

**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

**OPPOSITION OF PLAINTIFFS AND PLAINTIFF-IN-INTERVENTION
TO DEFENDANTS’ “MOTION FOR SUMMARY
JUDGMENT – INVALIDITY DUE TO GENERICNESS”**

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INTRODUCTION

Defendants ask the Court to declare the mark THE EPISCOPAL CHURCH generic. *See* Dkt. No. 610-1. They make this claim even though THE EPISCOPAL CHURCH is universally recognized as the name of one of the oldest and most well-known religious denominations in the United States, and *no* other organization in the country calls itself by that name. Even the Defendants themselves refer to the Plaintiff-in-Intervention, and *only* the Plaintiff-in-Intervention, as “The Episcopal Church.” This is strong evidence that the mark identifies a single source, and therefore is not generic. Defendants’ Motion ignores this and all other evidence showing how THE EPISCOPAL CHURCH is used and understood, which is the relevant evidence for assessing genericness. The Court should therefore deny the Motion.

Because THE EPISCOPAL CHURCH is a federally registered mark, Defendants have the burden of proving genericness. *See Glover v. Ampak, Inc.*, 74 F.3d 57, 59 (4th Cir. 1996); *Retail Servs. v. Freebies Publ’g*, 364 F.3d 535, 542-43 (4th Cir. 2004). Despite having the burden of proof, Defendants ignore the relevant law and the relevant facts, in at least four crucial ways:

(1) Defendants ignore the legal test that courts typically apply to decide whether the name of a religious organization is generic. Courts have nearly universally found such names *not* generic if they do not identify the name of a “religion” and do not prevent other organizations from naming themselves. *See* Dkt. No. 595-1 at pp. 36-37 of 50 (Church brief citing authorities). Because THE EPISCOPAL CHURCH is not the name of a religion, and because the Church’s ownership of that name has not prevented other religious organizations from naming themselves, the mark is not generic.

(2) Defendants argue that THE EPISCOPAL CHURCH was void *ab initio*—that is, from the beginning—and therefore should be cancelled. But 15 U.S.C. § 1064 identifies the

grounds on which an incontestable federally registered mark can be cancelled, and this is not one of them. In any event, Defendants offer no evidence showing that the mark was void from its inception.

(3) On the question whether the Church's mark is *currently* generic, Defendants make virtually no argument addressing the mark that is actually at issue—THE EPISCOPAL CHURCH. Instead, they claim individual words in the mark are generic, which is irrelevant under the anti-dissection rule. *See* Dkt. No. 595-1 at pp. 35-36 of 50 (Church brief explaining rule).

(4) Defendants ignore most of the evidence that courts consider when assessing genericness, including *all* of the record evidence from dictionaries, encyclopedias, listings, newspapers, internet sources, and *the Defendants themselves* showing that, far from being generic, THE EPISCOPAL CHURCH identifies only one source: the Plaintiff-in-Intervention. *See* Dkt. No. 595-1 at pp. 40-48 of 50 (Church brief detailing this record). It is impossible for Defendants to meet their burden of proof, let alone obtain summary judgment, when they ignore all of the relevant evidence.¹

¹ Defendants cite to findings made by the Circuit Court in the corollary state case as though they remain standing even after that court's reversal by the South Carolina Supreme Court. *See* Dkt No. 610-1 at pp. 5-9 of 33. For example, they say, "TECSC was first organized in [sic] January 26, 2013," *id.* at 3, but, as the Church showed in its Opening Brief and its brief opposing Defendant's second motion for summary judgment, a majority of the South Carolina Supreme Court has expressly overruled that finding. *See* Dkt. No. 595-1 at pp. 13-15 of 50. In any event, as this brief demonstrates, even under Defendants' understanding of the continued viability of the state Circuit Court's factual findings, their genericness motion should be denied.

These defects and others discussed below show that Defendants cannot prove that THE EPISCOPAL CHURCH is generic as a matter of law. The Court should therefore deny Defendants' Motion.²

ARGUMENT

I. DEFENDANTS IGNORE THE CASE LAW CONCERNING GENERICNESS OF RELIGIOUS ORGANIZATION NAMES.

A. The Case Law Holds That a Mark is Generic if it Names a Religion and Not Generic if it Names a Religious Organization.

