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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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Philanthropist.com, Inc.,	)	
	)	
Petitioner,	)	
	)	
v.	)	Cancellation No. 92065178 (Parent)
	)	Cancellation No. 92065255
	)	
The General Conference Corporation	)	
of Seventh-Day Adventists,	)	
	)	
Registrant.	)	

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**PETITIONER'S TRIAL BRIEF**

## TABLE OF CONTENTS

I.	INTRODUCTION .....	6
II.	FACTS .....	7
a.	Adventism and Seventh-Day Adventism .....	7
b.	GCCSDA and Adventist Trademarks.....	9
c.	Petitioner and Adventist.com .....	11
III.	RECORD.....	12
a.	Petitioner’s Record (36-46 TTABVUE).....	12
b.	GCCSDA’s Record (47-61 TTABVUE).....	13
c.	Petitioner’s Rebuttal Record (70-75 TTABVUE).....	14
IV.	ARGUMENT .....	14
a.	GCCSDA is not the source of the religion of Adventism, nor is it the single source of Adventism or its observance or services. ....	14
b.	No term other than “Adventist” can be used to identify a type of Adventist including a “Seventh-Day Adventist.” .....	15
c.	“Adventist” generally refers to the broad category of followers of Adventism, and not to members of any specific church and/or denomination.....	20
d.	GCCSDA’s survey evidence is flawed, and even if accepted as pertinent supports Petitioner and a finding of genericness.....	25
e.	Multiple Courts and the Board have found that Adventist is the generic name of the category of religion that believes in the nearness of the second coming of Christ.....	28
f.	GCCSDA’s defenses are legally flawed, factually unsupported, and contravene well-established caselaw and trademark doctrine.....	33
g.	GCCSDA’s status as the largest Adventist denomination does not permit it to remove “Adventist” from the public domain, nor does it grant it the right to prevent others from using “Adventist.” ....	37
h.	Allowing GCCSDA to monopolize the term “Adventist” to the exclusion of the general public unfairly stifles competition contrary to the Lanham Act and the U.S. Constitution. ....	40
i.	Excluding practitioners of the Adventist faith from using “Adventist” unconstitutionally infringes upon First Amendment freedoms of speech and free exercise of religion. ....	44
j.	Liberal standing requirements benefit the public, and Petitioner possesses a personal stake and real interest in the outcome of this proceeding. ....	46
V.	CONCLUSION .....	52

**TABLE OF AUTHORITIES**

**Cases**

*Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4 (2d Cir. 1976) ..... 25, 37, 38

*Am. Online, Inc. v. AT&T Corp.*, 243 F.3d 812 (4th Cir. 2001) ..... 14, 37, 38

*BellSouth Corp. v. White Directory Publishers, Inc.*, 49 U.S.P.Q.2d 1801 (M.D.N.C. 1999) ..... 32, 37

*Christ. Science B.O.D. v. Doris Evans, et. al*, 520 A.2d 1347 (N.J. 1987) ..... 37, 38

*Colt Defense LLC v. Bushmaster Firearms, Inc.*, 486 F.3d 701, 82 U.S.P.Q.2d 1759 (1st Cir. 2007). ... 39

*Continental Airlines Inc. v. United Air Lines Inc.*, 53 U.S.P.Q.2d 1385 (T.T.A.B. 2000) ..... 19

*Estate of Biro v. Bic Corp.*, 18 U.S.P.Q.2d 1382 (T.T.A.B. 1991) ..... 47

*GCCSDA v. McGill*, 624 F.Supp.2d 883 (W.D. Tenn. 2008) ..... passim

*GCCSDA v. Perez*, 97 F.Supp.2d 1154 (S.D. Fla. 2000); ..... 9, 28, 30

*GCCSDA v. Seventh-day Adventist Kinship, Int., Inc.*, CV 87-8113 MRP (Slip Op. 1992). ... 9, 28, 30, 31

*George & Co. LLC v. Imagination Entm't Ltd.*, 575 F.3d 383 (4th Cir. 2009) ..... 13

*Gimix, Inc. v. JS & A Group, Inc.*, 699 F.2d 901 (7th Cir. 1983) ..... 19

*Golden Gate Salami Co. v. Gulf States Paper Corp.*, 332 F.2d 184, 141 U.S.P.Q. 661 (1964) ..... 46

*Hunt Masters, Inc. v. Landry's Seafood Rest., Inc.*, 240 F.3d 251 (4th Cir. 2001) ..... 35

*In re Hikari Sales USA, Inc.* 2019 WL 1453259 (T.T.A.B. 2019) ..... 39

*In re Hotels.com, L.P.*, 573 F.3d 1300 (Fed. Cir. 2009) ..... 14, 15

*In re Nordic Naturals, Inc.*, 755 F.3d 1340 (Fed. Cir. 2014) ..... 14

*In re Patent & Trademark Services Inc.*, 49 U.S.P.Q.2d 1537 (T.T.A.B. 1998) ..... 19

*J. Kohnstam, Ltd. v. Louis Marx and Co.*, 280 F.2d 437 (C.C.P.A 1960) ..... 37

*Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. 111, 59 S.Ct. 109, 83 L.Ed. 73 (1938) ..... 27

*Lipton Inds., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 U.S.P.Q. 185 (C.C.P.A. 1982) ..... 46, 47, 50

<i>Luxco, Inc. v. Consejo Reglador del Tequila, A.C.</i> , 121 U.S.P.Q.2d 1477 (T.T.A.B. 2017) .....	14
<i>McDaniel v. Mirza Ahmad Sohrab</i> , 27 N.Y.S.2d 525 (1941);.....	44
<i>Mil-Mar Shoe Co. v. Shonac Corp.</i> , 75 F.3d 1153, 37 U.S.P.Q.2d 1633 .....	19
<i>Montecash LLC v. Anzar Enterprises, Inc.</i> , 95 U.S.P.Q.2d 1060, (T.T.A.B. 2010).....	46
<i>Murphy Door Bed Co. v. Interior Sleep Systems, Inc.</i> , 874 F.2d 95 (2d Cir. 1989) .....	19
<i>New Thought Church v. Chapin</i> , 159 A.D. 723 (N.Y. App. Div. 1913) .....	18, 43
<i>NSM Resource Corp.; Huck Doll LLC v. Microsoft Corp.</i> , 113 U.S.P.Q.2d 1029 (T.T.A.B. 2014)..	46, 47
<i>OBX-Stock, Inc. v. Bicast, Inc.</i> , 558 F.3d 334 (4th Cir. 2009).....	14, 15
<i>Park 'N Fly, Inc. v. Dollar Park and Fly, Inc.</i> , 469 U.S. 189, 194, 105 S. Ct. 658 (1985) .....	15, 16, 30
<i>Prince. Van., LLC v. Frito-Lay North Am., Inc.</i> , 786 F.3d 960, 114 U.S.P.Q.2d 1827 (Fed. Cir. 2015).	14
<i>Purcell v. Summers</i> , 145 F.2d 979 (1944) .....	44
<i>Ritchie v. Simpson</i> , 170 F.3d 1092, 50 U.S.P.Q.2d 1023 (Fed. Cir. 1999).....	45, 46, 49
<i>Robert Doyle v. Al Johnson’s Swedish Rest, &amp; Butik, Inc.</i> , 101 U.S.P.Q.2d 1780 (T.T.A.B. 2012) .....	47
<i>Roux Laboratories, Inc. v. Clairol, Inc.</i> , 427 F.2d 823 (C.C.P.A 1970) .....	37
<i>Stocker v. GCCSDA</i> , 39 U.S.P.Q.2d 1385 (T.T.A.B. 1996).....	passim
<i>Tanners' Council of America, Inc. v. Scott Paper Company</i> , 185 USPQ 630 (TTAB 1975).....	34
<i>TE-TA-MA Truth Found. v. World Church of Creator</i> , 297 F.3d 662, (7th Cir. 2002).....	41, 43, 44
<i>Texas Dept. of Transpo. v. Richard Tucker</i> , Cancel. Nos. 92030882 (T.T.A.B. 2010).....	46
<i>Weiss Noodle Co. v. Golden Cracknel and Specialty Co.</i> , 290 F.2d 845 (C.C.P.A.1961) .....	37, 38
<i>Young v. AGB Corp.</i> , 152 F.3d 1377 (Fed. Cir. 1998).....	45
<b>Statutes</b>	
15 U.S.C. § 1056(a) .....	31
15 U.S.C. § 1064(3).....	5, 14, 18

**Other Authorities**

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). ..... 40

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) ..... 40, 44

**Rules**

*T.M.E.P.* § 1213 ..... 31

**Treatises**

*McCarthy on Trademarks and Unfair Competition* (5th ed.) ..... passim

**Constitutional Provisions**

*U.S. Const., amend. I* ..... 44

## I. INTRODUCTION

The Petitioner, Philanthropist.com, Inc. (“Petitioner”), hereby submits this Trial Brief in support of its consolidated Petition to Cancel Reg. Nos. 1,218,657 and 1,176,153 (“Petition”). As McCarthy explains, “[i]t is long established that the name of a product or service itself—what it is—is the very antithesis of a mark.” *McCarthy on Trademarks and Unfair Competition* § 12:1 (5th ed.) (quotations omitted) (“*McCarthy*”); *see also* 15 U.S.C. § 1064(3). “Generic names are regarded by the law as free for all to use [and] [t]hey are in the public domain.” *McCarthy* § 12:2. “To grant an exclusive right to one firm of use of the generic name of a product would be equivalent to creating a monopoly in that particular product, something that the trademark laws were never intended to accomplish.” *Id.*

Yet examples abound of the Registrant, The General Conference Corporation of Seventh-Day Adventists (“GCCSDA”), asserting that the public and other followers of Adventism cannot use the term “Adventist” without GCCSDA’s approval. GCCSDA’s overreach stretches across international trademark classes 16 (religious books and bibles), 41 (educational instructional services) (film production and distribution), and 42 (religious observances and missionary services) (healthcare and nursing services). Twisting trademark law beyond its intent and purpose, GCCSDA (a corporate entity) asserts that it is the single source of “Adventism” and that it holds the exclusive right to invoke the term “Adventist” across the important areas of religion, healthcare, education, and media.

In support of its Petition, Petitioner asserts that:

- (a) GCCSDA is not the source of the religion of Adventism, nor is it the single source of Adventism or its services;
- (b) Multiple Courts, and this Board, have found that “Adventist” is the generic name of the category of religion that believes in the nearness of the second coming of Christ;
- (c) GCCSDA’s defenses are legally flawed, factually unsupported, and contravene well-established caselaw and trademark doctrine;

- (d) Allowing GCCSDA to monopolize “Adventist” to the exclusion of the general public unfairly stifles competition contrary to the Lanham Act and the U.S. Constitution; and
- (e) Liberal standing requirements benefit the public, and Petitioner possesses a personal stake and real interest in the outcome of this proceeding.

The facts and law of this matter are straightforward, despite GCCSDA’s attempt to manufacture procedural and evidentiary objections, mischaracterize legal standards, and create self-serving rebuttal evidence. This case *is not about* GCCSDA’s membership numbers or business interests, nor does it necessitate theological or intellectual inquiry into the religion of Adventism. This case *is about* whether the term “Adventist” is generic under well-established law for—among other goods and services invoking Adventism—“Religious Observances and Missionary Services” and “Religious Books, Magazines, Pamphlets, Newsletters, Brochures, Encyclopedias, Dictionaries, Commentaries, Fliers, Bulletins, Booklets and Bibles.”

Accordingly, the sole issue before the Trademark Trial and Appeal Board (“Board”) is whether the term “Adventist” is generic concerning the goods and services set forth in U.S. Reg. Nos. 1,218,657 and 1,176,153. The Petitioner meets this burden and respectfully requests that the Board CANCEL the subject marks pursuant to Section 14(3) of the Lanham Trademark Act of 1946 (“Lanham Act”).

## **II. FACTS**

### **a. Adventism and Seventh-Day Adventism**

An “Adventist” is anyone who belongs to, or believes in the doctrines expounded by, any of various denominations which emphasize that the second coming of Christ is imminent. 38 *TTABVUE* 12 (*Ex. 4*) (*Oxford English Dictionary*). “Since the year 1840, the name ‘Adventist’ has been known to the world as designating one who believes that the second advent of the Lord Jesus Christ to this world, is near at hand.” 38 *TTABVUE* 15 (*Ex. 5*) (*Seventh-Day Adventist Yearbook of Statistics for 1889, GCCSDA Publication*); *see also* 38 *TTABVUE* 12 (*Ex. 4*) (*Oxford English Dictionary*).



