

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF TENNESSEE
EASTERN DIVISION

GENERAL CONFERENCE CORPORATION
OF SEVENTH-DAY ADVENTISTS, et al.,

Plaintiffs,

vs.

Civil Action No. 1:06-cv-01207-JDT-sta

WALTER MCGILL d/b/a
CREATION SEVENTH DAY
ADVENTIST CHURCH, et al.,

Defendant.

DEFENDANT'S RESPONSE TO PLAINTIFFS' MOTION FOR SUMMARY JUDGMENT

Comes now the Defendant, Pastor Walter McGill ("Pastor McGill"), and submits this Response to Plaintiffs' Motion for Summary Judgment (Doc. 37).

I. NATURE OF ACTION

Plaintiffs and Pastor McGill disagree as to the fundamental nature of this action. Plaintiffs frame this case as a routine trademark action for infringement of service marks and trade names. *See* Memorandum In Support of Plaintiffs' Motion for Summary Judgment (Doc. 37-15), p. 1. Pastor McGill views this as a First Amendment freedom of religion issue in which Plaintiffs seek to monopolize the name of a religion and deny those who oppose them from practicing the religion. What is ironic and hypocritical about this case is that the Plaintiffs are zealous defenders of religious liberty, going so far as to establish a Department of Public Affairs and Religious Liberty within their church which produces a Religious Liberty Leader's

Handbook for local members whose role is to promote and support religious liberty in their community. *See* Religious Liberty Leader's Handbook, p. 7 (attached as Exhibit H to Defendant's Response to Plaintiffs' Statement of Undisputed Material Facts and Additional Material Facts ("RSUF")), ¶ 43 (attached hereto as Exhibit 1). As the Plaintiffs point out, they too have "sometimes been the victim of religious intolerance, and therefore identify with the rights of everyone to freely choose their own religious beliefs and to practice their convictions as they see fit." Religious Liberty Leader's Handbook, p. 7 (attached as Exhibit H to RSUF). Perhaps for that very reason, Plaintiffs refuse to acknowledge the free exercise concerns raised by their actions, and instead, ask this Court to wear blinders and consider this action only within the context of the laws of unfair competition and trademarks.

Even in the trademark context, Plaintiffs' argument suffers a fatal flaw. Case law is well established that the name of religion, for trademark purposes, is a generic term that is available to all to use in their worship. Plaintiffs continually refer to the Seventh-Day Adventist Church in an attempt to skirt the issue of whether Seventh-Day Adventism is the name of a religion. This tired fiction ignores the simple premise that every small child in Bible class knows—people go to church to practice their religion. If "Seventh-Day Adventist" does not describe the religion practiced by the Plaintiffs, what then, is the name of the religion they practice? As discussed below, Plaintiffs' registration of the marks and prior court decisions on this issue are not conclusive of whether the marks in question are generic, because even if the term "Seventh-day Adventist" was properly trademarked, such terms can lose their distinctiveness over time and become generic.

II. SUMMARY JUDGMENT STANDARD

Under Rule 56(c) of the Federal Rules of Civil Procedure, summary judgment is appropriate when “the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issues as to any material fact and that the moving party is entitled to a judgment as a matter of law.” Generally, the standard for determining whether summary judgment is appropriate is “whether the evidence presents a sufficient disagreement to require submission to a jury or whether it is so one-sided that one party must prevail as a matter of law.” *Booker v. Brown & Williamson Tobacco Co. Inc.*, 879 F.2d 1304, 1310 (6th Cir. 1989). The court must view the facts presented in the light most favorable to the non-moving party, and draw all reasonable inferences in the non-movant’s favor. *Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 587 (1986); *Rakiczy v. Traveler’s Insurance Co.*, 959 F. Supp. 777, 781 (E.D. Mich. 1997).

