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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91191016
Party	Defendant Kendal M. Sheets
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Date	11/30/2009
Attachments	app_response_dismiss.pdf ( 25 pages )(1090112 bytes )

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

_____	)	
INTELLECTUAL RESERVE, INC.	)	
Plaintiff	)	Cancellation No. 91191016
v.	)	
	)	
SHEETS, KENDAL M .	)	
Defendant	)	
_____	)	

**APPLICANT'S RESPONSE TO  
OPPOSER'S MOTION DISMISS COUNTERCLAIMS**

Applicant Kendal M. Sheets hereby files this response in opposition to Opposer's Motion to Dismiss.

**INTRODUCTION**

Applicant filed a proper Answer and Counterclaim to Opposer's Notice of Opposition to Applicant's mark, SECRET MORMON, and therefore the Motion to Dismiss should be denied. A counter-claim for cancellation of marks asserted against an Application in a cancellation proceeding is a proper response to an Opposition.

**APPLICANT'S COUNTER-CLAIMS ARE PROPERLY PLED IN RESPONSE TO  
OPPOSER'S ASSERTED MARKS**

In paragraphs 10-12 of the Counter-Claim, Applicant pleaded as follows:

10. The word “Mormon” is a well-known, generic term and accordingly should have never been registered under 15 U.S.C. 1052(e)(1) or (5), Lanham Act section 2(e)(1), and should be cancelled under of the Lanham Act, Section, 14(1) or (3); or 15 U.S.C. 1064(1) or (31), et seq or should be disclaimed as an unregistrable part of a mark under Trademark Act Section 6(a), 15 U.S.C. 1056(a).

11. Alternatively, “Mormon” merely describes or is merely descriptive of the services or goods being offered under Counter-Defendant’s registrations, and thereby should not have been registered under 15 U.S.C. 1052(e)(1), Lanham Act section 2(e)(1), and should be cancelled under the Lanham Act, section 14(1), or 15 U.S.C. 1064(1) et seq.

12. Based upon information and belief, Counter-Defendant knew or should have known that the term “MORMON” was generic, functional, or merely descriptive at the time of application for registration.

Thus, Applicant pleaded that the “Mormon” part of Opposer’s marks is a well-known, generic term that is unregistrable or in the alternative that it is descriptive or functional of Opposer’s goods and services. Opposer, stated its legal arguments under section “I. Facts” of its Motion to Dismiss, that because the pleading does not allege the word “MORMON” is generic, merely descriptive or functional as *applied to the goods and services listed in IRI’s registrations*, that the pleading is defective. This statement is clearly misleading because on its face, including the paragraphs listed above, the Counter-Claim does in fact plead that “Mormon” is generic or merely descriptive or functional in view of Opposer’s goods and services.

Applicant further pled that the word “Mormon” is a generic term for a religion and that Opposer should have been required by the Trademark Office to disclaim this term as unregistrable. The Office can require an applicant to disclaim exclusive rights to an unregistrable part of a mark, rather than refuse registration of the entire mark. For example, Applicant’s application for SECRET MORMON was not rejected by Examiner Peete for unregistrability based on Opposer’s marks, but rather that a disclaimer was required for the

unregisterable part of the mark, the term “MORMON.” This also should have been required for all of Opposer’s marks. Again, such allegations are proper to file in response to an Opposition before the Board.

Opposer’s section, “Argument,” alleges misleading statements to underlie its arguments. Firstly, in Section “A” Opposer alleges that Applicant “must provide a plain statement of the facts supporting each ground asserted.” This was done in the Answer and in paragraphs 1-15 of Counter-Claims. Surprisingly, Opposer’s demand for more evidence in its motion here is in direct opposition to its demands to remove evidence in its *Motion to Strike Evidentiary Matters Pleaded in the Answer and Counterclaims*, which was filed contemporaneous to the present motion. Opposer stated on page 2 of its *Motion to Strike* that “Petitions for cancellation are to be kept short” and that evidentiary matters are *improper* to file with pleadings. There, Opposer asks to strike Paragraphs 4-7 of the Answer and Counterclaim and Exhibits A, B, and C and states that it would be burdensome for Opposer to respond. Opposer fails to explain its about-face in this issue, because now it demands that evidence be filed in support of the counter-claims.

Discovery has not yet begun in this matter. Applicant asserts that an adequate foundation for its counterclaims has been shown through its pleadings and attached Exhibits. Applicant does not wish to burden the Board with duplicate filings, however, if the Board desires then Applicant requests leave to file and further brief evidence of its allegations, if necessary, as a showing to overcome the present motion. Opposer has stated in its two motions that on one hand, it demands evidence of Applicant’s allegations, yet on the other hand, it does not want to respond to evidence and that Applicant should keep its pleadings “short.” Even Opposer is confused over

substantive facts and issues, and Applicant asserts that such arguments are better left to the clarity of substantive pleadings at the conclusion of discovery.

Second, Opposer's arguments in Sections A, B, and C miss the point in a number of ways. Opposer alleges that Applicant has failed to plead in context of the goods and services for each of the MORMON marks. However, Opposer has already made admissions of alleged confusion, etc., in its Notice of Opposition. Opposer is the party who brought this action, not Applicant, claiming false connection, confusion, etc. based on the word "MORMON" in its marks. "MORMON" is the single word in common to Applicant's mark SECRET MORMON. IRI alleged in its Opposition pleading that there would be confusion of Applicant's goods and services with the goods and services of its own marks. Opposer, through its new counsel, now argues that this is not the case, which leads to the conclusion that Opposer filed a frivolous Notice of Opposition containing false allegations without performing a proper pre-filing investigation. (see Fed. R. Civ. P. Rule 11) Opposer should withdraw all frivolous assertions against Applicant immediately.