“[The Seventh-Day Adventist Church’s] origins lie in the aftermath of the Great Disappointment of October 22, 1844” when it was believed and calculated that Jesus Christ would return. 71 *TTABVUE* 49 (Ex. 3)(*Melton's Encyclopedia of American Religions*). “In the aftermath of the Great Disappointment . . . Adventism was for the most part isolated from the rest of American Christianity [and] Adventism would fracture into several associations, each with its unique understanding of the meaning of the Great Disappointment.” 70 *TTABVUE* 28, 13-47 (Ex. 1)(*Adventism Confronts Modernity*). “When Christ's Second Coming did not occur as the Adventist preacher William Miller (1782-1849) had predicted, a group including [Ellen] White . . . began to gather disheartened Adventists around them.” 71 *TTABVUE* 49 (Ex. 3). “About the same time, bible study led the [Ellen White’s] group to accept the idea of a Saturday [(i.e., seventh day)] Sabbath.” *Id.* “In 1860, as those who accepted sabbatarianism and [Ellen] White’s teachings were distinguished from other Adventists, the name Seventh-Day Adventist Church was adopted.” *Id.* “The church, which originally included approximately 3,500 members in 125 congregations, was officially organized in 1863.” *Id.*

“Statistics among the Adventist groups were not easy to come by in their early years [and the] divisions and mutual suspicions among the Adventist groups didn’t make the task any easier.” 70 *TTABVUE* 55 (Ex. 2) (*William Miller and The Rise of Adventism*). To track the various Adventist groups and varying Adventist beliefs, “[t]he first Adventist census was published in 1860.” *Id.* In particular, concerning the Sabbath “365 (ministers) held to Sunday, 57 to the seventh day, with 162 not reporting.” *Id.* “[By] 1860 the seventh-day keepers represented a little more than five percent of the Adventists.” *Id.* “The balance of them, presumably, were first-day worshipers.” *Id.*

“Seventh-day Adventism [is] just one, albeit the largest and most significant by far, of the branches or denominations of Adventism.” 43 *TTABVUE* (Ex. 19) (*Stocker Decision*) (*Stocker*, 1996 WL 427638 at \*15). “The central core of beliefs of these Adventist groups is essentially the same, with

various differences over doctrinal interpretations of the nature of the millennium, the nature of man, the ministry of Christ, the return of the Jews, the Sabbath, and spiritual gifts.” *Id.*; 71 *TTABVUE* 18, 13-50 (*Ex. 3*)(*Melton’s Encyclopedia of American Religions*) (especially page 18 listing “Intrafaith Organizations,” “Sunday Adventists,” “Seventh Day Adventists,” and “Church of God Adventists” under the “Adventist Family” heading and detailing the myriad groups practicing Adventism).

“[I]n addition to the Seventh-day Adventist Church, other ‘Adventist’ denominations that have existed through the years as follows: Advent Christian Church; Church of God of the Abrahamic Faith; Church of God (Adventist); Primitive Advent Christian Church; Evangelical Adventists; and Life and Advent Union.” 43 *TTABVUE* (*Ex. 19*) (*Stocker Decision*) (1996 WL 427638 at \*22) (citing *Melton’s Encyclopedia of American Religions* as does Petitioner in this proceeding); *see also generally* 71 *TTABVUE* 13-50 (*Ex. 3*)(*Melton’s Encyclopedia of American Religions*) and 72 *TTABVUE* 13-44 (*Ex. 4*)(*Melton’s Encyclopedia of American Religions*).

**b. GCCSDA and Adventist Trademarks**

The Registrant, “GCCSDA[,] is a non-profit corporation established to hold title to the assets of the Seventh-day Adventist Church, including its trademarks.” 22 *TTABVUE* 2-3 (*GCCSDA’s Motion for Summary Judgment*). “The Seventh-day Adventist Church is a unified body governed by a General Conference made up of divisions, union conferences, and local conferences.” *Id.* “Use of the Seventh-day Adventist Church’s trademarks, including the [“Adventist”] marks which are the subject of this proceeding, is by license and/or under the control of GCCSDA.” *Id.*

Specifically, GCCSDA is the registrant for the trademark registrations which are the subject of this proceeding. *See* 15 *TTABVUE*. The subject mark U.S. Reg. No. 1,218,657 for “Adventist” covers “religious observances and missionary services” in class 42 and “educational instruction services in academics at grade school, high school, and college levels” in class 41. *See id.* The subject mark U.S.

Reg. No. 1,176,153 for “Adventist” covers “religious books, magazines, pamphlets, newsletters, brochures, encyclopedias, dictionaries, commentaries, fliers, bullets, booklets and bibles” in class 16; “establishment and administration of employee health care and benefit programs and medical insurance programs” in class 36; “film production and distribution services” in class 41; and “health care services, namely, hospital, dental, pharmaceutical, nursing home, and medical laboratory services” in class 42.” *See id.* Only “[GCCSDA’s] member entities are licensed to use the ADVENTIST mark.” *Id.*

GCCSDA actively polices public use of the terms “Adventist,” “Seventh-Day Adventist,” and “SDA” among others and vigorously asserts its trademark rights including by threatening and/or initiating litigation against other competing Adventist sects and/or followers of Adventism in the areas of and around religion, healthcare, education, and media. 22 *TTABVUE* 2-3 (*GCCSDA’s Motion for Summary Judgment*); *see also infra* section IV(c)(ii). Consequently, whether GCCSDA’s “Seventh-Day Adventist” mark is generic has been previously litigated. *See* 43 *TTABVUE* 11-51 (*Ex. 19*); *see also* *Stocker v. General Conf. Corp. of Seventh-Day Adventists*, 39 U.S.P.Q.2d 1385 (T.T.A.B. 1996); *General Conf. Corp. of Seventh-Day Adventists v. McGill*, 624 F.Supp.2d 883 (W.D. Tenn. 2008), *affirmed* 617 F.3d 402 (6th Cir. 2010); *General Conf. Corp. of Seventh-Day Adventists v. Perez*, 97 F.Supp.2d 1154 (S.D. Fla. 2000); *see also* *General Conf. Corp. of Seventh-Day Adventists v. Seventh-day Adventist Kinship, International, Inc.*, Case No. CV 87-8113 MRP (Slip Op. 1992).

With the exception of *Kinship* (which found “Seventh-Day Adventist” generic), “Seventh Day Adventist” was found protectable because (as explained by the Board in *Stocker*), “the generic term for the religion is ‘Adventist’ (or ‘Adventism’).” *See* *Stocker*, 1996 WL 427638 at \*15 (emphasis added). The *Stocker* Board held, “[a]lthough we view the term ‘Adventist’ as generic, we cannot conclude that the present record establishes that the registered mark ‘Seventh-day Adventist’ [(“Adventist” disclaimed)] is also generic.” *Id.* at 19. GCCSDA further disclaimed the term “Adventist” in U.S. Reg.

No. 1,177,185 for “Seventh-Day Adventist.” *See* 42 *TTABVUE* 40-41 (Ex. 17) (TESS record, U.S. Reg. No. 1,177,185).

**c. Petitioner and Adventist.com**

“Petitioner is a buyer and reseller of domain names [and in] June [ ] 2016 [ ] acquired the domain name <adventist.com>.” 22 *TTABVUE* 2-3 (*GCCSDA’s Motion for Summary Judgment*). “GCCSDA subsequently sent a cease and desist letter to Petitioner in November [ ] 2016 advising of Registrant’s rights in the ADVENTIST marks and requesting transfer of the domain name to Registrant.” *Id.* The cease and desist letter asserts that GCCSDA has the right to exclusively use the term “Adventist” and that its trademarks and service marks allow it “to prevent third parties from using any similar name or mark [to “Adventist”] that is likely to cause confusion, such as the domain name located at: Adventist.com.” *See* 15 *TTABVUE* 3, 14-17 (¶3)(Ex. A-B)(*Petitioner’s 2nd Amended Petition to Cancel*); 17 *TTABVUE* 3 (¶3) (*GCCSDA’s Answer*) (GCCSDA admitting it sent the cease and desist letter attached to Second Amended Petition to Cancel as *Exhibit B*). The letter further accuses Petitioner of “intentionally trading on the goodwill of [GCCSDA] by using a trademark that is confusingly similar” to the challenged marks, alleging that “[the domain name ADVENTIST.com] confuses and misdirects customers,” which “is actionable under federal law.” *See* 15 *TTABVUE* 3, 11-17; 17 *TTABVUE* 3.

GCCSDA further alleges that it can “enforce its legal rights” against Petitioner concerning “trademark infringement and dilution” and seek remedies “including, but not limited to, preliminary and permanent injunctive relief, money damages, a defendant’s profits” and “attorneys’ fees and possible treble money damages.” *See* 15 *TTABVUE* 3, 14-17; 17 *TTABVUE* 3. GCCSDA continues that it is “prepared to file a lawsuit if necessary, to protect its rights and business.” *See* 15 *TTABVUE* 3, 14-17; 17 *TTABVUE* 3. Thereafter, GCCSDA filed “a complaint with the National Arbitration Forum under the

Uniform Domain Name Resolution Procedure (“UDRP”) seeking to have the <adventist.com> domain name transferred to Registrant.” 22 TTABVUE 2-3 (*GCCSDA’s Motion for Summary Judgment*).

“Petitioner filed the original Petition for Cancellation in this case on January 13, 2017 while the UDRP proceeding was still pending.” *Id.* Though the Petitioner prevailed in the UDRP proceeding, the resolution of the UDRP proceeding does not protect Petitioner (or any purchaser of Adventist.com) from future litigation in federal court or elsewhere by GCCSDA. *Id.* As such, the specter (cost, time, result) of prospective litigation looms over and complicates the possible sale of the domain name, which is Petitioner’s core business. Notably, GCCSDA must have a valid trademark for “Adventist” to pursue trademark infringement of dilution claims against Petitioner in federal court. The instant Petition to Cancel the subject “Adventist” marks, if granted, may preclude GCCSDA from bringing suit and protect Petitioner from future litigation.

### **III. RECORD**

#### **a. Petitioner’s Record (36-46 TTABVUE)**

1. All pleadings;
2. Petitioner’s 1<sup>st</sup> Notice of Reliance, Exhibit 1 (“*Pet. ’s 1st NOR*”) (36 TTABVUE);
3. Petitioner’s 2<sup>nd</sup> Notice of Reliance, Exhibit 2 (“*Pet. ’s 2nd NOR*”) (37 TTABVUE);
4. Petitioner’s 3<sup>rd</sup> Notice of Reliance, Exhibits 3-6 (“*Pet. ’s 3rd NOR*”) (38 TTABVUE);
5. Petitioner’s 4<sup>th</sup> Notice of Reliance, Exhibits 7-9 (“*Pet. ’s 4<sup>th</sup> NOR*”) (39 TTABVUE);
6. Petitioner’s 5<sup>th</sup> Notice of Reliance, Exhibits 10-11 (“*Pet. ’s 5<sup>th</sup> NOR*”) (40 TTABVUE);
7. Petitioner’s 6<sup>th</sup> Notice of Reliance, Exhibits 12-13 (“*Pet. ’s 6<sup>th</sup> NOR*”) (41 TTABVUE);
8. Petitioner’s 7<sup>th</sup> Notice of Reliance, Exhibits 14-17 (“*Pet. ’s 7<sup>th</sup> NOR*”) (42 TTABVUE);
9. Petitioner’s 8<sup>th</sup> Notice of Reliance, Exhibits 18-20 (“*Pet. ’s 8<sup>th</sup> NOR*”) (43 TTABVUE);
10. Petitioner’s 9<sup>th</sup> Notice of Reliance, Exhibit 21 (“*Pet. ’s 9<sup>th</sup> NOR*”) (44 TTABVUE);

11. Petitioner's 10<sup>th</sup> Notice of Reliance, Exhibits 22-24 ("*Pet. 's 10<sup>th</sup> NOR*") (45 TTABVUE);
12. Petitioner's 11<sup>th</sup> Notice of Reliance, Exhibits 25-26 ("*Pet. 's 11<sup>th</sup> NOR*") (46 TTABVUE).

**b. GCCSDA's Record (47-61 TTABVUE)**

1. GCCSDA's February 6, 2020 Declaration of Testimony ("*S. Parikh Dec.*") (47 TTABVUE);
2. GCCSDA's February 18, 2020 Declaration of Testimony ("*J. Woods Dec.*") (48 TTABVUE);
3. GCCSDA's February 10, 2020 Declaration of Testimony ("*C. Whalen Dec.*") (49 TTABVUE);
4. GCCSDA's February 10, 2020 Declaration of Testimony ("*G. Reid Dec.*") (50 TTABVUE);
5. GCCSDA's February 12, 2020 Declaration of Testimony ("*T. Forde Dec.*") (51 TTABVUE);
6. GCCSDA's February 13, 2020 Declaration of Testimony ("*M. Jobe Dec.*") (52 TTABVUE);
7. GCCSDA's February 14, 2020 Declaration of Testimony ("*L. Hardy Dec.*") (53 TTABVUE);
8. GCCSDA's January 25, 2020 Declaration of Testimony ("*P. Karssen Dec.*") (54 TTABVUE);
9. GCCSDA's January 27, 2020 Declaration of Testimony ("*D. Galusha Dec.*") (55 TTABVUE);
10. GCCSDA's February 10, 2020 Declaration of Testimony ("*G. Knight Dec.*") (56 TTABVUE);
11. GCCSDA's February 18, 2020 Declaration of Testimony ("*J. Perry Dec.*") (57 TTABVUE);
12. GCCSDA's February 20, 2020 Declaration of Testimony ("*D. Trim Dec.*") (58 TTABVUE);
13. GCCSDA's February 20, 2020 Declaration of Testimony ("*B. Knott Dec.*") (59 TTABVUE);
14. GCCSDA's February 21, 2020 Declaration of Testimony ("*K. Bazil Dec.*") (60 TTABVUE);
15. GCCSDA's February 13, 2020 Deposition Testimony ("*G. Everett Depo*") (61 TTABVUE);
16. GCCSDA's Notice of Reliance, Exhibits 1-16 ("*GCCSDA's 1<sup>st</sup> NOR*") (62 TTABVUE);
17. GCCSDA's Notice of Reliance, Exhibits 17-26 ("*GCCSDA's 2<sup>nd</sup> NOR*") (63 TTABVUE);
18. GCCSDA's Notice of Reliance, Exhibits 27-44 ("*GCCSDA's 3<sup>rd</sup> NOR*") (64 TTABVUE);
19. GCCSDA's Notice of Reliance, Exhibits 45-56 ("*GCCSDA's 4<sup>th</sup> NOR*") (65 TTABVUE);
20. GCCSDA's Notice of Reliance, Exhibits 57-72 ("*GCCSDA's 5<sup>th</sup> NOR*") (66 TTABVUE);

21. GCCSDA's Notice of Reliance, Exhibits 73-80 ("GCCSDA's 6<sup>th</sup> NOR") (67 TTABVUE).

**c. Petitioner's Rebuttal Record (70-75 TTABVUE)**

1. Petitioner's Rebuttal Notice of Reliance, Exhibits 1-2 ("Pet. 's 1<sup>st</sup> NOR") (70 TTABVUE);
2. Petitioner's Rebuttal Notice of Reliance, Exhibit 3 ("Pet. 's 2<sup>nd</sup> NOR") (71 TTABVUE);
3. Petitioner's Rebuttal Notice of Reliance, Exhibit 4 ("Pet. 's 3<sup>rd</sup> NOR") (72 TTABVUE);
4. Petitioner's Rebuttal Notice of Reliance, Exhibits 5-7 ("Pet. 's 4<sup>th</sup> NOR") (73 TTABVUE);
5. Petitioner's Rebuttal Notice of Reliance, Exhibits 8-10 ("Pet. 's 5<sup>th</sup> NOR") (74 TTABVUE);
6. Petitioner's Rebuttal Notice of Reliance, Exhibits 11-14 ("Pet. 's 6<sup>th</sup> NOR") (75 TTABVUE).

