

No. 18-1159

In The
Supreme Court of the United States

THE UNIVERSAL CHURCH, INC.,

Petitioner,

v.

CALVIN TOELLNER, et al.,

Respondents.

**On Petition For Writ Of Certiorari
To The United States Court Of Appeals
For The Second Circuit**

**BRIEF OF THE CHURCH OF JESUS CHRIST OF
LATTER-DAY SAINTS; GENERAL CONFERENCE
OF THE SEVENTH-DAY ADVENTIST CHURCH;
CHURCH OF GOD IN CHRIST, INC.; ORTHODOX
CHURCH IN AMERICA; AND JEWISH
COALITION FOR RELIGIOUS LIBERTY AS
AMICI CURIAE IN SUPPORT OF PETITIONER**

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INTEREST OF AMICI CURIAE¹

Religious organizations representing millions of Americans appear on this brief. Amici are The Church of Jesus Christ of Latter-day Saints; General Conference of the Seventh-day Adventist Church; Church of God in Christ, Inc.; Orthodox Church in America; and Jewish Coalition for Religious Liberty. Despite disagreements on many points of faith, we are united in supporting robust legal protections for religious organizations. This includes the ability of a faith community to define its religious identity through the choice of a distinctive name and to maintain the integrity of that name against misuse through trademarking. The decision below severely undermines that ability by invalidating The Universal Church's trademark as generic based on a legal analysis that substantially departs from the text and established understanding of the Lanham Act. Left unreviewed, the Second Circuit's decision especially threatens the trademarks of religious institutions. We submit this brief to draw attention to the national importance of this case for religious organizations of many faiths that face the risk of losing trademark protection unless the Court grants review.

¹ Counsel for all parties were timely notified of the intent to file this amicus curiae brief and all parties have consented to the filing of this brief. No counsel for any party authored this brief in whole or in part, and no person or entity other than amici and their counsel made any monetary contribution intended to fund the preparation or submission of this brief.

SUMMARY OF ARGUMENT

The name of a church reflects the exercise of religion.² Far more deliberately chosen than a commercial trademark, that name may be the outgrowth of theology, historical considerations, or the response to divine command. That name uniquely identifies a religious community for other community members and for the general public. Protecting a church's trademark from unpermitted or wrongful use is how a faith community safeguards the integrity of its internal communications and its public reputation.

The Second Circuit's decision poses a direct threat to the ability of many religious organizations to maintain trademarks for their institutional names by substantially departing from the text and established interpretation of the Lanham Act. The decision below committed two basic errors. Rather than applying the test of genericness prescribed by the Act, the court of appeals looked to cramped notions of historical usage alone and disregarded contemporary understanding. The court exacerbated this error by violating the anti-dissection rule—isolating single words within the registered trademark rather than examining the mark as a whole. In both respects, the decision below conflicts with decisions of other circuits. Review is imperative to restore the Lanham Act to its textual moorings, so

² We use the term “church” here in the broad sense of a religious denomination and its associated faith community, be it Christian, Jewish, Muslim, Hindu, or any other faith within the great tapestry of American religiosity.

that religious organizations can enjoy the protections that Congress enacted.

ARGUMENT

I. This Case Holds National Importance for Religious Organizations.

A. The Lanham Act vitally protects religious trademarks.

The question presented holds profound national importance for the religious organizations appearing here as amici curiae. For them, and for the millions of their adherents, resolving the question presented is necessary for a faith community to protect its legal identity through the tools accorded by Congress under the Lanham Act.

Under the Act, one may seek to register a trademark “which has become distinctive of the applicant’s goods in commerce.” 15 U.S.C. § 1052(f) (2006). Once registered, a trademark continues to be protected unless, among other things, it has become generic. *Id.* § 1064(3). To determine whether a mark is generic, “[t]he primary significance of the registered mark to the relevant public * * * shall be the test for determining whether the registered mark has become * * * generic.” *Ibid.* (emphasis added).

Religious organizations frequently rely on the Act’s trademark protections by registering their names and bringing actions against others who infringe their marks. See, e.g., *Church of Scientology Int’l v. Elmira*

Mission of the Church of Scientology, 794 F.2d 38, 40–41, 44–45 (2d Cir. 1986) (granting the Church of Scientology’s preliminary injunction against a former licensee’s use of the church’s trademarks); *Sovereign Order of Saint John of Jerusalem, Inc. v. Grady*, 119 F.3d 1236, 1239–41 (6th Cir. 1997) (granting a trademark infringement claim to a religious order whose former member founded a schismatic church and order and used the trademark holder’s mark without permission).

