

4-1-2013

Protecting Religious Identity with American Trademark Law

Steven John Olsen

Follow this and additional works at: <https://scholarship.kentlaw.iit.edu/ckjip>



Part of the [Intellectual Property Law Commons](#)

Recommended Citation

Steven J. Olsen, *Protecting Religious Identity with American Trademark Law*, 12 Chi.-Kent J. Intell. Prop. 129 (2013).

Available at: <https://scholarship.kentlaw.iit.edu/ckjip/vol12/iss1/5>

This Article is brought to you for free and open access by Scholarly Commons @ IIT Chicago-Kent College of Law. It has been accepted for inclusion in Chicago-Kent Journal of Intellectual Property by an authorized editor of Scholarly Commons @ IIT Chicago-Kent College of Law. For more information, please contact jwenger@kentlaw.iit.edu, ebarney@kentlaw.iit.edu.

PROTECTING RELIGIOUS IDENTITY WITH AMERICAN TRADEMARK LAW

Steven John Olsen*

“Obviously, the question of what is unfair competition in business must be determined with particular reference to the character and circumstances of the business.”¹

Introduction

In the early fifth century BC, a group of theologians began discussing the purpose of the universe.² They discussed the creation of the world, the purpose of the corporeal life, and the existence of an afterlife. These discussions quickly led to a set of beliefs focused on an identified creator of all things. News of these discussions spread throughout the country and the populace began to agree with the theologians’ beliefs. Devotional and ritual observances began to spread among the followers. The people of the country declared these beliefs as a religion known as Servyism.

As Servyism became more popular it began to spread beyond the country’s borders. The theologians founded a religious organization to provide guidance in the ways of Servyism: Servyism Mother Church. The organization, as the term mother church in contemporary usage describes, was used to create the tenets of Servyism, develop religious practices, and develop spiritual leaders for the ministry. Throughout the remaining portion of the fifth century BC, groups led by the Servyism Mother Church’s spiritual leaders devoted their lives to the Servyism faith. The followers began to view the term “Servyism” as a source identifier of the religious organization in addition to the religion itself.

During the turn of the fourth century BC, two groups of Servyism followers began taking issue with some of the ideological beliefs proclaimed by the Servyism Mother Church. These groups each broke away from the founding organization and began their own organizations: Holy Obeyist Church of Servyism and Exalted Church of Servyism. They professed very similar ideological beliefs to the Servyism Mother Church with only a few distinct differences. The Exalted Church of Servyism proclaimed that its followers would receive greater honor in the afterlife compared to followers of other Servyism branches. The Holy Obeyist Church of Servyism disagreed with the Servyism Mother Church’s use of parishioner donations. All three religious organizations continued to grow throughout the country. They all believed in spreading the faith among the entire populace. As the faith spread, the public began to identify the names of the three religious organizations as representing distinct branches (organizations) of the

* Steven John Olsen is a third-year associate at Yoder Ainlay Ulmer & Buckingham, LLP. He is licensed to practice law in Indiana and Michigan. His practice areas include, among other areas, corporate law and trademark protection and enforcement. He is a former adjunct professor of legal brand management for the Masters of Business Administration program at Valparaiso University. He can be reached at solsen@yaub.com.

¹ Int’l News Service v. Associated Press, 248 U.S. 215, 236 (1918).

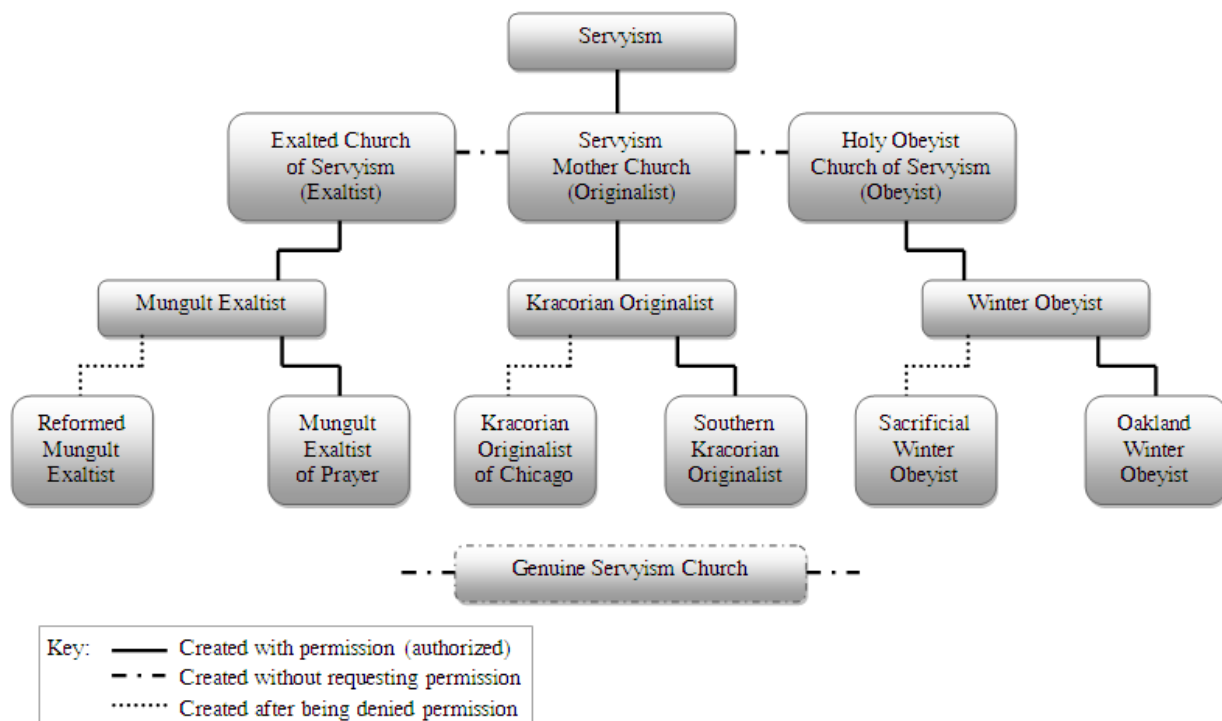
² The facts developed by the author in this introductory hypothetical are fictional and do not represent the history or background of any specific religion.

Servyism religion. The organizations and the public began to use the terms “Originalist,” “Obeyist,” and “Exaltist” to identify each respective organization.

As the third century BC approached, limbs of each branch began to grow. These limbs embraced the general ideological beliefs of each of the branches, but maintained a set of individual beliefs separate from those of the founding organizations. The branches accepted the limbs as authorized extensions of the religious organizations. A few of the sprouting limbs included the “Kracorian Originalist,” the “Winter Obeyist,” and the “Mungult Exaltist.” The public began viewing the terms as identifiers for the specific religious organizational limbs associated with their respective organizational branches within the Servyism faith.

By the second century BC, followers of the limbs began requesting permission to use the terms associated with the branches and limbs in their local churches. Some of these requests were granted and others were denied. Of those granted, some added regional or local terms to the name, such as “Southern Kracorian Originalist” and “Oakland Winter Obeyist”; while others added general religious terms to the name, such as ”Mungult Exaltist of Prayer.” Some of those who were denied permission to associate chose to ignore the denial and use the branch and limb names in their church: “Sacrificial Winter Obeyist,” who wanted to add human sacrifices; “Reformed Mungult Exaltist,” who wanted to preach a one race philosophy; and “Kracorian Originalist of Chicago,” who approved some criminal activities. Simultaneously, a group of non-believers formed the “Genuine Servyism Church,” whose purpose was to profess beliefs contrary to those of the Servyism faith.

Strife was building among and between the religious entities. The Servyism Mother Church wanted to prevent the development of additional branches of Servyism by preventing the Holy Obeyist Church of Servyism and Exalted Church of Servyism from using the term Servyism in their organizational names. After each was formed, they individually with their respective limbs wanted to prevent all denied parties from using their names in unaffiliated churches. Finally, every other branch and limb wished to prevent the “Genuine Servyism Church” from using the term Servyism in its religious organization.



I. Understanding the Context of Religious Trademarks

Before determining if any of the religious organizations described in the Servyism hypothetical can prevent another from using its terms, one must fully understand the context of religious trademarks. This context will be viewed in three separate parts. The first part discusses religion in the legal system and the structure of religious trademark infringement suits. The second part identifies marks worthy of trademark protection. It begins by discussing the scales of distinction generally; next, it analyzes tests for determining the genericness of a mark including an identification of the relevant public; finally, it discusses the distinctiveness of religious marks with a specific emphasis on denominations and religions. The third part then assesses religious trademark deception and consumer confusion.

