

**IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF SOUTH CAROLINA  
CHARLESTON DIVISION**

The Right Reverend Charles G. vonRosenberg )  
et al., )  
 )  
Plaintiffs, )  
 )  
The Episcopal Church, )  
 )  
Plaintiff-in-Intervention, )  
 )  
v. )  
 )  
The Right Reverend Mark J. Lawrence et al., )  
 )  
Defendants. )  
\_\_\_\_\_ )

No. 2:13-cv-00587-RMG

**PLAINTIFF-IN-INTERVENTION THE EPISCOPAL CHURCH'S  
MEMORANDUM IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT**

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## INTRODUCTION

Plaintiff-in-Intervention The Episcopal Church (the “Church”) hereby moves for summary judgment on its claims for trademark infringement and dilution, and on Defendants’ counterclaims. Defendants have purported to disaffiliate from the Church, but continue to use the names they used when they were part of the Church and/or continue to hold themselves out as belonging to the “Episcopal” diocese led by the “Episcopal” bishop. These actions are not only *likely* to cause confusion, but, as we detail below, *have* caused confusion over and over again. Further, Defendants’ assertion that the Church’s marks are “generic” fails as a matter of law for many reasons, including because “The Episcopal Church” refers *only* to the Plaintiff-in-Intervention, as confirmed by the undisputed record evidence, including from the Defendants themselves. For these and other reasons, the Court should grant the Church summary judgment.

## STATEMENT OF FACTS

### **I. STRUCTURE AND GOVERNANCE OF THE EPISCOPAL CHURCH**

The Episcopal Church is a three-tiered, hierarchical church composed of the Church’s General Convention at the topmost tier, regional dioceses in the middle tier, and worshipping congregations, typically parishes and missions, at the bottom tier.<sup>1</sup> The Church was formed in the 1780s after the American Revolution, as the successor to the Church of England in the new

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<sup>1</sup> See *Protestant Episcopal Church in the Diocese of South Carolina v. The Episcopal Church*, 806 S.E.2d 82, 86 (2017) (“TEC is a hierarchical church”) (Pleicones, J.); *id.* at 93 (same) (Hearn, J.); *id.* at 102 (same) (Beatty, C.J.); see also Order at 3 n.5, Dkt. No. 30 (Houck, J.) (“[T]he Canons of the Episcopal Church clearly establish that it is a hierarchy.” *Dixon v. Edwards*, 290 F.3d 699, 716 (4th Cir. 2002) (citing *Hiles v. Episcopal Diocese of Mass.*, 744 N.E.2d 1116, 1121 (Mass. App. Ct. 2001) (“It is undisputed that the Episcopal Church is hierarchical in structure; there are no judicial holdings to the contrary.”))); Declaration of Geoffrey T. Smith at ¶ 3 (Exh. 1 hereto) (three-tiered structure).



United States of America.<sup>2</sup> The Diocese of South Carolina has been a part of the Church since the Church's formation.<sup>3</sup> The Most Rev. Michael B. Curry is the Church's Presiding Bishop.<sup>4</sup>

The Church's governing documents are its Constitution, Canons, and *Book of Common Prayer*, all of which are binding on all parts of the Church.<sup>5</sup> From the time when it first adopted these documents in 1789,<sup>6</sup> the Church has extensively regulated the quality of the services provided by its lower tiers. Since 2006, for example, the Church's governing documents have contained detailed provisions regulating the discernment, examination, and ordination of new clergy,<sup>7</sup> standards of conduct for and discipline of clergy,<sup>8</sup> membership in the Church and rights of members,<sup>9</sup> marriage, divorce, and remarriage,<sup>10</sup> business methods including audits, depositories for church funds, records of trust funds, bonding for treasurers, insurance, and the holding of property,<sup>11</sup> and, of course, worship.<sup>12</sup>

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<sup>2</sup> See Declaration of Mark J. Duffy at ¶ 3 & Attachment 1 at 14-130 (Exh. 2 hereto) (excerpts from *Journals of General Conventions of the Protestant Episcopal Church in the United States, 1785—1835*, Vol. 1 (Perry, ed.) ("*Journals 1785-1835*") showing early actions to form the Church).

<sup>3</sup> See Duffy Decl. at ¶ 3 & Attachment 1 at 14-16 (excerpt from *Journals 1785—1835* showing participation by clergy and laity from South Carolina in the early conventions).

<sup>4</sup> See Smith Decl. at ¶ 5.

<sup>5</sup> See Smith Decl. at ¶ 6; *see also* n.1 *supra*.

<sup>6</sup> See Duffy Decl. at ¶ 3 & Attachment 1 (excerpt from *Journals 1785-1835* at 99-102 (Church's first Constitution) and 79-82 (Church's first Canons); *id.* at ¶ 4 & Attachment 2 at 8-11 (excerpts from the Church's 1979 *Book of Common Prayer* showing 1789 Ratification and Preface).

<sup>7</sup> See Duffy Decl. at ¶ 5 & Attachment 3 at 7-8, 63-117 (2006 Const. Article VIII; Title III of the Canons).

<sup>8</sup> See Duffy Decl. at ¶ 5 & Attachment 3 at 8, 119-180 (2006 Const. Article IX; Title IV of the Canons).

<sup>9</sup> See Duffy Decl. ¶ 5 & Attachment 3 at 53-56 (2006 Canon I.17).

<sup>10</sup> See Duffy Decl. ¶ 5 & Attachment 3 at 56-58 (2006 Canons I.18-19).

<sup>11</sup> See Duffy Decl. ¶ 5 & Attachment 3 at 38-40 (2006 Canon I.7).

## II. THE EPISCOPAL CHURCH'S MARKS

The Episcopal Church owns multiple federal trademark registrations. The Church has historically permitted its subordinate units—its dioceses, parishes and missions, and other institutions bound by the Church's governing documents—to use its marks. *See* Smith Decl. at ¶ 10. Similarly, the Church has allowed use of its marks by related organizations that support the Church's mission. *See id.* The Church's federally registered marks are as follows:

THE PROTESTANT EPISCOPAL CHURCH IN THE UNITED STATES OF AMERICA. The U.S. Patent and Trademark Office registered this mark on November 27, 2007, covering “[r]eligious services, namely, ministerial, evangelical, and missionary services.” Exh. 3. This mark has obtained “incontestable” status because it has been in continuous use for more than five years. Exh. 4. The name THE PROTESTANT EPISCOPAL CHURCH IN THE UNITED STATES OF AMERICA was in use at least as early as 1785, when early conventions were meeting to form the Church after the Revolution.<sup>13</sup> That was the name under which the Church adopted its first Constitution in October 1789.<sup>14</sup> The Church continues to use that name; for example, it remains in the current edition of the Church's Constitution and Canons.<sup>15</sup>

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<sup>12</sup> *See* Duffy Decl. ¶ 5 & Attachment 3 at 8-9, 59-62 (2006 Const. Article X; Title II of the Canons), and ¶ 4 & Attachment 2 (excerpts from the *Book of Common Prayer* showing delineation of Church calendar and prescribed prayers, worship services, and Scriptural readings).

<sup>13</sup> *See, e.g.*, Duffy Decl. ¶ 3 & Attachment 1 at 21-23 (excerpt from *Journals 1785-1835* showing proposal for “A General Ecclesiastical Constitution of the Protestant Episcopal Church in the United States of America”).

<sup>14</sup> *See* Duffy Decl. ¶ 3 & Attachment 1 at 99 (excerpt from *Journals 1785-1835* containing “The Constitution of the Protestant Episcopal Church in the United States of America” as adopted in 1789).

<sup>15</sup> *See* Duffy Decl. ¶ 6 & Attachment 4 (Constitution and Canons (2015) at Cover (“Constitution and Canons, Together with the Rules of Order, for the Government of the Protestant Episcopal Church in the United States of America Otherwise Known as The Episcopal Church”) and Preamble (referring to “The Protestant Episcopal Church in the United States of

THE EPISCOPAL CHURCH. The PTO registered this mark on January 9, 2007, for “[r]eligious services, namely, ministerial, evangelical, and missionary services” and for “[i]nformational publications and educational materials covering religious and church-related topics, namely, books, magazines, pamphlets, and newsletters.” Exhs. 5 and 6. The PTO also registered this mark on February 12, 2008, for “[r]eligious instruction services.” Exh. 7. Each registration has obtained incontestable status. Exh. 8. This mark came into use as a name for the Church over time, and was formally incorporated into the Church’s Constitution in 1967.<sup>16</sup> As we show in Section III.C below, the Church is now widely known by this name.

THE EPISCOPAL CHURCH WELCOMES YOU. This mark was registered on November 27, 2007, for “[r]eligious services, namely, ministerial, evangelical, and missionary services.” Exh. 9. The registration has achieved incontestable status. Exh. 10. The Church and its subordinate parts began using the term THE EPISCOPAL CHURCH WELCOMES YOU on road signs in the early 1950s, and that mark continues to be used to identify local Episcopal churches to this day. *See* Smith Decl. at ¶ 7.

LA IGLESIA EPISCOPAL. This mark (which translates from Spanish into English as “The Episcopal Church”) was registered by the PTO on February 5, 2008, for “[r]eligious instruction services” and “[i]nformational publications and educational materials covering religious topics, namely, books, magazines, pamphlets, and newsletters.” Exhs. 61 and 62. It has obtained incontestable status. *See* Exh. 63. The Church has used the name LA IGLESIA EPISOCPAL since at least 1976. *See* Smith Decl. at ¶ 8.

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America, otherwise known as The Episcopal Church (which name is hereby recognized as also designating the Church”).

<sup>16</sup> *See* Duffy Decl. ¶ 7 & Attachment 5 (pages from the 1967 Journal of the General Convention showing addition of name).

THE EPISCOPAL SHIELD. The Episcopal shield<sup>17</sup> has been registered with the PTO since October 16, 2007, for “[r]eligious services, namely, ministerial, evangelical, and missionary services,” and since October 30, 2007, for “[i]nformational publications and educational materials covering religious topics, namely, books, magazines, pamphlets, and newsletters.” Exhs. 64 and 65. The registrations have obtained incontestable status. *See* Exh. 66. The Church has used this mark since at least 1940. *See* Smith Decl. at ¶ 9.

### III. THE CURRENT DISPUTE

As a result of doctrinal differences, in 2012, a faction within the Church’s Diocese of South Carolina purported to withdraw the Diocese and many of its parishes from the Church. The Church’s Diocese of South Carolina has historically used the names “Diocese of South Carolina,” “Episcopal Diocese of South Carolina,” “Protestant Episcopal Diocese of South Carolina,” “Protestant Episcopal Church in South Carolina,” and “Protestant Episcopal Church in the Diocese of South Carolina” (*see* Duffy Decl. at ¶ 9), with the Church’s implied permission, as well as the Diocesan seal.

