

First Independent Church of Scientology” Serial No. 86817837 (79176)

I. Section 2(d) Refusal - Likelihood of Confusion

Registration of the applied-for mark is refused because of a likelihood of confusion with the marks in U.S. Registration Nos. 5246747, 5156526, 5134065, 5241823, 5241821, 5223543, 5223542, 5228480, 5241822, 5200277, and 5119859. In view of the following arguments and remarks, applicant respectfully requests that applicant's mark be approved for registration.

A. Cited Marks are Different In Appearance, Sound, Connotation and Commercial Impression From Applicant's Mark.

Marks must be viewed as a whole in assessing whether there would be a likelihood of confusion.

First, the cited marks are “Scientology Media Productions Los Angeles Historic Cultural Monument Est. 1912,” and “Scientology Media Productions,” most of which include an extensive graphics/logo that is dominantly depicted with respect to the wording and includes that wording only in its margins. In contrast, applicant's mark consists of five different words "First," "Independent," "Church," "Of," and "Scientology." The only common term between the cited marks and applicant mark is the term "Scientology" for which no prior registration has been cited. Consequently, it is clear that the compared marks in their entireties convey a significantly different commercial impression having several (up to nine) terms that are different and an extensive graphics/logo that is dominantly depicted.

More importantly, this common term ("Scientology") is merely descriptive describing a certain religion of scientology, if not generic (see discussion in Section C below) and therefore is not likely to be perceived by relevant consumers as a distinguishing source. See, for example, TMEP §1207.01(b)(iii); *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011); where the Federal Circuit affirmed Trademark Trial and Appeal Board's (TTAB) holding that there were no likelihood of confusion between “CAPITAL CITY BANK” mark which included a design consisting of a five-pointed star inside of a circle and the Opposer's registered mark “CITI BANK,” even though CITI BANK mark was widely used and recognized. (Id.). The court based its opinion on i) “CCB's marks are spelled differently than Citigroup's marks,” ii) “frequent usage of the phrase "City Bank" in the banking industry,” iii) and “the role of the word ‘Capital’ in distinguishing CCB's marks from Citigroup's marks.” (Id.).

Here, very similar to the above case, i) the marks are not only spelled differently including different terms, but most of them also include extensive graphics/logos that are dominantly depicted overshadowing the wording; ii) the frequent use of the common word scientology describing a certain religion, used as a "quasi science" related to study or investigation of knowledge, or epistemology, defined in Registrant's own website (without any trademark notice) as literally meaning "knowing how to know," or epistemology (Exhibit A, [2]); and iii) the role of the additional terms "First," "Independent" and "Church," in applicant' mark and even more different terms in the cited marks, eliminates any likelihood of confusion between the applicant

mark and the cited marks. See also, *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004).

Second, applicant's mark consists of five different words "First," "Independent," "Church," "Of," and "Scientology." The only common term between the cited marks and applicant mark is the term "Scientology" for which no prior registration has been cited. However, the prominent and distinctive portion of the applicant's mark is the word "Independent," which is the second word in the mark versus "Scientology," which is the fifth and last word of the mark describing a certain religion. This prominent and distinctive portion of the applicant's mark, "Independent," has a commonly known meaning of:

a (1) : *not subject to control by others :self-governing* (2) :*not affiliated with a larger controlling unit* <an independent bookstore>b (1) : *not requiring or relying on something else : not contingent* <an independent conclusion> (2) : *not looking to others for one's opinions or for guidance in conduct* (3). *not bound by or committed to a political party* c (1) : *not requiring or relying on others (as for care or livelihood).*

Merriam-Webster Dictionary. See, <http://www.merriam-webster.com/dictionary/independent>

"Not being subject to control, or affiliated with others," "not requiring or relying on something else," or "not looking to others for one's opinions or for guidance in conduct," creates a significantly different appearance, meaning and commercial impression from the cited marks "Scientology Media Productions Los Angeles Historic Cultural Monument Est. 1912," and "Scientology Media Productions" with or without the extensive graphics included therein. In fact, the term "Independent" as the prominent term of the applicant's mark makes it clear to the consumers that the services provided under applicant's mark are not related or affiliated with those provided under the cited marks.

Therefore, applicant's mark is significantly different in appearance, meaning and commercial impression from the cited registered marks.

