

REGISTER TRADEMARKS AND KEEP THE FAITH: TRADEMARKS, RELIGION AND IDENTITY

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ABSTRACT

Religious organizations frequently wage battles in court over the use of religious trademarks. These battles, however, are not directed toward winning traditional trademark rights. At the heart of these disputes is a struggle to protect religious identity. This article argues that religious organizations use trademark law to protect their identities because there are no other viable legal means available. Nevertheless, trademark law cannot wholly protect religious identity because of its focus on consumer perception. Because of the deficiency provided by current trademark law, this article proposes a new conceptual framework for resolving these disputes.

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INTRODUCTION

It is common knowledge among legal academics, practitioners and students of trademark law that trademarks act as source identifiers. Indeed, the goal of trademark law is to provide legal protection for names or symbols that represent a source. Though many trademark disputes arise between commercial corporations, not only large, commercial conglomerates use trademarks. This article examines trademark issues with respect to religious organizations. Specifically, this article explains why religious organizations use trademarks, the risks associated with religious trademark use, how these disputes play out in courts, whether trademark law sufficiently addresses the goals of religious organizations and which alternative methods of dispute resolution would better address these goals.

Part I of this article examines the role of trademarks as source identifiers. It also evaluates the ways in which trademarks can represent identity. Specifically, this section seeks to explain the degree to which trademarks can be used by religious organizations to protect their identities. In the process, the shortcomings of trademark law protection are outlined with respect to the goals of religious organizations. Part I further articulates how the limitations consciously imposed upon trademark law, such as the focus on consumer protection, prevent religious organizations from protecting their identities to the extent they desire.

Part II outlines real-world legal disputes between religious organizations enforcing their trademark rights. These disputes arise in several different contexts. This section analyzes the courts' decisions, paying particular attention to the courts' treatment of identity when resolving the disputes. This section also illustrates precisely how identity disputes play out in the courts under the guise of trademark law. Courts often explicitly mention the underlying religious dispute but, without fail, resolve the case on non-religious, trademark-based grounds. The courts' unwillingness to depart from trademark law principles highlights the ways in which trademark law is inappropriately used by religious organizations and courts to preserve religious identity. The underlying religious disputes are illuminated by relating each case to many of the problems, outlined in Part I, that religious organizations encounter when they attempt to protect their identities through trademark law.

Finally, Part III proposes a solution to the risks and problems associated with religious organizations' use of trademark law to protect their identities. This solution uses a non-judicial adjudicative entity to police the authenticity of religious identity. In many ways, it mimics the policy of the Uniform Dispute

Resolution Policy (“UDRP”),¹ developed by the Internet Corporation for Assigned Names and Numbers (“ICANN”) to resolve cybersquatting disputes. This section analyzes how the proposed solution differs from current trademark protection, how it differs from the UDRP and how it poses other problems for religious organizations.

I. TRADEMARKS AND IDENTITY

Trademarks are source identifiers. Trademark law protects “any word, term, name, symbol, or device, or any combination thereof” only when it indicates the *source* of the goods on which the mark appears.² But trademark owners typically can assert legal claims only if another uses a mark that “is likely to cause confusion, . . . mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person.”³ The protection is limited because “trademark law’s goal is to promote rigorous, truthful competition in the marketplace.”⁴ Unless two marks are confusingly similar, there is a low risk of jeopardizing the trademark’s source-identifying function.

What constitutes a “source,” however, is not limited to corporate producers of commercial products. Religious organizations can also serve as sources and, therefore, can also own trademarks in religious names or symbols.⁵

¹ ICANN, Uniform Domain Name Dispute Resolution Policy (Oct. 24, 1999), <http://www.icann.org/dndr/udrp/policy.htm> [hereinafter UDRP]. The UDRP also contains rules of procedure. ICANN, Rules for Uniform Domain Name Dispute Resolution Policy (Oct. 24, 1999), <http://www.icann.org/dndr/udrp/uniform-rules.htm> [hereinafter UDRP Rules].

² Lanham Act § 43, 15 U.S.C. § 1125(a)(1)(A) (2006); GRAEME B. DINWOODIE & MARK D. JANIS, *TRADEMARKS AND UNFAIR COMPETITION* 57 (2004) (stating that trademark rights are limited because they “symbolize the goodwill attaching to the product they identify”).

³ § 1125(a)(1)(A). Trademark law also protects the owner from “dilution,” *id.* § 1125(c), as well as several other causes of action. *See id.* § 1125.

⁴ David W. Barnes, *A New Economics of Trademarks*, 5 *NW. J. TECH. & INTELL. PROP.* 22, 49 (2006).

⁵ A trademark must indicate the source of goods or services by nature of its definition. 15 U.S.C. § 1127 (2006) (“The term ‘trademark’ includes any word, name, symbol, or device, or any combination thereof . . . [that] indicate[s] the source of the goods” (alterations added)). Thus, a religious organization must affix its mark to goods or services to qualify for trademark protection. *Id.*

The concept of “collective marks”⁶ helps show how religious organizations can obtain trademark protection. Groups own collective marks and use of a collective mark indicates membership in that group.⁷ Collective marks may be either “collective trade (or service) marks” or “collective membership marks.”⁸ Collective trade and service marks represent that the source of the goods or services is a member of a larger group,⁹ while membership marks indicate membership in a group rather than indicating a source.¹⁰

Religious trademarks embody one or both of these functions depending on the way in which the organization permits use of the mark. The theory of collective marks—that a mark can indicate membership in an organization—implies that the organization has a coherent identity. Thus, the theory of collective marks provides religious organizations with a legal means to attempt to protect their identities using trademark law.

Trademark law can protect religious trademarks that are source identifiers, such as religious names or symbols. The real issue, however, is *what* trademark law actually protects with respect to religious names or symbols. Scholars have traditionally articulated four functions of trademarks:

- (1) [t]o identify one seller’s goods and distinguish them from goods sold by others;
- (2) [t]o signify that all goods bearing the trademark come from or are controlled by a single, albeit anonymous, source;
- (3) [t]o signify that all goods bearing the trademark are of an equal level of quality; and
- (4) [a]s a prime instrument in advertising and selling the goods.¹¹

⁶ A collective mark is “a trademark or service mark used by the members of a cooperative, an association, or other collective group or organization . . . and includes marks indicating membership in a union, an association, or other organization.” *Id.*

⁷ Tunisia L. Staten, *Geographical Indications Protection Under the TRIPS Agreement: Uniformity Not Extension*, 87 J. PAT. & TRADEMARK OFF. SOC’Y 221, 239 (2005).

⁸ *Id.*

⁹ Trademark Manual of Examining Procedure § 1303 (2006) [hereinafter TMEP] (“Collective trademarks and collective service marks indicate commercial origin of goods or services, but as collective marks they indicate that the party providing the goods or services is a member of a certain group and meets its standards for admission. The mark is used by all members of the group; therefore, no one member can own the mark, and the collective organization holds the title to the collectively used mark for the benefit of all members of the group.”).

¹⁰ *Id.* § 1304.01 (“Membership marks are not trademarks or service marks in the ordinary sense; they are not used in business or trade, and they do not indicate commercial origin of goods or services. Registration of these marks fills the need of collective organizations who do not use the symbols of their organizations on goods or services but who wish to protect their marks to prevent their use by others.”).

¹¹ 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 3.2 (4th ed. 2007) (alterations added).

Equally important is trademark law's ability to protect "goodwill," the satisfaction and preference consumers experience with a product developed in connection with the trademark.¹² For example, consumers buy Coca-Cola Co. products because they have come to associate a particular quality, taste, image or other characteristic with the name "Coca-Cola." In essence, Coca-Cola Co.'s reputation is intertwined with its name. The reach of trademark law, however, is not limited to the protection of goodwill.¹³ Recently, trademarks have come to represent other aspects of life, such as image,¹⁴ myth¹⁵ or experience.¹⁶

As trademark law expands to encompass these other aspects of life, questions arise as to what else trademarks may protect. This article argues that, to a certain extent, trademark law can protect religious identity. Several examples in Part II show that religious organizations already use trademark law to protect their identity. This protection, however, is inadequate because the purpose of trademark law is not to protect religious identity.¹⁷ Instead, the law focuses on how consumers perceive a trademark, a focus targeted primarily at commercial organizations offering goods or services.

Subsection A discusses how religious organizations can use trademark law as a vehicle to protect their religious identity, exploring, in particular, what "identity" means for a religious organization. Subsection B then discusses how trademark law is an imperfect method of protection for religious organizations. Because trademarks are cultural symbols that are subject to change when consumer perception shifts, subsection B argues that religious groups face challenges when they attempt to protect their "authentic" religious identity with trademarks. Subsection C analyzes how the doctrines of parody, scandalous and disparaging marks, and dilution affect trademark law's ability to protect religious identity. Subsection D explains the Lanham Act's "use in commerce" requirement, which inhibits religious organizations from protecting their identity

¹² *Id.*

¹³ *Id.*

¹⁴ Thomas D. Drescher, *The Transformation and Evolution of Trademarks – From Signals to Symbols to Myth*, 82 TRADEMARK REP. 301, 329 n.98, 336 (1992). Status differs from lifestyle because a status need not be the way someone leads his or her life, it may just be a position in society (although it may be subsumed by lifestyle).

¹⁵ *Id.* at 329–33.

¹⁶ *Id.* at 332–33.

¹⁷ This article does not comment on the normative issue of whether this inadequate protection is better or worse for society. Part III assumes that the current inadequacies are at least an anathema for religious organizations and proposes a potential framework that addresses this issue.

through trademarks. Finally, subsection E proposes a hypothetical scenario that illustrates all of the problems outlined in the prior subsections.

A. *Identity*

Religious organizations' identities, like that of corporate entities, are intertwined with their trademarks, or at least in their names. It should therefore come as no surprise that religious organizations use trademark law to protect their identities. Religious organizations use trademarks because trademarks "are cultural forms that assume local meanings . . . [for] those who incorporate them into their daily lives."¹⁸ Trademarks allow consumers to differentiate themselves from one another.¹⁹ Consumers construct their identities in part by the products they consume; consumers identify with the products they buy and the religions to which they belong.²⁰ If a person does not consume a certain product or belong to a certain religion, the consumer will not identify with the particular mark associated with that product or religion. Rosemary Coombe disdainfully argues that intellectual property law gives the trademark owner the right to "fix social meaning."²¹ She argues that the use of trademarks, both corporate and religious, results in "excess meaning"—meaning beyond brand signification—which inures to the trademark owner's benefit.²² Trademark law, by protecting these marks, allows the owners of the marks to control, at least to some degree, the social meanings of the mark.²³

To a religious organization, this control allows it to construct and protect the representation(s) of a religious name. Control of the organizational trademark is crucial to religious capital because the value of the mark consists of

¹⁸ ROSEMARY J. COOMBE, *THE CULTURAL LIFE OF INTELLECTUAL PROPERTIES: AUTHORSHIP, APPROPRIATION, AND THE LAW* 7 (Stanley Fish & Fredric Jameson eds., 1998) (alteration added).

¹⁹ Llewellyn Joseph Gibbons, *Semiotics of the Scandalous and the Immoral and the Disparaging: Section 2(A) Trademark Law After Lawrence v. Texas*, 9 MARQ. INTELL. PROP. L. REV. 187, 201 (2005).

²⁰ COOMBE, *supra* note 18, at 7.

²¹ *Id.* at 26, 50–51, 70–71. Coombe does not restrict her contention to trademarks, but refers to owners of intellectual property rights generally. *Id.* at 26.

²² *Id.* at 53, 71.

²³ *Id.* at 53. As we shall see, Coombe's observation is not entirely correct as it relates to trademarks. While the owner of a trademark may "own" the "social meanings" associated with the mark, those meanings may change, mostly as a result of how consumers receive the product (and the producer's intended meaning). Moreover, the ownership rights that trademark law bestows do not prevent others from utilizing the work to produce new, creative social works (e.g., parody).

its identity.²⁴ The value of a mark for a religious organization lies in the association between the ideas, values and beliefs of the organization and the mark itself.²⁵

Collective marks play a role in the maintenance of religious organizations' identities.²⁶ The collective mark represents the embodiment of the organization's collective identity as owned by a group—something identified with and by all members of a religion.²⁷ Thus, the whole identity of the religious group—its ideology, its teachings and its practices—is contained in an identity-indicating name or symbol.²⁸ The collective mark allows a religious group to invest its identity in a legally-controllable entity. Legal control over the trademark therefore enables the religious organization to maintain its identity.²⁹

Yet, the actual amount of control religious organizations exercise over their trademarks may not be as great as Coombe argues. The meaning of a religious trademark, like other trademarks, changes over time. The identities that trademarks represent are fluid and formed through social processes.³⁰ Thus, identity is not a "possession"³¹ in the strict sense of the word; the trademark itself can be possessed, but the meaning identified with it is subject to change. Identity is created and sustained by human interaction and social discourse.³² The trademark is a cultural symbol, a semiotic sign, which gains importance only through its use and dialectical transformations.³³

²⁴ See COOMBE, *supra* note 18, at 56; Drescher, *supra* note 14, at 302–03.

²⁵ As can be gleaned from the discussion in this section, the identity discussed here is conceptually *outward*; the ontology of religious identity is described in terms of how everyone—not merely the group or its members—views the organization. This article recognizes that identity may also be *inward*, defining the ontology in terms of one's own beliefs about one's self, or a group's collective beliefs about itself. A full ontology would include both the inward and outward approaches, but this article concerns mostly the outward ontological approach because trademark law focuses on consumers, not producers.

²⁶ Staten, *supra* note 7, at 239.

²⁷ F.R. Lepage Bakery, Inc. v. Roush Bakery Prods. Co., 851 F.2d 351, 354–55 (Fed. Cir. 1988), *withdrawn and vacated on other grounds*, 863 F.2d 43 (Fed. Cir. 1988) (affirming TTAB decision that individuals cannot own collective marks).

²⁸ Staten, *supra* note 7, at 239.

²⁹ *Id.* at 240.

³⁰ Cf. THOMAS MEYER, *IDENTITY MANIA: FUNDAMENTALISM AND THE POLITICIZATION OF CULTURAL DIFFERENCES* 15 (2001) (discussing the fluid concept of personal and social identity generally).

³¹ *Id.*

³² COOMBE, *supra* note 18, at 29, 50–51.

³³ For more on semiotics, see Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 UCLA L. REV. 621, 630–632 (2004).

B. Instability of Identity

A religious organization cannot use trademarks to guarantee protection of its identity. The benefits of trademarks as legal protection come with attendant risks; all trademarks face the risk of instability or destabilization because the meaning associated with the trademark can change. This risk is especially poignant for religious organizations because they seek to protect their *religious* identity using trademarks. Because the destabilization of a trademark affects a religious organization's identity, instability threatens both legal rights and social identity—that is, the beliefs and values associated with the trademark.

There are two interrelated reasons for the instability of trademark identity, and for why religious organizations risk losing protection of the meaning they desire to be associated with their names.³⁴ First, trademarks are cultural symbols, the meanings of which are ever-changing.³⁵ Second, although trademark law incorporates the producer's intended meaning, it is concerned primarily with consumer perception, not factual truth.³⁶ Trademark law has a clear commercial focus; it is a system focused on the consumer. The interaction of these two forces illustrates why religious organizations face unique risks when protecting their identity with trademarks.

1. Changing Cultural Symbols

Trademarks are cultural symbols. They are not monolithic,³⁷ they “evoke a wealth of . . . meanings,”³⁸ and they are capable of capturing a panoply of experiences and ideas.³⁹ Cultural symbols are “cultural works, that is, works (objects, performances or services) whose primary purpose is the making of meaning,” that acquire significance through internalization and reception.⁴⁰

³⁴ They therefore also risk losing protection of the mark itself. If, for example, consumers begin to associate the mark with a generic source, a mark could lose its legal protection. *See, e.g., infra* Part I(B)(2)(a).

³⁵ CELIA LURY, *CULTURAL RIGHTS: TECHNOLOGY, LEGALITY AND PERSONALITY* 40–41 (John Urry ed., 1993).

³⁶ *See infra* Part I(B)(2).

³⁷ Drescher, *supra* note 14, at 304. Discussing the difference between signals and symbols, Drescher stated, “[w]hile signals might trigger a response, they lack the spectrum of meaning belonging to symbols. Symbols derive their power from a range of meanings which resonate like a grouping of notes, like a musical chord.” *Id.* (footnotes omitted).

³⁸ *Id.*

³⁹ *Id.* at 339.

⁴⁰ LURY, *supra* note 35, at 2, 40–41.

Internalization is the process by which producers “adopt[] . . . a particular conception of the audience and an implied activity of reception.”⁴¹ In this way, producers seek to maximize the reception of a cultural work. Producers conceive of an audience and present their ideas. The receivers are those individuals that comprise the audience; they *receive* the cultural symbols.⁴² If a particular symbol is presented to the public, but the public rejects the symbol rather than receiving it, it will not gain cultural significance. Likewise, if a mark owner adopts a mark, but it does not come to attain meaning as a source identifier for the public, the law does not recognize it as a trademark.⁴³

As a corollary, cultural symbols are always the result of the interaction of societal forces and cannot exist in isolation.⁴⁴ There is a constant, reciprocal relationship between receivers and producers, which creates constant change in the meaning of cultural symbols.⁴⁵ Since trademarks are cultural symbols, their meanings constantly change.⁴⁶ No matter how fixed the meaning of a cultural symbol may become,⁴⁷ it will inevitably change in some way.⁴⁸ This does not mean that a trademark is unable to constantly represent something. It simply means that the variety of things that a trademark represents is constantly chang-

⁴¹ *Id.* at 7 (alteration added).

⁴² *Id.* at 6–7, 14–15.

⁴³ *See, e.g.,* Park 'N Fly, Inc. v. Dollar Park & Fly, Inc., 469 U.S. 189, 194 (1985). In *Park 'N Fly*, the Supreme Court stated that a descriptive mark, which “describes the qualities or characteristics of a good or service, . . . may be registered only if the registrant shows that it has acquired secondary meaning.” *Id.* “Secondary meaning” signifies that the public associates the trademark with the owner’s source and not the product itself. *Qualitex Co. v. Jacobson Prods. Co., Inc.*, 514 U.S. 159, 162 (1995) (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851 n.11 (1982)).

⁴⁴ Drescher, *supra* note 14, at 304.

⁴⁵ LURY, *supra* note 35, at 40–41; *see also* Regan Smith, Note, *Trademark Law and Free Speech: Protection for Scandalous and Disparaging Marks*, 42 HARV. C.R.-C.L. L. REV. 451, 478 (2007) (discussing how semiotic theory relates to trademark law, the author observes that, “[s]ince the meaning of a symbol is created in relation to other symbols, a mark’s meaning would not be fixed”). Michael Holquist similarly views culture as an ongoing process of meaning acquisition. MICHAEL HOLQUIST, *DIALOGISM: BAKHTIN AND HIS WORLD* 41 (2d ed. 2000).

⁴⁶ COOMBE, *supra* note 18, at 82–84.

⁴⁷ *See* Justin Hughes, “Recording” *Intellectual Property and Overlooked Audience Interests*, 77 TEX. L. REV. 923, 952 (1999) (arguing that trademarks can be stable but seemingly overlooking the idea that trademarks have the potential to become unstable).

⁴⁸ COOMBE, *supra* note 18, at 85–86.

ing in small and probably unnoticeable ways, but it has the potential to transform into a different cultural symbol altogether.⁴⁹

Because the associations that create a trademark or a cultural symbol change, those that perceive them may also change. This change in audience can give rise to new meanings and symbols.⁵⁰ Celia Lury states that “[g]eneral movements of social and cultural relations can effect the entry of new audiences into the cultural market.”⁵¹ This can occur in at least three situations. First, new social groups can arise.⁵² In the context of religion, this can occur when a group of individuals establishes a new religion. In these cases, new producers, cultural symbols, and therefore receivers, arise. These cultural symbols may be similar or different from the existing cultural symbols associated with other religions. Second, a social group may redefine itself within its own context.⁵³ This often occurs within religions. One faction within a church, for example, may separate due to dissatisfaction with the ecclesiastical teaching of the mother church. Third, new means of production create new audiences.⁵⁴ Throughout the twenty-first century, technology has created new religious audiences.⁵⁵ The Internet has allowed millions of people to explore religions quickly and with low cost. People can now easily find new religions and develop their own meanings for religious marks.

These scenarios imply that new audiences necessarily include new receivers. The dynamic created by new audiences and receivers leads to new or changed cultural symbols and creates a number of issues for trademark law. Thus, this list is illustrative only, not exhaustive. Some of these scenarios include situations in which religious identities are involuntarily reshaped, thereby threatening the identity of the religious organizations.⁵⁶ Religious identity becomes threatened when new audiences arise in some of these contexts. As a

⁴⁹ Where, however, a mark no longer identifies a single source, it may lose its trademark protection. *See infra* Part I(B)(2).

⁵⁰ LURY, *supra* note 35, at 41.

⁵¹ *Id.* at 40–41.

⁵² *Id.*

⁵³ *Id.*

⁵⁴ *Id.*

⁵⁵ Elena Larsen, *Cyberfaith: How Americans Pursue Religion Online*, in RELIGION ONLINE: FINDING FAITH ON THE INTERNET 17 (Lorne L. Dawson and Douglas E. Cowan eds., Routledge 2004) (“Some 28 million Americans have used the Internet to get religious and spiritual information and connect with others on their faith journeys.”).

⁵⁶ *See infra* Part II.

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result, religious organizations use trademark law to maintain the uniformity of their trademark(s).⁵⁷

2. Consumer Perception

Trademarks are cultural symbols that change because of continuous distribution, reception and redefinition. Trademark law accommodates this uncertainty by maintaining a commercial focus. Specifically, trademark law focuses on consumer perception. Trademark law protects the trademark owner from the use of other marks that are likely to confuse the public.⁵⁸ This means that the likelihood of confusion, and thus the significance of a trademark, depends on public perception of the mark's meaning.⁵⁹ This approach reflects a concern for the cultural meaning of the mark. Trademark law recognizes that "Diamonds Are Forever,"⁶⁰ but the DeBeers trademark is not.

It might seem that consumer perception is only part of the equation since trademark law also examines the efforts of the producer to promote its trademark.⁶¹ To determine the likelihood of confusion between trademarks, courts look at factors related to the producer's activities.⁶² In the context of reli-

⁵⁷ See *infra* Part II.

