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

Proceeding	91215064
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE
THE TRADEMARK TRIAL AND APPEAL BOARD**

INTELLECTUAL RESERVE, INC., a Utah Corporation,		
v.	Opposer,	In the matter of Application Serial No. 85/949670
JONATHAN ELLER, as partner of the de facto partnership, Mormon Match,	Applicant.	Mark: MORMON MATCH (and Design) Published in the <i>Official Gazette</i> of October 29, 2013 Opposition No. 91215064

**APPLICANT'S MOTION TO DISMISS NOTICE OF OPPOSITION
AND MEMORANDUM OF LAW IN SUPPORT**

Jonathan Eller, an individual, in his capacity as partner of the *de facto* partnership Mormon Match (the "Applicant") hereby files this Motion to Dismiss under Rule 12(b)(6) of the Federal Rules of Civil Procedure, seeking an order (i) dismissing in its entirety, with prejudice, and without leave to amend, claims for false suggestion of a connection, priority and likelihood of confusion, and dilution in the Notice of Opposition No. 91215064 (the "Opposition"); (ii) denying Opposer's requested relief; (iii) declaring that Opposer is not and will not be damaged by registration of Applicant's mark; (iv) declaring the Opposition frivolous and otherwise improper under applicable rules; and (v) awarding Applicant any and all appropriate relief as the Trademark Trial and Appeal Board (the "Board") deems just and proper.

PROCEDURAL HISTORY

Mormons Jonathan Eller and Matthew LaPointe¹ founded Mormon Match to run a dating website for Mormons, currently at www.dateamormon.com. On June 3, 2013 Jonathan Eller filed application Serial No. 85/949,670 (the “Application”) for registration of the mark “MORMON MATCH (and Design)” (the “Design Mark”). The Application as amended expressly disclaims the words “MORMON MATCH” apart from the design and published for opposition in the *Official Gazette* of October 29, 2013. On November 5, 2013, Intellectual Reserve, Inc. (“IRI”) moved to extend its time to oppose. IRI eventually filed its Opposition on February 4, 2014.

The Opposition alleges IRI owns intellectual property used by the Church of Jesus Christ of Latter-day Saints (the “Church”)² and also owns all “right, title, and interest” in the word “Mormon” for an unspecified “variety of goods and services.” It cites seven registered marks wholly dissimilar to the Design Mark and for different goods and services, but which also use the word “Mormon.” The Opposition speculates that the Design Mark will cause false suggestion of connection, priority and likelihood of confusion, and dilution based on IRI’s ownership of marks and recitation of 15 paragraphs of bare legal conclusions.³ The only well-pled factual allegations IRI makes are that it owns seven marks using the word “Mormon, which word is also part of the Design Mark. These are insufficient to state any claim to oppose registration of the Design Mark. This Motion to Dismiss follows.

¹ Jonathan’s family has been affiliated with the Church for at least five generations, and co-founder Matthew’s family includes Mormon pioneers.

² (Opposition ¶ 2). IRI’s definition of “Opposer” as inclusive of all affiliated legal entities, affiliates, and predecessors of itself and the Church is ambiguous.

³ These appear to be cut-and-paste versions of other oppositions filed by IRI. *See e.g.* Opposition Nos. 91191016, 91190150, and 91186461,

PRELIMINARY STATEMENT AND STATEMENT OF FACTS

For almost two centuries, the word “Mormon” has generally described a set of religious and cultural traditions stemming from the teachings of Joseph Smith and the adherents to these traditions, specifically Latter-day Saints. This word and related terms have been a part of public discourse and the public domain for almost as long. Yet by its Opposition, IRI now insists that nobody can accurately market goods and services with the descriptive word “Mormon.” IRI’s Opposition is plainly meritless.

Mormon Match is a business started by Mormons to operate a dating website for Mormons (See www.dateamormon.com).⁴ The website displays the Design Mark, incorporating the word “Mormon,” not as a mark, but accurately in its ordinarily accepted meaning. The Design Mark consists of “MORMON” in blue above “MATCH” in gold, with the “M” in “MORMON” showing man and woman stick figures holding hands:



IRI speculates this design displayed on an online dating website will somehow confuse and deceive Mormons into believing the Church runs a dating website.⁵

⁴ The Application recites Internet-based dating, social introduction and social networking services as services for which the mark will be used.

