

No. _____

IN THE
Supreme Court of the United States

THE UNIVERSAL CHURCH, INC.,
Petitioner,

v.

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

**On Petition for a Writ of Certiorari
To the United States Court of Appeals
For the Second Circuit**

PETITION FOR A WRIT OF CERTIORARI

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QUESTION PRESENTED

Religious organizations frequently confront claims that their names are generic and ineligible for trademark protection. Courts are divided over such claims. The Sixth, Seventh, and Eighth Circuits apply the same test to religious organizations that applies to other marks: How does the relevant contemporary public understand the name? By contrast, the Second Circuit (in the decision below) and the New Jersey Supreme Court apply a religion-specific test. They determine the significance of religious organizations' names based on technical theological usages and archaic religious texts, regardless of whether those sources reflect contemporary perceptions. As a result, the Second Circuit held as a matter of law that "The Universal Church" and "Universal Church" are generic based on the same type of evidence that the Sixth, Seventh, and Eighth Circuits have rejected.

The Question Presented is:

Did the Second Circuit err by holding that marks of religious organizations, like "The Universal Church" and "Universal Church," may be generic as a matter of law regardless of evidence that the relevant public does not primarily understand them as generic?

PARTIES TO THE PROCEEDING

Petitioner is The Universal Church, Inc., which was plaintiff in the district court and plaintiff-appellant in the court of appeals.

Respondents are Calvin Toellner, George Freeman, Bruce Taylor, Universal Life Church/ULC Monastery, and Universal Life Church Monastery Storehouse. They were defendants and counter-claimants in the district court and defendants-appellees in the court of appeals.

CORPORATE DISCLOSURE STATEMENT

Pursuant to this Court's Rule 29.6, Petitioner states as follows:

Petitioner The Universal Church, Inc. has no parent corporation and no publicly held company owns ten percent or more of its stock.

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PETITION FOR CERTIORARI

The Universal Church, Inc. petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Second Circuit.

OPINIONS BELOW

The decision of the Second Circuit (Pet. App. 1a–7a) is unreported but available at 2018 WL 5783687. The decision of the district court (Pet. App. 8a–53a) is unreported but available at 2017 WL 3669625.

JURISDICTION

The judgment of the Second Circuit was entered on November 2, 2018. Justice Ginsburg granted Petitioner’s timely application for an extension to file this petition on or before March 4, 2019. This Court has jurisdiction pursuant to 28 U.S.C. § 1254(1).

STATUTORY PROVISION INVOLVED

Section 1064(3) of Title 15 contains the following provision:

A registered mark shall not be deemed to be the generic name of goods or services solely because such mark is also used as a name of or to identify a unique product or service. The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used.

INTRODUCTION

A threshold question for every trademark is whether it is generic. *Park 'N Fly, Inc. v. 11 Dollar Park & Fly, Inc.*, 469 U.S. 189, 194 (1985). A generic term names a category—that is, the “genus of which the particular product is a species.” *Id.* Generic terms cannot be trademarked. *Id.* By contrast, a term that *describes* a product is treated as “descriptive,” and is trademarkable if it has a secondary meaning associated with a single source. *Id.* In other words, “descriptive terms describe a thing, while generic terms name the thing.” 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 12:20, Westlaw (5th ed. database updated Nov. 2018). For example, “mattress” is a generic term for a device used to cushion a bed, while “breathable” describes a characteristic of certain mattresses, and thus the name “Breathable Mattress” could be trademarked if it has acquired secondary meaning. *See In re King Koil Licensing Co.*, 79 U.S.P.Q.2d 1048, 2006 WL 639160, at *4–5 (T.T.A.B. 2006).

This case presents an important and recurring question about how to determine whether names of religious organizations are generic. Consider “Episcopal Church.” That term—which means, literally, “a church governed by bishops”—has a long historical pedigree and is susceptible to multiple interpretations. It could be considered the generic name for a *category* of religious organizations (Christian churches governed by bishops). But the term could also be understood as the descriptive name for a *particular* religious organization (The Episcopal Church, which is headquartered in New

York), in which case it may be trademarked if it has acquired secondary meaning. Courts frequently encounter names of this sort, yielding a dizzying array of trademark determinations. To name just a few, “Christian Science Church” and “New Thought Church” have been deemed generic, while “Assembly of God” and “Church of the Creator” have been found to be descriptive.

The Sixth, Seventh, and Eighth Circuits have adopted one test for determining whether a religious mark is generic. In these circuits, the key inquiry is how the relevant contemporary public understands the mark. *Gen. 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); *Cnty. 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. This approach is faithful to 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).

In the decision below, the Second Circuit applied a different test and invalidated Petitioner’s trademarks. Petitioner is a Bible-based Christian church that operates under its federally registered trademarks “Universal Church” and “The Universal Church.” Pet.

App. 11a–12a. The summary judgment record contained substantial expert and documentary evidence establishing that those marks are not understood, in “[c]ontemporary usage,” as a generic name for a category of churches but rather are “recognizable” as the name for a particular religious organization—namely, Petitioner. *See TE-TA-MA Truth Found.*, 297 F.3d at 666. If a person said, “I belong to the Universal Church,” or “the Universal Church website is full of good information,” the summary judgment record showed that the speaker would be understood as referring to Petitioner. Under the test of the Sixth, Seventh, and Eighth Circuits, Petitioner would have been entitled to summary judgment in its favor, or at minimum a trial, on whether its marks were generic.

The Second Circuit subjected Petitioner to a different test. Because Petitioner is a religious organization, the Second Circuit did not assess Petitioner’s trademarks in light of the full record of contemporary understanding. Instead, the Second Circuit deemed “universal church” to be generic because the court believed it had found uses of this term referring to the Christian church as a whole in archaic and technical theological texts. Given this religious usage, the Second Circuit deemed irrelevant as a matter of law the documented evidence of contemporary public perceptions, including that “the vast majority” of Protestant, Orthodox, and Pentecostal Christians do not understand “universal church” as generic.

In so holding, the Second Circuit deepened a split over how to determine whether religious organizations’ names are generic and so ineligible for trademark

protection. The New Jersey Supreme Court and now the Second Circuit apply a religion-specific test under which they disregard evidence of contemporary public perceptions and resolve genericness as a matter of law based on archaic and technical religious documents. *Christian Sci. Bd. of Dirs. of First Church of Christ, Scientist v. Evans*, 520 A.2d 1347, 1352 (N.J. 1987); Pet. App. 4a–5a. Indeed, the district court below conceded that the Sixth and Seventh Circuits would have applied a different “test.” Pet. App. 33a n.23. And the Trademark Trial and Appeal Board has likewise recognized the “split” among courts on this question and the “difficulties” involved “in determining the trademark rights of religious institutions.” *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. 1996).

The Court’s review is warranted to resolve this acknowledged split. This case is a sound vehicle, squarely presenting and precisely framing the legal disagreement. And the question presented is important. Like other mark-holders, religious organizations depend on their marks to identify themselves, safeguard their goodwill, and prevent fraud. Yet the decisions below disfavor religion in general, and newer religious organizations in particular, by subjecting religious organizations to a uniquely stringent standard that divests them of trademark protection when—as is often the case—their names are susceptible to both generic and descriptive interpretations.

These concerns are not hypothetical. The district court here acknowledged that its approach called into question the trademark protection enjoyed by other

religious organizations, including the “Episcopal Church.” Indeed, if left undisturbed, the decision below will call into question an untold number of currently registered trademarks and afford litigants the opportunity to forum-shop by rushing to the Second Circuit.

The Court should grant review in order to end the disagreement that has resulted from the Second Circuit’s departure from the statutory text.

STATEMENT OF THE CASE

A. Legal Background

Enacted in 1946, the Lanham Act “provide[s] national protection for trademarks.” *Park ’N Fly*, 469 U.S. at 193 (citing S. Rep. No. 79-1333, at 5 (1946)). Every trademark infringement claim raises two questions: (1) is the mark protectable?, and (2) is the competing use of the mark likely to cause confusion? *See Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768–70 (1992).

The first question requires a court to classify the mark based on its distinctiveness. Marks classified as suggestive, arbitrary, or fanciful are “inherently distinctive” and therefore are entitled to trademark protection without any further showing. *Id.* at 768. Marks that merely describe the qualities or characteristics of a product or service are “descriptive.” *Park ’N Fly*, 469 U.S. at 194. These marks can receive protection if they have “secondary meaning”—that is, if they have become distinctive of the product or service. *Id.*; *see also* 15 U.S.C. § 1052(e), (f).

Generic terms, by contrast, lack trademark protection. A generic term names “the genus of which the particular product is a species.” *Park ’N Fly*, 469 U.S. at 194. Generic terms are not protectable, and registered marks are subject to cancellation at any time if they become generic. *See* 15 U.S.C. §§ 1052, 1064(3). Under the Lanham Act, “the test for determining whether the registered mark has become the generic name of goods or services” is “[t]he primary significance of the registered mark to the relevant public.” *Id.* § 1064(3).

Trademarks may be registered with the U.S. Patent and Trademark Office. A registered trademark carries a presumption of validity. *Reese Publ’g Co. v. Hampton Int’l Commc’ns, Inc.*, 620 F.2d 7, 11 (2d Cir. 1980). If a defendant challenges a registered mark as generic or as descriptive but lacking secondary meaning, it bears the burden to show genericness or descriptiveness. But once five years pass from the registration date, the registration cannot be challenged based on descriptiveness. 15 U.S.C. § 1064(1). Moreover, if marks have been in continuous use for at least five consecutive years from registration and remain in use, the Lanham Act establishes a procedure for marks to become “incontestable.” *Id.* § 1065. This status provides conclusive evidence of registration, validity, ownership, and exclusive use. *Id.*; *see Park ’N Fly*, 469 U.S. at 196 (identifying limited defenses enumerated by statute).

B. Factual Background

Petitioner The Universal Church, Inc. is a Christian church incorporated in 1987 as a not-for-profit corporation. Pet. App. 9a; *see generally* The Universal

Church, web.universal.org/usa (last visited Mar. 1, 2019). At summary judgment, Petitioner had more than 30,000 congregants in over 20 states (and now has 300 locations in 33 states, *see* web.universal.org/usa). Pet. App. 9a; JA357, 359 (Silva-Neto Deposition).¹ Petitioner is spiritually affiliated with the Universal Church of the Kingdom of God, a Brazilian church with millions of members (although the two are legally distinct). Pet. App. 9a–10a. Petitioner also produces and broadcasts popular weekly television and radio programming, publishes books and newsletters, holds charitable events, sponsors outreach programs, ordains ministers, and otherwise seeks to promote its religious mission while enriching and benefiting both its congregants and the community. *See* JA503–JA504 (screenshot of Petitioner’s website); JA2187–JA2190 (Petitioner’s newsletters).

Petitioner offers services and counseling under its trademarks “The Universal Church” and “Universal Church.” Pet. App. 11a–12a. Petitioner registered “Universal Church” with the U.S. Patent and Trademark Office in 2006 for use in “evangelistic and ministerial services, namely, conducting religious worship services.” Pet. App. 11a–12a. That mark achieved incontestable status in 2012. Pet. App. 12a. The same year, Petitioner also registered “The Universal Church” for use in “religious counseling and ministerial services,” “newsletters and informational brochures all about religious beliefs and practices,” and

¹ References to the Joint Appendix prepared for the Second Circuit are denoted as JA__.

“t-shirts distributed in connection with religious groups.” Pet. App. 12a.

Respondents operate the “Universal Life Church.” Pet. App. 10a–11a. Universal Life Church identifies as a church but has no physical presence and holds itself out as providing online ordinations that allow laypeople to perform marriages. Pet. App. 10a–11a; JA488 (screenshot of Respondents’ website). In 2009, Respondents attempted to register the mark “Universal Life Church.” Pet. App. 12a. The U.S. Patent and Trademark Office rejected the application, citing the likelihood of confusion with other registered marks, including Petitioner’s. Pet. App. 12a. Respondents then had the opportunity to respond with evidence supporting the distinctiveness of their proposed mark. Pet. App. 12a.

Instead, Respondents abandoned their application and used Petitioner’s registered marks. Pet. App. 12a–13a. Over the next four years, they acquired 17 domain names with the words “universal church”—including www.universalchurch.org. Pet. App. 13a. As shown in the screenshot below, Respondents prominently used the words “Universal Church” or “The Universal Church,” on their website, including in the top left-hand corner of the homepage. Pet. App. 14a.



JA2247–JA2248 (screenshot of Respondents’ website as it appeared on March 10, 2013).

In addition, Respondents drove traffic to the website through various tactics that traded on Petitioner’s marks. Pet. App. 14a–17a. To begin, Respondents manipulated the HTML metadata affiliated with the site so that it appeared under the title “The Universal Church” in search results. Pet. App. 15a–16a. Respondents also bid on Petitioner’s trademarks to place “pay-per-click” advertisements. Pet. App. 16a. Consequently, individuals who searched Petitioner’s marks—such as “The Universal Church”—were apt to find Respondents’ websites at the top of the results. Pet. App. 16a & n.8. Finally, Respondents hijacked location-based search results to redirect individuals toward their domains. Pet. App. 16a–17a. Thus, a person who searched the physical address of one of Petitioner’s locations (for example, 1077 Southern Boulevard in the Bronx) would see a search result that linked Respondents’ website (www.themonastery.org) to Petitioner’s church. Pet. App. 17a.

C. Proceedings In District Court

Petitioner sued Respondents for trademark infringement. Pet. App. 17a–18a. Petitioner brought claims under the Lanham Act, 15 U.S.C. §§ 1114(1) and 1125(a), and the Anticybersquatting Consumer Protection Act, *id.* § 1125(d). Petitioner also asserted claims under state law for trademark infringement, unfair competition, and deceptive business practices. Pet. App. 18a. Respondents counterclaimed by seeking declaratory judgment and trademark cancellation. Pet. App. 18a.

The parties cross-moved for summary judgment. Bearing the burden to prove genericness, Respondents relied largely on their expert—a Catholic theologian and canon lawyer who culled his examples from historical documents and technical theological texts from the Catholic Church, like Papal bulls that supposedly used the term “universal church” to draw an “important theological distinction.” JA636; *see* Pet. App. 24a–27a. Respondents’ expert did not seek to establish the term’s contemporary usage among the public as a whole, JA613–30, and admitted in his deposition that how the term “is used by contemporary people” “is not my expertise,” JA666. Indeed, he “wasn’t interested in that” but rather “was interested in the history of how the phrase was used.” JA666.

Respondents also relied on the *Oxford English Dictionary*’s fourth entry for the adjective “universal”— “[d]esignating the whole Christian Church or all Christians collectively.” Pet. App. 25a; JA572. The dictionary identifies only one example of that usage from the past 75 years—*The Oxford Companion to Christian*

Thought's description of the Pope's claim to "authority over the universal church in a way unique to itself and derived from St Peter." JA572.

For its part, Petitioner presented substantial evidence that the understanding offered by Respondents "is confined mostly to technical theological usage." JA742 (Irvin Report). Petitioner's evidence showed that "[t]he vast majority" of Protestant, Orthodox, and Pentecostal Christians do not understand "Universal Church" as generic, and that "among Pentecostal and Charismatic communities both in the USA and around the world, the phrase 'universal church' is highly distinctive" and "is immediately recognized as the name of a major Pentecostal denomination"—namely, Petitioner's denomination. *Id.* The summary judgment record also showed that tens of thousands of congregants attended weekly Universal Church services, and that Petitioner reached hundreds of thousands weekly through television broadcasts. JA358–60 (Silva-Neto Deposition). The record further showed that Petitioner maintained a social media presence and published books and letters. JA360-61 (Silva-Neto Deposition); JA1760–61 (DaSilva Deposition); JA1764, 1767–68 (Verma Deposition).