#### IRI'S MORMON MARKS ARE REGISTERED FOR RELIGIOUS ORGANIZATIONS

Applicant pled in its Answer and Counter-claims that the work "MORMON" is a generic, functional, or merely descriptive mark for a religion, which is unregistrable. Opposer has countered in its Motion to Dismiss by stating that the "MORMON marks are not registered for religious organizations..." (See Motion to Dismiss, p. 8) This is a misleading and false

statement. In an application for MORMON.ORG (not at issue in this matter), Intellectual Reserve, Inc., who now opposes Applicant's mark, stated that:

Applicant, Intellectual Reserve, Inc., is the entity which holds intellectual property used by The Church of Jesus Christ of Latter-day Saints. (Thus, for purposes of this response, the term "Applicant" will be deemed to include The Church of Jesus Christ of Latter-day Saints.) (see Response to Office Action, Ser. No. 77179068, filed Feb. 22, 2008, Attached as Exhibit A)

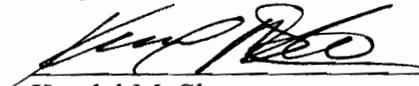
Clearly, by Opposer's own admissions to the Trademark Office, Intellectual Reserve Inc. is the same as The Church of Jesus Christ of Latter-day Saints and the MORMON marks are in fact registered for use by religious "Mormon" organizations. Thus, Applicant has stated a proper claim as to its basis for cancellation of the MORMON marks.

#### CONCLUSION

The word "MORMON" is generic, and therefore never should have been a registerable part of Opposer's marks. Alternatively, the "Mormon marks" are merely descriptive and Opposer has no exclusive association with the term "Mormon" in the relevant streams of commerce. "Mormon" is a generic name for a religion practiced by many different sects. Numerous religious groups refer to themselves as, and are known by third parties as, "Mormon." Generic names are regarded by the law as free for all to use. They are in the public domain. To grant an exclusive right to one firm of use of the generic name of a product or service would be equivalent to creating a monopoly in that particular product or service, something that the trademark laws were never intended to accomplish.

In its Notice, Intellectual Reserves alleged confusion between Applicant's goods and services and goods and services of the MORMON marks. Applicant's Counter-claims, in response to Opposer's Notice of Opposition, are properly pled against the asserted marks and based on a good-faith belief and evidence submitted therewith.

Respectfully Submitted;



Kendal M. Sheets  
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703-489-8937

Applicant

### CERTIFICATION OF SERVICE

I do hereby certify that on this 30th day of November, 2009, I served a copy of the above and foregoing pleading, **APPLICANT'S RESPONSE TO OPPOSER'S MOTION DISMISS COUNTERCLAIMS**, on all counsel for all parties to this proceeding, namely

Mr. Douglas R. Bush  
Mr. Michael A. Grow  
Arent Fox LLP  
1050 Connecticut Ave.NW  
Washington, DC 20036

Mr. Todd Zenger  
Kirton & McConkie  
1800 Eagle Gate Tower  
60 E. South Temple  
Salt Lake City, UT 84111

by mailing same via United States Mail, properly addressed and first class postage prepaid.

 11/30/09  
Kendal M. Sheets                      Date

# **EXHIBIT A**

## Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77179068
LAW OFFICE ASSIGNED	LAW OFFICE 102
MARK SECTION (no change)	
ARGUMENT(S)	

### RESPONSE

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

Sir:

This paper is being submitted in response to the communication from the Examining Attorney dated August 27, 2007. For the reasons set forth below, Applicant respectfully submits that its MORMON.ORG mark is registrable and hereby requests reconsideration of the Examining Attorney's action.

#### Discussion

##### A. Refusal of Registration under Section 2(e)(1)

In refusing registration of Applicant's mark, the Examining Attorney stated that Applicant's MORMON.ORG mark merely describes Applicant's services, contrary to the provisions of Section 2(e)(1) of the Trademark Act. For the reasons set forth below, however, Applicant respectfully submits that its mark is not "merely descriptive" of the services under the applicable legal standards.

Although the Trademark Act prohibits the registration of marks which are "merely descriptive," it is well established that a registrable mark "does not have to be devoid of all meaning in relation to the goods/services" to which it is applied. Trademark Manual of Examining Procedure ("T.M.E.P.") § 1209.01(a). Thus, the courts have frequently stated that a trademark may be valid and registrable even

though it is highly suggestive of such goods or their characteristics. See, e.g., Continental Scale Corp. v. Weight Watchers International, Inc., 517 F.2d 1378, 1380, 186 U.S.P.Q. 321, 323 (C.C.P.A. 1975); Application of Reynolds Metals Co., 480 F.2d 902, 904, 178 U.S.P.Q. 296, 297 (C.C.P.A. 1973). In this regard, the Court of Customs and Patent Appeals ("C.C.P.A.") reminded that "often the best trademarks are highly suggestive, and it is well settled that a valid trademark may be highly suggestive." Minnesota Mining & Manufacturing Co. v. Johnson & Johnson, 454 F.2d 1179, 1180, 172 U.S.P.Q. 491, 492 (C.C.P.A. 1972).

In distinguishing between trademarks which are permissibly suggestive and those which are "merely descriptive," courts have identified and considered several factors. For example, consistent with the underlying reason for the statutory prohibition against the registration of "merely descriptive" marks, courts have considered whether others are likely to use the mark in describing similar goods or services. See, e.g., Firestone Tire & Rubber Co. v. Goodyear Tire & Rubber Co., 189 U.S.P.Q. 348, 350 (C.C.P.A. 1976); Application of Reynolds Metals Co., 480 F.2d 902, 904, 178 U.S.P.Q. 296, 297 (C.C.P.A. 1973); Minnesota Mining & Manufacturing Co. v. Johnson & Johnson, 454 F.2d 1179, 1180, 172 U.S.P.Q. 491, 492 (C.C.P.A. 1972); Sperry Rand Corp. v. Sunbeam Corp., 442 F.2d 979, 980, 170 U.S.P.Q. 37, 38 (C.C.P.A. 1971). See also, Ex Parte Heatube Corp., 109 U.S.P.Q. 423, 424 (Dec. Comm'r Pat. 1956).