Further, the court cannot resolve issues of fact, but is empowered to determine only whether there are issues in dispute to be decided at trial. *Gutierrez v. Lynch*, 826 F.2d 1534, 1536 (6th Cir. 1987); *In re Atlas Concrete Pipe, Inc.*, 668 F.2d 905, 908 (6th Cir. 1982). A party seeking summary judgment must specify the basis upon which judgment should be granted and identify that portion of the record which demonstrates the absence of a genuine issue of material fact. *Pierce v. Commonwealth Life Ins. Co.*, 40 F.3d 796, 800 (6th Cir. 1994). If this burden is met, the non-moving party must provide facts, supported by evidence in the record, “upon which a reasonable jury could find there to be a genuine fact issue for trial.” *Bill Call Ford, Inc. v. Ford Motor Co.*, 48 F.3d 201, 205 (6th Cir. 1995).

II. LAW AND ARGUMENT

1. Plaintiffs marks have become generic

Plaintiffs argue that their marks are incontestable, and therefore, the only issue remaining for the court's determination is whether the use of the marks is likely to cause confusion. *See* Memorandum In Support of Plaintiffs' Motion for Summary Judgment (Doc. 37-15), p. 1. While it is true that one advantage to the registration of a mark on the Principal Register is that the mark may attain incontestable status, the label of "incontestability" is rather misdescriptive. *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 408 F.3d 596, 603 (9th Cir. 2005) (citing 5 MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION § 32:147 (2002)). An incontestable registration is still subject to certain defenses or defects, set forth in 15 U.S.C. § 1115 and does not apply to generic marks. *Id.*

Generic marks are not capable of receiving protection because they identify the product, rather than the product's source. *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 194, (1985). While it is true that once a trademark has been registered, there is a presumption that term is not generic, a registered mark may be canceled at any time on the grounds that it has become generic." *Kern's Kitchen, Inc. v. Bon Appetit*, 850 F.2d 692 (6th Cir. 1988) (quoting *Park 'N Fly, Inc.*, 469 U.S. at 194). Whether a name is generic is a question of fact. *Bath & Body Works v. Luzier Personalized Cosmetics*, 76 F.3d 743, 748 (6th Cir. 1996) (citing McCarthy on Trademarks and Unfair Competition, § 12.02[7][b] (3d ed. 1992)). The appropriate "test for genericness is whether the public perceives the term primarily as the designation of the article." *Id.* at 748.

While this Court should find that the "Seventh-day Adventist" mark always has been

generic, and therefore, improperly registered, if we assume *arguendo* and contrary to previous court decisions, that (1) the Seventh-Day Adventist Church existed before the religion, and (2) the mark was properly registered, that still does not answer the question of whether the term has become generic. See *General Conference Corporation of Seventh-Day Adventists v. Seventh-Day Adventist Kinship International, Inc.*, Case No. CV 87-8113 (C.D. Calif. 1991) (attached as Exhibit C to Defendant's Memorandum in Support of his Motion to Dismiss (Doc. 30-2) (finding that Seventh-Day Adventism the religion predated the Seventh-day Adventist Church)). Perhaps, when the Plaintiffs' Church was formed, the general public associated "Seventh-day Adventist" only with the Plaintiffs, and, perhaps, it was even correct to say that Plaintiffs' Church was the religion. Over time, however, this certainly has changed. Today, several denominations of Seventh-Day Adventism exist. In addition to the Defendant, the Seventh Day Adventist Reform Movement, started in 1915, and the Davidian Seventh Day Adventists, started in 1942, numerous other churches practice Seventh-Day Adventism. RSUF, ¶ 43 (See *The Seventh-Day Adventist Encyclopedia* (revised edition), Review and Herald Publishing Assoc., 1976 (excerpt attached as Exhibit M to RSUF); see also the *Kinship* Opinion, Case No. CV 87-8113 (C.D. Calif. 1991) page 14 (taking notice of two breakaway churches)). Whatever its origins, Seventh-Day Adventism today has evolved into a religion that has several denominations of followers who are all known as Seventh-Day Adventists. One belief of the faith that is somewhat unique to Seventh-Day Adventists, and particularly important in this litigation, is that Seventh-Day Adventists are commanded to call themselves by that name because it proclaims core beliefs of their religion—Christ's return is imminent and it is important to keep holy the Sabbath, i.e. Saturday, the last day of the week. RSUF, ¶ 7 (See Exhibits A and

E, Affidavits of Walter McGill and Russell Kelly).