In addressing the cross-motions, the district court properly placed on Respondents the burden of proving genericness. Pet. App. 24a. Even so, it held that "The Universal Church" and "Universal Church" are generic names for a "type of church" that "considers itself to be universal in the sense of representing the entire Christian church." Pet. App. 33a. For the district court, it was dispositive that the parties supposedly "agree[d]"

that these phrases appear in “Roman Catholic theology” and the *Oxford English Dictionary*’s historical catalog (as well as in “occasional” uses “by Lutherans and Methodists”). Pet. App. 26a. Given this historical and theological evidence, the district court deemed irrelevant as a matter of law the understanding shared by the “vast majority” of those who attend Methodist, Lutheran, or other Protestant Churches. JA742.

The court conceded that the Sixth and Seventh Circuits took a different approach. Pet. App. 33a–34a n.23 (citing *McGill*, 617 F.3d at 413; *TE-TA-MA Truth Found.*, 297 F.3d at 666). But it declined to “appl[y] such a test.” *Id.* And the court acknowledged its decision’s potentially broad effects—recognizing the argument that, under its rule, “the Episcopal Church” and “the Presbyterian Church ... must also be generic” but declining to resolve those questions “on the record before [it].” Pet. App. 35a–36a n.24.

In the alternative, the district court found that the trademark infringement claim failed because there was no likelihood of confusion about the origin or sponsorship of Respondents’ services. Pet. App. 36a. It incorporated its analysis of genericness into that finding, relying on its conclusion that “Universal Church” was generic “[a]s discussed above.” Pet. App. 39a. The court ordered the cancellation of the marks.² Pet. App. 55a.

D. Proceedings In The Second Circuit

The Second Circuit affirmed the genericness ruling. Pet. App. 6a. Like the district court, it pointed to

²The district court also granted summary judgment to Respondents on the rest of Petitioner’s claims. Pet. App. 48a–53a.

Respondents’ expert testimony and dictionary definition, which it found showed that “the phrase [‘universal church’] has been in generic usage over two millennia to describe the Church as a whole throughout the world.” Pet. App. 4a.

The Second Circuit then held that Petitioner had failed to present “any contrary admissible evidence that the term ‘Universal Church’ does not generically refer to religious counseling and evangelistic and ministerial services.” Pet. App. 5a. According to the Second Circuit, “the testimony of Universal Church’s ... expert alone failed to create a genuine dispute that the term ‘Universal Church’ refers to Christian services in general among the relevant public.” Pet. App. 5a. The Second Circuit likewise held that Petitioner’s broad viewership and membership failed to create a genuine dispute. Pet. App. 5a. In the Court’s view, “no matter ... what success [the user of a generic term] has achieved in securing public identification, it cannot deprive competing manufacturers of the product of the right to call an article by its name.” Pet. App. 5a (citing *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976)). The Second Circuit did not reach the district court’s alternative ruling on the likelihood of confusion. Pet. App. 6a–7a.

Petitioner timely filed this Petition on March 4, 2019.

REASONS FOR GRANTING THE WRIT

This case is a sound vehicle to resolve a circuit split on an important question of federal trademark law. In assessing whether Petitioner’s marks were generic, the courts below applied a different test than would have governed in the Sixth, Seventh, and Eighth Circuits—as

the district court acknowledged and the Second Circuit did not dispute. And because the courts below applied a different test, they reached a different result. Petitioner would have prevailed in the Sixth, Seventh, and Eighth Circuits, and at minimum, Petitioner's trademark infringement claims would have survived summary judgment.

This division of authority is important: It recurs frequently and goes to the heart of religious organizations' ability to protect their names—many of which have deep historical roots. Meanwhile, by departing from its sister circuits and the statutory text, the Second Circuit has called into question an untold number of currently registered trademarks. It has also disfavored religion by making religious organizations uniquely vulnerable to claims that their names are generic. This Court should grant certiorari to restore national uniformity and correct the Second Circuit's erroneous approach.

I. Courts Are Divided Over The Question Presented, Yielding Disarray In Lower Courts As Like Cases Are Decided Differently.

In the decision below, the Second Circuit deepened a division of authority over how to assess whether names of religious organizations are generic. Certiorari is warranted to resolve that disagreement.

A. The Sixth, Seventh, And Eighth Circuits Conduct A Fact-Based Inquiry Into Contemporary Public Perceptions.

The Sixth, Seventh, and Eighth Circuits ask a factual question that applies the same test to religious

organizations that governs elsewhere: How does the relevant public in fact perceive the religious organization's name? If the contemporary public understands the term as generic, it cannot be trademarked. But if the contemporary public understands the term as potentially referring to a specific religious organization or denomination, the term is not generic and it retains trademark protection.

The Sixth Circuit relied on this approach to conclude that “Seventh-day Adventist” is not generic. *Gen. Conference Corp. of Seventh-Day Adventists v. McGill*, 617 F.3d 402, 413 (6th Cir. 2010). The phrase dated to the nineteenth century, and the challenger stressed that it was possible to understand this phrase as a generic name for a particular set of religious beliefs—bolstering its position with a theological work and a dictionary definition. *Id.* at 415.³ But the Sixth Circuit deemed that possibility irrelevant and framed the test as how “society understands” the phrase. *Id.* at 412; *see id.* (citing the Seventh Circuit’s decision in *TE-TA-MA*, discussed below, as applying the same test).

The Sixth Circuit emphasized that the challenger could not demonstrate genericness without “an objective appraisal of the public’s view” or “any study of popular perceptions.” *Id.* at 416. Yet the challenger

³ Different religious organizations sometimes share a set of religious beliefs. For example, the Roman Catholic Church and the Episcopal Church are each discrete, identifiable religious organizations but share certain Christian religious beliefs. The Sixth Circuit understood that a term may be generic if the contemporary public understands the term—like “Christian”—to name a set of religious beliefs shared by many religious organizations.

offered only “scant evidence” about how “*the public* perceives the term.” *Id.* at 415 (emphasis in original). The Sixth Circuit therefore concluded that the challenger “adduced insufficient evidence to show that [Christians and Adventist Christians in particular] would understand ‘Seventh-day Adventist’ as referring to certain religious beliefs rather than to the plaintiffs’ church.” *Id.*

The Seventh Circuit likewise treats “contemporary usage” as the lodestar. It formulates the test as whether the mark is “recognizable” as a denominational name in “contemporary usage,” as opposed to “the designation of the religion to which the denominations belong.” *TE-TA-MA Truth Found.--Family of URI, Inc. v. World Church of the Creator*, 297 F.3d 662, 666 (7th Cir. 2002). Applying that test, the Seventh Circuit reversed a district court’s ruling that the trademark “Church of the Creator” is generic. *Id.*

Under the Seventh Circuit’s test, as in the Sixth, neither dictionary definitions nor historical usages are dispositive. The Seventh Circuit rejected the district court’s reliance on “lexicographers’ definitions ... because dictionaries reveal a range of historical meanings rather than how people use a particular phrase in contemporary culture.” *Id.* Even though it was possible to construe “Church of the Creator” as naming “the class of monotheistic religions” generally, the court found that the contemporary public did not use the phrase that way. *Id.*

The Seventh Circuit identified a host of other names that, under its test, are non-generic, including “Church of God,” “First Church of God,” “Worldwide Church of

God,” and “Church of Christ.” *Id.* Each of these names has a long historical pedigree. And for each, it is linguistically possible to understand the term as referring to a class of churches in general (such as “Church of God” for a “monotheistic religion,” or “Church of Christ” for religious organizations following the teachings of Jesus Christ). But in the Seventh Circuit, as in the Sixth, these historical usages and linguistic possibilities were irrelevant—because what mattered were the contemporary perceptions of the relevant public. The Seventh Circuit explained that “[i]n the contemporary United States,” these types of names serve to “differentiate individual denominations”—not to “denote the class of all religions.” *Id.* Thus, members of other monotheistic religions like Judaism and Islam would not count themselves as members of the “Church of the Creator,” even if they believe all things spring from one divine source. *Id.*

The Eighth Circuit follows that approach, too. *See Cmty. of Christ Copyright Corp. v. Devon Park Restoration Branch of Jesus Christ’s Church*, 634 F.3d 1005, 1012 (8th Cir. 2011). When required to decide whether the phrase “Reorganized Church of Jesus Christ of Latter Day Saints” was generic, the Eighth Circuit asked how “the relevant public understands the marks.” *Id.* (citing *TE-TA-MA Truth Found.*, 297 F.3d at 666) (capitalization omitted). Because the challenger “failed to present any evidence that the primary significance to the relevant public” of the mark was generic, its challenge failed. *Id.*

B. The Second Circuit, Joining The New Jersey Supreme Court, Disdains Evidence Of Contemporary Public Perceptions.

The Second Circuit and the New Jersey Supreme Court take a different approach, judging the trademarks of religious organizations by religious standards. In these courts, if a challenger produces evidence that a religious organization’s name carries an older and potentially broader meaning predating the organization—such as the dictionary definitions and theological texts rejected in *TE-TA-MA* and *McGill*—then the name is generic, regardless of how the contemporary public *in fact* understands the name.

That is the legal standard the Second Circuit followed in concluding that “Universal Church” and “The Universal Church” are generic. Pet. App. 4a–5a. In the Second Circuit’s view, what mattered—all that mattered—was that “universal church” had an ancient meaning that persisted in a technical theological usage. *Id.* That legal standard is why the Second Circuit could grant summary judgment to Respondents based on one entry in the *Oxford English Dictionary*’s definition of “universal,” and an expert opinion cataloging this technical usage in Catholic theology. *Id.*

That standard is also why the Second Circuit could disregard, as irrelevant as a matter of law, Petitioner’s evidence showing that the contemporary public does not understand “Universal Church” or “The Universal Church” to mean Christianity as a whole. Pet. App. 5a–6a; *see supra* at 12–13. The Second Circuit did not dispute the evidence that “the vast majority” of Protestant, Orthodox, and Pentecostal Christians do not

understand these phrases as generic, or that “among Pentecostal and Charismatic communities both in the USA and around the world, the phrase ‘universal church’ is highly distinctive” and refers to Petitioner’s church. JA742; *see* Pet. App. 5a–6a. In the Second Circuit’s view, the historical pedigree of “universal church” rendered irrelevant this evidence about the contemporary public’s understanding.⁴ Pet. App. 4a–6a.

This result cannot not be squared with the approach followed in the Sixth, Seventh, and Eighth Circuits. In those courts, Petitioner would have prevailed, and at a minimum, its evidence of contemporary public perceptions would have precluded entry of summary judgment *against* Petitioner. That evidence showed that Petitioner’s marks are “recognizable” in contemporary usage as something besides a generic name for a religion or set of religions—namely as the name of a specific religious organization. *TE-TA-MA Truth Found.*, 297 F.3d at 666. No more would be required in the Sixth, Seventh, and Eighth Circuits.

⁴ The district court at one point characterized Respondents’ expert as showing that the phrase “universal church” is “well established within the Roman Catholic Church.” Pet. App. 26a. But if the court meant that this phrase is well-established among contemporary Catholics generally, it misstated the record. The deposition testimony made clear that Respondents’ expert was not “interested in” contemporary usage, which was “not [his] expertise.” *Supra* at 11. The Second Circuit did not rely on this aspect of the district court’s reasoning. Indeed, the courts below did not identify any evidence that in any era—archaic or modern—*the public generally*, as opposed to theologians, used the phrase “universal church” in a generic manner.

In deeming this public-perception evidence irrelevant, moreover, the Second Circuit relied on factors that other circuits have rejected. Where the Second Circuit deemed a cherry-picked dictionary definition dispositive, the Sixth and Seventh Circuit rejected similar reliance on “lexicographers’ definitions,” which “reveal a range of historical meanings” rather than contemporary usage. *TE-TA-MA Truth Found.*, 297 F.3d at 666; *McGill*, 617 F.3d at 415. And where the Second Circuit ended its inquiry after finding that these definitions revealed a historical usage predating the establishment of Petitioner’s organization, the Seventh Circuit held that denomination names are non-generic even if they carry a similar historical pedigree. *Compare, e.g., TE-TA-MA Truth Found.*, 297 F.3d at 666 (identifying “Church of God” as non-generic), *with* John Smith, *An Exposition of the Creed: or, an Explanation of the articles of our Christian faith* 525 (1632) (“but the Church of God is the company of the faithfull ones, and the Elect people of God”); *TE-TA-MA Truth Found.*, 297 F.3d at 666 (identifying “Assembly of God” as non-generic), *with* Samuel Clark, *Sermons* 382 (1742) (identifying the “Assembly of God[]” as the entire Christian church “considered together”); *TE-TA-MA Truth Found.*, 297 F.3d at 666 (identifying “Disciples of Christ” as non-generic), *with* William Bayly, *A Collection of the Several Writings* 260 (1676 reprint 1830) (referring to the “disciples of Christ” as “the christians”).

It is no surprise, then, that the district court below found that, in order to grant judgment to Respondents, it had to part ways with the Sixth and Seventh Circuits.

Pet. App. 33a–34a n.23. The Second Circuit did not dispute this conclusion. Pet. App. 3a–6a.

While the Second Circuit’s approach is at odds with decisions in its sister circuits, it accords with the approach of the New Jersey Supreme Court. *See Christian Sci. Bd. of Dirs. of First Church of Christ, Scientist v. Evans*, 520 A.2d 1347, 1352 (N.J. 1987). In holding that “Christian Science Church” is generic, the New Jersey Supreme Court deemed it dispositive that this phrase “pre-existed” the establishment of the institution now known as the Christian Science Church. *Id.* at 1351. The court therefore concluded, “as a matter of pure common sense,” that the name *must be* generic. *Id.* at 1352. Like the Second Circuit, the New Jersey Supreme Court did not deem it necessary to assess evidence of the *actual* contemporary public understanding. *Id.*

II. This Case Merits The Court’s Review.

A. The Question Presented Is Important.

This division of authority warrants the Court’s intervention. The question arises frequently, and because courts disagree on the test to apply, they reach inconsistent results. Disarray reigns. “Seventh-day Adventist” is protected, while “Christian Science” is not; “Church of the Creator,” “Church of Christ,” and “Assembly of God” are protected, yet “Universal Church” is not; “Jews for Jesus” is protected, but “New Thought Church” is not. *McGill*, 617 F.3d at 412–13; *Cnty. 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).

Indeed, a panel of the Trademark Trial and Appeal Board that divided over “Seventh-day Adventist” lamented that “[t]his split in the courts illustrates the difficulties in determining the trademark rights of religious institutions.” *Stocker*, 1996 WL 427638, at *8. This disagreement and confusion cries out for the Court’s intervention.

Meanwhile, if the Court stays its hand, many other religious organizations are at risk. Many have the features that, in the Second Circuit, now render a term generic: They have historical roots and can be understood, linguistically, as referring to a group of churches or beliefs. Take, for example, two names that the district court declined to resolve “on the record before” it—Episcopal Church and Presbyterian Church. Pet. App. 35a–36a n.24. Both of these adjectives have been used “for hundreds of years, and even thousands of years.” Pet. App. 26a (quotation marks omitted). And both can be understood as a class of religious organizations, rather than a particular denomination—“episcopal” churches are churches governed by bishops; “presbyterian” churches are churches governed by elders. JA745. Also at risk will be many other trademarks registered by the U.S. Patent and Trademark Office and canvassed by the Seventh Circuit and the district court below, including “Church of God in

Christ,”⁵ “Living Church of God,”⁶ and the “Worldwide Church of God.”⁷ Outside the Second Circuit, these religious organizations can fend off challenges by showing that the contemporary public does not perceive their names as generic—but not in the Second Circuit, and not in New Jersey. The results of these challenges will now turn largely on where suit is brought.

