No. A-____

IN THE SUPREME COURT OF THE UNITED STATES

THE UNIVERSAL CHURCH, INC.,
Applicant,

v.

CALVIN TOELLNER, GEORGE FREEMAN, BRUCE TAYLOR, UNIVERSAL LIFE CHURCH/ULC MONASTERY, UNIVERSAL LIFE CHURCH MONASTERY STOREHOUSE,
Respondents,

DANIEL CHAPIN,
Defendant.

APPLICATION FOR AN EXTENSION OF TIME WITHIN WHICH TO FILE A PETITION FOR A WRIT OF CERTIORARI

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January 18, 2019

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To the Honorable Ruth Bader Ginsburg, Associate Justice of the United States and Circuit Justice for the Second Circuit:

Pursuant to this Court's Rules 13.5, 22, and 30.3, The Universal Church, Inc. (hereinafter "The Universal Church" or "Applicant") respectfully requests a 30-day extension of time, to and including March 4, 2019,[1] within which to file a petition for a writ of certiorari to review the judgment of the Second Circuit in this case. The Universal Church has not previously sought an extension of time from this Court. If not extended,

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[1] The requested 30-day extension ends on March 2, 2019, which is a Saturday. Under this Court's Rule 30.2, the period is therefore extended until March 4, 2019, which is the next day that is not a Saturday, Sunday, federal legal holiday, or day on which the Court building is closed.

the time for filing a petition will expire on January 31, 2019. Consistent with Rule 13.5, this application is being filed at least ten days before that date.

A copy of the Second Circuit's summary order and judgment (*Universal Church, Inc. v. Toellner*, No. 17-2960-CV, 2018 WL 5783687 (2d Cir. Nov. 2, 2018)) is attached hereto at Tab A. This Court has jurisdiction over this case under 28 U.S.C. § 1254(1).

1. The decision below of the Second Circuit addressed the validity of Applicant's registered trademarks. Applicant is a Christian religious organization that offers services and counseling under its trademarks "The Universal Church" and "Universal Church." Respondents, who offer online ordination services, attempted to register the mark "Universal Life Church." The U.S. Patent and Trademark Office rejected that mark based on the likelihood of confusion with other registered marks, including Applicant's.

2. When Respondents proceeded to use Applicant's registered marks, Applicant sued for infringement. Respondents principally defended the suit on the theory that "The Universal Church" and "Universal Church" are generic and therefore lack protection. On cross-motions for summary judgment, the district court agreed that these terms are generic as applied to churches and cancelled Applicant's trademark registrations. The district court acknowledged that these terms would be non-generic under the "test" that "some courts have applied," but it disagreed with decisions of the Sixth and Seventh Circuits. *See Universal Church, Inc. v. Universal Life Church/ULC Monastery*, No. 14 CIV. 5213 (NRB), 2017 WL 3669625, at *9 n.23 (S.D.N.Y. Aug. 8, 2017), attached hereto at Tab B (citing *Gen. Conference Corp. of Seventh-Day Adventists v.*

McGill, 617 F.3d 402, 413 (6th Cir. 2010); *TE-TA-MA Truth Found.—Family of URI, Inc. v. World Church of the Creator*, 297 F.3d 662, 666 (7th Cir. 2002)).

3. The Second Circuit affirmed in a summary order. Treating as irrelevant whether the contemporary public in fact perceives "The Universal Church" and "Universal Church" as denoting a generic class of churches generally, the Second Circuit resolved the genericness question as a matter of law. It held that these phrases were generic based on a historical and technical usage in the Roman Catholic Church that used "universal church" to "describe the [Catholic] Church as a whole," relying solely on (1) the Oxford English Dictionary's fourth entry for the adjective "universal," and (2) the report and testimony of Respondents' expert, a Catholic theologian and canon lawyer. *Universal Church, Inc.*, 2018 WL 5783687, at *1. Based on the court's view that "The Universal Church" and "Universal Church" should be regarded as generic, it treated Applicant's evidence of contemporary public perception as irrelevant as a matter of law.

4. In so holding, the decisions below deepened a split over when church names are generic and so ineligible for trademark protection. The New Jersey Supreme Court and now the Second Circuit disdain evidence of contemporary public perception and resolve genericness as a matter of law based on archaic dictionary definitions, technical theological texts, and the court's "common sense." *Christian Sci. Bd. of Dirs. of First Church of Christ, Scientist v. Evans*, 520 A.2d 1347, 1352 (N.J. 1987). This incorrect approach cannot be squared with the statutory text, which provides that the test for genericness is "[t]he primary significance of the registered mark to the relevant public"—meaning, the *contemporary* public. 15 U.S.C. § 1064(3).