Defendants' Motion ignores the established line of authority from other federal Circuits finding that the name of a religious organization is generic only when the organization's name is also the name of a "religion." Dkt. No. 595-1 at p. of 36-37 of 50; Dkt. No. 586 at pp. 13-14 of 31. Although the Fourth Circuit has yet to address the issue, the Seventh Circuit Court of Appeals in particular has grappled with the question of how to apply the genericness standard in the context of religious organizations, where so many of the names of those organizations contain essentially descriptive terms. Thus, in *Te-Ta-Ma Truth Foundation-Family of Uri v. World Church of the Creator*, 297 F.3d 662, 666-67 (7th Cir. 2002), that Court said:

"In the contemporary United States, variations on 'Church of [Deity]' are used to differentiate individual denominations, not to denote the class of all religions. The list is considerable: Church of God; Church of God (Anderson, Indiana); First Church of God; Worldwide Church of God ...; Church of God in Christ; Assembly of God; Korean Assembly of God; Church of the Nazarene; Church of Christ; United Church of Christ; Disciples of Christ; Church of Christ, Scientist; Church of Jesus Christ of Latter Day Saints. There is room for extension with Church of Our Savior, Church of the Holy Spirit, Church of the Holy Trinity, Church of Jehovah, and so on. Yet all of these are recognizable as *denominational*

² Defendants' genericness counterclaims are not properly asserted against TECSC and its Bishops, but they nonetheless join the Church in filing this Opposition because Defendants' Motion is made against them as well. *See Informix Software, Inc. v. Oracle Corp.*, 927 F. Supp. 1283, 1286 (N.D. Cal. 1996) ("Thus, the Court finds that an exclusive licensee of a trademark is not a proper defendant in a suit for cancellation of that trademark. Indeed, the owner of the trademark is the only proper defendant.").

names, not as the designation of the religion to which the denominations belong. ...

“What is more, as these lists show, 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. When the line between generic and descriptive terms is indistinct ... it is helpful to ask whether one firm’s exclusive use of the phrase will prevent a rival from naming itself and describing its product. ... 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.” (Emphasis added.)

As the Church noted in its Opening Brief, most other Courts that have confronted the question of genericness in the context of religious organization names have similarly embraced the religion-versus-religious organization distinction.³ That case law, as we have shown, supports a finding that the mark THE EPISCOPAL CHURCH is not generic, because the mark names a religious organization, not a religion.

Defendants ignore the bulk of this precedent. They include only two pertinent cases in their brief, and rely on each erroneously. First, they cite (at 1) *Christian Science Board of Directors of First Church of Christ, Scientist v. Evans*, 520 A.2d 1347 (N.J. 1987), but fail to mention that in that case the court found “Christian Science Church” to be generic because

³ See Dkt. 595-1 at 30 n.38 (citing *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”); *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)).

“[p]laintiffs simply cannot appropriate, from the public domain, the common name of a religion,” while noting that the organizational names “Church of Christ, Scientist” and “First Church of Christ, Scientist” were *not* generic. *Id.* at 1352, 1356 (emphasis added).

Second, Defendants cite (at 10) *Universal Church, Inc. v. Universal Life Church*, 2017 U.S. Dist. LEXIS 127362 (S.D.N.Y. Aug. 8, 2017), *aff’d sub nom.*, *Universal Church, Inc. v. Toellner*, 2018 U.S. App. LEXIS 31153 (2d Cir. Nov. 2, 2018), for the proposition that “Universal Church” was generic because it signifies a “type” of church and did not indicate “particularly only the plaintiff.” Although that case did not apply the religion-versus-religious organization distinction, the District Court opinion seems to be the only decision concerning the name of a religious organization where the court did not assess whether the church’s name was the name of a religion. The Second Circuit’s decision did not say whether it agreed with that method of analysis, merely affirming due to the evidence that “Universal Church” “has been in generic usage over two millennia to describe the Church as a whole throughout the world.” 2018 U.S. App. LEXIS 31153, at *2-3. Whether the Second Circuit will in some later case embrace the religion-versus-religious organization distinction remains to be seen. In any event, *Universal Church* cannot possibly be read to mean that THE EPISCOPAL CHURCH is generic, since that court contrasted “Universal Church” with “The Episcopal Church,” which it said was “*far more distinctive.*” 2017 U.S. Dist. LEXIS 127362 at *23 & n.25 (emphasis added).

B. The Case Law Holds That a Religious Mark is Not Generic if Does Not Prevent Other Organizations From Naming Themselves.

This is a critical issue, and, again, Defendants ignore it. As the Church’s summary judgment brief explained, and as the Seventh Circuit explained in *Te-Ta-Ma*, the name of a religious organization is not generic if its ownership by one organization does not prevent other religious organizations from naming themselves. *See* Dkt. No. 595-1 at pp. 37-38 of 50.