Heightening the threat posed by the decision below is the Second Circuit’s importance as a trademark jurisdiction. “There is no question that the Second Circuit has had a significant influence on the development of U.S. intellectual property law,” in part because “many of the business segments for which intellectual property rights were key assets, or at the heart of the endeavor, were concentrated in the New York area.” See Kenneth A. Plevan, *The Second Circuit and the Development of Intellectual Property Law: The First 125 Years*, 85 *Fordham L. Rev.* 143, 143 (2016). The decision below thus invites forum-shopping. Parties seeking to invalidate marks can rush to the Second Circuit in order to benefit from its more favorable test and obtain judgments invalidating marks that would

⁵ See, e.g., Hugh M’Neile, *The Church and the Churches; Or, the Church of God in Christ* 102 (1846) (identifying various Old Testament biblical figures as “member[s] of the church of God in Christ”).

⁶ See, e.g., Joseph Irons, *Grove Chapel Pulpit: Fifty-Two Discourses* 61 (1848) (referring to the Christian Church as the “living Church of God”); Charles Pettit M’Ilvaine, *The Holy Catholic Church or the Communion of Saints in the Mystical Body of Christ: A Sermon* 71 (1844) (referring to the “holy, Catholic, living Church of God”).

⁷ Henry Edward Manning, *The Grounds of Faith* 22 (1852) (referring to “communion with the world-wide Church of God”).

receive protection in the Sixth, Seventh, and Eighth Circuits.

The consequences for religious organizations and their members are serious. Like other mark-holders, religious organizations depend on their marks to identify themselves, safeguard their goodwill, and prevent fraud. *See* 1 McCarthy § 9:7.50 (“Confusion of source or affiliation can damage the religious status and fund raising efforts of a religious group.”). Those functions have special importance for places of worship, where people often turn in times of vulnerability and crisis for religious and spiritual guidance. Yet the decisions below *disfavor* religious organizations by subjecting their marks to a uniquely harsh test for genericness. They thereby compromise the ability of religious organizations to identify and distinguish themselves as legitimate organizations, intensifying the risk of predation on their would-be members or on congregants who want to ensure that donations reach the right hands. *See* Scott Cohn, *Religious-based financial fraud is rampant. Here’s how to fight it*, CNBC (Sept. 7, 2018), <https://www.cnbc.com/2018/09/06/religious-based-financial-fraud-is-rampant-heres-how-to-fight-it.html>. It also harms the religious organizations, which expend significant resources to develop marks as a means of protecting their good names.

Indeed, the rationale of the decisions below is not limited to religious names. If a word’s ancient roots can doom a religious organization’s trademark, the same is true for any word or phrase that can be found in a hoary treatise. This will place at risk an even wider array of trademarks. *Cf.* Arthur J. Greenbaum, Jane C. Ginsburg

& Steven M. Weinberg, *A Proposal for Evaluating Genericism after “Anti-Monopoly,”* 73 Trademark Rep. 101, 125 n.63 (1983) (using the example of the now-obsolete word “bodkin,” used in Shakespeare’s time to name a kind of knife, as “a perfectly acceptable trademark”).

B. This Case Is A Sound Vehicle.

This case is also a sound vehicle. The Second Circuit’s decision rests on a single legal determination: that “Universal Church” and “The Universal Church” are generic based on historical usage and technical theological works, regardless of how the contemporary public perceives these terms. Pet. App. 4a–6a. That ruling was determinative of Petitioner’s case. Pet. App. 6a–7a.

This case is a particularly strong vehicle because the record precisely frames the question presented. Petitioner adduced “evidence about how religious adherents use or understand the phrase as a unit”—exactly the type of evidence cited by the Seventh Circuit as capable of proving the “use [of] a particular phrase in contemporary culture.” *TE-TA-MA Truth Found.*, 297 F.3d at 666. Moreover, the Second Circuit deemed this evidence irrelevant as a matter of law, Pet. App. 5a–6a, and instead relied on the type of evidence dismissed by the Seventh Circuit as *irrelevant*: “lexicographers’ definitions” that “reveal a range of historical meanings” rather than memorializing contemporary usage. *TE-TA-MA Truth Found.*, 297 F.3d at 666; *see* Pet. App. 4a–5a. Notably, the Second Circuit relied on just one dictionary definition from the *Oxford English Dictionary*, a “historical dictionary” that describes itself

as “very different from Dictionaries of current English, in which the focus is on present-day meanings.” Oxford English Dictionary, “About,” <https://public.oed.com/about/>. The approaches of the Second and Seventh Circuits are at odds with each other.

It is no impediment to review that the district court found, in the alternative, that there was no likelihood of confusion. Pet. App. 36a. The Second Circuit did not reach that issue, instead affirming based solely on its genericness holding. This Court routinely grants certiorari in such circumstances and remands for a circuit court to consider alternative grounds it did not previously reach—including in this precise context. *See Park 'N Fly*, 469 U.S. at 205 (reversing and remanding to address likelihood of confusion, which was decided by the district court but not addressed by the court of appeals). Here, that approach is especially sensible: When the district court analyzed likelihood of confusion, it expressly relied on its conclusion that “Universal Church” was generic, “[a]s discussed above.” Pet. App. 39a. It is anyone’s guess whether the district court would reach the same result absent its flawed analysis of genericness.

III. The Decision Below Is Wrong.

Review is especially warranted because the approach adopted by the Second Circuit (and the New Jersey Supreme Court) is wrong. Instead, the Sixth, Seventh, and Eighth Circuits have it right: The critical question is how the contemporary public understands a religious organization’s name.

First, the Second Circuit’s approach cannot be squared with the statute’s text, which directs courts to

assess the “*primary* significance of the registered mark to the *relevant* public.” 15 U.S.C. § 1064(3) (emphasis added). Other circuits acknowledge that, because the “relevant public” consists of consumers *today*, the statute requires analyzing contemporary public perceptions. *See, e.g., Thomas & Betts Corp. v. Panduit Corp.*, 138 F.3d 277, 301 (7th Cir. 1998); *Nartron Corp. v. STMicroelectronics, Inc.*, 305 F.3d 397, 406 (6th Cir. 2002); *Cmty. of Christ Copyright Corp.*, 634 F.3d at 1011. As the Second Circuit acknowledged, the “relevant public” in this case “is all those who seek and provide religious worship services.” Pet. App. 4a. Yet the Second Circuit found “universal church” generic based on historical and specialized usages found in Catholic texts “mostly addressed to and read by the members of the hierarchy of the church and trained professional theologians,” and “not common[ly] read in churches, used in worship, or regularly cited by members of the laity.” JA743 (Irvin Report). That is not the approach the statute dictates. *See* 2 McCarthy §12:4 (proper test for genericness is meaning to ordinary consumers, “not to professionals in the trade”); *id.* § 11:33 (obscure meanings recognized only by “lexicographers or devotees of antiquity” are “irrelevant to the critical enquiry of the effect of the term upon a substantial segment of prospective purchasers.”). The Sixth, Seventh, and Eighth Circuits take the correct approach, which would not have disregarded Petitioner’s expert evidence addressing a broad cross-section of the “relevant public” and showing that the “primary

significance” of Petitioner’s marks is not generic. JA740–43.⁸

Second, the Second Circuit’s approach crowds out mark-holders who can legitimately demonstrate that the public finds their name to be distinctive. In the Second Circuit’s view, it does not matter how many members of the public understand Universal Church to refer to Petitioner; all that matters is the term had an older meaning that may not even be known to today’s church-going public. Trademark law should foster precisely the opposite result: to protect marks the public recognizes as distinctive. *Cf.* Greenbaum, 73 Trademark Rep. at 125 n.63 (1983). Moreover, as Judge Easterbrook explained, “using [Universal Church] as a denominational name leaves ample options for other sects to distinguish themselves and achieve separate identities. ... Because there are so many ways to describe religious denominations, there is no risk that exclusive use of [Universal Church] will appropriate a theology or exclude essential means of differentiating one set of beliefs from another.” *TE-TA-MA Truth Found.*, 297 F.3d at 666–67.

Third, if anything, the need to protect distinctive marks is even greater in the context of religious

⁸ For its part, the district court erred by giving weight to the appearance of “universal” in other denomination names, like “Universal Church of God, Fire Baptized,” or “Unitarian Universalism.” Pet. App. 26a–27a. As the Seventh Circuit explained, the genericness inquiry does not look to usages or “definitions of the individual words,” but only how the contemporary public “use[s] or understand[s] [a] phrase as a unit.” *TE-TA-MA Truth Found.*, 297 F.3d at 666.

services. Religious organizations like Petitioner occupy a special position of trust. They solicit donations for charitable endeavors; offer counseling for the most profound of problems; and enjoy a public and prominent position in the communities they serve. It is particularly important for Petitioner, its members, and the public to know that, when they see and hear about the Universal Church, it is this particular church—not some other organization trading on the church’s good name or stealing the church’s identity to perpetrate fraud. No one should be able to use the Episcopal Church mark except the owner of that mark; so too with the Universal Church.

In sum, the Second Circuit adopted an erroneous approach that does not make sense of the statutory text defining the genericness inquiry and does not advance the purpose of the genericness defense. This Court should grant review to clarify that religious organizations, like other mark-holders, receive federal trademark protection unless a challenger presents competent evidence of generic meaning in contemporary public usage.

CONCLUSION

For the reasons stated above, the petition should be granted.

Respectfully submitted,

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March 4, 2019

APPENDIX

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Appendix A

MANDATE ISSUED ON 11/26/2018

17-2960-cv

The Universal Church, Inc. v. Toellner

UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT

SUMMARY ORDER

RULINGS BY SUMMARY ORDER DO NOT HAVE PRECEDENTIAL EFFECT. CITATION TO A SUMMARY ORDER FILED ON OR AFTER JANUARY 1, 2007 IS PERMITTED AND IS GOVERNED BY FEDERAL RULE OF APPELLATE PROCEDURE 32.1 AND THIS COURT'S LOCAL RULE 32.1.1. WHEN CITING A SUMMARY ORDER IN A DOCUMENT FILED WITH THIS COURT, A PARTY MUST CITE EITHER THE FEDERAL APPENDIX OR AN ELECTRONIC DATABASE (WITH THE NOTATION "SUMMARY ORDER"). A PARTY CITING TO A SUMMARY ORDER MUST SERVE A COPY OF IT ON ANY PARTY NOT REPRESENTED BY COUNSEL.

At a stated term of the United States Court of Appeals for the Second Circuit, held at the Thurgood Marshall United States Courthouse, 40 Foley Square, in the City of New York, on the 2nd day of November, two thousand eighteen.

PRESENT: JOHN M. WALKER, JR.,
RAYMOND J. LOHIER, JR.,
Circuit Judges,

2a

WILLIAM H. PAULEY III,*
District Judge.

THE UNIVERSAL CHURCH, INC.,
*Plaintiff-Counter-
Defendant-Appellant,*

v. No. 17-2960-cv

CALVIN TOELLNER, GEORGE FREEMAN,
BRUCE TAYLOR, UNIVERSAL LIFE
CHURCH/ULC MONASTERY, UNIVERSAL
LIFE CHURCH MONASTERY STOREHOUSE,
*Defendants-Counter-
Claimants-Appellees,*

DANIEL CHAPIN,
Defendant.

FOR APPELLANT: DAVID DONAHUE (Laura
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Jennifer Insley-Pruitt, *on
the brief*), Fross Zelnick
Lehrman & Zissu, P.C.,
New York, NY; Katherine
J. Daniels, Tendy Law

* Judge William H. Pauley III, of the United States District Court
for the Southern District of New York, sitting by designation.

3a

Office, LLC, New York,
NY.

FOR APPELLEES: JURA C. ZIBAS (Stephen J.
Barrett, *on the brief*),
Wilson Elser Moskowitz
Edelman & Dicker LLP,
New York, NY.

Appeal from a judgment of the United States
District Court for the Southern District of New York
(Naomi Reice Buchwald, *Judge*).

UPON DUE CONSIDERATION, IT IS HEREBY
ORDERED, ADJUDGED, AND DECREED that the
judgment of the District Court is AFFIRMED.

The Universal Church, Inc. (“Universal Church”)
appeals from a September 20, 2017 order of the District
Court (Buchwald, *J.*) granting summary judgment in
favor of appellees (collectively, “Universal Life
Church”). We assume the parties’ familiarity with the
underlying facts and the record of prior proceedings, to
which we refer only as necessary to explain our decision
to affirm.

The standards for our *de novo* review of the District
Court’s grant of summary judgment are well
established. See *Nick’s Garage, Inc. v. Progressive Cas.
Ins. Co.*, 875 F.3d 107, 113 (2d Cir. 2017); *Nora
Beverages, Inc. v. Perrier Grp. of Am., Inc.*, 164 F.3d 736,
745 (2d Cir. 1998). In granting summary judgment on
Universal Church’s trademark infringement claim and
cancelling its trademark registrations, the District
Court concluded that the trademarks “Universal
Church” and “The Universal Church” are generic. A

term is generic if it “refers to the genus of which the particular product is a species.” *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 194 (1985) (citing *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976)). In determining whether a term is generic, moreover, “the relevant purchasing public is not the population at large, but prospective purchasers of the product.” *Lane Capital Mgmt., Inc. v. Lane Capital Mgmt., Inc.*, 192 F.3d 337, 345 (2d Cir. 1999). Here, the District Court concluded that the relevant public is all those who seek and provide religious worship services, and Universal Church does not challenge this conclusion on appeal.

In this case, Universal Life Church met its burden of showing that the term “Universal Church” is generic in the context of “evangelistic and ministerial services, namely, conducting religious worship services,” and that the term “The Universal Church” is generic in the context of “religious counseling and ministerial services,” the classes for which the trademarks are registered. App’x 55, 63. Specifically, Universal Life Church introduced admissible evidence in the form of an expert report and testimony that “the longstanding common use of the phrase ‘Universal Church’ in various contexts demonstrates without question that the phrase has been in generic usage over two millennia to describe the Church as a whole throughout the world.” App’x 610, 659–61 (deposition testimony). It also introduced the following definition of “universal” from the Oxford English Dictionary: “Designating the whole Christian Church or all Christians collectively . . . Freq. in *universal church*.” App’x 572 (emphasis in original); *see*

Harley Davidson, Inc. v. Grottanelli, 164 F.3d 806, 810 (2d Cir. 1999) (“Though not conclusive, dictionary definitions of a word to denote a category of products are significant evidence of genericness because they reflect the public’s perception of a word’s meaning and its contemporary usage.”).

