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## ALLOCATION OF NEW TOP-LEVEL DOMAIN NAMES AND THE EFFECT UPON RELIGIOUS FREEDOM

N. CAMERON RUSSELL

### ABSTRACT

The monopoly provided when trademark protection is given to a religious name is in direct tension with an individual's right to freedom of religion. One's ability to freely use a particular religious name in spiritual practice, and to identify one's belief system with the words that commonly describe it, are weakened when trademark law designates just one owner. This Article explores the impact of the impending issuance of brand new top-level domains utilizing religious names, and how the providing of an exclusive right for one entity to govern over a religious top-level domain, in addition to the existence of a trademark monopoly held upon the same name, may affect the vigor of freedoms of religion and speech. This Article argues that there should be a presumption against trademark protection of religious names in order to reaffirm constitutional freedoms, and that the implementation of such a presumption within U.S. law will have the additional benefit of improving an imperfect judicial framework for analyzing trademark cases involving religious names. The Article concludes by proposing some specific rules for implementation of such a presumption, as well as some comparative remarks juxtaposing the solution proposed by this Article with public policy objectives and the discourse within the international community.

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## INTRODUCTION

This Article will examine the ability of religious institutions to claim exclusive trademark rights in certain religious words, phrases and trade indicia. Specifically, the Article will approach this issue by analyzing the recent announcement of the Internet Corporation for Assigned Names and Numbers (“ICANN”) that it has accepted applications for new top-level domain (“TLD”) names—including religious domains, such as <.catholic>, <.islam> and <.bible>—in order to expand beyond <.com>, <.org> and the like.<sup>1</sup> Although ICANN has not yet processed any of these new TLD applications, thus assigning a TLD to a winning bidder, the mere prospect of doing so has already fueled worldwide theological debate.<sup>2</sup> Should one particular entity be given the exclusive right to govern a TLD utilizing a religious name or phrase? If so, what are the ramifications of granting the right of governance to one title-holder? Notwithstanding hortatory argument, the first results of the applications are due to be released by ICANN in the summer of 2013, when legal disputes will inevitably stem from the award of a religious TLD to one specific entity.<sup>3</sup>

In fact, it seems that legal proceedings are especially likely within the United States, where precedent in some courts recognizes no distinction between trademark rights in religious names versus secular trade names alleged to exist in any other commercial context, including when religious words and phrases are used within

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\* © N. Cameron Russell 2013. N. Cameron Russell, Esq., Teaching Fellow, Fordham University School of Law. B.S.B.A., UNC-Chapel Hill; J.D., University of Denver Sturm College of Law; LL.M., Fordham University School of Law. The author would like to thank Dr. Shlomit Yanisky-Ravid for her supervision, comments and guidance on these contents, as well as Professor Hugh C. Hansen for his cited contribution.

<sup>1</sup> ICANN Approves Historic Change to Internet's Domain Name System—Board Votes to Launch New Generic Top-Level Domains, ICANN (June 20, 2011), <http://www.icann.org/en/news/announcements/announcement-20jun11-en.htm>. For a full listing of applications received by ICANN for new gTLDs as of June 13, 2012, see *New gTLD Applied-For Strings*, ICANN (June 13, 2012), <http://newgtlds.icann.org/en/program-status/application-results/strings-1200utc-13jun12-en>. Also note that, for ease of reading, when specific TLDs or web addresses are referenced within the text, each is denoted within right and left angle brackets.

<sup>2</sup> Tom Heneghan, *Religious Groups Vie for New Web Domain Names*, REUTERS (Aug. 31, 2012, 6:56PM), <http://www.reuters.com/article/2012/08/31/net-us-internet-religion-names-idUSBRE87U0L320120831>. “The Vatican’s application for exclusive use of .catholic drew criticism from members of several Protestant churches who also use the term, which comes from the Greek for ‘universal.’” *Id.*

<sup>3</sup> *Id.*; see also *ICANN Increases Web Domain Suffixes*, BBC NEWS (June 20, 2011), <http://www.bbc.co.uk/news/technology-13835997> (indicating that a portion of funding will be set aside to “deal with potential legal actions raised, raised by parties who fail to get the domains they want”).

Internet domain names.<sup>4</sup> If there is an allegation of cybersquatting,<sup>5</sup> there is specific redress within the Lanham Act,<sup>6</sup> as well as an exclusive avenue for alternative dispute resolution under the Uniform Domain Name Dispute Resolution Policy (the “UDRP”) administered through the World Intellectual Property Organization (“WIPO”).<sup>7</sup> But absent a cybersquatting allegation, the analysis of one’s use of religious trademarks in the domain name context is generally the same as in any other trademark infringement action, so long as the challenged designation is used within a website in some commercial sense.<sup>8</sup> In short, religious names receive traditional trademark protection, and the rules and the legal analysis for determination of whether trademark rights exist do not change simply because another’s use of an asserted trademark takes place ahead of <.com>, or before or within any other TLD in a website address.<sup>9</sup>

Good faith uses of religious names in domain names, whether in sincere practice of one’s religion or in genuine exercise of freedom of speech, will not fall under the cybersquatting umbrella.<sup>10</sup> Therefore, in these cases, courts will apply traditional legal standards under the Lanham Act to claims of trademark infringement involving religious trade names, which looks to (i) whether the plaintiff has a protectable ownership interest in the mark, and (2) whether the defendant’s use of the mark is likely to cause consumer confusion.<sup>11</sup> We should rethink the current legal framework and how we apply the law to decide whether trademark rights exist in these religious names.

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<sup>4</sup> See, e.g., *Gen. Conf. Corp. of Seventh-Day Adventists v. McGill*, 617 F.3d 402, 416 (6th Cir. 2010) (finding that a pastor’s use of the term “Seventh-day Adventist” in church name was likely to cause confusion among the public); *Jews for Jesus v. Brodsky*, 993 F. Supp. 282, 305 (D.N.J. 1998), *aff’d*, 159 F.3d 1351 (3d Cir. 1998) (finding trademark rights existed in “Jews for Jesus” and finding against a critic of Jews for Jesus seeking registration of “jewsforjesus.org” and “jews-for-jesus.com.”); *Purcell v. Summers*, 145 F.2d 979, 983–84 (4th Cir. 1944) (finding “Methodist Episcopal Church” had exclusive rights to use the name).

<sup>5</sup> *Frequently Asked Questions: Internet Domain Names*, WORLD INTELL. PROP. ORG., <http://www.wipo.int/amc/en/center/faq/domains.html> (last visited May 24, 2013) (defining cybersquatting as “exploit[ing] the first-come, first-served nature of the domain name registration system to register names of trademarks, famous people or businesses with which they have no connection”).

<sup>6</sup> 15 U.S.C. § 1125(d) (2012).

<sup>7</sup> *Domain Name Dispute Resolution*, WORLD INTELL. PROP. ORG., <http://www.wipo.int/amc/en/domains/> (last visited May 24, 2013).

<sup>8</sup> 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 25:76 (4th ed. 2012) (explaining that the Lanham Act is triggered “[w]hen a domain name is used for a Web site that advertises or offers for sale any goods or services”).

<sup>9</sup> See *In re Hotels.com, L.P.*, 573 F.3d 1300, 1304 (Fed. Cir. 2009) (holding that “the generic term ‘hotels’ did not lose its generic character by placement in the domain name HOTELS.COM.”).

<sup>10</sup> 4 MCCARTHY, *supra* note 8, § 25:78 (“The good faith safe harbor was held broad enough to accommodate a religious group that had a reasonable belief that it could use the name of a group critical of its religion as the domain name of a web site mocking and rebutting the critic’s Web site.”); *Utah Lighthouse Ministry v. Found. for Apologetic Info. & Research*, 527 F.3d 1045, 1058–59 (10th Cir. 2008) (holding that supporters of the Mormon Church who created a website with a domain name the same as the name of an organization which was critical of the Mormon Church was not an ACPA violation.).

<sup>11</sup> 15 U.S.C. § 1125(a) (2012).

