

The Florida Trademark Decision

PART ONE OF THREE

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On Thursday morning, April 27, 2000, Judge James Lawrence King, presiding over the case of the Eternal Gospel Church of Seventh-day Adventists vs. the General Conference Corporation of Seventh-day Adventists, issued his official decision.

He ruled against the Perez group (the Eternal Gospel Church).

We are all shocked, totally shocked.

If this decision stands, the General Conference will be able to go through the United States like a mowing machine, cutting down many independent Adventist churches which openly declare themselves to be such.

We have full confidence that the Perez group and their attorney will appeal this case all the way to the U.S. Supreme Court. Whether or not they will win on appeal is not clear. Some think they will; others are not as sure. One thing is certain: Judge King was about as nice a judge as we could ask for, yet he ruled against us. He may have forewarned of this when, in the court transcript, he spoke of the painful duty he might have to do.

The Perez group has 10 working days in which to appeal this case. They will submit appeal papers before May 10.

The ruling was initially issued about three hours ago in faxes from the Judge's chambers to the opposing attorneys. An hour ago, we received a fax copy of the 18-page ruling. A carefully written document, it is our belief that Ramik probably authored it. Both sides in a civil suit often submit a paper which, if they win, can be used as a final decision which, if they win, the judge can use if he so desires. We know this was done in the Michigan Proctor suit against the General Conference in the mid-1980s, which the latter organization won.

Between court sessions in March, General Conference officers stated privately to their opponents that, if they won, they would hunt down and eliminate both large and small competitors.

This tract study will be mailed out within a few days. Along with it, we will enclose a copy of a tract set we were planning to send you very soon: *Summary of 36 Legal Defense Points to be Used in a Trademark Lawsuit or Appeal*.

There is no need to go over defense legal points

in this present paper, for we have abundantly dealt with that in other tracts and booklets.

Surely, as we view the General Conference hailing little groups into court because they refuse to abandon their faith, it is clear that we are nearing the end of time.

There are 52 numbered paragraphs, plus his official ruling, in Judge King's 18-page ruling. (The contested name, of course, is "Seventh-day Adventist." Although no evidence was presented by the plaintiff in court to defend its claim to control of "SDA," the ruling frequently referred to that acronym as also protected.)

Because there is so much detailed material, we are reprinting the entire ruling in the last part of this tract set, and will introduce it with some brief comments. You would need to read our comments in connection with the actual numbered paragraphs in the ruling. We will focus our comments on unique new items that will be cited here:

This present study is NOT concerned with stating our positions, but will clarify their positions, as stated in the judge's ruling.

SPECIAL ITEMS TO NOTE

#3 - (1) Two plaintiffs are listed, even though only the first did the suing! (2) The General Conference declares itself to be the "spiritual church," a doctrinal teaching Adventists have never believed. Is there no literal church anywhere? (3) The Corporation holds "title to the church's spiritual assets," i.e., the name Seventh-day Adventist. According to this, the name does not belong to the believers, even those on the church books, but only to a legal paper corporation, in Maryland, which has no other activity than one meeting a year to maintain its corporate status.

#4 - "Washington" is written because the Perez group was originally incorporated in Washington State.

#5 - The key point in the Lanham (Trademark) Act is the "likelihood of confusion" in the title. The best way to avoid this is to include "Independent" in the church title; that is, if your group wants to defend itself in a lawsuit over this.

#8 - *Incontestable*. The General Conference main-

— *Continued on page three*

LEGAL POINTS IN THE 18-PAGE RULING

INTRODUCTION

Jurisdiction (court authority over this matter), *venue* (trial location was correct), *plaintiff* and *defendant* identified. #1-3.

As we have pointed out many times, the key legal point of this trademark litigation is **likelihood of confusion**. This is the pivotal point in the Lanham Act. #5. Everything else in this ruling is focused on establishing this point.

There are **four levels** of legal strength in a trademark defense. #6. This ruling recognizes that **generic** names cannot be trademarked, but tries to identify the contested name as **descriptive**; that is, as **brand descriptive** (not **generic descriptive**), and therefore it is trademarkable.

Anything that is generic cannot be trademarked. It is the name of a general class, to which many different members belong. Here are three examples to explain generic and descriptive:

(1) *Generic non-trademarkable general class*: “tape.” *Trademarkable descriptive subclass*: “Scotch.” *Non-trademarkable generic subclasses* (which themselves can have trademarkable subheads): “magnetic tape,” “video tape.”

(2) *Generic non-trademarkable general class*: “Seventh-day Adventist.” *Trademarkable descriptive subclasses*: “General Conference of Seventh-day Adventists.” *Non-trademarkable descriptive subclass*: “Seventh-day Adventist believers,” “Seventh-day Adventist faith,” “Hillside Independent Seventh-day Adventist Church.” (The latter item is improperly rejected in this ruling.)