The remaining question before us, therefore, is whether Universal Church created a genuine factual dispute about the issue by presenting any contrary admissible evidence that the term “Universal Church” does *not* generically refer to religious counseling and evangelistic and ministerial services. We agree with the District Court that Universal Church did not. First, the testimony of Universal Church’s religious expert alone failed to create a genuine dispute that the term “Universal Church” refers to Christian services in general among the relevant public. Second, the testimony of Universal Church’s vice president that “Universal Church” is a “distinctive name” because the organization “promote[s] this brand” to its 30,000 members and in its weekly television program (which may reach up to 800,000 people), App’x 373; *see id.* 357, 360, also failed to establish the significance of the term “Universal Church” among the relevant public. In any event, “no matter . . . what success [the user of a generic term] has achieved in securing public identification, it cannot deprive competing manufacturers of the product of the right to call an article by its name.” *Abercrombie*, 537 F.2d at 9. In urging a contrary conclusion, Universal Church points to its efforts to police its mark by preventing other organizations from using the words “universal” and “church” in their name. But “when . . .

the mark has entered the public domain beyond recall, policing is of no consequence to a resolution of whether a mark is generic.” *Murphy Door Bed Co. v. Interior Sleep Sys., Inc.*, 874 F.2d 95, 101 (2d Cir. 1989) (quotation marks omitted). Because a generic term can never be trademarked, moreover, see *Park ‘N Fly*, 469 U.S. at 194; *Genesee Brewing Co. v. Stroh Brewing Co.*, 124 F.3d 137, 143 (2d Cir. 1997), the District Court did not abuse its discretion in thereafter cancelling the trademarks. We therefore affirm the District Court’s grant of summary judgment in favor of Universal Life Church and cancellation of the trademark registrations.

Because Universal Church’s marks are generic, we also affirm the District Court’s grant of summary judgment to Universal Life Church on Universal Church’s cybersquatting claims under the Anticybersquatting Consumer Protection Act, 15 U.S.C. § 1125, which required Universal Church to show that its marks were distinctive. See *Sporty’s Farm L.L.C. v. Sportsman’s Market, Inc.*, 202 F.3d 489, 497 (2d Cir. 2000).

Finally, the District Court was also correct to dismiss Universal Church’s unfair competition claims. Universal Church argues that even a generic term may give rise to an unfair competition claim if the junior user adopts the term in order to conflate itself with the senior user. But our review of the record does not suggest that Universal Life Church, an organization which provides free online ordination and does not conduct church services other than occasional mass weddings, attempted to portray itself as a Pentecostal church in order to “confus[e] the public into mistakenly purchasing

[its] product in the belief that the product is the product of the competitor.” *Murphy Door Bed*, 874 F.2d at 102 (quotation marks omitted).

We have considered Universal Church’s remaining arguments and conclude that they are without merit. For the foregoing reasons, the judgment of the District Court is AFFIRMED.

FOR THE COURT:

Catherine O’Hagan Wolfe, Clerk of
Court

/s/

A True Copy

Catherine O’Hagan Wolfe, Clerk

United States Court of Appeals, Second Circuit

/s/

8a

Appendix B

United States District Court, S.D. New York.
The UNIVERSAL CHURCH, INC., Plaintiff,

v.

UNIVERSAL LIFE CHURCH/ULC MONASTERY
d/b/a The Universal Life Church, Universal Life
Church Monastery Storehouse, George Freeman,
Bruce Taylor, Calvin Toellner and Daniel Chapin,
Defendants.

14 Civ. 5213 (NRB)

|
Signed 08/08/2017

Attorneys and Law Firms

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MEMORANDUM & ORDER

NAOMI REICE BUCHWALD, UNITED STATES
DISTRICT JUDGE

Plaintiff brings this trademark infringement action in connection with its registration of various marks, including “Universal Church” and “The Universal

Church.” Plaintiff asserts trademark infringement claims under the Lanham Act, 15 U.S.C. §§ 1114(1), 1125(a), claims under the Anticybersquatting Consumer Protection Act, 15 U.S.C. § 1125(d), and state law claims for trademark infringement, unfair competition, and deceptive business practices. *See* First Am. Compl. (ECF No. 15). Both parties have moved for summary judgment. For the reasons set forth below, we grant defendants’ motion and deny plaintiff’s motion. In doing so, we hold that “Universal Church” and “The Universal Church” are generic marks and that, even if they were not, plaintiff could not establish likelihood of confusion.

BACKGROUND¹

I. Factual Background

A. Parties

Plaintiff, The Universal Church, Inc., is a Pentecostal/Charismatic church. Pl.’s 56.1 (ECF No. 103) ¶ 2. It was incorporated in New York on May 5, 1987, as a not-for-profit corporation and has its principal place of business in New Jersey. *Id.* ¶ 1. Plaintiff is spiritually affiliated with, but legally independent of, the Universal Church of the Kingdom of God, a Brazilian church founded in 1977. Def.’s 56.1 (ECF No. 87) ¶¶ 35. Plaintiff has “around 30,000 members,” while plaintiff’s

¹ The following is taken from the parties’ statements of material facts pursuant to Local Rule 56.1 and is considered undisputed unless otherwise noted. At oral argument, the parties confirmed that all material evidence had been submitted in connection with the present motions and that no additional material evidence would be presented if the case were to proceed to trial. *See* Oral Arg. Tr. (ECF No. 138) at 23:7-15.

Brazilian affiliate has millions of members. Zibas Decl. (ECF No. 91), Ex. B at 21:15-19; 144:23-25; *see also* Pl.'s Opp. MSJ (ECF No. 113) at 16.²

Defendant Universal Life Church Monastery Storehouse, Inc. (“ULC”) was incorporated in Washington State on September 13, 2006, as a not-for-profit corporation. Def.’s 56.1 (ECF No. 87) ¶¶ 1617.³ Prior to that, ULC was an unincorporated association. *Id.* ¶ 18. Defendant ULC describes itself as a “a non-denominational, non-profit organization” that “recogniz[es] the importance of maintaining open hearts

² At oral argument, plaintiff’s counsel disputed that plaintiff has “only” 30,000 members. Counsel claimed that the figure was “far more” but was unable to provide an alternative figure. *See* Oral Arg. Tr. (ECF No. 138) at 18:2119:6. Given that plaintiff’s own vice-president and 30(b)(6) witness affirmed the 30,000 figure, *see* Daniels Decl. (ECF No. 104), Ex. 11 at 21:15-19 (“Q How many members do you have of [*sic*] The Universal Church, Inc., church members [*sic*]? A We have around 30,000 members.”), and the absence of evidence to the contrary, we take the figure as undisputed for summary judgment.

³ Plaintiff responded to and/or disputed several statements in defendants’ 56.1 statement by noting that it “lacks information sufficient to form a belief as to the truth of this unverified assertion.” *See, e.g.*, Pl.’s Opp. 56.1 (ECF No. 114) ¶¶ 16-18, 22-23. We treat such statements as undisputed for purposes of summary judgment. *See* S.D.N.Y. LR 56.1(c) (“Each numbered paragraph in the statement of material facts ... will be deemed to be admitted for purposes of the motion unless specifically controverted by a correspondingly numbered paragraph in the statement required to be served by the opposing party.”); *id.* 56.1(d) (“Each statement by the ... opponent ..., including each statement controverting any statement of material fact, must be followed by citation to evidence which would be admissible....”).

and minds, embracing any individual, no matter his spiritual background, who wishes to become a member of this family of faith.” *Id.* ¶ 30. It offers free ordinations to its members. *Id.* ¶ 31. It is an offshoot of a church founded in California in the 1950s that was initially called the “Universal Church.” *Id.* ¶¶ 22, 23, 27. There are other “Universal Life Churches” that are offshoots of the original church but are not affiliated with defendants. *Id.* ¶¶ 25, 27.

Defendant Universal Life Church/ULC Monastery is affiliated with defendant ULC. Oral Arg. Tr. (ECF No. 138) at 23:16-24:7. The four individual defendants are current or former officers of one of the corporate defendants. Def.’s 56.1 (ECF No. 87) ¶ 19.

B. Trademarks at Issue

This lawsuit involves three trademarks registered by plaintiff: “Universal Church,” “The Universal Church,” and “Universal Church of the Kingdom of God.”⁴ Two of the marks—“Universal Church” and “Universal Church of the Kingdom of God”—were registered in January 2006. Def.’s 56.1 (ECF No. 87) ¶¶ 38, 47. The marks were registered with the United States Patent and Trademark Office (the “USPTO”) for

⁴ Plaintiff’s motion papers reference a fourth mark, “*The Universal Church of the Kingdom of God*,” registration number 3,930,709. *See* Pl.’s 56.1 (ECF No. 103) ¶ 5(d) (emphasis added). Defendants object to its consideration since it was not identified in the first amended complaint as a trademark at issue. In any event, no such mark appears to exist. The mark that is registered under number 3,930,709 is “Universal Church of the Kingdom of God,” without a preceding “The.” *See* Daniels Decl. (ECF No. 104), Ex. 7.

use in “evangelistic and ministerial services, namely, conducting religious worship services.” Pl.’s 56.1 (ECF No. 103) ¶ 5(a), (b). The registration certificates state that the marks were first used in commerce in May 1987. Def.’s 56.1 (ECF No. 87) ¶¶ 39, 48. In February 2012, the USPTO issued Notices of Acceptance under Sections 8 and 15 of the Lanham Act granting incontestable status to the marks. *Id.* ¶¶ 41, 50.

The third mark, “The Universal Church,” was registered in April 2012 and has not reached incontestable status. *Id.* ¶¶ 43, 46. It is registered for use in “religious counseling and ministerial services,” “newsletters and informational brochures all about religious beliefs and practices,” and “t-shirts distributed in connection with religious groups.” Pl.’s 56.1 (ECF No. 103) ¶ 5(c).

In 2009, defendants attempted to register “Universal Life Church” and several similar marks. The USPTO rejected the mark on the grounds that there was a likelihood of confusion with other registered applications, including “Universal Church” and “Life Church.” Although defendants were afforded the opportunity to submit evidence and arguments in response, they instead choose to abandon their applications.⁵

⁵ Having found the parties’ submissions on this point lacking, we take judicial notice of the defendants’ trademark applications, which are available on the USPTO’s website, <http://tmsearch.uspto.gov>. See *Rockland Exposition, Inc. v. All. of Auto. Serv. Providers of N.J.*, 894 F. Supp. 2d 288, 301 n.6 (S.D.N.Y. 2012), *as amended* (Sept.

C. Defendants' Use of the Trademarks

Plaintiff claims that defendants use the trademarks at issue in one of five general ways: (1) by registering domain names, including universalchurch.org, containing the phrase “universal church”; (2) by using the “Universal Church” on the universalchurch.org website; (3) by using the “Universal Church” in the website’s metadata so that the website’s name shows up as “The Universal Church” in search results; (4) by bidding on advertising keywords, including “the universal church,” so that defendants’ websites appear in Internet search engine ads; and (5) by “hijacking” map-based searches so that defendants’ website is associated with the location of plaintiff’s churches. These uses are explained in greater detail below.

1. Registering Domain Names that Incorporate “Universal Church”

Defendants registered 17 domain names containing the phrase “universal church.” Pl.’s 56.1 (ECF No. 103) ¶ 18. The domain name that is central to this lawsuit is universalchurch.org, which defendants registered in 2010. *Id.* ¶ 24.⁶ The domain names were all registered by defendants between 2009 and 2013. *Id.* ¶¶ 2129.

19, 2012) (taking judicial notice of online trademark registration information).

⁶ Defendants also registered universalchurch.co, universalchurch.info, universalchurch.mobi, universalchurch.mx, universalchurch.net, theuniversalchurch.org, universalchurchoflife.org, universalchurchonline.com, universalchurchonline.net, universalchurchonline.org, universalchurchsupplies.com, universalchurchsupplies.net, universalchurchsupplies.org, universalchurchsupply.com, universal

2. Use of “The Universal Church” on Defendants’ Websites

Defendants used the phrase “universal church” in various ways on the website hosted at universalchurch.org. For example, the mark appears at the website’s top left corner and in the website’s text, as shown below:



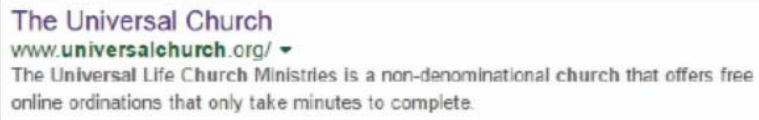
Pl.’s 56.1 (ECF No. 103) ¶ 36 (screenshot of universalchurch.org homepage taken on January 5, 2014); *see also id.* ¶¶ 31-33 (screenshots and descriptions of website’s content on different dates). At various times, the website also included a link to defendants’ website, themonastery.org, through which defendants offer online ordination services. *Id.* ¶ 30.

churchsupply.net, universalchurchsupply.org. *See* Pl.’s MSJ (ECF No. 102) at 7 n.2.

Plaintiff also claims that the website contained “defamatory content” about the founder of the Universal Church of the Kingdom of God, *id.* ¶ 40, and explained that “‘Universal Church’ is a registered trademark. The sponsor of this website is the Universal Life Church, unaffiliated with the legally recognized trademark holder, ‘Universal Church, Inc.,’” *id.* ¶ 31.⁷

3. Use of “The Universal Church” in Website Metadata

Defendants have also used “The Universal Church” as the “title tag” in the HTML metadata for universalchurch.org. The effect is that a search result for the website appears as follows:



⁷ Defendants argue that plaintiff’s screenshots of the universal church.org website, which are taken from archive.org’s Wayback Machine, have not been authenticated under Federal Rule of Evidence 901. However, plaintiff submitted with its reply an affidavit from an archive.org employee, *see* Daniels Decl. (ECF No. 125), Ex. 1, which courts in this Circuit have generally accepted as sufficient for authentication purposes, *see, e.g., Foster v. Lee*, 93 F. Supp. 3d 223, 231-32 (S.D.N.Y. 2015); *Mahmood v. Research in Motion Ltd.*, No. 11 CIV. 5345 KBF, 2012 WL 242836, at *4 n.2 (S.D.N.Y. Jan. 24, 2012). In addition, courts have taken judicial notice of screenshots taken from the Wayback Machine under Federal Rule of Evidence 201. *See, e.g., Distributorsoutlet.com, LLC v. Glasstree, Inc.*, No. 11-CV-6079(PKC)(SLT), 2016 WL 3248310, at *2 (E.D.N.Y. June 10, 2016).

Pl.'s 56.1 (ECF No. 103) ¶ 40 (screenshot of partial Google search result).

4. Bidding on “Universal Church” as a Keyword Search Term

Plaintiff next claims that defendants bid on certain keyword search terms in order to place “pay-per-click” ads.⁸ Pl.'s 56.1 (ECF No. 103) ¶ 43. Defendants do not dispute that they bid on the phrase “the universal church,” but do dispute that they bid on “universal church” and “universal church of the kingdom of god.” Def.'s Opp. 56.1 (ECF No. 121) ¶ 43.⁹

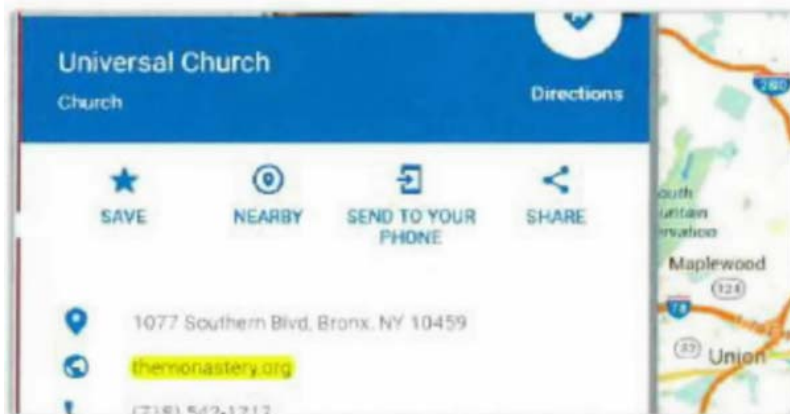
5. “Hijacking” Location-Based Search Results

Finally, plaintiff claims that the search results for its physical church locations in location-based search

⁸ Search engines such as Google generally return two types of search results: “organic” results and ads. Organic results are those that the search engine’s algorithm believes are most relevant to the particular search. Ads, in contrast, are bought by bidding on a particular keyword, such that an ad appears above the organic search results when someone searches for that keyword.

