

This Opinion is Not a
Precedent of the TTAB

Mailed: March 20, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re James R. Fonda
—

Serial No. 86817837
—

Raymond R. Tabandeh of Lewis Roca Rothgerber Christie LLP,
for James R. Fonda.

Robin S. Chosid-Brown, Trademark Examining Attorney, Law Office 102,
Mitchell Front, Managing Attorney.

—
Before Cataldo, Bergsman and Hudis,
Administrative Trademark Judges.

Opinion by Hudis, Administrative Trademark Judge:

James R. Fonda (“Applicant”) seeks registration on the Principal Register of the mark FIRST INDEPENDENT CHURCH OF SCIENTOLOGY (in standard characters) for “spiritual ministry services” in International Class 45.¹

The Trademark Examining Attorney refused registration under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the ground that Applicant’s mark, as applied to

¹ Application Serial No. 86817837 filed on November 12, 2015, under Trademark Act Section 1(b), 15 U.S.C. § 1051(b), based upon Applicant’s allegation of a bona fide intention to use the mark in commerce.

the services identified in the application, so resembles the following registered marks (and associated goods or services), all but one on the Principal Register and all commonly owned by the Religious Technology Center Corporation (“RTC”),² as to be likely to cause confusion, to cause mistake, or to deceive:

Mark	Reg. No./Reg. Date	Goods/Services
SCIENTOLOGY (Suppl. Register)	Reg. No.: 0898018 Issued: Sep. 1, 1970	Books and newsletters in Int’l Class 16
SCIENTOLOGY	Reg. No.: 1318717 Issued: Feb. 5, 1985	Religious and ministerial services including pastoral counseling in Int’l Class 42
SCIENTOLOGY	Reg. No.: 1306997 Issued: Nov. 27, 1984	Books, booklets, newsletters and bulletins in Int’l Class 16
SCIENTOLOGY	Reg. No.: 1329474 Issued: Apr. 9, 1985	Jewelry-namely, pins, badges, necklaces and bracelets in Int’l Class 14
SCIENTOLOGY	Reg. No.: 1342353 Issued: Jun. 18, 1985	Cinematographic films, pre-recorded audio and video tapes and pre-recorded audio and video tape cassettes in Int’l Class 9
SCIENTOLOGY	Reg. No.: 4533003 Issued: May 20, 2014	Pre-recorded media, namely, digital media, digital video discs, digital versatile discs, compact discs, downloadable audio and video recordings, DVDs, CDs and high definition digital discs all containing matter of a religious, educational and philosophical nature, and containing educational matter pertaining to religion and philosophy in Int’l Class 9

² Registrations made of record in First Office Action of March 18, 2016, at TSDR 38-53; Second Office Action of July 23, 2018, at TSDR 7-39; and Final Office Action of February 28, 2019, at TSDR 9-53. The RTC appears the alternate corporate ego behind the Church of Scientology. *See* First Office Action of March 18, 2016, at TSDR 59 (Church of Scientology Website).

Page references herein to the application record refer to the online database of the USPTO’s Trademark Status & Document Retrieval (“TSDR”) system. All citations to documents contained in the TSDR database are to the downloadable .pdf versions of the documents in the USPTO TSDR Case Viewer. References to the briefs on appeal refer to the Board’s TTABVUE docket system. Before the designation TTABVUE is the docket entry number; and after this designation are page references, if applicable.

Mark



(SCIENTOLOGY
VOLUNTEER
MINISTER & Design)



(SCIENTOLOGY
VOLUNTEER
MINISTER & Design)



(INTERNATIONAL
SCIENTOLOGY NEWS
& Design)

SCIENTOLOGY MEDIA
PRODUCTIONS

SCIENTOLOGY MEDIA
PRODUCTIONS

Reg. No./Reg. Date

Reg. No.: 2678135
Issued: Jan. 21, 2003

Reg. No.: 2717563
Issued: May 20, 2003

Reg. No.: 4674470
Issued: Jan. 20, 2015

Reg. No.: 5241821
Issued: Jul. 11, 2017

Reg. No.: 5241823
Issued: Jul. 11, 2017

Goods/Services

Newsletters, handbooks and course books
all relating to religion and philosophy in
Int'l Class 16

Association services, namely, promoting
the interests of volunteer ministers who
focus on assisting the individual, the
family, groups, and mankind in Int'l Class
35

Educational services, namely, conducting
classes, seminars, and lectures in the
fields of pastoral counseling, philosophy,
ethics and study technology in Int'l Class
41

Religious services namely, pastoral
counseling in Int'l Class 42

Magazines pertaining to religion,
education, philosophy, public service,
entertainment, volunteer works,
charitable works, charitable fundraising,
social betterment, literacy, teaching and
drug education in Int'l Class 16

Pre-recorded media, namely, digital
media digital video discs, digital versatile
discs, compact discs, downloadable audio
and video recordings, DVDs, CDs and
high definition digital discs featuring
educational and informative programs,
public service announcements and
documentaries in the fields of religion,
education, philosophy, public service,
entertainment, volunteer works,
charitable works, charitable fundraising,
social betterment, literacy, teaching, and
drug education in Int'l Class 9