Defendants are therefore wrong when they argue that because other church organizations use “Episcopal” or “Episcopal Church” in their names, that somehow means THE EPISCOPAL CHURCH is generic. In fact, the opposite is true. Plaintiff-in-Intervention’s exclusive use of the mark THE EPISCOPAL CHURCH has not prevented other church groups from naming and distinguishing themselves. Defendants deposed ten third-party churches, all of whom have been able to name themselves and identify their services without calling themselves or their services “The Episcopal Church.” As explained in *Te-Ta-Ma*, this shows that THE EPISCOPAL CHURCH is not generic.

This conclusion is consistent with the logic of many of the non-religious-organization cases Defendants cite, in which courts explained why generic terms are not entitled to trademark protection. For example, they cite (at 9 & n.9) *Retail Services v. Freebies Publishing*, 364 F.3d 535, 538 (4th Cir. 2004), for the proposition that protecting generic terms would make it “difficult for competitors to market their own brands of the same product. Imagine being forbidden to describe a Chevrolet as a ‘car’ or an ‘automobile’ because Ford or Chrysler or Volvo had trademarked these generic words.” Defendants also cite (at 10) *Universal Church* for the proposition that “trademark law is not intended to ‘create a monopoly’ over terms ‘necessary to describe a product [or service] characteristic.’” These statements support the conclusion that THE EPISCOPAL CHURCH is *not* generic. No other church organization needs to use THE EPISCOPAL CHURCH to accurately describe itself or its services. As a result, the mark is not generic.⁴

⁴ See also *Cnty. of Christ Copyright Corp. v. Devon Park Restoration Branch of Jesus Christ’s Church*, 634 F.3d 1005, 1011 (8th Cir. 2011) (name of religious organization not generic where challenger “could accurately describe its services without using [the] marks”); *In re Pennington Seed, Inc.*, 466 F.3d 1053, 1059 (Fed. Cir. 2006) (“the term ‘Rebel’ cannot be registered for grass seed because those in the trade ‘need to call it by the name that it is known or otherwise consumers will not know what they are buying’”).

II. GENERICNESS *AB INITIO* DOES NOT APPLY LEGALLY OR FACTUALLY.

Defendants argue (at 11-13) that “Episcopal” and “Episcopal Church” are generic *ab initio*, meaning they were generic when the Church started using the mark THE EPISCOPAL CHURCH. This argument fails both legally and factually.

A. As a Legal Matter, Genericness “*Ab Initio*” is Not a Basis for Cancelling an Incontestable Federally Registered Mark.

Under 15 U.S.C. § 1115(b), incontestable federal trademark registrations (such as those for THE EPISCOPAL CHURCH) 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.” This “conclusive evidence” of the validity of the registration is subject to a limited number of enumerated exceptions, including those set forth in 15 U.S.C. § 1115(b)(1)-(9), none of which concerns genericness, and certain exceptions set forth in 15 U.S.C. § 1064.

One exception under Section 1064 is where the mark “becomes the generic name for the goods or services, or a portion thereof, for which it is registered.” *Id.* § 1064(3). Under this statutory structure, an incontestable registration may be cancelled on genericness grounds only where it “becomes” generic. (By contrast, other grounds for cancellation set out in Section 1064 include that the mark “*is functional*” or “*has been abandoned.*”) Because the allegation that a mark was generic at the time it was first used by the registrant (i.e., genericness “*ab initio*”) is not one of the enumerated exceptions under Section 1064, such an argument is not a basis for cancelling an incontestable registration.

The Sixth Circuit rejected “*ab initio*” challenges to incontestable marks in *NetJets Inc. v. IntelliJet Grp., LLC*, 2017 U.S. App. LEXIS 2062 (6th Cir. Feb. 3, 2017). There, the defendant claimed the incontestable registered mark INTELLIJET was void *ab initio* because at the time it

was registered the mark was not actually being used by the party attempting to register the mark (with actual use being a requirement for registration). *See id.* at *2, 5. The court rejected this argument. *See id.* at *7-14. It first cited 15 U.S.C. § 1115(b)'s statement that an incontestable registration is "conclusive evidence of the validity of the registered mark." *Id.* at *8. Then it noted that the grounds for cancelling such a mark are limited to those set forth in 15 U.S.C. § 1064. *Id.* at *9. Because Section 1064 did not state that an incontestable registered mark may be cancelled on the ground that it was not actually in use when it was first registered, the court rejected the argument that the registration could be cancelled for being void *ab initio*. Other courts have applied *NetJets* in rejecting *ab initio* challenges to incontestable marks where Section 1064 did not otherwise specify the ground as one for cancellation.⁵