⁵ This website contains a notice stating: “Mormon Match is not commercially affiliated with or endorsed by The Church of Jesus Christ of Latter-day Saints.” (See www.dateamormon.com.)

IRI bases these speculations on its ownership of seven marks, including word marks and design marks. IRI also alleges total ownership of the word “Mormon.” For ready reference, the Design Mark is displayed side by side with the word “Mormon” and specimens of IRI’s claimed marks below.⁶

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)

⁶ The Board may take judicial notice of these specimens on this motion as contained in the Application and Opposition, and moreover as “capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned.” Fed. R. Evid. 201(b); *Continental Airlines Inc. v. United Air Lines Inc.*, 53 USPQ2d 1385, 1393 n.5 (TTAB 1999).

	<p>MORMON TABERNACLE CHOIR</p>	<p>Word/Design (Class 9 and 41) (Registered 9/23/2003)</p>
		<p>Word/Design (Class 9 and 16) (Registered 12/21/2004)</p>
	<p>“MORMON HANDICRAFT”</p>	<p>Word (Class 24) (Registered 2/14/1989)</p>
	<p>“MORMON HANDICRAFT”</p>	<p>Word (Class 42) (Registered 2/28/1989)</p>

Notably, outside of the common incorporation of the word “Mormon,” none of these marks are similar in any way to the Design Mark. Moreover, none are registered for the same or similar goods and services as recited in the Application (class 45 for “Internet-based dating, social introduction, and social networking services.”)

This is unsurprising, as IRI was legally prevented from registering “MORMON” in class 45 of goods and services concerning application serial number 78/161091. In that proceeding, numerous office actions 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).⁷ Because of weakness as a source-identifying term, IRI’s trademark in the word “MORMON” was narrowly restricted to a small range of services: Educational services, namely, providing classes, conferences, and institutes in the fields of history and religion, under class 41 and “genealogy services” under class 42. IRI abandoned “MORMON” for class 45 services after an appeal of the examining attorney's final refusal.

Further, even if “Mormon” ever had a source identifying purpose, the term has long ago transcended that identifying purpose by entering public discourse and becoming an integral part of public vocabulary.⁸ “Mormon” has developed a cultural significance that goes far beyond identification of goods or services produced or marketed by IRI or

⁷ The Board may take judicial notice of these findings and may consider them in deciding this motion. *See, e.g., Kaempe v. Myers*, 367 F.3d 958, 965 (D.C. Cir. 2004) (taking judicial notice of “documents recorded by the PTO” because “the cited documents are public records subject to judicial notice on a motion to dismiss”).

⁸ In 1892 Leo Tolstoy famously remarked to the then U.S. foreign minister to Russia that Mormonism is “the American religion.” Well-known American literary critic Harold Bloom used this remark in the title of his 1992 book *THE AMERICAN RELIGION: THE EMERGENCE OF A POST-CHRISTIAN NATION* (New York: Simon and Shuster, 1992), which featured a discussion of Mormonism as the “quintessential” American religion. American writer Jon Krakauer echoes that view, writing that Mormonism “is now widely considered the quintessential American religion.” JON KRAKAUER, *UNDER THE BANNER OF HEAVEN: A STORY OF VIOLENT FAITH 7* (First Anchor Books 2004). The Board may take judicial notice of these facts as capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned.” *Compagnie Gervais Danone v. Precision Formulations, LLC*, Opp’n Nos. 91179589, 91184174 (TTAB Jan. 5, 2009) (facts not subject to proof may be judicially noticed).

the Church.⁹ This is due in no small part to the efforts of the Church to use and encourage the public to use “Mormon” as a general and descriptive adjective as well as a noun signifying its members. The Church’s 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”¹⁰ Similarly, The Church also encourages the use of #Mormon as a one of a few “General Hashtags” for use in “social media discussions surrounding Mormonism.”¹¹ In fact, the Church has been promoting Mormonism through its “I’m a Mormon” campaign on mormon.org, in which Latter-day Saints identify as “Mormon,” encouraging generic use of “Mormon” as a noun describing Latter-day Saints.¹² On the other hand, the Church does not use and discourages use of Mormon as a source-identifying name for the Church: “Mormon Church . . . is not an authorized title, and the Church discourages its use.”¹³

Commonly known facts and references subject to judicial notice demonstrate the impossibility, much less implausibility, of Opposer’s claims due to the generic and