Similarly, courts have inquired whether the mark in some way indicates the origin of the goods or services. As the C.C.P.A. pointed out, the statutory term "merely descriptive" is considered to mean "only" or "solely" descriptive. See, Application of Quik-Print Copy Shops, Inc., 616 F.2d 523, 525 n.7, 205 U.S.P.Q. 505, 507 n.7 (C.C.P.A. 1980). Accordingly, the Court cautioned that "[a]lthough a mark may be generally descriptive, if it also functions as an indication of origin, it is not 'merely descriptive.'" Application of Abcor Development Corp., 588 F.2d 811, 813, 200 U.S.P.Q. 215, 218 (C.C.P.A. 1978). See also, Astra Pharmaceutical Products, Inc. v. Pharmaton, S.A., 345 F.2d 189, 194, 145 U.S.P.Q. 461, 466 (C.C.P.A. 1965); Ex parte Heatube Corp., 109 U.S.P.Q. 423, 424 (Dec. Comm'r Pat. 1956).

Further, courts have considered the amount of mental effort or imagination which is required, upon seeing or hearing the mark, in order to reach a conclusion as to the identity or nature of the goods or services to which it is applied. See, Application of Quik-Print Copy Shops, Inc., 616 F.2d 523, 525, 205 U.S.P.Q. 505, 507 (C.C.P.A. 1980); Application of Abcor Development Corp., 588 F.2d 811, 814, 200 U.S.P.Q. 215, 218 (C.C.P.A. 1978).

Importantly, in applying the foregoing principles, one must also keep in mind, as noted by the United States Supreme Court, that "[t]he commercial impression of a trade-mark is derived from it as a whole, not from its

elements separated and considered in detail. For this reason it should be considered in its entirety . . . ." Estate of P.D. Beckwith's, Inc. v. Commissioner of Patents, 252 U.S. 538, 545-46 (1920). See also, T.M.E.P. § 1209.03(d) (stating that an inventive "combination of merely descriptive components" may be registrable). Further, a determination of descriptiveness cannot be made in the abstract. Rather, the "descriptiveness of a mark, when applied to the goods or services involved, is to be determined from the standpoint of the average prospective purchaser." Application of Abcor Development Corp., 588 F.2d 811, 814, 200 U.S.P.Q. 215, 218 (C.C.P.A. 1978) (Emphasis in original).

The application of these principles is illustrated by the following two examples. In Ex parte Zip Abrasive Co., 99 U.S.P.Q. 16 (Dec. Comm'r Pat. 1953), the Commissioner reversed a decision of the Trademark Examiner and allowed registration of the mark SHORTSTOP as applied to a liquid moisture-repellent coating material for eliminating short circuiting due to moisture in the atmosphere. In so holding, the Commissioner stated: "Certainly, the word is not necessary to describe a product of this character -- and a competitor, in the ordinary course of business practice, would not use it to describe his product because it conveys no real meaning as a descriptive term applied to a moisture- repellent protective coating." Ex parte Zip Abrasive Co., 99 U.S.P.Q. 16, 17 (Dec. Comm'r Pat. 1953).

Similarly, the C.C.P.A. held that the mark BROWN-IN-BAG for transparent plastic film bags was registrable, stating:

It is true, but not fatal, that appellant's mark is informational. Because "bag" is obviously descriptive of the product and "brown" is descriptive of what can happen to some foods when the bag is used, the Commissioner's brief insists that the mark informs the housewife-purchaser of a purpose to which the bag may be put and thus it is merely descriptive of a purpose and unregistrable. But one may be informed by suggestion as well as by description. Here appellant is not seeking to register the "information" that their bags may be used to brown foods and is not seeking to register a direction such as "brown foods in this bag." Appellant seeks to register, as a unitary mark, the combination of words and hyphens which form the mark BROWN-IN-BAG.

....

The Commissioner's brief reflects concern that registration here would "deprive appellant's competitors of the use of common generic words which are in the public domain." We think not. Competitors are deprived only of the use of the three words in such format as would be likely to confuse. Competitors remain perfectly free to inform purchasers that foods may be browned in their bags and to use "brown," "in" and "bag" in whatever nontrademark manner they choose.

Application of Reynolds Metals Co., 480 F.2d 902, 904, 178 U.S.P.Q. 296, 297 (C.C.P.A. 1973) (Emphasis in original).

Applying the foregoing principles to the present case, Applicant's MORMON.ORG mark is clearly not "merely descriptive." The services with which the MORMON.ORG mark is used are commonly referred to as informational or instructional services. Prospective seekers of such services would commonly refer to the services as informational or instructional services. It is certainly not likely that anyone would use "MORMON.ORG" to describe the services, since such usage is grammatically incorrect, nonsensical, and conveys no real meaning with respect to the services. In this regard, there is no real need, motivation, or reason for those involved with informational or instructional services to refer to such services as "MORMON.ORG". Thus, there is clearly neither the need nor the inclination for others to use the term "MORMON.ORG" in connection with the services in question.

Applicant, Intellectual Reserve, Inc., is the entity which holds intellectual property used by The Church of Jesus Christ of Latter-day Saints. (Thus, for purposes of this response, the term "Applicant" will be deemed to include The Church of Jesus Christ of Latter-day Saints.) As evidenced by the dictionary definition attached by the Examining Attorney to the outstanding Office Action, the term "MORMON" has its origin in the name of an ancient American prophet who compiled and abridged the writings of several other American prophets who lived between the years 600 B.C. and 400 A.D. into what is now known as the Book of Mormon. The Book of Mormon was first published in 1830 and remains today a book of scripture used by members of The Church of Jesus Christ of Latter-day Saints. There are now over 13 million members of The Church of Jesus Christ of Latter-day Saints, and this Church is well-known throughout the world, especially in view of its active missionary effort.

