

THIS OPINION
IS NOT A PRECEDENT OF
THE T.T.A.B.

Hearing:
12/3/08

Mailed:
3/25/09

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Mary Queen of the Third Millennium, Inc.
v.
The Foundation for a Christian Civilization, Inc.

Opposition No. 91157073
to application Serial No. 76308243
filed on September 4, 2001

Michael C. Cesarano and Susan Marsillo of Feldman Gale for
Mary Queen of the Third Millennium, Inc.

Jordan S. Weinstein, Beth A. Chapman and Richard T. Matthews
of Oblon, Spivak, McClelland, Maier & Neustadt for The
Foundation for a Christian Civilization, Inc..

Before Quinn, Kuhlke and Mermelstein, Administrative
Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

The Foundation for a Christian Civilization, Inc.
("applicant") filed an application to register the mark
shown below ("the Habit")



for "clothing, namely ceremonial habit worn by distinguished religious representatives in certain ceremonies" (in International Class 25), and "promoting public awareness of the need for healthy and religious families in the United States" (in International Class 35).¹ In the application the mark is described as follows:

The mark consists of the design of the attire, namely, a scapular containing a cross centered on the front worn atop a habit and worn with a metal and beaded belt containing a cross. The matter shown by the dotted lines is not a part of the mark and exists only to show the position of the mark.

The application also includes a statement that "[t]he stippling in the drawing is for shading purposes only."

Mary Queen of the Third Millennium, Inc. ("opposer") opposed registration on July 1, 2003. It should be noted

¹ Application Serial No. 76308243, filed September 4, 2001, alleging first use anywhere and first use in commerce on August 26, 1978 for both the goods and services.

Opposition No. 91157073

that the original notice of opposition was filed by two parties, namely opposer and an individual, Father Joao Scognamiglio Cla Dias ("Cla Dias") who lives in Brazil. In the notice of opposition, it was alleged that Cla Dias is the owner of the mark sought to be registered, and that opposer is an authorized user of the mark in the United States, such authorization having been granted by Cla Dias. It further was alleged that opposer and Cla Dias are "related parties" as defined in Sections 5 and 45 of the Trademark Act, 15 U.S.C. §§1055 and 1127, and that they have the right to bring this opposition jointly.

During the course of this proceeding, the Board, on June 24, 2006, granted applicant's motion to take the discovery deposition of Cla Dias by way of oral deposition even though Cla Dias lives in Brazil (rather than by way of written questions under Trademark Rule 2.124; see Trademark Rule 2.120(c)). The Board ruled that "facts and information central to this case, namely who controls use of the habit, are solely within the control of Opposer Dias, as all agreements upon which Opposer relies are oral. Thus, these facts are within the proposed deponent's control, an oral deposition is necessary and applicant should not be deprived of the opportunity to depose Opposer in person." As a direct result of the Board's order, Cla Dias withdrew his opposition without the written consent of applicant.

Opposition No. 91157073

Accordingly, the Board, on August 21, 2006, dismissed with prejudice the opposition filed by Cla Dias.

In the notice of opposition opposer alleged that it is an "affiliated organization" with the international association Heralds of the Gospel ("Heralds"), and that their use of the Habit is pursuant to permission granted by Cla Dias. As grounds for opposition, opposer alleged that applicant is not the owner of the mark, but rather Cla Dias is the owner, and that opposer is an authorized user of the mark; that contrary to applicant's claim of acquired distinctiveness in Class 25 and inherent distinctiveness in Class 35, applicant has not had substantially exclusive and continuous use of the matter sought to be registered, and that the matter is incapable of serving as a trademark or service mark because of the widespread use of habits by others in the United States; and that the matter sought to be registered is likely to cause confusion with opposer's activities.² The specific allegations relating to likelihood of confusion give context to the current dispute:

Since the creation of the Habit by Cla Dias in 1971, its use has been limited to ceremonies sponsored by or having a connection to the Catholic Church, and to the promotion of values pursuant to the tenets of the Catholic Church as they may be promulgated or modified by church authorities from time to time. Control of the use of the Habit by Cla

² The Board, in an order dated August 10, 2007, denied opposer's motion to amend the notice of opposition to assert a fraud claim.

Dias has always been exercised in adherence to those principles, as is evidenced by the Holy See's authorization and approval for Heralds of the Gospel to practice its charism and participate in the liturgy wearing the habits (including the Habit) designed by Cla Dias. Through such use and approval, the public has come to associate the Habit with the ideals and policies of the Catholic Church as advocated by Cla Dias and as practiced by Mary Queen of the Third Millennium.

Registration of the mark would allow Applicant to use the mark in accordance with its own recognized secular and political policies. Such use would be likely to confuse the public who have come to associate the Habit with ceremonies conducted by Mary Queen of the Third Millennium, and who would mistakenly believe that Applicant's policies are those of the Catholic Church as advocated by Cla Dias and practiced [by] Mary Queen of the Third Millennium. In fact, neither Cla Dias nor the Catholic Church supports or endorses Applicant's policies.

Applicant, in its answer, denied the salient allegations in the notice of opposition, and asserted that opposer is an infringing user.

Preliminary Remarks

Before proceeding to the substantive merits of this case, a few comments are warranted. This has been a protracted case (five and one-half years), as evidenced by the number of motions and papers filed. This fact was not lost on the Deputy Commissioner for Trademark Examination Policy when she noted, in her order denying opposer's

Opposition No. 91157073

petition to overturn an interlocutory ruling in this proceeding, this case "has a lengthy factual and procedural history...filled with numerous extensions, motions, responses to motions, and Board orders." Opposer filed two motions for summary judgment, and applicant filed its own motion for summary judgment, all denied and forcing the Board, in its order dated September 5, 2007, to prohibit the filing of "any future motions for summary judgment on any issue from either party." In doing so, the Board noted that "[w]ithout doubt, these motions have delayed this case, increased the cost of the proceeding for both parties and strained the limited resources of the Board." Reading the trial testimony was an exercise in patience, with a large number of objections disrupting the flow of the depositions. Further, we question the need for the voluminous testimony taken by the parties, given that our jurisdiction is confined to the registrability of the applied-for designation.

It is clear that the parties have their differences outside of this proceeding; it would appear that this opposition merely is their fight "du jour" in a series of battles. In the words of opposer: "This is a most unusual scenario for a trademark dispute, as the trademark was conceived and used by an international religious order as a personal symbol of religious dedication and commitment until

Applicant forced a schism, in 1996, and attempted to expropriate to itself the symbol of the hermits." (Brief, p. 21) (emphasis in original). Or, as articulated by Cicero Sobriera De Sousa, a missionary of the Heralds, "[w]e are discussing an issue here that would be more proper to Canon law sphere.... By circumstances we are discussing it here, but this is a matter of religious spectrum." (p. 35).

