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ALLOCATION OF NEW TOP-LEVEL DOMAIN NAMES AND THE EFFECT UPON RELIGIOUS FREEDOM

N. CAMERON RUSSELL

ABSTRACT

The monopoly provided when trademark protection is given to a religious name is in direct tension with an individual's right to freedom of religion. One's ability to freely use a particular religious name in spiritual practice, and to identify one's belief system with the words that commonly describe it, are weakened when trademark law designates just one owner. This Article explores the impact of the impending issuance of brand new top-level domains utilizing religious names, and how the providing of an exclusive right for one entity to govern over a religious top-level domain, in addition to the existence of a trademark monopoly held upon the same name, may affect the vigor of freedoms of religion and speech. This Article argues that there should be a presumption against trademark protection of religious names in order to reaffirm constitutional freedoms, and that the implementation of such a presumption within U.S. law will have the additional benefit of improving an imperfect judicial framework for analyzing trademark cases involving religious names. The Article concludes by proposing some specific rules for implementation of such a presumption, as well as some comparative remarks juxtaposing the solution proposed by this Article with public policy objectives and the discourse within the international community.

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INTRODUCTION

This Article will examine the ability of religious institutions to claim exclusive trademark rights in certain religious words, phrases and trade indicia. Specifically, the Article will approach this issue by analyzing the recent announcement of the Internet Corporation for Assigned Names and Numbers (“ICANN”) that it has accepted applications for new top-level domain (“TLD”) names—including religious domains, such as <.catholic>, <.islam> and <.bible>—in order to expand beyond <.com>, <.org> and the like.¹ Although ICANN has not yet processed any of these new TLD applications, thus assigning a TLD to a winning bidder, the mere prospect of doing so has already fueled worldwide theological debate.² Should one particular entity be given the exclusive right to govern a TLD utilizing a religious name or phrase? If so, what are the ramifications of granting the right of governance to one title-holder? Notwithstanding hortatory argument, the first results of the applications are due to be released by ICANN in the summer of 2013, when legal disputes will inevitably stem from the award of a religious TLD to one specific entity.³

In fact, it seems that legal proceedings are especially likely within the United States, where precedent in some courts recognizes no distinction between trademark rights in religious names versus secular trade names alleged to exist in any other commercial context, including when religious words and phrases are used within

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¹ ICANN Approves Historic Change to Internet's Domain Name System—Board Votes to Launch New Generic Top-Level Domains, ICANN (June 20, 2011), <http://www.icann.org/en/news/announcements/announcement-20jun11-en.htm>. For a full listing of applications received by ICANN for new gTLDs as of June 13, 2012, see *New gTLD Applied-For Strings*, ICANN (June 13, 2012), <http://newgtlds.icann.org/en/program-status/application-results/strings-1200utc-13jun12-en>. Also note that, for ease of reading, when specific TLDs or web addresses are referenced within the text, each is denoted within right and left angle brackets.

² Tom Heneghan, *Religious Groups Vie for New Web Domain Names*, REUTERS (Aug. 31, 2012, 6:56PM), <http://www.reuters.com/article/2012/08/31/net-us-internet-religion-names-idUSBRE87U0L320120831>. “The Vatican’s application for exclusive use of .catholic drew criticism from members of several Protestant churches who also use the term, which comes from the Greek for ‘universal.’” *Id.*

³ *Id.*; see also *ICANN Increases Web Domain Suffixes*, BBC NEWS (June 20, 2011), <http://www.bbc.co.uk/news/technology-13835997> (indicating that a portion of funding will be set aside to “deal with potential legal actions raised, raised by parties who fail to get the domains they want”).

Internet domain names.⁴ If there is an allegation of cybersquatting,⁵ there is specific redress within the Lanham Act,⁶ as well as an exclusive avenue for alternative dispute resolution under the Uniform Domain Name Dispute Resolution Policy (the “UDRP”) administered through the World Intellectual Property Organization (“WIPO”).⁷ But absent a cybersquatting allegation, the analysis of one’s use of religious trademarks in the domain name context is generally the same as in any other trademark infringement action, so long as the challenged designation is used within a website in some commercial sense.⁸ In short, religious names receive traditional trademark protection, and the rules and the legal analysis for determination of whether trademark rights exist do not change simply because another’s use of an asserted trademark takes place ahead of <.com>, or before or within any other TLD in a website address.⁹

Good faith uses of religious names in domain names, whether in sincere practice of one’s religion or in genuine exercise of freedom of speech, will not fall under the cybersquatting umbrella.¹⁰ Therefore, in these cases, courts will apply traditional legal standards under the Lanham Act to claims of trademark infringement involving religious trade names, which looks to (i) whether the plaintiff has a protectable ownership interest in the mark, and (2) whether the defendant’s use of the mark is likely to cause consumer confusion.¹¹ We should rethink the current legal framework and how we apply the law to decide whether trademark rights exist in these religious names.

⁴ See, e.g., *Gen. Conf. Corp. of Seventh-Day Adventists v. McGill*, 617 F.3d 402, 416 (6th Cir. 2010) (finding that a pastor’s use of the term “Seventh-day Adventist” in church name was likely to cause confusion among the public); *Jews for Jesus v. Brodsky*, 993 F. Supp. 282, 305 (D.N.J. 1998), *aff’d*, 159 F.3d 1351 (3d Cir. 1998) (finding trademark rights existed in “Jews for Jesus” and finding against a critic of Jews for Jesus seeking registration of “jewsforjesus.org” and “jews-for-jesus.com.”); *Purcell v. Summers*, 145 F.2d 979, 983–84 (4th Cir. 1944) (finding “Methodist Episcopal Church” had exclusive rights to use the name).

⁵ *Frequently Asked Questions: Internet Domain Names*, WORLD INTELL. PROP. ORG., <http://www.wipo.int/amc/en/center/faq/domains.html> (last visited May 24, 2013) (defining cybersquatting as “exploit[ing] the first-come, first-served nature of the domain name registration system to register names of trademarks, famous people or businesses with which they have no connection”).

⁶ 15 U.S.C. § 1125(d) (2012).

⁷ *Domain Name Dispute Resolution*, WORLD INTELL. PROP. ORG., <http://www.wipo.int/amc/en/domains/> (last visited May 24, 2013).

⁸ 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 25:76 (4th ed. 2012) (explaining that the Lanham Act is triggered “[w]hen a domain name is used for a Web site that advertises or offers for sale any goods or services”).

⁹ See *In re Hotels.com, L.P.*, 573 F.3d 1300, 1304 (Fed. Cir. 2009) (holding that “the generic term ‘hotels’ did not lose its generic character by placement in the domain name HOTELS.COM.”).

¹⁰ 4 MCCARTHY, *supra* note 8, § 25:78 (“The good faith safe harbor was held broad enough to accommodate a religious group that had a reasonable belief that it could use the name of a group critical of its religion as the domain name of a web site mocking and rebutting the critic’s Web site.”); *Utah Lighthouse Ministry v. Found. for Apologetic Info. & Research*, 527 F.3d 1045, 1058–59 (10th Cir. 2008) (holding that supporters of the Mormon Church who created a website with a domain name the same as the name of an organization which was critical of the Mormon Church was not an ACPA violation.).

¹¹ 15 U.S.C. § 1125(a) (2012).

This Article argues that, absent bad faith in the selection and use of a particular religious name or phrase, such as in instances of domain name cybersquatting, there should exist a strong, but rebuttable presumption that religious trade indicia are excepted from trademark protection under U.S. intellectual property law. Rebuttal of the presumption should require “clear and convincing” evidence in order to protect the integrity of trademark protection at a fundamental level, while at the same time, reaffirm a constitutional absolute to preserve free practice of religion for all, whether big or small, and no matter how new or old a genuine religious belief may be. It seems apparent that courts’ application of the traditional law of trademarks in the context of religious names has not engendered bright-line, consistently-applied, rules for protection and cannot be sustained moving forward.¹² This Article posits that, especially in the imminent post-TLD-expansion era, use of religious names within Internet domain names aptly demonstrates why we should rethink how we apply the law to these cases. In turn, a presumption that such religious words and phrases are excepted from trademark protection is worthy of consideration by U.S. lawmakers and jurists.

Part I of this Article examines the current state of trademark jurisprudence from a practical and forward-looking standpoint through the impending scenario of ICANN’s expansion into new TLD names, a move toward an almost limitless creation of new “real estate” on the web.¹³ Providing one religious entity with an exclusive broad-sweeping intellectual property right, in addition to its exclusive right to occupy a particular area of cyberspace, would restrict *every* other bona fide user’s ability to use the particular religious name or phrase in *any other* area of cyberspace, including in other TLDs as they inevitably expand over time.¹⁴ Therefore, the example of TLD expansion aptly demonstrates why there should be a presumption against the existence of a trademark monopoly over a religious name.

Part II considers the present judicial framework for adjudicating cases involving trademarks and religious names, one which has been labeled an “intellectually unsatisfactory” rubric and criticized by many legal scholars.¹⁵ The bases for such criticism are generally two-fold. First, such religious words and phrases are largely generic, and are merely basic descriptions of the particular religious “product” or “service” being promoted.¹⁶ This Article argues that genericism becomes the overwhelming likelihood if traditional trademark tests are properly and secularly applied. Therefore, it should be presumed that religious trade indicia are incapable of

¹² Gen. Conf. Corp. of Seventh-Day Adventists v. McGill, 617 F.3d 402, 416 (6th Cir. 2010) (awarding trademark protection to “Seventh-day Adventist”); Christian Sci. Bd. of Dirs. of First Church of Christ, Scientist v. Evans, 520 A.2d 1347, 1349 (N.J. 1987) (providing no trademark protection to “Christian Science”).

¹³ ICANN Increases Web Domain Suffixes, *supra* note 3.

¹⁴ See Zippo Mfg. Co. v. Zippo Dot Com, Inc., 952 F. Supp. 1119, 1121 n.3 (W.D. Pa. 1997) (“Once a domain name is registered to one user, it may not be used by another.”).

¹⁵ See Louis J. Sirico, Jr., *Church Property Disputes: Churches as Secular and Alien Institutions*, 55 FORDHAM L. REV. 335, 335–37 (1986).

¹⁶ Jed Michael Silversmith & Jack Achiezer Guggenheim, *Between Heaven and Earth: The Interrelationship Between Intellectual Property Rights and the Religion Clauses of the First Amendment*, 52 ALA. L. REV. 467, 469 (2001) (“[M]ost religious organizations’ names consist of generic words . . .”); *id.* at 511 (providing that a religious trademark could be generic if it “contain[s] words that are common words merely describing a set of beliefs”).

acquiring the requisite secondary meaning in order to receive protection as a descriptive mark unless a party can demonstrate through “clear and convincing” evidence that the religious name is, in fact, a single source identifier. Second, notwithstanding whether religious names are capable of trademark protection in theory, U.S. courts, reasonably, have incredible difficulty deciding matters involving intellectual property rights and religious names because, absent clear bad faith, another’s bona fide use of religious words or phrases is protected by the First Amendment of the U.S. Constitution. Accordingly, both the genericism and constitutional aspects of any legal analysis in these cases auger in favor of a *per se* presumption against recognizing trademark rights in these religious names. These religious names should not be monopolized by limited groups and should be presumed available within the public domain for society’s use, whether to direct Internet traffic to a specific area of cyberspace, to freely describe one’s religion, or for purposes of criticism in the spirit of free speech.

Part III will briefly summarize the alternative means of dispute resolution available outside of the courts, which become especially relevant subsequent to TLD expansion, in the event of a dispute as to use of a religious name within a domain name. As posited herein, parties will seek to find redress through a more-able and more-efficient means of adjudication outside of the present inadequate court system if one is available. I submit that one is not, and adoption and implementation of a presumed exception for religious names from trademark protection within U.S. courts will assist to bandage the only means of adjudication existing.

Finally, Part IV proposes the solution—a presumption against trademark protection for religious names—by offering some clear rules of application, along with some concluding remarks regarding the proposal’s congruence with public policy objectives and international norms.

I. INFINITE EXPANSION OF TOP LEVEL DOMAINS WILL INEVITABLY REQUIRE CHANGE WITHIN THE LAW

The current legal framework does not make practical sense moving forward with respect to its application to domain names in Internet addresses. Currently, because of the relatively limited number of TLDs, and the resulting limitation on lower-level domain names within them, there is a corresponding limited ability to obtain “infringing” domain names which utilize words and phrases protected by trademark.¹⁷ Now, ICANN’s expansion into new TLD names signifies a step toward an almost limitless creation of potential, perhaps likely, infringing names.¹⁸ As discussed above, because religious names receive trademark protection, including within domain names, an exclusive intellectual property monopoly held by the

¹⁷ *ICANN Increases Web Domain Suffixes*, *supra* note 3 (“There are currently 22 gTLDs, as well as about 250 country-level domain names such as .uk or .de.”).

¹⁸ Brad Newberg & Judy Harris, *Understanding the Many Challenges Involved in Registering New GTLDS*, in *NAVIGATING ICANN’S NEW RULES REGARDING GENERIC TOP-LEVEL DOMAIN NAMES: AN IMMEDIATE LOOK AT THE OPPORTUNITIES AND CHALLENGES THAT COME WITH THE NEW GTLD PROGRAM* 65 (Aspatore Special Report 2012).

winning bidder for a new religious TLD, in addition to an exclusive right to occupy and divvy space on the TLD, will leave no avenue for other bona fide uses of that religious name or phrase on the Internet, even as TLDs continue to expand, and even at the risk of constitutional freedoms.

A. ICANN'S Release of New Religious Top-Level Domains

Without evaluating whether an applicant has the right to a certain name, ICANN has developed a complex administrative procedure, coined “Digital Archery,” for how it will process applications for new TLDs when received.¹⁹ Once a TLD is granted to a particular person, organization or entity, importantly, the award includes an exclusive right to make a determination as to who receives the lower-level domain names within its newly-acquired TLD.²⁰ It may “manage that domain exclusively, renting out addresses that use its extension and rejecting bids it considers unsuitable.”²¹

B. A Presumption Against Trademark Protection Comports with the Competition Objectives Underlying Trademark Law

A primary objective of trademark law, and of intellectual property law as a whole, is to generate and sustain an environment of robust competition.²² On one hand, trademark law allows for protection of “brands” so that a producer or service provider can build a reputation that its product or service is better than another, and consumers can reward producers for their hard work through purchase of products or services sold under one’s particular mark.²³ However, trademark law draws distinct boundaries where the providing of a monopoly on a particular word, phrase or other designation thwarts inter-brand competition by placing competitors at a significant non-reputation-related disadvantage.²⁴ Such limitation comports with a normative “distributive justice” theory underlying intellectual property as a legal construct, as well as international notions of basic human rights, to strike a balance between right holders’ and users’ interests such that monopolies are not unconditionally perpetual. In doing so, a basic right is preserved to share in the resources and societal

¹⁹ Heneghan, *supra* note 2. “We don’t look into whether the Vatican has the right to the .catholic name,” [Akram] Atallah [interim head of ICANN] said. “Hopefully, the process will get to a conclusion that is satisfying to the majority.” *Id.* For a description of the “Digital Archery” procedure, see *How ICANN Will Process Applications If Many are Received*, ICANN, <http://newgtlds.icann.org/en/applicants/tas/batching/basics> (last visited May 24, 2013).

²⁰ Heneghan, *supra* note 2.

²¹ *Id.*

²² U.S. DEPT. OF JUSTICE & FED. TRADE COMM’N., ANTITRUST ENFORCEMENT AND INTELLECTUAL PROPERTY RIGHTS: PROMOTING INNOVATION AND COMPETITION 2 (2007), *available at* <http://www.justice.gov/atr/public/hearings/ip/222655.pdf>.

²³ *Louboutin v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206, 215 (2d Cir. 2012).

²⁴ *Qualitex Co. v. Jacobson Prods. Co., Inc.*, 514 U.S. 159, 165 (1995).

advancement of the community and to participate in its cultural life.²⁵ At its core, trademark law's emphasis on healthy competition preserves these basic fundamentals.

Notwithstanding, the ability for religious voices to compete and culturally participate is tested when an exclusive trademark monopoly is held by the winning bidder for a new religious TLD. For instance, in the event that the American Bible Society is awarded the <.bible> TLD for which it has applied, then without American Bible Society approval, no matter how objectively provided or withheld, one will be forbidden from occupying a web space on <.bible>.²⁶ The American Bible Society will make a subjective determination as to whether a certain group has a "healthy respect for the Bible" sufficient to occupy space on the <.bible> TLD.²⁷ Will the American Bible Society approve of an organization affiliated with the Jehovah's Witnesses?²⁸ With Mormonism?²⁹ With Islam?³⁰ If not, then Jehovah's Witnesses, Mormons and Muslims must seek an alternative virtual home, that is, another web address on an alternate TLD, even if <.bible> becomes the renowned universal marketplace of ideas as to the Bible. As a result, the American Bible Society would have unilaterally restricted these groups from discourse in the mainstream.

Of course, the American Bible Society does not own trademark rights in the word "bible." However, in the event that an organization *does* possess a trademark monopoly on a religious name, in addition to the same power of exclusivity held by the American Bible Society for a certain TLD, where are minority groups to go on the

²⁵ Shubha Ghosh, *The Fable of the Commons: Exclusivity and the Construction of Intellectual Property Markets*, 40 U.C. DAVIS L. REV. 855, 858–59 (2007); Universal Declaration of Human Rights, G.A. Res. 217A (III), art. 27, U.N. GAOR, 3d Sess., U.N. Doc. A/810 (Dec. 10, 1948).

²⁶ See *List of New gLTDS*, *supra* note 1; *New gTLD Application By American Bible Society*, NEWTLDS.COM, <http://www.newtlds.com/applications/BIBLE> (last visited May 24, 2013).

²⁷ *Who We Are*, AMERICAN BIBLE SOCIETY, <http://www.americanbible.org/about/legal/disclaimer> (last visited May 24, 2013) (listing their mission statement as "mak[ing] the Bible available to every person in a language and format each can understand and afford, so all people may experience its life-changing message"). However, contrary to its all-inclusive mission statement, American Bible Society spokesperson Geoffrey Morin has publicly stated that, with regard to potential control of the <.bible> TLD, the American Bible Society would only share the <.bible> domain "with individuals and groups who, regardless of faith, have a healthy respect for the Bible." Heneghan, *supra* note 2.

²⁸ *Are You Christians?*, JEHOVAH'S WITNESSES, <http://www.jw.org/en/jehovahs-witnesses/faq/are-jehovahs-witnesses-christians/> (last visited May 24, 2013). Jehovah's Witnesses believe in the Bible and that they worship the one true religion. *Id.*; see also *Do You Believe That You Have the One True Religion*, JEHOVAH'S WITNESSES, <http://www.jw.org/en/jehovahs-witnesses/faq/true-religion/> (last visited May 24, 2013).

²⁹ *Articles of Faith*, THE CHURCH OF JESUS CHRIST OF LATTER-DAY SAINTS, <http://mormon.org/articles-of-faith> (last visited May 24, 2013). Mormons believe that the Bible, "as far as it is translated correctly," is a companion volume of scripture to the Book of Mormon. *Id.* Those of the Mormon faith likewise believe that they comprise "the only true and living church." See Dallin H. Oaks, *The Only True And Living Church*, THE CHURCH OF JESUS CHRIST OF LATTER-DAY SAINTS (last updated Feb. 21, 2012), <https://www.lds.org/youth/article/only-true-living-church?lang=eng>.