⁹ Trademark examiners in numerous *ex parte* proceedings have found “Mormon” generic and unregistrable for a wide range of services *See e.g.* application serial number 85/425334 for “MORMON SAVINGS” (August 14, 2012 Office Action); application serial number 85/537316 for “MORMON IN MANHATTAN” (May 29, 2012 Office Action); application serial number 78/833327 for “BABY MORMON” (September 1, 2006 June 25, 2007 Office Actions); and application serial number 78/608815 for “MORMON MAGNETS” (November 11, 2005 Office Action). The Board may take judicial notice of them on this motion. *HTC Corp. v. IPCom GmbH & Co., KG*, 671 F. Supp. 2d 146, 151 n.3 (D.D.C. 2009) (holding a “court may take judicial notice of court documents and other public records”).

¹⁰ See Church Style Guide, *available at*: www.mormonnewsroom.org/style-guide.

¹¹ See Church Hashtag Recommendations *available at*: <http://www.mormonnewsroom.org/article/mormon-hashtag-recommendations>.

¹² The “I’m a Mormon” campaign does not provide any method of contacting profiled individuals or otherwise facilitate introductions, promote social networking, or provide internet-based dating. It is merely an advertising campaign for the Church.

¹³ See Church Style Guide *available at*: www.mormonnewsroom.org/style-guide.

descriptive nature of “Mormon” in the English language. The Oxford English Dictionary defines “Mormon” first as a generic noun meaning “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.” The dictionary also provides a descriptive adjective meaning, “That is a Mormon; of, relating to, or characteristic of Mormons.”¹⁴

An Internet search for “Mormon” reveals numerous generic, descriptive and non-source identifying uses of “Mormon.”¹⁵ These include “Cultural Mormon”; “Mormon Pioneer National Historic Trail”; “Mormon History”; “Feminist Mormon Housewives”; “Old Las Vegas Mormon Fort”; “Mormon Temple”; “The Mormons,” (a PBS program); “The Book of Mormon,” (a Broadway musical); “Mormon Infographics”; “Mormon Artist”; “The Missouri Mormon War”; “Mormon Corridor”; “Mormon Transhumanist Conference”; “Mormon Battalion Association”; “Young Mormon Feminists”; “Mormon Studies” (a subject students can minor in at the University of Utah); “Mormon Blogosphere”; “Mormon Doctrine,” (a book by Bruce McConkie, which states in the front matter: “This work is not an official publication of The Church of Jesus Christ of Latter-day Saints”); “New Order Mormons”; “Society for Humanistic Mormonism”; and “European Mormon Studies Association,” among others.

Moreover, numerous cultural references attest to the generic and descriptive public use of Mormon long before IRI registered the trademarks cited in its Opposition.¹⁶

¹⁴ OXFORD ENGLISH DICTIONARY (3d ed. 2002).

¹⁵ Even if a list of search results has less weight for demonstrating public usage than printouts of pages demonstrating usage of terms, these search results do corroborate a wide range of non-source identifying uses of “Mormon.”

¹⁶ Setting aside its alleged unregistered common law mark “Mormon” for a “variety of goods and services,” “MORMON” was registered in 2007. Except for “MORMON HANDICRAFT” registered in 1989, all other marks cited in the Notice of Opposition

For example, Charles Dickens published accounts of Mormons in the periodical *All the Year Round* on July 4, 1863 under the column title “*The uncommercial traveller.*” These columns were later compiled into a book of the same title, with a chapter “Bound for the Great Salt Lake” specifically describing Dickens’ observations of “EIGHT HUNDRED MORMONS,” (capitalization in original) and his conversations with a “Mormon Agent,” and a Wiltshire laborer who states “O yes, I’m a Mormon . . . I’m a Mormon” when asked “You are of the Mormon religion, of course?” The term “Mormon” is also used in Jules Verne’s famous novel “*Around the World in Eighty Days,*” published in 1873, with chapter twenty-seven titled: “In which Passepartout Undergoes, at a Speed of Twenty Miles an Hour, a Course of Mormon History.” Similarly in Sir Arthur Conan Doyle’s *A Study in Scarlet*, published in 1887, Brigham Young and Mormon pioneers are characters and Mormon is used as a descriptive term.