Thus, a large segment of the U.S. population (as well as around the world) is familiar with The Church of Jesus Christ of Latter-day Saints, and those most familiar with this Church recognize that "The Church of Jesus Christ of Latter-day Saints" is the true name of the Church. However, because of the Book of Mormon, the term "MORMON CHURCH" has been used for over 170 years by many to refer to The Church of Jesus Christ of Latter-day Saints, and the term "MORMON" has similarly been used over this period of time by many to refer to the members of this Church.

Importantly, the term "MORMON" refers only to Applicant, and no one else. The public uses the term "MORMON" to refer to the Applicant, and no one else. Others do not need or desire to use the term "MORMON", because they realize that it refers solely to Applicant. It is true that the term "MORMON" enjoys heavy usage, but this is because of the fame the term has acquired over 170+ years in referring to

Applicant. The term has always referred to Applicant and to Applicant alone. The widespread usage and fame of the term "MORMON" does not speak to its descriptiveness, but rather to the distinctiveness of this term as it has become a strong identifier of a single source, namely, Applicant. The Examining Attorney has not cited any evidence to show that others use the term "MORMON" to refer to anyone other than Applicant.

Perhaps the Examining Attorney believes that since the term "MORMON" is so widespread, it then must follow that it is also descriptive. It is respectfully submitted that such logic is without merit. The widespread nature of Applicant's mark is a product of its many years of usage, always to refer to Applicant. It is true that Applicant could have filed for federal registration many years ago, before use of the term "MORMON" was so widespread. However, the fact that Applicant has waited until now to file does not change the fact that the term "MORMON" is and has been used over the years solely to refer to Applicant. Rather, the passage of time has only served to strengthen the function of the term "MORMON" as a single source identifier.

Who else besides Applicant would even want to be known by or associated with the term "MORMON"? Other religious organizations recognize the strength of this term as a service mark and source identifier, and intentionally stay away from usage of such term so that their religious organization will not be confused with Applicant. What Church or religious organization would reasonably ever want to be confused with another? That is the hallmark of different faiths – having different tenets and beliefs that distinguish them from others. To then adopt or use the names of other religions or faiths would destroy any distinctions between them, and defeat the real reason multiple Churches or religious organizations exist in the first place.

Clearly, the mark at issue, "MORMON.ORG", does not describe the content of the claimed informational or instructional services, but rather signals the source of the same. This is the hallmark and classic function of a true service mark. The mark "MORMON.ORG" signals a single source provider of very specific values. As mentioned, there are over 13 million members of The Church of Jesus Christ of Latter-day Saints, and the Church is actively involved in virtually every community of the United States, as well as around the world. The Church of Jesus Christ of Latter-day Saints is very active in proselyting via a missionary program and advertising campaign designed to spread the message of the Church and convert people to the faith. Indeed, especially in the United States, there are not many who have not heard of the Church or are not familiar with some of its teachings. Those teachings are very unique and value specific to Applicant, and the

public recognizes the term "MORMON" to be attached to and only to the single source of such values, namely, The Church of Jesus Christ of Latter-day Saints.

In summary, the public knows that the term "MORMON" and the mark "MORMON.ORG" are associated with one entity, and one entity only, namely the present Applicant. The fact that this venerable identifier has been used for more than 170 years has only served to strengthen its function as a source identifier, not diminish it.

When viewed by an average prospective seeker of Applicant's services, the primary significance of Applicant's MORMON.ORG mark would be to distinguish Applicant's services from those offered by others. As noted in the Firestone Tire & Rubber case, supra, courts have considered whether others are likely to use the mark in describing similar goods or services in determining whether or not a particular trademark is "merely descriptive." Applicant is aware of NO ONE else who uses "MORMON.ORG" in connection with any services whatsoever, much less those services claimed in the present application.

The Examining Attorney has cited a single dictionary reference as support for his allegation that the term "MORMON" is "merely descriptive wording". It is respectfully submitted that the cited dictionary reference actually instead supports the fact that the term "MORMON" is unique, distinctive, and refers only to Applicant. For example, the cited dictionary definition makes reference to the term "Latter-day Saint", which in turn is a reference to The Church of Jesus Christ of Latter-day Saints or Applicant. The cited dictionary definition also references the prophet Mormon, Joseph Smith, and the Book of Mormon. Who else could those references be to other than The Church of Jesus Christ of Latter-day Saints or Applicant? In fact, a close examination of the cited dictionary reference evidences that the term "MORMON", and in turn the mark "MORMON.ORG", could only refer to the religious group known as The Church of Jesus Christ of Latter-day Saints or Applicant. Once again, the purpose of a mark is to serve as a SINGLE source identifier. The mark "MORMON.ORG" does exactly that.

It is respectfully submitted that the reasoning of the Examining Attorney in the outstanding Office Action is in direct conflict with the SHORTSTOP and BROWN-IN-BAG cases cited herein, and it is clear that these cases cannot be distinguished over the present MORMON.ORG application for registration. In this regard, the Examining Attorney's reasoning falls quite short of the standard set forth in the relevant case law cited herein wherein a mark is held to be "merely descriptive," if the mark is "only" or "solely" descriptive. Clearly, the Examining Attorney has not met his burden of proof with regard to the descriptiveness issue.

B. Refusal of Registration under Section 2(e)(1) Continued – The Law Relating to Names of Religious Organizations

In the Office Action dated August 27, 2007, the Examining Attorney seems to be suggesting that the name of a religious organization is in and of itself merely descriptive and therefore unregistrable. However, such a position is in direct conflict with the relevant case law.