A. Religion in the Legal System

Civil courts may resolve property disputes between religious organizations, but may not make rulings as to internal ecclesiastical matters.³ On internal religious issues, civil courts should accept the rulings made within the established religious organization's decision-making body.⁴ "Thus no First Amendment issue arises when a court resolves a church property dispute by relying on state statutes concerning the holding of religious property, the language in the relevant deeds, and the terms of corporate charters of religious organizations."⁵ Since civil courts are not allowed to make an ecclesiastical exception to neutrally applicable laws, religious organizations have been instructed by courts to include their requirements for treating religious property within "such instruments as 'deeds or the corporate charter.'"⁶ These property protection techniques have been successfully used in the trademark context.⁷

In these cases, plaintiffs "are not seeking to interfere with Defendants' worship services or religious beliefs or practices."⁸ In trademark law, a religious organization is welcome to take the religious beliefs and practices (the good) and start a competing religious organization, but they are not allowed to take the good will or identity of another. Under this theory, a competing organization may take the tenets, purpose, and beliefs of another, but cannot refer to their new organization with the competing trademark or source identifier.⁹ As the United States Court of Appeals for the Fourth Circuit has clearly stated:

³ Sinkler v. Goldsmith, 623 F. Supp. 727, 729 (D. Ariz. 1985).

⁴ Maktab Tarighe Oveyssi Shah Maghsoudi, Inc. v. Kianfar, 179 F.3d 1244, 1248 (9th Cir. 1999) ("Civil courts . . . may defer[] to the decision-making authorities of hierarchical churches.").

⁵ *Id.* at 1249.

⁶ *Id.* at 1250 (quoting Jones v. Wolf, 443 U.S. 595, 606 (1979)).

⁷ Sovereign Order of Saint John of Jerusalem, Inc. v. Grady, 119 F.3d 1236, 1239 (6th Cir. 1997). The Sovereign Order of Saint John of Jerusalem prevented previously denied individuals from using the organization's mark to overtake those members actually chosen to maintain control of the religious organization. *Id.*

⁸ Cmty. of Christ Copyright Corp. v. Miller, No. 07-0543-CV-W-GAF, 2007 WL 4333192, at *2 (W.D. Mo. Dec. 7, 2007).

⁹ Nat'l Bd. of YWCA v. YWCA of Charleston, S.C., 335 F. Supp. 615, 624–25 (D.S.C. 1971), *quoted in* Gen. Conference Corp. of Seventh-Day Adventists v. Perez, 97 F. Supp. 2d 1154, 1164 (S.D. Fla. 2000).

The right to use the name inheres in the institution, not in its members; and, when they cease to be members of the institution, use by them of the name is misleading and, if injurious to the institution, should be enjoined. No question of religious liberty is involved. Men have the right to worship God according to the dictates of conscience; but they have no right in doing so to make use of a name which will enable them to appropriate the good will which has been built up by an organization with which they are no longer connected.¹⁰

Trademark disputes over the use of a religious name are most likely to occur in one of four different circumstances: (1) religious groups of similar ideological beliefs with some distinctive differences, (2) religious groups with conflicting ideological beliefs, (3) religious groups and those organizations that may disprove or disparage the religion, and (4) religious groups against secular organizations unrelated to the ideological beliefs.¹¹ The first category is the most common and is most likely to confuse parishioners;¹² however, each category threatens the identity of a religious mark and must be considered individually. Nonetheless, these categories are only considered upon first concluding that the religious mark, representing the identity of the religious entity, is worthy of trademark protection.

B. Identifying Marks Worthy of Trademark Protection

Before determining the likelihood of consumer confusion in any given factual situation, a court must determine if the mark in question deserves trademark protection. A religious organization must first use the mark as a source identifier before it can receive any protection.¹³ This alone is not enough, a mark must also be considered distinctive before it can receive trademark protection.

1. The Scales of Distinction

Once a court has determined that a mark has been used as a source identifier, it will then determine where the mark falls within the scales of distinction. The scales of distinction are used to determine the strength of the mark and the level of protection the mark is guaranteed.¹⁴ If the mark is registered then it is presumed to be valid and deserving of trademark protection;¹⁵ however, in an unregistered trademark infringement case, the case will be dismissed if the

¹⁰ Purcell v. Summers, 145 F.2d 979, 987 (4th Cir. 1944).

¹¹ See David A. Simon, *Register Trademarks and Keep the Faith: Trademarks, Religion and Identity* 49 IDEA 233, 264 (2009) (recognizing the former three categories).

¹² When religious groups exist that retain similar ideological beliefs with some distinctive differences, trademark infringement litigation can arise in a variety of circumstances: (1) a part of the religious followers break away from the religious organization, (2) a new and distinct religious organization is created by parties outside the original religious organization, (3) a religious assembly requests affiliation with the religious organization but is excluded, (4) a religious organization revokes the trademark rights of a current affiliate or (5) a unified mother organization is created from pre-existing religious organizations. *Id.* at 268.

¹³ See *Foremaster v. City of St. George*, 882 F.2d 1485, 1491–92 (10th Cir. 1989) (discussing whether the St. George of Ladder Day Saints Temple is a “universally identified symbol of Mormonism”).

¹⁴ See *infra* notes 17–20 and accompanying text (outlining each of the levels for which a mark may qualify on the scales of distinction).

¹⁵ 15 U.S.C. § 1115(a) (2012).

plaintiff does not allege that their trademark is inherently distinctive or has acquired secondary meaning.¹⁶

The lowest level mark of distinction is classified as a generic mark, “a designation that is understood by prospective purchasers to denominate the general category, type, or call of the goods, services, or business,” which receives no protection under the United States system of trademark law.¹⁷ The second level includes descriptive marks, a mark that a prospective purchaser will likely perceive as a mere description “of the nature, qualities, or other characteristics of the goods, services, or business with which it is used,” which only receives trademark protection upon a valid showing of secondary meaning.¹⁸ The third level includes suggestive marks, which require consumer imagination to understand the connection between the mark and the product, service or business, but do not require secondary meaning in order to receive trademark protection.¹⁹ The final and most distinctive level includes arbitrary and fanciful marks, which can include common words applied to a product, service, or business unrelated to its meaning or completely new words with no present meaning.²⁰ Of these distinctions religious marks are generally classified within the first three categories.

“Religious organizations frequently use terms of faith within their names, leaving them particularly susceptible to [distinction] problem[s].”²¹ The most difficult problem courts face in a religious trademark case is determining if a mark is generic. “A review of the genericness cases involving religious institutions reveals mixed results.”²² Each of the following marks has been declared generic by one court and distinctive by another: (1) Christian Science, (2) Baha’i, and (3) Self-Realization.²³ These discrepancies cause particular concern because a single court can declare that a mark is or has become generic, call for the cancellation of the mark, and recognize the unenforceable nature of the generic mark.²⁴ Therefore, prior to challenging another’s unauthorized use of a religious entity’s source identifier, a plaintiff must be prepared to argue that the mark is not generic under any current test.

¹⁶ See *Douglas v. Osteen*, 317 Fed.App’x 97, 99–100 (3d Cir. 2009) (dismissing the plaintiff’s case for failing to allege that his trademarked phrase “eyes of faith” was distinctive).

¹⁷ RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 15(1) (2008).

¹⁸ *Id.* § 14. See *infra* notes 71–76 and accompanying text (discussing secondary meaning).

¹⁹ See *Am. Television & Commc’ns Corp. v. Am. Commc’ns & Television, Inc.*, 810 F.2d 1546, 1549 (11th Cir. 1987).

²⁰ See *Sullivan v. CBS Corp.*, 385 F.3d 772, 776 (7th Cir. 2004) (classifying the term “survivor” as arbitrary when applied to a band because the term is applied to a service unrelated to its meaning); *Field Enters. Educ. Corp. v. Cove Indus., Inc.*, 297 F. Supp. 989, 994 (E.D.N.Y. 1969) (explaining how fanciful and coined words are strong marks protected against all users, but that “World Book” is neither fanciful nor coined because it described the work itself as a book including the relevant knowledge of the world). See *generally* RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 13 cmt. (c) (2008) (articulating the reasons why fanciful, arbitrary, and suggestive marks are declared inherently distinctive).

²¹ *Simon*, *supra* note 11, at 247.

²² *Stocker v. Gen. Conference Corp. of Seventh-Day Adventists*, 39 U.S.P.Q.2d 1385, 1996 WL 427638, at *8 (T.T.A.B. Apr. 25, 1994) (citations omitted).

²³ *Id.* (citations omitted).

²⁴ *TE-TA-MA Truth Found.–Family of URI, Inc. v. World Church of the Creator*, 297 F.3d 662, 665 (7th Cir. 2002). A court is given two options upon determining that plaintiff’s registered mark is generic in the context for which it is used: (1) a court may order the agency to cancel the mark or (2) the court may cancel the mark determining the right to registration itself. 15 U.S.C. § 1119 (2006), *cited in TE-TA-MA Truth*, 297 F.3d at 665.

2. Current Tests for Determining if a Mark is Generic

There are various tests used when determining if a mark is or has become generic. Courts regularly analyze whether the term is a noun or adjective, whether additional terms exist to describe the good, and whether the name is commonly used to describe the good itself or a class of goods. Under the first test, a trademark must be an adjective or adverb and cannot be considered a noun. When used, a mark should be capitalized or otherwise set apart from the generic term or noun used to describe the particular good or service.²⁵ This distinction, however, is not as relevant in the religious context because “religions and their adjectival forms are always capitalized” in the English language.²⁶ Identifying the noun within the religious context is very challenging. Accordingly, a plaintiff may argue that this test should not be applied to religious marks.