That purported withdrawal produced two dioceses, each with its own cadre of parishes: one under the supervision of Plaintiffs Bishop vonRosenberg and Bishop Adams, operating under the name “The Episcopal Church in South Carolina” (“TECSC”),<sup>18</sup> which is recognized by the Church as its continuing, historic diocese in southeastern South Carolina; and another under the supervision of defendant Bishop Lawrence (the “Lawrence Diocese” and the “Lawrence Parishes”), who is no longer a bishop of The Episcopal Church.

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<sup>17</sup> This is a design mark:



<sup>18</sup> TECSC began using that name when the state Circuit Court enjoined it from using the Diocese’s historic names.

The purported withdrawal also produced three lawsuits, described below.

**A. State Court Litigation**

**1. The primary lawsuit**

Shortly after the above-described efforts to withdraw the Diocese from the Church, most of the Defendants in the present case filed suit in state court against the Church and TECSC seeking resolution of which faction—the TECSC faction or the Lawrence faction—properly controlled the real and personal property of the historic Diocese and 36 of its parishes.<sup>19</sup> In addition, the plaintiffs in that case claimed that the Church and TECSC were improperly using names belonging to the Diocese and the parishes in violation of South Carolina law governing service mark infringement and improper use of names, styles, and emblems. The Church and TECSC counterclaimed, seeking adjudications in their favor on the same issues. *See The Protestant Episcopal Church in the Diocese of South Carolina v. The Episcopal Church*, No. 2013-CP-18-00013 (Cir Ct., County of Dorchester). After a trial, the Circuit Court found in favor of the Lawrence faction on all issues.

On August 2, 2017, the South Carolina Supreme Court reversed most of the Circuit Court’s decision. *See The Protestant Episcopal Church in the Diocese of South Carolina v. The Episcopal Church*, 806 S.E.2d 82 (2017), *reh’g denied* (Nov. 17, 2017). Three Justices (Acting Justice Pleicones, Justice Hearn, and Chief Justice Beatty) concluded that the group led by Bishop Lawrence could not maintain control over real and personal property dedicated to the Church’s Diocese of South Carolina after they left the Church, and that the parishes that had acceded to the Church’s rules governing property held that property in trust for the Church and TECSC. *Id.* at 92 (Pleicones, J.) (“I would ... reverse the circuit court’s decision ... to the extent

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<sup>19</sup> Nineteen parishes named as Defendants in this case were not parties in the state court case.

it held that the [Lawrence] Diocese, the Trustees, and parishes controlled or owned the disputed real and personal property”); *id.* at 93, 102 n.27 (Hearn, J.) (“I concur with [Justice Pleicones] and would confirm title to the property at issue in [The Episcopal Church] and reverse ... [and] I join Acting Justice Pleicones and Chief Justice Beatty in reversing the trial court as to the twenty-nine parishes that documented their reaffirmation to the National Church”); *id.* at 103 & n.29 (Beatty, C.J.) (“I agree with the majority as to the disposition of the remaining parishes because their express accession to the Dennis Canon was sufficient to create an irrevocable trust ... [and] the [Lawrence] Diocese can make no claim to being the successor to the Protestant Episcopal Church in the Diocese of South Carolina.”); *see also* Order and Opinion at 2, Dkt. No. 411 (Aug. 23, 2018) (Gergel, J.) (“[T]he South Carolina Supreme Court held that TEC owned most of the property at issue ... The court also held that twenty-eight parishes associated with the Diocese held real and personal property in trust for the benefit of TEC.”).

On the intellectual property issues, the same majority vacated the Circuit Court’s decision and deferred resolution of the issues to this Court. Acting Justice Pleicones and Justice Hearn would have reversed the Circuit Court outright, on the basis of their conclusion that the defendants in that case (the Church and TECSC) had exclusive rights in the service marks at issue. *See Protestant Episcopal Church in the Diocese of South Carolina*, 806 S.E.2d at 84-85 (Pleicones, J.); *id.* at 101-02 (Hearn, J.). Chief Justice Beatty, in the controlling opinion, would have “reverse[d] in part the order of the circuit court,” and concluded that any decision about “rights to the service marks ... should remain with the federal court.” *Id.* at 103 & n.28. *See also* Order and Opinion at 2, 7-8, Dkt. No. 411 (Aug, 23, 2018) (Gergel, J.) (same). Taken

together, these decisions vacated the Circuit Court’s decision on intellectual property and deferred them to this Court.<sup>20</sup>

## **2. The Betterment Act lawsuit**

Shortly after the South Carolina Supreme Court denied rehearing in the primary case, the Lawrence parties filed a new action against the Church and TECSC under the Betterments Act, S.C. Code Ann. § 27-27-10, seeking compensation for improvements made to the land at issue while the Lawrence parties held the land as trustees. A motion to dismiss that lawsuit is pending.

### **B. Federal Court Litigation (This Case)**

As we set out in detail in Section I.C.1 below, despite claiming to have withdrawn from the Church, the Lawrence Diocese continues to call itself an “Episcopal” diocese, using the same names it used before its purported disassociation. Similarly, the parishes in the Lawrence Diocese continue to hold themselves out as “Episcopal” parishes or, at a minimum, as part of an “Episcopal” Diocese led by an “Episcopal” bishop. *See* Section I.C.2, *infra*. These actions have caused widespread confusion, harming the Church and TECSC.

This action was filed as a result. In its original form, this case was brought on behalf of Bishop vonRosenberg—at that time the bishop authorized by the Church to lead TECSC—against Bishop Lawrence. Dkt. No. 1. Bishop vonRosenberg’s successor, Bishop Adams, was later added as a plaintiff. Dkt. No. 64. In addition, since the South Carolina Supreme Court’s decision in the original state court case, The Episcopal Church and TECSC have been added as plaintiffs to this case (*see* Dkt. No. 87 (allowing addition of the Church); Dkt. No. 140 (addition

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<sup>20</sup> There is an additional reason why the Circuit Court’s decision on intellectual property no longer stands: It is based on that court’s conclusion that the Lawrence Diocese and all of the Lawrence Parishes own their property free of any trust owed to the Church and TECSC. Now that that conclusion has been overruled by the South Carolina Supreme Court as to all the parties except a handful of parishes, the Circuit Court’s decision on intellectual property falls, as well.

of TECSC)), and the Lawrence Diocese (calling itself “The Protestant Episcopal Church in the Diocese of South Carolina”), the Trustees of The Protestant Episcopal Church in the Diocese of South Carolina (the “Trustees Corporation”), and the parishes and missions associated with the Lawrence Diocese (the “Lawrence Parishes”) have been added as defendants. *See* Dkt. No. 140.

The Church’s complaint seeks injunctive relief against all Defendants, barring them from using names and marks that infringe upon or dilute the Church’s marks. *See* Dkt. No. 150. The Lawrence Diocese filed counterclaims against the Church, seeking resolution in its favor of the same issues, and seeking a declaration that the Church’s marks are generic and, on that basis, cancellation of the Church’s federal registrations of those marks. *See* Dkt. No. 439.

### **ARGUMENT**

Under Fed. R. Civ. P. 56(a), “[t]he court shall grant summary judgment if the movant shows that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law.” The key question is “[w]hether the evidence presents a sufficient disagreement to request submission to a [factfinder] or whether it is so one-sided that one party must prevail as a matter of law.” *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 251 (1986).

#### **I. THE UNDISPUTED EVIDENCE SHOWS THAT DEFENDANTS ARE INFRINGING THE CHURCH’S MARKS.**

The Lanham Act, 15 U.S.C. § 1114(1)(a), establishes a claim for trademark infringement:

“Any person who shall, without the consent of the registrant – use in commerce any reproduction ... or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to confuse, or to cause mistake, or to deceive ... shall be liable in a civil action by the registrant for the remedies hereinafter provided.”



A plaintiff must prove four factors to prevail on an infringement claim under this statute: “(1) that it owns a valid mark; (2) that the defendant used the mark ‘in commerce’ and without plaintiff’s authorization; (3) that the defendant used the mark (or an imitation of it) ‘in connection with the sale, offering for sale, distribution, or advertising’ of goods or services; and (4) that the defendant’s use of the mark is likely to confuse consumers.” *Rosetta Stone Ltd. v. Google, Inc.*, 676 F.3d 144, 152 (4th Cir. 2012). Here, the undisputed evidence decisively demonstrates that each of these requirements is met.

**A. The Church Owns Valid Marks.**

The Church’s federal trademark registrations for the marks at issue are in the record, and the Court can take judicial notice of them.<sup>21</sup> The registrations have obtained “incontestable” status,<sup>22</sup> meaning they are “conclusive evidence of the validity of the registered mark and of the registration of the mark, of the registrant’s ownership of the mark, and of the registrant’s exclusive right to use the registered mark in commerce.” 15 U.S.C. § 1115(b). The validity of an incontestable mark “is conclusively presumed” and the mark “may not be challenged as merely descriptive.” *Retail Servs. Inc. v. Freebies Publ’g*, 364 F.3d 535, 548 (4th Cir. 2004).<sup>23</sup>

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<sup>21</sup> See Exhs. 3, 5, 6, 7, 9, 61, 62, 64, 65; *Rockland Exposition, Inc. v. Alliance of Auto. Serv. Providers*, 894 F. Supp. 2d 288, 300-01 n.7 (S.D.N.Y. 2012) (court may take judicial notice of PTO records); *Whitaker v. Hyundai Motor Co.*, 2018 U.S. Dist. LEXIS 174362, at \*30 n.5 (W.D. Va. Oct. 10, 2018) (same).

<sup>22</sup> See Exhs. 4, 8, 10, 63, 66 (PTO confirmations of incontestability).

<sup>23</sup> The State trademark registrations for “Episcopal Diocese of South Carolina (The)” and “Protestant Episcopal Church in the Diocese of South Carolina (The)” are owned by TECSC (*see* TECSC summary judgment brief), and have no bearing on the issue before the Court. Under South Carolina law, these registrations “shall” be “cancel[led]” if “a court of competent jurisdiction finds that the ... registered mark is so similar, as to be likely to cause confusion or mistake or to deceive, to a mark registered by another person in the United States Patent and Trademark Office before the date of the filing of the application for registration by the registrant under this article, and not abandoned.” S.C. Code Ann. § 39-15-1145(3)(f).

**B. Defendants Are Using the Marks Without the Church’s Authorization.**

The Church permits its constituent dioceses, parishes, and missions to use its marks. *See* Smith Decl. at ¶ 10. It does not, however, permit groups that are not affiliated with the Church (such as the Defendants) to use its marks or variants thereof. *See id.* In keeping with this practice, the Church has not authorized the Defendants to use its marks.

**C. Defendants Are Using the Marks or an Imitation of the Marks in Connection With the Offering of Services.**

Defendants have used and continue to use the Church’s marks, or confusingly similar variants thereof, in connection with the services they offer, and, in the case of the Defendant parishes and missions, to identify the Diocese of which they claim to be a part.