NetJets cites several other decisions that are instructive on this issue. It cites *Shakespeare Co. v. Silstar Corp. of America, Inc.*, 9 F.3d 1091 (4th Cir. 1993), where the court reversed the cancellation of an incontestable registration "on the grounds that [the mark was] functional, because that is not an authorized ground for cancellation under 15 U.S.C. § 1064."⁶ *Id.* at 1099. There is no reason to believe the Fourth Circuit would permit an incontestable

⁵ *See, e.g., Marketquest Grp., Inc. v. BIC Corp.*, 316 F. Supp. 3d 1234, 1292 (S.D. Cal. 2018) ("Void *ab initio* challenges are conspicuously absent from the list of statutory defenses to an incontestable registration under Section 1115(b). They are also absent from Section 1064, which means courts lack jurisdiction to cancel a registration under Section 1119 based on a void *ab initio* challenge."; citing *NetJets*); *Am. Cruise Lines, Inc. v. HMS Am. Queen Steamboat Co. LLC*, 2017 U.S. Dist. LEXIS 130430, at *40 (D. Del. Aug. 16, 2017) (alleged defect in chain of title not a basis for cancelling an incontestable registration because not enumerated in Section 1064, citing *NetJets*); *SPFM L.P. v. Midmark Corp.*, 2017 U.S. Dist. LEXIS 214130, at *22 (W.D. Tex. July 31, 2017) (rejecting claim that "a void registration could be cancelled at any time" because "§ 1064 limits basis for challenges to incontestable registrations," citing *NetJets*); *Spiral Direct, Inc. v. Basic Sports Apparel, Inc.*, 293 F. Supp. 3d 1334, 1372 (M.D. Fla. 2017) (applying *NetJets* and rejecting "void *ab initio*" challenge).

⁶ At the time of that decision, "is functional" was not a ground for cancellation under Section 1064; the statute was amended in 1998 to add it. *See Trademark Law Treaty Implementation Action*, PL 105-330, October 30, 1998, 112 Stat. 3064.

registration to be cancelled for being generic *ab initio*, which is not an authorized ground for cancellation under Section 1064, when it refused to cancel a mark for being functional because functionality was not at that time an enumerated defense in Section 1064.⁷ *NetJets* also cites *University of Kentucky v. Kentucky Gameday, LLC*, 2015 TTAB LEXIS 527 (TTAB 2015), where the Trademark Trial and Appeal Board refused to find an incontestable mark void because it was not being used when the application was filed because “[t]he nonuse claim ... is not enumerated under [Section 1064(3)] and is not available against a registration which is more than five years old.” *Id.* at *6. The same logic applies to Defendants’ genericness *ab initio* argument.

Even though Defendants ignore the statutory framework limiting the scope of the genericness defense, they cite two cases to support their genericness *ab initio* argument, neither of which addressed this issue. They cite *Schwan’s IP, LLC v. Kraft Pizza Co.*, 460 F.3d 971 (8th Cir 2006), where the court found “brick oven” to be generic. That court neither referred to the concept of genericness *ab initio* nor held that “brick oven” was generic for that reason. Further, the PTO had *refused* to register “brick oven.” *See id.* at 975. *Schwan’s* thus says nothing about whether an incontestable registration may be cancelled for being generic *ab initio*. That case is also distinguishable because the court found “brick oven” to be generic due to the evidence from “[c]ommentators and retailers” as well as “[n]ewspapers and restaurants” showing that “brick oven” pizza referred to a kind of pizza (that is, pizza cooked in a brick oven) and did not identify a particular source for that product. *Id.* Here, by contrast, all relevant evidence shows that THE EPISCOPAL CHURCH refers to a single source: the Plaintiff-in-Intervention.

⁷ The Church is aware of no case where either the Fourth Circuit or any District Court within this Circuit ever voided an incontestable federally registered mark because it was generic *ab initio*. The Court should not assume the Fourth Circuit would do so. *Cf. San Diego Comic Convention v. Dan Farr Prods.*, 2017 U.S. Dist. LEXIS 155681, at *24 (S.D. Cal. Sept. 22, 2017) (refusing to recognize a genericness *ab initio* defense where “the Ninth Circuit has not recognized a genericness *ab initio* theory of defense”).