The second test requires the court to determine if other terms exist which can be used to describe the good. This test supports government policy against granting monopolistic use of the only word or phrase capable of describing a specific product or service. If additional terms are available, then the trademark will not likely be classified as generic.²⁷ This analysis was performed in *Jews for Jesus*, where the United States District Court for the District of New Jersey suggested several ways to describe “individuals of Jewish heritage who believe in Jesus.”²⁸ In explaining the relevance of alternatives to the court’s determination of distinctiveness, the court notes that a generic mark has so few alternatives as to create a monopoly while “a descriptive mark ‘leaves a larger but finite set of equivalent alternatives’ ”²⁹ Consequently, a plaintiff must be prepared to show alternative ways to describe the good it offers.

The third test provides that a mark is or has become generic when it is the name of the product itself or the name of a class of products.³⁰ This test is easily applied to the general marketplace of goods and services. For instance, a company could not trademark the word book, computer, chair, massage, taxi, or therapy as each of these are the common name for the product or service itself. Additionally, a term does not escape a generic classification because it represents a class of products or services such as jewelry or doctor. In the religious context, one could not trademark the word “church” by itself as it represents the name for a class of services.³¹ Nonetheless, the existence of a term in the religious context that is itself a clear identification of a class of services is a rarity. Thus, a plaintiff may argue that this test is too simplistic for religious marks.

²⁵ *Stocker*, 1996 WL 427638, at *28 (Hohein, J., dissenting).

²⁶ *Id.*

²⁷ *TE-TA-MA Truth*, 297 F.3d at 667 (“[T]here is no risk that exclusive use of ‘Church of the Creator’ will appropriate a theology or exclude essential means of differentiating one set of beliefs from another.”).

²⁸ *Jews for Jesus v. Brodsky*, 993 F. Supp. 282, 297 (D.N.J. 1998).

²⁹ *Id.* (quoting *Duraco Prods., Inc. v. Joy Plastic Enters., Ltd.*, 40 F.3d 1431, 1442 (3d Cir. 1994)).

³⁰ See *TE-TA-MA Truth*, 297 F.3d at 666.

³¹ See *id.*

The final test, which is performed by many courts, is the written appearance test. This test analyzes how the word appears within various documents: dictionary, encyclopedia, newspaper, or magazine. Courts recognize that it is unlikely that a trademark has become synonymous with the product and not the producer, if it is not included in any dictionary.³² However, this alone cannot be the test for genericness as courts are unwilling to bestow such power upon lexicographers.³³

The United States Court of Appeals for the Seventh Circuit has noted that using individual definitions of each word within a composite mark carries little weight because “dictionaries reveal a range of historical meanings rather than [defining] how people use a particular phrase in contemporary culture.”³⁴ The court noted that “lexicographers’ definitions” of the individual words in the mark “Church of the Creator,” like the phrase “cut the mustard,” do not properly reveal the contemporary meaning of the term or phrase.³⁵ Additionally, the United States Court of Appeals for the Ninth Circuit has clearly stated that it is improper for a court to use a ruling on the validity or distinctiveness of component parts to determine the validity or distinctiveness of a composite term.³⁶ This ruling was used to overturn the lower courts holding that the mark “Self-Realization Fellowship Church” was generic because the terms “self-realization,” “fellowship,” and “church” when used alone were generic.³⁷ However, the Trademark Trial and Appeal Board rightfully continues to use dictionary definitions of each word as evidence of the composite words meaning within the context of the relevant public’s contemporary usage.³⁸ The Board also regularly refers to how the organization itself uses the phrase as well as what third parties (*i.e.*, printed publications or competitors) are referencing when using the phrase.³⁹ As a result, plaintiffs should be prepared to explain all written appearances of their religious marks.

Ultimately, these tests are used by the courts to determine the relevant public’s perception of the mark. It has been suggested that the noun/adjective test, alternative names test, and written appearance test are inappropriate when used individually because they are mechanistic tests which do not properly account for the factual circumstances of each case.⁴⁰ Similarly, these tests are not determinative individually, but should be used as “‘springboards for analysis’” in identifying the relevant public’s perception of a mark.⁴¹

³² *E.g.*, *Urantia Found. v. Maaherra*, 895 F. Supp. 1338, 1343 (D. Ariz. 1995).

³³ *See In re Minnetonka, Inc.*, 212 U.S.P.Q. 772, 778 (T.T.A.B. Dec. 4, 1981), *quoted in* *Stocker v. Gen. Conference Corp. of Seventh-Day Adventists*, 39 U.S.P.Q.2d 1385, 1996 WL 427638, at *15 (T.T.A.B. Apr. 25, 1994).

³⁴ *TE-TA-MA Truth*, 297 F.3d at 666.

³⁵ *Id.*

³⁶ *Self-Realization Fellowship Church v. Ananda Church of Self-Realization*, 59 F.3d 902, 912 (9th Cir. 1995).

³⁷ *Id.*

³⁸ *See, e.g., In re Missions Fest Int’l Assoc.*, No. 78631248, 2007 WL 2422989, at *3 (T.T.A.B. Aug. 23, 2007) (non-precedential).

³⁹ *Stocker v. Gen. Conference Corp. of Seventh-Day Adventists*, 39 U.S.P.Q.2d 1385, 1996 WL 427638, at *16 (T.T.A.B. Apr. 25, 1994).

⁴⁰ *Christian Sci. Bd. of Dirs. of First Church of Christ, Scientists v. Evans*, 520 A.2d 1347, 1359 (N.J. 1987) (Garibaldi, J., dissenting).

⁴¹ *Id.* (Garibaldi, J., dissenting) (quoting *Walt-West Enters. v. Gannett Co.*, 695 F.2d 1050, 1057 (7th Cir. 1982)).

3. Who is the Relevant Public?

When determining if a mark identifies the good itself, a court must consider the entire collection of potential clients: “the avid, the novice, and the not yet acquainted.”⁴² Courts discount a defendant’s argument that the religious audience targeted includes fewer members than that of the original mark holder; however, it would be inaccurate to suggest that this group includes the entire purchasing public.⁴³ The “potential clients” are limited to those who are likely to have an interest in the product or service being offered. The United States Court of Appeals for the Federal Circuit described this as limiting the relevant public to “actual or potential” clients of the specific services offered.⁴⁴ The Ninth Circuit recognized that “one term may have different meanings to different groups of listeners” and that “the way to determine whether a term is generic is to determine whether consumers of [those] products and services think it is generic.”⁴⁵ Accordingly, the relevant purchasing public or potential clients are determined on a case-by-case basis.⁴⁶ Once the relevant public is identified, a court can determine the contemporary meaning of a religious mark in the minds of that public.

4. Are Denominational Names Generic?

As previously noted, generic terms can be combined with other generic or more distinctive terms and the resulting composite term may be viewed in the eyes of the relevant public as distinctive and deserving of trademark protection.⁴⁷ This was the situation in *Te-Ta-Ma*, where the court recognized that “church” alone is generic, but “Church of the Creator” is descriptive.⁴⁸ The court reasoned that “Church of the Creator” does not denote the class of monotheistic religions or designate a specific religion for which a denomination belongs, but instead acts as a source identifier to differentiate an individual denomination.⁴⁹ Additionally, claims suggesting that the “Reorganized Church of Jesus Christ of Latter Day Saints” or the “RLDS Church” trademarks are generic have been found to be without merit because the trademarks represent a denomination of Christianity.⁵⁰ They are not RLDS, but men and women, and as such are called RLDS only because of membership and association with the

⁴² *Urantia Found. v. Maaherra*, 895 F. Supp. 1338, 1343 (D. Ariz. 1995).

⁴³ *See Jews for Jesus v. Brodsky*, 993 F. Supp. 282, 305 (D.N.J. 1998) (classifying the defendant’s argument that they only intended their audience to include Jewish apostates and not gentiles as “curious, at best”).

⁴⁴ *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 641 (Fed. Cir. 1991).

⁴⁵ *Self-Realization Fellowship Church v. Ananda Church of Self-Realization*, 59 F.3d 902, 909 (9th Cir. 1995).

⁴⁶ In determining whether the mark “self-realization” was the generic term for Hindu-Yoga spiritual organizations, the Ninth Circuit recognized that using persons with close association or intimate contact (*i.e.*, employees or distributors) as corroborating evidence is an inaccurate reflection of the relevant purchasing public. *Id.* at 910. The relevant public identified in one of the Seventh-Day Adventists cases was “Christians and, more specifically, Adventist Christians.” *Stocker*, 1996 WL 427638, at *11. This assessment, however, was highly criticized by the dissenting judge who suggested that the relevant public should be viewed as the general public because as a Protestant denomination, Seventh-Day Adventism is a proselytizing religion. *Id.* at *24 (Hohein, J., dissenting).

⁴⁷ *See In re Missions Fest Int’l Assoc.*, No. 78631248, 2007 WL 2422989, at *3 (T.T.A.B. Aug. 23, 2007) (non-precedential) (recognizing that two descriptive marks combined may create a separate nondescriptive meaning).

⁴⁸ *TE-TA-MA Truth Found.—Family of URI, Inc. v. World Church of the Creator*, 297 F.3d 662, 666 (7th Cir. 2002).