Plaintiffs base their argument that the mark “Seventh-day Adventist” is not generic on three outdated surveys that they say demonstrate that the general public identifies the mark with their church. *See* Memorandum In Support of Plaintiffs’ Motion for Summary Judgment (Doc. 37-15), p. 12 (citing surveys from 1970, 1986, and 1999). But as the Trademark Trial and Appeals Board noted in *Stocker*, “each case must be decided on its own facts.” *William L. Perry & Virginia L. Stocker v. General Conference Corporation of Seventh-day Adventists*, 39 U.S.P.Q.2D (BNA) 1385, 1996 TTAB LEXIS 41 at *48 (attached at Exhibit 11 to SUF). This Court should note that the TTAB in *Stocker* found the 1970 survey unhelpful to its decision, because it was “unable to extrapolate the results, to any significant degree, in analyzing the primary significance of the registered mark to the relevant public.” *Id.*

Plaintiffs have not filed these surveys as part of their motion, so it is impossible to determine whether they all employed flawed methodology, but the testimony of Plaintiffs’ witness, Harry O’Neill, in the *Perez* case further illustrates how much the surveys are open to interpretation and how his survey was poorly designed to elicit a favorable response for Plaintiffs. According to O’Neill—who was retained by Plaintiffs and reviewed the Complaint before drafting his survey—the survey conducted in 1999 consisted of three questions: (1) “Have you ever heard or seen the term Seventh-Day Adventist?” (2) “What type of organization, if any, comes to mind when you see or hear the term Seventh-Day Adventist?” and (3) “Do you associate the term Seventh-Day Adventist with anything else?” RSUF, ¶ 45; *See* Testimony of Harry O’Neill, Trial Transcript of March 14, 2000, pp. 16, 38-39, *General Conference Corp. of Seventh-Day Adventists v. Raphael Perez*, S.D. Fla. Case No. 98-2940-CIV-King (excerpt of

O'Neill testimony attached to RSUF as Exhibit C). Anyone who responded yes was then asked the follow up question "with what else do you associate it?" *Id.* O'Neill testified that 13 percent of the total public responded simply "religion." *Id.* at 21. Plaintiffs claimed that 44 percent of the public associated the term with Plaintiffs, but O'Neill testified that the answers "religious organization or group, church organization or group, and church," were combined to reach that number. *Id.* at 20. In fact, only 18 percent said a church and 5 percent said a church group or organization. *Id.* Twenty-three percent associated the term with a *religious* organization or group. *Id.* Regardless, the survey's major flaw is that it failed to inquire whether respondents even differentiated between a church and a religion. Had they asked whether people associate the term "Seventh-Day Adventist" with the name of a religion or the name of a church, the results likely would have been dramatically different.

Plaintiffs' use of outdated surveys also is of little help to this Court, because it is clear that trademarked terms can become generic over time. Some examples include the terms aspirin, cellophane and thermos. *See King-Seeley Thermos Co. v. Aladdin Industries, Inc.*, 321 F.2d 577, 580 (2nd Cir. 1963) (finding the term "thermos" had become generic and discussing cases finding the same for the terms aspirin and cellophane). Xerox and Kleenex are two examples of marks that are, or are dangerously close to becoming, generic. The first is the brand name for a copier that has become synonymous with the product itself. Judge King illustrated this in the *Perez* case during a discussion with the Defendant's attorney, in which he said, "You are asking him how he did his work. All he did was take a Xerox of the Yellow Pages. If he didn't Xerox the whole yellow page then you bring in the rest if they are important." *See* Trial Transcript of March 14, 2000, page 67, *General Conference Corp. of Seventh-Day Adventists v. Raphael*

Perez, S.D. Fla. Case No. 98-2940-CIV-King (excerpt of transcript attached to RSUF as Exhibit C). The significance is that in using Xerox as a noun, instead of an adjective, the mark becomes a generic term used to describe the product as opposed to signifying the product's source.

