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EXAMINING THE OUTER-LIMITS OF TRADEMARK LAW IN THE RELIGIOUS CONTEXT AND A POTENTIAL IMPLICIT BIAS FOR NON-SECULAR LITIGANTS: ELLER V. INTELLECTUAL RESERVE, INC.

I. INTRODUCTION

What sorts of words, names, and symbols generally come to mind when you hear the word “trademark?” Coca-Cola, the Nike Swoosh, the iconic Mercedes-Benz three-point star and Mr. Peanut, just to name a few. How about the Star of David? The crucifix? The word “Catholic,” or an image of the Vatican? What about the Islamic Star and Crescent or a picture of the Buddha? Typically, these words and symbols are not the first to enter your mind when you think about trademarks. Despite any initial misgivings these devices are, in theory, eligible for trademark protection. As source identifiers, these images, symbols, and words may signify where they come from and who produces them: the religious organization with which they are affiliated.

Can religious organizations own valid trademarks in commonly used and recognized devices? At what point does the exclusive use of such terms by such religious organization pass the outer-limits of protection afforded to religious marks and become not protectable? Do the courts that are responsible for fairly applying the law as it stands to all litigants, evenhandedly apply trademark law to secular as well as non-secular parties? Or is there a more cautious attitude present within certain circuits in regards to the evidentiary burdens such circuits are willing to place on religious organizations in the trademark context?

Eller v. Intellectual Reserve raises these issues and provides a looking glass through which to analyze the outer-limits of trademark law as applied in a religious context. Eller pits a small business owner in his attempts to bring together people of the Mormon faith against the corporate entity responsible for the intellectual property holdings of the Church of Jesus Christ of Latter-day
Saints (hereinafter "Mormon Church"). Eller touches on important issues surrounding the role of trademark law as it relates to religious words and symbols. Additionally, Eller brings issues of the boundaries and outer-limits of trademark law in the religious context to the forefront. This article uses Eller as a guide for analytic discussion of trademark law in the religious context; further, it will examine whether there is a tendency among certain courts to lessen evidentiary burdens for non-secular trademark litigants.

Section II of this article discusses the background in this realm of case law examining trademark in the religious context, beginning with the Lanham Act, the federal statute governing trademark law; it will then look at the qualifications a mark must meet to become federally registerable, including the issue of becoming certain types of trademarks becoming generic. Section III provides a brief discussion of the facts and procedural history of Eller. Section IV analyzes the future implications of cases such as Eller and the potential ramifications if the boundaries and outer-limits are pushed to these lengths. Section V concludes the article by summing up the outer-limits of trademark law as they stand today, and urge that public policy calls for a more conservative outer-limit of trademark law in this context and a more fair treatment for secular and non-secular litigants.

I. PROCEDURAL BACKGROUND

A mark performs a trademark function when the mark distinguishes a producer’s goods or products from other goods and services in the marketplace, and in order for a word, name, symbol, or other device to become (and remain) a valid trademark, the mark must perform and continue to perform such a function. When determining whether a mark performs a trademark function for typical consumer goods, it is often a relatively simple question to answer. Does the word, name, symbol, or device signal to the consumer that the red, cursive text and distinctive bottle are distinguishing

2. For example, when a consumer sees the Coca-Cola trademark, that consumer knows that the red, cursive text and distinctive bottle are distinguishing
consumer who is the producer of the goods? Think back to the examples listed in the introduction; each of those marks tells potential consumers where these products come from. However, when the goods or services enter the realm of the atypical, such as a religious mark, the answer to this question is not so black and white. It may be more difficult for the courts to ascertain whether a mark is actually performing a trademark function, as required by the Lanham Act.

A. The Lanham Act

Federal trademark law is governed by the Lanham Act (hereinafter “Act”). Section 45 of the Act defines a trademark as “any word, name, symbol, or device, or any combination thereof” used or intended to be used in commerce as a way to identify and distinguish goods of one producer of such goods from those manufactured, sold or produced by others, and to indicate the source of such goods. The Act provides a means of protection for the lawful owners of valid and federally registered marks against potential wrongdoers or infringers. It facilitates this protection by prohibiting infringing activity and providing private causes of action to aggrieved trademark owners against any potential infringers. A holder of a federally registered trademark may institute a suit for infringement against any person who uses any word, term, symbol,

this brand of soft drink from others in the market. The consumer knows that the product found in this glass bottle is, in fact, Coca-Cola, and is signaled to this fact by the product’s distinctive trademarks.

4. Id. § 1127.
5. Id. at § 1125(a)(1). The Act also provides a cause of action for trademark dilution. It specifically defines two types of trademark dilution: dilution by blurring and dilution by tarnishment. Id. § 1125(c). Dilution by blurring is association of marks arising from the similarity between the mark and a famous mark that lessens the distinctiveness of the famous mark. Id. § 1125(c)(2)(B). The Act enumerates several factors that the court may consider when assessing whether dilution by blurring. Id. On the other hand, dilution by tarnishment is association between marks arising from the similarity between two marks that harms or otherwise damages the reputation of the famous mark. Id. § 1125(c)(2)(C). However, this article will only focus on the cause of action for trademark infringement and as such, a further discussion of dilution is not necessary.
device, or any combination thereof in connection with goods and services and in commerce which is "likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection" as to the origin or source of the goods.\(^6\)

In order for a plaintiff to be successful in a trademark infringement claim, the plaintiff must demonstrate 1) that it owns a valid mark that was entitled to protection under the Act, and 2) that the defendant used a mark in commerce that was likely to cause confusion among the consuming public as to the source or origin of the defendant's mark.\(^7\) In assessing whether the defendant's use of the mark is likely to cause confusion as to source or origin the court analyzes the circumstances surrounding the alleged infringement using a series of factors articulated by the reigning Circuit Court of the applicable jurisdiction.\(^8\) For example, the Fifth Circuit Court of Appeals applies the *Roto-Rooter* Factors to assess this likelihood.\(^9\) Under the *Roto-Rooter* Factors, likelihood of confusion is assessed by examining the following factors: 1) the type of trademark at issue, 2) similarity of the marks, 3) similarity of the product(s), 4) identity of retail outlets and purchasers, 5) type of advertising used, 6) defendant's intent, and 7) actual confu-

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6. *Id.* at § 1125(a)(1)(A).

7. *Id.* See also Gov't Emps. Ins. Co. v. Google, Inc., 330 F. Supp. 2d 700, 702 (E.D. Va. 2004) (holding that a plaintiff alleging a cause of action for trademark infringement must demonstrate that 1) it possesses a mark, 2) the defendant used a mark, 3) defendant's use of the mark occurred in commerce, 4) the defendant used the mark in connection with sale, offering for sale, distribution, or advertising of goods and services, and 5) the manner in which the defendant used the mark is likely to confuse customers); CNA Fin. Corp. v. Brown, 922 F. Supp. 567, 572 (M.D. Fla. 1996) (holding that a plaintiff has established a prima facie case of service mark infringement when it has proven that 1) defendant used a term in commerce, 2) in connection with their services, 3) which is likely to cause confusion with 4) service marks rightfully owned and used by plaintiff in connection with its services).


9. Roto-Rooter Corp. v. O'Neal, 513 F.2d 44 (5th Cir. 1975). *Eller* would have been heard in the 5th Circuit's jurisdiction had it proceeded to trial and later appeal.
The court in *Roto-Rooter* emphasized that proof of actual confusion is not necessary for a finding of likelihood of confusion, but views the factor of actual confusion as the most important in assessing the likelihood of confusion.  