⁵⁸ 15 U.S.C. § 1125(a)(1)(A) (2006).

⁵⁹ E.g., *Libman Co. v. Vining Indus., Inc.*, 69 F.3d 1360, 1362 (7th Cir. 1995). The court is to "determine the purchasing public's state of mind." *Id.* (quoting *G.D. Searle & Co. v. Chas. Pfizer & Co.*, 265 F.2d 385, 388 (7th Cir. 1959)).

⁶⁰ U.S. Trademark Registration No. 2,995,708 (filed Aug. 21, 2002).

⁶¹ While ultimately focused on consumer perception, some circuits, when assessing likelihood of confusion, have employed factors that have a producer emphasis. The Federal Circuit, for example, has looked to the conditions under which sales are made to buyers. *In re DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (Fed. Cir. 1976). Producers control this factor, at least in part, by choosing how (and to whom) they market and sell their products. The Third Circuit has articulated a similar factor. *Scott Paper Co. v. Scott's Liquid Gold, Inc.*, 589 F.2d 1225, 1229 (3d Cir. 1978), *overruled on other grounds by Shire US Inc. v. Barr Labs., Inc.*, 329 F.3d 348, 352 n.10 (3d Cir. 2003).

⁶² E.g., *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348–49 (9th Cir. 1979) (stating several factors used to judge confusion, including "marketing channels used" by the producer and the "type of goods and the degree of care likely to be exercised by the purchaser," which is aimed at determining to whom the producer is marketing its products), *abrogated in part on other grounds by Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792 (9th Cir. 2003). The Ninth Circuit has subsequently cautioned against the "mechanical application of the *Sleekcraft* standard," emphasizing that some factors are more important than others. *Hansen Beverage Co. v. Nat'l Beverage Corp.*, 493 F.3d 1074, 1078 (9th Cir. 2007). The importance of each factor is determined on a case-by-case basis. *Id.* This is also the reason that Coombe claims that producers can "fix" social meaning. COOMBE, *supra* note 18, at 70–71.

gion, that means trademark law may examine the activities of both the religious organization protecting its registered mark (“religious producer”) and the rival organization using a confusingly similar mark (“religious rival”).

But even this focus aims at discerning what consumers perceive. When a court asks to whom the producer is directing its products, it is attempting to discern who those consumers are and what those consumers perceive. The question frames itself in terms of the producer’s action, but it is aimed at consumer perception. Thus, although the producer controls to whom it markets and therefore exercises at least a degree of control over its mark’s meaning,⁶³ the consumer ultimately decides the meaning of the trademark.

The producer may have some power in controlling the mark because it designs the mark; the consumer (or receiver) has no say in how the mark first appears. In that sense, the initial determination of the mark’s meaning is left to the producer.⁶⁴ The producer can limit the possibility of meanings the mark might obtain.⁶⁵ Nevertheless, the consumer is the ultimate arbiter of meaning. Thus, while a producer can impress certain meanings upon consumers, a producer can never ultimately determine what a mark means—by law consumers determine the ultimate meaning of a mark.

While trademark law does account for both producer activity and consumer perception, in theory it emphasizes the latter over the former. It values consumer perception of the trademark’s meaning over producer intention or actual truth. The reason for this is simple: trademarks are designed to publicly identify a source.⁶⁶ Trademarks act as shortcuts for the public, enabling them to identify a source through a word or symbol.⁶⁷ If trademarks focused on what the producer intended the mark to mean, consumers would be confused in circumstances where the consumers perceived the mark to mean something different.⁶⁸

⁶³ See COOMBE, *supra* note 18, at 26, 50–51, 70–71.

⁶⁴ See Smith, *supra* note 45, at 478. Explaining the concepts of scandalous and disparaging marks in light of semiotic theory, the author states that “[w]hile the creator or registrant of a symbol cannot own its meaning, the fact that she ‘spoke’ it may influence the actual meaning of the sign, which of course is a combination of the trademark submitted to the PTO and the signifieds which exist in our culture.” *Id.*

⁶⁵ The producer may not even have this much power over the consumer. After all, the consumer is free to devise any meaning at all to associate with the product. That, in theory, may be true, but in practice it seems a spurious argument.

⁶⁶ William M. Landes & Richard A. Posner, *The Economics of Trademark Law*, 78 TRADEMARK REP. 267, 270 (1988).

⁶⁷ *Id.*

⁶⁸ Dinwoodie provides valuable insights into how trademarks, when viewed as signs, reflect an emphasis on consumer protection. Graeme B. Dinwoodie, *What Linguistics Can Do for Trademark Law*, in TRADE MARKS AND BRANDS: AN INTERDISCIPLINARY CRITIQUE 140 (Lio-

In that case, trademarks would confuse, not aid, the public's ability to identify different sources. In sum, trademark law cares only about what consumers think a mark means.

This constraint is intentional. Trademark law is designed to create shortcuts for consumers.⁶⁹ The consumer-perception restraint facilitates this goal by providing protection for only those marks that have particular meaning to the consumer.⁷⁰ Yet trademark law's emphasis on consumer perception poses four problems for religious organizations: (1) a risk of losing their source-identification value, (2) a risk of capture when the trademark incorporates meanings not desired by the religious group, (3) the actual-perception problem of truth and (4) problems with preserving the authenticity of beliefs.

a. Genericide, the Problem of Capture and the Problem of Truth

Because trademark law protects marks that represent the perceived source of the goods, trademarks will not be protected if they do not have (or lose) their source-identification value. Trademarks that do not have source-identification value "by virtue of their natural relationship to the products with which they are used" may be deemed inherently generic.⁷¹ Although there are several tests for whether a mark is generic,⁷² the basic concept is that marks that demonstrate a "natural relationship" to the product or services do not deserve

nel Bently et al. eds., 2008). Additionally, Dinwoodie sketches the situations—such as where competing goods or a need for efficiency exist—wherein trademark law does *not* focus on consumer perception. *Id.*

⁶⁹ Mark McKenna argues that trademark law finds its origins in protecting producers from unfair competition. Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839, 1841–43, 1873–86 (2007). McKenna also criticizes the law-and-economics approach of trademark law, which argues that courts pursued economic efficiency when developing trademark law. *Id.* at 1841–43, 1848. He further indicates that the benefits that trademark law bestows upon consumers are an "added bonus." *Id.* at 1863–64.

⁷⁰ Landes & Posner, *supra* note 66, at 288.

⁷¹ DINWOODIE & JANIS, *supra* note 2, at 69.

⁷² *Compare In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1344 (Fed. Cir. 2001) (articulating the "genus test," which asks whether the mark refers to the genus of goods or services at issue), *with Filipino Yellow Pages, Inc. v. Asian Journal Publ'ns., Inc.*, 198 F.3d 1143, 1147 (9th Cir. 1999) (articulating the "'who-are-you/what-are-you' test" which defines generic goods by asking those two questions), *and Mil-Mar Shoe Co., v. Shonac Corp.*, 75 F.3d 1153, 1157–58 (7th Cir. 1996) (relying on the genus test, but looking to the dictionary for guidance).

protection.⁷³ For example, “Soda” brand soda pop would be inherently generic and therefore unprotectable. This is because trademark law is designed to protect both the public’s and competitors’ need to use language freely.⁷⁴ Protecting generic trademarks would significantly hinder a competitor’s ability to compete by making it more difficult to communicate information to the consumer.⁷⁵ Third-party users of generic marks that have acquired secondary meaning have a duty to not misrepresent the source of a product.⁷⁶ Often, courts will require a disclaimer if a third party uses a generic mark with *de facto* secondary meaning.⁷⁷

Religious organizations may confront the problem of genericness.⁷⁸ In fact, one religious organization may sue another for trademark infringement, but lose on the grounds that their organization’s name is generic. Religious organizations frequently use terms of faith within their names, leaving them particularly susceptible to this problem.

Trademarks can also *become* generic by losing their source-identification value if used too often in inconsistent ways, or in ways that rob them of their source-identifying function. This occurs when, as a result of the public’s use of the term, a trademark that once identified the source of a product now identifies a product itself.⁷⁹ This “genericide” occurs because once the mark becomes generic, the law extinguishes the trademark rights that the owner once held.⁸⁰

The concept of “genericide” demonstrates that, to some extent, the trademark owner is at the whim of the consumer. Lury’s observation about cultural products aptly applies to trademarks: “what audiences actually do with

⁷³ DINWOODIE & JANIS, *supra* note 2, at 69.

⁷⁴ See Jerre B. Swann, *Genericism Rationalized*, 89 TRADEMARK REP. 639, 645 (1999) (highlighting the beneficial functions that brand names generally serve).

⁷⁵ *Id.*

⁷⁶ *Blinded Veterans Ass’n v. Blinded Am. Veterans Found.*, 872 F.2d 1035, 1045 (D.C. Cir. 1989) (discussing *de facto* secondary meaning).

⁷⁷ *Id.* at 1043. The court stated that if evidence shows confusion between two generic marks, a “court may order that [the defendant] distinguish itself from [the plaintiff] to avoid confusion.” *Id.* at 1047 (alterations added).

⁷⁸ See *infra* Part II.

⁷⁹ *Freecycle Network, Inc. v. Oey*, 505 F.3d 898, 905–06 (9th Cir. 2007).

⁸⁰ For common examples of genericide, see *Bayer Co. v. United Drug Co.*, 272 F. 505 (S.D.N.Y. 1921) (Aspirin), *DuPont Cellophane Co. v. Waxed Products Co.*, 85 F.2d 75 (2d Cir. 1936) (Cellophane) and *Donald F. Duncan, Inc. v. Royal Tops Manufacturing Co.*, 343 F.2d 655, 667 (7th Cir. 1965) (Yo-yo).

cultural products is not predetermined by producers.”⁸¹ In other words, while the producer can project whatever image it likes, the consumer ultimately decides what a cultural symbol means.⁸² Audiences also have another power that producers do not: they can make demands on, and have expectations of, the cultural meaning of trademarks.⁸³ Consumers can tell the producers what they want the product to mean.⁸⁴

This problem of capture reflects trademarks’ ability to incorporate meanings not initially ascribed to them.⁸⁵ In particular, it affects companies and religions who seek to maintain protection of their trademarks. Religious organizations using trademark protection face uncertainty because the receiver may disregard the religious message altogether and form a distinct and dissonant one. Similarly, in societies where individuals’ personas and identities can be appropriated,⁸⁶ another group or the public may effectively capture a religious identity by using the trademark. In that sense, trademark law can both protect the identity of religion and simultaneously open it to capture by another religion or the public.⁸⁷

⁸¹ LURY, *supra* note 35, at 91.

⁸² *Id.*

⁸³ Hughes, *supra* note 47, at 988–89 (stating that consumers can make demands on and have expectations about a celebrity persona as well as trademarks).

⁸⁴ *Id.* at 989. One example given by Hughes suggests that Acura owners could make demands on Honda if it started making cars under the Acura mark that matched “the quality of [an] old Yugo.” *Id.* at 991 (alteration added). As mentioned before, some commentators like Coombe argue that the ultimate power to fix the social meaning of a mark remains with the producer. COOMBE, *supra* note 18, at 70–71. Yet, no matter what set of meanings a producer may devise, the receiver is always free to reject any and all of those meanings and devise a separate meaning altogether. Assume, for example, FocalOptics, an eyeglasses company, markets a pair of eyeglasses under the name PROFOCUS, seeking to portray the glasses as intellectual or hip. The consumer may accept the marketed meaning, or she may not. The consumer can adapt that meaning—in this case viewing the glasses as those worn by pseudo-intellectuals—or the consumer can reject the meaning altogether and assign a new meaning. Here, the consumer might view the glasses as dorky or inane—the very opposite of the image marketed by the company—or, at the most extreme, the consumer can ignore the image and form a distinct impression. The consumer is free to do what she wants with the image. In the sense that the consumer is limited at all, she is limited by her perceived possible relationships between the product and a particular meaning; that is, only those meanings that she would think to ascribe to the good.

⁸⁵ Simon Harrison, *The Politics of Resemblance: Ethnicity, Trademarks, Head-Hunting*, 8 J. ROYAL ANTHROPOLOGICAL INST. 211, 220 (2002) (U.K.).

⁸⁶ *Id.* at 215–16.

⁸⁷ *Id.* at 220 (stating that mimetic behavior in trademark law allows groups to use and assume identities of others, and stating that social actors are concerned with mimetic behavior directed at them and therefore try to control such behavior).

The problem of capture is related to another problem that acutely affects religious organizations: the actual-perception problem of truth. Because trademark law often focuses on what consumers perceive to be true, it sometimes excludes what is actually true. Religions, on the other hand, focus on truth, not on what consumers perceive to be true. In philosophy, a value gap exists between what “is” and what “ought to be.”⁸⁸ This article refers to the similar lacuna that exists in religious trademark law between what is true and what is perceived to be true as the actual-perception problem of truth.

b. Authenticity

Religious beliefs are often exclusive,⁸⁹ and preserving the authenticity of the beliefs associated with a mark may be as important as preserving the message itself.⁹⁰ Because religious organizations seek to protect truth, their identities as embodied by trademarks are at risk of adulteration. Thus, in this context of truth, the primary concern is not whether the mark assumes a different meaning; rather, it is whether the ideas and beliefs associated with the mark are authentic. To achieve this end, religions have attempted to secure intellectual property rights over their texts⁹¹ and other “knowledge-based assets.”⁹²

Authenticity, however, is constantly in question.⁹³ Paradoxically, securing rights in what is authentic may actually alienate the beliefs one seeks to protect.⁹⁴ Coombe aptly notes that “when group rights are entertained [in intellectual property], they are often conceived in individualistic terms that freeze and essentialize culture in the name of identity.”⁹⁵ That treatment inhibits the ability

⁸⁸ STEPHEN DARWALL, *PHILOSOPHICAL ETHICS* 24–25 (1998).

⁸⁹ RAIMON PANIKKAR, *THE INTRARELIGIOUS DIALOGUE* 5 (rev. ed. 1999) (stating that a belief of a particular religion considered to be true, logically signifies that anything contrary to that belief is false). However, not *all* religious beliefs are necessarily exclusive. For example, one group may have a religious belief that is *inclusive*; some other religions may hold that belief as well.

⁹⁰ See COOMBE, *supra* note 18, at 228. Moreover, organizations typically employ trademark law to preserve the authenticity of their identity.

⁹¹ Micaela Modiano, *Italy: Protecting the Words of the Pope*, *MANAGING INTELL. PROP.*, April 2007, at 154 (describing the Vatican’s attempt to copyright the words and images of the Pope).

⁹² See Ali Khan, *Islam as Intellectual Property “My Lord! Increase Me in Knowledge”*, 31 *CUMB. L. REV.* 631, 632 (2001).

⁹³ See *generally infra* Part II.

⁹⁴ See COOMBE, *supra* note 18, at 229.

⁹⁵ *Id.* (alteration added).

of groups to secure the rights in their ideas, which are more fluid and not conducive to static protection.⁹⁶

Susan Scafidi argues that authenticity of goods gives them added value.⁹⁷ “[K]nowledgeable consumers [may be] willing to pay many times the street price for ‘real’ luxury goods . . . [because] ‘authentic’ goods . . . offer the purchaser a certain intangible value.”⁹⁸ This intangible value consists largely in the consumer’s perception of status by owning an authentic product.⁹⁹ Scafidi dubs this “product authenticity,” for obvious reasons.¹⁰⁰ But this authenticity does not apply to religious trademarks, which are affixed to non-traditional goods.

More relevant here is Scafidi’s discussion of “Source-Community Authenticity” (“SCA”) and “Authenticity of a Central Authority” (“ACA”).¹⁰¹ SCA “focuses on the provenience of the cultural product rather than on the specific elements of the product or the process of its embodiment.”¹⁰² ACA is “authenticity . . . traced to a particular leading figure within the community.”¹⁰³ Despite her helpful commentary, Scafidi’s definitions have shortcomings when applied to the authenticity that religious organizations seek to protect. SCA reaches every individual within that “community.”¹⁰⁴ That definition is too amorphous in the context of trademark law, which defines a source more rigidly.¹⁰⁵ In other words, SCA ascribes religious authenticity to the beliefs of those

⁹⁶ *Id.*; see SUSAN SCAFIDI, WHO OWNS CULTURE? APPROPRIATION AND AUTHENTICITY IN AMERICAN LAW 56 (2005) (“Claims of product authenticity are also problematic to the extent that they cast cultural products as eternal and unchanging.”).

⁹⁷ SCAFIDI, *supra* note 96, at 52–53.

⁹⁸ *Id.* (alterations added).

⁹⁹ *Id.*

¹⁰⁰ *Id.* at 55.

¹⁰¹ *Id.* at 56–60.

¹⁰² *Id.* at 56.

¹⁰³ *Id.* at 58–59.

¹⁰⁴ See *id.* at 58 (“[T]he source community as a whole participates in the creation of a cultural product.”). Furthermore, authenticity *must* reach to the current community; otherwise no cultural product could ever maintain authenticity. If that was not so, authenticity would be lost every time a new child was born into that community. Scafidi states that “[u]nder . . . [SCA], if a product were attributable to a member of a source community’s diaspora, it would be ‘authentic.’” *Id.* at 57–58 (alteration added).

¹⁰⁵ In trademark law, for example, a “source” is typically a unified corporate entity, such as a corporation. *E.g.*, *Autozone, Inc. v. Strick*, 543 F.3d 923, 927–29 (7th Cir. 2008) (where Autozone owned several trademarks and sued another corporate entity for infringement). Since the corporate entity (in such a case) is the owner of the trademark, individual members of the

who are members of (or profess membership to) a religious organization.¹⁰⁶ Often, that conception of authenticity is exactly what leads to intra-religious disputes.¹⁰⁷ For that reason, the concept of SCA alone is insufficient to describe the authenticity that religious organizations are trying to protect through trademark law.

Similarly, using ACA by itself does not adequately describe the authenticity that religious organizations seek to protect. While an individual leader may be involved in ensuring religious authenticity, religious organizations typically vest authenticity in some body or government by which the rest of the organization is bound.¹⁰⁸ Therefore, to better illustrate the concepts discussed in this article, the meaning of ACA is modified to mean authenticity traced to a particular religious governing body, the actions of which bind the members of the religion. While neither SCA nor ACA standing alone describes the religious authenticity in the trademark context that religious organizations seek to protect, combining these two concepts provides a better description of religious authenticity. In other words, if we combine SCA and modified-ACA, the resulting concept is closer to the kind of authenticity that religious organizations strive to protect using trademark law: authenticity of the beliefs derived from a source community that are vested in a single governing body. This type of authenticity will be called religious authenticity.

In the process of protecting religious authenticity, groups may disagree over which marks are authentic. Conflict between groups seeking to monopolize the same religious mark may ensue.¹⁰⁹ Thus, while trademarks, especially religious symbols, can be used to express cohesion, they “can also be exploited divisively to promote sectional identities and antagonisms.”¹¹⁰ Simon Harrison

company are not the “source.” *E.g., id.* at 934 (discussing infringement and the fact that individuals may be confused, affiliating one entity with the other).

¹⁰⁶ See SCAFIDI, *supra* note 96, at 56. Scafidi notes that members of a source community could solve problems of authenticity by “formalizing the often implicit or mutually understood criteria for membership.” *Id.* at 58. She further writes that “an individual would only need to become a card-carrying member of a particular culture group if she wished to assert publicly the authenticity of her interpretation of that group’s cultural products.” *Id.*

¹⁰⁷ *Id.* at 63 (“Like commodification, the use of authenticity to support or replace assertions of ownership and to bind a cultural product to its source community has the potential to harm as well as to benefit the community. When members of a cultural group disagree about the authenticity of a cultural product, there may be pressure to disown the product or shun the individuals who participated in its creation as themselves inauthentic representatives of the spirit of the community or even traitors to the community.”).

¹⁰⁸ See cases cited *infra* Part III.

¹⁰⁹ See *infra* Part II.

¹¹⁰ Harrison, *supra* note 85, at 225.

argued that this antagonistic behavior occurs when one or more groups try to monopolize the symbol at issue.¹¹¹ He attributed these monopolizing attempts to organizational differences that drive each group “to differentiate themselves within the constraints of a closely shared and restricted universe of historical symbols.”¹¹²

In this way, authenticity can prove to be an anathema to religious organizations seeking to protect their identities through trademarks. Symbols and names have the power to both unite and divide an organization. Additionally, trademark law is not equipped to deal with claims of religious authenticity; rather, it is equipped to discern what meaning consumers ascribe to a particular mark. Thus, religious organizations cannot use trademarks to fully protect the authenticity of their identities.

C. Parody and Protecting Identity

In addition to the instability caused by the problems of genericide, capture, truth and authenticity, trademark law places religious trademarks, and religion itself, at risk of devaluation by parody—a defense to trademark infringement.¹¹³ The First Amendment protects the right of non-trademark owners to use others’ trademarks where the mark is used in a non-confusing way, such as a parody.¹¹⁴

The doctrine of parody protects unauthorized third-party trademark users because there is no risk of confusion.¹¹⁵ A parody criticizes or ridicules an original work, and is not used merely to call attention to another work.¹¹⁶ The

¹¹¹ *Id.*

¹¹² *Id.*

¹¹³ See *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 33 (1st Cir. 1987) (finding parody a constitutional defense to a state anti-dilution statute); MCCARTHY, *supra* note 11, § 31:153 (“The First Amendment, which protects individuals from laws infringing free expression, allows such ridicule in the form of parody.”). See generally *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 901–02 (9th Cir. 2002) (observing that, based on prior cases, “where an artistic work targets the original and does not merely borrow another’s property to get attention, First Amendment interests weigh more heavily in the balance,” and finding the defendant’s mark to be a parody of the plaintiff’s mark).

¹¹⁴ See *L.L. Bean*, 811 F.2d at 33.

¹¹⁵ See *Mattel*, 296 F.3d at 902 (finding defendant’s parody protected because “[t]he song title does not explicitly mislead as to the source of the work; it does not, explicitly or otherwise, suggest that it was produced by [the plaintiff]” (alteration added)).