**1. Names used by the Lawrence Diocese**

There is ample, undisputed evidence that the Lawrence Diocese is using names that have historically been used by the Church’s Diocese of South Carolina and are confusingly similar to The Episcopal Church’s marks. For example:

- In his Answer, Defendant Lawrence admitted that he refers to the diocese he leads as “The Episcopal Diocese of South Carolina” and “The Protestant Episcopal Church in the Diocese of South Carolina.” Dkt. No. 439 at 5 ¶ 27. He also claims to be the “Bishop of The Protestant Episcopal Church in the Diocese of South Carolina.” *Id.* at 2 ¶ 4.
- The corporation that the Lawrence Diocese purports to control is “The Protestant Episcopal Church in the Diocese of South Carolina.” Deposition of James Lewis (Lawrence Diocese 30(b)(6) representative) (“Lawrence Diocese Dep.”) at 18:10-16 (Exh. 67).
- The Lawrence Diocese’s banking documents still include the name “Protestant Episcopal Church in the Diocese of South Carolina.” Lawrence Diocese Dep. at 50:22-51:16.
- The Journal of the Lawrence Diocese’s 2017 convention (the latest Journal available) refers to that diocese as “The Episcopal Diocese of South Carolina” at the top of every other page. Exh. 68 (excerpts).
- The Lawrence Diocese’s Canons identify various “Institutions” of the diocese, including The Episcopal Home for Children, The Episcopal Church Home, and The South Carolina Episcopal Home at Still Hope. Exh. 69 at C10-C12. The Canons also establish rules for

participation in the “Protestant Episcopal Church in the Diocese of South Carolina 403(b) Retirement Plan.” *Id.*

- The Lawrence Diocese obtains annual parochial reports from its congregations using the letterhead of “The Protestant Episcopal Church in the Diocese of South Carolina.” *See, e.g.,* Lawrence Diocese Dep. at 60:9-61:22; Exh. 70.
- The Lawrence Diocese continues to claim ownership of State trademark registrations for the marks “Episcopal Diocese of South Carolina (The)” and “Protestant Episcopal Church in the Diocese of South Carolina (The).” Lawrence Diocese Dep. at 83:2-88:6. It has not sought to cancel these registrations. *See id.*

## 2. Names used by the Defendant Parishes and Missions

Similarly, there is undisputed evidence that the Lawrence Parishes hold themselves out as affiliated with the Lawrence Diocese (and, therefore, a diocese that claims to be an “Episcopal” diocese), and many use other misleading references in their representations to the public. The relevant evidence concerning these Defendants is summarized below. Because this evidence is voluminous, details are included in several accompanying charts (*see* Exhs. 71-74).

- Many of these Defendants used the term “Episcopal” in their names—including in their governing documents, incorporation documents, charters, advertising, signage, web sites, and newsletters—*after* they claimed to no longer be part of The Episcopal Church. This includes many current uses of that term. A compilation of these uses is included on the chart attached as Exhibit 71.
- Many of these Defendants hold themselves out as being part of the “Protestant Episcopal Church in the Diocese of South Carolina,” and/or a diocese led by Bishop Lawrence, whom they hold out as an “Episcopal” bishop. Exh. 72.
- Virtually all of these Defendants continue to occupy the same church buildings they used before they purported to leave The Episcopal Church. *See* Exh. 73.
- Almost all of these Defendants continue to use The Episcopal Church’s prayer book—the *Book of Common Prayer*—and its hymnals in their worship services and/or make these books available in their pews. *See* Exh. 74.<sup>24</sup>

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<sup>24</sup> The *Book of Common Prayer* is not copyrighted, and the Church does not take the position that use of the Prayer Book alone is actionable here. Rather, the continued use of the Prayer Book combined with the other factors set out above contributes to confusion.

**D. Defendants’ Use of the Marks is Likely To Confuse Consumers.**

*Rosetta Stone* identifies nine factors that “generally are relevant to the ‘likelihood of confusion’ inquiry” in this Circuit:

“(1) the strength or distinctiveness of the plaintiff’s mark as actually used in the marketplace; (2) the similarity of the two marks to consumers; (3) the similarity of the goods or services that the marks identify; (4) the similarity of the facilities used by the markholders; (5) the similarity of advertising used by the markholders; (6) the defendant’s intent; (7) actual confusion; (8) the quality of the defendant’s product; and (9) the sophistication of the consuming public.” 676 F.3d at 153.

The undisputed evidence, as applied to these factors, requires the conclusion that Defendants’ conduct is likely to create confusion among consumers.

**1. Actual confusion**

We begin with factor (7) because all other factors are secondary when there is evidence of actual confusion. As the Fourth Circuit has explained, “where the defendant in an infringement case has elected to use a mark similar to that of a competitor’s distinctive mark, and, as a result, has actually confused the public, our inquiry ends almost as soon as it begins.” *Sara Lee Corp. v. Kayser-Roth Corp.*, 81 F.3d 455, 467 (4th Cir. 1996).

“Actual confusion can be demonstrated by both anecdotal and survey evidence.” *George & Co. LLC v. Imagination Entm’t Ltd.*, 575 F.3d 383, 398 (4th Cir. 2009). Here, there is substantial, undisputed anecdotal evidence of actual confusion arising out of Defendants’ infringement, including the following:

- At his recent deposition as the Rule 30(b)(6) witness for TECSC, Bishop Adams testified that his office has received “many phone calls” wherein people stated that “I attended this church, it has the word Episcopal on it, but something doesn’t seem exactly the same as my experience.” TECSC Rule 30(b)(6) Dep. at 73:3-14 (Exh. 78). For example, in the fall of 2018, an individual called TECSC “want[ing] to make gifts to hurricane relief and wanted to ... make sure which address was correct ... so that they could do it through The Episcopal Church and were trying to get clear between Diocese of South Carolina and The Episcopal Church.” *Id.* at 74:18-76:6. In September 2018, a hurricane-relief check was in fact misdirected. *See id.* at 98:9-99:14.

- In 2017, a couple attended St. Michael's in Charleston because "they knew it to be a historical parish in Charleston and went there." They "worshiped there a couple times" but "then realized, well, wait a minute; something's not quite the same here. ... And then – then thereby looked for a church that was actually affiliated with The Episcopal Church. ... [T]hey attended St. Michael's because they knew it to be a historic Episcopal Church, or that was their memory. They didn't realize it had split away from The Episcopal Church." TECSC Rule 30(b)(6) Dep. at 95:25-97:15 (Exh. 78).
- Andrea McKellar, a TECSC employee since 2014, testified to multiple instances of actual confusion, including confusion arising out of Old St Andrew's use of a sign that included the term "Episcopal" even though it claims not to be part of The Episcopal Church; phone calls to TECSC by people who could not tell which churches were Episcopal churches; and mail being sent to Bishop Lawrence at TECSC's offices. Dep. at 9, 10, 28-33, 35-37, 45-46 (Exh. 116).
- Lauren Kinard, a TECSC employee since 2013, also testified to multiple instances of actual confusion, including mail and e-mails going to the wrong diocese; a person who intended to meet with Bishop Lawrence instead walking into TECSC's offices; and donations being sent to the wrong diocese. Dep. at 10, 51-52, 64-65 (Exh. 117).
- On November 7, 2018, an investigator named Franklin E. Worrell asked 38 people in the vicinity of St. Michael's Church and St. Philip's Church (both in Charleston), and The Parish Church of St. Helena (in Beaufort), what kind of churches they were. Even though the churches are currently under the control of the Lawrence Diocese, the respondents overwhelmingly stated that they were "Episcopal" churches. *See* Declaration of Franklin E. Worrell (Exh. 79).
- Bishop Adams was contacted by an individual who complained about bed bugs at Camp St. Christopher, which at the time was under the control of the Lawrence Diocese. *See* Deposition of The Rt. Rev. Gladstone B. Adams, III ("Adams Dep.") at 49:7-50:1 (Exh.80).
- Bishop Adams received a phone call from a priest in Illinois who could not determine whether St. John's parish on Johns Island was an Episcopal parish. *See* Adams Dep. at 53:3-22.
- Bishop Adams received a call from the father of a Citadel student who was "irritated" because services "were being offered there in the name of The Episcopal Church but, in fact, not offered by clergy of The Episcopal Church" and were instead "being offered by Bishop Lawrence's clergy." Adams Dep. at 55:12:56:13.
- Bishop Adams was approached at Epiphany Church in Summerville by a man who had moved to South Carolina and "had a very difficult time going online and trying to figure out which churches were Episcopal Church or not because he looked at the Diocese of South Carolina and assumed that was the Episcopal diocese." Adams Dep. at 66:24-67:8.

- Bishop Adams has received many calls from parents of students at Porter-Gaud School, which is “a member of the National Association of Episcopal Schools,” concerning whether the school is an “Episcopal school” because Bishop Lawrence was on the board and a priest there was “part of Bishop Lawrence’s diocese, not an Episcopal priest.” Adams Dep. 72:17-74:3.
- Christmas cards intended for Bishop Adams went to Bishop Lawrence’s diocese instead. *See* Adams Dep. 102:7-18.
- Bishop Adams testified that gifts were given to Cristosal—an organization for which he sat on the board—that were “listed as a gift of The Diocese of South Carolina.” Adams Dep. 102:19-103:1. He is also aware of other gifts “that went to Bishop Lawrence’s diocese instead of The Episcopal Church.” *Id.* at 103:3-6, 106:7-16. There were four or five of instances of money having been sent to the wrong diocese. *See id.* at 108:2-6.
- Bishop Adams reported that on a weekly basis, “at every parish visitation, somebody brings up something about confusion, their confusion about what it—what is a part of The Episcopal Church, what isn’t.” Adams Dep. 117:16-25. He also reported that on a 2017 trip for the consecration of a bishop in Indianapolis, “several people asked [him] about parishes in the diocese, are they a part of The Episcopal Church, or are they not a part of The Episcopal Church.” *Id.* at 118:1-8.
- Nancy Armstrong, Assistant Treasurer for the corporation the Lawrence Diocese claims to control, testified that there was actual confusion when that corporation used the term “Episcopal” in its name after it no longer claimed to be part of The Episcopal Church: “We received phone calls intended for the other diocese. We have actually had churches get confused and they weren’t with us anymore, send us a check and it was intended for the other diocese. *It has caused confusion.*” Exh. 81 at D-23 at 23:6-10 (emphasis added).
- The Rule 30(b)(6) witness for St. James Church, James Island testified that within the past three years, another local church, St. James Presbyterian Church, had run an advertisement for St. James Church using the word “Episcopal” in the name even though the church was no longer affiliated with The Episcopal Church. Exh. 29 at 33:19-36:2.
- Old St. Andrews parish testified that more than twice a year it is asked whether the parish is part of The Episcopal Church. *See* Exh. 49 at 84:8-85:21.
- The Episcopal Church’s Rule 30(b)(6) witness, Geoffrey Smith, testified that when in Charleston for his deposition, he overheard two different carriage drivers referring to “St. Philip’s Episcopal Church” even though it is currently controlled by individuals who are not part of The Episcopal Church. Smith Dep. at 104:1-14 (Exh. 82).