B. Legally protecting the name of a religious organization is an exercise of religion.

The name of a faith community holds enormous meaning and significance.³ A religious organization’s name expresses a faith community’s religious identity. See W. Cole Durham & Robert Smith, 4 *Religious Organizations and the Law* § 30:62 (2017) (“The names of religious organizations are extrinsically linked to the identity of the organization.”); *id.* § 30:1 (“[R]eligious symbols [and] names * * * may have sacred value to the religious organizations and their believers.”). Not surprisingly, courts recognize that “[t]he name of [a]

³ As the leader of one amicus religious organization recently declared, “So, what’s in a name? When it comes to the name of [a] [c]hurch, the answer is ‘Everything!’” President Russell M. Nelson, *The Correct Name of the Church*, *Ensign*, Nov. 2018, at 89, <https://www.lds.org/study/ensign/2018/11/sunday-morning-session/the-correct-name-of-the-church?lang=eng> (last visited April 3, 2019).

church * * * [i]s of great value” because “members associate[] with the name the most sacred of their personal relationships and the holiest of their family traditions.” *Purcell v. Summers*, 145 F.2d 979, 982 (4th Cir. 1944).

A faith community’s selection, promotion, and protection of its name is an important “means by which a religious community defines itself,” and religious organizations must have “[t]he authority to engage in this process of self-definition.” *Corp. of Presiding Bishop of Church of Jesus Christ of Latter-day Saints v. Amos*, 483 U.S. 327, 342 (1987) (Brennan, J., concurring). “Solicitude for a church’s ability to do so reflects the idea that furtherance of the autonomy of religious organizations often furthers individual religious freedom as well” because “[f]or many individuals, religious activity derives meaning in large measure from participation in a larger religious community.” *Ibid.*

Trademark law helps religious institutions establish their self-definition in the larger community. This is because “the whole identity of the religious group—its ideology, its teachings and its practices—is contained in an identity-indicating name or symbol.” David A. Simon, *Register Trademarks and Keep the Faith: Trademarks, Religion and Identity*, 49 IDEA: The Intell. Prop. L. Rev. 233, 240 (2008). Registering a trademark “allows a religious group to invest its identity in a legally-controllable entity,” and “[l]egal control over the trademark therefore enables the religious organization to maintain its identity.” *Ibid.* In other words, “[t]o a religious organization, this control allows it to

construct and protect the representation(s) of a religious name”; and “[c]ontrol of the organizational trademark is crucial to religious capital because the value of the mark consists of its identity.” *Id.* at 239–40. So the “value of a mark for a religious organization lies in the association between the ideas, values and beliefs of the organization and the mark itself.” *Id.* at 240.

The Lanham Act establishes a mechanism for religious organizations, which “are naturally concerned with their identities,” to defend themselves against “any entity using a confusingly similar mark [that] poses a risk to that identity.” Simon, 49 IDEA: The Intell. Prop. L. Rev. at 265. Religious organizations like the amici “us[e] [trademark] lawsuits to maintain their own identity, and thereby maintain their religious authenticity.” *Ibid.* This is to be expected because “[a] religious organization has a substantial interest in protecting the good will and reputation associated with its ministry” since they “are constantly under scrutiny and deserve to be able to control what occurs under the guise of their marks.” Steven John Olsen, *Protecting Religious Identity with American Trademark Law*, 12 Chi.-Kent J. Intell. Prop. 131, 143 (2013).

For some faith communities, the name of a church is the product of divine mandate. For instance, originally known as the “Church of God,” “in 1897, * * * the name ‘Church of God in Christ’ was revealed to Bishop [M]ason while walking along a certain street in Little

Rock, Arkansas.”⁴ Another amicus also owes its name to divine revelation. In 1838, “Joseph Smith the Prophet” received divine instruction declaring that the church’s name should “be called in the last days, even The Church of Jesus Christ of Latter-day Saints.”⁵ And just last fall that Church’s president reminded its members that “the name of the Church is not negotiable” because “it *is* the command of the Lord.” President Russell M. Nelson, *The Correct Name of the Church*, Ensign, Nov. 2018, at 87.

A religious organization earns the trust of its members when they know the organization’s messages are authentic, accurate, and true. By safeguarding the integrity of institutional names, trademarks secure intra-faith trust. That trust is vital. Trademark disputes over a religious name “most common[ly]” involve “religious groups of similar ideological beliefs with some distinctive differences”—which is the very kind of dispute “most likely to confuse parishioners.” Olsen, 12 Chi.-Kent J. Intell. Prop. at 134.