⁹ Plaintiff relies on the testimony of an employee of the company that optimized defendants’ search optimization strategy. The employee was asked whether the list of words that defendants bid on “include[s] Universal Church, The Universal Church, *or* the Universal Church of the Kingdom of God.” Zibas Decl. (ECF No. 91), Ex. BB at 17:21-24 (emphasis added). The employee responded affirmatively, but given the disjunctive framing of the question, it is not clear whether he was testifying that defendants had bid on all three marks or at least one mark. The employee later did clarify that defendants had bid on at least “the universal church.” *Id.* at 20:4-6.

engines have become associated with defendants' websites, a process known as "hijacking." Pl.'s 56.1 (ECF No. 103) ¶¶ 46-48. For example, plaintiff claims that the Google Maps search result for its church at 1077 Southern Boulevard in the Bronx was linked to defendants' website, themonastery.org, as shown below:



Id. ¶ 47. Plaintiff's expert claims to have found 290 such instances. *Id.* ¶ 46. However, the parties dispute whether defendants are responsible for the hijacking and whether any such hijacking is attributable to defendants' "use" of the trademarks in question. *Compare* Pl.'s 56.1 (ECF No. 103) ¶ 46, *with* Def.'s Opp. 56.1 (ECF No. 121) ¶ 46.

II. Procedural Background

Plaintiff filed suit on July 11, 2014, *see* Compl. (ECF No. 2), and filed its first amended complaint on November 18, 2015, *see* First Am. Compl. (ECF No. 15). The first amended complaint asserts three types of claims: (1) that defendants' use of plaintiff's trademarks constitutes trademark infringement under the Lanham

Act, 15 U.S.C. §§ 1114(1) and 1125(a); (2) that defendants' registration of certain domain names violates the federal Anticybersquatting Consumer Protection Act, 15 U.S.C. § 1125(d); (3) that defendants have engaged in deceptive business practices in violation of Sections 349 and 350 of the New York General Business Law; and (4) that defendants' conduct constitutes trademark infringement and unfair competition under New York state common law. *See id.*

Defendants answered the first amended complaint on January 12, 2015, and also brought counterclaims seeking (1) a declaratory judgment that plaintiff's trademarks are invalid and unenforceable; (2) cancellation of the marks; and (3) a declaratory judgment that defendants have not infringed on plaintiff's trademarks even if they are valid. *See Answer* (ECF No. 24).

Both parties moved for summary judgment. *See ECF Nos. 84, 92.* We heard oral argument on the parties' motions on July 11, 2017, and allowed both parties to file post-oral argument supplemental briefs. *See ECF Nos. 133, 137.*

DISCUSSION

I. Summary Judgment Standard

Summary judgment is appropriate when the moving party "shows that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(a). "A fact is 'material' when it might affect the outcome of the suit under governing law." *McCarthy v. Dun & Bradstreet Corp.*, 482 F.3d 184, 202 (2d Cir. 2007) (internal quotation

marks omitted). A genuine dispute exists if a reasonable factfinder could decide in the nonmoving party's favor. *Id.*

A court must resolve all ambiguities and draw all justifiable factual inferences in the nonmoving party's favor. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 255 (1986). The moving party must "make a prima facie showing that it is entitled to summary judgment." *Celotex Corp. v. Catrett*, 477 U.S. 317, 331 (1986). If the moving party puts forth such a showing, the party opposing summary judgment must then present "sufficient evidence favoring the nonmoving party for a jury to return a verdict for that party." *Liberty Lobby*, 477 U.S. at 249.

II. Federal Trademark Claims

Plaintiff asserts federal trademark infringement claims under Sections 1114(1) and 1125(a) of the Lanham Act, 15 U.S.C. §§ 1114(1), 1125(a). We analyze claims brought under either provision by applying a well-established two-prong test: We determine, "first ... whether the plaintiff's mark is entitled to protection, and second ... whether defendant's use of the mark is likely to cause consumers confusion as to the origin or sponsorship of the defendant's goods." *Virgin Enterps. Ltd. v. Nawab*, 335 F.3d 141, 146 (2d Cir. 2003).

A. “Universal Church” Is Generic and Not Entitled to Trademark Protection¹⁰

Defendants first argue that “Universal Church” is not entitled to protection because it is a generic rather than descriptive mark.

1. Standard

Potential trademarks are divided into five categories of distinctiveness that reflect the degree, in ascending order, to which they are eligible to be trademarked and protected: (1) generic, (2) descriptive, (3) suggestive, (4) arbitrary, and (5) fanciful. *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976).¹¹ As the Second Circuit has noted, however, “[t]he lines of demarcation ... are not always bright.” *Id.*

“A descriptive mark describes a product’s features, qualities or ingredients in ordinary language, or describes the use to which a product is put.” *Genesee Brewing Co. v. Stroh Brewing Co.*, 124 F.3d 137, 142 (2d Cir. 1997) (internal quotation marks omitted) (citations omitted). Such a mark “may be registered only if the registrant shows that it has acquired secondary

¹⁰ Defendants conceded at oral argument that they are not contesting whether “Universal Church of the Kingdom of God” is generic. *See* Oral Arg. Tr. (ECF No. 138) at 2:7-10. Given the similarity between “The Universal Church” and “Universal Church” marks, we treat them interchangeably unless noted otherwise.

¹¹ The last three categories, which are inapplicable here, are “inherently distinctive,” and are automatically entitled to protection under the Lanham Act.” *Genesee Brewing Co. v. Stroh Brewing Co.*, 124 F.3d 137, 143 (2d Cir. 1997).

meaning, *i.e.*, it has become distinctive of the applicant's goods in commerce." *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 194 (1985); 15 U.S.C. § 1052(e), (f). The USPTO "may accept as prima facie evidence that the mark has become distinctive ... proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made." 15 U.S.C. § 1052(f).

In contrast, a "generic mark is generally a common description of goods, one that refers, or has come to be understood as referring, to the genus of which the particular product is a species." *Genesee Brewing Co.*, 124 F.3d at 143 (internal quotation marks omitted) (citations omitted). "Generic names use common words that are synonymous with the nature of the organization." *Cancer Research Inst., Inc. v. Cancer Research Soc'y, Inc.*, 694 F. Supp. 1051, 1055 (S.D.N.Y. 1988). In other words, a generic mark is one that answers the question "What are you?" while a valid trademark answers "Who are you?" *See* 2 McCarthy on Trademarks and Unfair Competition § 12:1 (4th ed.). "Because they serve primarily to describe products rather than identify their sources, generic terms are incapable of becoming trademarks, at least in connection with the products that they designate." *Bos. Duck Tours, LP v. Super Duck Tours, LLC*, 531 F.3d 1, 14 (1st Cir. 2008).

"Generic terms are not registrable, and a registered mark may be canceled at any time on the grounds that it [is] generic." *Park 'N Fly*, 469 U.S. at 193-94; *see also* 15 U.S.C. § 1064(3). A mark may be cancelled regardless of

whether the USPTO has deemed it “incontestable.” *See Park ‘N Fly*, 469 U.S. at 195.¹²

To determine whether a mark is generic, the Lanham Act directs courts to consider the mark’s “primary significance” to the “relevant public.” 15 U.S.C. § 1064(3). Thus, a “mark is not generic merely because it has *some* significance to the public as an indication of the nature or class of an article. In order to become generic the *principal* significance of the word must be its indication of the nature or class of an article, rather than an indication of its origin.” *Genesee Brewing Co.*, 124 F.3d at 144 (internal quotation marks omitted).¹³

“Types of evidence to be considered in determining whether a mark is generic include: (1) dictionary definitions; (2) generic use of the term by competitors and other persons in the trade; (3) plaintiff’s own generic use; (4) generic use in the media; and (5) consumer surveys.” *Pilates, Inc. v. Current Concepts, Inc.*, 120 F. Supp. 2d 286, 297 (S.D.N.Y. 2000); *accord Tiffany & Co. v. Costco Wholesale Corp.*, 994 F. Supp. 2d 474, 482 (S.D.N.Y. 2014).

¹² A registrant’s right to use a mark is deemed “incontestable” if, after the mark has been registered for five years, the registrant files an affidavit with the USPTO stating, among other things, that the registrant’s use of the mark has been continuous for five years. *See* 15 U.S.C. § 1065.

¹³ The test for genericness is the same whether a mark becomes generic or is generic *ab initio*. *See Genesee Brewing Co.*, 124 F.3d at 144.

2. Burden

As an initial matter, the parties dispute who bears the ultimate burden of proving that “Universal Church” is generic.

Although the party seeking to enforce a trademark generally bears the burden of establishing that it has a valid trademark, registering a mark creates a presumption of validity. *See Reese Pub. Co. v. Hampton Int’l Commc’ns, Inc.*, 620 F.2d 7, 11 (2d Cir. 1980). That presumption, however, only extends to the class of products and services listed in the registration statement. *See Gameologist Grp., LLC v. Sci. Games Int’l, Inc.*, 838 F. Supp. 2d 141, 153–54 (S.D.N.Y. 2011) (“[T]he presumption of an exclusive right to use a registered mark extends only to the goods and services noted in a registration certificate.”), *aff’d*, 508 Fed.Appx. 31 (2d Cir. 2013). Therefore, the question of who bears the burden turns on whether plaintiff is attempting to enforce its trademark within the class of services for which it was registered.

The “Universal Church” trademark is registered for “evangelistic and ministerial services, namely conducting religious worship services.” We interpret this class broadly,¹⁴ and find that defendants’ use of the

¹⁴ Beyond the expansive language used in the class definition, a broad interpretation is supported by the fact that plaintiff’s counsel disclaimed that the word “evangelistic” limited the class’s scope. Oral Arg. Tr. (ECF No. 138) at 4:13-24. Moreover, plaintiff has attempted to enforce its trademarks against a wide range of religious (and apparently even some non-religious) organizations, suggesting that it also interprets the class broadly. *See Daniels Decl.* (ECF No. 123), Ex. 4 (cease-and-desist letters sent to, among

trademark falls within it.¹⁵ While it is true that defendants are not a traditional church, their core business is ordaining ministers, which is a “ministerial service.” See “Ordain,” Merriam-Webster’s Collegiate Dictionary (10th ed. 1996) (defining “ordain” as “to invest officially ... with ministerial or priestly authority”). Accordingly, plaintiff is entitled to a presumption of validity, *i.e.*, that its “Universal Church” mark is not generic.

3. Application

Despite this presumption, we find that “universal” is generic as applied to churches. The following facts are not genuinely in dispute.¹⁶ First, defendants presented

others, The Universal Church, Inc., One Life Universal Church, Universal Church of Metaphysics, Inc., Universal Church of God, Inc., Universal Church of Fellowship, American Universal Church, Inc., First Universal Church of Knowledge, Universal Church of God in Christ, Inc., Universal Church of Truth Consciousness, Universal Church of Baba’s Kitchen, Inc., Maxam Universal Church, Pentecostal Universal Church, The Universal Church of God Inc., Universal Church of Salvation, Universal Church of God, Universal Church of the Living God, Universal Church of God and Action, Universal Church of God and Christ, Universal Church of God in Christ, Inc., Universal Church of Jesus Christ, Universal Church of Olodumare, Inc., Universal Church of Christ, Inc., The Universal Church of Mind-Body Enlightenment, and The Universal Church Assembly of First-Born).

¹⁵ We find the same with respect to “The Universal Church” mark, which is registered for use in “religious counseling and ministerial services,” among other things. Pl.’s 56.1 (ECF No. 103) ¶ 5(c).

¹⁶ In considering the evidence, we keep in mind that test for genericness is the mark’s primary significance to the “relevant public.” 15 U.S.C. § 1064(3). Since plaintiff has registered the mark

evidence that “universal” is understood as referring to the entire Christian Church or all Christians collectively. For example, the Oxford English Dictionary includes a definition of “universal” as “[d]esignating the whole Christian Church or all Christians collectively; = CATHOLIC ... Freq. in *universal church*.” Zibas Decl. (ECF No. 91), Ex. N. As the dictionary notes, “universal” in this sense has a similar meaning to “catholic,” *id.*, which is simply the transliteration of the Greek word for “universal,” “καθολικός” or “katholikos.” “Catholic,” Oxford English Dictionary Online (June 2017).

for “evangelistic and ministerial services, namely, conducting religious worship services,” the relevant public is extremely broad and includes all those who seek out and provide religious worship services, including all Christians. We therefore reject plaintiff’s argument that the relevant public should be construed narrowly as only Pentecostal and Charismatic Christians. *See* Pl.’s Supp. Mem. (ECF No. 133) at 4 n.6; *cf.* Pl.’s Opp. MSJ (ECF No. 113) at 8, 21.

The parties also dispute whether “consumer” surveys are relevant to the question of genericness. While the relevant public here does not include “consumers” as that word is used in sense of a commercial product or service, we see no reason why the parties could not have conducted surveys of how the relevant public understands plaintiff’s mark. Nevertheless, the failure to produce a survey is not fatal, especially since defendants claim that the mark was generic *ab initio*. *See Miller Brewing Co. v. Joseph Schlitz Brewing Co.*, 605 F.2d 990, 995 (7th Cir. 1979) (consumers surveys not necessary to establish “the meaning of a familiar English word”); *Horizon Mills Corp. v. Qvc, Inc.*, 161 F. Supp. 2d 208, 213 (S.D.N.Y. 2001) (where “the term was generic before the seller used it,” “[a]n individual challenging the mark need only establish that the term is generic through an examination of the term itself”).

While the parties disagree on how widespread this understanding is, they agree that it is well-established within the Roman Catholic Church and that at least some non-Catholics understand and use the term in this sense. *See* Zibas Decl. (ECF No. 91), Ex. R at 30 (“[T]he phrase ‘Universal Church’ is a standard, hallowed usage in the Catholic Church as well as in many other Churches to refer to the Church as a world-wide reality.”); Irvin Decl. (ECF No. 96), Ex. A at 9 (“[The term ‘universal church’] refers specifically to the Roman Catholic Church in Catholic teachings, and is part of the claim made in official Roman Catholic theology that other churches or communions are not even ‘churches’ in a proper sense.”); *id.* at 5 (recognizing “occasional” use of the term by Lutherans and Methodists); *see also* Def.’s 56.1 (ECF No. 87) ¶¶ 75-76.¹⁷

Moreover, “universal” has been used in this sense for hundreds of years, and even thousands of years if the original Latin and Greek versions are considered. *See* Zibas Decl. (ECF No. 91), Ex. N; *see generally id.*, Ex. R.

Second, defendants presented evidence that numerous churches use “universal” and “universal church” in their name. *See* Def.’s 56.1 (ECF No. 87) ¶¶ 87-89. For example, defendants’ search of

¹⁷ To the extent that plaintiff argues that a word’s historic use is irrelevant to whether it is generic, plaintiff is wrong. *See, e.g., Harley Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 810-11 (2d Cir. 1999) (examining historic use of “hog” in finding that it was generic as applied to motorcycles); *E. Air Lines, Inc. v. N.Y. Air Lines, Inc.*, 559 F. Supp. 1270, 1274-76 (S.D.N.Y. 1983) (analyzing historic use of “shuttle” in finding that it was generic).

organizations registered to do business in New York shows that the “Universal Church of the Spirit, Inc.” was registered in 1935, the “Universal Church of God, Fire Baptized, Inc.” was registered in 1945, the “Universal Church of Christ” was registered in 1980, the “Universal Church Development Corp.” was registered in 1981, and the “Universal Church of Life” was registered in 1997. *See* Zibas Decl. (ECF No. 91), Ex. X. Similarly, defendants’ search of organizations registered to do business in California shows that “The Universal Church of the New Birth” was registered in 1966, the “Universal Church of God and Institute of Applied Religious Sciences” was registered in 1983, and the “Universal Church of Religious Freedom” was registered in 1989. *See id.* Neither list is exhaustive. Defendants produced similar search results for Florida, Georgia, Louisiana, Maryland, Massachusetts, New Jersey, and Pennsylvania, identifying almost 100 active or inactive entities using “universal church” in their names. *Id.*¹⁸

Third, “universal” is used in the name of the denomination, Unitarian Universalism, *see* Def.’s 56.1 (ECF No. 87) ¶ 62, while “universal’s” etymological counterpart, “catholic,” is used in the name of the largest Christian denomination, the Roman Catholic Church.