Other examples abound. “Mormon Culture Region” and “Mormon Corridor” are long established in the public’s vocabulary.¹⁷ The American Historical Association (AHA) has an affiliate organization called “Mormon Historical Association,” (MHA) founded at a 1972 AHA meeting. The MHA is an independent organization with publications including *The Journal of Mormon History* and *Mormon History Newsletter*. The article “Mormon Stereotypes in Popular Fiction: 1979-1998” by Michael Austin of Shepherd College demonstrates generic and descriptive uses of “Mormon.”¹⁸ These uses demonstrate that “Mormon” had long been genericized before IRI registered its marks.

were registered on or after 2004 (“MORMON TABERNACLE CHOIR” was registered in 2004).

¹⁷ See e.g., Meinig, D. W. *The Mormon Culture Region: Strategies and Patterns in the Geography of the American West, 1847-1964*, 55 ANNALS OF THE ASSOC. OF AM. GEOGRAPHERS 191 (Jun. 1965).

¹⁸ Available at: http://www.adherents.com/lit/austin_lds_poplit.html.

The public continues its generic use and understanding of “Mormon,” consistent with the Church’s own efforts to encourage use of “Mormon” as merely descriptive or generic (and to discourage and avoid its use as source-identifying). “Cultural Mormon” continues to describe people who identify with Mormon cultural norms without subscribing to the doctrines of the Church.¹⁹ These examples attest to the continuing generic use of the word “Mormon.”

ARGUMENT

POINT I

**THE OPPOSITION FAILS TO MEET THE MINIMUM
PLEADING STANDARD AND SHOULD BE DISMISSED**

The Opposition is legally insufficient and the claims therein should be dismissed. Threadbare recitals of the elements of a cause of action, supported by mere conclusory statements, do not suffice, and the Board need not give any weight to the bare legal conclusions stated in the Opposition. Only a pleading that states a plausible claim for relief survives a motion to dismiss. *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).

When examined in its entirety, the Opposition fails because it does not allege plausible facts as would, if proved, establish a valid ground exists for opposing the registration of the Design Mark. *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). Simply put, the Opposition does not contain “enough facts to state a claim to relief that is plausible on its face.” *Bell Atlantic Corp.*, 550 U.S. at 570.

¹⁹ For further examples of recent and/or contemporary use, see n. 8, *supra*.

POINT II

**OPPOSER LACKS STANDING TO PROSECUTE THIS
OPPOSITION AND THE OPPOSITION SHOULD BE DISMISSED****A. IRI Does not Own All “Right, Title,
and Interest” to the Mark “Mormon”**

In the Opposition, IRI contends it owns all “right, title, and interest” to the mark “MORMON,” as it and/or the Church have allegedly used “MORMON” in connection with a “variety of goods and services” continuously since 1833.²⁰ IRI does not attempt to allege how it acquired any common-law trademark in the word “Mormon,” nor does it claim that it ever registered a supposed trademark in Mormon. Moreover, as discussed above, IRI failed to notify the Board of numerous prior findings that IRI is not entitled to broad trademark protection for “Mormon” because it is generic and/or descriptive. Many of these findings issued in proceedings prosecuted by IRI’s current counsel.

IRI’s silence as to these facts does not save the Opposition from dismissal. Indeed, IRI’s bare assertion that it owns the word “Mormon” is inadequate. *Seybert v. Nat’l Ctr. for Missing & Exploited Children*, No. 09-169, 2009 U.S. Dist. LEXIS 103427, at **6–7 (E.D. Tex. Aug. 10, 2009) (holding the “legal conclusion that plaintiff owns a common law trademark” “not entitled to the assumption of truth” on a motion to dismiss). In order to acquire trademark rights, a mark must be used in the “ordinary course of trade” on goods or containers, or, if the nature of the goods makes that impractical, on documents associated with the goods or their sale.” *Brookfield Commc'ns v. West Coast Entm't Corp.*, 174 F.3d 1036, 1051-52 (9th Cir. 1999) (citing 15 U.S.C. § 1127). IRI does not even attempt to allege such use. Moreover, as a matter of law, IRI

²⁰ (Opposition ¶¶ 3–4).

cannot show a common law trademark in “Mormon” because “Mormon” is not “inherently distinctive” nor has it acquired distinctiveness through secondary meaning, as this Board has previously found. *DeGidio v. West Grp. Corp.*, 355 F.3d 506, 509–10 (6th Cir. 2004). In short, the word “Mormon” cannot be a legally protectable trademark for an unspecified “variety of goods and services” because it is generic or at best merely descriptive. Neither IRI nor the Church may claim complete ownership of the generic and descriptive word “Mormon” and IRI cannot cure this defect in the Opposition.