Consider companies that provide kosher certification, for instance. They stamp their symbols on food labels to communicate that the food was prepared in compliance with a particular standard of kosher

⁴ Church of God in Christ, *Our History: Young C. H. Mason*, <http://www.cogic.org/about-company/our-history/> (last visited April 3, 2019).

⁵ The Church of Jesus Christ of Latter-day Saints, *The Doctrine & Covenants of The Church of Jesus Christ of Latter-day Saints* § 115:4 (2013), <https://www.lds.org/scriptures/dc-testament/dc/115?lang=eng> (last visited April 3, 2019).

observance. Since there are many different opinions regarding kosher dietary requirements, the seemingly generic names of these certifying organizations have taken on great significance to kosher consumers. Words like “orthodox” or “kosher” or “rabbinical” may qualify as generic in other contexts, but in the context of kosher certification, they permit the faithful to identify food that complies with their religious strictures. Organizations that utilize names and marks such as those listed above are well-known and relied on within the community. Kosher supervision agencies rigorously enforce the use of their marks, sending notices to companies that misuse their symbols on products, and issuing notices to Jewish communities if mislabeled products are circulating. The decision below threatens these legal protections to the extent that it precludes kosher certification organizations from using their established names and symbols. Such a result would create confusion among Jews who observe kosher dietary laws.

Trademarks also reduce public confusion. In one case, the Fourth Circuit relied on trademark law to prevent a dissenting Methodist group from using the mark of a pre-merger sect. See *Purcell*, 145 F.2d at 982–83. The court of appeals explained that “[a] large portion of any community is not well informed about ecclesiastical matters.” *Id.* at 983. Thus, “for the dissident members to use the name of the old church will enable them to appear in the eyes of the community as the continuation of that church, and to make the

united church, which is in reality the continuation of the old church, appear as an intruder.” *Ibid.*

II. The Decision Below Especially Threatens the Trademarks of Religious Organizations.

The Second Circuit’s decision poses a direct threat to the ability of many religious organizations to maintain trademarks for their institutional names. Religious trademarks tend to differ from non-religious ones. Religious organizations, particularly churches, often have names composed of common religious words, such as “God,” “orthodox,” or “church.” See Simon, 49 IDEA: The Intell. Prop. L. Rev. at 247 (“Religious organizations frequently use terms of faith within their names, leaving them particularly susceptible to th[e] problem” “of genericness”). If courts assess the validity of a church’s trademark by dissecting a name and analyzing its constituent parts, religious trademarks would often fail the test for genericness.

Take one of the amici here, Church of God in Christ, Inc. Considered in isolation, each word of its trademark is a generic word common to many other denominations. As Judge Easterbrook explained, “[i]n the contemporary United States, variations on ‘Church of [Deity]’ are used to differentiate individual denominations, not to denote the class of all religions,” which would make the name generic. *TE-TA-MA Truth Found.—Family of URI, Inc. v. World Church of Creator*, 297 F.3d 662, 666 (7th Cir. 2002). He further observed:

The list is considerable: Church of God; Church of God (Anderson, Indiana); First Church of God; Worldwide Church of God; Church of God in Christ; Assembly of God; Korean Assembly of God; Church of the Nazarene; Church of Christ; United Church of Christ; Disciples of Christ; Church of Christ, Scientist; [The] Church of Jesus Christ of Latter[-d]ay Saints. There is room for extension with Church of Our Savior, Church of the Holy Spirit, Church of the Holy Trinity, Church of Jehovah, and so on. Yet all of these are recognizable as denominational names.

Ibid. (citation omitted). Like fingerprints consisting of lines that are indistinguishable if considered individually, the countless ways of combining common faith terms “leaves ample options for other sects to distinguish themselves and achieve separate identities.”
Ibid.

Adopting the Second Circuit’s approach means that a religious trademark can be invalidated for being generic when just *one* of the mark’s words is generic in isolation or used by other faiths. On that mistaken test, many religious organizations could lose their trademarks. For instance, the words “orthodox,” “Methodist,” “Evangelical,” and “Lutheran” are used by numerous religious groups. If each word of a trademark is analyzed in artificial isolation, as in the decision below, a trademark with a common religious term like these could be declared generic.

In short, allowing the Second Circuit’s generic trademark analysis to stand would have disastrous consequences for religious institutions in a way not comparable with more commercial entities. Commercial trademarks like Nike or Dell do not rely on common terms or a word shared by similar entities. Unlike businesses, faith communities often select a name constrained—or even mandated—by sincere religious belief. The decision below heightens these and other burdens that religious organizations already face when they seek trademark protection.⁶

III. Review Is Essential to Restore the Lanham Act to Its Textual Foundations and this Court’s Established Interpretation.