Printed materials, namely, magazines,
newsletters, booklets, instructional and
teaching materials and informational
flyers in the fields of religion, education,
philosophy, public service, entertainment,
volunteer works, charitable works,
charitable fundraising, social betterment,
literacy, teaching and drug education in
Int'l Class 16

Mark

SCIENTOLOGY MEDIA
PRODUCTIONS

Reg. No./Reg. Date

Reg. No.: 5223542
Issued: Jun. 13, 2017

Goods/Services

Public relations and marketing services, namely, promoting and marketing educational and informative programs, public service announcements and documentaries in the fields of religion, education, philosophy, public service, entertainment, volunteer works, charitable works, charitable fundraising, social betterment, literacy, teaching and drug education in Int'l Class 35

SCIENTOLOGY MEDIA
PRODUCTIONS

Reg. No.: 5156526
Issued: Mar. 7, 2017

Communication and broadcasting services, namely, audio, video, online, radio, television, enhanced television, satellite and cable television services; simulcasting broadcast television, radio and Internet programs of live events and replay of live events and broadcasting of live television, radio and Internet programs; electronic transmission of audio, video, radio, television, enhanced television, satellite and cable television programming; cable television transmission in Int'l Class 38

SCIENTOLOGY MEDIA
PRODUCTIONS

Reg. No.: 5134065
Issued: Jan. 31, 2017

Providing on-line educational, entertainment and informational publications, namely, magazines, newsletters, booklets, instructional and teaching materials and informational flyers in the fields of religion, education, philosophy, public service, volunteer works, charitable works, charitable fundraising, social betterment, literacy, teaching and drug education in Int'l Class 41



(S SCIENTOLOGY
MEDIA PRODUCTIONS
LOS ANGELES
HISTORIC CULTURE
MONUMENT EST. 1912
& Design)

Reg. No.: 5241822
Issued: Jul. 11, 2017

Pre-recorded media, namely, digital media digital video discs, digital versatile discs, compact discs, downloadable audio and video recordings, DVD's, CD's and high definition digital discs featuring educational and informative programs, public service announcements and documentaries in the fields of religion, education, philosophy, public service, entertainment, volunteer works, charitable works, charitable fundraising, social betterment, literacy, teaching, and drug education in Int'l Class 9

Mark



(S SCIENTOLOGY
MEDIA PRODUCTIONS
LOS ANGELES
HISTORIC CULTURE
MONUMENT EST. 1912
& Design)

Reg. No./Reg. Date

Reg. No.: 5228480
Issued: Jun. 20, 2017

Goods/Services

Printed materials, namely, magazines, newsletters, booklets, instructional and teaching materials and informational flyers in the fields of religion, education, philosophy, public service, entertainment, volunteer works, charitable works, charitable fundraising, social betterment, literacy, teaching and drug education in Int'l Class 16



(S SCIENTOLOGY
MEDIA PRODUCTIONS
LOS ANGELES
HISTORIC CULTURE
MONUMENT EST. 1912
& Design)

Reg. No.: 5223543
Issued: Jun. 13, 2017

Public relations and marketing services, namely, promoting and marketing educational and informative programs, public service announcements and documentaries in the fields of religion, education, philosophy, public service, entertainment, volunteer works, charitable works, charitable fundraising, social betterment, literacy, teaching and drug education in Int'l Class 35



(S SCIENTOLOGY
MEDIA PRODUCTIONS
LOS ANGELES
HISTORIC CULTURE
MONUMENT EST. 1912
& Design)

Reg. No.: 5246747
Issued: Jul. 18, 2017

Communication and broadcasting services, namely, audio, video, online, radio, television, enhanced television, satellite and cable television services; simulcasting broadcast television, radio and Internet programs of live events and replay of live events and broadcasting of live television, radio and Internet programs; electronic transmission of audio, video, radio, television, enhanced television, satellite and cable television programming; cable television transmission in Int'l Class 38



(S SCIENTOLOGY
MEDIA PRODUCTIONS
LOS ANGELES
HISTORIC CULTURE
MONUMENT EST. 1912
& Design)

Reg. No.: 5200277
Issued: May 9, 2017

Education and entertainment services, namely, media production services, video and film production; multimedia entertainment services in the nature of development, production and post-production services for music, audio, video and films featuring educational and informative programs, public service announcements and documentaries in the fields of religion, education, philosophy, public service, entertainment, volunteer works, charitable works, charitable fundraising, social betterment, literacy,

Mark

Reg. No./Reg. Date

Goods/Services



(S SCIENTOLOGY
MEDIA PRODUCTIONS
LOS ANGELES
HISTORIC CULTURE
MONUMENT EST. 1912
& Design)