³⁰ YASSER GABR & HOUDA KARKOUR, ISLAM IN BRIEF: A SIMPLIFIED INTRODUCTION TO ISLAM 24 (2008). Muslims believe that "Allah revealed Books to his Prophets and Messengers," of which were the "Scripture of the Prophet Abraham" and the "Psalms given to the Prophet David and the Gospel, which was brought by the Prophet Jesus Christ." *Id.*

Internet when seeking to use the monopolized religious name in the genuine practice of their religion? Thus, for fear of exclusion, news of disputes among various religious groups shortly followed ICANN's announcement, whether or not these groups were actively vying for a particular TLD.³¹ When these restrictions on uses of religious names are tested, which they are certain to be, the floodgates may pour open with disputes before courts and arbiters that neither are equipped to resolve.

II. A PRESUMPTION MAY BUILD COGENCY WITHIN A PRESENT DAY "INTELLECTUALLY UNSATISFACTORY" FRAMEWORK

Prior to discussing the specifics of U.S. legal doctrine at present, it is helpful to first provide a context for how disputes as to religious names generally arise and enter the court system. The "prototypical" religious trade name dispute has been aptly described as follows:

The prototypical dispute occurs when a small group of parishioners breaks away from its mother church. In doing so, they hope to use part of their mother church's name in the name of their new church. Out of a legitimate concern of confusion, or perhaps out of spite, the members of the mother church attempt to enjoin the breakaway church from using its name.³²

In such cases, courts are faced with a difficult and delicate task. A trade name is of course, like all intellectual property, a property right, and a property right includes the right to exclude others.³³ Disputes regarding church property are often problematic, not only for courts that are faced with resolution of same, but also for church parishioners who do not want the government intermeddling in autonomous church dealings and, perhaps, excluding them from use of something which has been determined to be "church property."³⁴ Thus, when faced with these decisions, there is an intricate interplay of divergent considerations between (A) recognition of intellectual property rights and (B) protection of constitutional freedoms of speech and religion under the First Amendment of the U.S Constitution.³⁵ These two bodies of legal doctrine are discussed in the following subsections.

A. There Should Be a Presumption Because Most Religious Names Are Generic

The inadequacy of the current U.S. legal framework is especially apparent in determining whether religious organizations have intellectual property rights in

³¹ Heneghan, *supra* note 2 (using an example of several Protestant churches opposing the Vatican's application for the exclusive use of <.catholic> because those churches use the term to mean "universal").

³² Silversmith & Guggenheim, *supra* note 16, at 469, 504.

³³ Nat'l Bd. of YWCA v. YWCA of Charleston, 335 F. Supp. 615, 625 (D.S.C. 1971).

³⁴ See Kent Greenawalt, *Hands Off! Civil Court Involvement in Conflicts Over Religious Property*, 98 COLUM. L. REV. 1843, 1843 (1998).

³⁵ Silversmith & Guggenheim, *supra* note 16, at 468.

their names. Because of the issues presented by the First Amendment, the legal framework crafted by the U.S. Supreme Court is one of “judicial restraint” in resolving disputes as to church property generally.³⁶ Under Supreme Court precedent, if no clear decision by the polity is apparent, courts must apply neutral principles of intellectual property law.³⁷

Underlying the objective to further robust competition is the *ultimate* goal of trademark law—to protect “brands” that serve as source identifiers.³⁸ For consumers, being assured that a product or service comes from a particular source and has the qualities that consumers desire reduces consumer search costs and provides assurance of authenticity, whether because a consumer has used the product or service before, or because a brand from a particular source has a positive reputation within the marketplace.³⁹

1. *Neutral Principles of Genericism*

Generic marks “refe[r] to the genus of which the particular product is a species.”⁴⁰ In applying neutral principles of trademark law to church names, “most religious organizations’ names consist of generic words with the confusion stemming from similarly-named organizations.”⁴¹ Genericism exists if the “church name contain[s] words that are common words merely describing a set of beliefs” and do not provide an indication of source.⁴² As a general matter, generic words and phrases receive no trademark protection, as they would not further the underlying goals of trademark law, which is to facilitate healthy competition and to assist consumers in identifying particular brands.⁴³

Notwithstanding, it is possible that, “[e]ven if the words [within a] name are individually generic, the composite name may not be generic if it indicates a source producer, such as the sect behind a generic church name.”⁴⁴ Under trademark law,

³⁶ *Id.* at 470; Greenawalt, *supra* note 34, at 1844.

³⁷ Greenawalt, *supra* note 34, at 1881; *see also* Sirico, Jr., *supra* note 15, at 335 (“The free exercise clause requires a court to resolve the matter without ruling on any religious controversy that lies at the heart of the dispute.”); Greenawalt, *supra* note 34, at 1844. Intra-church disputes present two alternative approaches to the courts—one of “polity-deference” or of “neutral principles.” Greenawalt, *supra* note 34, at 1844. As the names connote, courts must choose between (i) deferring to the decision of the group or church as determined according to its own procedure for decision-making or (ii) applying neutral and secular principles of law. *Id.*

³⁸ David A. Simon, *Register Trademarks and Keep the Faith: Trademarks, Religion and Identity*, 49 IDEA 233, 235 (2009) (“Indeed, the goal of trademark law is to provide legal protection for names and symbols that represent a source.”).

³⁹ *See* Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 UCLA L. REV. 621, 623 (2004).

⁴⁰ *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (2002) (citing *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 194 (1985)).

⁴¹ *Silversmith & Guggenheim*, *supra* note 16, at 469.

⁴² *Id.* at 511.

⁴³ *Canal Co. v. Clark*, 80 U.S. (13 Wall.) 311, 323 (1871).

⁴⁴ *Silversmith & Guggenheim*, *supra* note 16, at 505.

this concept is commonly referred to as “secondary meaning.”⁴⁵ A generic religious name or phrase may acquire secondary meaning if “the primary significance of the [generic] term in the minds of the consuming public is not the product[s] name] but the producer.”⁴⁶ Thus, in the context of religious names, the primary significance of the term in the minds of the public must be a particular religious unit or organization and not the belief system itself in order to acquire secondary meaning.⁴⁷ In making this determination, it is the minds of the “relevant public” that matter.⁴⁸ Whether the “relevant public” is the broad general public, a less broad “purchasing public,” or another even narrower segment of the public at large is a question for each court to determine on a case-by-case basis.⁴⁹

It is conceivable that, within this intellectual property framework, “a church name over time can take on the connotation of a specific sect affiliation” that is the sole producer of a certain belief system.⁵⁰ However, I postulate that, if secular trademark principles are properly applied as they ordinarily would be in a non-religious commercial context, it will be infrequent that a religious word or phrase sought to be used by others will primarily signify a single source. Based upon this notion, the imposition of a *per se* rule establishing a presumption in favor of genericism will merely mirror the realities of the context in which these religious names are actually used such that attempts to seek monopolies of generic religious names through courts will be appropriately diminished.

2. Religious Organizations as an Indicator of Source

A local, regional or worldwide public association with a single source institution is rarely the case in the religious context. Indeed, it is not the conscious and natural objective of promoters of religious belief systems to claim to be the source at all. Religions spread across continents and, at a doctrinal level, do not derive from an Earthly source. Often the parties freely admit that a heavenly message (i.e. the “product or service” in trademark jargon) derives from a *divine* source, and is purposefully disseminated through various affiliated and unaffiliated institutions and organizations. Thus, how can the name of a religious belief come from one mortal individual or entity that is capable of having scribed one’s name on a trademark registration with the United States Patent and Trademark Office (“PTO”)? If a religious name is recognized as a trademark, and a trademark is a property right, then this property must have a specific owner. In the cases of secondary meaning, this singular owner must likewise be the solitary supplier of a

⁴⁵ *Id.*; *Two Pesos*, 505 U.S. at 769 (indicating that secondary meaning is also known as “acquired distinctiveness.”).

⁴⁶ *Jews for Jesus v. Brodsky*, 993 F. Supp. 282, 298 (D.N.J. 1998).

⁴⁷ *Id.*

⁴⁸ 15 U.S.C. § 1064(3) (2012).

⁴⁹ James Lockhart, *When Does Product Become Generic Term So As To Warrant Cancellation of Registration of Mark*, Pursuant to § 14 of Lanham Act (15 U.S.C.A. § 1064), 156 A.L.R. FED. 131,

*8(a)–8(b) (1999).

⁵⁰ *Silversmith & Guggenheim*, *supra* note 16, at 505.

religious “brand” sufficient to monopolize what would ordinarily be a common generic name.

Many churches admit and make clear that the “relevant public” for their religious message is *everyone* in the world. For example, the Southern Baptist Convention’s explicit mission statement is, “[a]s a convention of churches . . . to present the Gospel of Jesus Christ to every person in the world and to make disciples of all the nations.”⁵¹ Therefore, when courts determine the primary significance of a church name or phrase to the relevant consuming public, this “poses a question of fact in each case, and the trier of fact has the formidable task of ascertaining on the evidence submitted the meaning of the word among an indeterminable number of persons, perhaps millions.”⁵² The Southern Baptist Convention’s mission statement suggests that the number of members of the relevant public will most often be in the millions, if not billions.⁵³ As a result, neutral principles of genericness and secondary meaning are difficult, if not impossible, for courts to properly apply to religious names used throughout the world.⁵⁴ Adoption of a *per se* presumption that religious names are generic and do not acquire secondary meaning without “clear and convincing” evidence that the primary significance to the relevant public is that of a certain source producer will bring religious trade names back within the intent and underlying objectives of trademark law as a legal doctrine. This will also prevent generic names of belief systems or of a certain individual believer from monopolization by one incorporated or unincorporated association.

3. *There Is Already a Movement in the Courts Toward Generic Per Se*

Should we provide one person or artificial entity a trademark in the name of a religious faith and remove it from the public domain? Many courts have already answered this question in the negative, finding that religious names are *per se* generic.⁵⁵ The New York Court of Appeals in *The New Thought Church v. Chapin* stated that religious names simply convey to the relevant public:

[F]irst, the system of religion which it teaches, and, *second*, that it teaches that system through the medium of organizations known as churches. It surely is not in a position to successfully claim a monopoly of teaching this

⁵¹ *Mission & Vision*, S. BAPTIST CONVENTION, <http://www.sbc.net/missionvision.asp> (last visited May 24, 2013).

⁵² 1 JEROME GILSON, TRADEMARK PROTECTION AND PRACTICE § 2.02[7] (2012).

⁵³ *Mission & Vision*, *supra* note 51 (seeking to “present the Gospel of Jesus Christ to every person in the world”).

⁵⁴ Silversmith & Guggenheim, *supra* note 16, at 511.

⁵⁵ See, e.g., *Christian Sci. Bd. of Dirs. of First Church of Christ, Scientist v. Evans*, 520 A.2d 1347, 1352 (N.J. 1987) (“Plaintiffs simply cannot appropriate, from the public domain, the common name of a religion and somehow gain an exclusive right to its use and the right to prevent others from using it.”); *The New Thought Church v. Chapin*, 144 N.Y.S. 1026, 1027–28 (N.Y. App. Div. 1913).

form of religious faith by means of organizations known by the generic names of churches.⁵⁶

Courts have determined that this is true even if there is a point in time when only one institution is using a particular religious name and may claim to be a single source.⁵⁷

4. Have Other Courts Been Analytically Honest and True to the Justifications for Trademark Protections?

At times, courts find that trademark rights exist in a religious name.⁵⁸ According to the legal framework discussed above, such a finding legally concludes that the plaintiff established that the religious name at issue is associated by the “relevant public” with the *plaintiff* as a single source of a particular religious belief system.⁵⁹ By means of example, one such case is the *General Conference Corp. of Seventh-Day Adventists v. McGill*, where at issue was a break-away church’s use of “Seventh-day Adventist” in its church name.⁶⁰ The General Conference had registered SEVENTH-DAY ADVENTIST and ADVENTIST with the PTO.⁶¹ McGill, originally a member of a Seventh Day Adventist church affiliated with the General Conference, decided to separate from the church because of a theological dispute.⁶² Because McGill believed he was “divinely required” to use the name “Seventh Day

⁵⁶ See *The New Thought Church*, 144 N.Y.S. at 1028; see also Silversmith & Guggenheim, *supra* note 16, at 514 (“The plaintiffs have no right to a monopoly of the name of a religion. The defendants, who purport to be members of the same religion, have an equal right to use the name of the religion in connection with their own meetings, lectures, classes and other activities.”); *Christian Science Bd. of Dirs.*, 520 A.2d at 1352 (“Plaintiffs simply cannot appropriate, from the public domain, the common name of a religion and somehow gain an exclusive right to its use and the right to prevent others from using it.”).

⁵⁷ See, e.g., *Christian Science Bd. of Dirs.*, 520 A.2d at 1352–53.

[T]he absence of other groups using the name of a religion in the names of their churches does not render the right to use of the name the exclusive property of [the mother church]. Exclusive use “cannot take the *common descriptive* [*i.e.*, generic] name of an article out of the public domain and give the temporarily exclusive user of it exclusive rights to it, no matter how much money or effort it pours into promoting the sale of the merchandise.”

Id. at 1353 (quoting *J. Kohnstram Ltd. v. Louis Marx & Co.*, 280 F.2d 437, 440 (C.C.P.A. 1960)).

⁵⁸ See, e.g., *Gen. Conf. Corp. of Seventh-Day Adventists v. McGill*, 617 F.3d 402, 405 (6th Cir. 2010) (recognizing registration of the “Seventh-day Adventist” mark); *Jews for Jesus v. Brodsky*, 993 F. Supp. 282, 313 (D.N.J. 1998) (issuing an injunction against defendant and finding trademark rights existed in “Jews for Jesus” and found against a critic of Jews for Jesus seeking registration of “<jewsforjesus.org>” and “<jews-for-jesus.com>”); *Purcell v. Summers*, 145 F.2d 979, 983–84 (4th Cir. 1944) (holding that “Methodist Episcopal Church” had exclusive rights to use the name).

⁵⁹ See *supra* notes 47–49 and accompanying text.

⁶⁰ *Gen. Conf. Corp. of Seventh-Day Adventists v. McGill*, 617 F.3d 402, 404 (6th Cir. 2010).

⁶¹ *Id.* at 405.

⁶² *Id.*

Adventist” in his new church’s name, he did so, naming his church “A Creation Seventh Day & Adventist Church.”⁶³ McGill also purchased Internet domain names for, among others, <7th-day-adventist.org>, <creation-7th-dayadventist-church.org>, and <creationseventhday-adventistchurch.org>.⁶⁴ The U.S. Court of Appeals for the Sixth Circuit held against McGill, finding that the General Conference has trademark rights in the name “Seventh-day Adventist” and that McGill’s use was infringing.⁶⁵ Thus, based upon court precedent in *McGill*, the General Conference has national, court-approved, exclusive trademark rights to the name “Seventh-day Adventist” or any name which is confusingly similar, including one used in a domain name.⁶⁶

Hence, the Sixth Circuit’s opinion in *McGill* begs some questions. Did the Sixth Circuit properly apply neutral principles of trademark law in *McGill*? Did the court further any of the theoretical objectives of trademark law in finding for the General Conference? Customer surveys are often used in trademark cases to gauge whether a proffered trademark has acquired secondary meaning.⁶⁷ If one hundred members of the “relevant public” were questioned as to the primary significance of the term “Seventh-day Adventist,” how many would state that it identified the name of a particular “brand” of the Protestant religion produced by the General Conference? Without commissioning a survey, it seems unlikely that the majority of those questioned would state that it was the name of the particular religion itself. In fact, even if one hundred members of the Seventh-day Adventist church were asked as to the name of their religion, what would they call it? It seems likely that the majority would say “Seventh-day Adventist” and that they were “Seventh-day Adventists.”

The type of monopoly provided to the General Conference in *McGill* seems to be just the type that black-letter trademark law tries to prohibit.⁶⁸ If a theoretical justification of trademark law is to foster competition, how is anyone supposed to compete with the General Conference to provide an alternative to its “brand” of the Protestant religion? If McGill cannot use the words “Seventh-day Adventist” in the name of his new church, then what is he supposed to call it so that people will readily identify the particular belief system he believes in and which he is seeking to promote to others? McGill’s doctrinal dispute with the General Conference should not require him to create an entirely new name for his religious beliefs.

Moreover, if a “Seventh-day Adventist” is seeking a new congregation, perhaps one that promotes McGill’s religious interpretation, does the Sixth Circuit’s decision in *McGill* further the primary objective of trademark law to provide consumers with a clear indication of source and reduce consumer search costs? If McGill cannot use the name “Seventh-day Adventist” in the name of his new church, then it seems that it will be difficult for those looking for a like-minded church to find the type of “product” they are seeking. In the context of domain names and Internet search engines, if not “Seventh-day Adventist,” then what is a potential member of the

⁶³ *Id.*

⁶⁴ *Id.* at 405–06.

⁶⁵ *Id.* at 416.

⁶⁶ *Id.*

⁶⁷ See *Amazing Spaces, Inc. v. Metro Mini Storage*, 608 F.3d 225, 249 (5th Cir. 2010).

⁶⁸ See 15 U.S.C. § 1064(3) (2012).

congregation supposed to type into his or her browser? This deprivation of use rights seems especially onerous in a modern age of Internet search optimization.

McGill and others similarly situated could certainly choose another name. However, a “personality” approach to intellectual property theorizes that they should not have to. The personality theory of property puts forward that property should be owned by those who most personally identify with it.⁶⁹ This principle particularly embodies the underlying justifications for copyright law and patent law by protecting authors and inventors who personally identify with the fruits of their ideas and of their labor as extensions of themselves on an emotional and intimate level. In the context of religious names, certainly these are deeply personal to righteous believers. Undoubtedly, McGill’s fervent self-identification as a “Seventh-day Adventist” fueled his pursuit of an ability to call himself one. Thus, perhaps there is a personality approach within the underpinnings of a constitutional right to freedom of religion itself, and such an approach toward ownership of religious names supports a presumption in favor of societal ownership by a collective of individual believers.

5. Will a Presumption Discriminate Against Religious Entities in Pursuit of Commercial Endeavors Which Need Trademarks to Build Revenues?

It is proffered that a *per se* presumption against trademark protection will reduce the frequency of cases involving religious names as trademarks and lessen the number of cases where freedoms of religion and speech hang in the balance. In the event that such a presumption is codified, undoubtedly many will criticize the limitation as infringing upon the rights of religious organizations to acquire and benefit from trademark rights as a commercial business necessity. Of course, non-profit ventures unrelated to religious aims may acquire intellectual property rights. However, I submit that churches and other religious organizations will not receive disparate treatment from secular non-profits and will merely be playing by the same rules as any other enterprise, whether not-for-profit or commercial.

In the corporate world, marketing departments are on constant guard of selecting generic or descriptive names for products and services in fear that such names will not be protectable vis-à-vis competitors or will not be able to garner a registration through the PTO. As discussed above, an intellectually evenhanded analysis of these religious names would not meet the requisite level for trademark protection in most cases.⁷⁰ If, indeed, a religious word does meet the threshold through clear and convincing evidence that the primary significance of the word mark is that of a source producer, then churches certainly may possess trademark rights just as any other commercial actor. However, only then will the providing of a monopoly on a particular religious word or phrase fulfill the theoretical objectives of trademark law on a fundamental level.

⁶⁹ See Margaret Jane Radin, *Property and Personhood*, 34 STAN. L. REV. 957, 982 (1982).