Evidentiary Objections

With respect to the record, applicant filed an eleven-page "statement of evidentiary objections." The objections pertain to certain items and associated statements submitted with opposer's notice of reliance; to certain portions of opposer's trial testimony and opposer's cross-examination during applicant's testimony; to certain portions of opposer's rebuttal testimony; and to unsupported statements in opposer's brief at final hearing.

At the outset of considering these objections, we should point out that none of the testimony or evidence in question is outcome determinative of this proceeding. And, accordingly, we will not burden this opinion with an extended discussion of the objections.

The objections to the unsupported statements in opposer's notice of reliance are sustained. Further, three of the exhibits are in a foreign language, and no translation accompanied these documents. See Wright and

Opposition No. 91157073

Graham, Federal Practice and Procedure (1977), §5075 ("If a party puts in evidence the whole of an encoded writing, he should only be held to have introduced the part of it that he has had translated for the jury."). Thus, the objected-to statements and the two foreign language documents have not been considered.

Applicant has objected to the entirety of certain testimonial depositions, and to portions of others. Although applicant raised a variety of objections during the depositions, applicant now highlights its principal objections, namely to testimony regarding activities outside of the United States, and to testimony relating to Cla Dias. Suffice it to say that we have considered this testimony to give context to the sequence of events leading to this litigation. We recognize that the activities in Brazil do not have a direct bearing on the issues herein, but applicant itself has introduced certain testimony relating to activities in Brazil, specifically those of Professor Plinio and the "Sociedade Brasileira de Defesa da Tradicao, Familia e Propriedade"; as translated to English, "Brazilian Society for the Defense of Tradition, Family and Property" ("Brazilian TFP"). Likewise, although we have considered the testimony regarding Cla Dias, the testimony has its problems, most especially with hearsay. Thus, although the

Opposition No. 91157073

testimony has been considered, we have accorded it only the probative value it merits.

Applicant also has objected on a variety of grounds to the entirety of opposer's cross-examination of certain of applicant's testimonial witnesses. Although we have considered this testimony, we have read it again keeping applicant's objections in mind.

Applicant has objected to seven depositions taken by opposer as improper rebuttal, and has again objected to all testimony that concerns activities outside the United States and all testimony relating to Cla Dias. The objection grounded on improper rebuttal is overruled, and we have considered the rebuttal testimony, according it whatever probative value it merits.. With respect to foreign activities and Cla Dias, as indicated above, we again have considered this testimony to the extent that it gives us context for this litigation.

Lastly, applicant has objected to "numerous unsupported facts in Opposer's Trial Brief." To state the obvious, we have disregarded any factual statements that are not supported by evidence properly introduced at trial. TBMP §704.06(b) (2d ed. rev. 2004).

The record consists of the pleadings; the file of the involved application; trial testimony, with related

exhibits, taken by each party;³ portions of a discovery deposition (Thomas McKenna),⁴ and excerpts of printed publications⁵ attached to opposer's notice of reliance; and excerpts of printed publications, and TARR printouts of eleven third-party registrations made of record by way of applicant's notice of reliance. The parties filed briefs and both were represented by counsel at an oral hearing held before this Board panel.

Background

At the center of this controversy is the "ceremonial habit" or "gala uniform" sought to be registered. (Drake dep., p. 7). Raymond Drake, applicant's president, offers the following description:

[It is] comprised of a tunic slightly longer--it goes slightly below the knees. On top of that tunic is a scapular. It would be the brown piece of fabric...with a large cross of Saint James, a red and white cross of Saint

³ So as to be clear, opposer also attempted to rely on portions of the discovery deposition of Steven Schmieder. In an order on reconsideration dated April 30, 2008, the Board denied opposer's motion to introduce and use the discovery deposition of its Fed. R. Civ. P. 30(b)(6) witness, Steven Schmieder, in lieu of a testimonial deposition on oral examination. Opposer filed a petition to the Commissioner to reverse the Board's ruling. The Commissioner, in a decision dated November 25, 2008, denied the petition. Accordingly, the portions of the discovery deposition of Steven Schmieder upon which opposer attempted to rely do not form part of the record, and have not been considered in reaching a decision.

⁴ The parties stipulated that opposer could introduce the excerpts of this discovery deposition in lieu of a testimonial deposition on oral examination.

⁵ Three of the articles are in Spanish. As indicated earlier, opposer failed to provide English translations, so these articles have no probative value.

James down the center of the front of the scapular. On the back of the scapular...there is a hood on the scapular. On the left shoulder of the scapular is the TFP cape, which is folded in order to hang over the left shoulder...another element of the habit would be the chain that goes around the waist. On top of the scapular in the back, but underneath the scapular on the front. And on the right-hand side of this chain is a large beaded Rosary that hangs on the right side, suspended from the chain. (Drake dep., pp. 7-8).

Over the years the Habit went through various modifications, with new colors (white and beige) introduced and worn by members depending on the age of the individual receiving the Habit.

The parties have focused their attention on the question of ownership of the mark. A determination of this question is greatly complicated by the fact that one of the original purported owners, Cla Dias, as asserted by opposer, is no longer a plaintiff in this proceeding; and the other, Professor Plinio Correa de Oliveira ("Plinio"), as asserted by applicant, is deceased (1995). These two non-party individuals, both Brazilians, play key roles in the story of the Habit.

The record shows that the Habit was conceived as a way to identify hermits who were true to the teachings and rules of Plinio, Cla Dias and the Catholic Church. Mr. Drake testified that the habit is to "identify the organization to the public. As a TFP symbol, it expresses symbolically the

Opposition No. 91157073

three elements of the moral profile of the TFP member, namely monk, warrior and slave." (p. 9). The record is devoid of any hint that either Cla Dias or Plinio ever intended that the Habit would be used in a commercial sense involving the sale of goods and/or services. The ownership question is further complicated by the complete absence of any written agreement, license or other contract governing ownership and/or use of the Habit.

Indeed, opposer itself is not sure who "owned" the mark:

Although Prof. Plinio is recognized as the 'inspiration' and the 'founder' of the congregation of hermits, it is not clear whether it was he or Fr. Cla Dias who exercised ultimate control over the use of the Habit. During Prof. Plinio's life, both men were frequently heard to give total credit to the other for the establishment and maintenance of the international congregation of hermits. Ultimately, it does not make a difference, as the issue is not whether Fr. Cla Dias or Prof. Plinio owned the Habit, but whether Applicant owns the Habit and may register it - - and the answer is clearly that Applicant never owned the Habit or exercised control over its use. (Brief, pp. 22-23, n. 11).