**B. Genericism**

A generic term is one that refers to a product category in which the particular product the mark purports to describe may be classified, and is therefore not distinctive in the trademark sense of the word.  

12. A mark may be deemed generic when the primary significance of the term in the minds of the consuming public is the *product*, not the *producer*.  

13. In order to receive trademark protection, a mark must be distinctive, that is, it must perform a trademark function in that it distinguishes a producer’s goods and services from other goods in the market place.  

14. A mark that is generic receives no protection because it serves no trademark function.  

A common test for determining whether a mark is generic, and therefore ineligible for trademark protection, is the “Who Are You-What Are You?” Test, derived from McCarthy’s treatise and

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10. *Id.* at 45. Although not specifically articulated in the *Roto-Rooter* case, courts following the 5th Circuit *Roto-Rooter* test typically assess an eighth factor, level of consumer sophistication, when determining whether a likelihood of confusion exists. *See e.g.* Xtreme Lashes, LLC v. Xtended Beauty, Inc., 576 F.3d 221 (5th Cir. 2009) (Where the court held that the similarity between two different eyelash extension marks were substantially similar enough to confuse the sophisticated consumer).


13. *Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 120 (1938); *see also* Liquid Controls Corp. v. Liquid Controls Corp., 802 F.2d 934, 936 (7th Cir. 1986) (a trademark is supposed to identify the source of a product, whereas a generic term “merely specifies the genus of which the particular product is a species.”); *McCarthy*, *supra* note 8, (noting that a generic name of a product can never function as a trademark in that it does not indicate origin; the terms trademark and generic are mutually exclusive).


adopted by numerous courts.\textsuperscript{16} When a consumer asks the questions “Who are you? Where do you come from? Who made you? Who vouches for you?” a mark is able to answer these questions because it is performing a trademark function; identifying the origin or the source of the goods.\textsuperscript{17} A generic term answers the question “What are you?” because a generic term is simply the name of a product category, and fails to denote the origin of the goods.\textsuperscript{18} As a final note, a federally registered trademark may be cancelled at any time on the basis that it has become generic, based on the reasoning that it is no longer performing a trademark function.\textsuperscript{19}

\textit{C. Development of Genericism and Likelihood of Confusion in the Federal Courts}

In order to fully grasp the issues and potential outcomes of \textit{Eller}, as well as the treatment of a religious trademark, it is essential to examine the relevant case law in the trademark context, focusing on cases in which courts determined either 1) whether or not a religious trademark had fallen prey to genericism, or 2) whether a defendant’s use of the plaintiff’s religious trademark was likely to cause confusion.

\textit{1. Generic Mark Analysis in the Religious Context}

There have been several cases in the federal district courts as well as in the Circuit Courts of Appeals that addressed the issue of genericism regarding trademarks owned by religious organiza-

\begin{itemize}
  \item \textsuperscript{16} \textsuperscript{16} MCCARTHY, supra note 8.
  \item \textsuperscript{17} \textit{Id}.
  \item \textsuperscript{18} \textit{Id}.
  \item \textsuperscript{19} § 1064 (3) (A term that is generic does not perform a trademark function because it no longer signals to the consumer the source of that product; instead, it merely describes the product category in which the product belongs.) see e.g., Serv. Merch. Co. v. Serv. Jewelry Stores, Inc., 737 F. Supp. 983, 998 (S.D. Tex. 1990); Park N’Fly, supra note 12.
\end{itemize}
Whether the religious trademarks are found to be generic or not is largely dependent on the facts of the case.

a. General Conference Corp. of Seventh-Day Adventists v. McGill

In General Conference Corp. of Seventh-Day Adventists v. McGill, the court held that the defendant had failed to establish that the mark "SEVENTH-DAY ADVENTIST," was not generic, and therefore protectable under the Lanham Act. In assessing whether the marks were generic, the court applied a variation of the classic test for genericism: "whether the public perceives the term primarily as the designation of the article." In the religious context of McGill, the court ultimately held that the test to be applied to generic religious marks was whether the general consum-

20. See General Conference Corp. of Seventh-Day Adventists v. McGill, 617 F.3d 402 (6th Cir. 2010); General Conference Corp. of Seventh-Day Adventists v. Seventh-Day Adventist Congregational Church, 887 F.2d 228 (9th Cir. 1989); Urantia Found. v. Maaherra, 895 F. Supp. 1338 (D. Az. 1995) (holding that the religious organization's trademark was not generic); Christian Science Bd. of Dir. of the First Church of Christ, Scientist v. Evans, 520 A.2d 1347 (N.J. 1987).

21. McGill, 617 F. 3d at 415. The defendant in McGill was accused of infringing the plaintiff's trademark based on his use of their purported mark SEVENTH-DAY ADVENTIST in connection with advertising and other promotions of his church, which were not affiliated with plaintiff's church. Id. at 404. The plaintiff had federally registered trademarks in the marks "Seventh-day Adventist," "Adventist," and "General Conference of Seventh-day Adventists." Id. at 405. The defendant had originally been a member of the plaintiff's church but had separated himself from the church due to theological differences, and formed his own church, which he called "A Creation Seventh Day & Adventist Church." Id.

22. Id. at 416. The defendant also referred to his church as the "Creation Seventh Day Adventist Church" in the complaint. Id. at 405. The defendant used the SEVENTH DAY ADVENTIST mark on several advertisement and promotional materials in connection with his nonaligned church, as well as incorporates the mark into several domain names associated with his church. Id. at 405-06.
ing public associates the contested mark with the religious beliefs practiced by the church, or with the church itself.\(^{23}\)

In examining these marks, the district court ruled that the trademarks had become incontestable\(^{24}\) and were presumed valid as a result.\(^{25}\) When the defendant challenged the marks on the basis that they had become generic, defendant now had the burden of proving genericism, and barring trademark protection.\(^{26}\) Ultimately the McGill court found that the defendant failed to meet this burden.\(^{27}\)

The court found that evidence provided by the defendant was not sufficient to demonstrate that the plaintiff's marks were generic.\(^{28}\) In its opinion, the court found that the plaintiff's marks were not generic because the defendant failed to demonstrate that the general public identified the mark SEVENTH DAY ADVENTIST

\(^{23}\) Id. at 415 (quoting Bath & Body Works, Inc. v. Luzier Personalized Cosmetics, Inc., 76 F.3d 743, 748 (6th Cir. 1996)). In arguing for the marks to be deemed generic, the defendant asserted that the term "Seventh-day Adventist" described a religion, and provided the following evidence to support his assertions: 1) testimony from himself and a theology graduate student, 2) a dictionary definition, 3) an entry from Wikipedia, 4) evidence of the plaintiffs using "Seventh-day Adventist" as a noun rather than an adjective, and 5) evidence of two additional "breakaway" churches using the term "Seventh-day Adventist" in the names of their congregations. Id. at 415-16.

\(^{24}\) See 15 U.S.C. § 1065(4) (2012) ("no incontestable right shall be acquired in a mark which is the generic name for the goods or services or a portion thereof, for which it is registered.").

\(^{25}\) McGill, 617 F.3d at 406.

\(^{26}\) Id.

\(^{27}\) Id. at 415.