⁷⁰ See, e.g., *The New Thought Church v. Chapin*, 159 A.D. 723, 725 (1913) (finding the name “The New Thought Church” to be generic and indistinct).

B. There Should Be a Presumption Because Monopolization Violates Constitutional Freedoms

In reviewing U.S. jurisprudence in the area as a whole, it seems difficult to discern a clear body of black-letter law that is consistently applied by U.S. courts in disputes regarding religious names as trademarks.⁷¹ Simply put, courts inconsistently analyze and decide these cases, and such is not purely the product of jurists' imprudence.⁷² Perhaps, instead of consciously abandoning underlying justifications and black-letter law of trademarks altogether, it is more likely that constitutional constraints and the limited availability of analytical frameworks cause courts to reach certain ownership determinations in cases of religious names and the volatility of the resulting body of case law is the result of a complex interplay of constitutional and property interests.⁷³ Indeed, a "senior" organization taking priority over a name as a trademark impedes another's future religious freedoms. Moreover, these cases often involve the parties' request that the court determine which among them is the "true faith," which courts cannot constitutionally adjudicate.⁷⁴

Specifically, with respect to trademark rights, when a court grants to one party a monopoly on the name of a church or a phrase associated with one religion or another, it simultaneously orders that others desist from using the name or phrase.⁷⁵ Because the trade name may be a "religious touchstone for another individual," this acknowledgement of property protection may impede the ability of individuals to freely exercise religion without government interference.⁷⁶ Thus, a court decision as to ownership and infringement of a trade name may run afoul of the Free Exercise Clause of the First Amendment. At the same time, the Establishment Clause of the First Amendment may be at odds with such a court determination since this government action may establish the prevailing party's religion ahead of another

⁷¹ See Sirico, Jr., *supra* note 15, at 335–37. Professor Sirico explains that:

In 1979, the Supreme Court made clear that courts have at their disposal more than one method for resolving [church property dispute] cases. Since then, supreme courts and appellate courts in at least twenty-five states have published opinions in which they either have reaffirmed their traditional methods for resolving church property disputes or have adopted new methods. Most courts have failed to give a detailed justification for choosing one approach over another. I believe that this failure has occurred because the available methods are intellectually unsatisfactory. Each test requires assuming that a church fits an organizational stereotype that may or may not be accurate.

Id. at 335–37.

⁷² Compare *The New Thought Church*, 159 A.D. at 724–25 (holding the name "The New Thought Church" to be generic and incapable of trademark protection), with *McGill*, 617 F.3d at 416 (holding that "Seventh Day Adventist" was not generic and was capable of trademark protection).

⁷³ See Sirico, Jr., *supra* note 15, at 337.

⁷⁴ *Silversmith & Guggenheim*, *supra* note 16, at 475–76; *Watson v. Jones*, 80 U.S. (13 Wall.) 679, 707–08 (1871).

⁷⁵ See, e.g., *McGill*, 617 F.3d at 407.

⁷⁶ *Silversmith & Guggenheim*, *supra* note 16, at 468.

practitioner seeking to worship the religion in his or her own way.⁷⁷ Lastly, providing an intellectual property monopoly to one religious institution for exclusive use may unconstitutionally restrict another's ability to utilize the name or phrase, not to worship, but to speak out *against* certain religious tenets or policies, in violation of a U.S. citizen's inalienable right to freedom of speech.

1. Neither of the Tests Available to Courts Are Sufficient

Notwithstanding the theoretical objectives of the “polity-deference” or “neutral principles” approaches—the two alternative tests available at present—often neither is viable in practice. In terms of deference to church decision-making authority, what if the parties disagree as to who or what the decision-making body is? Moreover, what if church tenets connote that the ultimate decider is God, Allah, Adonai or Buddah, and that all direction comes above? Reality suggests that not all churches have a clear hierarchy like the Catholic Church with an edict promulgated from God via the Vatican. A court determination, even as to the mere *existence* of a hierarchy, may run afoul of the First Amendment in itself.⁷⁸ In addition, some churches like the Baptist Church have a congregational polity based upon democratic principles employed among church members.⁷⁹ This makes it almost impossible for courts to pinpoint a “church decision” on the matter, much less defer to it, because it is likely that the parties' positions will be at odds if they are in litigation against one another in the first place and have been unable to resolve the matter out of court. The parties may not even agree on the mere identity of the “true church” on a fundamental level if one sect has broken off from another.⁸⁰

Further, the alternative approach of “neutral principles” likewise presents difficult questions for courts as to how these neutral and secular principles of law should be applied within a church setting where church members may not think or act as they reasonably would in a commercial one.⁸¹ General principles of commercial law may be inapplicable and incongruent due to parties' reasonable expectations or prior normal courses of dealing as church members.⁸² Indeed, what may be reasonable in a commercial context may be unreasonable under the specter of religious doctrine, and vice versa.

2. Are Courts Reluctant to Shift the Status Quo?

At first blush, it may seem as if courts are simply averse to adjudicate these types of cases at all, at least by means of rendering a decision that changes the parties' positions. Hugh C. Hansen, Director of the Intellectual Property Law

⁷⁷ See *id.* at 471–72.

⁷⁸ Greenawalt, *supra* note 34, at 1877–82.

⁷⁹ *Id.* at 1864 (“Under the polity approach, if a church organization is congregational, courts assume that it governs itself like an ordinary voluntary association.”).

⁸⁰ *Id.* at 1843–44.

⁸¹ See, e.g., Sirico, Jr., *supra* note 15, at 356.

⁸² See, e.g., Greenawalt, *supra* note 34, at 1885–86.

Institute and Professor of Law at Fordham University School of Law, has suggested that court decisions regarding disputes over church names can be largely reconciled simply by recognizing that courts desire to maintain the status quo in these cases in an effort to avoid involvement in doctrinal disputes.⁸³ Professor Hansen opines that, in order to maintain matters as they existed prior to commencement of the action, so that the court cannot be accused of taking government action that changed the parties' positions, courts usually decide against the plaintiff, whether the plaintiff is the senior user (i.e. the "mother" church) or the junior user (i.e. the "break-away" church).⁸⁴ Therefore, in the case of break-away members from a parent church, if the parent files suit seeking to stop the break-away members from using a name, the court finds that the church name is generic and the break-away members prevail. Alternatively, if the break-away members seek a declaratory judgment from a court to affirm its lawful use of the church name, the court finds that the name is *not* generic, the declaratory judgment is denied, and the parent church prevails.

Perhaps, like *McGill*, not all cases fit perfectly into Professor Hansen's proffered rubric. Nonetheless, it seems to be a reasonable and pragmatic approach for courts to employ given the constitutional dangers and impracticalities implicit in the "polity-deference" and "neutral principles" alternatives. At present, courts are placed in an untenable position. Neither of the alternatives permitted by the Supreme Court are satisfactory in the context of religious trade names, and a *per se* presumption will focus courts to a narrow issue in applying neutral principles of whether a religious name or phrase has acquired the requisite secondary meaning when the traditional test is objectively applied.⁸⁵

3. *The Law Should Err in Favor of Individual Religious Autonomy*

Despite the constitutional difficulties in deciding these cases, courts must nevertheless render a decision one way or another when these disputes come to bar. Courts do not possess an ostrich-like luxury to bury its proverbial head in the sand. A decision either way can be argued as having the effect of infringing upon freedom of religion, and simultaneously, as upholding religious freedoms. It is with this reality in mind that the proposed presumption against protection of religious names is tendered. Why choose constitutional freedoms of individuals to practice free religion over other constitutional and commercial considerations in tension with same, such as a religious organization's constitutional ability to engage in commerce and acquire property through trademarks? I submit that preservation of religious protections for the less-authoritative minority should take precedent.

Break-away churches are often smaller, less powerful and less established than the mother church. A presumed exception would protect the interests of disadvantaged minority groups who will not have established priority rights in a particular religious name, but yet have a genuine constitutional interest in its use.

⁸³ Professor Hugh C. Hansen, Oral Lecture at Fordham Law School (Oct. 17, 2012) (cited with speaker's written permission).

⁸⁴ *Id.*

⁸⁵ Greenawalt, *supra* note 34, at 1905–06; Sirico Jr., *supra* note 15, at 337.

Conversely, without a presumed exception, a mother church with senior use would be able to eliminate competing voices of minority groups within a particular religious sect. This type of discrimination is enabled by a trademark monopoly.

In fact, § 110 of the U.S. Copyright Act already includes an exception whereby a “performance of a nondramatic literary or musical work or of a dramatico-musical work of a religious nature, or display of a work, in the course of services at a place of worship or other religious assembly” does not receive copyright protection.⁸⁶ Excepting religious services from copyright law preserves a right to worship. A similar exception in trademark law for religious words and phrases will further a similar objective toward religious freedom.

Furthermore, the United States, unlike other countries, recognizes *any* genuine religion as legitimate, even if it only has one practitioner. Indeed, “religious beliefs need not be acceptable, logical, consistent, or comprehensible to others in order to merit First Amendment protection.”⁸⁷ With this in mind, courts have often prioritized freedom of religion over business necessity to ensure reasonable accommodation of religious freedoms, even above significant bona fide commercial interests.⁸⁸ In fact, I premise that such a priority is necessary to sustain religious freedoms at all. Otherwise, a powerful commercial world may soon swallow individual religious voices whole.

III. ALTERNATIVE AVENUES FOR DISPUTE RESOLUTION OUTSIDE OF U.S. COURTS AND THE AFOREMENTIONED FRAMEWORK

As discussed above, disputes as to alleged trademarks within domain names may be brought in court subject to the aforementioned imperfect judicial framework. Alternatively, the party with the power of forum selection may elect, instead, to bring a claim through the UDRP.⁸⁹ Importantly, the UDRP has a different legal standard to be applied to allegations of trademark infringement within domain names,⁹⁰ and because of this, it is ill-equipped to resolve disputes involving bona fide uses of religious names within URLs.

Upon purchasing a domain name from an ICANN-accredited registry, the purchaser is required to consent to dispute resolution through the UDRP.⁹¹ In terms of the overall process, the UDRP is similar to that of the American Arbitration

⁸⁶ 17 U.S.C. § 110(3) (2012).

⁸⁷ *Thomas v. Review Bd. of Ind. Emp't Sec. Div.*, 450 U.S. 707, 714 (1981).

⁸⁸ *See, e.g., Trans World Airlines, Inc. v. Hardison*, 432 U.S. 63, 76 (1977).

⁸⁹ *See WIPO Guide to the Uniform Domain Name Dispute Resolution Policy (UDRP)*, WORLD INTEL. PROP. ORG., <http://www.wipo.int/amc/en/domains/guide/#a2> (last visited May 24, 2013).

⁹⁰ *Id.*

⁹¹ *How Does the UDRP Work?*, Response to *Frequently Asked Questions: Internet Domain Names*, WORLD INTEL. PROP. ORG., <http://www.wipo.int/amc/en/center/faq/domains.html#8> (last visited May 24, 2013). As a condition to becoming accredited as a registry by ICANN, ICANN mandates that each registry contractually agree to impose UDRP provisions within each of its individual contracts with URL purchasers. *ICANN Registrar Accreditation Agreement*, § 3.8, ICANN, <http://www.icann.org/en/resources/registrars/raa/ra-agreement-21may09-en.htm> (last visited May 24, 2013). Thus, as a practical matter, every URL occupant has consented to UDRP jurisdiction and resolution of domain name disputes through the UDRP.

Association, and many other popular avenues for alternative dispute resolution.⁹² However, WIPO's UDRP activities are isolated *only* to resolution of domain name disputes.⁹³ The UDRP has its own set of rules distinct from national trademark laws, including specific frameworks to determine whether a complainant is entitled to relief. Specifically, paragraph 4(a) of the UDRP Rules (the "Rules") requires that the complainant prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred: (1) the domain name registered by the respondent is identical or confusingly similar to a trademark or service mark in which the complainant has rights; (2) the respondent has no rights or legitimate interest in respect of the domain name; and (3) the domain name has been registered and is being used in bad faith.⁹⁴ Apparent in this UDRP legal standard, the UDRP is intended to resolve instances of clear cybersquatting, rather than bona fide uses of another's alleged trademark.⁹⁵ Thus, in comparison to U.S. common law jurisprudence, the UDRP framework is much more lenient to the respondent than for a defendant in a court lawsuit under U.S. trademark infringement standards. As a consequence, the UDRP is unsuited for resolution of trademark infringement disputes when a subsequent user of a mark either (i) has a legitimate interest in doing so or (ii) is using another's asserted mark within a domain name in good faith.⁹⁶ In short, under the UDRP, proof of mere "likelihood of confusion" is not

⁹² Compare source cited *supra* note 89 (providing that the UDRP's five basic stages are the filing of the complaint, the filing of the response, the appointment of a dispute resolution service provider, the issuance of a decision, and the implementation of that decision), *with Arbitration*, AM. ARB. ASS'N, http://www.adr.org/aaa/faces/services/disputeresolutionservices/arbitration?_afLoop=471206020521674&_afWindowMode=0&_afWindowId=1a3odniana_6#%40%3F_afWindowId%3D1a3odniana_6%26_afLoop%3D471206020521674%26_afWindowMode%3D0%26_adf.ctrl-state%3D1a3odniana_18 (last visited May 24, 2013) (listing that the American Arbitration Association's stages for arbitration are filing and initiation, arbitrator selection, preliminary hearing, information exchange and preparation, hearings, post-hearing submissions, and the award).

⁹³ *What is the UDRP?* Response to *Frequently Asked Questions: Internet Domain Names*, WORLD INTELL. PROP. ORG., <http://www.wipo.int/amc/en/center/faq/domains.html#16> (last visited May 24, 2013) (indicating that the UDRP focuses only on conflicts between trademarks and domain names).

⁹⁴ *Uniform Domain Name Dispute Resolution Policy*, ¶ 4(a), ICANN (Aug. 26, 1999), <http://www.icann.org/en/help/dndr/udrp/policy>; see also *The Coca Cola Company v. The Holy See*, Nat'l Arb. F., Claim No. FA0304000155454 (July 3, 2003) (Samuels, Arb.).

⁹⁵ Nicholas Smith & Erik Wilbers, *The UDRP: Design Elements of an Effective ADR Mechanism*, 15 AM. REV. INT'L ARB. 215, 221 (2004).

⁹⁶ See *What Types of Disputes Are Covered by the UDRP Administrative Procedure?*, FAQ for *WIPO Guide to the Uniform Domain Name Dispute Resolution Policy (UDRP)*, WORLD INTELL. PROP. ORG., <http://www.wipo.int/amc/en/domains/guide/index.html#a3> (last visited May 24, 2013). The UDRP is only available for disputes that meet the following criteria:

- (i) the domain name registered by the domain name registrant is identical or confusingly similar to a trademark or service mark in which the complainant (the person or entity bringing the complaint) has rights; and
- (ii) the domain name registrant has no rights or legitimate interests in respect of the domain name in question; and
- (iii) the domain name has been registered and is being used in bad faith.

enough for a claimant to prevail.⁹⁷ Thus, claimants asserting trademark rights in religious names used within URLs would be remiss to bring claims against good faith users within the UDRP.

As a result, although UDRP claims must be resolved by the UDRP arbitration panel within fourteen days of their appointment, and thus, is often the most cost and time efficient means of resolving domain name disputes, this abbreviated type of proceeding will not be available for *McGill*-type cases. Because alleged infringers will have sought and obtained a domain name based upon a bona fide religious basis to do so, disputes as to these religious names in the new TLDs will be incapable of resolution within the UDRP dispute resolution process. Instead, these disputes will be timely and more costly, and will require resolution within courts. Courts may then be confronted with a flooded caseload of disputes over an expanded set of religious domain names, and they must resolve these cases within the existing methodology. Not only may courts struggle to do justice within this inadequate framework, in the event that it finds that trademark rights exist through a conjectural analysis of neutral principles, it may likely trample upon constitutional rights in the process and, in doing so, remove descriptors of common religious belief systems from the public domain.

This is not all. In restricting all *but one's* use of a particular religious name or phrase, courts will simultaneously be thwarting the objectives of TLD name expansion altogether for religious organizations. It seems to be incredibly inefficient to force TLD owners and registries to leave infinite “placeholders” for one particular intellectual property right-holder, or else, face imminent suit. Thus, I submit that the current religious trademark monopoly defies common sense moving forward in a modern world of infinite TLDs. Therefore, a presumption within the U.S. court system may serve to alleviate problems presented by TLD expansion in the current status quo when courts, not the UDRP, are faced with resolution of these disputes.

IV. PROPOSED SOLUTION: A PRESUMPTION THAT RELIGIOUS WORDS ARE GENERIC AND NOT PROTECTED BY TRADEMARK

The law creates presumptions in the interest of societal good in order to produce a probability of outcomes that promotes fairness and sound public policy.⁹⁸ For example, within U.S. trademark law, there currently exists a presumption against trademark protection of surnames.⁹⁹ If a proposed trademark is “primarily merely a surname,” then it is not capable of obtaining trademark rights unless a petitioner can present evidence of long and exclusive use that changes its significance to the public from that of a surname of an individual to that of a mark for a particular source

Id.

⁹⁷ *Id.*

⁹⁸ Fed. R. Evid. 301 advisory committee's note (“The same considerations of fairness, policy, and probability which dictate the allocation of the burden of the various elements of a case as between the prima facie case of a plaintiff and affirmative defenses also underlie the creation of presumptions.”).

⁹⁹ See 15 U.S.C. § 1052(e)(4) (2012).

goods or services (i.e. secondary meaning).¹⁰⁰ Public policy behind such a presumed exception keeps surnames available for people who wish to use their own surnames in their businesses, and not allow one person coming before them to monopolize another's own name.¹⁰¹ Such an exception is presumed so long as the consuming public will not be confused due to a secondary meaning acquired by the name.¹⁰² The presumption against trademark protection of religious names, as proposed in this Article, follows this same model.

A. Proposed Procedural Rules

To be clear, this Article does not propose that the law absolutely prohibit the protection of religious names as trademarks. Under the proposed framework, it is possible for religious names to garner protection. However, like surnames, a higher threshold for protection is necessary.

The following procedural mechanics are proposed: Regardless of whether or not a PTO registration exists, a party asserting trademark rights in a word or phrase that is “primarily merely a religious name” will have the burden to prove through “clear and convincing evidence” that the name has acquired secondary meaning—that the primary significance of the religious name in the minds of the relevant consuming public is not merely a religion or a religious belief system, but is instead a particular religious unit or organization that is an indication of source.¹⁰³ Whether or not a particular word or phrase is “primarily merely a religious name” will depend upon the court’s evaluation of the word or phrase on a case-by-case basis, but should include consideration of the following two factors: (i) the frequency and geographic scope of use of the designation as the name of a religion or belief system; and (ii) the extent to which the designation has a recognized meaning as something other than the name of a religion or belief system. So as to avoid circumventing a trier of fact’s determination as to whether the designation has acquired secondary meaning, in determining whether the designation is “primarily merely religious name,” a court should construe the facts in the light most favorable to the party against whom the proponent is seeking to enforce trademark rights. With regard to the proponent’s burden of proof, “clear and convincing” evidence shall be found to exist when the proponent places in the mind of the ultimate fact finder that the proponent’s factual contentions are “highly probably true.”¹⁰⁴ A “clear and convincing” standard of proof

¹⁰⁰ See *Conagra, Inc. v. Singleton*, 743 F.2d 1508, 1513 (11th Cir. 1984).