(3) *Generic general class*: “Latter Day Saints.” *Trademarkable descriptive subclass*: “Church of Latter Day Saints,” “Reorganized Church of Latter Day Saints.” *Non-trademarkable descriptive subclass*: “Latter Day Saints books,” “[Location name] ‘Latter Day Saints Temple.’”

We have noted two of the four levels, cited in #6 (generic and descriptive). Here are the other two: An example of a **suggestive** term would be “Whirlpool Washing Machine Company.” The company name describes the action of the machine. An example of a **fan-ciful or arbitrary** term would be “Exxon Oil Corporation.” The name in no way describes the product, thus rendering an extremely strong factor.

Another key point is **secondary meaning** #7. Descriptive words, which would normally be generic, can be trademarked when they acquire a secondary meaning. (Scotch tape means not tape from Scotland, but from the 3M Company).

TWENTY LEGAL POINTS

After the introductory groundwork is laid in the first few paragraphs, the following legal points are discussed. Everything is geared to showing that the General Conference has a duly processed trademark,

that there is confusion when other religious groups use it, and that the Perez group has damaged the General Conference and the name by using it.

Likelihood of confusion. This is discussed in #5, 9, 10, 11, 21, 30, 44, 45, 46.

Similarity. #9. Seven factors are listed. The key point repeatedly discussed, in this ruling, is **similarity of marks**. (Because others are calling their groups by the contested name, therefore they are in trademark violation.)

Secondary meaning. #12, 13, 24, 25, 26.

Trademark control. The contested name is under trademark control. This is discussed in #14 (note coverage; the Kinship ruling permitted both individual usage of the name and non-General Conference organizations to use it in titles not bearing the name “church.”), #15, 29.

History and actions of the Perez group, showing it should not be permitted to use the name. Everything is made to show a conspiracy on the part of the Perez group, to misuse the name and bring both it and the General Conference into disrepute through controversial radio broadcasts and newspaper ads. The only point whereby this was said to be done was attacks on the Roman Catholic Church. #16, 17, 18, 19, 20, 21, 22, 30, 38, 41, 43, 47, 48, 49, 50, 51.

Generic. #6, 22, 31, 32, 33, 34, 35, 37. #37 says the name may be generic when applied to a religion [so ruled by Kinship], but not when applied to a church.

Suggestive. #6, 22.

Descriptive. #6, 22, 23.

Incontestable. #8.

Early Adventist history. #24, 36.

The Roper survey. #26, 37 (but the data is wrongly applied).

Foreign equivalent names also covered. #28.

Injury to plaintiff's reputation. #16-22, 29, 30, 49.

Relation to the Kinship Case. How the Kinship decision relates to this one. #31, 32, 33, 34, 35. Important admissions are made in King’s official ruling: (1) The right of other organizations to use the name in their group name, as long as they do not add the word “church” to the title #32, 33. (Added is the false claim that Kinship ruled that the name could not be used in religious publications.)

Laches. #38, 39, 40, 41 (whether or not the General Conference improperly delayed in asserting its trademark right).

Acquiescence. #38, 41, 42, 43, 44. (Did a General Conference entity actively consent to usage of the name by the Perez group?)

Fair use. #31, 46, 47.

Source or origin. #48, 49.

Good faith. #49.

Religious institutions can use the trademarking laws. #52.

The Florida Trademark Decision

tains the name cannot be overturned in a court battle because, after applying for the trademark, the General Conference waited five years (November 1981–November 1986) before going after its rivals. (But the trademark was falsely obtained on the basis that no one else was already using it and it was the original user.)

#10-11 - Think through the “seven factors,” espe-

cially as stated in #11. There are flaws in the General Conference’s claim, that it can rely on any of the seven. The religious faith nature of the name, the prophet’s requirement that we all use it, prior usage by individual believers before the General Conference had it, the untruthful trademark application, the fact that a church is not a business and has no products nor customers—are all points to consider in discounting

How can you protect yourself and your little group from legal harassment by the General Conference? (By “the name,” we mean, “Seventh-day Adventist.”)

1 - This case did not deal with your personal freedom to call yourself by the name. You have that right, and it cannot be taken from you. Undergirding that right is the Kinship decision, which stated that even former Adventists (no longer on church rolls) have the right to call themselves by the name.

2 - If you are a member of a group, which wants to advertise itself using the name, but is not a church, the Kinship judge ruled that this right is secure to you. However, even though that is true, if your non-church group does advertise itself by the name, you should expect that Ramik may threaten a suit to stop you, and may actually sue you. The problem here is they have more money than you do; for they can, and do tap, directly into the tithe funds of the North American Division. By threatening, they hope to intimidate you into yielding.