Third, the addition of the other two words "First" and "Church" in the five-word applicant's mark of "First Independent Church of Scientology" provides a different commercial impression than the cited marks. There are many known marks, which include the distinctive word "First" to distinguish them over other marks or generic names, such as "First Foundation Trust," "First Foundation Advisors," "First Foundation," "First Foundation Bank," "Consumer First," "First Market Capital," "First Aid," etc.. Accordingly, the addition of the particular word "First" (in addition to the distinctive word "Independent") to many marks, operates to significantly differentiate between them. Additionally, there is a clear distinction between the term "Church" in the applicant's mark and the term "Media Productions" in the cited marks.

As a result, applicant's mark is significantly different in appearance, meaning and commercial impression from the cited registered marks.

B. Sophisticated Relevant Buyers of Applicant's Services Are Not Likely to be Confused by Registrant's Marks.

The consumers of both applicant's services and the services of registrant are professionals, celebrities, prominent business owners and educated individuals who are sophisticated and are familiar with the service providers of such religious services nation-wide. Most of these sophisticated consumers are repeat customers and are closely familiar with various service providers in religious, self-fulfillment, spiritual, ministerial industries. Since applicant's mark prominently includes the term "Independent," which stands for "Not being subject to control, or affiliated with others," "not requiring or relying on something else," or "not looking to others for one's opinions or for guidance in conduct, such sophisticated consumers would readily recognize that the source of goods and services for the applicant's mark is not the same as those of the registrant's.

As Professor McCarthy so appropriately stated (*J. Thomas McCarthy, McCarthy on Trademarks*, §23:101) "[m]any cases state that where the relevant buyer class is composed of professionals or commercial buyers familiar with the field, they are sophisticated enough to not be confused by trademarks that are closely similar. That is, it is assumed that such professional buyers are less likely to be confused than the ordinary consumer." Thus, while two marks might be sufficiently similar to confuse an ordinary consumer, a professional buyer or an expert in the field may be more knowledgeable and will not be confused. (See, for example, *Arrow Fastener Co. v. Stanley Works*, 59 F.3d 384 35 U.S.P.Q.2d 1449 (2nd Cir. 1995), where knowledgeable buyer of defendant's \$400 pneumatic stapler gun used for building construction and furniture manufacture is sophisticated and not likely to be confused with defendant's model number; and *CMM Cable Rep. v. Ocean Coast Props., Inc.* 888 F. Supp. 192, 36 U.S.P.Q.2d 1458 (D. Me. 1995), *aff'd*, 97 F.3d 1054, 41 U.S.P.Q.2d (1st Cir. 1996), where sophisticated professional buyers "are less likely to be confused as to the source of origin of a product than ordinary consumers of inexpensive foods or services"; summary of judgment of no likelihood of confusion of radio station executives.

Here, like any of the above cases, relevant buyers of registrant's services are professionals and educated individuals, who are more knowledgeable than ordinary consumers and thus will not be confused by applicant's use and registration of "First Independent Church of Scientology" for spiritual ministry services.

In short, considering differences in appearance, meaning and commercial impression of the marks and the sophistication of the relevant class of consumers of the services, no likelihood of confusion would arise as a result of applicant's use and registration of the trademark of "First Independent Church of Scientology" for spiritual ministry services.

C. The Term "Scientology" Has Become a Generic Term and Therefore is Not Entitled To a Trademark Protection.

"A generic or common descriptive term is one which is commonly used as the name or description of a kind of goods." *Miller Brewing Co. v. G. Heileman Brewing Co.*, 561 F.2d 75, 79. "The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question." *H. Marvin Ginn Corp. v. Int'l Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 530 (Fed. Cir. 1986); *In re America Online Inc.*, 77 USPQ 2d. 1618, 1622 (TTAB 2006). Trademarks act as source-identifiers; their purpose is to distinctly point out the source of

the goods. *In re Taylor & Francis Publishers, Inc.*, 55 U.S.P.Q.2d 1213, 1215 (T.T.A.B. 2000) (holding that "a generic entity designation [] is incapable of serving a source-indicating function"); TMEP § 1209.03(d) (same).

Here, for example, in a book (Exhibit A, [1]) written in the year 1910 (way before the term "scientology" was coined by the registrant, Religious Technology Center Corporation), the term "scientology" was used generically all over the book as a "quasi science" related to study or investigation of knowledge, or epistemology.

Registrant's own website defines scientology (without any trademark notice) as literally meaning "knowing how to know," or epistemology (Exhibit A, [2]). This word has now become generic for religious services including "Religious and Ministerial Services Including pastoral Counseling." (See, the cited Registration No. 1318717).