¹⁰¹ *Nat’l Cigar Stands Co. v. Frishmuth Bro. & Co.*, 297 F. 348, 349 (D.C. Cir. 1924) (“A person may put his own name upon his own goods, notwithstanding another person of the same name may, in that name, manufacture and sell the same or similar articles.”) (quoting *Columbia Mill Co. v. Alcorn*, 150 U.S. 460, 466 (1883)).

¹⁰² *Id.* at 349–50.

¹⁰³ *Cf. Jews for Jesus v. Brodsky*, 993 F. Supp. 282, 298–99 (D.N.J. 1998). The standard suggested in this Article mirrors the standard promulgated in *Jews for Jesus. Id.*

¹⁰⁴ See *Har v. Boreiko*, 986 A.2d 1072, 1080 (Conn. App. Ct. 2010). One court described the “clear and convincing” standard as:

[A] degree of belief that lies between the belief that is required to find the truth or existence of the [fact in issue] in an ordinary civil action and the belief that is

is appropriate here, as the Supreme Court has previously applied the same standard in other cases which, like freedom of religion, involve important liberty interests.¹⁰⁵

B. The Proposal Will Comport with International Norms

Especially with regard to new TLD name extensions, it is important to keep in mind that these will have international reach on the Internet. If ICANN selects AGITSys, the private Turkish IT company that has submitted a bid for the <.islam> TLD, it will be able to control which Islamic voices are capable of being heard via the TLD. Perhaps this is why Saudi Arabia has opposed AGITSys' selection, as well as all other religious TLD issuances by ICANN.¹⁰⁶ Saudi Arabia, the birthplace of Islam, clearly has an interest in the preservation of its own religious heritage and sovereign autonomy. Others within the international community may also have similar important interests to safeguard against religious control.

In fact, to avoid trademark monopolization of religious designations, members of the international community have already determined that religious names and symbols should be treated differently with respect to trademarks. In Israel, "a mark identical with or similar to emblems of exclusively religious significance" is incapable of federal registration.¹⁰⁷ Moreover, in Hungary, "[a] sign shall be excluded from trade mark protection if . . . it consists exclusively of symbols having a close relation to religious or other beliefs."¹⁰⁸

CONCLUSION

Technology has previously compelled change within the law, and it will continue to do so. There was a time when the keystone of real property law was that land is protected by trespass law all the way down below and to an indefinite extent upward.¹⁰⁹ However, the expansion of technology, such as the invention and

required to find guilt in a criminal prosecution. . . . [The burden] is sustained if evidence induces in the mind of the trier a reasonable belief that the facts asserted are highly probably true, that the probability that they are true or exist is substantially greater than the probability that they are false or do not exist.

Id.

¹⁰⁵ See, e.g., *Addington v. Texas*, 441 U.S. 418, 433 (1979) (holding that due process under the Fourteenth Amendment requires the State to prove by clear and convincing evidence that a person should be involuntarily committed for an indefinite period of time to a State hospital); *Santosky v. Kramer*, 455 U.S. 745 (1982) (holding that due process under the Fourteenth Amendment requires that "the State support its allegations" by clear and convincing evidence before it "may sever completely and irrevocably the rights of parents in their natural child").

¹⁰⁶ See Heneghan, *supra* note 2.

¹⁰⁷ Trade Marks Ordinance (New Version), 5732-1972, 26 LSI 511, art. 11(7) (Isr), available in English at http://www.wipo.int/wipolex/en/text.jsp?file_id=128044.

¹⁰⁸ 1997. évi XI. törvény a védjegyek és a földrajzi árujelzők oltalmáról (Act XI of 1997 on the Protection of Trademarks and Geographical Indications, art. 3(2)(c)) (Hung.)

¹⁰⁹ See Sir William Blackstone, *Commentaries on the Laws of England (1765–1769)*, LONANG, <http://www.lonang.com/exlibris/blackstone/bla-202.htm> (last visited May 24, 2013).

widespread prevalence of airplanes, made it necessary to craft new law, as the “indefinite extent upward” concept defied common sense in contemporary times and would expose every airplane flight operator to “countless trespass suits.”¹¹⁰ Although admittedly not as technologically pioneering as aviation, the impact of ICANN’s release of new TLDs places the protection of religious trademarks at a precipice. Once a religious TLD is awarded, a generic religious name should not also be monopolized elsewhere in cyberspace or in the physical world.

We should rethink how we apply the law to cases involving religious trade names. A presumption against trademark protection may indeed reduce the number of religious trademark cases brought forward to courts, limiting those cases that *do* come to bar to those with convincing claims of secondary meaning. In addition to bolstering the integrity of a neutral principles trademark analysis, minimizing monopolies on generic religious names will correspondingly reaffirm a commitment to preservation of constitutional freedoms.

¹¹⁰ *United States v. Causby*, 328 U.S. 256, 260–61 (1946).

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EXAMINING THE OUTER-LIMITS OF TRADEMARK LAW IN THE RELIGIOUS CONTEXT AND A POTENTIAL IMPLICIT BIAS FOR NON-SECULAR LITIGANTS: ELLER V. INTELLECTUAL RESERVE, INC.

I. INTRODUCTION

What sorts of words, names, and symbols generally come to mind when you hear the word “trademark?” Coca-Cola, the Nike Swoosh, the iconic Mercedes-Benz three-point star and Mr. Peanut, just to name a few. How about the Star of David? The crucifix? The word “Catholic,” or an image of the Vatican? What about the Islamic Star and Crescent or a picture of the Buddha? Typically, these words and symbols are not the first to enter your mind when you think about trademarks. Despite any initial misgivings these devices are, in theory, eligible for trademark protection. As source identifiers, these images, symbols, and words may signify where they come from and who produces them: the religious organization with which they are affiliated.

Can religious organizations own valid trademarks in commonly used and recognized devices? At what point does the exclusive use of such terms by such religious organization pass the outer-limits of protection afforded to religious marks and become not protectable? Do the courts that are responsible for fairly applying the law as it stands to all litigants, evenhandedly apply trademark law to secular as well as non-secular parties? Or is there a more cautious attitude present within certain circuits in regards to the evidentiary burdens such circuits are willing to place on religious organizations in the trademark context?

Eller v. Intellectual Reserve raises these issues and provides a looking glass through which to analyze the outer-limits of trademark law as applied in a religious context. *Eller* pits a small business owner in his attempts to bring together people of the Mormon faith against the corporate entity responsible for the intellectual property holdings of the Church of Jesus Christ of Latter-day

Saints (hereinafter “Mormon Church”). *Eller* touches on important issues surrounding the role of trademark law as it relates to religious words and symbols. Additionally, *Eller* brings issues the outer-limits of trademark law in the religious symbol context to the forefront. This article uses *Eller* as a guide for analytic discussion of the boundaries and outer-limits of trademark law in the religious context; further, it will examine whether there is a tendency among certain courts to lessen evidentiary burdens for non-secular trademark litigants.

Section II of this article discusses the background in this realm of case law examining trademark in the religious context, beginning with the Lanham Act, the federal statute governing trademark law; it will then look at the qualifications a mark must meet to become federally registerable, including the issue of becoming certain types of trademarks becoming generic. Section III provides a brief discussion of the facts and procedural history of *Eller*. Section IV analyzes the future implications of cases such as *Eller* and the potential ramifications if the boundaries and outer-limits are pushed to these lengths. Section V concludes the article by summing up the outer-limits of trademark law as they stand today, and urge that public policy calls for a more conservative outer-limit of trademark law in this context and a more fair treatment for secular and non-secular litigants.

I. PROCEDURAL BACKGROUND

A mark performs a trademark function when the mark distinguishes a producer’s goods or products from other goods and services in the marketplace, and in order for a word, name, symbol, or other device to become (and remain) a valid trademark, the mark must perform and continue to perform such a function.¹ When determining whether a mark performs a trademark function for typical consumer goods, it is often a relatively simple question to answer.² Does the word, name, symbol, or device signal to the

1. J. THOMAS MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION § 12:1 (2d ed. 1984).

2. For example, when a consumer sees the Coca-Cola trademark, that consumer knows that the red, cursive text and distinctive bottle are distinguishing

consumer who is the producer of the goods? Think back to the examples listed in the introduction; each of those marks tells potential consumers where these products come from. However, when the goods or services enter the realm of the atypical, such as a religious mark, the answer to this question is not so black and white. It may be more difficult for the courts to ascertain whether a mark is actually performing a trademark function, as required by the Lanham Act.

A. The Lanham Act

Federal trademark law is governed by the Lanham Act (hereinafter “Act”)³. Section 45 of the Act defines a trademark as “any word, name, symbol, or device, or any combination thereof” used or intended to be used in commerce as a way to identify and distinguish goods of one producer of such goods from those manufactured, sold or produced by others, and to indicate the source of such goods.⁴ The Act provides a means of protection for the lawful owners of valid and federally registered marks against potential wrongdoers or infringers. It facilitates this protection by prohibiting infringing activity and providing private causes of action to aggrieved trademark owners against any potential infringers.⁵ A holder of a federally registered trademark may institute a suit for infringement against any person who uses any word, term, symbol,

this brand of soft drink from others in the market. The consumer knows that the product found in this glass bottle is, in fact, Coca-Cola, and is signaled to this fact by the product’s distinctive trademarks.

3. 15 U.S.C. § 1051 (2012).

4. *Id.* § 1127.

5. *Id.* at § 1125(a)(1). The Act also provides a cause of action for trademark dilution. It specifically defines two types of trademark dilution: dilution by blurring and dilution by tarnishment. *Id.* § 1125(c). Dilution by blurring is association of marks arising from the similarity between the mark and a famous mark that lessens the distinctiveness of the famous mark. *Id.* § 1125(c)(2)(B). The Act enumerates several factors that the court may consider when assessing whether dilution by blurring. *Id.* On the other hand, dilution by tarnishment is association between marks arising from the similarity between two marks that harms or otherwise damages the reputation of the famous mark. *Id.* § 1125(c)(2)(C). However, this article will only focus on the cause of action for trademark infringement and as such, a further discussion of dilution is not necessary.

device, or any combination thereof in connection with goods and services and in commerce which is “likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection” as to the origin or source of the goods.⁶

In order for a plaintiff to be successful in a trademark infringement claim, the plaintiff must demonstrate 1) that it owns a valid mark that was entitled to protection under the Act, and 2) that the defendant used a mark in commerce that was likely to cause confusion among the consuming public as to the source or origin of the defendant’s mark.⁷ In assessing whether the defendant’s use of the mark is likely to cause confusion as to source or origin the court analyzes the circumstances surrounding the alleged infringement using a series of factors articulated by the reigning Circuit Court of the applicable jurisdiction.⁸ For example, the Fifth Circuit Court of Appeals applies the *Roto-Rooter* Factors to assess this likelihood.⁹ Under the *Roto-Rooter* Factors, likelihood of confusion is assessed by examining the following factors: 1) the type of trademark at issue, 2) similarity of the marks, 3) similarity of the product(s), 4) identity of retail outlets and purchasers, 5) type of advertising used, 6) defendant’s intent, and 7) actual confu-

6. *Id.* at § 1125(a)(1)(A).

7. *Id.* See also *Gov’t Emps. Ins. Co. v. Google, Inc.*, 330 F. Supp. 2d 700, 702 (E.D. Va. 2004) (holding that a plaintiff alleging a cause of action for trademark infringement must demonstrate that 1) it possesses a mark, 2) the defendant used a mark, 3) defendant’s use of the mark occurred in commerce, 4) the defendant used the mark in connection with sale, offering for sale, distribution, or advertising of goods and services, and 5) the manner in which the defendant used the mark is likely to confuse customers); *CNA Fin. Corp. v. Brown*, 922 F. Supp. 567, 572 (M.D. Fla. 1996) (holding that a plaintiff has established a prima facie case of service mark infringement when it has proven that 1) defendant used a term in commerce, 2) in connection with their services, 3) which is likely to cause confusion with 4) service marks rightfully owned and used by plaintiff in connection with its services).

8. J. THOMAS MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION § 23:1 (4th ed. 2014).

9. *Roto-Rooter Corp. v. O’Neal*, 513 F.2d 44 (5th Cir. 1975). *Eller* would have been heard in the 5th Circuit’s jurisdiction had it proceeded to trial and later appeal.

sion.¹⁰ The court in *Roto-Rooter* emphasized that proof of actual confusion is not necessary for a finding of likelihood of confusion, but views the factor of actual confusion as the most important in assessing the likelihood of confusion.¹¹

B. Genericism

A generic term is one that refers to a product category in which the particular product the mark purports to describe may be classified, and is therefore not distinctive in the trademark sense of the word.¹² A mark may be deemed generic when the primary significance of the term in the minds of the consuming public is the *product*, not the *producer*.¹³ In order to receive trademark protection, a mark must be distinctive, that is, it must perform a trademark function in that it distinguishes a producer's goods and services from other goods in the market place.¹⁴ A mark that is generic receives no protection because it serves no trademark function.¹⁵

A common test for determining whether a mark is generic, and therefore ineligible for trademark protection, is the "Who Are You-What Are You?" Test, derived from McCarthy's treatise and

10. *Id.* at 45. Although not specifically articulated in the *Roto-Rooter* case, courts following the 5th Circuit *Roto-Rooter* test typically assess an eighth factor, level of consumer sophistication, when determining whether a likelihood of confusion exists. See e.g. *Xtreme Lashes, LLC v. Xtended Beauty, Inc.*, 576 F.3d 221 (5th Cir. 2009) (Where the court held that the similarity between two different eyelash extension marks were substantially similar enough to confuse the sophisticated consumer).

11. *Roto-Rooter*, 513 F.2d at 45-46.

12. See *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 194 (1985).

13. *Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. 111, 120 (1938); see also *Liquid Controls Corp. v. Liquid Controls Corp.*, 802 F.2d 934, 936 (7th Cir. 1986) (a trademark is supposed to identify the source of a product, whereas a generic term "merely specifies the genus of which the particular product is a species."); MCCARTHY, *supra* note 8, (noting that a generic name of a product can never function as a trademark in that it does not indicate origin; the terms trademark and generic are mutually exclusive).

14. MCCARTHY, *supra* note 8.

15. See 15 U.S.C. § 1064(3) (2012).

adopted by numerous courts.¹⁶ When a consumer asks the questions “Who are you? Where do you come from? Who made you? Who vouches for you?” a mark is able to answer these questions because it is performing a trademark function; identifying the origin or the source of the goods.¹⁷

A generic term answers the question “What are you?” because a generic term is simply the name of a product category, and fails to denote the origin of the goods.¹⁸ As a final note, a federally registered trademark may be cancelled at any time on the basis that it has become generic, based on the reasoning that it is no longer performing a trademark function.¹⁹

C. Development of Genericism and Likelihood of Confusion in the Federal Courts

In order to fully grasp the issues and potential outcomes of *Eller*, as well as the treatment of a religious trademark, it is essential to examine the relevant case law in the trademark context, focusing on cases in which courts determined either 1) whether or not a religious trademark had fallen prey to genericism, or 2) whether a defendant’s use of the plaintiff’s religious trademark was likely to cause confusion.

1. Generic Mark Analysis in the Religious Context

There have been several cases in the federal district courts as well as in the Circuit Courts of Appeals that addressed the issue of genericism regarding trademarks owned by religious organiza-

16. MCCARTHY, *supra* note 8.

17. *Id.*

18. *Id.*

19. § 1064 (3) (A term that is generic does not perform a trademark function because it no longer signals to the consumer the source of that product; instead, it merely describes the product category in which the product belongs.) *see e.g.*, *Serv. Merch. Co. v. Serv. Jewelry Stores, Inc.*, 737 F. Supp. 983, 998 (S.D. Tex. 1990); *Park N’Fly*, *supra* note 12.

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tions.²⁰ Whether the religious trademarks are found to be generic or not is largely dependent on the facts of the case.

a. General Conference Corp. of Seventh-Day Adventists v. McGill

In *General Conference Corp. of Seventh-Day Adventists v. McGill*, the court held that the defendant had failed to establish that the mark “SEVENTH-DAY ADVENTIST,” was not generic, and therefore protectable under the Lanham Act.²¹ In assessing whether the marks were generic, the court applied a variation of the classic test for genericism: “whether the public perceives the term primarily as the designation of the article.”²² In the religious context of *McGill*, the court ultimately held that the test to be applied to generic religious marks was whether the general consum-

20. See *General Conference Corp. of Seventh-Day Adventists v. McGill*, 617 F.3d 402 (6th Cir. 2010); *General Conference Corp. of Seventh-Day Adventists v. Seventh-Day Adventist Congregational Church*, 887 F.2d 228 (9th Cir. 1989); *Urantia Found. v. Maaherra*, 895 F. Supp. 1338 (D. Az. 1995) (holding that the religious organization’s trademark was not generic); *Christian Science Bd. of Dir. of the First Church of Christ, Scientist v. Evans*, 520 A.2d 1347 (N.J. 1987).

21. *McGill*, 617 F. 3d at 415. The defendant in *McGill* was accused of infringing the plaintiff’s trademark based on his use of their purported mark SEVENTH-DAY ADVENTIST in connection with advertising and other promotions of his church, which were not affiliated with plaintiff’s church. *Id.* at 404. The plaintiff had federally registered trademarks in the marks “Seventh-day Adventist,” “Adventist,” and “General Conference of Seventh-day Adventists.” *Id.* at 405. The defendant had originally been a member of the plaintiff’s church but had separated himself from the church due to theological differences, and formed his own church, which he called “A Creation Seventh Day & Adventist Church. *Id.*

22. *Id.* at 416. The defendant also referred to his church as the “Creation Seventh Day Adventist Church” in the complaint. *Id.* at 405. The defendant used the SEVENTH DAY ADVENTIST mark on several advertisement and promotional materials in connection with his nonaligned church, as well as incorporated the mark into several domain names associated with his church. *Id.* at 405-06.

ing public associates the contested mark with the religious beliefs practiced by the church, or with the church itself.²³

In examining these marks, the district court ruled that the trademarks had become incontestable²⁴ and were presumed valid as a result.²⁵ When the defendant challenged the marks on the basis that they had become generic, defendant now had the burden of proving genericism, and barring trademark protection.²⁶ Ultimately the *McGill* court found that the defendant failed to meet this burden.²⁷

The court found that evidence provided by the defendant was not sufficient to demonstrate that the plaintiff's marks were generic.²⁸ In its opinion, the court found that the plaintiff's marks were not generic because the defendant failed to demonstrate that the general public identified the mark SEVENTH DAY ADVENTIST

23. *Id.* at 415 (quoting *Bath & Body Works, Inc. v. Luzier Personalized Cosmetics, Inc.*, 76 F.3d 743, 748 (6th Cir. 1996)). In arguing for the marks to be deemed generic, the defendant asserted that the term "Seventh-day Adventist" described a religion, and provided the following evidence to support his assertions: 1) testimony from himself and a theology graduate student, 2) a dictionary definition, 3) an entry from Wikipedia, 4) evidence of the plaintiffs using "Seventh-day Adventist" as a noun rather than an adjective, and 5) evidence of two additional "breakaway" churches using the term "Seventh-day Adventist" in the names of their congregations. *Id.* at 415-16.

24. See 15 U.S.C. § 1065(4) (2012) ("no incontestable right shall be acquired in a mark which is the generic name for the goods or services or a portion thereof, for which it is registered.").