Reg. No.: 5119859
Issued: Jan. 10, 2017

teaching and drug education; Publishing services, namely, publishing and distributing educational booklets, brochures, magazines, newsletters, periodicals and pamphlets; Online electronic publishing services, namely, publishing and distributing educational booklets, brochures, magazines, newsletters, periodicals, and pamphlets; Publishing of electronic publications of others, namely, publishing and distributing educational booklets, brochures, magazines, newsletters, periodicals and pamphlets; all of the forgoing publication services pertaining to religion, education, philosophy, public service, entertainment, volunteer works, charitable works, charitable fundraising, social betterment, literacy, teaching and drug education in Int'l Class 41

Providing on-line educational, entertainment and informational publications, namely, magazines, newsletters, booklets, instructional and teaching materials and informational flyers in the fields of religion, education, philosophy, public service, volunteer works, charitable works, charitable fundraising, social betterment, literacy, teaching and drug education in Int'l Class 41

The Examining Attorney also refused registration under Trademark Act Section 2(a), 15 U.S.C. § 1052(a), on the ground that Applicant's mark falsely suggests a connection with the Church of Scientology; and because Applicant ignored the USPTO's request that he enter a disclaimer of the descriptive wording in the mark, namely, "First Independent Church," pursuant to Trademark Act Sections 2(e)(1) and 6(a), 15 U.S.C. §§ 1052(e)(1) and 1056(a).

After the Trademark Examining Attorney made the refusals final, Applicant appealed to this Board. The appeal is fully briefed. We affirm the refusal to register on all three grounds raised and maintained by the Examining Attorney.

I. Likelihood of Confusion

We base our determination of likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on an analysis of all of the probative facts in evidence that are relevant to the factors enunciated in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”), cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015); see also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We must consider each *DuPont* factor for which there is evidence and argument. See, e.g., *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). However, “each case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973).

In applying the *DuPont* factors, we bear in mind the fundamental purposes underlying Trademark Act Section 2(d), which are to prevent confusion as to source and to protect registrants from damage caused by registration of confusingly similar marks. *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 224 USPQ 327, 331 (1985); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161, 1163 (1995); *DuPont*, 177 USPQ at 566. We have considered each *DuPont* factor that is relevant and of record, and have treated any other factors as neutral. See *M2*

Software, Inc. v. M2 Commc'ns, Inc., 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”).

Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“the various evidentiary factors may play more or less weighty roles in any particular determination”). Two key considerations are the similarities between the marks and the similarities between the goods or services. *See In re IAM.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375 (Fed. Cir. 2002) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods [or services].”)).

We focus our likelihood of confusion analysis on the Examining Attorney’s citation to Registration No. 1318717, for the mark SCIENTOLOGY for “religious and ministerial services including pastoral counseling” (hereinafter, the “Cited Registration”). This mark, along with the identified services, is the most similar to Applicant’s mark and services. If we find that there is a likelihood of confusion with this mark, there is no need for us to consider a likelihood of confusion with the Registrant’s other marks. Conversely, if we find there is no likelihood of confusion

with this mark, we would find no likelihood of confusion with the Registrant's other marks as they incorporate the word "Scientology" with other matter and identify less closely related goods or services. *See In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

A. The Similarity or Dissimilarity and Nature of the Services and Established, Likely-to-Continue Trade Channels

We first consider the similarity or dissimilarity and nature of the services and established, likely-to-continue trade channels, the second and third *DuPont* factors. To determine the relationship between the services, we are bound by the identifications in Applicant's involved Application and the Cited Registration. *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) ("Likelihood of confusion must be determined based on an analysis of the marks as applied to the ... services recited in applicant's application vis-à-vis the ... services recited in [a] ...registration, rather than what the evidence shows the... services to be.") (citing *Canadian Imperial Bank v. Wells Fargo Bank, N.A.*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987)). Here, the services identified in Applicant's Application and the Cited Registration are identical. Applicant does not argue otherwise.

Where Applicant's and the Registrant's services are identical and without restriction, we must presume, as we do here, that the channels of trade and classes of purchasers for those services are the same. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of purchasers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion).

B. The Strength of the Registered Mark, and the Number and the Nature of Similar Marks in use on Similar Services

We next consider the “fame” or strength of the Registrant’s mark, and the number and nature of similar marks in use on similar services, the fifth and sixth *DuPont* factors, based on the evidence of record.

1. Strength of the Registered Mark

Applicant argues that SCIENTOLOGY is “merely descriptive describing a certain religion of scientology, if not generic ... and therefore is not likely to be perceived by relevant consumers as a distinguishing source,” and is “used as a ‘quasi science’ related to study or investigation of knowledge, or epistemology, defined in Registrant’s own website (without any trademark notice) as literally meaning ‘knowing how to know,’ or epistemology.”³ We interpret Applicant’s argument as contending that SCICENTOLOGY is a weak mark entitled to only a narrow scope of protection or exclusivity of use.