This evidence is more than sufficient to show actual confusion. *See, e.g., Choice Hotels Int’l, Inc. v. Zeal, LLC*, 135 F. Supp. 3d 451, 468 (D.S.C. 2015) (two instances of confusion constituted “meaningful evidence of consumer confusion”).

In addition to anecdotal evidence, Plaintiffs also produced survey evidence on the issue of confusion. (Defendants did not.) Robert Klein surveyed whether people believed “The Protestant Episcopal Church in the Diocese of South Carolina” and “The Episcopal Diocese of South Carolina” were “affiliated with a national or international organization” and, if so, which one. Exh. 83. Respondents associated “The Protestant Episcopal Church in the Diocese of South Carolina” with The Episcopal Church as follows:

<u>Survey Group</u>	<u>Net Confusion</u> <sup>25</sup>
Episcopalians	41%
Other Christians	16%
S.C. residents	18%

Respondents associated “The Episcopal Diocese of South Carolina” with The Episcopal Church as follows:

<u>Survey Group</u>	<u>Net Confusion</u>
Episcopalians	64%
Other Christians	30%
S.C. residents	24%

These figures easily satisfy the legal requirements for actual confusion. *See, e.g., Rosetta Stone*, 676 F.3d at 159 (17% net confusion “is clear evidence of actual confusion”); *Sara Lee*, 81 F.3d at 467 (survey showed 30-40% confusion; “even if the true figure were only half of the survey estimate, actual confusion would, in our view, nevertheless exist to a significant degree”).

This level of confusion should come as no surprise. The Lawrence Diocese purports to have removed the Diocese of South Carolina from The Episcopal Church, but is calling itself by

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<sup>25</sup> “Net Confusion” means the level of confusion after removing the percentage of respondents who associated the fictional test term “The Protestant Church in the District of South Carolina” with The Episcopal Church. Exh. 83 at 8.

the names historically used by the Church's Diocese of South Carolina. Many of the Defendant parishes and missions have also continued to use the names they used when they were part of the Church, and refer to the Diocese of which they are a part as the "Episcopal" diocese.

But a local church cannot purport to leave a larger church organization and keep using the same name without inevitably creating confusion. This is what happened in *Purcell v. Summers*, 145 F.2d 979 (4th Cir. 1944), where former members of the Methodist Episcopal Church, South "set up a rival church organization and were claiming the right to ... use the name of the Methodist Episcopal Church, South." *Id.* at 981. The court noted that this created confusion that "seem[ed] so clear ... as hardly to admit of argument." *Id.* at 983. It explained:

"That the use of the name of the Methodist Episcopal Church, South, by the seceding members as the name of the new and rival organization that they are creating will result in injury and damage to the united church into which the Methodist Episcopal Church, South, has been merged, ... seems so clear to our minds as hardly to admit of argument. A large portion of any community is not well informed about ecclesiastical matters; and 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. ... And in addition to all this, the old church, notwithstanding the merger, will still continue to be thought of under the old name in the minds of many of the members who have joined in the union, and gifts intended for it will be made in that name and may be lost or held only through expensive litigation, if the new organization of dissident members is allowed to use the name. Other confusion with resulting damage which cannot now be clearly foreseen must inevitably arise from the use of the old name by the seceding members." *Id.*<sup>26</sup>

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<sup>26</sup> See also 1 McCarthy on Trademarks and Unfair Competition § 9:7.50 (2018) ("A parent religious group is entitled to protection against a schismatic group or a dissident minority's confusing use of the same name."); *cf.*, *e.g.*, *Choice Hotels*, 135 F. Supp. 3d at 459 ("It is axiomatic that continued unauthorized use of a mark by a holdover franchisee creates a likelihood of confusion in the marketplace. Several circuits have held that where a franchisee continues to use the franchisor's mark without authorization, likelihood of confusion can be assumed and the traditional analysis is unnecessary.").



The same is true here. The Lawrence Diocese has purported to leave The Episcopal Church; so have the Lawrence Parishes.<sup>27</sup> They cannot keep using the names they used when they were affiliated with the Church, or confusion as to their affiliation with The Episcopal Church is inevitable. As the evidence discussed above shows, that confusion has manifested itself over and over again.

## **2. Strength or distinctiveness of marks as actually used in the marketplace**

Even if there were no evidence of actual confusion, the undisputed evidence on the other relevant factors would be sufficient to prove likelihood of confusion.<sup>28</sup> Initially, the Church's marks are strong. Strength in this context is based on "conceptual strength and commercial strength." *CareFirst of Maryland, Inc. v. First Care, P.C.*, 434 F.3d 263, 269 (4th Cir. 2006).

"Conceptual strength" "focuses on the linguistic or graphical 'peculiarity' of the mark." *Choice Hotels*, 135 F. Supp. 3d at 460-61. Here, the Church's marks "describe a function, use, characteristic, size or intended purpose" of the services. *Id.* at 461 (quotation omitted). Descriptive marks "are entitled to trademark protection if they have acquired secondary meaning." *Id.* The Church's marks have indeed acquired secondary meaning. In fact, the PTO requested evidence of the acquired distinctiveness of THE EPISCOPAL CHURCH, and when it was provided, the PTO registered the mark. *See* Exh. 84. In addition, because the Church's marks are incontestable, they are "conclusively presumed to be nondescriptive or to have acquired secondary meaning." *Lone Star Steakhouse*, 43 F.3d at 936 (quoting *Soweco, Inc. v.*

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<sup>27</sup> A handful of the Lawrence Parishes were created after 2012, and therefore were never part of The Episcopal Church. These parishes are nonetheless implicated in the present suit because they hold themselves out as part of a Diocese that claims to be an "Episcopal" Diocese.

<sup>28</sup> *See Lone Star Steakhouse & Saloon, Inc. v. Alpha of Va., Inc.*, 43 F.3d 922, 933 (4th Cir. 1995) ("this Court has emphasized that a trademark owner need not demonstrate actual confusion").

*Shell Oil Co.*, 617 F.2d 1178, 1184 (5th Cir. 1980)). *See also, e.g., Choice Hotels*, 135 F. Supp. 3d at 462 (“the plaintiff’s marks are not only registered, but have achieved incontestable status, and this fact weighs in favor of finding that the marks are sufficiently distinctive to warrant protection”).

“Commercial strength” measures “the degree to which the designation is associated by prospective purchasers with a particular source,” and whether “a substantial number of present or prospective customers understand the designation when used in connection with a business to refer to a particular person or business enterprise.” *Choice Hotels*, 135 F. Supp. 3d at 461. The Church’s marks have a high degree of commercial strength, meaning they are entitled to significant protection. As we detail below (in Section III.C), the World Council of Churches, the National Council of Churches, the media (including CNN, Time, and the Washington Post), dictionaries and encyclopedias, internet sources, and *the Defendants themselves* recognize that THE EPISCOPAL CHURCH refers to the Plaintiff-in-Intervention and no other organization. Further, the 30(b)(6) representatives of numerous other churches testified that THE PROTESTANT EPISCOPAL CHURCH IN THE UNITED STATES OF AMERICA also refers to the Plaintiff-in-Intervention. *See* n.32 *infra*. These marks therefore refer to “a particular ... business enterprise,” making them strong marks.<sup>29</sup>

### **3. Similarity of the marks to consumers**

This factor looks to whether the marks are “sufficiently similar in appearance, with greater weight given to the dominant or salient portions of the marks.” *Lone Star Steakhouse*, 43 F.3d at 936. Here, “Episcopal” is the dominant term in all of the names and marks at issue. In

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<sup>29</sup> *Choice Hotels*, 135 F. Supp. 3d at 461; *see, e.g., id.* at 463 (“even if the marks are descriptive from a conceptual standpoint, they have almost certainly acquired secondary meaning because consumers associate them with the plaintiff’s brand”). The same conclusion is true for the Church’s other marks, since there is no evidence that other users use any of them.

fact, “The Protestant Episcopal Church in the Diocese of South Carolina” is identical to the Church’s mark THE PROTESTANT EPISCOPAL CHURCH IN THE UNITED STATES OF AMERICA, except for its more limited geographic scope, which falsely connotes that the Lawrence Diocese is a regional sub-unit of the Church.

#### **4. Similarity of the goods or services that the marks identify**

This factor requires “some degree of overlap” in the services that the marks at issue identify, but the services “need not be identical or in direct competition with each other for this factor to be satisfied.” *JFJ Toys, Inc. v. Sears Holdings Corp.*, 237 F. Supp. 3d 311, 338 (D. Md. 2017) (citing *George & Co.*, 575 F.3d at 397); *see also Choice Hotels*, 135 F. Supp. 3d at 467 (“The parties’ offerings do not have to be identical for a court to find that they are similar.”). There is overlap between the types of services the Church and Defendants provide, since all offer religious and educational services.<sup>30</sup>

#### **5. Similarity of facilities used by the markholders**

“With respect to similarity of the facilities, the likelihood of confusion may also be increased if both goods are sold in the same channels of trade.” *JFJ Toys*, 237 F. Supp. 3d at 338. This factor favors a finding that confusion is likely, since the Church and the Defendants provide their services primarily in church buildings. In fact, Defendants continue to use the same buildings they used before they purported to leave the Church, which has added to the confusion. *See Worrell Decl.* (Exh. 79); Exh. 73 (chart). Where, as here, the defendant is using the same building it used when it was affiliated with the plaintiff, “[t]he facilities used by the parties are as similar as they could possibly be.” *Choice Hotels*, 135 F. Supp. 3d at 467.

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<sup>30</sup> Defendants also generally continue to use the Church’s prayer book—the *Book of Common Prayer*—and hymnals during worship services, or they make them available in their pews. *See Exh. 74*. Defendants’ use of these books highlights the similarity of the parties’ services.

## 6. Similarity of advertising used by the markholders

The parties do not engage in significant advertising. To the extent they do, the parties advertise in similar ways in similar locations, including on the Internet.<sup>31</sup>

## 7. Defendants' intent

Defendants' intent to confuse the public is shown by the refusal by many of them to change their names, or, in the case of the Lawrence Parishes, to change their reference to the name of the diocese of which they are part, after being served with the Complaint. *See, e.g., JFJ*, 237 F. Supp. 3d at 339 (after "serv[ing] Defendants with a copy of their Complaint," the "Defendants nonetheless continued to sell the infringing product").<sup>32</sup>

## 8. Quality of the Defendant's services

Although the religious services that the Church and the Defendants provide are different in their particular details, the quality of those services is similar for these purposes. This is one of the reasons why individuals have mistakenly attended religious services at a church affiliated with the Lawrence Diocese believing it was affiliated with The Episcopal Church. *See, e.g.,* TECSC Rule 30(b)(6) Dep. at 73:3-14 (individual reported to Bishop Adams: "I attended this church, it has the word Episcopal on it, but something doesn't seem exactly the same as my experience.") (Exh. 78); *id.* at 95:25-97:15 (couple attended St. Michael's "a couple times" but "then realized, well, wait a minute; something's not quite the same here").