\(^{28}\) Id. at 416. The court noted that the existence of other "breakaway" churches using the mark did not help the defendant because this evidence supported the conclusion that the public would associate the term "Seventh-day Adventist" with churches affiliated with the plaintiff's church, the exact opposite of the proposition that the defendant was tasked with proving. Id. The court also reasoned that the testimony offered by defendant and the graduate student was not an accurate representation of the public's view, that the dictionary and Wikipedia entries referenced the term "Adventist" and not "Seventh-day Adventist," and that the noun/adjective distinction was more applicable to an analysis regarding the descriptiveness of a mark (which is not grounds to challenge an incontestable mark), rather than an analysis of the generic nature of a mark. Id.
as referring to certain religious beliefs, rather than the church itself.\(^29\)

*McGill* holds the position that for a religious trademark to be generic, the party with the burden of proving genericism must demonstrate that the public views the mark as reference to the body of religious beliefs, rather than the specific church that touts these religious beliefs.\(^30\) The test articulated in *McGill* appears to be the court's interpretation of the traditional definition of a generic mark as specifically applied to the religious context; i.e. a mark is generic if the consumer views the mark as identifying a particular kind of goods (a *product*) as opposed to being the *producer* of said goods.\(^31\) In *McGill*, and in the broader religious context, the "goods" are the religious beliefs, teachings, ideologies and the like that are spread by the "source," (the religious organization). Therefore, if the consumer sees the mark and identifies it with the religious beliefs, that mark is generic; on the other hand, if the mark is associated with the religious organization itself, the mark has not become generic.

b. *General Conference Corp. of Seventh-Day Adventists v. Seventh-Day Adventists Congregational Church*

A case heard in the Ninth Circuit, *General Conference Corp. of Seventh-Day Adventists v. Seventh-Day Adventists Congregational Church*, applied a similar test to the one articulated in *McGill*.\(^32\) The plaintiff in *General Conference* sued for trademark infringe-

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29. *Id.*

30. *See id.* When a mark has been registered with the United States Patent and Trademark Office, the defendant in an infringement action has the burden of proving that the mark is generic because the trademark has a presumption of validity. Reese Pub. Co., Inc. v. Hampton Intern. Commc’ns, 620 F.2d 7, 11 (2d Cir. 1980). However, when the trademark has not been federal registered, the plaintiff bears this burden of proving that its mark is not generic, due to the absence of the presumption of validity. *Id.*

31. Liquid Controls Corp. v. Liquid Controls Corp., 802 F.2d 934, 936 (7th Cir. 1986). ("A generic term is one that is commonly used as the name of a kind of goods.")

32. Gen. Conference Corp. of Seventh-Day Adventists v. Seventh-Day Adventists Congregational Church, 887 F.2d 228 (9th Cir. 1989).
ment, alleging that the defendant had used the plaintiff's mark SEVENTH DAY ADVENTIST to describe its church. The defendant again asserted the defense of genericism. As in McGill, the defendant argued that the mark was generic because it referred to the set of Christian beliefs, doctrines and standards, rather than plaintiff's church. The court did not rule on the merits of whether the mark was generic, but held that the defendant had properly pled the affirmative defense in its answer, as to preclude a judgment on the pleadings.

c. Christian Science Board of Directors of the First Church of Christ, Scientist v. Evans

In Christian Science Board of Directors of the First Church of Christ, Scientist v. Evans, the Supreme Court of New Jersey found that the names “Christian Science” or “Christian Science Church” were generic and therefore not protectable as trademarks. In arriving at this decision, they took a different approach than the McGill court.

In Evans, the plaintiff was the First Church of Christ, Scientist (referred to as the “Mother Church” by the court) of the Christian Science faith, a religion founded by Mary Baker Eddy in the 19th century. The defendants were trustees of a church that was at one time a branch of the Mother Church and therefore affiliated with

33. Id. at 229.
34. Id. at 231.
35. Id.
36. Id. The court in General Conference reviewed de novo a judgment on the pleadings, and held that judgment was not proper because defendants had properly pled the affirmative defense of genericism in its answer. Id. Therefore, judgment on the pleadings was improper. Id.
38. Id. at 1349. The court explained the organizational structure of the faith as follows: The Mother Church is the center of the international Christian Science community and is therefore given the formal name of the First Church of Christ, Scientist. Id. Local branches of the church are smaller in size than the Mother Church and are designated as “First Church of Christ, Scientist,” followed by a geographic description or other indication. Id.
the plaintiff. The defendants, however, continued to use the phrase “Christian Science” in connection with its organization after the split, spurring the trademark infringement claim that was the crux of this case. The Supreme Court of New Jersey held that the terms in which the plaintiffs were attempting to secure trademark rights and enforcement were generic and therefore not protectable.

In an interesting take on the issue presented, the court was careful to point out that the religion of Christian Science was founded at least a decade before the Mother Church was founded. This careful distinction emphasized the fact that the religion and its organization (The Mother Church) are conceptually separate and that the religion was in existence before the organization.

The court highlighted two essential policy reasons for its decision. First, the court reasoned because the term “Christian Science” is the name of a religion, anyone practicing “Christian Science” should be permitted to use the term “Christian Science in connection with the name of a Church, and those not practicing the religion should not be permitted to use the term in connection with their religious organization or church.” Secondly, the court extrapolated that because the defendant is practicing the Christian Science Religion, it should be permitted to use the term in connection with the name of its church. The court noted that the plaintiffs did not have the law on their side in their attempts to prohibit the defendants from using the term “Christian Science” in connection with their church, since term has become the common—and

39. Id. Years after the defendant’s branch was officially authorized as a branch of the Mother Church, a theological schism occurred and the Mother Church withdrew its “recognition” of the defendant’s organization as an official branch of the Mother Church, and ordered the defendants to cease using the name “Christian Science” in connection with its organization. Id.

40. Id.

41. Id. at 1357.

42. Evans, 520 A.2d at 1349. The court noted that these facts were essential to its reasoning in the case. Id.

43. Id.

44. Id.
therefore generic—term used to describe any religion following the teachings of Mary Baker Eddy.45

The court went on to say that just because the plaintiff’s use of the term has been relatively exclusive and unchallenged for a substantial amount of time, it does not lend weight to the argument that the plaintiffs should be granted exclusive rights as to use of the term; to do so would be against the fundamental objectives of trademark law.46 The court also stressed that it must protect against monopolies in generic terms in the religious products context just as much, if not more, as in the commercial products and services cases, highlighting the importance of this realm of cases and the policy concerns implicated in each of these religious trademark cases.47

2. “Likelihood of Confusion” and the Religious Context

Treatment of likelihood of confusion has also varied among the circuit courts, as demonstrated by Jews For Jesus v. Brodsky and Lamparello v. Falwell. Both cases have somewhat analogous facts, but produced diametrically opposed results, perhaps turning on the content of the alleged infringer’s materials.

45. Id. at 1352 (citingPrimal Feeling Center of New England, Inc. v. Janov, 201 U.S.P.Q. (BNA) 44 (T.T.A.B. 1978). Holding that the plaintiff’s asserted trademark in “Primal Therapy,” a type of therapy that he had created as well as named, was invalid, due to the fact that it was impossible to describe the therapy without using the name “Primal Therapy.” Id. at 50. Therefore, the TTAB concluded that those individuals providing the therapy piloted by Dr. Janov had the right to use the name “Primal Therapy” in conjunction with their services. Id. at 56.)

