

No. 10 - 1707

UNITED STATES COURT OF APPEALS FOR THE EIGHTH CIRCUIT

COMMUNITY OF CHRIST COPYRIGHT CORPORATION and COMMUNITY
OF CHRIST aka REORGANIZED CHURCH OF JESUS CHRIST OF LATTER
DAY SAINTS,

Plaintiffs-Appellees,

v.

DEVON PARK RESTORATION BRANCH OF JESUS CHRIST'S CHURCH and
DAVID MCLEAN,

Defendants-Appellants.

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE
WESTERN DISTRICT OF MISSOURI IN 4:08-CV-00906,
JUDGE GARY A. FENNER.

BRIEF OF PLAINTIFFS-APPELLEES

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SUMMARY OF THE CASE

This appeal arises from the District Court's summary judgment enforcing the trademark rights of Appellees Community of Christ Copyright Corporation and Community of Christ aka Reorganized Church of Jesus Christ of Latter Day Saints (collectively the "Church"). Appellant Devon Park Restoration Branch of Jesus Christ's Church, led by its pastor, Appellant David McLean, (collectively "Devon Park"), is a separatist group that has never been an authorized branch of the Church; yet it used some of the Church's long-held trademarks, particularly the name Reorganized Church of Jesus Christ of Latter Day Saints, to promote its own religious services in the same locale as the Church to attract members of the public, including Church members, to its services and to avoid the perception that it had formed a new church. Based on these undisputed facts, the District Court permanently enjoined Devon Park from using the Church's trademarks. Given the deliberate and willful nature of Devon Park's infringement, the District Court also held the case exceptional and awarded the Church its reasonable attorney fees.

The District Court dismissed Devon Park's counterclaims for cancellation of the Church's federally registered marks, finding Devon Park's claims of entitlement to use the marks meritless. The Church submits that Devon Park's appeal is equally so. As such, the Church believes that 15 minutes for each side at oral argument will be sufficient to assist the Court in this appeal.

CORPORATE DISCLOSURE STATEMENT

Pursuant to Federal Rules of Appellate Procedure 26.1 and Local Rule 26.1A, Community of Christ Copyright Corporation and Community of Christ aka Reorganized Church of Jesus Christ of Latter Day Saints state that there is no parent company or subsidiary of either party and neither party has issued shares to the public.

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I. STATEMENT OF THE ISSUES

1. Did the district court properly enjoin Devon Park, a religious organization unaffiliated with the Church, from using the Church's trademarks on its sign, in its sanctuary, and on its written materials to promote its religious services in the same vicinity as the Church when Devon Park admits that: it did not have permission to use the Church's marks; it used the marks to attract Church members to itself; and it placed the Church's full name mark, Reorganized Church of Jesus Christ of Latter Day Saints, on its sign so others would not think it had started a new church?

- 15 U.S.C. §§ 1114, 1125(a)(1)
- *Kemp v. Bumble Bee Seafoods, Inc.*, 398 F.3d 1049 (8th Cir. 2005)
- *SquirtCo v. Seven-Up Co.*, 628 F.2d 1086 (8th Cir. 1980)
- *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397 (8th Cir. 1987)

2. A federally registered trademark is presumed to be distinctive and, thus, protectable. But it may lose that status if consumers understand that the mark is not distinctive, but has become generic, i.e., that it refers to a class of services or products rather than identifying the source of particular services or products offered under the mark. The Church's full name and RLDS marks are federally registered and, thus, presumed to be distinctive and protectable. Did the District

Court properly protect the Church's marks and reject Devon Park's claim that they have become generic given that Devon Park admitted that it could accurately offer its services under non-infringing names and also failed to present any evidence of how consumers understand the marks, much less sufficient evidence to rebut the presumption of distinctiveness the marks enjoy?

- 15 U.S.C. § 1115(a)
- *First Federal Savings and Loan Association of Council Bluffs v. First Federal Savings and Loan Ass'n of Lincoln*, 929 F.2d 382 (8th Cir. 1991)
- *Anheuser-Busch Inc. v. Stroh Brewery Co.*, 750 F.2d 631 (8th Cir. 1984)
- *Te-Ta-Ma Truth Found.-Family of URI, Inc. v. World Church of Creator*, 297 F.3d 662 (7th Cir. 2002)

3. A trademark may be considered abandoned only if the owner ceases using it with the intent not to resume use or otherwise causes the mark to lose its significance as an indicator of origin. When the Church adopted its additional name, Community of Christ, it concurrently announced that it was retaining the name Reorganized Church of Jesus Christ of Latter Day Saints. The Church has continued to use its trademarks on the exterior and interior of many of its buildings, on hymnals used in each of its authorized congregations in the United States, on weekly orders of worship at various authorized congregations, on books and other goods sold in its stores, and in a variety of other ways. Given these

circumstances, did the District Court correctly find that the Church had not abandoned its trademarks?

- 15 U.S.C. § 1127
- *Guiding Eyes for the Blind, Inc. v. Guide Dog Found. for the Blind, Inc.*, 384 F.2d 1016 (C.C.P.A. 1967)
- *Electro Source, LLC v. Brandess-Kalt-Aetna Group, Inc.*, 458 F.3d 931 (9th Cir. 2006)

4. Under the Lanham Act, courts may award reasonable attorney fees to the prevailing party in exceptional cases. A case is exceptional when a party intentionally and willfully infringes another's trademark. Did the District Court properly award reasonable attorney fees to the Church where Devon Park used the Church's trademarks without permission, knowing that the District Court had recently enforced the Church's rights in the same marks against a similarly situated entity, defiantly stating in a letter to the Church that it would continue using the marks, refusing to respond to the Church's cease and desist letter because it had no intent to cease using the marks, and using the marks because it believed it could attract Church members and did not want others to believe it had started a new church?

- 15 U.S.C. § 1117(a)

(continued on the following page)

- *Metric & Multistandard Components Corp. v. Metric's, Inc.*, 635 F.2d 710 (8th Cir. 1980)
- *Hallmark Cards, Inc. v. Hallmark Dodge, Inc.*, 634 F. Supp. 990 (W.D. Mo. 1986)

II. STATEMENT OF THE CASE

The Church agrees with the procedural posture of this appeal provided in Devon Park's Statement of the Case, with the clarification that the District Court determined as part of its January 14, 2010 summary judgment order that this case was an "exceptional case" under the Lanham Act entitling the Church to its attorney fees and, after subsequent briefing, determined the amount of fees to be awarded as part of its order on March 24, 2010. The latter order rejected Devon Park's arguments seeking reconsideration of the "exceptional case" determination. In addition, the Church does not agree with several of Devon Park's argumentative statements concerning the merits of the case. First, the Church did not recently obtain its marks; it has used its full name mark, REORGANIZED CHURCH OF JESUS CHRIST OF LATTER DAY SAINTS, since 1869, its RLDS mark since 1931, and its design marks in various forms since 1965. The Church registered its RLDS mark and one of the design marks at issue in the 1970s and then registered its full name mark and another design mark in 2006. Second, there is no evidence that Devon Park or any member of the consuming public use the Church's full name or RLDS marks to refer generically to religious services or membership in a

church. Finally, the Church has not abandoned its marks; it and its members continue to use the marks for their intended purposes.

III. STATEMENT OF THE FACTS

Devon Park provides a number of facts that were never presented to the District Court before it issued the summary judgment order. Because Devon Park has intermingled new information with undisputed facts presented to the District Court and because the Church does not believe Devon Park has fairly characterized a number of the material facts, the Church first presents below what it believes to be the material undisputed facts, followed by a response to each section of Devon Park's statement of facts.

A. THE MATERIAL UNDISPUTED FACTS

The Church owns the following federally registered trademarks:

- a. Service Mark Registration No. 3,188,759 for REORGANIZED CHURCH OF JESUS CHRIST OF LATTER DAY SAINTS (Add. 1; PI 5-7);¹
- b. Collective Membership Mark Registration No. 956,687 for RLDS (Add. 2; PI 8-11);
- c. Service Mark Registration No. 1,044,453 for PEACE (and design) (Add. 3; PI 12-15); and

¹ Documents in the Addendum to the Appellee Church's Brief are referenced as "Add. ___" while documents in the Addendum to Appellant Devon Park's Brief are referenced as "A___." References to "PI ___" indicate pages in the Preliminary Injunctions Exhibit Appendix; and references to "App. ___" indicate pages in the Joint Appendix.

- d. Service Mark Registration No. 3,173,265 for REORGANIZED CHURCH OF JESUS CHRIST OF LATTER DAY SAINTS PEACE (and design version 1) (Add. 4; PI 16-17).

In addition, the Church owns the unregistered mark REORGANIZED CHURCH OF JESUS CHRIST OF LATTER DAY SAINTS PEACE (and design version 2).

App. 407. The design marks (also referred to as "seals") are displayed below:



Reg. No. 1,044,453



Reg. No. 3,173,265



Unregistered Mark

The Church has used one or more of these marks to distinguish its ministerial services throughout the world and to identify its 250,000 members for more than 125 years. Add. 1-4; PI 5-17, 175.