Granted, “the record does not establish that the cited mark is famous, [but] the owner of the cited registration is not a party to this *ex parte* appeal, and the Examining Attorney is under no obligation to demonstrate the fame of a cited mark.” *In re Integrated Embedded*, 120 USPQ2d 1504, 1512 (TTAB 2016). Moreover, “inasmuch as the cited mark is registered on the Principal Register, we must assume that it is at least [inherently] suggestive and we cannot entertain Applicant’s argument that the registered mark is descriptive [if not generic] of Registrant’s

³ Applicant’s Brief, 4 TTABVUE 3-4.

services.” *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1517 (TTAB 2016) (citing *In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1363 (TTAB 2007)). See also Trademark Act Section 7(b), 15 U.S.C. § 1057(b) (“A certificate of registration of a mark upon the principal register ... shall be prima facie evidence of the validity of the registered mark ... on or in connection with the ... services specified in the certificate....”). We therefore consider the Registrant’s SCIENTOLOGY mark to fall in the middle of the spectrum of from very strong to very weak. See *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003)).

We find that, in connection with the Registrant’s services, the SCIENTOLOGY mark is inherently distinctive, but with no proof of fame or strength on this record. Therefore, we find the fame or strength factor to be neutral.

2. Third Party Marks

Applicant argues that SCIENTOLOGY is shown in “various media using the term scientology descriptively.”⁴ The sixth *DuPont* factor “considers ‘[t]he number and nature of similar marks in use on similar goods [or services].’” *DuPont*, 177 USPQ at 567. In support of its argument, Applicant made of record the following third party uses of “Scientology”:⁵

⁴ Applicant’s Brief, 4 TTABVUE 9-10.

⁵ Office Action Response of September 19, 2016, at TSDR 37-99. Applicant also provided Internet search engine results of other third party uses of “Scientology,” but without the accompanying web pages showing the Scientology uses in context. Office Action Response of September 19, 2016, at TSDR 109. These mere search engine results have little probative value. *In re Bayer AG*, 488 F.3d 960, 82 USPQ2d 1828, 1833 (Fed. Cir. 2007) (“Search engine

- **The Scientology of Crossfit | Adam Berke | LinkedIn**

<https://www.linkedin.com/pulse/scientology-crossfit-adam-berke>

LinkedIn Nov 24, 2015 - I am not a douche-bag, I am “Crossfit confident”? The first time I witnessed Crossfit I was working on Brickell Avenue in Miami's financial district.

- **Paleo is the Scientology of Diets | Body for Wife**

www.bodyforwife.com/paleo-is-the-scientology-of-diets/

I was close to landing a fitness interview with Tom Cruise, but then he bailed. And so I am now free to say that **Scientology** is stupid. People make fun of the...

- **Giordano Memorization System (GMS)–The “Scientology of memory...”**

mt.artofmemory.com/.../giordano-memorization-system-gms-the-scientology-of-mem...

I've been doing a bit of research on GMS (Giordano Memorization Systems), which one poster here referred to as "**the Scientology of memory systems**".

- **The Beatles: The Scientology Of Pop - The Afterword**

theafterword.co.uk › Blog

Nov 3, 2015 - Maybe I don't like some of them, maybe you don't, but the argument that The Beatles Are the Best is now the scripture of **the Scientologist**.

- **The scientology of pizza - The Something Awful Forums**

<https://forums.somethingawful.com/showthread.php?threadid=3786008>

42 posts - 6 authors

the scientology of pizza. ... Hobgoblin. **Scientology** has science in it but the only math they do is counting their dirty money. Emotes I bought: Thanks to: ...

“[E]vidence of third-party use [of similar marks] bears on the strength or weakness of [the Registrant’s] ... mark. ... The weaker [the Registrant’s] ... mark, the closer an applicant’s mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection.”

Juice Generation, Inc. v. GS Enters. LLC, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015) (citing *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005)).

results—which provide little context to discern how a term is actually used on the web page that can be accessed through the search result link—may be insufficient to determine the nature of the use of a term or the relevance of the search results to registration considerations”).

However, Applicant’s Internet references to third-party uses of “Scientology” are not for the same or similar services as set forth in the Application or Registration currently at issue, *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1693-94 (Fed. Cir. 2018) (“the relevant *DuPont* inquiry is ‘[t]he number and nature of similar marks in use **on similar goods** [or services].’”) (quoting *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992)); *Weiss Assocs., Inc. v. HRL Assocs., Inc.*, 902 F.2d 1546, 14 USPQ2d 1840, 1842 (Fed. Cir. 1990)), nor does Applicant’s evidence demonstrate “ubiquitous” or “considerable” third-party use of “Scientology” for this evidence to be meaningful. *In re I.A.M.Symbolic*, 123 USPQ2d at 1751 (citing *Juice Generation*, 115 USPQ2d at 1674 and *Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015), *cert. denied*, 136 S. Ct. 982 (2016)). Nevertheless, the third-party uses Applicant made of record show that the word “Scientology” is used to refer to a quasi-science, albeit on a very limited basis. As we have noted, the five uses discussed above are not sufficient to limit the inherent or conceptual strength of Registrant’s SCIENTOLOGY mark.

Thus, based on the evidence of record, we find the sixth *DuPont* likelihood of confusion factor (similar marks in use on similar services) to be neutral with respect to a finding of a likelihood of confusion.