25. *McGill*, 617 F.3d at 406.

26. *Id.*

27. *Id.* at 415.

28. *Id.* at 416. The court noted that the existence of other "breakaway" churches using the mark did not help the defendant because this evidence supported the conclusion that the public would associate the term "Seventh-day Adventist" with churches affiliated with the plaintiff's church, the exact opposite of the proposition that the defendant was tasked with proving. *Id.* The court also reasoned that the testimony offered by defendant and the graduate student was not an accurate representation of the public's view, that the dictionary and Wikipedia entries referenced the term "Adventist" and not "Seventh-day Adventist," and that the noun/adjective distinction was more applicable to an analysis regarding the descriptiveness of a mark (which is not grounds to challenge an incontestable mark), rather than an analysis of the generic nature of a mark. *Id.*

as referring to certain religious beliefs, rather than the church itself.²⁹

McGill holds the position that for a religious trademark to be generic, the party with the burden of proving genericism must demonstrate that the public views the mark as reference to the body of religious beliefs, rather than the specific church that touts these religious beliefs.³⁰ The test articulated in *McGill* appears to be the court's interpretation of the traditional definition of a generic mark as specifically applied to the religious context; i.e. a mark is generic if the consumer views the mark as identifying a particular kind of goods (a *product*) as opposed to being the *producer* of said goods.³¹ In *McGill*, and in the broader religious context, the "goods" are the religious beliefs, teachings, ideologies and the like that are spread by the "source," (the religious organization). Therefore, if the consumer sees the mark and identifies it with the religious beliefs, that mark is generic; on the other hand, if the mark is associated with the religious organization itself, the mark has not become generic.

b. *General Conference Corp. of Seventh-Day Adventists v. Seventh-Day Adventists Congregational Church*

A case heard in the Ninth Circuit, *General Conference Corp. of Seventh-Day Adventists v. Seventh-Day Adventists Congregational Church*, applied a similar test to the one articulated in *McGill*.³² The plaintiff in *General Conference* sued for trademark infringe-

29. *Id.*

30. *See id.* When a mark has been registered with the United States Patent and Trademark Office, the defendant in an infringement action has the burden of proving that the mark is generic because the trademark has a presumption of validity. *Reese Pub. Co., Inc. v. Hampton Intern. Commc'ns*, 620 F.2d 7, 11 (2d Cir. 1980). However, when the trademark has not been federal registered, the plaintiff bears this burden of proving that its mark is not generic, due to the absence of the presumption of validity. *Id.*

31. *Liquid Controls Corp. v. Liquid Controls Corp.*, 802 F.2d 934, 936 (7th Cir. 1986). ("A generic term is one that is commonly used as the name of a kind of goods.")

32. *Gen. Conference Corp. of Seventh-Day Adventists v. Seventh-Day Adventists Congregational Church*, 887 F.2d 228 (9th Cir. 1989).

ment, alleging that the defendant had used the plaintiff's mark SEVENTH DAY ADVENTIST to describe its church.³³ The defendant again asserted the defense of genericism.³⁴ As in *McGill*, the defendant argued that the mark was generic because it referred to the set of Christian beliefs, doctrines and standards, rather than plaintiff's church.³⁵ The court did not rule on the merits of whether the mark was generic, but held that the defendant had properly pled the affirmative defense in its answer, as to preclude a judgment on the pleadings.³⁶

c. *Christian Science Board of Directors of the First Church of Christ, Scientist v. Evans*

In *Christian Science Board of Directors of the First Church of Christ, Scientist v. Evans*, the Supreme Court of New Jersey found that the names "Christian Science" or "Christian Science Church" were generic and therefore not protectable as trademarks. In arriving at this decision, they took a different approach than the *McGill* court.³⁷

In *Evans*, the plaintiff was the First Church of Christ, Scientist (referred to as the "Mother Church" by the court) of the Christian Science faith, a religion founded by Mary Baker Eddy in the 19th century.³⁸ The defendants were trustees of a church that was at one time a branch of the Mother Church and therefore affiliated with

33. *Id.* at 229.

34. *Id.* at 231.

35. *Id.*

36. *Id.* The court in *General Conference* reviewed *de novo* a judgment on the pleadings, and held that judgment was not proper because defendants had properly plead the affirmative defense of genericism in its answer. *Id.* Therefore, judgment on the pleadings was improper. *Id.*

37. *Christian Science Bd. of Dir. of the First Church of Christ, Scientist v. Evans*, 520 A.2d 1347 (N.J. 1987).

38. *Id.* at 1349. The court explained the organizational structure of the faith as follows: The Mother Church is the center of the international Christian Science community and is therefore given the formal name of the First Church of Christ, Scientist. *Id.* Local branches of the church are smaller in size than the Mother Church and are designated as "First Church of Christ, Scientist," followed by a geographic description or other indication. *Id.*

the plaintiff.³⁹ The defendants, however, continued to use the phrase “Christian Science” in connection with its organization after the split, spurring the trademark infringement claim that was the crux of this case.⁴⁰ The Supreme Court of New Jersey held that the terms in which the plaintiffs were attempting to secure trademark rights and enforcement were generic and therefore not protectable.⁴¹

In an interesting take on the issue presented, the court was careful to point out that the religion of Christian Science was founded at least a decade before the Mother Church was founded. This careful distinction emphasized the fact that the religion and its organization (The Mother Church) are conceptually separate and that the religion was in existence before the organization.⁴²

The court highlighted two essential policy reasons for its decision. First, the court reasoned because the term “Christian Science” is the name of a religion, anyone practicing “Christian Science” should be permitted to use the term “Christian Science in connection with the name of a Church, and those not practicing the religion should not be permitted to use the term in connection with their religious organization or church.”⁴³ Secondly, the court extrapolated that because the defendant is practicing the Christian Science Religion, it should be permitted to use the term in connection with the name of its church.⁴⁴ The court noted that the plaintiffs did not have the law on their side in their attempts to prohibit the defendants from using the term “Christian Science” in connection with their church, since term has become the common—and

39. *Id.* Years after the defendant’s branch was officially authorized as a branch of the Mother Church, a theological schism occurred and the Mother Church withdrew its “recognition” of the defendant’s organization as an official branch of the Mother Church, and ordered the defendants to cease using the name “Christian Science” in connection with its organization. *Id.*

40. *Id.*

41. *Id.* at 1357.

42. *Evans*, 520 A.2d at 1349. The court noted that these facts were essential to its reasoning in the case. *Id.*

43. *Id.*

44. *Id.*

therefore generic—term used to describe any religion following the teachings of Mary Baker Eddy.⁴⁵

The court went on to say that just because the plaintiff's use of the term has been relatively exclusive and unchallenged for a substantial amount of time, it does not lend weight to the argument that the plaintiffs should be granted exclusive rights as to use of the term; to do so would be against the fundamental objectives of trademark law.⁴⁶ The court also stressed that it must protect against monopolies in generic terms in the religious products context just as much, if not more, as in the commercial products and services cases, highlighting the importance of this realm of cases and the policy concerns implicated in each of these religious trademark cases.⁴⁷

2. "Likelihood of Confusion" and the Religious Context

Treatment of likelihood of confusion has also varied among the circuit courts, as demonstrated by *Jews For Jesus v. Brodsky* and *Lamparello v. Falwell*. Both cases have somewhat analogous facts, but produced diametrically opposed results, perhaps turning on the content of the alleged infringer's materials.

45. *Id.* at 1352 (citing *Primal Feeling Center of New England, Inc. v. Janov*, 201 U.S.P.Q. (BNA) 44 (T.T.A.B. 1978). Holding that the plaintiff's asserted trademark in "Primal Therapy," a type of therapy that he had created as well as named, was invalid, due to the fact that it was impossible to describe the therapy without using the name "Primal Therapy." *Id.* at 50. Therefore, the TTAB concluded that those individuals providing the therapy piloted by Dr. Janov had the right to use the name "Primal Therapy" in conjunction with their services. *Id.* at 56.)

46. *Evans*, 520 A.2d at 1352. The court opined that the plaintiffs were essentially attempting to remove a term from the public domain and gain exclusive use as their own. *Id.* at 1352.

47. *Id.* at 1355.

a. Jews for Jesus v. Brodsky

In *Jews for Jesus v. Brodsky*, the plaintiff was a non-profit outreach ministry that was founded in 1973.⁴⁸ The plaintiff claimed that it held a common law service mark in “Jews for Jesus” based on its continuous use of the mark in commerce for a substantial amount of time, as well as the service mark “Jews f✶r Jesus”, with the “O” of the word “for” being replaced with a stylized Star of David.^{49,50} The plaintiff claimed that the widespread use of its name and marks had gained the mark significant recognition and that the public recognized its name and marks as identifying the plaintiff’s religious organization and its associated mission and beliefs.⁵¹ The plaintiff also secured a domain name of “jews-for-jesus.org” in order to promote its religious organization.⁵²

The plaintiff sued a professional website developer and vocal critic of the plaintiff’s organization, for a violation of their trademark rights pursuant to the Lanham Act.⁵³ At issue in the suit was

48. *Jews For Jesus v. Brodsky*, 993 F. Supp. 282, 288 (D.N.J. 1998). The founders of the Jews for Jesus ministry founded their religious organization on the belief that Jesus is the “Messiah of Israel” and the “savior of the World,” and promoted this idea through education and religious camaraderie directed towards Jews and non-Jews alike. *Id.* The court emphasized that the plaintiff’s organization employs 145 staff members, has twelve permanent branches around the world, and 68 chapters perform voluntary activities on its behalf. *Id.*

49. *Id.* The plaintiff had owned and maintained a federally registered service mark in this stylized version of its service mark since 1983. *Id.*

50. The court also emphasized the plaintiff’s broad information dissemination efforts, including four publications that it distributes around the United States, as well as numerous other mediums of dissemination, including classes, meetings, television and radio broadcasts, magazines, brochures, and newspapers. *Id.* at 289. The plaintiff has also spent a considerable amount of time and money in creating and distributing advertising campaigns for its religious teachings and organization. *Id.* However, the plaintiff has conceded that not every single piece of literature or other material that it distributed contained the stylized mark. *Id.*

51. *Id.*

52. *Id.* at 290. The plaintiff maintained that the domain name did not contain the stylized “O” in the word “for,” nor did it contain spaces in the domain name because such characters are not recognized in internet domain names. *Id.*

53. *Id.*

a website created by the defendant with the domain name “jews-forjesus.org.”⁵⁴

In determining whether the plaintiff was likely to succeed on the merits of the case,⁵⁵ the court held that the plaintiff had successfully demonstrated a likelihood of success on the merits.⁵⁶ The court found that the plaintiff owned a valid and legally protectable mark, and the defendant’s use of a similar mark in conjunction with its website was likely to cause confusion as to the source of the website and related content.⁵⁷ Defendant relied on *Blinded Veterans* in

54. *Jews For Jesus*, 993 F. Supp. at 290. The defendant’s website contained about one page of text referring to the plaintiff’s organization as “Jews for Jesus,” without the stylized mark. *Id.* The defendant stated that his purpose behind creating his website was to “intercept potential converts before they have a chance to see the obscene garbage on the real J4J site.” *Id.* at 291, (quoting Exhibit J to the Complaint). The defendant also repeatedly referred to his own website as bogus. *Id.* at 286. The website contained a disclaimer that stated “**PLEASE NOTE** This website is an independent project which reflects the personal opinion of its owner, and is in no way affiliated with the Jewish organization Outreach Judaism, or the Christian organization Jews for Jesus.” *Id.* at 290 n. 13 (quoting Exhibit E to the Complaint) (emphasis in original). The website also contained a clickable link that transported users to the internet site for the Outreach Judaism Organization, another “vocal opponent” of Jews for Jesus. *Id.* at 290-91. The court pointed out that the website for the Outreach Judaism Organization was commercial in nature in that one of the sections of the website sold certain items relating to the teaching of the Outreach Judaism Organization.

55. The plaintiff in *Jews for Jesus* sought a preliminary injunction. *Id.* at 287. The court articulated that, in order for injunctive relief to be proper, the plaintiff has the burden of demonstrating 1) the likelihood of the plaintiff prevailing on the merits at the final hearing, 2) the extent to which the plaintiff is being irreparably harmed by the defendant’s activities, 3) the extent to which the defendant will experience irreparable harm if the injunctive relief is granted, and 4) the public interests involved in granting the injunctive relief. *Id.*

56. *Id.* at 305.

57. In regards to the likelihood of confusion as to the federally registered service mark, the court held that the defendant’s use of the domain name was confusingly similar to the plaintiff’s mark and therefore was likely to constitute infringement on the merits. *Id.* at 296. In deciding so, the court reasoned that in order to constitute infringement, exact similarities are not required between the senior mark and the one allegedly infringing upon such mark. *Id.* The court instead stated that in order for a finding of infringement, the marks must be confusingly similar or used to deceive the public, further stating that two marks are confusingly similar if ordinary consumers may incorrectly assume that the two

arguing that the common law service mark “Jews for Jesus” was generic and therefore not entitled to trademark protection.⁵⁸

The court rejected the plaintiff’s argument for a finding of genericism.⁵⁹ In articulating the standard for a generic term, the court stated that a term is generic “if that term has ‘so few alternatives (perhaps none) for describing the good [or service] that to allow someone to monopolize the word would debilitate competitors.’”⁶⁰ The court rejected the analogy to *Blinded Veterans*, stating that the cases were distinguishable because there was ample evidence demonstrating that the plaintiff has consistently used the term “Jews for Jesus” to refer to the organization, and not its practitioners.⁶¹

marks share a common “source, affiliation, connection, or sponsorship.” *Id.* (quoting *Fisons Horticulture Inc., v. Vigoro Indus., Inc.*, 30 F.3d 466, 477 (3d Cir. 1994)). However, in its reasoning, the court fails to mention the defendant’s stated objective in creating the website, to intercept potential seekers of the plaintiff’s site, and instead based its reasoning on a bare and unsupported assertion that consumers will likely inappropriately assume that the defendant’s website is affiliated with or otherwise endorsed by the plaintiff’s organization because the names are almost identical. *Id.* However, the court fails to recognize that once any potential consumers reach the website, any such assumptions held by said consumers will be proven false, as the content on the defendant’s website is in opposition to and in critique of those beliefs held by the plaintiff’s organization.

58. *Jews for Jesus*, 993 F.Supp at 297. In arguing that the plaintiff’s common law service mark was generic, the defendant analogizes to the decision handed down by the D.C. Circuit in *Blinded Veterans Ass’n v. Blinded American Veterans Found.* (Where the court held that the common law (and therefore unregistered) mark BLINDED VETERANS was generic because the organization used the term “blinded veterans” numerous times to refer to soldiers who had lost their sight, instead of the actual organization itself. *Jews for Jesus* at 298, citing to *Blinded Veterans Ass’n v. Blinded American Veterans Found.*, 872 F.2d 1035, 1041 (D.C. Cir. 1989). The court also went on to state that it would be hard to designate another term for the public to refer to the category of people who were both blind and veterans. *Blinded Veterans*, 872 F.2d at 1041).

59. *Jews for Jesus*, 933 F. Supp at 297.

60. *Id.* (alteration in the original) (quoting *Duraco Prods., Inc. v. Joy Plastic Enters., Ltd.*, 40 F.3d 1431, 1442 (3d Cir. 1994)).

61. *Id.* Additionally, the court further distinguished *Blind Veterans* by noting that there are many other terms available for the public to use in order to refer to Jews who believe in Jesus Christ. *Id.*

The *Jews for Jesus* court also assessed the likelihood of confusion created or potentially created by the defendant's use of the mark.⁶² The court determined that, based on an extensive analysis of the *Scott* Factors, which are used by the Third Circuit in assessing likelihood of confusion, the defendant's use of the mark in conjunction with his website was likely to cause confusion because a majority of the factors weighed in favor of a likelihood of confusion.⁶³ Therefore, the court held, the plaintiff had successfully demonstrated a likelihood of success on the merits.⁶⁴

b. Lamparello v. Falwell

In order to contextualize *Jews for Jesus*, the Fourth Circuit case of *Lamparello v. Falwell* provides an interesting, and distinguishable, case from *Jews for Jesus* but with similar base facts.⁶⁵ In *Lamparello*, the defendant created a website⁶⁶ criticizing the plaintiff Jerry Falwell⁶⁷, a nationally known minister who expressed con-

62. *Id.* at 301. In assessing likelihood of confusion, the court used the Third Circuit Scott Factors. *Id.* Those factors include "1) the degree of similarity between the owner's mark and the alleged infringing mark; 2) the strength of owner's mark; 3) the price of the goods and other factors indicative of the care and attention expected of consumers when making a purchase; 4) the length of time the defendant has used the mark without evidence of actual confusion arising; 5) the intent of the defendant in adopting the mark; 6) the evidence of actual confusion; 7) whether the goods, though not competing, are marketed through the same channels of trade and advertised through the same media; 8) the extent to which the targets of the parties' sales efforts are the same; 9) the relationship of the goods in the minds of the public because of the similarity of function; [and] 10) other facts suggesting that the consuming public might expect the prior owner to manufacture a product in the defendant's market." *Id.* See *Scott Paper Co. v. Scott's Liquid Gold, Inc.*, 589 F.2d 1225, 1229 (3d Cir. 1978).

63. *Id.*

64. *Id.* at 305.

65. *Lamparello v. Falwell*, 420 F.3d 309 (4th Cir. 2005).

66. The court refers to the defendant's website as a "gripe site." *Id.* at 311.

67. Christopher Lamparello actually sought declaratory judgment that he was not in violation of Jerry Falwell's trademark rights, making Lamparello the *de facto* plaintiff. *Id.* at 312. For clarity's sake, Lamparello shall be referred to as the defendant throughout this discussion, because it was his actions that were potentially infringing.

troversial ideas about homosexuals and homosexuality.⁶⁸ The plaintiff had several common law trademarks in “Jerry Falwell” and “Falwell,” and maintained a website for his ministry at “www.falwell.com.”⁶⁹ The defendant registered the domain name “www.fallwell.com” and used this website as a platform from which to respond to and criticize the plaintiff’s views about homosexuality.⁷⁰ In response to several cease and desist letters sent by the plaintiff and his representative, the defendant filed suit, seeking declaratory judgment of noninfringement.⁷¹

Upon review, the Fourth Circuit articulated that to be successful in a cause of action for infringement, the plaintiff must demonstrate 1) that it possesses a mark, 2) that the defendant has used the mark, 3) that the defendant’s use of the mark occurred in commerce, 4) that the defendant used the mark in connection with the sale, distribution, or advertising of goods or services, and 5) that the defendant used the mark in a way that was likely to cause confusion among customers.⁷² The Fourth Circuit refers to these five factors that assess likelihood of confusion as the *Pizzeria Uno* Factors.⁷³ The court ultimately held that the defendant’s gripe site was not likely to cause confusion among consumers.⁷⁴

68. *Id.* at 311.

69. *Id.*

70. *Id.* The defendant’s website contained a disclaimer on the homepage disowning any affiliation or other association with the plaintiff’s ministry as well as a link to the plaintiff’s website for patrons who inadvertently accessed the defendant’s website. *Id.* The defendant’s website also contained a clickable link to amazon.com, where visitors were directed to a page selling a book that supported the defendant’s interpretation of the Bible and homosexuality. *Id.*

71. *Lamparello*, 420 F.3d at 312. On summary judgment, the district court ruled in favor of the plaintiff, Jerry Falwell. *Id.*

72. *Id.* at 313. In assessing likelihood of confusion, the Fourth Circuit utilizes (and did so in *Lamparello*) the *Pizzeria Uno* Factors. *Id.* at 314-15. See *Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522, 1527 (4th Cir. 1984). The relevant factors include 1) the strength or distinctiveness of the mark, 2) the similarity of the marks, 3) the similarity of the goods and/or services that the two marks are being used to identify, 4) the similarity of the facilities used by the parties in connection with their goods/services, 5) similarity of advertising, 6) the potential infringer’s intent, and 7) actual confusion. *Id.* at 315.