**IV. ARGUMENT**

**a. GCCSDA is not the source of the religion of Adventism, nor is it the single source of Adventism or its observance or services.<sup>1</sup>**

"A generic mark describes a product in its entirety [and therefore] neither signifies the source of goods nor distinguishes the particular product from other products on the market." *George & Co. LLC v. Imagination Entm't Ltd.*, 575 F.3d 383, 394 (4th Cir. 2009). "The terms 'generic' and 'trademark' are mutually exclusive." *Id.* "A generic term cannot be registered as a trademark, for generic terms by definition are incapable of indicating source." *In re Hotels.com, L.P.*, 573 F.3d 1300, 1302 (Fed. Cir. 2009). Examples of generic terms include: "APPLE . . . for the edible fruit of the apple tree, but [it is] a trademark for computers;" "BICYCLE . . . for the two-wheeled vehicle, but [it is] a trademark [ ] for playing cards;" "DIESEL . . . for a type of engine, but [it is] a trademark for wearing apparel;" "SANDALS . . . for warm-weather footwear, but [it is] a service mark for a chain of Caribbean resort hotels;" and "SHELL . . . for the covering of an egg, the covering of a sea creature and for a part of an explosive projectile, but [it is] a trademark for petroleum products." *McCarthy* § 12:1.

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<sup>1</sup> Petitioner notes that much of the evidence of record speaks to both prongs of, and generally to, a genericness determination. The inclusion of any evidence in any particular section of this Trial Brief does not and should not preclude its consideration by the Board towards any finding or determination.

Section 14(3) of the Lanham Act provides that: “[a] petition to cancel a registration of a mark . . . [may be filed] . . . by any person who believes that he is or will be damaged[:] . . . [a]t any time if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered.” 15 U.S.C. § 1064(3). “Generic words, which are ‘the common name of a product’ or ‘the genus of which the particular product is a species’ can never be valid marks under any circumstances.” *OBX-Stock, Inc. v. Bicast, Inc.*, 558 F.3d 334, 340 (4th Cir. 2009); *see also Am. Online, Inc. v. AT&T Corp.*, 243 F.3d 812, 822 (4th Cir. 2001) (mark was generic because the evidence “d[id] not reveal that the primary significance of the term” was a single source rather than its generic meaning); *In re Nordic Naturals, Inc.*, 755 F.3d 1340, 1342 (Fed. Cir. 2014) (a generic term “cannot acquire distinctiveness and cannot be registered as a trademark”). Deciding whether a term is generic involves determining: (1) the genus of the goods or services at issue, and (2) whether the term is understood by the relevant public primarily to refer to that genus of goods or services. *See Princeton Vanguard, LLC v. Frito-Lay North America, Inc.*, 786 F.3d 960, 114 U.S.P.Q.2d 1827, 1830-31 (Fed. Cir. 2015); *Luxco, Inc. v. Consejo Reglador del Tequila, A.C.*, 121 U.S.P.Q.2d 1477, 1497 (T.T.A.B. 2017).

**b. No term other than “Adventist” can be used to identify a type of Adventist including a “Seventh-Day Adventist.”**

“Adventist” is the genus for which “Seventh-Day Adventist” is the species, and no term other than “Adventist” can be used to identify a type of “Adventist” including a “Seventh-Day Adventist.” “A term represents the genus of a good or service when no commonly used alternative effectively communicates the same functional information.” *McCarthy* § 12:23. Again, a term is generic if it is “the common name of a product” or “the genus of which the particular product is a species.”<sup>2</sup> *OBX-Stock*,

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<sup>2</sup>“To properly be called an unprotectable ‘generic name’ . . . , the designation must be the name of the same product or service which it is alleged to identify the source of.” *McCarthy* § 12:1. “A genus inquiry should focus on the goods and services description set forth in the application for registration.” *In re Hotels.com LP*, 573 F.3d at 1305-06. Importantly, “[a] generic name of goods may also be a generic name of the service of selling or designing those goods [or services.]” *McCarthy* § 12:24; *see also In re Hotels.com LP*, 573 F.3d at 1305-06. “Using this approach . . . ‘Lens’ was a generic name for retail



558 F.3d at 340; *see also Park 'N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 194, 105 S. Ct. 658 (1985).

The word “Advent” is a religious term used to refer to the arrival of Jesus Christ in Christian theology, and the anticipated future return of Jesus Christ at the core of most Christian belief systems is commonly known as the “Second Advent.” *See Stocker*, 1996 WL 427638 at \*15. The Board explained in *Stocker* that “[Adventism] is the name given to a core of beliefs, most significantly, a belief in the nearness of the second coming of Christ.” *Id.* The Board thus found that that “the generic term for the religion is ‘Adventist’ (or ‘Adventism’).” *Id.* The evidence proves the Board correct. *See e.g., supra Section II; see also generally 36-46 TTABVUE; 70-75 TTABVUE.*

As explained in GCCSDA’s own encyclopedia, “the terms ‘Adventist’ and ‘Adventism’ were coined by the Millerites [and are] most correctly employed in the framework of Millerite eschatology.” 73 TTABVUE 18 (Ex. 5) (*Seventh-Day Adventist Encyclopedia, GCCSDA Publication*). The term “Adventist” has been commonly used to refer to myriad followers of Adventism since the 19th Century.” 37 TTABVUE 21, 3-21 (Ex. 2) (*14<sup>th</sup> Handbook of Denominations in the United States*); *see e.g., 73 TTABVUE 12-52 (Ex. 5-6) (Seventh-Day Adventist Encyclopedia); 74 TTABVUE 13-45 (Ex. 8) (The Edges of Seventh-day Adventism); 71 TTABVUE 13-50 (Ex. 3)(Melton’s Encyclopedia of American Religions); 72 TTABVUE 13-44 (Ex. 4) (Melton’s Encyclopedia of American Religions)*. Public use of the word “Adventist” to refer to a non-specific person or group that practices Adventism dates back to the Second Great Awakening, a Protestant religious revival movement that took place during the early 19<sup>th</sup> century and that led to the formation of multiple new Christian denominations, all referring to themselves generally as “Adventists.” 37 TTABVUE 21, 3-21 (Ex. 2) (*14<sup>th</sup> Handbook of Denominations*

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Internet stores services selling contacts eyewear[,] ‘Churrascos’ was a generic name of restaurant services where the specialty is churrasco style steak, ‘Log Cabin Homes’ was a generic name of log cabin home design services, [and] ‘tires tires’ was a generic name for retail tire sales services.” *McCarthy* § 12:24.

*in the United States*); see e.g., 73 TTABVUE 12-52 (Ex. 5-6) (*Seventh-Day Adventist Encyclopedia*); 74 TTABVUE 13-45 (Ex. 8) (*The Edges of Seventh-day Adventism*); 71 TTABVUE 13-50 (Ex. 3) (*Melton's Encyclopedia of American Religions*); 72 TTABVUE 13-44 (Ex. 4) (*Melton's Encyclopedia of American Religions*).

A person who observes or practices Adventism is referred to as “Adventist” regardless of whether they are, for example, the Advent Christians, the Davidian Seventh-day Adventist Association, the Seventh Day Adventist Reform Movement, the True and Free Adventists, the United Sabbath-Day Adventist Church, or the Seventh-Day Adventists. See 73 TTABVUE 12-52 (Ex. 5-6) (*Seventh-Day Adventist Encyclopedia*) (detailing that “Seventh-Day Adventists” are but one of a number of “Adventist” bodies and denominations); 74 TTABVUE 13-45 (Ex. 8) (*The Edges of Seventh-day Adventism*) (detailing the many separate Adventist movements other than the “Seventh-day Adventists”).

No term other than “Adventist” can be used to identify that “Seventh-Day Adventists” or any “Adventist” group or denomination are indeed “Adventists” and follow Adventism. See *Park 'N Fly, Inc.*, 469 U.S. at 194; *McCarthy* § 12:23 (“A term represents the genus of a good or service when “no commonly used alternative effectively communicates the same functional information.” “There is no term that adequately describes an adherent to the religion of Seventh-day Adventism, other than “Seventh-day Adventist”; the only possible alternative would be “Adventist,” and that term is too broad.” *Stocker*, 1996 WL 427638 at \*23 (Hohein, J.) (Dissent) (finding “Seventh-Day Adventist” to be generic where the majority found “Adventist” to be generic) (emphasis added). For example, “Seventh-Day” modifies and limits the broader, generic term “Adventist” so as to make clear that it is a particular sect (species) of the Adventist religion (genus). See *Stocker*, 1996 WL 427638 at \*15 (Board Majority determining that “the generic term for the religion is ‘Adventist’ (or ‘Adventism’).”

Additionally, from the “many misconceptions of Adventism [perhaps] the most common one is that all ‘Adventists’ belong to the largest individual denomination whose name includes the word ‘Adventist,’ the Seventh-Day Adventist Church (or General Conference).” 37 TTABVUE 21, 3-21 (Ex. 2) (14<sup>th</sup> Handbook of Denominations in the United States); see e.g., 73 TTABVUE 12-52 (Ex. 5-6) (Seventh-Day Adventist Encyclopedia); 74 TTABVUE 13-45 (Ex. 8)(The Edges of Seventh-Day Adventism); 71 TTABVUE 13-50 (Ex. 3) (Melton’s Encyclopedia of American Religions) and 72 TTABVUE 13-44 (Ex. 4)(Melton’s Encyclopedia of American Religions). To the extent that GCCSDA may attempt to seed doubt that the term “Adventist” is used only by “Seventh-Day Adventists” as opposed to all “Adventists,” the Executive Director of Advent Christian General Conference (“ACGC”) provides clarity. On February 26, 2020, the ACGC’s Executive Director, Steve Lawson wrote to GCCSDA’s Associate General Counsel, Jennifer Gray Woods:

After discussing your questions and the document we felt we could not sign [the declaration] on behalf of the Advent Christian General Conference because many Advent Christians do use the term ‘Adventist’ in referring to our group and it is used regularly in our history.

75 TTABVUE 13-17 (Ex. 11) (S. Lawson Email) (emphasis added); but see 75 TTABVUE 2-8 (¶28)(J. Woods Dec.) (misrepresenting ACGC/Steve Lawson letter to show and/or suggest that only “Seventh-Day Adventists” are and/or use the term “Adventist.”).

Furthermore, a corporation cannot be the single source of religious beliefs or faith. See *Stocker*, 1996 WL 427638 at \*22. Not only would that be historically inaccurate concerning GCCSDA, but it is contrary to the Constitution and the Lanham Act for a corporation (i.e., GCCSDA) to have a monopoly over a religious faith. See 15 U.S.C. § 1064(3); *New Thought Church v. Chapin*, 159 A.D. 723, 724-25 (N.Y. App. Div. 1913). Indeed, “a religion itself is neither ‘goods’ nor ‘services’ within the statutory framework of the Lanham Act.” *Stocker*, 1996 WL 427638 at \*22 (Hohein, J.) (Dissent). Thus, “a name originated for a new religion, including the adjectival form thereof, is inherently unregistrable for the

religion inasmuch as it cannot function either as a trademark for publications pertaining to the religion [(i.e., class 26)] or as a service mark for religious observances and missionary services based upon the religion [(i.e., class 42) .” *Stocker*, 1996 WL 427638 at \*22 (Hohein, J.) (Dissent).

Under no circumstances is a monopoly over the practice or observance of a religious faith the intent or purpose of the Lanham Act and U.S. trademark law. *See* 15 U.S.C. § 1064(3); *see also* *McCarthy* § 12:2 (“To grant an exclusive right to one firm [to] use of the generic name of a product would be equivalent to creating a monopoly in that particular product, [for which] trademark laws were never intended.”). It is axiomatic that “Adventist” (or “Adventism”) is generic for “Religious Observances and Missionary Services” in class 42 and “Religious Books, Magazines, Pamphlets, Newsletters, Brochures, Encyclopedias, Dictionaries, Commentaries, Fliers, Bulletins, Booklets and Bibles” in class 16, as well as for other services necessarily invoking Adventism including in class 41 (education) and (film production), and class 42 (healthcare).<sup>3</sup> Those who offer goods or services connected to the Adventist belief system are entitled to use the term “Adventist” in order to freely communicate about and/or carry out their business.