C. The Similarity or Dissimilarity of the Marks in their Entireties

Under the first *DuPont* factor, we determine the similarity or dissimilarity of Applicant’s and the Registrant’s marks in their entireties, taking into account their

appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567; *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1048 (Fed. Cir. 2018). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014).

“The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quotation omitted). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *In re Ass’n of the U.S. Army*, 85 USPQ2d 1264, 1268 (TTAB 2007). Here, from the evidence of record we find that the typical purchasers of Applicant’s and the Registrant’s services are average Americans wishing to avail themselves of “spiritual, religious, ministerial or pastoral counseling services.”

“[I]n determining [likelihood of] confusion between marks[, they] must be compared in their entireties” *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 750 (Fed. Cir. 1985). “[L]ikelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark.” *Id.* at 751. “On the other hand, in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties.” *Id.*

Here, we find that the dominant portion of Applicant's mark is SCIENTOLOGY, because that is the "term most likely to be remembered by consumers" and "used in calling for the services" or in otherwise referring to Applicant. *In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009).

The terms "First," "Independent" and "Church" are inherently weak as differentiators of the source of Applicant's services, because each term readily describes an aspect of its services. The term "First" means "coming before all others in time or order; earliest; foremost in position, rank, or importance;" "Independent" means "free from outside control, not subject to another's authority; self-governing; not connected with another or with each other; separate;" and "Church" means "institutionalized religion as a political or social force."⁶ These are the very attributes of Applicant's services that he wishes to convey to the public, as demonstrated by an online press release announcing the incorporation of Applicant's organization:

Today, Articles of Incorporation were filed with the California Secretary of State for First Independent Church of Scientology (FICS), a nonprofit religious corporation.

The name says it all. The **first** of its kind, and wholly **independent** of the **church** [RTC Chairman of the Board David] Miscavige hijacked and then used to alter, degrade and reverse both the technology and the aims of Scientology.

Establishment - This is Your Church

Now that FICS is incorporated, it will need to be established. This phase will take as long as it takes. A lot depends on the amount of participation and support it receives.

While Jim Fonda is the incorporator of FICS, and we have assisted him, this church belongs to those who build and support it.

⁶ First Office Action of March 18, 2016 at TSDR 63-77 (Definitions of "First," "Independent" and "Church" from the online version of OXFORD DICTIONARIES).

Based on the outpouring of support and positive feedback we received in response to the article announcing the plan for FCIS, this new church is greatly and enthusiastically ... (emphasis added).⁷

“That a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark” *In re Nat’l Data*, 224 USPQ at 751. Thus, because the descriptive, if not generic, phrase FIRST INDEPENDENT CHURCH merely describes the type of entity providing Applicant’s services, this phrase is not source-identifying. *See, e.g., In re Dixie Rests.*, 41 USPQ2d at 1533-34 (“DELTA,” not the disclaimed generic term “CAFE,” was the dominant portion of the mark THE DELTA CAFE).

Moreover, where, as here, the involved services are identical, “the degree of similarity [between the marks] necessary to support a conclusion of likely confusion declines.” *In re Viterra Inc.*, 101 USPQ2d at 1908. We note, too, that Applicant’s mark encompasses the whole of the Registrant’s mark. While there is no explicit rule that likelihood of confusion automatically applies where an applicant’s mark contains in part the whole of another mark, the fact that the cited mark is subsumed by Applicant’s mark increases the similarity between the two. *See, e.g., In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1271 (TTAB 2009) (applicant’s mark VANTAGE TITAN for medical magnetic resonance imaging diagnostic apparatus confusingly similar to TITAN for medical ultrasound diagnostic apparatus).

⁷ Office Action of September 19, 2016, at TSDR 99.

Thus, when we compare Applicant's mark FIRST INDEPENDENT CHURCH OF SCIENTOLOGY and the Registrant's mark SCIENTOLOGY in their entireties, taking into account their appearance, sound, connotation and commercial impression, noting that the dominant portion of both marks is the term SCIENTOLOGY, giving less weight to the descriptive, if not generic, phrase FIRST INDEPENDENT CHURCH in Applicant's mark, and noting that both marks are associated with identical services, we find the marks are more similar than dissimilar. This factor therefore supports an ultimate finding that confusion is likely.

D. The Conditions under which and Buyers to whom Sales are made, i.e. "Impulse" v. Careful, Sophisticated Purchasing

The fourth *DuPont* factor is the "conditions under which and buyers to whom sales are made, i.e. 'impulse' v. 'careful, sophisticated purchasing.'" *DuPont*, 177 USPQ at 567. Applicant argues:

The consumers of both applicant's services and the services of registrant are professionals, celebrities, prominent business owners and educated individuals who are sophisticated and are familiar with the service providers of such religious services nation-wide. Most of these sophisticated consumers are repeat customers and are closely familiar with various service providers in religious, self-fulfillment, spiritual, ministerial industries. ... [S]uch sophisticated consumers would readily recognize that the source of goods and services for the applicant's mark is not the same as those of the registrant's.⁸

This entire passage from Applicant's brief constitutes argument of counsel without any citations to the evidentiary record. Counsel's arguments are not evidence, and we do not rely on them. *Cai v. Diamond Hong*, 127 USPQ2d at 1799 (quoting *Enzo*

⁸ Applicant's Brief, 4 TTABVUE 11.

