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

Proceeding	92065178
Party	Plaintiff Philanthropist.com, Inc.
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Attachments	Opp to MTD Adventist 92065178.pdf(635365 bytes )

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PHILANTHROPIST.COM, INC. :  
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           Petitioner, :       Cancellation No. 92065178  
 :       Registration No. 1176153  
 :  
           v. :       Mark: ADVENTIST  
 :  
GENERAL CONFERENCE CORPORATION :  
 :  
OF SEVENTH-DAY ADVENTISTS :  
 :  
           Registrant. :  
 :  
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**OPPOSITION TO REGISTRANT’S MOTION TO DISMISS**

PHILANTHROPIST.COM, INC. (“Petitioner”) responds to and respectfully opposes the Motion to Dismiss submitted by THE GENERAL CONFERENCE CORPORATION OF SEVENTH-DAY ADVENTISTS (“Registrant”). Registrant has based its motion on claims that: (a) Petitioner lacks standing to bring this suit; and (b) Petitioner failed to state a claim for which relief can be granted. Petitioner addresses and refutes each allegation below.

**I. OPPOSER HAS STANDING IN THIS MATTER**

Any person who believes that he would be damaged by the registration of a mark upon the principal register has standing to challenge that mark in the Patent and Trademark Office. 15 U.S.C. § 1063(a); Trademark Act § 14. A petitioner must also satisfy two judicially-created requirements in order to have standing; namely, that the petitioner has a "real interest" in the proceeding, and that petitioner has a "reasonable" basis for his belief of damage. *See* Guess? IP

Holder L.P. v. Knowlux LLC, 116 USPQ2d 2018 (TTAB 2015); Ritchie v. Simpson, 17 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999).

Here, Registrant attacks Petitioner's standing by attempting to characterize Petitioner as a "cybersquatter" and a "pirate." These accusations are demonstrably false, reckless, and not well-taken. The substantive facts relating to Petitioner's and Registrant's respective business activities, however, are not the proper subject of a motion to dismiss and are not relevant to whether or not Petitioner has standing.

It is an acknowledged fact that Petitioner owns ADVENTIST.COM and that Registrant has taken active steps to divest Petitioner of this domain because of Registrant's ADVENTIST registration. *General Conference Corporation of Seventh-day Adventists v. Philanthropist.com* (adventist.com), FA161200-1706357. Registrant argues that Petitioner has lost its standing in this matter because the UDRP proceeding cited above has recently been resolved in Petitioner's favor. Registrant's assertion is misguided. While the existence of the UDRP proceeding certainly supported Petitioner's standing, Petitioner's standing was not dependent upon it. Rather, Petitioner's standing is based on its ownership of and real commercial interest in the word ADVENTIST as it appears in ADVENTIST.COM. If anything, the UDRP Panel's affirmation of Petitioner's ownership rights in ADVENTIST.COM strengthen, rather than weaken, Petitioner's standing.

Further, while Petitioner was successful in defeating Registrant's initial attempt to seize ADVENTIST.COM, there is certainly no guarantee that Petitioner's registered domain will remain free from future challenges by Registrant. To the contrary, Registrant's long history of overzealously enforcing what it believes to be its marks is well-documented and chilling, indicating that the battle to protect Petitioner's legitimate interests from Registrant is, in all

likelihood, far from over. *See. e.g.*, Andrew Hanson, “Adventist Denomination Again Goes to Court to Force Congregation to Stop Using Name,” ADVENTIST TODAY (Aug. 14, 2015), available at: <http://atoday.org/adventist-denomination-again-goes-to-court-to-force-congregation-to-stop-using-name/>; Elizabeth Lechleitner, “Trademark Infringement Case Sees North American Pastor Imprisoned,” ADVENTIST NEWS NETWORK (Jul. 30, 2012), available at: <https://news.adventist.org/en/all-news/news/go/2012-07-30/trademark-infringement-case-sees-north-american-pastor-imprisoned/>; AT News Team, “Second Man Arrested in Trademark Battle over the Name ‘Seventh-day Adventist,’” ADVENTIST TODAY (Aug. 2, 2012), available at: <http://atoday.org/second-man-arrested-in-trademark-battle-over-the-name-seventh-day-adventist/>; Michael Hirsley, “Adventist Suit Won by Gay Group,” CHICAGO TRIBUNE (Nov. 1, 1991), available at: [http://articles.chicagotribune.com/1991-11-01/news/9104080192\\_1\\_seventh-day-disfellowship-trademark-protection](http://articles.chicagotribune.com/1991-11-01/news/9104080192_1_seventh-day-disfellowship-trademark-protection); Russell Chandler, “Tiny Church in Hawaii Battles Adventists Over Trademark Use,” LOS ANGELES TIMES (Nov. 27, 1988), available at: [http://articles.latimes.com/1988-11-27/news/mn-1068\\_1\\_adventist-church](http://articles.latimes.com/1988-11-27/news/mn-1068_1_adventist-church). In light of Registrant’s record of aggressive litigiousness, Petitioner’s concern over the possibility of additional future attacks on ADVENTIST.COM based on Registrant’s ADVENTIST registration is more than reasonable.

Notably, there is no requirement that actual damage be pleaded or proved in order to establish standing or to prevail in a cancellation proceeding. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943 (Fed. Cir. 2000). As such, the fact that Petitioner recently won the parallel UDRP dispute initiated by Registrant does not affect or eliminate its standing. Even if there were a damage requirement, however, Petitioner can easily demonstrate that it suffered actual harm by having to defend itself in an expensive and time-consuming UDRP proceeding.