The Second Circuit’s methodology for deciding whether the trademark for The Universal Church is generic substantially departed from the text of the Lanham Act and this Court’s decisions in two important respects.

First, the court of appeals disregarded the Act’s unambiguous direction to test whether a trademark

⁶ Religious trademarks are already at a disadvantage compared to more commercial trademarks. See David A. Simon, *Register Trademarks and Keep the Faith: Trademarks, Religion and Identity*, 49 IDEA: The Intell. Prop. L. Rev. 233, 259, 260 (2008) (observing that “most religious marks are not ‘famous,’ [so] dilution probably will not aid religious organizations in their quest to protect their identity” and that the “‘use in commerce’ requirement is another obstacle for religious organizations seeking to protect their identities with trademark law”).

has become generic by “[t]he primary significance of the registered mark to *the relevant public*.” 15 U.S.C. § 1064(3) (emphasis added). The statute removes any doubt as to the importance of this phrase by stating plainly that it “shall be the test” for genericness. *Ibid.* But rather than applying this test, the Second Circuit turned to expert testimony and reports on obscure theological texts regarding historical usage of particular words. See Pet. App. 4a (relying on respondents’ “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”) (internal quotation marks omitted). Also, the court leaned on a dictionary definition with the most recent documented usage from 75 years ago. See *ibid.* (relying on respondents’ evidence in the form of a “definition of ‘universal’ from the Oxford English Dictionary”).

Millennia-old linguistic usage from obscure texts and outdated definitions, standing alone, cannot qualify as “the relevant public” under the Lanham Act since a dead “public” is no public at all. Without a focus on the living public, the Act’s test for generic marks would miss the phenomenon of linguistic drift—where the historical meaning of a word comes to differ significantly from contemporary understandings. See Thomas R. Lee & James C. Phillips, *Data-Driven Originalism*, 167 U. Penn. L. Rev. 261, 298–302 (2019), https://papers.ssrn.com/sol3/papers.cfm?abstract_id=

3036206 (last visited April 4, 2019) (documenting how the most common meaning of “domestic violence” drifted from an insurrection sense in 1789 to the contemporary sense of assaulting a household member).

This is not to say that evidence of a trademark’s historical usage is irrelevant. The relevant public meaning of a church’s name may be deeply informed by the long history of its use. Historical usage may be one of several factors used to demonstrate that a challenged trademark is not generic. See, e.g., *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 1570 (Fed. Cir. 1987) (“Evidence of the public’s understanding of the term may be obtained from any competent source, such as purchaser testimony, consumer surveys, listings in dictionaries, trade journals, newspapers and other publications.”); *Glover v. Ampak, Inc.*, 74 F.3d 57, 59 (4th Cir. 1996) (“[E]vidence may come from purchaser testimony, consumer surveys, listings and dictionaries, trade journals, newspapers and other publications.”). Of course, the relevance of historical usage of a church’s name turns on its influence on the mark’s “primary significance * * * to the relevant public.” 15 U.S.C. § 1064(3).

The Second Circuit solely relied on historical usage at the expense of the Lanham Act’s mandatory focus on “the relevant public.” In doing so, the court of appeals flouted the “fundamental canon of statutory construction that words generally should be interpreted as taking their ordinary * * * meaning.” *New Prime Inc. v. Oliveira*, 139 S. Ct. 532, 539 (2019) (internal quotation marks omitted). Not only did the court of

appeals make no effort to discern what “relevant public” means in this case, it measured the validity of the petitioner’s trademark according to a different test than the one Congress mandated. Petitioner has ably shown how the Second Circuit’s atextual approach creates a conflict with at least the Sixth, Seventh, and Eighth Circuits.⁷ See Pet. 15–18. This conflict places religious trademarks at particular risk since they often consist of words and phrases that convey a different meaning from a historical perspective than they communicate to a contemporary public.

Second, the court below also departed from this Court’s precedent by assessing the petitioner’s trademark one word at a time, rather than as a single whole. See Pet. App. 4a (relying on the definition of a single word in petitioner’s trademarked name and noting evidence of usage in “various contexts”⁸). Slicing up a trademark for analysis violates the anti-dissection rule, meaning that “a composite mark is tested for its

⁷ The circuit split implicated by the Second Circuit’s decision may be even broader. Petitioner confined its analysis to religious trademark disputes, but the Lanham Act applies the same statutory test to religious and non-religious trademarks. Examining how federal circuits perform the genericness analysis in the context of non-religious trademarks almost surely would increase the number of circuits in conflict with the decision below. See, e.g., *CareFirst of Md., Inc. v. First Care, P.C.*, 434 F.3d 263, 267 (4th Cir. 2006) (“[W]e look to how the two parties actually use their marks in the marketplace.”).