⁴⁹ *Id.*

⁵⁰ *Cnty. of Christ Copyright Corp. v. Miller*, No. 07-0543-CV-W-GAF, 2007 WL 4333192, at *2 (W.D. Mo. Dec. 7, 2007).

organization which has adopted that name.⁵¹ Nevertheless, some registrations within the United States Patent & Trademark Office currently include disclaimers for denominations while others do not.⁵²

In a seminal case on religious trademarks, the Fourth Circuit suggested, in dicta, that a third party may have the right to use denominational names like “Methodist” or “Episcopal” in its name so long as its name was constructed as to avoid confusion with other mark holders.⁵³ In contrast, three years later the Supreme Court of Pennsylvania determined that the denominational name “Church of God” could not be used by a defendant unaffiliated with the general assembly.⁵⁴ The court held that “defendants may not lawfully use the name ‘The Church of God,’ or any similar name, to designate any other denominational organization than that of the General Assembly.”⁵⁵ These discrepancies may be explained by the courts’ various interpretations of what a denomination represents in comparison to a religion. For instance, a dissenting judge has argued that “each religious denomination, while often sharing some of the basic beliefs as other groups, fundamentally has its own irreducible set of principles, tenets or precepts which collectively make the *religion* it offers one of a kind.”⁵⁶ By classifying denominations as new and different religions, the judge suggested that denomination names should not receive trademark protection as they are generic words for their specific religion.⁵⁷

This same argument has been made after the creation of a new religion, such as Christian Science. As new religions do not have denominations upon their creation, courts have suggested that the name adopted to refer to the religion cannot also be used as a trademark to refer to either the governing organization or a specific church.⁵⁸ Most courts have held that the name of a religion is available for all followers to use and that no one can hold a monopoly upon the name of a religion.⁵⁹ Nonetheless, the United States District Court for the Western District of North Carolina held the mark “Christian Science” as distinctive and worthy of protection after quoting, “Christian Science is a religion”⁶⁰ Given these discrepancies, it is important for courts to

⁵¹ See *Purcell v. Summers*, 145 F.2d 979, 987 (4th Cir. 1944); *Grand Lodge Improved, B.P.O.E. of the World v. Eureka Lodge No. 5, Indep. Elks*, 114 F.2d 46, 48 (4th Cir. 1940) (noting that men are only “Elks” when associated with the organization).

⁵² *Stocker v. Gen. Conference Corp. of Seventh-Day Adventists*, 39 U.S.P.Q.2d 1385, 1996 WL 427638, at *16 (T.T.A.B. Apr. 25, 1994) (noting that “Presbyterian” is disclaimed in Reg. Nos. 1,012,486 and 1, 431,066 while “Lutheran” is not disclaimed in Reg. No. 1,085,986).

⁵³ *Purcell*, 145 F.2d at 988.

⁵⁴ *Church of God v. Church of God*, 50 A.2d 357, 361 (Pa. 1947).

⁵⁵ *Id.*

⁵⁶ *Stocker*, 1996 WL 427638, at *31 (Hohein, J., dissenting) (emphasis added).

⁵⁷ *Id.*

⁵⁸ See *Christian Sci. Bd. of Dirs. of First Church of Christ, Scientists v. Evans*, 520 A.2d 1347, 1351 (N.J. 1987) (suggesting that the phrase signifying the name of a religion cannot be protected when applied to the name of a church).

⁵⁹ See *id.* at 1356 (citation omitted).

⁶⁰ *Christian Sci. Bd. of Dirs. of the First Church of Christ, Scientists v. Robinson*, 115 F. Supp. 2d 607, 609, 612 (W.D.N.C. 2000) (quotation and citation omitted). But see *Stocker*, 1996 WL 427638, at *15 (Hohein, J., dissenting). The court noted:

Similarly, since a religion itself is neither “goods” nor “services” within the statutory framework of the Lanham Act, 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

remember that in the context of churches and religious organizations only material including the term used for the religion is considered orthodox within that religion.⁶¹ Given this fact, some courts have suggested that a mark may be generic when used to refer to a religion, but distinctive when used as a church name.⁶² Anyone can use the term to refer to his or her religion, but not everyone should be allowed to name his or her church or organization with the term.⁶³ Therefore, a court may decide that although the plaintiff's mark is distinctive, the defendant uses the plaintiff's mark in its generic form and therefore does not infringe the mark.⁶⁴

5. *If Not Generic, are Religious Marks Descriptive or Suggestive?*

The line between descriptive and suggestive is just as blurry as the line between generic and descriptive. For instance, in the religious context, the United States District Court for the Southern District of Florida noted that the mark "Seventh Day Adventists" was suggestive even though the phrase describes elements of the faith.⁶⁵ The court reasoned that the mark only described two parts of the faith and did not properly describe the other beliefs which distinguish it from organizations of a similar faith.⁶⁶ The court used this reasoning to find the mark "clearly suggestive."⁶⁷ Conversely, the Trademark Trial and Appeal Board has noted that a mark does not have to describe all attributes associated with it to be classified as descriptive.⁶⁸ Instead, the mark need only describe a significant attribute of the product or service before it is declared descriptive.⁶⁹ For example, an examining attorney determined that the term "Kabbalah Red String" for religious articles by a "mystical segment of Jewish belief, Kabbalah," was merely descriptive because "the term as a whole would merely describe a [*single*] feature of the religious articles—items consisting or containing red string, used in the practice of Kabbalah or in support of Kabbalistic beliefs."⁷⁰

A mark classified as suggestive or better is inherently distinctive; however, if a mark is determined to be descriptive then a plaintiff must prove secondary meaning. Circuit courts are split when determining which factors to consider in a secondary meaning case.⁷¹ In *Jews for Jesus*, the court determined that the trademark "Jews for Jesus" was descriptive and therefore required secondary meaning before trademark protection could be granted.⁷² Secondary meaning

publications pertaining to the religion or as a service mark for religious observances and missionary services based upon the religion.

Stocker, 1996 WL 427638, at *15 (Hohein, J., dissenting).

⁶¹ See *Church of Spiritual Tech. v. United States*, 26 Cl. Ct. 713, 731 n.38 (1992).

⁶² *Gen. Conference Corp. of Seventh-Day Adventists v. Perez*, 97 F. Supp. 2d 1154, 1162 (S.D. Fla. 2000).

⁶³ *Evans*, 520 A.2d at 1358 (Garibaldi, J., dissenting).

⁶⁴ See *infra* text accompanying note 109 (providing an example).

⁶⁵ *Perez*, 97 F. Supp. 2d at 1159.

⁶⁶ *Id.*

⁶⁷ *Id.*

⁶⁸ *In re Missions Fest Int'l Assoc.*, No. 78631248, 2007 WL 2422989, at *1 (T.T.A.B. Aug. 23, 2007) (non-precedential).

⁶⁹ *Id.*

⁷⁰ U.S. PATENT & TRADEMARK OFFICE, OFFICE ACTION SER. NO. 76/490387, at 1–2 (Aug. 11, 2003), available at <http://www.thesmokinggun.com/file/kabbalah-gets-its-string-pulled>.

⁷¹ See generally Theodore H. Davis, Jr., *Trademark Infringement and Unfair Competition in the Courts of General Jurisdiction*, 98 TRADEMARK REP. 52, 76–85 (2008) (outlining the various tests used by courts).

⁷² *Jews for Jesus v. Brodsky*, 993 F. Supp. 282, 298 (D.N.J. 1998).

suggests that the consuming public views the mark as identifying the producer, not the product.⁷³ The *Jews for Jesus* Court used four factors to determine what the phrase “Jews for Jesus” means in the minds of the relevant consumers: (1) money spent on advertising, (2) media coverage of the religious organization and its attributes, (3) effectiveness of marketing efforts, and (4) length and extent of the marks continual use.⁷⁴ In addition to the factors analyzed in *Jews for Jesus*, courts regularly examine how many third parties are using similar marks and in what markets they are being applied.⁷⁵ Finally, the extent of the public to actually view the mark as a source identifier for the producer is regularly considered the most important factor.⁷⁶

Nonetheless, being recognized as a source identifier alone is not enough. For instance, in the religious context, if a mark is held by the relevant public to refer synonymously to the religion as well as the organization, a court may find that the mark has either only received *de facto* secondary meaning or is a dual-function mark. *De facto* secondary meaning arises in cases where the general public begins to view a generic term, which existed before it was first used as a mark, as a source identifier for a specific organization.⁷⁷ In this context, some scholars classify the mark as inherently generic rather than initially valid.⁷⁸ Once a court determines that a mark only possesses *de facto* secondary meaning then it will acknowledge that this does not create or preserve trademark rights for the mark.⁷⁹

This analysis was performed by the New Jersey Supreme Court when they determined that the Christian Science religion was founded at least thirteen years before the Mother Church, the religion’s principal organization.⁸⁰ Recognizing that “the religion pre-existed the organization” and that “the religion and the organization are conceptually separate” the court held the Christian Science mark to be generic as applied to all Christian Science churches.⁸¹ The court reasoned that this conclusion is true even when the Mother Church has been the exclusive supplier of the Christian Science religion.⁸² This reasoning is derived from our initial recognition that *de facto* secondary meaning does not grant exclusive rights upon the user. “Even though they succeed in the creation of *de facto* secondary meaning, due to a lack of competition or other happenstance, the law respecting registration will not give any effect.”⁸³

⁷³ *Id.*

⁷⁴ *See id.* at 298–99. The Court ultimately found that “Jews for Jesus” does not refer to messianic Jews in general, but identifies the plaintiff’s organization and its attributes. *Id.*

⁷⁵ *See* U.S. Conference of Catholic Bishops v. Media Research Ctr., 432 F. Supp. 2d 616, 619 (E.D. Va. 2006) (recognizing thirty-five third-party uses of the term CNS).