## 9. Sophistication of the consuming public

The Church does not dispute that churchgoers are sophisticated. This fact underscores the magnitude of the confusion, since notwithstanding these individuals' sophistication, there is

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<sup>31</sup> *See* [www.episcopalchurch.org](http://www.episcopalchurch.org) (The Episcopal Church's site); [www.dioceseofsc.org](http://www.dioceseofsc.org) (Lawrence Diocese site); [www.episcopalchurchsc.org](http://www.episcopalchurchsc.org) (TECSC site).

<sup>32</sup> In any event, proof of intent to confuse is not required to prove trademark infringement. *See, e.g., Sara Lee*, 81 F.3d at 466 (finding infringement without deciding whether there was an intent to confuse); *Choice Hotels*, 135 F. Supp. 3d at 467 (same).

*still* ample evidence of confusion. Mr. Klein’s survey also shows that even among the group of Episcopalian respondents—who presumably have the most ability to discern the differences between the Church and its Diocese on the one hand, and the Lawrence Diocese on the other—the names the Lawrence Diocese uses create significant confusion. *See* Exh. 83 (among Episcopalians, 41% net confusion for “The Protestant Episcopal Church in the Diocese of South Carolina” and 64% net confusion for “The Episcopal Diocese of South Carolina”).

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In sum, applying the undisputed evidence to these factors shows that the names used by the Defendants are highly likely to be confused with the Church’s marks, and are in fact causing signification confusion.

**II. THE UNDISPUTED EVIDENCE SHOWS THAT DEFENDANTS ARE DILUTING THE CHURCH’S MARKS.**

15 U.S.C. § 1125(c)(1) establishes a cause of action for trademark dilution. It provides:

“[T]he owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner’s mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.”

“Dilution is not concerned with confusion in the marketplace.” *Rosetta Stone*, 676 F.3d at 167. Instead, “dilution theory provides that ‘if customers or prospective customers see the plaintiff’s famous mark used by other persons in a non-confusing way to identify other sources for many different goods and services, then the ability of the famous mark to clearly identify and distinguish only one source might be ‘diluted’ or weakened.’” *Id.* (citing McCarthy).

There are four elements to a claim for dilution by blurring:

“(1) that the plaintiff owns a famous mark that is distinctive;

- (2) that the defendant has commenced using a mark in commerce that allegedly is diluting the famous mark;
- (3) that a similarity between the defendant's mark and the famous mark gives rise to an association between the marks; and
- (4) that the association is likely to impair the distinctiveness of the famous mark or likely to harm the reputation of the famous mark."

*Rosetta Stone*, 676 F.3d at 168. The undisputed evidence shows that Defendants are diluting the Church's marks as a matter of law.

**A. The Church Owns Famous Marks That Are Distinctive.**

Under 15 U.S.C. § 1125(c)(2)(A), "a mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner." Two of the Church's marks clearly satisfy this requirement. There is a massive evidentiary record (discussed in detail in Section III.C below), including specimens from major media outlets, dictionaries and encyclopedias, and associations of religious denominations showing the widespread recognition of the mark THE EPISCOPAL CHURCH and understanding that this mark refers to the Plaintiff-in-Intervention. Similarly, when Defendants deposed representatives of churches that are not affiliated with The Episcopal Church, those representatives testified that they were familiar with the name THE PROTESTANT EPISCOPAL CHURCH IN THE UNITED STATES OF AMERICA, and that it referred to the Plaintiff-in-Intervention.<sup>33</sup> This evidence shows the wide recognition of these names as designating the source of the services that the Church provides.

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<sup>33</sup> See, e.g., Exh. 85 at 18:5-9 (deposition of the Episcopal Missionary Church); Exh. 86 at 11:24-12:12 (deposition of the Southern Episcopal Church); Exh. 87 at 44:22-45:10 (deposition of the African Methodist Episcopal Zion Church); Exh. 88 at 10:16-21 (deposition of the United Episcopal Church of North America).

**B. Defendants Are Using Marks in Commerce That Allegedly Dilute the Church’s Famous Marks.**

As explained above, Defendants are using marks that dilute the church’s famous marks, including (i) the Lawrence’s Diocese’s use of the names “The Episcopal Diocese of South Carolina” and “The Protestant Episcopal Church in the Diocese of South Carolina,” (ii) the parish and mission names that include the term “Episcopal,” and (iii) the parishes and missions that hold themselves out as being part of an “Episcopal” diocese led by an “Episcopal” bishop.

**C. The Similarity Between Defendants’ Marks and Plaintiff’s Famous Marks Gives Rise to an Association Between the Marks.**

This element is easily met. Defendants’ names and references to the “Episcopal” diocese led by Bishop Lawrence give rise to a clear association with the Church’s marks THE EPISCOPAL CHURCH and THE PROTESTANT EPISCOPAL CHURCH IN THE UNITED STATES OF AMERICA. The Lawrence Diocese’s use of the name “The Protestant Episcopal Church in the Diocese of South Carolina” is derivative of THE PROTESTANT EPISCOPAL CHURCH IN THE UNITED STATES OF AMERICA, and implies (falsely) that the Lawrence Diocese is a regional sub-unit of the Church itself. All other uses of the term “Episcopal” by the Defendants—who claim that they *used to be*, but no longer are, part of The Episcopal Church and its “Episcopal” diocese—give rise to an association between those marks. This conclusion is confirmed by the evidence of actual confusion discussed above, where individuals drew exactly this association. It is also consistent with Mr. Klein’s survey, where many respondents associated the names “The Protestant Episcopal Church in the Diocese of South Carolina” and “The Episcopal Diocese of South Carolina” with The Episcopal Church itself. *See* Exh. 83.

**D. This Association is Likely to Impair the Distinctiveness of the Church's Famous Marks.**

Finally, Defendants' use of the names "The Episcopal Diocese of South Carolina" and "The Protestant Episcopal Church in the Diocese of South Carolina" is likely to impair the distinctiveness of the Church's marks, namely THE EPISCOPAL CHURCH and THE PROTESTANT EPISCOPAL CHURCH IN THE UNITED STATES OF AMERICA.

Under 15 U.S.C. § 1125(c)(2)(B), "'dilution by blurring' is association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark." To determine whether dilution by blurring is likely to occur, "the court may consider all relevant factors," including "(i) The degree of similarity between the mark or trade name and the famous mark. (ii) The degree of inherent or acquired distinctiveness of the famous mark. (iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark. (iv) The degree of recognition of the famous mark. (v) Whether the user of the mark or trade name intended to create an association with the famous mark. [and] (vi) Any actual association between the mark or trade name and the famous mark." *Id.*

These considerations show that dilution by blurring is likely to occur. (i) First, the dominant term in each mark is the word "Episcopal." And the name "The Protestant Episcopal Church in the Diocese of South Carolina" is identical to THE PROTESTANT EPISCOPAL CHURCH IN THE UNITED STATES OF AMERICA, except for its more limited geographic descriptor. (ii) As detailed above, the Church's marks have such distinctiveness that it is understood that those marks refer to the Plaintiff-in-Intervention and no other organization, including by the Defendants themselves. (iii) The Church is the exclusive user of the Church's marks—there is no evidence of any unrelated organization using the marks. (iv) The Church's marks are highly recognizable, as evidenced by the many sources that use those marks (including



major media sources) to identify the Church and only the Church, *see infra* at Section III.C. (v) Defendants’ intent to confuse is shown by their continued use of the names in question even after being served with the Complaint. And, (vi) the record is replete with examples of people actually associating the names Defendants are using with the Church and its marks.

The association between the names Defendants are using and the Church’s marks is therefore likely to impair the distinctiveness of the Church’s marks as a matter of law.

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For all of these reasons, the Court should grant The Episcopal Church summary judgment on its trademark dilution claim.

### **III. THE COURT SHOULD DISMISS DEFENDANTS’ COUNTERCLAIMS.**

Defendants have asserted three counterclaims against the Church. *See* Dkt. No. 439. The first seeks a declaration that Defendants have not infringed the Church’s marks. This counterclaim mirrors the Church’s claims and should be dismissed for the reasons detailed above. Defendants’ other counterclaims seek (1) a declaration that the Church’s mark THE EPISCOPAL CHURCH, and its other marks including the word “Episcopal,” should be declared generic and, as a result, (2) cancellation of the Church’s federal registrations for these marks.

This is a massive overreach by Defendants. They are urging this Court to declare the widely known and historic names of one of the nation’s oldest religious denominations to be generic, thereby leaving any group that wishes to call itself “The Episcopal Church” free to do so. Defendants make this request even though it is undisputed that the Plaintiff-in-Intervention is the *only* organization that calls itself “The Episcopal Church.” Many other church groups have had no trouble finding other names for their organizations and their services notwithstanding Plaintiff-in-Intervention’s exclusive rights in this term. Defendants’ claim ignores the fact that the entire country—including other religious organizations, the media, dictionaries, and *the*

*Defendants themselves*—refers to the Plaintiff-in-Intervention, and *only* the Plaintiff-in-Intervention, as “The Episcopal Church.” THE EPISCOPAL CHURCH thus refers to a single source, not to the services that The Episcopal Church or any other church provides. As such, Defendants cannot possibly meet their burden of proof on their genericness counterclaims, and the Court should dismiss those claims.