In McCarthy on Trademarks and Unfair Competition, § 9:7 at 9-16 (4th Ed. 2007), it is stated that:

Similarly protected are the names of educational institutions and religious organizations.

Board of Provincial Elders v. Jones, 273 N.C. 174, 159 S.E.2d 545 (1968). See also National Spiritual Assembly of Baha'is v. National Spiritual Assembly of Baha'is, Inc., 150 U.S.P.Q. 346 (N.D. Ill. 1966) (protection for name of religious assembly); TE-TA-MA Truth Foundation – Family of URI, Inc. v. World Church of Creator, 297 F.3d 662, 63 U.S.P.Q.2d 1760 (7<sup>th</sup> Cir. 2002), cert. denied, 537 U.S. 1111, 123 S. Ct. 864, 154 L. Ed. 2d 784 (2003) (defendant's WORLD CHURCH OF THE CREATOR was enjoined as an infringement of plaintiff's CHURCH OF THE CREATOR).

Hundreds of marks have been registered to religious groups, and a recent search of the U.S. Patent and Trademark Office website for marks containing the term "CHURCH\*" yielded 1475 hits. In this regard, a substantial number of churches have successfully obtained federal trademark or service mark registrations for their religious goods or services. Due to the volume of such, they are not cited here. However, more specific details regarding such citations can be made available if the Examining Attorney so desires.

As one example, the name of the Church known as "SEVENTH DAY ADVENTIST" was successfully registered under U.S. Registration No. 1,177,185 for a variety of religious goods and services. The Trademark Trial and Appeal Board upheld this SEVENTH DAY ADVENTIST registration in a cancellation proceeding and held this Church name to be a protectable mark. Stocker v. General Conference Corp., 39 U.S.P.Q.2d 1385 (T.T.A.B. 1996) ("[F]or a period of over 130 years, the primary significance of the description "Seventh-day Adventist" has been to identify the source or origin of religious publications and services emanating from respondent." 39 U.S.P.Q.2d 1385 at 1398. Two petitions to cancel were dismissed.)

It is respectfully submitted that the SEVENTH DAY ADVENTIST case is directly applicable to the present case and situation. As with the Church name SEVENTH DAY ADVENTIST, the primary significance of the term "MORMON" has been to identify the source or origin of religious goods and services emanating from Applicant over a very long period of time, more than 170 years. Thus, it is clear that the position taken by the Examining Attorney in the outstanding Office Action is in direct conflict with the SEVENTH DAY ADVENTIST case cited herein, and it is clear that the SEVENTH DAY ADVENTIST case cannot be distinguished over the present MORMON.ORG application for registration.

The Trademark Trial and Appeal Board has made it clear that conjecture and doubts about the descriptiveness of a term require resolution of the issue in favor of the Applicant. In re American Standard, Inc., supra, at 223 U.S.P.Q. 355. See also In re Bliss & Laughlin Industries, Inc., 198 U.S.P.Q. 127 (T.T.A.B. 1978); In re Hospital Supply Corp., 219 U.S.P.Q. 949, 951 (T.T.A.B. 1983).

In summary, the Examining Attorney has not met his burden to show that the "MORMON.ORG" mark is "merely descriptive," i.e., "only" or "solely" descriptive, and it is clear that the mark is in fact not "merely descriptive" of Applicant's services. Hence, it is respectfully submitted that the refusal of registration based upon the allegation that Applicant's mark is descriptive is improper and should be withdrawn.

#### Conclusion

In view of the foregoing, Applicant respectfully submits that this application is in condition for allowance and publication. In the event the Examining Attorney finds any remaining impediment to the prompt allowance of this application which could be clarified in a telephone conference, the Examining Attorney is respectfully requested to initiate the same with Dale E. Hulse at (801) 321-4815.

Respectfully submitted,

Dale E. Hulse  
Attorney for Applicant

Kirton & McConkie  
1800 Eagle Gate Tower  
60 East South Temple  
P.O. Box 45120  
Salt Lake City, UT 84145-0120  
Telephone: (801) 321-4815

Docket: 6925.765

**SIGNATURE SECTION**

**RESPONSE SIGNATURE** /Dale E. Hulse/  
**SIGNATORY'S NAME** Dale E. Hulse  
**SIGNATORY'S POSITION** Attorney of Record  
**DATE SIGNED** 02/22/2008  
**AUTHORIZED SIGNATORY** YES

**FILING INFORMATION SECTION**

**SUBMIT DATE** Fri Feb 22 16:40:47 EST 2008  
USPTO/ROA-207.225.193.114  
-20080222164047465455-771  
**TEAS STAMP** 79068-41065cdd3afce3282bf  
6c0faf4bf4ff6dc-N/A-N/A-2  
0080222151503328679

**Response to Office Action  
To the Commissioner for Trademarks:**

Application serial no. **77179068** has been amended as follows:

**ARGUMENT(S)**

**In response to the substantive refusal(s), please note the following:**

**RESPONSE**

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

Sir:

This paper is being submitted in response to the communication from the Examining Attorney dated August 27, 2007. For the reasons set forth below, Applicant respectfully submits that its MORMON.ORG mark is registrable and hereby requests reconsideration of the Examining Attorney's action.

## Discussion

### A. Refusal of Registration under Section 2(e)(1)

In refusing registration of Applicant's mark, the Examining Attorney stated that Applicant's MORMON.ORG mark merely describes Applicant's services, contrary to the provisions of Section 2(e)(1) of the Trademark Act. For the reasons set forth below, however, Applicant respectfully submits that its mark is not "merely descriptive" of the services under the applicable legal standards.