Defendants also cite *Boston Duck Tours, LP v. Super Duck Tours, LLC*, 531 F.3d 1 (1st Cir. 2008), where the court found “duck tour” to be generic based on the record evidence from the media and other sources showing that the terms were used generically and that other companies used those terms. *See id.* at 19-20. This is quite different from the record concerning THE EPISCOPAL CHURCH, which shows no generic use of the mark and that the mark is used only by, and in reference to, the Plaintiff-in-Intervention. Defendants cite that case only for its statement that the use of “ordinary words” used according to their “ordinary meaning, and not distinctively,” are not protected by trademark law. *Id.* at 21-22. But this general statement says nothing about THE EPISCOPAL CHURCH, which is universally recognized as referring to only the Plaintiff-in-Intervention. *See* Dkt. No. 595-1 at pp. 40-48 of 50.

B. As a Factual Matter, Defendants Have Not Shown That the Mark THE EPISCOPAL CHURCH Was Generic *Ab Initio*.

Even putting aside the fact that genericness *ab initio* is not a basis for cancelling an incontestable registered mark, Defendants also have made no factual record showing that the mark in question—THE EPISCOPAL CHURCH—was generic when the Church began using that name.⁸ As their sole support for this argument, Defendants offer a quote from Dr. Grant Wacker, who discusses historical uses of the term “episcopal.” But that analysis says nothing about whether THE EPISCOPAL CHURCH was a generic term when the Church started using that name, because, as we explain more fully below, under the “anti-dissection rule” the alleged genericness of particular terms in a multi-word mark is irrelevant to whether the full mark is generic. *See* Dkt. No. 595-1 at pp. 35-36 of 50; Section III *infra*. Moreover, Defendants provide

⁸ Defendants contend this happened in 1967, when the Church formally adopted that name. *See* Dkt. No. 610-1 at p. 16 of 33. The Church used the name prior to then, leading to the name change. But for present purposes, it is immaterial whether the correct date is 1967 or some years before then.

no evidence that THE EPISCOPAL CHURCH was generic in or around 1967, when they contend the Church first started using that mark. As a result, even if this were a legitimate basis for cancelling an incontestable registered mark (which it is not), Defendants' argument fails because they have not made the necessary factual showing that THE EPISCOPAL CHURCH was generic *ab initio*.

III. DEFENDANTS' CLAIM THAT PARTICULAR WORDS IN THE MARK "THE EPISCOPAL CHURCH" ARE GENERIC VIOLATES THE ANTI-DISSECTION RULE.

Almost every argument Defendants make in an attempt to show that THE EPISCOPAL CHURCH is generic depends on first breaking down the mark into its constituent terms, and then arguing that each term in isolation is generic. But the Church's summary judgment brief explained that the anti-dissection rule requires the Court to assess whether a mark is generic by looking at the mark as a whole, not assessing the genericness of individual terms in the mark. See Dkt. No. 595-1 at pp. 35-36 of 50. Defendants' summary judgment brief concerning the Church's trademark-infringement claim in fact recognized that it is a "correct statement of the law" that "[t]he commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety.'" Dkt. No. 603 at p. 36 of 65 (citing and quoting *Estate of P.D. Beckwith, Inc. v. Comm'r of Patents*, 252 U.S. 538, 545-46 (1920)).

Defendants' only attempt to justify their contradictory position in this Motion—that the mark THE EPISCOPAL CHURCH should be dissected to determine whether it is generic—is their citation to *Hunt Masters, Inc. v. Landry's Seafood Restaurant, Inc.*, 240 F.3d 251 (4th Cir. 2001), which they claim says that "[c]ourts may consider the meaning of individual words in determining the meaning of the entire mark." Dkt. No. 610-1 at p. 16 of 33. But this is highly misleading characterization of what the court actually said. The court in *Hunt Masters* stated:

“In determining whether a mark is generic, *courts should not parse terms to determine that they are made up of generic components*. However, the principle that a mark must be considered as a whole to determine its validity does not preclude court from considering the meaning of individual words in determining the meaning of the entire mark.” 240 F.3d at 254 (emphasis added).