In April 2000, the Church adopted the additional name Community of Christ. At that time, the Church announced its intent to continue using the Reorganized Church of Jesus Christ of Latter Day Saints mark. App. 416 (69:11-72:8). Since then, the Church has continued to use the full name mark, the RLDS mark, and the design marks on the exterior and interior of the buildings of many of its authorized congregations (including its world headquarters and multiple congregations in Independence, Missouri), in publications, to hold title to real

estate, in the receipt of gifts and bequests, and as identifiers by its members, both as a matter of outward display and as a matter of personal expression of faith, inside Church sanctuaries, in the worship setting, on podiums, on hymnals, and on books and assorted items for sale in its bookstores. Add. 5-10; PI 18-103; App. 408 (37:13-38:1), 410 (47:2-49:3), 411 (51:11-52:16), 435 (146:3-148:20); 481 (328:21-329:24), 494 (380:10-381:15).

Since the adoption of the name Community of Christ, members of the Church have continued to identify themselves using the RLDS mark. For example, some use the RLDS mark as their user name in email addresses (such as rldsguy@verizon.com), on a license plate, on license plate frames, and in referring to themselves as members of Community of Christ by stating, for instance, that they are "a member of the RLDS Church" or that they are "fifth generation RLDS." PI 104-06; App. 415 (65:19-66:10 and 67:9-67:15), 484 (342:2-9).²

The Church recently defended its exclusive right to use its REORGANIZED CHURCH OF JESUS CHRIST OF LATTER DAY SAINTS and RLDS marks in *Community of Christ Copyright Corp. v. Miller*, No. 07-0543-CV-W-GAF, 2007 WL 4333192 (W.D. Mo. Dec. 7, 2007). In *Miller*, the district court preliminarily enjoined South Restoration Branch and its pastor, Charles Miller, from using those

²The photograph of the "RLDS" Virginia license plate at PI 104 was not admitted into evidence at the preliminary injunction hearing; however, the accompanying Virginia Department of Motor Vehicles documents (PI 105-06) were admitted into evidence.

marks and any confusingly similar mark in signage, advertising, and literature. *Id.* at *3. The case was ultimately resolved with a consent judgment that permanently enjoined defendants Miller and South Restoration Branch from using the marks. App. 403-04 (20:5-21:18).

Appellant Devon Park is what is known as a "Restoration Branch" and was originally formed in 1987 by individuals who separated themselves from the hierarchical structure of the Church. App. 443-44 (179:19-181:13). Devon Park is not and never has been an authorized congregation of Community of Christ. App. 444 (181:24-182:4). It "is entirely separate from, and independent of, the institutional portion of the RLDS Church and all its officers whatsoever." App. 444-45 (184:5-185:6). Devon Park's official name of incorporation is "Devon Park Restoration Branch of Jesus Christ's Church." App. 444 (182:5-10).

Devon Park's current sign, which is erected outside of its building in Independence, Missouri and advertises its religious services, is pictured below:



Add. 15; PI 117-21; App. 404 (23:15-24:8), 460 (243:10-12). Devon Park deliberated about installing this sign and determined to use the full name, Reorganized Church of Jesus Christ of Latter Day Saints, so people would not think it had started a new church. App. 460 (243:25-244:19). It also claims that it is important to use the Church's marks to identify itself in order to gather to itself members of the Church who may not be currently attending church. App. 509-10 (442:16-443:9). Nevertheless, Devon Park admits that its sign would still be accurate if it used non-infringing names, such as its official name, Devon Park Restoration Branch of Jesus Christ's Church, or descriptive language such as "We follow the original doctrines of Joseph Smith III." App. 460 (243:25-244:19).

Devon Park has also used the Church's marks on a bronze seal mounted in its sanctuary, on a flag hanging in its sanctuary, in various business meeting minutes, newsletters, and social event flyers, on its website, in periodic ads placed with the Independence Examiner, and on baptismal, priesthood, and baby blessing certificates. App. 552. Devon Park did not ask for or obtain authorization from the Church to use its marks in any manner. App. 461 (247:9-17), 509 (441:24-442:8).

On October 16, 2008, the Church received a letter from Devon Park stating that it was using and intended to continue using the Church's marks on signage, literature, church bulletins, and advertisements. Add. 11-14; PI 110-113. The purpose of the letter was to inform the Church that Devon Park intended to continue using the Church's marks. App. 461 (248:10-13). Devon Park was aware of the district court's orders in the *Miller* case. App. 403-04 (19:18-21; 20:5-21:18), 461 (248:20-22). It sent the October 16, 2008 letter, in part, due to the outcome of the *Miller* case. App. 461 (247:24-248:1). Devon Park was also aware that the Church was using its marks on the exterior of its church buildings and that other Restoration Branches operate without using the Church's marks. App. 403 (17:20-18:13), 458 (238:13-15), 509 (440:14-441:7).

The Church sent a letter back to Devon Park requesting that it cease and desist from using the marks. App. 461 (248:17-19). Devon Park did not respond

to the Church's letter because it had no intention to stop using the marks. App. 461 (249:5-7). As a result, the Church filed this lawsuit for, among other things, trademark violations under 15 U.S.C. §§ 1114 and 1125.

B. RESPONSE TO DEVON PARK'S FACTS

Devon Park Brief, Statement of Facts, Section A (pp. 5-8): Devon Park did not submit the alleged facts on pages 5-6 (concerning the purported continuation of the "true RLDS Church" in splinter groups, the perpetuation of "branches," and church government) for consideration at summary judgment. It therefore cannot rely on them now. *See Winthrop Res. Corp. v. Eaton Hydraulics, Inc.*, 361 F.3d 465, 469 (8th Cir. 2004) ("we review de novo only the evidence and arguments that were made before the district court when it made its determination in the orders challenged on appeal"). The affidavit of Robert Moore (App. 1022-26), which is cited for these propositions, was not presented at the evidentiary hearing or during summary judgment briefing. It was submitted to the District Court after the summary judgment ruling, when Devon Park filed its opposition to the Church's statement detailing the amount of attorney fees sought to be recovered. App. 1026. Devon Park also did not submit the alleged facts in the carryover paragraph on pages 7-8 (for which there is no citation to the record) concerning new by-laws and designation of fundamental units and seed congregations. These "facts" may be properly disregarded on appeal. But even if they are considered,

they are immaterial to the issues on appeal and would not preclude summary judgment. The remaining facts in Section A are generally uncontroverted, though Devon Park's characterizations of testimony or other cited evidence are not always consistent with the record and less precise on appeal than in the summary judgment briefing.

Devon Park Brief, Statement of Facts, Section B (at 8-13): Pages 8-10 of these alleged facts are largely based on materials that were never admitted into evidence at the preliminary injunction hearing nor properly authenticated. Such materials include (in order of appearance in Appellants' Brief) App. 192, App. 139, A-38, App. 193, App. 137, and App. 102 (which is merely argument from Devon Park's preliminary injunction opposition brief). Further, in a number of instances, Devon Park stretches or mischaracterizes the underlying evidence. For instance, App. 480 does not support Devon Park's statement at p. 12 that "no money has been spent by COC to promote religious services in the RLDS name." The cited testimony was that the witness did not know whether or not the Church had spent any money since April 6, 2001 to promote the name Reorganized Church of Jesus Christ of Latter Day Saints. App. 480 (324:21-325:3). Devon Park ignores the evidence that the Church offers its religious services under the marks and undertakes efforts to ensure the quality of the religious services offered under its

marks, including stopping unauthorized use of its marks. Add. 5-10; App. 403 (19:2-19:15), 413 (57:25-59:3), 416-17 (72:18-75:6).

Likewise, App. 440 does not support Devon Park's statement that the Church presents itself to the public only as Community of Christ. Instead the cited testimony was that the Church's international headquarters presents itself to the public as Community of Christ. There is no dispute that the Church has taken steps to make the name Community of Christ known in the public, but that has no bearing on what the consuming public understands the Church's marks in question to mean.

Finally, although Devon Park uses rhetoric (such as "flooded the local market" and "aggressive program") that is not found in the record as cited, there is ultimately no dispute in general with the remaining facts in this section that the Church undertook a program to change most of its signs and documentation to reflect the name Community of Christ and that the latter name is considered to reflect the Church's mission. But none of these facts controverts the Church's undisputed evidence of continued use of the marks-in-suit.

Devon Park Brief, Statement of Facts, Section C (at 13-15): In this section, Devon Park makes a material admission concerning its infringement. At page 15, Devon Park expressly admits that the Church has continuously used the "Peace" trademark (Registration No. 1,044,453) and holds all right, title, and interest in it.

Although Devon Park claims not to use this mark, it ignores the facts that it uses a seal that is identical to the Church's unregistered mark, which includes the same child, lion, and lamb figures placed above the word "Peace" in Registration No. 1,044,453. Add. 3, 8, 11; App.460 (245:10-24). Thus, although Devon Park may not be using the exact PEACE design mark, its use of a seal that is confusingly similar to the registered mark and identical to the Church's unregistered mark constitutes infringement and dilution.

