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Filing date: **05/12/2014**

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

Proceeding	91215064
Party	Defendant Jonathan Eller
Correspondence Address	SIDDARTHA RAO 121 E 12TH ST APT LG NEW YORK, NY 10003 UNITED STATES srao@dateamormon.com, joneller@hotmail.com
Submission	Opposition/Response to Motion
Filer's Name	Siddartha Rao
Filer's e-mail	srao@dateamormon.com, joneller@hotmail.com
Signature	/Siddartha Rao/
Date	05/12/2014
Attachments	MoL.pdf(549075 bytes) Declaration in Support of Opposition to Motion to Amend.pdf(110229 bytes) Exhibit A.pdf(175403 bytes) Exhibit B.pdf(196365 bytes) Exhibit C.pdf(153717 bytes) Exhibit D.pdf(133391 bytes) Exhibit E.pdf(228616 bytes) Exhibit F.pdf(304036 bytes) Exhibit G.pdf(100705 bytes) Exhibit H.pdf(970737 bytes) Exhibit I.pdf(1740322 bytes) Exhibit J.pdf(3029107 bytes) Exhibit K.pdf(2187355 bytes) Exhibit L.pdf(878081 bytes) Exhibit M.pdf(289204 bytes) Certificate re Opposition.pdf(60280 bytes)

Opposition to Motions to Amend and Extend Time Opposition No. 91215064

services. Many dating websites brand as “Mormon” and have “Mormon” in their logos. IRI cannot allege harm from one more such website using “Mormon” in its logo. Accordingly, IRI is a mere intermeddler, and its motions should be denied.

The Trademark Trial and Appeal Board (the “Board”) should not allow IRI to further delay this proceeding. Eller filed his motion to dismiss on April 5, 2014. IRI has now had over a month to respond to Eller’s motion. IRI inexcusably waited until the day before its response was due to seek a second extension of time.

The Board ordered IRI to respond on May 9, 2014. It never granted IRI an extension of time to respond. Yet IRI refused to respond. The Board should construe IRI’s failure to abide by scheduling orders as no opposition to the Motion to Dismiss.

For all of the reasons stated herein, the Board should deny IRI’s motions to amend and get a second extension of its time to respond to Eller’s Motion to Dismiss.

PROCEDURAL HISTORY AND STATEMENT OF FACTS

On June 3, 2013 Eller filed an “intent to use application” for registration of “MORMON MATCH (and Design)” Serial No. 85/949,670 (the “Logo”) shown here:



Although Eller created the Logo with the advice and help of two others, both left the business and gave Eller the Logo for his own use. When Eller applied for the trademark, Eller was the sole owner of the Logo. Eller also had a bona fide intent to use the Logo in commerce, as himself. Ten days after applying for the Logo, on June 3, 2013 Eller filed for an “Assumed Name” or d/b/a as “Mormon Match” under file number V111911 with the Harris County Clerk in Harris County, Texas. See Exhibit A to accompanying declaration of Siddartha Rao, dated May 10, 2014 (“Rao Decl.”). Thus, at the time Eller applied to register the Logo, he was its owner and intended to use it in commerce in his individual capacity, albeit under the d/b/a “Mormon Match.”

Eller, a Mormon, has displayed the Logo for since June of last year on the website dateamormon.com (the “Dating Website”) where he is promoting and advertising the company Mormon Match. See dateamormon.com (showing Eller’s photograph and promotional materials, and comments posted a year ago). Several months after applying for registration of the Logo, Eller approached others about joining his business, and had discussions about forming a company called Mormon Match. Mormon Match, LLC is now a Texas company. (Exhibit B to Rao Decl.)

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Eller's application published for opposition on October 29, 2013, expressly disclaiming the words "MORMON MATCH" apart from the Logo. On November 5, 2013, IRI moved to extend its time to oppose. IRI eventually opposed on February 24, 2014 by opposition No. 91215064 (the "Opposition"). In Opposition, IRI asserts ownership of "all right, title, and interest" to the descriptive term "Mormon." The Board entered an institution order setting an April 5, 2014 response date.

Eller accommodated IRI by placing a notice on the Dating Website that Mormon Match is not commercially affiliated with or endorsed by The Church of Jesus Christ of Latter-day Saints. Eller then emailed, called, and sent letters to IRI's counsel to open settlement negotiations. IRI did not respond to or even acknowledge these six communications sent over a period of two weeks. (Rao Decl. ¶¶ 4–11 and Exs. C–E).

On April 4, 2014, the eve of Eller's response date, counsel for IRI sent a demand to Linode, LLC, the company hosting the Dating Website, insisting Linode shut the website down.¹ IRI asserted it "own[s]" "the term MORMON" and had not given the Dating Website "permission" to "use the term MORMON" "on its internet site and social networking pages." IRI further asserted "intentional misuse of IRI's intellectual property." (Exhibit F to Rao Decl.) Counsel's late night plea averted a shutdown in the midst of finalizing Eller's response.² (Exhibit G to Rao Decl.) The next day, Eller timely filed a Motion to Dismiss.³

¹ Although styled as a takedown notice under the Digital Millennium Copyright Act, the demand letter alleges no copyright infringement.

² A server shut down would have barred Mormon Match's business partners and counsel access to all prior email communications the day before a response was due.

³ Eller's counsel filed and served a motion on April 4 to protect Eller from default while Mormon Match diverted all resources to a possibly protracted effort to keep the Dating

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Although Eller has displayed the allegedly unlawful logo and word “Mormon” on his website since June of last year, and had been actively and openly promoting Mormon Match online for two years, IRI picked the day before Eller’s answer was due to demand the Dating Website be put out of operation.

Because IRI asserted all-encompassing rights over the word “Mormon,” threatening Eller’s business, Eller commenced a proceeding the following Monday captioned *Eller and Mormon Match, LLC v. Intellectual Reserve, Inc.*, 4:14-cv-00914 (S.D. Tex. 2014) (the “Texas Proceeding”) seeking injunctive and declaratory relief. Eller explained that Mormon Match is allowed to use the descriptive term “Mormon” to describe Mormon Match’s intended users and an essential characteristic of its dating services. (Exhibit H to Rao Decl. [Texas Proceeding Dkt. 10]).

IRI responded by suing Eller for federal and common law infringement and federal unfair competition and cybersquatting for using the descriptive term “Mormon.” (Exhibit I to Rao Decl. [Texas Proceeding Dkt. 23]). IRI also accused Eller of perjury in papers replete with mischaracterizations and insinuations about Eller’s motivations and faith. (Exhibit J to Rao Decl. [Texas Proceeding Dkt. 24]).

Eller’s trademark application stated: “no other firm, corporation or association has the right to use” the Logo. Consistent with settled trademark law, Eller had also stated in the Texas Proceeding, that nobody could monopolize the descriptive word “Mormon” for online dating. IRI apparently did not understand that the Logo is not the same as the word “Mormon,” or that Eller’s application only claims colors, shapes and designs. IRI misconstrued Eller’s honest statements to be perjury.

Website. After that issue was temporarily resolved, Eller’s counsel filed and served a corrected motion to dismiss with exhibits on Saturday April 5, 2014.

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In response to IRI's strained accusations of perjury, Eller filed Reply papers stating in relevant part:

Eller and his business partners created Mormon Match's logo This means "no other firm, corporation or association has the right to use" it. Eller did not commit perjury when he told the truth. Eller is not asking to own the words "Mormon" or "Match." He is simply trying to stop other people from copying Mormon Match's logo.

(Exhibit K to Rao Decl; [Texas Proceeding Dkt. 30 at p. 15]). Eller also filed an affidavit, stating in relevant part: "I worked with Mormon Match members to design a logo for the business." (Exhibit L to Rao Decl.; [Texas Proceeding Dkt. 30-9 at ¶ 39]).

Eller made these statements to respond to IRI's spurious allegations of perjury, not to educate IRI in the intricacies of Eller's business formation. Yet IRI now grasps at this fact in a desperate attempt to manufacture a technical circumvention of Eller's Motion to Dismiss. At the time of application, the business was a d/b/a of Eller, and Eller's application is entirely proper. It is not void ab initio, as IRI imagines.

This Board should deny IRI's motions to amend its pleading and to get a second extension of its time to respond to Eller's Motion to Dismiss. If the Board wishes to allow IRI a chance to pursue its newly-minted claim to void registration, at a minimum, this Board should deny IRI's attempt to re-plead its other claims as futile, and should decide Eller's motion on those claims.

ARGUMENT

POINT I

THE BOARD SHOULD DENY AMENDMENT OF IRI'S CLAIMS RELATING TO "MORMON" AS FUTILE AND CONTRARY TO SETTLED LAW

It is well settled that amendments that are so legally insufficient as to be futile should not be granted. *Zanella Ltd. v. Nordstrom Inc.*, 90 USPQ2d 1758, 1759 (TTAB 2008); *Media Online Inc. v. El Clasificado Inc.*, 88 USPQ2d 1285, 1286 (TTAB 2008); *Enter. Rent-A-Car Co. v. Advantage Rent-A-Car Inc.*, 62 U.S.P.Q.2d 1857 (TTAB 2002) (amendment denied as futile); *Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 221 U.S.P.Q. 151, 154 (TTAB 1983) (denying opposer leave to amend where proposed claim was baseless and amendment "would serve no useful purpose"), *aff'd*, 739 F.2d 624 (Fed. Cir. 1984). Where claims are contrary to settled law, amendment is futile. *Commodore Elecs. Ltd. v. CBM Kabushiki Kaisha*, 26 U.S.P.Q.2d 1503 (T.T.A.B. 1993); *U.S. Olympic Comm. v. O-M Bread, Inc.* 26 U.S.P.Q.2d 1221 (T.T.A.B. 1993).

Here, the Opposition requires a fatally flawed assumption that IRI "owns" the descriptive word "Mormon" in online dating. No pleading based on this demonstrably false assertion survives a motion to dismiss, and therefore amendment is futile. *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1755 (Fed. Cir. 1998); *Otto Int'l Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861, 1862 (TTAB 2007); *Ashcroft v. Iqbal*, 556 U.S. 662, 129 S. Ct. 1937, 1949-50 (2009), citing *Bell Atlantic Corp. v. Twombly*, 550 U.S. 554, 555-556 (2007).

A recent April 23, 2012 office action denying registration of "THE MORMON MATCHMAKER" for online dating is illustrative. It states "Mormon" is

merely descriptive for online dating⁴ (there the applicant disclaimed “MATCHMAKER”) because: “Mormon” as “an intended user or group of users of a product or service is merely descriptive.” (Exhibit M to Rao Decl.) *citing In re Planalytics, Inc.*, 70 USPQ2d 1453 (TTAB 2004) (GASBUYER merely descriptive for pricing and purchasing natural gas); *In re Camel Mfg. Co.*, 222 USPQ 1031 (TTAB 1984) (MOUNTAIN CAMPER merely descriptive of services for outdoor equipment and apparel). Trademark law embodies a policy that “[b]usinesses and competitors should be free to use descriptive language . . . in advertising and marketing materials.” *In re Styleclick.com Inc.*, 58 USPQ2d 1523, 1527 (TTAB 2001). Because “Mormon” is merely descriptive for online dating, it cannot be owned and IRI’s motion to amend should be denied as futile.

POINT II

**IRI LACKS STANDING TO PROSECUTE AN OPPOSITION
AND THE BOARD SHOULD DENY ITS MOTIONS**

IRI lacks standing because it fails to show “real interest” in this proceeding. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Yamaha Int’l Corp. v. Hoshino Gakki Co., Ltd.*, 231 USPQ 926, 931 (TTAB 1986) (holding standing “is an essential element”), *aff’d*, 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988). Standing requires a “reasonable” belief that one will be damaged by the registration and a “real interest” in the case. Subjective belief is not enough. *Ritchie*, 50 USPQ2d at 1027, *citing, Universal Oil Products v. Rexall Drug & Chemical Co.*, 463 F.2d 1122, 174 USPQ 458, 459-60 (CCPA 1972). Here, IRI fails to plead facts supporting any such reasonable belief or real interest in the case.

⁴ This examiner opinion applies settled law to substantially the same facts, and should be considered highly indicative of the result of applying trademark law to the facts here.

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Simply using the internet would allow anyone to see there are many dating websites that feature “Mormon” in their logos, domains, and branding, including:

Name	Logo
The Mormon Matchmaker themormonmatchmaker.com	
Meet Mormon Singles meetmormonsingles.com	
Local Mormon Singles localmormonsingles.com	
Mormon Matchmaking mormonmatchmaking.com	
My Mormon Crush mymormoncrush.com	

IRI is unable to allege any damage from registration of Eller’s Logo when numerous “Mormon” logos are already used in commerce for online dating. Further, IRI admits that neither it nor the Church offers dating services. (Rao Decl. Ex. J at p. 9). Accordingly, IRI lacks reasonable belief that it will be damaged, any real interest in the proceeding, and does not have standing.

This Board has held an opposer lacks standing even where “there has been identification of a previously used, nearly identical mark on goods which clearly overlap those of applicant” simply because nothing connected “opposer with use of that mark in a way that demonstrates its commercial stake or ‘real interest’ in precluding registration to

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applicant and, by virtue thereof, the reasonableness of opposer’s belief or apprehension that it might be damaged by registration of applicant’s mark.” *Compuclean Marketing and Design v. Berkshire Products Inc.*, 1 USPQ2d 1323, 1324–25 (TTAB 1986). IRI has not alleged a nearly identical mark on goods overlapping Eller’s, *nor* has it alleged anything connecting IRI with use of marks in online dating. In fact, IRI admits it does not use marks in online dating. Accordingly, “although the threshold for determining standing generally is quite low, [IRI] has failed to clear it in this case.” *Nobelle.com LLC v. Quest Communications Int’l Inc.*, 66 USPQ2d 1300, 1304 (TTAB 2003).

POINT III

THE BOARD SHOULD DENY IRI’S ATTEMPT TO ADD A NEW CLAIM

After failing to get broad U.S. trademark registration over the descriptive term “Mormon,” IRI now wants to litigate its way into rights it does not have. IRI’s newly-minted claim that Eller did not intend to use the Logo in commerce is false and simply a delay tactic to avoid an adverse ruling on the Motion to Dismiss. Rather than continue to waste the Board’s and Eller’s time with frivolous arguments, IRI should have responded to the Motion to Dismiss or admitted it does not own descriptive language.

Here, IRI’s speculations are incorrect. *On the application filing date*, Eller was entitled to use the Logo in commerce and had a bona fide intention to use the mark in commerce, meeting the necessary requirements. 15 U.S.C. §§1051(b)(3)(A), 1051(b)(3)(B), 1126(d)(2), and 1126(e). Thus amendment is futile and will only result in discovery and judicial resources spent on spurious and false allegations. *Enter. Rent-A-Car Co.*, 62 U.S.P.Q.2d 1857; *Pure Gold, Inc*, 221 U.S.P.Q. at 154, *aff’d*, 739 F.2d 624; *Commodore Elecs. Ltd.*, 26 U.S.P.Q.2d 1503; *U.S. Olympic Comm.*, 26 U.S.P.Q.2d 1221.

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More troublingly, IRI lacks standing to prosecute its Opposition. As a mere intermeddler, IRI should not be allowed to inject further claims into a proceeding it has no legal right to prosecute.

IRI attempts to justify its eleventh hour requests by citing the inapposite case *Am Forests v. Sanders*, 54 USPQ2d 1869 1864 (TTAB 1999), *aff'd* 232 F.2d 907 (Fed Cir. 2000). Setting aside that there was nothing improper about Eller applying as an individual here, in *Sanders*, “the Board partly relied on Sanders’ lack of involvement in the ‘business’ and her general lack of knowledge concerning the product,” when it sustained the challenge to registration. *Sanders*, 232 F.2d at 907. That case is clearly distinguishable from the facts here where Eller is the architect of the business and his photograph and a message addressed from him appear on the Dating Website.

At a minimum, if the Board wants to entertain IRI’s newly conceived theory, it should only grant amendment as to that theory and decide Eller’s motion to dismiss IRI’s existing claims. IRI should not be permitted to make specious amendments to its opposition as a delay tactic.

POINT IV

**THE BOARD SHOULD DENY IRI’S MOTION TO EXTEND TIME
AND TREAT ELLER’S MOTION TO DISMISS AS UNOPPOSED**

Eller filed a motion to dismiss on April 5, 2014. IRI has now had over a month to respond to this motion. Despite already seeking and obtaining an extension of time, IRI failed to respond to the motion to dismiss on May 9, 2014 as it was ordered to do. Instead, the day before its response was due, IRI sought a second extension of time.

The Board did not grant IRI additional time, and IRI simply failed to respond. This is inexcusable and unexplained. As IRI is no doubt aware, a “brief in

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response to a motion, must be filed within 15 days from the date of service of the motion unless another time is specified by the Board; or the time is extended by stipulation of the parties approved by the Board” Trademark Board Procedure Manual 502.02(b). Here a stipulation approved by the Board extended IRI’s time to respond to May 9, 2014. IRI did not respond by this deadline.

IRI was aware of its allegedly new claim for at least a week before it sought any extension of time or brought the issue to the Board’s attention. This Board should not grant IRI’s eleventh hour requests for more time to respond to a motion filed and served over a month ago, especially where that deadline came and passed without any response from IRI.

IRI inexcusably failed to respond to Eller’s motion to dismiss. Its motion to extend time should be denied and the motion should be decided as unopposed.

CONCLUSION

For each and every one of the reasons herein, Applicant Jonathan Eller respectfully requests the Board deny IRI's motions to amend its opposition and get a second extension of its time to respond to Eller's Motion to Dismiss. To the extent the Board wishes to entertain IRI's newly-minted and demonstrably false theories about registration, the Board should at a minimum deny IRI's motion for futile amendment of its original claims. Finally, the Board should not indulge IRI's delay tactics and should decide Eller's Motion to Dismiss.

Respectfully submitted,

 /Siddartha Rao/
Siddartha Rao, Esq.
Counsel for Applicant
121 E. 12th St. Apt. LG
New York, New York 10003
(646) 221 1846
srao@dateamormon.com

5. IRI did not respond to the March 19th letter.
6. Annexed hereto as **Exhibit D** is a true and accurate copy of a March 21, 2014 email to IRI’s counsel again sending the March 19th letter.
7. IRI did not respond to the March 21 email.
8. Annexed hereto as **Exhibit E** is a true and accurate copy of a letter dated March 26, 2104 to IRI’s counsel sent by mail and electronic mail, again seeking settlement.
9. IRI did not respond to the March 26th letter.
10. On April 2, 2014, as counsel for Applicant I called and left a voicemail with attorney Dale Hulse, counsel for IRI.
11. IRI did not respond.
12. Annexed hereto as **Exhibit F** is a true and accurate copy of a demand sent by IRI’s lawyers dated April 4, 2014.
13. Annexed hereto as **Exhibit G** is a true and accurate copy of a letter from Eller’s lawyer dated April 4, 2014.
14. Annexed hereto as **Exhibit H** is a true and accurate copy of a memorandum of law filed in a proceeding in the Southern District of Texas captioned *Eller and Mormon Match, LLC v. Intellectual Reserve, Inc.*, 4:14-cv-00914 (S.D. Tex. 2014) (the “Texas Proceeding”)
15. Annexed hereto as **Exhibit I** is a true and accurate copy of an answer and counterclaims filed by IRI in the Texas proceeding.
16. Annexed hereto as **Exhibit J** is a true and accurate copy of a memorandum of law in opposition filed by IRI in the Texas proceeding.

17. Annexed hereto as **Exhibit K** is a true and accurate copy of a reply memorandum of law filed in in the Texas proceeding.

18. Annexed hereto as **Exhibit L** is a true and accurate copy of an affidavit filed in the Texas proceeding.

19. Annexed hereto as **Exhibit M** is a true and accurate copy of an April 23, 2012 office action concerning registration of “THE MORMON MATCHMAKER.”

I declare under penalties of perjury that the foregoing is true and correct.

May 11, 2014

/Siddartha Rao/
Siddartha Rao, Esq.

Exhibit A



[urts](#)
 [Property Records](#)
 [Personal Records](#)
 [Other](#)

Assumed Names - January 1978 to present

File No.:	<input type="text"/>	<input type="button" value="Search"/>		
<input type="radio"/> Business Owner	<input type="text" value="Eller Jonathan"/>	<input type="button" value="Search"/>	<input type="button" value="Clear"/>	1 Record(s) Found.
Date:	<input type="text" value="YYYYMMDD"/>	<input type="button" value="Search"/>		

File Number	Term	Business Name and Address	Owner Name(s) and Address(es)	Status Type Date	Pgs	Film Code
V111911	10	MORMON MATCH 18630 MINDEN OAKS DRIVE SPRING TX 77388	ELLER JONATHAN 18630 MINDEN OAKS DRIVE SPRING TX 77388	Unincorporated 20130613	1	242832805

Exhibit B



Office of the Secretary of State

April 23, 2014

Attn: Mormon Match

Mormon Match
4008 Louetta Road #348
Spring, TX 77388 USA

RE: Mormon Match, LLC
File Number: 801975154

It has been our pleasure to file the certificate of formation and issue the enclosed certificate of filing evidencing the existence of the newly created domestic limited liability company (llc).

Unless exempted, the entity formed is subject to state tax laws, including franchise tax laws. Shortly, the Comptroller of Public Accounts will be contacting the entity at its registered office for information that will assist the Comptroller in setting up the franchise tax account for the entity. Information about franchise tax, and contact information for the Comptroller's office, is available on their web site at <http://window.state.tx.us/taxinfo/franchise/index.html>.

The entity formed does not file annual reports with the Secretary of State. Documents will be filed with the Secretary of State if the entity needs to amend one of the provisions in its certificate of formation. It is important for the entity to continuously maintain a registered agent and office in Texas. Failure to maintain an agent or office or file a change to the information in Texas may result in the involuntary termination of the entity.

If we can be of further service at any time, please let us know.

Sincerely,

Corporations Section
Business & Public Filings Division
(512) 463-5555

Enclosure



Office of the Secretary of State

CERTIFICATE OF FILING OF

Mormon Match, LLC
File Number: 801975154

The undersigned, as Secretary of State of Texas, hereby certifies that a Certificate of Formation for the above named Domestic Limited Liability Company (LLC) has been received in this office and has been found to conform to the applicable provisions of law.

ACCORDINGLY, the undersigned, as Secretary of State, and by virtue of the authority vested in the secretary by law, hereby issues this certificate evidencing filing effective on the date shown below.

The issuance of this certificate does not authorize the use of a name in this state in violation of the rights of another under the federal Trademark Act of 1946, the Texas trademark law, the Assumed Business or Professional Name Act, or the common law.

Dated: 04/21/2014

Effective: 04/21/2014



NANDITA BERRY

Nandita Berry
Secretary of State

Exhibit C

MormonMatch

18630 MINDEN OAKS DRIVE | SPRING, TEXAS 77388 | www.dateamormon.com

March 19, 2014

BY FIRST CLASS MAIL AND EMAIL

Dale E. Hulse
Counsel for Intellectual Reserve Inc.
KIRTON McCONKIE
1800 World Trade Center at
City Creek, 60 East South Temple
Salt Lake City, UT 84111
dhulse@kmclaw.com

Re: Notice of Opposition No. 9121564 Opposing Mormon Match Application

Dear Mr. Hulse,

I write as counsel for the de facto partnership Mormon Match (“Mormon Match”) regarding application serial No. 85/949,670 (the “Application”) for registration of the mark “MORMON MATCH (and Design)” (the “Trademark”).¹ The Application is not a standard character application and claims design and other elements for the Trademark.²

As stated in the Application, Mormon Match will use the Trademark to deliver “Internet-based dating, social introduction and social networking services,” via its website (the “Dating Website”). These services are not associated with The Church of Jesus Christ of Latter-day Saints (the “Church of Jesus Christ” or the “Church”), which is a religious organization.

We are in receipt of the Notice of Opposition in proceeding No. 91215064 (the “Opposition”) you filed for Intellectual Reserve, Inc. The Opposition speculates that the Trademark may confuse the public into thinking the Church of Jesus Christ operates the Dating Website. To our knowledge and upon reasonable investigation, the Church of Jesus Christ has not operated a commercial dating website or service in its nearly one hundred and eighty-four years of existence. Moreover, none of the

¹ Jonathan Eller, the Trademark applicant, is at present a founder and de facto partner of Mormon Match and will shortly be a member of Mormon Match, LLC.

² The notice contains the disclaimer “No claim is made to the exclusive right to use ‘MORMON MATCH’ apart from the mark as shown.” See Trademark Official Gazette (October 29, 2013) pp. 1404–05, available at: http://www.uspto.gov/web/trademarks/tmog/20131029_OG.pdf.

trademarks referenced in the Opposition fall within class 45 of goods and services³ or relate to internet-based dating services like the Trademark.