Opposer further acknowledged the difficulties in applying traditional trademark principles to an admittedly non-traditional trademark situation:

Application of these factors [regarding ownership and public recognition of the Habit as a source indicator] in this case is severely limited by the fact

that, from 1978 until the schism in 1996, the Habit was rarely worn where it could be viewed by the public. While it was occasionally worn in private celebrations sponsored by the American TFP, such uses were not public, and it was only members of the hermitage and TFP members and supporters who were exposed to such uses. That fact alone makes it difficult, if not impossible, to give proper weight to the relevant factors in the context of a trademark analysis. (Brief, p. 28).

Notwithstanding all of its assertions that Cla Dias and/or Plinio own rights to the Habit, opposer concludes that "Heralds of the Gospel, represented in the United States by Opposer Mary Queen of the Third Millennium, should be recognized by this Board as the owner of the Habit." (Brief, p. 34).

As to likelihood of confusion, opposer explains its position as follows:

The long-time use of the Habit, internationally, as a religious symbol of hermits dedicated to a life of sanctity within the Catholic Church, and its continuing use as the symbol of hermits who have established themselves as Heralds of the Gospel, virtually assures that the Habit has become, and will continue to be, widely recognized by the public as the symbol of a religious entity within the Catholic Church. The registration and use of the Habit by members of Applicant, in pursuit of Applicant's societal and political goals, could only cause great confusion to the public, and cause it to mistakenly identify Applicant's political and societal views as being those of the Catholic Church. The public, and the parties to this

opposition, require a resolution that will not unduly cause mistake and confusion, nor will permit the attribution of Applicant's political agenda to Opposer and Heralds of the Gospel. (Brief, p. 33) (emphasis in original).

With respect to opposer's allegations that applicant's mark is incapable of registration, the gist of opposer's theory is that the mark sought to be registered is not inherently distinctive for the goods and services identified in the application, and that applicant failed to establish that the matter has acquired distinctiveness for the goods and services.

Facts

The Habit's origins date back to the late 1960's in Brazil. Plinio founded the Brazilian TFP in 1960. The organization originally was established as an anti-Communist or counter-revolutionary group. The first community was established in Sao Paulo, Brazil at "Eremo de Sao Bento," meaning "Hermitage of Saint Benedict." Cla Dias, an ordained Catholic priest, was a member of the group and served in a position of authority. Because of their lifestyle, the congregation's members were called "hermits" and the places in which they lived were called "hermitages." Hermits followed certain rules, called the "Ordo," promulgated by Plinio and Cla Dias. Hermits who followed these rules, completed training and committed themselves to

Opposition No. 91157073

the congregation were authorized, with the passage of time, to wear the Habit. Neither the original Ordo nor any subsequent Ordos included any provisions pertaining to control and use of the Habit. (Drake dep., p. 114).

Over time other groups were spawned from the original Brazilian organization. One of these groups was the American Society for the Defense of Tradition, Family and Property ("American TFP"). This first American group was incorporated in 1975, and established its first hermitage in 1977 in Yonkers, New York. The goal of American TFP was "to defend Christian civilization against the liberal struggle to reshape Western civilization." The first uses of the Habit in the United States were confined to the New York hermitage. The Yonkers location and a second location (Bedford, New York) were subsequently closed, with the hermits establishing their permanent hermitage on 70 acres in Spring Grove, Pennsylvania. There is nothing in the record indicating the number of applicant's hermits, only that "there's not that many members of the TFP." (Balan dep., p. 14). The first documented public display of the Habit in this country took place on August 26, 1978 in New York City. The Habit was worn by four hermits in a "parade" on Fifth Avenue that ended at St. Patrick's Cathedral. Subsequent "public" events at which applicant's hermits have worn the habit in the United States include conferences that

Opposition No. 91157073

applicant sponsored for its supporters, and two ceremonies at the Spring Grove hermitage to commemorate book launchings by Plinio. Applicant's hermits wear the Habit at their regular Saturday meetings, holidays, feast days, March for Life parades, and open houses.

The Foundation for a Christian Civilization ("Foundation") was incorporated in 1973, originally founded to help fundraising for a Catholic counterrevolution against communism, and subsequently becoming a civil cultural organization that aims to uphold and promote the values of Christian civilization. (McKenna dep., 9). The American TFP is described as the largest organizer of protests against anti-Catholic blasphemy in the United States. (McKenna dep., p. 79). The Foundation later merged in June 1992 with American TFP to form a single corporation identified as The Foundation for a Christian Civilization. Cla Dias served as the "quidam" or leader of the American TFP for the period of 1986 until October 1996.

Things began to change significantly upon Plinio's death on October 3, 1995. There had been growing differences between the American TFP and Cla Dias on various issues, including whether to follow certain reforms taking place in the Catholic Church. Cla Dias wished to follow these reforms with the intention of becoming closer to the Catholic Church, culminating in Vatican recognition for the

Opposition No. 91157073

American TFP. As the differences intensified, the hermits residing at the Spring Grove, Pennsylvania hermitage held a meeting in October 1996. It was decided to split with Cla Dias, and the hermitage, in a letter to Cla Dias dated October 24, 1996, informed him of this "schism."

After this decision, the hermits who maintained their allegiance to Cla Dias left the Spring Grove hermitage for Brazil. In 1999, Cla Dias founded a group called the Heralds of the Gospel ("Heralds"), with headquarters in Brazil; Cla Dias remains president and superior general of this group. Former members of the American TFP, now members of the Heralds, continued to wear the Habit. In October 1999, opposer, Mary Queen of the Third Millennium, was incorporated in the United States to provide support, both financial and administrative, to the newly formed Heralds. In February 2001, the Heralds received Vatican recognition as a "Private Association of Christ's Faithful of Pontifical Right."

In summer 2001, members of the Heralds first wore the Habit in the United States as members of this group. At the same time applicant's hermits also continued to wear the Habit. Finally, in September 2001, the involved application was filed, alleging first use on August 26, 1978, that is, the date of the American TFP hermits' participation in the "parade" ending at St. Patrick's Cathedral in New York City.

Thomas McKenna, who signed the involved application, spoke with the Brazilian TFP when the application was filed, and asked what Cla Dias was doing regarding the Habit in Brazil. Applicant's directors were aware of the Heralds' use of the Habit in the United States, and about another unspecified use by the Knights of the New Millennium,⁶ so applicant decided to pursue registering the Habit as a trademark in an attempt to avoid confusion among the organizations. (McKenna dep., p. 144).

Mr. McKenna was a member of applicant until March 2005, when he terminated his membership to "pursue other goals in life." When asked to describe the individuals identified by the terminology "distinguished religious representatives" in the recitation of services, Mr. McKenna stated they were dedicated members who spoke on religious topics, or those who taught the catechism of the Catholic Church. These individuals are "distinguished" because they gave up a career and dedicated themselves full time to promote Catholic ideals.