Biochem, Inc. v. Gen-Probe Inc., 424 F.3d 1276, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005) (“Attorney argument is no substitute for evidence.”)).

In any event, focusing (as we must) on the least sophisticated potential customers of Applicant’s and the Registrant’s services (average Americans wishing to avail themselves of “spiritual, religious, ministerial or pastoral counseling services”), we find the fourth *DuPont* factor to be neutral.⁹ See *Stone Lion Capital Partners v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1163 (Fed. Cir. 2014) (“Although the services recited in the application also encompass sophisticated investors, Board precedent requires the decision to be based ‘on the least sophisticated potential purchasers.’”). Even were we to consider care in purchasing the services in the cited registration, particularly in the context of such similar marks and identical services, this would not render the consumers “immune from trademark confusion.” See *Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1442 (TTAB 2014); see also *In re Research and Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) (“That the relevant class of buyers may exercise care does not necessarily impose on that class the responsibility of distinguishing between similar trademarks for similar goods [or services].”).

⁹ While Applicant asserts that the consumers of its services and the Registrant’s services “are professionals, celebrities, prominent business owners and educated individuals who are sophisticated and are familiar with the service providers of such religious services nationwide” (Applicant’s Brief, 4 TTABVUE 11), this is not reflected in either the evidence of record, Applicant’s description of services in its Application, or the Registrant’s description of services in the Cited Registration.

E. Conclusion: Likelihood of Confusion

The first, second and third *DuPont* likelihood of confusion factors favor finding a likelihood of confusion. The marks at issue are more similar than they are dissimilar, bearing particularly in mind that Applicant's mark contains in part the whole of the Registrant's mark, the services are identical, and we presume the trade channels and classes of purchasers overlap. The Registrant's mark is inherently distinctive, and Applicant did not provide probative evidence weakening the scope of protection for the Registrant's mark. The conditions under which and buyers to whom sales are made comprise a neutral factor. Neither Applicant nor the Examining Attorney presented evidence or argument in their briefs as to the other *DuPont* factors. We therefore find that Applicant's mark, FIRST INDEPENDENT CHURCH OF SCIENTOLOGY, used in connection with Applicant's services, so closely resembles the registered mark, SCIENTOLOGY, as to be likely to cause confusion, mistake or deception as to the source of Applicant's services.

II. False Suggestion of a Connection

Section 2(a) of the Trademark Act prohibits the registration of a mark that consists of or comprises matter that may falsely suggest a connection with "persons, living or dead, institutions, beliefs, or national symbols" 15 U.S.C. § 1052(a). False suggestion of a connection under the Trademark Act was intended to preclude registration of a mark which conflicts with another's rights, and evolved from the rights of privacy and publicity. *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co., Inc.*, 703 F.2d 1372, 217 USPQ 505, 509 (Fed. Cir. 1983); *see also Bridgestone/Firestone Research Inc. v. Auto. Club de L'Ouest de la France*, 245 F.3d

1359, 58 USPQ2d 1460, 1463 (Fed. Cir. 2001) (“The rights protected under the §2(a) false suggestion provision are not designed primarily to protect the public, but to protect persons and institutions from exploitation of their persona.”).

To establish that a proposed mark falsely suggests a connection with a person or an institution, the following four elements must be shown:

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 re Pedersen, 109 USPQ2d 1185, 1188-89 (TTAB 2013); *In re Jackson Int’l Trading Co.*, 103 USPQ2d 1417, 1419 (TTAB 2012).

A. Whether FIRST INDEPENDENT CHURCH OF SCIENTOLOGY is, or is a close approximation of, the Church of Scientology’s name or identity, as Previously Used by the Church of Scientology as an Institution?

The term “institution” has been broadly construed with respect to Section 2(a). *In re Pedersen*, 109 USPQ2d at 1191 (citing *In re Shinnecock Smoke Shop*, 571 F.3d 1171, 1173, 91 USPQ2d 1218, 1219 (Fed. Cir. 2009) (“[T]he ordinary meaning of ‘institution’ suggests the term is broad enough to include a self-governing Indian nation,” quoting BLACK’S LAW DICTIONARY ... defining “institution” as “[a]n established organization,” and “organization” as a “body of persons . . . formed for a

common purpose”); *In re White*, 73 USPQ2d 1713, 1718 (TTAB 2004) (“each federally recognized Apache tribe is necessarily either a juristic person or an institution”); *In re Urbano*, 51 USPQ2d 1776, 1779 (TTAB 1999) (entire organization comprising the Olympic Games, as a whole, qualifies as an “institution” within the meaning of Section 2(a)). An institution need not be “large,” “well known,” or “national” to be protected from the registration of a mark that falsely suggests a connection under Trademark Act Section 2(a). See *Gavel Club v. Toastmasters Int’l*, 127 USPQ 88, 94 (TTAB 1960).