Nonetheless, in light of your concerns, Mormon Match has posted a prominent notice on the Dating Website stating: "Mormon Match is not commercially affiliated with or endorsed by The Church of Jesus Christ of Latter-day Saints."⁴ In light of this, we would like to negotiate a settlement and stipulated dismissal of the Opposition with prejudice. Note that under the current schedule set by the Trademark Trial and Appeal Board, Mormon Match must file an answer to the Opposition by April 5, 2014.

Please respond and advise accordingly.

Sincerely,



Siddartha Rao, Esq.
srao@dateamormon.com
Tel: (646) 221-1846

Cc: Jonathan Eller (by email)
Matthew LaPointe (by email)

³ Indeed, trademark examiner Jill Alt repeatedly disallowed prior attempts to claim class 45 registration for "MORMON" in correspondence with attorney Michael F. Krieger of your firm about application serial number 78/161091.

⁴ See Dating Website, *available at*: www.dateamormon.com.

Exhibit D



Siddartha Rao <siddartha.rao@gmail.com>

FW: Letter Re Notice of Opposition Concerning Mormon Match Trademark

Siddartha Rao <siddartha.rao@gmail.com>

Fri, Mar 21, 2014 at 12:33 PM

To: dhulse@kmclaw.com

Cc: jeller@dateamormon.com, mlapointe@dateamormon.com

Mr. Hulse,

Please see the attached letter, sent from a different email account in the event there was an issue with receipt of our Wednesday email.

Best,

Siddartha Rao, Esq.
Mormon Match
18630 Minden Oaks Dr.
Spring, Texas 77388
www.dateamormon.com
Tel: (646) 221-1846
srao@dateamormon.com

----- Original Message -----

Subject: Letter Re Notice of Opposition Concerning Mormon Match Trademark Application

Date: 2014-03-19 18:58

From: Siddartha Rao <srao@dateamormon.com>To: "Dale E. Hulse" <dhulse@kmclaw.com>Cc: Jonathan Eller <jeller@dateamormon.com>, Matthew LaPointe <mlapointe@dateamormon.com>

Mr. Hulse,

Please see the attached correspondence.

Best,

Siddartha Rao, Esq.
Mormon Match
18630 Minden Oaks Dr.
Spring, Texas 77388
www.dateamormon.com
Tel: (646) 221-1846
srao@dateamormon.com

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 **Letter Re Mormon Match Trademark Opposition.pdf**
56K

Exhibit E



18630 MINDEN OAKS DRIVE | SPRING, TEXAS 77388 | www.dateamormon.com

March 26, 2014

BY FIRST CLASS MAIL AND EMAIL

Dale E. Hulse
Counsel for Intellectual Reserve Inc.
Kirton McConkie
1800 World Trade Center at
City Creek, 60 East South Temple
Salt Lake City, UT 84111
dhulse@kmclaw.com

Re: Notice of Opposition No. 9121564 Opposing Mormon Match Application

Dear Mr. Hulse,

We have received no response or acknowledgment of receipt of our letter dated March 19, 2014, regarding Notice of Opposition in proceeding No. 91215064 (the "Opposition") to application serial No. 85/949,670 (the "Application") for registration of the mark "MORMON MATCH (and Design)" (the "Trademark").¹ In that letter, we offered to open settlement negotiations and indicated we must file an answer to your Opposition by April 5, 2014. We again suggest you consider our offer before we file an answer to the demonstrably frivolous Opposition.

Please note that two founders of Mormon Match, Jonathan Eller and Matthew LaPointe, are Latter-day Saints and are active recommended members in full fellowship.² Their company's purpose is to facilitate online dating and social introductions between Latter-day Saints via their website.³ This purpose directly and materially aids the Church by creating stronger ties and more families in the community of Latter-day Saints.

¹ The Application is not a standard character application and no claim is made to the exclusive right to use "MORMON MATCH" apart from the mark as shown. Trademark Official Gazette (October 29, 2013) pp. 1404-05, *available at*: http://www.uspto.gov/web/trademarks/tmog/20131029_OG.pdf.

² Jonathan's family has been affiliated with the Church for at least five generations, and Matthew's family includes Mormon pioneers.

³ The website contains a disclaimer stating: "Mormon Match is not commercially affiliated with or endorsed by The Church of Jesus Christ of Latter-day Saints." See www.dateamormon.com.

Jonathan and Matthew have spent two years actively building Mormon Match's brand and, because of their efforts, Mormon Match is projected to have approximately 35,000 Mormon users in the next few months. They would not enjoy informing these active users that the Church insists Mormon Match not self-identify under the descriptive and generic name "Mormon," which has been descriptive of Latter-day Saints for almost two centuries. This would cause understandable bewilderment for Mormon Match's many thousands of Mormon users.⁴

You of course are familiar with the years of correspondence between attorney Michael F. Krieger of your firm and trademark examiner Jill Alt about application serial number 78/161091 that narrowly restricted trademark rights in "MORMON," and prevented you from registering MORMON in class 45 of goods and services, the class of Mormon Match's Trademark. That correspondence included findings that "MORMON" is "merely descriptive" and "appears to be generic," (Mar. 18, 2003 Office Action); "is incapable of serving as a source-identifier for [the Church's] goods and/or services," (Nov. 24, 2003 Office Action); is "refused [registration] . . . because the proposed mark is generic for applicant's services," (Jul. 10 2004 Office Action); and is "the common descriptor of a key ingredient, characteristic or feature of the goods[,] . . . generic and thus incapable of distinguishing source," (Nov 1, 2005 Office Action).

You should also know that the Church openly encourages the use of "Mormon" as a general and descriptive term for its religion and members. Its style guide states: "'Mormon' is correctly used . . . as an adjective in such expressions as 'Mormon pioneers,'" and "'Mormons' is acceptable" "[w]hen referring to Church members"⁵ On the other hand, the Church states Mormon should not be a source-identifying name for the Church: "Mormon Church . . . is not an authorized title, and the Church discourages its use."⁶ The Church also encourages the use of #mormon as a one of a few "General Hashtags" for use in "social media discussions surrounding Mormonism."⁷ Your insistence that Mormon Match not be permitted to self-identify as "Mormon" is both contrary to law and the Church's own guidance.

⁴ Trademark law cannot prevent individuals from authentically self-identifying with their own religious group, an activity protected under the First Amendment. Moreover, it is well-settled that a one "simply cannot appropriate, from the public domain, the common name of a religion and somehow gain an exclusive right to its use and the right to prevent others from using it. This principle is fundamental to the law of trademarks." *Christian Science Board of Directors v. Evans*, 520 A.2d 1347 (N.J. 1987); see also, *McDaniel et al. v. Mirza Ahmad Sohrab et al.*, 27 N.Y.S.2d 525 (1941), *aff'd* 262 A.D. 838, 29 N.Y.S.2d 509 (App.Div. 1941) (holding plaintiffs had "no right to a monopoly of the name of a religion" and dismissing complaint).

⁵ Annexed hereto and available at: www.mormonnewsroom.org/style-guide.

⁶ *Id.*

⁷ Annexed hereto and available at:

<http://www.mormonnewsroom.org/article/mormon-hashtag-recommendations>.

Your client's Opposition is frivolous in light of facts provided in this letter and our prior letter of March 19, 2014. Mormon Match has already expended considerable time and effort in these correspondences providing facts known to your client or available through ordinary diligence. It would prefer not to draw attention to your client's trademark bullying in pursuit of a frivolous Opposition by filing an answer.⁸ We ask that you reconsider your insistence on pursuing this Opposition.

Please be advised accordingly.

Sincerely,



Siddartha Rao, Esq.
srao@dateamormon.com
Tel: (646) 221 1846

Cc: Jonathan Eller (by email)
Matthew LaPointe (by email)

⁸ See generally, United States Patent and Trademark Office, *Report to Congress: Trademark Litigation Tactics and Federal Government Services to Protect Trademarks and Prevent Counterfeiting*, (April 2011), available at: http://www.uspto.gov/ip/TMLitigationReport_final_2011April27.pdf.

Exhibit F



Siddartha Rao <siddartha.rao@gmail.com>

Fwd: Linode Support Ticket 3001052 - gondor (linode209791) - ToS Violation - Copyright Infringement

Jonathan Eller <joneller@hotmail.com>

Fri, Apr 4, 2014 at 2:45 PM

To: Siddartha Rao <siddartha.rao@gmail.com>, Matthew LaPointe <matt@unifiedmediallc.com>, Gordon Child <gordon.child@gmail.com>

Gents, the church demands we take it down

Jonathan Eller | Account Executive
Proofpoint, Inc
M: 281-853-5681

Sent from my iPhone

Begin forwarded message:

From: "Gordon Child" <gordon.child@gmail.com>
Date: April 4, 2014 at 1:32:07 PM CDT
To: "Jonathan Eller" <joneller@hotmail.com>
Subject: Fwd: Linode Support Ticket 3001052 - gondor (linode209791) - ToS Violation - Copyright Infringement

Hey buddy, I have to take it down.

Sent from [Mailbox](#) for iPhone

----- Forwarded message -----

From: support@linode.com <support@linode.com>
Date: Fri, Apr 4, 2014 at 12:28 PM
Subject: Linode Support Ticket 3001052 - gondor (linode209791) - ToS Violation - Copyright Infringement
To: "gordon.child@gmail.com" <gordon.child@gmail.com>

Support Ticket 3001052 regarding Linode 'gondor (linode209791)' has been updated by 'avelardi'

?VIA email to: abuse@linode.com

Linode, LLC

dba [Linode.com](http://linode.com)

329 E. Jimmie Leeds Road, Suite A Galloway, NJ 08205

April 04, 2014

RE: Trademark and unfair competition abuses at www.dateamormon.com Dear [Linode.com](http://linode.com):

We represent Intellectual Reserve, Inc. ("IRI"), an intellectual property holding company for The Church of Jesus Christ of Latter-day Saints also commonly known as the Mormon or LDS Church ("the Church"). IRI hereby requests that [Linode.com](http://linode.com) ("Linode") cancel/suspend certain pages of the website www.dateamormon.com ("Offending Website") which are in violation of the intellectual property laws of New Jersey, Utah and the United States including at least trademark and unfair competition laws. Specifically, the web pages identified below of the Offending Website should be terminated because they violate section 3 of the Linode's Terms of Service.

Background

Since at least as early as 1833, the Church and others have used the name MORMON to identify the Church and its operations. These uses give IRI and the Church century-long recognizable trademark rights in the term MORMON. Church uses of the term MORMON are also the subject of a number of trademark registrations including United States Trademark Registration No. 3,239,919, No. 3,715,744, No. 2,883,572, No. 2,766,231, No. 2,913,694, No. 1,524,555 and No. 1,527,447.

Linode.com April 04, 2014 Page 2

In 1893 the Church completed the construction of its Salt Lake City, Utah Temple ("Salt Lake Temple"):

The Salt Lake City, Utah Temple

Images of the unique and distinctive construction of the Salt Lake Temple have also become recognizable icons and identifiers of the Church and its operations. Images of the Salt Lake Temple are also the subject of a number of trademark registrations including United States Trademark Registration No. 4,323,142, No. 2,552,030 and No. 2,057,540.

The Church has used and continues to use the name MORMON and images of the Salt Lake Temple to introduce itself and its members to others on the Church's internet and social network pages including Mormon.org, Mormonchannel.org, LDS.org, Facebook, Twitter, YouTube, Google+ and related Apps.

The term MORMON and images of the Salt Lake Temple are famous icons used to uniquely identify the Church and its operations. These unique identifiers are owned by IRI. IRI has not given the owners of www.dateamormon.com permission to use the term MORMON or any image of the Salt Lake Temple to introduce itself or its members to others on its internet site and social networking pages.

????????????????????????????????????

Linode.com April 04, 2014 Page 3

Pages of the Offending Website should be removed from www.dateamormon.com The Offending Website violates Linode's Term of Service. In this regard, section 3 of Linode's Terms of Service expressly lists "Prohibited Usage" which "will result in immediate account suspension or cancellation." Improper conditions of use are prohibited of each customer of Linode including www.dateamormon.com:

Linode and the services it provides may only be used for lawful purposes. Transmission, distribution, or storage of any information, data or material in violation of United States or state regulation or law, or by the common law, is prohibited. This includes, but is not limited to, material protected by copyright, trademark, trade secret, or other intellectual property rights.

Linode.com's services may not be used to facilitate infringement of these laws in any way. Linode's Terms of Service, section 3.

Without authorization from IRI, the Offending Website's use of the term MORMON and an image of the Salt Lake Temple in a branding fashion constitute trademark and/or trade name Home page of www.dateamormon.com infringement under the laws of at least New Jersey, Utah and the United States.

????????????????????????????????????

Linode.com April 04, 2014 Page 4

In addition, misleading representations about association, sponsorship, origin or affiliation and trademark infringement are examples of unlawful unfair competition. For example, the unfair competition laws of the United States, 15 U.S.C. 1125(a), establish that the Offending Website is carrying on unlawful activity:

(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities, shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act. 15 U.S.C. 1125 (a)(1).

Again, without authorization from IRI the Offending Website's use of the term MORMON and/or an image of the Salt Lake Temple constitute unfair competition by improperly suggesting affiliation, connection or association with the Church.

Furthermore, the Offending Website uses the MORMON name and an image of the Salt Lake Temple to direct traffic to its Facebook page and Twitter page which promote products, services, personalities, trends and news of third parties completely unaffiliated or unassociated with IRI or the Church. This intentional misuse of IRI's intellectual property must be terminated at www.dateamormon.com.

Pages of the Offending Website violate Linode's Terms of Service by infringing on a uniquely identifying trademark owned by IRI and by unfairly using an image uniquely associated with the Church. Therefore, IRI requests that the following pages of the Offending Website be removed, namely:

www.dateamormon.com www.dateamormon.com/faq www.dateamormon.com/volunteer
?????

Linode.com April 04, 2014 Page 5

The content of these pages of the Offending Website violates provisions of the Linode's Terms of Service, including section 3, and includes activity deemed unlawful by State and United States' law. In light of each of these violations IRI requests that Linode promptly terminate the above identified pages of the Offending Website www.dateamormon.com.

????KIRTON M
MCCONKIE
E
????TODD E. Z
ZENGER

Please use <https://manager.linode.com/support/ticket/3001052> to respond to this ticket.

Thank you,
Linode.com

Exhibit G

Linode, LLC
dba Linode.com
329 E. Jimmie Leeds Road, Suite A
Galloway, NJ 08205
April 04, 2014

Re: Intellectual Reserve, Inc.'s extrajudicial attempt to shut down Mormon Match and prevent it from litigating its claims

Dear Linode,

I am an attorney representing the de facto partnership Mormon Match. Mormon Match was formed to run a dating website for Mormons (www.dateamormon.com). The company has spent two years building its brand in the Mormon community and acquiring thousands of pre-launch users. They are about to launch.

I understand you are in receipt of a notice purporting to be a takedown notice under the Digital Millennium Copyright Act ("DMCA") from attorney Todd Zenger at Kirton McConkie. The notice was sent on behalf of Intellectual Reserve, Inc. ("IRI"). Based on that notice you have instructed Gordon Child, who is hosting Mormon Match's site, to remove the site. The purported DMCA notice is not a DMCA notice and is deficient because it does not describe or allege any copyright infringement. Therefore, it does not obligate you or us to remove any content from the site under the DMCA. See DMCA Section 512(c) (providing liability for "infringement of *copyright*") (emphasis added).

We are sending this counter notice as a reservation of rights in the event you choose to remove our content. Please note that such removal would be unauthorized.

In compliance with 17 U.S.C. § 512(g)(3), Mormon Match states the following. Mormon Match, understands that attorney Zenger asserts, contrary to numerous legal findings, that all use of "Mormon" for promotion is trademark infringement. Therefore, the material he seeks removed would be the entire site, since the site dateamormon.com itself incorporates the word "Mormon." Further, Mormon Match represents that it has a good faith belief that any material removed or disabled would be removed or disabled as a result of mistake or misidentification of the material to be removed or disabled, insofar as its use of "Mormon" does not infringe any intellectual property of IRI.

For context, last year, Mormon Match applied for a trademark in a design features stick figures of a man and a woman holding hands under the "M" of the word "Mormon" in blue, on top of the word "Match" in gold. Mormon Match's application does not seek ownership of the words "Mormon Match" outside of this design.

IRI opposed the application in February of this year, claiming "all right, title, and interest" to the mark "Mormon." IRI insists nobody else can use "Mormon" in any trademark or promotional manner. That Opposition is utterly frivolous. Because IRI refused to respond to our letters and calls seeking a settlement, we filed a motion to

dismiss today contesting all of IRI's claims. We believe the Trademark Board will find in our favor and dismiss the frivolous Opposition

Indeed, the Trademark Board has already found on numerous occasions that the word "Mormon" cannot obtain broad trademark rights because it is generic and descriptive. Many of these proceedings were proceedings by IRI, using Kirton McConkie as counsel.

Attorney Todd Zenger knows or should know of this proceeding because it was *commenced by his firm*, Kirton McConkie. He of course knows that Trademark Board has not yet decided the issues that could conclusively disprove his speculation of trademark infringement. IRI is attempting to shut down the company and prevent it from exercising its rights or having its day in court, before there is even a chance for the trademark judge to make a decision.

Mormon Match is not removing anything from its site at this time and is merely sending this counter-notice to reserve its rights. As counsel for Mormon Match, I submit on behalf of Mormon Match to the jurisdiction of the Federal District Court for the Southern District of New York, which is the Federal District where I live. Mormon Match will accept service of process from the person who provided notification (IRI) or an agent of such person.

Sincerely,

Electronic Signature: /Siddartha Rao/
Name: Siddartha Rao, Esq.
Address: 121 E. 12th St. Apt. LG
New York, New York 10003
Telephone Number: (646) 221 1846
Email: srao@dateamormon.com

Exhibit H

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF TEXAS
HOUSTON DIVISION

JONATHAN ELLER, as partner of
the de facto partnership, Mormon Match,

Plaintiff,

v.

INTELLECTUAL RESERVE, INC.,
a Utah Corporation, holding intellectual
property for The Church of Jesus Christ
of Latter-day Saints,

Defendant.

CIVIL ACTION NO.:

**MEMORANDUM OF LAW IN SUPPORT OF *EX PARTE* MOTION FOR
TEMPORARY RESTRAINING ORDER AND PRELIMINARY INJUNCTION**

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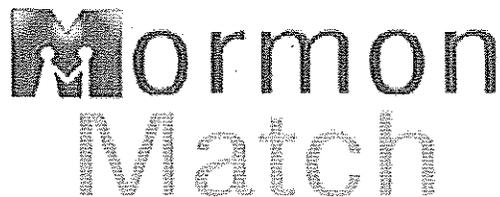
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PRELIMINARY STATEMENT

The issue here is narrow: whether the mere word “Mormon” and an image of a Mormon Temple is infringing when used to advertise a Mormon dating website. This Court is likely familiar with the rise and popularity of online dating and social networking. Examples of religiously themed dating websites include: Christian Mingle, Muslim & Single, Catholic Match, Jewish Friend Finder, JDate, LDSSingles, and LDSDateMate. Plaintiff Jonathan Eller is a Mormon and partner of Mormon Match. He and Mormon business partner Matthew LaPointe are building a dating site for Mormons at www.dateamormon.com, which they own. This site went live on June 16, 2013, although it has not launched. The site states: “Mormon Match is not commercially affiliated with or endorsed by The Church of Jesus Christ of Latter-day Saints.”

Since going live, the website has shown a background Mormon Temple photo and displayed the site’s logo depicting man and woman stick figures holding hands



On June 3, 2013, Jonathan filed an application to trademark the logo for “Internet-based dating, social introduction, and social networking services.” He only seeks registration of the design, and not the words. On February 4, 2014, Intellectual Reserve, Inc. (“IRI”) commenced a proceeding before the Trademark Trial and Appeal Board (the “Board”) opposing registration of this logo. IRI asserted it owns all “right, title, and interest” to the

word “Mormon,” an apparently unregistered common law mark IRI imagines is protected for a “variety of goods and services.” Not content to simply delay registration, last Friday, the day before Jonathan’s deadline to answer IRI’s opposition, IRI demanded Jonathan’s web-hosting company shut down his website because it displays the word “Mormon” which it purports to own. Jonathan narrowly escaped a website shut down after a plea from counsel and the web-hosting company’s decision to wait.

For the past two years, Jonathan has worked strenuously to build and promote Mormon Match. Because of these efforts, Mormon Match currently has active campaigns on all of the major social media sites, an active mail server with tens of thousands of opt-in email addresses, business cards and flyers, and more than thirty active volunteers in more than seven countries, helping promote Mormon Match to their Mormon friends and colleagues. Jonathan wants to fully launch in the next two months. However, IRI now asserts Jonathan is prohibited from using the word “Mormon” or images relating to Mormonism to advertise his Mormon dating website.

The timing of IRI’s attempt to shut down Jonathan’s website strongly suggest an improper litigation tactic.¹ Jonathan has displayed the allegedly unlawful logo and image on his website since June of last year, and has been actively and openly promoting Mormon Match in the online Mormon community for two years. Yet IRI picked the day before Jonathan’s answer was due in the Board proceeding to demand the website be put out of operation. This is an apparent strategy is to silence Jonathan by irreparably harming his business so that he is unable to defend claims before the Board. The Board has not yet addressed IRI’s claims or Jonathan’s pending motion to dismiss.

¹ A server shut down would have barred Mormon Match’s business partners and counsel access to all prior email communications the day before a response was due.

Accordingly, Plaintiff filed this action seeking a preliminary injunction and declaratory judgment of non-infringement and also brings an order to show cause, seeking a temporary restraining order against further interference with his dating website.

BACKGROUND AND FACTS RELATING TO BOARD PROCEEDING

On March 19, 2014, Mormon Match sent a letter through counsel by email and first class mail to attorney Dale Hulse at Kirton McConkie, IRI's counsel. That letter stated Mormon Match's time to answer IRI's opposition was April 5, 2014. It also expressed Mormon Match's view that IRI's assertions in the Board proceeding were meritless but nonetheless stated "we would like to negotiate a settlement." IRI did not respond. On March 21, Mormon Match resent the letter from a different email account to confirm receipt. IRI did not respond. On March 26, Mormon Match sent a follow up letter. That letter also reiterated the April 5, 2014 answer date. It further cited trademark examiner findings that previously prevented IRI from trademarking "MORMON" for class 45 "religious services," namely that "MORMON" is "merely descriptive," "appears to be generic," "is incapable of serving as a source-identifier for [the Church's] goods and/or services," is "refused [registration] . . . because the proposed mark is generic for applicant's services," and is "the common descriptor of a key ingredient, characteristic or feature of the goods[,] . . . generic and thus incapable of distinguishing source." The letter again sought settlement. IRI did not respond. Mormon Match's counsel then called opposing counsel Hulse on April 2, 2014, and left a voicemail. IRI did not respond. Instead, on April 4, 2014, the day before Plaintiff's response was due in the Board proceeding, Todd Zenger, another Kirton McConkie attorney, sent a demand to Mormon Match's web-hosting service demanding it shut down the dating website.

ARGUMENT

**THIS COURT SHOULD ISSUE A TEMPORARY
RESTRAINING ORDER AND PRELIMINARY INJUNCTION**

Plaintiff should be granted a temporary restraining order here because he demonstrates: (1) a substantial likelihood of success on the merits; (2) a substantial threat of irreparable injury if an injunction is denied; (3) the balance of equities favors Plaintiff; and (4) the injunction advances the public interest. *See, Planned Parenthood of Houston & Southeast Tex. v. Sanchez*, 403 F.3d 324, 329 (5th Cir. 2005); *Knights of the Ku Klux Klan Realm of La. v. East Baton Rouge Parish Sch. Bd.*, 578 F.2d 1122, 1125 (5th Cir. 1978) (“Where one or more of the factors is strongly established this will ordinarily be seen as compensating for a weaker showing as to another or others.”). All the factors are satisfied here and a TRO should issue.

A. Plaintiff Establishes a Likelihood of Success on the Merits

IRI’s position rests on the untenable assertion that, in its words, the “term MORMON and images of the Salt Lake Temple . . . are owned by IRI.” IRI has no copyright ownership in this Salt Lake Temple photo appearing on Jonathan’s website. Rather, its theory is that merely because that photo is associated with Mormonism, it is an infringement for Jonathan to display it on his Mormon dating website. IRI also does not own the word “Mormon” for all purposes. They cannot own all words or images that are associated with the Church of Jesus Christ of Latter-day Saints (the “Church”) or Mormonism. It is obvious that Jonathan’s dating website for Mormons will be crippled if it cannot reference Mormonism in any way on its site or promotional materials.