Grounds for Relief

The Board, in its order dated September 5, 2007, indicated as follows: "The claims currently set for trial are: 1) ownership of applicant's mark; 2) whether the mark

⁶ The record does not include any additional information about this group or its use of any habit.

is capable of distinguishing applicant's goods and services from those of opposer; and 3) whether there is a likelihood of confusion between the parties' respective marks."

Standing

We first consider opposer's standing relative to its claim that the mark sought to be registered is incapable of distinguishing applicant's goods and services.

Opposer must prove its standing as a threshold matter to be heard on its substantive claims. *See, e.g., Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). The purpose of standing is to prevent mere intermeddlers from initiating proceedings. The Federal Circuit has enunciated a liberal threshold for determining standing to oppose within the meaning of Section 13 of the Trademark Act, namely, that the plaintiff has a belief in damage with a reasonable basis in fact, and that the party can demonstrate a "real interest" in the proceeding. *Ritchie v. Simpson*, 170 F.3d 1092, 41 USPQ2d 1859 (Fed. Cir. 1996).

Applicant attacks opposer's standing by asserting that opposer was incorporated to offer financial and administrative support to the Heralds, and that it has no legal interest in the Habit at issue. Opposer has no link to Cla Dias, applicant states, and opposer has never used the Habit as a mark or received authority to use the mark,

Opposition No. 91157073

the Heralds being the only entity between the two to have actually used the mark. Applicant contends that "all the services Opposer claims were rendered in the Habit on its behalf were rendered by the Heralds of the Gospel, the organization for which Opposer Mary Queen provides financial and administrative support, and which is not a party to this proceeding." (Brief, p. 12). Applicant urges that the Board may dismiss the opposition on this basis alone.

Opposer responds by contending that it and Cla Dias, owner of the mark, are "related parties"; that opposer stands in the same position relative to the user of the mark (Heralds) as a trade association does in relation to its members; that while opposer does not "use" the mark it does represent the interest of its members, namely individuals who are authorized to wear the Habit, "many of whom were 'hermits' at a time when Applicant performed the same services to them that are now performed by Mary Queen"; and that opposer is the legal entity in the United States that supports its members administratively and financially, and protects their legal interests and those of the international religious organization Heralds of the Gospel.

Again, this is not the usual trademark case where an opposer is a "competitor" selling competing goods and/or services. Opposer is asserting that applicant's mark lacks distinctiveness; that is, inherent distinctiveness of the

Opposition No. 91157073

mark for the identified services, and acquired distinctiveness for the identified goods. To have standing to assert a ground that a mark lacks distinctiveness opposer must have a present or prospective right to use the same or similar "mark" in its "business." *Plyboo America, Inc. v. Smith & Fong Co.*, 51 USPQ2d 1633 (TTAB 1999). It is not necessary that opposer has actually used the mark in some fashion, nor even contemplate doing so. See *Cummins Engine Co. v. Continental Motors Corp.*, 359 F.2d 892, 149 USPQ 559 (CCPA 1966). The standard for standing to oppose on the ground of descriptiveness is the same as the one involved here: "An opposer...need only assert an equal right to use the mark for the goods. Proprietary rights in the opposer are not required." *Jewelers Vigilance Committee, Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2024 (Fed. Cir. 1987), *on remand*, 5 USPQ2d 1622 (TTAB 1987), *rev'd*, 853 F.2d 888, 7 USPQ2d 1628 (Fed. Cir. 1988). Here, opposer admittedly is not using the Habit, but such use is not required. The facts that opposer represents the legal interests of the Heralds, and that it is affiliated with the Heralds who actually use the habit (a fact conceded by applicant), establish opposer's "sufficient interest" in using the Habit in carrying out its ministry and that of the group to whom it furnishes administrative and financial support. Opposer is, in effect, a "competitor" of

applicant; opposer has a present or prospective right to use the Habit. *Binney & Smith, Inc. v. Magic Marker Industries, Inc.*, 222 USPQ 1003 (TTAB 1984).

Accordingly, we find that opposer has standing to oppose the registration sought by applicant. Once the standing threshold has been crossed, opposer may rely on any legal ground that negates applicant's right to the registration it seeks. *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991).

Distinctiveness

We first turn our attention to opposer's claim that the Habit is incapable of registration as a mark because it is not a distinctive mark, neither inherently distinctive nor by virtue of acquired distinctiveness for the goods and services listed in the application.

By way of background, applicant originally sought to register the mark on the Principal Register for both its goods and services on the basis of inherent distinctiveness. During the examination of the involved application, the examining attorney viewed the mark as a configuration of the goods, and required applicant to establish acquired distinctiveness of its mark in connection with the identified goods; no such requirement was made as to the services. Applicant submitted a declaration, claiming substantially exclusive and continuous use of its mark on

Opposition No. 91157073

clothing since August 26, 1978 (the date of the "parade" in New York City). The examining attorney accepted the declaration as sufficient proof of acquired distinctiveness of the mark as used for clothing.

Opposer contends that the Habit is not distinctive of applicant's goods and services. (Brief, p. 31). According to opposer, applicant was aware at the time of filing its application that the Heralds had appeared in numerous public performances and television events while wearing the Habit in this country. Opposer argues that prior to the schism between the Brazilian TFP and the American TFP, the Habit had been used and perceived only as a symbol of a hermit's dedication to a life of sanctity, and that following the schism, the Habit was used by opposer and applicant at the same time. Because the Heralds' use of the Habit in the context of religious celebrations far outweighs any public use of the Habit by applicant after the schism, applicant cannot show acquired distinctiveness of its mark for the goods and services. Thus, opposer contends, the trade dress applicant seeks to register has not acquired distinctiveness. See *Minnesota Mining & Mfg. Co. v. Addressograph-Multigraph Corp.*, 155 USPQ 470 (TTAB 1967).

Applicant counters by arguing that opposer did not meet its burden of proof to show either lack of inherent distinctiveness of the Habit for applicant's services or

Opposition No. 91157073

lack of acquired distinctiveness of the Habit for applicant's goods. More specifically with respect to the services, applicant argues that opposer failed to meet its initial burden of establishing no inherent distinctiveness, but that if the Board "miraculously" finds that the burden is met, then applicant's mark has acquired distinctiveness for its services. (Brief, pp. 29-31). Further, if the Board finds that opposer met its initial burden relative to showing no acquired distinctiveness for the goods, then applicant's testimony and evidence rebuts the showing and, according to applicant, further establishes acquired distinctiveness for the goods.