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<sup>3</sup> *Stocker* explains:

Counsel for [GCCSDA] candidly and admirably conceded at the oral hearing in this case that trademark law recognizes the existence of generic adjectives and prohibits their registration, just as it more commonly deals with generic nouns and likewise precludes registration thereof. . . . Interestingly, while [GCCSDA’s] counsel ventured that there probably are even such things as generic adverbs, the point is simply that for purposes herein, if the nominative term “SEVENTH-DAY ADVENTISM” is generic for a religion, then its adjectival form “SEVENTH-DAY ADVENTIST” is a fortiori generic, not only for the religion but also, in my view, for goods and/or services which are based upon, pertain to or otherwise have such religion as their subject matter.

*Stocker*, 1996 WL 427638 at \*29, n.5. (Hohein, J.) (Dissent) (citations omitted) (emphasis added).

c. **“Adventist” generally refers to the broad category of followers of Adventism, and not to members of any specific church and/or denomination.**

The relevant public understands “Adventist” to refer to “Adventism” and the religious belief that the second coming of Jesus Christ is imminent. Genericness deals “with the common use of language [and it] is the relevant consumers, not the courts, who determine whether the term signifies the genus of [products].” *McCarthy* § 12:4. To start, “dictionary definitions are relevant and sometimes persuasive in determining public usage [of a term.]” *McCarthy* § 12:13; *see also Gimix, Inc. v. JS & A Group, Inc.*, 699 F.2d 901 (7th Cir. 1983) (“[A] dictionary is an especially appropriate source of evidence.”); *Murphy Door Bed Co. v. Interior Sleep Systems, Inc.*, 874 F.2d 95 (2d Cir. 1989) (dictionary definitions are influential because they reflect the general public's perception of a designation”); *Mil-Mar Shoe Co. v. Shonac Corp.*, 75 F.3d 1153, 37 U.S.P.Q.2d 1633 (7th Cir. 1996) (“Because generic use implies use consistent with common understanding, [the court has] often looked to dictionaries as a source of evidence on genericness.”).

The weight afforded to dictionaries is “based upon the assumption that dictionary definitions usually reflect the public's perception of a word's meaning and its contemporary usage.” *McCarthy* § 12:13 (quotations omitted). The Board may take judicial notice of dictionary listings.” *Id.*; *see e.g., In re Patent & Trademark Services Inc.*, 49 U.S.P.Q.2d 1537 (T.T.A.B. 1998); *Continental Airlines Inc. v. United Air Lines Inc.*, 53 U.S.P.Q.2d 1385 (T.T.A.B. 2000) (taking judicial notice of dictionary definitions in holding “e-ticket” to be a generic name for electronic airline ticketing services).

Generally, the word “Adventist” is defined as anyone who belongs to, or believes in the doctrines expounded by, any of various denominations which emphasize that the second coming of Christ is imminent. The extremely well-respected and long-standing Oxford English Dictionary, which full definition of “Adventist” justifies close study including regarding the term’s etymology and historical usage/tracking, defines “Adventist” as:

A member of any of various Christian sects emphasizing belief in the imminent Second Coming of Christ; *spec.* a follower of William Miller (1782–1849), who predicted that the Second Coming of Christ and the end of the present world order would take place between 21 March 1843 and 21 March 1844; . . . Cf. *Seventh-day Adventists*.

38 *TTABVUE 12 (Ex. 4) (Oxford English Dictionary)*. This definition tracks the use of Adventist to before GCCSDA’s claimed date of first use in 1860, and compares “Adventist” to “Seventh-day Adventist” for purposes of drawing distinction between the terms. *See Stocker*, 1996 WL 427638 at \*15 (Board Majority determining that “the generic term for the religion is ‘Adventist’ (or ‘Adventism’) but that “Seventh-Day Adventist” is registerable). Consistent with the Oxford English Dictionary, the American Heritage Dictionary of the English Language ([www.ahdictionary.com](http://www.ahdictionary.com)) defines “Adventist” as “member of any of several Christian denominations that believe Jesus's Second Coming and the end of the world are near.” *McCarthy* § 12:13.

Similarly, the Second Revised Edition (1996) of *Seventh-Day the Adventist Encyclopedia* defines “Adventist” as “[o]riginally, and properly, a member of the Adventist (or Millerite) movement or of any one of the six (now five) Adventist church bodies that sprang from it.” 73 *TTABVUE 18 (Ex. 5) (Seventh-Day Adventist Encyclopedia, Second Revised Edition, GCCSDA Publication)*. It continues that an “Adventist” is “any believer in the doctrine of the nearness of the Second Advent.” *Id.*; *see also* 75 *TTABVUE 19-22 (Ex. 12) (Adventist Today Website)* (“Adventist Today defines ‘Adventist’ in a broad sense beyond the official members of one denomination, including a number of groups within the Adventist faith tradition, inactive and former members of these groups, and many people who were raised in Adventist families and today may participate in other denominations or faith communities, or no religion at all”).

These definitions clearly do not limit the term “Adventist” to adherents of GCCSDA’s specific denomination of Adventism. To the contrary, these definitions show that the Adventist faith

considerably predates GCCSDA's particular practice of it, and that multiple other denominations follow the Adventist faith, independent of GCCSDA. The evidence is indicative of the genericness of the designation "Adventist" since it shows that, to the relevant public, the primary significance of the designation is to connote any follower of the set of religious beliefs known as Adventism.

"[E]ncyclopedia evidence, just as in the case of dictionaries, is not dispositive, but is, nonetheless, a factor to be considered in [a cancellation] case." *Stocker*, 1996 WL 427638 \*15. As in *Stocker*, the instant "[encyclopedia] evidence [supports] that the generic term for the type or category of religion is 'Adventist' and not 'Seventh-day Adventist.'" *Id.* In addition to any previously cited encyclopedia evidence (which also pertain to the "relevant public prong" of the genericness test), the Wikipedia entry for "Adventist" is informative. *See e.g., McGill*, 624 F.Supp.2d at 896 (relying upon Wikipedia entry/evidence to determine that "Seventh-Day Adventist" is registerable). One of the most visited and popular websites on the internet (13<sup>th</sup> in the world in June 2020, per Alexa), Wikipedia is a crowd-sourced (public-sourced) encyclopedia, created and edited by volunteers from around the world. Wikipedia has become the largest and most popular general reference work on the World Wide Web, and accordingly holds a unique place in a determination of genericness.

The Wikipedia "Adventism" entry is similarly consistent with the above definitions. In pertinent part, the entry states:

Adventism is a branch of Protestant Christianity that believes in the imminent Second Coming (or "Second Advent") of Jesus Christ. It originated in the 1830s in the United States during the Second Great Awakening when Baptist preacher William Miller first publicly shared his belief that the Second Coming would occur at some point between 1843 and 1844 . . .

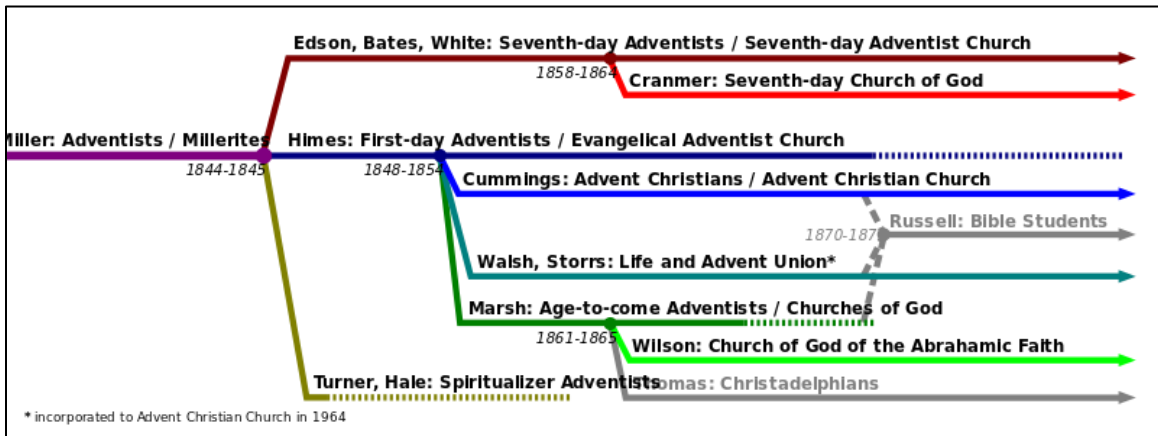
After the Great Disappointment, the Millerite movement split up and was continued by a number of groups that held different doctrines from one another. *These groups, stemming from a common Millerite ancestor, became known collectively as the Adventist movement. . . .*

The movement has encouraged the examination of the whole Bible, leading Seventh-day Adventists and some smaller Adventist groups to observe the Sabbath. In 2010, Adventism claimed some 22 million believers scattered in various independent churches . . . The largest church within the movement—the Seventh-day Adventist Church—had more than 19 million baptized members in 2015.

43 TTABVUE 52-57 (Ex. 20) (Adventism Wikipedia Entry) (emphasis added). Culminating with a useful visualization of Adventist denominations, the entry continues:

Adventism began as an inter-denominational movement. Its most vocal leader was William Miller. Between 50,000 and 100,000 people in the United States supported Miller's predictions of Christ's return. After the "Great Disappointment" of October 22, 1844, many people in the movement gave up on Adventism.

Of those remaining Adventist, the majority gave up believing in any prophetic (biblical) significance for the October 22 date, yet they remained expectant of the near Advent (second coming of Jesus). Of those who retained the October 22 date, many maintained that Jesus had come not literally but "spiritually", and consequently were known as "spiritualizers". A small minority held that something concrete had indeed happened on October 22, but that this event had been misinterpreted. This belief later emerged and crystallized with the Seventh-day Adventist Church, the largest remaining body today.



*Id.* (emphasis added).

Though GCCSDA may contend that the Wikipedia entry contains inaccuracies concerning Adventism, Wikipedia is by design representative of the public's collective impressions and knowledge about a particular subject. Here, that subject is Adventism. *McCarthy* § 12:4 (genericness deals "with



the common use of language [and it] is the relevant consumers, not the courts, who determine [what] the term signifies.”). Written and regularly edited by the public at large, the entry is illustrative of the fact that the general public perceives “Adventist” as generic for Adventism.

Lastly and similarly, the Board found in *Stocker*:

“Adventism,” as shown by the dictionary and encyclopedia evidence, is the name given to a core of beliefs, most significantly, a belief in the nearness of the second coming of Christ. In the encyclopedia excerpts of record, the Seventh-day Adventist Church invariably is classified under the heading “Adventism.” The encyclopedias include both general and religious ones.

*Stocker*, 1996 WL 427638 \*15. The Majority continued that:

The excerpts identify Seventh-day Adventism as just one, albeit the largest and most significant by far, of the branches or denominations of Adventism. By way of example, we point to petitioners' submission of excerpts from J. Gordan [sic] Melton, *Encyclopedia of American Religions* (3d ed. 1989). Each section [in Melton's *Encyclopedia*] bears a “family” heading, as for example, “Lutheran Family,” “Reformed-Presbyterian Family,” “Baptist Family,” “Pietist-Methodist Family” and “Adventist Family.”<sup>4</sup> Under each “family” the various religious groups falling within that category of religion are listed. Under the “Adventist” heading, the encyclopedias variously identify, in addition to the Seventh-day Adventist Church, other “Adventist” denominations that have existed through the years as follows: Advent Christian Church; Church of God of the Abrahamic Faith; Church of God (Adventist); Primitive Advent Christian Church; Evangelical Adventists; and Life and Advent Union. The central core of beliefs of these Adventist groups is essentially the same, with various differences over doctrinal interpretations of the nature of the millennium, the nature of man, the ministry of Christ, the return of the Jews, the Sabbath, and spiritual gifts.

*Id.*

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<sup>4</sup> See 71 TTABVUE 18, 13-50 (Ex. 3)(Melton's *Encyclopedia of American Religions*) (Eighth Edition)(especially page 18 listing “Intrafaith Organizations,” “Sunday Adventists,” “Seventh Day Adventists,” and “Church of God Adventists” under the “Adventist Family” heading and detailing the myriad groups practicing Adventism).

**d. GCCSDA's survey evidence is flawed, and even if accepted as pertinent supports Petitioner and a finding of genericness.**

GCCSDA writes that “the relevant public for Registrant’s religious services is ‘Protestant Christians’ since the Seventh-day Adventist Church is a Protestant Christian denomination, as are all of the other denominations that Petitioner alleges are referred to as ‘Adventist.’” *See 22 TTABVUE 9-10*. This assertion is blatantly self-serving because members of GCCSDA are more likely to associate the term “Adventist” with GCCSDA or Seventh-Day Adventism. As explained in the *Stocker* dissent:

[M]ost of the persons who come into contact with GCCSDA's religious observances, missionary services and religious publications will [ ] be members of [GCCSDA] since it is by far the largest Adventist group, [ ]

[T]he relevant public should [encompass] the general public and not just Christians or Adventist Christians . . . [because] it is understandable that members of the General Conference would perhaps regard “SEVENTH-DAY ADVENTIST” as signifying religious materials and activities which emanate from their mother church.