Devon Park's remaining facts in this section are generally undisputed, though Devon Park makes several unsupported exaggerations. First, Devon Park's evidence does not establish that the "RLDS moniker is no longer available to designate a religious affiliation for those who enlist in the military . . . or those that are admitted to hospitals." App. 470 (286:9-17) merely states that the Church gave notice to the branches of the armed forces of the new name, Community of Christ; and App. 449 (203:3-17) merely establishes that an employee in a local hospital denied Appellant McLean the use of RLDS to identify his religious affiliation and, instead, offered that he (being the pastor of a Restoration Branch) could use the word "Restoration." But even if RLDS were no longer available for use in the armed forces or in hospitals, that would not negate the uncontroverted evidence that Church members continue to use RLDS to designate their membership in the Church, through license plates, license plate holders, email usernames, and in

common parlance. PI 104-06; App. 415 (65:19-66:10 and 67:9-67:15), 484 (342:2-9).

Devon Park Brief, Statement of Facts, Section D (at 15-16): These facts are not disputed, but they are incomplete. For example, although Devon Park prefers to focus on statements that the RLDS name was retained "for legal purposes" it ignores language from the Church's official world conference resolution stating that "concurrent" with the adoption of the name Community of Christ, the RLDS name was to remain "legally binding." PI 107. It also ignores testimony that the Church leadership understands this provision to mean that it will continue to use its Reorganized Church of Jesus Christ of Latter Day Saints name and may not abandon it without authorization from a world conference. App. 416 (69:11-70:21).

Devon Park likewise attempts to minimize the number of authorized congregations in the United States where the Church continues to use the marks-in-suit. Rather than a mere "handful," the evidence shows that the Church displays only the full name mark, Reorganized Church of Jesus Christ of Latter day Saints, on the signs of at least 51 of its authorized congregational buildings, and that another unknown number of authorized congregations added signs with the Community of Christ name but also retained their original signs that bear the Reorganized Church of Jesus Christ of Latter Day Saints mark. Add. 5-8; PI 22-

44; App. 435 (146:3-148:20). Likewise, while acknowledging that the design marks are embedded in some of the Church's buildings, Devon Park attempts to minimize that admission by stating that they are "often" difficult to see from the street. Devon Park's evidence for that qualification, however, is equivocal. Its witness testified that he did not know if five of the design marks (or seals) he was shown (PI 37, 38, 40, 41, 42 (Mission Woods)) were visible from the street, while stating only that two were not readable from the street (PI 39, 42 (Gudgell Park photograph)). More importantly, Devon Park ignores the evidence (photographic and testimonial) that these seals are found on the exteriors and interiors of Church buildings and on podiums throughout the United States in easily removable as well as built-in forms. Add. 5-8; PI 23-45; App. 408 (37:13-38:1), 410 (47:2-49:3), 411 (51:11-52:16), 481 (328:21-329:24), 494 (380:10-381:15).

Devon Park Brief, Statement of Facts, Section E (at 16-17): The Church does not controvert the facts that the referenced advertisements were run in *The Examiner*. However, as explained in Argument Section VI.B.1. below, the advertisements are not evidence of generic use of the RLDS or full name marks because in every instance RLDS or the full name is used to refer to the Church or its members and not, as Devon Park argues, to a set of beliefs or members of other churches.

Devon Park Brief, Statement of Facts, Section F (at 17-19): The first sentence of this section (concerning Devon Park's sign) is uncontroverted. But Devon Park's subsequent description of the sign's purpose is not consistent with the record. Devon Park's record citations do not reflect the "facts" in this section. Moreover, Devon Park omits the testimony of its pastor that Devon Park deliberately used the Church's full name mark, Reorganized Church of Jesus Christ of Latter Day Saints, on its sign because he did not want people to think he and his followers had started a new church. App. 460 (243:25-244:19).

With respect to the asserted facts concerning the lack of mistaken donations or known expressions of confusion, there is no dispute. But the cited testimony differs from Devon Park's statement that its members hold to the "traditional RLDS beliefs." Rather than referring to "RLDS beliefs," the actual testimony uses the RLDS mark to identify the Church, not as a generic term for a set of doctrines or practices. App. 453 (217:11-14) (affirming that "members that are choosing to worship with the Devon Park Branch are there worshipping because they hold the beliefs, traditional beliefs, of the RLDS Church . . ."). Likewise, although the facts in the final paragraph of this section are uncontroverted, Devon Park has stretched them improperly to imply that RLDS refers to something other than the Church or its members. The affidavits of Messrs. Howell and Worthington both define "RLDS" as the Reorganized Church of Jesus Christ of Latter Day Saints.

App. 622 (¶ 9), 700 (¶ 7) ("I do not associate the traditional doctrines and beliefs of the Reorganized Church of Jesus Christ of Latter Day Saints, or RLDS, with the religious services offered by the Community of Christ church"). Given this definition, their later references to the "RLDS religion" are at best ambiguous and, in any event, do not serve to create a material issue of fact on the question of genericness.

Devon Park Brief, Statement of Facts, Section F [sic] (at 19-20): Most of the facts in this section are uncontroverted, with only the following exceptions. First, Devon Park cites no evidence to support its contention that the Church abandoned its marks. The facts are to the contrary. Add. 5-10; PI 18-106; App. 408 (37:13-38:1), 411 (51:11-52:16), 415 (65:19-66:10 and 67:9-67:15), 481 (328:21-329:24), 484 (342:2-9), 494 (380:10-381:15). Second, Devon Park may have used the RLDS and full name marks for twenty years, but it cites to no evidence that its use was "tolerated and permitted by the COC." Devon Park omits the undisputed evidence that the Church first became aware of Devon Park's use of the full name mark on its sign during the *Miller* trademark litigation. App. 417 (75:7-16). Unlike other entities that may have received permission at one time to use the marks, Devon Park admitted that it never received permission to use the Church's marks. App. 461 (247:9-17), 509 (441:24-442:8). Finally, Devon Park dissembles in claiming (without a citation to the record) that it did not respond to

the Church's cease and desist letter because it had "already explained its position." The record shows that Devon Park never responded to the Church's letter because it had no intention to stop using the Church's trademarks. App. 461 (249:5-7).

IV. SUMMARY OF THE ARGUMENT

The District Court properly entered summary judgment in favor of the Church. The uncontroverted facts show that Devon Park intentionally displayed the Church's trademarks on its sign, in its sanctuary, and in other ways to attract people (including the Church's members) to Devon Park's competing worship services. Devon Park was formed in the late 1980s by a small group of dissident Church members who disagreed with certain changes in the Church's practices. Devon Park is not and never has been an authorized congregation of the Church. Yet Devon Park insists on holding itself out as the Reorganized Church of Jesus Christ of Latter Day Saints because it does not want the public to believe that it formed a new church. Trademark law is well equipped to deal with this improper trading on the Church's goodwill.

This Court has long held that religious, fraternal, benevolent, or social associations are entitled to injunctive relief against the use by another of their name or emblem and of any name or emblem so similar as to likely create confusion. *Talbot v. Independent Order of Owls*, 220 F. 660, 661-62 (8th Cir. 1915) (it was "too clear for discussion" that separatist group's use of the name Independent Order

of Owls and emblem similar to that used by senior organization, Order of Owls, was likely to create confusion and to deceive). Applying this Court's six-factor test under *SquirtCo v. Seven-Up Co.*, 628 F.2d 1086, 1091 (8th Cir. 1980), the District Court correctly found that five of the factors weigh in favor of finding a high likelihood of confusion. A22. The undisputed facts on those five factors show that the marks-in-suit are strong, that Devon Park is using marks identical to the Church's marks in the same geographical vicinity, that Devon Park is offering competing religious services under the Church's marks, that Devon Park intended to pass off its services as the Church's, and that the likelihood of confusion as to Devon Park's affiliation with the Church as a result of using the Church's marks cannot be eliminated by the exercise of care by even sophisticated persons. Although the remaining factor (actual confusion) remains neutral, the law does not require a showing of actual confusion to find a likelihood of confusion. As the District Court held, there is no genuine issue of fact for trial under any of these factors.

Devon Park seeks to excuse its admitted use of the Church's trademarks by arguing that the trademarks have become generic or have been abandoned. With respect to its "genericness" argument, Devon Park ignores the presumption of distinctiveness that is afforded federally registered trademarks. Although it argues that the RLDS name has significance apart from indicating membership in the

Church and that it has become the generic name of a religion, it never offers evidence that supports this theory. Courts look to what consumers understand a mark to mean when determining whether the mark is generic. But Devon Park has offered no survey, expert, or other evidence as to what religious consumers, let alone the general public, may or may not understand. Its only evidence is a set of advertisements placed by it and various other splinter groups at various times prior to 2000 and two affidavits from leaders of competing splinter groups. Those advertisements and leaders use the RLDS mark to refer to the Church and its members, not a particular set of religious beliefs or services. Moreover, they do not ever profess to reflect the understanding of the consuming public. Finally, like other splinter groups, Devon Park has alternative ways to identify itself without using the Church's marks. "To determine that a trademark is generic and thus pitch it into the public domain is a fateful step" *Ty Inc. v. Softbelly's, Inc.*, 353 F.3d 528, 531 (7th Cir. 2003) (J. Posner). Devon Park's unsupported arguments do not approach the standard required to rebut the presumption of distinctiveness that the Church's registered marks enjoy, nor do they offer any reasonable basis for taking the "fateful step" of pitching the Church's long established marks into the public domain.

Devon Park's arguments of abandonment are similarly meritless. Clear and convincing evidence is required to prove that a trademark has been abandoned.