73. *Id.*

74. *Id.*

Although the court looked at all of the *Pizzeria Uno* factors, the most relevant to this discussion are the similarity of goods and services and actual confusion. The court noted that the two sites did not offer similar goods and services and that, in fact, the views presented by each site are in absolute opposition to one another.⁷⁵ The court opined that because the two websites offered such differing views, users attempting to access the plaintiff's site who instead inadvertently encountered the defendant's gripe site would not believe that the plaintiff would endorse, create, or otherwise sponsor a website criticizing his own religious teachings.⁷⁶ In other words, the court posited that the consumers were intelligent enough to distinguish between the two websites. Furthermore, the court reasoned, there was actual anecdotal evidence of internet users who came across the defendant's website while looking for the plaintiff's website, soon thereafter realized that the plaintiff was not the source of such website.⁷⁷ Therefore, the court concluded, there was no likelihood of confusion.⁷⁸

III. *ELLER* CASE SUMMARY

Eller v. Intellectual Reserve, Inc. was filed in the United States District Court for the Southern District of Texas on April 7, 2014.⁷⁹ Plaintiff, Jonathan Eller, seeks declaratory judgment and a preliminary judgment regarding his use of the word "Mormon" to promote his Mormon-centered online dating site, Mormon Match, as well as use in his domain name for the same. Defendant, Intellectual Reserve, Inc. ("Intellectual Reserve") filed counterclaims asserting that Eller has committed violations of trademark and unfair competition law, both in the federal and common law domains; fi-

75. *Id.*

76. *Lamparello*, 420 F.3d at 315; see also *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 308-09 (9th Cir. 1992) (stating that when a mark is used by someone other than the markholder to criticize the markholder, this use implies that the use is not sponsored by the senior markholder).

77. *Lamparello*, 420 F.3d at 315.

78. *Id.*

79. Complaint at 1, *Eller v. Intellectual Reserve, Inc.* (S.D. Tex. Apr. 29, 2014) (No. 4:14-cv-00914).

nally, Intellectual Reserve sought declaratory judgment regarding Eller's use of MORMON.⁸⁰

A. Factual Background

Plaintiff, Jonathan Eller, is the founder of Mormon Match, an online dating service which is geared towards helping members of the Mormon Church meet significant others who share similar religious faith and beliefs.⁸¹ The domain name for Mormon Match is www.dateamormon.com.⁸² Eller sought federal trademark registration for the mark MORMON MATCH as well as Mormon Match's logo, and sought to apply the registration of these marks for "Internet-based dating, social introduction, and social networking services."⁸³

Intellectual Reserve, Inc. is a "non-profit Utah Corporation holding intellectual property used by The Church of Jesus Christ of Latter-day Saints."⁸⁴ The Church is more commonly known as the

80. Capitalization of a word throughout this article will denote the trademark or group of trademarks at issue.

81. Complaint at 30-32. Eller describes himself as a Mormon and an "active member of the Church in full fellowship." *Id.* at 27.

82. *Id.* at 31-32. Eller alleges that he created this website and dating service to serve as a safe, comfortable, and convenient forum for members of the Mormon Church to meet and facilitate "relationships, dating, and marriages between Mormon users of his website." *Id.* Since this time the website has used the domain name of www.dateamormon.com, as well as has displayed Mormon Match's logo, a background image of the Salt Lake City Temple, and made other and numerous usages of the word "Mormon" in a variety of contexts. *Id.* at 39-40. Eller maintains that since the website was activated in June of 2006 and that he never received any cease and desist letters or any other correspondence for that member from the Intellectual Reserve or any authority members of the Church informing him that he could not use the word Mormon to promote his dating website. *Id.* at 40.

83. Complaint at 42. Eller's final trademark application did not claim trademark in MORMON MATCH, only the design elements of the site. *Id.* at 43-44. On October 29, 2013, Eller's trademark application was published for opposition in the *Official Gazette*, a weekly publication in which the United States Patent and Trademark Office publishes newly registered trademarks. *Id.* at 45.

84. *Id.* at 2; see also Answer, Affirmative Defenses and Counterclaims at 2, *Eller v. Intellectual Reserve, Inc.* (S.D. Tex. Apr. 29, 2014) (No. 4:14-cv-00914).

Mormon Church, and Intellectual Reserve holds claims to trademarks in several marks incorporating the word MORMON.⁸⁵ The Church has had a federally registered trademark in the word MORMON since May 8, 2007.⁸⁶ Intellectual Reserve asserts that all of the Mormon marks it has federally registered have been deemed incontestable.⁸⁷

On January 4, 2014, Intellectual Reserve filed a Notice of Opposition, asserting ownership of all right, title, and interest in the trademark MORMON.⁸⁸ Eller alleges that none of the aforementioned marks are claimed for goods and services similar to those in which his trademark is registered⁸⁹ and that the Intellectual Reserve was denied trademark in the word MORMON.⁹⁰

Eller sought declaratory judgment in regard to his use of the word “Mormon” in conjunction with his internet dating site, as well as declaratory judgment that MORMON is a generic and/or descriptive mark and therefore the Church has no rights in the mark.⁹¹ Eller’s believed that his use of MORMON and other purportedly trademarked images does not constitute infringement of any rights purported by Intellectual Reserve or the Mormon Church⁹². Furthermore, Eller sought enjoinder of Intellectual Reserve from interfering or otherwise attempting to restrict or other-

85. Affirmative Defenses at 10. Intellectual Reserve’s trademarks incorporate the word MORMON alone or in combination with other words, as well as design marks involving or otherwise depicting the temple located in Salt Lake City, Utah. *Id.*

86. *Id.* at 15.

87. *Id.* at 16.

88. Complaint at 47. Intellectual Reserve asserted that this mark is an unregistered common law mark protected for an “unspecified variety of goods and services” as well as several additional federally registered marks all related to the Church and its products/services. *Id.* at 47-50. The additional federally registered trademarks that Eller claimed the Intellectual Reserve identified included MORMON, MORMON.ORG, BOOK OF MORMON, MORMON TABERNACLE CHOIR, MORMON TABERNACLE CHOIR (and Design), MORMON HANDICRAFT, and MORMON HANDICRAFT. *See Id.* at 50.

89. *See Id.* at 51. Eller’s mark is filed under Section 45, “Internet-based dating, social introduction, and social networking services.”

90. *Id.* at 51-52.

91. *Id.* at 105-110.

92. *Id.* at 17.

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wise interfere with Eller's operation and control of his Internet-based dating site.⁹³

Intellectual Reserve filed five counterclaims alleging that, Eller infringed on its trademark and violated several provisions of federal copyright law.⁹⁴ Furthermore, Eller's use of these marks has created a likelihood of confusion among "actual and prospective customers" and that this likelihood of confusion has damaged the goodwill of the MORMON marks.⁹⁵

VI. ANALYSIS

It seems as though there is little to no consistency with which the various court's examination of religious trademarks. Why did the *McGill* court hold that the plaintiff's mark was not generic and did not create a likelihood of confusion, while the *Evans* court in examining strikingly similar facts, held that the plaintiff's mark was generic?

A. *Varying Interpretations of Religious Trademarks*

One possible explanation for the variety of religious trademark interpretations may be certain circuits' tendencies to provide an implicit (or explicit) bias to plaintiffs who hold religious trademarks. It seems as though in some circuits, the courts are unwilling (whether consciously choosing to be so or not) to place the same

93. Complaint at 17.

94. Answer at 47-79. Intellectual Reserve's counterclaim asserts that Eller engaged in trademark infringement in violation of federal law pursuant to 15 U.S.C. § 1114(1)(a). Counterclaim at 49. Furthermore, Intellectual Reserve alleged that Eller has used Intellectual Reserve's marks in an infringing manner in connection with Eller's Internet-based dating site. *Id.* at 48.

95. *See* Complaint. Eller filed his Complaint at Law in the United States District Court for the Southern District of Texas on April 7, 2014. On April 29, 2014, Intellectual Reserve filed its Answer as well as the counterclaims against Eller described above. *See* Answer; Counterclaims. On June 20, 2014, the parties filed a notice of settlement, the terms of which remain undisclosed to the public at this time. Bill Donahue, *Mormon Dating Site Settles Trademark Spat with LDS Church*, LAW 360 (June 20, 2014, 2:46 PM), <http://www.law360.com/articles/550306/mormon-dating-site-settles-trademark-spat-with-lds-church>.

evidentiary burdens as are placed on secular litigants. When examining such cases, it appears as though the court does not scrutinize the evidence put forth for likelihood of confusion and against genericism at the same level that it does for secular litigants. Some critics have alleged that the court in *McGill* failed to properly and neutrally apply trademark law to the facts in *McGill*.⁹⁶ N. Cameron Russell, in his examination of domain names in the religious context, critiques the court's decision that the relevant consuming public viewed the plaintiff's mark as referring to the religious organization, rather than the "goods" offered by the religious organization (i.e. the producer rather than the product).⁹⁷

There is also a difference in the way in which the courts examine likelihood of confusion as well. Although *Jews for Jesus* and *Lamparello* both dealt with non-secular plaintiffs, there was one glaring difference in the court's interpretation: both the defendants in these cases maintained gripe sites that criticized the plaintiff's religious beliefs. In *Lamparello*, the court emphasized this feature of the website, stating that any likelihood of confusion was simply absent due to the fact that the defendant's site was critical of the plaintiff's beliefs. However, this analysis is absent from *Jews for Jesus*. The disparities in these cases are harder to explain because both cases dealt with non-secular litigants, but the inconsistencies between the courts' interpretation are conspicuous.

It is well-settled and fundamental principle of law in our national jurisdiction that when presiding over a matter concerning a religious property dispute, the court may not "take sides" and must take great efforts to avoid ruling based on religious doctrine.⁹⁸

96. N. Cameron Russell, *Allocation of New Top-Level Domain Names and the Effect upon Religious Freedom*, 12 J. MARSHALL REV. INTELL. PROP. L. 697, 709 (2013).

97. Russell notes that customer surveys are often employed in trademark infringement cases, and that if members of the relevant public were administered surveys regarding the significance of the plaintiff's purported trademark, it seems "unlikely" that the majority would answer that it was the religious organization itself. *Id.*, Russell seems to be implying that the *McGill* court was improper in its decision that the plaintiff's term was not generic.

98. J. THOMAS MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION §9:7.50 (4th ed. 2014) (citing Serbian E. Orthodox Diocese for the U.S. & Can. v. Milivojevic, 426 U.S. 696 (1976)). See also Nat'l Spiritual Assembly of the

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However, the examination of the relevant precedents has been instrumental in revealing the inconsistencies of the court's application of the trademark rules and tests to religious organizations and their affiliates. *McGill* suggests the court's unwillingness to place such the burden required of secular plaintiffs to demonstrate a likelihood of confusion. Although there is a clear mandate for religious neutrality and impartiality, some courts are taking these principles too far and perhaps lightening the burden on religious plaintiffs attempting to secure rights in trademarks that would not otherwise be protected if not for their religious affiliations.

B. Eller: A Meritorious Case?

Although *Eller* was settled and the District Court was not required to issue a written ruling on the merits of the case, it is compelling to examine the case law in the realm of religion and trademark, and analyze what may have happened if the merits of the case had been heard by the court. The ultimate question is whether Intellectual Reserve's counterclaims in *Eller* had a likelihood of success on the merits, and whether a decision in Intellectual Reserve's favor would have pushed the boundaries of trademark law in the religious context.

The facts of the *Eller* case and the Mormon Church's proclamation that it owns trademarks in such words and symbols associated with the Church raise several questions, all relating back to one main inquiry: Does the Mormon Church have a valid counterclaim against Eller's use of the word Mormon in connection with his Internet dating site? Could *Eller* have pushed the outer-limits of trademarkable religious marks?

Bahá'is of the U.S. Under Hereditary Guardianship, Inc. v. Nat'l Spiritual Assembly of the Bahá'is of the U.S., Inc., 628 F.3d 837 (7th Cir. 2010) (applying the fundamental principle that courts must remain neutral in adjudicating church property disputes to trademark disputes). In *National Spiritual Assembly*, the court was required to decide a forty-year-old trademark dispute between two religious organizations, one of which had split and formed a schism from the other. *Id.* at 840. The court stressed that in analyzing and deciding upon such a case, courts must be cautious as to not take sides in the religious schism and to use the neutral application of the law to determine the resolution to the legal dispute. *Id.* at 845.

It is essential to note that the purpose of this treatment of trademark in the religious context is *not* to make the assertion that a religious organization cannot or should not be afforded the right to obtain, own, and enforce its right as to any trademarks or other intellectual property. In fact, courts have observed that nothing in the Constitution prohibits religious organizations from owning property, intellectual or otherwise, nor “prohibits the government from protecting that property from unlawful appropriation by others.”⁹⁹ In other words, religious organizations are, or at least should be, treated the same as nonreligious organizations with regards to their intellectual property rights and their right to enforce these private causes of action. However, *Eller* focuses on the Church’s claim that it holds an *exclusive right* to use the word “Mormon,” which the majority of people use to describe the Church and all of its proffered religious services.

Eller alleged that his purpose in creating Mormon Match was to create a forum in which members of the Mormon Church could meet, interact, and create loving relationships with other members who share the same religious beliefs and ideals.¹⁰⁰ It seems unlikely, and Intellectual Reserve has provided little evidence to the contrary, that Eller created his site with the intention of unfairly and inappropriately capitalizing off of the Mormon Church. Additionally, Eller’s website contains a disclaimer that reads “MORMON MATCH IS NOT COMMERCIALY AFFILIATED WITH OR ENDORSED BY THE CHURCH OF JESUS CHRIST OF

99. Nat’l Bd. of Young Women’s Christian Ass’n of U.S.A. v. Young Women’s Christian Ass’n of Charleston, S.C., 335 F. Supp. 615, 625 (D.S.C. 1971) (holding that granting a religious organization the exclusive use of a name only deprives other religious groups of the use of that same name and that such exclusivity does not deny other religious organizations the right to establish competing organizations with the same purpose but with different names); *see also* Gen. Conference Corp. of Seventh-Day Adventists v. Perez, 97 F. Supp. 2d 1154, 1164 (S.D. Fl. 2000) (holding that it is a well-established principle of law that religious organizations are entitled to the same amount of protection for their trademarks, copyright, and other intellectual property as are commercial enterprises; furthermore, enforcement of the Act in the religious context does not “abridge the religious freedom rights” of a group who is legitimately infringing upon another’s valid trademarks).

100. Complaint at 8-9.

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LATTER-DAY SAINTS.”¹⁰¹ People should be permitted to trademark use of the name of the religion in a non-reputation harming way, even if they may not be entitled to immunity from trademark infringement through the fair use defense. Uses such as Eller’s do not harm the Mormon Church; in fact, it could be argued that such uses help promote the Mormon Church’s ideals, theology, and beliefs, in that it helps raise public awareness and a positive image of the Mormon Church.

In *Eller*, the goods purported to be distributed by Intellectual Reserve and the Church present a quandary in determining whether their group of Mormon trademarks are actually performing a trademark function. The specific goods and the Church is distributing under these trademarks do not fit the traditional categories of consumer products. It is necessary to decide whether the Church’s claimed trademarks in the word MORMON and associated terms, as well whether as the image of the Temple, is capable of, and actually does, perform a trademark function.

1. Eller’s Likelihood of Success on the Merits

Although *Eller v. Intellectual Reserve* was settled, an examination of Intellectual Reserve’s likelihood of success on the merits of its trademark infringement counterclaims is still relevant.

a. Valid Mark

In *Eller*, the goods purported to be distributed by Intellectual Reserve and the Church present a dilemma in determining whether their group of MORMON trademarks are actually performing a trademark function. It is seemingly more difficult to define what exactly the goods or services provided by the Church whether the Church’s claimed trademarks in the word MORMON and associated terms, as well whether as the image of the Temple, is capable

101. MORMON MATCH, <https://dateamormon.com/> (last visited July 21, 2014). However, it is important to note that this website was accessed *after* the June 2014 settlement. As the settlement terms are as of this date, unknown, the disclaimer may have been incident to the settlement of this matter. See Donahue, *supra* note 95.

of, and actually do, perform a trademark function. Therefore, the issue becomes whether the MORMON marks are generic.

Under the test genericism articulated in *McGill* and applied to the facts of *Eller*, the court must ascertain whether the general consuming public views the marks as referring to the set of religious beliefs held by the religious organization. If the general public views the marks as referring to the religious doctrine taught by the religious organization (i.e. as reference to a product), then the marks will be determined to be generic. On the other hand, if the public views the marks as referring to the religious organization itself, the source of the goods (i.e. as reference to the producer), then the mark will not be held to be generic.¹⁰² if it can be demonstrated that the general consuming public views the marks as referring to the “goods” (Mormon beliefs, doctrines, morals, etc.) rather than the Mormon Church itself, then the MORMON marks should be found generic. If this were the case, analysis stops here, as the Mormon Church does not have a viable claim due to lack of a valid trademark. However, if the converse is true, and the public does view these marks as referring to the Mormon Church itself, the analysis continues as to whether Eller’s use of the mark is likely to cause confusion.

Additionally, if analyzed under the framework of *Evans*, it seems as though *Eller* would not have been found liable for infringing Intellectual Reserve’s MORMON Marks. As discussed *supra*, the *Evans* court held that when it is impossible to discuss or otherwise name the plaintiff’s religion without using the plaintiff’s purported mark, that mark has been deemed generic and therefore is not protected by trademark law.¹⁰³ Additionally, the *Evans* court articulated that if someone is practicing the religion, he or she has the right to use the religious name in connection with its goods and services.¹⁰⁴ Therefore, because Eller is a practicing Mormon, and “Mormon” is the name of a religion, Eller should be permitted to

102. *McGill*, 617 F. 3d at 416.

103. *See Russell, supra* note 96 at 709.

104. *See Evans*, 520 A.2d at 1355.

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use the word Mormon in conjunction with the goods and/or services that he is marketing to the public.¹⁰⁵

b. Likelihood of Confusion

In order to be successful in a trademark infringement claim, the plaintiff must also demonstrate that there is a likelihood of confusion caused by the defendant's use of the mark.¹⁰⁶ Traditionally, the courts apply several factors when analyzing whether a defendant's mark is likely to cause confusion. In the 5th Circuit, courts apply the *Roto-Rooter* factors.¹⁰⁷

Although the 5th Circuit has not (yet) specifically applied these factors to the religious context, other federal District Courts and Circuit Courts of Appeal have.¹⁰⁸ In *McGill*, the 6th Circuit held that the defendant's use of the plaintiff's mark, SEVENTH-DAY ADVENTIST, was likely to cause confusion based on the similarity of each party's relative services and the close similarity of the marks.¹⁰⁹

105. This statement excludes the use of such mark in a disparaging, dilutive, or other damaging manner. Such causes of action are beyond the scope of this treatment.

106. 15 U.S.C. § 1125(a)(1)(A) (2012).