This Article argues that, absent bad faith in the selection and use of a particular religious name or phrase, such as in instances of domain name cybersquatting, there should exist a strong, but rebuttable presumption that religious trade indicia are excepted from trademark protection under U.S. intellectual property law. Rebuttal of the presumption should require “clear and convincing” evidence in order to protect the integrity of trademark protection at a fundamental level, while at the same time, reaffirm a constitutional absolute to preserve free practice of religion for all, whether big or small, and no matter how new or old a genuine religious belief may be. It seems apparent that courts’ application of the traditional law of trademarks in the context of religious names has not engendered bright-line, consistently-applied, rules for protection and cannot be sustained moving forward.<sup>12</sup> This Article posits that, especially in the imminent post-TLD-expansion era, use of religious names within Internet domain names aptly demonstrates why we should rethink how we apply the law to these cases. In turn, a presumption that such religious words and phrases are excepted from trademark protection is worthy of consideration by U.S. lawmakers and jurists.

Part I of this Article examines the current state of trademark jurisprudence from a practical and forward-looking standpoint through the impending scenario of ICANN’s expansion into new TLD names, a move toward an almost limitless creation of new “real estate” on the web.<sup>13</sup> Providing one religious entity with an exclusive broad-sweeping intellectual property right, in addition to its exclusive right to occupy a particular area of cyberspace, would restrict *every* other bona fide user’s ability to use the particular religious name or phrase in *any other* area of cyberspace, including in other TLDs as they inevitably expand over time.<sup>14</sup> Therefore, the example of TLD expansion aptly demonstrates why there should be a presumption against the existence of a trademark monopoly over a religious name.

Part II considers the present judicial framework for adjudicating cases involving trademarks and religious names, one which has been labeled an “intellectually unsatisfactory” rubric and criticized by many legal scholars.<sup>15</sup> The bases for such criticism are generally two-fold. First, such religious words and phrases are largely generic, and are merely basic descriptions of the particular religious “product” or “service” being promoted.<sup>16</sup> This Article argues that genericism becomes the overwhelming likelihood if traditional trademark tests are properly and secularly applied. Therefore, it should be presumed that religious trade indicia are incapable of

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<sup>12</sup> Gen. Conf. Corp. of Seventh-Day Adventists v. McGill, 617 F.3d 402, 416 (6th Cir. 2010) (awarding trademark protection to “Seventh-day Adventist”); Christian Sci. Bd. of Dirs. of First Church of Christ, Scientist v. Evans, 520 A.2d 1347, 1349 (N.J. 1987) (providing no trademark protection to “Christian Science”).

<sup>13</sup> ICANN Increases Web Domain Suffixes, *supra* note 3.

<sup>14</sup> See Zippo Mfg. Co. v. Zippo Dot Com, Inc., 952 F. Supp. 1119, 1121 n.3 (W.D. Pa. 1997) (“Once a domain name is registered to one user, it may not be used by another.”).

<sup>15</sup> See Louis J. Sirico, Jr., *Church Property Disputes: Churches as Secular and Alien Institutions*, 55 FORDHAM L. REV. 335, 335–37 (1986).

<sup>16</sup> Jed Michael Silversmith & Jack Achiezer Guggenheim, *Between Heaven and Earth: The Interrelationship Between Intellectual Property Rights and the Religion Clauses of the First Amendment*, 52 ALA. L. REV. 467, 469 (2001) (“[M]ost religious organizations’ names consist of generic words . . .”); *id.* at 511 (providing that a religious trademark could be generic if it “contain[s] words that are common words merely describing a set of beliefs”).

acquiring the requisite secondary meaning in order to receive protection as a descriptive mark unless a party can demonstrate through “clear and convincing” evidence that the religious name is, in fact, a single source identifier. Second, notwithstanding whether religious names are capable of trademark protection in theory, U.S. courts, reasonably, have incredible difficulty deciding matters involving intellectual property rights and religious names because, absent clear bad faith, another’s bona fide use of religious words or phrases is protected by the First Amendment of the U.S. Constitution. Accordingly, both the genericism and constitutional aspects of any legal analysis in these cases auger in favor of a *per se* presumption against recognizing trademark rights in these religious names. These religious names should not be monopolized by limited groups and should be presumed available within the public domain for society’s use, whether to direct Internet traffic to a specific area of cyberspace, to freely describe one’s religion, or for purposes of criticism in the spirit of free speech.

Part III will briefly summarize the alternative means of dispute resolution available outside of the courts, which become especially relevant subsequent to TLD expansion, in the event of a dispute as to use of a religious name within a domain name. As posited herein, parties will seek to find redress through a more-able and more-efficient means of adjudication outside of the present inadequate court system if one is available. I submit that one is not, and adoption and implementation of a presumed exception for religious names from trademark protection within U.S. courts will assist to bandage the only means of adjudication existing.

Finally, Part IV proposes the solution—a presumption against trademark protection for religious names—by offering some clear rules of application, along with some concluding remarks regarding the proposal’s congruence with public policy objectives and international norms.

#### I. INFINITE EXPANSION OF TOP LEVEL DOMAINS WILL INEVITABLY REQUIRE CHANGE WITHIN THE LAW

The current legal framework does not make practical sense moving forward with respect to its application to domain names in Internet addresses. Currently, because of the relatively limited number of TLDs, and the resulting limitation on lower-level domain names within them, there is a corresponding limited ability to obtain “infringing” domain names which utilize words and phrases protected by trademark.<sup>17</sup> Now, ICANN’s expansion into new TLD names signifies a step toward an almost limitless creation of potential, perhaps likely, infringing names.<sup>18</sup> As discussed above, because religious names receive trademark protection, including within domain names, an exclusive intellectual property monopoly held by the

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<sup>17</sup> *ICANN Increases Web Domain Suffixes*, *supra* note 3 (“There are currently 22 gTLDs, as well as about 250 country-level domain names such as .uk or .de.”).

<sup>18</sup> Brad Newberg & Judy Harris, *Understanding the Many Challenges Involved in Registering New GTLDS*, in *NAVIGATING ICANN’S NEW RULES REGARDING GENERIC TOP-LEVEL DOMAIN NAMES: AN IMMEDIATE LOOK AT THE OPPORTUNITIES AND CHALLENGES THAT COME WITH THE NEW GTLD PROGRAM 65* (Aspatore Special Report 2012).

winning bidder for a new religious TLD, in addition to an exclusive right to occupy and divvy space on the TLD, will leave no avenue for other bona fide uses of that religious name or phrase on the Internet, even as TLDs continue to expand, and even at the risk of constitutional freedoms.

#### *A. ICANN'S Release of New Religious Top-Level Domains*

Without evaluating whether an applicant has the right to a certain name, ICANN has developed a complex administrative procedure, coined “Digital Archery,” for how it will process applications for new TLDs when received.<sup>19</sup> Once a TLD is granted to a particular person, organization or entity, importantly, the award includes an exclusive right to make a determination as to who receives the lower-level domain names within its newly-acquired TLD.<sup>20</sup> It may “manage that domain exclusively, renting out addresses that use its extension and rejecting bids it considers unsuitable.”<sup>21</sup>

#### *B. A Presumption Against Trademark Protection Comports with the Competition Objectives Underlying Trademark Law*

A primary objective of trademark law, and of intellectual property law as a whole, is to generate and sustain an environment of robust competition.<sup>22</sup> On one hand, trademark law allows for protection of “brands” so that a producer or service provider can build a reputation that its product or service is better than another, and consumers can reward producers for their hard work through purchase of products or services sold under one’s particular mark.<sup>23</sup> However, trademark law draws distinct boundaries where the providing of a monopoly on a particular word, phrase or other designation thwarts inter-brand competition by placing competitors at a significant non-reputation-related disadvantage.<sup>24</sup> Such limitation comports with a normative “distributive justice” theory underlying intellectual property as a legal construct, as well as international notions of basic human rights, to strike a balance between right holders’ and users’ interests such that monopolies are not unconditionally perpetual. In doing so, a basic right is preserved to share in the resources and societal

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<sup>19</sup> Heneghan, *supra* note 2. “We don’t look into whether the Vatican has the right to the .catholic name,” [Akram] Atallah [interim head of ICANN] said. “Hopefully, the process will get to a conclusion that is satisfying to the majority.” *Id.* For a description of the “Digital Archery” procedure, see *How ICANN Will Process Applications If Many are Received*, ICANN, <http://newgtlds.icann.org/en/applicants/tas/batching/basics> (last visited May 24, 2013).

<sup>20</sup> Heneghan, *supra* note 2.

<sup>21</sup> *Id.*

<sup>22</sup> U.S. DEPT. OF JUSTICE & FED. TRADE COMM’N., ANTITRUST ENFORCEMENT AND INTELLECTUAL PROPERTY RIGHTS: PROMOTING INNOVATION AND COMPETITION 2 (2007), *available at* <http://www.justice.gov/atr/public/hearings/ip/222655.pdf>.