B. IRI Lacks Standing

IRI cannot demonstrate standing because neither it nor the Church have a “real interest” and a “direct and personal stake” in the registration of the Design Mark. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999). IRI and the Church lack exclusive rights to the mark “Mormon” and are clearly not harmed by registration of the Design Mark, which is dissimilar in appearance, meaning, and commercial connotation to IRI’s registered marks, and used for a different class of goods and services. The Board should dismiss the Opposition with prejudice for lack of standing.

POINT III

THE OPPOSITION FAILS TO STATE A CLAIM FOR RELIEF AND SHOULD BE DISMISSED

A. The Opposition Fails to State a Claim for False Suggestion of a Connection Under Trademark Act Section 2(a)

A claim for false suggestion of a connection requires that: (1) Applicant’s mark is the same or a close approximation of IRI’s or the Church’s previously used name or identity; (2) the Design Mark would be recognized as such; (3) neither IRI nor the Church is connected with the activities performed by the Applicant under the Design Mark; and (4) IRI or the Church’s name or identity is of sufficient fame or reputation that

when the Design Mark is used for dating services, a connection with them would be presumed. *In Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428 (TTAB 1985), citing *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).

IRI fails to plead any facts plausibly demonstrating any of these elements. Indeed, there are no such facts. First, the mark at issue is not the same or a close approximation of any of the marks identified in the Opposition. "Mormon" is expressly disclaimed in the Application and the Design Mark does not in any other way appear similar or to be a close approximation to any mark identified by IRI. Second, Applicant's mark does not point uniquely and unmistakably to IRI or the Church. The term "Mormon" is generic, descriptive, and not source-identifying with respect to the Church. Third, "Mormon" in the Design Mark accurately describes the founders of Mormon Match and its goods and services in relation to the consumers as Mormons. Finally, the mere use of "Mormon" in connection with Internet-based dating, social introduction and social networking services directed at Mormons will not cause Mormon consumers to connect those services to IRI or the Church. Its use does not suggest to the general public that IRI or the Church is running a dating website or is commercially affiliated with one.

IRI's speculation is materially indistinguishable from claims rejected in *University of Notre Dame du Lac, supra*, in which the Federal Circuit affirmed dismissal of an opposition. The Court held "NOTRE DAME (and Design)," for cheese, did not falsely suggest a connection with the University of Notre Dame, 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. Thus it cannot be said that the only 'person' which the name possibly identifies is the University and that the mere use of NOTRE DAME by another appropriates its identity."

Similarly, here, "Mormon" is not a name "solely associated" with the Church (the Church itself discourages such use), but serves to identify a religious prophet and is used in the names of religious traditions and cultural movements related to those traditions. It cannot be said that the only "person" which the name possibly identifies is the Church and that the mere use of MORMON by another appropriates its identity. These pleading defects are incurable, and the claim should be dismissed with prejudice.

B. The Opposition Fails to State a Claim for Priority and Likelihood of Confusion

The Opposition fails to allege any facts supporting a claim for priority and likelihood of confusion under Trademark Act section 2(d). It is beyond cavil that if the common element of two marks is "weak" in that it is generic, descriptive or highly suggestive of the named goods or services, consumers typically will be able to avoid confusion. *See, e.g., In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986) (BED & BREAKFAST REGISTRY for making lodging reservations in private homes held not likely to be confused with BED & BREAKFAST INTERNATIONAL for room booking agency services); *The U.S. Shoe Corp. v. Chapman*, 229 USPQ 74 (TTAB 1985) (COBBLER'S OUTLET for shoes held not likely to be confused with CALIFORNIA COBBLERS (stylized) for shoes); *In re Istituto Sieroterapico E Vaccinogeno, Toscano "SCLAVO" S.p.A.*, 226 USPQ 1035 (TTAB 1985) (ASO QUANTUM (with "ASO" disclaimed) for diagnostic laboratory reagents held not likely to be confused with QUANTUM I for laboratory instrument for analyzing body

fluids). Here, as noted above, “Mormon” is extremely weak in that it is generic and descriptive, and its mere use as a common element cannot be the basis of a claim for likelihood of confusion.