This is a statement of the anti-dissection rule, and it counsels *against* doing what Defendants claim the Court should do. To assess whether THE EPISCOPAL CHURCH is generic, the Court should *not* consider whether the individual terms that comprise the mark are generic. (It may, of course, consider what each term means to determine what the entire mark means.) This is why marks such as PIZZA HUT, AMERICAN AIRLINES, FEDERAL EXPRESS, KENTUCKY FRIED CHICKEN, and NATIONAL FOOTBALL LEAGUE are registered, protectable, and not generic, since even though the individual terms that make up the marks are generic or descriptive, the marks as a whole are not. There are also many examples of incontestable registered church names that are comprised only of generic or descriptive terms that alone would not be protectable, such as CHURCH OF GOD IN CHRIST (PTO Reg. No. 3260084), LIVING CHURCH OF GOD (PTO Reg. No. 2966965), CHRISTIAN CHURCHES OF GOD (PTO Reg. No. 2661694), and UNITED CHURCH OF GOD (PTO Reg. No. 2628455).⁹ The key point is that in assessing whether these marks, as well as the mark THE EPISCOPAL CHURCH, are generic, the analysis focuses on whether the mark as a whole is generic, not whether individual terms therein are generic. *Any other holding would open up these marks, and many others, to cancellation on genericness grounds.*

The result of Defendants’ misstatement of the anti-dissection rule is that their genericness argument is legally irrelevant. For example, they claim (at 1, 12-23) that “episcopal” and

⁹ See also *Te-Ta-Ma*, 297 F.3d at 666-67 (quoted above and identifying many other examples of protected church names comprised of only a series of generic or descriptive words).

“episcopal church” are not protectable because they are used by other entities. But the full mark at issue is THE EPISCOPAL CHURCH. To assess the alleged genericness of THE EPISCOPAL CHURCH, the Court must focus on the mark in its entirety, not whether individual terms therein are generic.¹⁰

IV. THE RECORD EVIDENCE SHOWS THAT “THE EPISCOPAL CHURCH” IS, AS A MATTER OF LAW, *NOT* GENERIC.

Although Defendants almost entirely ignore it, the large factual record in this case conclusively shows that THE EPISCOPAL CHURCH identifies a particular source (the Plaintiff-in-Intervention) and not a group of organizations or a type of services, and therefore that the mark is not generic.

As the Church’s summary judgment brief explained, the relevant evidence for assessing genericness includes “purchaser testimony, consumer surveys, listings and dictionaries, trade journals, newspapers, and other publications.” *Glover*, 74 F.3d at 59. This is because such evidence shows whether the primary significance of the mark is as a source identifier (and is not generic) or as the name of a type of goods or services (and is generic). *See id.* (“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.”). The record shows that the primary

¹⁰ Defendants claim (at 1) that “Plaintiffs assert they, and they alone, are entitled to exclusive right to [the] word” “episcopal.” This is not true. Many organizations that have never been affiliated with the Church use the word “episcopal” in their names, along with various modifiers distinguishing themselves from The Episcopal Church. The Church has not objected to the use of those names. It is a very different story, however, with respect to the Lawrence Diocese and the Lawrence Parishes, which claim to have separated from the Church but continue to use the names they used before the separation, including calling themselves “Episcopal” churches and claiming an affiliation with an “Episcopal” diocese led by an “Episcopal” bishop. As the Church’s motion for summary judgment explains, the use of the term “Episcopal” by those particular groups is likely to cause confusion and has in fact caused significant confusion. *See* Dkt. No. 595-1; *see also Purcell v. Summers*, 145 F.2d 979, 983 (4th Cir. 1944) (the actions by former members of a church who left but sought to keep the church’s name created confusion that “seems so clear ... as hardly to admit of argument”).

significance of THE EPISCOPAL CHURCH (and, in fact, the *exclusive* significance of the mark) is to identify the Plaintiff-in-Intervention, and therefore that the mark is not generic.

Purchaser testimony. Defendants' brief does not address the substantial evidence showing that both the Lawrence Diocese and the other Defendants use the terms "The Episcopal Church" to refer only to the Plaintiff-in-Intervention. *See* Dkt. No. 595-1 at pp. 41-42 of 50. They also ignore that the third-party churches they deposed also recognize that "The Episcopal Church" refers to the Plaintiff-in-Intervention. *See id.* at pp. 42-43 of 50. This evidence shows that THE EPISCOPAL CHURCH refers to a single source, not a type of goods or services.

Instead of confronting this evidence, Defendants claim the Church has used the terms "episcopal" and "Episcopal Church" generically. Dkt. No. 610-1 at pp. 18-19 of 33. Quite obviously, the Church uses the word "Episcopal" to describe various entities with which it is affiliated and programs it offers. But those uses of "Episcopal" say nothing about whether THE EPISCOPAL CHURCH is generic. Defendants do not identify a single example of the Church using that mark except as a reference to its own name.