As indicated above, applicant has claimed acquired distinctiveness of the Habit for "clothing, namely ceremonial habit worn by distinguished religious representatives in certain ceremonies." At least insofar as the goods are concerned, "[w]here, as here, an applicant seeks a registration based on acquired distinctiveness under Section 2(f), the statute accepts a lack of distinctiveness as an established fact." *Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1571, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988). In any event, product design trade dress is never inherently distinctive. *Wal-Mart Stores v. Samara Bros.*, 529 U.S. 205, 54 USPQ2d 1065 (2000).

The examining attorney, however, did not require applicant to claim acquired distinctiveness of the mark for the identified services, namely "providing public awareness of the need for healthy and religious families in the United States." Rather, the examining attorney essentially accepted the notion that the Habit is inherently distinctive for the services. Thus, we first must consider the question of whether the Habit is inherently distinctive as used in connection with applicant's services. "[A]n opposer's burden of establishing no inherent distinctiveness...exists only where an applicant seeks registration on the basis of inherent distinctiveness." *Yamaha*, 6 USPQ2d at 1005. See *Anchor Hocking Glass Corp. v. Corning Glass Works*, 162 USPQ 288 (TTAB 1969).

In answering this question, we apply the time-tested analysis first articulated in *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342, 196 USPQ 289 (CCPA 1977). Under *Seabrook*, we consider the Habit and determine:

Whether the Habit is a common basic shape or design;

Whether the Habit is unique or unusual in the particular field;

Whether the Habit is a mere refinement of a commonly-adopted and well-known form or ornamentation for a particular class of goods or services viewed by the public as a dress or ornamentation for the goods or services; and

Whether the Habit is capable of creating a commercial impression distinct from any accompanying words.⁷

Our analysis also includes consideration of more recent authoritative cases, notably the Supreme Court's opinions in *Wal-Mart Stores v. Samara Bros.*, supra, *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 34 USPQ2d 1161 (1995), and *Two Pesos Inc. v. Taco Cabana Inc.*, 505 U.S. 763, 23 USPQ2d 1081 (1992). These cases "complement" the *Seabrook* test and provide additional useful guidance. *In re Creative Beauty Innovations Inc.*, 56 USPQ2d 1203, 1206 (TTAB 2000).

In *Wal-Mart*, the Supreme Court discussed the distinction between the trade dress at issue in *Two Pesos* (restaurant décor for restaurant services), and the product design trade dress (designs for children's clothing) under consideration in *Wal-Mart*:

Two Pesos unquestionably establishes the legal principle that trade dress can be inherently distinctive, but it does not establish that *product design* trade dress can be. *Two Pesos* is inapposite to our holding here because the trade dress at issue, the décor of a restaurant, seems to us not to constitute *product design*. It was either product packaging - which, as we have discussed, normally is taken by the consumer to indicate origin - or else some *tertium quid* that is akin to product packaging.

Wal-Mart, 54 USPQ2d at 1069.

⁷ The fourth factor is not relevant in this case.

Although trade dress used with services may be inherently distinctive, as was the case in *Two Pesos*, not all such trade dress is inherently distinctive. See, e.g., *In re Chippendales USA, Inc.*, ___USPQ2d___ (TTAB, S.N. 78666598, March 25, 2009); *In re File*, 48 USPQ2d 1363 (TTAB 1998); and *In re Hudson New Co.*, 39 USPQ2d 1915 (TTAB 1996), *aff'd per curium*, 114 F.3d 1207 (Fed. Cir. 1997).

As stated before, this is not your "typical" trademark/service mark at issue. While the Supreme Court in *Wal-Mart* observed that consumers may be predisposed to regard packaging for goods as an indicator of source, the Court also recognized that there are cases where it is not reasonable to assume that predisposition. *Wal-Mart* at 1068. In cases of trade dress used in connection with services, it may not be useful to categorize the case as either a "product" or "packaging" case. *Wal-Mart* at 1069. Rather, we must focus on whether or not it is reasonable to assume that the consumer is predisposed to view the trade dress as a source indicator. See, e.g., *In re Chippendales USA, Inc.*, at slip opinion p. 12; and *In re Hudson Co.*, 39 USPQ2d at 1923.

We find, with regard to the services, that the mark at issue here, like the service mark in *Two Pesos*, is a form of trade dress that may be inherently distinctive for the

services. Whether or not the Habit is inherently distinctive is the question we first must answer.

The relevant *Seabrook* factors overlap in this case. Professor McCarthy has observed that “[i]n reality, all three [*Seabrook*] questions are merely different ways to ask whether the design, shape or combination of elements is so unique, unusual or unexpected in this market that one can assume without proof that it will automatically be perceived by customers as an indicia of origin -- a trademark.” J.T. McCarthy, McCarthy on Trademarks and Unfair Competition, §8.02[4] (3d ed. 1993). “Thus the focus of the inquiry is whether or not the trade dress is of such a design that a buyer will immediately rely on it to differentiate the product [services] from those of competing manufacturers [service providers]; if so, it is inherently distinctive.” *Tone Brothers Inc. v. Sysco Corp.*, 28 F.3d 1192, 31 USPQ2d 1321, 1331 (Fed. Cir. 1994), citing *Paddington Corp. v. Attiki Importers & Distributors, Inc.*, 996 F.2d 577, 27 USPQ2d 1189, 1192-93 (2d Cir. 1993). The facts of each case must dictate the determination. See *Hoover Co. v. Royal Appliance Manufacturing Co.*, 238 F.3d 1357, 57 USPQ2d 1720 (Fed. Cir. 2001) (“The issue of inherent distinctiveness is a factual determination made by the board.”).

Turning to the first *Seabrook* factor of whether the Habit is a common basic shape or design, it is common

Opposition No. 91157073

knowledge and indisputable that religious members, both clergy and lay, wear habits. The fact that religious garb is adorned by a cross design is hardly surprising. Also, wearing a rosary around the waist is far from novel in the religious world. The wearing of such garb is so conventional and prosaic that it cannot be assumed to stand out and be perceived as a source indicator without proof of that fact. The Habit at issue does not strike us as so unique, unusual or unexpected in connection with religious garb or quasi-religious services that one may assume without proof that it will automatically be perceived by others as a trademark or service mark. The Habit does not automatically and instantaneously serve as a source indicator; rather, it simply tells someone that the individual is wearing a vestment like so many others in religious life. In sum, the Habit is not unusual in that it falls within the general realm of habits worn by other religious groups.

Next up for consideration is whether the Habit is or was unique or unusual in the particular field. Clearly, a religious habit, whether the one at issue here or any of those worn by other religious, is hardly unique or unusual - habits are what clergy or lay religious wear. At the time the Habit was first worn, it was not unique or unusual.

Next we must consider whether the Habit was a refinement of an existing form of ornamentation for the

Opposition No. 91157073

particular class of services. We answer in the affirmative, given that habits are routinely worn by religious members, and applicant merely added its own touches to an otherwise ordinary brown habit.