<sup>23</sup> *Louboutin v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206, 215 (2d Cir. 2012).

<sup>24</sup> *Qualitex Co. v. Jacobson Prods. Co., Inc.*, 514 U.S. 159, 165 (1995).

advancement of the community and to participate in its cultural life.<sup>25</sup> At its core, trademark law's emphasis on healthy competition preserves these basic fundamentals.

Notwithstanding, the ability for religious voices to compete and culturally participate is tested when an exclusive trademark monopoly is held by the winning bidder for a new religious TLD. For instance, in the event that the American Bible Society is awarded the <.bible> TLD for which it has applied, then without American Bible Society approval, no matter how objectively provided or withheld, one will be forbidden from occupying a web space on <.bible>.<sup>26</sup> The American Bible Society will make a subjective determination as to whether a certain group has a "healthy respect for the Bible" sufficient to occupy space on the <.bible> TLD.<sup>27</sup> Will the American Bible Society approve of an organization affiliated with the Jehovah's Witnesses?<sup>28</sup> With Mormonism?<sup>29</sup> With Islam?<sup>30</sup> If not, then Jehovah's Witnesses, Mormons and Muslims must seek an alternative virtual home, that is, another web address on an alternate TLD, even if <.bible> becomes the renowned universal marketplace of ideas as to the Bible. As a result, the American Bible Society would have unilaterally restricted these groups from discourse in the mainstream.

Of course, the American Bible Society does not own trademark rights in the word "bible." However, in the event that an organization *does* possess a trademark monopoly on a religious name, in addition to the same power of exclusivity held by the American Bible Society for a certain TLD, where are minority groups to go on the

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<sup>25</sup> Shubha Ghosh, *The Fable of the Commons: Exclusivity and the Construction of Intellectual Property Markets*, 40 U.C. DAVIS L. REV. 855, 858–59 (2007); Universal Declaration of Human Rights, G.A. Res. 217A (III), art. 27, U.N. GAOR, 3d Sess., U.N. Doc. A/810 (Dec. 10, 1948).

<sup>26</sup> See *List of New gLTDS*, *supra* note 1; *New gTLD Application By American Bible Society*, NEWTLDS.COM, <http://www.newtlds.com/applications/BIBLE> (last visited May 24, 2013).

<sup>27</sup> *Who We Are*, AMERICAN BIBLE SOCIETY, <http://www.americanbible.org/about/legal/disclaimer> (last visited May 24, 2013) (listing their mission statement as "mak[ing] the Bible available to every person in a language and format each can understand and afford, so all people may experience its life-changing message"). However, contrary to its all-inclusive mission statement, American Bible Society spokesperson Geoffrey Morin has publicly stated that, with regard to potential control of the <.bible> TLD, the American Bible Society would only share the <.bible> domain "with individuals and groups who, regardless of faith, have a healthy respect for the Bible." Heneghan, *supra* note 2.

<sup>28</sup> *Are You Christians?*, JEHOVAH'S WITNESSES, <http://www.jw.org/en/jehovahs-witnesses/faq/are-jehovahs-witnesses-christians/> (last visited May 24, 2013). Jehovah's Witnesses believe in the Bible and that they worship the one true religion. *Id.*; see also *Do You Believe That You Have the One True Religion*, JEHOVAH'S WITNESSES, <http://www.jw.org/en/jehovahs-witnesses/faq/true-religion/> (last visited May 24, 2013).

<sup>29</sup> *Articles of Faith*, THE CHURCH OF JESUS CHRIST OF LATTER-DAY SAINTS, <http://mormon.org/articles-of-faith> (last visited May 24, 2013). Mormons believe that the Bible, "as far as it is translated correctly," is a companion volume of scripture to the Book of Mormon. *Id.* Those of the Mormon faith likewise believe that they comprise "the only true and living church." See Dallin H. Oaks, *The Only True And Living Church*, THE CHURCH OF JESUS CHRIST OF LATTER-DAY SAINTS (last updated Feb. 21, 2012), <https://www.lds.org/youth/article/only-true-living-church?lang=eng>.

<sup>30</sup> YASSER GABR & HOUDA KARKOUR, ISLAM IN BRIEF: A SIMPLIFIED INTRODUCTION TO ISLAM 24 (2008). Muslims believe that "Allah revealed Books to his Prophets and Messengers," of which were the "Scripture of the Prophet Abraham" and the "Psalms given to the Prophet David and the Gospel, which was brought by the Prophet Jesus Christ." *Id.*

Internet when seeking to use the monopolized religious name in the genuine practice of their religion? Thus, for fear of exclusion, news of disputes among various religious groups shortly followed ICANN's announcement, whether or not these groups were actively vying for a particular TLD.<sup>31</sup> When these restrictions on uses of religious names are tested, which they are certain to be, the floodgates may pour open with disputes before courts and arbiters that neither are equipped to resolve.

## II. A PRESUMPTION MAY BUILD COGENCY WITHIN A PRESENT DAY "INTELLECTUALLY UNSATISFACTORY" FRAMEWORK

Prior to discussing the specifics of U.S. legal doctrine at present, it is helpful to first provide a context for how disputes as to religious names generally arise and enter the court system. The "prototypical" religious trade name dispute has been aptly described as follows:

The prototypical dispute occurs when a small group of parishioners breaks away from its mother church. In doing so, they hope to use part of their mother church's name in the name of their new church. Out of a legitimate concern of confusion, or perhaps out of spite, the members of the mother church attempt to enjoin the breakaway church from using its name.<sup>32</sup>

In such cases, courts are faced with a difficult and delicate task. A trade name is of course, like all intellectual property, a property right, and a property right includes the right to exclude others.<sup>33</sup> Disputes regarding church property are often problematic, not only for courts that are faced with resolution of same, but also for church parishioners who do not want the government intermeddling in autonomous church dealings and, perhaps, excluding them from use of something which has been determined to be "church property."<sup>34</sup> Thus, when faced with these decisions, there is an intricate interplay of divergent considerations between (A) recognition of intellectual property rights and (B) protection of constitutional freedoms of speech and religion under the First Amendment of the U.S Constitution.<sup>35</sup> These two bodies of legal doctrine are discussed in the following subsections.

### *A. There Should Be a Presumption Because Most Religious Names Are Generic*

The inadequacy of the current U.S. legal framework is especially apparent in determining whether religious organizations have intellectual property rights in

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<sup>31</sup> Heneghan, *supra* note 2 (using an example of several Protestant churches opposing the Vatican's application for the exclusive use of <.catholic> because those churches use the term to mean "universal").

<sup>32</sup> Silversmith & Guggenheim, *supra* note 16, at 469, 504.

<sup>33</sup> Nat'l Bd. of YWCA v. YWCA of Charleston, 335 F. Supp. 615, 625 (D.S.C. 1971).

<sup>34</sup> See Kent Greenawalt, *Hands Off! Civil Court Involvement in Conflicts Over Religious Property*, 98 COLUM. L. REV. 1843, 1843 (1998).

<sup>35</sup> Silversmith & Guggenheim, *supra* note 16, at 468.

their names. Because of the issues presented by the First Amendment, the legal framework crafted by the U.S. Supreme Court is one of “judicial restraint” in resolving disputes as to church property generally.<sup>36</sup> Under Supreme Court precedent, if no clear decision by the polity is apparent, courts must apply neutral principles of intellectual property law.<sup>37</sup>

Underlying the objective to further robust competition is the *ultimate* goal of trademark law—to protect “brands” that serve as source identifiers.<sup>38</sup> For consumers, being assured that a product or service comes from a particular source and has the qualities that consumers desire reduces consumer search costs and provides assurance of authenticity, whether because a consumer has used the product or service before, or because a brand from a particular source has a positive reputation within the marketplace.<sup>39</sup>

### 1. *Neutral Principles of Genericism*

Generic marks “refe[r] to the genus of which the particular product is a species.”<sup>40</sup> In applying neutral principles of trademark law to church names, “most religious organizations’ names consist of generic words with the confusion stemming from similarly-named organizations.”<sup>41</sup> Genericism exists if the “church name contain[s] words that are common words merely describing a set of beliefs” and do not provide an indication of source.<sup>42</sup> As a general matter, generic words and phrases receive no trademark protection, as they would not further the underlying goals of trademark law, which is to facilitate healthy competition and to assist consumers in identifying particular brands.<sup>43</sup>

Notwithstanding, it is possible that, “[e]ven if the words [within a] name are individually generic, the composite name may not be generic if it indicates a source producer, such as the sect behind a generic church name.”<sup>44</sup> Under trademark law,

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<sup>36</sup> *Id.* at 470; Greenawalt, *supra* note 34, at 1844.