Devon Park has advanced no such evidence. Apparently feeling unconstrained by the facts, Devon Park argues that the Church "eliminated virtually all public references to the RLDS name." In making this statement, Devon Park ignores the uncontroverted evidence (including its own admissions) detailing how the Church continues to use its marks to promote its ministerial services. For example, the Church displays only the full name mark, Reorganized Church of Jesus Christ of Latter Day Saints, on signs in front of at least 50 of its congregational buildings. In addition, it uses both the full name mark and its Community of Christ name on signs in front of a number of its congregational buildings. And the Church displays its design marks even more extensively inside and outside of the Church's buildings, including on podiums in its worship sanctuaries that are open to the public. Finally, the full name mark is found in the hymnals used by every congregation of the Church.

There is no dispute that today the Church predominantly uses the name Community of Christ and believes the name embodies its mission. But giving greater prominence to the new name does not constitute abandonment of the Church's marks-in-suit, which would require actual cessation of use coupled with an intent not to resume use or otherwise causing the marks to lose their significance as indicators of origin. The uncontroverted facts show that the Church has continued to use all of the marks-in-suit to offer its service to the public or

identify its members, and the Church's own resolution adopting the name Community of Christ plainly expresses an intent to continue using the Reorganized Church of Jesus Christ of Latter Day Saints name. There is, thus, no evidence of abandonment.

Without evidence that the Church's marks are generic or abandoned, Devon Park is left with no defense for its trademark infringement and no counterclaim for cancellation of the Church's federal registrations. As a result, the Church is entitled to a permanent injunction to ensure that it will not continue to be harmed by Devon Park's unlawful activities. Finally, Devon Park cannot deny that it intentionally infringed the Church's marks. It acknowledged using the Church's marks without permission, admitted that it was aware of the Church's prior actions to enforce its trademark rights, admitted it wished to use the Church's marks to avoid having potential members believe it had started a new church, and refused to respond to the Church's letter requesting that it cease and desist from using the marks-in-suit. Under the Lanham Act, such deliberate and willful conduct warrants an award of attorney fees to the Church.

V. STANDARD OF REVIEW

The Church accepts Devon Park's statement of the standard of review. In addition, in a trademark infringement case, summary judgment is appropriate when "a trade mark dispute centers on the proper interpretation to be given to the facts,

rather than on the facts themselves." *Davis v. Walt Disney Co.*, 430 F.3d 901, 905 (8th Cir. 2005).

VI. ARGUMENT

A. THE DISTRICT COURT PROPERLY FOUND THAT DEVON PARK'S USE OF THE CHURCH'S MARKS CREATES A LIKELIHOOD OF CONFUSION.

The District Court properly granted summary judgment on the Church's claims for trademark infringement and unfair competition under the Lanham Act, 15 U.S.C. §§ 1114 and 1125(a)(1), because there is no genuine issue of material fact that the Church owns federally protected trademarks, and Devon Park's use of those marks creates a likelihood of confusion.

This Court considers six factors in determining likelihood of confusion: (1) the strength of the trademark owner's mark; (2) the similarity between the trademark owner's and infringer's marks; (3) the degree to which the services offered under the infringing mark compete with the trademark owner's services; (4) the infringer's intent to confuse the public; (5) the degree of care reasonably expected of potential customers; and (6) evidence of actual confusion. *See Kemp v. Bumble Bee Seafoods, Inc.*, 398 F.3d 1049, 1053 (8th Cir. 2005); *SquirtCo v. Seven-Up Co.*, 628 F.2d 1086, 1091 (8th Cir. 1980). "[N]o one factor controls, and because the inquiry is inherently case-specific, different factors may be entitled to more weight in different cases." *Kemp*, 398 F.3d at 1054. In addition, "[f]actual

disputes regarding a single factor are insufficient to support the reversal of summary judgment unless they tilt the entire balance in favor of such a finding." *Davis*, 430 F.3d at 903. As found by the District Court, "five of the factors weigh heavily in favor of finding a high likelihood of confusion, while the remaining factor remains neutral." A22.

1. The Church's marks are strong or have acquired significant secondary meaning.

"Generally, the strength of a mark depends on two factors--the distinctiveness of the mark and the extent to which the mark is recognized by the relevant consumer class." *Aveda Corp. v. Evita Marketing, Inc.*, 706 F. Supp. 1419, 1428 (D. Minn. 1989). The Church's registered marks are presumed to be distinctive, and the Church's long, prominent, and substantially exclusive use of its marks bolsters that presumption. *Aromatique, Inc. v. Gold Seal, Inc.*, 28 F.3d 863, 869 (8th Cir. 1994). Devon Park has not rebutted the presumption of distinctiveness the Church's registered marks enjoy and admits that there is no dispute that the "RLDS name" is distinctive and meaningful. *See* Appellants' Brief at 37. Contrary to Devon Park's argument that the Church's marks are associated with restoration branch services, which is not supported by any citation to the record, there is no evidence that the consuming public understands the Church's marks to refer to a class of religious services offered by restoration branches like

Devon Park such that it would leave Devon Park without means to identify its services without using the Church's marks.

Moreover, as the District Court found, Devon Park's intentional copying and threat to continue using the Church's marks on ministerial services in the same geographic area as the Church, despite the availability of Devon Park's own distinct name for use in identifying its services, evidences how highly distinctive the Church's marks are. A18; App. 460-61; *see Ford Motor Co. v. Lloyd Design Corp*, 184 F. Supp. 2d 665, 670 (E.D. Mich. 2002) (intentional and precise copying of another's mark is evidence of strong secondary meaning). Accordingly, the District Court properly found that the Church's marks are "very strong and/or have developed secondary meaning" and weighed this factor in favor of a likelihood of confusion. A19.

2. Devon Park is using marks that are identical or nearly identical to the Church's marks.

Devon Park's appropriation of the Church's exact marks without authorization suffices in and of itself to establish a likelihood of confusion. *See Solutech, Inc. v. Solutech Consulting Servs., Inc.*, 153 F. Supp. 2d 1082, 1088 (E.D. Mo. 2000) (foregoing the traditional six-factor analysis because a likelihood of confusion was presumed when the infringer used marks identical to the trademark owner's marks in the same geographic area and on the same class of services as the trademark owner. Devon Park has admitted using and threatening

to continue using marks identical to the Church's marks³ on the sign outside its church building, on display in its sanctuary, on ministerial publications, and on other church-related documents. Add. 5-10; PI 110-13; App. 404, 460, 552.

Devon Park's use of the Church's marks in this manner alone establishes a likelihood of confusion.

For the first time on appeal, Devon Park argues that its use of the phrase "Devon Park Branch" underneath the Church's Reorganized Church of Jesus Christ of Latter Day Saints mark distinguishes it from the Church. It also argues that it is not offering its religious services in the same geographic area as the Church. In its brief in opposition to the Church's motion for summary judgment, Devon Park did not present any arguments to the District Court on this factor. Thus, this Court may decline to entertain Devon Park's arguments that could have been, but were not, made to the District Court. *Cole v. Int'l Union, United Auto., Aerospace & Agric. Implement Workers of America*, 533 F.3d 932, 936 (8th Cir. 2008) ("a party cannot assert arguments that were not presented to the district court in opposing

³ Devon Park contends that it has not infringed the Church's PEACE (and design) mark because it has not used an identical seal. This is incorrect. Devon Park admits that it has a large seal hanging in its sanctuary that is very similar if not identical to the Church's unregistered seal, which incorporates the child, lion, lamb, and "PEACE" feature of the Church's PEACE (and design) mark. Add. 3, 8, 11; App. 460. Thus, Devon Park has infringed the church's PEACE (and design) mark by using a seal design that is confusingly similar to the registered mark.

summary judgment in an appeal contesting an adverse grant of summary judgment).

However, even if the Court considers these untimely arguments, they fail. Devon Park's first argument is absurd. By placing the phrase "Devon Park Branch" directly under the full name mark, Reorganized Church of Jesus Christ of Latter Day Saints, Devon Park is obviously suggesting that it is affiliated with the Church. Devon Park admits as much when it conceded that it deliberately used the full name mark so others would not think Devon Park had started a new church. App. 460. With regard to Devon Park's second argument, there is no dispute that Devon Park was aware of the Church's use of its marks in Independence, Missouri, the same town where Devon Park uses its infringing marks. App. 509. Accordingly, the District Court properly found that this factor, at a minimum, weighs heavily in favor of finding a likelihood of confusion. A19.

3. Devon Park is using the Church's marks for the same services for which the marks are registered.

Devon Park has used the Church's marks for the purpose of offering its ministerial services and identifying its members. Add. 11-15; PI 110-13; App 404, 460, 552. These are precisely the services for which the Church's marks were registered and are used. Add. 1-4. On this basis alone, the Church is entitled to a presumption that there is a likelihood of confusion. *Solutech*, 153 F. Supp. 2d at 1088.

Devon Park argues that its religious services are not similar to the Church's religious services because the underlying beliefs differ. It misses the point. Because Devon Park is offering religious services under the Church's marks in the same town as the Church, it is inevitable that some members of the public who encounter Devon Park's church building sign, publications, and other materials will mistakenly conclude that there is some affiliation with the Church or that the Church has sponsored or approved of Devon Park's services. Moreover, Devon Park admits that it invites members of the Church to worship at Devon Park. App. 509-10. Because the District Court found that the Church and Devon Park are direct competitors, this factor weighs in favor of a likelihood of confusion. A20.