Relatedly, Defendants claim (at 16-19) other church groups use "Episcopal Church" in their names. But, as discussed above, the fact that other groups have been able to name and distinguish themselves without calling themselves THE EPISCOPAL CHURCH shows that the mark is *not* generic. Nor is there any reason for the Church to seek to stop such third-party uses, since those groups do not call themselves THE EPISCOPAL CHURCH, and their use of the words "Episcopal Church" in longer church names that include various modifiers to signify that they are *not* affiliated with The Episcopal Church is not likely to create confusion.

Consumer surveys. Defendants claim their Motion is supported by survey evidence from Hal Poret. The Church's arguments as to why the Court should exclude that survey are explained in its Motion to Exclude the "Genericness" Expert Report of Hal Poret (Dkt. No. 586),

including that (a) it is irrelevant under *Hunt Masters* because THE EPISCOPAL CHURCH is not a coined term, (b) it is irrelevant because Mr. Poret did not survey whether THE EPISCOPAL CHURCH is perceived to be the name of a religion, (c) it is unreliable because the results are within the margin of error and therefore not statistically significant, and (d) it is unreliable because it uses a methodology that no court has ever accepted and even Mr. Poret cannot apply in this context. Additional reasons for giving the Poret survey no weight are explained in the Church's summary judgment brief. *See* Dkt. No. 595-1 at pp. 43-44 of 50.

As a rebuttal to Mr. Poret, the church submitted a survey from Mark Keegan. *See* Dkt. No. 597-2. Defendants claim the Court should ignore that survey, and have moved to exclude it. *See* Dkt. No. 597. The Church's response to that Motion is being filed this day. Without repeating that response unnecessarily, it should be noted that, unlike Mr. Poret's survey, Mr. Keegan surveyed the precise question that courts ask in this context: whether THE EPISCOPAL CHURCH is understood as identifying a religion or a religious organization. Mr. Keegan's survey found overwhelmingly that THE EPISCOPAL CHURCH is perceived as identifying a religious organization and not a religion, meaning the mark is not generic. The Court should consider that evidence when assessing whether THE EPISCOPAL CHURCH is generic.

Listings and dictionaries. All relevant church listings and dictionary and encyclopedia references to THE EPISCOPAL CHURCH state that this mark refers to the Plaintiff-in-Intervention. This includes church listings by the Anglican Communion, the World Council of Churches, the National Council of Churches, Christian Churches Together, and Churches Uniting in Christ. *See* Dkt. No. 595-1 at pp. 44-45 of 50. Further, "An Episcopal Dictionary of the Church," the Academic American Encyclopedia, Collier's Encyclopedia, the Encyclopedia Americana, the World Book Encyclopedia, and Wikipedia all refer to the Plaintiff-in-Intervention as "The Episcopal Church." *Id.*

Defendants brief cites no listing, dictionary, or encyclopedia that refers to any entity other than the Plaintiff-in-Intervention as “The Episcopal Church,” nor do such sources use that mark as a generic reference to any kind of church. Instead, Defendants cite (at 14-15) irrelevant references to the words “Church” or “Episcopal,” in violation of the anti-dissection rule.

Newspapers and other publications. The Church’s summary judgment brief identifies voluminous evidence from national newspapers referring to the Plaintiff-in-Intervention as “The Episcopal Church,” as well as the results of an internet search showing that all references to “The Episcopal Church” were references to Plaintiff-in-Intervention or one of its affiliated entities. *See* Dkt. No. 595-1 at pp. 46-47 of 50. Additional examples of such uses by major media sources have appeared even since the parties filed their initial briefs.¹¹ Defendants cite no evidence to the contrary. This is strong evidence that THE EPISCOPAL CHURCH refers to a single source, and is not generic.

All of this unanimous evidence viewed together shows that (a) Defendants cannot obtain summary judgment on their genericness counterclaims, and (b) the Court should grant summary judgment to the Church on this issue and dismiss Defendants’ counterclaims.¹²

Nor do the cases Defendants rely on suggest otherwise. Rather, upon close inspection, these cases counsel in favor of finding THE EPISCOPAL CHURCH *not* generic. They first cite (at 8) *Retail Services, Inc. v. Freebies Publishing*, 364 F.3d 535 (4th Cir. 2004), where the court

¹¹ *See, e.g.*, <https://www.cbsnews.com/news/bishop-michael-curry-on-the-real-message-of-christmas/>; <https://www.pbs.org/newshour/show/bishop-curry-on-love-poetry-and-the-royal-wedding>; <https://www.goodmorningamerica.com/news/video/religious-leaders-reflect-back-2018-60008308> (all visited Jan. 4, 2019).