¹¹⁶ *Id.* at 901 (finding that “where an artistic work targets the original and does not merely borrow another’s property to get attention, First Amendment interests weigh more heavily in the balance,” and further stating that First Amendment parody protection does not exist for

Fourth Circuit has stated that “[a] parody must convey two simultaneous-and contradictory-messages: that it is the original, but also that it is *not* the original and is instead a parody.”¹¹⁷ The parody must therefore comment on the underlying work—the trademark itself—rather than use the trademark to comment on another work.¹¹⁸ While a parody necessarily derives its value from the reputation of another mark, there is no risk of confusion between the two marks because the association between them is humorous rather than confusing.¹¹⁹ The message the parody conveys is essential to its function; the message, usually humorous, differentiates the parody from the original trademark.¹²⁰

For a religious organization, the use of parody may offend its basic ethos. The difference between viewing a parody as offensive rather than humorous is one of perspective. Ali Kahn has suggested that within the context of Sunni Islam, this reactionary difference is the result of one’s commitment to the religion at issue; he calls the differing viewpoints and commitments to religion the “external” and “internal” views.¹²¹ The external view “defends the freedom of belief, granting individuals the right to make any changes in the protected knowledge of Islam. [It] protects freedom of speech, granting individuals the right to denigrate God, the Quran, and the Prophet.”¹²² In other words, the external view embodies the Western ideal of freedom of speech and expression, viewing ideas and concepts as freely appropriated. The internal view, by contrast, understands religion as a heightened form of intellectual property.¹²³ This view posits that adherents hold in trust religion and its accompanying ideas and

“trademarks and lyrics [used] to get attention rather than to mock” the underlying work (alteration added)).

¹¹⁷ *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, L.L.C.*, 507 F.3d 252, 260 (4th Cir. 2007) (quoting *PETA v. Doughney*, 263 F.3d 359, 366 (4th Cir. 2001)) (alteration added).

¹¹⁸ *See Mattel*, 296 F.3d at 901 (“The [Barbie] song does not rely on the Barbie mark to poke fun at another subject but targets Barbie herself.” (alteration added)).

¹¹⁹ *See Jordache Enters., Inc. v. Hogg Wyld, Ltd.*, 828 F.2d 1482, 1486 (10th Cir. 1987) (“In one sense, a parody is an attempt ‘to derive benefit from the reputation’ of the owner of the mark, if only because no parody could be made without the initial mark. The benefit to the one making the parody, however, arises from the humorous association, not from public confusion as to the source of the marks.” (citation omitted)).

¹²⁰ *Haute Diggity Dog*, 507 F.3d at 260–61 (finding that a dog chew-toy mimicking the Louis Vuitton trademark qualified as a parody because it differentiated itself as a non-luxury good and was not confusing).

¹²¹ Khan, *supra* note 92, at 631–32.

¹²² *Id.* at 632 (alteration added).

¹²³ *See id.* at 631–32 (“Muslims view Islam as knowledge-based (intellectual) property, not an idea. . . . Muslims elevate the knowledge-based assets of Islam to the highest level of protection.”).

that the timeless assets of the religion are “protected knowledge that no one may alter or dishonor.”¹²⁴

Similarly, Coombe has argued for establishing intellectual property rights in the “traditional knowledge” held by indigenous tribes, thereby protecting the “knowledge, innovations, and practices of indigenous and local communities embodying traditional lifestyles.”¹²⁵ Coombe argued that if traditional knowledge is not protected, its benefits, both for society and the culture that holds the information, will be lost.¹²⁶ While Kahn and Coombe differ in motivations—Kahn for sanctity and Coombe for the utility of preserving biodiversity and enhancing the livelihood of indigenous people¹²⁷—their ideas are related. Each recognizes intellectual property rights in ideas that are typically viewed as freely appropriated. This section, however, focuses on Kahn’s conception because it addresses religion (Sunni Islam) and the problems for religious entities when individuals appropriate religious symbols.

Just as Kahn views the ideas and beliefs of Islam as sacred, many individuals view their own religious beliefs as superior to, and subject to a higher order of protection than, other ideas typically protected by the law. To many people, religion is different from traditional forms of intellectual property because it is something created by the divine, not by humans.¹²⁸ For that reason, individuals may react adversely to parodies of religious symbols. Recently, for instance, Flemming Rose, Editor of the Danish newspaper *Jyllands-Posten*,¹²⁹ published several cartoons of the Prophet Muhammad.¹³⁰ In Islam, some believe

¹²⁴ *Id.* at 631–32.

¹²⁵ Rosemary J. Coombe, *The Recognition of Indigenous Peoples’ and Community Traditional Knowledge in International Law*, 14 ST. THOMAS L. REV. 275, 276 (2001). Coombe’s desire to use intellectual property to protect indigenous knowledge is confusing since she espouses disdain for the ability of trademark law to allow commercial producers to create cultural symbols and fix their meanings. Perhaps she thinks that trademark law is “here to stay” and should be used to protect those who needs its protection.

¹²⁶ *Id.*

¹²⁷ *See id.* (noting that the Convention on Biological Diversity, whose efforts Coombe studied extensively, aims to preserve biodiversity and allow indigenous people an equitable share in the benefits derived from the use of their knowledge).

¹²⁸ *See Khan, supra* note 92, at 636 (“For Muslims, however, the Quran is a divine asset, inscribed in the Preserved Tablet. ‘And this Quran is not such as could ever be produced by other than Allah’”).

¹²⁹ Flemming Rose, *Why I Published Those Cartoons*, WASH. POST, Feb. 19, 2006, at B01.

¹³⁰ *Mutual Incomprehension, Mutual Outrage; Islam and Free Speech*, ECONOMIST, Feb. 9, 2006 [hereinafter *Mutual Incomprehension*].

that the Quran prohibits the visual depiction of the Prophet Muhammad.¹³¹ For many, these cartoons not only violated that sacred principle, but also criticized and ridiculed Islam.¹³² Muslims across the world reacted with protests and, in some cases, violence.¹³³ Kahn's conception of the internal view of Sunni Islam aids our understanding of this reaction. While many see the cartoon as a satire on Islam or Islamic Fundamentalism, some Muslims saw the act as a transgression of their religion, as well as an affront to Islam.¹³⁴ In Muslims' eyes, Islam should be revered, not desecrated.¹³⁵ Thus, when the law fails to protect what Muslims perceive as the asset most worthy of protection—their collective Muslim identity—the law is viewed as a failure. If the law fails religion, many will protest. In this instance, some have called for murder.¹³⁶

But the internal view of religion is not without recourse in U.S. trademark law for two reasons. First, the Lanham Act contains a provision that allows the U.S. Patent and Trademark Office ("PTO") to refuse to register or to cancel trademarks "consist[ing] of . . . immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute."¹³⁷ Second, the Lanham Act creates a cause of action for

¹³¹ The textual source of this modern tradition is not clear. One author suggests that this tradition, which developed in the later stages of Islamic jurisprudence, is known as "hilya"—meaning "quality or aggregate of attributes and qualities, appearance, something pleasing, ornament." Oleg Grabar, *The Story of Portraits of the Prophet Muhammad*, 96 *STUDIA ISLAMICA* 19, 33 (2004). It is derived from a "hadīth," a traditional saying of the prophet and source of Islamic law, "in which the Prophet promises that 'for him who sees my *hilya* after my death it is as if he had seen me myself, and he who sees it, longing for me, for him God will make Hellfire prohibited, and he will not be resurrected naked at Doomsday.'" *Id.*

¹³² *Mutual Incomprehension*, *supra* note 130.

¹³³ *Id.*

¹³⁴ *Id.* The violation of the "hadīth," mentioned *supra* note 131, may also qualify as a heretical "insult[] against the Prophet." KNUT VIKØR, *BETWEEN GOD AND THE SULTAN: A HISTORY OF ISLAMIC LAW* 293 (2005) (alteration added).

¹³⁵ See *supra* note 123 and accompanying text. Scafidi makes an interesting observation about the refusal of the Ottoman Empire to accept the printing press in the fifteenth century. SCAFIDI, *supra* note 96, at 33. She wonders "[w]hether the Islamic mistrust of printing resulted from fear of desecration of the Qur'an or from the power of the calligraphers' guild." *Id.* Without answering that question, she notes that this refusal "is described by many Western scholars as an enormous mistake that led to the modern cultural isolation of Islam." *Id.*

¹³⁶ English.AJazeera.net, *Bounty Set in Sweden Cartoon Row*, <http://english.aljazeera.net/news/europe/2007/09/2008525134430112432.html> (last visited Oct. 27, 2008) (stating that Abu Omar al-Baghdai placed a \$100,000 bounty on the life of Lars Vilks, the cartoonist who depicted Muhammad).

¹³⁷ 15 U.S.C. § 1052(a) (2006) (alteration added).

use of famous marks that are “likely to cause dilution by blurring or dilution by tarnishment . . . regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.”¹³⁸ Despite their seeming promise for protecting religious identity, these two provisions of the Lanham Act are ineffective in that task.

1. Scandalous and Disparaging Marks

Scandalous and disparaging marks are, as indicated by the Lanham Act, two different bases for invalidity.¹³⁹ These terms provide the PTO with grounds to refuse to register¹⁴⁰ or cancel a trademark.¹⁴¹ After the meaning of a trademark is determined,¹⁴² it is determined if the mark is scandalous or disparaging.¹⁴³ Whether a mark is scandalous is determined from the viewpoint of a substantial composite of the general public.¹⁴⁴ Whether a mark is disparaging, however, is determined by the perception of those referred to by the mark.¹⁴⁵ There-

¹³⁸ *Id.* § 1125(c)(1).

¹³⁹ *Id.* § 1052(a).

¹⁴⁰ *Id.* While a scandalous or disparaging mark is grounds for a refusal to register, there has been some debate about whether common law rights can persist in light of the Lanham Act. See Stephen R. Baird, *Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks*, 83 TRADEMARK REP. 661, 673–74 n.39, 747, 788–89, 792–95 (1993) (outlining the reasons why scandalous or immoral trademarks may receive common law protection).

¹⁴¹ 15 U.S.C. § 1064(3) (2006) (stating that a mark may be cancelled “[a]t any time if the registered mark[’s] . . . registration was obtained fraudulently or contrary to the provisions of section 1054 of this title or of subsection (a), (b), or (c) of section 1052 of this title” (alteration added)).

¹⁴² *Pro-Football, Inc. v. Harjo (Harjo II)*, 284 F. Supp. 2d 96, 125 (D.D.C. 2003) (holding that the TTAB correctly analyzed how to determine whether a mark is disparaging, which included first inquiring into the meaning of the trademark).

¹⁴³ *Id.*

¹⁴⁴ *In re Boulevard Entm’t, Inc.*, 334 F.3d 1336, 1339 (Fed. Cir. 2003).

¹⁴⁵ *Compare id.* (“[W]hether the mark consists of or comprises scandalous matter must be determined from the standpoint of a substantial composite of the general public (although not necessarily a majority), and in the context of contemporary attitudes, keeping in mind changes in social mores and sensitivities.” (citation omitted)), and *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994) (noting that courts should consider the mark “in the context of the marketplace as applied to only the goods described in [the trademark owner’s] application for registration” (alteration added)), with *Harjo v. Pro-Football, Inc. (Harjo I)*, 50 U.S.P.Q.2d (BNA) 1705, 1739 (T.T.A.B. 1999), *rev’d on other grounds*, 284 F. Supp. 2d 96 (D.D.C. 2003) (“In determining whether or not a mark is disparaging, the perceptions of the general public are irrelevant. Rather, because the portion of Section 2(a) proscribing disparaging marks targets certain persons, institutions or beliefs, only the percep-

fore, the difference between scandalous and disparaging marks turns on the audience in question.

For religious groups, each test may be grounds for partially protecting a particular mark from certain uses. When an individual or organization uses a mark in a way that qualifies as scandalous or disparaging, a religious group can stop such use by canceling or opposing the mark. Yet, the claim's success may depend on the identity of the group challenging the mark. In theory, the wider the audience becomes, the greater the chance that the mark will not be viewed as scandalous. Since the test for a scandalous mark focuses on the general public, it will be difficult for a religious organization to prove that use of its trademark is scandalous. Conversely, a claim of disparaging use would likely be easier to prove because courts examine disparagement from the standpoint of the relevant group.¹⁴⁶ This action focuses on a smaller group of individuals, most of whom are more likely than the general public to view the use of their religious mark as disparaging.¹⁴⁷

Actions to prevent scandalous and disparaging use of marks, however, fall short of protecting religious identity. Ironically, by eliminating a group's protection in a scandalous trademark, anyone else can use that mark in any manner other than as a mark.¹⁴⁸ In effect, the use of the mark may be facilitated, rather than curbed, by the action.¹⁴⁹ Thus, the marks may actually become more widespread as a result of the prohibition on its use as a trademark.¹⁵⁰

tions of those referred to, identified or implicated in some recognizable manner by the involved mark are relevant to this determination." (quoting *In re Hines*, 31 U.S.P.Q.2d (BNA) 1685, 1688 (T.T.A.B. 1994)). The *Harjo I* court further explained that the implicated group "must be determined on the basis of the facts in each case." *Harjo I*, 50 U.S.P.Q.2d at 1739.

¹⁴⁶ See *Harjo II*, 284 F. Supp. 2d at 125.

¹⁴⁷ See *Harjo I*, 50 U.S.P.Q.2d at 1739 ("Only the perceptions of those . . . identified . . . by the involved mark are relevant to [disparagement]." (alteration added)).

¹⁴⁸ If a mark is not protected by trademark law, anyone is free to use that symbol, provided, of course, it does not violate any other law. A generic mark, for example, can be used by anyone because it has no status as a trademark and thus no use can infringe on anyone's rights. *Otokoyama Co. Ltd. v. Wine of Japan Import, Inc.*, 175 F.3d 266, 270 (2d Cir. 1999) ("It is a bedrock principle of the trademark law that no trader may acquire the exclusive right to the use of a term by which the covered goods or services are designated in the language. Such a term is "generic." Generic terms are not eligible for protection as trademarks; everyone may use them to refer to the goods they designate.").

¹⁴⁹ See, e.g., Baird, *supra* note 140, at 663 ("Section 2(a) does not prevent the use of marks that fit the description. Rather, Section 2(a) prevents the government from placing its imprimatur on such marks and denies the statutory benefits that would otherwise result from their federal registration.").

¹⁵⁰ In light of the observation that these prohibitions can actually defeat religious organizations' goals, Regan Smith has argued that "the current prohibition on registering scandalous trade-

Even if actions against scandalous or disparaging marks protect religious identity to a greater degree, they are not a panacea; religious organizations can bring a claim only when the mark is in fact disparaging or scandalous.¹⁵¹ The vast majority of litigation over religious identity, however, has not been over marks that could be perceived as scandalous or disparaging.¹⁵² This is because trademark law is not designed to protect the static identity of religious organizations; it is meant instead to act as a tool for consumers, competitors and producers of commercial goods.¹⁵³ This tool, although useful, can only marginally aid religious organizations in protecting their identities.¹⁵⁴

2. Dilution

In addition to the prohibitions on scandalous and disparaging marks, the dilution cause of action gives religious organizations another legal tool with which they can use to attempt to protect their identities. The Lanham Act provides a cause of action for dilution of the mark, either by tarnishment or by blurring.¹⁵⁵ The mark, however, must be “famous” under the Lanham Act, and fame is difficult to prove.¹⁵⁶ Dilution, like trademark law generally, was crafted with

marks largely serves no purpose and represents a challenge to First Amendment considerations,” but contended that “the prohibition on disparaging speech is strong enough to warrant its retention in some form.” Smith, *supra* note 45, at 452–53.

¹⁵¹ The Lanham Act provides that scandalous and disparaging marks will be refused registration. 15 U.S.C. § 1052(a) (2006). Thus, either the examiner will refuse to register the mark or a third party may initiate a cancellation or opposition proceeding. *See id.* § 1064 (regarding cancellation); *id.* § 1063 (“Any person who believes that he would be damaged by the registration of a mark . . . may . . . file an opposition in the Patent and Trademark Office.”).

¹⁵² *See infra* Part II.

¹⁵³ Mark P. McKenna, *The Normative Foundations of Trademark Law*, 97 TRADEMARK REP. 1126, 1129–30 (2007) (stating that “the goal of trademark law is—and always has been—to improve the quality of information in the marketplace and thereby reduce consumer search costs,” which, others have pointed out, can have positive effects on competition and spur investment in goods).

¹⁵⁴ *See, e.g., In re Riverbank Canning Co.*, 95 F.2d 327, 329 (C.C.P.A. 1938) (holding, under the Trademark Act of 1905, that the Madonna trademark on wine was scandalous).

¹⁵⁵ 15 U.S.C. § 1125(c) (2006).

¹⁵⁶ *Id.*; *TCPIP Holding Co. v. Haar Commc’ns, Inc.*, 244 F.3d 88, 97 (2001) (describing the standard for fame and stating that “to be famous within the meaning of the statute, the mark must have achieved a high ‘degree of . . . acquired distinctiveness,’ meaning that it must have become very widely recognized by the U.S. consumer public as the designator of the plaintiff’s goods”).

commercial interests in mind.¹⁵⁷ It is meant to be a limited cause of action for limited types of marks. It focuses on commercial interests likely to be affected by trademark use, for example, those whose marks are likely to suffer from free riders or usurpers.¹⁵⁸ These interests will typically involve corporate trademark owners that have used their marks widely.¹⁵⁹ Under this definition, most religious marks are not “famous,” and dilution probably will not aid religious organizations in their quest to protect their identity.

Dilution could, however, protect a religious organization if its mark is indeed famous. Essentially, dilution represents the theory that uses of a mark on products or services other than on those which they traditionally appear may “dilute” the meaning of the mark.¹⁶⁰ Dilution is a useful concept for understanding how religious organizations view their trademarks. Ideally, many religious organizations want to prevent any group from using their mark on goods unrelated to religious services or products.¹⁶¹ Through a dilution cause of action, organizations could attempt to preserve the strength of their marks.¹⁶² Much like Kahn’s internal viewpoint, religious organizations might view any use of religious symbols as an affront and a threat to the authenticity and identity of the

¹⁵⁷ At least one commentator has suggested that this is a result of large, corporate lobbying machines. See Sarah Mayhew Schlosser, *The High Price of (Criticizing) Coffee: The Chilling Effect of the Federal Trademark Dilution Act on Corporate Parody*, 43 ARIZ. L. REV. 931, 959–62 (2001) (arguing that corporate entities, because of their access to wealth, media and government, have an influence so great that the law has been distorted to reflect interest-specific agendas, and specifically noting that large, public corporations will be the most successful users of the dilution cause of action).

¹⁵⁸ For a brief history on the origins of dilution law, see Thomas R. Lee, *Demystifying Dilution*, 84 B.U. L. REV. 859, 864–72 (2004).

¹⁵⁹ It stands to reason that larger companies will typically be those with famous marks since they will have the greatest ability to spread their mark throughout the country and the world. Nevertheless, it is conceivable that smaller companies also benefit from dilution.

¹⁶⁰ *Horphag Research Ltd. v. Garcia*, 475 F.3d 1029, 1037 (2007).

“Blurring occurs when a defendant uses a plaintiff’s trademark to identify the defendant’s goods or services, creating the possibility that the mark will lose its ability to serve as a unique identifier of the plaintiff’s product.” The theory of dilution by blurring thus protects the benefits that flow from a sharp and distinct connection between one mark and one product.

Id. (quoting *Panavision Intern., L.P. v. Toeppen*, 141 F.3d 1316, 1326 (9th Cir. 1998)); see also Sarah L. Burstein, *Dilution by Tarnishment: The New Cause of Action*, 98 TRADEMARK REP. 1189, 1191 (2008) (“Dilution ‘is the legal theory that seeks to protect a trademark owner directly against the diminution of a trademark’s ‘commercial magnetism’ or selling power by unauthorized junior use of the same or substantially similar mark’”).

¹⁶¹ See *infra* Part II.

¹⁶² *Garcia*, 475 F.3d at 1037; Burstein, *supra* note 160, at 1191.

religion.¹⁶³ Ultimately, dilution will not apply to most religious marks. Nevertheless, it illustrates yet another way in which the commercial design of trademark law prevents religious organizations from protecting their identity in the manner they desire.

D. The “Use in Commerce” Requirement

The “use in commerce” requirement is another obstacle for religious organizations seeking to protect their identities with trademark law. To be eligible for protection, the Lanham Act requires that a mark be both “used in commerce”¹⁶⁴ and used as a mark.¹⁶⁵ The Commerce Clause and congressional powers define “use in commerce.”¹⁶⁶ Supreme Court Commerce Clause jurisprudence is instructive in defining the extent of congressional power. In *United States v. Lopez*,¹⁶⁷ the Court held that Congress can regulate commerce in three instances: (1) to regulate the use of channels of interstate commerce, (2) to regulate and protect the instrumentalities of commerce and (3) to regulate those economic activities that substantially affect interstate commerce.¹⁶⁸ Since *Lopez*, the scope of “economic activities” has expanded to include production, consumption and distribution of commodities.¹⁶⁹

A trademark owner must use its trademark in one of these ways to receive protection. Courts evaluate the totality of the circumstances to determine

¹⁶³ See *infra* Part II.

¹⁶⁴ 15 U.S.C. § 1051(a)(1) (2006) (“The owner of a trademark used in commerce may request registration of its trademark.”); *accord id.* §§ 1051(b)(1), 1125(a)(1) (provides a civil action only if marks are used in commerce).

¹⁶⁵ 1-800 Contacts, Inc. v. WhenU.com, Inc., 414 F.3d 400, 408–13 (2d Cir. 2005) (discussing the requirement of “use” as a mark and noting its difference from the “in commerce” requirement under the Lanham Act). The “use” requirement is not germane to this discussion. Therefore, this article will not discuss it in any detail.

¹⁶⁶ 15 U.S.C. § 1127 (“The word ‘commerce’ means all commerce which may lawfully be regulated by Congress.”).

¹⁶⁷ 514 U.S. 549 (1995).

¹⁶⁸ *Id.* at 559.