We find that applicant has failed to present sufficient evidence to establish that the Habit is inherently distinctive. In view of the pedestrian nature of the Habit, and the ubiquitous nature of such garb in religious or quasi-religious situations, we are not persuaded that the Habit was, at the time of adoption and first use, an inherently distinctive design that achieved instant recognition as a service mark denoting origin of applicant's services. Individuals do not expect that religious garb functions as a mark to designate source or origin. That is to say, it is not reasonable to assume that individuals are predisposed toward equating religious garb such as the Habit with any source, let alone a single source. *See In re MBNA American Banc, N.A.*, 340 F.3d 1328, 67 USPQ2d 1778 (Fed. Cir. 2003).

We find the opinion in *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 467 F. Supp. 740, 201 USPQ 740 (S.D.N.Y. 1979), *aff'd*, 604 F.2d 200, 203 USPQ 161 (2d Cir. 1979), to be particularly instructive. Notwithstanding some arguably ambiguous language earlier in the opinion, it is clear that the Court, in determining that the trade dress

functioned as a mark, based its conclusion on a finding of acquired distinctiveness. The Court states:

The evidence further shows that the Dallas Cowboys Cheerleaders uniform has come to be identified as the distinctive uniform of plaintiff's group, and is associated with the Dallas Cowboys Cheerleaders as distinguished from other entertainment groups. This identification and association have been acquired through use of the uniform in Dallas Cowboys Cheerleaders performances and appearances, both live and on television, over a period of about seven years, and through the use of the uniform in the licensed products already described.

Id. at 744.

Later in the opinion the Court also states:

The evidence shows that plaintiff, through promotion and use of the uniform, has established a strong identification between the uniform and the particular entertainment furnished by the Dallas Cowboys Cheerleaders, as distinct from cheerleading or other entertainment furnished by other parties, and also identifying the particular products licensed by plaintiff. Thus, the evidence shows that the uniform has acquired a secondary meaning associated with the Dallas Cowboys Cheerleaders.

Id. 746-747. The Court's language supports the proposition that certain types of garb, as different in nature and use as the Dallas Cowboys Cheerleaders uniforms and the Habit, are neither unusual nor inherently distinctive. Quite frankly, if the Dallas Cowboys Cheerleaders uniform is not inherently distinctive for services (just as in the case of

Chippendale's "Cuffs and Collar" mark), it is hard to imagine that the Habit is.

Because the Habit lacks inherent distinctiveness for both the identified goods and services, the applied-for mark may be protected only upon a showing of acquired distinctiveness. We now turn to review the record pertaining to this issue. The nature of the mark involved has a bearing in this case on the amount of evidence needed to show acquired distinctiveness. The trade dress of the Habit is relatively ordinary, and thus applicant has a heavy burden to prove it has acquired distinctiveness. *Yamaha*, 6 USPQ2d at 1008; *In re Gibson Guitar Corp.*, 61 USPQ2d 1948, 1953 (TTAB 2001); and *In re Ennco Display Systems, Inc.*, 56 USPQ2d 1279, 1286 (TTAB 2000). Of course, sticking with the theme that this case is not your "typical" trademark dispute, the evidence of acquired distinctiveness is missing some of the usual types of evidence, namely sales and advertising figures, promotional efforts, and the like. Section 2(f) requires that the substantially exclusive and continuous use must be "as a mark." Given the nature of the Habit, it is not surprising that applicant neither used the Habit on any tag or label associated with the goods, nor advertised or promoted the Habit as a source indicator for its goods and services. The record, in fact, does not

reveal even a single sale of any goods or services; opposer, however, has not raised this as a ground for opposition.

Our analysis of the issue of acquired distinctiveness is founded on the teachings of *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, supra. As *Yamaha* explains, when matter proposed for registration under Section 2(f) is approved by the USPTO for publication, there is a presumption that the examining attorney found a prima facie case of acquired distinctiveness by the applicant for registration. Id., 6 USPQ2d at 1004. In an opposition, "the opposer has the initial burden to establish prima facie that the applicant did not satisfy the acquired distinctiveness requirement of Section 2(f)." Id., 6 USPQ2d at 1005. "If the opposer does present its prima facie case challenging the sufficiency of applicant's proof of acquired distinctiveness, the applicant may then find it necessary to present additional evidence and argument to rebut or overcome the opposer's showing..." Id. However, under this analysis, the "ultimate burden of persuasion" on the acquisition of acquired distinctiveness is on the applicant. Id. Finally, the standard for applicant to meet its burden is preponderance of the evidence, "although logically that standard becomes more difficult to meet as the mark's descriptiveness increases." Id., 6 USPQ2d at 1008.

Opposition No. 91157073

Thus, in an opposition proceeding, opposer has the initial burden to present *prima facie* evidence or argument upon which the Board could reasonably conclude that applicant's mark has not acquired distinctiveness. If opposer carries the initial burden, then the burden of proof shifts to applicant to prove by at least a preponderance of the evidence that the mark has acquired distinctiveness. In an opposition proceeding such as this, the Board determines the question of acquired distinctiveness based on the facts existing as of the time registrability is being considered. The Board will take into account facts arising all the way through the trial period of the proceeding. The Board has stated:

In assessing secondary meaning, it is important to note that the right to register an allegedly descriptive designation must be determined not on the basis of the significance or meaning of the mark when first adopted, or even when registration was applied for, but rather on the basis of the factual situation at the time registration is under consideration, including during and throughout the pendency of *ex parte* and *inter partes* proceedings in which the mark may be involved. Thus, . . . the Board can and must consider all evidence of use, promotion, consumer reaction, etc. properly presented up to the close of the opposition's trial period.

General Foods Corp. v. MGD Partners, 224 USPQ 479, 486 (TTAB 1984). See also *McCormick & Co. v. Summers*, 354 F.2d 668, 148 USPQ 272 (CCPA 1966); *Harsco Corp. v. Electrical*

Opposition No. 91157073

Sciences, Inc., 9 USPQ2d 1570 (TTAB 1988); and *Kaiser Aluminum & Chemical Corp. v. American Meter Co.*, 153 USPQ 419 (TTAB 1967).

Thomas Walsh, opposer's director, secretary and treasurer, testified that the Herald's roots go back to the Brazilian TFP founded by Plinio. The Heralds began its use of the Habit in this country when its hermits returned to the United States in mid-2001. The Habit has been worn during hundreds of public activities undertaken by the Heralds, such as evangelization work and in processions that followed Mass at parishes in Miami. Other appearances occurred in California, Texas, and Louisiana, among other states. Of most significance is the Heralds' formation of musical ensembles, choirs and symphonic bands; the performers wear the Habit. Many of the Herald's public activities are musical performances, and some have been nationally televised on the cable network of the Catholic Church, EWTN ("Eternal Word Television Network"), on several occasions. (Walsh dep., Ex. 2 listing the Heralds' appearances and performances). Francisco Tobon, an officer of opposer and in charge of the Herald's house in Miami, Florida, testified about television interviews of Herald members wearing the Habit. Photographs of Herald members in the Habit have appeared in the Miami diocese newspaper and in Miami parish bulletins.

