all.

To support a such claim under Section 2(a), an opposer must establish that: (1) the mark is the same as, or a close approximation of, the name or identity previously used by another person or institution; (2) the mark would be recognized as such, in that it points uniquely and unmistakably to that person or institution; (3) the person or institution named by the mark is not connected with the activities

performed by the applicant under the mark; and (4) the fame or reputation of the person or institution is such that, when the mark is used with the applicant's goods or services, a connection with the person or institution would be presumed.

In this case, the Board had no trouble finding that the applied-for mark PIERCE-ARROW is a close approximation of Opposer's name PIERCE-ARROW SOCIETY, and that Applicant is not connected with Opposer. However, the Board found that Opposer failed to show that PIERCE-ARROW points uniquely and unmistakably to it. Opposer maintained that Applicant's mark would be recognized as the name of the famous historical cars and that Opposer was the "de facto successor" to the historical car company. The Board, however, held that when The Pierce-Arrow Motor Car Company ceased to exist, so did its trademarks. There was no assignment of any interest in these rights to any another entity. Opposer did not prove that it could claim rights in the name or identity of the defunct company. Likewise, Opposer failed to show that it has any fame or reputation.

Therefore, the claim of false suggestion of a connection failed.

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### **Section 2(d) – LIKELIHOOD OF CONFUSION**

Opposer's claim that Applicant's registration of the trademark PIERCE-ARROW was likely to cause consumer confusion fared better with the Board. The Board explained that the likelihood of confusion analysis involving a collective membership mark and a trademark is not based on confusion as to the source of the goods or services provided by the organization; rather, the issue is whether relevant consumers are likely to believe that the trademark owner's goods "emanate from or are endorsed by or in some other way associated with the collective organization." Thus, the operative question was whether Applicant's PIERCE-ARROW cars and Opposer's organization whose aim was to foster and preserve interest in PIERCE-ARROW cars were sufficiently related that prospective purchasers of Applicant's cars would be likely to believe that they are sponsored by or in some way affiliated with Opposer.

The Board easily found that the parties' marks were highly similar in appearance, sound, connotation, and commercial impression.

The Board then focused on the parties' goods and services, paying close attention to the precise words claimed in the respective registration and application. "Opposer's collective membership mark identifies its organization's focus on PIERCE ARROW automobiles. Applicant Spintek's goods are PIERCE-



ARROW automobiles.” The Board pointed out that Opposer’s registration was not limited to used cars, or specifically, cars manufactured by The Pierce-Arrow Motor Car Company. Therefore, the Board held that Opposer’s registration could encompass Applicant’s PIERCE-ARROW cars.

“To find a likelihood of confusion, the parties’ goods and services need not be similar or competitive. It is sufficient that they are related in some manner and/or that the conditions and activities surrounding the marketing of the cars and membership services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer or source. “

The Board therefore concluded that consumers are likely to assume a connection or affiliation with, or sponsorship by, the Pierce-Arrow Society if the proposed PIERCE-ARROW mark is used for cars. Therefore, the Board sustained the opposition on the ground of likelihood of confusion under Section 2(d).

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This presents an unusual but fascinating case of a famous brand’s fan group successfully preventing someone else from re-launching that dead brand. In this case, the Board handed the Pierce-Arrow Society a win by interpreting the claim of “foster[ing] and preserv[ing] interest in Pierce Arrow motor cars,” as any Pierce-Arrow cars, rather than the antique Pierce-Arrow cars that were obviously originally intended. This case could allow other fan groups to preserve the caché of their favorite dead luxury brands.

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