46. Evans, 520 A.2d at 1352. The court opined that the plaintiffs were essentially attempting to remove a term from the public domain and gain exclusive use as their own. Id. at 1352.

47. Id. at 1355.
a. Jews for Jesus v. Brodsky

In *Jews for Jesus v. Brodsky*, the plaintiff was a non-profit outreach ministry that was founded in 1973. The plaintiff claimed that it held a common law service mark in “Jews for Jesus” based on its continuous use of the mark in commerce for a substantial amount of time, as well as the service mark “Jews for Jesus”, with the “O” of the word “for” being replaced with a stylized Star of David. The plaintiff claimed that the widespread use of its name and marks had gained the mark significant recognition and that the public recognized its name and marks as identifying the plaintiff’s religious organization and its associated mission and beliefs. The plaintiff also secured a domain name of “jews-for-jesus.org” in order to promote its religious organization.

The plaintiff sued a professional website developer and vocal critic of the plaintiff’s organization, for a violation of their trademark rights pursuant to the Lanham Act. At issue in the suit was

48. Jews For Jesus v. Brodsky, 993 F. Supp. 282, 288 (D.N.J. 1998). The founders of the Jews for Jesus ministry founded their religious organization on the belief that Jesus is the “Messiah of Israel” and the “savior of the World,” and promoted this idea through education and religious camaraderie directed towards Jews and non-Jews alike. *Id.* The court emphasized that the plaintiff’s organization employs 145 staff members, has twelve permanent branches around the world, and 68 chapters perform voluntary activities on its behalf. *Id.*

49. *Id.* The plaintiff had owned and maintained a federally registered service mark in this stylized version of its service mark since 1983. *Id.*

50. The court also emphasized the plaintiff’s broad information dissemination efforts, including four publications that it distributes around the United States, as well as numerous other mediums of dissemination, including classes, meetings, television and radio broadcasts, magazines, brochures, and newspapers. *Id.* at 289. The plaintiff has also spent a considerable amount of time and money in creating and distributing advertising campaigns for its religious teachings and organization. *Id.* However, the plaintiff has conceded that not every single piece of literature or other material that it distributed contained the stylized mark. *Id.*

51. *Id.*

52. *Id.* at 290. The plaintiff maintained that the domain name did not contain the stylized “O” in the word “for,” nor did it contain spaces in the domain name because such characters are not recognized in internet domain names. *Id.*

53. *Id.*
a website created by the defendant with the domain name “jews-forjesus.org.”

In determining whether the plaintiff was likely to succeed on the merits of the case, the court held that the plaintiff had successfully demonstrated a likelihood of success on the merits. The court found that the plaintiff owned a valid and legally protectable mark, and the defendant’s use of a similar mark in conjunction with its website was likely to cause confusion as to the source of the website and related content. Defendant relied on Blinded Veterans in

54. Jews For Jesus, 993 F. Supp. at 290. The defendant’s website contained about one page of text referring to the plaintiff’s organization as “Jews for Jesus,” without the stylized mark. Id. The defendant stated that his purpose behind creating his website was to “intercept potential converts before they have a chance to see the obscene garbage on the real J4J site.” Id. at 291, (quoting Exhibit J to the Complaint). The defendant also repeatedly referred to his own website as bogus. Id. at 286. The website contained a disclaimer that stated “PLEASE NOTE This website is an independent project which reflects the personal opinion of its owner, and is in no way affiliated with the Jewish organization Outreach Judaism, or the Christian organization Jews for Jesus.” Id. at 290 n. 13 (quoting Exhibit E to the Complaint) (emphasis in original). The website also contained a clickable link that transported users to the internet site for the Outreach Judaism Organization, another “vocal opponent” of Jews for Jesus. Id. at 290-91. The court pointed out that the website for the Outreach Judaism Organization was commercial in nature in that one of the sections of the website sold certain items relating to the teaching of the Outreach Judaism Organization.

55. The plaintiff in Jews for Jesus sought a preliminary injunction. Id. at 287. The court articulated that, in order for injunctive relief to be proper, the plaintiff has the burden of demonstrating 1) the likelihood of the plaintiff prevailing on the merits at the final hearing, 2) the extent to which the plaintiff is being irreparably harmed by the defendant’s activities, 3) the extent to which the defendant will experience irreparable harm if the injunctive relief is granted, and 4) the public interests involved in granting the injunctive relief. Id.

56. Id. at 305.

57. In regards to the likelihood of confusion as to the federally registered service mark, the court held that the defendant’s use of the domain name was confusingly similar to the plaintiff’s mark and therefore was likely to constitute infringement on the merits. Id. at 296. In deciding so, the court reasoned that in order to constitute infringement, exact similarities are not required between the senior mark and the one allegedly infringing upon such mark. Id. The court instead stated that in order for a finding of infringement, the marks must be confusingly similar or used to deceive the public, further stating that two marks are confusingly similar if ordinary consumers may incorrectly assume that the two
arguing that the common law service mark "Jews for Jesus" was generic and therefore not entitled to trademark protection. 58

The court rejected the plaintiff’s argument for a finding of genericism. 59 In articulating the standard for a generic term, the court stated that a term is generic "if that term has 'so few alternatives (perhaps none) for describing the good [or service] that to allow someone to monopolize the word would debilitating competitors.'" 60 The court rejected the analogy to Blinded Veterans, stating that the cases were distinguishable because there was ample evidence demonstrating that the plaintiff has consistently used the term "Jews for Jesus" to refer to the organization, and not its practitioners. 61

marks share a common "source, affiliation, connection, or sponsorship." Id. (quoting Fisons Horticulture Inc., v. Vigoro Indus., Inc., 30 F.3d 466, 477 (3d Cir. 1994)). However, in its reasoning, the court fails to mention the defendant’s stated objective in creating the website, to intercept potential seekers of the plaintiff’s site, and instead based its reasoning on a bare and unsupported assertion that consumers will likely inappropriately assume that the defendant’s website is affiliated with or otherwise endorsed by the plaintiff’s organization because the names are almost identical. Id. However, the court fails to recognize that once any potential consumers reach the website, any such assumptions held by said consumers will be proven false, as the content on the defendant’s website is in opposition to and in critique of those beliefs held by the plaintiff’s organization.

58. Jews for Jesus, 993 F.Supp at 297. In arguing that the plaintiff’s common law service mark was generic, the defendant analogizes to the decision handed down by the D.C. Circuit in Blinded Veterans Ass’n v. Blinded American Veterans Found. (Where the court held that the common law (and therefore unregistered) mark BLINDED VETERANS was generic because the organization used the term "blinded veterans" numerous times to refer to soldiers who had lost their sight, instead of the actual organization itself. Jews for Jesus at 298, citing to Blinded Veterans Ass’n v. Blinded American Veterans Found., 872 F.2d 1035, 1041 (D.C. Cir. 1989). The court also went on to state that it would be hard to designate another term for the public to refer to the category of people who were both blind and veterans. Blinded Veterans, 872 F.2d at 1041).


60. Id. (alteration in the original) (quoting Duraco Prods., Inc. v. Joy Plastic Enters., Ltd., 40 F.3d 1431, 1442 (3d Cir. 1994)).