1. Nobody can appropriate the name of a religion for all purposes

It has long been the law that one “simply cannot appropriate, from the

public domain, the common name of a religion and somehow gain an exclusive right to its use and the right to prevent others from using it. This principle is fundamental to the law of trademarks.” *Christian Science Board of Directors v. Evans*, 520 A.2d 1347 (N.J. 1987); see also, *McDaniel et al. v. Mirza Ahmad Sohrab et al.*, 27 N.Y.S.2d 525 (N.Y. Sup. Ct. 1941), *aff’d* 262 A.D. 838, 29 N.Y.S.2d 509 (N.Y. App.Div. 1941) (holding plaintiffs had “no right to a monopoly of the name of a religion” and dismissing complaint).

This is consistent with the general principle that some marks can “transcend their identifying purpose” and “enter public discourse and become an integral part of our vocabulary.” *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002). When they do so they “assume a role outside the bounds of trademark law.” *Id.* Moreover, “[w]here a mark assumes such cultural significance, First Amendment protections come into play.” *Id.*² In these situations, “the trademark owner does not have the right to control public discourse whenever the public imbues his mark with a meaning beyond its source-identifying function.” *Id.* Here “Mormon” has so transcended its identifying purpose that IRI cannot claim infringement as a matter of law.

Cases where trademark infringement is recognized relating to a religious name are distinguishable as nearly all involve disputes between *rival religious sects* over use of the religion’s names and symbols. See, e.g., *General Conference Corporation of*

² Indeed, IRI’s attempt to assert total ownership of “Mormon” to proscribe speech and expression concerning “Mormon” is constitutionally troubling under, *inter alia*, the First and Fourteenth Amendments rights of expression, religion, and assembly. To the extent IRI invokes state action to deprive individuals of such rights this is constitutionally impermissible. See, *Shelley v. Kraemer*, 334 U.S. 1 (1948) (holding court barred from enforcement of private contract as enforcement invokes state action to effect unconstitutional discrimination).

Seventh Day Adventists v. McGill, 2008 U.S. Dist. LEXIS 45526 (W.D.TN., June 11, 2008) (trademark infringement suit by Seventh Day Adventist Church against a break away pastor of a three-member church called “A Creation Seventh Day & Adventist Church”).

The issue here is much closer to that decided in *Gen. Conference Corp. of Seventh-Day Adventist v. Seventh-Day Adventist Kinship, Int'l, Inc.*, No. CV 87-8113, 1991 WL 11000345, at *6-7 (C.D.Cal. Oct.7, 1991). There, the court held that a company which runs a website for gay and lesbian Seventh Day Adventists, could use the trademarked term “Seventh Day Adventist” “as a matter of law” because, like “Mormon,” the trademarked “Seventh Day Adventist” also refers to adherents of a religion. *Id.* See also, *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), *aff'g* 213 USPQ 594 (TTAB 1982) (dismissing opposition of “NOTRE DAME (and Design)” as applied to cheese because “'Notre Dame' is not a name solely associated with the University. It serves to identify a famous and sacred religious figure and is used in the names of churches dedicated to Notre Dame, such as the Cathedral of Notre Dame in Paris, France.”)

2. Trademark examiner findings contradict IRI’s assertions of complete ownership of “Mormon”

Here, IRI’s existing trademarks that use the word “Mormon” have been restricted to narrow categories of goods and services because trademark examiners have repeatedly found “Mormon” generic and descriptive in registration proceedings by IRI.

For example, concerning application serial number 78/161091, the examiner repeatedly denied registration because “MORMON” is “merely descriptive” and “appears to be generic,” (Mar. 18, 2003 Office Action); “is incapable of serving as a

source-identifier for [the Church's] goods and/or services," (Nov. 24, 2003 Office Action); is "generic for applicant's services," (Jul. 10 2004 Office Action); and is "the common descriptor of a key ingredient, characteristic or feature of the goods[,] . . . generic and thus incapable of distinguishing source," (Nov 1, 2005 Office Action). Ultimately, IRI abandoned its application for "MORMON" for class 45 religious services after an appeal of the examining attorney's final refusal. Similarly, in connection with IRI's attempt to trademark "MORMON.ORG," serial number 77/179068, the examiner initially refused registration because the mark is "merely descriptive because it consists of the merely descriptive wording "Mormon" for the subject matter of its services . . . combined with the top-level domain (TLD) '.ORG,'" (August 27, 2007 Office Action); and "arguments that the proposed mark as a whole is not merely descriptive of the services in issue, fail [because] . . . [t]he proposed mark clearly describes the religion that is the subject mater of these services," (March 16, 2008 Office Action).

IRI's claim to exercises total control over the word "Mormon" is completely belied by these examiners' repeated refusals to allow broad trademark protection for Mormon. IRI was a party to these proceedings and should understand that if in fact, "Mormon" had such broad protection as to prevent all others from using it in describing unrelated goods and services, then the examiners would not have gone to such pains to repeatedly tell IRI that Mormon is too generic and/or descriptive to be broadly trademarked.

3. Any possible infringement claim fails for statutory fair use

Even if, somehow, IRI could assert strong trademark rights in "Mormon" and a support a claim confusion to at a bare minimum actually state a claim for

infringement (it can not), the claim would fail on the affirmative defense of statutory fair use under 15 U.S.C. § 1115(b)(4). That section allows “the use of the name, term, or device charged to be an infringement” “otherwise than as a mark” “which is descriptive of and used fairly and in good faith only to describe the goods or services.” It is fair use to use the word Mormon to mean “Latter-day Saint,” which is its primary and ordinarily understood meaning.³ Here, Mormon Match’s founder and lead developer are Latter-day Saints, or Mormons, and Mormon Match’s target customers are Latter-day Saints, or Mormons. Thus, use of “Mormon” on the site to mean “Latter-day Saint” is fair use.

The statutory fair use defense was created to let third parties accurately describe their goods. Because the use is "otherwise than as a mark," the "fair use" of someone else's trademark in this manner should not be likely to cause confusion, and in any event, a showing of confusion does not bar the defense of fair use. *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004); see also, *Wonder Labs, Inc. v. Proctor & Gamble Co.*, 728 F. Supp. 1058 (S.D.N.Y. 1990) (defendant’s use of “Dentist’s Choice” prominently in his advertisements was not infringement of the mark “DENTIST’S CHOICE” because defendant was using the words not as a mark but in their ordinarily understood meaning.”)

The case of *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786 (5th Cir. 1983) is instructive. There, the plaintiff had a federal trademark registration for FISH-FRI for a corn flour product used to batter fish for frying purposes. The district court deemed defendant's use of "Fish Fry" a fair use of the term under the statute. In

³ See OXFORD ENGLISH DICTIONARY (3d ed. 2002) (providing definitions of “Mormon,” the first being “A member or adherent of the Church of Jesus Christ of Latter-day Saints, a millenary Christian sect founded in 1830 at Manchester, New York, by Joseph Smith”).

affirming, the Fifth Circuit highlighted the defendant's good faith, in that it had not used the term in a trademark sense, and had never attempted to register the words. (Here plaintiff's application expressly disclaims the words. It is an application for a design). The court also noted "[t]he dissimilarity of trade dress" between defendant's products and plaintiff's. 698 F.2d at 796. In that regard, here, Mormon Match's design is completely different in look and impression from IRI's marks as can be seen by the chart below:

Design Mark (Class 45)	(Alleged) Mark cited in Opposition	Type
	"MORMON"	Unregistered ("variety" of unspecified goods and services)
	"MORMON"	Word (Class 41 and 42) (Registered 5/8/2007)
	MORMON.ORG	Word/Design (Class 41) (Registered 11/24/2009)
	BOOK OF MORMON	Word/Design (Class 9 and 16) (Registered 9/14/2004)
	MORMON TABERNACLE CHOIR	Word/Design (Class 9 and 41) (Registered 9/23/2003)

		Word/Design (Class 9 and 16) (Registered 12/21/2004)
	“MORMON HANDICRAFT”	Word (Class 24) (Registered 2/14/1989)
	“MORMON HANDICRAFT”	Word (Class 42) (Registered 2/28/1989)

Therefore, even if IRI could actually state facts supporting trademark or trade dress infringement, fair use is a bar to such a claim. *Car Freshener Corp. v. S.C. Johnson & Son, Inc.*, 70 F.3d 267 (2d Cir. 1995) (fair use applies to trade dress).

Accordingly, Plaintiff is likely to succeed on the merits. IRI’s assertions of ownership of “Mormon” and infringement are patently meritless.

B. Plaintiff Will Sufferable Irreparable Harm Absent Relief

It is well-settled that loss of customers and business reputation can constitute an irreparable injury. For example, in *Med. Shoppe Int’l, Inc. v. S.B.S. Pill Dr., Inc.*, 336 F.3d 801, 805 (8th Cir. 2003), the court affirmed a grant of preliminary injunction because forcing a defendant to change its name would constitute irreparable harm due to consumer confusion and loss of confidence. *See also, Multi-Channel TV Cable Co. v. Charlottesville Quality Cable Operating Co.*, 22 F.3d 546, 552 (4th Cir.

1994) (affirming injunction because “when the failure to grant preliminary relief creates the possibility of . . . loss of goodwill, the irreparable injury prong is satisfied.)

Here, Jonathan Eller faces more than a mere abstract or speculative loss. Jonathan has spent two years promoting his website and has engaged in outreach with thousands of Mormons to build his brand. IRI has now made explicit claims to own the word “Mormon” and threats to shut down Jonathan’s website. In order to comply with IRI’s demands, Jonathan would have to find a new business name, a new domain name, and would need to purge all references to Latter-day Saints or Mormonism in his websites and any promotional materials. This would be a total destruction of his business, his reputation, and two years of effort. These facts are supported by sworn affidavits and documentary evidence. This is not a mere speculation.

Even courts that have found loss of goodwill insufficient have gone out of their way to note that total loss of business constitutes irreparable injury. *See, e.g., Dotster, Inc. v. Internet Corp.*, 296 F.Supp.2d 1159, 1163–64 (C.D. Cal. 2003) (“credible and admissible evidence that such damage threatens Plaintiff’s business with termination” constitutes irreparable harm); *accord, Metromedia Broadcasting Corp. v. MGM/UA Entertainment Co., Inc.*, 611 F. Supp. 415, 426 (C.D. Cal. 1985). Here, IRI’s actions threaten total loss of Jonathan Eller’s business.

Accordingly, Jonathan Eller has shown he will suffer irreparable harm if a restraining order does not issue.

C. The Balance of Equities Favors Plaintiff

Here, the balance of equities favors Plaintiff. Absent a restraining order, he faces complete loss of his business. On the other hand, IRI suffers no harm if a

restraining order issues. For the past two years, Jonathan has been openly promoting Mormon Match. His website, logo and the image have been openly displayed and visible since last June. Yet, strangely, IRI did not bother during that time to inform Jonathan of the claimed infringement or take any action. IRI waited until Jonathan was forced to respond in a litigation IRI commenced before IRI tried to shut Jonathan's site down. Either IRI was previously unharmed by Jonathan's website, or it utterly failed to police its alleged mark in "Mormon." In either case, it cannot now claim that the website's mere existence is a harm, when it has not even officially launched or begun offering dating services. Accordingly, the balance of equities favors plaintiff.

D. Injunctive Relief is in the Public Interest

One would have to be averse to computers and the Internet to be unaware of online dating, social networking, and social media websites, given their now ubiquitous use. Indeed, by some estimates online dating is a two billion dollar industry.⁴ There is a serious public interest in preserving the freedom of online content creators to create content that addresses religion, even commercial content.

The arguments made by IRI, if logically extended to this industry, would cause the immediate collapse or put at risk nearly every religiously themed website or online community. Accordingly, the public interest favors issuing a restraining order.

⁴ See e.g. Steve Yoder, *How Online Dating Became a 2-Billion Dollar Industry*, (The Week, February 19, 2004), available at: <http://theweek.com/article/index/256506/how-online-dating-became-a-2-billion-dollar-industry>.

Exhibit I

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF TEXAS
HOUSTON DIVISION

JONATHAN ELLER	:	
	:	
Plaintiff	:	
	:	
v.	:	Civ. Action 4:14-cv-00914
	:	
INTELLECTUAL RESERVE, INC.	:	
	:	
Defendant/Counterclaim Plaintiff	:	
	:	
v.	:	
	:	
JONATHAN ELLER	:	
	:	
Counterclaim Defendant	:	
	:	

**ANSWER, AFFIRMATIVE DEFENSES
AND COUNTERCLAIMS**

Defendant Intellectual Reserve, Inc. hereby answers the Complaint as follows.

PARTIES

1. Defendant is without sufficient knowledge to form a belief as to the allegations contained in Paragraph 1 and, therefore, denies said allegations.
2. Defendant admits the allegations contained in Paragraph 2.
3. Defendant admits the allegations contained in Paragraph 3.
4. Defendant admits the allegations contained in Paragraph 4.
5. Defendant admits the allegations contained in Paragraph 5.

NATURE OF THE CASE

6. Paragraph 6 contains a description of Plaintiff's alleged cause of action to which no response is required.

7. Defendant denies the allegations contained in Paragraph 7.

8. Defendant is without sufficient knowledge to form a belief as to the allegations contained in Paragraph 8 and, therefore, denies said allegations.

9. Defendant is without sufficient knowledge to form a belief as to the allegations contained in Paragraph 9 and, therefore, denies said allegations.

10. Defendant admits that it owns exclusive rights in a family of MORMON marks and that the laws of the United States prohibit Plaintiff from using any confusingly similar mark containing the word MORMON in connection with Plaintiff's commercial activities. Defendant denies the remaining allegations in Paragraph 10.

11. Defendant admits that the logo displayed in Paragraph 11 appears to show stylized figures within the first letter "M" in Plaintiff's infringing mark MORMON MATCH. Defendant also admits that the word "Mormon" is blue and the word "Match" is gold. Defendant denies the remaining allegations in Paragraph 11.

12. Defendant admits that it owns exclusive rights in its family of MORMON marks. Defendant denies the remaining allegations in Paragraph 12.

13. Defendant admits that it opposed registration of the infringing mark MORMON MATCH and that the opposition proceeding is pending before the Trademark Trial and Appeal Board at the Patent and Trademark Office. Defendant denies the remaining allegations in Paragraph 13.

14. Defendant admits the allegations contained in Paragraph 14.

15. Defendant admits the allegations contained in Paragraph 15.

16. Defendant admits that on April 4, 2014, a letter was sent on behalf of IRI to Linode, LLC asking Linode to remove infringing content from the www.dateamormon.com website. Defendant denies the remaining allegations contained in Paragraph 16.

17. Defendant admits the allegations contained in Paragraph 17.

18. Defendant admits that the mark MORMON MATCH and the temple image displayed at Plaintiff's website infringe Defendant's rights in Defendant's family of MORMON marks and in its federally registered Temple design marks. Defendant otherwise denies the allegations contained in Paragraph 18.

19. Defendant denies the allegations contained in Paragraph 19.

20. Defendant is without knowledge sufficient to form a belief as to the allegations contained in Paragraph 20 and, therefore, denies said allegations.

21. Defendant is without knowledge sufficient to form a belief as to the allegations contained in Paragraph 21 and, therefore, denies said allegations.

22. Defendant denies the allegations contained in Paragraph 22.

23. Defendant denies the allegations contained in Paragraph 23.

24. Defendant admits the allegations contained in Paragraph 24.

25. Defendant admits that Defendant commenced this action, but is without sufficient knowledge to form a belief as to the underlying reasons and, therefore, denies said allegations.

FACTUAL ALLEGATIONS

26. Defendant is without knowledge sufficient to form a belief as to the allegations contained in Paragraph 26 and, therefore, denies said allegations.

27. Defendant admits that Eller is a member of the Church, but is without knowledge sufficient to form a belief as to the remaining allegations contained in Paragraph 27 and, therefore, denies said allegations.

28. Defendant is without knowledge sufficient to form a belief as to the allegations contained in Paragraph 28 and, therefore, denies said allegations.

29. Defendant admits that LaPointe is a member of the Church, but is without knowledge sufficient to form a belief as to the remaining allegations contained in Paragraph 29 and, therefore, denies said allegations.

30. Defendant is without knowledge sufficient to form a belief as to the allegations contained in Paragraph 30 and, therefore, denies said allegations.

31. Defendant is without knowledge sufficient to form a belief as to the allegations contained in Paragraph 31 and, therefore, denies said allegations.

32. Defendant is without knowledge sufficient to form a belief as to the allegations contained in Paragraph 32 and, therefore, denies said allegations.

33. Defendant is without knowledge sufficient to form a belief as to the allegations contained in Paragraph 33 and, therefore, denies said allegations.

34. Defendant is without knowledge sufficient to form a belief as to the allegations contained in Paragraph 34 and, therefore, denies said allegations.

35. Defendant is without knowledge sufficient to form a belief as to the allegations contained in Paragraph 35 and, therefore, denies said allegations.

36. Defendant is without knowledge sufficient to form a belief as to the allegations contained in Paragraph 36 and, therefore, denies said allegations.

37. Defendant is without knowledge sufficient to form a belief as to the allegations contained in Paragraph 37 and, therefore, denies said allegations.

38. Defendant admits that the Dating Website currently displays the infringing mark MORMON MATCH. Defendant is without knowledge sufficient to form a belief as to the remaining allegations contained in Paragraph 38 and, therefore, denies said allegations.

39. Defendant admits that the Dating Website currently displays an image of the Salt Lake City Temple. Defendant is without knowledge sufficient to form a belief as to the remaining allegations contained in Paragraph 39 and, therefore, denies said allegations.

40. Defendant is without knowledge sufficient to form a belief as to the allegations contained in Paragraph 40 and, therefore, denies said allegations.

41. Defendant admits the allegations contained in Paragraph 41.

42. Defendant admits the allegations contained in Paragraph 42.

43. Defendant denies the allegations contained in Paragraph 43.

44. Defendant denies the allegations contained in Paragraph 44.

45. Defendant admits the allegations contained in Paragraph 45.

46. Defendant admits the allegations contained in Paragraph 46.

47. Defendant admits that IRI timely filed Notice of Opposition Number 91215064 on February 4, 2014. Defendant denies the remaining allegations contained in Paragraph 47.

48. Defendant admits that it asserted ownership of the mark MORMON for a variety of goods and services. Defendant denies the remaining allegations in Paragraph 48.

49. Defendant admits that it identified seven of its registrations for MORMON marks in the notice of opposition it filed against Plaintiff's infringing mark MOROMON MATCH, as alleged in Paragraph 49.

50. Defendant admits the allegations contained in Paragraph 50.

51. Defendant denies the allegations contained in Paragraph 51.

52. Defendant admits that it abandoned one of its applications for the mark MORMON, Serial Number 78161091. Defendant otherwise denies the allegations contained in Paragraph 52.

53. Defendant admits that correspondence took place between Defendant and a Trademark Examiner working at the lowest level of the Patent and Trademark Office, all of which is a matter of public record and that the correspondence speaks for itself. Defendant denies the remaining allegations in Paragraph 53.

54. Defendant admits that correspondence took place between Defendant and a Trademark Examiner working at the lowest level of the Patent and Trademark Office, all of which is a matter of public record and that the correspondence speaks for itself. Defendant denies the remaining allegations in Paragraph 54.

55. Defendant admits that the notice opposition filed by Defendant alleges false suggestion of a connection, likelihood of confusion and dilution as grounds for its opposition to Plaintiff's infringing mark MORMON MATCH. Defendant denies the remaining allegations in Paragraph 55.

56. Defendant admits the allegations contained in Paragraph 56.

57. Defendant admits the allegations contained in Paragraph 57.

58. Defendant admits the allegations contained in Paragraph 58.

59. Defendant admits the allegations contained in Paragraph 59.

60. Defendant denies the allegations contained in Paragraph 60.

61. Defendant admits the allegations contained in Paragraph 61.

62. Defendant denies the allegations contained in Paragraph 62.

63. Defendant admits the allegations contained in Paragraph 63.

64. Defendant admits that the letter included numerous references to allegations contained in Office Actions issued by a Trademark Examiner at the lowest level of the Patent and Trademark Office, which documents speak for themselves. Defendant denies the remaining allegations in Paragraph 64.

65. Defendant admits the allegations contained in Paragraph 65.

66. Defendant admits the allegations contained in Paragraph 66.

67. Defendant denies the allegations contained in Paragraph 67.

68. Defendant admits the allegations contained in Paragraph 68.

69. Defendant admits the allegations contained in Paragraph 69.

70. Defendant admits the allegations contained in Paragraph 70.

71. Defendant admits the allegations contained in Paragraph 71.

72. Defendant is without knowledge sufficient to form a belief as to the allegations contained in Paragraph 72 and, therefore, denies said allegations.

73. Defendant is without knowledge sufficient to form a belief as to the allegations contained in Paragraph 73 and, therefore, denies said allegations.

74. Defendant admits that on April 4, 2014, a letter was sent on behalf of IRI to Linode, LLC asking Linode to remove infringing content from the www.dateamormon.com website.

75. Defendant admits that the letter sent on its behalf to Linode, LLC claimed rights in the mark MORMON and images of the Salt Lake Temple.

76. Defendant admits the allegations contained in Paragraph 76,

77. Defendant admits the allegations contained in Paragraph 77.

78. Defendant admits the allegations contained in Paragraph 78.

79. Defendant admits the allegations contained in Paragraph 79.

80. Defendant is without sufficient knowledge to form a belief as to Paragraph 80 and, therefore, denies said allegations.

81. Defendant denies the allegations in Paragraph 81.

82. Defendant denies the allegations contained in Paragraph 82.

83. Defendant admits that the letter sent on its behalf to Linode, LLC did not use the term “copyright.” Defendant denies the remaining allegations in Paragraph 83.

84. Defendant denies the allegations in Paragraph 84.

85. Defendant is without knowledge to form a belief as to the allegations contained in Paragraph 85 and, therefore, denies said allegations.

86. Defendant is without knowledge to form a belief as to the allegations contained in Paragraph 86 and, therefore, denies said allegations.

87. Defendant admits that the Dating Website has not been shut down. Defendant is without knowledge to form a belief as to the remaining allegations contained in Paragraph 87 and, therefore, denies said allegations.

88. Defendant is without knowledge to form a belief as to the allegations contained in Paragraph 88 and, therefore, denies said allegations.

89. Defendant admits Plaintiff filed a motion to dismiss with the Trademark Trial and Appeal Board; but Defendant is without knowledge to form a belief as to the remaining allegations contained in Paragraph 89 and, therefore, denies said allegations.

90. Defendant denies the allegations contained in Paragraph 90.

91. Defendant is without knowledge to form a belief as to the allegations contained in Paragraph 91 and, therefore, denies said allegations

92. Defendant denies the allegations contained in Paragraph 92.

93. Defendant denies the allegations contained in Paragraph 93.

94. Defendant is without knowledge to form a belief as to the allegations contained in Paragraph 94 and, therefore, denies said allegations.

95. Defendant denies the allegations contained in Paragraph 95.

96. Defendant is without knowledge to form a belief as to the allegations contained in Paragraph 96 and, therefore, denies said allegations.

**COUNT I
(Declaratory Judgment)**

97. No response to this paragraph is required because it merely incorporates the allegations in preceding paragraphs. To the extent a response is required, Defendant repeats and re-alleges its answers in the preceding paragraphs.

98. The allegations in Paragraph 98 call for a legal conclusion to which no response is required. To the extent a response is required, Defendant denies the allegations

99. The allegations in Paragraph 99 call for a legal conclusion to which no response is required. To the extent a response is required, Defendant denies the allegations.

100. Defendant admits that the April 4, 2014 letter sent on its behalf to Linode, LLC asked Linode to remove infringing content from the www.dateamormon.com website.

Defendant denies the remaining allegations contained in Paragraph 100.

101. Defendant denies the allegations contained in Paragraph 101.

102. Defendant denies the allegations contained in Paragraph 102.

103. Defendant admits that the Trademark Trial and Appeal Board is unable to adjudicate infringement claims but denies the remaining allegations in Paragraph 103.

104. Defendant admits that the Court can decide infringement claims but denies the remaining allegations in Paragraph 104.

105. Defendant denies that it lacks complete ownership of the mark MORMON.

106. The allegations in Paragraph 106 call for a legal conclusion to which no response is required. To the extent a response is required, Defendant denies the allegations.

