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TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE  
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March 28, 2019

Cancellation No. 92065178 (parent case)

Cancellation No. 92065255

*Philanthropist.com, Inc.*

*v.*

*The General Conference Corporation of  
Seventh-day Adventists*

**Before Bergsman, Wellington and Goodman,  
Administrative Trademark Judges.**

**By the Board:**

These consolidated proceedings are before the Board for consideration of Respondent's motion for summary judgment filed September 29, 2018. The motion is fully briefed.

### **Background**

In the operative pleadings, Petitioner sets forth the claim that Respondent's mark ADVENTIST (standard characters) is generic, pursuant to Trademark Act § 14(3), 15 U.S.C. § 1064(3), in:

- 1) Cancellation No. 92065178, 15 TTABVUE<sup>1</sup>, Registration No. 1176153, registered November 3, 1981, for:

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<sup>1</sup> When referring to the record, the parties should reference the Board's TTABVUE docket by the entry and page number, *e.g.*, 10 TTABVUE 15. *Turdin v. Trilobite, Ltd.*, 109 USPQ2d

religious books, magazines, pamphlets, newsletters, brochures, encyclopedias, dictionaries, commentaries, fliers, bulletins, booklets and bibles, in International Class 16;

film production and distribution services, in International Class 41; and

health care services - namely, hospital, dental, pharmaceutical, nursing home, and medical laboratory services, in International Class 42;<sup>2</sup> and

- 2) Cancellation No. 92065255, 16 TTABVUE, Registration No. 1218657, registered November 30, 1982, under Trademark Act § 2(f), for:

educational instruction services in academics at grade school, high school and college levels, in International Class 41, and

religious observances and missionary services, in International Class 42.

Respondent filed a motion for summary judgment on Petitioner's standing and the claim that the mark ADVENTIST is generic. The motion is fully briefed.<sup>3</sup>

## Analysis

Summary judgment is appropriate where the movant demonstrates that there is no genuine dispute as to any material fact, and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a). A party asserting that a fact cannot be true or is genuinely disputed must support its assertion by either: 1) citing to materials in the record, or 2) showing that the materials cited do not establish the absence or presence

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1473, 1476 n.6 (TTAB 2014). In this order, unless otherwise noted, references are to the record in Cancellation No. 92065178.

<sup>2</sup> The registration also identifies International Class 36 services which are not subject to the petition to cancel. Canc. No. 92065178, 1 TTABVUE 1.

<sup>3</sup> The Board has considered the parties' briefs on the contested motion, but does not repeat or discuss all of the arguments and submissions, and does not address irrelevant arguments. *Guess? IP Holder LP v. Knowlux LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015). However, the Board has carefully considered all arguments and evidence of record.

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of a genuine dispute, or that an adverse party cannot produce admissible evidence to support the fact. Fed. R. Civ. P. 56(c). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. *Opryland USA Inc. v. Great Am. Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). The party seeking judgment in its favor carries the initial burden of demonstrating that there is no genuine dispute regarding any material fact remaining for trial and that it is entitled to judgment as a matter of law. *Celotex Corp. v. Catrett*, 477 U.S. 317, 323-24 (1986).

Evidence on summary judgment must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. *Lloyd's Food Prods., Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA*, 23 USPQ2d at 1472. The Board may not resolve genuine disputes as to material facts; it may only ascertain whether genuine disputes as to material facts exist. *Lloyd's Food Prods.*, 25 USPQ2d at 2029; *Olde Tyme Foods*, 22 USPQ2d at 1544. *See also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") § 528.01 (2018), and cases cited therein.

To prevail on summary judgment, Respondent carries the burden of demonstrating that there is no genuine dispute of material fact that Petitioner lacks standing, and/or that Respondent's mark ADVENTIST is not generic as used on or in connection with the goods and services identified in its registrations for which cancellation is sought.

## **Standing**

Standing is a threshold issue that must be proven by a plaintiff in every inter partes case. *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). To establish standing, a plaintiff must show that it has a “real interest” in the outcome of the proceeding and a “reasonable” basis for its belief of damage; that is, that it has a direct and personal stake in the outcome of the proceeding. *Empresa Cubana*, 111 USPQ2d at 1062; *Ritchie v. Simpson*, 50 USPQ2d at 1025; *Jewelers Vigilance Committee, Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021 (Fed. Cir. 1987).