Although the Trademark Act prohibits the registration of marks which are "merely descriptive," it is well established that a registrable mark "does not have to be devoid of all meaning in relation to the goods/services" to which it is applied. Trademark Manual of Examining Procedure ("T.M.E.P.") § 1209.01(a). Thus, the courts have frequently stated that a trademark may be valid and registrable even though it is highly suggestive of such goods or their characteristics. See, e.g., Continental Scale Corp. v. Weight Watchers International, Inc., 517 F.2d 1378, 1380, 186 U.S.P.Q. 321, 323 (C.C.P.A. 1975); Application of Reynolds Metals Co., 480 F.2d 902, 904, 178 U.S.P.Q. 296, 297 (C.C.P.A. 1973). In this regard, the Court of Customs and Patent Appeals ("C.C.P.A.") reminded that "often the best trademarks are highly suggestive, and it is well settled that a valid trademark may be highly suggestive." Minnesota Mining & Manufacturing Co. v. Johnson & Johnson, 454 F.2d 1179, 1180, 172 U.S.P.Q. 491, 492 (C.C.P.A. 1972).

In distinguishing between trademarks which are permissibly suggestive and those which are "merely descriptive," courts have identified and considered several factors. For example, consistent with the underlying reason for the statutory prohibition against the registration of "merely descriptive" marks, courts have considered whether others are likely to use the mark in describing similar goods or services. See, e.g., Firestone Tire & Rubber Co. v. Goodyear Tire & Rubber Co., 189 U.S.P.Q. 348, 350 (C.C.P.A. 1976); Application of Reynolds Metals Co., 480 F.2d 902, 904, 178 U.S.P.Q. 296, 297 (C.C.P.A. 1973); Minnesota Mining & Manufacturing Co. v. Johnson & Johnson, 454 F.2d 1179, 1180, 172 U.S.P.Q. 491, 492 (C.C.P.A. 1972); Sperry Rand Corp. v. Sunbeam Corp., 442 F.2d 979, 980, 170 U.S.P.Q. 37, 38 (C.C.P.A. 1971). See also, Ex Parte Heatube Corp., 109 U.S.P.Q. 423, 424 (Dec. Comm'r Pat. 1956).

Similarly, courts have inquired whether the mark in some way indicates the origin of the goods or services. As the C.C.P.A. pointed out, the statutory term "merely descriptive" is considered to mean "only" or "solely" descriptive. See, Application of Quik-Print Copy Shops, Inc., 616 F.2d 523, 525 n.7, 205 U.S.P.Q. 505, 507 n.7 (C.C.P.A. 1980). Accordingly, the Court cautioned that "[a]lthough a mark may be generally descriptive, if

it also functions as an indication of origin, it is not 'merely descriptive.'" Application of Abcor Development Corp., 588 F.2d 811, 813, 200 U.S.P.Q. 215, 218 (C.C.P.A. 1978). See also, Astra Pharmaceutical Products, Inc. v. Pharmaton, S.A., 345 F.2d 189, 194, 145 U.S.P.Q. 461, 466 (C.C.P.A. 1965); Ex parte Heatube Corp., 109 U.S.P.Q. 423, 424 (Dec. Comm'r Pat. 1956).

Further, courts have considered the amount of mental effort or imagination which is required, upon seeing or hearing the mark, in order to reach a conclusion as to the identity or nature of the goods or services to which it is applied. See, Application of Quik-Print Copy Shops, Inc., 616 F.2d 523, 525, 205 U.S.P.Q. 505, 507 (C.C.P.A. 1980); Application of Abcor Development Corp., 588 F.2d 811, 814, 200 U.S.P.Q. 215, 218 (C.C.P.A. 1978).

Importantly, in applying the foregoing principles, one must also keep in mind, as noted by the United States Supreme Court, that "[t]he commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety . . . ." Estate of P.D. Beckwith's, Inc. v. Commissioner of Patents, 252 U.S. 538, 545-46 (1920). See also, T.M.E.P. § 1209.03(d) (stating that an inventive "combination of merely descriptive components" may be registrable). Further, a determination of descriptiveness cannot be made in the abstract. Rather, the "descriptiveness of a mark, when applied to the goods or services involved, is to be determined from the standpoint of the average prospective purchaser." Application of Abcor Development Corp., 588 F.2d 811, 814, 200 U.S.P.Q. 215, 218 (C.C.P.A. 1978) (Emphasis in original).

The application of these principles is illustrated by the following two examples. In Ex parte Zip Abrasive Co., 99 U.S.P.Q. 16 (Dec. Comm'r Pat. 1953), the Commissioner reversed a decision of the Trademark Examiner and allowed registration of the mark SHORTSTOP as applied to a liquid moisture-repellent coating material for eliminating short circuiting due to moisture in the atmosphere. In so holding, the Commissioner stated: "Certainly, the word is not necessary to describe a product of this character -- and a competitor, in the ordinary course of business practice, would not use it to describe his product because it conveys no real meaning as a descriptive term applied to a moisture- repellent protective coating." Ex parte Zip Abrasive Co., 99 U.S.P.Q. 16, 17 (Dec. Comm'r Pat. 1953).

Similarly, the C.C.P.A. held that the mark BROWN-IN-BAG for transparent plastic film bags was registrable, stating:

It is true, but not fatal, that appellant's mark is informational. Because "bag" is obviously descriptive of the product and "brown" is descriptive of what can happen to some foods when

the bag is used, the Commissioner's brief insists that the mark informs the housewife-purchaser of a purpose to which the bag may be put and thus it is merely descriptive of a purpose and unregistrable. But one may be informed by suggestion as well as by description. Here appellant is not seeking to register the "information" that their bags may be used to brown foods and is not seeking to register a direction such as "brown foods in this bag." Appellant seeks to register, as a unitary mark, the combination of words and hyphens which form the mark BROWN-IN-BAG.