<sup>37</sup> Greenawalt, *supra* note 34, at 1881; *see also* Sirico, Jr., *supra* note 15, at 335 (“The free exercise clause requires a court to resolve the matter without ruling on any religious controversy that lies at the heart of the dispute.”); Greenawalt, *supra* note 34, at 1844. Intra-church disputes present two alternative approaches to the courts—one of “polity-deference” or of “neutral principles.” Greenawalt, *supra* note 34, at 1844. As the names connote, courts must choose between (i) deferring to the decision of the group or church as determined according to its own procedure for decision-making or (ii) applying neutral and secular principles of law. *Id.*

<sup>38</sup> David A. Simon, *Register Trademarks and Keep the Faith: Trademarks, Religion and Identity*, 49 IDEA 233, 235 (2009) (“Indeed, the goal of trademark law is to provide legal protection for names and symbols that represent a source.”).

<sup>39</sup> *See* Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 UCLA L. REV. 621, 623 (2004).

<sup>40</sup> *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (2002) (citing *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 194 (1985)).

<sup>41</sup> *Silversmith & Guggenheim*, *supra* note 16, at 469.

<sup>42</sup> *Id.* at 511.

<sup>43</sup> *Canal Co. v. Clark*, 80 U.S. (13 Wall.) 311, 323 (1871).

<sup>44</sup> *Silversmith & Guggenheim*, *supra* note 16, at 505.

this concept is commonly referred to as “secondary meaning.”<sup>45</sup> A generic religious name or phrase may acquire secondary meaning if “the primary significance of the [generic] term in the minds of the consuming public is not the product[’s name] but the producer.”<sup>46</sup> Thus, in the context of religious names, the primary significance of the term in the minds of the public must be a particular religious unit or organization and not the belief system itself in order to acquire secondary meaning.<sup>47</sup> In making this determination, it is the minds of the “relevant public” that matter.<sup>48</sup> Whether the “relevant public” is the broad general public, a less broad “purchasing public,” or another even narrower segment of the public at large is a question for each court to determine on a case-by-case basis.<sup>49</sup>

It is conceivable that, within this intellectual property framework, “a church name over time can take on the connotation of a specific sect affiliation” that is the sole producer of a certain belief system.<sup>50</sup> However, I postulate that, if secular trademark principles are properly applied as they ordinarily would be in a non-religious commercial context, it will be infrequent that a religious word or phrase sought to be used by others will primarily signify a single source. Based upon this notion, the imposition of a *per se* rule establishing a presumption in favor of genericism will merely mirror the realities of the context in which these religious names are actually used such that attempts to seek monopolies of generic religious names through courts will be appropriately diminished.

## 2. Religious Organizations as an Indicator of Source

A local, regional or worldwide public association with a single source institution is rarely the case in the religious context. Indeed, it is not the conscious and natural objective of promoters of religious belief systems to claim to be the source at all. Religions spread across continents and, at a doctrinal level, do not derive from an Earthly source. Often the parties freely admit that a heavenly message (i.e. the “product or service” in trademark jargon) derives from a *divine* source, and is purposefully disseminated through various affiliated and unaffiliated institutions and organizations. Thus, how can the name of a religious belief come from one mortal individual or entity that is capable of having scribed one’s name on a trademark registration with the United States Patent and Trademark Office (“PTO”)? If a religious name is recognized as a trademark, and a trademark is a property right, then this property must have a specific owner. In the cases of secondary meaning, this singular owner must likewise be the solitary supplier of a

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<sup>45</sup> *Id.*; *Two Pesos*, 505 U.S. at 769 (indicating that secondary meaning is also known as “acquired distinctiveness.”).

<sup>46</sup> *Jews for Jesus v. Brodsky*, 993 F. Supp. 282, 298 (D.N.J. 1998).

<sup>47</sup> *Id.*

<sup>48</sup> 15 U.S.C. § 1064(3) (2012).

<sup>49</sup> James Lockhart, *When Does Product Become Generic Term So As To Warrant Cancellation of Registration of Mark, Pursuant to § 14 of Lanham Act (15 U.S.C.A. § 1064)*, 156 A.L.R. FED. 131,

\*8(a)–8(b) (1999).

<sup>50</sup> *Silversmith & Guggenheim*, *supra* note 16, at 505.

religious “brand” sufficient to monopolize what would ordinarily be a common generic name.

Many churches admit and make clear that the “relevant public” for their religious message is *everyone* in the world. For example, the Southern Baptist Convention’s explicit mission statement is, “[a]s a convention of churches . . . to present the Gospel of Jesus Christ to every person in the world and to make disciples of all the nations.”<sup>51</sup> Therefore, when courts determine the primary significance of a church name or phrase to the relevant consuming public, this “poses a question of fact in each case, and the trier of fact has the formidable task of ascertaining on the evidence submitted the meaning of the word among an indeterminable number of persons, perhaps millions.”<sup>52</sup> The Southern Baptist Convention’s mission statement suggests that the number of members of the relevant public will most often be in the millions, if not billions.<sup>53</sup> As a result, neutral principles of genericness and secondary meaning are difficult, if not impossible, for courts to properly apply to religious names used throughout the world.<sup>54</sup> Adoption of a *per se* presumption that religious names are generic and do not acquire secondary meaning without “clear and convincing” evidence that the primary significance to the relevant public is that of a certain source producer will bring religious trade names back within the intent and underlying objectives of trademark law as a legal doctrine. This will also prevent generic names of belief systems or of a certain individual believer from monopolization by one incorporated or unincorporated association.

### 3. *There Is Already a Movement in the Courts Toward Generic Per Se*

Should we provide one person or artificial entity a trademark in the name of a religious faith and remove it from the public domain? Many courts have already answered this question in the negative, finding that religious names are *per se* generic.<sup>55</sup> The New York Court of Appeals in *The New Thought Church v. Chapin* stated that religious names simply convey to the relevant public:

*[F]irst*, the system of religion which it teaches, and, *second*, that it teaches that system through the medium of organizations known as churches. It surely is not in a position to successfully claim a monopoly of teaching this

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<sup>51</sup> *Mission & Vision*, S. BAPTIST CONVENTION, <http://www.sbc.net/missionvision.asp> (last visited May 24, 2013).

<sup>52</sup> 1 JEROME GILSON, TRADEMARK PROTECTION AND PRACTICE § 2.02[7] (2012).

<sup>53</sup> *Mission & Vision*, *supra* note 51 (seeking to “present the Gospel of Jesus Christ to every person in the world”).

<sup>54</sup> Silversmith & Guggenheim, *supra* note 16, at 511.

<sup>55</sup> See, e.g., *Christian Sci. Bd. of Dirs. of First Church of Christ, Scientist v. Evans*, 520 A.2d 1347, 1352 (N.J. 1987) (“Plaintiffs simply cannot appropriate, from the public domain, the common name of a religion and somehow gain an exclusive right to its use and the right to prevent others from using it.”); *The New Thought Church v. Chapin*, 144 N.Y.S. 1026, 1027–28 (N.Y. App. Div. 1913).

form of religious faith by means of organizations known by the generic names of churches.<sup>56</sup>

Courts have determined that this is true even if there is a point in time when only one institution is using a particular religious name and may claim to be a single source.<sup>57</sup>

#### *4. Have Other Courts Been Analytically Honest and True to the Justifications for Trademark Protections?*

At times, courts find that trademark rights exist in a religious name.<sup>58</sup> According to the legal framework discussed above, such a finding legally concludes that the plaintiff established that the religious name at issue is associated by the “relevant public” with the *plaintiff* as a single source of a particular religious belief system.<sup>59</sup> By means of example, one such case is the *General Conference Corp. of Seventh-Day Adventists v. McGill*, where at issue was a break-away church’s use of “Seventh-day Adventist” in its church name.<sup>60</sup> The General Conference had registered SEVENTH-DAY ADVENTIST and ADVENTIST with the PTO.<sup>61</sup> McGill, originally a member of a Seventh Day Adventist church affiliated with the General Conference, decided to separate from the church because of a theological dispute.<sup>62</sup> Because McGill believed he was “divinely required” to use the name “Seventh Day

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<sup>56</sup> See *The New Thought Church*, 144 N.Y.S. at 1028; see also Silversmith & Guggenheim, *supra* note 16, at 514 (“The plaintiffs have no right to a monopoly of the name of a religion. The defendants, who purport to be members of the same religion, have an equal right to use the name of the religion in connection with their own meetings, lectures, classes and other activities.”); *Christian Science Bd. of Dirs.*, 520 A.2d at 1352 (“Plaintiffs simply cannot appropriate, from the public domain, the common name of a religion and somehow gain an exclusive right to its use and the right to prevent others from using it.”).