In the second amended petition to cancel<sup>4</sup> Petitioner alleges that 1) it owns the domain name Adventist.com; 2) it received a cease and desist letter from Respondent demanding surrender of the domain name and stating that Respondent would seek injunctive relief and damages; and 3) Petitioner’s ownership of the domain name was upheld in a Uniform Domain Name Dispute Resolution Policy (“UDRP”) action Respondent brought against Petitioner. 15 TTABVUE 3-4. Petitioner included with the pleading copies of the UDRP pleadings and decision, and cease and desist letter. 15 TTABVUE 15-58.

On summary judgment, Respondent posits that the allegations of standing “are without any factual basis” (22 TTABVUE 6) because in view of the UDRP decision,

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<sup>4</sup> The Board found that Petitioner alleged standing in the first amended petition to cancel. 14 TTABVUE 5-8. Respondent acknowledges this. 22 TTABVUE 4.

Petitioner no longer has a reasonable belief of damage through legal action from Respondent, that any belief it still has of threat of litigation from Respondent does not rise to the level of a reasonable belief of damage, that the value of the domain name has not depreciated, and that Petitioner's motive is its spite toward Respondent. 22 TTABVUE 7-8; 29 TTABVUE 4.

Petitioner argues that it has standing inasmuch as its belief of economic damage is not merely hypothetical, but is based on its continued ownership of and commercial interest in the domain name, the continued threat of potential legal action by Respondent, and depreciation in the value of the domain name. It reiterates the contents of the cease and desist letter, and notes that Respondent never recanted its threats. 28 TTABVUE 15; 15 TTABVUE 15.

On this record, there is a genuine dispute of material facts that are relevant to Petitioner's standing, including, at a minimum, whether Petitioner has a reasonable belief of damage through potential legal action from Respondent, as detailed in Respondent's cease and desist letter. Petitioner must maintain its basis for standing throughout this proceeding and must prove its standing at trial. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Indus., Inc. v. Ralston Purina Co.*, 213 USPQ at 189.

### **Ground for Cancellation – Generic**

Deciding whether a term is generic involves determining 1) the genus of the goods or services at issue, and 2) whether the term is understood by the relevant public primarily to refer to that genus of goods or services. *Princeton Vanguard, LLC v.*

*Frito-Lay North America, Inc.*, 786 F.3d 960, 114 USPQ2d 1827, 1830-31 (Fed. Cir. 2015); *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1553 (Fed. Cir. 1991); *H. Marvin Ginn Corp. v. Int’l Assoc. of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 531-32 (Fed. Cir. 1986); *Luxco, Inc. v. Consejo Reglador del Tequila, A.C.*, 121 USPQ2d 1477, 1497 (TTAB 2017).

In seeking summary judgment, Respondent does not specifically delineate the genus of goods and services on which its arguments are focused, but appears to maintain that the genus is a class or category of Protestant Christian religious observances and missionary services. 22 TTABVUE 9-10. Petitioner does not address the genus issue.

Respondent maintains that Petitioner has no evidence that the term “Adventist” is generic in connection with the educational services, health care services, film production services and printed publications. 22 TTABVUE 19. It points to the Wikipedia entry Petitioner included with its petition to cancel as flawed and uncorroborated and having various points of false information; argues that the dictionary definitions Petitioner references in its pleading and responses to interrogatories do not address how the term “Adventist” is actually used and understood by relevant consumers; argues that the reports of Respondent’s two experts in theology and religious history show that Petitioner’s allegations on the historical meaning of “Adventist” are false; and argues that various groups outside of the General Conference that Petitioner identified in discovery as using the mark actually use “Adventist” in their name in a nominative manner to inform consumers

that the groups used to be affiliated with the Seventy-day Adventists but since broke away from the Church, and do not use it as a generic term. 22 TTABVUE 10-15. Respondent submits, inter alia, excerpts from the discovery deposition of Petitioner's designee, Greg Everett; the reports of Respondent's experts Clinton Wahlen, Ph.D. and George W. Reid, Ph.D., and supporting documents; the declaration of its Associate General Counsel Jennifer Gray Woods, and supporting documents; and Petitioner's responses to Respondent's first and second sets of interrogatories.