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The Commissioner's brief reflects concern that registration here would "deprive appellant's competitors of the use of common generic words which are in the public domain." We think not. Competitors are deprived only of the use of the three words in such format as would be likely to confuse. Competitors remain perfectly free to inform purchasers that foods may be browned in their bags and to use "brown," "in" and "bag" in whatever nontrademark manner they choose.

Application of Reynolds Metals Co., 480 F.2d 902, 904, 178 U.S.P.Q. 296, 297 (C.C.P.A. 1973) (Emphasis in original).

Applying the foregoing principles to the present case, Applicant's MORMON.ORG mark is clearly not "merely descriptive." The services with which the MORMON.ORG mark is used are commonly referred to as informational or instructional services. Prospective seekers of such services would commonly refer to the services as informational or instructional services. It is certainly not likely that anyone would use "MORMON.ORG" to describe the services, since such usage is grammatically incorrect, nonsensical, and conveys no real meaning with respect to the services. In this regard, there is no real need, motivation, or reason for those involved with informational or instructional services to refer to such services as "MORMON.ORG". Thus, there is clearly neither the need nor the inclination for others to use the term "MORMON.ORG" in connection with the services in question.

Applicant, Intellectual Reserve, Inc., is the entity which holds intellectual property used by The Church of Jesus Christ of Latter-day Saints. (Thus, for purposes of this response, the term "Applicant" will be deemed to include The Church of Jesus Christ of Latter-day Saints.) As evidenced by the dictionary definition attached by the Examining Attorney to the outstanding Office Action, the term "MORMON" has its origin in the name of an ancient American prophet who compiled and abridged the writings of several other American prophets who lived between the years 600 B.C. and 400 A.D. into what is now known as the Book of Mormon. The Book of Mormon was first published in 1830 and remains today a book of scripture used by members of The Church of Jesus Christ of Latter-day Saints. There are now over 13 million members of The Church of Jesus Christ of Latter-day Saints, and this Church is well-known throughout the world, especially in view of its active

missionary effort.

Thus, a large segment of the U.S. population (as well as around the world) is familiar with The Church of Jesus Christ of Latter-day Saints, and those most familiar with this Church recognize that “The Church of Jesus Christ of Latter-day Saints” is the true name of the Church. However, because of the Book of Mormon, the term “MORMON CHURCH” has been used for over 170 years by many to refer to The Church of Jesus Christ of Latter-day Saints, and the term “MORMON” has similarly been used over this period of time by many to refer to the members of this Church.

Importantly, the term “MORMON” refers only to Applicant, and no one else. The public uses the term “MORMON” to refer to the Applicant, and no one else. Others do not need or desire to use the term “MORMON”, because they realize that it refers solely to Applicant. It is true that the term “MORMON” enjoys heavy usage, but this is because of the fame the term has acquired over 170+ years in referring to Applicant. The term has always referred to Applicant and to Applicant alone. The widespread usage and fame of the term “MORMON” does not speak to its descriptiveness, but rather to the distinctiveness of this term as it has become a strong identifier of a single source, namely, Applicant. The Examining Attorney has not cited any evidence to show that others use the term “MORMON” to refer to anyone other than Applicant.

Perhaps the Examining Attorney believes that since the term “MORMON” is so widespread, it then must follow that it is also descriptive. It is respectfully submitted that such logic is without merit. The widespread nature of Applicant’s mark is a product of its many years of usage, always to refer to Applicant. It is true that Applicant could have filed for federal registration many years ago, before use of the term “MORMON” was so widespread. However, the fact that Applicant has waited until now to file does not change the fact that the term “MORMON” is and has been used over the years solely to refer to Applicant. Rather, the passage of time has only served to strengthen the function of the term “MORMON” as a single source identifier.

Who else besides Applicant would even want to be known by or associated with the term “MORMON”? Other religious organizations recognize the strength of this term as a service mark and source identifier, and intentionally stay away from usage of such term so that their religious organization will not be confused with Applicant. What Church or religious organization would reasonably ever want to be confused with another? That is the hallmark of different faiths – having different tenets and beliefs that distinguish them from others. To then adopt or use the names of other religions or faiths would destroy any distinctions between them, and defeat the real reason multiple Churches or religious organizations exist in the first place.

Clearly, the mark at issue, "MORMON.ORG", does not describe the content of the claimed informational or instructional services, but rather signals the source of the same. This is the hallmark and classic function of a true service mark. The mark "MORMON.ORG" signals a single source provider of very specific values. As mentioned, there are over 13 million members of The Church of Jesus Christ of Latter-day Saints, and the Church is actively involved in virtually every community of the United States, as well as around the world. The Church of Jesus Christ of Latter-day Saints is very active in proselyting via a missionary program and advertising campaign designed to spread the message of the Church and convert people to the faith. Indeed, especially in the United States, there are not many who have not heard of the Church or are not familiar with some of its teachings. Those teachings are very unique and value specific to Applicant, and the public recognizes the term "MORMON" to be attached to and only to the single source of such values, namely, The Church of Jesus Christ of Latter-day Saints.

In summary, the public knows that the term "MORMON" and the mark "MORMON.ORG" are associated with one entity, and one entity only, namely the present Applicant. The fact that this venerable identifier has been used for more than 170 years has only served to strengthen its function as a source identifier, not diminish it.

When viewed by an average prospective seeker of Applicant's services, the primary significance of Applicant's MORMON.ORG mark would be to distinguish Applicant's services from those offered by others. As noted in the Firestone Tire & Rubber case, supra, courts have considered whether others are likely to use the mark in describing similar goods or services in determining whether or not a particular trademark is "merely descriptive." Applicant is aware of NO ONE else who uses "MORMON.ORG" in connection with any services whatsoever, much less those services claimed in the present application.