While clumsy and ill-suited for use in the religious context, courts have attempted to apply trademark law terms to cases such as this one, resulting in an uncomfortable fit much like a gospel choir at a grunge concert. Nonetheless, in this case Plaintiffs argue that the term "Seventh-day Adventist" indicates the source of the product and not the product (religion) itself. It is hard to imagine, however, a more apt way for the public to describe Pastor McGill's product (religion) than as Creation Seventh Day & Adventist—Saturday worshipers who believe in the imminent return of Christ; believers in the imminent return of Christ who worship on Saturday—neither succinctly conveys Pastor McGill's religion like Creation Seventh Day & Adventist. *See also*, Judge Pfaelzer's opinion in the *Kinship*, Case No. CV 87-8113 (C.D. Calif. 1991) (attached as Exhibit C to Defendant's Memorandum in Support of his Motion to Dismiss (Doc. 30-2), p. 14 ("There is no term that adequately describes an adherent to the religion of Seventh-day Adventism, other than 'Seventh-day Adventist[.]'")).

The Court of Appeals for the District of Columbia faced a similar conundrum in *Blinded Veterans Association v. Blinded American Veterans Foundation*, 872 F.2d 1035 (D.C. Cir. 1989). In that case, the Blinded Veterans Association (the "Association") sued the Blinded American Veterans Foundation (the "Foundation") for trademark infringement and unfair competition over the use of the term "blinded veterans" and the acronym "BAVF." 872 F.2d at 1036. In an opinion authored by Justice Ginsburg, then Judge Ginsburg, the court held that the term "blinded veterans" was generic, and therefore, not subject to trademark protection. *Id.* at

1041-42. The court opined that it was “difficult to imagine another term of reasonable conciseness and clarity by which the public refers to former members of the armed forces who have lost their vision,” and it noted that other courts have held terms generic that were “less distinctly apt denotations of their respective articles.” *Id.* at 1041 (citing *National Conf. of Bar Examiners v. Multistate Legal Studies, Inc.*, 692 F.2d 478, 488 (7th Cir. 1982) (“Multistate Bar Examination” as denoting “test prepared for determining the competency of applicants to the bars of several states”); *Abercrombie & Fitch v. Hunting World, Inc.*, 537 F.2d 4, 11-12 (2nd Cir. 1976) (“Safari” as denoting particular types of khaki-colored apparel)).

The *Blinded Veterans* Court based its decision on a finding that each term was a generic term used to denote a particular type of individual and that together they denoted a category of people who were both blind and veterans. *Id.* Similarly, both “Seventh Day” and “Adventist” are generic terms. RSUF, ¶¶ 17, 19. The term Seventh Day indicates that a particular religion observes the Sabbath on Saturday, and it is used by multiple faiths, such as the Seventh Day Baptists and the Church of God (Seventh Day). RSUF, ¶ 17 (*See* Wikipedia entry for “List Christian Denominations,” available at www.Wikipedia.com, last accessed January 4, 2008; *see also* www.seventhdaybaptist.org and www.cog7.org, last accessed January 4, 2008. Although the Plaintiffs claim a valid trademark on the word “Adventist” alone, this mark too, is a generic term which “generally refers to someone who believes in the Second Advent of Jesus (popularly known as the Second coming) in the tradition of the Millerites.” RSUF, ¶ 19; *See* Wikipedia entry for “Adventism,” available at www.Wikipedia.com, last accessed January 4, 2008; *see also*, “Adventism—1: the doctrine that the second coming of Christ and the end of the world are near at hand; 2: The principles and practices of Seventh-Day Adventists” Merriam-Webster

Online Dictionary, available at www.m-w.com/dictionary/adventist, last accessed January 4, 2008. A dictionary definition is an appropriate and relevant indication of the ordinary significance and meaning of words to the public.” *Discount Muffler Shop, Inc. v. Meineke Realty Corp.*, 535 F. Supp. 439 (N.D. Ohio 1982).