⁷⁶ Gen. Conference Corp. of Seventh-Day Adventists v. Perez, 97 F. Supp. 2d 1154, 1157 (S.D. Fla. 2000).

⁷⁷ Christian Sci. Bd. of Dirs. of First Church of Christ, Scientists v. Evans, 520 A.2d 1347, 1354 (N.J. 1987) (“[E]ven if that producer successfully establishes ‘*de facto*’ secondary meaning, it will not be recognized *de jure*.”).

⁷⁸ *See* Stocker v. Gen. Conference Corp. of Seventh-Day Adventists, 39 U.S.P.Q.2d 1385, 1996 WL 427638, at *30 (T.T.A.B. Apr. 25, 1994) (Hohein, J., dissenting). (“Thus, because the Seventh-day Adventist religion pre-existed the formation of the Seventh-day Adventist Church (as the General Conference is often informally referred to), it is clear that these proceedings involve a designation which was inherently generic rather than one which initially was a valid mark.”).

⁷⁹ *Id.* at *26.

⁸⁰ *Evans*, 520 A.2d at 1351.

⁸¹ *Id.*

⁸² *Id.* at 1353.

⁸³ *Id.* at 1354 (quoting Weiss Noodle Co. v. Golden Cracknel & Specialty Co., 290 F.2d 845, 848 (C.C.P.A. 1961)).

Distinguishable from those marks only capable of receiving *de facto* secondary meaning are those marks capable of becoming dual-function marks—those that refer generically to the product or service and simultaneously act as a source identifier for the producer.⁸⁴ These types of marks only exist when a mark was initially valid and not inherently generic.⁸⁵ When handling a dual-mark, a court must determine the primary significance of the mark in the mind of the consumer.⁸⁶ A court applies the same tests used when analyzing whether the mark was generic to determine a mark’s primary significance.

Fundamentally, a plaintiff must first prove that its religious mark is worthy of trademark protection. Religious marks that are inherently distinctive—arbitrary, fanciful, and suggestive marks—automatically qualify. On the other hand, descriptive marks and dual-function marks require secondary meaning or proof that the primary significance of the mark in the mind of the relevant consumers is to identify the producer or provider, not the product or service itself. Therefore, once the religious mark has been deemed worthy of trademark protection, a court will evaluate whether infringement has occurred. Nonetheless, even when a mark is found unworthy of trademark protection—generic marks and marks with only *de facto* secondary meaning—a court may still preclude a defendant’s specific use of a term or mark because the term or mark is deceptive in nature.

C. Religious Trademark Deception & Confusion

Courts must determine whether a plaintiff should be successful in preventing the defendant from using specific terms in the defendant’s mark. In making this decision a court will likely consider the relevant interests associated with the various parties affected by trademarks. A court will also review the context of the industry in which the trademark is used. In reviewing this context, a court may evaluate whether the defendant’s specific use is deceptive in nature or whether it infringes another’s protectable trademark. A court may then preclude all future use of deceptive or infringing marks.

1. The Interests of Those Affected by Trademarks

A court reviewing trademark suits must evaluate the effect infringement or deception might have on all of the relevant parties. Within the context of trademark law, the public interest refers to the public’s right not to be “confused or deceived.”⁸⁷ Simultaneously, the public interest refers to the public’s right to rely on a valid mark as a source identifier for the attributes associated with a specific producer or provider.⁸⁸ If someone transferred membership from an organization in one geographic location to a differently-located organization with a very similar name, he or she would expect the principles and policies of each to be the same because he or she would believe both entities were controlled by the same organization.⁸⁹

⁸⁴ *Id.*

⁸⁵ *See id.* at 1355 (“The Lanham Act amendments dealt only with [marks that were initially valid].”).

⁸⁶ *Id.* at 1361 (Garibaldi, J., dissenting).

⁸⁷ *Jews for Jesus v. Brodsky*, 993 F. Supp. 282, 312 (D.N.J. 1998) (quotation and citation omitted).

⁸⁸ *Transfer Print Foils, Inc. v. Transfer Print Am., Inc.*, 720 F. Supp. 425, 441 (D.N.J. 1989).

⁸⁹ *See Nat’l Bd. of Young Women’s Christian Ass’n v. Young Women’s Christian Ass’n of Charleston, S.C.*, 335 F. Supp. 615, 628 (D.S.C. 1971).

In addition to protecting the public interest, trademark law is meant to protect the trademark owner from “unfair practices by an ‘imitating competitor.’”⁹⁰ A religious organization has a substantial interest in protecting the good will and reputation associated with its ministry. Religious organizations are constantly under scrutiny and deserve to be able to control what occurs under the guise of their marks. Protecting the good will associated with a trademark is equally important to the consumer of the product or service — especially in the religious context. Millions of members are “associated with the name the most sacred of their personal relationships and the holiest of their family traditions.”⁹¹

2. *Structure of the Religious Marketplace & Opportunity for Deception*

Before analyzing the potential for consumer confusion, a court must recognize the structure of the religious marketplace. Many religious organizations provide “a range of spiritual services, including: classes, lectures, and seminars on religion and self-help; ministerial services; religious consulting; ordination services; and religious, spiritual, and educational information via the [I]nternet.”⁹² The world is full of diverse religions and a variety of religious organizations associated with those religions. Each religion has its own hierarchical structure. For instance, “a Christian congregation would classify itself first into its denomination ([e.g.] Baptist, Lutheran, Russian Orthodox, Society of Friends), then into one of the major groupings (Roman Catholic, Orthodox, and Protestant), and finally into Christianity”⁹³

Within these structures exists an array of different groups each with their own distinct ideological differences. Each organization tries to maintain the good will connected with the attributes associated with its religious trademarks; however, tenets have been known to change with religious organizations. As these tenets change, the attributes associated with the organization changes. During this time, a portion of the followers are likely to separate, maintain the old ideological beliefs, and use a part of the original organizations mark to reference its newly founded religious organization.⁹⁴

In *YWCA* the defendant suggested that an organization deceives the public by maintaining a Christian religious connotation within its name after removing the Christian religious ideals from its organization.⁹⁵ These allegations suggested that by deviating from the religious beliefs plaintiff was causing the use of the word “Christian” in its name to become a misrepresentation under trademark law—invalidating its rights.⁹⁶ The United States District Court for the District of South Carolina held that inquiring into an organization’s religious beliefs and then ruling on

⁹⁰ *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 428 (2003) (citation omitted), *cited in* *Gen. Council of Assemblies of God v. Fraternidad De Iglesia De Asamblea De Dios Autonoma Hispana, Inc.*, 382 F. Supp. 2d 315, 322 (D.P.R. 2005).

⁹¹ *Purcell v. Summers*, 145 F.2d 979, 982 (4th Cir. 1944).

⁹² *TE-TA-MA Truth Found.–Family of URI, Inc. v. World Church of the Creator*, 392 F.3d 248, 250 (7th Cir. 2004).

⁹³ *TE-TA-MA Truth Found.–Family of URI, Inc. v. World Church of the Creator*, 297 F.3d 662, 666 (7th Cir. 2002).

⁹⁴ *Christian Sci. Bd. of Dirs. of First Church of Christ, Scientists v. Evans*, 520 A.2d 1347, 1355 (N.J. 1987).

⁹⁵ *Nat’l Bd. of Young Women’s Christian Ass’n v. Young Women’s Christian Ass’n of Charleston, S.C.*, 335 F. Supp. 615, 617 (D.S.C. 1971).

⁹⁶ *Id.* at 624.

whether it is “Christian” is “prohibited by the First Amendment to the United States Constitution.”⁹⁷ The court suggested that “[i]f plaintiff lost its valuable trademark rights because it did not conform to this Court’s interpretation of ‘Christianity,’ it would be a very serious encroachment upon religious freedom.”⁹⁸ However this conclusion is one that should be scrutinized.