The Examining Attorney has cited a single dictionary reference as support for his allegation that the term "MORMON" is "merely descriptive wording". It is respectfully submitted that the cited dictionary reference actually instead supports the fact that the term "MORMON" is unique, distinctive, and refers only to Applicant. For example, the cited dictionary definition makes reference to the term "Latter-day Saint", which in turn is a reference to The Church of Jesus Christ of Latter-day Saints or Applicant. The cited dictionary definition also references the prophet Mormon, Joseph Smith, and the Book of Mormon. Who else could those references be to other than The Church of Jesus Christ of Latter-day Saints or Applicant? In fact, a close examination of the

cited dictionary reference evidences that the term "MORMON", and in turn the mark "MORMON.ORG", could only refer to the religious group known as The Church of Jesus Christ of Latter-day Saints or Applicant. Once again, the purpose of a mark is to serve as a SINGLE source identifier. The mark "MORMON.ORG" does exactly that.

It is respectfully submitted that the reasoning of the Examining Attorney in the outstanding Office Action is in direct conflict with the SHORTSTOP and BROWN-IN-BAG cases cited herein, and it is clear that these cases cannot be distinguished over the present MORMON.ORG application for registration. In this regard, the Examining Attorney's reasoning falls quite short of the standard set forth in the relevant case law cited herein wherein a mark is held to be "merely descriptive," if the mark is "only" or "solely" descriptive. Clearly, the Examining Attorney has not met his burden of proof with regard to the descriptiveness issue.

B. Refusal of Registration under Section 2(e)(1) Continued – The Law Relating to Names of Religious Organizations

In the Office Action dated August 27, 2007, the Examining Attorney seems to be suggesting that the name of a religious organization is in and of itself merely descriptive and therefore unregistrable. However, such a position is in direct conflict with the relevant case law.

In McCarthy on Trademarks and Unfair Competition, § 9:7 at 9-16 (4th Ed. 2007), it is stated that:

Similarly protected are the names of educational institutions and religious organizations.

Board of Provincial Elders v. Jones, 273 N.C. 174, 159 S.E.2d 545 (1968). See also National Spiritual Assembly of Baha'is v. National Spiritual Assembly of Baha'is, Inc., 150 U.S.P.Q. 346 (N.D. Ill. 1966) (protection for name of religious assembly); TE-TA-MA Truth Foundation – Family of URI, Inc. v. World Church of Creator, 297 F.3d 662, 63 U.S.P.Q.2d 1760 (7<sup>th</sup> Cir. 2002), cert. denied, 537 U.S. 1111, 123 S. Ct. 864, 154 L. Ed. 2d 784 (2003) (defendant's WORLD CHURCH OF THE CREATOR was enjoined as an infringement of plaintiff's CHURCH OF THE CREATOR).

Hundreds of marks have been registered to religious groups, and a recent search of the U.S. Patent and Trademark Office website for marks containing the term "CHURCH\*" yielded 1475 hits. In this regard, a substantial number of churches have successfully obtained federal trademark or service mark registrations for their religious goods or services. Due to the volume of such, they are not cited here. However, more specific details regarding such citations can be made available if the Examining Attorney so desires.

As one example, the name of the Church known as "SEVENTH DAY ADVENTIST" was successfully registered under U.S. Registration No. 1,177,185 for a variety of religious goods and services. The Trademark Trial and Appeal Board upheld this SEVENTH DAY ADVENTIST registration in a cancellation proceeding and held this Church name to be a protectable mark. Stocker v. General Conference Corp., 39 U.S.P.Q.2d 1385 (T.T.A.B. 1996) ("[F]or a period of over 130 years, the primary significance of the description "Seventh-day Adventist" has been to identify the source or origin of religious publications and services emanating from respondent." 39 U.S.P.Q.2d 1385 at 1398. Two petitions to cancel were dismissed.)

It is respectfully submitted that the SEVENTH DAY ADVENTIST case is directly applicable to the present case and situation. As with the Church name SEVENTH DAY ADVENTIST, the primary significance of the term "MORMON" has been to identify the source or origin of religious goods and services emanating from Applicant over a very long period of time, more than 170 years. Thus, it is clear that the position taken by the Examining Attorney in the outstanding Office Action is in direct conflict with the SEVENTH DAY ADVENTIST case cited herein, and it is clear that the SEVENTH DAY ADVENTIST case cannot be distinguished over the present MORMON.ORG application for registration.

The Trademark Trial and Appeal Board has made it clear that conjecture and doubts about the descriptiveness of a term require resolution of the issue in favor of the Applicant. In re American Standard, Inc., supra, at 223 U.S.P.Q. 355. See also In re Bliss & Laughlin Industries, Inc., 198 U.S.P.Q. 127 (T.T.A.B. 1978); In re Hospital Supply Corp., 219 U.S.P.Q. 949, 951 (T.T.A.B. 1983).

In summary, the Examining Attorney has not met his burden to show that the "MORMON.ORG" mark is "merely descriptive," i.e., "only" or "solely" descriptive, and it is clear that the mark is in fact not "merely descriptive" of Applicant's services. Hence, it is respectfully submitted that the refusal of registration based upon the allegation that Applicant's mark is descriptive is improper and should be withdrawn.

#### Conclusion

In view of the foregoing, Applicant respectfully submits that this application is in condition for allowance and publication. In the event the Examining Attorney finds any remaining impediment to the prompt allowance of this application which could be clarified in a telephone conference, the Examining Attorney is respectfully requested to initiate the same with Dale E. Hulse at (801) 321-4815.

Respectfully submitted,

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**SIGNATURE(S)**

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Signature: /Dale E. Hulse/ Date: 02/22/2008

Signatory's Name: Dale E. Hulse

Signatory's Position: Attorney of Record

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

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