¹⁸ Plaintiff’s argument that there is no evidence that these entities are recognized by consumers or use “universal church” in commerce, *see* Pl.’s Opp. MSJ (ECF No. 113) at 18, is undermined by the fact that plaintiff sent cease-and desist letters to similar organizations, *see supra* n.13.

In contrast, there is little evidence that the relevant public understands “Universal Church” as referring to plaintiff, despite the fact that the USPTO registered the mark as having achieved secondary meaning and subsequently granted it incontestable status. For example, plaintiff claims that it uses the mark in connection with its 230 physical locations and weekly broadcasts that reach 800,000 people. *See* Pl.’s 56.1 (ECF No. 103) ¶¶ 7, 911. This claim is based largely on the testimony from plaintiff’s own employees. *See, e.g.*, Daniels Decl. (ECF No. 104), Ex. 11 at 83:19-84:2 (“[W]e promote this brand, this name all over the media, our locations, even in front of each location of ours. We always try to promote the name of the church and the buildings we own and we lease. I would say that the Universal Church is pretty much known as the church as we are.”); *id.*, Ex. 12 at 38:19-21 (“[W]e use [‘Universal Church’] when we evangelize, when we have brochures, flyers, newspapers, tee shirts.”); *id.* at 39:2-10 (“I believe that when you use the words Universal Church, everyone thinks of us. Q. And what makes you say that? A. Just because, Universal Church, everybody knows it as us. That’s the name we use when we do advertising, when we do T.V. programs, it’s all over the place and has been in the United States since 1987.”).¹⁹ However, “little probative value” attaches to such testimony because “[t]rademark law is skeptical of the ability of an associate of a trademark holder to transcend personal biases to give an impartial account of the value of the

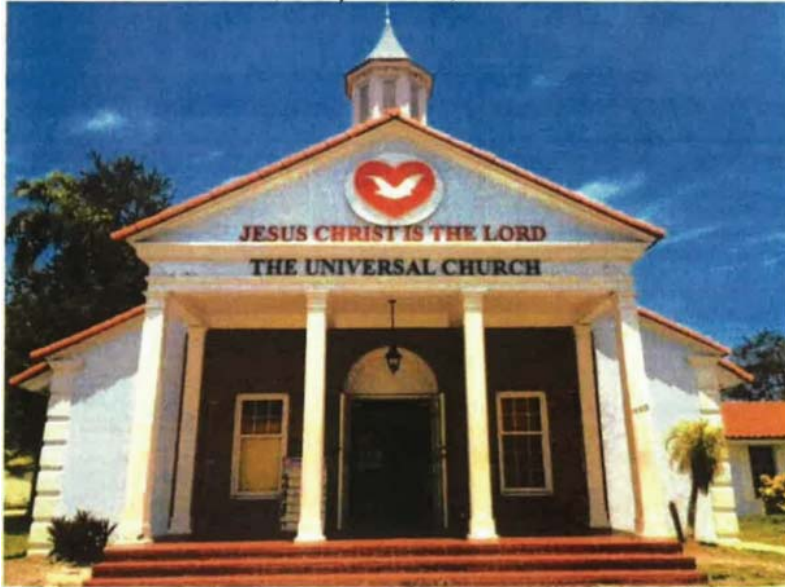
¹⁹ Apart from the newsletter discussed below, plaintiff submitted no documentary evidence showing that it uses the “Universal Church” mark on brochures, flyers, newspapers, or tee shirts.

holder's mark." *Self-Realization Fellowship Church v. Ananda Church of Self-Realization*, 59 F.3d 902, 910 (9th Cir. 1995); *see also Jewish Sephardic Yellow Pages, Ltd. v. DAG Media, Inc.*, 478 F. Supp. 2d 340, 370 (E.D.N.Y. 2007) (same).²⁰

There is also little documentary evidence to support the claim. Plaintiff submitted the below photograph, which shows "The Universal Church" mark on one of its churches:

²⁰ Much of the testimony that plaintiff cites is also irrelevant because it does not specifically address plaintiff's use of the "Universal Church" mark or distinguish between plaintiff's use of "Universal Church" versus "Universal Church of the Kingdom of God." *See, e.g., Daniels Decl.* (ECF No. 104), Ex. 11 at 21:5-14 ("Q Is there more than one location? A Yes Q How many locations does The Universal Church, Inc. have? A We have around 230. Q Are those locations all in the U.S.? A Yes."); *see also id.* at 29:22-32:18, 30:11-32:18, 34:9-36:4, 47:13-18, 72:14-22, 83:12-84:2, 86:20-23; *id.*, Ex. 13 at 23:7-13, 43:6-44:9.

30a



*See Daniels Decl. (ECF No. 123), Ex. 15.*²¹ Plaintiff also submitted a newsletter that it publishes called “Universal News,” which contains sporadic references to the “Universal Church” in the text and a Facebook link to “Like us: The Universal Church”:

²¹ Plaintiff submitted three other photographs of its church fronts, but one of the photographs is indiscernible and the other two use the Spanish version of the “Universal Church of the Kingdom of God” name rather than “Universal Church.” *See Daniels Decl. (ECF No. 123), Ex. 15.*

Edition 68 Visit us at: www.universal.org/usa/en Like us: The Universal Church Follow us: USA_Universal



Bishop Edir Macedo

“The idea that there are ‘little sins’ and ‘big sins’ is completely false”

Different kinds of sin

Sin is a transgression committed by man against God, and could be an act or a condition.

The idea that there are ‘little sins’ and ‘big sins’ is completely false because all sins are serious and, without repentance, can lead to condemnation in hell.

However, the way the Almighty handles each sin reveals that there are different kinds and criteria. If this were not so, the Bible would not detail these fruits and their consequences.

Let’s take a look at the examples below to differentiate them better:

David’s reign was already established and he had many victories. But while the kings were with their troops in the war, he preferred to stay in the palace and rest. His idleness gave birth to adultery and the pregnancy of the wife of his most loyal soldier, Uriah.

To hide his sin, David lied, schemed and had him killed.

Uriah’s life led to the death of four of David’s children. This is same punishment he suggested the prophet Nathan apply to the “rich man who took the poor man’s lamb” (2 Samuel 12, 1-7).

David gave into the temptation of the flesh and sinned. Though his repentance brought him forgiveness, it didn’t exempt him from reaping the evil he sowed. He suffered shame in the same palace terrace, was cruelly betrayed and the sword of death struck his family.

Years later, this man, who learned firsthand the consequences of disobedience, sinned again.

David ignored the instructions of the Law on the census and decided to conduct it with vain purposes. He was living a time of many personal achievements and felt exalted by them. He wanted to measure his strength and know the size of his army. Because of his pride, he ignored the fact that his victories came from the Most High.



David saw the Angel of the Lord kill, with a plague, seventy thousand men.

The man, who had God as his ally, now had Him as his Sentencer, bearing a sword in His hand (1 Chronicles 21.16). The heavens that poured down blessings were now pouring down death.

He turned to the Most High with a broken and repentant spirit. He obtained mercy, and the plague ceased, since he built an Altar and sacrificed. The Altar he turned away from by sinning was now the only place where he would find Salvation.

On both occasions, David found God’s forgiveness, because he truly repented. The eternal consequences of his actions were erased. However, the earthly consequences were not.

The difference between David’s two sins is that the first was committed by a weakness of the flesh, when he gave into temptation. The second was spiritual, when he trusted more in his own strength than in the Provision of God.

Opportunities to sin arise all the time, and they happen to everyone, but we must remember that sin is a rebellion against God, especially when it is committed by people who have knowledge of the Holy Scriptures.

Even if human eyes do not see it or qualify it as serious, a sin is a sin, no matter its intensity.

WWW.BISHOPMACEDO.COM

See Daniels Decl. (ECF No. 123), Ex. 8.

Plaintiff was also unable to substantiate its claim that its weekly broadcast reach 800,000 figure, *see* Zibas

Decl. (ECF No. 117), Ex. A at 2 (letter from plaintiff's counsel to defense counsel noting that plaintiff was "not aware of any written documentation [regarding the weekly viewership of plaintiff's services] at this time"), a figure that appears high given that plaintiff only has approximately 30,000 U.S. members.

But even if we were to accept plaintiff's claim that plaintiff uses the "Universal Church" mark in connection with its physical churches and broadcasts, it does little to show how the mark is understood by the vast majority of the "relevant public" who do not belong to plaintiff's church. With respect to those individuals, the only evidence in plaintiff's favor appears to be two articles referring to plaintiff as the "Universal Church." *See* Zibas Decl. (ECF No. 91), Ex. EE (N.Y. Post article); Daniels Decl. (ECF No. 123), Ex. 23 (N.Y. Times article).²² Thus, we find that there is virtually no evidence in the record that anyone in the relevant public, outside plaintiff's own members, understands "Universal Church" as referring to plaintiff.

²² Again, the record contains numerous other articles that are irrelevant, either because they do not use the "Universal Church" name or because they refer to plaintiff's Brazilian affiliate rather than plaintiff. *See* Zibas Decl. (ECF No. 91), Ex. EE; Daniels Decl. (ECF No. 123), Ex. 6. Likewise, plaintiff points to an entry in *The New International Dictionary of Pentecostal and Charismatic Movements* for the "Universal Church of The Kingdom of God" that uses the shorthand "Universal Church" to refer to the subject of the article. *See* Daniels Decl. (ECF No. 123), Ex. 17. But as plaintiff concedes, the entry describes plaintiff's Brazilian affiliate, not plaintiff. *See* Pl.'s Opp. MSJ (ECF No. 113) at 5.

Based on this record, we hold that the primary significance of “universal church” to the relevant public is a type of church rather than plaintiff, namely one that considers itself to be universal in the sense of representing the entire Christian church. *See Self-Realization Fellowship Church*, 59 F.3d at 909–10 (finding that “Self-Realization Fellowship Church” was generic because the “evidence suggests that a ‘Self-realization’ organization is a class of organization dedicated to spiritual attainment in the manner taught by Yoga, not an organization that is part of [plaintiff’s] chain of churches”); *see also Rudolph Int’l, Inc. v. Realys, Inc.*, 482 F.3d 1195, 1198 (9th Cir. 2007) (“Our review of the record amply supports the district court’s conclusions [that ‘disinfectable’ as applied to nail files is generic]. The district court correctly found that the term ‘disinfectable’ has a history of established use as a generic adjective within the nail care industry as well as in other fields such as medicine and dentistry. For example, the district court noted that ‘disinfectable’ is included in at least 25 patents issued since 2001.”); *Miller Brewing Co. v. G. Heileman Brewing Co.*, 561 F.2d 75, 80-81 (7th Cir. 1977) (finding that “light” had “been widely used in the beer industry for many years” to describe certain beer characteristics, that such use “long antedated” plaintiff’s, and concluding that “even if Miller had given its light beer a characteristic not found in other light beers, it could not acquire the exclusive right to use the common descriptive word ‘light’ as a trademark for that beer”).²³

²³ The fact that “Universal” does not name a religion is not dispositive. Although some courts have applied such a test, *see Gen.*

In reaching this holding, we are guided by the policies behind trademark law. *See E. R. Squibb & Sons, Inc. v. Cooper Labs., Inc.*, 536 F. Supp. 523, 527 (S.D.N.Y. 1982) (“[W]hether a term is generic or descriptive as applied to a particular article should be resolved by reference to the policies for refusing any protection to some terms....”).

By their very nature, trademarks give holders a monopoly over the right to use certain terms in describing their products or services. However, trademark law is not intended to create

a monopoly over a particularly effective marketing phrase. Instead the law grants a monopoly over a phrase only if and to the extent it is necessary to enable consumers to distinguish one producer’s goods from others and even then only if the grant of such a monopoly will not substantially disadvantage competitors by preventing them from describing the nature of their goods. Accordingly, if a term is necessary to describe a product characteristic that a competitor has a right to copy, a producer may

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 Creator*, 297 F.3d 662, 666 (7th Cir. 2002), there are many ways to classify a church other than by the religion it practices. For example, “Spanish church” would surely be generic as describing a category of Spanish-language churches, even though there is no denomination known as the “Spanish Church.” *Cf. GMT Prods., L.P. v. Cablevision of N.Y. City, Inc.*, 816 F. Supp. 207, 210-13 (S.D.N.Y. 1993) (holding that the “Arabic Channel,” as a channel broadcasting in Arabic, was generic).

not effectively preempt competition by claiming that term as its own.

Genesee Brewing Co., 124 F.3d at 144 (quoting *A.J. Canfield Co. v. Honickman*, 808 F.2d 291, 305 (3d Cir. 1986)); see also *CES Pub. Corp. v. St. Regis Publ'ns, Inc.*, 531 F.2d 11, 13 (2d Cir. 1975) (“To allow trademark protection for generic terms, *i.e.*, names which describe the genus of goods being sold, even when these have become identified with a first user, would grant the owner of the mark a monopoly, since a competitor could not describe his goods as what they are.”); cf. *Miller Brewing Co.*, 561 F.2d at 80-81 (“Other brewers whose beers have qualities that make them ‘light’ as that word has commonly been used remain free to call their beer ‘light.’ Otherwise a manufacturer could remove a common descriptive word from the public domain by investing his goods with an additional quality, thus gaining the exclusive right to call his wine ‘rosé,’ his whiskey ‘blended,’ or his bread ‘white.’”).

Here, finding that “universal church” is generic would grant plaintiff a monopoly over the word “universal” as used in church names, a monopoly which plaintiff has already indicated that it would enforce aggressively. See *supra* n.13 (listing cease-and-desist letters sent by plaintiff). We are persuaded that the trademark law is simply not intended to allow the mark to be weaponized by plaintiff in this way.²⁴

²⁴ Plaintiff argues that if “universal” is generic as applied to churches, then the Episcopal Church, the Presbyterian Church, and the Catholic Church must also be generic names. Whatever the

Finally, we note that our holding does not turn on the fact that plaintiff is a non-profit church rather than a for-profit company. As the parties agreed at oral argument, there is no separate trademark law that applies to non-profits or religious organizations. *See* Oral Arg. Tr. (ECF No. 138) at 14:19-24. And as plaintiff points out, church names frequently receive trademark protection. *See* Pl.’s Supp. Mem. (ECF No. 133) at 4 n.5. However, even a cursory examination of the church names that have been registered reveals that they are far more distinctive than “Universal Church.” *Id.*²⁵

B. There Is No Likelihood of Confusion

Even if we were to find that “Universal Church” is descriptive rather than generic, plaintiff’s trademark claims would still fail because no reasonable juror could find a likelihood of confusion.

1. Standard

To prevail on its federal trademark claims, plaintiff must show that there is a likelihood of confusion as to the origin or sponsorship of defendants’ services. *Virgin*

merits of that argument, we need not and, indeed, cannot decide it on the record before us.