The issue of deception can also be argued by a plaintiff. Many marks in the religious context include the name of a religion. Generally, a plaintiff represents the organization in charge of or affiliated with that religion. If a defendant is practicing a religion other than that designated within its mark, a plaintiff will argue that inclusion of the religion within the defendant’s mark is a deception upon the public. A court may prohibit a defendant from including the name of a religion in its mark, if the defendant is not practicing that particular religion.⁹⁹

3. *Infringement in the Religious Context*

Although deception can be argued by both parties, the issue of consumer confusion must be proven by a plaintiff in an infringement suit. “[I]f the overall impression created by [the] marks is essentially the same, ‘it is very probable that the marks are confusingly similar.’ ”¹⁰⁰ In the context of religious marks, it is common that the alleged infringer will be a competitor offering the same or substantially similar products and services. When a court is determining the likelihood of confusion between competitors, the court will likely focus its attention on the overall impression of the mark itself;¹⁰¹ however, the court will still put the mark through a set of confusion factors as identified by the specific circuit.¹⁰²

Understanding that the overall impression of the mark itself matters, some defendants believe that they have eliminated confusion by adding words in addition to the trademarked terms. Under this guise, a church unaffiliated with the Seventh Day Adventists chose the name “Eternal Gospel Church of Seventh Day Adventists.”¹⁰³ The initial qualifying phrase was found not to have reduced the danger of confusion in light of the overwhelming similarity of the marks.¹⁰⁴ The term “committee” has also been held to be an insufficient qualifying term when the infringer’s mark is so similar as to include a substantial portion of the original mark.¹⁰⁵ Conversely, other courts who have found the same overwhelming similarity of the marks have reached alternative conclusions. The Supreme Court of Oklahoma suggested that there is a key distinction between qualifying “Assembly of God” with the name of one’s town, which will

⁹⁷ *Id.*

⁹⁸ *Id.*

⁹⁹ *Evans*, 520 A.2d at 1351.

¹⁰⁰ *Opticians Ass’n of Am. v. Indep. Opticians of Am.* 920 F.2d 187, 195 (3d Cir. 1990) (citation omitted).

¹⁰¹ *See Jews for Jesus v. Brodsky*, 993 F. Supp. 282, 302 (D.N.J. 1998).

¹⁰² *See Steven Olsen, Note, Mixed Signals in Trademark’s “Likelihood of Confusion Law”: Does Quality Matter?*, 44 VAL. U. L. REV. 659, 667–69 n.29 (2010) (outlining each circuit court’s likelihood of consumer confusion test).

¹⁰³ *Gen. Conference Corp. of Seventh-Day Adventists v. Perez*, 97 F. Supp. 2d 1154, 1157 (S.D. Fla. 2000).

¹⁰⁴ *Id.* at 1157–58.

¹⁰⁵ *Int’l Comm. of Young Women’s Christian Ass’ns v. Young Women’s Christian Ass’n*, 62 N.E. 551, 552 (Ill. 1901).

likely result in infringement, and qualifying it with terms such as “Holiness” or “Southern.”¹⁰⁶ The overwhelming similarity referenced in these cases is likely to be common among all cases within the religious trademark context.

In addition to qualifying terms, some organizations have tried adding a parenthetical to their name. Courts have found that infringement exists even when churches include the terms “independent” or “not merged” in a parenthetical after their names.¹⁰⁷ Although these qualifying terms and phrases have been found to be insufficient, courts have not completely ruled out the use of qualifying phrases. One dissenting judge has suggested that a church could use an unrelated name and include a dual-mark in a qualifying phrase to reference the religion.¹⁰⁸ For example, the dissenting judge suggested using the following name for a church unaffiliated with the Christian Science Mother Church: “Plainfield Community Church—An Independent Church Practicing Christian Science.”¹⁰⁹

In the religious trademark context, four of the confusion factors generally favor the plaintiff. Religious trademarks are usually applied to a finite number of goods, this means that the goods in question are of very close proximity. This also removes the need to determine if the plaintiff is likely to expand into the specific product line. Additionally, as noted earlier, trademark infringement suits rarely arise outside of situations where the marks in question are very similar if not even identical. Finally, competing religious marks will likely be viewed by a similar audience because religious organizations generally use similar marketing channels.

In addition to these factors, courts analyze a defendant’s intent in adopting the mark, sophistication of the consumer, evidence of actual confusion, and the strength of the mark. A defendant’s intent can play a big role when a court analyzes the likelihood of confusion. Unclean hands exist when a plaintiff can prove that a defendant used a mark knowing and intending it to cause confusion and mislead the public as to the defendant’s affiliation with or sponsorship by the allegedly infringed trademark.¹¹⁰ In *Jews for Jesus*, the defendant admitted that the “intent behind [his] bogus ‘Jews for Jesus’ site (www.jewsforjesus.org) is to intercept potential converts before they have a chance to see the [content] on the real J4J site.”¹¹¹ This admission proved that the defendant used the mark’s good will in order to siphon potential followers. It is common for a court to determine that the alleged infringer was aware of the original mark and adopted it because of the attributes and good will associated with it. This factor also weighs heavily in favor of the plaintiff.

An inquiry into the level of consumer sophistication includes whether the consumers are sophisticated in the marketplace (*i.e.*, Internet, door to door, store front) and the sophistication

¹⁰⁶ Okla. Dist. Council of Assemblies of God of Okla., Inc. v. New Hope Assembly of God Church of Norman, Okla., Inc., 597 P.2d 1211, 1215 (Okla. 1979).

¹⁰⁷ *Carnes v. Smith*, 222 S.E.2d 322, 342 (Ga. 1976) (“Noah’s Ark Methodist Church (Independent)”); *Lutheran Free Church v. Lutheran Free Church (not merged)*, 141 N.W.2d 827, 830 (Minn. 1966).

¹⁰⁸ *Christian Sci. Bd. of Dirs. of First Church of Christ, Scientists v. Evans*, 520 A.2d 1347, 1358 (N.J. 1987) (Garibaldi, J., dissenting).

¹⁰⁹ *Id.* (Garibaldi, J., dissenting) (footnote omitted).

¹¹⁰ *See Christian Sci. Bd. of Dirs. of the First Church of Christ, Scientist v. Nolan*, 259 F.3d 209, 213 (4th Cir. 2001).

¹¹¹ *Jews for Jesus v. Brodsky*, 993 F. Supp. 282, 291 (D.N.J. 1998).

level the consumer possesses with regard to information about religious organizations.¹¹² “A large portion of any community is not well informed about ecclesiastical matters”¹¹³ Additionally, the general nature of many parishioners is to trust and not second guess the authenticity of religious leaders and their organizations. Given these facts, courts are likely to find that this factor also favors the plaintiff.

Only two factors remain that could favor the defendant: evidence of actual confusion and strength of the mark. While proof of actual confusion is not necessary in order for the plaintiff to prove trademark infringement, proof that consumers are not confused by the use of the mark eliminates the need to perform the multifactor test.¹¹⁴ Although this factor can be used to benefit the defendant, it is very difficult to prove. A defendant’s strongest argument when suggesting that confusion does not exist lies within the strength of a plaintiff’s mark. This is the reason most religious trademark cases center on an argument of genericness or descriptiveness without secondary meaning. Therefore, if a plaintiff can prove that its mark is distinctive and worthy of trademark rights, then the court will likely find that a defendant has infringed those rights.

II. Evaluating the Servyism Hypothetical Within the Religious Trademark Context

The religious trademark context analyzed above is not just theoretical, but is intended as a framework to be factually applied to any given religious trademark scenario. This section will apply the facts included in the introductory Servyism hypothetical to the religious trademark context. This part will assume a federal court is examining each of the legal issues. The federal court will begin by analyzing the distinctiveness of the plaintiffs’ marks. It will then evaluate the consumer confusion and deception claims. Finally, it will produce a ruling on all of the issues.

A. Distinctiveness of Marks

The distinctiveness of each mark must be evaluated separately. There are several marks that have to be considered in the proposed hypothetical. The written appearance test will be limited to current dictionary definitions of terms as the introductory facts did not include any details of public or private writings.¹¹⁵ Each of the other tests may be appropriately applied in their entirety to the facts of the introductory hypothetical.¹¹⁶ In applying these tests, the marks will be evaluated in the order of the respective entity’s appearance. The Servyism Mother Church claims rights in three marks: Servyism, Servyism Mother Church, and Originalist. This section will begin with Servyism.

¹¹² *Id.* at 303.

¹¹³ *Purcell v. Summers*, 145 F.2d 979, 983 (4th Cir. 1944).

¹¹⁴ TRADEMARK AND COPYRIGHT LITIGATION UPDATE 22 (Nat’l Bus. Inst. March 2008) (quoting *Top Tobacco v. North Atlantic Operating Co.*, 509 F.3d 380, 383 (7th Cir. 2007)). The *Top Tobacco* court noted:

Like other courts, this circuit has articulated a multi-factor approach to assessing the probability of confusion. These factors include whether the trademarks use the same word, whether they sound alike, and so on. . . . A list of factors designed as *proxies* for the likelihood of confusion can’t supersede the statutory inquiry. If we know for sure that consumers are not confused about a product’s origin, there is no need to consult even a single proxy.

Top Tobacco, 509 F.3d at 383 (internal citation omitted) (emphasis in original).

¹¹⁵ See *supra* notes 32–39 and accompanying text (providing an understanding of the written appearance test).

¹¹⁶ These tests include the noun/adjective test, alternative names test, and the contemporary usage test.