61. Id. Additionally, the court further distinguished Blind Veterans by noting that there are many other terms available for the public to use in order to refer to Jews who believe in Jesus Christ. Id.
The Jews for Jesus court also assessed the likelihood of confusion created or potentially created by the defendant’s use of the mark.\textsuperscript{62} The court determined that, based on an extensive analysis of the Scott Factors, which are used by the Third Circuit in assessing likelihood of confusion, the defendant’s use of the mark in conjunction with his website was likely to cause confusion because a majority of the factors weighed in favor of a likelihood of confusion.\textsuperscript{63} Therefore, the court held, the plaintiff had successfully demonstrated a likelihood of success on the merits.\textsuperscript{64}

\textit{b. Lamparello v. Falwell}

In order to contextualize Jews for Jesus, the Fourth Circuit case of Lamparello v. Falwell provides an interesting, and distinguishable, case from Jews for Jesus but with similar base facts.\textsuperscript{65} In Lamparello, the defendant created a website\textsuperscript{66} criticizing the plaintiff Jerry Falwell\textsuperscript{67}, a nationally known minister who expressed con-

\textsuperscript{62} Id. at 301. In assessing likelihood of confusion, the court used the Third Circuit Scott Factors. Id. Those factors include “1) the degree of similarity between the owner’s mark and the alleged infringing mark; 2) the strength of owner’s mark; 3) the price of the goods and other factors indicative of the care and attention expected of consumers when making a purchase; 4) the length of time the defendant has used the mark without evidence of actual confusion arising; 5) the intent of the defendant in adopting the mark; 6) the evidence of actual confusion; 7) whether the goods, though not competing, are marketed through the same channels of trade and advertised through the same media; 8) the extent to which the targets of the parties’ sales efforts are the same; 9) the relationship of the goods in the minds of the public because of the similarity of function; [and] 10) other facts suggesting that the consuming public might expect the prior owner to manufacture a product in the defendant’s market.” Id. See Scott Paper Co. v. Scott’s Liquid Gold, Inc., 589 F.2d 1225, 1229 (3d Cir. 1978).

\textsuperscript{63} Id.

\textsuperscript{64} Id. at 305.

\textsuperscript{65} Lamparello v. Falwell, 420 F.3d 309 (4th Cir. 2005).

\textsuperscript{66} The court refers to the defendant’s website as a “gripe site.” Id. at 311.

\textsuperscript{67} Christopher Lamparello actually sought declaratory judgment that he was not in violation of Jerry Falwell’s trademark rights, making Lamparello the \textit{de facto} plaintiff. Id. at 312. For clarity’s sake, Lamparello shall be referred to as the defendant throughout this discussion, because it was his actions that were potentially infringing.
controversial ideas about homosexuals and homosexuality.68 The plaintiff had several common law trademarks in “Jerry Falwell” and “Falwell,” and maintained a website for his ministry at “www.falwell.com.”69 The defendant registered the domain name “www.fallwell.com” and used this website as a platform from which to respond to and criticize the plaintiff’s views about homosexuality.70 In response to several cease and desist letters sent by the plaintiff and his representative, the defendant filed suit, seeking declaratory judgment of noninfringement.71

Upon review, the Fourth Circuit articulated that to be successful in a cause of action for infringement, the plaintiff must demonstrate 1) that it possesses a mark, 2) that the defendant has used the mark, 3) that the defendant’s use of the mark occurred in commerce, 4) that the defendant used the mark in connection with the sale, distribution, or advertising of goods or services, and 5) that the defendant used the mark in a way that was likely to cause confusion among customers.72 The Fourth Circuit refers to these five factors that assess likelihood of confusion as the Pizzeria Uno Factors.73 The court ultimately held that the defendant’s gripe site was not likely to cause confusion among consumers.74

68. Id. at 311.
69. Id.
70. Id. The defendant’s website contained a disclaimer on the homepage disowning any affiliation or other association with the plaintiff’s ministry as well as a link to the plaintiff’s website for patrons who inadvertently accessed the defendant’s website. Id. The defendant’s website also contained a clickable link to amazon.com, where visitors were directed to a page selling a book that supported the defendant’s interpretation of the Bible and homosexuality. Id.
71. Lamparello, 420 F.3d at 312. On summary judgment, the district court ruled in favor of the plaintiff, Jerry Falwell. Id.
72. Id. at 313. In assessing likelihood of confusion, the Fourth Circuit utilizes (and did so in Lamparello) the Pizzeria Uno Factors. Id. at 314-15. See Pizzeria Uno Corp. v. Temple, 747 F.2d 1522, 1527 (4th Cir. 1984). The relevant factors include 1) the strength or distinctiveness of the mark, 2) the similarity of the marks, 3) the similarity of the goods and/or services that the two marks are being used to identify, 4) the similarity of the facilities used by the parties in connection with their goods/services, 5) similarity of advertising, 6) the potential infringer’s intent, and 7) actual confusion. Id. at 315.
73. Id.
74. Id.
Although the court looked at all of the Pizzeria Uno factors, the most relevant to this discussion are the similarity of goods and services and actual confusion. The court noted that the two sites did not offer similar goods and services and that, in fact, the views presented by each site are in absolute opposition to one another.\textsuperscript{75} The court opined that because the two websites offered such differing views, users attempting to access the plaintiff’s site who instead inadvertently encountered the defendant’s gripe site would not believe that the plaintiff would endorse, create, or otherwise sponsor a website criticizing his own religious teachings.\textsuperscript{76} In other words, the court posited that the consumers were intelligent enough to distinguish between the two websites. Furthermore, the court reasoned, there was actual anecdotal evidence of internet users who came across the defendant’s website while looking for the plaintiff’s website, soon thereafter realized that the plaintiff was not the source of such website.\textsuperscript{77} Therefore, the court concluded, there was no likelihood of confusion.\textsuperscript{78}

III. Eller Case Summary

Eller v. Intellectual Reserve, Inc. was filed in the United States District Court for the Southern District of Texas on April 7, 2014.\textsuperscript{79} Plaintiff, Jonathan Eller, seeks declaratory judgment and a preliminary judgment regarding his use of the word “Mormon” to promote his Mormon-centered online dating site, Mormon Match, as well as use in his domain name for the same. Defendant, Intellectual Reserve, Inc. (“Intellectual Reserve”) filed counterclaims asserting that Eller has committed violations of trademark and unfair competition law, both in the federal and common law domains; fi-

\textsuperscript{75} Id.
\textsuperscript{76} Lamparello, 420 F.3d at 315; see also New Kids on the Block v. News Am. Publ’g, Inc., 971 F.2d 302, 308-09 (9th Cir. 1992) (stating that when a mark is used by someone other than the markholder to criticize the markholder, this use implies that the use is not sponsored by the senior markholder).
\textsuperscript{77} Lamparello, 420 F.3d at 315.
\textsuperscript{78} Id.
\textsuperscript{79} Complaint at 1, Eller v. Intellectual Reserve, Inc. (S.D. Tex. Apr. 29, 2014) (No. 4:14-cv-00914).
nally, Intellectual Reserve sought declaratory judgment regarding Eller’s use of MORMON.80

A. Factual Background

Plaintiff, Jonathan Eller, is the founder of Mormon Match, an online dating service which is geared towards helping members of the Mormon Church meet significant others who share similar religious faith and beliefs.81 The domain name for Mormon Match is www.dateamormon.com.82 Eller sought federal trademark registration for the mark MORMON MATCH as well as Mormon Match’s logo, and sought to apply the registration of these marks for “Internet-based dating, social introduction, and social networking services.”83