Petitioner argues that "Adventist" is generic for religious services, publications, observances, and other goods and services that pertain to or signal an association with the religion of Adventism. It submits, inter alia, dictionary excerpts to show that various definitions of the term are not limited to adherents of Respondent's specific church, but rather state that the Adventist faith predates Registrant's particular practices, and that at least nine other sects using the term "Adventist" follow the Adventist faith, independent of Respondent; encyclopedia entries to show that the generic term for the type or category of religion that believes in the second advent of Christ is "Adventist" and that Respondent's sect is one of many Adventist denominations, to show that "Adventist" is the generic name of the category of religion that believes that the second coming of Christ is imminent; and encyclopedia entries to show that not all Adventists are Seventh-day Adventists belonging to Respondent's congregation. With respect to Respondent's survey evidence, Petitioner notes that a minority of those polled connected "Adventist" to Respondent, that a majority associate the term with either a generic Christian faith or with nothing at

all, and that even within Christian religious communities Respondent is not perceived as the sole or primary user of the word. 28 TTABVUE 14. Petitioner also points to the dissent in *Stocker v. Gen'l. Conference Corp. of Seventh-Day Adventists*, 39 USPQ2d 1385 (TTAB 1996).

Having viewed the evidence on summary judgment in a light most favorable to Petitioner, and having drawn all justifiable inferences in Petitioner's favor, we find that Respondent has not carried its burden to demonstrate that there is no genuine issue of material fact that the mark ADVENTIST is not generic for the identified goods and services. At a minimum, there is a genuine dispute with respect to whether "Adventist" is used or understood, by purchasers or potential purchasers of the goods and services at issue, primarily to refer to a class or category of Protestant Christian religious observances and missionary services. Moreover, the parties have not adequately focused on the goods and services for which Petitioner seeks to cancel the registrations. For example, Respondent emphasizes that Petitioner did not provide evidence that the term "Adventist" is generic for the International Class 36 services in Registration No. 1176153 (22 TTABVUE 23); however, International Class 36 is not subject to cancellation.

Furthermore, Petitioner has submitted, at a minimum, dictionary and encyclopedia evidence that demonstrates the existence of a genuine dispute regarding whether the term "Adventist" is understood by the relevant public primarily to refer to Protestant Christian religious observances and missionary services. In view thereof, Respondent's motion for summary judgment is **denied**.



The evidence submitted in connection with the motion for summary judgment is of record only for consideration of that motion. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. *Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1438 n.14 (TTAB 2007); *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993). Moreover, the fact that we have identified certain issues that are in dispute should not be construed as a finding that these are necessarily the only issues which remain for trial.

Inasmuch as this proceeding is on the verge of trial, the Board will not entertain any further motions for summary judgment.

### **Expert Disclosure**

The deadline to serve expert disclosures, as reset, was July 17, 2018. On July 18, 2018, Respondent filed notice to the Board that it had served expert disclosures on Petitioner, but did not state when it served said disclosures. 20 TTABVUE 2. Petitioner did not raise the issue of the untimeliness of the disclosures, and thereafter Respondent filed its motion for summary judgment on the eve of trial.

Based on this record, the Board presumes that Petitioner did not disclose plans to use a rebuttal expert, and that the parties completed discovery of the disclosed experts. TBMP § 401.03. Accordingly, the parties shall proceed to trial.

### **Resumption and Schedule**

These consolidated proceedings are resumed, and trial dates are reset as indicated below:

Plaintiff's Pretrial Disclosures Due	4/19/2019
Plaintiff's 30-day Trial Period Ends	6/3/2019
Defendant's Pretrial Disclosures Due	6/18/2019
Defendant's 30-day Trial Period Ends	8/2/2019
Plaintiff's Rebuttal Disclosures Due	8/17/2019
Plaintiff's 15-day Rebuttal Period Ends	9/16/2019
Plaintiff's Opening Brief Due	11/15/2019
Defendant's Brief Due	12/15/2019
Plaintiff's Reply Brief Due	12/30/2019
Request for Oral Hearing (optional) Due	1/9/2020

Generally, the Federal Rules of Evidence, Federal Rules of Civil Procedure and Trademark Rules of Practice apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, matters in evidence, the manner and timing of taking testimony, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).