*Stocker*, 1996 WL 427638 at \*24 (Hohein, J.) (Dissent).

Furthermore, GCCSDA wrote in its summary judgment motion that in addition to being “a world-wide denomination . . . the Seventh-day Adventist Church [ ] operates more than 800 primary and 200 secondary schools; 11 colleges and universities; over 140 health care institutions, including 65 hospitals; more than 20 radio stations and two major satellite television networks in the United States.” *22 TTABVUE 3 (GCCSDA Summary Judgment Motion)*. These services serve and reach the general public. At a minimum, the awareness of the availability of these services extends beyond only Protestant Christians, necessitating a broader relevant public.

In any event, scrutiny of GCCSDA’s survey evidence is warranted. Closer examination of GCCSDA’s assertions reveal that GCCSDA’s survey is presumptuous and its conclusions are flawed. *Stocker*, 1996 WL 427638 at \*16 (Board was unable to extrapolate, to any significant degree, any insight into a genericness determination from a study indicating high recognition (i.e., secondary

meaning) of the Seventh-Day Adventist Church.). Here, GCCSDA requested that its survey “measure whether, and to what extent, the term ‘Adventist’ has acquired secondary meaning in the minds of the relevant consuming public.” See 47 TTABVUE 9 (Ex. 1) (S. Parikh Dec.) (emphasis added). But a generic term cannot acquire secondary meaning. See e.g., *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976).

As explained by McCarthy, “a [genericness] survey must be directed at the issue of consumer perception as to the significance and meaning of the designation in issue . . . [and] asking a question that is not directly relevant to the issue of genericness is irrelevant.” *McCarthy* § 12:14. GCCSDA’s survey erroneously starts from a presumption that the term “Adventist” is able acquire secondary meaning and is not generic. The survey treats secondary meaning as pertinent to determining genericness, which it is not. See *Abercrombie*, 537 F.2d at 9. Further, the survey and its results considered responses only from Christians and it offers results for only Protestant Christians and non-Protestant Christians, each of which is a self-servingly narrow response group. 47 TTABVUE 11 (¶9)(Ex. 1) (S. Parikh Dec.) (“Respondents . . . Must be Christian.”).

To the extent that GCCSDA may rely upon the survey, its results nonetheless undermine GCCSDA’s position because a majority of those polled (Protestant Christian or non-Protestant Christian) do not associate “Adventist” with “Seventh-Day Adventism.” Even within the Christian religious communities, GCCSDA is not perceived as the sole, or even primary, user of the word “Adventist.” A clear minority of the Protestant Christians polled connected the term “Adventist” to “Seventh-Day Adventism.” See 47 TTABVUE 20 (Ex. 1)(S. Parikh Dec.). Rather, the majority of the Protestant Christians polled associated the term “Adventist” with a generic Christian faith or nothing at all. *Id.* Thirty percent (30%) of the Protestant Christians polled responded “[I] don’t know” to the question of whether “Adventist” conveyed a particular meaning, and only twenty-five percent (25%) of

the Protestant Christians polled associated the term “Adventist” with “Seventh-Day” or “Seventh-Day Adventist.” *Id.* The remaining forty-five percent (45%) of the Protestant Christians polled associated the term “Adventist” with a general Christian belief system or with broad, non-Seventh-Day Adventist specific terms such as “Advent,” “Mormon,” “Follows Jewish tradition,” “Door-to-door,” “Cult/Strange,” and “Devout.” 47 *TTABVUE* 20 (*Ex. 1*)(*S. Parikh Dec.*). The survey results further show that a mere thirty-three percent (33%) of the Protestant Christians polled associated the term “Adventist” with the single denomination of “Seventh-Day Adventist.” *Id.* at 21-22.

Notably, the survey included more than just Protestant Christians. Three hundred and forty-five (345) total Christians were polled from which two hundred and five (205) were Protestant Christians. *See* 47 *TTABVUE* 11 (¶9)(*Ex. 1*) (*S. Parikh Dec.*) (“Respondents . . . Must be Christian.”). But the results for the total Christians polled are conspicuously absent from the survey results and must be independently calculated by the survey reader.

Alas, a clear minority of the Christians polled connected the term “Adventist” to “Seventh-Day Adventism.” *See* 47 *TTABVUE* 20 (*Ex. 1*)(*S. Parikh Dec.*). Rather, the majority of the Christians polled associated the term “Adventist” with a generic Christian faith or nothing at all. *Id.* Twenty-nine percent (29%) of the Christians polled responded “[I] don’t know” to the question of whether “Adventist” conveyed a particular meaning, and only twenty-three percent (23%) of the Christians polled associated the term “Adventist” with “Seventh-Day” or “Seventh-Day Adventist.” *Id.*; *see* *McCarthy* § 12:6. The remaining forty-eight percent (48%) of the Christians polled associated the term “Adventist” with a general Christian belief system or with broad, non-Seventh-Day Adventist specific terms such as “Advent,” “Mormon,” “Follows Jewish tradition,” “Door-to-door,” “Cult/Strange,” and “Devout.” 47 *TTABVUE* 20 (*Ex. 1*). The survey results further show that a mere twenty-nine percent (29%) of the

Christians polled associated the term “Adventist” with the single denomination of “Seventh-Day Adventist.” *Id.* at 21-22.

These results indicate that any association between the terms “Adventist” and Seventh-Day Adventism becomes weaker the broader the survey respondents are made. Despite GCCSDA’s characterizations of it, and despite the legal irrelevance of secondary meaning to genericness,<sup>5</sup> the survey results far from defend against genericness or evidence secondary meaning for the term “Adventist.” *See McCarthy* § 12:6 (“[I]f a survey showed that 75 percent of the public regard the word as generic, then that is its majority usage and its ‘principal significance.’”).

**e. Multiple Courts and the Board have found that Adventist is the generic name of the category of religion that believes in the nearness of the second coming of Christ.**

The Board and other Courts have determined that the term “Adventist” is generic. A term may be generic if, for example, it was previously determined to be generic by a court. *See Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. 111, 117, 59 S.Ct. 109, 83 L.Ed. 73 (1938) (“shredded wheat” determined to be generic because a court had already deemed the term to be so). This is not the first case to address GCCSDA’s exclusive ownership of “Adventist.” Courts—and the Board—have consistently held that “Adventist” is generic when evaluating GCCSDA’s “Seventh-Day Adventist” mark.

Courts necessarily analyzed the “Adventist” portion of “Seventh-Day Adventist” mark when evaluating whether “Seventh-Day Adventist” is generic. Across time and geography, every single court and tribunal faced with this analysis determined “Adventist” to be generic. *See Stocker v. General Conf. Corp. of Seventh-Day Adventists*, 39 U.S.P.Q.2d 1385 (T.T.A.B. 1996); *General Conf. Corp. of Seventh-Day Adventists v. McGill*, 624 F.Supp.2d 883 (W.D. Tenn. 2008), *affirmed* 617 F.3d 402 (6th Cir. 2010);

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<sup>5</sup> In a petition to cancel based on genericness grounds, it is further conspicuous that sophisticated trademark owners such as GCCSDA would elect to conduct a survey measuring secondary meaning instead of either of the well-known “Teflon” or “Thermos” genericness survey methods, which results could have better attempted to defend the continued registration of the subject marks. *See McCarthy* § 12:14.

*General Conf. Corp. of Seventh-Day Adventists v. Perez*, 97 F.Supp.2d 1154 (S.D. Fla. 2000); *see also General Conf. Corp. of Seventh-Day Adventists v. Seventh-day Adventist Kinship, International, Inc.*, Case No. CV 87-8113 MRP (Slip Op. 1992) (finding “Seventh-Day Adventist” to be generic). The instant case is a logical extension to this well-reasoned and well-supported jurisprudence.

Inconvenient to GCCSDA as these cases may be, they demand attention. The findings of the Board and the federal courts remain true regardless of how GCCSDA (a) may attempt to distinguish them as inapplicable or (b) whether GCCSDA ultimately prevailed with respect to the separate “Seventh-Day Adventist” mark. The thread between these cases is evident and unambiguous—the term “Adventist” is generic. Substantial deference, if not precedence, should be afforded to the findings of the Board and the federal courts in this regard. *Stocker, McGill, Kinship, and Perez* individually and collectively show that this case cannot be decided in GCCSDA’s favor as a matter of law. To do so would blatantly contradict prior decisions, including of this very tribunal.

Furthermore, GCCSDA should ostensibly agree that “Adventist” is generic. The *Stocker, McGill, and Perez* holdings that “Seventh-Day Adventist” is not generic are each predicated on the finding that “Adventist” is generic. *See Stocker*, 1996 WL 427638 at \*15; *McGill*, 624 F. Supp. 2d at 896; *Kinship*, Case No. CV 87-8113 MRP (Slip Op. 1992) at 13-15; *Perez*, 97 F.Supp.2d at 1159. GCCSDA indeed disclaimed “Adventist” for Reg. No. 1177185 for SEVENTH-DAY ADVENTIST in 1991 prior to *Kinship* (1992), *Stocker* (1996), *Perez* (2000), and *McGill*, (2008). *See Stocker*, 1996 WL 427638 at \*15 (“Given the genericness of ‘Adventist,’ we fully concur with respondent's voluntary disclaimer of this term in its registration.”); *McCarthy* § 12:13 (“A kind of estoppel arises when the proponent of trademark use is proven to have itself used the term before the public as a generic name, yet now claims that the public perceives it as a trademark.”); *see also 42 TTABVUE 40-41 (Ex. 17) (TESS record, U.S. Reg. No. 1177185)*. In upholding the registration of GCCSDA’s “Seventh-Day Adventist” mark, the

*Stocker, McGill, and Perez* courts reasoned that “Seventh-Day Adventist” is not generic because a person or entity can use the term “Adventist” to identify Adventism. “Adventist” cannot also be unavailable for the public to use with respect to, at a minimum, class 16 for religious books and bibles and class 42 religious observances and missionary services.

**Stocker**

In *Stocker*, the Board unequivocally declared that “Adventist” is generic and specifically for classes 16 and 42. *See Stocker*, 1996 WL 427638 at \*15. To reach the determination that “Seventh-Day Adventist is distinctive, the Majority first found that “the generic term for the religion is ‘Adventist’ (or ‘Adventism’).” *See id.* The Board expressly held and explained that “[a]lthough we view the term ‘Adventist’ as generic, we cannot conclude that the present record establishes that the registered mark ‘Seventh-day Adventist’ (‘Adventist’ disclaimed) is also generic.” *Id. at 19.*

Still, Judge Hohein dissented and wished to go further. His dissent explained that “[u]pon consideration of the entire record, the designation “SEVENTH-DAY ADVENTIST” is a generic term for respondent's religious publications, observances and missionary services.” *Id.* at 22. The dissent concluded that “the designation ‘Seventh-Day Adventist’ primarily signifies the name of a religion to the relevant public [and is] therefore a generic term for [GCCSDA’s] goods and services inasmuch as it primarily signifies a category or class of publications, observances and missionary services which have such religion as their subject matter.” *Id.* at \*32 (further stating with emphasis added, “[GCCSDA] 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—this] principle is fundamental to the law of trademarks.”).

### McGill

In *McGill*, the Court found that the term “Adventist” was generic before holding that the “Seventh-Day Adventist” mark was not generic and therefore registerable. *See McGill*, 624 F. Supp. 2d at 896. Citing *Stocker*, the *McGill* Court denied summary judgment because it found that “[b]oth the dictionary definition and the Wikipedia entry support the conclusion that the term ‘Adventist’ refers to a set of beliefs, rather than to the churches led by GCCSDA.” *Id.* (citing *Stocker*, 1996 WL 427638 at \*15).

Specifically, the *McGill* Court relied upon Webster’s dictionary definitions of “Adventism” as “the doctrine that the second coming of Christ and the end of the world are near at hand.” *See McGill*, 624 F. Supp. 2d at 896. The *McGill* Court further relied upon the Wikipedia entry for Adventism which “provides that the term ‘Adventist’ generally refers to someone who believes in the Second Advent of Jesus” and that “there are over nine churches in the ‘Adventist family,’ including Jehovah’s Witnesses, Seventh-day Adventists, and the Advent Christian Church.” *Id.* (emphasis added).

### Perez

In *Perez*, yet another case specifically implicating the genericness of “Adventist,” the Court unequivocally found “Adventist” to be generic. *See Perez*, 97 F.Supp.2d at 1159. The *Perez* Court explained that “the word ‘Adventist’ alone defines the coming of Christ, but alone does not suggest the specificity of Christ’s coming within the total doctrines and tenets of the Seventh-day Adventist Church.” *Id.* at 1159.

### Kinship

In *Kinship*, the Court went further, like Judge Hohein’s dissent in *Stocker*, finding that “[t]he words ‘Seventh-Day Adventist’ are generic and not entitled to trademark protection.” *Kinship*, Case No. CV 87-8113 MRP (Slip Op. 1992) at 13-15. The *Kinship* Court wrote:



Seventh-day Adventism, the religion, pre-existed the Seventh-day Adventist Church. Although not determinative, the Court finds it significant that the term 'Seventh-day Adventist' appears in a standard American language dictionary.

The use of the name "Seventh-day Adventist" by at least two breakaway churches, The Seventh-day Adventist Church, Reform Movement, and the Davidian Seventh-day Adventists Association, without opposition by the General Conference also tends to support the view that the term "Seventh-day Adventist" has significance other than to indicate membership in the mother church.

