

## Court Says “Lights Out” on UL Certification Lanham Act Claim

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Last week, a federal judge in Manhattan examined the intersection of false advertising and trademark infringement law in connection with the alleged misuse of a certification mark, and found the plaintiff to be entitled to neither body of law as a means to stop a competitor from advertising its products as “UL Certified.” The court granted a motion to dismiss a Lanham Act claim that alleged the defendant’s light switches were falsely labelled as meeting the Underwriters Laboratories (“UL”) safety certification standard. *Board-Tech Elec. Co. v. Eaton Elec. Holdings LLC*, No. 17-cv-5028 (KBF). This case sheds light on how courts treat false advertising claims based on alleged non-compliance with an awarded certification marking.

Underwriters Laboratories registered the UL certification under Section 1054 of the Lanham Act as a “mark [that] is used by persons authorized by [UL] to indicate that representative samplings of the products conform to the safety requirements of [UL].” Eaton, the defendant, labeled its light switches as having been certified by Underwriters Laboratories as meeting a safety standard for “General Use Snap Switches.” According to plaintiff Board-Tech, it tested eight samples of six models of Eaton’s light switches that bear the UL certification mark and found that none of them complied with the UL safety standard. Board-Tech alleged based on its testing that several of Eaton’s product lines—which included at least 30 different models in total—were falsely labeled as meeting the UL standard.

The Court snuffed out Board-Tech’s claims on two independent grounds. First, Board-Tech’s complaint failed to identify with any specificity the defendant’s products at issue in the lawsuit, thus failing to meet Rule 8(a)’s specificity requirements. Although Board-Tech alleged in general terms that it tested six different light switch models, it failed to specify which models it tested and failed to allege any plausible basis on which one could extrapolate that all of Eaton’s other light switch models failed to comply with the UL standard. Board-Tech’s failure to identify to the Court and Eaton which particular light switches failed to meet the UL standard in Board-Tech’s testing was especially inexcusable since it had twice amended its complaint and this issue had been raised previously by the Court.

The second and more noteworthy basis for dismissal was that Board-Tech failed to plausibly allege that Eaton’s advertising was false. The Court drew a distinction between a claim alleging that a

product is advertised as UL certified without authorization, versus a claim that a product permitted to use the UL certification fails to actually comply with the UL standard. Board-Tech conceded that Eaton's light switches were UL certified and that Eaton was authorized to display a UL certification mark on its light switches, but nonetheless contended that Eaton was deceiving consumers by using the UL mark. While Board-Tech acknowledged that UL tested a representative sample of Eaton's light switches and found that they conformed to the safety standard, Board-Tech alleged it had tested Eaton's light switches itself and found the devices did not meet the UL standard, rendering Board-Tech's advertising that its switches met the UL standard false.

The Court held that allowing Board-Tech to allege a false advertising claim on this basis would be nothing less than allowing it (and future plaintiffs) to police the UL mark. That, Board-Tech was not entitled to do, and the court wisely considered the implications of allowing these types of claims to proceed. To the extent Board-Tech believed that the certification itself was unwarranted, the court recognized that plaintiff could seek to cancel the mark under Section 1064(5) of the Lanham Act. However, Board-Tech's Section 1125(a) Lanham Act false advertising claim was extinguished.

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