⁸ The Second Circuit’s analysis here is terse. The “various contexts” appear to include the evidence the district court noted of the use of *universal* in at least one other denomination’s name. See Pet. App. 27a.

validity and distinctiveness by looking at it as a whole, rather than dissecting it into its component parts.” 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 11:27 (5th ed. 2018).

Adopted by this Court nearly a century ago, the anti-dissection rule is an essential element of trademark law. See *Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 545–46 (1920) (“The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety.”). By dissecting petitioner’s trademark for analysis, the decision below conflicts with still other circuits.⁹ Unfortunately, the decision here is not the first time the Second Circuit has violated the anti-dissection rule. See, e.g., *Reese Pub. Co. v. Hampton Int’l Commc’ns, Inc.*, 620 F.2d 7, 10–11 (2d Cir. 1980) (finding no trademark protection for “Video Buyer’s Guide” because its constituent terms—*video* and *buyer’s guide*—were generic in isolation); *CES Pub. Corp. v. St. Regis Publications, Inc.*, 531 F.2d 11, 13–15 (2d Cir. 1975) (finding no trademark protection for a periodical

⁹ By our count, at least nine circuits have adopted the anti-dissection rule. See, e.g., *Bos. Duck Tours, LP v. Super Duck Tours, LLC*, 531 F.3d 1, 33 (1st Cir. 2008) (“[T]he ‘anti-dissection rule’ instructs that composite trademarks, those with more than one word, are considered as a whole.”); *Assoc. of Coop. Members, Inc. v. Farmland Indus., Inc.*, 684 F.2d 1134, 1140 (5th Cir. 1982) (“The whole, in trademark law, is often greater than the sum of its parts. Common words in which no one may acquire a trademark because they are descriptive or generic may, when used in combination, become a valid trademark.”).

with the term *consumer electronics* in its title because the term is generic).

This established anti-dissection rule is especially crucial for religious trademarks. Because they tend to consist of common faith-related words, ignoring the anti-dissection rule makes it significantly more likely that a court will invalidate a trademark as generic.

Understanding these risks, the Ninth Circuit applied the anti-dissection rule to a religious trademark. See *Self-Realization Fellowship Church v. Ananda Church of Self-Realization*, 59 F.3d 902 (9th Cir. 1995). There, the district court invalidated the trademarks “Self-Realization Fellowship” and “Self-Realization Fellowship Church” because the term “Self-realization” was invalid, so the court reasoned, “adding ‘Fellowship’ or ‘Fellowship Church’ could not make the composite terms valid.” *Id.* at 912. But the Ninth Circuit reversed. “A court may not review the validity of a composite-term trademark by ‘dissecting’ the term and reviewing the validity of its component parts individually.” *Ibid.*

Another reason for rejecting the Second Circuit’s interpretation of the Lanham Act is the principle of constitutional avoidance. See, e.g., *Gomez v. United States*, 490 U.S. 858, 864 (1989) (“It is our settled policy to avoid an interpretation of a federal statute that engenders constitutional issues if a reasonable alternative interpretation poses no constitutional question.”). As we explained above, religious trademarks reflect religious beliefs, practices, and self-definition. Failing to protect a faith community’s registered trademark

raises serious constitutional questions that can be avoided by hewing to the statutory text.

A final reason supporting review is that the Second Circuit is perhaps the most influential circuit in the country on issues of trademark law. See Kenneth A. Plevan, *The Second Circuit and the Development of Intellectual Property Law: The First 125 Years*, 85 *Fordham L. Rev.* 143, 143–44, 166–77 (2016) (noting that the Second Circuit’s path-breaking trademark doctrines were eventually adopted by all other circuits). Since lower courts often follow the Second Circuit’s lead on trademark issues, a serious aberration like the decision below can spread to other circuits. And given how seldom a question under the Lanham Act regarding “relevant public” comes before the Court,¹⁰ allowing the decision below to remain unreviewed would be disastrous for religious trademarks given their particular vulnerabilities under the Second Circuit’s analysis.

¹⁰ Our research has located only one other petition raising the “relevant public” issue in the past 39 years. See Petition for Writ of Certiorari, *Elliott v. Google* (Aug. 14, 2017) (No. 17-258), 2017 WL 3601395.

CONCLUSION

For these reasons, the Court should grant the petition.

Respectfully submitted,

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