Servyism was not initially adopted by the religious organization. Instead, the term was created by the public to identify the religion itself. It was not until after the public began referring to the theologians set of religious beliefs as Servyism that the theologians formed the Servyism Mother Church and desired to protect the term Servyism. Therefore, the term Servyism is inherently generic and identifies the religion itself.¹¹⁷ The fact that followers began to view the term Servyism as a source identifier for the religious organization is only proof of *de facto* secondary meaning.¹¹⁸ *De facto* secondary meaning cannot create rights in an inherently generic term.¹¹⁹ Therefore, Servyism is a term that has been acquired by the general public and cannot be owned by any one organization.

“Servyism Mother Church” is the second mark for which the religious organization claims trademark rights. First, it should be noted that Servyism by itself has already been declared generic. Additionally, the term Mother Church as admitted in the facts is contemporarily used to mean the original organization that developed the church’s tenets, practices, and spiritual leaders. Since this is the only term that describes this specific type of organization, the term Mother Church alone would be declared generic.¹²⁰ However, the combination of the generic term Servyism with the generic term Mother Church may be classified as distinctive, but each word individually must be disclaimed.¹²¹ Therefore, the term Servyism Mother Church should be declared descriptive and require secondary meaning. Although several factors are considered in determining the existence of secondary meaning, the facts noted that the general public recognized the mark as an identifier for that specific branch of the Servyism religion.¹²² Therefore, secondary meaning has been proven and the composite mark is worthy of trademark protection.

Finally, the Servyism Mother Church claims trademark rights for the “Originalist” mark. This mark has been used by the organization as a source identifier.¹²³ It could be argued that the mark is descriptive because the term original is defined as “preceding all others.”¹²⁴ Additionally, the –ist suffix transforms the word to mean adherent to the doctrines that preceded all others.¹²⁵ Given these facts, the Originalist mark should be declared descriptive. Nonetheless, secondary meaning has been proven by showing that the public identifies the Servyism Mother Church with the term Originalist. Like all branches and limbs of Servyism, the

¹¹⁷ See *supra* note 78 and accompanying text (discussing inherently generic marks).

¹¹⁸ See *supra* note 77 and accompanying text (discussing *de facto* secondary meaning).

¹¹⁹ See *supra* text accompanying note 83 (recognizing that a lack of competition may create *de facto* secondary meaning, but not trademark rights).

¹²⁰ See *supra* notes 27–29 and accompanying text (recognizing the importance of additional terms in deciding whether a mark is generic).

¹²¹ See *supra* note 47 and accompanying text (acknowledging that the combination of non-distinctive marks can make a distinctive mark); see *supra* note 52 and accompanying text (referencing the need to disclaim certain terms). However, it is important to note that the term should only be disclaimed because of the generic ruling already explained.

¹²² See *supra* notes 74–76 and accompanying text (outlining the material relevant for a secondary meaning analysis).

¹²³ See *supra* note 13 and accompanying text (noting that a mark must be used by the organization before it can receive trademark protection).

¹²⁴ AMERICAN HERITAGE DICTIONARY 587 (3d ed. 1994).

¹²⁵ *Id.* at 446.

Servyism Mother Church and Originalist act as adjectives for which the Servyism religion is the noun.¹²⁶

The next set of marks under analysis includes “Holy Obeyist Church of Servyism,” “Obeyist,” “Exalted Church of Servyism,” and “Exaltist.” The mark “Holy Obeyist Church of Servyism” does not describe a feature specific to the religious organization. In order to determine if the mark is descriptive or suggestive the court analyzes each word separately to determine the composite terms contemporary meaning. “Holy” is defined as “associated with a divine power.”¹²⁷ “Obeyist” can be seen as an adherent to the specific doctrine of obedience.¹²⁸ “Church” is defined as “a congregation.”¹²⁹ Finally, “Servyism” has already been classified as the generic term for the religion. Therefore, the composite term, without additional evidence, refers to a Servyism congregation associated with a divine power that adheres to the doctrine of obedience. This does not describe a characteristic specific to this branch of Servyism, but instead describes a characteristic of all Servyism branches and most other religions.¹³⁰ Given these meanings, both “Holy Obeyist Church of Servyism” and “Obeyist” should be declared suggestive marks. However, if they were to be declared descriptive the general public views the marks as source identifiers for this distinct branch (organization) of the Servyism religion. Under either theory these marks should be classified as distinctive and worthy of protection.

“Exalted Church of Servyism” must be evaluated in the same manner. “Exalted” is defined as “raised in rank or status.”¹³¹ Therefore, the composite term means, without additional evidence, a Servyism congregation raised in rank or status. This meaning describes a key feature specific to the branch of Servyism: receiving greater honor in the afterlife in comparison to followers of the other Servyism branches. As such, this mark must be declared descriptive.¹³² However, the general public has recognized that it views the mark as a source identifier for the distinct branch of the Servyism religion. This proof of secondary meaning generates protectable trademark rights within the mark.

On the other hand, the mark “Exaltist” does not describe a specific feature of the religious organization. Exaltist would refer to a group that adheres to the doctrine of exalting.¹³³ In this case, the contemporary public would likely apply the most common definition of “exalt” within the religious context, not exalted: “to glorify, praise, or honor.”¹³⁴ The public is then likely to view the term as an organization adhering to the doctrine of glorifying, praising, and honoring the creator of all things. This is not a feature specific to this branch or religion. Therefore, “Exaltist” should be declared suggestive and worthy of trademark protection.

¹²⁶ Cf. *supra* text accompanying notes 25–26 (explaining the difficult nature of determining the noun within the religious context).

¹²⁷ AMERICAN HERITAGE DICTIONARY 400 (3d ed. 1994).

¹²⁸ *Id.* at 446 (defining -ist).

¹²⁹ *Id.* at 158.

¹³⁰ See *supra* text accompanying note 69 (recognizing the significant feature standard).

¹³¹ AMERICAN HERITAGE DICTIONARY 294 (3d ed. 1994).

¹³² See *supra* text accompanying note 69 (noting that a mark is descriptive if it describes a significant feature of the good).

¹³³ AMERICAN HERITAGE DICTIONARY 446 (3d ed. 1994) (defining -ist).

¹³⁴ *Id.* at 294.

The final set of marks under analysis is the branches' authorized limbs. "Kracorian Originalist" and "Mungult Exaltist" are the easiest to determine distinctiveness. The terms "Kracorian" and "Mungult" do not have either English or foreign meanings.¹³⁵ Since these are new terms with no present meaning they are each declared fanciful marks worthy of protection.¹³⁶ Conversely, "Winter Obeyist" cannot be declared fanciful because the term winter has a present meaning. "Winter" is defined as "the coldest season of the year."¹³⁷ This meaning is completely unrelated to Winter Obeyist religious practices. Therefore, the mark should be declared arbitrary and worthy of protection.¹³⁸

The distinctiveness of the local groups affiliated with the limbs are not in question because only the plaintiff is required to show that its mark is distinctive and worthy of trademark protection. Similarly, the distinctiveness of the marks used to describe the groups for whom affiliation was denied and the name of the non-believers group are also not in question. Nonetheless, these marks must still be evaluated for purposes of consumer confusion and deception.

B. Consumer Confusion & Deception Claims

The claims of this case are separated into two categories: consumer confusion and deception. The category of consumer confusion includes the cases involving each branch, and its respective limb, against the local groups who chose to use the organizational marks after being denied affiliation with the organizations. The deception category includes the original claim brought by the Servyism Mother Church against the two branches that broke away from the organization and the newest claim by all Servyism religious organizations against the group of non-believers who identify themselves as the Genuine Servyism Church.

Beginning with the consumer confusion claims, the court recognizes that the interests of the religious organizations, the parishioners of those organizations, and the general public are all at stake.¹³⁹ In order to evaluate the overall impression of the marks, the court places them side by side: Winter Obeyist v. Sacrificial Winter Obeyist; Mungult Exaltist v. Reformed Mungult Exaltist; and Kracorian Originalist v. Kracorian Originalist of Chicago.¹⁴⁰ After viewing the similarities of the marks, the court acknowledges that simply adding an additional term will not prevent a finding of infringement.¹⁴¹ This is especially true under the facts of this case, where affiliated groups regularly add similar terms to designate their identity. Next, the court begins evaluating the marks through the circuit's likelihood of consumer confusion test.

¹³⁵ A foreign language mark is translated for purposes of distinctiveness and infringement. *Gen. Conference Corp. of Seventh-Day Adventists v. Perez*, 97 F. Supp. 2d 1154, 1160 (S.D. Fla. 2000).

¹³⁶ *See supra* note 20 and accompanying text (explaining fanciful marks).

¹³⁷ ENCARTA WORLD ENGLISH DICTIONARY 2039 (1999).

¹³⁸ *See supra* note 20 and accompanying text (explaining arbitrary marks).

¹³⁹ *See supra* text accompanying notes 87–91 (outlining those individuals whose interests are affected by trademark disputes).

¹⁴⁰ *See supra* text accompanying note 101 (acknowledging the importance of evaluating the overall impression of the mark).

¹⁴¹ *See supra* text accompanying notes 103–107 (providing example applications of this doctrine).