107. The allegations in Paragraph 107 call for a legal conclusion to which no response is required. To the extent a response is required, Defendant denies the allegations.

108. The allegations in Paragraph 108 call for a legal conclusion to which no response is required. To the extent a response is required, Defendant denies the allegations.

109. Defendant denies the allegations contained in Paragraph 109.

110. Defendant denies the allegations contained in Paragraph 110.

111. Defendant denies the allegations contained in Paragraph 111.

112. Defendant denies the allegations contained in Paragraph 112.

113. Defendant denies the allegations contained in Paragraph 113.

114. Defendant admits that Eller and LaPointe are members of The Church of Jesus Christ of Latter-day Saints, but is without sufficient knowledge to form a belief as to the remaining allegations in Paragraph 114 and, therefore, denies said allegations.

115. Defendant is without sufficient knowledge to form a belief as to the allegations in Paragraph 115 and, therefore, denies said allegations.

116. Defendant admits that the term MORMON is used on some occasions to refer to members of The Church of Jesus Christ of Latter-day Saints. Defendant denies the remaining allegations in Paragraph 116.

117. Defendant denies the allegations in Paragraph 117.

118. Defendant is without sufficient knowledge to form a belief as to the allegations in Paragraph 118 and, therefore, denies said allegations.

119. Defendant denies the allegations in Paragraph 119.

120. No response is required by Defendant to the allegations in Paragraph 120 because the allegations merely request a form of relief to which Plaintiff is not entitled. To the extent a response is required Defendant denies the allegations in Paragraph 120.

**COUNT II
(Preliminary Injunction)**

121. No response to this paragraph is required because it merely incorporates the allegations in preceding paragraphs. To the extent a response is required, Defendant repeats and re-alleges its answers in the preceding paragraphs.

122. Defendant denies the allegations contained in Paragraph 122.

123. Defendant denies the allegations contained in Paragraph 123.

124. Defendant denies the allegations contained in Paragraph 124.

125. Defendant denies the allegations contained in Paragraph 125.

126. Defendant denies the allegations contained in Paragraph 126.

127. Defendant denies the allegations contained in Paragraph 127.

128. Defendant denies the allegations contained in Paragraph 128.

129. Defendant is without sufficient knowledge to form a belief as to the allegations in Paragraph 129 and, therefore, denies said allegations.

130. Defendant is without sufficient knowledge to form a belief as to the allegations of Paragraph 130 and, therefore, denies said allegations.

131. IRI has openly opposed attempts by others to claim rights in MORMON as a trademark and that Eller knew or should have known of those objections since they were a matter of public record. Defendant therefore denies that it has not recently complained of any infringement. Defendant admits that it first complained of Eller's infringement at least as early as February 24, 2014, by opposing Eller's registration of the alleged mark MORMON MATCH (and Design) before the PTO.

132. Defendant denies the allegations contained in Paragraph 132.

133. Defendant is without sufficient knowledge to form a belief as to the allegations of Paragraph 133 and therefore denies said allegations.

134. Defendant is without sufficient knowledge to form a belief as to the allegations of Paragraph 134 and therefore denies said allegations.

135. Defendant denies the allegations contained in Paragraph 135.

136. Defendant denies the allegations contained in Paragraph 136.

137. Defendant denies that the public interest favors issuance of an injunction against Defendant.

138. Defendant denies the allegations in Paragraph 138.

139. Defendant is without sufficient knowledge to form a belief as to the allegations contained in Paragraph 139 and, therefore, denies said allegations.

140. Defendant is without sufficient knowledge to form a belief as to the allegations contained in Paragraph 140 and, therefore, denies said allegations.

141. Defendant denies the allegations contained in Paragraph 141.

142. Defendant denies the allegations contained in Paragraph 142.

143. No response is required of Defendant to Paragraph 143 because it merely recites a claim for a remedy to which Plaintiff is not entitled. To the extent a response is required, Defendant denies that Plaintiff is entitled to any relief.

FIRST AFFIRMATIVE DEFENSE

Plaintiff's claims should be dismissed because Plaintiff has failed to state a claim upon which relief can be granted, in that Plaintiff admittedly does not own the website at www.dateamormon.com and has not alleged use or a right to use the mark MORMON MATCH in commerce.

SECOND AFFIRMATIVE DEFENSE

Plaintiff's claims should be dismissed because although Plaintiff identified others who apparently have an interest in this matter, including Gordon Child and Matthew LaPointe, and Plaintiff has failed to join one or more required parties some of whom may be identified through discovery to have an interest relating to the subject of the action and in whose absence the Court cannot afford complete relief.

THIRD AFFIRMATIVE DEFENSE

Plaintiff's claims are barred by the fact that Plaintiff lacks standing in that Plaintiff has no rights in any mark containing the word MORMON, admittedly does not own the website at www.dateamormon.com and, therefore, will not be damaged by Defendant's efforts to enforce its intellectual property rights.

FOURTH AFFIRMATIVE DEFENSE

Plaintiff's claims and allegations as to descriptiveness are barred by the fact that Defendant owns incontestable federal trademark registrations.

FIFTH AFFIRMATIVE DEFENSE

Plaintiff's claims are barred by the doctrine of unclean hands in that Plaintiff has engaged in inequitable conduct directly related to the subject matter of this litigation in that, among other things, Plaintiff has made claims under penalty of perjury before the PTO which have been directly contradicted by pleadings filed by Plaintiff in this proceeding.

SIXTH AFFIRMATIVE DEFENSE

Plaintiff's claims are barred by the doctrine of estoppel in that the allegations made by Eller in his complaint are contradicted by prior sworn statements made by Eller.

SEVENTH AFFIRMATIVE DEFENSE

Plaintiff's claims are barred by the doctrine of laches in that Plaintiff knew or should have known of Defendant's long established rights in its family of MORMON Marks, and Plaintiff unreasonably delayed the claims asserted herein thereby causing detriment to Defendant.

WHEREFORE, Defendant prays:

- (1) That the relief requested by Plaintiff be denied;
- (2) That the Court enter judgment in favor of Defendant dismissing all of Plaintiff's claims;
- (3) That Defendant be awarded all costs and attorneys' fees associated with its defense in this action;
- (4) That Defendant be granted such other, further, different or additional relief as this court deems equitable and proper.

COUNTERCLAIMS

Counterclaim Plaintiff Intellectual Reserve, Inc. (“IRI”) hereby asserts the following counterclaims against Counterclaim Defendant Jonathan Eller (“Eller”).

THE PARTIES

1. This is an action for trademark and service mark infringement, unfair competition, cybersquatting, and declaratory judgment arising under the Trademark Act of 1946, 15 U.S.C. § 1051 et seq. and the common law.

2. IRI is a nonprofit corporation organized under the laws of Utah having an address of 50 East North Temple, Salt Lake City, Utah 84150.

3. On information and belief, Eller is a resident of Texas with an address of 18630 Minden Oaks Drive, Spring, Texas 77388.

JURISDICTION AND VENUE

4. This Court has jurisdiction over the subject matter of this action under Section 39 of the Trademark Act of 1946, 15 U.S.C. § 1121; 28 U.S.C. § § 1331, 1332 and 1338; and under the doctrine of supplemental jurisdiction, 28 U.S.C. § 1367.

5. This Court has personal jurisdiction over Eller because he is doing business in Texas within this Judicial District and because he has caused tortious injury to IRI within this Judicial District.

6. Venue is appropriate in this judicial district pursuant to 28 U.S.C. § 1391(b), because Eller claims to reside within this district and a substantial part of the events giving rise to the counterclaims occurred in this district.

FACTS

7. IRI owns all right, title and interest in and to a family of trademarks and service marks containing the word MORMON alone or in combination with other words or designs.(collectively, the “MORMON Marks”).

8. IRI also owns various design marks depicting the Salt Lake Temple, (the “Temple Design Marks”).

9. IRI also owns and manages intellectual property used by The Church of Jesus Christ of Latter-day Saints (the “Church”).

10. The Church is widely known in the United States and throughout the world as the MORMON CHURCH. For many years, the Church has used the word MORMON extensively alone and with other words and designs extensively as a trademark and service mark to identify and distinguish its goods and services from those owned by others.

11. IRI holds title to a family of MORMON Marks and other trademarks, service marks and other intellectual property rights used by the Church.

12. Long prior to the acts complained of herein, IRI adopted and began using the MORMON Marks and the Temple Design Marks in interstate commerce in connection with a variety of goods and services including, but not limited to, providing on-line religious instruction promoting family values; counsel and advice on dating and marriage, providing a website on which individuals may engage in social networking and the posting of information about themselves, providing information and instruction in the fields of religion, ethics, and moral and religious values; providing information in the field of parenting concerning education and entertainment of children; and providing courses of instruction in the field of marital relations educational services, providing online religious instruction, entertainment services, pre-recorded

audio and video cassette tapes and compact discs featuring religious content, printed matter; namely religious books, religious instructional pamphlets, and brochures; photographs, artist materials, instructional and teaching material, posters, engravings, prints of paintings and, books.

13. The Church establishes moral standards for dating and it engages in counseling services designed to help individuals find a spouse and to qualify for marriage.

14. The ultimate goal of worthy members of the Church is to qualify for marriage in one of the many temples operated by the Church, including the temple in Salt Lake City where IRI and the Church have their headquarters.

15. To facilitate these goals, IRI obtained the following registrations from the Patent and Trademark Office:

- Registration No. 3239919, MORMON, on May 8, 2007;
- Registration No. 3715744, MORMON.ORG, on November 24, 2009;
- Registration No. 2766231, MORMON TABERNACLE CHOIR, on September 23, 2003;
- Registration No. 2913694, MORMON TABERNACLE CHOIR & Design, on December 21, 2004;
- Registration No. 2883572, BOOK OF MORMON, on September 14, 2004;
- Registration No. 1524555, MORMON HANDICRAFT, on February 14, 1989;
- Registration No. 1527447, MORMON HANDICRAFT, on February 28, 1989;
- Registration No. 2552030, for a Temple Design mark, issued March 26, 2002, for printed instructional manuals featuring religious subject matter;
- Registration No. 4323142, for a Temple Design mark issued April 23, 2013 for video recordings featuring religious subject matter;

IRI also owns the following registration issued by the State of Utah.

- Utah Registration No. 5160149-0190, THE MORMON CHURCH, issued July 18, 2002.

16. These registrations are valid and subsisting and the federal registrations provide nationwide constructive notice and *prima facie* proof of IRI's ownership of and exclusive right to use the MORMON Marks in commerce pursuant to 15 U.S.C. §§ 1057(b) and 1072. Reg. Nos. 1524555, 1527447, 2552030, 2766231, 2883572, 2913694, and 3239919 are incontestable and they provide conclusive evidence of IRI's exclusive right to use the marks in commerce pursuant to 15 U.S.C. § 1065. Copies of these registrations are attached as Exhibit A.

17. The MORMON Marks have been widely publicized throughout the United States for many years and they have become distinctive indicators of the goodwill owned by IRI and the Church.

18. As a result of the extensive use and publicity, the MORMON Marks have become well known among members of the public as distinctive indicators of the source of goods and services offered by the Church and as valuable symbols of IRI's goodwill.

19. Notwithstanding IRI's prior rights in the MORMON Marks, Eller began using the confusingly similar mark MORMON MATCH and an imitation of IRI's Temple Design Marks (collectively the "Infringing Marks") in connection with a website where individuals may engage in social networking and with the advertising of a future dating service.

20. On June 3, 2013, Eller filed Application No. 85/949670 with the United States Patent and Trademark Office seeking registration of MORMON MATCH for Internet-based dating, social introduction, and social networking services.

21. In his application, Eller claimed the exclusive right to use the Infringing Mark and, declared under penalty of perjury that **"no other person, firm, corporation, or association has the right to use the mark in commerce."**

22. Eller has displayed the Infringing Mark together with a large photograph that incorporates IRI's Temple Design Mark on advertisements and on the website at www.dateamormon.com, (which is also reachable through the domain name "Mormon-Match.com"). ("dateamormon.com" and "mormon-match.com" are hereinafter referred to as the "Infringing Domain Names").

23. Eller does not own the unhyphenated domain name www.mormonmatch.com and, unlike Eller, the owner of that domain name has not attempted to register MORMON MATCH as a trademark or service mark.

24. Eller could have selected any number of marks to identify and distinguish his services from those of others but, instead, chose to use and seek registration of the Infringing Mark.

25. There are several other dating websites that provide dating services to members of the Church. However, unlike Eller, the owners of these sites have respected IRI's rights in its family of MORMON Marks by refraining from using the word MORMON as a trademark or service mark.

26. Eller could have used the term Mormon in a non-trademark manner in good faith, merely to communicate the fact that his services are offered to Mormons or members of the Church.

27. Instead, Eller is using and seeking to register the Infringing Mark as a service mark to identify and distinguish his services from those of others.

28. Eller's allegation that his use of the Infringing Mark is "fair use" directly conflicts with the representations he made to the Patent and Trademark Office and it is further contradicted by his display of the Infringing Mark as the most prominent words on his website.

29. The Infringing Mark is the only word mark displayed on Eller's website.

30. IRI obtained registrations for the MORMON Marks long before Eller decided to begin using the Infringing Marks.

31. Eller knew or should have known that IRI owns a family of federally registered MORMON Marks before he adopted the Infringing Mark.

32. Eller knew or should have known that the Church uses the MORMON marks on services closely related to those that Eller is offering under the Infringing Marks.

33. Eller never sought the permission of IRI or the Church to use imitations of IRI's registered MORMON Marks or the Temple Design Marks.

34. Eller adopted the Infringing Mark for commercial purposes with an intent to use it for his own personal gain.

35. Eller adopted the infringing Mark with an intent to mislead members of the public into believing that his services are approved, endorsed, sponsored or otherwise affiliated with IRI and the Church.

36. Eller adopted the Infringing Mark with a deliberate intent to misappropriate the goodwill symbolized by the Mormon Marks.

37. Eller was aware of objections by IRI and the Church to his use and registration of the Infringing Marks before he filed this lawsuit.

38. Despite said objections, Eller has deliberately persisted in the use of the Infringing Marks and has continued his efforts to cause confusion, mistake and deception and to falsely suggest that his services are approved, endorsed, sponsored by or otherwise affiliated with IRI and the Church.

39. While Eller is a member of the Church, his desire to pursue his own financial interests outweighs any loyalty he may have to the Church as shown by his imitation of federally registered marks used by the Church, his attack on the validity of those marks, his attempts to trade on the goodwill symbolized by the MORMON Marks and his filing of this action.

40. Neither IRI nor the Church have any contractual relationship with Eller and, therefore, they have no control over the manner in which he uses the Infringing Mark and no contractual ability to prevent Eller from using said mark in a manner that damages the goodwill symbolized by the Church's MORMON Marks.

41. Because IRI and the Church are being damaged by Eller's use of the Infringing Mark, IRI timely filed Opposition No. 91215064 with the Trademark Trial and Appeal Board on February 24, 2014, opposing registration of the Infringing Mark.

42. Owners of other applications for infringing marks containing the word MORMON have voluntarily abandoned those applications after receiving objections or notices of opposition from IRI.

43. Eller knew or should have known that other users of MORMON marks have abandoned their applications after receiving objections or notices of opposition from IRI.

44. Despite the objections raised on behalf of IRI in the opposition proceeding and in correspondence concerning the Infringing Mark, Eller has continued using and attempting to register the Infringing Mark with full knowledge of IRI's prior rights in the MORMON Marks.

45. Thus, Eller has engaged in this unlawful activity in bad faith with a willful and, deliberate intent to trade on IRI's goodwill, to cause confusion among members of the public, and to injure IRI and the Church.

46. Eller's unauthorized use of the Infringing Marks is deliberately calculated to cause confusion among consumers as to the source, origin, or sponsorship of services offered by Eller.

**COUNT I
TRADEMARK INFRINGEMENT IN VIOLATION OF FEDERAL LAW**

47. As a separate cause of action and claim for relief, IRI alleges that Eller has and is engaged in acts of trademark infringement that give rise to a cause of action under 15 U.S.C. §1114(1)(a). Paragraphs 1 through 47 of this counterclaim are incorporated by reference as part of this claim.

48. Eller has used and is using or intends to use the Infringing Marks in connection with Internet-based dating, social introduction, and social networking services in this district in such a manner as to create a likelihood of confusion, mistake, or deception among actual and prospective consumers, and said acts have damaged and impaired that part of goodwill symbolized by the MORMON Marks, to IRI's immediate and irreparable damage.

49. Eller's unauthorized use of the Infringing Mark in the manner alleged constitutes trademark infringement within the meaning of 15 U.S.C. §1114(1)(a).

50. Eller's unauthorized use of the Infringing Mark is likely to cause confusion mistake or deception.

51. Eller had actual knowledge of IRI's exclusive right to use the MORMON Marks when he engaged in the conduct complained of herein.

52. Thus, Eller has willfully and deliberately engaged in the aforesaid acts of infringement with an intent to injure IRI and to deceive the public.

53. Eller's acts of infringement have caused IRI irreparable injury and loss of reputation. Unless enjoined by this Court, Eller will continue these acts of infringement to IRI's immediate and irreparable damage.

COUNT II
UNFAIR COMPETITION IN VIOLATION OF FEDERAL LAW

54. As a separate cause of action and claim for relief, IRI alleges that Eller has and is engaged in acts of unfair competition of a type proscribed by Section 43(a) of the Trademark Act of 1946, 15 U.S.C. § 1125(a). Paragraphs 1 through 54 of this counterclaim are incorporated by reference as part of this claim.

55. Eller has used and is using the Infringing Mark in connection with the advertising and sale of services in a manner that creates a likelihood of confusion among prospective purchasers, thereby inducing purchasers and others to believe, contrary to fact, that the goods or services sold by Eller are rendered, sponsored, or otherwise approved by, or connected with IRI or the Church, which acts of Eller have damaged and impaired that part of IRI's goodwill symbolized by the MORMON Marks to IRI's immediate and irreparable damage.

56. Eller's use of a mark that is confusingly similar to that owned by IRI, in connection with the advertising and sale of Eller's goods or services, constitutes use of a false designation of origin and a false and misleading representation within the meaning of Section 43(a) of the Trademark Act of 1946, 15 U.S.C. § 1125(a).

57. Eller's use of a mark confusingly similar to the MORMON Marks constitutes unfair competition entitling IRI to remedies pursuant to Section 43(a) of the Trademark Act of 1946, 15 U.S.C. § 1125(a).

58. Eller's acts of false designation of origin, false representation and false advertising have caused IRI irreparable injury, loss of reputation and pecuniary damages. Unless enjoined by this court, Eller will continue the acts of unfair competition complained of herein to IRI's immediate and irreparable damage.

**COUNT III
CYBERSQUATTING IN VIOLATION OF FEDERAL LAW**

59. As a separate cause of action and claim for relief, IRI alleges that Eller has and is engaged in acts of trademark cybersquatting of a type proscribed by Section 43(d) of the Trademark Act of 1946, 15 U.S.C. § 1125(d). Paragraphs 1 through 59 of this counterclaim are incorporated by reference as part of this claim.

60. Acting alone or in concert with others, Eller has registered and/or used and is using the Infringing Domain Names with a bad faith intent to profit from the MORMON Marks.

61. Eller is using the Infringing Domain Names in connection with the advertising and sale of services in a manner which creates a likelihood of confusion among prospective purchasers, thereby inducing purchasers and others to believe, contrary to fact, that the goods or services sold by Eller are rendered, sponsored, or otherwise approved by, or connected with IRI, which acts of Eller have damaged and impaired that part of IRI's goodwill symbolized by the MORMON Marks to IRI's immediate and irreparable damage.

62. Evidence of Eller's bad faith is shown by the fact that the Infringing Domain Names adopted by Eller are identical or confusingly similar to the MORMON Marks.

63. Eller's use of the Infringing Domain Names, in connection with the advertising and sale of Eller's goods or services, constitutes trademark cybersquatting within the meaning of The Anticybersquatting Consumer Protection Act, Section 43(d) of the Trademark Act of 1946, 15 U.S.C. § 1125(d).

64. Eller's use of the Infringing Domain Names entitles IRI to remedies pursuant to Section 43(d) of the Trademark Act of 1946, 15 U.S.C. § 1125(d), including statutory damages pursuant to 15 U.S.C. § 1117(d).

65. Eller's acts of cybersquatting have caused IRI irreparable injury, loss of reputation and pecuniary damages. Unless enjoined by this court, Eller will continue the acts of unfair competition complained of herein to IRI's immediate and irreparable damage.

**COUNT IV
TRADEMARK INFRINGEMENT UNDER THE COMMON LAW**

66. As a separate cause of action and claim for relief, IRI alleges that Eller has and is engaged in acts of trademark infringement in violation of the common law. Paragraphs 1 through 66 of this counterclaim are incorporated by reference as a part of this claim.

67. Eller has used and is using the Infringing Mark in connection with the advertising and selling of services in a manner which creates a likelihood of confusion among prospective purchasers, thereby inducing purchasers and others to believe, contrary to fact, that the goods or services sold by Eller are rendered, sponsored, or otherwise approved by, or connected with IRI, which acts of Eller have damaged and impaired that part of IRI's goodwill symbolized by the MORMON Marks, to IRI's immediate and irreparable damage.

68. The nature, probable tendency and effect of Eller's use of a confusingly similar name and mark in the manner alleged is to enable Eller to deceive the public by passing off his goods or services as being rendered, sponsored, or otherwise approved by or connected with IRI.

69. Eller's use of a mark confusingly similar to that used by IRI in connection with the advertising and selling of services is likely to cause confusion, mistake or deception as to the source or origin of Eller's services and constitutes infringement of the MORMON Marks under the common law.

70. Eller's acts of infringement have caused IRI's irreparable injury, loss of reputation and pecuniary damages. Unless enjoined by this court, Eller will continue these acts of infringement thereby deceiving the public and causing IRI immediate and irreparable damage.

COUNT V
UNFAIR COMPETITION IN VIOLATION OF THE COMMON LAW

71. As a separate cause of action and claim for relief, IRI alleges that Eller has and is engaged in acts constituting willful and deliberate unfair competition in violation of the common law. Paragraphs 1 through 71 of this counterclaim are incorporated by reference as a part of this claim.

72. Eller has used and is using the Infringing Mark in connection with the unauthorized advertising and selling of services in interstate commerce in such a manner as to create a likelihood of confusion among prospective purchasers and to unfairly compete with IRI. Eller's use of the Infringing Mark induces purchasers and others to believe, contrary to fact, that the goods or services sold by Eller are rendered, sponsored, or otherwise approved by, or connected with IRI. Eller's acts have damaged and impaired that part of IRI's goodwill symbolized by the MORMON Marks, to IRI's immediate and irreparable damage.

73. The aforesaid acts of Eller constitute willful and deliberate unfair competition under the common law of Texas.

74. Eller's acts of unfair competition have caused IRI irreparable injury, loss of reputation, and pecuniary damages. Unless enjoined by this Court, Eller will continue said unlawful acts of willful and deliberate unfair competition to IRI's immediate and irreparable damage.

COUNT VI
DECLARATORY JUDGMENT

75. As a separate cause of action and ground for relief, IRI respectfully submits that it is entitled to a declaratory judgment pursuant to 28 U.S.C. § 2201 and 15 U.S.C. § 1119, finding that Eller is not entitled to use or register the mark MORMON MATCH or any other mark

containing the word MORMON and directing the Patent and Trademark Office to enter judgment in favor of IRI on each of the grounds asserted as a basis for IRI's opposition in Opposition No. 91215064.

76. The threats and allegations made by Eller have created a case of actual controversy between the parties.

77. Eller's use and registration of the Infringing Mark is likely to cause confusion, mistake or deception among prospective customers in violation of 15 U.S.C. § 1052(d).

78. Eller's use and registration of the Infringing Mark creates a false suggestion of connection with IRI or the Church or with the beliefs of the Church in violation of 15 U.S.C. § 1052(a).

79. Eller's attempts to use and register the Infringing Mark have caused IRI to suffer irreparable injury, loss of reputation and pecuniary damages. Unless enjoined by this Court, Eller will continue these acts thereby deceiving the public and causing IRI immediate and irreparable damage.