²⁵ Examples of church names that have been trademarked include the Church of Religion of God, Divine Church of God, The World’s Church of the Living God, Church of God Ministry of Jesus Christ, The United States Church, The Lord of the Universe Church, The Church of Good Karma, Church of God in Christ, Living Church of God, True Jesus Church, Church of the King, Christ’s Sanctified Holy Church, The Episcopal Church, New Apostolic Church, and United Church of God and Worldwide Church of God. *See* Pl.’s Supp. Mem. at 4 n.5.

Enters. Ltd., 335 F.3d at 146. Likelihood of confusion exists when “there is any likelihood that an appreciable number of ordinarily prudent purchasers are likely to be misled, or indeed simply confused, as to the source of the goods in question.” *Mushroom Makers, Inc. v. R. G. Barry Corp.*, 580 F.2d 44, 47 (2d Cir. 1978).

To determine whether there is a likelihood of confusion, we apply the multi-factor balancing test articulated by Judge Friendly in *Polaroid Corporation v. Polarad Electronics Corporation*, 287 F.2d 492, 495 (2d Cir. 1961). See *New Kayak Pool Corp. v. R&P Pools, Inc.*, 246 F.3d 183, 185 (2d Cir. 2001). The *Polaroid* factors are (1) the strength of the mark; (2) evidence of actual confusion; (3) the sophistication of the relevant public; (4) the degree of similarity between the two marks; (5) the proximity of the services; (6) the likelihood that the prior owner will bridge the gap between its services and defendants’; (7) defendants’ bad faith; and (8) the quality of defendants’ services. *Polaroid*, 287 F.2d at 495.

Plaintiff bears the ultimate burden of establishing confusion at trial. See *Medisim Ltd. v. BestMed LLC*, 910 F. Supp. 2d 591, 606 (S.D.N.Y. 2012) (“Generally speaking, establishing that probability is the plaintiff’s burden, which means that the defendant typically does not need to disprove a likelihood of confusion.” (footnotes omitted)).

“Summary judgment based on likelihood of confusion under the *Polaroid* analysis is appropriate where the undisputed evidence would lead only to one conclusion.” *Luv N’ Care, Ltd. v. Walgreen Co.*, 695 F. Supp. 2d 125, 132 (S.D.N.Y. 2010) (internal quotation marks omitted).

The issue “is not how many factors favor each side but whether a reasonable trier of fact might differ as to likelihood of confusion.” *Id.*

2. Strength of Plaintiff’s Trademark

Even if we were to find that “Universal Church” is descriptive rather than generic, we would still find it to be a weak mark.

“When determining whether a ... descriptive mark is a strong one for purposes of the *Polaroid* inquiry, we look to the secondary meaning that the mark has acquired.” *The Sports Auth., Inc. v. Prime Hosp. Corp.*, 89 F.3d 955, 961 (2d Cir. 1996). “Secondary meaning attaches when the name and the business have become synonymous in the mind of the public, submerging the primary meaning of the term in favor of its meaning as a word identifying that business.” *Arrow Fastener Co. v. Stanley Works*, 59 F.3d 384, 390 (2d Cir. 1995) (internal quotation marks omitted). In determining whether a mark has acquired secondary meaning, courts have considered (1) length and exclusivity of use; (2) advertising expenditures; (3) consumer studies linking the product to product source; (4) sales success; (5) unsolicited media coverage of the product; (6) attempts to plagiarize. *See Thompson Med. Co. v. Pfizer Inc.*, 753 F.2d 208, 217 (2d Cir. 1985). Even where a mark has achieved incontestable status, “independent indicia of strength [are] relevant to deciding whether the strength of the mark weighs in favor or against a finding of likelihood of confusion under *Polaroid*.” *The Sports Auth.*, 89 F.3d at 961.

We find that there is little evidence that “Universal Church” has acquired a strong secondary meaning as referring to plaintiff. As discussed above, plaintiff has neither used the mark exclusively nor as long as many other churches; the phrase “universal church” has been used for millennia to refer to the entire Christian Church or Christian community, as well as in the name of numerous other churches; “universal” is used in the name of the Christian denomination, Unitarian Universalism; and the word’s etymological counterpart, “catholic,” is used in the name of Christianity’s most populous religion. *See supra* at 17-20.

In contrast, plaintiff has only been using the mark since 1987, only has 30,000 members, and there is little evidence in the record that anyone outside plaintiff’s church refers to it as the “Universal Church.” *See supra* at 21-25.

With respect to media coverage, we noted above that there are only two articles in the record that refer to plaintiff by the “Universal Church” name, while the remaining articles in the record either refer to plaintiff by its longer name or to plaintiff’s Brazilian affiliate. *See supra* at 25.

None of the remaining factors to be considered in analyzing secondary meaning are helpful to plaintiff. There is no evidence in the record regarding plaintiff’s advertising expenditures. *See* Def.’s 56.1 (ECF No. 87) ¶ 138. Nor is there any evidence that plaintiff’s mark has been widely plagiarized. *See* Pl.’s Opp. MSJ (ECF No.

113) at 19-20.²⁶ Although plaintiff claims that it occasionally publishes and sells books, audiovisual materials, and other items incidental to its ministry, *see* Pl.’s Opp. 56.1 (ECF No. 114) ¶ 6, there does not appear to be any evidence of the amount of such sales or that the materials use the “Universal Church” mark. Finally, while plaintiff conducted a survey, the survey was intended to measure confusion rather than whether the relevant public associates the “Universal Church” mark with plaintiff. *See* Cornerstone Decl. (ECF No. 114), Ex. A at 6; Pl.’s Opp. 56.1 (ECF No. 114) ¶ 127 (“People were told that they were looking for information about a church called ‘The Universal Church’ even if they had no prior knowledge of Plaintiff.”).

Accordingly, we find that the “Universal Church” mark is weak.²⁷

²⁶ Plaintiff argues that defendants’ conduct at issue here constitutes an instance of plagiarism. *See* Pl.’s Opp. MSJ (ECF No. 113) at 19-20. However, as discussed below in the context of whether defendants acted in bad faith, *see infra* at II.B.7, we find that there is little evidence that defendants intentionally copied plaintiff’s mark. Moreover, a single example hardly constitutes widespread plagiarizing.

²⁷ As a result, the USPTO should not have registered the mark or subsequently granted it incontestable status. *See Park ‘N Fly*, 469 U.S. at 193-94 (A “descriptive” mark “may be registered *only* if the registrant shows that it has acquired secondary meaning, *i.e.*, it has become distinctive of the applicant’s goods in commerce.” (emphasis added)); *see also* 15 U.S.C. § 1052(f) (The USPTO “may accept as prima facie evidence that the mark has become distinctive ... *proof of substantially exclusive ... use* thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made.” (emphasis added)).

3. Evidence of Actual Confusion

Although plaintiff claims that there is “overwhelming” evidence of actual confusion, we find that there is little to none in the record. At most, plaintiff’s evidence suggests that someone searching the Internet for “universal church” will sometimes land on defendants’ website. However, the evidence generally fails to establish (1) that this occurs because of defendants’ use of the “Universal Church” mark or (2) that individuals searching for “universal church” are actually searching for plaintiff. More importantly, there is *no* evidence that anyone purchasing defendants’ ordination services was confused by defendants’ alleged use of “Universal Church.”

Plaintiff’s evidence consists of a survey, testimony from its 30(b)(6) witness and plaintiff’s expert, and a Facebook message. Plaintiff’s survey attempts to measure the extent to which someone googling “the universal church” would believe that he had landed on a website for an entity called “The Universal Church.” *See* Cornerstone Decl. (ECF No. 114), Ex. A. However, we find the survey of limited value since the survey takers were simply told that they were searching for a generic entity named “The Universal Church,” without any attempt to measure whether the survey takers associated such an entity with plaintiff. *See id.*; Pl.’s Opp. 56.1 (ECF No. 114) ¶ 127.

Plaintiff’s vice president and 30(b)(6) witness testified that “many” of its pastors and members “had a hard time trying to reach our correct Web site while they were searching for our domain.” *See* Daniels Decl.

(ECF No. 104), Ex. 11 at 69:9-14; *id.* at 72:22-73:4.²⁸ As an initial matter, the testimony is entitled to little weight since it comes from defendants' vice-president, an interested party. *See Filipino Yellow Pages, Inc. v. Asian Journal Publications, Inc.*, 198 F.3d 1143, 1152 (9th Cir. 1999) ("Evidence of secondary meaning from a partial source possesses very limited probative value."); *Jewish Sephardic Yellow Pages, Ltd. v. DAG Media, Inc.*, 478 F. Supp. 2d 340, 370 (E.D.N.Y. 2007) (same). Moreover, such testimony is simply too vague to establish that anyone was actually confused between the services that plaintiff and defendants offered or that such confusion resulted from defendants' use of plaintiff's trademarks, as opposed to, for example, defendants' non-infringing search optimization strategies.²⁹

²⁸ Defendants argue that the testimony is inadmissible hearsay. However, the Second Circuit has permitted testimony describing other individuals' confusion in trademark cases on the grounds that the testimony is not being offered for the truth of the matter asserted, but rather to show the consumers' state of mind. *See Fundamental Too, Ltd. v. Gemmy Indus. Corp.*, 111 F.3d 993, 1003-04 (2d Cir. 1997).

²⁹ Such confusion might be relevant to "initial interest confusion," something neither party addressed in their briefing. *See Savin Corp. v. Savin Grp.*, 391 F.3d 439, 462 n.13 (2d Cir. 2004) ("[Initial interest confusion] arises when a consumer who searches for the plaintiff's website with the aid of a search engine is directed instead to the defendant's site because of a similarity in the parties' website addresses."). However, we question whether initial interest confusion is even relevant here. *See Network Automation, Inc. v. Advanced Sys. Concepts, Inc.*, 638 F.3d 1137, 1149 (9th Cir. 2011) ("[B]ecause the *sine qua non* of trademark infringement is consumer confusion," even under an initial interest confusion

Plaintiff also points to a message that it received on its Facebook page from an individual who mistakenly believed that he had been ordained by plaintiff in 1972, well before plaintiff's church was in operation. Pl.'s 56.1 (ECF No. 103) ¶ 52; Daniels Decl. (ECF No. 104), Ex. 13 at 41:13-42:16. However, the individual did not say who he believed he had been ordained by, and therefore it is impossible to know whether his confusion even involves defendants.

Finally, plaintiff claims that defendants' expert found five instances of actual confusion and testified that he could find a "much, much, much, much, much higher number" if given additional time. *See* Daniels Decl. (ECF No. 104), Ex. 18 at 80:15-18. However, contrary to plaintiff's characterization, the expert was describing instances where individuals "refer[red] to the defendants by the misnomer Universal Church." *Id.* at 78:15-80:18; *see also* Zibas Decl. (ECF No. 91), Ex. CC at 22 ("There are several examples where people, without any prompting or connection with Defendant, will refer to the Defendant as 'Universal Church' by unintentionally omitting the word 'life' from Defendant's name."). Such "confusion" is not relevant to plaintiff's trademark claim because "universal church" is not being used in any way to refer to plaintiff.³⁰

theory, "the owner of the mark must demonstrate likely confusion, not mere diversion.").

³⁰ In the defendants' expert's examples, "universal church" was used to refer either to defendants or to the Roman Catholic notion of church. *See* Zibas Decl. (ECF No. 91), Ex. CC at 22 (website discussing legal opinion that "take[s] note of the unconventional methods of becoming ordained as a minister via the Universal

4. Similarity of the Trademarks

Defendants are using the same words that comprise plaintiff's mark. Accordingly, this factor favors plaintiff.

5. Proximity of the Services in the Marketplace

In considering proximity, "direct competition between the products is not a prerequisite to relief"; at the same time "products that share the same channel of trade are not necessarily proximate." *The Sports Auth.*, 89 F.3d at 963 (internal quotation marks omitted). This factor favors defendants. Although both parties are nominally churches, they offer different services. While plaintiff is a traditional church offering spiritual services to its members, defendant primarily offers online ordinations so that its members can perform weddings and other religious ceremonies for non-members, something plaintiff does not do. *See Zibas Decl., Ex. B* at 67:25-68:12 ("Q Does Universal Church offer the same services as the defendants? A ... I read in their Web site that they offer some strange way to ordain people online

Church Life Website"); *id.* (question posted on a forum ndnation.com, which describes itself as "The independent voice of Notre Dame Athletics," asking whether, "As a Catholic, is it possible to become ordained through some sort of universal church without renouncing my commitment to Catholicism?"); *id.* at 23 (comment to an online article discussing Representative Nancy Pelosi's views on Catholicism where the comment refers to Rep. Pelosi as a "self proclaimed Theologian & Doctor of the Universal Church"); *id.* at 23-25 (websites identifying various wedding officiants who were ordained by defendants but described themselves as being ordained by the "Universal Church" or the "Universal Church of Light").

which is completely different than we usually do as a church. Q So Universal Church doesn't offer ordinations; is that correct? A We don't offer ordinations online.”).

6. Likelihood that the Plaintiff Will “Bridge the Gap”

“The term ‘bridging the gap’ is used to describe the senior user’s interest in preserving avenues of expansion and entering into related fields.” *C.L.A.S.S. Promotions, Inc. v. D.S. Magazines, Inc.*, 753 F.2d 14, 18 (2d Cir. 1985). This factor favors defendants. As just noted, plaintiff does not currently offer online ordination and there is no indication that it will do so in the future.

7. Defendants’ Bad Faith

“Under this factor, we look to whether the defendant adopted its mark with the intention of capitalizing on plaintiff’s reputation and goodwill and any confusion between his and the senior user’s product.” *The Sports Auth.*, 89 F.3d at 964 (internal quotation marks omitted). Although we believe this factor favors defendant, a reasonable juror could come out either way. On one hand, plaintiff does not contest defendants’ right to use the name “Universal Life Church,” and therefore defendants have a legitimate, good faith reason to use “universal” and “church” in their search engine optimization strategies. Moreover, it is difficult to imagine what benefit or motive defendants would have to trade off plaintiff’s goodwill.³¹ On the other hand, a

³¹ When asked at oral argument, plaintiff’s counsel could only suggest that defendants were “vindictive” because they were

reasonable juror could find that defendants' use of the mark "universal church" in various domain names, on their website, in metadata, and in search terms, could be construed as evidence of an intent to capture Internet users looking for plaintiff's organization. Because a reasonable juror could find this factor in either parties' favor, we assume that it points in plaintiff's favor for purposes of summary judgment.

8. Quality of Defendants' Services

"Generally, quality is weighed as a factor when there is an allegation that a low quality product is taking unfair advantage of the public good will earned by a well-established high quality product." *Gruner + Jahr USA Pub., a Div. of Gruner + Jahr Printing & Pub. Co. v. Meredith Corp.*, 991 F.2d 1072, 1079 (2d Cir. 1993).

Plaintiff argues that defendants' ordination services are inferior because they allow anyone to become ordained online without committing to a particular teaching or faith, without formal education, without training, and without committing to attend to the spiritual needs of others. *See* Pl.'s MSJ (ECF No. 102) at 25. On the other hand, the features that plaintiff views disparagingly are likely the very features that defendants' customers value. Thus, we find that

denied their trademark application by the USPTO. Oral Arg. Tr. (ECF No. 138) at 28:10-18. However, this theory amounts to little more than speculation, which courts will not consider on summary judgment. *See Knight v. U.S. Fire Ins. Co.*, 804 F.2d 9, 12 (2d Cir. 1986) ("Nor may a party rely on mere speculation or conjecture as to the true nature of the facts to overcome a motion for summary judgment.").

defendants' services are not inherently inferior. Moreover, there is no evidence in the record that defendants are taking advantage of plaintiff's public goodwill. Accordingly, we find that this factor favors defendants.