4. Devon Park intentionally copied the Church's marks to trade on the Church's goodwill in those marks.

Devon Park's intentional copying of the Church's marks also suffices in and of itself to establish a likelihood of confusion. *See Ford*, 184 F. Supp. 2d at 673 ("Since Defendant admitted to intentionally copying Plaintiffs' trademarks onto its [products], this factor alone is sufficient for the Court to find a likelihood of confusion."). The intent factor "demonstrates *the junior user's true opinion* as to the dispositive issue, namely, whether confusion is likely." *Kemp*, 398 F.3d at 1057 (*emphasis* in original). "An inference of an intent to trade upon the plaintiff's good will arises if the defendants, with knowledge of plaintiff's mark, chose a mark

similar to that mark from the infinite number of possible marks." *Aveda*, 706 F. Supp. at 1429-30.

On appeal, Devon Park argues, without pointing to any evidence, that it seeks to distinguish its services from those offered by the Church and that potential consumers do not associate the full name and RLDS marks with the Church. This is contrary to Devon Park's own witnesses' testimony that Devon Park determined to use the Church's full name mark, Reorganized Church of Jesus Christ of Latter Day Saints, on its sign so that people would not think Devon Park was a new church and that it is important to use the Church's marks to gather to themselves members of the Church who may not be attending services. App. 460, 509-10 Affidavits from two leaders of other splinter groups stating that they know the difference between Devon Park and the Church do not diminish Devon Park's knowing and unauthorized use of the Church's marks to trade on the goodwill the Church built through years of use, investment, and defense. As found by the District Court, this factor supports a likelihood of confusion. A20.

5. Regardless of the degree of care exercised by potential consumers, Devon Park's use of the Church's marks creates a likelihood of confusion.

It is undisputed that Devon Park is using the Church's marks on the sign outside of its church building to advertise its ministerial services and on displays in its sanctuary. "[E]ven a highly sophisticated and discriminating class of consumers

cannot be relied upon to allay confusion when the marks and products are nearly identical." *Centaur Commc'ns., Ltd. v. A/S/M Commc'ns., Inc.*, 652 F. Supp. 1105, 1113-14 (S.D.N.Y. 1987), *aff'd*, 830 F.2d 1217 (2d Cir. 1987).

Devon Park asserts that "a consumer seeking a new religious home is expected to exercise a good deal of care." This expectation is not supported by any citation to the record or case law. Even if taken as true, exercising "a good deal of care" will not preclude the likelihood that potential church members will view Devon Park's sign and be confused as to whether the services originate from the Church or are affiliated with, sponsored by, or approved by the Church. The District Court properly found Devon Park's "good deal of care" argument insufficient and weighed this factor in favor of a likelihood of confusion. A22.

6. Actual confusion is not necessary to establish a likelihood of confusion.

Devon Park relies on the lack of evidence of actual confusion to support its position that there is no likelihood of confusion. This does not create an issue of fact for trial. A trademark owner is not required to prove any instances of actual confusion. *See Pfizer Inc. v. Sachs*, 652 F. Supp. 2d 512, 523 (S.D.N.Y. 2009) ("[i]t is black letter law that actual confusion need not be shown to prevail under the Lanham Act, . . . [it] is very difficult to prove and the Act requires only a likelihood of confusion as to source."); *Ford*, 184 F. Supp. 2d at 671, 671 (same); *Aveda*, 706 F. Supp. at 1430 (same). Where there is an intentional use of identical

marks, on identical services, and in the same geographic location, there is a likelihood that the public will be confused as to whether Devon Park's services are affiliated with or authorized by the Church. *See Pfizer*, 652 F. Supp. 2d at 523, 527) (granting the trademark owner's motion for summary judgment on its infringement claims without evidence of actual confusion). The District Court appropriately found the lack of any evidence of actual confusion was a neutral factor in determining a likelihood of confusion. A21.

B. THE DISTRICT COURT PROPERLY HELD DEVON PARK LIABLE FOR TRADEMARK INFRINGEMENT, UNFAIR COMPETITION, AND DILUTION

The undisputed facts show that five out of the six *SquirtCo* factors weigh heavily in favor of finding a likelihood of confusion as a matter of law. Therefore, the District Court properly held Devon Park liable for infringement and unfair competition of the Church's federally registered marks under the Lanham Act. Devon Park has not addressed the Church's state and common law claims independent of the Church's Lanham Act claims on appeal. For the same reasons articulated by the District Court in holding for the Church on its federal claims, the District Court properly held Devon Park liable for dilution and unfair competition under state and common law. *See Gilbert/Robinson, Inc. v. Carrie Beverage-Missouri, Inc.*, 758 F. Supp. 512, 527 (E.D. Mo. 1991) (the same facts that support

a claim for trademark infringement support a claim for unfair competition, including infringement of common law trademark rights).

C. THE DISTRICT COURT PROPERLY ENJOINED DEVON PARK FROM CONTINUING TO INFRINGE THE CHURCH'S RIGHTS AND DILUTE THE CHURCH'S MARKS

It is axiomatic that "[i]n trademark infringement, it is not necessary for plaintiff to prove actual damage or injury to obtain injunctive relief. Injury is presumed once a likelihood of confusion has been established. All that the complaining party must do to establish its right to an injunction is to prove the likelihood of confusion." *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 403 n.11 (8th Cir. 1987) (citations omitted); *see also* Lanham Act, 15 U.S.C. § 1116(a) and Mo. Rev. Stat. § 417.061 (2008) (expressly authorizing injunctive relief for trademark violations and acts of dilution, respectively). Because Devon Park's use of the Church's marks creates a likelihood of confusion and of dilution the District Court properly enjoined it from such use.

D. THE DISTRICT COURT PROPERLY DISMISSED DEVON PARK'S AFFIRMATIVE DEFENSES AND COUNTERCLAIMS.

Devon Park argues that the Church's REORGANIZED CHURCH OF JESUS CHRIST OF LATTER DAY SAINTS and RLDS marks are generic, despite admitting that the marks are distinctive. It also argues that all of the Church's marks-in-suit (except for the PEACE and design mark) have been

abandoned, despite admitting that it knew the Church continued to use these marks after adopting the name Community of Christ. As explained in detail below, Devon Park has not established any dispute of material fact that should have precluded the District Court from enforcing the Church's marks.

1. The District Court properly held that the Church's full name and RLDS marks are not generic.

Under trademark law, the Church's full name and RLDS marks would be considered generic only if the relevant public understood that the marks refer to a particular genus or class of which the Church (and the services it offers) is but a member. *See Anheuser-Busch Inc. v. Stroh Brewery Co.*, 750 F.2d 631, 638 (8th Cir. 1984); *Hallmark Cards, Inc. v. Hallmark Dodge, Inc.*, 634 F. Supp. 990, 997 (W.D. Mo. 1986) (the generic term for greeting cards or social expression products is "Cards," not "Hallmark"). Citing *Te-Ta-Ma Truth Found.-Family of URI, Inc. v. World Church of Creator*, 297 F.3d 662, 666 (7th Cir. 2002), the District Court explained that "[a] mark is generic 'when it has become the name of a product (e.g., 'sandwich' for meat between slices of bread) or class of products (thus 'church' is generic).'" A17. The District Court properly held the Church's full name and RLDS marks not generic because they are not "representative or synonymous with religion or church in general; rather they distinguish [the Church's] unique and individual religious denomination and beliefs from others." A17. Furthermore, Devon Park provided no evidence that the public uses or understands these marks

to refer to a group of churches of which the Church is a member or members of organizations other than the Church.

The District Court's holding that the Church's full name and RLDS marks are not generic accords with this Court's precedent in *First Federal Savings and Loan Association of Council Bluffs v. First Federal Savings and Loan Ass'n of Lincoln*, 929 F.2d 382 (8th Cir. 1991). In *First Federal*, this Court held that the mark FIRST FEDERAL was not generic for a federal institution providing savings and loan services despite the fact that there were almost 300 such institutions with FIRST and FEDERAL in their names. *Id.* at 383. In its analysis, this Court explained, "One does not say that he or she is going down to the 'First Federal' to deposit some money or to take out a loan. Rather, one would say that he or she is going to the 'savings and loan,' or more likely, to the 'bank.'" *Id.* at 384. "Bank" is generic for a class of financial institutions; FIRST FEDERAL is a protectable trademark that identifies financial services offered by a particular institution.

Similarly, a member of the public would say he or she is going to the Reorganized Church of Jesus Christ of Latter Day Saints on Sunday only if he or she was referring to services offered by the Church and not if he or she was referring to services offered by religious institutions generally. In the latter case, someone would say "church" instead. *See Te-Ta-Ma Truth Found.*, 297 F.3d at 666 (finding the term "church" generic for religious services, holding "Church of

the Creator" not generic of such services, and listing "Church of Jesus Christ of Latter Day Saints" as another example of a non-generic name used to distinguish particular services under the class of monotheistic religious services).