Opposition No. 91157073

The bulk of testimony and evidence bearing on applicant's use of the Habit comes from two individuals, namely Raymond Drake, applicant's president, and Philip Calder, a founding member of the American TFP, and who claims to be the first American to receive the Habit from Plinio. These two witnesses testify that the Habit has been worn at the American TFP hermits' regularly held Saturday evening meetings for thirty years. They also recount uses of the Habit at church events, rallies, "protests against blasphemy," conferences, two book launchings, holidays, and feast days. A closer reading of the testimony reveals, however, that the uses have been relatively minor, and fall far short of establishing acquired distinctiveness of the mark sought to be registered.

The Saturday meetings are held at the hermitage in Spring Grove and are attended by an average of forty people, "15 or so wearing the TFP Habit." (Drake dep., p. 13). Attendance of nonmembers averages 4-5 individuals, and these individuals "come from all over the country." (Drake dep., p. 13).

The first "public" event at which the Habit was worn by the hermits occurred on August 26, 1978 during a "parade" on Fifth Avenue in New York City. The parade was launched at the conclusion of a conference sponsored by American TFP at which there were 80-90 attendees (30 members, 50 guests).

Opposition No. 91157073

Four hermits wore the Habit during the "parade" that ended in prayer on the steps of St. Patrick's Cathedral. (Calder dep., pp. 6-8; Czaja dep., p. 9). The number of people who witnessed the hermits in the Habit is unknown. Mr. Calder described the event as a "perfectly public event," but one that "did not take up the whole street." (Calder dep., pp. 26 and 29).

The second "public" display took place in May 1980 in connection with a book launch sponsored by American TFP to commemorate the release of the American-English edition of Plinio's book "Revolution and Counter-Revolution." About 30 members and 40-50 guests attended the event at the Spring Grove hermitage; 17 hermits wore the Habit. (Calder dep., pp. 7, 11-12).

The third "public" display took place at the Spring Grove hermitage in September 1980 at a ceremony to commemorate the launching in Brazil of Plinio's book "Tradition, Family and Property: Half a Century of Epic Anticommunism." About 100 people were in attendance, including 50 members and 50 guests. Hermits wearing the Habit numbered 25. (Calder dep., p. 7, 13-14).

Applicant sponsors an annual conference for its supporters over a weekend. No numbers are given as to the numbers of hermits wearing the Habit or nonmembers in attendance. (Drake dep., p. 15).

Opposition No. 91157073

Mr. Drake described certain "special events" held by applicant at its Spring Grove hermitage. The events include Call to Chivalry Camps (30-40 boys in attendance) (p. 17); holiday celebrations (40-50 attend, 3-4 nonmembers) (p. 20); and a Christmas "open house" (100-300 attend, mostly nonmembers) (p. 25). Mr. Drake did not recall specifically the number of hermits wearing the Habit at these events, indicating only that the Habit is "sometimes" worn. (pp. 26-27).

Certain other events are held at the hermitage on feast days. There are other religious events, such as when the International Pilgrim Virgin Statue was displayed at the hermitage; again, Mr. Drake indicated that "sometimes" the Habit is worn, other times not. (p. 29).

Applicant's members have attended the March for Life in Washington, D.C. In 2006 and 2007, about 50 members attended, but Mr. Drake did not indicate how many wore the Habit. (pp. 43-44).

Mr. Drake also testified about the attendance of applicant's members at rosary rallies. Applicant's members also have participated in "public acts of reparation for blasphemies," such as demonstrations against "The DaVinci Code" movie and Mardi Gras in New Orleans. (p. 44). The number of hermits wearing the Habit, if any, is not reflected in the testimony.

Mr. Calder testified that the Habit "is to be used only in the TFP, not to be used outside publicly without express permission from [the quidam]." (Calder dep., 32). Mr. Drake testified that hermits come in contact with the public, but usually it happens "accidentally." (p. 49). There is a guard house on the property "to keep track of people going in or out of the property." (McKenna dep., p. 106). Nevertheless, applicant is engaged in publicity efforts that include a newsletter, a website and a magazine. Applicant's Crusade magazine is published bimonthly, with a circulation of 75,000 in 2007. (Drake dep., p. 54). The March/April 2006 and September/October 2006 editions each included a photograph of some hermits wearing the Habit. (Drake dep., pp. 61-62, Exs. X and Y).

Gregory Escaro, a full-time volunteer of applicant, works on applicant's website. Mr. Escaro detailed the effort to quantify the number of hits on applicant's website during December 2006-December 2007. There were 986,000 page views as a result of 411,000 visits (although it is unknown whether the visits were unique or repeats). There are 2000 pages on the website, of which only 20 pages (about 1%) display hermits wearing the Habit. The report does not indicate the number of views of the pages on which the Habit is displayed, leaving one to only speculate as to whether

visitors to the website even viewed any of the pages displaying the Habit.

Also of record is the testimony of three people, William Collins, Matthew Balan and Mary Laczkoskie. These individuals describe themselves as supporters and friends of applicant. All have attended various events, both public and private, at which hermits wearing the Habit have participated. Their testimony essentially is that the Habit signifies that the event is directly sponsored by or at least co-sponsored by applicant. (Balan dep., p. 7). Although he is a subscriber to Crusade magazine, Mr. Balan stated that he does not recall ever seeing the Habit in a photograph in the magazine. (Balan dep., p. 11). He also testified, as noted earlier, that "there's not that many members of the TFP, to my knowledge." (Balan dep., p. 14).

Given the ordinary nature of the habit, the evidence falls far short of showing acquired distinctiveness. Much of the use has been private, and the public displays of the Habit have been minimal, both in quality and quantity. The Habit is used in one way and one way only: it is worn by applicant's members. However, the mere wearing of the Habit, mostly in private situations, does not magically transform the Habit into a source indicator for applicant's goods and services.

As indicated earlier, the proof of acquired distinctiveness is so unusual in this case because it is entirely devoid of the normal types of evidence, such as sales figures, advertising expenditures, "look for" promotional efforts, product/service popularity, brand awareness numbers, market share, and the like.

We have considered, of course, the direct evidence of acquired distinctiveness, namely the testimony of the three individuals who identified themselves as supporters of applicant and its efforts. This evidence points out another unusual aspect of this case, namely the question of who comprises the relevant "buyer" class of applicant's goods and services. Applicant's goals have been identified as "the defense of the perennial values of Christian civilization, namely tradition, family and property" (Drake dep., p. 5) and "[the defense of] Christian civilization against the liberal struggle to reshape western civilization, even to destroy Christian civilization." (Balan dep., p. 17).