5. By contrast, the Sixth, Seventh, and Eighth Circuits have held that religious mark-holders are entitled to the same protection as anyone else, determining whether church names are protectable through a fact-based inquiry into how the contemporary public understands the names. *General Conference Corp. of Seventh-Day Adventists v. McGill*, 617 F.3d 402 (6th Cir. 2010); *TE-TA-MA Truth Found.--Family of URI, Inc. v. World Church of the Creator*, 297 F.3d 662 (7th Cir. 2002); *Cmty. of Christ Copyright Corp. v. Devon Park Restoration Branch of Jesus Christ's Church*, 634 F.3d 1005 (8th Cir. 2011). Thus, for example, the Seventh Circuit held that "Church of the Creator" was not generic because the term was "recognizable" as a denominational name in "[c]ontemporary usage," not as "the designation of the religion to which the denominations belong." *TE-TA-MA Truth Found.*, 297 F.3d at 666; *see also General Conference Corp.*, 617 F.3d at 415-16 (similar test); *Cmty. of Christ Copyright Corp.*, 634 F.3d at 1011-12 (similar). Had the Second Circuit applied the approach of the Sixth, Seventh, and Eighth Circuits, summary judgment could not have been granted against Applicant, as the district court properly acknowledged.

6. These differing approaches have contributed to disarray in the lower courts: "Seventh Day Adventist" is protectable, while "Christian Science" is not; "Church of the Creator," "Church of Christ," and "Assembly of God" are protectable, yet "Universal Church" is not; "Jews for Jesus" is protectable, yet "New Thought Church" is not. *General Conference Corp.*, 617 F.3d at 412-13; *Cmty. of Christ Copyright Corp.*, 634 F.3d at 1011-12; *TE-TA-MA Truth Found.*, 297 F.3d at 666; *Jews For Jesus v. Brodsky*,

993 F. Supp. 282, 297 (D.N.J.), *aff'd*, 159 F.3d 1351 (3d Cir. 1998) (unpublished table decision).

7. Moreover, by splitting from the Sixth, Seventh, and Eighth Circuits and departing from the statutory text, the decisions below threaten broad and disruptive effects. Church names often have deep historical roots and linguistically may be construed as either names for a particular church or for a group of churches or religions as a whole—features that, under the decisions below, deprive a mark of protection under federal trademark law. These churches, like other mark-holders, depend on their marks to identify themselves, safeguard their goodwill, and prevent fraud. Yet if left undisturbed, the decisions below will call into question an untold number of currently registered trademarks. *Universal Church*, 2017 WL 3669625, at *10 n.24 (acknowledging concern that, under the decisions below, "the Episcopal Church, the Presbyterian Church, and the Catholic Church must also be generic names" but declining to "decide [that question] on the record before us"). Moreover, it would afford litigants the opportunity to forum-shop. Parties seeking to invalidate marks would rush to the Second Circuit, an important jurisdiction for intellectual property, where the decision below would invalidate marks that would receive protection in the Sixth, Seventh, and Eighth Circuits.

8. Applicant intends to file a petition for a writ of certiorari asking this Court to review the Second Circuit's decision. The petition for certiorari is currently due on January 31, 2019. Appellate counsel from Jenner & Block have primary drafting responsibility for the petition, and they have substantial commitments that necessitate

this extension. During the period of the sought extension, Counsel of Record Mr. Hellman has an oral argument in the D.C. Circuit on January 22, 2019 in 18-1315, *In re Spears*, an opening merits brief in the Fifth Circuit due on January 22, 2019 in 18-20695, *Lowe v. General Dynamics Corporation*, and an opposition to a motion to dismiss in the District of Maine due on January 25, 2019 in 18-405, *Bath Iron Works Corporation v. Congoleum Corporation*.

9. An extension is therefore necessary to allow Applicant's counsel adequate time to determine the full implications of the Second Circuit's decision and to determine how best to present these critical issues to this Court. Counsel are working diligently on this case. But because of the significant effect of the Second Circuit's decision on myriad trademarks, sufficient time to thoroughly prepare Applicant's petition is essential.

Accordingly, The Universal Church respectfully requests that the time within which it may file a petition for a writ of certiorari be extended to and including March 4, 2019.

Respectfully submitted,

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