<sup>57</sup> See, e.g., *Christian Science Bd. of Dirs.*, 520 A.2d at 1352–53.

[T]he absence of other groups using the name of a religion in the names of their churches does not render the right to use of the name the exclusive property of [the mother church]. Exclusive use “cannot take the *common descriptive* [*i.e.*, generic] name of an article out of the public domain and give the temporarily exclusive user of it exclusive rights to it, no matter how much money or effort it pours into promoting the sale of the merchandise.”

*Id.* at 1353 (quoting *J. Kohnstram Ltd. v. Louis Marx & Co.*, 280 F.2d 437, 440 (C.C.P.A. 1960)).

<sup>58</sup> See, e.g., *Gen. Conf. Corp. of Seventh-Day Adventists v. McGill*, 617 F.3d 402, 405 (6th Cir. 2010) (recognizing registration of the “Seventh-day Adventist” mark); *Jews for Jesus v. Brodsky*, 993 F. Supp. 282, 313 (D.N.J. 1998) (issuing an injunction against defendant and finding trademark rights existed in “Jews for Jesus” and found against a critic of Jews for Jesus seeking registration of “<jewsforjesus.org>” and “<jews-for-jesus.com>”); *Purcell v. Summers*, 145 F.2d 979, 983–84 (4th Cir. 1944) (holding that “Methodist Episcopal Church” had exclusive rights to use the name).

<sup>59</sup> See *supra* notes 47–49 and accompanying text.

<sup>60</sup> *Gen. Conf. Corp. of Seventh-Day Adventists v. McGill*, 617 F.3d 402, 404 (6th Cir. 2010).

<sup>61</sup> *Id.* at 405.

<sup>62</sup> *Id.*

Adventist” in his new church’s name, he did so, naming his church “A Creation Seventh Day & Adventist Church.”<sup>63</sup> McGill also purchased Internet domain names for, among others, <7<sup>th</sup>-day-adventist.org>, <creation-7<sup>th</sup>-dayadventist-church.org>, and <creationseventhday-adventistchurch.org>.<sup>64</sup> The U.S. Court of Appeals for the Sixth Circuit held against McGill, finding that the General Conference has trademark rights in the name “Seventh-day Adventist” and that McGill’s use was infringing.<sup>65</sup> Thus, based upon court precedent in *McGill*, the General Conference has national, court-approved, exclusive trademark rights to the name “Seventh-day Adventist” or any name which is confusingly similar, including one used in a domain name.<sup>66</sup>

Hence, the Sixth Circuit’s opinion in *McGill* begs some questions. Did the Sixth Circuit properly apply neutral principles of trademark law in *McGill*? Did the court further any of the theoretical objectives of trademark law in finding for the General Conference? Customer surveys are often used in trademark cases to gauge whether a proffered trademark has acquired secondary meaning.<sup>67</sup> If one hundred members of the “relevant public” were questioned as to the primary significance of the term “Seventh-day Adventist,” how many would state that it identified the name of a particular “brand” of the Protestant religion produced by the General Conference? Without commissioning a survey, it seems unlikely that the majority of those questioned would state that it was the name of the particular religion itself. In fact, even if one hundred members of the Seventh-day Adventist church were asked as to the name of their religion, what would they call it? It seems likely that the majority would say “Seventh-day Adventist” and that they were “Seventh-day Adventists.”

The type of monopoly provided to the General Conference in *McGill* seems to be just the type that black-letter trademark law tries to prohibit.<sup>68</sup> If a theoretical justification of trademark law is to foster competition, how is anyone supposed to compete with the General Conference to provide an alternative to its “brand” of the Protestant religion? If McGill cannot use the words “Seventh-day Adventist” in the name of his new church, then what is he supposed to call it so that people will readily identify the particular belief system he believes in and which he is seeking to promote to others? McGill’s doctrinal dispute with the General Conference should not require him to create an entirely new name for his religious beliefs.

Moreover, if a “Seventh-day Adventist” is seeking a new congregation, perhaps one that promotes McGill’s religious interpretation, does the Sixth Circuit’s decision in *McGill* further the primary objective of trademark law to provide consumers with a clear indication of source and reduce consumer search costs? If McGill cannot use the name “Seventh-day Adventist” in the name of his new church, then it seems that it will be difficult for those looking for a like-minded church to find the type of “product” they are seeking. In the context of domain names and Internet search engines, if not “Seventh-day Adventist,” then what is a potential member of the

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<sup>63</sup> *Id.*

<sup>64</sup> *Id.* at 405–06.

<sup>65</sup> *Id.* at 416.

<sup>66</sup> *Id.*

<sup>67</sup> See *Amazing Spaces, Inc. v. Metro Mini Storage*, 608 F.3d 225, 249 (5th Cir. 2010).

<sup>68</sup> See 15 U.S.C. § 1064(3) (2012).

congregation supposed to type into his or her browser? This deprivation of use rights seems especially onerous in a modern age of Internet search optimization.

McGill and others similarly situated could certainly choose another name. However, a “personality” approach to intellectual property theorizes that they should not have to. The personality theory of property puts forward that property should be owned by those who most personally identify with it.<sup>69</sup> This principle particularly embodies the underlying justifications for copyright law and patent law by protecting authors and inventors who personally identify with the fruits of their ideas and of their labor as extensions of themselves on an emotional and intimate level. In the context of religious names, certainly these are deeply personal to righteous believers. Undoubtedly, McGill’s fervent self-identification as a “Seventh-day Adventist” fueled his pursuit of an ability to call himself one. Thus, perhaps there is a personality approach within the underpinnings of a constitutional right to freedom of religion itself, and such an approach toward ownership of religious names supports a presumption in favor of societal ownership by a collective of individual believers.

##### *5. Will a Presumption Discriminate Against Religious Entities in Pursuit of Commercial Endeavors Which Need Trademarks to Build Revenues?*

It is proffered that a *per se* presumption against trademark protection will reduce the frequency of cases involving religious names as trademarks and lessen the number of cases where freedoms of religion and speech hang in the balance. In the event that such a presumption is codified, undoubtedly many will criticize the limitation as infringing upon the rights of religious organizations to acquire and benefit from trademark rights as a commercial business necessity. Of course, non-profit ventures unrelated to religious aims may acquire intellectual property rights. However, I submit that churches and other religious organizations will not receive disparate treatment from secular non-profits and will merely be playing by the same rules as any other enterprise, whether not-for-profit or commercial.

In the corporate world, marketing departments are on constant guard of selecting generic or descriptive names for products and services in fear that such names will not be protectable vis-à-vis competitors or will not be able to garner a registration through the PTO. As discussed above, an intellectually evenhanded analysis of these religious names would not meet the requisite level for trademark protection in most cases.<sup>70</sup> If, indeed, a religious word does meet the threshold through clear and convincing evidence that the primary significance of the word mark is that of a source producer, then churches certainly may possess trademark rights just as any other commercial actor. However, only then will the providing of a monopoly on a particular religious word or phrase fulfill the theoretical objectives of trademark law on a fundamental level.

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<sup>69</sup> See Margaret Jane Radin, *Property and Personhood*, 34 STAN. L. REV. 957, 982 (1982).

<sup>70</sup> See, e.g., *The New Thought Church v. Chapin*, 159 A.D. 723, 725 (1913) (finding the name “The New Thought Church” to be generic and indistinct).