¹⁶⁹ *Gonzales v. Raich*, 545 U.S. 1, 25–26 (2005). This rationale applies where a statute, such as the Lanham Act, regulates many different activities and does not focus merely on the challenged activity. Indeed, the Federal Circuit has previously applied a modified form of this rationale. See *Larry Harmon Pictures Corp. v. Williams Restaurant Corp.*, 929 F.2d 662, 664–65 (Fed. Cir. 1991) (holding that a mark owner can satisfy the “use in commerce” requirement by operating a single location not in close proximity to the highway or serving a certain number of interstate travelers).

whether a mark was used in commerce.¹⁷⁰ For that reason, no sales of goods are required to establish use.¹⁷¹ Typically, this requires showing that the party asserting use adopted the mark, and used the mark “in a way sufficiently public to identify or distinguish the marked goods in an appropriate segment of the public mind as those of the adopter of the mark, . . . even without evidence of actual sales.”¹⁷² Factors used to determine whether the owner satisfied this second inquiry include actual sales, advertisements, relevance of the market, the distribution of a mark and evidence that members of the targeted public associate the mark with the producer.¹⁷³

The “use in commerce” requirement is a barrier for protecting religious identity. Many religious organizations do not sell paraphernalia, and smaller organizations may not operate a website or use advertisements. It is difficult for these organizations to acquire trademark protection. If a religious group fails to acquire a trademark, otherwise valid concerns such as consumer perception and parody do not arise. Thus, the “use in commerce” requirement can hinder religious organizations from acquiring trademark protection and utilizing its limited protection.

E. Illustrating the Problems Posed by Trademark Law

To illustrate how trademark law’s focus on perception places religious identity and authenticity at risk, consider the following example. Assume a group called Faith Practitioners of Trent practices a religion called Winsop. Winsopians believe that the Earth was created by Divine Plan and adhere to an absolute rule that no human should ever kill another. Since religious beliefs are usually exclusionary,¹⁷⁴ the Winsopian beliefs will necessarily exclude a belief in killing others.

Now also assume that a group of self-professed Winsopians, a religion called Lipose by the Winsopians, also practices under the name Faith Practitioners of Trent. Liposians believe that while Earth was created by Divine Plan, God requires biweekly human sacrifice; otherwise God will revoke his Divine Plan.

Each group practices under the same name, and each group holds at least one belief that the other does not. All Faith Practitioners of Trent adhering

¹⁷⁰ *Planetary Motion, Inc. v. Techsplosion, Inc.*, 261 F.3d 1188, 1195–96 (11th Cir. 2001).

¹⁷¹ *Id.*

¹⁷² *Id.* (quoting *New England Duplicating Co. v. Mendes*, 190 F.2d 415, 418 (1st Cir. 1951)).

¹⁷³ *Id.* at 1195–1201.

¹⁷⁴ PANIKKAR, *supra* note 89, at 5.

to Winsop profess truth of Winsop and assume that all Faith Practitioners of Trent do as well. Faith Practitioners of Trent adhering to Lipose, however, profess the truth of Lipose and assume that all Faith Practitioners of Trent do as well. Thus, in both cases, each religion assumes that the name Faith Practitioners of Trent represents one set of true ideological beliefs. In reality, however, Winsopians and Liposians practice different religions under the same name.

As a result, the security of the name Faith Practitioners of Trent is unstable for the following reasons. First, the name Faith Practitioners of Trent, whether formally recognized as a trademark or not, is a cultural symbol which is subject to change by societal forces. For example, the receivers or consuming public, however they are defined, may originally associate the name Faith Practitioners of Trent with the Winsopian belief barring human sacrifice. One or several members, however, may turn out to be former executioners, and the public may discover this fact. After this discovery, the public may come to recognize Faith Practitioners of Trent as a symbol of hypocrisy or an organization that endorses human killings in some circumstances.

Furthermore, the term itself may be generic or may become so. If the religious name was generic, the term Faith Practitioners of Trent would already refer to some religion. To simplify, assume that the name of the hypothetical religion is Believers of Christianity. This name is generic because the name bears a natural relationship to the products (that is, the organizational message and beliefs) with which they are used. A believer of Christianity merely subscribes to the general doctrine of Christianity while not necessarily belonging to any particular religious organization. Indeed, another organization, for example, The Faith Practitioners of Trent, might want to use that phrase in its literature or advertisements because its members profess Christianity. Prohibiting other organizations' use of the phrase "Believers of Christianity" would stifle competition and free speech. If, however, "Believers of Christianity" had acquired secondary meaning, the Faith Practitioners of Trent would have to distinguish itself in some way when it used that phrase.

To illustrate how the religious name may become generic, return to the original example and assume that when Faith Practitioners of Trent was founded, the trademark represented the Winsopian religion. Over time, however, individuals may begin to use the term to refer to any religious group with similar ideological tenets. For example, consumers may use the term "Faith Practitioners of Trent" generally to refer to other any religion whose members believe in an absolute bar on killing humans. In other words, when an individual says, "John is a Faith Practitioner of Trent," that individual really means that John belongs to one of any number of churches that absolutely prohibit killing human beings. In this case, the mark comes to represent churches that hold a particular belief, specifically that killing humans is absolutely wrong, rather

than representing the organization that adheres to that belief. Therefore, the mark loses protection because of the public's usage.

In addition to the risk of becoming generic, Lipose may capture and receive trademark protection for the name "Faith Practitioners of Trent" because it acquired secondary meaning prior to Winsop, or because Winsop may not have acquired secondary meaning at all. Lipose may acquire a secondary meaning because it may market itself better than Winsop, and as a result, consumers may associate Faith Practitioners of Trent with Lipose. Lipose may also acquire secondary meaning because Winsop never advertised or made a sufficient association in the consumers' minds between Winsop and Faith Practitioners of Trent. Finally, Winsop may have acquired trademark protection for Faith Practitioners of Trent, but failed to enforce those rights against Lipose when Lipose used the same mark for its own services and products.

Moreover, the Winsopians will face the problem of authenticity. Winsopians have to battle over their claim of being the true Faith Practitioners of Trent. Winsopians might therefore fight Liposians in court over this claim. But the court dispute will focus on doctrinal legal questions—such as "use in commerce" and "likelihood of confusion"—and not the question of which religious group represents the true Faith Practitioners of Trent. Nevertheless, their battle for ownership over the trademark can be seen as a battle of which religion is the authentic Faith Practitioners of Trent.¹⁷⁵ Indeed, this is the type of claim that religious organizations want to bring but cannot because courts are unable to decide them on grounds of authenticity alone.

Finally, none of these issues may arise if neither party used its mark in commerce. Nothing in this hypothetical suggests that either party handed out pamphlets or maintained a website with its trademark. Under these circumstances, all of the aforementioned trademark claims would fail and none of trademark law's risks would be present (although other risks may exist). That does not mean, however, that the parties could never obtain trademark protection; in fact, quite the opposite is true. As long as the Faith Practitioners of Trent used the name in commerce, it could receive trademark protection. The Faith Practitioners of Trent could likely receive trademark protection if it had started a website and placed its mark in various places on the website, affixed the mark to paraphernalia it sold or otherwise distributed, or affixed the mark to pamphlets or literature it produced and distributed.

This example demonstrates that trademarks may not always protect a religious identity because that identity is ultimately decided by the consumer. This example also illustrates that trademarks can create conflict. We often think

¹⁷⁵ See SCAFIDI, *supra* note 96, at 63.

of trademarks as unifying symbols—ones that draw people to a common cause. But this example shows that while Faith Practitioners of Trent may unite a group of people with similar beliefs, the authenticity of a trademark can divide groups that disagree over the beliefs that the mark represents.

II. THEORY IN PRACTICE: LEGAL DISPUTES INVOLVING RELIGIOUS NAMES

Because of its commercial focus, trademark law has gaps that preclude absolute protection of cultural symbols. Thus, while it may seem obvious that religious trademarks are at risk, it is not obvious when a name becomes threatening to a religious organization. In other words, in what situations do religious organizations sue for trademark infringement?

Lury hypothesized that societal forces create three principal results for social groups: (1) new groups arise, (2) a group redefines itself within context and (3) new audiences are created.¹⁷⁶ This section will use Lury's three categories as a framework to discuss how trademark disputes over identity are litigated. Trademark cases generally fall into one of these three categories.

The lines between categories (1) and (2) are often blurred. Many times, a new group will arise as a result of redefinition within context. The differences between a new group and a redefined group are not always semantic. For the purposes of this article, however, it is immaterial to what degree a new group can be distinguished from a redefined group. Instead, Lury's three categories provide a heuristic to explore how religious organizations use trademarks to protect their identities. The primary function of Lury's categories in this section is to illustrate that societal forces do cause changes, and trademark owners must respond to these changes to protect their identity.

With this understanding, this section will explore the scenarios in which religious identity has been litigated using trademark law. There are three primary scenarios in which trademark disputes over religious names arise: (1) religious groups with diametrically opposed ideologies, (2) religious groups with similar ideologies but fundamental differences and (3) religious groups and other groups critical of that religion. The following subsections detail the cases that involve these disputes and describe the court's analysis in each case. This discussion places particular emphasis on the nature of the plaintiff's cause of action and the plaintiff's concerns of identity, since these considerations are of paramount importance.

¹⁷⁶ *Supra* Part I(A)(i).

A. *Religiously-Motivated Groups with Diametrically Opposed Ideologies*

Religious organizations are naturally concerned with their identities. As a result, any entity using a confusingly similar mark poses a risk to that identity. Confusion can result when two religious groups use a similar name but the groups adhere to diametrically opposed ideologies. When an organization employs a confusingly similar mark, but adheres to a set of beliefs fundamentally different from the original organization, the original organization's identity is threatened. The original organization risks being associated with an organization whose beliefs are in conflict with its own. In other words, its identity is compromised by the problem of capture. As a result, the original organization may sue to prevent its identity from being associated with, and subject to capture by, an ideologically different organization. Religious organizations try to combat the actual-perception problem of truth by using lawsuits to maintain their own identity, and thereby maintain their religious authenticity.

The most prominent case in this area is *Te-Ta-Ma Truth Foundation-Family of URI, Inc. v. World Church of the Creator (Te-Ta-Ma III)*.¹⁷⁷ In *Te-Ta-Ma III*, the Te-Ta-Ma Truth Foundation-Family ("Foundation") sued the World Church of the Creator ("World Church"), alleging that the World Church infringed its registered trademark "Church of the Creator."¹⁷⁸ The mark was incontestable at the time the Foundation filed the lawsuit.¹⁷⁹ The World Church was one of three primary divisions of the white supremacist movement.¹⁸⁰ The mission of the World Church was twofold: (1) to ensure the survival, expansion and advancement of the white race and (2) to eliminate Jews, blacks and "mud-races."¹⁸¹ The Foundation, on the other hand, was a religion professing universal love and respect¹⁸² and actively included everyone who wished to join.¹⁸³

¹⁷⁷ 392 F.3d 248 (7th Cir. 2004) (reversing district court's decision denying the Foundation's motion in *Te-Ta-Ma Truth Found.-Family of URI, Inc. v. World Church of the Creator (Te-Ta-Ma I)*, No. 00 C 2638, 2002 U.S. Dist. LEXIS 1478, at *1 (N.D. Ill. Jan. 31, 2002)).

¹⁷⁸ *Te-Ta-Ma Truth Found.-Family of URI, Inc. v. World Church of the Creator (Te-Ta-Ma III)*, 392 F.3d 248, 249 (7th Cir. 2004).

¹⁷⁹ *Te-Ta-Ma Truth Found.-Family of URI, Inc. v. World Church of the Creator (Te-Ta-Ma II)*, 297 F.3d 662, 664 (7th Cir. 2002).

¹⁸⁰ Betty A. Dobratz, *The Role of Religion in the Collective Identity of the White Racialist Movement*, 40 J. FOR SCI. STUDY RELIGION 287, 289-301 (2001).

¹⁸¹ *Te-Ta-Ma II*, 297 F.3d at 663.

¹⁸² *Id.*

¹⁸³ *Trademark Litigation - Church Of The Creator*, <http://churchofthecreator.org/TM/TMindex.html> (last visited Feb. 2, 2009).

The bigotry practiced by the World Church was diametrically opposed to the universal acceptance practiced by the Foundation.¹⁸⁴

On appeal, the Seventh Circuit found that the World Church infringed the Foundation's trademark.¹⁸⁵ Although the decision rested on a finding that the Foundation's mark was descriptive rather than generic, the court emphasized the role identity played in its decision.¹⁸⁶ The court held that the Foundation's name did not preclude others from distinguishing themselves and implied that the name encapsulated the Foundation's identity: "[U]sing 'Church of the Creator' as a denominational name leaves ample options for other sects to distinguish themselves and achieve separate identities."¹⁸⁷ In other words, the Foundation's mark captured its identity both by incorporating its own beliefs and by excluding others. On this basis, the court concluded that "there is no risk that exclusive use of 'Church of the Creator' will appropriate a theology or exclude essential means of differentiating one set of beliefs from another."¹⁸⁸

As *Te-Ta-Ma III* illustrates, a religious organization may use trademark law to fight concerns of reverse confusion and authenticity. The Foundation clearly felt threatened by the World Church's use of its trademark. At least part of the Foundation's fear of capture may have been related to the risk of reverse confusion;¹⁸⁹ it did not want people to assume that the World Church was the first user of the trademark.

Similarly, the Foundation was concerned that people would assume, based on this reverse confusion, that the World Church was the authentic user of the mark. The Seventh Circuit's decision makes clear that the World Church

¹⁸⁴ *Te-Ta-Ma II*, 297 F.3d at 664.

¹⁸⁵ *Id.* at 667.

¹⁸⁶ *Id.* at 666–67.

¹⁸⁷ *Id.* at 667.

¹⁸⁸ *Id.*

¹⁸⁹ Reverse confusion results where a junior user enters the market using the senior user's mark, but consumers believe that the junior user is actually the senior user. *See* A&H Sportswear, Inc. v. Victoria's Secret Stores, Inc., 237 F.3d 198, 227–28 (3d Cir. 2000) (describing the harms of reverse confusion). It also appears that the Foundation was concerned with the problem of capture as it related to reverse confusion. *Te-Ta-Ma Truth Found.-Family of URI, Inc. v. World Church of the Creator (Te-Ta-Ma III)*, 392 F.3d 248, 250–52 (7th Cir. 2004) ("Given the confusing similarity in the names of the two organizations, it was certainly possible that the Foundation might be mistaken for the unsavory organization headed by Hale, and that is precisely what happened."). That is, the Foundation worried that reverse confusion could lead to the capture of its identity. *Id.*

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was suing over authenticity.¹⁹⁰ Samples of the messages sent by the World Church to the Foundation or its attorneys illustrate this point.

“I’m a member of a white racel [sic] racial religion called creativity. Are [sic] church is called the [W]orld [C]hurch of the [C]reator What makes you think that we stould [sic] the name from you FUCKING KIKE?”

. . .

“W[e] had the name [World Church of the Creator] first. No one else did and it’s been proven. . . .”

. . .

“The World Church of the Creator has had our name for many years more than you. . . . [Y]ou will make a lot of people very angry.”

. . .

(voicemail) “Yes, my name is John Pierce. I’m a member of the COTC, the Church of the Creator, the *real* Church of the Creator. . . .”¹⁹¹

While many of these messages contain threats and hint at priority of use, they all express a claim to the authenticity of the name Church of the Creator. Although the opinion did not contain messages from the Foundation concerning authenticity, at a minimum, the Foundation must have felt that it deserved the name Church of the Creator. Despite the importance of this authenticity, the court focused instead on the descriptive nature of the trademark¹⁹² because that is what the law commands. The court found for the Foundation based on trademark principles, but concerns of authenticity played a role in its decision-making process.

B. Religiously-Motivated Groups with Similar Ideologies but Fundamental Differences

Religious groups with diametrically opposed ideologies are not the only groups likely to fight over their identities. Identity is often threatened when two groups share similar ideologies but have differing views on fundamental aspects of that ideology. Within this context, litigation can arise where (1) a group within a religion splinters off from the religion, (2) a separate religious group arises, (3) a religious group seeks to join another religious group but is denied

¹⁹⁰ *Te-Ta-Ma III*, 392 F.3d at 251–55 (discussing the claims of authenticity made by the World Church).

¹⁹¹ *Id.* at 251–53 (alterations added) (emphasis added).

¹⁹² *Te-Ta-Ma II*, 297 F.3d. at 667.

affiliation or admission, (4) a religious organization revokes the trademark rights of its affiliates or (5) individuals seek to form a mother organization from pre-existing organizations.

Lury's hypothesis of social forces shows that these conflicts arise because trademarks are cultural symbols to which people attach different meanings at different times. The following parts outline these conflicts, including cases to illustrate the fight over identity using trademark law.

1. Splinter Groups

As noted earlier, changing social relationships between receivers and producers may create new social groups.¹⁹³ One reaction to changing social groups is the redefinition of a group within context.¹⁹⁴ This typically occurs where a faction within an organization becomes dissatisfied or disagrees with the organization's doctrine. This dissenting group typically will form its own splinter organization, spurring a conflict over the authenticity of each group's religious identity.

a. Circuit Court Decisions

That splintering is exactly what happened in *Maktab Tarighe Oveyssi Shah Maghsoudi, Inc. v. Kianfar*.¹⁹⁵ In that case, both parties practiced a mystical form of Islam known as Sufism.¹⁹⁶ Maghsoudi, Inc. was the corporate embodiment of the Sufi Order, which by 1970 had passed its traditions through a succession of forty-one teachers since the time of Muhammad.¹⁹⁷ In 1970, Nader Angha was formally appointed the Forty-Second Teacher.¹⁹⁸ As Teacher, Angha inherited ownership of the Order's property, including its trademarks and service marks.¹⁹⁹ Ali and Nahid Kianfar ("Kianfars") were members of the Maghsoudi who, until 1983, recognized Angha as the legitimate Teacher of the

¹⁹³ LURY, *supra* note 35, at 41.

¹⁹⁴ *Id.*

¹⁹⁵ 179 F.3d 1244 (9th Cir. 1999).

¹⁹⁶ *Id.* at 1246. For a full account of Sufism, see A.J. ARBERRY, *SUFISM: AN ACCOUNT OF THE MYSTICS OF ISLAM* (Routledge 2007) (1950).

¹⁹⁷ *Maghsoudi*, 179 F.3d at 1246.

¹⁹⁸ *Id.*

¹⁹⁹ *Id.* at 1246–47. These marks include the name of the organization itself, "Maktab Tarighat Oveyssi Shahma Ghsoudi" (School of Islamic Sufism), U.S. Trademark Registration No. 1,652,335 (filed Sept. 1, 1988), a service mark of a symbolic representation of an open heart, U.S. Trademark Registration No. 1,440,550 (filed July 8, 1986) and some variations.

Order.²⁰⁰ Angha expelled the Kianfars for wrongdoing in 1983, and the Kianfars founded a new order of Sufism that established them as the rightful successors to the Forty-First Teacher.²⁰¹ Maghsoudi filed a trademark infringement action in 1995 after the Kianfars established “the International Association of Sufism, Inc.”²⁰² The Kianfars assumed Maghsoudi felt its identity was at risk and, in response, filed a motion to dismiss on the grounds that the First Amendment barred judicial adjudication.²⁰³

The Ninth Circuit first observed that “[t]he First Amendment not only precludes a civil court from determining for itself who is entitled to hold religious office, but also precludes it from determining whether the religious organization followed its own ecclesiastical rules in anointing one of its leaders.”²⁰⁴ The court also noted that the central question in this case involved identity; the court had to choose the legitimate Forty-Second Teacher or other leader of the Order.²⁰⁵ In other words, the court described the dispute in terms of religious authenticity. It was a battle over the authentic leadership of the Order. For that reason, the court correctly stated that, on remand, the district court should resolve the dispute by secular principles, focusing on whether the Kianfars infringed Maghsoudi’s marks, not which group retained the authentic religious identity.²⁰⁶ Indeed, courts cannot resolve disputes over religious authenticity. Instead, the courts must use the principles of trademark and unfair competition law to settle disputes that, at their heart, deal with religious identity.

Similarly, in *Self-Realization Fellowship Church v. Ananda Church of Self-Realization*,²⁰⁷ Donald Walters, a former member of the Self-Realization Fellowship Church (“SRF”), founded his own organization with the name “Church of Self-Realization” (“CSR”).²⁰⁸ SRF had widely published its name on products and services, including posters, video tapes and publications.²⁰⁹ Both SRF and CSR represented themselves as “Yogananda’s disciples,” practicing the religion which Parahmahnsa Yogananda made famous in his book, *Au-*

²⁰⁰ *Maghsoudi*, 179 F.3d at 1247.

²⁰¹ *Id.*

²⁰² *Id.*

²⁰³ *Id.*

²⁰⁴ *Id.* at 1247–48 (citing *Serbian Eastern Orthodox Diocese v. Milivojevich*, 426 U.S. 696, 710–11 (1976)).

²⁰⁵ *Id.* at 1247.

²⁰⁶ *Id.* at 1250.

²⁰⁷ 59 F.3d 902 (9th Cir. 1995).

²⁰⁸ *Id.* at 904.

²⁰⁹ *Id.*

tobiography of a Yogi.²¹⁰ In fact, Donald had received much of his training at SRF, which was founded in the 1930s.²¹¹ He founded his organization in 1962, but did not adopt the name CSR until the 1980s.²¹² In February 1990, SRF filed a series of trademark applications covering the name “Self-Realization Fellowship” and many of its variants.²¹³ Then, in July 1990, SRF sued CSR in federal court for, *inter alia*, trademark infringement.²¹⁴

Among other issues, the court resolved the issue of Self-Realization’s status as a trade name.²¹⁵ The court focused on whether the mark adequately captured SRF’s identity.²¹⁶ It found that “Self-Realization” was generic as a trade name because it identified “a general class of spiritual organizations, instead of a single, unique organization.”²¹⁷ In other words, “Self-Realization” did not represent the identity of SRF or any other religious organization because “a ‘Self-Realization’ organization is a class of organization dedicated to spiritual attainment in the manner taught by Yoga, not an organization that is part of the SRF chain of churches.”²¹⁸ Yet, the court did not find that the composite marks, “Self-Realization Fellowship” or “Self-Realization Fellowship Church,” were invalid because the district court erroneously dissected²¹⁹ the marks.²²⁰

The principle of genericness prevented a religious organization from adequately protecting its identity. Here, SRF was attempting to assert the authenticity of its mark and to prevent CSR from capturing it.²²¹ In fact, CSR’s efforts show a faction-initiated capture because CSR, the splinter group, attempted to capture SRF’s identity by using a similar name.²²² Unfortunately for SRF—and fortunately for CSR—the court did not address the issues of authenticity and capture because it determined that SRF’s name did not describe the

²¹⁰ *Id.*

²¹¹ *Id.* at 904–05.