Additionally, another registrant's own website ("scientology.org") (Exhibit A, [3]), uses numerous headers including the word scientology generically and without any trademark notice. For example, "Scientology Video Channel", "Scientology Newsroom", "What is Scientology?", "Scientology Today", "Inside a church of Scientology", "New Churches of Scientology", "Meet a Scientologist", "Scientology Today", "Ideal Saint Hill Inauguration Crowns Extraordinary Scientology Season of Expansion", "What is the Concept of God in Scientology?", "David Miscavige - Scientology's Ecclesiastical Leader", "The Scientology Bridge to Total Freedom", "Scientology Beliefs and Practices", etc. If Scientology is supposed to be an adjective, they could talk about Scientology processing, or something like that. There are two references to "the Scientology religion", but there is also a statement that "Scientology is a religion ...". The word Scientology is mostly used as a generic noun.

In this main website, the word Scientology and Scientologist are shown in the same font as the surrounding text, do not stand out and lack any trademark notices.

Accordingly, the members of the relevant public primarily visiting registrant's website understand the terms Scientology and Scientologist refer to the genus of services for "Religious and Ministerial [and spiritual] Services," and not the specific services or goods provided by the registrant.

Generic terms are in the public domain and should be free for all to use.¹ As the U.S. Supreme Court stated: "Sharing in the goodwill of an article unprotected by patent or trademark is the exercise of a right possessed by all—and in the free exercise of which the consuming

¹ *King-Seeley Thermos Co. v. Aladdin Industries, Inc.*, 321 F.2d 577, 581, 138 U.S.P.Q. 349 (2d Cir. 1963) ("The word [Thermos] 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."); *Application of Sun Oil Co.*, 57 C.C.P.A. 1147, 426 F.2d 401, 404, 165 U.S.P.Q. 718 (1970) ("All of the generic names for a product belong in the public domain."); *Henri's Food Products Co., Inc. v. Tasty Snacks, Inc.*, 817 F.2d 1303, 1305, 2 U.S.P.Q.2d 1856 (7th Cir. 1987) ("[A] generic name is irretrievably in the public domain, and the preservation of competition precludes its protection.").

public is deeply interested.”² To grant an exclusive right to one firm of use of the generic name of a product would be equivalent to creating a monopoly in that particular product, something that the trademark laws were never intended to accomplish³. Judge Friendly remarked that to permit exclusive trademark rights in a generic name “would grant the owner of the mark a monopoly, since a competitor could not describe his goods as what they are.”⁴

Registrant consistently refers to scientology as a religion. See, for example, Exhibit A [1] and [2]:

<http://www.scientology.org/what-is-scientology/the-practice-of-scientology.html>

Within the vast amount of data which makes up Scientology’s religious beliefs and practices there are many principles which, when learned, give one a new and broader view of life.

Here, to grant an exclusive right to registrant for use of the generic name of a religion would be equivalent to creating a monopoly in that particular religion, which is also against the First Amendment rights of free exercise of religion.

Over time, a myriad of terms were held to be generic and unprotectable as valid marks. For example, CHRISTIAN SCIENCE (for a religious organization following the teachings of Mary Baker Eddy), was held to be generic.⁵ Other terms that started as a protectable trademarks and then were held generic and therefore unprotectable as valid marks include: MONTESSORY (for educational method and toys used for such method)⁶, SELF-REALIZATION (a type of yoga spiritual organization)⁷, SOCIOGRAPHICS (for technique of management consulting)⁸,

² Kellogg Co. v. National Biscuit Co., 305 U.S. 111, 83 L. Ed. 73, 59 S. Ct. 109 (1938).

³ Car-Freshner Corp. v. Auto Aid Mfg. Corp., 461 F. Supp. 1055, 201 U.S.P.Q. 233 (N.D.N.Y. 1978); Anti-Monopoly, Inc. v. General Mills Fun Group, 611 F.2d 296, 204 U.S.P.Q. 978 (9th Cir. 1979) (“Trademarks are not properly used as patent substitutes to further or perpetuate product monopolies.”); Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 189 U.S.P.Q. 759, 769 (2d Cir. 1976) (to protect a generic name would be to confer a “monopoly” on one seller in the sale of the named product); A.J. Canfield Co. v. Honickman, 808 F.2d 291, 1 U.S.P.Q.2d 1364, 1375 (3d Cir. 1986) (“The genericness doctrine prevents trademarks from serving as the substitutes for patents, and protects the public right to copy any non-patented, functional characteristic of a competitor's product.”).

⁴ CES Publishing Corp. v. St. Regis Publications, 531 F.2d 11, 188 U.S.P.Q. 612, 615 (2d Cir. 1975) (the author would slightly amend this comment to substitute “name” for “describe”).