*B. There Should Be a Presumption Because Monopolization Violates Constitutional Freedoms*

In reviewing U.S. jurisprudence in the area as a whole, it seems difficult to discern a clear body of black-letter law that is consistently applied by U.S. courts in disputes regarding religious names as trademarks.<sup>71</sup> Simply put, courts inconsistently analyze and decide these cases, and such is not purely the product of jurists' imprudence.<sup>72</sup> Perhaps, instead of consciously abandoning underlying justifications and black-letter law of trademarks altogether, it is more likely that constitutional constraints and the limited availability of analytical frameworks cause courts to reach certain ownership determinations in cases of religious names and the volatility of the resulting body of case law is the result of a complex interplay of constitutional and property interests.<sup>73</sup> Indeed, a "senior" organization taking priority over a name as a trademark impedes another's future religious freedoms. Moreover, these cases often involve the parties' request that the court determine which among them is the "true faith," which courts cannot constitutionally adjudicate.<sup>74</sup>

Specifically, with respect to trademark rights, when a court grants to one party a monopoly on the name of a church or a phrase associated with one religion or another, it simultaneously orders that others desist from using the name or phrase.<sup>75</sup> Because the trade name may be a "religious touchstone for another individual," this acknowledgement of property protection may impede the ability of individuals to freely exercise religion without government interference.<sup>76</sup> Thus, a court decision as to ownership and infringement of a trade name may run afoul of the Free Exercise Clause of the First Amendment. At the same time, the Establishment Clause of the First Amendment may be at odds with such a court determination since this government action may establish the prevailing party's religion ahead of another

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<sup>71</sup> See Sirico, Jr., *supra* note 15, at 335–37. Professor Sirico explains that:

In 1979, the Supreme Court made clear that courts have at their disposal more than one method for resolving [church property dispute] cases. Since then, supreme courts and appellate courts in at least twenty-five states have published opinions in which they either have reaffirmed their traditional methods for resolving church property disputes or have adopted new methods. Most courts have failed to give a detailed justification for choosing one approach over another. I believe that this failure has occurred because the available methods are intellectually unsatisfactory. Each test requires assuming that a church fits an organizational stereotype that may or may not be accurate.

*Id.* at 335–37.

<sup>72</sup> Compare *The New Thought Church*, 159 A.D. at 724–25 (holding the name "The New Thought Church" to be generic and incapable of trademark protection), with *McGill*, 617 F.3d at 416 (holding that "Seventh Day Adventist" was not generic and was capable of trademark protection).

<sup>73</sup> See Sirico, Jr., *supra* note 15, at 337.

<sup>74</sup> *Silversmith & Guggenheim*, *supra* note 16, at 475–76; *Watson v. Jones*, 80 U.S. (13 Wall.) 679, 707–08 (1871).

<sup>75</sup> See, e.g., *McGill*, 617 F.3d at 407.

<sup>76</sup> *Silversmith & Guggenheim*, *supra* note 16, at 468.

practitioner seeking to worship the religion in his or her own way.<sup>77</sup> Lastly, providing an intellectual property monopoly to one religious institution for exclusive use may unconstitutionally restrict another's ability to utilize the name or phrase, not to worship, but to speak out *against* certain religious tenets or policies, in violation of a U.S. citizen's inalienable right to freedom of speech.

### *1. Neither of the Tests Available to Courts Are Sufficient*

Notwithstanding the theoretical objectives of the “polity-deference” or “neutral principles” approaches—the two alternative tests available at present—often neither is viable in practice. In terms of deference to church decision-making authority, what if the parties disagree as to who or what the decision-making body is? Moreover, what if church tenets connote that the ultimate decider is God, Allah, Adonai or Buddah, and that all direction comes above? Reality suggests that not all churches have a clear hierarchy like the Catholic Church with an edict promulgated from God via the Vatican. A court determination, even as to the mere *existence* of a hierarchy, may run afoul of the First Amendment in itself.<sup>78</sup> In addition, some churches like the Baptist Church have a congregational polity based upon democratic principles employed among church members.<sup>79</sup> This makes it almost impossible for courts to pinpoint a “church decision” on the matter, much less defer to it, because it is likely that the parties' positions will be at odds if they are in litigation against one another in the first place and have been unable to resolve the matter out of court. The parties may not even agree on the mere identity of the “true church” on a fundamental level if one sect has broken off from another.<sup>80</sup>

Further, the alternative approach of “neutral principles” likewise presents difficult questions for courts as to how these neutral and secular principles of law should be applied within a church setting where church members may not think or act as they reasonably would in a commercial one.<sup>81</sup> General principles of commercial law may be inapplicable and incongruent due to parties' reasonable expectations or prior normal courses of dealing as church members.<sup>82</sup> Indeed, what may be reasonable in a commercial context may be unreasonable under the specter of religious doctrine, and vice versa.

### *2. Are Courts Reluctant to Shift the Status Quo?*

At first blush, it may seem as if courts are simply averse to adjudicate these types of cases at all, at least by means of rendering a decision that changes the parties' positions. Hugh C. Hansen, Director of the Intellectual Property Law

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<sup>77</sup> See *id.* at 471–72.

<sup>78</sup> Greenawalt, *supra* note 34, at 1877–82.

<sup>79</sup> *Id.* at 1864 (“Under the polity approach, if a church organization is congregational, courts assume that it governs itself like an ordinary voluntary association.”).

<sup>80</sup> *Id.* at 1843–44.

<sup>81</sup> See, e.g., Sirico, Jr., *supra* note 15, at 356.

<sup>82</sup> See, e.g., Greenawalt, *supra* note 34, at 1885–86.

Institute and Professor of Law at Fordham University School of Law, has suggested that court decisions regarding disputes over church names can be largely reconciled simply by recognizing that courts desire to maintain the status quo in these cases in an effort to avoid involvement in doctrinal disputes.<sup>83</sup> Professor Hansen opines that, in order to maintain matters as they existed prior to commencement of the action, so that the court cannot be accused of taking government action that changed the parties' positions, courts usually decide against the plaintiff, whether the plaintiff is the senior user (i.e. the "mother" church) or the junior user (i.e. the "break-away" church).<sup>84</sup> Therefore, in the case of break-away members from a parent church, if the parent files suit seeking to stop the break-away members from using a name, the court finds that the church name is generic and the break-away members prevail. Alternatively, if the break-away members seek a declaratory judgment from a court to affirm its lawful use of the church name, the court finds that the name is *not* generic, the declaratory judgment is denied, and the parent church prevails.

Perhaps, like *McGill*, not all cases fit perfectly into Professor Hansen's proffered rubric. Nonetheless, it seems to be a reasonable and pragmatic approach for courts to employ given the constitutional dangers and impracticalities implicit in the "polity-deference" and "neutral principles" alternatives. At present, courts are placed in an untenable position. Neither of the alternatives permitted by the Supreme Court are satisfactory in the context of religious trade names, and a *per se* presumption will focus courts to a narrow issue in applying neutral principles of whether a religious name or phrase has acquired the requisite secondary meaning when the traditional test is objectively applied.<sup>85</sup>

### 3. *The Law Should Err in Favor of Individual Religious Autonomy*

Despite the constitutional difficulties in deciding these cases, courts must nevertheless render a decision one way or another when these disputes come to bar. Courts do not possess an ostrich-like luxury to bury its proverbial head in the sand. A decision either way can be argued as having the effect of infringing upon freedom of religion, and simultaneously, as upholding religious freedoms. It is with this reality in mind that the proposed presumption against protection of religious names is tendered. Why choose constitutional freedoms of individuals to practice free religion over other constitutional and commercial considerations in tension with same, such as a religious organization's constitutional ability to engage in commerce and acquire property through trademarks? I submit that preservation of religious protections for the less-authoritative minority should take precedent.

Break-away churches are often smaller, less powerful and less established than the mother church. A presumed exception would protect the interests of disadvantaged minority groups who will not have established priority rights in a particular religious name, but yet have a genuine constitutional interest in its use.

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<sup>83</sup> Professor Hugh C. Hansen, Oral Lecture at Fordham Law School (Oct. 17, 2012) (cited with speaker's written permission).

<sup>84</sup> *Id.*

<sup>85</sup> Greenawalt, *supra* note 34, at 1905–06; Sirico Jr., *supra* note 15, at 337.

Conversely, without a presumed exception, a mother church with senior use would be able to eliminate competing voices of minority groups within a particular religious sect. This type of discrimination is enabled by a trademark monopoly.