107. *Roto-Rooter* 513 F.2d at 45. Likelihood of confusion is assessed by examining the following non-exclusive factors: 1) the type of trademark at issue, 2) similarity of design, 3) similarity of product, 4) identity of retail outlets and purchasers, 5) identity of advertising media utilized, 6) defendant's intent, and 7) actual confusion. *Id.* The court in *Roto-Rooter* made sure to emphasize that although proof of actual confusion is not necessary for a finding of likelihood of confusion and subsequent liability for trademark infringement, the court views the factor of actual confusion as the most important and as the best evidence of likelihood of confusion. *Id.* at 45-46.

108. See *McGill*, 617 F.3d 402 (holding that a breakaway church's use of the mark SEVENTH-DAY ADVENTIST was likely to cause confusion because of the relatedness of the parties' services and similarity of the marks).

109. *Id.* at 416. The factors the court assessed in *McGill* to determine likelihood of confusion were 1) the strength of the senior mark, 2) relatedness of the goods and services, 3) similarity of the marks, 4) evidence of actual confusion, 5) the marketing channels used, 6) likely degree of purchaser care, 7) the intent of the defendant in selecting the mark, and 8) the likelihood of expansion of the product lines. *Id.*

Of the *Roto-Rooter* factors as applied in *McGill*, the most relevant would be relatedness of the goods and services, and likely degree of purchaser care. First, the service provided by Mormon Match is just that: an online forum and dating site tailored towards those involved in the Mormon Church. Intellectual Reserve, by way of the Mormon Church, provides no such service or product to the members of the Mormon congregation. In fact, the Mormon Church's products are its teachings, philosophies, doctrines, which it shares with its congregation and preaches to its believers. The difference between the two products is great, with this factor weighing heavily in favor of Eller's use being permitted. Because there is no similarity at all between the products, current and potential consumers are not likely to be confused as to the source of Eller's dating service being the Mormon Church or Intellectual Reserve.

Additionally, the degree of purchaser care weighs in favor of Eller. It is likely that those individuals using Eller's dating website are devoted members of the Mormon Church. They are likely to know that the Mormon Church is not officially affiliated with Eller's dating website; Intellectual Reserve has provided no evidence of actual confusion. Intellectual Reserve has made bare assertions that Eller's website is likely to cause confusion among prospective customers.¹¹⁰

V. FUTURE IMPLICATIONS

Although *Eller v. Intellectual Reserve, Inc.* settled, this is not the end of religious organizations asserting their right to certain trademarks and disputing the use of these trademarks. This litigation is particularly relevant among the relatively recently established faiths, such as the Mormon Church and Scientology¹¹¹, as

110. *Eller v. Intellectual Reserve*, No. 14 CV 00914 (S.D. Tex. May 12, 2014), counterclaims at 77, (where Intellectual Reserve does not refute claims that *dateamormon.com* contains the word "Mormon" and simply alleges that such fact causes confusion or is an infringement of their trademark).

111. *See Church of Scientology Intern. V. Elmira Mission of the Church of Scientology*, 794 F.2d 38 (2d Cir. 1986) (litigation concerning the Church of Scientology's asserted trademark in the mark SCIENTOLOGY).

opposed to religions, such as the Judeo-Christian religions, which pre-date the founding of America. *Eller*'s significance, had it reached the trial stage, could have helped to shape and determine the limitations of religion and trademark. The Mormon Church has over 15,000,000 members.¹¹² Allowing the Mormon Church the *exclusive* right to use the MORMON marks in conjunction with goods and services limits access to those who practice the religion and wish to use the mark in connection with their goods and services. Additionally, this potential exclusivity would remove use of the mark from not only competitors, but also from those who have the desire to market products that are in alignment with the Mormon Church's doctrines. An *Eller* decision could have determined whether religious organizations may have the exclusive right to trademark something as unremarkable as a colloquialism (i.e. "Mormon" to describe the beliefs of those in the Church of Jesus Christ of Latter-day Saints).

Eller exemplifies the limitations that could be imposed on a wide number of individuals if any sizeable religious organization is given the opportunity to trademark such colloquialisms. If this right were given, it could potentially lead to the exploitation of the licensing, and lead to loyalists of the Church being exploited or otherwise completely unable to use the name to promote their products that are touting the ideals of the religion. Why should religious organizations be entitled to the *exclusive* use of the name of the religion when there are other who may want to use the name in connection with their goods and services in a non-reputation harming way? There are other individuals and corporations, such as Jonathan Eller who have a need to use the names of such religions in a legitimate, non-disparaging trademark manner. Such individuals should not have the constant threat of litigation hanging over their heads. Some critics have noted that entitling a religious organization to the exclusive trademark rights creates a sort of monopoly, seemingly in direct contradiction to trademark law.¹¹³ If Intellectual-

112. Church of Jesus Christ of Latter-day Saints, Statistical Report, 2013, <https://www.lds.org/general-conference/2014/04/statistical-report-2013> (last visited July 10, 2014).

113. Russell, *supra* note 81, at 708. Russell notes that customer surveys are often employed in trademark infringement cases, and that if members of the rel-

al Reserve is entitled to exclusive trademark rights, this would only lead to a further perpetuation of this monopoly and seemingly render many of the Lanham Act's protections useless. Such religious marks should only be protected if they truly deserve to be protected under the law, and the courts must be compelled to apply the same standards to non-secular litigants as secular litigants.

VI. CONCLUSION

Trademark enthusiasts and religious leaders alike were hoping that *Eller* would help in setting the outer boundaries of trademark *vis - a - vis* religion. However, due to the case settling, interested parties will have to speculate as to what the result may have been as they wait for another case ripe for the issue. Based on an examination of the relevant precedent, it seems as though Intellectual Reserve would not have prevailed in its counterclaims against Eller, and Eller would have been allowed to continue using the marks in connection with his online dating service.

Jenna DiJohn*

evant public were administered surveys regarding the significance of the plaintiff's purported trademark, it seems "unlikely" that the majority would answer that it was the religious organization itself. *Id.* Russell notes that the court in *McGill* created a monopoly that is expressly the type proscribed by the Act. *Id.*

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IS PROTECTING THE DENOMINATION'S NAME IMPORTANT ENOUGH TO SEND PEOPLE TO JAIL?

BY ANDREW HANSON *

SHOULD THE SEVENTH-DAY ADVENTIST CHURCH SEEK TO PUT PEOPLE IN JAIL BECAUSE OF A NONVIOLENT RELIGIOUS BELIEF THAT INTERFERES WITH THE LEGAL RIGHTS OF THE DENOMINATION? THAT IS THE BOTTOM LINE TO THE LONG STORY OF A LITTLE, INDEPENDENT CONGREGATION AND THE GENERAL CONFERENCE ATTORNEYS.

The Creation Seventh Day Adventists broke away from the Adventist denomination in 1988, but its leaders believe that the group must continue to use the name "Seventh Day Adventist." The General Conference of Seventh-day Adventists has registered the name "Seventh-day Adventist" with the United States federal trademark authorities to try to protect the name of the denomination.

The leaders of the Creation SDAs, Walter "Chick" McGill and Lucan Chartier, have been ordered by Federal Judge J. Daniel Breen to stop using the name, fined \$500 each, and required to pay attorney costs to the General Conference.¹

Adventist Today interviewed Chartier a number of times over the summer via the Internet. He stated that the two men expected to be jailed and would go to jail because of their religious beliefs. There was a federal bench warrant out for their arrest, and the San Bernardino County (California) Sheriff took McGill into custody July 13; he served 30 days in the county jail. Chartier turned himself in to the Redlands (California) police late in July and served 10 days before he was released on August 9.

Adventist Today was not able to discover the particulars of the releases of these men. There are several possibilities. Maybe the federal judge in Tennessee decided that they had been punished sufficiently. Maybe the General Conference lawyers communicated with the federal judge and indicated a wish for leniency. Maybe the Federal Department of Justice decided that it

was a waste of money to keep paying San Bernardino County for their incarceration in view of government budget woes and cases of greater priority to American citizens. Maybe the medical staff at the jail were concerned about the fact that McGill went on a liquid-only "fast" and dropped from 170 pounds to 153 pounds. Maybe it just slipped through the bureaucratic cracks. Reporters at the *San Bernardino Sun* and *Riverside Press-Enterprise* have given no explanation.

Defending the Seventh-day Adventist Name

The Adventist denomination does have the legal right to protect its name from misuse by groups that are not part of the organization. At times, independent ministries have done things that are embarrassing to the entire denomination. One only needs to mention "Waco" to illustrate that reality.

On the other hand, most Adventists think of their faith in terms of the larger movement, not legal definitions and bureaucratic lines. We have about 14 million members, but we have twice that many adherents who identify with the movement. Do we want a narrow definition of our identity that trims and throws away the margins? Or is it better to take a broad view and welcome all who are interested, despite the wide range of views and sometimes weird causes and personalities?

Do church members and pastors think that this is an appropriate way for the denomination to deal with splinter

groups? Do they believe that this is a good use of church resources? Is there a Bible basis for enforcement efforts that go so far as to put people in jail? Protecting the denomination's name is a good idea, but how far is too far in accomplishing this goal?

About the Creation SDA Group

The little congregation led by McGill is located in the small town of Guys, Tennessee. The group operates free clinics in two places in Uganda and has members scattered in various other countries. The name "Creation Seventh Day Adventist" is based on what they believe is divine revelation received by Danny Smith and McGill. It was organized as an independent religious association at a meeting held in Plant City, Florida.

THIS CASE RAISES IMPORTANT ISSUES ABOUT THE RESPONSIBLE USE OF LITIGATION ... [AND] THE ISSUE OF RELIGIOUS FREEDOM WITHIN THE ADVENTIST BODY OF BELIEVERS. HOW MUCH VARIATION CAN OR SHOULD BE TOLERATED?

The Creation SDAs believe that the name "Seventh-day Adventist" was given by God to describe the Adventist faith in general and that, as a result, those who accept the key beliefs must use the name in identifying themselves and their organizations. They consider this to be a matter of conscience equivalent to denying or affirming the name "Christian." They base this on several quotes from Ellen G. White regarding the adoption and use of the name being divinely commissioned.

The group holds to a number of key Adventist doctrines, including the observance of the seventh-day Sabbath, the imminent Second Coming of Christ, the investigative judgment, and avoiding unclean meat. While differing from contemporary Adventist theology, their doctrines regarding religious accountability, the Trinity, and victory over all known sin were accepted by many early Adventists.

The Creation SDAs reject the doctrine of the Trinity as an extra-biblical error. They believe that the Father and Son are

two distinct and separate beings and that each may be referred to by the Hebrew term "El," usually translated as "God" in the Old Testament, or collectively by the plural term "Elohim," also translated as "God." They reject the idea of the Holy Spirit as a person in the same sense as the Father and Son, believing it to be the shared essence, power, characteristics, presence, and life of those two.

The group also believes in a complete separation of church and state, rejecting the idea that government agencies possess any authority to intrude on religious activities or groups. They hold strict views on church membership, claiming that once an individual has come into unity with Christ, unity with "His Church" (meaning their group) will be the natural result, with one not being valid while rejecting the other.

The Creation SDAs observe new moons monthly during the conjunction phase of the lunar cycle. Also referred to in their writings as the "New Moon Festival of Humility," it is the day on which they partake of the communion meal, foot washing, etc. They observe new moons in the way they observe weekly Sabbaths, in that secular work and trade are prohibited.

How Did This Conflict Get Started?

Believe it or not, the struggle over the Seventh-day Adventist name began in Hawaii with a different group, the Seventh-day Adventist Congregational Church of Kona. The *Los Angeles Times* described the first exhibit in this story as "only a 4-foot-by-8-foot sheet of plywood with hand-painted lettering on a rainbow background. The board hangs in Kona, Hawaii, outside a small rented hall where a few souls quietly worship God each Saturday morning. But the sign contains a forbidden name, and a legal battle over its use has stirred a tsunami of church reaction on the mainland. The case is now pending in the U.S. 9th Circuit Court of Appeals in San Francisco."²

The article quoted "a defendant in the unusual lawsuit" who described it as "a Goliath vs. David situation" and noted that it "pits the [then] 5.5-million-member Seventh-day Adventist Church against an 11-member splinter congregation." It also quoted Lily Anne Deniz, a member of the group: "The real issue is forcing us to change our name, not allowing *any* use of the words 'Seventh-day Adventist' because it is a registered trade name."³

The Kona group started in 1980 when John Marik, an intern pastor in the Hawaii Conference of Seventh-day Adventists, "began relating 'dreams and visions,' which he said came from God."⁴ The following July, Marik was fired by the conference.

“He and his mother, wife and daughter, along with a handful of followers, formed a separate congregation and rented a \$765-a-month suite on the second floor of a corrugated metal industrial building near Kailua Bay.”⁵

After Marik’s firing the denomination’s attorneys registered the words “Seventh-day Adventist” with the U. S. government as a trade name. Denominational officials issued repeated warnings to Marik to stop using the name and finally filed suit on April 9, 1987, to enforce the denomination’s legal rights. Marik, who had no legal training, filed a document in self-defense.⁶

Marik’s congregation did not secure legal counsel until after the Federal District Court of Hawaii handed down a judgment and injunction against it on Dec. 8, 1987, “prohibiting the defendants [the 11-member church and their pastor, John Marik] from using the name ‘Seventh-day Adventist’ and enjoining them to remove the sign and hand over to Federal agents all of their personal books, magazines, and other property that contained the name ‘Seventh-day Adventist.’”⁷

General Conference attorneys tried to reach a compromise with Marik, suggesting that his church could use either “Seventh-day” or “Adventist” as part of its name, but not both. A General Conference attorney wrote to Marik, “We would recommend and will favorably consider your using, for example, the name ‘Seventh-day Congregational Church.’” Marik refused.

In May 1988, the court entered an order for Marik’s arrest. Marik was arrested, and while out on bail he became a fugitive. Then the court issued a warrant for his arrest on contempt charges and levied a \$500-a-day fine against the congregation. Marik hid for more than a year.

With the passing of time, Marik apparently became careless. He would occasionally speak at some small Adventist gathering. It is rumored that a local pastor employed by the denomination turned him in. On Friday morning, Dec. 16, 1989, federal marshals entered the home where he was living at the time in Yucca Valley, California, and placed him under arrest. His bond was set at \$25,000.

Apparently frightened at the possibility of again going to prison, Marik contacted the Hawaii attorney representing the General Conference of Seventh-day Adventists and said he would sign anything. He was given a settlement agreement, which he signed. Evidently it was not reviewed by an attorney representing him.

It is important not to miss a key fact in this complicated case: the General Conference did not win the case or establish a legal precedent. They settled for a signature on an out-of-court

agreement. On Dec. 5, 1991, the *Adventist Review* announced the end of the Hawaii case.

History of Related Litigation

A significant amount of litigation has piled up since the Marik case. A quick summary includes the following:

1988—The General Conference of Seventh-day Adventists is challenged by the Bashan Group in Missouri, the Salem Association in South Carolina, and the Mountaindale Association in New York. These groups filed an *amicus curiae* brief in the United States Court of Appeals for the Ninth Circuit.

1989—Due to the challenges noted in the paragraph above, the judgment against the Kona group was reversed and the case was remanded to the district court for further proceedings.

1991—The General Conference attorneys brought a lawsuit against Seventh-day Adventist Kinship International, Inc., an organization of gay and lesbian Adventists. The General Conference lost the case. It was ruled that “kinship” refers to a social network, not a worship group.

1993—W.L. Perry and Max A. Corbett, Adventist attorneys (not representing the denomination), argued against the General Conference’s trademark. Perry filed a petition for a hearing to take place in Virginia, and leaders of some Davidian Adventist groups attended as well as representatives of the Seventh-day Adventist Reform Movement, a separate denomination formed in Europe in the aftermath of World War I when leaders of the Adventist Church there moved away from the historic peace-church position taken when the denomination was founded in the early 1860s.

1996—A decision on the Perry-Corbett appeal was rendered in February. Two of the three judges voted against cancellation of the trademark, while one sided with the Perry-Corbett appeal. On December 16, the General Conference won the case.

1999—The General Conference threatened legal action against the Eternal Gospel SDA Church in West Palm Beach, Fla., for using the abbreviation “SDA.”

Events in 2012

On Apr. 5, 2012, a decision was rendered in the case against the Creation SDAs that began in 2008 when McGill was sued by the General Conference. The court “held that defendant’s ‘Creation Seventh Day and Adventist Church’ infringed the ‘Seventh-day Adventist’ trademark owned by plaintiff,” stated the decision. “Although a trademark like that of [the General Conference] becomes incontestable five years after its registration, it could still

be challenged as generic, in which case the burden of proof lies on the challenger. ... Defendant failed to present sufficient evidence to overcome the presumption that such mark was not generic. The fact that two other small churches utilize the name does not establish that the relevant public does not associate it with the 'mother' church. In the absence of proof, the district court could not just assume that the relevant public would view the disputed term merely as a way to refer to a person who believes that the Sabbath should be celebrated on the seventh day and that the return of Jesus Christ is imminent, and not primarily as a means of reference to a member of the" denomination. McGill and Chartier were ordered by Federal Judge J. Daniel Breen to stop using the name, required to pay attorney costs to the General Conference, and fined \$500 each.⁸

AT TIMES, INDEPENDENT
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McGill and Chartier contacted *Adventist Today* and announced that they were traveling across the country, contacting independent Adventist groups as well as local churches affiliated with the denomination because "this issue has been largely kept from the Adventist constituency. The majority of members have no idea what is happening on their behalf, or that they have been included as plaintiffs. ... The issues need to be brought to the forefront and discussed, so that decided positions may be taken."

The two men expected to be jailed and said they would turn themselves in. "The victims of this policy are not simply names on a court document or words on a screen," Chartier said. "They are real people with real faces. We want people to know who we are and what we stand for, so that, when they make their final decision, it will be an informed one."

"We are in the closing hours of Earth's history," Chartier said, because the Adventist denomination "is using civil power to force 'all, both small and great, rich and poor, free and bond' to either forsake the buying and selling of the three angels' messages, or to 'receive a (trade) mark in their right hand, or in their forehead,'"

equating the General Conference trademark registration with the Bible language traditionally related by Adventists to the "mark of the beast" in Revelation.

"Our hope is that men and women will take a stand and become true Adventists; true Protestants. Adventism once stood against the arbitrary authority of the church, fighting against the civil magistrate's intrusion into matters of conscience. Adventism once stood for the separation of church and state, and freedom of religion for every believer and unbeliever alike. Adventism once stood for liberty of conscience, whether the one exercising it agreed with us or not. Adventism still stands for these things in the Creation Seventh Day Adventist Church, and what we hope to find ... are those few true Adventists that remain. We are in the midst of a modern reformation, with modern persecution. It is high time for modern Protestants to stand up and be counted. That is what we hope for in visiting the brethren."

Asked why people should care about his obscure case, Chartier quotes Martin Luther King, Jr., who wrote that "Injustice anywhere is a threat to justice everywhere."⁹ He believes that the General Conference attorneys have "deceived" the federal court and that, by seeking to enforce the trademark, they have made use of "papal weaponry." He quotes Ellen White: "Force is the last resort of every false religion."¹⁰

Response by the North American Division

A statement released by the North American Division (NAD) of the General Conference of Seventh-day Adventists said the denomination was not seeking to close down McGill's group or restrict his religious liberty. It said that unauthorized use of the Adventist name "confuses the public, media, and at times our own members." When people see a congregation that uses the name Seventh-day Adventist, they assume it is affiliated with the large denomination.