*Id.* (emphasis added). The *Kinship* Court continued that:

More importantly, there is no term that adequately describes an adherent to the religion of Seventh-day Adventism, other than "Seventh-day Adventist"; the only possible alternative would be "Adventist," and that term is too broad.... [T]he terms 'Seventh-day Adventist,' and its acronym 'SDA' are generic, and are not entitled to trademark protection."

*Id.* (emphasis added).

**U.S. Reg. No. 1,177,185**

Furthermore, in concert with these findings, GCCSDA disclaimed any rights to the term "Adventist" apart from the "Seventh-Day Adventist" mark (Reg. No. 1,177,185). *See 42 TTABVUE 40-41 (Ex. 17) (TESS record, U.S. Reg. No. 1,177,185)*. "The purpose of a disclaimer is to permit the registration of a mark that is registrable as a whole but contains matter that would not be registrable standing alone, without creating a false impression of the extent of the registrant's right with respect to certain elements in the mark." *T.M.E.P.* § 1213; *see* 15 U.S.C. § 1056(a) ("The Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable [and/or] [a]n applicant may voluntarily disclaim a component of a mark sought to be registered). GCCSDA's Reg. No. 1,177,185 includes the following disclaimer: "No claim is made to the exclusive right to use the word 'Adventist'." The disclaimer was entered by the Commissioner on August 21, 1990 on the basis that "Adventist" is generic and could not be owned solely by GCCSDA.

In this respect, McCarthy explains that “[a] kind of estoppel arises when the proponent of trademark use is proven to have itself used the term before the public as a generic name, yet now claims that the public perceives it as a trademark.” *See McCarthy* § 12:13; *see also BellSouth Corp. v. White Directory Publishers, Inc.*, 49 U.S.P.Q.2d 1801 (M.D.N.C. 1999) (“express disavowal of rights by AT&T followed by extensive third-party use resulted in genericness for the [subject] logo.”). GCCSDA disclaimed “Adventist” to then later assert exclusive and expansive rights to the term.

**f. GCCSDA’s defenses are legally flawed, factually unsupported, and contravene well-established caselaw and trademark doctrine.**

GCCSDA’s rebuttal evidence is undeniably biased and largely manufactured to support itself in this specific proceeding. Stated simply: GCCSDA cites and *relies upon its own institutionally held opinions and writings* to defend against genericness and the instant Petition. To the extent GCCSDA’s evidence was not manufactured, critical examination of it reveals that it sits in the range of mischaracterized to logically flawed. GCCSDA’s own opinion that its marks are not generic—*no matter how frequently repeated or whether presented in varying formats*—does not constitute credible evidentiary support. Comparatively, Petitioner’s evidence is independent (if not even from GCCSDA) and legally sound. It consistently supports a finding that the term “Adventist” is generic.

**Declarants Employed by or Associated with GCCSDA**

GCCSDA’s expected rebuttal evidence consists of self-serving declarations from its own employees, former employees, attorneys, agents, and members. In each instance, the unavoidably biased declarants offer conclusory opinions that members of Adventist denominations other than their own do not refer to themselves as “Adventists” and how the history of Adventism indicates that GCCSDA and Seventh-Day Adventists are the only Adventists. But “affidavits from friendly employees and dealers are of little weight [to the Board when determining genericness], as having the appearance of bias.”

*McCarthy* § 12:13.

“Trademark law is skeptical of the ability of an associate of a trademark holder to give an impartial account of the value of the holder's mark.” *Id.* This is precisely what GCCSDA attempts.

That is, GCCSDA is expected to rely upon declaration testimony from:

*GCCSDA's Legal Counsel:*

- (1) Jonah Perry (Docket Clerk, Buchanan Ingersoll & Rooney PC);
- (2) Kathy Bazil (Legal Assistant, Buchanan Ingersoll & Rooney PC);

*GCCSDA's Employees and/or Members:*

- (3) Jennifer Gray Woods (Associate General Counsel, GCCSDA);
- (4) Dr. George R. Knight (Professor Emeritus, Andrews University, GCCSDA)
- (5) Dr. Clinton Whalen (Director, Bible Research Institute, GCCSDA);
- (6) Dr. George Reid (Former Director, Bible Research Institute, GCCSDA);
- (7) Dr. Lisa Beardsley-Hardy (Director of Education, GCCSDA);
- (8) David Trim (Director, Office of Archives, Statistics, and Research, GCCSDA);

*GCCSDA's Publishing Houses and/or Members:*

- (9) Dale Galusha, (President, Pacific Press Publishing Association)
- (10) Bill Knott (Executive Editor, Adventist Review, Adventist World);

*GCCSDA's Members/Licensees and/or Members:*

- (11) Terry Forde (CEO, Adventist Healthcare, GCCSDA Member/Licensee) and
- (12) Meredith Jobe (Vice President, Adventist Health, GCCSDA Member/Licensee).

*See generally 47-60 TTABVUE.* By their own admission, these declarants are members of GCCSDA and/or are paid by GCCSDA. *See id.* There exists a clear social and financial stake for each declarant in supporting GCCSDA's position. Each declaration is undermined by the declarant's inherent bias and must be viewed with appropriate scrutiny by the Board.

The declarants are also not reliable witnesses regarding the beliefs, verbiage, or practices of competing or other sects or denominations as they are members of GCCSDA and are Seventh-Day Adventists. Excluding Dr. Clinton Whalen and Dr. George Reid who were disclosed, these declarants have not been disclosed or qualified as expert witnesses in compliance with Fed. R. Civ. P. 26, T.B.M.P § 401.03, or the applicable Federal Rules of Evidence. They are laypersons and are unqualified to expound upon the history or theology of Adventism. Irrespective of the professional titles conferred on

them by GCCSDA or its agents, these declarants are lay witnesses and merely members of the public selected by GCCSDA to offer inherently biased opinions on Adventism which benefit their employer and denomination. Rather, these declarants are not select members of the public at all. They belong to a much narrower group. They are select members of GCCSDA's own employees, former employees, attorneys, agents, and members who GCCSDA recruited to testify in its favor.

Furthermore, the proffered expert testimony of Dr. Clinton Whalen and Dr. George Reid carries only limited persuasive value towards a genericness determination. As the Board has explained, “[i]t is the understanding of the public, of course, and not that of the expert which is determinative [of genericness].” *Stocker*, 1996 WL 427638 at \*15 (emphasis added); see *Tanners' Council of America, Inc. v. Scott Paper Company*, 185 USPQ 630, 637 (TTAB 1975). The Board must then “recognize the shortcomings of expert testimony on the issue of whether a trademark/service mark is understood by the purchasing public to be a generic name.” *Stocker*, 1996 WL 427638 at \*15.

#### **Publications Produced by GCCSDA**

GCCSDA further filed and is expected to rely upon various publications produced and/or published by its own publishing houses, (1) Pacific Press Publishing Association and (2) Review and Herald Publishing Association. See 59 TTABVUE 2 (¶4) (*B. Knott Dec.*) (“The Seventh-day Adventist Church has two publishing houses in the United States, the Pacific Press Publishing Association and the Review and Herald Publishing Association.”). For example, GCCSDA relies upon the *Adventist Review* to support its defenses. The *Adventist Review* was printed by the “Review Herald Publishing Association until 2014, and since then by Pacific Press Publishing Association, [and] is the official news magazine of the Seventh-day Adventist Church.” See *id.* Similar to the declarants' testimony, these publications are selectively offered and unavoidably biased in GCCSDA's favor.

### **Unrelated Marks Registered by GCCSDA**

GCCSDA is additionally expected to rely upon various other federal registrations in distinct classes (e.g., ADVENTIST HEALTH in class 16 for printed material in the field of health and medical care, class 35 for hospital administration services, and class 44 for health care services) for composite marks that contain the term “Adventist.” A mark must always be viewed in its entirety, and GCCSDA has no rights to the term “Adventist” apart from the full marks, e.g., the term “Adventist” apart from the SOUTHERN ADVENTIST UNIVERSITY mark. *See Hunt Masters, Inc. v. Landry's Seafood Rest., Inc.*, 240 F.3d 251, 254 (4th Cir. 2001) (“[A] mark must be considered as a whole to determine its validity.”). GCCSDA nonetheless seems to suggest that its registration of other composite marks for other goods and services that include the term “Adventist” means that Reg. Nos. 1218657 and 1176153 are not generic and/or that it possesses rights to the term “Adventist” alone. These registrations, however, have no apparent factual or legal bearing on determining whether Reg. Nos. 1218657 and 1176153 are generic.

Also, in some instances these registrations are based on a 2(f) acquired distinctiveness statement citing U.S. Reg. Nos. 1,218,657 and/or 1,176,153, meaning it is logically circular to use them to defend against a genericness finding and/or to assert rights to the term “Adventist” alone and apart from the mark in its entirety. For example, U.S. Reg. No. 5,284,292 for ADVENTIST was registered upon the affirmative 2(f) statement that “The mark has become distinctive of the goods and/or services as evidenced by the ownership of active U.S. Registration No(s). 1,176,153 . . . on the Principal Register for the same mark for sufficiently similar goods and/or services.”

### **Selective Media Mischaracterized by GCCSDA**

GCCSDA is lastly expected to point to numerous media articles in which it asserts that the term “Adventist” is used to refer only to Seventh-Day Adventists. Of course, GCCSDA the corporate entity

is distinct from followers of Seventh-Day Adventism. Even if a media outlet does use the term “Adventist” to refer only to Seventh-Day Adventists, this does not mean or prove that Seventh-Day Adventist are the only Adventists. It merely means that an author or media outlet in that specific instance chose to use the broader term of “Adventist” instead of the more specific “Seventh Day Adventist,” or that it chose to use the term “Adventist” as shorthand after identifying Seventh-Day Adventists as the subject of the writing. The use of “Adventist” in the articles is also typically to refer to followers of Seventh-Day Adventism, as opposed to GCCSDA the corporate entity; a critical distinction.

For example, GCCSDA asserts that the October 27, 2015 New York Times article titled “*Ben Carson Puts Spotlight on Seventh-day Adventists*” shows media use of “Adventist” to refer solely to the Seventh-day Adventist Church. *See 63 TTABVue 65-72 (New York Times Articles) (Ex. 23)*. Attentive reading of the article, however, reveals differently. By its title, the article is specifically about Seventh-Day Adventists which immediately makes it clear that the term “Adventist” may be used therein as a shorter version of “Seventh-Day Adventist.” *Id.* The article additionally refers to the “Seventh-Day Adventist denomination” while including a brief historical background on how Seventh-Day Adventists evolved from the origination of “Adventism” by William Miller in the 19<sup>th</sup> Century. *Id.* It also cites membership numbers pertaining to Seventh-Day Adventism, and not Adventism overall. To extrapolate that Seventh-Day Adventists are the only Adventists from this article strains credulity. It instead assumes casual, surface level reading of the article by the reader and/or Board, which is not its practice.

- g. GCCSDA’s status as the largest Adventist denomination does not permit it to remove “Adventist” from the public domain, nor does it grant it the right to prevent others from using “Adventist.”**

Irrespective of its since accumulated size or influence, GCCSDA is legally prohibited from possessing exclusive ownership of the generic term “Adventist.” Ostensibly, GCCSDA knows this to be true because it disclaimed the term “Adventist” as generic in its “Seventh-Day Adventist” registration.

See 42 TTABVue 40-41 (Ex. 17) (TESS record, U.S. Reg. No. 1,177,185); see also McCarthy § 12:13 (“[a] kind of estoppel arises when the proponent of trademark use is proven to have itself used the term before the public as a generic name, yet now claims that the public perceives it as a trademark.”); *BellSouth Corp.*, 49 U.S.P.Q.2d 1801 (“express disavowal of rights by AT&T followed by extensive third-party use resulted in genericness for the [subject] logo.”).

“[M]erchants [like GCCSDA] act at their peril in attempting, by advertising, to convey common descriptive names, which belong to the public, to their own exclusive use.” *Weiss Noodle Co. v. Golden Cracknel and Specialty Co.*, 290 F.2d 845, 847–48 (C.C.P.A.1961). “No matter what the market situation may have been as to indication of origin or secondary meaning, the common descriptive name of the product cannot become a trademark owned exclusively by one vendor.” *Christian Science Board of Directors of the First Church of Christ, Scientist v. Doris Evans, et. al*, 520 A.2d 1347, 1351 (N.J. 1987). “The repeated use of ordinary words ... cannot give [a single corporation] a proprietary right over those words, even if an association develops between the words and [that corporation].” *Am. Online, Inc.*, 243 F.3d at 821 (emphasis added)/

“No matter how much money and effort the user of a generic term has poured into promoting the sale of its [goods or services] and what success it has achieved in securing public identification, that user cannot claim the exclusive right through trademark protection to call the [good] or service by its common name.” *Abercrombie*, 537 F.2d at 9; see also *J. Kohnstam, Ltd. v. Louis Marx and Co.*, 280 F.2d 437, 440 (C.C.P.A 1960) (“Once determined to be a generic name, advertising cannot create a secondary meaning and exclusive rights.”). “Even though [or if] they succeed in the creation of de facto secondary meaning, due to lack of competition or other happenstance, the law respecting registration will not give it any effect.” *Weiss Noodle Co.*, 290 F.2d at 847–848; see also *Roux Laboratories, Inc. v. Clairol, Inc.*, 427 F.2d 823, 829 (C.C.P.A 1970) (“mere advertising or other evidence of supposed

secondary meaning cannot convert something unregistrable by reason of its being the common descriptive name or generic name for the goods . . . into a registrable mark.”) (emphasis added).