The cases on which Devon Park relies do not support its position that the full name and RLDS marks have become generic. In *Christian Sci. Bd. of Dirs. of the First Church of Christ, Scientist v. Evans*, 520 A.2d 1347 (N.J. 1987), the plaintiff First Church of Christ Scientist did not have a federal registration for the terms "Christian Science Church" or "Christian Science" for religious services. *Id.* at 1350. Further, the name the defendants had chosen, "Independent Christian Science Church of Plainfield, New Jersey," differed from the formal name, "First Church of Christ, Scientist [geographical designation]," used by all authorized branches of the "Mother Church." *Id.* 1356. The court distinguished those cases in which dissident church groups were enjoined from using names identical or nearly-identical to names they held when formerly affiliated with their adversaries. *Id.* at 1356-57 (citing six cases enjoining use of names by dissident church branches that were identical or nearly-identical to the parent church).⁴

Similarly, the marks at issue in *General Conference Corp. of Seventh-Day Adventists v. Seventh-Day Adventist Kinship, International*, No. CV 87-8113 MRP,

⁴ It should be noted that Devon Park was never affiliated with the Church. It was formed as a new entity by a group of disaffected members of the Church. App. 444 (181:24-182:4).

1991 WL 11000345 (C.D. Cal. Oct. 7, 1991) were not distinctive marks like the Church's full name and RLDS marks here. The phrase "Seventh-day Adventist" (or its acronym SDA), literally and immediately denotes its dictionary definition, namely, "a member of a sect of Adventism distinguished chiefly for its observance of the Sabbath on Saturday." *See Seventh-Day Adventists*, 1991 WL 11000345, at *6-7 (holding "Seventh-day Adventist" generic, but noting that courts have reached conflicting results in cases involving religious institutions and that use of the phrase with the term "church" would arguably lead to a different result).

By contrast, Devon Park readily admits that the Church's full name and RLDS marks are meaningful and distinct. *See Appellant's Brief* at 37. The only reason that the Church's nine-word name and four-letter RLDS mark (which is not a true acronym) are meaningful and distinct is that the Church has extensively used the marks for more than 75 years to promote its services and identify its members and has spent considerable time and resources defending its exclusive right to do so. *Add.* 5-10; *PI* 18-106; *App.* 403, 408, 410-11, 413, 415-17, 481, 484, 494. Federal law prohibits Devon Park from taking advantage of the goodwill and secondary meaning the Church has developed in these marks.

Devon Park attacks the District Court's holding on the basis that there is an apparent inconsistency among courts as to whether denominational names should categorically be considered generic or descriptive. Whether courts have held

denominational names generic or not is not the issue here. The issue is whether the Church's marks are understood by the relevant public to refer to a class of services, within which both Devon Park and the Church provide services, such that it would leave Devon Park without means to identify its services without using the Church's marks. *See Ty Inc.*, 353 F.3d at 531-32 (fateful step of finding trademark generic not taken until trademark becomes exclusive descriptor of product precluding competitors from effectively describing their products)

Devon Park did not offer any survey or expert evidence to show what the relevant public understands the Church's marks to mean. Instead, it merely pointed to advertisements run by dissenting groups prior to 2000 and two affidavits from the leaders of two other splinter organizations. The advertisements obviously do not represent what the consuming public understands the Church's marks to mean, but they also do not support Devon Park's argument that various groups have used the RLDS or full name marks in a generic way to refer to religious services or doctrines. For example, Devon Park's own advertisements clearly state its official former name, "**SOUTHEAST INDEPENDENCE BRANCH**," in large, uppercase, bold type and, parenthetically in reduced, sometimes italicized type, that it is an "Ass'n of fundamental R.L.D.S." Sometimes Devon Park's advertisements include a second parenthetical explaining that Devon Park is "Not officially affiliated with the RLDS Church." Devon Park describes the services it

offers as "Sunday School," "Sunday Worship," "Communion Service," and "Wednesday Prayer Meeting." App. 711-44. Devon Park thus only used the RLDS name to refer to the Church or the Church's members, never generally to mean religious services. The same is true for virtually every other advertisement Devon Park submitted for the District Court's consideration. As summarized in the chart below, each advertisement uses the RLDS name to refer to either the Church or its members:

Entity Placing Advertisement	Language Used in Advertisement
Association of Independent Groups and Branches	<p>"The Association Invites All Fundamental RLDS"</p> <p>"All Fundamental RLDS Members Are Invited"</p> <p>"a religious organization comprised primarily of members of the Reorganized Church of Jesus Christ of Latter Day Saints. Not officially affiliated with RLDS Church."</p> <p>"RLDS Church members dedicated to the preservation of the Restored Gospel"</p>
Center Branch of the Lord's Remnant	"Services for fundamental R.L.D.S."
The Gathering Center	"Services Conducted For Fundamental RLDS Members"

Entity Placing Advertisement	Language Used in Advertisement
Hajicek Library	<p>"We buy books from members of both the RLDS Church and the Restoration Branches"</p> <p>"The Largest Known Library of RLDS & Related Books Outside Utah."</p>
Independence Branch's Restoration Headquarters	"Invites RLDS World Conference Visitors to attend Restorationist Services"
Independence Center Branch	"Fundamental RLDS: not officially affiliated with the Reorganized Church of Jesus Christ of Latter Day Saints"
Liahona Branch	"Services for Fundamental RLDS"
The Lord's Remnant	<p>"Services for fundamental R.L.D.S."</p> <p>"Services for fundamental members of the R.L.D.S. Church"</p>
Price Publishing Company	"Featuring literature which proclaims the original RLDS beliefs"
Restoration Bookstore	"features religious literature which proclaims the <u>original</u> doctrines of the Reorganized Church of Jesus Christ of Latter Day Saints."
Restoration Gospel Feast	<p>"Teaching and preaching ministry for all fundamental RLDS members"</p> <p>"All Fundamental RLDS Members Welcome"</p>
Unidentified	<p>"What Does the R.L.D.S. Church Teach?"</p> <p>"What R.L.D.S. People Believe"</p>
Zarahemla Branch	"An Unauthorized Branch of The Reorganized Church of Jesus Christ of Latter Day Saints"

Entity Placing Advertisement	Language Used in Advertisement
Zion's Remnant	"All Fundamental RLDS Invited
A Letter to the Saints of the Restoration	<p>"Many have believed that the Lord would come and set aright The Church (RLDS Church)."</p> <p>"The Leadership of the RLDS church . . ."</p> <p>"We felt it was necessary to separate ourselves from the Institution (RLDS)."</p>

App. 746-815. These advertisements are not evidence that the Church's full name and RLDS marks are used by the consuming public to refer to other churches, a set of doctrines or beliefs, or membership generally in religious associations. Nor do they overcome the presumption that the Church's registered marks are distinctive (quite the contrary) much less establish a genuine issue of material fact as to whether the marks are generic. *See In re American Fertility Society*, 188 F.3d 1341, 1344 n. 4 (Fed. Cir. 1999) (newspaper articles that referred to the trademark owner itself were "of course, insufficient to render the mark generic.").

The affidavits of two religious leaders⁵ and other documents that Devon Park submitted to oppose summary judgment also fail to show that the public understands the full name and RLDS marks to refer to a class of churches or church members. Indeed, they show that other associations sharing a common

⁵ The test for whether a mark is generic is what consumers, not persons in the trade, understand the term to mean. *See Anheuser*, 750 F.2d at 638.

history with the Church use alternative names to distinguish themselves, their members, and the services they offer. In paragraph 1 of Woodrow Howell's affidavit he identifies himself as a leader of a religious association called Restoration Church of Jesus Christ of Latter Day Saints and, in paragraph 5, refers to members of his association as "members of the Restoration Church." App. 621-22. Howell's affidavit does not refer to members of his own association as RLDS. Likewise, the hearsay documents at App. 634-697 concern the religious association called Remnant Church of Jesus Christ of Latter Day Saints. In a booklet entitled "Genesis of the Remnant Church of Jesus Christ of Latter Day Saints," Frederick Larson, the leader of this association, refers to his members as "the membership of the Remnant Church of Jesus Christ of Latter Day Saints." App. 691. Notably, Larsen's letter does not refer to members of his own association as RLDS. Finally, in paragraph 1 of Dan Worthington's affidavit he identifies himself as a leader of a religious association called Church of Christ, Restored and, in paragraph 5, refers to members of his association as "members of the Church of Christ, Restored." App. 699-700. Worthington's affidavit does not refer to members of his own association as RLDS. Devon Park's evidence thus fails to support its argument that the Church's full name and RLDS marks have become generic.

In the recent "Christian Science" case cited by Devon Park, the court held the mark "Christian Science" not generic. *Christian Science Bd. of Dirs. of the*

First Church of Christ, Scientist v. Robinson, 115 F. Supp. 2d 607 (W.D.N.C. 2000). Relying on Fourth Circuit precedent in *Purcell v. Summers*, 145 F.2d 979, 991 (4th Cir. 1944), the *Robinson* court held, ". . . Defendants 'have the right to withdraw from the church and form a new organization, calling it by any name that will not lead to confusion or enable it to appropriate the standing and good will of the [Mother Church]; but they have no right to use the name of the organization . . . and thus hold themselves out to the community as a continuation of or as connected with that organization.'" 115 F. Supp. 2d at 611 (quoting *Purcell*, 145 F.2d at 991).