In the *Thermos* case, the court also noted the pitfalls of producing a popular product (religion):

[T]he Aspirin and Cellophane doctrine can be a harsh one for it places a penalty on the manufacturer who has made skillful use of advertising and has popularized his product. However, King-Seeley has enjoyed a commercial monopoly of the word 'thermos' for over fifty years. During that period, despite its efforts to protect the trademark, the public has virtually expropriated it as its own. The word having become part of the public domain, it would be unfair to unduly restrict the right of a competitor of King-Seeley to use the word.

321 F.2d at 581. (Citations omitted).

The same can be said for Plaintiffs, a manufacturer (church) that has made skillful use of advertising (evangelizing) and popularized its product (religion). Plaintiffs had a mere 3,500 members in 1863 when they organized; today, they number over 14 million worldwide. SUF, ¶ 44. It is a given that the larger a religion grows, the more likely it is that ideological differences will arise among members. RSUF, ¶ 47. When this happens, some members inevitably will leave the denomination and form a new denomination where they can practice the religion as their consciences' dictate. As discussed in Pastor McGill's Motion to Dismiss, courts have not hesitated to impose restrictions when two competing groups have sought to use the same name for a church. *See* Def.'s Memorandum in Support of Motion to Dismiss (Doc. 30), pp. 16-17. The logic behind not allowing two churches to use the exact same, such as First Presbyterian

Church, is self-evident. No defensible position exists, however, for denying every individual the right to use the name of his or her chosen religion, which is why we have Bible Presbyterians, Evangelical Presbyterians, Reformed Presbyterians, Orthodox Presbyterians, Cumberland Presbyterians. . . Upper Cumberland Presbyterians, etc. RSUF, ¶ 17 (*See* Wikipedia entry for “List of Christian Denominations,” available at www.Wikipedia.com, last accessed January 4, 2008).

One would think that Plaintiffs, as members of Seventh-Day Adventism, would look positively on the fact that the religion has become so prevalent that it is experiencing the same “growing pains” already undergone by more established denominations such as the Catholics, Baptists and Presbyterians. Instead, Plaintiffs have ignored their own teachings on religious liberty and attempted to use trademark law to control the growth of the religion.

Genuine issues of material fact exist as to whether Plaintiffs marks have become generic. Plaintiffs’ evidence that they are entitled to summary judgment boils down to the argument that their marks are not generic because they are incontestable, were registered more than 20 years ago, and they have three outdated surveys—the most recent of which is inherently flawed and almost a decade old—that show that the public associates the term “Seventh-day Adventist” with their church. By Plaintiffs’ own admission, however, Seventh-Day Adventism is a religion that has continued to grow worldwide. As the Wikipedia entry on denominations illustrates, the longer a religion exists and the larger it grows, the more likely it is to sprout more denominations. RSUF, ¶ 47. Both Pastor McGill and Russell Kelly—a theology graduate from a college associated with Plaintiffs and a former minister in Plaintiffs’ denomination—believe that Seventh Day Adventism is a generic term used to describe a religion. RSUF, ¶ 43.

Additionally, at least two other denominations other than Defendant's have continuously used the words Seventh Day Adventist for eight years since the *Perez* case and nine years since the last survey on public perception. RSUF, ¶ 43. Even if this Court were to find the *Perez* opinion dispositive as to whether Plaintiffs' marks were not generic in 2000, that does establish that the marks have not become generic since that time. Defendant's evidence raises a genuine issue of material fact about whether the marks have become generic, and therefore, Plaintiffs' motion for summary judgment should be denied.

2. In the alternative, Plaintiffs' marks are descriptive but have not acquired secondary meaning.

Should this Court find that no genuine issue exists regarding the factual question of whether Plaintiffs marks have become generic, this Court should hold that a genuine issue of material fact exists as to whether Plaintiffs' marks have acquired secondary meaning.

Only "distinctive" marks are accorded trademark protection. *Leelanau Wine Cellars v. Black & Red*, 502 F.3d 504 (6th Cir. 2006). Arbitrary, fanciful, or suggestive marks are inherently distinctive and protectable as opposed to so-called "generic" marks, which may never qualify for trademark protection. *Id.* Between these two poles lie "descriptive" marks, which are not inherently distinctive but may enjoy the benefit of protection if they develop a secondary meaning. *Id.* A descriptive mark achieves secondary meaning when in the minds of the public, the primary significance of a term is to identify the source of the product rather than the product.