⁵ Christian Science Bd. of Directors of First Church of Christ, Scientist v. Evans, 105 N.J. 297, 520 A.2d 1347, 2 U.S.P.Q.2d 1093 (1987).

⁶ American Montessori Soc’y v. Association Montessori Internationale, 155 U.S.P.Q. 591, 1967 WL 7288 (T.T.A.B. 1967).

⁷ Self-Realization Fellowship Church v. Ananda Church of Self-Realization, 59 F.3d 902, 35 U.S.P.Q.2d 1342 (9th Cir. 1995) (“Self-Realization” held to be a generic name for a type of organization dedicated to spiritual attainment in the manner taught by yoga, but a descriptive term when used in connection with products and services sold by the organization; no secondary meaning found.).

THERMOS (for vacuum-insulated bottles)⁹, EASTER BASKET (Easter floral bouquet)¹⁰, and many more.

In the present case, similar to CHRISTIAN SCIENCE, the term Scientology has become generic. Also, it is a well-established law that showing of secondary meaning can never earn trademark status for a generic word or phrase.¹¹

D. Even if the term "scientology" has not become a generic term, Registrant's Mark is a Weak Mark and Therefore is Entitled to a Narrower Scope of Protection.

Exhibit B is a list of various media using the term scientology generically to refer to product or services defined by the term that are not associated with those of the registrant. As evidenced by Exhibits A and B, there are many media that use the term scientology generically. As stated above, registrant's own websites use the term scientology (and scientologist) generically without any trademark notice. Therefore at a minimum, on the scale of trademarks, the marks including some or all of the above word (in IC 042) must be considered rather weak.

One important factor to be relied upon in determining registrability of a mark is the strength or weakness of the marks at issue. *See, e.g. In re Hamilton Bank*, 222 U.S.P.Q. 174 (T.T.A.B. 1984). Even weak marks are entitled to protection. *In re National Data Corp.*, 222 U.S.P.Q. 515 (T.T.A.B. 1984), *aff'd* 224 U.S.P.Q. 749 (Fed. Cir. 1985); *Plus Products v. Physicians Formula Cosmetics, Inc.*, 198 U.S.P.Q. 111 (T.T.A.B. 1978); *In re Textron, Inc.*, 180 U.S.P.Q. 341 (T.T.A.B. 1973). However, weak marks are entitled to a narrower scope of protection than strong marks. Based on the premise that weak marks are entitled to limited protection, the courts and the Trademark Trial and Appeal Board have repeatedly held that even where marks are nearly identical and even where the goods at issue are related to one another, confusion is not likely where the marks themselves are weak and where there are specific differences between the particular goods.

For example, *In re General Motors Corp.*, 23 U.S.P.Q. 2d 1465 (T.T.A.B. 1992), registration of the mark GRAND PRIX for automobiles was refused by the examining attorney based on a prior registration for the identical mark for use with automobile tires. However, the Board reversed the examining attorney in spite of the fact that the identical mark was used on closely related goods. In reaching this decision, the Board pointed out that the term "grand prix" was a weak mark. Therefore, based in large part on specific differences in the goods at issue, the Board concluded that confusion was not likely. (23 U.S.P.Q. 2d at 1470.)

Here, there is evidence of many media that use the term scientology generically, without referring to registrant's services or source of such services. Therefore, the cited marks, which

⁸ *In re B. C. Switzer & Co.*, 211 U.S.P.Q. 644 (T.T.A.B. 1981).

⁹ *King-Seeley Thermos Co. v. Aladdin Industries, Inc.*, 321 F.2d 577, 138 U.S.P.Q. 349 (2d Cir. 1963).

¹⁰ *Teleflora, Inc. v. Florists Transworld Delivery Ass'n*, 217 U.S.P.Q. 1081 (C.D. Cal. 1981).

¹¹ *General Conference Corporation of Seventh-Day Adventist v. Seventh-Day Adventist Kinship International, Inc.* 1991 WL 11000345, *4+, C.D.Cal; and *American Ort, Inc. v. Israel* 2007 WL 2049733, *6+, S.D.N.Y.

consist of or include the above word, are weak marks. Because of the weakness of the cited marks, as a whole, the registered marks are entitled to only narrow protection and do not bar registration of applicant's mark.