Application of the appropriate *du Pont* factors only strengthens this conclusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973); *see, In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003) (discussing *du Pont* factors in likelihood of confusion analysis). These factors include:

- (1) similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression;
- (2) relatedness of the goods or services as described in an application or registration or in connection with which a prior mark is in use;
- (3) similarity or dissimilarity of established, likely-to-continue trade channels; and
- (4) conditions under which and buyers to whom sales are made.

Id. Of these, the two key considerations are the similarities between the marks and between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); *see also, In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). As to similarity, marks must be considered “in their entireties as to appearance, sound, connotation, and commercial impression.” *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567).

Here, the marks cited in the Opposition are wholly dissimilar to the Design Mark (considered in its “entirety”) in appearance, sound, meaning, connotation, and

commercial impression. Moreover, the “Internet-based dating, social introduction, and social networking” services described in the Application relate to online dating and are wholly unrelated to goods and services of the marks cited in the Opposition. Further, the trade channels for the mark at issue are dissimilar to those for the marks cited in the Opposition. The Design Mark will be displayed on Mormon Match’s website and trade channels related to online dating. Finally, the conditions under which sales are made to buyers using the Design Mark are dissimilar to those for the marks cited by IRI. The Design MARK will be used in conditions requiring buyers to set up an online profile for dating and social introductions, which is wholly different from the conditions under which sales are made to buyers using the marks cited in the Opposition.

In short, it strains logic to assert the registration of the Design Mark in relation dating services is likely to cause confusion, mistake, or to deceive the public that the dating services emanate from or are otherwise endorsed by IRI or the Church. The Design Mark and the dating services it will be used with are completely unrelated to IRI’s marks for educational services, genealogical services, religious instruction, religious books and pamphlets, pre-recorded audio and audio-video tapes and compact discs featuring musical entertainment incorporating religious, family, and educational themes, books featuring musical performances and religious, family, and educational themes, live performance by the Mormon Tabernacle Choir, fabrics, linens, bats, towels, and other textile material, and catalog mail order and telephone order services for craft items and materials, baby clothes, toys, *inter alia*.

The Opposition fails to state any facts supporting a likelihood of confusion claim, indeed no such facts exist, and this claim should be dismissed with prejudice.

C. The Notice of Opposition Fails to State a Claim for Dilution

Dilution under section 43(c) of the Trademark Act is an “extraordinary remedy” and the Board “will not resolve doubts in favor of the party claiming dilution.” *The Toro Company v. ToroHead, Inc.*, 61 USPQ2d 1164, 1173 (TTAB 2001). In deciding IRI’s dilution claim, the Board should consider whether: (1) IRI’s marks are famous; (2) IRI’s marks became famous prior to Applicant’s date of constructive use; and (3) Applicant’s Design Mark is likely to cause dilution by blurring or tarnishing the distinctiveness of IRI’s marks. *Coach Services Inc. v. Triumph Learning LLC*, 96 USPQ2d 1600 (TTAB 2010); *Citigroup Inc. v. Capital City Bank Group Inc.*, 94 USPQ2d 1645 (TTAB 2010). Here, IRI’s Opposition pleads no *facts* plausibly supporting any of these elements. IRI merely pleads legal conclusions.

A mark is defined under 15 U.S.C. §1125(c)(2)(A) as “famous” for dilution purposes if it is “widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark’s owner.” In general, the opposer has the burden of establishing that its marks have become famous, and the requirements are “stringent” when claiming dilution. *Coach Services*, 96 USPQ2d at 1610, citing *Toro Co.*, 61 USPQ2d at 1170. “Mormon” is not famous in the sense of being widely recognized as *a designation of source* of IRI’s or the Church’s goods or services. As discussed above, “Mormon” is a word describing members of the Church and religious and cultural movements stemming from the teachings of Joseph Smith. Indeed, “Mormon” was genericized long before IRI registered any of the marks cited in the Opposition. IRI’s marks in “MORMON” and “MORMON.ORG” are not famous, and cannot satisfy the first and second factors. To the extent the remaining marks

relating to Book of Mormon, Mormon Tabernacle Choir, and Mormon Handicraft *may* identify source, claims for dilution of these marks fail under the third factor.

IRI fails to satisfy the third factor because as a matter of law, the Design Mark cannot dilute IRI's marks by the mere accurate use of the generic and descriptive word "Mormon." It is well settled 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.*²¹ 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 satisfy the third factor as a matter of law.