Intellectual Reserve, Inc. is a “non-profit Utah Corporation holding intellectual property used by The Church of Jesus Christ of Latter-day Saints.” 84 The Church is more commonly known as the

80. Capitalization of a word throughout this article will denote the trademark or group of trademarks at issue.
81. Complaint at 30-32. Eller describes himself as a Mormon and an “active member of the Church in full fellowship.” Id. at 27.
82. Id. at 31-32. Eller alleges that he created this website and dating service to serve as a safe, comfortable, and convenient forum for members of the Mormon Church to meet and facilitate “relationships, dating, and marriages between Mormon users of his website.” Id. Since this time the website has used the domain name of www.dateamormon.com, as well as has displayed Mormon Match’s logo, a background image of the Salt Lake City Temple, and made other and numerous usages of the word “Mormon” in a variety of contexts. Id. at 39-40. Eller maintains that since the website was activated in June of 2006 and that he never received any cease and desist letters or any other correspondence for that member from the Intellectual Reserve or any authority members of the Church informing him that he could not use the word Mormon to promote his dating website. Id. at 40.
83. Complaint at 42. Eller’s final trademark application did not claim trademark in MORMON MATCH, only the design elements of the site. Id. at 43-44. On October 29, 2013, Eller’s trademark application was published for opposition in the Official Gazette, a weekly publication in which the United States Patent and Trademark Office publishes newly registered trademarks. Id. at 45.
84. Id. at 2; see also Answer, Affirmative Defenses and Counterclaims at 2, Eller v. Intellectual Reserve, Inc. (S.D. Tex. Apr. 29, 2014) (No. 4:14-cv-00914).
Mormon Church, and Intellectual Reserve holds claims to trademarks in several marks incorporating the word MORMON. The Church has had a federally registered trademark in the word MORMON since May 8, 2007. Intellectual Reserve asserts that all of the Mormon marks it has federally registered have been deemed incontestable. On January 4, 2014, Intellectual Reserve filed a Notice of Opposition, asserting ownership of all right, title, and interest in the trademark MORMON. Eller alleges that none of the aforementioned marks are claimed for goods and services similar to those in which his trademark is registered and that the Intellectual Reserve was denied trademark in the word MORMON. Eller sought declaratory judgment in regard to his use of the word “Mormon” in conjunction with his internet dating site, as well as declaratory judgment that MORMON is a generic and/or descriptive mark and therefore the Church has no rights in the mark. Eller’s believed that his use of MORMON and other purportedly trademarked images does not constitute infringement of any rights purported by Intellectual Reserve or the Mormon Church. Furthermore, Eller sought enjoinment of Intellectual Reserve from interfering or otherwise attempting to restrict or other-

85. Affirmative Defenses at 10. Intellectual Reserve’s trademarks incorporate the word MORMON alone or in combination with other words, as well as design marks involving or otherwise depicting the temple located in Salt Lake City, Utah. Id.
86. Id. at 15.
87. Id. at 16.
88. Complaint at 47. Intellectual Reserve asserted that this mark is an unregistered common law mark protected for an “unspecified variety of goods and services” as well as several additional federally registered marks all related to the Church and its products/services. Id. at 47-50. The additional federally registered trademarks that Eller claimed the Intellectual Reserve identified included MORMON, MORMON.ORG, BOOK OF MORMON, MORMON TABERNACLE CHOIR, MORMON TABERNACLE CHOIR (and Design), MORMON HANDICRAFT, and MORMON HANDICRAFT. See Id. at 50.
89. See Id. at 51. Eller’s mark is filed under Section 45, “Internet-based dating, social introduction, and social networking services.”
90. Id. at 51-52.
91. Id. at 105-110.
92. Id. at 17.
wise interfere with Eller’s operation and control of his Internet-based dating site.93

Intellectual Reserve filed five counterclaims alleging that, Eller infringed on its trademark and violated several provisions of federal copyright law.94 Furthermore, Eller’s use of these marks has created a likelihood of confusion among “actual and prospective customers” and that this likelihood of confusion has damaged the goodwill of the MORMON marks.95

VI. ANALYSIS

It seems as though there is little to no consistency with which the various court’s examination of religious trademarks. Why did the McGill court hold that the plaintiff’s mark was not generic and did not create a likelihood of confusion, while the Evans court in examining strikingly similar facts, held that the plaintiff’s mark was generic?

A. Varying Interpretations of Religious Trademarks

One possible explanation for the variety of religious trademark interpretations may be certain circuits’ tendencies to provide an implicit (or explicit) bias to plaintiffs who hold religious trademarks. It seems as though in some circuits, the courts are unwilling (whether consciously choosing to be so or not) to place the same

93. Complaint at 17.
94. Answer at 47-79. Intellectual Reserve’s counterclaim asserts that Eller engaged in trademark infringement in violation of federal law pursuant to 15 U.S.C. § 1114(1)(a). Counterclaim at 49. Furthermore, Intellectual Reserve alleged that Eller has used Intellectual Reserve’s marks in an infringing manner in connection with Eller’s Internet-based dating site. Id. at 48.
95. See Complaint. Eller filed his Complaint at Law in the United States District Court for the Southern District of Texas on April 7, 2014. On April 29, 2014, Intellectual Reserve filed its Answer as well as the counterclaims against Eller described above. See Answer; Counterclaims. On June 20, 2014, the parties filed a notice of settlement, the terms of which remain undisclosed to the public at this time. Bill Donahue, Mormon Dating Site Settles Trademark Spat with LDS Church, LAW 360 (June 20, 2014, 2:46 PM), http://www.law360.com/articles/550306/mormon-dating-site-settles-trademark-spat-with-lds-church.
evidentiary burdens as are placed on secular litigants. When examining such cases, it appears as though the court does not scrutinize the evidence put forth for likelihood of confusion and against genericism at the same level that it does for secular litigants. Some critics have alleged that the court in *McGill* failed to properly and neutrally apply trademark law to the facts in *McGill*. N. Cameron Russell, in his examination of domain names in the religious context, critiques the court’s decision that the relevant consuming public viewed the plaintiff’s mark as referring to the religious organization, rather than the “goods” offered by the religious organization (i.e. the producer rather than the product).

There is also a difference in the way in which the courts examine likelihood of confusion as well. Although *Jews for Jesus* and *Lamparello* both dealt with non-secular plaintiffs, there was one glaring difference in the court’s interpretation: both the defendants in these cases maintained grip sites that criticized the plaintiff’s religious beliefs. In *Lamparello*, the court emphasized this feature of the website, stating that any likelihood of confusion was simply absent due to the fact that the defendant’s site was critical of the plaintiff’s beliefs. However, this analysis is absent from *Jews for Jesus*. The disparities in these cases are harder to explain because both cases dealt with non-secular litigants, but the inconsistencies between the courts’ interpretation are conspicuous.

It is well-settled and fundamental principle of law in our national jurisdiction that when presiding over a matter concerning a religious property dispute, the court may not “take sides” and must take great efforts to avoid ruling based on religious doctrine.

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97. Russell notes that customer surveys are often employed in trademark infringement cases, and that if members of the relevant public were administered surveys regarding the significance of the plaintiff’s purported trademark, it seems “unlikely” that the majority would answer that it was the religious organization itself. *Id.* , Russell seems to be implying that the *McGill* court was improper in its decision that the plaintiff’s term was generic.