On this record, the term “Scientology,” is of such a nature that a connection with the institution of the Church of Scientology would be presumed when Applicant's mark is used in connection with his services. According to the Church of Scientology website at <http://scientology.org>, the Church of Scientology has its origins with the publication of L. Ron Hubbard's book, DIANETICS: THE MODERN SCIENCE OF MENTAL HEALTH, in 1950. The first Church of Scientology was formed in 1954, and today includes some 11,000 churches, missions and affiliated groups.¹⁰ According to the website <http://www.whatisscientology.org/>, Scientology today is a religion that attracts 4.4 million new people each year across 167 nations. Its members have contributed 27.7 million volunteer hours to their communities.¹¹

The Examining Attorney also made of record an online Business Insider article at <http://www.businessinsider.com>, documenting twenty-one celebrity members of the

¹⁰ First Office Action of March 18, 2016 at TSDR 59-62.

¹¹ *Id.* at 54-58.

Church of Scientology who help to make it a well-known institution.¹² The record additionally contains seven other news articles published about the Church of Scientology, ranging from informational to critiques about its inner workings and practices.¹³

We have said in the past that “the similarity required for a ‘close approximation’ is akin to that required for a likelihood of confusion under § 2(d) and is more than merely ‘intended to refer’ or ‘intended to evoke.’” *Bos. Athletic Ass’n v. Velocity, LLC*, 117 USPQ2d 1492, 1497 (TTAB 2015). Applicant’s mark must do more than simply bring the institution’s name to mind. *Id.* (citing *Bos. Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581 (TTAB 2008) (test for false suggestion of a connection more stringent than in disparagement, where reference to a persona suffices).

Although the first element of the false suggestion test is akin to similarity of the marks under Trademark Act Section 2(d), overall Section 2(a) offers protection different in kind than Section 2(d). As was made clear in *In re Wielinski*, 49 USPQ2d 1754, 1757 (TTAB 1998) (quoting *Univ. of Notre Dame v. J.C. Gourmet Food Imps.*, 217 USPQ at 508) “[T]he legislative history ... [of] what became Section 2(a) shows that the drafters were concerned with protecting the name of an individual or institution which was not a technical ‘trademark’ or ‘trade name’ upon which an objection could be made under Section 2(d) Although not articulated as such, ... the drafters sought by Section 2(a) to embrace the concepts of the right to privacy”

¹² *Id.* at 102-119.

¹³ *Id.* at 120-136.

Thus, while there may be some analogy between these statutory provisions, “[c]learly the same standard cannot be adopted for § 2(a) as for § 2(d).” *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps.*, 217 USPQ at 508.

The Church of Scientology is that organization’s name and identity. Applicant has applied to register the mark FIRST INDEPENDENT CHURCH OF SCIENTOLOGY, differing only by the highly descriptive terms “First Independent,” and to be used in connection with services identical to those of the Church of Scientology. This relatively insignificant difference is insufficient to avoid a false suggestion refusal. *See In re White*, 73 USPQ2d at 1719 (“Just as an applicant cannot take another’s name and add matter to it to avoid a refusal of false suggestion under Section 2(a), an applicant cannot take a significant element of the name of another and avoid a refusal by leaving one or more elements behind, provided that that which has been taken still would be unmistakably associated with the other person.”); *see also In re Jackson Int’l Trading*, 103 USPQ2d at 1419 (“We find that the commercial impression engendered by applicant’s mark [BENNY GOODMAN COLLECTION THE FINEST QUALITY (stylized)] is that there is a ‘Benny Goodman’ collection of products which makes applicant’s mark a close approximation of the name Benny Goodman.”).

B. Whether FIRST INDEPENDENT CHURCH OF SCIENTOLOGY would be recognized as such, in that it points uniquely and unmistakably to the Church of Scientology?

“[U]nder concepts of the protection of one’s ‘identity,’ ... [a] critical requirement is that the name (or an equivalent thereof) claimed to be appropriated by another must be unmistakably associated with a particular personality or ‘persona.’” *Univ. of*

Notre Dame du Lac v. J.C. Gourmet Food Imps., 217 USPQ at 509. “[I]t is not sufficient to show merely prior identification with the name adopted by another.” *Id.* “The protection afforded a name or its equivalent under Section 2(a) is acquired only when the name claimed to be appropriated points ‘uniquely and unmistakably’ to the plaintiff’s ‘persona,’ that is the personal or trade identity of the claimant.” *Bos. Athletic Ass’n v. Velocity, LLC*, 117 USPQ2d at 1497 (citing *Buffett v. Chi-Chi’s, Inc.*, 226 USPQ, 428, 429 (TTAB 1985)). *See also Hornby v. TJX Cos. Inc.*, 87 USPQ2d 1411, 1424 (TTAB 2008) (“[T]he name claimed to be appropriated by the defendant must point uniquely to the plaintiff.”).