WHEREFORE, IRI prays for judgment against Eller as follows:

(1) Pursuant to 15 U.S.C. § 1116, and the law of the State of Texas, that Eller and each of his agents, servants, employees, attorneys, assigns, and all others in privity or acting in concert with them be preliminarily and permanently enjoined from:

(a) Using or authorizing others to use as a trademark, service mark or trade name, or domain name, MORMON MATCH, DATE A MORMON or any other name or mark containing the term MORMON, or any confusingly similar names or marks, in the advertising or sale of any goods or services;

(b) Using or authorizing others to use in any manner any service mark, trademark, trade name, trade dress, domain name, words, numbers, abbreviations, designs, colors, arrangements, collocations, or any combinations thereof which would imitate, resemble or suggest the MORMON Marks;

(c) Otherwise infringing the MORMON Marks;

(d) Unfairly competing with IRI, diluting the distinctiveness of the MORMON Marks, and otherwise injuring IRI's business reputation in any manner;

(e) Publishing any telephone listings, using any domain names, web pages or Internet advertisements, or keywords using the names or marks MORMON, MORMON MATCH, DATEAMORMON.COM, or any other name or mark confusingly similar to the MORMON Marks.

(2) Pursuant to 15 U.S.C. § 1118 and the law of the State of Texas, that Eller be directed to deliver up for destruction all advertisements, labels, signs, prints, packages, wrappers, receptacles and all other materials in its possession or under its control that resemble or bear the name or mark MORMON MATCH, or any other name or mark containing MORMON MATCH or any other reproduction, counterfeit, copy or colorable imitation of the MORMON Marks and all plates, molds, matrices, and other means of making or duplicating said allegations.

(3) Pursuant to 15 U.S.C. § Eller be directed to abandon his application to register the mark MORMON MATCH.

(3) Pursuant to 15 U.S.C. § 1117 and the law of the State of Texas, that Eller account and pay to IRI damages in an amount sufficient to fairly compensate IRI for the injury it has sustained plus all profits which are attributable to the infringing sale of goods or services under

the name and mark complained of herein, and further that the amount of the monetary amount granted herein be trebled in view of the willful and deliberate nature of Eller's unlawful conduct.

(4) Pursuant to 15 U.S.C. § 1117, and the law of the State of Texas, that Eller be ordered to pay to IRI the costs of this action and IRI's attorneys' fees.

(6) That IRI be granted such other, further, different or additional relief as this court deems equitable and proper.

Dated: April 29, 2014

/s/ Robert M. Schick

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CERTIFICATE OF SERVICE

I hereby certify that on April 29, 2014, I electronically transmitted the attached document to the Clerk of Court using the ECF System for filing and transmittal of Notice of Electronic Filing to the following ECF registrants:

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Exhibit J

**IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF TEXAS
HOUSTON DIVISION**

JONATHAN ELLER,

Plaintiff/Counterclaim Defendant,

v.

INTELLECTUAL RESERVE, INC.,

Defendant/Counterclaim Plaintiff.

Civil Action No. 4:14-cv-00914

**MEMORANDUM IN OPPOSITION TO *EX PARTE* MOTION FOR TEMPORARY
RESTRAINING ORDER AND PRELIMINARY INJUNCTION**

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Statement of the Nature and Stage of the Proceeding

In this declaratory judgment action, a trademark applicant, Plaintiff/Counter-Defendant Jonathan Eller (“Eller”), seeks a declaration that his use of the mark MORMON MATCH does not infringe the trademark rights of Defendant/Counter-Plaintiff Intellectual Reserve, Inc. (the “Church”) in a family of federally registered and common law marks containing the word MORMON. Eller has filed a Complaint and a motion for emergency relief, and the Church has filed an Answer, Affirmative Defenses, and Counterclaims for trademark infringement, unfair competition, cybersquatting and for a declaration that Eller is not entitled to register the mark MORMON MATCH.

Statement of the Issues to Be Ruled Upon by the Court

Before the Court is Eller’s *Ex Parte* Motion for Temporary Restraining Order and Preliminary Injunction. Injunctive relief may be granted only if the plaintiff *clearly establishes* four elements: (1) a substantial likelihood of success on the merits; (2) a substantial threat that the movant will suffer irreparable injury if the injunction is denied; (3) that the threatened injury outweighs any damage that the injunction might cause the defendant; and (4) that the injunction will not disserve the public interest. *Guy Carpenter & Co. v. Provenzale*, 334 F.3d 459, 464 (5th Cir. 2003); *Kern River Gas Transmission Co. v. Coastal Corp.*, 899 F.2d 1458, 1462 (5th Cir. 1990).

Summary of the Argument

To establish that he is entitled to injunctive relief, Eller must demonstrate that his use of the mark MORMON MATCH is not infringing, *i.e.*, that the Church does not have protectable trademark rights in its family of “MORMON” Marks, despite the fact that the United States Patent and Trademark Office has repeatedly recognized such rights and that Eller’s proposed use of MORMON MATCH is not likely to cause confusion, despite the fact that actual confusion has already occurred.

Eller is unable to rebut the Church’s exclusive rights in its well-known family of Registered MORMON marks, many of which provide conclusive evidence of the Church’s ownership of and exclusive right to use the MORMON marks in commerce. Moreover, each of the factors this Court considers in making a determination regarding whether use of Eller’s MORMON MATCH mark would cause a likelihood of confusion as to the Church’s MORMON marks weighs heavily in the Church’s favor. *Roto-Rooter Corp. v. O’Neal*, 513 F.2d 44, 45 (5th Cir. 1975). Eller’s failure to meet the burden of proof is fatal to Eller’s motion.

Likewise, Eller cannot establish irreparable harm because he can launch a website without using MORMON as a trademark or service mark, any injury he may suffer is compensable with money damages, and his alleged harm absent an injunction outweighs the irreparable harm the Church will suffer if an injunction is issued and Eller is permitted to infringe its federally registered MORMON marks. Finally, the public interest weighs heavily in favor of avoiding the confusion Eller’s use of MORMON MATCH has caused.

Eller is unable to meet his burden in demonstrating entitlement to preliminary injunctive relief, and the Court should deny his motion.

I. FACTUAL BACKGROUND.

Defendant and Counterclaim Plaintiff Intellectual Reserve, Inc. (“IRI”) hereby opposes the Motion for Temporary Restraining Order filed by Plaintiff Jonathan Eller (“Eller”). The opposition is based in part on the attached declaration of Barry V. Taggart (“Taggart Decl.”).

A. The Nature of the Dispute

This action arose after IRI objected to Eller’s use and registration of the mark MORMON MATCH for a commercial dating site that Eller and others are planning to launch. (Taggart Decl. ¶ 1). In total disregard for IRI’s long established rights in the mark MORMON, Eller filed a Declaratory Judgment Complaint and Motion for *Ex Parte* Temporary Restraining Order on April 7, 2014. IRI filed an Answer, Affirmative Defenses and Counterclaims against Eller on April 29, 2014. Although others are apparently aiding and abetting Eller in his lawsuit, none have been joined in the suit as yet.

The Complaint seeks to enable Eller to use the well-known MORMON mark for his own financial gain and his motion seeks to restrain IRI from enforcing its family of federally registered MORMON trademarks. Among other things, Eller asks that IRI be precluded from disrupting Eller’s social networking and dating website on which Eller is using the infringing mark MORMON MATCH.

B. The Lack of Need for Preliminary Relief

There is no need for issuance of a TRO in this case because, in the course of their continuing settlement discussions, IRI has agreed to maintain the status quo for the time being. IRI will not seek to have the website taken down. *Id.* ¶ 2. Even before Eller filed his motion, there was no imminent likelihood that the www.dateamormon.com website would be terminated. While IRI requested that the website host remove infringing content from the site, the host refused to comply with this demand. *Id.* ¶ 3. Moreover, this dispute could be resolved and the site can

continue operating if Eller merely ceases using MORMON as a trademark or service mark and ceases imitating IRI's federally registered Temple Design Marks.

The word MORMON is a valid trademark used to identify and distinguish goods and services that emanate from The Church of Jesus Christ of Latter-day Saints (the "Church"). Like many trademarks, it may also be used fairly and in good faith to describe Church members. IRI has no objection to Eller's operation of a dating website that contains non-trademark references to the term "Mormon." For example, Eller could use descriptive language on his site such as "this is a website intended for Mormons." However, Eller is not using MORMON MATCH to describe anything. Rather he is using it as a mark to identify and distinguish his services from those of others in a manner that competes in part with services offered by the Church.

C. The Co-Pending TTAB Proceeding

Eller has applied to register MORMON MATCH as a trademark, and the parties are currently involved in a trademark opposition proceeding, pending before the Trademark Trial and Appeal Board ("TTAB") in the United States Patent and Trademark Office ("PTO"), that raises many of the same issues raised in Eller's Complaint. *Id.* ¶ 4. The opposition was instituted on February 24, 2014, after IRI timely¹ filed a notice of opposition to Eller's "intent to use" application to register MORMON MATCH. *Id.* ¶ 5, Ex. A.

D. Intellectual Reserve, Inc. and the Church

IRI is a non-profit corporation based in Salt Lake City, Utah, which owns and manages intellectual property used by the Church. *Id.* ¶ 6. IRI holds title to the Church's trademarks and

¹ On June 3, 2013, Plaintiff filed application Serial No. 85/949,670 for registration of the alleged mark "MORMON MATCH (and Design)." That application was published in the Official Gazette on October 29, 2013 for "Internet-based dating, social introduction and social networking services." After obtaining a 90 day Extension of Time to Oppose, IRI filed its opposition on February 24, 2014, pursuant to 15 U.S.C. § 1063.

other intellectual property. *Id.* ¶ 7. (Hereinafter IRI and the Church will be collectively referred to as the “Church”).

The Church is commonly referred to in the United States and throughout the world as the “Mormon Church,” and it uses MORMON alone and with other words as a trademark and service mark to identify and distinguish its goods and services from those offered by others. *Id.* ¶ 8. The Church’s trademarks and service marks comprise a family of marks containing the word MORMON (the “MORMON Marks”). The Church also owns registered design marks showing depictions of the Church’s Salt Lake City temple (the “Temple Design Marks”) *Id.* ¶ 9.

E. The Church’s Federally Registered MORMON Marks

Long prior to the acts complained of herein, the Church began using and established common law rights in a number of MORMON Marks and Temple Design Marks, which have been used extensively in connection with a variety of goods. *Id.* ¶ 10. Among other things, the Church offers counsel and advice on dating and social networking services closely related to those Eller plans to offer under the MORMON MATCH mark. *Id.* ¶ 11.

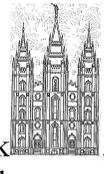
The PTO and the State of Utah have recognized the Church’s ownership of and exclusive right to use many of the MORMON Marks by issuing the following registrations, copies of which are submitted herewith. *Id.* ¶ 12, Ex. B.

- (1) Registration No. 3715744, **MORMON.ORG**, issued November 24, 2009 for providing information and instruction in the fields of religion, ethics, and moral and religious values; providing on-line religious instruction promoting family values; providing information in the field of parenting concerning education and entertainment of children; **and providing courses of instruction in the field of marital relations** (emphasis added);
- (2) Registration No. 3239919, **MORMON**, issued May 8, 2007, for educational and genealogical services;
- (3) Registration No. 2883572, **BOOK OF MORMON**, issued September 14, 2004, for recordings, printed matter;

- (4) Registration No. 1524555, **MORMON HANDICRAFT**, issued February 14, 1989, for fabrics, linens, bats, towels, dish cloths, pillowcases, afghans, lap robes, quilts, quilt kits, and wall hangings, table covers, soft gifts, and hem-stitched items of textile material;
- (5) Registration No. 1527447, **MORMON HANDICRAFT**, issued February 28, 1989, for retail catalog mail order and telephone order services for craft items and materials, dolls, baby clothes, toys, young girls' clothing, quilts, personal gifts, needlework, porcelain statues and the like;
- (6) Registration No. 2766231, **MORMON TABERNACLE CHOIR**, issued September 23, 2003, for recordings, live entertainment services, and related goods and services;
- (7) Registration No. 2913694, **MORMON TABERNACLE CHOIR and Design**, issued December 21, 2004, for recordings, publications, live performances, and related goods and services;



- (8) Registration No. 2552030, for the Temple Design Mark , issued March 26, 2002, for printed instructional manuals featuring religious subject matter;



- (9) Registration No. 4323142, for the Temple Design Mark , issued April 23, 2013 for video recordings featuring religious subject matter; and

- (10) Utah Registration No. 5160149-0190, **THE MORMON CHURCH**, issued July 18, 2002.

Through many years of extensive use and publicity, the MORMON Marks have become well known and famous among members of the public in Texas and throughout the United States as distinctive indicators of the source of goods and services offered by the Church. *Id.* ¶ 13, Ex.

C. The marks have been widely publicized through radio, television and print media. *Id.* ¶ 14.

For example, the Church has disseminated a number of television advertisements directed at promoting parenting skills and family values, many of which are viewable on

www.YouTube.com, www.mormonchannel.org, and other websites. *Id.* ¶ 15, Ex. D. It has also

disseminated a series of informative commercials entitled “I’m a Mormon,” many of which are visible on www.mormonchannel.org/Im-a-mormon. *Id.* ¶ 16, Ex. E.

The Church has used the mark MORMON TABERNACLE CHOIR with a continuing series of weekly radio broadcasts since 1929 under the mark MUSIC AND THE SPOKEN WORD. *Id.* ¶ 17. Those weekly programs are carried on over 2,000 radio, television and cable networks, and it is the world’s longest continuous radio broadcast. *Id.* ¶ 18. This 360-member chorus of volunteer men and women has performed at World’s Fairs and expositions, at inaugurations of U.S. presidents, and throughout the United States and abroad. *Id.* ¶ 19.

The registrations do not cover all goods and services offered by the Church. And the Church owns a number of unregistered common law MORMON Marks, including “MORMON CHANNEL,” “MORMON NEWSROOM,” and “MORMON TIMES.” *Id.* ¶ 20, Exs. F, G.

F. The Church’s Social Networking and Dating Related Services

The Church has established moral standards and guidelines for dating and offers counseling services to help individuals find marriage partners. *Id.* ¶ 21. The goal of worthy members of the Church is to be married in one of the Church’s many temples. *Id.* ¶ 22. The Church often uses photographs of the Salt Lake Temple and other temples with its materials on dating. *Id.* ¶ 23. For example, at <https://www.lds.org/youth/for-the-strength-of-youth/dating?lang=eng> the Church has posted dating guidelines along with the temple image shown below. *Id.* ¶ 24, Ex. H; *see also id.* ¶ 20, Ex. G.



Since long before Eller decided to begin offering social networking and dating services under the mark MORMON MATCH, the Church has been offering a type of social networking services under its MORMON.ORG mark. *Id.* ¶ 25. Church members may post a profile of themselves and may find people having similar interests at <http://www.mormon.org/create>. *Id.* ¶ 26, Ex. I.

G. Eller’s Unauthorized Commercial Use of the MORMON Marks.

Eller is attempting to trade on the Church’s reputation and goodwill by using MORMON MATCH as the trademark for his internet dating service. Although he has not yet begun offering dating services, he is advertising those services under the mark MORMON MATCH at the www.dateamormon.com site, which is linked to the domain name “Mormon-Match.com”.² *Id.* ¶ 27, Ex. J. The website’s home page prominently displays the mark MORMON MATCH, the only word mark on the page. *Id.* ¶ 28. The word MORMON is the first word in the mark and is in a different color than the word MATCH. *Id.* ¶ 29. The site also prominently displays an imitation



of the Church’s Temple Design Marks.

Id. ¶ 29.

² Eller does not own the domain name MormonMatch.com and, unlike Eller, the owner of that domain name has not attempted to register MORMON MATCH as a trademark or service mark.

In the declaration attached to his application to register MORMON MATCH as a trademark, Eller admitted that he intends to use the term MORMON as part of a service mark to identify and distinguish his services from those of others by claiming “no other firm, corporation or association has the right to use the mark.” *Id.* ¶ 30, Ex. K at 5. The Church objects to Eller’s trademark use of MORMON MATCH because it has already created the false impression that his services are connected with, endorsed or sponsored by, or otherwise affiliated with the Church. *Id.* ¶ 31. Although Eller claims to be a “Mormon,” he never secured the Church’s permission to use or register the mark MORMON or the domain names “mormon-match.com” or “dateamormon.com.” *Id.* ¶ 32.

The Church has no objection to Eller’s operation of a dating service or to Eller’s fair use of the term “Mormon” to refer to members of the Church (e.g. “an online dating service for Mormons”). *Id.* ¶ 33. In fact, there are several other dating websites that provide dating services to members of the Church. Some of these use the term “Mormon” in a descriptive manner. However, unlike Eller, none of them have attempted to use or claim rights in the word “MORMON” as a trademark and none have attacked the validity of the Church’s marks. *Id.* ¶ 34. The Church does object to Eller’s unauthorized commercial use of MORMON MATCH as a trademark, service mark, trade name or domain name.

H. Eller’s Unauthorized Application to Register the Mark MORMON MATCH



Eller filed Application Serial Number 85/949670, for the mark  less than a year ago, on June 3, 2013. *Id.* ¶ 35. The application alleges that Eller intends to use the mark on “internet-based dating, social introduction and social networking services.” In his application, Eller declared under penalty of perjury that **“no other person, firm, corporation, or association has the right to use the mark in commerce.”** *Id.* ¶ 36.

In his Complaint and Motion for Temporary Restraining Order, Eller contradicts his prior declaration by asserting that MORMON MATCH is descriptive or generic. Moreover, Eller is clearly using MORMON MATCH as a service mark by displaying it as the most prominent feature and source identifier on the site.

Eller alleges that he has disclaimed the exclusive right to use the words, “MORMON MATCH.” However, in his PTO application he only disclaimed rights apart from the mark as shown. Moreover, if Eller obtains a registration for MORMON MATCH even with a disclaimer, he may at some point seek a registration without a disclaimer pursuant to 15 U.S.C. § 1052(f).

The application’s Examiner made no written finding that the words MORMON MATCH are generic or descriptive. And Eller’s website does not state that MORMON MATCH is descriptive or generic. *Id.* ¶ 37. If it did, any third party would be free to use those words on competing websites. Eller would not have filed this lawsuit unless he intended to use and claim rights in MORMON MATCH as a service mark.

I. Facts Relating to the Likelihood of Confusion

1. Eller’s Prior Knowledge of the Church’s Prior Registered MORMON Marks

IRI’s federal registrations for the MORMON Marks and the Temple Design Mark were a matter of public record in the PTO for many years prior to Eller’s application. *Id.* ¶ 38. Eller had constructive notice of the Church’s MORMON Marks before he applied to register MORMON MATCH. *See* 15 U.S.C. § 1072. If Eller conducted a search of the PTO’s online records before adopting his alleged mark, he had actual knowledge the Church’s registered MORMON Marks and the Church’s prior success in opposing applications containing the word MORMON listed below:

- *Intellectual Reserve, Inc. v. Sheets*, Opposition No. 91191016, for the mark SECRET MORMON, sustained on January 17, 2012;

- *Intellectual Reserve, Inc. et al. v. Harnett*, Opposition No. 91186284, for the mark MORMON CHICKS RULE, sustained on March 3, 2009; and
- *Intellectual Reserve, Inc. v. Book of Mormon Broadway Ltd.* IRI filed an extension of time to oppose Application No. 76714295, for the mark THE BOOK OF MORMON & Design. That application was abandoned on February 10, 2014 as result of the threatened opposition.

Id. ¶ 39, Ex. L.

2. The Similarity Between the Parties' Marks

The word MORMON is the first word and most dominant feature in Eller's alleged mark. *Id.* ¶ 40. Because the Church owns registrations for MORMON in combination with other words, people viewing Eller's site are likely to believe that his services are approved or endorsed by the Church. *Id.* The likelihood of confusion is enhanced by Eller's unauthorized use of the Salt Lake Temple photograph, which imitates the federally registered Temple Design Mark. *Id.* ¶ 41. Anyone seeing the word MORMON combined with the photograph will inevitably be misled into believing that Eller's services are approved, sponsored or endorsed by the Church.

3. The Similarity Between the Parties' Services

The Church's mark MORMON.ORG is registered for various services including many that are closely related to those listed in Eller's application, *e.g.*, "**promoting family values . . . and providing courses of instruction in the field of marital relations.**" *Id.* ¶ 42. The subject of dating falls within the scope of the instructional services provided by the Church on marital relations. *Id.* ¶ 43. While the Church does not offer a "dating service" per se, it offers dating guidelines and counseling services on dating and closely related subjects. *Id.* In addition, the Church provides social networking services under its MORMON.ORG mark through its website at <http://www.mormon.org/people/find>. *Id.* ¶ 44, Ex. M. The site allows users to select profiles of people by age, gender, location, name, ethnicity, previous religion and other keywords. Users also

may post photographs, profiles and contact information. *See*

<http://www.mormon.org/me/C4TX/Rosay>.

4. The Similarity in Prospective Customers

The potential customers to whom Eller intends to sell his service are members of the Church. *Id.* ¶ 45. Thus, there is direct overlap between those who obtain services under the Church's MORMON Marks and the intended targets of the services Eller offers under the infringing mark MORMON MATCH. *Id.*

5. The Similarity in Trade Channels

Both parties display their marks on and disseminate their services through websites. *Id.* ¶ 46. Thus, Eller's trade channels are identical to those in which IRI's marks are used.

6. Eller's Intent to Cause Confusion and Injure the Church

While Eller professes to be a Church member, he is deliberately using a counterfeit imitation of the MORMON Marks on his website, despite objections communicated by counsel on behalf of Church. *Id.* ¶ 47. Eller is pursuing his own financial interests at the expense of the Church. *Id.* ¶ 48. Eller's attack on the validity of the Church's federally registered MORMON Marks damages the Church and the goodwill symbolized by those marks. *Id.* ¶ 49.

7. The High Risk of Damage to IRI Posed by Eller's Uncontrolled Use of a Counterfeit MORMON Mark

Because Eller has not obtained a license from the Church, his use of MORMON MATCH will not be subject to quality control. *Id.* ¶ 50. Individuals who find deficiencies in or who are dissatisfied with Eller, his services or his site's content may develop feelings of ill will that will injure the goodwill symbolized by the Church's family of registered MORMON Marks. *Id.* ¶ 51.

8. Eller Will Not Be Damaged If He is Required to Adopt a New Trademark that Does Not Contain the Word “MORMON.”

Eller has not yet begun offering dating services under the mark MORMON MATCH. *Id.* ¶ 52. However, he is already providing social networking services and has begun to solicit customers. *Id.* ¶ 53. At this moment, there is no indication that Eller has an established business, or a single customer. *Id.* ¶ 54. Similarly, he apparently has no office or signage, and changing to a new name would impose no hardship on Eller.

There are an infinite number of ways for Eller to offer a dating service directed at Mormons, without using a trademark, service mark or trade name containing the word MORMON. For example, a dating service for Jews uses the mark JDATE with a number of descriptive phrases like “Meet Jewish Singles.” *Id.* ¶ 55, Ex. N. Eller could use MMATCH and similar descriptive phrases like “our site will help you meet Mormon singles.” *Id.* ¶ 56.

II. APPLICABLE LEGAL STANDARDS

Temporary injunctions are an exceptional type of relief. It is well established that a preliminary injunction may be granted only if the plaintiff establishes four elements: (1) a substantial likelihood of success on the merits; (2) a substantial threat that the movant will suffer irreparable injury if the injunction is denied; (3) that the threatened injury outweighs any damage that the injunction might cause the defendant; and (4) that the injunction will not disserve the public interest. *Guy Carpenter & Co. v. Provenzale*, 334 F.3d 459, 464 (5th Cir. 2003). To satisfy the burden of proof, Plaintiffs must *clearly establish* each of the four elements. *See Kern River Gas Transmission Co. v. Coastal Corp.*, 899 F.2d 1458, 1462 (5th Cir. 1990). Failure to make an adequate showing on one element is fatal to the motion. Here, Plaintiff cannot meet his burden on even *one* of the four elements.

III. ARGUMENT

A. Plaintiff Cannot “Clearly Establish” that He is Likely to Prevail on the Merits.

To establish entitlement to injunctive relief, Eller must “clearly establish” a negative: that his use of the mark MORMON MATCH is not infringing, *i.e.*, that the Church does *not* have protectable trademark rights in “MORMON” and that his proposed use of MORMON MATCH is *not* likely to cause confusion. Eller’s burden is exceptionally high, and he fails to meet it.

1. Eller Has Not and Cannot Rebut the Church’s Rights in its Well Known Family of Registered MORMON Marks.

a. The Church Enjoys Strong Trademark Rights in MORMON.

As shown above, the PTO has recognized the Church’s exclusive rights in a family of marks including the word MORMON alone and in combination with other words. All of these registrations are valid and subsisting, provide nationwide constructive notice of the Church’s claim of ownership in marks containing the word MORMON, and are prima facie evidence of the Church’s ownership of and exclusive right to use the MORMON Marks in commerce. Furthermore, Registration Numbers 1524555, 1527447, 2552030, 2766231, 2883572, 2913694, and 3239919 are more than five years old, incontestable, Taggart Decl. ¶ 12, and **conclusive** evidence of the Church’s ownership and exclusive right to use the marks. *See* Section I.E, *supra*.

b. Eller Has Mischaracterized the PTO’s Position with Regard to the MORMON Marks.