"Mormon" is not inherently distinctive, and has not become well and favorably known such that IRI and the Church can claim exclusive use of the word for use in internet-based dating, social introduction and social networking services. Even if the public associated the Design Mark used for dating services with IRI's marks, no plausible facts support a showing that this would cause any impairment to IRI's marks, and the claim would still fail. *Gap Inc. v. G.A.P. Adventures Inc.*, 100 USPQ2d 1417, 1431 (S.D.N.Y. 2011) (dismissing dilution claim despite finding of likely association of marks

²¹ Indeed, IRI's attempt to assert total ownership of "Mormon" and use this Board to proscribe speech and expression concerning "Mormon" asks this Board to impermissibly use state action to diminish or deny constitutional rights guaranteed under, *inter alia*, the First and Fourteenth Amendments. 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).

because of lack of any showing of impairment). Here, there is simply no plausible basis to deny the public imbues the word “Mormon” with meaning beyond a source-identifying function, and no plausible basis to claim that it’s accurate use to describe dating services tarnishes IRI’s other marks. Therefore the pleading defect is incurable, and the Opposition’s claim for dilution should be dismissed with prejudice.

POINT IV

THE OPPOSITION IS BARRED BY COLLATERAL ESTOPPEL AND SHOULD BE DISMISSED WITH PREJUDICE

Collateral estoppel bars re-litigation of an issue where a prior action presented the issue, the party litigated the issue, and a judgment in the prior action determined the issue. *Laguna Hermosa Corp. v. United States*, 671 F.3d 1284 (Fed. Cir. 2012) (affirming application of collateral estoppel to dismiss claim). Here, collateral estoppel bars IRI’s claims that “Mormon” may be registered or protected outside of a narrowly circumscribed set of goods and services.

IRI already unsuccessfully attempted to register “Mormon” in class 45 of goods and services for “religious services” concerning application serial number 78/161091.²² There, 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[,] . . .

²² In that proceeding IRI was represented by the same firm prosecuting this Opposition.

generic and thus incapable of distinguishing source,” (Nov 1, 2005 Office Action).²³ Ultimately, IRI abandoned its application for “MORMON” for class 45 services after an appeal of the examining attorney's final refusal.

Here, the Application seeks to register the Design Mark in class 45 for Internet-dating, social introduction, and social networking services. Collateral estoppel now bars IRI from arguing that “MORMON” is source-identifying for those services. *Stephen Slesinger, Inc. v. Disney Enterprises Inc.*, No. 11-1593 (Fed. Cir. 2013); *Miller's Ale House, Inc. v. Boynton Carolina Ale House, LLC*, Case No. 10-15140 (11th Cir. Dec. 20, 2012) (plaintiff could not re-litigate genericness of “ale house” before 11th Circuit after litigating the issue to a final decision by the 4th Circuit). The defect is incurable, and the Opposition should be dismissed in its entirety with prejudice.

POINT V

JUDICIAL ESTOPPEL BARS THE OPPOSITION AND IT SHOULD BE DISMISSED WITH PREJUDICE

Judicial estoppel prevents a party from taking inconsistent positions in judicial proceedings to gain an advantage in each proceeding. *New Hampshire v. Maine*, 532 U.S. 742 (2001). Previously, IRI represented to the trademark examiner that it only sought registration within a narrowly specified category of goods and services to successfully trademark “MORMON.ORG,” serial number 77/179068, in the face of the examiner's refusal of registration. The examiner initially refused registration finding “MORMON.ORG” is “merely descriptive because it consists of the merely descriptive wording “Mormon” for the subject matter of its services . . . combined with the top-level

²³ The Board may consider these citations in the context of the collateral estoppel issue. *General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270, 1275 n.9 (TTAB 1992)

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 matter of these services,” (March 16, 2008 Office Action). IRI then directed the examiner’s attention towards the “very similar” services recited in the previously registered word mark “MORMON,”²⁴ and in response, the examiner withdrew the refusal. (June 8, 2008 Office Action). Consistent with trademark practice, the examiner noted: “identifications of services may be amended to clarify or limit the services, adding to or broadening the scope of the services is not permitted.” (June 8, 2008 Office Action).

In short, this Board already found Mormon merely descriptive and IRI obtained registration of “MORMON.ORG” only by reassuring the Board that the registration was for narrowly circumscribed services for which it registered “MORMON.” IRI’s silence as to these facts does not save the Opposition from dismissal. IRI is now judicially estopped from asserting that “Mormon” is not generic or descriptive outside of narrowly specified goods and services.²⁵ Accordingly, the Opposition should be dismissed.