However, the examination of the relevant precedents has been instrumental in revealing the inconsistencies of the court’s application of the trademark rules and tests to religious organizations and their affiliates. McGill suggests the court’s unwillingness to place such the burden required of secular plaintiffs to demonstrate a likelihood of confusion. Although there is a clear mandate for religious neutrality and impartiality, some courts are taking these principles too far and perhaps lightening the burden on religious plaintiffs attempting to secure rights in trademarks that would not otherwise be protected if not for their religious affiliations.

B. Eller: A Meritorious Case?

Although Eller was settled and the District Court was not required to issue a written ruling on the merits of the case, it is compelling to examine the case law in the realm of religion and trademark, and analyze what may have happened if the merits of the case had been heard by the court. The ultimate question is whether Intellectual Reserve’s counterclaims in Eller had a likelihood of success on the merits, and whether a decision in Intellectual Reserve’s favor would have pushed the boundaries of trademark law in the religious context.

The facts of the Eller case and the Mormon Church’s proclamation that it owns trademarks in such words and symbols associated with the Church raise several questions, all relating back to one main inquiry: Does the Mormon Church have a valid counterclaim against Eller’s use of the word Mormon in connection with his Internet dating site? Could Eller have pushed the outer-limits of trademarkable religious marks?

Bahá’ís of the U.S. Under Hereditary Guardianship, Inc. v. Nat’l Spiritual Assembly of the Bahá’ís of the U.S., Inc., 628 F.3d 837 (7th Cir. 2010) (applying the fundamental principle that courts must remain neutral in adjudicating church property disputes to trademark disputes). In National Spiritual Assembly, the court was required to decide a forty-year-old trademark dispute between two religious organizations, one of which had split and formed a schism from the other. Id. at 840. The court stressed that in analyzing and deciding upon such a case, courts must be cautious as to not take sides in the religious schism and to use the neutral application of the law to determine the resolution to the legal dispute. Id. at 845.
It is essential to note that the purpose of this treatment of trademark in the religious context is not to make the assertion that a religious organization cannot or should not be afforded the right to obtain, own, and enforce its right as to any trademarks or other intellectual property. In fact, courts have observed that nothing in the Constitution prohibits religious organizations from owning property, intellectual or otherwise, nor "prohibits the government from protecting that property from unlawful appropriation by others."99 In other words, religious organizations are, or at least should be, treated the same as nonreligious organizations with regards to their intellectual property rights and their right to enforce these private causes of action. However, Eller focuses on the Church's claim that it holds an exclusive right to use the word "Mormon," which the majority of people use to describe the Church and all of its proffered religious services.

Eller alleged that his purpose in creating Mormon Match was to create a forum in which members of the Mormon Church could meet, interact, and create loving relationships with other members who share the same religious beliefs and ideals.100 It seems unlikely, and Intellectual Reserve has provided little evidence to the contrary, that Eller created his site with the intention of unfairly and inappropriately capitalizing off of the Mormon Church. Additionally, Eller's website contains a disclaimer that reads "MORMON MATCH IS NOT COMMERCIALY AFFILIATED WITH OR ENDORSED BY THE CHURCH OF JESUS CHRIST OF

99. Nat'l Bd. of Young Women's Christian Ass'n of U.S.A. v. Young Women's Christian Ass'n of Charleston, S.C., 335 F. Supp. 615, 625 (D.S.C. 1971) (holding that granting a religious organization the exclusive use of a name only deprives other religious groups of the use of that same name and that such exclusivity does not deny other religious organizations the right to establish competing organizations with the same purpose but with different names); see also Gen. Conference Corp. of Seventh-Day Adventists v. Perez, 97 F. Supp. 2d 1154, 1164 (S.D. Fl. 2000) (holding that it is a well-established principle of law that religious organizations are entitled to the same amount of protection for their trademarks, copyright, and other intellectual property as are commercial enterprises; furthermore, enforcement of the Act in the religious context does not "abridge the religious freedom rights" of a group who is legitimately infringing upon another's valid trademarks).

100. Complaint at 8-9.
ELLER V. INTELLECTUAL RESERVE, INC.

LATTER-DAY SAINTS.”101 People should be permitted to trademark use of the name of the religion in a non-reputation harming way, even if they may not be entitled to immunity from trademark infringement through the fair use defense. Uses such as Eller’s do not harm the Mormon Church; in fact, it could be argued that such uses help promote the Mormon Church’s ideals, theology, and beliefs, in that it helps raise public awareness and a positive image of the Mormon Church.

In Eller, the goods purported to be distributed by Intellectual Reserve and the Church present a quandary in determining whether their group of Mormon trademarks are actually performing a trademark function. The specific goods and the Church is distributing under these trademarks do not fit the traditional categories of consumer products. It is necessary to decide whether the Church’s claimed trademarks in the word MORMON and associated terms, as well whether as the image of the Temple, is capable of, and actually does, perform a trademark function.

1. Eller’s Likelihood of Success on the Merits

Although Eller v. Intellectual Reserve was settled, an examination of Intellectual Reserve’s likelihood of success on the merits of its trademark infringement counterclaims is still relevant.

a. Valid Mark

In Eller, the goods purported to be distributed by Intellectual Reserve and the Church present a dilemma in determining whether their group of MORMON trademarks are actually performing a trademark function. It is seemingly more difficult to define what exactly the goods or services provided by the Church whether the Church’s claimed trademarks in the word MORMON and associated terms, as well whether as the image of the Temple, is capable

101. MORMON MATCH, https://dateamormon.com/ (last visited July 21, 2014). However, it is important to note that this website was accessed after the June 2014 settlement. As the settlement terms are as of this date, unknown, the disclaimer may have been incident to the settlement of this matter. See Donahue, supra note 95.
of, and actually do, perform a trademark function. Therefore, the issue becomes whether the MORMON marks are generic.

Under the test generecism articulated in McGill and applied to the facts of Eller, the court must ascertain whether the general consuming public views the marks as referring to the set of religious beliefs held by the religious organization. If the general public views the marks as referring to the religious doctrine taught by the religious organization (i.e. as reference to a product), then the marks will be determined to be generic. On the other hand, if the public views the marks as referring to the religious organization itself, the source of the goods (i.e. as reference to the producer), then the mark will not be held to be generic. If it can be demonstrated that the general consuming public views the marks as referring to the “goods” (Mormon beliefs, doctrines, morals, etc.) rather than the Mormon Church itself, then the MORMON marks should be found generic. If this were the case, analysis stops here, as the Mormon Church does not have a viable claim due to lack of a valid trademark. However, if the converse is true, and the public does view these marks as referring to the Mormon Church itself, the analysis continues as to whether Eller’s use of the mark is likely to cause confusion.