“A showing of ‘secondary meaning,’ no matter how strong, can never earn trademark status for a generic word or phrase [and it] is this fact that has led to the coining of the phrase ‘*de facto secondary meaning.*’” *Christian Sci.*, 520 A.2d at 1354. “What is meant is that when a producer [e.g., GCCSDA] selects as a trademark a term that is deemed already to have been the commonly-recognized (generic) name of the goods [e.g., “Adventist”], then even if that producer successfully establishes ‘*de facto*’ secondary meaning, it will not be recognized ‘*de jure.*’” *Id.*

GCCSDA wrote in its Motion for Summary Judgment that:

GCCSDA is a non-profit corporation established to hold title to the assets of the Seventh-day Adventist Church, including its trademarks. The Seventh-day Adventist Church (the “Church”) is a world-wide denomination with over 20 million members, including over 1.1 million members and over 5,000 churches in the United States.

The Seventh-day Adventist Church also operates more than 800 primary and 200 secondary schools; 11 colleges and universities; over 140 health care institutions, including 65 hospitals; more than 20 radio stations and two major satellite television networks in the United States.

22 *TTABVUE* 3-4 (citations omitted). However, this information as well as GCCSDA’s survey evidence (discussed *supra* and which measured “secondary meaning”) is legally irrelevant to a genericness determination because a generic term cannot acquire secondary meaning or come to refer to only one specific source. *See Abercrombie.*, 537 F.2d at 9; *Am. Online, Inc.*, 243 F.3d at 821; *Weiss Noodle Co.*, 290 F.2d at 847–848. Stated otherwise, GCCSDA’s size and influence does not change the pertinent history or the law concerning what is or is not a generic designation of “Adventism,” i.e., “Adventist.”

Rather, as discussed *infra*, GCCSDA’s assertion of its size and influence only serves to highlight the significant imbalance of resources between the GCCSDA and the recipients of its cease and desist letters and aggressive litigation tactics (e.g., Petitioner *et al*). Frequently this imbalance of resources



allows GCCSDA to prevail through a “money-over-merits” litigation strategy in which lesser-resourced opponents and/or competitors settle because they cannot or can no longer financially afford to litigate.

Critically, “[t]he fact that the proponent of trademark rights has prevailed on others to settle a claim and admit that the designation is a valid trademark has very little relevance to the understanding of the designation by the public.” *McCarthy* § 12:13; *see also Colt Defense LLC v. Bushmaster Firearms, Inc.*, 486 F.3d 701, 82 U.S.P.Q.2d 1759 (1st Cir. 2007). The Board recently addressed this situation in the matter of *In re Hikari Sales USA, Inc.* 2019 WL 1453259 \*12 (T.T.A.B. 2019). Therein, the Board explained that it assigns little weight to competitors agreeing to discontinue use of a designation upon threat of legal action because the discontinuance is more likely motivated by a desire to avoid costly litigation than to acknowledge trademark significance. *Id. See 22 TTABVue 16 (GCCSDA’s Summary Judgment Motion)* (arguing that a limited number of other groups using the term “Adventist” is evidence that groups have other ways to identify themselves and term is not generic).

That GCCSDA has pervasively leaned on the public (non-GCCSDA members) and competitors (splinter and other Adventist churches) to discontinue their use of the generic term “Adventist” or face expensive (typically unsustainable) litigation should be given no evidentiary merit, nor conflated with it being a singular source for Adventism. It instead only reinforces the importance of the public policy and statutory prohibition against trademarking generic terms.

**h. Allowing GCCSDA to monopolize the term “Adventist” to the exclusion of the general public unfairly stifles competition contrary to the Lanham Act and the U.S. Constitution.**

“Sharing in the goodwill of an article unprotected by [ ] trademark is the exercise of a right possessed by all—and in the free exercise of which the consuming public is deeply interested.”

*McCarthy* § 12:2. “To grant an exclusive right to one firm of use of the generic name of a product would be equivalent to creating a monopoly in that particular product, something that the trademark laws were

never intended to accomplish.” *Id.* “[I]t is no purpose of trademark protection to allow a firm to prevent its competitors from informing consumers about the attributes of the competitors' brands. ... To allow a firm to use as a trademark a generic word, ... would make it difficult for competitors to market their own brands of the same product.” *Id.*

These concerns are indeed true with respect to GCCSDA. The reading of GCCSDA’s “Trademark and Logo Usage” notice shows GCCSDA’s clear intent to use generic words under the guise of trademark law, including “Adventist,” to prevent others from practicing their religious beliefs. *See 43 TTABVUE 5-10 (Ex. 18) (GCCSDA’s Trademark Usage Policy)*. Examples of GCCSDA’s misuse in practice are set forth below, as well as in the above cited cases concerning the genericness of “Seventh-Day Adventist” and/or “Adventist.” Discussing the *McGill* case (discussed *supra*), Attorney and Professor of Law N. Cameron Russell writes:

The type of monopoly provided to [GCCSDA] in *McGill* seems to be just the type that black-letter trademark law tries to prohibit. If a theoretical justification of trademark law is to foster competition, how is anyone supposed to compete with [GCCSDA] to provide an alternative to its “brand” of the Protestant religion?

If McGill cannot use the words “Seventh-day Adventist” [or “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 [GCCSDA] should not require him to create an entirely new name for his religious beliefs.

*See 41 TTABVUE 15, 2-26 (Ex. 12)*; 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); see also 41 TTABVUE 26-56 (Ex. 12.); 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). The same logic and concerns

that Professor Russell expresses concerning registration of “Seventh-Day Adventist” naturally apply with even greater intensity to the broader and more necessary term “Adventist.”

Professor Russell continues:

If McGill cannot use the name “Seventh-day Adventist” [or “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” [or “Adventist”] then what is a potential member of the 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.

*See 41 TTABVUE 15, 2-26 (Ex. 12).* As an illustrative thought exercise, GCCSDA could not have formed and grown into Adventism’s largest group if was prohibited from using the term “Adventist” or *Church of Creator*, 297 F.3d 662, 666–667 (7th Cir. 2002)(“[When evaluating genericness] it is helpful to ask whether one firm's exclusive use of the phrase will prevent a rival from naming itself and describing its product.”). Other Adventists and/or Adventist groups must be afforded the same opportunity as Ellen White and her originally small Seventh-Day Adventist group to communicate their practice of Adventism generally and in the name of their denomination or group. *See 70 TTABVUE 55 (Ex. 2) (William Miller and The Rise of Adventism by George R. Knight)* (“[By] 1860 the seventh-day keepers represented a little more than five percent of the Adventists.”).

As noted, examples of the GCCSDA’s misuse of trademark law to effectively “appropriate a theology” are numerous. *See TE-TA-MA*, 297 F.3d at 666-667 (discussing danger of allowing the registration of generic terms with respect to religion and using the example “one firm appropriating the word ‘sandwich’ and thus disabling its rivals from explaining to consumers what's to eat.”). In this respect, consider the informative exchange between GCCSDA and (formerly) Guthrie Memorial Adventist Chapel. *See 40 TTABVUE 11-19 (Ex. 11).* As explained on its website:

[O]ur congregation changed its name from Guthrie Memorial Adventist Chapel to Guthrie Memorial Chapel.

Although our congregation started with the name GUTHRIE MEMORIAL ADVENTIST CHAPEL in August of 2001, [GCCSDA], in 2007, forced us (under threat of legal action) to remove the word ADVENTIST from our church's name.

However, please know that our belief in both the seventh-day Sabbath and the second coming of Christ, is just as strong as ever. WE HAVE NOT CHANGED OUR BELIEFS!

*Id.* at 19. On June 28, 2007, GCCSDA sent a cease and desist letter to Guthrie Memorial Adventist Chapel demanding removal of the term "Adventist" from its name, writing:

[GCCSDA has] been informed that you were once a member of the Seventh-day Adventist Church family, but sadly chose to leave the Church and form your own congregation called Guthrie Memorial Adventist Chapel.

Please understand that since you decided to leave the sisterhood of Seventh-day Adventist(R) churches, you can no longer identify your congregation with any of the Church's registered trademarks/service marks such as ADVENTIST(R).

Therefore, your current use of ADVENTIST(R) is unauthorized . . . Kindly confirm your compliance with these demands in writing as well as by removing the Church's trademarks/service marks from any signage, literature, domain names, websites, brochures, and from any other place, location or other use . . .

*Id.* at 11-12 (*emphasis added*). Pastor Hevener responded on July 15, 2007:

No doubt you are aware that the word ADVENTIST is used by various churches. The "New Light Index" states that the Seventh-day Adventist Church is the largest of "some 200 Adventist denominations."

The Encyclopedia Britannica states that an Adventist is a "member of a group (*italics mine*) of Protestant Christian churches...."

The Wikipedia Encyclopedia also lists various churches using the word ADVENTIST. Therefore, it is our understanding that, because of the widespread use of the word ADVENTIST by multiple churches, the word is a generic term like, for example, BAPTIST.

*Id.* at 13-14 (emphasis added). GCCSDA then wrote back on July 24, 2007:

*Perhaps we neglected to attach the trademark/service mark registrations for the mark ADVENTIST®, which belong to the Seventh-day Adventist Church [ ]. The registrations cover numerous categories, including specifically "religious observances and missionary services," with the first use in commerce dating back to 1860. These registrations establish that the Seventh-day Adventist® Church has the exclusive right to use these marks for the stated purposes, despite any claims that the mark is "generic."*

[O]ur request for you to immediately cease and desist from using the name ADVENTIST to identify your religious organization does not stem from your beliefs pertaining to almsgiving or any other tenet.

*It is simply based on the fact that your organization's use of the name ADVENTIST in connection with your religious observances and missionary services is confusingly similar to the use of the Seventh-day Adventist® Church in the same areas of classification. Therefore we must respectfully demand that you cease and desist from your use . . .*

*Id.* at 15-16 (emphasis added). Numerous other example abound and continue. *See 40 TTABVUE 20-24 (Exhibit 11) (GCCSDA's Cease and Desist Letter to Battle Creek Gospel of Fellowship of Historic Seventh Day Adventist)* (GCCSDA demanded Battle Creek Gospel of Fellowship of Historic Seventh Day Adventists not use the term "Adventist" or "Seventh-Day Adventist" in its name because it is independent from GCCSDA."); *42 TTABVUE 6-12(Ex. 14) (San Diego Union-Tribune Article)* (GCCSDA sued the Jewish Adventist Society in San Diego because of its use of "Adventist" in the Society's name); *42 TTABVUE 13-16 (Ex. 15) (Vance Ferrell's "Letter to the Trademark Judge")* (detailing danger of allowing GCCSDA to monopolize "Adventist" for or related to Adventism).

**i. Excluding practitioners of the Adventist faith from using "Adventist" unconstitutionally infringes upon First Amendment freedoms of speech and free exercise of religion.**

It is unconstitutional and directly contrary to the Lanham Act for a party or person to have a monopoly over a religious faith or religious beliefs. *See New Thought Church v. Chapin*, 159 A.D. 723, 724-25 (N.Y. App. Div. 1913); *TE-TA-MA*, 297 F.3d at 666–67 (addressing possibility of the misuse of

trademark law to “appropriate a theology”). Under no circumstances is a religious monopoly the intent or purpose of U.S. trademark law, and trademark law should not be permitted to be twisted to this effect. *McCarthy* § 12:2; *TE-TA-MA*, 297 F.3d at 666–67.

As has often occurred with GCCSDA, Professor Russell explains that “a ‘senior’ organization taking priority over a [religious] name as a trademark impedes another’s future religious freedoms.” 41 *TTABVUE* 15, 2-26 (*Ex. 12.*)(*N. Cameron Russell Law Review Article*) “[W]ith 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.” *Id.*

As Judge Hohein explained in *Stocker*, “a religion itself is neither ‘goods’ nor ‘services’ within the statutory framework of the Lanham Act, [and] a name originated for a new religion, including the adjectival form thereof, is inherently unregistrable for the religion inasmuch as it cannot function either as a trademark.” *Stocker*, 1996 WL 427638 at \*22 (Hohein, J.) (Dissent) (finding “Seventh-Day Adventist” to be generic where the majority found the broader “Adventist” to be generic). It follows, then, that it is a corruption of trademark law to be weaponized to prohibit, limit, or influence the practice or expression of religion.

Excluding practitioners of the Adventist faith from using the term in connection with religious goods and services unconstitutionally infringes upon the fundamental First Amendment freedoms of speech and free exercise of religion. *U.S. Const., amend. I.* “[A registrant has no right to a monopoly of the name of a religion [because] members of the same religion have an equal right to use the name of the religion.” *McDaniel v. Mirza Ahmad Sohrab*, 27 N.Y.S.2d 525, 527 (1941); *Purcell v. Summers*, 145 F.2d 979 (1944) (finding “Methodist” and “Episcopal” to be generic). Accordingly, though its jurisdiction may be limited to the registration of trademarks, public policy and constitutional

considerations must inform the Board's decision. Each weigh in favor of a genericness determination by the Board and cancellation of Reg. Nos. 1,218,657 and 1,176,153.