In fact, § 110 of the U.S. Copyright Act already includes an exception whereby a “performance of a nondramatic literary or musical work or of a dramatico-musical work of a religious nature, or display of a work, in the course of services at a place of worship or other religious assembly” does not receive copyright protection.<sup>86</sup> Excepting religious services from copyright law preserves a right to worship. A similar exception in trademark law for religious words and phrases will further a similar objective toward religious freedom.

Furthermore, the United States, unlike other countries, recognizes *any* genuine religion as legitimate, even if it only has one practitioner. Indeed, “religious beliefs need not be acceptable, logical, consistent, or comprehensible to others in order to merit First Amendment protection.”<sup>87</sup> With this in mind, courts have often prioritized freedom of religion over business necessity to ensure reasonable accommodation of religious freedoms, even above significant bona fide commercial interests.<sup>88</sup> In fact, I premise that such a priority is necessary to sustain religious freedoms at all. Otherwise, a powerful commercial world may soon swallow individual religious voices whole.

### III. ALTERNATIVE AVENUES FOR DISPUTE RESOLUTION OUTSIDE OF U.S. COURTS AND THE AFOREMENTIONED FRAMEWORK

As discussed above, disputes as to alleged trademarks within domain names may be brought in court subject to the aforementioned imperfect judicial framework. Alternatively, the party with the power of forum selection may elect, instead, to bring a claim through the UDRP.<sup>89</sup> Importantly, the UDRP has a different legal standard to be applied to allegations of trademark infringement within domain names,<sup>90</sup> and because of this, it is ill-equipped to resolve disputes involving bona fide uses of religious names within URLs.

Upon purchasing a domain name from an ICANN-accredited registry, the purchaser is required to consent to dispute resolution through the UDRP.<sup>91</sup> In terms of the overall process, the UDRP is similar to that of the American Arbitration

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<sup>86</sup> 17 U.S.C. § 110(3) (2012).

<sup>87</sup> *Thomas v. Review Bd. of Ind. Emp't Sec. Div.*, 450 U.S. 707, 714 (1981).

<sup>88</sup> *See, e.g., Trans World Airlines, Inc. v. Hardison*, 432 U.S. 63, 76 (1977).

<sup>89</sup> *See WIPO Guide to the Uniform Domain Name Dispute Resolution Policy (UDRP)*, WORLD INTELL. PROP. ORG., <http://www.wipo.int/amc/en/domains/guide/#a2> (last visited May 24, 2013).

<sup>90</sup> *Id.*

<sup>91</sup> *How Does the UDRP Work?*, Response to *Frequently Asked Questions: Internet Domain Names*, WORLD INTELL. PROP. ORG., <http://www.wipo.int/amc/en/center/faq/domains.html#8> (last visited May 24, 2013). As a condition to becoming accredited as a registry by ICANN, ICANN mandates that each registry contractually agree to impose UDRP provisions within each of its individual contracts with URL purchasers. *ICANN Registrar Accreditation Agreement*, § 3.8, ICANN, <http://www.icann.org/en/resources/registrars/raa/ra-agreement-21may09-en.htm> (last visited May 24, 2013). Thus, as a practical matter, every URL occupant has consented to UDRP jurisdiction and resolution of domain name disputes through the UDRP.

Association, and many other popular avenues for alternative dispute resolution.<sup>92</sup> However, WIPO's UDRP activities are isolated *only* to resolution of domain name disputes.<sup>93</sup> The UDRP has its own set of rules distinct from national trademark laws, including specific frameworks to determine whether a complainant is entitled to relief. Specifically, paragraph 4(a) of the UDRP Rules (the "Rules") requires that the complainant prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred: (1) the domain name registered by the respondent is identical or confusingly similar to a trademark or service mark in which the complainant has rights; (2) the respondent has no rights or legitimate interest in respect of the domain name; and (3) the domain name has been registered and is being used in bad faith.<sup>94</sup> Apparent in this UDRP legal standard, the UDRP is intended to resolve instances of clear cybersquatting, rather than bona fide uses of another's alleged trademark.<sup>95</sup> Thus, in comparison to U.S. common law jurisprudence, the UDRP framework is much more lenient to the respondent than for a defendant in a court lawsuit under U.S. trademark infringement standards. As a consequence, the UDRP is unsuited for resolution of trademark infringement disputes when a subsequent user of a mark either (i) has a legitimate interest in doing so or (ii) is using another's asserted mark within a domain name in good faith.<sup>96</sup> In short, under the UDRP, proof of mere "likelihood of confusion" is not

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<sup>92</sup> Compare source cited *supra* note 89 (providing that the UDRP's five basic stages are the filing of the complaint, the filing of the response, the appointment of a dispute resolution service provider, the issuance of a decision, and the implementation of that decision), *with Arbitration*, AM. ARB. ASS'N, [http://www.adr.org/aaa/faces/services/disputeresolutionservices/arbitration?\\_afLoop=471206020521674&\\_afWindowMode=0&\\_afWindowId=1a3odniana\\_6#%40%3F\\_afWindowId%3D1a3odniana\\_6%26\\_afLoop%3D471206020521674%26\\_afWindowMode%3D0%26\\_adf.ctrl-state%3D1a3odniana\\_18](http://www.adr.org/aaa/faces/services/disputeresolutionservices/arbitration?_afLoop=471206020521674&_afWindowMode=0&_afWindowId=1a3odniana_6#%40%3F_afWindowId%3D1a3odniana_6%26_afLoop%3D471206020521674%26_afWindowMode%3D0%26_adf.ctrl-state%3D1a3odniana_18) (last visited May 24, 2013) (listing that the American Arbitration Association's stages for arbitration are filing and initiation, arbitrator selection, preliminary hearing, information exchange and preparation, hearings, post-hearing submissions, and the award).

<sup>93</sup> *What is the UDRP?* Response to *Frequently Asked Questions: Internet Domain Names*, WORLD INTELL. PROP. ORG., <http://www.wipo.int/amc/en/center/faq/domains.html#16> (last visited May 24, 2013) (indicating that the UDRP focuses only on conflicts between trademarks and domain names).

<sup>94</sup> *Uniform Domain Name Dispute Resolution Policy*, ¶ 4(a), ICANN (Aug. 26, 1999), <http://www.icann.org/en/help/dndr/udrp/policy>; see also *The Coca Cola Company v. The Holy See*, Nat'l Arb. F., Claim No. FA0304000155454 (July 3, 2003) (Samuels, Arb.).

<sup>95</sup> Nicholas Smith & Erik Wilbers, *The UDRP: Design Elements of an Effective ADR Mechanism*, 15 AM. REV. INT'L ARB. 215, 221 (2004).

<sup>96</sup> See *What Types of Disputes Are Covered by the UDRP Administrative Procedure?*, FAQ for *WIPO Guide to the Uniform Domain Name Dispute Resolution Policy (UDRP)*, WORLD INTELL. PROP. ORG., <http://www.wipo.int/amc/en/domains/guide/index.html#a3> (last visited May 24, 2013). The UDRP is only available for disputes that meet the following criteria:

(i) the domain name registered by the domain name registrant is identical or confusingly similar to a trademark or service mark in which the complainant (the person or entity bringing the complaint) has rights; and

(ii) the domain name registrant has no rights or legitimate interests in respect of the domain name in question; and

(iii) the domain name has been registered and is being used in bad faith.

enough for a claimant to prevail.<sup>97</sup> Thus, claimants asserting trademark rights in religious names used within URLs would be remiss to bring claims against good faith users within the UDRP.

As a result, although UDRP claims must be resolved by the UDRP arbitration panel within fourteen days of their appointment, and thus, is often the most cost and time efficient means of resolving domain name disputes, this abbreviated type of proceeding will not be available for *McGill*-type cases. Because alleged infringers will have sought and obtained a domain name based upon a bona fide religious basis to do so, disputes as to these religious names in the new TLDs will be incapable of resolution within the UDRP dispute resolution process. Instead, these disputes will be timely and more costly, and will require resolution within courts. Courts may then be confronted with a flooded caseload of disputes over an expanded set of religious domain names, and they must resolve these cases within the existing methodology. Not only may courts struggle to do justice within this inadequate framework, in the event that it finds that trademark rights exist through a conjectural analysis of neutral principles, it may likely trample upon constitutional rights in the process and, in doing so, remove descriptors of common religious belief systems from the public domain.