²¹² *Id.* at 904.

²¹³ *Id.* at 902, 905.

²¹⁴ *Id.*

²¹⁵ *Id.* at 909–13.

²¹⁶ *Id.* at 909.

²¹⁷ *Id.*

²¹⁸ *Id.*

²¹⁹ The principle of anti-dissection states that the reviewing court should view the mark as it is seen by the public, and should not separate the mark and analyze its individual components to determine its validity. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1345–46 (Fed. Cir. 2001). Thus, courts should consider the mark “as a whole.” *Id.* at 1346.

²²⁰ *Self-Realization*, 59 F.3d at 912–13.

²²¹ *See id.* at 904.

²²² *See id.*

beliefs it held.²²³ Instead, the name indicates a “class of organization” that shares similar beliefs.²²⁴ For this reason, SRF could not protect its religious identity through trademark law.

*Purcell v. Summers*²²⁵ involved a similar scenario. In *Purcell*, bishops of the Methodist Church sued former members of the Methodist Episcopal Church, South, which had since been united by the plaintiffs with other charitable institutions.²²⁶ While the opinion does not detail the facts surrounding the split, it does point out that “[t]hese former members had set up a rival church organization and were claiming the right . . . to the use of the name of the Methodist Episcopal Church, South.”²²⁷ The former members united the Methodist Episcopal Church, the Methodist Episcopal Church, South and the Methodist Protestant Church.²²⁸ The court noted the value that each church derived from its name:

The name of this church, [the Methodist Episcopal Church,] like the names of the other uniting churches was of great value, not only because business was carried on and property held in that name, but also because of members associated with the name the most sacred of their personal relationships and the holiest of their family traditions.²²⁹

The court therefore observed the prominent role identity played in the organization’s name, for both the organization and its members.²³⁰ The court emphasized this point when it stated that the purpose of the unification was to “preserve the values . . . attach[ed] to the names of the uniting bodies.”²³¹

In deciding the case in favor of the plaintiffs, the court endorsed a rationale that included preserving the identity of the plaintiffs’ church. The court reasoned:

A large portion of any community is not well informed about ecclesiastical matters; and for the dissident members to use the name of the old church will enable them to appear in the eyes of the community as the continuation of that

²²³ *Id.* at 909–12.

²²⁴ *Id.* at 909.

²²⁵ 145 F.2d 979 (4th Cir. 1944).

²²⁶ *Id.*

²²⁷ *Id.*

²²⁸ *Id.* at 981–82.

²²⁹ *Id.* (alteration added).

²³⁰ *Id.*

²³¹ *Id.* (alteration added).

church, and to make the united church, which in reality the continuation of the old church, appear as an intruder.²³²

The court further remarked that the use of the name “Methodist Episcopal Church, South” by the defendants’ rival organization would confuse people as to which church represented the true church.²³³ The court also emphasized the ability of a religious organization to control the use of its trademark in connection with the organization’s professed beliefs, stating that “it is not fair to [the plaintiffs] that [the] name [Methodist Episcopal, South] be used by persons over whose professions of faith and practices [the plaintiffs] can exercise no control.”²³⁴

While the *Purcell* court relied on a secondary-meaning rationale to resolve the dispute, it seemed acutely attuned to the problem of capture, and to a lesser extent, authenticity. Much of its rhetoric was devoted to giving the plaintiffs the ability to preserve the identity of their church (as embodied in the church’s trademark). Implicit in this rhetoric were two claims about authenticity and capture. First, when the court argued that the value ascribed to the name (that is, its sanctity) warranted its protection, it endorsed the idea that the name deserved protection because it was authentic. Specifically, the court expressed concerns that consumers would not be able to distinguish the authentic church from the newly formed rival church if both names were used.²³⁵ The court’s focus, however, was still commercial in nature and not directed at the religious authenticity with which religious organizations are concerned. Thus, the court failed to resolve a real issue of the dispute: whether the plaintiffs’ church’s name was authentic.

From that claim about authenticity, it takes only a small logical step to promote protection based on capture. If the plaintiffs’ church was the authentic church, it follows that it should be protected from consumer confusion that may result in capture. The court explicitly stated that it feared a similar name might

²³² *Id.* at 983.

²³³ *Id.* The court continued by stating:

[U]se of the name ‘Methodist Episcopal Church, South’, by a rival church operating in the same territory formerly occupied by that church and now occupied by its successor, The Methodist Church, would . . . confus[e] the minds and mislead[] many members of The Methodist Church . . . into the belief that The Methodist Church is not the true and lawful successor of the Methodist Episcopal Church, South, . . . and would necessarily confuse the minds and mislead those person wishing to join a church of the Methodist faith . . .

Id. (alterations added).

²³⁴ *Id.* (alterations added).

²³⁵ *Id.*

result in confusion, which could result in the defendant's capture of the plaintiff's identity.²³⁶ In this way the court's theory of protection did, although not purposefully or explicitly, account for the two problems that religious organizations typically face in trademark law. Nevertheless, the court cannot combat the problem of capture or authenticity completely because of trademark's consumer-centered focus. Thus, while the court was attuned to these issues, its decision does little to preserve the plaintiff's religious identity.

b. District Court Decisions

The U.S. district courts have also decided cases involving groups that splinter from the main group. In *National Board of the Young Women's Christian Association v. Young Women's Christian Association of Charleston, South Carolina*,²³⁷ the National Board of the Young Women's Christian Association ("National Board") sued the Young Women's Christian Association of Charleston, South Carolina ("Charleston Association") for trademark infringement.²³⁸ In 1903, the founding members formed the Charleston Association.²³⁹ Three years later, the National Board was formed and the Charleston Association applied for a charter membership, which the National Board approved.²⁴⁰

The National Board had, at the time of trial, "over 400 affiliated community organizations, about 200 student organizations, and about 134 Y-Teen clubs throughout the United States."²⁴¹ The dispute began when the Charleston Association requested and received disaffiliation from the National Association in 1969.²⁴² The Charleston Association continued to use the name "Young Women's Christian Association."²⁴³ The court concluded that the Charleston Association infringed the National Board's mark.²⁴⁴ The court found that the National Association assumed the Charleston Association's identity when the Charleston Association agreed to the National Association's charter.²⁴⁵ In other

²³⁶ *Id.*

²³⁷ 335 F. Supp. 615 (D.S.C. 1971).

²³⁸ *Id.* at 617.

²³⁹ *Id.* at 618.

²⁴⁰ *Id.*

²⁴¹ *Id.*

²⁴² *Id.* at 619.

²⁴³ *Id.*

²⁴⁴ *Id.* at 628–29.

²⁴⁵ *Id.* at 622.

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words, any independent identity the Charleston Association may have had no longer existed.²⁴⁶

In making this decision, the court implicitly decided the issue of religious authenticity. By deciding that the Charleston Association no longer existed,²⁴⁷ the court essentially affirmed the authenticity of the National Association as a religious body. It also prevented the possible genericide and capture that may have resulted from the Charleston Association's use of the trademark. For if the Charleston Association continued to use its old mark, the National Association's identity might have been captured, at least locally, by the Charleston Association. Despite these steps, however, the court's decision did not wholly protect the National Association's religious identity. The trademark may still become generic or become captured by a different religion.

This factual situation occurred again in *National Spiritual Assembly of the Baha'is of the United States Under the Hereditary Guardianship, Inc. v. National Spiritual Assembly of the Baha'is of the United States, Inc.*²⁴⁸ Like other cases dealing with splinter groups, *National Spiritual Assembly* involved a former member who founded his own religious group.²⁴⁹ The defendant's group, National Spiritual Assembly ("NSA"), originated in 1863 in what is modern-day Iran, and reached the United States around 1892.²⁵⁰ The formal incorporation of NSA occurred in 1909.²⁵¹ NSA owned several trademark registrations covering its name and had used those trademarks in promotion of religious books, publication and other paraphernalia.²⁵² But like all organizations discussed in this section, NSA had its detractors. Here, it was Mason Remey, who unilaterally proclaimed himself "Hereditary Guardian" of the Baha'i Faith, the Successor to the Persian Shoghi Effendi.²⁵³ Remey's new group, the New Mexico Group, established a public relations office and distributed publications.²⁵⁴ In its publications, the New Mexico Group foretold global catastrophe that would wipe out the earth.²⁵⁵ NSA held no such belief.²⁵⁶

²⁴⁶ *Id.*

²⁴⁷ *Id.*

²⁴⁸ 150 U.S.P.Q. (BNA) 346 (N.D. Ill. 1966).

²⁴⁹ *See id.* at 351.

²⁵⁰ *Id.* at 347.

²⁵¹ *Id.*

²⁵² *Id.* at 350–51.

²⁵³ *Id.* at 351.

²⁵⁴ *Id.* at 352.

²⁵⁵ *Id.* at 353.

²⁵⁶ *Id.*

The court held that NSA's mark was protectable because it was registered and valid.²⁵⁷ Moreover, the New Mexico Group's name would likely confuse the public, compromising NSA's identity.²⁵⁸ Like the *Purcell* court, the *National Spiritual Assembly* court found that the existing confusion would likely result in capture.²⁵⁹ First, the court stated its concern for possible physical capture (that is, capture of NSA's members): "The NSA and the Baha'i Faith are legally entitled to continue expanding membership, and are entitled to be free from interference and probable loss of potential members to the New Mexico [G]roup because of the use of confusingly similar names and symbols."²⁶⁰

Then, the court dealt with ideological capture—that is, capture of the identity itself—stating:

The general public is likely to assume or believe that the New Mexico [G]roup is affiliated with or connected with the NSA, and is likely to join the New Mexico [G]roup intending to join the Baha'i Faith and to attribute publications, press releases and the like originating from the New Mexico [G]roup as emanating from the NSA and the Baha'i Publishing Trust.²⁶¹

The court emphasized its concern that the New Mexico Group would capture or make generic NSA's identity because NSA did not control the New Mexico Group's activities or beliefs, which ran contrary to NSA's.²⁶² Yet, the court was forced to rely on the doctrine of consumer confusion to resolve the issue instead of looking to a more appropriate doctrine, that of religious identity.

The court also implicitly recognized the authenticity of the NSA, albeit through trademark principles. This recognition, of course, has no force other than in trademark law. Again, this is not religious authenticity.²⁶³ The court has

²⁵⁷ *Id.* at 354.

²⁵⁸ *Id.* at 355.

²⁵⁹ *See id.* ("The general public is likely to assume or believe that the New Mexico [G]roup is affiliated with or connected with the NSA . . ." (alteration added)).

²⁶⁰ *Id.* (alteration added).

²⁶¹ *Id.* (alterations added).

²⁶² *Id.* The court further stated:

The general public is becoming more and more aware of the Baha'i Faith, and the growth of the Faith would be irreparably impaired if extreme religious dogma espoused by the New Mexico [G]roup were thought, like the catastrophism doctrine, to originate with the NSA. The NSA has no control over the actions or doctrines of the New Mexico [G]roup, which may promulgate new and extreme religious doctrines which would, if attributed to the NSA, severely damage the NSA and the Baha'i Faith in their spiritual progress.

Id. (alterations added).

²⁶³ *Supra* Part II(B).

not promulgated or secured ownership of an authentic religious identity. A religious organization must work within the confines of trademark law to assert its non-trademark dispute. The parties could not make arguments about which group had the correct beliefs and values. Thus, the identity the court dealt with here concerned the organization as an entity with a particular *name*. The court made no pronouncement that the NSA generally retained the authentic Baha'i religious identity; it stated only that the NSA had the right to use a particular name.²⁶⁴ Moreover, the trademark itself may still become associated with other values and beliefs that NSA finds objectionable as a result of shifting consumer association or genericide. The problem of truth may also arise in the future. Consumers may come to associate NSA with a particular set of beliefs even though, despite NSA's best efforts to show the contrary, it does not hold those beliefs. If this association became extremely widespread, NSA may be forced to abandon its trademark. Thus, while the court attempted to use trademark law to settle a dispute over identity, it could not completely resolve the problem.

c. *State Court Decisions*

State courts, like federal courts, have experience dealing with legal issues involving religious splinter groups. The Supreme Court of New Jersey decided *Christian Science Board of Directors of the First Church of Christ, Scientist v. Evans*,²⁶⁵ to settle this issue. The Christian Science Board of Directors of the First Church of Christ, Scientist was the organization representing the Church of Christ, Scientist ("Mother Church"), which Mary Baker Eddy, the founder of Christian Science, established in 1889.²⁶⁶ The Mother Church consisted of local branch churches or societies.²⁶⁷ In 1892, the defendant church ("Plainfield Church") joined the Mother Church.²⁶⁸ But in 1977, "a doctrinal schism developed between the [Mother Church] and the Plainfield Church."²⁶⁹ As a result, the Plainfield Church took efforts to disassociate itself with the Mother Church, formally ending its legal relationship with the Mother Church and re-incorporating itself as "Independent Christian Science Church of Plainfield, New Jersey."²⁷⁰ In response, the Mother Church filed an action for trade-

²⁶⁴ *National Spiritual Assembly*, 150 U.S.P.Q. at 355.

²⁶⁵ 520 A.2d 1347 (N.J. 1987).

²⁶⁶ *Id.* at 1349–50.

²⁶⁷ *Id.* at 1349.

²⁶⁸ *Id.*

²⁶⁹ *Id.* (alteration added).

²⁷⁰ *Id.*

mark infringement.²⁷¹ On appeal, the Plainfield Church “challenged only the restraints on [its] use of [the terms] ‘Christian Science’ and ‘Christian Science Church.’”²⁷²

The New Jersey Supreme Court held that the Mother Church’s name was generic.²⁷³ The court intimated that the identity of a religious trademark does not and cannot embody the ideals of a religion. The court stated two reasons for this conclusion: “[F]irst, the religion and the organization are conceptually separate; and second, the religion pre-existed the organization.”²⁷⁴ After divorcing the identity of a religious organization from its religion, it took minimal analytical effort for the court to conclude that trademark law did not protect the Mother Church’s name.²⁷⁵ To do this, the court found that the religious name, Christian Science, was generic.²⁷⁶ The court’s view on identity, however, was not required for its conclusion. It is possible to find a religious name generic even if the organization and the religion are not conceptually separate.²⁷⁷ While the court’s observation that religions pre-exist the formal organization was correct, it is also rather banal since, conceptually, all religions pre-exist the formal organization that represents their religious beliefs.

The commercial focus of trademark law is clearly evident in the *Christian Science* case.²⁷⁸ The court seemed particularly adverse to the application of trademark law in the context of religious identity.²⁷⁹ Moreover, the court used trademark law, specifically the doctrine of genericness, to prevent the Mother Church from protecting its religious identity.²⁸⁰ The conscious limitations im-

²⁷¹ *Id.*

²⁷² *Id.* at 1351 (alterations added).

²⁷³ *Id.* at 1352. The court erroneously cited *In re Bailey Meter Co.*, 102 F.2d 843, 844 (C.C.P.A. 1939) as an example of how to determine whether a mark is generic. *Id.* In *Bailey*, however, the Court of Customs and Patent Appeals found the mark “Boiler Meter” to be *descriptive*, not generic. *Bailey*, 102 F.2d at 844 (“We are of opinion that the commissioner was correct in holding that the mark applied for named the appellant’s device and is, therefore, descriptive.”). The court in *Christian Science* therefore further erred when it failed to address why the mark was generic rather than descriptive.

²⁷⁴ *Christian Science*, 520 A.2d at 1351.

²⁷⁵ *Id.* at 1353.

²⁷⁶ *Id.* at 1352.

²⁷⁷ One example of this might be an intellectual property holding organization for a religion. In this case, the company would own the trademarks of various religious organizations and yet be conceptually separate from them.

²⁷⁸ See *Christian Science*, 520 A.2d at 1353.

²⁷⁹ See *id.* at 1352.

²⁸⁰ *Id.* at 1354.

posed on trademark law can effectively thwart religious organizations' attempts to protect their identities. The court's view on the consonance of religious identity and trademark law was decisive; it determined that no organization seeking protection of its identity can wrap itself in the shawl of a religion because religious names—provided they are generic—are free for all to use.²⁸¹

The Supreme Court of Pennsylvania faced a similar fact pattern in *Church of God at Markleysburg v. Church of God at Markleysburg*.²⁸² There, the Church of God at Markleysburg, Pennsylvania ("Congregation") sued the General Assembly of the Churches of God ("General Assembly") for possession of property, including use of the name Church of God at Markleysburg.²⁸³ The litigation arose because of a doctrinal disagreement within the Church.²⁸⁴ From 1883 until the winter of 1939, the General Assembly remained the sole governing organization of the Congregation.²⁸⁵ In the 1930s, dissention grew within the Congregation.²⁸⁶ To quell dissention and disagreement, the Church adopted a "Bishops' Agreement" in 1939.²⁸⁷ But instead of squelching disagreement, the resolution fostered it.²⁸⁸ That same year, a member of the Congregation, H.W. Poteat, withdrew his membership and founded a new church with the name Church of God, enlisting the support of several other dissatisfied members of the General Assembly.²⁸⁹

The court began its discussion with the law of Pennsylvania, which implicated identity: "A local congregation which is a part of a larger religious organization cannot divorce or separate itself from the church family, set up a new

²⁸¹ *Id.* at 1352. The court stated its view on a fundamental trademark principle:

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. This principle is fundamental to the law of trademarks, the body of law under which plaintiffs seek relief.

...

[A]s a matter of pure common sense, 'Christian Science Churches' is a generic name for churches in which Christian Science is practiced.

Id.

²⁸² 355 Pa. 478 (1947).

²⁸³ *Id.* at 478–79.

²⁸⁴ *Id.* at 483.

²⁸⁵ *Id.* at 482.

²⁸⁶ *Id.*

²⁸⁷ *Id.*

²⁸⁸ *Id.* at 483.

²⁸⁹ *Id.*

independent organization, and by so doing entitle itself to retain the congregational property.”²⁹⁰ The court also underscored the importance of a religious organization’s ability to control its affiliated members, and explained that control of their names enabled organizations to achieve that objective.²⁹¹ In other words, the court emphasized that the General Assembly must be allowed to attempt to maintain its authenticity and prevent its capture by a new or splinter organization.²⁹² The court enjoined the Congregation from using “‘The Church of God,’ or any similar name, to designate any other denominational organization than that of the General Assembly.”²⁹³

The Supreme Court of Georgia ruled on a similar scenario in *Carnes v. Smith*.²⁹⁴ In that case, the United Methodist Church (“Parent Church”) acted as the parent church for several other local churches, including Noah’s Ark Methodist Church (“Member Church”).²⁹⁵ The Parent Church had deeded property to the Member Church as trustees in 1852; from that time until 1969, the Member Church contributed funds and participated actively with the Parent Church.²⁹⁶ In 1969, the Member Church requested a full-time pastor for its congregation, which the Parent Church refused, stating that it would not be financially feasible to support the Member Church with a full-time pastor.²⁹⁷ That same year, the Member Church withdrew from the Parent Church, but continued to use its pre-existing property and name.²⁹⁸ The Parent Church sued, seeking to enjoin the Member Church from using the property and the name, which it claimed for itself.²⁹⁹ In upholding the trial court’s order enjoining the Member Church from using its previous name, the court quoted *Purcell* to emphasize the role of names in creating and maintaining religious identity.³⁰⁰ Specifically, the court emphasized the fact that the value of a religious name extends beyond

²⁹⁰ *Id.* at 484.

²⁹¹ *Id.* at 486 (“[I]t would be a mistake to think that a local congregation subject to superior ecclesiastical judicatories could be permitted to sit in judgment on questions of orthodox belief, since in that event opportunistic desires and ambitions would render denominational authority vain and ineffectual.”).

²⁹² *See id.* at 485.

²⁹³ *Id.* at 487–88.

²⁹⁴ 222 S.E.2d 322 (Ga. 1976).

²⁹⁵ *Id.* at 324.

²⁹⁶ *Id.*

²⁹⁷ *Id.*

²⁹⁸ *Id.*

²⁹⁹ *Id.*

³⁰⁰ *Id.* at 329 (“The local name of a church is ‘of great value’” (quoting *Purcell v. Summers*, 145 F.2d 979, 982 (4th Cir. 1944))).

economic terms “because millions of members associated with the name the most sacred of their personal relationships and the holiest of their family traditions.”³⁰¹ In making its decision, the court noted that the name of the Member Church had always been in use and prominently displayed.³⁰²

Carnes provides another example of the problems religious organizations face in protecting their identity using trademark law. The *Carnes* court had to deal with the problem of capture and the actual-perception problem of truth.³⁰³ As to the former, the aforementioned quote adequately seizes the concept: the Parent Church should be able to prevent another from effectively capturing its identity by using its name without authorization. As to the latter, the court was attempting to maintain the identity of the Parent Church’s members.³⁰⁴ To the extent that the court focused on the identity of the organization as perceived by its members, rather than the identity produced by the governing body, the court did not work to protect the identity of the religious organization.³⁰⁵ Although the Parent Church won the case, the decision did not support the producer-centric theory that religious organizations desire.

The Florida Supreme Court decided a similar issue in *First Born Church of the Living God v. The First Born Church of the Living God*.³⁰⁶ Since 1913, The First Born Church of Living God (“First Church”) had practiced its religion in Georgia.³⁰⁷ It had done the same in Florida since 1939.³⁰⁸ J.Q. Croom, along with several others, founded the organization in 1913.³⁰⁹ After numerous people thwarted several attempts by Croom to obtain the office of bishop, he chartered a rival organization under the name “First Born Church of the Living God” (“Rival Church”).³¹⁰

The court enjoined the Rival Church’s use of the name First Born Church of the Living God.³¹¹ In doing so, it recognized that Croom’s purpose in

³⁰¹ *Id.* (quoting *Purcell*, 145 F.2d at 982).

³⁰² *Id.* at 330.

³⁰³ *See id.* at 329–30.

³⁰⁴ *See id.* at 329 (noting the fundamental role beliefs and traditions played in the Church members’ lives).

³⁰⁵ *Id.* at 330 (sustaining the injunction but making no mention of the identity of the religious organization).

³⁰⁶ 22 So. 2d 452 (Fla. 1945).