9. Sophistication of the Relevant Public

This factor also favors defendants. As discussed above, the relevant public is the audience for religious worship services. Such individuals are unlikely to confuse plaintiff's religious services—offered in its physical churches and through weekly broadcasts—with defendants' online ordination services.

10. Conclusion

In sum, the majority of the factors point in defendants' favor: (1) the "Universal Church" mark is weak; (2) there is little to no evidence of actual, actionable confusion; (3) the parties' services are not in close proximity; (4) it appears unlikely that plaintiff will "bridge the gap"; (5) defendants' services are not inferior; and (6) the relevant public is sufficiently sophisticated so as not to be confused. In contrast, only two factors—the similarity of the marks and evidence of bad faith—favor plaintiff for purposes of summary judgment. Based on this balance, we find that there is no likelihood of confusion as a matter of law. *See, e.g., Medici Classics Prods., LLC v. Medici Grp., LLC*, 683 F. Supp. 2d 304, 314 (S.D.N.Y. 2010) (granting summary judgment to defendant under *Polaroid* where only two factors pointed "weakly" in plaintiff's favor). Accordingly, we hold that even if "Universal Church"

were descriptive rather than generic, plaintiff's trademark infringement claims would still fail.

III. Federal Cybersquatting Claim

“To successfully assert a claim under the [Anticybersquatting Consumer Protection Act], a plaintiff must demonstrate that (1) its marks were distinctive at the time the domain name was registered; (2) the infringing domain names complained of are identical to or confusingly similar to plaintiff's mark; and (3) the infringer has a bad faith intent to profit from that mark.” *Webadviso v. Bank of Am. Corp.*, 448 Fed.Appx. 95, 97 (2d Cir. 2011); *see also* 15 U.S.C. § 1125(d)(1)(A).

Because we found that the “Universal Church” mark is generic and therefore not “distinctive,” *see supra* II.A, plaintiff's cybersquatting claim must fail as well. However, even if “Universal Church” were not generic, plaintiff's primary cybersquatting claim would still fail because the mark was not distinctive *at the time* universalchurch.org was registered.

As noted above, a descriptive mark is only considered “distinctive” if it has acquired secondary meaning, *see Park 'N Fly, Inc.*, 469 U.S. at 194, *i.e.*, it has come through use to be “uniquely associated with a single source,” *PaperCutter, Inc. v. Fay's Drug Co.*, 900 F.2d 558, 564 (2d Cir. 1990). Secondary meaning must be acquired “before [plaintiff's] competitor commenced use of the mark.” *Id.*

The primary domain name at issue, universalchurch.org was registered by defendants in 2010, Pl.'s 56.1 (ECF No. 103) ¶ 24, well before the “Universal Church” mark achieved incontestable status

in February 2012, *id.* at ¶ 5(a). Accordingly, the mark’s incontestable status is irrelevant to the mark’s degree of distinctiveness when defendants’ registered the domain name. For the reasons set forth above—and especially in light of the long and varied use of “universal” by churches, *see supra* at 17-20—we find that “Universal Church” had not acquired secondary meaning as referring to plaintiff at the times universalchurch.org was registered in 2010.³²

IV. New York Unfair Competition Claims

Because the standards for New York common law unfair competition and trademark infringement claims are essentially the same as under the Lanham Act, *see Twentieth Century Fox Film Corp. v. Marvel Enters., Inc.*, 220 F. Supp. 2d 289, 297-98 (S.D.N.Y. 2002), we dismiss plaintiff’s New York common law claims for the same reasons as above.

V. New York General Business Law Claims

Plaintiff asserts claims under Sections 349 and 350 of the New York General Business Law (the “NYGBL”). NYGBL § 349 prohibits “[d]eceptive acts or practices in the conduct of any business, trade or commerce or in the furnishing of any service in this state.” N.Y. Gen. Bus. Law § 349(a). NYGBL § 350 prohibits “[f]alse advertising in the conduct of any business, trade or commerce or in the furnishing of any service in this

³² A similar argument would apply to most of the remaining domain names, all but two of which—universalchurch.net and theuniversalchurch.org—were registered after February 2012. *See* Kent Decl. (ECF No. 95), Ex. 1 ¶¶ 84-97.

state.” *Id.* § 350. “To successfully assert a claim under either section, a plaintiff must allege that a defendant has engaged in (1) consumer-oriented conduct that is (2) materially misleading and that (3) plaintiff suffered injury as a result of the allegedly deceptive act or practice.” *Orlander v. Staples, Inc.*, 802 F.3d 289, 300 (2d Cir. 2015) (internal quotation marks omitted).

Although only plaintiff moved for summary judgment on its NYGBL claims, we nevertheless grant summary judgment to defendants and dismiss the claims because they fail as a matter of law.³³

“[T]he majority view in this Circuit is that trademark or trade dress infringement claims are not cognizable under §§ 349 and 350 of the New York General Business Law unless there is a specific and substantial injury to the public interest *over and above ordinary trademark infringement* or dilution.” *Nomination Di Antonio E Paolo Gensini S.N.C. v. H.E.R. Accessories Ltd.*, No. 07 CIV.6959 (DAB), 2009 WL 4857605, at *8 (S.D.N.Y. Dec. 14, 2009) (internal quotation marks omitted) (alterations

³³ “A *sua sponte* grant of summary judgment against the moving party is permissible only if ‘the facts before the district court were fully developed so that the moving party suffered no procedural prejudice’ and ‘the court is absolutely sure that no issue of material fact exists.’” *Donachie v. Liberty Life Assur. Co. of Bos.*, 745 F.3d 41, 45 n.3 (2d Cir. 2014) (quoting *Bridgeway Corp. v. Citibank*, 201 F.3d 134, 139 (2d Cir. 2000)) (alteration omitted). Where the moving party has not been “denied the opportunity to place all relevant evidence in the record,” a grant of summary judgment for the nonmoving party is “not procedurally deficient.” *Id.* Here, as noted above, plaintiff conceded that it has placed all relevant evidence in the record. *See supra* n.2.

omitted); *see also Kaplan, Inc. v. Yun*, 16 F. Supp. 3d 341, 352 (S.D.N.Y. 2014) (“[C]ourts in New York have routinely dismissed trademark claims brought under Sections 349 and 350 as being outside the scope of the statutes, because ordinary trademark disputes do not pose a significant risk of harm to the public health or interest and are therefore not the type of deceptive conduct that the statutes were designed to address.” (internal quotation marks omitted)).³⁴

Here, plaintiff’s NYGBL claims are merely duplicative of its trademark claims and therefore do not

³⁴ Plaintiff cites two cases, *George Nelson Found. v. Modernica, Inc.*, 12 F. Supp. 3d 635 (S.D.N.Y. 2014), and *Zip Int’l Grp., LLC v. Trilini Imports, Inc.*, No. 09-CV-2437 JG VVP, 2010 WL 648696 (E.D.N.Y. Feb. 22, 2010), reflecting the minority position that ordinary trademark infringement allegations may be sufficient to state claims under NYGBL §§ 349 and 350. Besides being in the clear minority, the decisions are entitled to little weight as they fail to recognize the majority position or even analyze whether ordinary trademark infringement claims may be brought under Sections 349 and 350. Moreover, the court in *Zip International* subsequently backed away from its position. As Judge Gleeson recognized in a later opinion in the same case, “[s]ome courts have held that trademark cases fall outside the scope of the New York’s consumer protection statute, reasoning that the public harm that results from trademark infringement is too insubstantial to satisfy the pleading requirements of § 349. Thus, Zip’s allegations may not even be actionable under the asserted provisions of New York law, an issue I need not address here.” *Zip Int’l Grp., LLC v. Trilini Imports, Inc.*, No. 09-CV-2437 JG VVP, 2011 WL 2132980, at *9 n.10 (E.D.N.Y. 2011 May 24, 2011) (internal quotation marks omitted) (citations omitted). Accordingly, we do not believe these cases warrant rejecting the majority position.

allege an injury to the public interest “over and above” ordinary trademark infringement.

Plaintiff argues that it has alleged an injury to the public beyond ordinary trademark confusion in that defendants’ “promotion of their ordination services” under the “Universal Church” mark “injures consumers ‘because they are inadvertently purchasing a product of inferior quality, a product they do not prefer, or both.’” Pl.’s MSJ (ECF No. 102) at 28 (quoting *Zip Int’l Grp., LLC v. Trilini Imports, Inc.*, No. 09-CV-2437 JG VVP, 2010 WL 648696, at *6 (E.D.N.Y. Feb. 22, 2010)).

However, there is no evidence in the record to support these allegations, which, frankly, we find implausible. We are confident that defendants’ customers knew exactly what they were purchasing when they obtained free online ordinations and were unlikely to mistakenly believe they were ordained by plaintiff. Moreover, even if confusion existed, the injury is precisely the type of injury that results from ordinary trademark confusion and does not constitute a separate public injury. *See DO Denim, LLC v. Fried Denim, Inc.*, 634 F. Supp. 2d 403, 409 (S.D.N.Y. 2009) (assertion that “Defendant’s use of Plaintiff’s designs causes injury to the public because ‘the consuming public needs to be free from competitive practices that deceive and therefore complicate consumers’ purchase decisions’” was “no different from the type of ‘injury’ alleged in any garden variety trade dress infringement claim”).

Plaintiff also argues that defendants’ conduct is distinguishable from ordinary trademark infringement because defendants have been “bombarding New Yorkers searching for The Universal Church online with

advertisements for Defendants’ ordination services (which are not legally valid everywhere in the State)” and “have caused significant harm to the public interest by willfully attacking a duly registered trademark and attempting to render it invalid, rather than challenging it through legitimate channels.” Pl.’s Reply MSJ (ECF No. 124) at 11-12. Again—assuming that plaintiff is referring to defendants’ search engine advertisements—we find that there is no evidence in the record that defendants’ consumers have been injured and, even if there were, “[t]he alleged ‘deceptive acts of practices’ ... are precisely the acts that constitute the alleged trademark infringement, which are outside the scope of the statutes.” *Kaplan, Inc. v. Yun*, 16 F. Supp. 3d 341, 352-53 (S.D.N.Y. 2014) (citations omitted).

Accordingly, we grant summary judgment for defendant on plaintiff’s NYGBL claims.

CONCLUSION

For the reasons set forth above, defendants’ motion for summary judgment (ECF No. 84) is granted, plaintiff’s motion (ECF No. 92) is denied, and plaintiff’s complaint is dismissed. This Memorandum and Order resolves docket numbers 84 and 92.

Defendants are directed to submit a proposed judgment on notice by August 15, 2017.

SO ORDERED.

Appendix C

UNITED STATES DISTRICT
COURT
SOUTHERN DISTRICT OF NEW
YORK

USDC SDNY
DOCUMENT
ELECTRONICALLY FILED
DOC#: _____
DATE FILED: 9/13/17

-----X
THE UNIVERSAL CHURCH, INC.,

Plaintiff and Counterclaim-
Defendant,

- against -

**FINAL
JUDGMENT**

UNIVERSAL LIFE CHURCH/ULC 14 Civ. 5213
MONASTERY d/b/a THE (NRB)
UNIVERSAL LIFE CHURCH,
UNIVERSAL LIFE CHURCH
MONASTERY STOREHOUSE,
GEORGE FREEMAN, BRUCE
TAYLOR, CALVIN TOELLNER
and DANIEL CHAPIN,

Defendants and
Counterclaim-Plaintiffs.

-----X
**NAOMI REICE BUCHWALD
UNITED STATES DISTRICT
JUDGE**

WHEREAS defendants UNIVERSAL LIFE
CHURCH/ULC MONASTERY d/b/a THE
UNIVERSAL LIFE CHURCH, UNIVERSAL LIFE
CHURCH MONASTERY STOREHOUSE, GEORGE
FREEMAN, BRUCE TAYLOR and CALVIN

TOELLNER (“defendants”) having moved for summary judgment and

WHEREAS plaintiff THE UNIVERSAL CHURCH, INC. having moved for summary judgment and

WHEREAS the Court having issued a Memorandum and Order on August 8, 2017, granting summary judgment to defendants and denying plaintiff’s motion for summary judgment and dismissing plaintiff’s First Amended Complaint, it is now

DECLARED that the mark Universal Church Registration No. 3,037,551 is generic, and it is further

DECLARED that the mark The Universal Church Registration No. 4,142,440 is generic, and it is further

ORDERED that the mark Universal Church Registration No. 3,037,551 is cancelled and the Commissioner of Patents and Trademarks is directed to cancel trademark Registration No. 3,037,551, and it is further

ORDERED that the mark The Universal Church Registration No. 4,142,440 is cancelled and the Commissioner of Patents and Trademarks is directed to cancel trademark Registration No. 4,142,440, and it is further

ORDERED that plaintiff’s First Amended Complaint is dismissed with prejudice and that Judgment is entered for defendants, and it is further

ORDERED that the Court shall maintain jurisdiction over this action for the purpose of enforcing this Judgment.

56a

Dated: New York, New York
September 13, 2017

/s/

NAOMI REICE BUCHWALD
UNITED STATES DISTRICT JUDGE

Appendix D

UNITED STATES DISTRICT
COURT
SOUTHERN DISTRICT OF NEW
YORK

USDC SDNY
DOCUMENT
ELECTRONICALLY FILED
DOC#: _____
DATE FILED: 9/20/17

-----X
THE UNIVERSAL CHURCH, INC.,

Plaintiff and Counterclaim-
Defendant,

- against -

UNIVERSAL LIFE CHURCH/ULC
MONASTERY d/b/a THE
UNIVERSAL LIFE CHURCH,
UNIVERSAL LIFE CHURCH
MONASTERY STOREHOUSE,
GEORGE FREEMAN, BRUCE
TAYLOR, CALVIN TOELLNER
and DANIEL CHAPIN,

Defendants and
Counterclaim-Plaintiffs.

**CORRECTED
FINAL
JUDGMENT**

14 Civ. 5213
(NRB)

-----X
**NAOMI REICE BUCHWALD
UNITED STATES DISTRICT
JUDGE**

WHEREAS defendants UNIVERSAL LIFE
CHURCH/ULC MONASTERY d/b/a THE
UNIVERSAL LIFE CHURCH, UNIVERSAL LIFE
CHURCH MONASTERY STOREHOUSE, GEORGE
FREEMAN, BRUCE TAYLOR and CALVIN

TOELLNER (“defendants”) having moved for summary judgment and

WHEREAS plaintiff THE UNIVERSAL CHURCH, INC. having moved for summary judgment and

WHEREAS the Court having issued a Memorandum and Order on August 8, 2017, granting summary judgment to defendants and denying plaintiff’s motion for summary judgment and dismissing plaintiff’s First Amended Complaint, it is now

DECLARED that the mark Universal Church Registration No. 3,037,551 is generic, and it is further

DECLARED that the mark The Universal Church Registration No. 4,124,440 is generic, and it is further

ORDERED that the mark Universal Church Registration No. 3,037,551 is cancelled and the Commissioner of Patents and Trademarks is directed to cancel trademark Registration No. 3,037,551, and it is further

ORDERED that the mark The Universal Church Registration No. 4,124,440 is cancelled and the Commissioner of Patents and Trademarks is directed to cancel trademark Registration No. 4,124,440, and it is further

ORDERED that plaintiff’s First Amended Complaint is dismissed with prejudice and that Judgment is entered for defendants, and it is further

ORDERED that the Court shall maintain jurisdiction over this action for the purpose of enforcing this Judgment.

59a

Dated: New York, New York
September 20, 2017

/s/

NAOMI REICE BUCHWALD
UNITED STATES DISTRICT JUDGE