3 - If you are a church group and wish to use the name, along with the word, “Church” in your title, you should expect to be sued; whether or not it actually occurs. However, if sued, you are more likely to win your case if you include the word, “Independent” in your title. Unfortunately, the Perez group did not do this. It would have made their defense stronger if they had.

4 - You are likely to receive a threatening letter, before you are sued. You may wish to write back, that you will stop using the name on all public and legal papers and signs (corporation papers, property ownership, yellow pages, church signs, church bulletins, advertising, etc.). If you do what you wrote, that should end the matter.

5 - But if the General Conference actually files a suit against your group, it will only settle out of court if you agree to sign the notorious (and terrible) *Settlement Agreement*. (See our booklet, *Legal Defense against a Trademark Lawsuit, plus the Notorious Settlement Agreement*, in which the Agreement is reprinted.)

6 - If you choose to go to court, you will want to obtain our various trademark booklets. They are

filled with information and legal data.

7 - Keep in mind that the Kinship case ruling gives non-church groups the right to use the name both in their title and in their advertising. The Kinship group was flagrantly mailing flyers to students in Adventist colleges and universities, encouraging them to get involved. Oddly enough, the Kinship group frequently held weekly, and other, worship services. Yet they did not happen to call themselves a church. They differed from the Perez group in that they did not use the word, “church,” and they primarily engaged in non-church activities (partying around and advertising themselves). The Kinship case also ruled that individuals, who were no longer General Conference church members, could openly call themselves by the name.

8 - Here are several suggestive ideas for your group worship meetings:

(1) Do not place a sign out front. If you do not use the words on any group signs, legal papers, or advertising (including church bulletins), you should not legally be able to be sued.

(2) Do place a sign, and on it write simply, “Seventh-day Adventist Believers Meet Here.” To legally strengthen it, write something like this:

**Independent
Seventh-day Adventist Believers
Meet Here**

(3) In any advertising, either do not include the name in your title or, if you want to identify your religious faith, write something like this:

**Published by
Independent Seventh-day Adventists
[address or phone number]**

Your independence and your individuality are key factors. The statement of independence (separateness) shows non-confusion; the individuality links you to your First Amendment religious rights.

Immediately beneath your sign, ads, and any public papers (including your worship bulletins), print this disclaimer. It should be the same size as the above title or only slightly smaller.

**Not part of or affiliated with
The General Conference of Seventh-day Adventists
headquartered in Silver Spring, Maryland
or any of its subsidiaries**

these “seven factors.”

#14 - Note the claim that the trademark extends to publications. (In reality, they will only threaten you with a suit if, in your meetings or publications, you identify yourself as a “Seventh-day Adventist Church.”) / Ignored is the fact that the Kinship organization was permitted to use the name, without “Church.”

#22 - The name “is at least suggestive and, at a minimum, is descriptive (not generic).” This is essentially stated twice in this paragraph. The Kinship judge ruled that the name is generic; this Florida ruling says it is not. (A generic name cannot be trademarked.) Our name is definitely generic! It is the name of a class of people, whether or not they are affiliated with the General Conference, because it expresses their religious faith. It is also the name of the faith itself. These facts, covered by the First Amendment, ought to cancel the suit. / Great efforts are repeatedly made to declare the name to be descriptive—but not of the faith or the individual believers (to which it also applies; therefore making it a general class generic term), but solely to the General Conference Corporation (that exclusive application is ridiculous).

#25 - The survey did not “identify the” name “with the Plaintiff Church.” Read our analysis of the transcript or the transcript itself.

#31 - Another untruth. The Kinship ruling only stated that it was not ruling on the word, “Church”

with the name; that would have to be decided in a separate court decision. Yet the General Conference started a second trial on the use of the name, when that had already been decided by the Kinship judge.

#38-41 - “Latches” is a legal term and means a party has the right to use the name because, for a time, the party belonged to the organization owning it.

#42 - “Acquiescence” means an official of the ownership organization gave permission to the other party to use it. (For more on this, see our analysis of the transcript or the actual transcript.)

#46-50 - “Used fairly and in good faith” is a definition of the “fair use defense.” The General Conference contends the Perez group did not use the name properly.

#51 - Another untruth. During the trial, it was clearly shown that the defendants had to keep the name as a matter of religious faith.

In view of the many half-truths and mistruths, I do believe Ramik, not the judge, wrote this ruling.

On the last page of the 18-page ruling, you will find the judge’s ruling. He has “enjoined” the group from using the name, “Seventh-day Adventist,” or the acronym, “SDA.” No penalties are mentioned. (They could have been!) Since the group will be appealing the decision, the penalty stage (to be determined in another hearing) will be on hold till all appeals are completed.