As shown by the above-quoted online press release announcing the incorporation of Applicant’s organization,¹⁴ we find without question that Applicant intends FIRST INDEPENDENT CHURCH OF SCIENTOLOGY to point uniquely and unmistakably to the Church of Scientology “the church [RTC Chairman of the Board David] Miscavige hijacked and then used to alter, degrade and reverse both the technology and the aims of Scientology.”

C. The Church of Scientology is Not Connected with the Activities Performed by Applicant under the FIRST INDEPENDENT CHURCH OF SCIENTOLOGY Mark.

The Examining Attorney has satisfied the third *Pedersen* factor because Applicant and his activities are not connected to the Church of Scientology.

¹⁴ Office Action of September 19, 2016, at TSDR 99.

D. The Reputation of the Church of Scientology is such that, when the FIRST INDEPENDENT CHURCH OF SCIENTOLOGY Mark is used with Applicant's Services, a Connection with the Church of Scientology would be Presumed.

In light of the evidence that the Church of Scientology has a considerable reputation in the United States in connection with religious and ministerial services including pastoral counseling, and given Applicant's intended use of the FIRST INDEPENDENT CHURCH OF SCIENTOLOGY mark for the same services, we may draw an inference that Applicant intended to create a connection with the Church of Scientology, and that the public would make the intended false association. *In re N. Am. Free Trade Ass'n*, 43 USPQ2d 1282, 1287 (TTAB1997) (citing *Univ. of Notre Dame*, 217 USPQ at 509).

E. Conclusion: False Suggestion of a Connection

The FIRST INDEPENDENT CHURCH OF SCIENTOLOGY is a close approximation of the Church of Scientology's name and identity, as previously used by the Church of Scientology as an institution. The Church of Scientology is not connected with the activities performed by Applicant under the FIRST INDEPENDENT CHURCH OF SCIENTOLOGY mark. FIRST INDEPENDENT CHURCH OF SCIENTOLOGY would be recognized as pointing uniquely and unmistakably to the Church of Scientology. The reputation of the Church of Scientology is such that, when the FIRST INDEPENDENT CHURCH OF SCIENTOLOGY Mark is used with Applicant's Services, a connection with the Church of Scientology would be presumed. In fact, that is what Applicant has intended. We find, therefore, that the Examining Attorney has established the

elements necessary to justify the refusal to register based upon false suggestion of a connection under Trademark Act 2(a).¹⁵

III. Disclaimer

A “disclaimer” is a statement in the application record that an applicant does not claim exclusive rights to an unregistrable component of his mark. *See Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978, 144 USPQ 433, 433 (CCPA 1965). The applicant must provide a disclaimer of the unregistrable part of the applied-for mark even though the mark as a whole appears to be registrable. *See Trademark Act Section 6(a)*, 15 U.S.C. §1056(a). Registration can be conditioned on disclaimer of an unregistrable component of a mark. *In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 116 USPQ2d 1262, 1266 (Fed. Cir. 2015). In fact, registration may be refused if an applicant does not comply with the disclaimer requirement made by the Examining Attorney. *See In re Slokevage*, 441 F.3d 957, 78 USPQ2d 1395, 1399-1400 (Fed. Cir. 2006).

As discussed above, the wording “FIRST INDEPENDENT CHURCH” in Applicant’s mark is not inherently distinctive. The combination of these unregistrable terms at best are merely descriptive of a quality, characteristic, function, feature, purpose, or use of Applicant’s services. *See Trademark Act Section 2(e)(1)*, 15 U.S.C. § 1052(e)(1); *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012).

¹⁵ Applicant did not even discuss the false suggestion of a connection factors under Trademark Act Section 2(a), *Univ. of Notre Dame and Pedersen* in this section of his appeal brief. Applicant’s Brief, 4 TTABVUE 6-9.

During prosecution, the Examining Attorney repeatedly requested that Applicant voluntarily disclaim exclusive rights to “FIRST INDEPENDENT CHURCH” apart from Applicant’s mark as a whole.¹⁶ Applicant either put off compliance with the Examining Attorney’s disclaimer requirement until the § 2(d) and § 2(a) refusals were resolved,¹⁷ or simply ignored responding to the disclaimer requirement altogether.¹⁸ Applicant again completely ignored this issue in his appeal brief. We find that Applicant’s failure to comply with the Examining Attorney’s requirement of disclaiming exclusive rights to “FIRST INDEPENDENT CHURCH” apart from Applicant’s mark as a whole is a separate ground for refusing registration.

IV. Decision

The refusal to register Applicant’s mark FIRST INDEPENDENT CHURCH OF SCIENTOLOGY under Trademark Act Sections 2(a), 2(d) and 6(a) is affirmed on all three grounds.

¹⁶ First Office Action of March 18, 2016 at TSDR 7; Second Office Action of July 23, 2018 at TSDR 3; Final Office Action of February 28, 2019 at TSDR 2, 6.

¹⁷ Office Action Response of September 19, 2016 at TSDR 106.

¹⁸ Office Action Response of January 17, 2019 at TSDR 4-10.