Plaintiffs' recitation of the seven factors the Sixth Circuit considers when determining if a descriptive mark has obtained secondary meaning is misplaced. *See Memorandum In Support of Plaintiffs' Motion for Summary Judgment (Doc. 37-15), pp. 9-10.* Plaintiffs' marks have not

achieved secondary meaning based on the same argument that Plaintiffs' marks are generic. Plaintiffs claim that their marks have become distinctive as a result of the large number of people to whom they have ministered and the millions of dollars and considerable effort spent promoting the marks. *See* Memorandum In Support of Plaintiffs' Motion for Summary Judgment (Doc. 37-15), p. 10. As this Court has no doubt already noticed in reviewing the parties' briefs, however, cramming religion into rubric of trademark law is difficult, at best. Plaintiffs' propositions actually support Pastor McGill's position—the greater the amount and manner of “advertising” a religion does and the amount of “sales” and “customers” it has, the more likely it is that the particular religion will become generic. RSUF, ¶ 47. The evolution of various denominations, such as the Baptists, Catholics and Presbyterians, illustrates that a religion is most likely to have secondary meaning in its early years.

For example, the Branch Davidian Seventh Day Adventists, an offshoot of the Davidian Seventh Day Adventists, likely have acquired secondary meaning in the descriptive terms “Branch Davidian” because of the Waco incident in 1993. Most people probably equate “Branch Davidian” with the source (the particular Texas group) as opposed to the product (religious denomination). Over time, however, if the religious denomination became increasingly popular, at some point the term would represent the product (religious denomination) as opposed to the source, and it would not be unusual to see offshoot denominations such as the Orthodox Branch Davidians or Evangelical Branch Davidians. The very existence of the Creation Seventh Day & Adventist Church, the Branch Davidian Seventh Day Adventists, and the Seventh Day Adventist Reform Movement provide evidence that the term “Seventh-day Adventist,” has lost any

secondary meaning it may have had. For this reason, a genuine issue of material facts exists, and Plaintiffs' cannot prevail on summary judgment.

3. In the alternative, little, if any, likelihood of confusion exists between Plaintiffs' and Defendant

Should this Court find that no genuine issue of material facts exists regarding the "incontestability" of Plaintiffs' marks, genuine issues of material fact exist as to whether Plaintiffs' and Defendant's marks are subject to a likelihood of confusion.

Courts determine whether a likelihood of confusions exists by examining the eight *Frisch* factors: (1) "strength of the plaintiff's mark," (2) "relatedness of the goods or services," (3) "similarity of the marks," (4) "evidence of actual confusion," (5) "marketing channels used," (6) "likely degree of purchaser care," (7) "the defendant's intent in selecting its mark," and (8) "likelihood of expansion of the product lines." *Gibson Guitar Corp. v. Paul Reed Smith Guitars, LP*, 423 F.3d 539, 548 (6th Cir. 2005) (quoting *Jet, Inc. v. Sewage Aeration Sys.*, 165 F.3d 419, 422 (6th Cir. 1999)).

The question of whether there is a likelihood of confusion is a mixed question of fact and law. *Gibson Guitar*, 423 F.3d at 548 quoting *Homeowners Group, Inc. v. Home Mktg. Specialists, Inc.*, 931 F.2d 1100, 1107 (6th Cir. 1991). Factual findings must be made with respect to the likelihood of confusion factors, but whether a given set of foundational facts establishes a likelihood of confusion is a legal conclusion. *Id.* To resist summary judgment where the likelihood of confusion is the dispositive issue, a nonmoving party must establish, through pleadings, depositions, etc., that there are genuine factual disputes concerning those *Frisch's* factors which may be material in the context of the specific case. *Id.* Section 1115(b)

places a burden of proving likelihood of confusion (that is, infringement) on the party charging infringement even when relying on an incontestable registration. *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 121 (2004).