Additionally, if analyzed under the framework of Evans, it seems as though Eller would not have been found liable for infringing Intellectual Reserve’s MORMON Marks. As discussed supra, the Evans court held that when it is impossible to discuss or otherwise name the plaintiff’s religion without using the plaintiff’s purported mark, that mark has been deemed generic and therefore is not protected by trademark law. Additionally, the Evans court articulated that if someone is practicing the religion, he or she has the right to use the religious name in connection with its goods and services. Therefore, because Eller is a practicing Mormon, and “Mormon” is the name of a religion, Eller should be permitted to

102. McGill, 617 F. 3d at 416.
103. See Russell, supra note 96 at 709.
104. See Evans, 520 A.2d at 1355.
use the word Mormon in conjunction with the goods and/or services that he is marketing to the public.\textsuperscript{105}

\textit{b. Likelihood of Confusion}

In order to be successful in a trademark infringement claim, the plaintiff must also demonstrate that there is a likelihood of confusion caused by the defendant’s use of the mark.\textsuperscript{106} Traditionally, the courts apply several factors when analyzing whether a defendant’s mark is likely to cause confusion. In the 5th Circuit, courts apply the \textit{Roto-Rooter} factors.\textsuperscript{107}

Although the 5th Circuit has not (yet) specifically applied these factors to the religious context, other federal District Courts and Circuit Courts of Appeal have.\textsuperscript{108} In \textit{McGill}, the 6th Circuit held that the defendant’s use of the plaintiff’s mark, SEVENTH-DAY ADVENTIST, was likely to cause confusion based on the similarity of each party’s relative services and the close similarity of the marks.\textsuperscript{109}

\textsuperscript{105} This statement excludes the use of such mark in a disparaging, dilutive, or other damaging manner. Such causes of action are beyond the scope of this treatment.


\textsuperscript{107} \textit{Roto-Rooter} 513 F.2d at 45. Likelihood of confusion is assessed by examining the following non-exclusive factors: 1) the type of trademark at issue, 2) similarity of design, 3) similarity of product, 4) identity of retail outlets and purchasers, 5) identity of advertising media utilized, 6) defendant’s intent, and 7) actual confusion. \textit{Id.} The court in \textit{Roto-Rooter} made sure to emphasize that although proof of actual confusion is not necessary for a finding of likelihood of confusion and subsequent liability for trademark infringement, the court views the factor of actual confusion as the most important and as the best evidence of likelihood of confusion. \textit{Id.} at 45-46.

\textsuperscript{108} See \textit{McGill}, 617 F.3d 402 (holding that a breakaway church’s use of the mark SEVENTH-DAY ADVENTIST was likely to cause confusion because of the relatedness of the parties’ services and similarity of the marks).

\textsuperscript{109} \textit{Id.} at 416. The factors the court assessed in \textit{McGill} to determined likelihood of confusion were 1) the strength of the senior mark, 2) relatedness of the goods and services, 3) similarity of the marks, 4) evidence of actual confusion, 5) the marketing channels used, 6) likely degree of purchaser care, 7) the intent of the defendant in selecting the mark, and 8) the likelihood of expansion of the product lines. \textit{Id.}
Of the Roto-Rooter factors as applied in McGill, the most relevant would be relatedness of the goods and services, and likely degree of purchaser care. First, the service provided by Mormon Match is just that: an online forum and dating site tailored towards those involved in the Mormon Church. Intellectual Reserve, by way of the Mormon Church, provides no such service or product to the members of the Mormon congregation. In fact, the Mormon Church’s products are its teachings, philosophies, doctrines, which it shares with its congregation and preaches to its believers. The difference between the two products is great, with this factor weighing heavily in favor of Eller’s use being permitted. Because there is no similarity at all between the products, current and potential consumers are not likely to be confused as to the source of Eller’s dating service being the Mormon Church or Intellectual Reserve.

Additionally, the degree of purchaser care weighs in favor of Eller. It is likely that those individuals using Eller’s dating website are devoted members of the Mormon Church. They are likely to know that the Mormon Church is not officially affiliated with Eller’s dating website; Intellectual Reserve has provided no evidence of actual confusion. Intellectual Reserve has made bare assertions that Eller’s website is likely to cause confusion among prospective customers.110

V. FUTURE IMPLICATIONS

Although Eller v. Intellectual Reserve, Inc. settled, this is not the end of religious organizations asserting their right to certain trademarks and disputing the use of these trademarks. This litigation is particularly relevant among the relatively recently established faiths, such as the Mormon Church and Scientology111, as

110. Eller v. Intellectual Reserve, No. 14 CV 00914 (S.D. Tex. May 12, 2014), counterclaims at 77, (where Intellectual Reserve does not refute claims that datemormon.com contains the word "Mormon" and simply alleges that such fact causes confusion or is an infringement of their trademark).

111. See Church of Scientology Intern. V. Elmira Mission of the Church of Scientology, 794 F.2d 38 (2d Cir. 1986) (litigation concerning the Church of Scientology’s asserted trademark in the mark SCIENTOLOGY).
opposed to religions, such as the Judeo-Christian religions, which pre-date the founding of America. Eller’s significance, had it reached the trial stage, could have helped to shape and determine the limitations of religion and trademark. The Mormon Church has over 15,000,000 members.\textsuperscript{112} Allowing the Mormon Church the \textit{exclusive} right to use the MORMON marks in conjunction with goods and services limits access to those who practice the religion and wish to use the mark in connection with their goods and services. Additionally, this potential exclusivity would remove use of the mark from not only competitors, but also from those who have the desire to market products that are in alignment with the Mormon Church’s doctrines. An \textit{Eller} decision could have determined whether religious organizations may have the exclusive right to trademark something as unremarkable as a colloquialism (i.e. “Mormon” to describe the beliefs of those in the Church of Jesus Christ of Latter-day Saints).

\textit{Eller} exemplifies the limitations that could be imposed on a wide number of individuals if any sizeable religious organization is given the opportunity to trademark such colloquialisms. If this right were given, it could potentially lead to the exploitation of the licensing, and lead to loyalists of the Church being exploited or otherwise completely unable to use the name to promote their products that are touting the ideals of the religion. Why should religious organizations be entitled to the \textit{exclusive} use of the name of the religion when there are other who may want to use the name in connection with their goods and services in a non-reputation harming way? There are other individuals and corporations, such Jonathan Eller who have a need to use the names of such religions in a legitimate, non-disparaging trademark manner. Such individuals should not have the constant threat of litigation hanging over their heads. Some critics have noted that entitling a religious organization to the exclusive trademark rights creates a sort of monopoly, seemingly in direct contradiction to trademark law.\textsuperscript{113} If Intellectu-

\footnotesize

\textsuperscript{113} Russell, \textit{supra} note 81, at 708. Russell notes that customer surveys are often employed in trademark infringement cases, and that if members of the rel-
al Reserve is entitled to exclusive trademark rights, this would only lead to a further perpetuation of this monopoly and seemingly render many of the Lanham Act's protections useless. Such religious marks should only be protected if they truly deserve to be protected under the law, and the courts must be compelled to apply the same standards to non-secular litigants as secular litigants.

VI. CONCLUSION

Trademark enthusiasts and religious leaders alike were hoping that Eller would help in setting the outer boundaries of trademark vis-à-vis religion. However, due to the case settling, interested parties will have to speculate as to what the result may have been as they wait for another case ripe for the issue. Based on an examination of the relevant precedent, it seems as though Intellectual Reserve would not have prevailed in its counterclaims against Eller, and Eller would have been allowed to continue using the marks in connection with his online dating service.

Jenna DiJohn*

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event public were administered surveys regarding the significance of the plaintiff's purported trademark, it seems "unlikely" that the majority would answer that it was the religious organization itself. Id. Russell notes that the court in McGill created a monopoly that is expressly the type proscribed by the Act. Id.

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