Although it is indisputable that the PTO has recognized the Church’s ownership of the MORMON Marks, Eller has disingenuously cited a Trademark Examiner’s rejection of the Church’s Application Serial Number 78/161091, seeking to register the mark MORMON for religious services, on the grounds that it was allegedly “descriptive” or “generic.”

This occurred over ten years ago in connection with the Church’s application. Although the Church did not appeal this refusal and the application was abandoned, this has no relevance to

the facts at issue in this case. The Church has obtained numerous other registrations of its MORMON Marks, for religious goods and services, both before and after that instance. Eller is seeking to use and register MORMON for a commercial venture involving services directly related to those covered by the Church's registered MORMON.ORG mark. Moreover, opinions expressed at the lowest level of the Patent and Trademark Office by an examiner have no precedential value. *See* Trademark Manual of Examining Procedure ("TMEP") § 1203.01 (2013) ("[A]n earlier [PTO] decision is insufficient to warrant the same finding in a future case"); TMEP § 1216.01 ("Trademark rights are not static, and eligibility for registration must be determined on the basis of the facts and evidence of record that exist at the time registration is sought."); *In re Loew's Theatres, Inc.*, 769 F.2d 764, 769 (Fed. Cir. 1985) (noting that "each application for registration of a mark for particular goods must be separately evaluated"). Such opinions are often tentative and are often changed.

The Church actually obtained Registration Number 3239919 for the mark MORMON for some of the services listed in application Serial Number 78/161091, *i.e.*, educational services including conferences in the field of religion. Because the Church offers educational services relating to dating, Eller's services are closely related to those offered by the Church under its MORMON Marks. The Church's registration for the mark MORMON is now incontestable and is conclusive evidence of the Church's ownership and exclusive right to use the mark MORMON. *See* 15 U.S.C. § 1115(b). Eller does not address this fact in his motion for temporary restraining order.

Eller also alleges that a trademark examiner *initially* refused registration of the mark in the Church's application Serial Number 77/179068 for "MORMON.ORG" on descriptiveness grounds. Again, he fails to disclose that the Church overcame the refusal and now owns registration for MORMON.ORG.

2. Eller's Use of MORMON MATCH Is Likely to Cause Confusion.

Eller has failed to meet his burden to show that his use of the mark "MORMON MATCH" is *not* likely to cause confusion. In determining whether a likelihood of confusion exists, courts in the Fifth Circuit consider the following nonexhaustive list of factors: (1) the type of trademark allegedly infringed, (2) the similarity between the two marks, (3) the similarity of the products or services, (4) the identity of the retail outlets and purchasers, (5) the identity of the advertising media used, (6) the defendant's intent, and (7) any evidence of actual confusion. *Roto-Rooter Corp. v. O'Neal*, 513 F.2d 44, 45 (5th Cir. 1975). Applying these factors to MORMON MATCH demonstrates that Eller's mark is likely to cause confusion.

The first factor, "type of trademark," refers to the strength of the senior mark. *Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188, 201 (5th Cir. 1998). Stronger marks are entitled to greater protection. *Amstar Corp. v. Domino's Pizza, Inc.*, 615 F.2d 252, 259 (5th Cir. 1980). Here, the PTO has concluded that the MORMON Marks are inherently distinctive with regard to some goods and services and they have acquired distinctiveness as to others. Moreover, because IRI owns a family of marks containing the word MORMON, the marks are entitled to broader protection than a single mark. *See J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 1462 (Fed. Cir. 1991).

As shown in Registration No. 3239919, the mark MORMON has been in use since at least as early as 1833. Millions of products bearing the MORMON Marks have been sold or distributed in the United States and millions have visited the Church's websites and seen or heard the MORMON Marks on television or in radio broadcasts and on printed materials. The Marks' strength is further evidenced by the Church's successful oppositions to other applications for marks containing the word MORMON filed by others who, like Eller, have tried to use the mark

for commercial purposes.³ These facts demonstrate that the MORMON Marks are strong and deserving of protection against junior users like Eller, who deliberately attempt to cause confusion.

Similarity of the marks, the second factor, “is determined by comparing the marks’ appearance, sound, and meaning,” *Elvis Presley Enters.*, 141 F.3d at 201, with emphasis on the “total effect rather than individual features.” *Quantum Fitness Corp. v. Quantum LifeStyle Ctrs., LLC*, 83 F. Supp. 2d 810, 822 (S.D. Tex. 1999) (citation omitted). Here, MORMON MATCH is sufficiently similar to the MORMON Marks to cause likelihood of confusion. “MORMON” is the dominant portion of MORMON MATCH, *i.e.*, the word MORMON is what people see and remember when looking at Eller’s webpage, thus making the mark virtually identical. *Country Floors, Inc. v. P’ship Composed of Gepner & Ford*, 930 F.2d 1056, 1065 (3d Cir. 1991) (when dominant portion of two marks is same, “confusion is likely.”), *cited by Quantum*, 83 F. Supp. 2d at 823. *Century 21 Real Estate Corp. v. Sandlin*, 846 F.2d 1175, 1179 (9th Cir. 1988) (identical dominant lead word in each entity’s name, “can foster confusion.”).⁴

Third, MORMON MATCH will be used on services similar to those offered by the Church under the MORMON Marks. Eller’s MORMON MATCH services, internet-based dating, social

³ The MORMON Marks’ history of success at the PTO definitively rebuts Eller’s unfounded claim that “‘Mormon’ has so transcended its identifying purpose that the Church cannot claim infringement as a matter of law.” In fact, the MORMON Marks’ registrations are evidence that their marks are protectable. *Amazing Spaces, Inc. v. Metro Mini Storage*, 608 F.3d 225, 237 (5th Cir. 2010) (“Registration of a [trade]mark with the PTO constitutes prima facie evidence [under the Lanham Act] of the mark’s validity and the registrant’s exclusive right to use the registered mark in commerce with respect to the specified goods or services.”); *Am. Heritage Life Ins. Co. v. Heritage Life Ins. Co.*, 494 F.2d 3, 10 (5th Cir. 1974) (“registration is prima facie evidence of the registrant’s ownership of the mark and of the registrant’s exclusive right to use the mark in commerce in connection with the services specified in the registration certificate”).

⁴ As set forth below, the fact that Eller’s registration “disclaims” the words MORMON and MATCH is irrelevant to the likelihood of confusion analysis. *See* Section 3 below.

introduction, and social networking, overlap with services offered by the Church, including but not limited to “courses of instruction in the field of marital relations,” listed in the Church’s MORMON.ORG registration.⁵ “The greater the similarity between products and services, the greater the likelihood of confusion.” *Elvis Presley Enters.*, 141 F.3d at 202. The services of MORMON MATCH (dating and social introduction) are also complementary with those offered under the MORMON Marks such as marital relations instruction and the social interaction features provided as part of the MORMON.ORG services. “Complementary products have been held particularly susceptible to confusion.” *Fuji Photo Film Co. v. Shinohara Shoji Kabushiki Kaisha*, 754 F.2d 591, 598 (5th Cir. 1985).

Regarding the fourth factor, Eller’s MORMON MATCH services are to be sold in the same channels of trade, most notably the Internet, and are offered to the same potential customers—Church members. As to the fifth factor, Eller’s use of the Internet websites as advertising media overlaps with the media used by the Church for its social networking and other dating-related services offered under the MORMON.ORG mark.

Regarding defendant’s intent, the sixth factor, there is no doubt that Eller chose the mark MORMON MATCH and an imitation of the Church’s registered Temple Design marks to trade on the goodwill associated with the MORMON Marks. “[T]he intent of defendants in adopting (their mark) is a critical factor, since if the mark was adopted with the intent of deriving benefit from the

⁵ By virtue of the MORMON Marks’ federal registrations, the Church’s exclusionary rights are not limited to the goods and services specified in the registration, but go to any goods or services on which the use of the mark is likely to cause confusion. *Pure Foods v. Minute Maid Corp.*, 214 F.2d 792, 796 (5th Cir. 1954) (“The remedies of an owner of a registered trade-mark ... extend to any goods on which the use of an infringing mark ‘is likely to cause confusion or mistake or to deceive purchasers as to the source of origin of such goods.’”) (quoting 15 U.S.C. §1114(1)); *Cont’l Motors Corp. v. Cont’l Aviation Corp.*, 375 F.2d 857, 861 (5th Cir. 1967) (“The remedies of the owner of a registered trademark are not limited to the goods specified in the certificate, but extend to any goods on which the use of an infringing mark is ‘likely to cause confusion ...’ Confusion ... not competition, is the real test of trademark infringement.”).

reputation of (the plaintiff,) that fact alone may be sufficient to justify the inference that there is confusing similarity.” *Am. Rice, Inc. v. Producers Rice Mill, Inc.*, 518 F.3d 321, 332 (5th Cir. 2008) (citation omitted).

The seventh factor also weighs heavily against Eller’s claim that his unauthorized use of MORMON will not cause confusion. Despite the fact that Eller has not yet launched his dating services, there is already evidence of actual confusion as to affiliation between his MORMON MATCH service and the Church. The following comments appeared on the current version of the MORMON MATCH website www.dateamormon.com as of April 28, 2014:

- “We are in the LDS church ... you know the one that is meant to seal you for time and all eternity. That should be the goal of an [sic] so-called LDS site. I’m glad that this truly seems like it will be run by someone who is actually LDS not a company using LDS in the title to earn money off of us.”
- “Hello, I am new to this site. I have read a lot of comments and I am happily getting the impression that is a legit [sic] LDS site. :)”
- “This is a site you can trust. If you are having problem finding that right person or you have suffered lots of turn downs, here is the answer to all suck [sic] kinds of problems. This is purely **Latter Day Saints**. You can be sure of having that desired person in your life.”
- “While I like that this is LDS operated, the same basic pool of people are the target. ...”
- “I am far from perfect & I am afraid that being on a Mormon site will have men scanning for the ‘perfect Mormon wife.’”
- Please have them put in there MEMBERSHIP NUMBER SO THEY CAN JOIN, WITHOUT IT PLEASE DONT ALLOW ANYONE TO JOIN. I pay on cite related to members and encounter with lots of so call MORMONS. That just my take for this site.”
- “...I think there should be away that non-member (non-LDS) can’t get access to this whole site. once again, this is really great and it should be for only Mormons.”
- “There should be a feature where you could put your Membership Record Number so that you can really tract [track] if they are really LDS or not.”
- “I think a great feature would be to have a church member confirmation like putting in the member ID you get when you are baptized and confirmed. This I think will put trust into

knowing who I am looking at or talking to is a confirmed member and not a non member signing up on every site they can think of with bad intentions...”

- “I think you have to come up with some way to be sure that the people on the site are truly LDS. I don’t know of anything except a membership number...”

(Taggart Decl. ¶ 57, Ex. O).

Thus, all of the Fifth Circuit’s confusion factors weigh in favor of a finding that Eller’s use of MORMON MATCH is likely to cause confusion, and to falsely suggest a connection with the Church or its beliefs, thereby diluting the distinctive quality of the Church’s MORMON marks. *See CICCorp., Inc. v. AIMTech Corp.*, 32 F. Supp. 2d 425, 438 (S.D. Tex. 1998) (“Fifth Circuit precedent is clear that *even a minority* of [factors] favoring a finding of likelihood of confusion will suffice.”) (emphasis added).

The cases cited by Eller do not support his contention that his use of MORMON MATCH will not cause confusion. For example, in *General Conference Corp. of Seventh-Day Adventists v. Seventh-Day Adventist Kinship, Int’l, Inc.*, No. CV 87-8113 MRP, 1991 WL 11000345 (C.D. Cal. Oct. 7, 1991), the court rejected the defendant’s allegation that it was entitled to rely on the fair use defense. Ultimately, the court declined to find infringement but only because defendants were using the name to identify themselves as gay and lesbian Seventh Day Adventists. Unlike Eller, defendants in that case had not applied to register their name as a trademark for a dating service or for any type of service. Similarly, unlike Eller, they had not declared under penalty of perjury to the Patent and Trademark Office that no other person or entity had the right to use their name.

3. Eller’s “Affirmative Defenses” Are Invalid.

a. Eller’s Disclaimer of the Words “Mormon” and “Match” Does Not Defeat Likelihood of Confusion and May Promote Confusion.

After filing his application to register MORMON MATCH, Eller voluntarily entered a disclaimer of exclusive rights in the words “Mormon” and “Match” apart from the mark as shown

in the application. He suggests, without any supporting authority, that these disclaimers (which the public never sees) are evidence that MORMON MATCH will not cause confusion. Eller's claim is unfounded because the entry of disclaimers in a PTO application is not relevant to the likelihood of confusion analysis. Eller's disclaimer of the words "Mormon" and "Match" does not "cure"—or otherwise impact—likelihood of confusion. *In re Nat'l Data Corp.*, 753 F.2d 1056, 1059 (Fed. Cir. 1985) ("[A] disclaimer in [an] application to register [a] mark has no legal effect on the issue of likelihood of confusion. The public is unaware of what words have been disclaimed during prosecution of the trademark ..."); *see also* 3 J. Thomas McCarthy, *Trademarks and Unfair Competition* § 19:72 (4th ed. 1998) ("For purposes of determining the likelihood of confusion concerning a registered composite mark of which portions [have been] disclaimed, the disclaimed matter cannot be ignored.") (hereinafter "McCarthy").

Even if MORMON MATCH was descriptive, it would have the potential to acquire secondary meaning and qualify for registration without a disclaimer under 15 U.S.C. § 1052(f). *See Texas Pig Stands, Inc. v. Hard Rock Cafe Int'l, Inc.*, 951 F.2d 684, 691 (5th Cir. 1992) (holding that 1930 state court decision that "pig sandwich" did not have secondary meaning did not bar a claim in 1990 that the mark had attained secondary meaning: "While 'pig sandwich' may not have had a secondary meaning in 1930 ... the jury finding to the contrary sixty years later affirms that a factual change has perhaps altered the basis upon which *Dixiepig* depended.").⁶ Any such result would dilute the Church's rights in the MORMON marks.

⁶ *See also Cont'l Motors Corp.*, 375 F.2d at 862 (held erroneous for trial judge to rely on earlier decision denying trademark protection to "continental" as geographic term where "economic fact[s]" had changed and remanded for further consideration of whether term had acquired secondary meaning).

b. “Mormon Match” is Not A Generic Term.

A generic term refers to the class of which a good or service is a member. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992). MORMON MATCH is not a generic term because it does not refer to any class of services. Online social networking and dating services are not generically referred to as Mormon Match. As used by Eller, MORMON and MATCH together form a unitary mark, not a generic term. *See Ass’n of Co-op Members, Inc. v. Farmland Indus., Inc.*, 684 F.2d 1134, 1140 (5th Cir. 1982) (unprotectable words “may, when used in combination, become a valid trademark”).

c. Eller Has Not Used the Mark MORMON MATCH in Good Faith.

Eller has further alleged that his use of MORMON was in good faith, preventing a finding of infringement. As an initial matter, good faith is not a defense to trademark infringement. *Fuji Photo Film Co.*, 754 F.2d at 596 (“The reason for this is clear: if potential purchasers are confused, no amount of good faith can make them less so. Bad faith ... may, without more, prove infringement.”), *citing Amstar Corp.*, 615 F.2d at 263 (finding that trial court erred in basing “no confusion” determination on fact that trademark use was in good faith).

Contrary to his representations Eller adopted MORMON MATCH in bad faith for his own commercial gain and with a willful intent to deceive customers into believing he has the approval of the Church. First, the federal registrations of the MORMON Marks put Eller on constructive notice of the Mormon Marks, and he undoubtedly had actual knowledge of the Church’s rights because the registrations are a matter of public record. Knowledge of marks is a factor that weighs against a finding of good faith. While “good faith” is not well-defined in the trademark infringement case law, it has been held that an inference of a lack of good faith may be drawn from defendant’s use of a mark with “the intent to ‘trade upon and dilute the good will’ represented by the plaintiff’s mark.” *Dow Brands, L.P. v. Helene Curtis, Inc.*, 863 F. Supp. 963,

970 (D. Minn. 1994), *citing* McCarthy § 11.17. Moreover, an alleged infringer's knowledge also gives rise to an inference of bad faith. *See id.*

Eller's reliance on *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786 (5th Cir. 1983) to argue fair use is misplaced. That case was expressly abrogated by the Supreme Court in *KP Permanent Makeup, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 121 (2004) (holding that, contrary to Fifth Circuit's ruling in *Zatarains*, "some possibility of consumer confusion must be compatible with fair use").

d. Eller's Use of "Mormon" Is Not Fair Use.

"Fair use" is typically an affirmative defense asserted by a trademark infringement defendant. It arises where the allegedly infringing term is used "in good faith to describe [a defendant's] goods or services, but only in actions involving descriptive terms and only when the term is used in its descriptive sense rather than in its trademark sense." *See Sugar Busters LLC v. Brennan*, 177 F.3d 258, 270-71 (5th Cir. 1999); *see also* 15 U.S.C. § 1115(b)(4). A fair use defense is established if a defendant proves that its use is "(1) other than as a mark, (2) in a descriptive sense, and (3) in good faith." *Compliance Review Servs., Inc. v. Callista Davis-Osuawu*, C.A. No. H-04-3635, 2006 WL 2385291 at *5 (S.D. Tex. Aug. 17, 2006), *citing Int'l Stamp Art, Inc. v. U.S. Postal Serv.*, 456 F.3d 1270, 2006 WL 1982685, at *3 (11th Cir. July 8, 2006) (quoting *EMI Catalogue P'ship v. Hill, Holliday, Connors, & Cosmopolos, Inc.*, 228 F.3d 56, 64 (2d Cir. 2000)). *See also Soweco, Inc. v. Shell Oil Co.*, 617 F.2d 1178, 1185 (5th Cir. 1980). Eller fails each element of this test. *See* Sections I.G, I.H, III.A.3.c, *supra*.

Eller is using MORMON MATCH and an imitation of the Temple Design as trademarks and service marks to distinguish his service from those of others. Thus, his use is not fair use.

B. Eller Will Not Suffer Irreparable Injury If His Motion is Denied.

As the moving party, Eller bears a heavy burden of establishing that he will suffer irreparable harm absent an injunction. *Watchguard Techs., Inc. v. Valentine*, 433 F. Supp. 2d 792, 794 (N.D. Tex. 2006), *citing Enter. Int'l, Inc. v. Corporacion Estatal Petrolera Ecuatoriana*, 762 F.2d 464, 472 (5th Cir. 1985). “Irreparable harm requires a showing that: (1) the harm to Plaintiff is imminent; (2) the injury would be irreparable; and (3) that Plaintiff has no other adequate legal remedy.” *Gonannies, Inc. v. Goaupair.com, Inc.*, 464 F. Supp. 2d 603, 608 (N.D. Tex. 2006), *citing Chacon v. Granata*, 515 F.2d 922, 925 (5th Cir. 1975)). As the Fifth Circuit has observed, “it is not so much the magnitude but the *irreparability* [of the threatened harm] that counts for purposes of a preliminary injunction.” *Dennis Melancon, Inc. v. City of New Orleans*, 703 F.3d 262, 279 (5th Cir. 2012) (citation omitted) (quoting *Enter. Int'l, Inc.*, 762 F.2d at 472), *cert. denied*, 133 S. Ct. 2396 (2013).

An injury is not irreparable if it can be adequately remedied by money damages. *Id.* (“Mere injuries, however substantial, in terms of money, time and energy necessarily expended in the absence of [an injunction], are not enough. The possibility that adequate compensatory or other corrective relief will be available at a later date, in the ordinary course of litigation, [weighs] heavily against a claim of irreparable harm.”) (quoting *Morgan v. Fletcher*, 518 F.2d 236, 240 (5th Cir. 1975)); *see also DFW Metro Line Servs. v. Sw. Bell Tel. Co.*, 901 F.2d 1267, 1269 (5th Cir. 1990) (per curiam) (“There can be no irreparable injury where money damages would adequately compensate a plaintiff.”); *Keane v. Fox Tel. Stations, Inc.*, Civ. No. H-03-1642, 2003 WL 22331255, at *2 (S.D. Tex. May 16, 2003) (denying plaintiff’s ex parte TRO motion in part based on plaintiff’s inability to show damages insufficient to compensate plaintiff if he were to prevail).

Eller will not be irreparably injured if the Court denies his request for a temporary restraining order. Eller has not yet begun providing services and will suffer no harm even if he is

precluded from doing so under the mark MORMON MATCH during the pendency of this proceeding. Indeed, www.dateamormon.com currently has no customers and generates no revenue because the website is not yet providing dating services.

In addition, denial of immediate injunctive relief will not preclude Eller from offering online dating services to members of the Church under a non-infringing name, something he could have elected to do from the start. Eller complains that changing the name of his dating service will destroy the customer goodwill and business reputation he has developed over two years of promoting “Mormon Match.” *Pltf’s First Memo. of Law in Support of Mot. for Temporary Restraining Order*, ECF No. 10 at 11. These threatened injuries are not irreparable. Eller cannot claim “total loss” of a business that has been in development for a short time period and that has not begun offering any dating services. The Fifth Circuit has recognized that “lost goodwill of a business operated over a short period of time is usually compensable in money damages.” *DFW Metro Line Servs.*, 901 F.2d at 1269 n.7 (loss of customer goodwill not irreparable where DFW Metro had only been in business for one and a half years at the time suit was filed).⁷ In addition, Eller offers no evidence, other than conclusory statements contained in affidavits, to show that he will be unable to market online dating services to members of the Church under a different, non-infringing name. *See White v. Carlucci*, 862 F.2d 1209, 1211 (5th Cir. 1989) (“Without question, the irreparable harm element must be satisfied by independent proof, or no injunction may issue.”); *Enter. Int’l, Inc.*, 762 F.2d at 474 (lower court’s finding that plaintiff’s reputation and

⁷ The cases Eller cites in support of his argument that loss of business goodwill constitutes irreparable harm are from other jurisdictions and involve readily distinguishable facts. In *Medicine Shoppe International, Inc. v. S.B.S. Pill Dr., Inc.*, 336 F.3d 801, 805 (8th Cir. 2003), for example, the court found that a franchisor, Medicine Shoppe, would suffer irreparable harm absent an injunction barring a franchisee from de-identifying as a Medicine Shoppe pharmacy where the franchisee had been operating under the Medicine Shoppe name for over 25 years.

goodwill in the marketplace would be irreparably harmed was “speculative” and “without evidentiary support”).

In short, Eller will not suffer irreparable harm if the Court denies his motion because his dating service is not yet operational and thus has no customer base and generates no revenue. Any alleged loss of business goodwill that will result from operating the online dating service under a different, non-infringing name is capable of being quantified and may be compensated in money damages. Accordingly, Eller has failed to satisfy his burden of demonstrating irreparable harm, and his request for a temporary restraining order must be denied.

C. Eller’s Alleged Threatened Injury Does Not Outweigh the Harm that an Injunction Would Cause the Church.

In addition to demonstrating a likelihood of success on the merits and irreparable harm (which he cannot do), Eller must show that the balance of the hardships favors granting injunctive relief. *Dennis Melancon, Inc.*, 703 F.3d at 268. Eller is unable to satisfy this burden because Eller’s use of the MORMON MATCH mark is already causing actual confusion and will cause the Church irreparable harm. This harm outweighs any alleged threatened harm to Eller.

Eller’s MORMON MATCH mark will cause irreparable injury because the Church has no control over the quality of the services he offers and, therefore, is unable to control its goodwill and reputation, thereby causing the Church irreparable harm. *See* Section I.I.7; *see also Quantum Fitness Corp.*, 83 F.Supp.2d at 831 (“When a likelihood of confusion exists, the plaintiff’s lack of control over the quality of the defendant’s goods or services constitutes an immediate and irreparable injury ...”).⁸ By contrast, Eller’s alleged harm is adequately compensated by money

⁸ *See also Chemlawn Servs. Corp. v. GNC Pumps, Inc.*, 690 F. Supp. 1560, 1569 (S.D. Tex. 1988) (“Likelihood of confusion due to the subsequent use of the confusingly similar mark ... causes irreparable harm.”), *aff’d*, 856 F.2d 202 (Fed. Cir. 1988); *Am. Rice, Inc.*, 532 F. Supp. at 1389 (loss of control as to quality of infringing competitor’s goods constituted “immediate, irreparable harm”); 5 McCarthy § 30:47 (irreparable injury flows from showing of likely confusion).

damages and is not irreparable. *See Dennis Melancon, Inc.*, 703 F.3d at 279. Because Eller's alleged threatened harm is outweighed by the harm an injunction would cause the Church, Eller's request for temporary injunctive relief should be denied.