POINT VI

MISUSE OF ALLEGED MARKS AND UNCLEAN HANDS BAR THE OPPOSITION AND IT SHOULD BE DISMISSED WITH PREJUDICE

It is well settled that unclean hands bars relief where the plaintiff’s inequitable conduct directly relates to its request for equitable relief. *Aristotle Int’l, Inc. v. NGP Software, Inc.*, 714 F. Supp. 2d 1, 15 (D.D.C. 2010) (quoting *Precision Instrument Mfg.*

²⁴ See Communication filed May 29, 2008. This communication was filed by attorney Dale Hulse who also filed the Opposition at issue here.

²⁵ Indeed, taking a contrary position now would imply prior fraud on the patent and trademark office by IRI in filing this communication.

Co. v. Auto. Maint. Mach. Co., 324 U.S. 806, 814 (1945)). Here, even if “Mormon” was ever a word that indicated origin of goods and services, by its own actions, the Church has encouraged the word “Mormon” to be used in a manner that strips its significance as an indicator of origin of goods or services. After misusing its alleged marks in this manner, it cannot now oppose use of “Mormon” consistent with its own instructions.

As noted above, the Church’s Style guide instructs the public to use “Mormon” generically and descriptively “as an adjective in such expressions as ‘Mormon pioneers,’” “[w]hen referring to Church members,”²⁶ and as a “General Hashtag[.]” for use in “social media discussions surrounding Mormonism.”²⁷ Conversely, the Church has instructed the public against the source-identifying expression “Mormon Church” stating this “is not an authorized title, and the Church discourages its use.”²⁸ Accordingly, it cannot now claim that “Mormon” is source-identifying.

The false advertising case of *Stokely-Van Camp, Inc. v. Coca-Cola Co.*, 646 F. Supp. 2d 510 (S.D.N.Y. 2009) is instructive. There, the plaintiff complained of statements by the defendants bearing on the calcium and magnesium content of the defendants’ sports drink. Plaintiff had previously “marketed the advantage of adding calcium and magnesium” to its own sports drink. *Id.* at 533. Accordingly, the court denied plaintiff’s request for a preliminary injunction. *Id.* Here, Applicant’s use of “Mormon” is entirely consistent with the Church’s use of the word and it’s instructions to the public. Therefore, it cannot be the basis for opposition by the Church, and IRI’s Opposition should be dismissed with prejudice.

²⁶ See Church Style Guide *available at*: www.mormonnewsroom.org/style-guide.

²⁷ See Church Hashtag Recommendations *available at*: <http://www.mormonnewsroom.org/article/mormon-hashtag-recommendations>.

²⁸ See Church Style Guide *available at*: www.mormonnewsroom.org/style-guide.

CONCLUSION

By its Opposition, IRI and the Church insist that they have total ownership of the word "Mormon" such that no person can accurately use that term in a trademark to describe goods and services. This position is clearly meritless. Moreover, as shown herein, none of the facts pled in the Opposition establish any plausible claim for false suggestion of a connection, likelihood of confusion, or dilution. Indeed no facts exist to plausibly establish such claims. These pleading defects cannot be cured as the rest on the fundamentally untenable position that the Church completely owns the word "Mormon," and require this Board to turn a blind eye to its own numerous findings to the contrary.

Accordingly, Applicant seeks an order: (i) dismissing the Opposition in its entirety with prejudice and without leave to amend; (ii) denying the Opposer's requested relief; (iii) declaring that Opposer is not and will not be damaged by registration of the Design Mark; (iv) declaring the Opposition frivolous and otherwise improper under applicable rules; and (v) awarding Applicant any and all appropriate relief as the TTAB deems just and proper.

Dated: April 4, 2014

Respectfully submitted,

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CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this **MOTION TO DISMISS NOTICE OF OPPOSITION AND MEMORANDUM OF LAW** is being filed electronically to the Trademark Trial and Appeal Board through the Electronic System for Trademark Trials and Appeals (ESTTA) on April 4, 2014.

/Siddartha Rao/
Siddartha Rao, Esq.

CERTIFICATE OF SERVICE

I hereby certify that on April 4, 2014 a copy of the foregoing **MOTION TO DISMISS NOTICE OF OPPOSITION AND MEMORANDUM OF LAW** was served on Intellectual Reserve, Inc. by depositing said copy with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to:

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