³⁰⁷ *Id.* at 453.

³⁰⁸ *Id.*

³⁰⁹ *Id.*

³¹⁰ *Id.*

³¹¹ *Id.* at 454.

forming the new organization was to anoint himself bishop of that organization “with a name so similar as to be almost indistinguishable.”³¹² Indeed, Croom’s mission was to create dissension among the First Church’s members.³¹³ When it examined the documents presented by First Church, the court noted that discrepancies existed.³¹⁴ Nevertheless, it found that First Church maintained its identity through constant use of property and that the discrepancies were insignificant.³¹⁵ In other words, the court found that Croom calculated his efforts to cause confusion, and this attack on the First Church’s identity would fail in the eyes of the law.³¹⁶

As with the other cases described in this section, *First Born* manifests themes of religious identity. Although the court framed the dispute in terms of confusion,³¹⁷ the real contest was over the authenticity of the First Church. Croom’s attempt to capture the First Church trademark was evident, and the court essentially concluded that the First Church was authentic when it described the dispute as one of capture by the Rival Church. Importantly, however, the court was forced to resort to a likelihood-of-confusion analysis and failed to discuss authenticity or capture, primarily because trademark law does not explicitly provide for consideration of these issues.³¹⁸

d. Trademark Trial and Appeal Board Decisions

The Trademark Trial and Appeal Board (“TTAB”) has also confronted issues involving splinter-religious organizations. In *Church of God v. Church of God of Prophecy*,³¹⁹ Church of God of Prophecy (“Prophecy”) applied to register a design mark for “evangelistic and ministerial services, namely, religious services and ceremonies.”³²⁰ The Church of God (“Church”) opposed the registra-

³¹² *Id.* at 453.

³¹³ *See id.* at 452–54 (discussing the means used to confuse the public).

³¹⁴ *Id.* at 453.

³¹⁵ *Id.* (stating that despite discrepancies in the instruments cited, “the property has been used by the appellee corporation for church purposes for many years and especially when we recall Croom’s connection with that organization we can only conclude that these differences are insignificant”).

³¹⁶ *Id.* at 454.

³¹⁷ *Id.* at 454 (“The remedy of injunction is quite appropriate to prevent the use of a corporate name so similar to that of an existing corporation that deception, unfair competition, or confusion may result.”).

³¹⁸ *See id.*

³¹⁹ Opposition No. 94,180, 2000 TTAB LEXIS 338 (T.T.A.B. May 18, 2000).

³²⁰ *Id.* at *1.

tion on the grounds of, *inter alia*, prior use and confusing similarity.³²¹ In 1990, a group within the Prophecy became discontented with its teachings and alleged that the Prophecy had deviated from the true theological teachings of the Prophecy's founder, A.J. Tomlinson.³²² These members established the Church, considering themselves the "true" Church of God of Prophecy and sought to reclaim that identity.³²³ After the Prophecy filed its mark, the Church attempted to protect its own identity by opposing the registration.³²⁴ The TTAB hardly dealt with the issue of the confusing similarity between the two organizations' identities and instead decided the case on priority grounds.³²⁵ By doing so, the court skirted the identity issue and tacitly affirmed the original identity of the Prophecy.

Interestingly, the TTAB's decision, though not focused on validity, does implicate the concepts discussed in this article. Specifically, it appears the TTAB used priority as a proxy for authenticity. In other words, the TTAB ruled in favor of the Prophecy because, apparently, it used its mark prior to the Church.³²⁶ While priority of a trademark is the closest method of approximating authenticity, this method illustrates the problem with using priority as a proxy: the first religious organization to use a mark in commerce will not always be the authentic religious organization embodying the true ideals of the religion. Many religious organizations may use their mark before the authentic organization uses the mark, thus leaving the authentic organization with no recourse under trademark law.

The TTAB faced a slightly different issue in *Stocker v. General Conference Corp. of Seventh-day Adventists*.³²⁷ Stocker, a current due-paying member of the General Conference Corporation of Seventh-day Adventists ("General Conference"), sought to cancel the General Conference's trademark, "Seventh-day Adventist."³²⁸ The General Conference was "a corporate entity established by the spiritual church to hold title to certain property, such as real estate and trademarks."³²⁹ Stocker also belonged to several independent congregations

³²¹ *Id.*

³²² *Id.* at *5–6.

³²³ *Id.* at *6.

³²⁴ *Id.* at *1, *5–6.

³²⁵ *Id.* at *16.

³²⁶ *Id.*

³²⁷ 39 U.S.P.Q.2d (BNA) 1385 (T.T.A.B. 1996).

³²⁸ *Id.* at 1386.

³²⁹ *Id.* at 1388–89.

with names that included “Seventh-day Adventist.”³³⁰ The General Conference had a trademark policy that restricted use of its trademarks to preserve its “good name.”³³¹ This case, the TTAB noted, “presents a twist” because this “suit [was] brought by members of a splinter group to cancel a trademark registration owned by the Mother Church.”³³² The issue of “genericness [was raised] as a sword rather than as a shield.”³³³ In other words, the defendant attempted to use genericness to undercut the plaintiff’s authenticity.

The identity of the General Conference was at stake. The TTAB engaged in a lengthy analysis as to the genericness argument,³³⁴ noting that “for a period of over 130 years, the primary significance of the designation ‘Seventh-day Adventist’ has been to identify the source or origin of religious publications and services emanating from respondent.”³³⁵ Additionally, the institution’s identity was entangled with its services, such as “its administration of churches, schools, hospitals, and colleges.”³³⁶ Therefore, the public viewed the General Conference’s mark as indicating all of the services and beliefs provided by the General Conference.³³⁷ Based on its analysis, the TTAB concluded that the term “Seventh-Day Adventist” was not generic.³³⁸

Like *Church of God, Stocker* implicitly dealt with identity. But unlike *Church of God*, where the court focused on priority as a proxy for authenticity,³³⁹ the *Stocker* court used secondary meaning as a proxy for authenticity.³⁴⁰ The Board relied on the plaintiff’s 130-year usage of the mark to conclude that the organization was not generic and thus authentic,³⁴¹ seemingly defying the traditional limitations of trademark law.

³³⁰ *Id.* at 1388.

³³¹ *Id.* at 1389.

³³² *Id.* at 1391 (alteration added).

³³³ *Id.* at 1393 (alteration added).

³³⁴ *Id.* at 1391–1398.

³³⁵ *Id.* at 1398.

³³⁶ *Id.*

³³⁷ *See id.* (“In every instance made of record, the relevant public is exposed to the registered mark, with the result that the primary significance of SEVENTH-DAY ADVENTIST to them is as an indicator of the source or origin of respondent’s various goods and/or services.”).

³³⁸ *Id.*

³³⁹ *See Church of God v. Church of God of Prophecy*, Opposition No. 94,180, 2000 TTAB LEXIS 338, *15–16 (T.T.A.B. May 18, 2000).

³⁴⁰ *See Stocker*, 39 U.S.P.Q.2d at 1398.

³⁴¹ *Id.*

Nonetheless, the Board's conclusion further shows the deficiencies trademark law has for religious organizations. Secondary meaning, like priority, may indicate which religious organization is authentic, but neither doctrine is designed to do so. It is entirely possible and probable that a religious organization could develop secondary meaning prior to the authentic religious group. Again, trademark law is dealing with problems and disputes it is not equipped to handle.

2. Revocation of Trademark Licenses

The redefinition of an organization can result in outcomes other than splinter groups. When a mother organization feels an affiliated organization threatens its identity, the mother organization will attempt to protect the authenticity of its identity by restricting the affiliated organization's use of the trademark. This reduces the attendant risks of trademark law, such as genericide, capture and battles over authenticity. A mother organization will typically feel threatened when the affiliated group adheres to beliefs the mother organization finds in conflict with its own beliefs. There are at least four different scenarios when this threat arises: (1) the mother organization redefines itself (consciously or unconsciously) while the affiliated organization does not, (2) the affiliated organization redefines its own ideology while the mother organization does not, (3) the mother organization views, incorrectly, the affiliated organization as practicing a religion different from the one represented by the mother organization's trademark or (4) the affiliated organization breaches the license with the mother organization, such as failing to make licensing fee payments. In any of these cases, the mother organization will attempt to control and protect its identity by revoking the trademark license or the group's formal affiliation.

In *Church of Scientology International v. Elmira Mission of the Church of Scientology*,³⁴² the Church of Scientology ("CS") had licensed the right to use its trademark to Elmira Mission of the Church of Scientology ("EM").³⁴³ At that time, CS had thirty-three churches and eighty missions in the United States and owned various trademarks.³⁴⁴ CS licensed the use of its trademarks to organizations, including EM, for ten percent of the organization's income.³⁴⁵ EM and CS had an agreeable relationship for six years, until September 9, 1982, when EM signed a new licensing agreement with CS requiring EM to pay fifteen percent

³⁴² 794 F.2d 38 (2d Cir. 1986).

³⁴³ *Id.* at 40.

³⁴⁴ *Id.*

³⁴⁵ *Id.*

of its income and other additional fees.³⁴⁶ After executing the agreement, EM renounced the license the following day and continued using the trademarks.³⁴⁷ Subsequently, CS sued for trademark infringement.³⁴⁸ Although CS filed suit primarily for monetary breach, the court aptly noted that religious organizations must have control over their trademarks to ensure the user portrays the proper message.³⁴⁹ The Second Circuit further explained that CS used licensing agreements to control and monitor its trademarks, which the court believed was necessary to regulate the theories being preached.³⁵⁰

The court found that CS had likely proven infringement and therefore remanded the case back to the district court “with a direction . . . to issue the preliminary injunction pending trial.”³⁵¹ The court’s explanation of the licensing arrangement between CS and EM illustrates how CS used trademarks to maintain its identity. The court stated that “[t]he Scientology Church . . . has always believed it critical to monitor the services provided by [the defendant] as a means of protecting its marks, and to dictate the standards by which [the defendant] preaches the Scientology faith.”³⁵² Indeed, the goal of the licensing agreement was to “monitor all operations . . . to insure [sic] compliance with all standards, specifications and guidelines.”³⁵³ Therefore, much of the court’s decision rested on the licensing agreement that granted power to CS to protect its perceived identity through the legally binding agreement.

The court specifically stated how the licensing agreement allowed it to avoid issues of religious identity: “[P]laintiffs did not need to prove that defendants had departed from the tenets of the religion to monitor their activities. The [plaintiffs’] ability at any time to insure [sic] compliance with the agreement and to control defendants’ activities was an integral part of the contract.”³⁵⁴ In other words, the licensing agreement avoided the problems religious organizations face in maintaining identity through trademarks. In particular, the

³⁴⁶ *Id.* at 40–41.

³⁴⁷ *Id.*

³⁴⁸ *Id.*

³⁴⁹ *See id.* at 43–44 (“Denying a preliminary injunction in this case—where the district court found a likelihood of confusion—puts the Church’s reputation beyond its own control. And, it is that loss of control which is the very thing that constitutes irreparable harm in the licensing context.”).

³⁵⁰ *Id.* at 43.

³⁵¹ *Id.* at 45.

³⁵² *Id.* at 43 (alterations added).

³⁵³ *Id.*

³⁵⁴ *Id.* at 43–44 (alterations added).

agreement avoids capture of the mark by a sister organization by providing the mother organization the ability to prevent *ex ante* generic and capturing uses of the trademark. Thus, the agreement prevents the mother organization from losing its identity to the sister organization using the mother organization's mark.

Likewise, the court in *Oklahoma District Council of the Assemblies of God of the State of Oklahoma, Inc. v. New Hope Assembly of God Church of Norman, Oklahoma, Inc.*,³⁵⁵ dealt with the same issue as the court in *Church of Scientology*. The Oklahoma District Council of the Assemblies of God ("Oklahoma Council") and its General Council had authorized New Hope Assembly of God Church of Norman's ("New Hope") to use "Assembly of God" in New Hope's name. Oklahoma Council allowed this provided that New Hope followed the General Council's constitution and by-laws.³⁵⁶ Eventually, Oklahoma Council decided that New Hope failed to follow its constitution and by-laws and revoked New Hope's right to use "Assembly of God" in its name.³⁵⁷ New Hope continued to use its name and Oklahoma Council sued for trademark infringement.³⁵⁸ In both the first and second appeals, the Oklahoma Supreme Court avoided most identity-implicating issues, instead focusing on unfair competition and First Amendment issues.³⁵⁹ Despite the court's avoidance of the identity-implicating issues, the Oklahoma Counsel was likely concerned with the risk of losing authenticity and having New Hope capture its identity.³⁶⁰

3. New and Separate Religious Group

While a social group may redefine itself in context as a result of social forces, sometimes these forces cause the formation of new groups. Within the religious context, a new group can threaten an existing group's identity if it presents itself in a manner that is confusingly similar to the existing group's trademark. To prevent the deterioration or destruction of its identity, a religious group will sue for trademark infringement.

³⁵⁵ *New Hope II*, 597 P.2d 1211 (Okla. 1979) (second appeal); *Oklahoma District Council of the Assemblies of God of the State v. New Hope Assembly of God Church of Norman, Inc.* (*New Hope I*), 548 P.2d 1029 (Okla. 1976) (first appeal).

³⁵⁶ *New Hope I*, 548 P.2d at 1030.

³⁵⁷ *New Hope II*, 597 P.2d at 1213; *New Hope I*, 548 P.2d at 1030.

³⁵⁸ *New Hope II*, 597 P.2d at 1213.

³⁵⁹ *Id.* at 1214–15; *New Hope I*, 548 P.2d at 1030–32.

³⁶⁰ *See New Hope II*, 597 P.2d at 1213.

In *Christian Science Board of Directors of the First Church of Christ, Scientist v. Robinson*,³⁶¹ defendant, David Robinson (“Robinson”), an active Christian Scientist, founded the University of Christian Science (“UCS”).³⁶² Robinson’s beliefs differed in significant respects from the plaintiff, the First Church of Christ, Scientist (“FCCS”).³⁶³ After Robinson founded the UCS, FCCS filed a trademark infringement claim alleging that the name of Robinson’s church was confusingly similar to FCCS.³⁶⁴

The trial court found for FCCS on the basis of preserving the organization’s identity.³⁶⁵ The trial court noted that “[t]he right to use the name inheres in the institution, not in its members; and, when they cease to be members of the institution, use by them of the name is misleading and, if injurious to the institution, should be enjoined.”³⁶⁶ The court also noted that this principle did not prohibit worship—it simply preserved the goodwill of religious organizations and prevented others from appropriating that goodwill.³⁶⁷ For these reasons, the trial court issued an injunction against UCS.³⁶⁸ Thus, *Robinson* represents a decision concerned with maintaining authenticity of the religious institution. The purpose of the court’s decision was to prevent others from using FCCS’s mark and thus perverting FCCS’s genuine identity. The court’s decision, however, still focused on the authenticity of FCCS’s identity as perceived by consumers,³⁶⁹ and not by FCCS. Therefore, trademark law does not address religious organizations’ fundamental concern: the authenticity of religious identity as perceived by the religious organization.

Authenticity is a common theme, and occasionally a court will allude to the necessity of preserving authenticity in the face of possible parody or misuse.

³⁶¹ 115 F. Supp. 2d 607 (W.D.N.C. 2000), *aff’d*, *Christian Science Bd. of Directors of the First Church of Christ, Scientist v. Nolan*, 259 F.3d 209 (4th Cir. 2001).

³⁶² *Nolan*, 259 F.3d at 212–13.

³⁶³ *Id.* at 212.

³⁶⁴ *Id.* at 213.

³⁶⁵ *Robinson*, 115 F. Supp. 2d at 611.

³⁶⁶ *Id.* at 610.

³⁶⁷ *See id.*

No question of religious liberty is involved. Men have the right to worship God according to the dictates of conscience; but they have no right in doing so to make use of a name which will enable them to appropriate the good will which has been built up by an organization with which they are no longer connected.

Id. (quoting *Purcell v. Summers*, 145 F.2d 979 (4th Cir. 1944)).

³⁶⁸ *Id.* at 612.

³⁶⁹ *Id.* at 611.

In *Board of Provincial Elders of the Southern Province of the Moravian Church v. Jones*,³⁷⁰ defendant, Jones, independently conducted services “under the name of The Bible Moravian Church in Forsyth County.”³⁷¹ The plaintiff, the Moravian Church, operated forty-seven churches all bearing the name Moravian.³⁷² Yet, Jones’s church was in no way affiliated with the Moravian Church.³⁷³ In assessing the case, the trial court emphasized the importance religious names play in religious identity and the possible adulteration of authenticity the organization might face from unauthorized use of its trademark.³⁷⁴ The court held that Jones could not use the Moravian Church’s name, noting that “the name of the Moravian Church is of great value, not only because of the business carried on and property held in that name, but also because thousands of members associate with the name the most sacred of their personal relationships in the holiest of their family traditions.”³⁷⁵ In doing so, it also highlighted the importance of religious identity because an organization without a coherent religious identity has little value, religious or otherwise, to protect. Courts can manipulate trademark law to partially yet inadequately accomplish goals not contemplated by trademark law. Even though one party cannot use the Moravian Church’s name, it may still become generic or its meaning may change.

4. Solicitation to Join a Religious Group and Denial of a Trademark License

Sometimes social forces produce new audiences or groups. A new religious group may arise seeking to affiliate itself with an existing religious group because it associates itself with that group’s religious identity. Problems can arise, however, when an existing religious group refuses admission to an applicant group, and the applicant group continues to use the existing trademark without permission. In other words, the applicant group wants to assume the identity of an already-existing religious group while the existing group concludes that the applicant group does not sufficiently embody its religious ideals. Nevertheless, the applicant group continues to use the trademark of the existing

³⁷⁰ 159 S.E.2d 545 (N.C. 1968).

³⁷¹ *Id.* at 547.

³⁷² *Id.*

³⁷³ *Id.*

³⁷⁴ *Id.*

³⁷⁵ *See id.* This quote also illustrates how Ali Kahn’s internal view of religion plays out in the court. Khan, *supra* note 92, at 631–32 (noting that the internal view perceives religion as sacred and inalienable).

group and thereby compromises the existing group's identity. In response to this threat, the existing group sues to maintain its identity.

That was precisely the fact scenario the Sixth Circuit confronted in *Sovereign Order of Saint John of Jerusalem, Inc. v. Grady*.³⁷⁶ The Sovereign Order of Saint John of Jerusalem ("Sovereign Order") dates back to the Crusades, but formally became a corporation in the United States in the 1950s.³⁷⁷ During the late 1950s, the Sovereign Order registered trademarks in its name and design, and subsequently renewed those marks in 1977.³⁷⁸ The Sovereign Order, in the capacity of the "supreme council," licensed its trademarks for use by other organizations.³⁷⁹ John L. Grady ("Grady") sought a license from the Sovereign Order in 1979 for "American Christian Church and Order," the religious organization he founded.³⁸⁰ The Sovereign Order denied Grady's request for a license "because of Dr. Grady's alleged participation in para-military and white supremacist groups, and the Corporation's board of directors expelled Grady from the Order in 1983."³⁸¹ Despite his expulsion and denial of a trademark license, Grady used the Sovereign Order's trademarks.³⁸² To protect their identity and the authenticity of their trademark, the Sovereign Order filed a trademark infringement action against Grady.³⁸³ The court's discussion of trademark law in this case focused on statutory construction of the Lanham Act, rather than issues of identity.³⁸⁴ The court decided the case in favor of the Sovereign Order.³⁸⁵

Grady shows us, yet again, how religious organizations' non-trademark motives spur their trademark lawsuits. When a religious organization feels that a third party threatens its religious authenticity, the religious organization will use trademark law—the only legal means it has—to prevent the adulteration or possible capture of its identity. In this case, the Sovereign Order thought that

³⁷⁶ 119 F.3d 1236 (6th Cir. 1997).

³⁷⁷ *Id.* at 1238.

³⁷⁸ *Id.* at 1239.

³⁷⁹ *Id.*

³⁸⁰ *Id.*

³⁸¹ *Id.*

³⁸² *Id.*

³⁸³ *Id.*

³⁸⁴ *See id.* at 1240–42 (discussing defenses that can be raised after a mark is declared incontestable; finding that, regardless of its conclusion on the issue, the defendant failed to raise any facts substantiating any of his defenses; and discussing the issue of fraudulent registration under the Lanham Act).

³⁸⁵ *See id.* at 1244 (prohibiting the "use by Grady of the registered collective membership trademark").

Grady's use of its trademark would corrupt its religious identity.³⁸⁶ The Sovereign Order's use of trademark law to litigate its identity, however, does not adequately address its problems. While trademark law was effective in this case, trademark law is not directed towards protecting religious authenticity or preventing the problem of capture.

5. Formation of a Mother Church

Different sects of a religious group also can disagree over their *collective* identity. In litigation, this situation arises when a new organization forms to unite all sister organizations, but one of the pre-existing sister organizations refuses to join and continues to use its own confusingly similar name. This was the exact situation that arose in *International Committee Young Women's Christian Ass'ns v. Young Women's Christian Ass'n of Chicago*.³⁸⁷ Delegates of various Young Women's Christian Associations met biennially at an "International Conference."³⁸⁸ At one conference, several delegates proposed an "Evangelical test" for future membership in the conference.³⁸⁹ The court stated the test as follows: "[I]n the future no association should be permitted representation in the conference unless its separate constitution should contain a provision making a prerequisite to voting and officeholding membership therein that they should be members in good standing of Evangelical churches."³⁹⁰

Several supporters of the Evangelical test continued to meet on their own for the purpose of organizing a central association in which no member association could belong unless it passed the Evangelical test.³⁹¹ During a conference in 1886, the various associations united to form the International Committee of Young Women's Christian Association ("International Association"), which was incorporated in 1891.³⁹² The organization of the International Association was formed based on a desire to implement the Evangelical test for future membership in the conference.³⁹³

³⁸⁶ See *id.* at 1239.

³⁸⁷ 194 Ill. 194 (1901).

³⁸⁸ *Id.* at 195–96.

³⁸⁹ *Id.* at 196.

³⁹⁰ *Id.* at 196–97.

³⁹¹ *Id.* at 197.

³⁹² *Id.*

³⁹³ *Id.* at 196–98 ("[T]he motive for the creation of the International Committee was brought about by the failure of the International Conference to adopt the resolution requiring the 'Evangelical test.'").