D. An Injunction Permitting "MORMON MATCH" to Move Forward as a Commercial Business Venture Will Disserve the Public Interest.

Granting Eller's request for injunctive relief will disserve the public, which has a significant interest in being free from deception or confusion. *Augusta Nat'l, Inc. v. Exec. Golf Mgmt., Inc.*, 996 F. Supp. 492, 499 (D.S.C. 1998) (public's right "to be free from the deception that results from [misuse of a] trademark is transcendent"); *Opticians Ass'n of Am. v. Independent Opticians of Am. Eyeglasses*, 920 F.2d 187, 197, 17 U.S.P.Q.2d 111 (3d Cir. 1990) ("Public interest ...in a trademark case ... is most often a synonym for the right of the public not to be deceived or confused."); *Advantus Capital Mgmt., Inc. v. Aetna, Inc.*, 81 U.S.P.Q.2d 1743, 2006 WL 2916840 at *6 (D. Minn. 2006) ("The public has an interest in protecting intellectual property and preventing consumer confusion."). If Eller is permitted to launch business activities under the mark MORMON MATCH, the public will be deceived and confused into believing that there is a connection between the Church and his business venture. *See Quantum Fitness Corp.*, 83 F. Supp. 2d at 832 (noting that "[t]he public interest is always served by requiring compliance with ... the Lanham Act and by enjoining the use of infringing marks" and that protecting a "valid trademark from infringement by a junior user does not disserve the public interest.").

CONCLUSION

For all of the reasons stated above, the Church requests that Eller's request for a temporary restraining order be denied.

Dated: April 29, 2014

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CERTIFICATE OF SERVICE

I hereby certify that on April 29, 2014, I electronically transmitted the attached document to the Clerk of Court using the ECF System for filing and transmittal of Notice of Electronic Filing to the following ECF registrants:

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Exhibit K

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF TEXAS
HOUSTON DIVISION

JONATHAN ELLER, as partner of
the de facto partnership, Mormon Match,

Plaintiff,

v.

INTELLECTUAL RESERVE, INC.,
a Utah Corporation, holding intellectual
property for The Church of Jesus Christ
of Latter-day Saints,

Defendant.

CIVIL ACTION NO.: 14-CV-00914

**REPLY MEMORANDUM OF LAW IN SUPPORT OF *EX PARTE* MOTION FOR
TEMPORARY RESTRAINING ORDER AND PRELIMINARY INJUNCTION**

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NATURE AND STAGE OF THE PROCEEDING

This case is about who owns the word “Mormon.” Defendant Intellectual Property, Inc. (“IRI”) claimed to completely own “Mormon,” and tried to shut down Plaintiff’s business for using the word. Plaintiff seeks injunctive and declaratory relief.

Plaintiff is a Mormon. He is also a member of Mormon Match, LLC f/k/a Mormon Match (“Mormon Match”), which he has promoted for over two years. Mormon Match wants to run a Mormon dating website at dateamormon.com (the “Dating Website”). The Dating Website uses the word Mormon to describe its dating services. It also displays a photograph of the Salt Lake Temple, which many Mormons associate with marriages between Mormons. Mormon Match has license rights to the photograph.

IRI tried to shut down the Dating Website. It said that:

1. “The term MORMON and images of the Salt Lake Temple are . . . owned by IRI.”
2. “IRI has not given the owners of www.dateamormon.com permission to use the term MORMON or any image of the Salt Lake Temple”
3. “. . . [U]se of the term MORMON and an image of the Salt Lake Temple in a branding fashion constitute trademark and/or trade name infringement”
4. “. . . [U]se of the term MORMON and/or an image of the Salt Lake Temple constitute unfair competition”

[Dkt. 9-7]. After more than two years of promotion, IRI now insists that Mormon Match build a new business, stop using “Mormon,” and stop displaying a licensed photograph.

Plaintiff asks the Court to protect it from IRI shutting down Mormon Match’s business. Plaintiff’s Verified Complaint also asks for a declaration that the Dating Website can describe dating services as “Mormon,” call itself “Mormon Match,” and display a licensed photograph of the Salt Lake Temple.

This Motion for Temporary Restraining Order and Preliminary Injunction (the “Motion”) is not about trademark rights to Mormon Match’s logo. That trademark does not exist because IRI moved to block registration. This motion is also not about “Mormon” as a “service mark.” Many Mormon dating websites have “Mormon” or temple drawings in their logos. This motion is about IRI’s claims to own “Mormon” and a photograph. IRI opposed injunctive relief, [Dkt. 24], and this Reply follows.

IRI now sues Plaintiff for trademark infringement, unfair competition, and cybersquatting. IRI also asks for a declaratory judgment blocking registration of Mormon Match’s logo. [Dkt. 23] That claim entirely duplicates claims IRI already made in an ongoing trademark proceeding. Arguments about the logo’s registration are properly made in that proceeding, where IRI faces a motion to dismiss.

STATEMENT OF THE ISSUES TO BE RULED UPON BY THE COURT

The issue before the Court is narrow: whether the Court should restrain and enjoin IRI from shutting down the Dating Website for using the word “Mormon” and a licensed photograph. The factors considered are: (1) Plaintiff’s likelihood of success on the claim that the Dating Website can use the word “Mormon” and display a Salt Lake Temple photograph; (2) Plaintiff’s threat of irreparable injury if IRI shuts down the Dating Website; (3) whether IRI faces greater injury if the Court stops IRI from shutting down the Dating Website; and (4) whether the injunction serves the public interest. *Byrum v. Landreth*, 566 F.3d 442, 445 (5th Cir. 2009).

SUMMARY OF THE ARGUMENT

The Court should issue relief. Plaintiff shows likely success on the merits, substantial threat of irreparable harm, a favorable balance of equities, and public interest.

Nobody completely owns “Mormon,” which is often generic or merely descriptive. IRI does not have rights to “Mormon” or all images of the Salt Lake Temple in online dating or social introduction. Marks are enforced for the goods and services where they are registered or used. None of IRI’s marks are registered or used for those online dating. Even if IRI once had such rights in online dating (it never did), it failed to police or abandoned those rights as numerous dating websites brand as “Mormon.”

Plaintiff is likely to succeed on the claim that the Dating Website can use the word “Mormon” and a licensed image of the Salt Lake Temple. Trademark infringement requires a likelihood of confusion, not a mere possibility of confusion. Here there is no likelihood of confusion. A multifactor analysis only confirms this. Regardless, Mormon Match’s use of “Mormon” is nominative or statutory fair use.

Without an injunction, Plaintiff faces total loss of business, which is irreparable. This injury is also irreparable because damages are difficult to calculate. Plaintiff’s business should not be subject to the whims of IRI’s lawyers. IRI has no right to force Plaintiff to abandon a name and Internet domain he spent two years building, and start a new business from scratch under a new name and Internet domain.

The equities favor Plaintiff. Mormon Match faces an existential threat to its business. IRI does not suffer at all. Many dating websites brand as Mormon. One more does not harm IRI. Further, the Dating Website’s content is not infringing.

Finally, the public interest favors an injunction. IRI's legal theories would put at risk nearly every religiously themed commercial website. Moreover, there is a public interest in preventing trademark bullying. The injunction should issue.

IRI's other speculations and accusations about Plaintiff's motivations, sincerity, and religious faith are demonstrably false, baseless, or irrelevant. The Court should disregard these comments attacking Plaintiff without advancing a legal argument.

ARGUMENT

I. IRI Does not Own the Word Mormon

All words are not equal in the eyes of trademark law. Words like "Mormon" get limited protection as "generic" or "merely descriptive." *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 11 (2d Cir. 1976).

Mormon is often generic because it means a "genus" or group, as in "I'm a Mormon," instead of a specific person or source, as in "I am President Barrack Obama." Mormon is also often descriptive, because it can describe nouns. For example, "Mormon Church" informally means the Church of Jesus Christ. However "Mormon doctrine," "Mormon studies," "Mormon blog," and "Mormon Match" do not mean the Church of Jesus Christ. "Mormon" can describe many nouns besides the Church.

"Mormon" is merely descriptive for online dating. It has not acquired secondary meaning as it doesn't identify "a single thing coming from a single source." *Aloe Crème Labs. Inc. v. Milsan, Inc.*, 423 F.2d 845, 849 (5th Cir. 1970).

Recent examiner opinions denying registration of "THE MORMON

MATCHMAKER” state that “Mormon” is merely descriptive for online dating¹ (there the applicant disclaimed “MATCHMAKER”). An April 23, 2012 office action explained:

- (i) “Mormon” as “an intended user or group of users of a product or service is merely descriptive.” *In re Planalytics, Inc.*, 70 USPQ2d 1453 (TTAB 2004) (GASBUYER merely descriptive of intended user of services for pricing and purchasing natural gas); *In re Camel Mfg. Co.*, 222 USPQ 1031 (TTAB 1984) (MOUNTAIN CAMPER merely descriptive of intended users of services for outdoor equipment and apparel).
- (ii) Owners of descriptive marks should not “inhibit[] competition in the marketplace and . . . [bring] costly infringement suits” *In re Abcor Dev. Corp.*, 588 F.2d 811, 813, 200 USPQ 215, 217 (C.C.P.A. 1978).
- (iii) “Businesses and competitors should be free to use descriptive language . . . in advertising and marketing materials.” *In re Styleclick.com Inc.*, 58 USPQ2d 1523, 1527 (TTAB 2001).

Exhibit 1 to accompanying Declaration of Siddhartha Rao dated May 5 (“Rao Decl.”). A later office action rejected the applicant’s claims of acquired distinctiveness, and reiterated that “THE MORMON MATCHMAKER” is merely descriptive because it “clearly references the nature of the services and the intended users of the services.” (Rao Decl. Ex. 2). Similarly, trademark examiners have found “LDS” descriptive for social networking. LDS, meaning “Latter-day Saint” or “Mormon,” also describes the users of such services. (Rao Decl. Exs. 3 and 4). Merely descriptive terms do not get trademark protection. Nobody owns “Mormon” for online dating.²

¹ These examiner opinions apply settled law to substantially the same facts. While not precedential, there are no contrary examples, and these opinions should be considered highly indicative of the result of applying trademark law to the facts here.

² Other “Mormon” marks have been denied Principal Register registration as descriptive (e.g. “Mormon Savings,” and “Mormon in Manhattan”). (Rao Decl. Exs. 5–6).

II. IRI has not Established Trademark Rights for Online Dating

As IRI's cases confirm, registration provides evidence of rights only for "specified goods or services." *Amazing Spaces, Inc. v. Metro Mini Storage*, 608 F.3d 225, 237 (5th Cir. 2010); *Am. Heritage Life Ins. Co. v. Heritage Life Ins. Co.*, 494 F.2d 3, 10 (5th Cir. 1974) (same). IRI's "MORMON" trademarks are not registered for online dating or introduction and do not evidence rights for those services.

IRI's further admits "the Church does not offer a 'dating service'". [Dkt. 24 p. 9]. Yet IRI imagines Mormon.org is like a dating service because it profiles Mormons. By analogy, the law firm websites of IRI's attorneys are like dating services because they profile lawyers.³ The primary purpose of Mormon.org is outreach to "investigators," or non-Mormons considering conversion. *Mormon.org's Redesign Connects Members and Investigators*, THE CHURCH (September 15, 2010).⁴ This is why Mormon.org provides no way to contact profiled Mormons, a *sine qua non* of introduction and dating, but does let visitors "chat" online with missionaries. *See*, Bosker, Bianca, *Hook of Mormon: Inside the Church's Online-Only Missionary Army*, THE HUFFINGTON POST (April 14, 2014) (describing conversion after chats with Mormon.org missionaries).⁵ IRI also strains to equate "educational services related to dating" and "instruction in . . . marital relations" to dating and social introductions. [Dkt. 24 p. 9]. This is like saying an etiquette class teaching proper table manners provides a similar service as a restaurant, or a place to eat. These arguments are unavailing.

³ *See*, Profile of attorney Michael Grow: <http://www.arentfox.com/people/michael-grow>; profile of attorney Robert Schick: <http://www.schickcopeland.com/attorney/robert-m-schick/>.

⁴ <https://www.lds.org/church/news/mormonorgs-redesign-connects-members-and-investigators>.

⁵ http://www.huffingtonpost.com/2014/04/09/mormon-church-online_n_5024251.html.

IRI asserts some of its marks are “incontestable.” This has nothing to do with the strength of the marks. *Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031 (TTAB 2010) (incontestability establishes presumed validity, not strength); *Oreck Corp. v. U.S. Floor Sys., Inc.*, 803 F.2d 166, 171 (5th Cir.1986), *cert. denied*, 481 U.S. 1069 (1987) (same); *Lone Star Steakhouse & Saloon, Inc. v. Alpha of Va., Inc.*, 43 F.3d 922, 934 (4th Cir.1995) (same); *Miss World (U.K.) Ltd. v. Mrs. America Pageants, Inc.*, 856 F.2d 1445, 1448-49 (9th Cir.1988) (same). IRI also contends the “family” of “MORMON” marks confers strength. The family of marks doctrine applies only if the common element is strong, and does not itself establish strength. *Aloe Crème Labs., Inc.*, 423 F.2d at 848 (granting protection to weak family marks risks giving a monopoly); *Victoria Secrets Brand Management v. Sexy Hair Concepts*, 2009 WL 955795 (S.D.N.Y. 2009) (family of incontestable marks held weak for descriptiveness).

A strong mark is “rarely” used by third parties, while a weak mark is “often used by other parties.” *Exxon Corporation v. Texas Motor Exchange of Houston*, 628 F.2d 500, 504 (5th Cir.1980). “Mormon” is a weak mark often used by other parties. As Mormon writer Jana Riess states: “‘Mormon’ is how we Mormons find each other [online]. It’s probably how you found this blog post.” Riess, Jana, *Who Owns the Name Mormon*, RELIGION NEWS SERVICE (April 24, 2014);⁶ *see*, Matchar, Emily, *Why I Can’t Stop Reading Mormon Housewife Blogs*, SALON (Jan. 15, 2011).⁷ Because IRI’s marks are weak for online dating, IRI can’t stop others from using “Mormon” in online dating.⁸

⁶ <http://janariess.religionnews.com/2014/04/24/owns-word-mormon/>.

⁷ http://www.salon.com/2011/01/15/feminist_obsessed_with_mormon_blogs/.

⁸ IRI downplays five years of examiner findings that prevented it from broadly trademarking Mormon. The examiner allowed IRI to trademark Mormon.org only after

Even if IRI once had trademark rights in online dating (it never did), it has lost those rights by failure to police and abandonment. Thomas McCarthy, McCarthy On Trademarks And Unfair Competition § 17:8 (2007); *Exxon Corp. v. Oxxford Clothes, Inc.*, 109 F.3d 1070, 1080 (5th Cir.1997) (abandonment is “loss of trade significance” from widespread use). Many dating websites have logos with “Mormon,” including:

Name	Logo
The Mormon Matchmaker themormonmatchmaker.com	
Meet Mormon Singles meetmormonsingles.com	
Local Mormon Singles localmormonsingles.com	
Mormon Matchmaking mormonmatchmaking.com	
My Mormon Crush mymormoncrush.com	

IRI has not complained about these websites. Similarly, IRI never communicated any objections to Plaintiff during his two years of promotion and one year of website hosting.

IRI has singled out Plaintiff of all Mormon dating websites. IRI claims this is because no other business has applied for trademark. The Mormon Matchmaker did apply for a trademark. IRI also can't prohibit “Mormon” in online dating logos.

IRI represented it would be for services similar to the narrow services of “Mormon.” Now IRI improperly attempts to argue its Mormon.org mark is broadly protectable.

III. The Court Should Grant Injunctive Relief

A. Plaintiff Establishes Likelihood of Success on the Merits

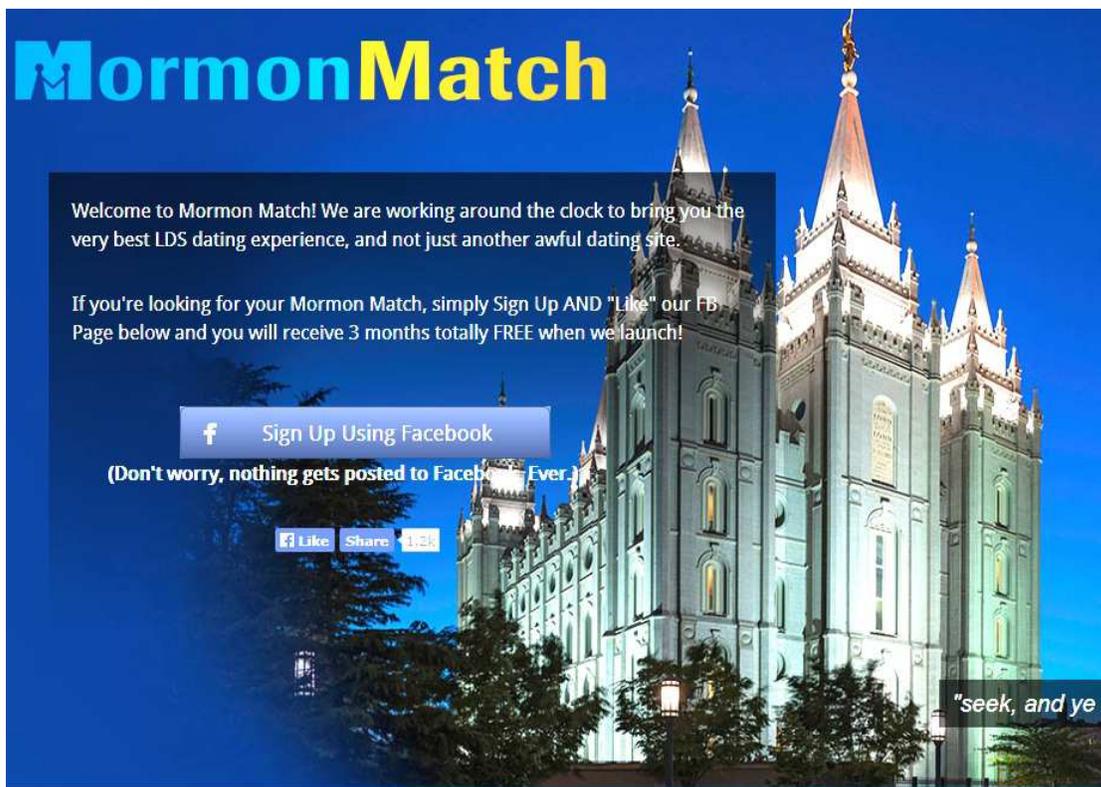
Trademark infringement requires likelihood of confusion. Mormon Match's content will not confuse customers and is not infringing. Courts in the Fifth Circuit look at a "nonexhaustive" list of eight likelihood of confusion factors: (1) the type of trademark (strong or weak); (2) mark similarity; (3) product similarity; (4) outlet and purchaser identity; (5) advertising media identity; (6) defendant's intent; (7) actual confusion; and (8) care exercised by potential purchasers. *Xtreme Lashes, LLC v. Xtended Beauty, Inc.*, 576 F.3d 221, 227 (5th Cir. 2009). "No one factor is dispositive," and "a court is free to consider other relevant factors." *Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188, 194 (5th Cir. 1998). Likelihood of confusion requires "a probability," not mere possibility. See *Xtreme Lashes*, 576 F.3d at 226.

All factors support plaintiff: (1) IRI's marks are weak. (2) Where the common element is weak, similarity is reduced.⁹ (3) IRI and the Church do not offer online dating services. (4) Mormon.org is directed at non-Mormons for conversion while the Dating Website is directed at Mormons for dating. (5) IRI's marks are not advertised on online dating websites. (6) Mormon Match is not trading on the Church's good will. The Dating Website displays a notice that Mormon Match is not commercially affiliated with the Church. (7) IRI reviewed thousands of comments posted to the Dating Website and found no confusion. (8) Mormon Match's Mormon purchasers know the Church as "The Church of Jesus Christ of Latter-day Saints," a logo appearing on Church websites.

⁹ See, e.g., *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986) (BED & BREAKFAST REGISTRY for making reservations in private homes held not likely to be confused with BED & BREAKFAST INTERNATIONAL for room booking agency services).

IRI disingenuously misrepresents comments referring to the Dating Website as an “LDS” website. As IRI knows, the acronym “LDS” means Latter-day Saint and is largely synonymous with “Mormon.” If IRI sincerely believed “LDS” indicates confusion, it would have stopped LDS branded websites, including dating websites like LDS Singles (www.ldssingles.com), LDS Planet (www.ldsplanet.com), LDS Mingle (www.ldsmingle.com), LDS Pals (www.ldspals.com), LDS Passions (www.ldspassions.com), etc. IRI deliberately misrepresents facts because it lacks any real argument. The comments show demand for a Mormon-run Mormon dating service.

Similarly, as IRI admits, many Mormons desire to be married in Mormon Temples. [Dkt. 24-1 at ¶ 22]. Mormons associate the Salt Lake Temple with marriage between Mormons. This is not confusing. Yet IRI repeatedly accuses Plaintiff of “imitating” its Temple Design Marks. To be clear, IRI says that this photograph





is “imitating” this drawing:

Mormon Match uses a licensed photograph of the Salt Lake Temple on a Dating Website. (See accompanying affidavit of Jonathan Eller, sworn to May 5, 2014 (“Eller Aff.”) at ¶ 48). IRI has trademarked a drawing for “printed instructional manuals” and “video recordings” featuring religious subject matter. There is no likelihood of confusion.

IRI now repeatedly accuses Plaintiff of using a “counterfeit” Mormon mark as a service mark. IRI’s speculations are irrelevant because nominative fair use protects Plaintiff’s use. *Pebble Beach Company v. Tour 18 I Limited*, 155 F.3d 526, 545 (5th Cir.1998); *see also, Board of Supervisors for Louisiana State University v. Smack Apparel Company*, 550 F.3d 465, 488 (5th Cir.2008) (recognizing nominative fair use defense). Plaintiff’s use is nominative fair use because it only uses the necessary word “Mormon,” (and not “Mormon Tabernacle Choir,” “Mormon Handicraft,” or “Mormon Church”) and a notice on the Dating Website negates any suggestion of Church affiliation, sponsorship, or endorsement. *Smack Apparel*, 550 F.3d at 489.

Plaintiff’s use is also protected statutory fair use. *See, Venetianaire Corp. v. A & P Import Co.*, 429 F.2d 1079, 1081–82 (5th Cir. 1970). Statutory fair use protects good faith use of descriptive terms in their descriptive rather than trademark sense, *Sugar Busters LLC v. Brennan*, 177 F.3d 258, 271 (5th Cir. 1999), and stops a trademark owner from “appropriat[ing] a descriptive term for his exclusive use and so prevent[ing] others from accurately describing a characteristic of their goods,” *Soweco, Inc. v. Shell Oil Co.*, 617 F.2d 1178, 1185, 1186–87 (5th Cir. 1980).

Plaintiff's reliance on *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786 (5th Cir. 1983) is proper, as its discussion of fair use remains valid. *Zatarains* also held that fair use does not apply when there is a likelihood of confusion. This latter holding was abrogated when the Supreme Court held that fair use *can* apply *even where there is a likelihood of confusion*, as Plaintiff also argues in its moving papers. *KP Permanent Makeup, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 121 (2004). It is unclear what IRI means by pointing this out since these cases support Plaintiff's position.

B. Plaintiff Establishes Irreparable Harm Absent Relief

Destruction of business constitutes irreparable injury. *Nat'l Screen Serv. Corp. v. Poster Exchange, Inc.*, 305 F.2d 647 (5th Cir.1962) (affirming preliminary injunction where denial would result in the destruction of movant's business). Here, IRI insists Mormon Match abandon its name, abandon its website, abandon its brand, and build a new business from scratch after two years of promotion. Although IRI compares this to a change of signage, it is an irreparable destruction of Plaintiff's business.

IRI argues business loss is compensable with money damages. However, "[a] substantial loss of business may amount to irreparable injury if the amount of lost profits is difficult or impossible to calculate" *Florida Businessmen v. City of Hollywood*, 648 F.2d 956, 958 n. 2 (5th Cir.1981)). Here, IRI insists Plaintiff start a new business from scratch before Mormon Match has had a chance to launch and build a revenue stream. Accordingly, it will be difficult to calculate lost profits.