Similarly, Devon Park should not be permitted to hold itself out as a continuation of the Church by using the Church's marks. To the extent Devon Park is asking the Court to hold that the RLDS and full name marks should be available to all organizations that practice "traditional RLDS teachings," that request is inappropriate. There is no evidence in the record of what "traditional RLDS teachings" are, and under the "neutral principles approach," the Court should refrain from determining which organization adheres to "traditional RLDS teachings." See *Bd. of Educ. of Kiryas Joel Village Sch. Dist. v. Grumet*, 512 U.S. 687, 696 (1994); *Reorganized Church of Jesus Christ of Latter Day Saints v. Thomas*, 758 S.W.2d 726, 729, 731-32 (Mo. Ct. App. 1988).

Finally, Devon Park has a variety of legal options for identifying its members and services. It conceded that its sign would still be accurate if it used non-infringing names, such as its official name, Devon Park Restoration Branch of Jesus Christ's Church, or descriptive language such as "We follow the original doctrines of Joseph Smith III." App. 460 (243:25-244:19). And it and similar associations in the community have used variations of the terms "Restoration Branches" and "Restorationists" to refer to the class of religious organizations (and their members) of which Devon Park is a part. PI. 122; *see also* Summary Chart of Advertisement Evidence (presented above). Devon Park's own evidence demonstrates that other groups that adhere to "traditional RLDS teachings," use other, non-infringing names to identify their services and members. App. 621-22, 625, 691, 699-700. The existence of these alternative names and evidence of other similarly situated organizations operating under their own non-infringing name, confirm that the District Court correctly rejected Devon Park's genericness argument.

2. The District Court properly held that the Church has not abandoned its rights in the marks.

The District Court correctly held that the Church has not abandoned its marks because the Church and its members have continued to use the marks as service source and membership identifiers and Devon Park has not shown by clear and convincing evidence that the Church has otherwise caused the marks to lose

their significance as an indication of origin. *See* A 25; 15 U.S.C. § 1127⁶; 3 J.

McCarthy, *Trademarks and Unfair Competition* § 17:12 at 17-22, 23 (4th ed.

2009). Devon Park attempts to minimize, but has not identified any evidence that controverts, the significant and powerful evidence that the Church continues to use its marks in commerce in the following ways:

- The Church displays only the full-name mark, Reorganized Church of Jesus Christ of Latter Day Saints, on the signs in front of at least 51 of its congregations (PI 7, 27, 28, 44; App. 408-11, 435);
- The Church displays both its full-name mark, Reorganized Church of Jesus Christ of Latter Day Saints, and the Community of Christ name on the signs in front of an additional, unknown number of its congregations (PI 23; App. 408-11, 435);
- The Church displays its design marks (some built-in and some removable) on the exterior and interior of many of its congregations, including on podiums in its sanctuaries (PI 24-43, App. 408-11);
- The Church uses its full-name mark, Reorganized Church of Jesus Christ of Latter Day Saints, on the title page of the hymnal that it uses in all of its congregations in the United States and at its Temple headquarters in Independence, Missouri (PI 46-52; App. 412-13);
- The Church displays its full-name mark, Reorganized Church of Jesus Christ of Latter Day Saints, on weekly worship service bulletins (PI 60-65; App. 413);
- Church members use the RLDS mark in email usernames, license plate and license plate frames, and in referring to themselves as members of the Church (PI 104-06; App. 415, 484); and

⁶ Devon Park incorrectly cites 15 U.S.C. § 1127; the time period for nonuse under the statutory definition of abandonment is three years, not two.

- The Church displays both the RLDS and full-name marks on a variety of books, postcards, and other items currently offered for sale in the Church's bookstores. (PI 66-103; App. 413-15).

Significantly, Devon Park admitted that it was aware of the Church's use of its marks on signs and at least the exteriors of some of its buildings. App. 403, 509.

These undisputed uses of the marks in commerce easily defeat any claim of abandonment. *See Electro Source, LLC v. Brandess-Kalt-Aetna Group, Inc.*, 458 F.3d 931, 938 (9th Cir. 2006) (reiterating a bright line rule that even a single instance of good faith trademark use is sufficient against a claim of abandonment).

Devon Park's references to the Church's promotional activities surrounding the adoption and use of the name Community of Christ (*see* Appellant's Brief at 42-43) do not constitute evidence of abandonment of the marks. Abandonment does not occur when a once primary trademark merely becomes subordinate to another. *See Guiding Eyes for the Blind, Inc. v. Guide Dog Found. for the Blind, Inc.*, 384 F.2d 1016, 1017-18 (C.C.P.A. 1967) (no abandonment where plaintiff adopted name "Second Sight," which was to be "injected wherever feasible in publicity," but concurrently agreed to continue using the name "Guiding Eyes" and continued to do so on signs outside training center and plaques on its offices). Furthermore, even if the Church's efforts to promote its Community of Christ name somehow implied a prospective intent to stop using the Church's marks, that would not be enough. Abandonment requires actual cessation of use coupled with an

intent not to resume use. 15 U.S.C. § 1127; *Electro Source*, 458 F.3d at 937 (under § 1127, intent not to resume trademark use presupposes that the use has already ceased).

Devon Park argues that the Church uses the RLDS marks "only for legal purposes," *see* Appellants' Brief at 49, but omits the facts concerning the Church's adoption of the name Community of Christ. When the Church adopted the additional name Community of Christ, it concurrently agreed that the name Reorganized Church of Jesus Christ of Latter Day Saints would continue to be "legally binding" as well as retained for "legal purposes," PI 107; App. 416. These terms meant to Church officers that they could not abandon the name without further authorization from a world conference. *Id.*

Devon Park also misstates evidence in arguing that "zero resources have been spent to promote services under the RLDS name." Appellants' Brief at 49. The witness's testimony was that he did not know whether the Church had spent money since April 6, 2001 to promote the name Reorganized Church of Jesus Christ of Latter Day Saints. App. 480. Spending money to promote the name itself is different than spending money to promote religious services under that name. The undisputed evidence shows that the Church publishes bulletins using the full name mark, that Devon Park admitted that one of the Church's authorized congregations recently erected a new sign using the full name mark, and that the

Church undertakes significant training and other efforts to ensure the quality of the services being offered in its congregations (whether under the name Reorganized Church of Jesus Christ of Latter Day Saints or Community of Christ). App. 403, 413, 416-17. Moreover, Devon Park has never controverted the fact that the Church has expended considerable time and resources enforcing its marks. App. 417 (73:24-75:6); *see also Miller*, 2007 WL 4333192.

The cases on which Devon Park relies for its "warehousing" arguments show that the Church is not "warehousing" its marks at all. Devon Park relies primarily on *Intrawest Fin. Corp. v. Western Nat'l Bank of Denver*, 610 F. Supp. 950 (D. Colo. 1985) to support its position that the Church's use of its marks is not bona fide trademark use. But, as Devon Park admits, the alleged trademark owner in *Intrawest* never actually used the name at issue except on a limited basis in its safe deposit box department. Appellant's Brief at 46-47; *Intrawest*, 610 F. Supp. at 958-60. Similarly inapposite, *Anvil Brand, Inc. v. Consol. Foods Corp.*, 464 F. Supp. 474 (S.D.N.Y. 1978), found abandonment because there had been a decision by management to stop using the mark and subsequent use was only on inventory that was systematically being depleted. *Id.* at 481. Devon Park's remaining "warehousing" cases are also obviously inapplicable. *See La Societe Anonyme des Parfums Le Galion v. Jean Patou, Inc.*, 495 F.2d 1265, 1273 (2d Cir. 1974) (meager 89 sales in 20 years, contrived solely for trademark maintenance purposes,

were insufficient to establish rights in mark whose registration had expired and where owner's purported purpose was to preserve the option of someday using the mark on a larger scale); *Silverman v. CBS Inc.*, 870 F.2d 40, 46 (2d Cir. 1989) (limited, minor activities insufficient to establish intent to resume use after a 21-year period of non-use); *Hiland Potato Chip Co. v. Culbro Snack Foods, Inc.*, 720 F.2d 981, 983 (8th Cir. 1983) (company made public statement that mark at issue would no longer be used and subsequently ceased using the mark); *Kusek v. Family Circle, Inc.*, 894 F. Supp. 522, 534 (D. Mass. 1995) (denying *defendant's* motion for summary judgment of *non-infringement* based on disputed fact whether statute of limitations had run before allegedly infringing articles were removed from magazine racks); *Application of Chicago Rawhide Manufacturing Co.*, 455 F.2d 563, 565 (C.C.P.A. 1972) (invoice displaying mark inserted in package with goods not appropriate specimen of use to support *registration* of mark for the goods).