One group, the Young Women's Christian Association of Chicago ("Chicago Association"), which had existed since 1877, disagreed with the International Association's choice of name.³⁹⁴ As a result, the Chicago Association sought an injunction against the International Association based on deceptive and unfair business practices under state law.³⁹⁵

The court held that the International Association could not use the name it had selected.³⁹⁶ The court emphasized both the necessity to protect the Chicago Association's identity and the quest to prevent fraud upon the public.³⁹⁷ The court felt that the names of each association were so similar that the International Association's name "would [incorrectly] indicate to the public that it was the representative of [the Chicago Association] and the conference with which [the Chicago Association] is affiliated."³⁹⁸ Additionally, it appeared clear to the court that the International Association used its chosen name for the purpose of subsuming the identity of the Chicago Association.³⁹⁹ Indeed, the court did not base its decision on whether the mark was generic or descriptive.⁴⁰⁰ Finally, the court enjoined the International Association from using the name "International Committee of Young Women's Christian Association."⁴⁰¹

The YWCA decision is seemingly more attuned to the issue of identity than other recent cases. Yet, the decision reflects fundamental principles of secular law, devoted wholly to consumer perception. The court centered on the possible association *consumers* might make between unrelated groups.⁴⁰² Such focus is entirely deficient for an organization seeking to protect the collective identity its trademarks embody. A consumer-centric position fails to account

³⁹⁴ *Id.* at 196–97.

³⁹⁵ *Id.* at 195.

³⁹⁶ *Id.* at 198.

³⁹⁷ *Id.*

³⁹⁸ *Id.* (alterations added).

³⁹⁹ *See id.* at 199. Here, the court stated:

[F]rom an examination of the entire record it clearly appears that such name was adopted by the appellant advisedly and for the purpose of leading the general public, and the persons with whom it was likely to be associated, and from whom it hoped and expected to obtain support by way of donations, to believe that it stood as the committee and representative of the associations known as 'The Young Women's Christian Association,' then organized in the field where it expected to operate.

Id.

⁴⁰⁰ *Id.*

⁴⁰¹ *Id.* at 201.

⁴⁰² *Id.* at 198.

for the beliefs and values that the religious organization perceives itself as practicing, or actually practices. Remember the actual-perception problem of truth: trademark law focuses on what consumers perceive to be true of the organization, not what is actually true. This approach illustrates how trademark law falls short in protecting religious identity.

A similar situation occurred in *Lutheran Free Church v. Lutheran Free Church (not merged)*.⁴⁰³ From 1897 until 1963, The Lutheran Free Church (“LFC”) consisted of an unincorporated association of Lutheran congregations.⁴⁰⁴ In 1961, however, more than two-thirds of the LFC congregations voted to merge with The American Lutheran Church (“ALC”).⁴⁰⁵ In response, the congregations that opposed the merger formed The Lutheran Free Church (not merged) (“NM”), and used this name after the merger between LFC and ALC.⁴⁰⁶

In analyzing the case, the court first focused on any possible shift in the LFC’s identity caused by the merger. In doing so, the court examined the doctrinal similarities between ALC and the LFC.⁴⁰⁷ It found that “[t]he doctrinal beliefs of The Lutheran Free Church and The American Lutheran Church are identical.”⁴⁰⁸ Indeed, the name of the “association [was] comprised of all its congregations adhering to the beliefs set forth therein.”⁴⁰⁹ Satisfied that no ideological confusion would result from the merger, the court summarily stated that “[n]either by the merger with The American Lutheran Church, nor by any action prior or subsequent thereto, have the rights of plaintiffs in the use of the name ‘The Lutheran Free Church’ been surrendered or abandoned.”⁴¹⁰ The court was careful to note that the “the exact nature of the new association and its precise doctrinal basis are not fully disclosed by the evidence.”⁴¹¹ As a result, the court engaged in a common-law analysis and concluded that NM could not use its name because it would likely result in confusion.⁴¹²

As usual, the court in *Lutheran Free* could not settle the true identity dispute underlying the trademark controversy. This case is unique since the

⁴⁰³ 141 N.W.2d 827 (Minn. 1966).

⁴⁰⁴ *Id.* at 830.

⁴⁰⁵ *Id.* at 831.

⁴⁰⁶ *Id.*

⁴⁰⁷ *Id.*

⁴⁰⁸ *Id.*

⁴⁰⁹ *Id.* at 833 (alteration added).

⁴¹⁰ *Id.* at 831.

⁴¹¹ *Id.* at 834.

⁴¹² *Id.*

court explicitly ventured into questions of religious doctrine, even quoting the “Fundamental Principles” and “Rules of Work” of the LFC.⁴¹³ It appears that this inquiry was directed primarily at discerning the authenticity of the LFC’s religious doctrine upon its merger with ALC. It seems the court engaged in this discussion to show that the merger did not compromise either the LFC or ALC’s religious identity and authenticity. Nevertheless, the court did not—indeed, could not—base its decision on its findings of fidelity to particular religious beliefs with respect to NM. Instead, the court had to rely on common law principles to find that NM would result in confusion with LFC. Thus, *Lutheran Free* shows again how a court may understand a dispute as purely religious but decide the case, as the law compels it be decided, on secular principles.

C. Religiously-Motivated Groups and Groups Critical of its Ideology

In addition to groups with diametrically opposed ideologies or groups with similar ideologies but fundamental differences, litigation may ensue when one group, religious or not, criticizes another religiously-motivated group. Such litigation arises because religiously-motivated groups are threatened by almost any unauthorized use of their trademarks. Even when the organization using the trademark is not religious, that organization’s use threatens the religious organization’s identity. The religious organization loses control over the meaning of the trademark through the unauthorized organization’s use of the trademark. This unauthorized use alters the public’s perception of the mark. This subsection is devoted to the instance where a group projects or disseminates a message critical of the mother organization’s ideology or doctrine. This message poses an obstacle for any religion seeking to maintain its uniform identity.

*Jews for Jesus v. Brodsky*⁴¹⁴ presented such a scenario. Jews for Jesus (“JJ”) was an organization that espoused the view that “Jesus is the Messiah of Israel and the Savior of the World; its mission includes advocacy, education and religious camaraderie for both Gentiles and Jews.”⁴¹⁵ JJ was well organized and had a website with the domain name “jews-for-jesus.org.”⁴¹⁶ Brodsky, the defendant, was a professional Internet developer who disagreed strongly with JJ’s message.⁴¹⁷ In an attempt to criticize JJ, Brodsky established his own website with the domain name, “jewsforjesus.org,” which discredited the JJ organization

⁴¹³ *Id.* at 831–32.

⁴¹⁴ 993 F. Supp. 282 (D.N.J. 1998).

⁴¹⁵ *Id.* at 288.

⁴¹⁶ *Id.* at 290.

⁴¹⁷ *Id.*

and its message.⁴¹⁸ In response to this critical message and potentially misleading website, JJ filed a complaint alleging that Brodsky infringed its federal and state trademark rights.⁴¹⁹

Rather than emphasizing the importance of JJ's identity, the *Brodsky* court adhered to a trademark infringement analysis, finding that consumers were likely confused by Brodsky's mark.⁴²⁰ The court noted Brodsky's bad-faith motive in registering his mark; however, when analyzing the likelihood of confusion, the court observed that "[Brodsky] ha[d] created, in his words, a 'bogus 'Jews for Jesus'' site intended to intercept, through the use of deceit and trickery, the audience sought by the Plaintiff Organization."⁴²¹ Brodsky himself stated his goal was "to intercept potential converts."⁴²² Essentially, Brodsky tried to assume JJ's identity by "conveying the impression to Internet users that the Plaintiff Organization is the sponsor of the Defendant Internet site."⁴²³

Under its common law unfair competition analysis, the court noted the important role trademarks play in maintaining organizational authenticity: "A party's 'mark is his authentic seal; by it he vouches for the goods which bear it; it carries his name for good or ill.'"⁴²⁴ In the case of misappropriation, "the offending party is using the reputation of the trademark owner for self gain."⁴²⁵

Additionally, the court engaged in a dilution analysis.⁴²⁶ First, the court found that the mark was famous because of its wide publication and use, noting its appearance in the media for more than twenty-four years.⁴²⁷ The court then found that Brodsky's mark diluted JJ's mark because Brodsky's disparaging messages both tarnished and blurred the mark.⁴²⁸ The tarnishment and blurring resulted from Brodsky's unauthorized use of his mark, which degraded and de-

⁴¹⁸ *Id.* at 290–91.

⁴¹⁹ *Id.* at 287.

⁴²⁰ *Id.* at 304.

⁴²¹ *Id.* at 308 (alterations added).

⁴²² *Id.* at 304.

⁴²³ *Id.* at 308.

⁴²⁴ *Id.* at 311 (quoting *Opticians Ass'n of Am. v. Indep. Opticians of Am.*, 920 F.2d, 187, 195 (3d Cir. 1990) (quoting *Ambassador E., Inc. v. Orsatti, Inc.*, 257 F.2d 79, 82 (3d Cir. 1958))).

⁴²⁵ *Id.*

⁴²⁶ *Id.* at 304–08.

⁴²⁷ *Id.* at 306.

⁴²⁸ *Id.* at 307.

stroyed the strength of JJ's mark.⁴²⁹ In the end, the court granted an order to show cause why an injunction should not be granted against Brodsky.⁴³⁰

Brodsky presents a rich illustration of many concepts delineated in Part I of this article. The essence of this case evokes Kahn's internal view of religion.⁴³¹ JJ's goal was to squelch any criticism of its religion. Much like Kahn, JJ viewed its religion as something sacred and free from any appropriation or criticism by others. But trademark law does not view religion in its sacred form; it provides protection only through causes of action such as dilution.

Brodsky also represents a unique situation of capture. Brodsky's goal was not to capture the theological aspect of JJ and use it as his own, but rather to capture the physical aspect of its religion, meaning potential members, and then discredit the religion.⁴³² This situation represents a threat to religion other cases do not illustrate. Brodsky also threatened JJ's authenticity by seeking to disparage and denigrate JJ's authenticity.

The *Brodsky* court resolved this claim under trademark law, specifically under a dilution cause of action, finding that Brodsky had diluted JJ's mark.⁴³³ Thus, this case marks a victory of sorts for religious organizations. JJ successfully protected its mark from capture and the adulteration of its authenticity by using dilution to protect its internal view of religion.

III. FUTURE PROTECTION FOR RELIGIOUS ORGANIZATIONS

The previous two sections have shown that trademarks are cultural symbols, that religious organizations use trademarks to protect identity and that trademark law may allow religious organizations to protect themselves against some potential risks. Although trademark law's focus on consumer perception accounts for the nature of cultural symbols, it cannot wholly protect religious identity from appropriation. Concepts like the actual-perception problem of truth, the problem of capture, parody and the limited possibilities for enforcement all illustrate that trademark law does not protect religious identity to the extent that religious organizations desire. Trademark law's focus on the consumer necessarily compromises the religious organization's goal of protecting its identity, or more precisely, the authenticity of its identity.

⁴²⁹ *Id.*

⁴³⁰ *Id.* at 313.

⁴³¹ See Khan, *supra* note 92, at 631–32 (noting that the internal view perceives religion as sacred and inalienable).

⁴³² *Brodsky*, 993 F. Supp. at 304–08.

⁴³³ *Id.* at 307.

The question then arises: Should trademark law be the tool that religious organizations use to protect their identities? The answer depends on how much emphasis one places on the value of religious names or the authenticity of religion. Those, like Coombe and Kahn, who value cultural knowledge as inalienable intellectual property,⁴³⁴ would answer the question differently than those who place a lower value on religious authenticity.

This article assumes that trademark law currently provides an inadequate system for protecting religious identity and a new system should be developed to resolve disputes over religious identities. Nevertheless, this article acknowledges that, to some extent, trademark law provides a means of protection for religious organizations seeking to guard their identities.

Because of its intellectual and theoretical proximity to trademark law, this article uses the Uniform Domain Name Dispute Resolution Policy (“UDRP”) as a model for developing a system for resolving religious disputes. Subsection A describes the UDRP and its success. Subsection B shows how specific features of the UDRP could be changed or eliminated to adapt the UDRP to work in the context of religious disputes over the authenticity of religious names. Finally, this article attempts to outline potential changes that would allow for a model policy to resolve religious-identity disputes.

A. The Uniform Domain Name Dispute Resolution Policy: A Short Conspectus

Trademark law seems to be an unlikely place to look for a model for resolving religious disputes. But the UDRP, developed by ICANN, is an existing framework for non-judicial resolution of trademark cybersquatting disputes. ICANN is a non-profit organization “dedicated to preserving the operational stability of the Internet; to promoting competition; to achieving broad representation of global Internet communities; and to developing policy appropriate to its mission through bottom-up, consensus-based processes.”⁴³⁵ In an effort to fulfill this objective, ICANN developed the UDRP, which “is a policy between a registrar and its customer and is included in registration agreements for all ICANN-accredited registrars.”⁴³⁶ The policy aims to solve domain name dis-

⁴³⁴ See *supra* Parts I(A)–(B) (discussing the theories of Coombe and Khan).

⁴³⁵ Internet Corporation for Assigned Names and Numbers, ICANN Factsheet, <http://www.icann.org/en/factsheets/fact-sheet.html> (last visited Feb. 2, 2009).

⁴³⁶ Internet Corporation for Assigned Names and Numbers, Domain Name Dispute Resolution Policies, <http://www.icann.org/en/udrp/#udrp> (last visited Feb. 2, 2009) [hereinafter UDRP Policies].

putes through private action.⁴³⁷ The policy is akin to an arbitration agreed to by private contract, rather than by judicial proceeding. Disputes are settled through an administrative proceeding, conducted by a provider selected by the complainant and sometimes the respondent.⁴³⁸ The presiding administrative officers have the power only “to requir[e] the cancellation of your domain name or the transfer of your domain name registration to the complainant.”⁴³⁹

The UDRP has been successful in resolving disputes between domain name providers and registrants over domain names.⁴⁴⁰ As of 2004, the UDRP was used in over 13,000 cases, over 8,000 of which had been mediated before the World Intellectual Property Organization (“WIPO”) Arbitration and Mediation Center (the “Center”).⁴⁴¹ Today, the Center is recognized as the leading dispute resolution forum for UDRP cases, administering over 29,000 proceedings since 1999.⁴⁴²

B. An Alternative Solution: Binding Religious Resolution

The UDRP’s success and its general applicability have great intrigue. Indeed, the same type of procedure could be valuable to religious organizations seeking to protect their identities. It could resolve religious disputes, instead of disputes over the ownership of domain names. It also could be less time-consuming and costly than legal battles.⁴⁴³ Obviously, the UDRP cannot be transplanted to the religious context verbatim if the goal is to protect religious organizations’ identities in a manner different from trademark law. The changes made to the policy would not be extreme, and in some cases, only mere adaptations might be needed. Other times, reworking language might be necessary; however, the purpose of this article is to show how the UDRP framework can be used to protect religious identity in a way trademark law cannot. For this rea-

⁴³⁷ *Id.*

⁴³⁸ UDRP, *supra* note 1, at paras. 4(a), 4(d).

⁴³⁹ *Id.* at para. 4(i) (alteration added).

⁴⁴⁰ Nicholas Smith & Erik Wilbers, *The UDRP: Design Elements of an Effective ADR Mechanism*, 15 AM. REV. INT’L ARB. 215, 215 (2004).

⁴⁴¹ *Id.* at 216.

⁴⁴² World Intellectual Property Organization, Domain Name Dispute Resolution Resources, <http://www.wipo.int/amc/en/domains/resources/index.html> (last visited Feb. 2, 2009).

⁴⁴³ *See* Smith & Wilbers, *supra* note 440, at 215 (“The [UDRP] provid[es] low-cost alternative means of resolving disputes involving bad faith registration of trademarks or variations thereof as Internet domain names.” (alterations added)).

son, this article does not explore whether the criticisms of the UDRP⁴⁴⁴ have merit, or whether those criticisms would apply to a religious formulation of the UDRP. This article will deal with certain criticisms to the extent that they are necessary to illustrate the ability to adapt the UDRP to the religious arena.

In sum, this subsection will demonstrate that a dispute resolution forum devoted purely to disputes over religious identity is possible and, in fact, may be more desirable than judicial resolution of such disputes. This religious dispute resolution policy will be referred to as the Religious Arbitration Policy (“RAP”). The following analysis will concentrate on the provisions of the UDRP that may present obstacles for the RAP. This section is meant to provide a discussion upon which others can build.

1. Binding the Parties with the RAP: Contractual Formation

The first issue is how to incentivize parties to agree to the RAP. The UDRP is a policy used by domain-name registrars to settle disputes.⁴⁴⁵ Registrars require the individual or corporation registering the domain name to submit to the UDRP upon registration of a domain name.⁴⁴⁶ Thus, the enforcement rights of the UDRP are derived from the contract between the two parties. The policy alone has no enforcement value.

How this contract would be formed in a religious dispute is an open question. Indeed, one of the problems with this approach is that parties in religious disputes may have no relationship to a particular church. Unlike domain names, individuals can start their own church or synagogue without a private registry—unless the organization registers for a domain name. This section briefly examines some of the ways in which parties can be induced into agreements using incentives.

First, tax-exempt status could be used as an incentive to induce religious groups to agree to an arbitration clause. A church may register as a non-profit

⁴⁴⁴ See, e.g., Michael Geist, *Fair.com?: An Examination of the Allegations of Systemic Unfairness in the ICANN UDRP*, 27 BROOK. J. INT’L L. 903, 904–10 (2002) (discussing the unfairness of domain name dispute resolution under the UDRP); Patrick D. Kelley, *Emerging Patterns in Arbitration Under the Uniform Domain-Name Dispute-Resolution Policy*, 17 BERKELEY TECH. L. J. 181, 185–94 (2002) (highlighting criticism that the UDRP is biased in favor of trademark holders, and that prior UDRP decisions are used improperly by panels to guide decisions even though those prior decisions are not binding precedent).

⁴⁴⁵ UDRP, *supra* note 1, at para. 4 (discussing mandatory administrative proceedings).

⁴⁴⁶ *Id.* at para. 2.

organization under state law.⁴⁴⁷ Because of First Amendment concerns, the judiciary cannot decide ecclesiastical matters.⁴⁴⁸ Thus, a state probably could not incorporate a RAP arbitration agreement into the application for the registration of a religious non-profit organization. A similar impediment prevents incorporating a comparable agreement into the application to register a trademark. That being said, the First Amendment's Establishment Clause does not prohibit a *private* arrangement of this type.⁴⁴⁹

Second, state certification to perform briss or marriage ceremonies could induce individuals or corporations to register with the state or particular body that requires consent to the RAP. Without the ability to perform marriages or other ceremonies with government approval, religious organizations would have to forgo important functions. The tumult over gay marriage⁴⁵⁰ indicates

⁴⁴⁷ This incentive, however, does not cover organizations that choose not to register for tax-exempt status.

⁴⁴⁸ See, e.g., *Okla. Dist. Council of Assemblies of God of the State v. New Hope Assembly of God Church of Norman, Inc.*, 548 P.2d 1029, 1030–31 (noting that only “in the most limited of circumstances” will the court resolve controversies involving religious “doctrine or precepts”); *Serbian Eastern Orthodox Diocese for United States and Canada v. Millivojevich*, 426 U.S. 696, 710–13 (1976) (holding that the First Amendment prohibits courts from deciding ecclesiastical law matters and noting that, in this case, the First Amendment prohibited “analyz[ing] whether the ecclesiastical actions of a church judicatory are in that sense ‘arbitrary’ [because it] must inherently entail inquiry into the procedures that canon or ecclesiastical law supposedly requires the church judicatory to follow, or else in to the substantive criteria by which they are supposedly to decide the ecclesiastical question” (alterations added)). For an argument against this view, see Jared A. Goldstein, *Is There a “Religious Question” Doctrine? Judicial Authority to Examine Religious Practices and Beliefs*, 74. CATH. U. L. REV. 497, 525–34 (2005) (arguing that an absolute prohibition on judicial resolution of religious issues is a myth and is imprudent).

⁴⁴⁹ Courts have held contracts unenforceable because they contain religious terms. For example, in *Elmora Hebrew Center, Inc. v. Fishman*, 593 A.2d 725, 727, 730 (N.J. 1991), the court held a contract unenforceable because it could not construe the phrase “perform all normal rabbinical duties incumbent upon a Rabbi of a traditional Jewish Congregation.” Contracts that require the parties to submit to the jurisdiction of a non-governmental body do not contain such terms; thus, the enforceability of these contracts is an open question. In light of the fact that “civil courts can accept the authority of a recognized religious body in resolving a particular doctrinal question,” *id.* at 729, this type of agreement may actually promote the goals of the First Amendment, especially since courts have stated that religious decisions *should be* referred to a religious body. E.g., *id.* at 730 (“Similarly, in disputes involving a church with a congregational structure, courts should defer to resolutions by a majority (or other appropriate subgroup) of the church’s governing body.”).

⁴⁵⁰ Bonnie Goldstein, *Mormons for Traditional Marriage!*, SLATE, Nov. 6, 2008, <http://www.slate.com/id/2204000/> (last visited Feb. 14, 2009) (discussing Mormon opposition to California’s Proposition 8); Steven Waldman, *A Common Missed Conception: Why*

that marriage is important to some religious organizations. To these organizations, the ability to conduct marriage ceremonies could be a strong incentive to agree to the RAP.

A third option might use criminal law to induce compliance. In other words, a sovereign could make it illegal to operate a religious institution that functions on a certain budget, such as an institution operating as a corporation. This, however, would net only the larger religious organizations. Once again, this raises certain First Amendment constitutional questions in the United States, and it raises legal questions internationally.⁴⁵¹

2. Uniform and Universal Application

The next major issue is whether the RAP should be applied universally and uniformly. The UDRP applies to all Top Level Domains (“TLDs”), such as “.org,” “.com” and “.net.”⁴⁵² In other words, no matter what domain name the registrant uses, the contractual agreement applies. This aspect of the agreement makes dispute resolution extremely efficient because it “ensures that the UDRP can be invoked against all domain name holders, at any time, regardless of the identity and location of the domain name holder.”⁴⁵³ The UDRP also removes jurisdictional constraints, allowing complainants to resolve a dispute without worrying about the application of different territorial laws.⁴⁵⁴

The RAP presents unique challenges that the UDRP need not address. Unlike domain names, religious organizations do not possess universal or unifying characteristics among all religious organizations that make them amenable to a dispute-resolution system. A religion’s underlying system of belief may invoke ecclesiastical laws unfamiliar to one religion, but familiar to another. Finding a common thread between various religious beliefs seems to present a major problem for the RAP. This problem is not present under the UDRP, which is able to capture all domain name registrants under TLDs, thus requiring parties to submit to arbitration before a panel. Under the UDRP, the complainant must prove all of the following elements:

Religious People are Against Gay Marriage, SLATE, Nov. 19, 2003, <http://www.slate.com/id/2091413/> (last visited Feb. 3, 2009).