IRI also speculates Plaintiff could provide dating services under a different name. This argument misses the point that Plaintiff has a right to use the name he has been promoting for two years, and there is no basis to force him to start a new business

with a different name. Plaintiff's competitors will presumably continue to brand as "Mormon," purchase advertising in "Mormon" and even trade on the Plaintiff's good will, as they will not face the restrictions IRI wants to put on Plaintiff.

IRI argues that "JDate.com" successfully provides dating services to Jews without using the word "Jew" or "Jewish" in its brand. JDate also has purchased AdWords for Jewish Matchmaking, which directs searches of "Jewish Match" to its website. (Rao Decl. Ex. 7). If Plaintiff is forced to abandon Mormon brand and domain names, any new business he starts will also require ongoing increased advertising costs, while his competitors do not face such costs. Moreover, Jewish Match, Muslim Match, and Catholic Match are active dating websites with seemingly no confusion.

IRI says that Plaintiff does not face harm because "in the course of their continuing settlement discussions, IRI has agreed to maintain the status quo for the time being," and "IRI will not seek to have the website taken down." As the Court is aware the status quo agreement expired the day IRI made this representation. IRI is now perfectly capable of acting to shut down the Dating Website.

Just a month ago, IRI claimed to own the word Mormon and tried to end Plaintiff's business. Now it has apparently changed its mind. It makes no argument for total ownership of Mormon in its opposition. IRI can change its mind again. Plaintiff's business should not be subject to the whims of IRI's lawyers.

Finally, IRI says that Plaintiff faces no threat because IRI couldn't shut down the Dating Website the first time it tried. IRI's failure does not preclude a second attempt. IRI has sued Plaintiff for trademark infringement, unfair competition, and cybersquatting, and apparently believes it has the right to shut down the Dating Website.

C. The Equities Favor Plaintiff

The balance of equities clearly favors Plaintiff. The harm to Plaintiff of losing his business is clear. IRI suffers no harm. Plaintiff's mere existence cannot be harm when Mormon Match would be just one more of many dating websites branded as Mormon. Further, the Dating Website is not infringing and does not harm IRI.

D. The Public Interest Favors an Injunction

IRI's arguments would put at risk nearly every religiously themed website or online community. Moreover, IRI earnestly argues that Eller should have behaved like others who abandoned their trademark applications in the face of IRI's claims to own "Mormon." This is not a legal argument. It is, however, strongly suggestive of trademark bullying, and IRI's financial motive to stop a judgment that would prevent IRI from further bullying. Prevention of trademark bullying is in the public interest. In 2010 President Obama tasked the Department of Commerce to study the extent to which small businesses may be harmed by abusive trademark enforcement tactics.¹⁰ Accordingly, the public interest favors issuing a restraining order and injunction.

IV. The Court Should Disregard or Strike IRI's Accusations and Speculations

Plaintiff's reasons for starting this action are fully explained by uncontested facts. Plaintiff tried to talk to IRI's lawyers to settle several times. IRI's lawyers never responded. Instead IRI tried to shut down the Dating Website and servers. The Court should disregard IRI's conspiracy theories because they are not necessary to

¹⁰ See, Report to Congress, *Trademark Litigation Tactics and Federal Government Services to Protect Trademarks and Prevent Counterfeiting* (April 2011), available at: http://www.uspto.gov/ip/TMLitigationReport_final_2011April27.pdf.

explain Plaintiff's actions. Eller simply wants to run a business lawfully and benefit the Latter-day Saint community. (Eller Aff. ¶¶ 22-38). He does not enjoy this litigation which has already resulted in smears to his reputation, accusations of apostasy, and other negative reactions within the Mormon community. (Eller Aff. ¶¶ 52-56). He sought protection because IRI forced him with an existential business threat. (Eller Aff. ¶ 51).

IRI submits a declaration of Barry Taggart claiming personal knowledge that Eller is "deliberately . . . pursuing his own financial interests at the expense of the Church," [Dkt. 24-1 at ¶¶ 47-48]. Eller has never met or spoken to Taggart. (Eller Aff. at ¶ 53). The Court should strike Taggart's statements about Plaintiff's intentions as hearsay and not the best evidence. Plaintiff is available as a declarant.

IRI's other accusations are false or irrelevant. Eller and his business partners created Mormon Match's logo. (Eller Aff. ¶ 39). This means "no other firm, corporation or association has the right to use" it. Eller did not commit perjury when he told the truth. Eller is not asking to own the words "Mormon" or "Match." He is simply trying to stop other people from copying Mormon Match's logo. (Eller Aff. ¶ 41).

Finally, although IRI repeatedly questions Eller's faith, this Court cannot decide that religious issue. *See, McClure v. Salvation Army*, 460 F.2d 553, 558-60 (5th Cir. 1972) (Court lacks jurisdiction over ecclesiastical issues). IRI's insinuations have no bearing on the fact that Eller is a Mormon launching a business for Mormons that can be fairly described as "Mormon." This is a case about secular law and IRI's claims to own "Mormon." It is not a case about whether Eller is a good enough Mormon for IRI. Nonetheless, IRI has utterly failed to contradict or discredit Eller's sworn testimony that he is, in fact, a devout Mormon.

CONCLUSION

For each and every one of the foregoing reasons, Plaintiff respectfully requests that injunctive relief issue restraining and enjoining defendant Intellectual Reserve, Inc. from interfering with Plaintiff's use of the Dating Website.

Respectfully submitted,

/Siddartha Rao/
Siddartha Rao, Esq.
Counsel for Plaintiff
Admitted *pro hac vice*
121 E. 12th St. Apt. LG
New York, New York 10003
(646) 221 1846

Kiernan McAlpine, Esq.
Local counsel for Plaintiff
(Admitted in the Southern
District of Texas)
3310 Louisiana St Ste 2413
Houston, TX 77006
(832)314-1383
Fax: (832)201-7814

Exhibit L

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF TEXAS
HOUSTON DIVISION

JONATHAN ELLER, as partner of
the de facto partnership, Mormon Match,

Plaintiff,

v.

INTELLECTUAL RESERVE, INC.,
a Utah Corporation, holding intellectual
property of the Church of Jesus Christ
of Latter-day Saints,

Defendant.

CIVIL ACTION NO.: 14-CV-00914

**AFFIDAVIT OF JONATHAN ELLER IN SUPPORT OF *EX PARTE*
MOTION FOR TEMPORARY RESTRAINING ORDER AND INJUNCTION**

JONATHAN ELLER, being duly sworn, deposes:

1. I am a member of Mormon Match LLC f/k/a Mormon Match (“Mormon Match”) and am Plaintiff in this action, acting on behalf of Mormon Match.

My Background

2. My parents raised our family out of severe poverty.
3. I have always been grateful for their example and been personally driven to make a difference.
4. I attended public schools in Spring, Texas and completed my first year of college at the University of Texas at Austin.

5. I left University of Texas after my freshman year to serve a full-time two year mission for the Church in Venezuela, a life altering experience filled with both miracles, and extreme deprivation.

6. When I returned home from my mission, I decided to transfer to Sam Houston State University to save money and also to specialize in Criminal Justice.

7. I completed my bachelor's degree in 2006, with honors, and began graduate work in 2009. I am currently working towards a Masters in Public Administration.

My Career

8. As an intern for the FBI, I was awarded the FBI Award of Excellence by the Houston SAC (Special Agent in Charge) for services rendered.

9. This was based mostly on the internal confidential publication I authored that detailed every aspect of a local Houston gang that I was tasked with researching, representing months of work.

10. As a salesman, I have achieved quotas quarterly and annually and received many awards for doing so.

11. Above and beyond raw numbers, I have received several awards for working as a team member and supporting others.

12. I have been promoted to roles of leadership to train and teach my colleagues, and I consider that an honor.

13. I'm proud of the career that I've built, especially considering the humble beginnings that my family comes from.

My Community Involvement

14. I am a Wish Grantor for the Make A Wish Foundation.

15. I've been actively volunteering there since early 2013 and currently have seven kids that I'm working for on their wishes.

16. These wishes range from trips to Disney World and Hawaii, shopping sprees, trips to the Vatican to meet the Pope, and others.

17. Being able to love and support and give to these children with life-threatening illness is worth every effort and it has made a special impact on me.

18. Aside from Make a Wish, I have worked as a volunteer fireman off and on for the past sixteen years.

19. I started with my brothers when I turned fifteen, and have continued that service even as far as completing EMT courses and other specialized training to serve my local community.

20. I volunteered at Station 75 for six years, and have worked at other stations in the Spring Volunteer Fire Department as I have relocated for work and school.

21. I also drive for Meals on Wheels on occasion, volunteer in the kitchens at the Star of Hope Mission, and actively serve in my local LDS congregation.

Founding Mormon Match

22. I have been a part of dozens of business ventures, some successful, and many unsuccessful, and learned many important lessons in founding, marketing, operating, funding, and managing a business.

23. I'm glad to have been able to support many of my friends and colleagues in their own business ventures as well.

24. I am, myself, an LDS Single. I have been divorced now for roughly five years.

25. I am active in my faith, I possess an "active temple recommend," and I attend church meetings, activities, and events.

26. It has been a great challenge finding active Mormon women within my age range and preferences on my own, so I began dating online.

27. I tried the popular non-LDS dating sites, but found very few Mormon women.

28. I then tried several Mormon themed dating sites and found that there were more Mormons, but the websites weren't always staying true to Mormon values and it was hard to find the right match.

29. I discovered that the owners and founders of those websites sometimes sold to larger conglomerates, so the LDS standards weren't always kept up.

30. I saw that there really didn't exist a safe popular place for Mormons to find a similar match online.

31. Thus, Mormon Match was born.

32. I found a need, I had an audience, and I was highly personally motivated.

33. I did exhaustive research on every single dating website I could find, online keyword search analysis, ran the numbers, worked the projections, wrote the business plan, and presented it to friends for their opinions.

34. The response was overwhelmingly positive.

35. I concluded that Mormon Match perfectly describes what my business does, who it serves (Mormons), and offers me online search engine optimization and descriptiveness, both key elements for a successful online marketing strategy.

36. The name “Mormon Match” was officially born in my kitchen after several months of research and consideration.

37. I consider Mormon Match my best entrepreneurial achievement, and I’ve spent the last two years employing my skills and talents, and those of a select group of professionals, to help Mormon Match become not a only a successful business, but also a forum for good.

38. Creating a forum that will help my single Mormon brothers and sisters find their match brings me more joy that I can express. I’m going to help people I love find their spouses, and marry in the Temple.

My Trademark Application

39. I worked with Mormon Match members to design a logo for the business.

40. I am not a lawyer and had not hired a lawyer when I applied for a trademark.

41. I applied for the trademark for one reason: I didn’t want anyone else to copy me.

42. I knew this was a really good idea, and thought that the other dating sites would copy everything I was proposing to do.

43. I believe several of the features and functions that Mormon Match will offer will change online dating for the better, forever.

44. I never imagined the Church would take notice, let alone target me.

45. Before I applied for a trademark, I knew that dozens of dating sites already existed using both the words Mormon and LDS.

46. I assumed they also had trademarks.

47. I and my business partners decided to show a photo of the Salt Lake Temple on the website because we are trying to help Mormons meet Mormons to marry in the Temple.

48. We purchased a license to the photograph from iStock.

Starting this Case

49. This case has been a tremendous struggle, not only legally, but personally.

50. When this first started, I tried to reach out to the IRI in several different ways on many occasions, to no response or reply.

51. When IRI tried to shut my website down, I was floored.

52. I was upset to see IRI's arguments filled with personal attacks that call into question my faith and motivations.

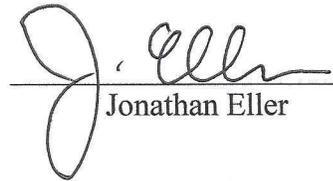
53. I do not know Barry Taggart, and have never met him or spoken to him.

54. My faith has not wavered, despite this lawsuit and personal attacks.

55. I've received hate mail, emails calling me an apostate, anonymous comments calling me sleazy and slimy, questioning me about awful things because I'm divorced, and accusing me of unsubstantiated wrongdoing.

56. The damage to my reputation is hurtful. My reputation is key to Mormon Match being a successful dating site.

5/5/2014
Date


Jonathan Eller

STATE OF: TEXAS
COUNTY OF: Harris

Before me, a notary public in and for Harris County, came the affiant, Jonathan Eller, who stated that the facts contained in this affidavit are true upon affiant's own knowledge, information, or belief, and that affiant believes this information to be true.


Notary Public
Harris County, Texas

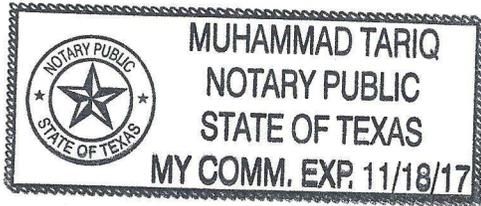


Exhibit M

To: Tristen Ure (tristenure@gmail.com)
Subject: U.S. TRADEMARK APPLICATION NO. 85367530 - THE MORMON MATCHMAKER - N/A
Sent: 4/23/2012 4:29:12 PM
Sent As: ECOM105@USPTO.GOV
Attachments:

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

APPLICATION SERIAL NO. 85367530

MARK: THE MORMON MATCHMAKER

85367530

CORRESPONDENT ADDRESS:

TRISTEN URE
10 LAPIS AVE
DANA POINT, CA 92629-2971

CLICK HERE TO RESPOND TO THIS LETTER:
http://www.uspto.gov/trademarks/teas/response_forms.jsp

APPLICANT: Tristen Ure

CORRESPONDENT'S REFERENCE/DOCKET

NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

tristenure@gmail.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 4/23/2012

THIS IS A FINAL ACTION.

This Office action is in response to applicant's communication filed on April 5, 2012. The applicant submitted additional information about the goods and a disclaimer of the term "MATCHMAKER."

The information requirement has been satisfied. TMEP §§713.02, 714.04.

The refusal under Trademark Act Section 2(e)(1) is now made FINAL for the reasons set forth below. *See* 15 U.S.C. §1052(e)(1); 37 C.F.R. §2.64(a).

SECTION 2(E)(1) – MERELY DESCRIPTIVE FINAL REFUSAL

For the reasons set forth below, the refusal of registration because the proposed mark merely describes features of applicant's services is made FINAL. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); TMEP §§1209 *et seq.*

The applicant has applied to register the mark THE MORMON MATCHMAKER for "Marriage partner introduction or dating services." In the initial Office action, the examining attorney determined that the mark was merely descriptive of the services because the mark identifies the function and intended users of the services, i.e. bringing together two unmarried Mormons in an attempt to promote marriage. To support the descriptiveness finding, the examining attorney attached dictionary definitions and pages from applicant's website.

Applicant has disclaimed the term "MATCHMAKER." In the response, applicant admits that the services are directed towards those of the Mormon faith, but argues that the services are still unique.

The examining attorney has reviewed the applicant's position on the descriptiveness issue, but remains unpersuaded. For the reasons stated below, the examining attorney maintains the refusal of registration based on Trademark Act Section 2(e)(1).

A mark that describes an intended user or group of users of a product or service is merely descriptive. *E.g., In re Planalytics, Inc.*, 70 USPQ2d 1453 (TTAB 2004) (holding GASBUYER merely descriptive of intended user of risk management services in the field of pricing and purchasing natural gas); *In re Camel Mfg. Co.*, 222 USPQ 1031 (TTAB 1984) (holding MOUNTAIN CAMPER merely descriptive of intended users of retail and mail order services in the field of outdoor equipment and apparel); *see* TMEP §1209.03(i).

As conceded in the response to the Office action, the mark identifies the intended users of the services. Further, the mark identifies the function of the services.

Two major reasons for not protecting descriptive marks are (1) to prevent the owner of a descriptive mark from inhibiting competition in the marketplace and (2) to avoid the possibility of costly infringement suits brought by the trademark or service mark owner. *In re Abcor Dev. Corp.*, 588 F.2d 811, 813, 200 USPQ 215, 217 (C.C.P.A. 1978); TMEP §1209. Businesses and competitors should be free to use descriptive language when describing their own goods and/or services to the public in advertising and marketing materials. *See In re Styleclick.com Inc.*, 58 USPQ2d 1523, 1527 (TTAB 2001).

In light of the evidence of record in this case, the examining attorney finds that consumers who encounter the applicant's mark in commerce in the context of the identified goods would immediately perceive the wording THE MORMON MATCHMAKER identifying matchmaking services for Mormons. Accordingly, for the above reasons, the examining attorney again concludes that the applied-for mark is merely descriptive of the identified services, and is unpersuaded by the applicant's arguments to the contrary. Therefore, the refusal to register under Section 2(e)(1) is hereby maintained.

Response Options

The applied-for mark has been refused registration on the Principal Register. Applicant may respond by

amending the application to seek registration on the Supplemental Register. *See* 15 U.S.C. §§1052(f), 1091.

Supplemental Register

To amend the application to the Supplemental Register, applicant must request such an amendment. TMEP §816.01; *see* 15 U.S.C. §1091; 37 C.F.R. §2.47. Registration on the Supplemental Register does not afford all the benefits of registration on the Principal Register. Specifically, registration on the Supplemental Register does not offer:

- The presumptions under Section 7(b) and (c), e.g. validity ownership, exclusive right to use, and constructive use;
- Incontestability after 5 years use;
- Publication for opposition in the Official Gazette or subject to TTAB opposition proceedings;
- or
- Section 42, which allows posting of trademark registrations with Customs to prevent imports of infringing goods.

However, it does provide the following advantages:

- The registrant may use the registration symbol ®;
- The registration is protected against registration of a confusingly similar mark under Trademark Act Section 2(d);
- The registrant may bring suit for infringement in federal court; and
- The registration may serve as the basis for a filing in a foreign country under the Paris Convention and other international agreements.

See 15 U.S.C. §§1052(d), 1091, 1094; TMEP §815.

Advisory: Disclaimer on the Supplemental Register

Applicant is advised that, if the application is amended to seek registration on the Supplemental Register, applicant must keep the disclaimer of “MATCHMAKER” because such wording appears to be generic in the context of applicant’s services as discussed in the previous Office action. *See* 15 U.S.C. §1056(a); *In re Wella Corp.*, 565 F.2d 143, 196 USPQ 7 (C.C.P.A. 1977); *In re Creative Goldsmiths of Wash., Inc.*, 229 USPQ 766 (TTAB 1986); TMEP §1213.03(b).

A “disclaimer” is a statement that applicant does not claim exclusive rights to an unregistrable component of a mark; it does not affect the appearance of the mark. TMEP §1213. An unregistrable component of a mark includes wording and designs that are generic of the services, and is wording or an illustration that others would need to use to describe or show their services in the marketplace. 15 U.S.C. §1052(e); *see* TMEP §§1209.03(f), 1213.03 *et seq.*

The following is the standardized format for a disclaimer:

No claim is made to the exclusive right to use “MATCHMAKER” apart from the mark as shown.

TMEP §1213.08(a)(i).

RESPONSE GUIDELINES

Because of the legal technicalities involved in this application, applicant may wish to hire an attorney specializing in trademark or intellectual property law. For attorney referral information, applicant may consult the American Bar Association's Consumers' Guide to Legal Help at <http://www.abanet.org/legalservices/findlegalhelp/home.cfm> or a local telephone directory. The USPTO cannot aid in the selection of an attorney. 37 C.F.R. §2.11.

If applicant does not respond within six months of the date of issuance of this final Office action, the application will be abandoned. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). Applicant may respond to this final Office action by:

- (1) Submitting a response that fully satisfies all outstanding requirements, if feasible; and/or
- (2) Filing an appeal to the Trademark Trial and Appeal Board, with an appeal fee of \$100 per class.

37 C.F.R. §§2.6(a)(18), 2.64(a); TBMP ch. 1200; TMEP §714.04.

In certain rare circumstances, a petition to the Director may be filed pursuant to 37 C.F.R. §2.63(b)(2) to review a final Office action that is limited to procedural issues. 37 C.F.R. §2.64(a); TMEP §714.04; *see* 37 C.F.R. §2.146(b); TBMP §1201.05; TMEP §1704 (explaining petitionable matters). The petition fee is \$100. 37 C.F.R. §2.6(a)(15).

If applicant has questions regarding this final Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. *See* 37 C.F.R. §2.191; TMEP §§709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) in this final Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. *See* TMEP §§705.02, 709.06.

TEAS PLUS APPLICANTS MUST SUBMIT DOCUMENTS ELECTRONICALLY OR SUBMIT FEE: Applicants who filed their application online using the reduced-fee TEAS Plus application must continue to submit certain documents online using TEAS, including responses to Office actions. *See* 37 C.F.R. §2.23(a)(1). For a complete list of these documents, *see* TMEP §819.02(b). In addition, such applicants must accept correspondence from the Office via e-mail throughout the examination process and must maintain a valid e-mail address. 37 C.F.R. §2.23(a)(2); TMEP §§819, 819.02(a). TEAS Plus applicants who do not meet these requirements must submit an additional fee of \$50 per international class of goods and/or services. 37 C.F.R. §2.6(a)(1)(iv); TMEP §819.04. In appropriate situations and where all issues can be resolved by amendment, responding by telephone to authorize an examiner's amendment will not incur this additional fee.

/Tashia Bunch Henderson/
Trademark Examining Attorney
Law Office 105
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tashia.bunch@uspto.gov

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/ mailing date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at <http://tarr.uspto.gov/>. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/teas/eTEASpageE.htm>.

To: Tristen Ure (tristenure@gmail.com)
Subject: U.S. TRADEMARK APPLICATION NO. 85367530 - THE MORMON MATCHMAKER - N/A
Sent: 4/23/2012 4:29:16 PM
Sent As: ECOM105@USPTO.GOV
Attachments:

IMPORTANT NOTICE REGARDING YOUR TRADEMARK APPLICATION

Your trademark application (Serial No. 85367530) has been reviewed. The examining attorney assigned by the United States Patent and Trademark Office (“USPTO”) has written a letter (an “Office Action”) on 4/23/2012 to which you must respond. Please follow these steps:

1. **Read** the Office letter by clicking on this [link](#) **OR** go to <http://tportal.uspto.gov/external/portal/tow> and enter your serial number to [access](#) the Office letter.

PLEASE NOTE: The Office letter may not be immediately available but will be viewable within 24 hours of this e-mail notification.

2. **Respond** within 6 months, calculated from 4/23/2012 (*or sooner if specified in the Office letter*), using the Trademark Electronic Application System [Response to Office Action form](#). If you have difficulty using the USPTO website, contact TDR@uspto.gov.

3. **Contact** the examining attorney who reviewed your application with any questions about the content of the office letter:

/Tashia Bunch Henderson/
Trademark Examining Attorney
Law Office 105
571-272-3941
tashia.bunch@uspto.gov

WARNING

Failure to file any required response by the applicable deadline will result in the [ABANDONMENT](#) of your application.

Do NOT hit “Reply” to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses. Instead, please use the Trademark Electronic Application System [Response to Office Action form](#).

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this **APPLICANT'S MEMORANDUM OF LAW IN OPPOSITION TO OPPOSER'S MOTIONS TO AMEND OPPOSITION AND EXTEND TIME**, with accompanying **DECLARATION OF SIDDARTHA RAO IN SUPPORT OF APPLICANT'S MEMORANDUM OF LAW IN OPPOSITION TO OPPOSER'S MOTIONS TO AMEND OPPOSITION AND EXTEND TIME** and **EXHIBITS** thereto is being filed electronically to the Trademark Trial and Appeal Board through the Electronic System for Trademark Trials and Appeals (ESTTA) on May 12, 2014.

/Siddartha Rao/
Siddartha Rao, Esq.

CERTIFICATE OF SERVICE

I hereby certify that on May 12, 2014 a copy of the foregoing **APPLICANT'S MEMORANDUM OF LAW IN OPPOSITION TO OPPOSER'S MOTIONS TO AMEND OPPOSITION AND EXTEND TIME**, with accompanying **DECLARATION OF SIDDARTHA RAO IN SUPPORT OF APPLICANT'S MEMORANDUM OF LAW IN OPPOSITION TO OPPOSER'S MOTIONS TO AMEND OPPOSITION AND EXTEND TIME** and **EXHIBITS** thereto was served on Intellectual Reserve, Inc. by electronic transmission as mutually agreed upon by the parties (37 CFR § 2.119(6)) by transmitting the foregoing to the following e-mail addresses:

- (1) Michael Grow <grow.michael@arentfox.com>;
- (2) Douglas Bush <bush.doug@arentfox.com>;
- (3) Dale Hulse <dhulse@kmclaw.com>; and
- (4) Eileen Henry <henrye@arentfox.com>

/Siddartha Rao/
Siddartha Rao, Esq.