¹² Defendants’ counterclaims also seek cancellation of the marks THE PROTESTANT EPISCOPAL CHURCH IN THE UNITED STATES OF AMERICA, THE EPISCOPAL CHURCH WELCOMES YOU, LA IGLESIA EPISCOPAL, and the Episcopal shield. Defendants have not sought summary judgment on their claim that those marks are generic. As set forth in the Church’s summary judgment brief, the Court should find, as a matter of law, that those marks are not generic. *See* Dkt. No. 595-1 at pp. 47-48 of 50.

found FREEBIES to be generic because the relevant evidence from dictionaries, the internet, and the mark's owner showed that the term was used generically to describe something that was free, and not as a reference to the mark owner's magazine. *See id.* at 544-46. Here, by contrast, the evidence is completely one-sided in the other direction, showing that THE EPISCOPAL CHURCH refers only to the Plaintiff-in-Intervention and is never used generically to refer to a type of services or a kind of church. *See* Dkt. No. 595-1 at pp. 40-47 of 50.

Second, Defendants cite (at 9-10) *Universal Church*, 2017 U.S. Dist. LEXIS 127362 (S.D.N.Y. Aug. 8, 2017), *aff'd sub nom.*, *Universal Church, Inc. v. Toellner*, 2018 U.S. App. LEXIS 31153 (2d Cir. Nov. 2, 2018), mentioned above. But, as noted, that case supports a finding that THE EPISCOPAL CHURCH is *not* generic, since that court stated that "The Episcopal Church" is "*far more distinctive*" than "Universal Church." 2017 U.S. Dist. LEXIS 127362 at *23 & n.25 (emphasis added). Defendants also ignore that that court found "virtually no evidence in the record that anyone in the relevant public, outside plaintiff's own members, understands 'Universal Church' as referring to plaintiff." *Id.* at *17. That is a stark contrast with this case, where the evidence shows that THE EPISCOPAL CHURCH is understood as referring only to the Plaintiff-in-Intervention. *See* Dkt No. 595-1 at pp. 40-47 of 50.

Third, Defendants cite (at 10-11) *Hunt Masters*, where the court found "crab house" generic. Although both sides owned trademark registrations incorporating that term, "both registrations disclaim[ed] protection for the term 'crab house' alone" (240 F.3d at 253), meaning there was no presumption of non-genericness for those words standing alone. By contrast, although the Church disclaimed the word "Church" in two of its registrations (*see* Dkt. No. 595-7, 595-9), it owns registrations for THE EPISCOPAL CHURCH, which is the mark at issue. As a result, the Church benefits from a presumption that its mark is *not* generic (Dkt. N. 595-1 at pp. 34-35 of 50), which the parties in *Hunt Masters* did not have. The court in *Hunt Masters* also

did not identify any evidence that the relevant public associated “crab house” with a particular source. That is, again, different from this case, where substantial record evidence shows that THE EPISCOPAL CHURCH refers only to the Plaintiff-in-Intervention. *See* Dkt. No. 595-1 at pp. 40-48 of 50.

Finally, Defendants cite (at 11) *Ale House Management v. Raleigh Ale House*, 205 F.3d 137 (4th Cir. 2000), where the court found “ale house” generic. In *Ale House* as well, the party claiming the exclusive right to use those words had not registered them, and therefore bore the burden of proving the words were not generic. *See id.* at 140. Here, Defendants have the burden of proving genericness because the Church’s mark is registered. Moreover, in *Ale House*, the party seeking the right to exclusively use “ale house” had “failed ... to present any evidence that ‘ale house’ does not refer to institutions that serve both food and beer,” whereas the party claiming genericness “presented extensive evidence, including citations to newspapers, dictionaries, books, and other publications, that the term ‘ale house’ is generic.” *Id.* at 140-41. Here, the opposite is true, since a unanimous record of listings, dictionaries, encyclopedias, newspapers, internet references, and uses by the Defendants themselves shows that THE EPISCOPAL CHURCH refers only to the Plaintiff-in-Intervention, and is therefore not generic.

The overwhelming evidence, and even Defendants’ case citations, thus favor a finding that THE EPISCOPAL CHURCH is *not* generic.

CONCLUSION

The Court should deny Defendants’ “Motion for Summary Judgment – Invalidity Due to Genericness.”

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Respectfully submitted,

/s/ Allan R. Holmes

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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 January 11, 2019.

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