"The Seventh-day Adventist Church has no interest in seeing Mr. McGill or his associates in jail, nor is the church responsible for Mr. McGill's disposition toward the court. The Seventh-day Adventist Church has neither legislative nor judicial authority in that it neither makes nor enforces the law. It grieves the church to see any person or group act in opposition of the law and be forced to suffer the penalty of their own actions. Our prayers will be with Mr. McGill."

An attorney explained to *Adventist Today* that once the federal court issues orders that direct someone (McGill, in this case) to cease and desist or to pay costs or otherwise comply, then the other litigant (the General Conference, in this case) no longer has any control over the outcome. It is no longer a case of a

disagreement between two litigants. It becomes a matter of law enforcement. When McGill refuses to obey a court order, he is breaking the law.

What McGill and Chartier engaged in last summer is sometimes called “civil disobedience.” They broke the law because they believe the law to be wrong, a violation of their religious liberty. For some observers it is a classic case of “your freedom ends where my nose begins.” McGill and Chartier have the freedom to believe in any religious beliefs they wish so long as they do not take action stepping on the freedoms of others. In this case, the General Conference believes that it has the freedom to keep the name “Seventh-day Adventist” from being used by churches that are not actually part of the organization.

Reaction of Adventist Church Members

Many Adventists may be turned off by the ultra-fundamentalist positions of these splinter groups and the legal tactics of the General Conference attorneys. Does a worldwide denomination approaching 30 million adherents need to chase small groups that are largely unknown? Is it good stewardship to spend money going to court to stop these little groups from using variations on the denomination's name?

These groups may do things that are embarrassing in local areas on occasion, such as the group that put up highway billboards in Orlando and Denver explicitly connecting the pope to “the mark of the beast.” But this litigation cannot actually stop people from doing that—nor even from including a line such as “This is the teaching of the Seventh-day Adventist Church.”

Clearly most Adventists today are not interested in that kind of publicity. It is counterproductive to the mission of the church. But how far should we go in countering this sort of thing? When do legal tactics become counterproductive to their purpose?

At a minimum, we must consider the issue of religious freedom in the contemporary context of our church. There is also reason to question the value of the money spent in 32 years of litigation and related legal work. *Adventist Today* has tried unsuccessfully to clarify how much money has been spent on this project.

Clearly the denomination has a legal right to protect its name from misuse and fraud. Perhaps it has a moral duty to seek to prevent situations in which the name may be used for dishonest purposes in fundraising or investment scams. Who makes the decisions about when moral duty prevails and when compassion and the forgiveness taught by Jesus is the priority? For example, is there a policy that requires a vote at an Annual Council before litigation of this kind is filed? It is unlikely that the General Conference attorneys act independently on these

matters. They, like all lawyers, represent a client and cannot be both client and attorney. Who is the client in these cases? Is it the denomination as a whole? The delegates at a General Conference Session? The members of the General Conference executive committee? How small is the group that makes these decisions?

The New Testament admonishes the followers of Jesus that it is inappropriate for believers to go to court against each other. But the world we live in today is far more complicated, and litigation is almost impossible to avoid even for the Amish. This case raises important issues about the responsible use of litigation.

This case also dramatically raises the issue of religious freedom *within* the Adventist body of believers. How much variation can or should be tolerated? What about believers who were baptized before the statement of 27 Fundamental Beliefs (now 28) was adopted in 1980? How is orthodoxy to be determined, and who should determine it? What are the *de facto* requirements for baptism and continued membership? Do they differ here in the United States from some other countries around the world? Is the process of dropping people from church membership carefully policed? If so, by whom? Is there an appeals process for those who feel that they may be unfairly excluded?

The Adventist Church takes a strong stand advocating religious liberty. That is one of its great strengths and defining features. Is it being equally zealous in protecting the religious liberty of those within its ranks or within the broader Adventist movement? Perhaps the most difficult of these situations is when the rights of the institution—the “organized work,” as it has been traditionally labeled among Adventists—is in conflict with the rights of individuals and small groups. Given the rapid rate of church growth and the cultural diversity and global reach of the Adventist family, issues of this kind are likely to occur more and more often. ✱

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¹General Conference Corporation of Seventh-day Adventists v. McGill, case 06-1207, U.S. District Court for the Western District of Tennessee.

²Russell Chandler, “Tiny Church in Hawaii Battles Adventists Over Trademark Use,” *Los Angeles Times*, Nov. 27, 1988.

³*ibid.*

⁴*ibid.*

⁵*ibid.*

⁶*ibid.*

⁷Case 06-1207, U. S. District Court for the Western District of Tennessee.

⁸*ibid.*

⁹Letter from Birmingham Jail, April 16, 1963.

¹⁰*Seventh-day Adventist Bible Commentary*, Vol. 7, p. 956.

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ROCKY MOUNTAIN CONFERENCE
TERMINATES PECK

DAMASCUS ROAD CHURCH
CLOSES LAND DEAL

MUSLIM RELATIONS
REVOLUTIONIZED

PHYSICS MAJOR THREATENED
AT LA SIERRA UNIVERSITY

CHRISTMAS FICTION:

It's Christmas and All You Can Do Is Cry



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Inside Adventist Today

But Is It Adventist?

Five seminary students were summoned to the president's office for a conversation with Grady Smoot, Andrews University president, and John Kronke, pastor of Pioneer Memorial Church. The topic of conversation: "Home Church," a gathering of about one hundred twenty-five people, mostly Andrews University students, on Sabbath mornings in a basement in the community.

Smoot led the conversation. What we were doing could hardly be called church—people sitting on the floor, guitars instead of an organ, offering basket by the door. Home Church endangered the students' future religious lives because they wouldn't find a church like it after graduation.

But all that was secondary. The real question was, "Is it Adventist?" The fact that we worshipped on Sabbath morning, that we preached the gospel, the Sabbath, the Second Coming and other Adventist doctrines, that the leaders of Home Church were all students in the Adventist seminary planning on careers as Adventist pastors, that Ellen White was

I'm not urging the abolition of the church organization, but a recognition of its limits.

regarded as a spiritual authority, that we saw ourselves as Adventists—none of that mattered. We still weren't a Seventh-day Adventist church, so our worship was illegitimate. We must cease.

The longer I listened the more amazed I was. I had attended countless evangelistic meetings throughout my childhood. I knew that we defined our church theologically and spiritually. The definition had something to do with the testimony of Jesus and the commandments of God. Finally I asked, "Dr. Smoot, just what is your definition of a Seventh-day Adventist church?"

"A Seventh-day Adventist church is a body of believers organized according to the constitution and bylaws of a local Seventh-day Adventist Conference." Period.

It was a tidy definition. One that could be used effectively in court battles over property or use of the name. But it ruled out effective ministry to an entire group of kids from Adventist homes. It didn't fit what I had heard from evangelists. Besides, if the church organization "owns" Adventism, then who's to say the Vatican doesn't "own" Christianity?

Church structure has its place. After several years, Home Church fell apart. We were unable to sustain our ministry over time. With every form of organization there are characteristic benefits and risks. I'm not urging the abolition of the church organization, but a recognition of its limits.



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An Open Letter to Adventist Conference Officials

BILLE BURDICK

Dear Leaders:

The unfolding saga of the Damascus Road church interests me.

I wonder why administrators respond to this development so differently from the way others did to such incidents as the founding of Madison College in 1904. In an overt act of rebellion Edward A. Sutherland and his associates resigned from the faculty of the newly created Emmanuel Missionary College. Church leaders assumed he was in error. They also assumed that the school he launched was illegitimate and unworthy of support.

Ellen White took a different view of things. In spite of the fact that Sutherland established the school outside the organized work, Mrs. White not only helped him find a location for his school but also told the leading brethren that Sutherland felt called of God to this work. She said they should assist him.

Since that time scores of enterprises have proliferated under the benign umbrella of the Adventist denomination. They vary widely in focus—medical, lifestyle, educational; some have remained small, but some have grown so large that they have their own worldwide networks of institutions. All of them are considered fully Seventh-day Adventist, even though they are neither supported nor controlled by the organized church.

All of these organizations own their own property. All of them are either incorporated or are owned by incorporated foundations. In the larger of these, fully recognized Seventh-day Adventist congregations worship every Sabbath in church buildings which the institutions own. Although conference-employed ministers serve some of these, many have provided their own ministerial services.

In addition to these precedents of allowing independent incorporated units to function as Seventh-day Adventist institutions, Ellen White strongly advocated principles of local self-governance and consistently resisted the brethren's efforts to centralize power.

In spite of these precedents, however, we are witnessing an increasing emphasis on centralizing and concentrating authority and control in one central "worldwide headquarters" rather than on giving the reins of authority and control into the hands of churches in geographical locations where they are able to sustain themselves. This trend has dismayed many, including those who are not pressing for congregationalism but strongly believe in the advantages of a benign, overarching denominational structure. Astute observers have warned us that if this centralization of authority continues to increase, it might lead to a backlash of growing pressure for a complete overthrow of central authority and a strong push toward extreme congregationalism.

We have already seen indications of this backlash. Not only are churches forming using congregational styles of governance, but conference-owned churches are experiencing changes in giving patterns. More and more people give increasing percentages of their offerings to local needs as they become aware of the use of money in ways they see as wasteful, unnecessary, and wrong.

Meanwhile, when local congregations follow the example of their forefathers by forming corporations to hold and administer their own local funds and assets, they are now refused the same cooperative inclusion in the Seventh-day Adventist Church that other types of independent institutions enjoy.

I call for those in authority to take a second look at what they are doing in the light of Adventist history and in the light of the current acceptance of independent Adventist health and educational ministries. Shouldn't the organized church be big enough to allow congregations to operate as fully Seventh-day Adventist churches in the same way that it allows health ministries to operate independently of Adventist Health Systems?

There are now two Sabbath keeping churches in Damascus. I am not suggesting that the actions that formed them be repealed. What I am very strongly urging is that the conference organizations adopt a corporate mindset that would allow congregational churches to exist peacefully within the conference boundaries as fully Seventh-day Adventist, even though not under their administrative control.

Pastors of these churches should be treated not as "separated brethren" who are grudgingly recognized by conference administrators as fellow Christians, but as "tentmaker pastors." There is precedent already for this in some conferences. These self-supporting workers should be fully recognized and credentialed even though they receive financial support from sources other than conference treasuries. They should be allowed to form their own networking organization, much as ASI (Adventist Laymen's Services and Institutions) originally did. Other than in administrative and financial matters, they should be treated as full-fledged Adventist ministers. They should be invited to attend ministerial meetings and supplied with all materials that are available for conference-employed ministers.

We stand at a very important crossroad. At this moment, you conference officials still have your hands on the wheel. One route leads to increasing centralized control and equally increasing dissatisfaction on the part of local churches. This route might result in a solid, tightly knit worldwide church, but there would be an enormous price to pay in lost members, in more and more independent congregations (with no denominational affiliations and thus no stabilizing ballast outside their own church walls), and in huge amounts of lost revenue. It is doubtful that the church can actually realize this route, given the financial loss compared with the ever increasing cost of maintaining such a centralized power.

The alternate route is frightening to some, especially to those who do not trust each other to make good decisions unless they are forced to do so by some centralized authority. But this route is the one which many of us believe is the only one which will keep the Seventh-day Adventist dream alive, well, and prospering as we move into the next century.

This is the route of giving the church back to the people and letting them decide for themselves what form of governance best suits their situations and preferences. Doubtless most Adventists would continue to prefer being a part of a worldwide empire of churches and would continue giving to support that empire. Many prefer letting others do the planning and execution of the church mission while they stand by in support.

But allowing an "alternate track" of congregationally owned and operated churches for those who feel called to the mission fields on their doorsteps could be a great blessing to the church in North America. The church could increase its membership by reclaiming those who once worshipped with it but are not comfortable with authoritarian governments. Such an attitude of goodwill would greatly enhance the likelihood that the conference-owned churches could retain and add members.

For most of our denominational life we have been able to accommodate both conference and individually owned educational and medical institutions. I don't think it is revolutionary to suggest that we now extend those policies to church congregations. It's time, I believe, to recognize a new class of churches whose members and pastors enjoy Seventh-day Adventist fellowship and standing as fully as those in conference-owned churches.

Sincerely yours,

Bille Burdick

Bille Burdick lives in the Georgia-Cumberland Conference. She has been a board member of the internet's SDAnet for three years and is a regular correspondent on it. She has done extensive research in Adventist history.



Editorial: But Is It Adventist?

CONTINUED FROM PAGE 2

The Adventist Church is not merely a denomination owned by a legal entity headquartered near Washington, D.C., capital of the most powerful empire in history. It is a spiritual reality, a people who share a history, belief system, Biblical hermeneutic, common traditions and a social network. The Adventist organization is called to serve that spiritual reality, not define it.

Within the denomination there are constraints that hinder innovative ministry; those same restraints may protect congregations from the personal dysfunctions of the leadership core. Outside the denominational structure congregations may be less stable, but they are freer to develop a sharply focused ministry to reach people not well served by the denomination. Neither congregationalism

nor a strong centralized denominational structure is intrinsic to Adventism. Neither is the perfect tool for every ministry objective.

Historically Adventism has benefited from the (often unintended) synergy of independent ministries and the denominational structure. We'll do better work for our Master if we cultivate that synergy.

In the coming issues of *Adventist Today*, we will examine church organization and theology, lifestyle and worship style. We'll look at institutions and individuals. We'll hear from the left and the right. We'll publish articles by those who lean toward congregationalism and by those who are convinced a centralized hierarchy is God's ideal for the church. We'll feature analysis and firsthand testimony regarding different ways of think-

ing, living, and sharing Adventism.

We are Adventists, you and I. The definition of Adventism that matters most is the one we live. And the greatest proof that Adventists are Christians is that we show respect when we listen to each other.

I invite you to be part of the discussion. Write us with your vision of the church, your report on what it looks like in your congregation. Share with others through the pages of *Adventist Today* the very best of your spiritual life.

But don't substitute words for action. Don't wait around for permission. Don't sit and wring your hands. Get out of your rocking chair; ditch the remote and demonstrate your answer to the question, "But is it Adventist?" Show your neighbors something good.

John McLarty, Editor

Christian Record Services Ends Ministry to Deaf

CONTINUED FROM BACK

together in one operation. The blind cannot read the signs of the deaf nor the deaf hear the voices of the blind. But they had expected the deaf department and its services would be transferred to another area of the church, as was recommended in a General Conference Taskforce Report released in December, 1996.

CRS began work for the deaf in 1980. While funding for the blind work comes mostly from the non-Adventist public, an adequate source has never been found for the deaf department. (The annual budget for the blind is over 4.5 million dollars; for the deaf, approximately \$150,000, of which \$60,000 came from the NAD.)

In all but one year since 1980, the deaf work has run a deficit which was made up by subsidies from the blind work of CRS and from the NAD. Because of internal financial pressures, CRS asked the NAD to increase its subsidy for the deaf work of CRS. When the NAD declined, CRS voted to end its deaf work.

The NAD had proposed redirecting its annual subsidy to CRS to local groups involved in deaf ministry, but deaf advocates argued a continent-wide organization serving the deaf would be better than a grant program. They proposed forming a new organization under NAD auspices to expand the deaf work previously done by CRS.

A committee appointed at the November 24 meeting has begun meeting via the Internet to create a proposal for an organization whose board will have a majority of deaf members. The NAD is expected to consider the proposal sometime in 1998.

The need for this kind of ministry arises out of the deaf experience. The average profoundly deaf person who became deaf before learning to speak reads at only a grade 4-5 reading level. Many deaf need the Easy English publications that CRS produced. The main language of most profoundly deaf is Sign Language, so the deaf need many video productions in their language.

The deaf world has its own culture, clubs, sports organizations and even churches. The deaf are hard to find, and hearing people can seldom, if ever, truly become part of the "Deaf World." Some feel that the work for the deaf is the most difficult and complicated the Adventist church faces because they live as subgroups within other cultures. For every "hard group," whether Native American, Muslim or Hindu, there is within that group an even more difficult-to-reach subgroup. Even if deaf people could be found and invited to church, who would interpret for them?

There are only about 650 known deaf Adventists in the U.S., 20 in Canada, and 2000 worldwide. The estimated global population of deaf is 50 million; they use some 75 different sign languages.

Christian Record Services began in 1899 as The Christian Record Braille Foundation. It takes its name from its magazine for the blind, *The Christian Record*, the oldest continuously published magazine for the blind.

JOHN BLAKE PASTORS THE ONOWAY, ALBERTA, SEVENTH-DAY ADVENTIST CHURCH AND IS COORDINATOR OF ADVENTIST DEAF MINISTRY IN CANADA.

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

PHILANTHROPIST.COM, INC.

Petitioner,

v.

GENERAL CONFERENCE CORPORATION
OF SEVENTH-DAY ADVENTISTS

Respondent.

Cancellation No. 92065178 (parent)
Cancellation No. 92065255

Mark: ADVENTIST

PETITIONER PHILANTHROPIST.COM, INC.'S SIXTH NOTICE OF RELIANCE

Pursuant to 37 C.F.R. § 2.122 and Chapter 700 of the TBMP, Petitioner intends to rely on the documents, Internet materials, and printed publications submitted through these Notices of Reliance in support of its Petition for Cancellation.

Exhibit 12: True and correct print outs of two peer-reviewed, published law review articles relevant to the genericness of religious names and the dangers of monopolizing the name of a belief system. Specifically, Exhibit 12 contains the following articles:

- N. Cameron Russell, *Allocation of New Top-Level Domain Names and the Effect Upon Religious Freedom*, 12 J. MARSHALL REV. INTELL. PROP. L. 697 (2013); and
- Jenna DiJohn, *Examining the Outer-Limits of Trademark Law in the Religious Context and Potential Implicit Bias for Non-Secular Litigants: Eller v. Intellectual Reserve, Inc.*, 25 DEPAUL J. ART TECH. & INTELL. PROP. L. 209 (2014-2015).

Exhibit 13: True and correct copies of printed publications from Respondent's own magazine, *Adventist Today*. *Adventist Today* is a publicly available publication in general circulation. The

articles contained in Exhibit 13 are relevant to show the dangers of allowing Respondent to maintain a monopoly over the generic term “Adventist” for the goods and services challenged in the Petition for Cancellation, and the history of usage of the generic term “Adventist” as referring to a broader genus of goods and services than those encompassed solely by Respondent. The articles are also relevant to revealing the position of many within Respondent’s own organization that Respondent should not own or enforce “Adventist” as a trademark. Specifically, Exhibit 13 contains the following articles:

- Andrew Hanson, *Is Protecting the Denomination’s Name Important Enough to Send People to Jail?*, pp. 19 – 23, ADVENTIST TODAY (Nov. – Dec. 2012 issue).
- John McLarry, *But Is It Adventist?*, Editorial, pp. 2 and 22, ADVENTIST TODAY (Nov. – Dec. 1997 issue).
- Bille Burdick, *An Open Letter to Adventist Conference Officials*, pp. 19 – 20, ADVENTIST TODAY (Nov. – Dec. 1997 issue).

Dated: December 23, 2019

BARTON GILMAN LLP



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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of Petitioner's Sixth Notice of Reliance was served upon counsel of record pursuant to the Federal Rules of Civil Procedure via email on December 23, 2019 as follows:

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Dated: December 23, 2019

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