In its argument with respect to the RLDS mark (Appellants' Brief, at 49-51), Devon Park speculates about the conservative mindset of the Church's members who continue to use the RLDS mark to identify their membership in the Church. Even assuming only conservative Church members identify themselves using the RLDS mark (which again has no basis in the record), this does nothing to diminish the fact that Church members are presently using the RLDS collective membership

mark. Devon Park also stretches the facts beyond the breaking point to make its arguments about abandonment. For example, the record does not support Devon Park's arguments that members cannot use RLDS in the military or at hospitals to identify themselves as Church members. The record only shows that the Church informed the military of its adoption of the name Community of Christ, App. 470, and that one local hospital denied Devon Park's pastor the use of RLDS and required him to use "Restoration" to identify his religious affiliation. App. 449. Rather than constituting evidence that RLDS has become generic, the testimony about the hospital, if anything, shows that RLDS is understood by the public to refer to membership in the Church and that the hospital's employee at least recognized that Appellant McLean cannot legitimately call himself RLDS when he is the pastor of an independent, dissident group.

Devon Park has failed to identify any evidence, let alone clear and convincing evidence, that the District Court improperly overlooked when it found that the Church and its members continue to use the marks and have not undertaken any course of conduct that would cause the marks to lose significance. A.4-5, 17. Consequently, the District Court properly rejected as a matter of law Devon Park's affirmative defense and counterclaim based on abandonment.

E. THE DISTRICT COURT PROPERLY AWARDED THE CHURCH ITS REASONABLE ATTORNEY FEES

Under the Lanham Act, a "court in exceptional cases may award reasonable attorney fees to the prevailing party." 15 U.S.C. § 1117(a). A case is exceptional when the defendant intentionally and willfully infringes the trademark of another. *Metric & Multistandard Components Corp. v. Metric's, Inc.*, 635 F.2d 710, 716 (8th Cir. 1980); *Hallmark Cards*, 634 F. Supp. at 1001.

In its opposition to the Church's motion for summary judgment, Devon Park essentially conceded that its use of the Church's marks was intentional and willful, arguing only that it should be exempt from liability for attorney fees because its use of the marks was rooted in its religious beliefs. App. 617-18 The District Court properly rejected this argument and found Devon Park had intentionally and willfully infringed the Church's marks. A27 Devon Park sent a letter to the Church stating that it was using the Church's trademarks and that it had no intent to discontinue their use. *Id.* Devon Park was aware of the Church's actions to enforce its trademark rights against others. *Id.* Devon Park admitted that at least one reason it wished to use the Church's marks was to avoid having potential members believe Devon Park had started a new church. *Id.* And Devon Park continued using the Church's trademarks despite knowing that it did not have the Church's permission to do so and despite receiving the Church's letter requesting that it cease and desist from using the marks. *Id.*

In addition to the actions recited above, which were articulated by the District Court as the basis for holding this case exceptional, the record also shows Devon Park admitted that one of the reasons it decided to offer its ministerial services under the Church's marks was to attract some of the Church's members. App. 509-10. These facts, particularly when placed within the context of Devon Park's awareness of the recent decision enforcing the Church's same trademark rights in the *Miller* case, evidence deliberate, willful conduct that satisfies the exceptional case standard under the Lanham Act. *See Metric*, 635 F.2d at 716 (despite failed genericness defense, defendant's "willful and deliberate" conduct fit "exceptional case" for which an attorney fee award was appropriate); *Hallmark Cards*, 634 F. Supp. at 1001 (awarding attorney fees despite failed genericness defense because defendant's infringement was intentional and willful).

Devon Park's arguments on appeal are the same belated arguments it made during post-summary judgment briefing on the amount of the fee award where it improperly attempted to revisit the "exceptional case" determination. *See* A.33; App. 1011, 1013-18. Devon Park's authorities provide no support for its cause. None of the cases is on point or suggests that the award of attorney fees was improper here. For example, in both *Aromatique* and *Blue Dane Simmental Corp. v. American Simmental Ass'n*, 178 F.3d 1035 (8th Cir. 1999) this Court examined whether the alleged trademark owner's actions in bringing the lawsuit warranted an

award of attorney fees to a prevailing defendant. That analysis is not instructive where, as here, the trademark owner has prevailed. The proper analysis is whether Devon Park's willful and deliberate infringing actions render the case exceptional. *See Metric*, 635 F.2d at 716 (in view of the trial court's finding that the unlawful conduct was willful and deliberate, the court may determine that this is an "exceptional" case for which an award of attorney fees is appropriate); *Lam, Inc. v. Johns-Manville Corp.*, 668 F.2d 462, 476 (10th Cir. 1982) (affirming an attorney fee award based on the defendant's willful infringement).

Devon Park cites *Sovereign Order of Saint John of Jerusalem, Inc. v. Grady*, 119 F.3d 1236 (6th Cir. 1997), and *International Olympic Committee v. San Francisco Arts & Athletics*, 781 F.2d 733 (9th Cir. 1986) ("SFAA"), for their references to the role that a defendant's reasonable doubts about the validity of a trademark or patent may play in the determination of attorney fee awards. In *Grady*, the defendant reasonably believed he was entitled to use the plaintiffs' mark due to religious and historical reasons and he did not know his use was contrary to law. 119 F.3d at 1244. And in *SFAA*, the Ninth Circuit remanded because the district court had erroneously ruled as irrelevant the only prior case concerning the "Olympic" trademark, which had language that might reasonably have been interpreted to allow the defendant's use of the mark. 781 F.2d. at 738-39. But Devon Park does not fit the *Grady* or *SFAA* profile. Devon Park was aware of the

ruling in *Miller* enforcing the Church's rights in some of the same marks at issue here, admitted knowing that it did not have the Church's permission to use the marks, and yet used marks for the same purposes in the same locale.

Finally, Devon Park presents purported religious justifications for its infringement. Devon Park would like the Court to spare it the legal consequences of its trademark violations merely because it holds a religious belief that it should be entitled to use the Church's marks. Not only is such an argument logically flawed (for example, it would thwart enforcement of duly established law in an infinite variety of crimes in the name of religion), it violates the "neutral principles approach," which keeps courts out of the business of determining questions of law and equity on the basis of disputed religious doctrine. *See Bd. of Educ. of Kiryas*, 512 U.S. at 696; *Reorganized Church*, 758 S.W.2d at 729, 731-32.

With respect to the amount of attorney fees awarded, Devon Park has failed to show that the District Court abused its discretion. On the contrary, the amount of the attorney fee award was reasonable and well within the District Court's broad discretion. *See Metric*, 635 F.2d 710 at 716 (district courts have broad discretion to fashion a just remedy consistent with the statute, which expressly permits an award of reasonable attorney fees in an exceptional case). Devon Park has not challenged the reasonableness of Church counsel's rates, hours expended, or scope of counsel's work for which the Church sought recovery of its fees. On appeal,

Devon Park argues, as it did before the District Court, that the fee award should be reduced because Devon Park is a small organization and its pastor an uncompensated pastor. The District Court was not unmindful of Devon Park's status, but it recognized that status cannot erase Devon Park's knowing violation of the Church's trademark rights. A34. Devon Park's disregard for the District Court's prior decision in *Miller* and the Church's established trademark rights forced the Church to expend substantial sums to protect its property.

Finally, Devon Park's case law fails to support its argument for reducing the fee award on the basis of Devon Park's size. For example, the court reduced the amount of fees in *Scholastic* in part because the defendant was "an individual of limited means," but the reduced amount still totaled over \$575,000. *See Scholastic Inc. v. Stouffer*, 246 F. Supp. 2d 355, 360 (S.D.N.Y. 2003). Further, the dicta Devon Park quotes from *Schieffelin & Co. v. The Jack Co. of Boca, Inc.*, 850 F. Supp. 232 (S.D.N.Y. 1994) is inapposite. In that case, the infringer had engaged in a legitimate attempt to market a parody and the court found that he was not merely trying to take a free ride on the strength of the marks in question. *Id.* at 253. As for the remaining cases that Devon Park cites in a footnote, Devon Park fails to state how the reasons cited in those cases for reducing the prevailing party's fee request would apply here or, more importantly, how they suggest that the District Court abused its discretion in awarding the Church its fees. They don't; and it

didn't. Devon Park should be accountable for the Church's fees as a result of its deliberate and willful violation of the Church's rights.

VII. CONCLUSION

For the foregoing reasons, the Church requests that the District Court's Summary Judgment and Attorney Fee Award Orders be affirmed.

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

I certify that this brief complies with the type-volume limitation of Federal Rule of Appellate Procedure 32(a)(7)(B). The brief contains 13,287 words, excluding the parts of the brief exempted by Federal Rule of Appellate Procedure 32(a)(7)(B)(iii).

I also certify that this brief complies with the typeface requirements of Federal Rule of Appellate Procedure 32(a)(5) and the type style requirements of Federal Rule of Appellate Procedure 32(a)(6). The brief has been prepared in a proportionally spaced typeface using Microsoft Office Word 2007 in 14 point font size and Times New Roman style.

/s/Mark M. Iba

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July 12, 2010

CERTIFICATE OF SERVICE

I hereby certify that on July 12, 2010 I caused the original, ten hard copies, and an electronic copy of the document entitled BRIEF FOR PLAINTIFFS-APPELLEES to be sent via Federal Express, next business day delivery, to the United States Court of Appeals for the Eighth Circuit (St. Louis Office) and two hard copies to be sent via hand courier to the following:

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ADDENDUM

Church's Trademark Registration Certificates Add. 1 – 4
Evidence of the Church's Use Add. 5 – 10
Devon Park's October 7, 2008 LetterAdd. 11 – 14
Devon Park's Sign Add. 15