**j. Liberal standing requirements benefit the public, and Petitioner possesses a personal stake and real interest in the outcome of this proceeding.**

As a peripheral matter, GCCSDA's continued assertion that Petitioner lacks standing is indicative of its need to avoid the merits of this case. GCCSDA has challenged Petitioner's standing without avail throughout each stage of this petition to cancel. *See 14 TTABVUE (Motion to Dismiss Decision); 30 TTABVUE (Summary Judgment Decision)*. Petitioner's standing has been argued, considered by the Board, and resolved at the motion to dismiss and summary judgment stages in favor of Petitioner. *Id.* The Board already found that, in explicitly alleging that it is the rightful owner of a property, namely, the domain name Adventist.com, Petitioner has shown that: (1) Petitioner has a real commercial interest in said property; (2) that said property has value in its business; (3) that its ownership of said property is impacted by threat of potential legal action by GCCSDA; and (4) that the value of said property has depreciated. *See 14 TTABVUE (Motion to Dismiss Decision); 30 TTABVUE (Summary Judgment Decision)*. The facts and circumstances have not changed since the Board's decisions, irrespective of the evolving standard of review.

Nonetheless, standing is established and applied as follows. "In the Lanham Act, both the opposition provisions and the cancellation provisions speak of "belief" in "damage" by the Opposer or Petitioner. *McCarthy* § 20:7. "Standing to petition to cancel and standing to oppose are [thus] based on the same criteria." *Id.*; *see also Ritchie v. Simpson*, 170 F.3d 1092, 1095, n.2, 50 U.S.P.Q.2d 1023, n.2 (Fed. Cir. 1999) (standing requirements for opposition and cancellation construed "consistently."); *Young v. AGB Corp.*, 152 F.3d 1377, 1380 (Fed. Cir. 1998) ("The linguistic and functional similarities between the opposition and cancellation provisions of the Lanham Act mandate that we construe the requirements of these provisions consistently.").

To establish standing, a petitioner must prove that it has a “real interest” in the proceedings and a basis for its belief of damage that has a “reasonable basis in fact.” *Ritchie*, 170 F.3d at 1095. “[A] petitioner asking for cancellation need not plead or prove actual damage.” *McCarthy* § 20:46; *see also Golden Gate Salami Co. v. Gulf States Paper Corp.*, 51 C.C.P.A. 1391, 332 F.2d 184, 188, 141 U.S.P.Q. 661 (1964) (“There would seem to be a very real difference between a statutory provision referring to a belief in damage, which is all we have, and a provision requiring proof of damage, which we do not have.”); *Montecash LLC v. Anzar Enterprises, Inc.*, 95 U.S.P.Q.2d 1060, 1062, 2010 WL 1847596 (T.T.A.B. 2010) (“The focus must be on whether petitioner has shown a reasonable basis for its belief in damage, and there is no requirement that any actual ‘damage’ be pled or proved to establish standing or even to prevail in a cancellation proceeding.”).

“Although the standard is low, the belief in damage resulting from registration must be objectively reasonable.” *NSM Resource Corp.; Huck Doll LLC v. Microsoft Corp.*, 113 U.S.P.Q.2d 1029, 2014 WL 7206403 (T.T.A.B. 2014). “Traditionally, all [a] petitioner need [ ] are facts supporting a reasonable belief that there is a likelihood of damage caused by the continuing registration of the mark.” *McCarthy* § 20:46; *see e.g., Texas Department of Transportation v. Richard Tucker*, Cancellation Nos. 92030882 and Opposition No. 91165417 (T.T.A.B. 2010) (party had standing to cancel registration by virtue of being the defendant in another proceeding because the registrant had actually asserted its registration against the petitioner).

“The requirement for standing is fairly easy to satisfy in the vast majority of [cancellation] cases.” *McCarthy* § 20:46. “The Federal Circuit and its predecessor court [believe] the public interest is served in “broadly interpreting the class of persons Congress intended to be allowed to institute cancellation proceedings.”” *Id.*; *see Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 1030, 213 U.S.P.Q. 185 (C.C.P.A. 1982). “The requirements for standing to oppose over the years have [thus]



become progressively less restrictive.” *McCarthy* § 20:46. McCarthy accordingly explains that “[i]f a [cancellation] is dismissed on the standing . . . it may well be that such a decision prevents someone from raising a valid claim that a mark about [that] suffers from a fatal defect under the law and should not be given federal registration.” *Id.* § 20:7.

“The purpose of the standing requirement in [ ] cancellation proceedings [exists] to prevent a ‘mere intermeddler’ from initiating such a proceeding.” *Id.*; see also *Estate of Biro v. Bic Corp.*, 18 U.S.P.Q.2d 1382, 1991 WL 325858 (T.T.A.B. 1991) (“[T]here is a low threshold for a plaintiff to go from being a mere intermeddler to one with an interest in the proceeding...”) “To establish standing [in a cancellation proceeding, the [petitioner] need only be something more than a gratuitous interloper or a vicarious avenger of someone else's rights.” *McCarthy* § 20:7. A “gratuitous interloper”<sup>6</sup> or “mere intermeddler”<sup>7</sup> is someone “[without] a personal interest in the outcome beyond that of the general public.” *Lipton Industries*, 670 F.2d at 1028. “Since ‘mere intermeddlers’ only rarely bring such challenges, few proceedings are ever dismissed for lack of standing and a challenge to standing is usually just a futile procedural gesture.” *Id.*

As the owner of Adventist.com, Petitioner unquestionably has personal interest in the cancellation of Reg. Nos. 1,218,657 and 1,176,153 for “Adventist” beyond that of the general public. See 15 TTABVUE 2-4 (¶¶ 1-11) (Ex. A – D (*Pet. ’s 2<sup>nd</sup> Amended Petition to Cancel*) and 17 TTABVUE

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<sup>6</sup> The rare “gratuitous interloper” was found in *Robert Doyle v. Al Johnson’s Swedish Restaurant & Butik, Inc.*, 101 U.S.P.Q.2d 1780, 2012 WL 695211 (T.T.A.B. 2012). In *Doyle*, the petitioner lacked standing because his alleged injury was being unable to take photographs of goats on the roof of registrant’s restaurant. See *McCarthy* § 20:46. The registration was for a restaurant with a grass roof with goats grazing on it. See *id.*. Because the registration did not keep the petitioner from taking such photos there were neither damages in this manner nor a real controversy between the parties. See *id.*

<sup>7</sup> The rare “mere intermeddler” was found in *NSM Resource Corp.; Huck Doll LLC v. Microsoft Corp.*, 113 U.S.P.Q.2d 1029, 2014 WL 7206403 (T.T.A.B. 2014). In *Huck Doll* “a petition to cancel Microsoft’s registration for the XBOX 360 mark was dismissed for failure of petitioner to allege standing because petitioner’s HUCK trademark was so dissimilar from the challenged XBOX 360 that there was no objective possibility of a likelihood of confusion.” *McCarthy* § 20:7.

2-4 (¶¶ 1-11) (*GCCSDA's Answer*). Two weeks after purchasing Presbyterian.com, at the online auction platform, NameJet, Petitioner then purchased Adventist.com in a separate auction, competing against eighty-one (81) other bidders. Five months later, on November 10, 2016, Petitioner received a cease and desist letter from GCCSDA alerting Petitioner to GCCSDA's ownership of the challenged registrations and demanding that Petitioner consequently immediately surrender ownership of Adventist.com for no consideration. *See id.*

The cease and desist letter asserted that GCCSDA possesses the "exclusive right to use the mark 'Adventist' for various religious purposes" and that this right permits it "to prevent third parties from using any similar name or mark that is likely to cause confusion, such as the domain name located at: Adventist.com." *See id.* The letter accused Petitioner of "intentionally trading on the goodwill of the [GCCSDA] by using a trademark that is confusingly similar" to the challenged marks, alleging that "The domain name ADVENTIST.com confuse[d] and misdirect[ed] customers seeking GCCSDA's website to Philanthropist.com's website," which GCCSDA wrote "is actionable under federal law." *See id.*

The letter further warned Petitioner that GCCSDA may "enforce its legal rights" against Petitioner by seeking remedies for "trademark infringement and dilution" and "including, but not limited to," preliminary and permanent injunctive relief, money damages, attorneys' fees" and "possible treble money damages." *See id.* GCCSDA further informed Petitioner that GCCSDA was "prepared to file a lawsuit if necessary, to protect its rights and business." *See id.* True to its written threats, the next month GCCSDA commenced a proceeding against Petitioner under ICANN's Uniform Domain-Name Dispute-Resolution Policy ("UDRP"), asserting Reg. Nos. 1,218,657 and 1,176,153 as grounds to seize Petitioner's property. *See id.*

While Petitioner's legitimate and rightful ownership of Adventist.com was upheld in the UDRP proceeding, Petitioner remains under threat. GCCSDA's cease and desist letter explicitly specifies that it

may take “[action] under federal law” and that it may seek “preliminary and permanent injunctive relief, money damages, attorneys' fees and possible treble money damages.” *See id.* ICANN is not a federal court or agency, but rather a private organization with international stakeholders, and UDRP proceedings are limited to resolving disputes concerning top-level domains.

There is no dispute that Petitioner sells domain names and owns Adventist.com, and GCCSDA’s actual initiation of the UDRP proceeding against the Petitioner shows GCCSDA’s willingness and ability to follow through on its threats of litigation. These threats are not hollow. Damage to the Petitioner is not merely hypothetical but based on its continued ownership of, and commercial interest in, the domain name Adventist.com, the continued threat of potential legal action by GCCSDA, and depreciation in the value of the domain. *See id.* Moreover, GCCSDA has never recanted its threats and, even if it did, they are easily re-alleged or commenced in the future against Petitioner or any future owner of Adventist.com.

Any assertion by GCCSDA that there is no longer any threat or harm to Petitioner because the UDRP matter has resolved is equally hollow. In its cease and desist letter, GCCSDA expressly identified taking action in *federal court* and implicated claims and relief that cannot be achieved through a UDRP proceeding, including infringement and dilution claims and obtaining injunctive relief and money damages. Thus, Petitioner (and/or any prospective buyer of Adventist.com) then has notice that expensive and prolonged litigation concerning the domain looms. *See Ritchie*, 170 F.3d at 1095 (a petitioner possesses standing if it has a real interest” in the proceedings and belief of damage that has a “reasonable basis in fact”); *McCarthy* § 20:46 (“[A] petitioner asking for cancellation need not plead or prove actual damage.”). Presumably, no buyer of Adventist.com desires to purchase the domain only to find itself as the target of legal action or the threat of legal action from the aggressive and well-resourced GCCSDA. Consideration of the same unquestionably factors into the commercial value and

transactional price for the domain name, and Petitioner holds a *good faith duty* to disclose the threat of litigation to any prospective buyer.

Simply stating—in an attempt to manufacture a standing defense and avoid litigating the merits of the case—that there is no “active threat to bring a federal action for trademark infringement against Petitioner” does not eradicate Petitioner’s standing. It is merely convenient pretext. The statement itself includes the term “*active threat*” which implies “not at this present time but possibly in the future.” GCCSDA’s self-serving statement hardly removes the possibility of future litigation. By GCCSDA’s design, Petitioner could not credibly raise GCCSDA’s statement that there is no “active threat” as evidence of a waiver of claims or a release from liability against an infringement or dilution suit.

While Petitioner may be on the front side of the *versus* in the above case caption, its Petition to cancel Reg. Nos. 1218657 and 1176153 arises from GCCSDA’s engagement of the Petitioner with the threat of and then actual litigation. Petitioner, or any subsequent buyer or owner of Adventist.com, cannot benefit from quiet enjoyment of the domain without removing the threat of expensive and time-consuming litigation. Cancellation of the subject marks achieves this. Clearly then, Petitioner cannot be a “gratuitous interloper” or “mere intermeddler” because it has a “personal interest in the outcome [of this proceeding far] beyond that of the general public.” See *Lipton Industries*, 670 F.2d at 1028; *McCarthy* § 20:7 (liberal standard for standing in cancellation proceedings for policy reasons and in practice). Further, it is logically untenable for GCCSDA to simultaneously claim that it is harmed by Petitioner’s ownership of Adventist.com *but also that* Petitioner lacks a real interest in this proceeding.

As of the date of submission of this Trial Brief, Petitioner: (1) remains the owner of Adventist.com; (2) continues to have a real commercial interest in the domain; (3) the domain continues to have value for Petitioner’s business; (4) Petitioner’s ownership of the domain continues to be impacted by threat of potential legal action by GCCSDA; and (5) the value and transferability of the

domain has been negatively affected by GCCSDA's ongoing claim to the word "Adventist" and threat to any third-party purchaser who may subsequently own and/or use it. *See* 15 TTABVUE 2-4 (¶¶ 1-11)(Ex. A – D (*Pet. 's 2<sup>nd</sup> Amended Petition to Cancel*) and 17 TTABVUE 2-4 (¶¶ 1-11)(*GCCSDA 's Answer*). Petitioner is not a "mere intermeddler" and possesses standing to bring this lawsuit, certainly under the liberal standard for standing in cancellation proceedings. Finding otherwise denies the Board the opportunity to scrutinize whether Reg. Nos. 1,218,657 and 1,176,153 suffer from a "fatal defect under the law and should not be given federal registration" and for the public to benefit from that evaluation. *McCarthy* § 20:7.

#### V. CONCLUSION

For the reasons articulated herein, the Petitioner meets its burden and respectfully requests that this Board CANCEL Reg. Nos. 1,218,657 and 1,176,153 pursuant to Section 14(3) of the Lanham Trademark Act of 1946.

Respectfully submitted,  
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**CERTIFICATE OF SERVICE**

I, C. Alexander Chiulli, hereby certify that a true copy of the foregoing document has been served this 5<sup>th</sup> day of June 2020 by electronic mail on:

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