## **A. Legal Standards for Assessing Genericness**

### **1. The law concerning genericness**

As we set out above, The Episcopal Church owns federal trademark registrations for the marks THE EPISCOPAL CHURCH, THE PROTESTANT EPISCOPAL CHURCH IN THE UNITED STATES OF AMERICA, THE EPISCOPAL CHURCH WELCOMES YOU, LA IGLESIA EPISCOPAL (Spanish for “The Episcopal Church”), and the Episcopal shield. *See* Exhs. 3, 5-7, 9, 61, 62, 64, 65 (registrations). These marks were registered ten or more years ago, in the fields of “religious services,” “religious instruction services,” and/or “informational publications.” *See id.*

Under 15 U.S.C. § 1064(3), a registered mark may be cancelled if, in the mind of the “relevant public,” it “becomes the generic name for the goods or services ... for which it is registered.”<sup>34</sup> A trademark registration is “prima facie evidence of the validity of the registered mark.” 15 U.S.C. § 1057(b). Because Defendants are seeking to cancel the Church’s registered marks, they have the burden of proving the marks are generic by a preponderance of the

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<sup>34</sup> *See also Glover v. Ampak, Inc.*, 74 F.3d 57, 59 (4th Cir. 1996) (“To become generic, the *primary* significance of the mark must be its indication of the nature or class of the product or service, rather than an indication of source.”).

evidence. *See Glover*, 74 F.3d at 59; *Retail Servs. v. Freebies Publ'g*, 364 F.3d 535, 542-43 (4th Cir. 2004).<sup>35</sup>

## 2. The anti-dissection rule

The Supreme Court has explained that “[t]he commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail.” *Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 545-46 (1920). This is called the “anti-dissection rule.” 2 McCarthy on Trademarks and Unfair Competition § 11:27 (2018). Courts within the Fourth Circuit have repeatedly recognized and applied this rule.<sup>36</sup>

The anti-dissection rule applies when assessing whether a term is generic. For example, in *Educational Tours, Inc. v. Hemisphere Travel, Inc.*, 2004 U.S. Dist. LEXIS 7113 (N.D. Ill. Apr. 26, 2004), the issue was whether “ET Educational Tours, Inc.” was generic. The defendants asserted that “Educational Tours”—part of the term at issue—was generic. The court stated that “whether the term ‘education tours’ is too generic by itself is not the proper question because it controverts the ‘anti-dissection rule.’” *Id.* at \*3-4. It added that “[u]nder this rule, trademarks composed of numerous parts must be evaluated as a whole, not term by term,”

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<sup>35</sup> The difficulty of meeting this burden is evidenced by the fact that one court within this Circuit has called the standard “clear and convincing evidence.” *Booking.com v. Matal*, 278 F. Supp. 3d 891, 902 (E.D. Va. 2017) (“The burden of proof rests with the party seeking to establish genericness, in this case the defendants, who must prove that the mark is generic by clear and convincing evidence”). That is the standard the PTO itself must show before declaring a mark generic. *See In re Cordua Rests., Inc.*, 823 F.3d 594, 600-01 (Fed. Cir. 2016).

<sup>36</sup> *See, e.g., United States v. Chong Lam*, 677 F.3d 190, 198 n.7 (4th Cir. 2012) (“The antidissection rule instructs that ‘[c]onflicting composite marks are to be compared by looking at them as a whole, rather than breaking the marks into their component parts for comparison.’”) (quoting McCarthy); *Choice Hotels Int’l, Inc. v. Zeal, LLC*, 135 F. Supp. 3d 451, 461-62 (D.S.C. 2015) (“the Court declines to break the marks into separate components for comparison”); *Cava Group, Inc. v. Mezeh-Annapolis, LLC*, 2016 U.S. Dist. LEXIS 87822, at \*22 (D. Md. July 7, 2016) (“[I]n evaluating the strength of a trademark, courts generally look at the mark as a whole, not at its individual components.”) (quotation omitted); *Timex Group USA, Inc. v. Focarino*, 2013 U.S. Dist. LEXIS 177835, at \*15 (E.D. Va. Dec. 17, 2013) (quoting *Beckwith*).

because “even though certain words may not individually be entitled to trademark protection, they may become a trademark when taken together.” *Id.* at \*3.<sup>37</sup>

This rule is critical, because Defendants have devoted considerable resources to showing that the word “Episcopal” has a particular meaning, and that other churches use the word “Episcopal” in their names. This is undisputed. It is also immaterial, however, since under the anti-dissection rule, the focus is on the mark THE EPISCOPAL CHURCH as a whole, not on whether particular terms therein are generic.

**B. There Are Multiple Threshold Legal Reasons Why THE EPISCOPAL CHURCH is Not Generic.**

In Section C below, we discuss the evidence showing that THE EPISCOPAL CHURCH is universally understood to identify The Episcopal Church itself, and not the services that the Church or any other organization provides. In this Section, we identify four independent, threshold reasons why THE EPISCOPAL CHURCH is not generic, even before the Court considers all of the record evidence.

**1. THE EPISCOPAL CHURCH is not generic because it is not the name of a religion.**

To assess whether the name of a religious organization is generic, courts undertake a straightforward inquiry: If the organization’s name is not the name of a religion, it is not

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<sup>37</sup> See also *Buffalo Wings Factory, Inc. v. Mohd*, 622 F. Supp. 2d 325, 333 (E.D. Va. 2007) (assessing whether BUFFALO WINGS FACTORY was generic; applied the “anti-dissection rule” and focused on the mark “as a whole,” not just “buffalo wings” or “factory”); *Frito-Lay N. Am., Inc. v. Princeton Vanguard, LLC*, 2017 TTAB LEXIS 300, at \*8-11 (Sept. 6, 2017) (question was the genericness of PRETZEL CRISPS; focus is on “the meaning of the applied-for mark ‘as a whole’”); *Skydive Ariz., Inc. v. Quattrocchi*, 2009 U.S. Dist. LEXIS 128418, at \*55 (D. Ariz. Feb. 2, 2009) (“To determine whether a term is generic, courts employ an anti-dissection rule, whereby the distinctiveness of a composite trademark is determined by viewing the trademark as a whole.”).

generic.<sup>38</sup> (The relevant case law is discussed in the Church’s accompanying Motion to Exclude the “Genericness” Expert Report of Hal Poret.) Here, it is undisputed that THE EPISCOPAL CHURCH is not the name of a religion. This is such an obvious point that the Court could take judicial notice of it. *See* Fed. R. Evid. 201(b). The evidence also confirms this conclusion,<sup>39</sup> and Defendants have not claimed or offered any evidence to the contrary. Under the all of the relevant authority, because THE EPISCOPAL CHURCH does not identify a religion, the mark is not generic.

**2. THE EPISCOPAL CHURCH is not generic because the Church’s use of that name does not prevent other groups from naming themselves.**

To assess genericness in the context of religious organizations, courts also examine whether the use of the term at issue prevents other such organizations from selecting an appropriate name for themselves. For example, in *Te-Ta-Ma Truth Foundation*, the Seventh

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<sup>38</sup> *See, e.g., Gen. Conf. Corp. v. McGill*, 617 F.3d 402, 413 (6th Cir. 2010) (“Seventh-Day Adventist” not generic because there was a lack of evidence “that the public considers ‘Seventh-day Adventist’ to refer generically to a religion”); *Te-Ta-Ma Truth Found.-Family of Uri v. World Church of the Creator*, 297 F.3d 662, 666 (7th Cir. 2002) (“Church of the Creator” not generic because it was not “the name for monotheistic religion—or any other genus of religion”); *Cnty. of Christ Copyright Corp v. Devon Park Restoration Branch of Jesus Christ’s Church*, 634 F.3d 1005, 1012 (8th Cir. 2011) (marks owned by the Reorganized Church of Jesus Christ of Latter Day Saints not generic because “there is no evidence that the RLDS marks identify a religion”; defendant “failed to meet its burden of presenting evidence that the primary significance of the marks was religion and not that of identifying the institutional source”); *Gen. Conf. Corp. of Seventh-Day Adventists v. Perez*, 97 F. Supp. 2d 1154, 1162 (S.D. Fla. 2000) (“Seventh-Day Adventist” not generic because it is “the name of the Plaintiff Church and not a religion”); *Christian Science Bd. of Dir. of the First Church of Christ v. Evans*, 520 A.2d 1347, 1352, 1356 (N.J. 1987) (“Christian Science” was generic because “Plaintiffs simply cannot appropriate, from the public domain, the common name of a religion,” whereas the organizational names “Church of Christ, Scientist” and “First Church of Christ, Scientist” were not generic).

<sup>39</sup> *See* Declaration of Margaret Rose at ¶ 3 and Attachment 1 (The Episcopal Church’s web site states that the Church is “part of the third largest group of Christians in the world”) (Exh. 89 hereto); Smith Decl. at ¶ 4 (The Episcopal Church is a Christian denomination) (Exh. 1); Expert Report of Mark Keegan at 15 (96% of respondents perceived THE EPISCOPAL CHURCH to be the name of an organization and only 4% perceived it to be the name of a religion) (Exh. 90).

Circuit found “Church of the Creator” not generic both because it was not the name of a religion, but also because

“using ‘Church of the Creator’ as a denominational name leaves ample options for other sects to distinguish themselves and achieve separate identities. It is not remotely like one firm appropriating the word ‘sandwich’ and thus disabling its rivals from explaining to consumers what’s to eat. ... Because there are so many ways to describe religious denominations, there is no risk that exclusive use of ‘Church of the Creator’ will appropriate a theology or exclude essential means of differentiating one set of beliefs from another.” 297 F.3d at 666-67.<sup>40</sup>

Here, Plaintiff-in-Intervention’s exclusive rights in THE EPISCOPAL CHURCH have not prevented other organizations—such as the United Episcopal Church, the Christian Episcopal Church, the Christian Methodist Episcopal Church, the Reformed Episcopal Church, the African Methodist Episcopal Zion Church, the Communication of Evangelical Episcopal Churches, and others—from naming themselves. Defendants deposed many of these organizations, which said they are each able to function and distinguish themselves without the need to call themselves “The Episcopal Church.” *See* Exhs. 85-88, 107-09. As a result, because the registration of THE EPISCOPAL CHURCH does not prevent any other church organization from naming itself and describing itself and its services, THE EPISCOPAL CHURCH is not generic.

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<sup>40</sup> *See also, e.g., Cmty. of Christ Copyright Corp.*, 634 F.3d at 1011 (“[Defendant] admitted that it could accurately describe its services without using [the Plaintiff’s] marks. Similar to other dissident churches, [Defendant] stated that it could use the term ‘Restoration’ ... instead of the [Plaintiff’s] marks. Thus [Defendant] has acknowledged that the [Plaintiff’s] marks have not become the exclusive descriptor of the services.”); *In re Am. Fertility Soc’y*, 188 F.3d 1341, 1347 (Fed. Cir. 1999) (“AMERICAN BAR ASSOCIATION is certainly an apt name for a national association of lawyers; however, it is not used as a generic name for national associations of lawyers (see, e.g., NATIONAL ASSOCIATION OF WOMEN LAWYERS; FEDERAL BAR ASSOCIATION; AMERICAN HEALTH LAWYERS ASSOCIATION; NATIONAL LAWYERS ASSOCIATION).”).

**3. THE EPISCOPAL CHURCH is not generic because that mark is not the name of the services that any church provides.**

There is no evidence that the services Plaintiff-in-Intervention offers, or that any other group offers, are called “The Episcopal Church.” This is a dispositive fact. As noted, a term is generic when it “becomes the generic name for the goods or services ... for which it is registered.” 15 U.S.C. § 1064(3). *See also H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 989-90 (Fed. Cir. 1986) (“The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question.”). Here, however, there is *no* evidence that THE EPISCOPAL CHURCH refers to a type of goods or services. No church says the services it provides (or goods it sells) are “The Episcopal Church.” For this basic reason, as a matter of law, the term cannot be generic. *See Glover v. Ampak, Inc.*, 74 F.3d 57, 59 (4th Cir. 1996).