This is not all. In restricting all *but one's* use of a particular religious name or phrase, courts will simultaneously be thwarting the objectives of TLD name expansion altogether for religious organizations. It seems to be incredibly inefficient to force TLD owners and registries to leave infinite “placeholders” for one particular intellectual property right-holder, or else, face imminent suit. Thus, I submit that the current religious trademark monopoly defies common sense moving forward in a modern world of infinite TLDs. Therefore, a presumption within the U.S. court system may serve to alleviate problems presented by TLD expansion in the current status quo when courts, not the UDRP, are faced with resolution of these disputes.

#### IV. PROPOSED SOLUTION: A PRESUMPTION THAT RELIGIOUS WORDS ARE GENERIC AND NOT PROTECTED BY TRADEMARK

The law creates presumptions in the interest of societal good in order to produce a probability of outcomes that promotes fairness and sound public policy.<sup>98</sup> For example, within U.S. trademark law, there currently exists a presumption against trademark protection of surnames.<sup>99</sup> If a proposed trademark is “primarily merely a surname,” then it is not capable of obtaining trademark rights unless a petitioner can present evidence of long and exclusive use that changes its significance to the public from that of a surname of an individual to that of a mark for a particular source

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*Id.*

<sup>97</sup> *Id.*

<sup>98</sup> Fed. R. Evid. 301 advisory committee’s note (“The same considerations of fairness, policy, and probability which dictate the allocation of the burden of the various elements of a case as between the prima facie case of a plaintiff and affirmative defenses also underlie the creation of presumptions.”).

<sup>99</sup> See 15 U.S.C. § 1052(e)(4) (2012).

goods or services (i.e. secondary meaning).<sup>100</sup> Public policy behind such a presumed exception keeps surnames available for people who wish to use their own surnames in their businesses, and not allow one person coming before them to monopolize another's own name.<sup>101</sup> Such an exception is presumed so long as the consuming public will not be confused due to a secondary meaning acquired by the name.<sup>102</sup> The presumption against trademark protection of religious names, as proposed in this Article, follows this same model.

#### A. Proposed Procedural Rules

To be clear, this Article does not propose that the law absolutely prohibit the protection of religious names as trademarks. Under the proposed framework, it is possible for religious names to garner protection. However, like surnames, a higher threshold for protection is necessary.

The following procedural mechanics are proposed: Regardless of whether or not a PTO registration exists, a party asserting trademark rights in a word or phrase that is “primarily merely a religious name” will have the burden to prove through “clear and convincing evidence” that the name has acquired secondary meaning—that the primary significance of the religious name in the minds of the relevant consuming public is not merely a religion or a religious belief system, but is instead a particular religious unit or organization that is an indication of source.<sup>103</sup> Whether or not a particular word or phrase is “primarily merely a religious name” will depend upon the court's evaluation of the word or phrase on a case-by-case basis, but should include consideration of the following two factors: (i) the frequency and geographic scope of use of the designation as the name of a religion or belief system; and (ii) the extent to which the designation has a recognized meaning as something other than the name of a religion or belief system. So as to avoid circumventing a trier of fact's determination as to whether the designation has acquired secondary meaning, in determining whether the designation is “primarily merely religious name,” a court should construe the facts in the light most favorable to the party against whom the proponent is seeking to enforce trademark rights. With regard to the proponent's burden of proof, “clear and convincing” evidence shall be found to exist when the proponent places in the mind of the ultimate fact finder that the proponent's factual contentions are “highly probably true.”<sup>104</sup> A “clear and convincing” standard of proof

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<sup>100</sup> See *Conagra, Inc. v. Singleton*, 743 F.2d 1508, 1513 (11th Cir. 1984).

<sup>101</sup> *Nat'l Cigar Stands Co. v. Frishmuth Bro. & Co.*, 297 F. 348, 349 (D.C. Cir. 1924) (“A person may put his own name upon his own goods, notwithstanding another person of the same name may, in that name, manufacture and sell the same or similar articles.”) (quoting *Columbia Mill Co. v. Alcorn*, 150 U.S. 460, 466 (1883)).

<sup>102</sup> *Id.* at 349–50.

<sup>103</sup> *Cf. Jews for Jesus v. Brodsky*, 993 F. Supp. 282, 298–99 (D.N.J. 1998). The standard suggested in this Article mirrors the standard promulgated in *Jews for Jesus. Id.*

<sup>104</sup> See *Har v. Boreiko*, 986 A.2d 1072, 1080 (Conn. App. Ct. 2010). One court described the “clear and convincing” standard as:

[A] degree of belief that lies between the belief that is required to find the truth or existence of the [fact in issue] in an ordinary civil action and the belief that is

is appropriate here, as the Supreme Court has previously applied the same standard in other cases which, like freedom of religion, involve important liberty interests.<sup>105</sup>

### *B. The Proposal Will Comport with International Norms*

Especially with regard to new TLD name extensions, it is important to keep in mind that these will have international reach on the Internet. If ICANN selects AGITSys, the private Turkish IT company that has submitted a bid for the <.islam> TLD, it will be able to control which Islamic voices are capable of being heard via the TLD. Perhaps this is why Saudi Arabia has opposed AGITSys' selection, as well as all other religious TLD issuances by ICANN.<sup>106</sup> Saudi Arabia, the birthplace of Islam, clearly has an interest in the preservation of its own religious heritage and sovereign autonomy. Others within the international community may also have similar important interests to safeguard against religious control.

In fact, to avoid trademark monopolization of religious designations, members of the international community have already determined that religious names and symbols should be treated differently with respect to trademarks. In Israel, "a mark identical with or similar to emblems of exclusively religious significance" is incapable of federal registration.<sup>107</sup> Moreover, in Hungary, "[a] sign shall be excluded from trade mark protection if . . . it consists exclusively of symbols having a close relation to religious or other beliefs."<sup>108</sup>

## CONCLUSION

Technology has previously compelled change within the law, and it will continue to do so. There was a time when the keystone of real property law was that land is protected by trespass law all the way down below and to an indefinite extent upward.<sup>109</sup> However, the expansion of technology, such as the invention and

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required to find guilt in a criminal prosecution. . . . [The burden] is sustained if evidence induces in the mind of the trier a reasonable belief that the facts asserted are highly probably true, that the probability that they are true or exist is substantially greater than the probability that they are false or do not exist.

*Id.*

<sup>105</sup> See, e.g., *Addington v. Texas*, 441 U.S. 418, 433 (1979) (holding that due process under the Fourteenth Amendment requires the State to prove by clear and convincing evidence that a person should be involuntarily committed for an indefinite period of time to a State hospital); *Santosky v. Kramer*, 455 U.S. 745 (1982) (holding that due process under the Fourteenth Amendment requires that "the State support its allegations" by clear and convincing evidence before it "may sever completely and irrevocably the rights of parents in their natural child").

<sup>106</sup> See Heneghan, *supra* note 2.

<sup>107</sup> Trade Marks Ordinance (New Version), 5732-1972, 26 LSI 511, art. 11(7) (Isr), *available in English at* [http://www.wipo.int/wipolex/en/text.jsp?file\\_id=128044](http://www.wipo.int/wipolex/en/text.jsp?file_id=128044).

<sup>108</sup> 1997. évi XI. törvény a védjegyek és a földrajzi árujelzők oltalmáról (Act XI of 1997 on the Protection of Trademarks and Geographical Indications, art. 3(2)(c)) (Hung.)

<sup>109</sup> See Sir William Blackstone, *Commentaries on the Laws of England (1765–1769)*, LONANG, <http://www.lonang.com/exlibris/blackstone/bla-202.htm> (last visited May 24, 2013).

widespread prevalence of airplanes, made it necessary to craft new law, as the “indefinite extent upward” concept defied common sense in contemporary times and would expose every airplane flight operator to “countless trespass suits.”<sup>110</sup> Although admittedly not as technologically pioneering as aviation, the impact of ICANN’s release of new TLDs places the protection of religious trademarks at a precipice. Once a religious TLD is awarded, a generic religious name should not also be monopolized elsewhere in cyberspace or in the physical world.

We should rethink how we apply the law to cases involving religious trade names. A presumption against trademark protection may indeed reduce the number of religious trademark cases brought forward to courts, limiting those cases that *do* come to bar to those with convincing claims of secondary meaning. In addition to bolstering the integrity of a neutral principles trademark analysis, minimizing monopolies on generic religious names will correspondingly reaffirm a commitment to preservation of constitutional freedoms.

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<sup>110</sup> United States v. Causby, 328 U.S. 256, 260–61 (1946).