First, the court immediately notes that the alleged infringers use the full and complete mark of the plaintiffs. Additionally, each defendant is in the same market and offers the same good as their respective plaintiff. As noted earlier by the court, the good in this case is the religion of Servyism. Given this fact, the court finds that expanding the product line or bridging the gap is an unnecessary factor in this case. Since no evidence was shown to suggest what marketing channels either party used or whether actual confusion was or was not present, the court will find these factors neutral to both parties.

However, the defendants' intentions appear clear to the court as they were each denied affiliation with the respective branch, but still chose to use the marks.¹⁴² Since the defendants knew the marks were connected with the branches, this factor weighs in favor of the plaintiffs. When evaluating the sophistication of the consumers, this court agrees with the view that the general public is unsophisticated in ecclesiastical matters and tends to trust the authenticity of religious organizations.¹⁴³ In light of these facts, this factor also weighs in favor of the plaintiffs.

The final factor the court will consider is the strength of the plaintiffs' marks in question. The three limb marks were declared the highest degree of distinction: fanciful or arbitrary. This high level of distinction is combined with proof that the public views the plaintiffs' marks as identifiers for their specific religious organizational limbs. Additionally, the three branch marks were found to be either suggestive or descriptive and possessed a strong degree of secondary meaning. This factor, like every other non-neutral factor, weighs heavily in favor of the plaintiffs. Each defendant is held liable for trademark infringement and shall be permanently enjoined from using any mark similar to those of the plaintiffs.

After ruling on the consumer confusion cases the court begins to evaluate the claims of deception. The original claim by Servyism Mother Church against Holy Obeyist Church of Servyism and Exalted Church of Servyism would have likely begun as a consumer confusion case. However, once this court determined that the term "Servyism" was a generic term for the religion, the Servyism Mother Church would have likely alleged deception. The theory of deception in this particular case is weak because the facts specified that the two new branches professed very similar ideological beliefs to that of the Servyism Mother Church. Branches with a few distinct differences in religious beliefs are common and should be allowed within the marketplace of a particular religion.¹⁴⁴ Given the structure of the marketplace and the generic nature of the religious name, no deception took place when the two new branches were formed and included the term Servyism in their names.

The second and stronger claim of deception is against the Genuine Servyism Church. In this case, the facts are significantly different than those in the previous deception case. Here, we face a new religious organization that intends to profess beliefs contrary to those of the Servyism faith. Additionally, the defendant includes the word "genuine" in its mark which is defined as

¹⁴² See *supra* text accompanying note 111 (presenting an additional example of a defendant's bad faith intent).

¹⁴³ *Supra* text accompanying note 113.

¹⁴⁴ See *supra* text accompanying note 93 (offering an example of the variety of religious organizations associated with one particular religion).

“actually possessing the alleged or apparent attribute or character.”¹⁴⁵ Given the sophistication of the relevant public,¹⁴⁶ as previously noted, this mark is highly likely to deceive the consuming public. Although the term “Servyism” is not a protected mark, a religious organization practicing Servyism can prevent false practitioners from using the term in its name or claiming in any other way that their teachings are those of the Servyism faith.¹⁴⁷ As such this court finds that the Genuine Servyism Church is deceiving the consuming public and is therefore enjoined from using the word Servyism or any word associated with that religion in its name.

This court finds that all marks in question, except Servyism, are distinctive and worthy of trademark protection. This court also finds that all claims of consumer confusion were viable and defendants are permanently enjoined from using any term similar to those of the branch and limb religious organizations. This court finds the claim of deception against the two branches to be without merit; however, this court finds the claim of deception against the Genuine Servyism Church to be valid and permanently enjoins the defendant from claiming or suggesting any affiliation with the Servyism religion.

III. Recognizing the New Tests as Applied

Some of the conclusions drawn in the previous section are contrary to several state and federal court decisions. Specifically, the court recognized all marks other than that of the religion itself as distinctive. It also used the admissions of the parties and the view of the relevant public to determine if an organization was committing deception by using the name of a religion in its mark. Although, the court did come to the same conclusion as the majority of courts with regard to consumer confusion; it recognized that if a religious mark is found to be distinctive, it will likely result in confusion. This section will outline the parts of the test applied in the previous section which are contrary to that of some state and federal courts.

Several courts have suggested that names used to describe denominations, like religions, are generic.¹⁴⁸ However, general conclusions of this nature are inappropriate in a trademark infringement suit. Each religious trademark case must be analyzed separately, applying the specific facts of the case to the context and structure of religious trademarks. In determining whether the name used to designate a religion deserves trademark protection, turns on which came first. In the hypothetical, the religion was identified by the term “Servyism” before the organization used the term. In this case, the best a religious organization can do is to create *de facto* secondary meaning and accept that it will not be granted monopolistic power over the term. However, if the organization had used the term “Servyism” before the public began using it, then the mark would have become a dual-function mark. In this case, an organization may be able to receive trademark rights for the term if it can show that the primary significance of the mark is to refer to the organization and not the religion itself.

Once the court has determined whether the term used to describe the religion is worthy of protection, the court can then evaluate whether the terms used to describe branches are worthy of

¹⁴⁵ AMERICAN HERITAGE DICTIONARY 352 (3d ed. 1994).

¹⁴⁶ See *supra* text accompanying notes 42–46 (describing who qualifies as the relevant public).

¹⁴⁷ *Supra* text accompanying note 99.

¹⁴⁸ See *supra* Part II.B.4 (describing courts analysis of denominational names).

protection. These separate and distinct religious organizations should be run through the same test as every other mark. The problem courts generally face in running these branch and limb marks through the test is to suggest that the marks represent a completely different religion. This problem can be easily solved by determining if the general public views the religious organization as a new religion or a branch of a current religion. If the general public views it as a new, unaffiliated religion, then a court should apply the test as outlined above. If the general public views it as a branch affiliated with a current religion, then a court should apply the general genericness tests. These tests begin by determining whether the mark is used to identify the good itself. The first test generally applied is identifying the noun and recognizing that a noun cannot receive protection. It is important to remember in the religious trademark context that the noun should always be the religion and not the name of a specific branch or limb of that religion. More specifically, the good is the religion, not the branch or limb. Branches and limbs are competitors offering the same good—the religion.

Once the good has been identified, the mark can be evaluated separately. By eliminating concerns relating to the name of the religion, a court can evaluate the mark as a whole to determine whether it is distinctive. If words, with an independent meaning, are included in the mark in addition to the term used to describe the religion, then a court should not find the mark to be generic.¹⁴⁹ If the words included in the mark describe a significant feature associated with the specific branch or limb, then the mark should be declared descriptive.¹⁵⁰ If the mark does not directly refer, but instead requires imagination to recognize the feature of the branch or limb being referenced, then the mark should be declared suggestive. Additionally, a mark should be declared suggestive if it describes a religious tradition in general and not one specific to the organization.¹⁵¹ If the words have a meaning unrelated to the religion and the branch or limbs specific features, they should be declared arbitrary.¹⁵² Finally, if they are completely new words then the mark should be declared fanciful.¹⁵³

This analysis was applied by the federal court in Part III in reaching its conclusions as to the distinctiveness of each mark. By applying this test the court was able to protect those religious marks that truly deserved protection. In doing so, the court protected the interests of the religious organizations, the parishioners of those religious organizations, and third parties considering joining the religious organizations.

In addition to protecting these parties through the appropriate alterations to the distinctiveness analysis, the court also protected these parties by preventing a deception from

¹⁴⁹ In the hypothetical, the branches were separate organizations not claiming to control the name of the religion, but trying to control the name of their branch.

¹⁵⁰ In the hypothetical, Servyism Mother Church described that it was the original organization of the church and was therefore declared descriptive. Additionally, the Exalted Church of Servyism was declared descriptive because it described a key feature of the specific branch.

¹⁵¹ In the hypothetical, Holy Obeyist Church of Servyism was declared suggestive because it did not describe a key feature of the branch or religion but generally suggested that the mark was religious in nature.

¹⁵² In the hypothetical, Winter Obeyist was declared arbitrary because the specific limb did not have any relation to the meaning of the word winter.

¹⁵³ In the hypothetical, Kracorian Originalist and Mungult Exaltist were declared fanciful because they were brand new words without any previous meaning.

occurring on the general public. Some courts have suggested that a court violates first amendment rights by determining if a religious organization is using the name of a religion in its mark for which it does not practice.¹⁵⁴ Only one part of this argument is valid: a court should not create its own interpretation, without the support of evidence, of what a religion represents. Instead, a court should be allowed to use a defendant's admissions in determining whether it follows the religious beliefs as described by the general public. This requires the parties to provide survey evidence showing the relevant public's interpretation of the religion. The general practices applied by all branches of the religion can also be used as evidence to show the public understanding of what the religion represents. By applying these standards and legal principles, a court can provide general protection to the identity associated with the generic term of a specific religion.

Conclusion

Religious trademark suits must be evaluated in a three-stage process. First, courts must fully understand the context of religious trademarks in general. Second, courts must evaluate the specific facts of a case within the religious trademark context. Finally, courts must apply the appropriate tests, as identified in this article, to the specific facts identified within the religious trademark context. This three-stage process will protect the identity of an organization held most sacred to many in our populace.

¹⁵⁴ See *supra* text accompanying notes 95–98 (describing the first amendment argument).