Not only must Defendants show that THE EPISCOPAL CHURCH identifies goods or services, but they have to show that “the *primary* significance of the mark [is] its indication of the nature or class of the product or service, rather than an indication of sources.” *Glover*, 74 F.3d at 59.<sup>41</sup> There is zero evidence that the “primary significance” of THE EPISCOPAL CHURCH is as a reference to a type of goods or services. As a matter of law, therefore, the mark is not generic.

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<sup>41</sup> *See also Am. Fertility Soc’y*, 188 F.3d at 1347 (“the correct legal test for genericness, as set forth in *Marvin Ginn*, requires evidence of ‘the genus of goods or services at issue’ and the understanding by the general public that the mark refers primarily to ‘that genus of goods or services’”).

**4. THE EPISCOPAL CHURCH is not generic because no other organization in this country calls itself by that name.**

Finally, it is undisputed that other than Plaintiff-in-Intervention, no organization in this country calls itself “The Episcopal Church.” The Lawrence Diocese admitted this at its rule 30(b)(6) deposition:

“Q. Are you aware of any religious organization in the United States, other than the Plaintiff-in-Intervention in this case, that holds itself out as being called ‘The Episcopal Church’?”

A. Personally, no.”

Lawrence Diocese Dep. at 91:17-21 (Exh. 67). If there is only one user of the term in question, the term cannot be generic.<sup>42</sup> Here, because there is one user of THE EPISCOPAL CHURCH, the mark cannot be generic.

**C. A Substantial Record Shows That THE EPISCOPAL CHURCH is Not Generic as a Matter of Law Because the Mark Is Widely Understood to Refer Only to the Plaintiff-in-Intervention.**

Even if the Court looks past the threshold reasons why THE EPISCOPAL CHURCH is not generic, and instead scrutinizes the record evidence, that record is completely one-sided. It presents a compelling picture showing that THE EPISCOPAL CHURCH refers to the Plaintiff-in-Intervention, and not the services that it or any other organization offers.

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<sup>42</sup> See, e.g., *Penta Hotels, Ltd. v. Penta Tours*, 1988 U.S. Dist. LEXIS 15713, at \*62 (D. Conn. Sept. 30, 1988) (“Plaintiffs are the sole users of the mark [PENTA] in the hotel industry and with the exception of the defendants [the alleged infringers], there is no evidence that such mark is used by anyone else in the travel trade industry. Such mark is clearly not generic, nor does it describe the hotel services which plaintiffs provide to consumers.”). Indeed, even if there were a small number of other users of the term (which there are not), that would still support a finding that the mark is *not* generic. See, e.g., *Gen. Conf. Corp. of Seventh-Day Adventists v. McGill*, 624 F. Supp. 2d 883, 894 (W.D. Tenn. 2008) (“Seventh-day Adventist” not generic because “the fact that the Defendant can point to only two other splinter groups founded in the last century that bear the name supports the conclusion that members of the relevant public would generally associate the term with the churches affiliated with the General Conference”).



In this Circuit, to assess whether a term is generic, relevant evidence includes “purchaser testimony, consumer surveys, listings and dictionaries, trade journals, newspapers, and other publications.” *Glover*, 74 F.3d at 59. That evidence shows overwhelmingly that Defendants cannot meet their burden of proof of showing that THE EPISCOPAL CHURCH is generic.

Purchaser testimony. In this case, the “purchasers” of The Episcopal Church’s services are members or former members. There is substantial evidence showing that representatives of the Defendants themselves—who used to be members of the Church—call the Plaintiff-in-Intervention, and *only* the Plaintiff-in-Intervention, “The Episcopal Church.”

First and foremost is the evidence from the Lawrence Diocese itself, which testified that it has never referred to any organization other than the one led by Bishop Curry as “The Episcopal Church.” Lawrence Diocese Dep. at 29:20-30:2 (Exh. 67). When asked at its Rule 30(b)(6) deposition what “The Episcopal Church” is, the Lawrence Diocese responded: “That’s the current operating title and, I guess, legal title of the Protestant Episcopal Church, what was formerly PECUSA, now TEC.” *Id.* at 29:5-11. The Lawrence Diocese agreed that that is the organization now led by Presiding Bishop Curry. *See id.* at 29:12-14. This testimony is consistent with the Lawrence Diocese’s newsletters, which for years have used the terms “The Episcopal Church” in reference to the Plaintiff-in-Intervention. *Id.* at 30:5-46:13.<sup>43</sup> At no point

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<sup>43</sup> *See* Exh. 91 at 1 (Fall 2012 newsletter references “the Episcopal Church”); Exh. 92 at 1, 3 (“Legal Defense Fund Special Edition 2013” references “The Episcopal Church”); Exh. 93 at 1 (Spring 2013 newsletter references “The Episcopal Church”); Exh. 94 at 1 (Fall 2013 newsletter references “The Episcopal Church”); Exh. 95 at 1 (Spring 2014 newsletter references “The Episcopal Church”); Exh. 96 at 1 (Winter 2013 newsletter references “The Episcopal Church”); Exh. 97 at 1 (Summer/Fall 2014 newsletter references “The Episcopal Church”); Exh. 98 at 12 (Winter 2014 newsletter references “The Episcopal Church”); Exh. 99 at 2 (Summer 2015 newsletter references “The Episcopal Church”); Exh. 100 at 1 (Fall 2015 newsletter references “The Episcopal Church”); Exh. 101 at 1, 6 (Winter 2015 newsletter references “The Episcopal Church”); Exh. 102 at 1 (Spring/Summer 2016 newsletter references “The Episcopal Church”); Exh. 103 at 1 (Fall 2017 newsletter references “The Episcopal Church”); Exh. 104 at 8

after these newsletters were published did anyone ever tell the Lawrence Diocese they did not understand what the reference to “The Episcopal Church” meant. *Id.* at 46:14-21.

The Defendant parishes and missions provided similar testimony at their depositions, recognizing that THE EPISCOPAL CHURCH refers to the Plaintiff-in-Intervention.<sup>44</sup> None said that any organization other than the Plaintiff-in-Intervention calls itself “The Episcopal Church.”

In addition to Defendants’ own testimony, Defendants deposed the representatives of several churches that are not affiliated with The Episcopal Church, who also testified that THE EPISCOPAL CHURCH refers to the Plaintiff-in-Intervention.<sup>45</sup> In fact, when defense counsel asked the representative for the Christian Methodist Episcopal Church whether counsel could

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(Spring 2018 newsletter references “The Episcopal Church”); Exh. 105 at 1 (Fall 2018 newsletter references “The Episcopal Church”); Exh. 106 at 2 (June 2018 “Litigation Facts, Legal Update” references “The Episcopal Church”). (Underlining of relevant references added for the Court’s convenience.) *See generally* Lawrence Diocese Dep. at 30-46 (Exh. 67) (authenticating these documents).

<sup>44</sup> *See, e.g.*, Deposition of Laura Bowman at 24:21-25:10 (30(b)(6) deponent for Grace Parish: “Q. What’s The Episcopal Church? ... A. When I think of The Episcopal Church, I think of TEC. The Episcopal Church. Q. Is that the church led by Bishop Curry? A. Okay. That works, yes.”) (Exh. 19); Deposition of Fred Gough at 26:17-27:1 (30(b)(6) deponent for St. Barnabas: “Q. The next one is The Episcopal Church. Do you know what that is? A. Yes. Q. Is that the church led by Bishop Curry? A. Yes, I believe so. Yes.”) (Exh. 25); Deposition of J. Robert Horn, IV at 31:16-32:3 (30(b)(6) deponent for Holy Apostles: agreed that The Episcopal Church is “headquartered in New York City” and “Michael Curry would be the presiding bishop at that time”) (Exh. 40); Deposition of Arthur Mack Jenkins at 30:10-31:3 (30(b)(6) deponent for St. James Church on James Island: “The Episcopal Church began as The Protestant Episcopal Church of the United States of America. Then it became The Episcopal Church of the USA. Then it became TEC, The Episcopal Church.”; agrees that it is headquartered in New York and led by Bishop Curry) (Exh. 29).

<sup>45</sup> *See, e.g.*, Deposition of Walter Banek at 19:12-14, 32:24-33:11 (30(b)(6) deponent for the Reformed Episcopal Church: The Reformed Episcopal Church describes itself in detail on its web site so “people who have been members of The Episcopal Church or The Episcopal Church USA” can learn about the Reformed Episcopal Church) (Exh. 107); Deposition of Michael Moran at 11:10-12:5 (30(b)(6) deponent for the Southern Episcopal Church: Southern Episcopal Church has used that name since it “broke away from the Episcopal Church,” meaning “the Protestant Episcopal Church of the United States”) (Exh. 86); Deposition of John Garrett at 51:13-24 (30(b)(6) deponent for the Charismatic Episcopal Church of North America: familiar with “PECUSA, the Episcopal Church”) (Exh. 108).

refer to The Episcopal Church as “the National Episcopal Church,” the witness quickly corrected him: “I’ll understand that you’re not calling them who they say they are, yes, because they call themselves the Episcopal Church. And I would not want you to call us anything other than who we are.” Exh. 109 at 64:18-24.

Thus, among the Defendants as well as other church groups, it is universally understood that THE EPISCOPAL CHURCH refers only to the Plaintiff-in-Intervention.

Consumer surveys. There are two relevant consumer surveys in this case. Defendants have offered a survey conducted by Hal Poret. The reasons why Mr. Poret’s survey results are both irrelevant and unreliable are detailed in the accompanying Motion to Exclude the “Genericness” Expert Report of Hal Poret. These points include (1) that in this Circuit, consumer surveys are irrelevant for assessing whether terms that are not “coined” are generic, (2) the survey is irrelevant because Mr. Poret did not ask whether respondents perceived THE EPISCOPAL CHURCH to be the name of a religion, which, as noted above, is the pertinent inquiry in this context, (3) his results are within the margin of error and therefore not statistically significant, and (4) his survey modified the standard Teflon survey format in ways that are improper and no court has ever accepted. These issues represent such serious flaws in Mr. Poret’s survey that they require its outright exclusion under *Daubert*. Even if the report is not excluded, however, these same issues severely undermine the usefulness of the report for assessing genericness.

In any event, the Court should give little or no weight to Mr. Poret’s survey for two additional reasons. First, even if they were statistically significant (which they are not), Mr. Poret’s survey results—55.3% to 43.7% for his group of 300 respondents and 53.6% and 45.8% for his group of 166 Episcopalians—are so close that they do not help Defendants meet

their burden of proof. There is no precedent for finding genericness based on survey results this close, especially when the proper statistical error rate is applied to the results. Mr. Poret has “no idea” about the closest survey results he has seen to support a finding of genericness, but has never seen survey results as close as those he obtained for the group of 166 Episcopalians used to support such a finding. *See* Poret Dep. (Exh. 110) at 185:7-10, 203:9-204:8.