Thus, applicant's services of "promoting public awareness of the need for healthy and religious families in the United States" services are hardly confined to just its members and supporters. Although we are not suggesting that the relevant "buyer" class is the general public, we do think, given applicant's lofty goals, that the focus on the

"consuming public" in this case needs to be broader than just applicant's members and supporters. This fact is shown by applicant's activities against the "blasphemies" of "The DaVinci Code" movie and Mardi Gras in New Orleans. Thus, we do not find the state of mind of three of applicant's supporters to be particularly probative in this case. They are obviously very familiar with applicant and its activities, and we find their testimony to be extremely unrepresentative, in the same manner that an employee's, officer's or dealer's testimony as to recognition of a design as a mark is not very helpful in determining the issue of acquired distinctiveness.

There is an additional infirmity in applicant's case for acquired distinctiveness. "In most oppositions to registrations under Section 2(f), prevailing opposers have presented some evidence that the mark has not acquired distinctiveness, such as others' use of the proposed mark or similar marks." *Yamaha*, 6 USPQ2d at 1008-09. Section 2(f) requires that the applicant's use be "substantially" exclusive. The statute makes allowance for use by others which may not rise to a level so as to invalidate the applicant's claim.

The record herein establishes that the Heralds' use of the Habit in the United States has been significantly more public in nature than applicant's own use of the Habit. The

Heralds' members wearing the Habit during public musical performances, some of which have been broadcast on a nationally televised cable channel, has garnered more public exposure than the handful of public displays of the Habit by applicant's members.⁸

We find that the Herald's use of the Habit contemporaneously with applicant's use rebuts applicant's contention of substantially exclusive use, and acts to defeat applicant's claim of acquired distinctiveness. *Quaker State Oil Refining Corp. v. Quaker Oil Corp.*, 453 F.2d 1296, 172 USPQ 361, 363 (CCPA 1972); *McCormick & Co. v. Summers*, 354 F.2d 668, 148 USPQ 272 (CCPA 1966); and *DeWalt, Inc. v. Magna Power Tool Corp.*, 289 F.2d 656, 129 USPQ 275 (CCPA 1961).

We should note that if the roles somehow ever were reversed, that is, if opposer were to attempt to register the mark, opposer would face some of the same hurdles experienced by applicant in obtaining a registration of the Habit. Perhaps this will not be a concern in the future

⁸ Further, while there is testimony that the Habit was patterned after the one worn by the Third Order of Carmelites (Cla Dias and Plinio were members), there is no testimony or evidence as to the extent of this use. (Dantas dep., p. 12). Neither is there a picture of that garb so as to gauge its similarity with the Habit. However, given the proper proofs, this third-party use may act as an additional barrier against any claim of "substantially exclusive" use. Mr. McKenna also identified (with no details) another use by the Knights of the New Millennium. (McKenna dep., p. 147).

given opposer's statement that

[o]pposer does not contend that the use of the Habit in the United States by its members was intended to indicate a source for the goods and services named in Applicant's application. As previously noted, the Habit was conceived and used by Cla Dias and Prof. Plinio as a symbol that its wearer strives to live a life of sanctity in accordance with the teachings and discipline of the Catholic Church.

(Reply Brief, p. 19). Nevertheless, although applicant's public use has been minimal, there would be a fact issue in any opposition as to whether applicant's use would negate a claim by opposer that its use was "substantially exclusive" as required by the statute.

So as to be clear, the record is devoid of any evidence of the promotion of the Habit as a source indicator for the identified goods and services, and what evidence there is of record bearing on acquired distinctiveness falls short of establishing it. Although the Habit may signify other recognizable purposes, such as obedience and commitment, the Habit does not serve as a source indicator for applicant's goods and services.

We also note applicant's reliance on a handful of third-party registrations of marks comprising uniforms or costumes. Each case must rest on its own record, and we recognize that such marks are registrable with the proper proofs. Nevertheless, these registrations do not compel a

different result in this case. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("Even if some prior registrations had some characteristics similar to [applicant's] application, the PTO's allowance of such prior registrations does not bind the board or this court.").

We have carefully considered all of the evidence pertaining to this disputed claim, as well as all of the parties' arguments with respect thereto (including any evidence and arguments not specifically discussed in this opinion).

Accordingly, we conclude that the Habit is not inherently distinctive in connection with applicant's services, and that applicant has failed to establish acquired distinctiveness in connection with either the goods or services identified in the application.

Other Issues

Having determined that opposer is entitled to prevail in this opposition based upon its claim that the matter sought to be registered is not distinctive, we need not reach the merits of opposer's claims regarding ownership and likelihood of confusion. See *American Paging Inc. v. American Mobilphone Inc.*, 13 USPQ2d 2036, 2039-40 (TTAB 1989), *aff'd without opinion*, 17 USPQ2d 1726 (Fed. Cir. 1990).

Final Comment

In addition to the valid claim herein, there are additional significant problems with the involved application that, in our view, raise serious doubts about the registrability of the Habit based on the current application. In the event applicant ultimately prevails in this proceeding, a remand, pursuant to Trademark Rule 2.131, is in order. See TBMP §805 (2d ed. rev. 2004).

If our decision herein is reversed on appeal with respect to either standing or the grounds for relief, or both, a remand is appropriate. There does not appear to be any "goods in trade" in Class 25. Before rights in a designation as a trademark can be established, the subject matter to which the designation is applied must be "goods in trade." Incidental items that an applicant uses in conducting its business, as opposed to items sold or transported in commerce for use by others, are not "goods in trade." See *In re Shareholders Data Corp.*, 495 F.2d 1360, 181 USPQ 722 (CCPA 1974). While a formal sale is not always necessary, items sold or transported in commerce are not "goods in trade" unless they have utility to others as the type of product named in the application. If a mark is not used on "goods in trade," it is not registrable. See TMEP §1202.06 (5th ed. 2007).

Opposition No. 91157073

If our decision herein is reversed on appeal with respect to standing only, and the reviewing court does not address the grounds for relief, a remand is appropriate. Insofar as the services in Class 35 are concerned, the Habit does not appear to function as a mark within the meanings of Sections 1, 2 and 45 of the Trademark Act. To function as a service mark, a designation must be used in a manner that would be perceived by the relevant public as identifying and distinguishing the source of the services recited in the application. See TMEP §1301.02(a) (5th ed. 2007).

Decision: The opposition is sustained on the claim that the mark sought to be registered is not inherently distinctive, and that it has not acquired distinctiveness for either the listed goods or services. Registration to applicant is refused.