Through its established proprietary rights in ADVENTIST.COM, and because of Registrant's tangible efforts to interfere with those rights, Petitioner has demonstrated a real personal interest in the proceeding and a reasonable basis to believe that it has been, and is likely to continue to be, damaged by Registrant's registration. Based on the definitions of standing and damages as set forth in the U.S.C. and Trademark Act, Petitioner has standing to bring the instant cancellation.

## **II. PETITIONER'S COMPLAINTS OF GENERICNESS AND FRAUD ON THE USPTO ARE VALID GROUNDS TO CONTEST REGISTRANT'S REGISTRATION**

Registrant is incorrect in asserting that its incontestability with respect to its registration renders it immune to challenge. Incontestability shields a registrant from certain challenges to the validity of a mark. It does not, however, imbue the registration with a complete buffer against attack.

Registrations are subject to cancellation at any time based on genericness, functionality, and fraud on the USPTO, among other claims. 15 U.S.C. § 1064 (a petition to cancel an incontestable registration may be filed *whenever* the registered mark has become generic for the identified goods or services, is functional, and/or when the registration was asserted fraudulently); *see also* Caymus Vineyards v. Caymus Medical, Inc., 107 USPQ2d 1519 (TTAB 2013); Montecash LLC v. Anzar Enterprises, Inc., 95 USPQ2d 1060 (TTAB 2010); Saint-Gobain Abrasives, Inc. v. Unova Industrial Automation Systems, Inc., 66 USPQ2d 1355 (TTAB 2003).

Whether a petitioner can prove its allegations is not a matter to be determined upon a motion to dismiss. Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc., 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993). Discovery has not yet been exchanged,

initial disclosures have not been served, and neither party has had the opportunity to conduct necessary investigations into the underlying facts. In spite of the early stage of this proceeding, however, it is evident that Petitioner's petition contains more than enough facts to state a claim to relief that is "plausible on its face." *Ashcroft v. Iqbal*, 556 U.S. 662, 129 S. Ct. 1937, 1949 (2009), *quoting* *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007). *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007).

Petitioner bases the instant petition on two grounds: namely, that: (a) Registrant's mark is generic pursuant to Trademark Act § 14(3); and (b) Petitioner wrongfully acquired its registration through fraud on the USPTO in contravention of Trademark Act § 14(3) and *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009).<sup>1</sup> The petition contains sufficient factual matter to state a claim to relief that is plausible on its face. TBMP § 503.02; *see also* *Doyle v. Al Johnson's Swedish Restaurant & Butik Inc.*, 101 USPQ2d 1780 (TTAB 2012); *Corporacion Habanos SA v. Rodriguez*, 99 USPQ2d 1873, 1874 (TTAB 2011); *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007); *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998) (for purposes of determining a motion to dismiss for failure to state a claim upon which relief can be granted, a complaint need only allege such facts as would, if proved, establish that the plaintiff is entitled to the relief sought).

In particular, on pages 2-6 of its Petition for Cancellation, Petitioner specifically alleges the following well-pleaded factual matter:

- **ADVENTIST is a generic dictionary term referring to various groups that hold in common a belief in the second coming, or "advent," of Jesus Christ.**

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<sup>1</sup> Petitioner also referenced the improper descriptiveness of Registrant's mark in its petition, but, contrary to Registrant's assertion, did not include descriptiveness among its grounds for cancellation on the ESTTA cover sheet. Petitioner will stipulate that, based on the incontestability of Registrant's mark, a descriptiveness claim is not part of the petition.

- **The etymology of the term ADVENTIST dates back to 1831 and originates from the Latin word ADVENTUS, which was applied by the Christian church to the coming of the church's savior, both the first or the anticipated second.**
- **The first use of the term ADVENTIST applied to members of millenarian sects, especially and originally the Millerites. Later denominations of Adventists include the Evangelical Adventists, the Advent Christians, the Primitive Advent Christian Church, the Davidian Seventh-day Adventist Association, the Seventh-day Adventists, the Seventh Day Adventist Reform Movement, the True and Free Adventists, the Creation Seventh-Day Adventists, and the United Sabbath-Day Adventist Church.**
- **Registrant knew at the time that it applied for the challenged registration that the word ADVENTIST was generic, non-distinctive, and was used to refer to any of a large number of individuals, entities, organizations, and groups.**
- **Registrant filed its application with the USPTO despite its knowledge that it was not the exclusive owner or user of the term ADVENTIST, in order to acquire and enforce a wrongful and harmful monopoly over a generic word and to control the practice of an entire religion.**
- **Registrant has demonstrated a pattern of trademark overreaching and misuse with regard to generic words and phrases. Other terms Registrant claims to exclusively own include: BIBLE STORY; BREATHE-FREE; CYCLE OF LIFE; DIALOGUE; EVIDENCE; FAMILY BIBLE STORY; I LOVE BEING FREE FROM SMOKING; IT IS WRITTEN; LIBERTY; MINISTRY; POWERPOINTS; and QUIT NOW!**

These allegations are more than sufficient to allege both fraud and genericness with particularity, thus meeting Petitioner's burden.

WHEREFORE, Petitioner respectfully requests that the Board deny Registrant's Motion to Dismiss and allow this cancellation proceeding to continue.

Dated: March 8, 2017

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ATTORNEY FOR PETITIONER



CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing document has been served upon counsel for Registrant by e-mail this 8<sup>th</sup> day of March, 2017.

A handwritten signature in black ink that reads "Eve Brown". The signature is written in a cursive style with a horizontal line underneath it.

Eve J. Brown