Second, Mr. Poret’s survey results for THE EPISCOPAL CHURCH, when compared to his results for THE CHRISTIAN CHURCH (a term he selected because he believed it was “generic”), are particularly telling. Only 6% of respondents said THE CHRISTIAN CHURCH was a trademark, whereas 43.7% and 45.8% of the respondent groups said THE EPISCOPAL CHURCH was a trademark. *See* Exh. 111 at 29, 31 (Poret report). This means that, notwithstanding all of the methodological flaws in the survey, *almost 40%* of respondents were able to differentiate between THE EPISCOPAL CHURCH and a generic church name.

In contrast with the Poret survey, which surveyed the wrong issue, the Church has offered a survey from Mark Keegan. *See* Exh. 90.<sup>46</sup> He surveyed the relevant question: whether THE EPISCOPAL CHURCH is perceived to be the name of a religion. 96% of respondents said THE EPISCOPAL CHURCH was the name of a religious organization and only 4% said it was the name of a religion. *Id.* at 15. These results show that consumers do not perceive THE EPISCOPAL CHURCH to be the name of a religion, and therefore that it is not generic.

Listings and dictionaries. All relevant evidence of this type indicates that THE EPISCOPAL CHURCH refers to the Plaintiff-in-Intervention, and not the services that it or any other organization offers. There are several relevant listings. The Anglican Communion’s web

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<sup>46</sup> Mr. Keegan’s survey was a rebuttal to Mr. Poret’s genericness survey. If the Court excludes Mr. Poret’s survey, then Mr. Keegan’s survey is moot, except to the extent the Court considers it relevant to showing that the public does not believe THE EPISCOPAL CHURCH is the name of a religion.

site lists its member churches, including “The Episcopal Church,” which links to Plaintiff-in-Intervention’s web site, describes the Church’s history, links to news stories about the Church, and links to the Church’s member dioceses. Rose Decl. at ¶ 4 and Attachment 2. The web site for the World Council of Churches also lists its member churches, including “The Episcopal Church,” which links to Plaintiff-in-Intervention’s web site. *Id.* at ¶ 5 and Attachment 3. The web site for the National Council of Churches also identifies “The Episcopal Church (USA)” as a member communion, and links to Plaintiff-in-Intervention’s web site. *Id.* at ¶ 6 and Attachment 4. Christian Churches Together has a web site that includes among its list of participant churches “The Episcopal Church,” which links to Plaintiff-in-Intervention’s web site. *Id.* at ¶ 7 and Attachment 5. And Churches Uniting in Christ also lists “The Episcopal Church” among its member communions, and, like all of the other organizations identified above, links to Plaintiff-in-Intervention’s web site. *Id.* at ¶ 8 and Attachment 6.

The dictionary entitled “An Episcopal Dictionary of the Church” includes a section on “The Episcopal Church,” which describes the Plaintiff-in-Intervention. Rose Decl. at ¶ 9 and Attachment 7.

Encyclopedias also refer to The Episcopal Church. The Academic American Encyclopedia entry for “Episcopal Church” describes the Plaintiff-in-Intervention and refers to it as “the Episcopal Church.” Declaration of Walter Edgar at ¶ 3 and Attachment 1 (Exh. 112 hereto). Collier’s Encyclopedia includes an entry for “Protestant Episcopal Church in the United States of America,” which discusses the Plaintiff-in-Intervention and refers to it as “the Episcopal Church.” *Id.* at ¶ 4 and Attachment 2. The Encyclopedia Americana and the World Book Encyclopedia include entries for “Episcopal Church” which discuss Plaintiff-in-Intervention and refer to it as “the Episcopal Church.” *Id.* at ¶¶ 5-6 and Attachments 3 and 4.

And the Wikipedia page for “Episcopal Church (United States)” begins by stating “The Episcopal Church (TEC) is the United States-based member church of the worldwide Anglican Communion,” and then proceeds to discuss the Church itself, noting that it is led by Bishop Curry. Rose Decl. at ¶ 10 and Attachment 8.

Newspapers. The newspaper articles referring to Plaintiff-in-Intervention as “The Episcopal Church” are voluminous. Several representative examples are sufficient for present purposes. For example, earlier this year, many media outlets reported on the sermon given by the Church’s Presiding Bishop Curry at the Royal Wedding in England, referring to the denomination he leads as “The Episcopal Church.”<sup>47</sup> And just this week, the media referred to Bishop Curry as “Presiding Bishop and Primate, The Episcopal Church,” in covering his participation in President George H.W. Bush’s funeral.<sup>48</sup> Many other newspaper articles also refer to the Plaintiff-in-Intervention as “The Episcopal Church.”<sup>49</sup>

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<sup>47</sup> See, e.g., Rose Decl. at ¶ 11 and Attachment 9 (article by The State (Columbia, SC) stating that Bishop Curry is “the head of the Episcopal Church”); *id.* at ¶ 12 and Attachment 10 (CNN article stating that Bishop Curry is the “leader of the Episcopal Church”); *id.* at ¶ 13 and Attachment 11 (Chicago Tribune article stating that Bishop Curry is “The Presiding Bishop and Primate of The Episcopal Church”); *id.* at ¶ 14 and Attachment 12 (Weekly Standard article stating that Bishop Curry is “The Episcopal Church’s first African-American leader”); *id.* at ¶ 15 and Attachment 13 (article from Ebony stating that Bishop Curry leads “the Episcopal Church”); *id.* at ¶ 16 and Attachment 14 (Washington Post article stating that Bishop Curry leads “the Episcopal Church in the United States”); *id.* at ¶ 17 and Attachment 15 (Time article stating that Bishop Curry leads “the Episcopal Church”); *id.* at ¶ 18 and Attachment 16 (Berkshire Eagle article describing Bishop Curry as “the primate of the Episcopal Church”).

<sup>48</sup> See <https://www.cnn.com/2018/12/05/politics/george-h-w-bush-funeral-program> (Exh. 114). See also <https://www.usatoday.com/story/news/politics/2018/12/05/bishop-michael-curry-bush-funeral/2214709002/> (“Bishop Michael Curry, the head of the Episcopal Church, was the presiding bishop at the funeral for former President George H.W. Bush.”) (Exh. 115).

<sup>49</sup> See, e.g., Rose Decl. at ¶ 19 and Attachment 17 (Atlanta Journal-Constitution article: Bishop Curry leads “the Episcopal Church”); *id.* at ¶ 20 and Attachment 18 (Associated Press article concerning state-court litigation referring to “The Episcopal Church”); *id.* at ¶ 21 and Attachment 19 (CNN article entitled “Episcopal Church Fast Facts,” providing information and timeline concerning Plaintiff-in-Intervention and referring to it as “The Episcopal Church”); *id.* at ¶ 22 and Attachment 20 (Fox News article reporting on “The Episcopal Church”); *id.* at ¶ 23

Other publications. Other sources confirm that THE EPISCOPAL CHURCH refers to only the Plaintiff-in-Intervention. This includes many internet sources. Dr. Walter Edgar conducted an internet search for the terms “The Episcopal Church” using both Google and Yahoo, and reviewed the first 20 pages of search results, amounting to over 200 results per search engine. His searches showed the following:

“Every citation referencing ‘The Episcopal Church’ in each search result was a reference to The Episcopal Church itself (the plaintiff-in-intervention in this case) or to a parish or diocese affiliated with the plaintiff-in-intervention. It appears from my search that the plaintiff-in-intervention is the only organization that commonly refers to itself as ‘The Episcopal Church.’” Exh. 113.

\* \* \* \* \*

Because the mark THE EPISCOPAL CHURCH refers to the Plaintiff-in-Intervention and not the services that it or any other church provides, as a matter of law this mark is not generic.

**D. The Other Marks That The Episcopal Church Owns Are Also Not Generic.**

Defendants’ counterclaims also assert that the marks THE PROTESTANT EPISCOPAL CHURCH IN THE UNITED STATES OF AMERICA, THE EPISCOPAL CHURCH WELCOMES YOU, LA IGLESIA EPISCOPAL (Spanish for The Episcopal Church), and the Episcopal shield are generic. *See* Dkt. No. 439 at ¶¶ 100-114. The counterclaims with respect to these marks arise out of the fact that most include the word “Episcopal.” These claims also fail as a matter of law, for many of the reasons detailed above.

First, to the extent Defendants assert that the marks are generic because they include the term “Episcopal,” this claim fails because it violates the anti-dissection rule. Under that rule, “[t]he commercial impression of a trade-mark is derived from it as a whole, not from its elements

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and Attachment 21 (New York Times letter to the editor for which the author was identified as an employee of “the Episcopal Church”).

separated and considered in detail.” *Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 545-46 (1920). *See also United States v. Chong Lam*, 677 F.3d 190, 198 n.7 (4th Cir. 2012); *Choice Hotels Int’l, Inc. v. Zeal, LLC*, 135 F. Supp. 3d 451, 461-62 (D.S.C. 2015). A mark is therefore not generic just because it includes the word “Episcopal.”

Second, Defendants have no evidence that any of these marks prevent Defendants or any other religious organizations from naming themselves or properly describing their services. The marks therefore cannot be generic. *See, e.g., Te-Ta-Ma Truth Foundation*, 297 F.3d at 666-67.

Third, Defendants have no evidence that these marks have “become[] the generic name for the goods or services ... for which [they are] registered,” which is the legal standard for genericness. 15 U.S.C. § 1064(3). *See also Glover*, 74 F.3d at 59. Because none of these marks identifies any goods or services, the marks are not generic.

Fourth, Defendants have no evidence that anyone other than the Plaintiff-in-Intervention is using any of these marks, which shows that they are not generic. *See Penta Hotels*, 1988 U.S. Dist. LEXIS 15713, at \*62.

Finally, there is no evidence in the record from users or former users of the services, listings, dictionaries, encyclopedias, trade journals, newspapers, or other publications showing that any of these marks identifies a type of goods or services rather than a particular source. Defendants also have not offered survey evidence concerning these marks. *See Exh. 110 (Poret Dep.)* at 255:7-22 (he did no survey as to these marks). Thus, Defendants do not have the evidence they would need to meet their burden of proof on genericness as to these marks.



**CONCLUSION**

The Court should grant The Episcopal Church summary judgment on its claims for trademark infringement and dilution, and dismiss Defendants' counterclaims.

Dated: December 7, 2018

Respectfully submitted,

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**CERTIFICATE OF SERVICE**

I hereby certify that the foregoing was served upon all counsel of record via the Court's ECF system on December 7, 2018.

/s/ Allan R. Holmes  
Allan R. Holmes