Evidence of actual confusion

Plaintiffs base much of their confusion argument on a series of guestbook entries to the Creation Seventh Day & Adventist Church website which they conclude establish that people visiting Defendant's website have mistaken it for a website run by Plaintiffs. *See* Memorandum In Support of Plaintiffs' Motion for Summary Judgment (Doc. 37-15), pp. 6-8. Pastor McGill cannot recall any time that anyone signed his guest book under the impression that his church was connected with the General Conference of Seventh-day Adventists, and it would surprise him if such entries did exist. RSUF, ¶ 46 (*See* Deposition of Walter McGill, May 15, 2007, pp. 100-101 (excerpts attached to RSUF as Exhibit I)). The first problem with Plaintiffs' conclusions about the entries, however, is that they assume that these people use the term "Seventh-Day Adventist" or "SDA" to mean the Plaintiffs' church and not the religion. Second, out of more than 75 entries in Defendant's guestbook, many of which have pointed questions or comments about the differences between the two denominations, Plaintiffs' have selected only a handful of entries. RSUF, ¶ 46. Several of these selected entries are vague or from people who appear to be from other countries and may be facing language barriers, while others do not even support Plaintiffs' position. RSUF, ¶ 46.

For example, in the third entry cited in Plaintiffs' brief, Bates No. GC01813, the guest states that she is "currently a New member of the Seventh Day Adventist Church." She then asks for information on "your church. I need the closest Address to North Miami, Florida." This

suggests that this person is not confused about where she is—why would someone who is *already* a new member of Plaintiffs’ church ask for information on the closest address of “your church” in Miami, Florida? The clear import of the entry is that the woman is looking for information a Creation Seventh Day & Adventist denomination near her.

In another entry that allegedly illustrates confusion, a fourteen-year-old who says she has been raised Seventh-day Adventist, writes that she found some of the health information very informational. *See* Bates No. GC01833, Memorandum In Support of Plaintiffs’ Motion for Summary Judgment (Doc. 37-15, p. 7). She then goes on to say that she will be sure to tell her “fellow church members,” among others. *Id.* Her entry supports a conclusion that she is confused as much as it supports the conclusion that the health information she read taught her about a belief different from her own held by the Creation Seventh Day Adventists, and she wanted to share it with her church members.

Plaintiffs’ reliance on the guestbook to show confusion fails, because it is a guessing game; it is impossible to discern from many of the selected entries whether the person is confused or just dealing with a language barrier. Plus, the test inquires as to the *likelihood* of confusion, not *possible* confusion. The standard in assessing the likelihood of confusion to the public is the typical buyer exercising ordinary caution. *See Pita Delight v. Salami*, 24 F. Supp. 2d 795, 802 (E.D. Mich. 1998). As Defendant’s overall guestbook shows, most people who visit the site are not confused. RSUF, ¶ 46. Genuine disputes over material facts also exist for several of the remaining seven *Frisch* factors.

Strength of Plaintiffs’ mark

At most, as argued above, Plaintiffs’ marks are merely descriptive and any secondary

meaning that may have been acquired decreases with each passing day and each new member. As Plaintiffs point out, their marks have been in use more than 150 years. SUF, ¶ 40. And as the *Thermos* decision underscores, time wears down the distinctiveness of many marks. *See King-Seeley Thermos Co. v. Aladdin Industries, Inc.*, 321 F.2d 577, 581 (2nd Cir. 1963)

Relatedness of goods or services, marketing channels used, and the likelihood of expansion of the product lines

The nature of religion again demonstrates why it is ill-suited for trademark law when applying the second, fifth, and eighth *Frisch* factors. Defendant's church is of the same faith as Plaintiffs', Seventh Day Adventism, so the goods and services offered are undoubtedly related, the marketing channels used are similar, and the likelihood of the expansion of the Defendant's product lines is certain, but based on the denomination's growth.