Applicant respectfully submits that the evidence in Exhibits A and B relied upon by Applicant is properly submitted and carries evidentiary value. According to the Trademark Trial and Appeal Board, such evidence is "competent to show that others in a particular area of commerce have adopted and registered marks incorporating a particular term." *In re Hamilton Bank*, 222 U.S.P.Q. 174, 177 (T.T.A.B. 1984). In that decision, a number of prior registrations for marks that included the word "key" were cited by applicant to establish that its stylized trademark for KEY, though admittedly weak, was entitled to some narrow scope of protection. In reversing the refusal of registration, the Board relied on the evidence submitted by applicant and held that confusion was not likely. *Id.* at 178. Therefore, the evidence submitted by Applicant must be considered.

In short, considering the substantial differences in appearance, sound, connotation and commercial impression in applicant's mark from the cited marks, many generic and descriptive uses of the word "scientology", the sophistication of the relevant class of consumers, and the weakness of the cited marks, no likelihood of confusion would arise as a result of applicant's use and registration of the trademark of "First Independent Church of Scientology," for spiritual ministry services. Accordingly, applicant respectfully requests that applicant's mark be approved for registration.

As a result, applicant respectfully requests that applicant's mark be approved for registration.

Exhibit A

Many other references to the term "scientology" in connection with religious, ministerial and spiritual services can be found by running a Google™ or Yahoo™ search.

[1] The New Word by Allen Upward, Mirtchel, Kenerly, New York,1910. Online archived searchable copy available at:

https://archive.org/stream/newwordanopenle01upwagoog/newwordanopenle01upwagoog_djvu.txt

I find there are at least three atoms known to science, or at least to **Scientology**, the arithmetical atom, the physical one, and the logical one. Of these the logical one has been kept intact by unheard of efforts ; the other two have been split, and are being split every day.

All this is not really science, but only **Scientology**. It is language. It is the magic lullaby in which the shapes of things melt and reshape themselves forever.

It is no whit better than theological writing. And unhappily **Scientology** is as often mistaken for science as theology is for worship.

whereas Materialism was a mix - we had no quarrel with its facts. We distinguished between science and **Scientology**.

[2] "What Is Scientology" <http://www.whatisscientology.org/> Registrant's own website.

Definition of Scientology

The word Scientology is taken from the Latin *scio*, which means "knowing, in the fullest sense of the word," and the Greek word *logo*, meaning "study of." It literally means knowing how to know.

Scientology is knowing

YOURSELF, LIFE, FAMILY, the universe, the spirit, GOD

The study of Truth

Scientology is a religion in its highest meaning, as it helps bring man to total freedom and truth.

[3] "Scientology.org" <http://www.scientology.org/> This is one of the registrant's main websites.

Exhibit B

[1] **Kwanzaa: The Scientology of Holidays - Conservative Outfitters**

<https://www.conservativeoutfitters.com/blogs/news/11155173-kwanzaa-the-scientology-of-holidays>

[2] **Libertarianism: The Scientology of Politics - YouTube**

<https://www.youtube.com/watch?v=rpXJkwddsYY>

Jun 6, 2014 - Uploaded by The Majority Report with Sam Seder

After briefly discussing the paper, A Dilemma for Libertarians, with a listener, Sam and the crew get into a ...

[3] **The Scientology of Crossfit | Adam Berke | LinkedIn**

<https://www.linkedin.com/pulse/scientology-crossfit-adam-berke>

LinkedIn

Nov 24, 2015 - I am not a douche-bag, I am "Crossfit confident"? The first time I witnessed Crossfit I was working on Brickell Avenue in Miami's financial district.

[4] **Paleo is the Scientology of Diets | Body for Wife**

www.bodyforwife.com/paleo-is-the-scientology-of-diets/

I was close to landing a fitness interview with Tom Cruise, but then he bailed. And so I am now free to say that **Scientology** is stupid. People make fun of the ...

[5] **Giordano Memorization System (GMS) - The "Scientology of memory ...**

mt.artofmemory.com/.../giordano-memorization-system-gms-the-scientology-of-mem...

I've been doing a bit of research on GMS (Giordano Memorization Systems), which one poster here referred to as "**the Scientology of memory systems**".

[6] **The Beatles: The Scientology Of Pop - The Afterword**

theafterword.co.uk › Blog

Nov 3, 2015 - Maybe I don't like some of them, maybe you don't, but the argument that The Beatles Are The Best is now the scripture of **the Scientist**.

[7] **The scientology of pizza - The Something Awful Forums**

<https://forums.somethingawful.com/showthread.php?threadid=3786008>

42 posts - 6 authors

the scientology of pizza. ... Yobgoblin. **scientology** has science in it but the only math they do is counting their dirty money. 519x301. Emotes I bought: Thanks to: ...

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