Similarity of the marks

Plaintiffs claim protection for the marks "Adventist," "Seventh-day Adventist," "General Conference of Seventh-day Adventists," and the acronym "SDA." Pastor McGill and the Plaintiffs' "Adventist" marks are identical. Pastor McGill has never used the mark "General Conference of Seventh-Day Adventists," in connection with any products, services or religious observances except to differentiate Plaintiffs from the Creation Seventh Day & Adventist Church. RSUF, ¶ 28.

Pastor McGill uses the generic "SDA" mark in connection with products, services and religious observances. RSUF, ¶ 36. Even if "SDA" is a valid mark, Pastor McGill's mark, "CSDA" is wholly different and unique from Plaintiffs' marks and meets the YWCA test discussed in his Motion to Dismiss. *See National Board of YWCA v. YWCA of Charleston*, 335

F. Supp. 615 (D. S.C. 1971); *see also*, Defendant's Memorandum in Support of Motion to Dismiss (Doc. 30-2), pp. 17-18.

Plaintiffs' final mark, "Seventh-day Adventist" is also not similar to the mark Pastor McGill uses. Pastor McGill's mark does not have the hyphen between "Seventh" and "day," the word "Day is capitalized" and the CSDA logo has the "&" symbol or its lingual equivalent between "Seventh Day" and "Adventist." RSUF, ¶ 46. Pastor McGill also uses the article "The" and the word "Creation" in front of the worldwide church and the article "a" and the word "Creation" at the beginning of marks when identifying the local congregation, i.e. "A Creation Seventh Day & Adventist Church." RSUF, ¶ 46.

Likely degree of purchaser care

The sixth *Frisch* factor is probably the one factor out of the eight that weighs most heavily in Pastor McGill's favor. For most people, religion encompasses deeply personal and core beliefs. As the North Carolina Supreme Court has noted, church names are important to people because they associate them with "the most sacred of their personal relationships and the holiest of their family traditions." *The Board of Provincial Elders of the Southern Province of The Moravian Church v. Jones*, 159 S.E.2d 545, 551 (N.C. 1968). The degree of "purchaser care" in this case is about as high as it gets. It is hard to imagine someone "purchasing" Defendant's products carelessly. Few, if any, members of the public familiar with Plaintiffs' church would make it through a full worship service, much less the door, without realizing that they were not in one of Plaintiffs' churches. Those unfamiliar with the differences between Plaintiffs' and Pastor McGill's denominations would learn quickly too, since Creation Seventh Day Adventists openly and actively identify themselves as wholly separate from the Plaintiffs.

RSUF, ¶ 46.

Defendant's intent in selecting the mark

Plaintiffs urge this Court to find that no material dispute exists regarding Pastor McGill's intent in selecting the mark, the seventh *Frisch* factor. Pastor McGill, however, has repeatedly stated that he uses the term "Seventh Day Adventist" as part of the name of his church because he is required to by his religion. RSUF, ¶ 7 (*See* Affidavit of Walter O. McGill, ¶ 2 (attached as Exhibit A to RSUF). Pastor McGill's church openly and actively identifies itself as wholly separate from the Plaintiffs' church. RSUF, ¶ 46. In fact, Pastor McGill has modified the name of his church to the extent allowable by the dictates of his faith in an effort to avoid confusion. RSUF, ¶ 46.

III. CONCLUSION

Plaintiffs' Motion for Summary Judgment should be denied. Genuine issues of material fact exist for the jury to determine whether Plaintiffs' marks were, or have become generic. In the alternative, genuine issues of fact exist over whether Plaintiffs' marks have lost any secondary meaning. And should this Court grant summary judgment on the issue of infringement, the foundational facts in this case establish a dispute of material issues over whether a likelihood of confusion exists between Plaintiffs' and Defendant's marks.

Dated: January 7, 2008

Respectfully submitted,

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CERTIFICATE OF SERVICE

I, Charles L. Holliday, hereby certify that on January 7, 2007, I electronically filed the foregoing with the Clerk of the Court for the Western District of Tennessee via the Electronic Filing System with notice to Plaintiffs' attorneys, Emily C. Taube and Joel Galanter, and all parties listed on the Electronic Filing Receipt.

S/ Charles L. Holliday
CHARLES L. HOLLIDAY