⁴⁵¹ See *supra* note 448 (discussing the court’s extreme hesitation in religious controversies involving religious doctrine).

⁴⁵² Smith & Wilbers, *supra* note 440, at 217.

⁴⁵³ *Id.*

⁴⁵⁴ *Id.* at 217–18.

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- (i) [the domain-name holder's] domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (ii) [the domain-name holder has] no rights or legitimate interests in respect of the domain name; and
- (iii) [the domain-name holder's] domain name has been registered and is being used in bad faith.⁴⁵⁵

These elements are similar to, but different from, the likelihood-of-confusion standard for trademark infringement.⁴⁵⁶ As previously illustrated, there are shortcomings to this approach, as religions seek to protect more than just a name. To protect a religious identity, different elements of proof must be established.

Since religious identity is often intertwined with beliefs, the RAP must include a requirement that the complainant's beliefs are different from the responding party's beliefs. Next, the complainant's beliefs must be authentic, meaning that the complainant's beliefs are the true beliefs associated with the name that the complainant employs. Third, the names must be similar. Although confusing similarity may be the appropriate standard, it need not be the one employed. An ecclesiastically-associated standard, for example, might be more appropriate. This standard might require that a reasonable person well versed in the religion or religions at issue would assume affiliation between the organizations. Finally, the RAP should require that the complainant establish an injury as a result of the respondent's actions.

This scheme is not a perfect proposal. Instead, it illustrates the considerations needed to adapt the UDRP to the context of disputes over religious identity. While it is possible to adapt the elements needed to prove a claim under the UDRP to a religious context, this alternative scheme may provide a more accurate and focused inquiry into the religious dispute.

Under the UDRP, the ability to impose "uniform, mandatory dispute settlement rules" on all parties eliminates "the ability of registrants to opt out of UDRP dispute settlement proceedings or to tailor the system to their needs."⁴⁵⁷ Similarly, the RAP would function as a uniform system administered by an in-

⁴⁵⁵ UDRP, *supra* note 1, at paras. 4(a)(i)–(iii) (alterations added).

⁴⁵⁶ Although it concerns the Anticybersquatting Consumer Protection Act (ACPA) and not the UDRP, *Sporty's Farm L.L.C. v. Sportsman's Market, Inc.*, 202 F.3d 489, 497 n.11, 498 (2d Cir. 2000) notes the difference between the "identical to and confusingly similar" standard of the ACPA and the likelihood-of-confusion standard of the Lanham Act.

⁴⁵⁷ Laurence R. Helfer & Graeme B. Dinwoodie, *Designing Non-National Systems: The Case of the Uniform Domain Name Dispute Resolution Policy*, 43 WM. & MARY L. REV. 141, 199 (2001).

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dependent third party, thus enhancing its effectiveness in resolving disputes over religious identity provided that the procedures are fair and effectuate the purposes of the RAP.⁴⁵⁸ Thus, the RAP would be an appropriate mechanism to resolve disputes over religious identities.

3. Court Option

The RAP must jettison the option that allows parties under the UDRP to resolve their dispute in court. Under the UDRP, either party—the complainant or the respondent—has the option of seeking redress in the courts after the UDRP proceeding.⁴⁵⁹ The UDRP has been criticized for this provision because many parties face jurisdictional and other obstacles to filing suit after losing a dispute under the UDRP.⁴⁶⁰ Such criticism would hold true if the RAP applied internationally, but it would be irrelevant if the RAP were implemented only in the United States.

The court option could not be maintained under the RAP. The purpose of the RAP is to resolve disputes that trademark law cannot adequately resolve, such as the authenticity of a religion's identity or disputes that the U.S. Constitution prohibits the courts from resolving.⁴⁶¹ For this reason, the RAP should not contain a court option.

Nevertheless, it would be beneficial to have a non-governmental oversight body, such as an oversight body internal to the RAP. While the UDRP does provide for judicial oversight, the purposes of the UDRP probably do not require one. The drafters “designed the UDRP as a soft-law system that supplements but does not supplant national court adjudication of domain names disputes.”⁴⁶² The RAP, by contrast, is intended to supplant the legal system. The RAP would provide a forum to hear and resolve disputes that the courts cannot or were not designed to address. For this reason, a body that can review panel decisions is essential. The depth of review and the activity of the reviewing body are issues outside the scope of this article. Nonetheless, stronger internal controls, perhaps in the form of an administrative review body or appellate tribunals, should be used under the RAP because, unlike the UDRP, the RAP is meant to resolve disputes finally.

⁴⁵⁸ See *id.* at 200–01 (noting that fair balancing of domain-name registrants and trademark owners is required for a legitimate alternative dispute resolution mechanism).

⁴⁵⁹ UDRP, *supra* note 1, at para. 4(k).

⁴⁶⁰ Kelley, *supra* note 444, at 191.

⁴⁶¹ See *supra* note 448.

⁴⁶² Helfer & Dinwoodie, *supra* note 457, at 203.

Additionally, under the UDRP, respondents may lack an incentive to contest disputes before an organization like WIPO because complainants are more likely to prevail in UDRP proceedings. A legitimate federal law remedy, such as the Anticybersquatting Consumer Protection Act (“ACPA”), also discourages appearances before WIPO.⁴⁶³ The ACPA amended the Lanham Act because then “[c]urrent law d[id] not expressly prohibit the act of cybersquatting.”⁴⁶⁴ Congress designed the ACPA

to protect consumers, promote the continued growth of electronic commerce, and protect the goodwill of American businesses . . . [by] clarify[ing] the rights of trademark owners with respect to bad faith, abusive domain name registration practices, [by] provid[ing] clear deterrence to prevent bad faith and abusive conduct, and [by] provid[ing] adequate remedies for trademark owners in those cases where it does occur.⁴⁶⁵

The ACPA, however, provides a remedy in court.⁴⁶⁶ Alleged cybersquatters might have more success in court than under the UDRP. Thus, there should not be a court option under the RAP since there would be less incentive to litigate under the RAP if a decision could be appealed to court.

Lastly, the RAP should have strict internal checks since the RAP and its administrative bodies will function as an independent legal system rather than as a standard Alternative Dispute Resolution (“ADR”) forum. Because the RAP will provide an appeals process, the problems created by the lack of internal controls under the UDRP⁴⁶⁷ will not exist. Minimally, the RAP will require a well-reasoned decision according to principles articulated by an administrative body and an appeals process. Maintaining “permanent” panelists may be beneficial because they could devote more time to disputes than typical panelists

⁴⁶³ Anticybersquatting Consumer Protection Act, Pub. L. 106-113, 113 Stat. 1501A-545 (codified as 15 U.S.C. § 1125(d)(1)(A) (1999)); Kelley, *supra* note 444, at 186.

⁴⁶⁴ ORRIN HATCH, THE ANTI-CYBERSQUATTING CONSUMER PROTECTION ACT, S. REP. NO. 106-140, at 7 (1999) (alterations added).

⁴⁶⁵ *Id.* at 7–8 (alterations added).

⁴⁶⁶ *See* 15 U.S.C. § 1125(d)(1)(A).

⁴⁶⁷ Helfer & Dinwoodie, *supra* note 457, at 232.

The lack of any appeal process within the UDRP makes the need for a deliberative approach to decision making particularly acute. Although some observers have criticized ICANN’s failure to include such an appellate mechanism to resolve interpretive differences among panel rulings, dispute settlement systems can create coherent jurisprudence without an appeals body or a doctrine of binding precedent.

Id.

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under the UDRP.⁴⁶⁸ Strong internal checks also may allow the RAP to take advantage of the New York Convention (“Convention”), which recognizes arbitration decisions in countries that have adopted the Convention.⁴⁶⁹

4. Complainant Pays

Under the UDRP, the complainant generally pays the entire costs of the proceeding.⁴⁷⁰ The rationale behind this policy is that it would be difficult to force unwilling parties in different countries to pay.⁴⁷¹ This rationale applies with less force under the RAP, which would apply only to institutions within the United States. The party asserting inauthentic use should bear the cost of the proceeding since it may initiate proceedings against as many individuals that it deems to be infringing its religious identity. Indeed, an alleged inauthentic user may be acting in “good faith” or may not be liable for inauthentic use. Conversely, the inauthentic user may be liable for acting in bad faith or may be using inauthentic names to undermine the authentic user’s identity.

Religious names, however, present a different problem than cybersquatters’ domain-names. In some instances, the alleged inauthentic use will be concerned with a confusingly similar name, in other cases it will not. But the primary inquiry when assessing inauthentic use is whether the user is authentic, not whether the name of the group the user employs is confusingly similar to the complainant’s name.⁴⁷² A complainant under the RAP will have to initiate actions against any and all groups using a name that sounds similar since each proceeding would decide the respective rights of the parties and not the parties’ rights against the world. In other words, the complainant could establish possession of the authentic beliefs embodied by its name, but not ownership of those beliefs. Since initiating complaints might be expensive, it may be unfair

⁴⁶⁸ *Id.* at 231.

⁴⁶⁹ Convention on the Recognition and Enforcement of Foreign Arbitral Awards art. X, Jun. 10, 1958, 330 U.N.T.S. 38, available at http://www.uncitral.org/pdf/english/texts/arbitration/NY-conv/XXII_1_e.pdf (last visited Feb. 9, 2009). For a case involving the Convention and some potential obstacles, see *Telecordia Tech, Inc. v. Telkom SA, L.T.D.*, 458 F.3d 172 (3d Cir. 2006) (discussing issues such as issue preclusion, personal and subject matter jurisdiction, and Article VI of the Convention).

⁴⁷⁰ UDRP, *supra* note 1, at para. 4(g).

⁴⁷¹ Smith & Wilbers, *supra* note 440, at 219.

⁴⁷² However, “confusing similarity” or a similar standard, may still be relevant. Almost every dispute focuses on the name used by the allegedly inauthentic party because religious organizations often feel threatened when a third party represents itself as the authentic religious organization. This is difficult without using a similar name.

to make only the respondent pay. Therefore, the RAP should impose costs on both parties.⁴⁷³

5. No Legal Representation Required

The UDRP does not require either party to a dispute to obtain legal counsel.⁴⁷⁴ The purpose is to facilitate the use of the UDRP as a true alternative to litigation.⁴⁷⁵ Similarly, the RAP should not require legal representation. The purpose of the RAP is to provide a forum in which religious parties can settle religious disputes without having to resort to a potentially inadequate judicial resolution of the dispute. Although lawyers should be able to advocate for their clients at RAP proceedings, requiring lawyers would undermine the purposes of the RAP.

6. Remedies

The UDRP limits the complainant's remedy "to requiring the cancellation of [the respondent's] domain name or the transfer of [the respondent's] domain name registration to the complainant."⁴⁷⁶ Under the RAP, a similar provision might be considered to limit the remedies available to the complainant. These remedies may include an order preventing the respondent from using the religious names, an order declaring the complainant the true religion, or an order requiring the respondent to disseminate the fact that it is not the true religion and stating that the complainant is the true religion.⁴⁷⁷

Whatever the appropriate remedy, its purpose is to force the losing party to stop using the name and to declare the winning party the true religion. Thus, the focus of these non-judicial proceedings is to resolve religious disputes over identity and authenticity of the religion. Any remedy provided should effectuate these purposes.

One crucial remedial difference between the UDRP and the RAP should be highlighted. Under the UDRP, the registrar, a party to the original contract,

⁴⁷³ How the cost between the parties should be divided is not considered in this article.

⁴⁷⁴ Smith & Wilbers, *supra* note 440, at 220.

⁴⁷⁵ *Id.*

⁴⁷⁶ UDRP, *supra* note 1, at para. 4(i) (alterations added).

⁴⁷⁷ This remedy is analogous to "corrective advertising" orders in false advertising cases. *See generally* Highmark, Inc. v. UPMC Health Plan, 276 F.3d 160, 165, 174 (3d Cir. 2001) (affirming district court's injunctive relief mandating corrective advertising); Rhone-Poulenc Rorer Pharm. v. Marion Merrell Dow, 93 F.3d 511, 514–16 (8th Cir. 1996) (discussing corrective advertising and when it is appropriate).

enforces the decision of the administrative panel.⁴⁷⁸ Under the RAP, the panel's decision will have to be enforced by a third party. This third party likely will have to be an independent organization, like ICANN, that can develop policies and procedures for enforcing remedies against the respondent.

7. Composition and Selection of Panel

The UDRP requires the parties to submit their dispute to a panel, the members of which the parties may select from an ICANN-approved provider's list of panelists.⁴⁷⁹ The ICANN-approved providers list of panelists is comprised of individuals who have been previously trained in arbitration and are knowledgeable about the legal principles surrounding domain-name disputes.⁴⁸⁰ The complainant states in the complaint whether it elects a three- or one-member panel.⁴⁸¹ The complainant then submits the names and contacts of three potential panelists, one of which will serve on the panel.⁴⁸² The respondent then must submit three potential panelists within twenty days of service of the complaint, one of which will serve on the panel.⁴⁸³ If the complainant selects a one-member panel, the respondent can elect to have a three-member panel, thus resulting in the parties splitting the cost of the proceeding.⁴⁸⁴ In the case of a one-member panel, ICANN selects the panelist; the parties have no role in the selection of the arbitrator.⁴⁸⁵

a. Composition of the Panel

This article assumes that the panel is the most efficient way to resolve disputes. Under this assumption, the focus of this discussion revolves around the intellectual composition of the panel. Obviously, the RAP panel will need to be specialized. Judge Learned Hand once stated that “[n]o one will deny that

⁴⁷⁸ UDRP, *supra* note 1, at para. 3.

⁴⁷⁹ *Id.* at para. 3(b)(iv).

⁴⁸⁰ Internet Corporation for Assigned Names and Numbers, Information Concerning Approval Process for Dispute-Resolution Service Providers, <http://www.icann.org/udrp/udrp-provider-approval-process.htm> (last visited Feb. 2, 2009) (“Applicants are expected thoroughly to train the listed neutrals concerning the policy, the uniform rules, the technology of domain names, and the basic legal principles applicable to domain-name disputes.”).

⁴⁸¹ UDRP, *supra* note 1, at para. 3(b)(iv).

⁴⁸² *Id.*

⁴⁸³ *Id.* at paras. 5(a), 5(b)(v).

⁴⁸⁴ *Id.* at para. 5(b)(iv).

⁴⁸⁵ *Id.* at para. 6(b).

the law should in some way effectively use expert knowledge wherever it will aid in settling disputes. The only question is as to how it can do so best.⁴⁸⁶ But “as Judge Plager [of the Federal Circuit] points out, ‘it does not follow that if a court specializes in one or more areas of the law, the judges appointed to the court should be specialists in those areas.’”⁴⁸⁷ Like arbitrators under the UDRP, arbitrators under the RAP should be knowledgeable about arbitration as well as about the ecclesiastical principles that would govern the resolution of the dispute.

This raises another issue: How knowledgeable must a RAP arbitrator be to decide the dispute? That question raises further issues about bias. The arbitrators most knowledgeable about a particular religion would likely be those involved in that religion in one way or another. That involvement may potentially bias the outcome of the arbitration. Conversely, if the required knowledge of the arbitrator is relegated to only a minimal working understanding, the RAP boards may make erroneous decisions because of the arbitrator’s limited knowledge. This has been a problem under the UDRP, where evidence suggests that arbitrators, typically practitioners and former judges, retain a bias in favor of the complainant.⁴⁸⁸ Thus, a balance must be struck—the arbitrator must be knowledgeable about the ecclesiastical law and arbitration while remaining neutral in decision-making.

Additionally, experienced judges who work only on special cases may develop doctrinal “myopia.”⁴⁸⁹ “Because specialized courts are isolated from the broader legal system, they are prone to developing arcane doctrines and procedures that do not cohere with the broader legal corpus and that create disadvantages for non-repeat players.”⁴⁹⁰ Specialized judges tend to lack a diverse

⁴⁸⁶ LeRoy L. Kondo, *Untangling the Tangled Web: Federal Court Reform Through Specialization for Internet Law and Other High Technology Cases*, 2002 UCLA J.L. & TECH. 1, 3 (2002) (quoting Learned Hand, *Historical and Practical Considerations Regarding Expert Testimony*, 15 HARV. L. REV. 40 (1901)).

⁴⁸⁷ Jeffery W. Stempel, *Two Cheers for Specialization*, 61 BROOK. L. REV. 67, 70 (1995) (quoting S. Jay Plager, *The United States Courts of Appeals, the Federal Circuit, and the Non-Regional Subject Matter Concept: Reflections on the Search for a Model*, 39 AM. U. L. REV. 853, 858 (1990)).

⁴⁸⁸ Helfer & Dinwoodie, *supra* note 457, at 211–12.

⁴⁸⁹ Edward K. Cheng, *The Myth of the Generalist Judge*, 61 STAN L. REV. 519 (forthcoming 2009) (manuscript at 31, available at http://papers.ssrn.com/sol3/papers.cfm?abstract_id=985677).

⁴⁹⁰ *Id.* But see Kondo, *supra* note 486, at 11 (“[I]t would be highly inconsistent for detractors to maintain that generalist judges may become skilled in specialized areas of law through self-study but then argue that specialist judges could not use self-study to widen their span of knowledge of other areas of law outside their own expertise.”).

docket—the subject matter of their cases never changes—which can lead to additional bias.⁴⁹¹ Further, expertise may vary “from one panel to the next.”⁴⁹² Paradoxically, increased specialization may lead to inconsistent results.⁴⁹³

Nevertheless, knowledgeable judges are important for several reasons.⁴⁹⁴ First, because of their expertise, judges with more experience in a particular area of law are less likely to make errors than inexperienced judges.⁴⁹⁵ Although expertise may give rise to the aforementioned problems, Edward K. Cheng suggests that this expertise could give rise to self-regulating norms of specialization.⁴⁹⁶ LeRoy L. Kondo also argues against the idea of “myopic” specialist judges, contending that assumptions about a jurist’s lack of legal or doctrinal breadth are unfounded.⁴⁹⁷ Second, while specialist judges may exhibit decisional inconsistency, that problem is likely to be greater with generalist judges, whose inexperience makes them prone to greater variation in their analysis and decisions.⁴⁹⁸ Third, the judge’s knowledge of the subject matter legitimizes the judge’s decision in the eyes of parties to the proceeding.⁴⁹⁹

There are several solutions to deal with the potential bias of experienced arbitrators. One possible solution would be to select individuals who belong to a different religion, or no religion at all, but have experience with or knowledge of religious law. These individuals can then study the law of the particular religion and make a decision based on this knowledge. This solution is similar to a

⁴⁹¹ Cheng, *supra* note 489, at 31. This “percolation” or “cross-pollination” theory has been criticized by Stempel because “there appears to be no dramatic evidence of specialized courts making erroneous decisions, deciding issues too quickly or too firmly, or basing their decisions on too narrow a base of fact, law or nonlegal information.” Stempel, *supra* note 487, at 93.

⁴⁹² Cheng, *supra* note 489, at 34.

⁴⁹³ Inconsistency here refers to both analytic and outcome-based inconsistency. Analytic inconsistency results from the use of different reasoning methods. This can result where judges’ expertise varies. Outcome-based inconsistency occurs where judges confronted with identical or substantially similar situations reach different decisions. Again, outcome-based inconsistency can result from varying expertise.

⁴⁹⁴ There are numerous rationales for specialized courts and judges. *See generally* Richard L. Revesz, *Specialized Courts and the Administrative Lawmaking System*, 138 U. PA. L. REV. 1111, 1116–21 (1990) (discussing reasons favoring specialized review for administrative action). This article, however, focuses only on considerations relevant to the RAP.

⁴⁹⁵ *Id.* at 1117.

⁴⁹⁶ Cheng, *supra* note 489, at 28–29.

⁴⁹⁷ Kondo, *supra* note 486, at 11.

⁴⁹⁸ *See* Cheng, *supra* note 489, at 4 (discussing the enhanced ability of specialist judges to select the better answers when compared to generalist judges).

⁴⁹⁹ *Id.* at 28.

specialized judicial body, such as the Federal Circuit.⁵⁰⁰ For example, such individuals may include religious historians or divinity professors.

Another solution is to use neutral arbitrators who have little or no knowledge about religion or ecclesiastical teachings.⁵⁰¹ Having neutral arbitrators will likely eliminate any potential for bias. This solution would make the arbitration panel analogous to a judicial arm; a neutral body deciding religious disputes based only on the facts presented. But given the nature of the disputes at issue and the scholarly support for specialist judges, this approach may not adequately protect the interests of the disputing parties. The religious context is inherently one of arcane doctrines full of mythos; thus, it requires adjudicators with knowledge of the subject matter.⁵⁰²

Finally, the arbitrators may belong to the disputed religious organization. This raises problems of bias. The UDRP has faced similar problems.⁵⁰³ Practitioners and retired judges typically serve as panelists for the UDRP.⁵⁰⁴ Statistics show that one-member panelists favor complainants by large margins. Three-member panelists also favor complainants, but to a lesser degree.⁵⁰⁵ In view of the undeniable bias, having arbitrators with beliefs in the disputed religion is likely unworkable. For that reason, such a solution would undermine the integrity of dispute resolution under the RAP. Instead, the first solution offered, employing arbitrators with scholarly knowledge of religions who are not members of the religious organization at issue, seems the most workable.

b. Panel Selection

The process of selecting arbitrators is another important consideration in establishing a panel. The observation that “specialized courts reflect the views of current agencies and legislatures rather than those of the legislatures that established the statutes at issue”⁵⁰⁶ applies with equal force to the RAP context. The selection process needs to reflect the religious concerns of all religious or-

⁵⁰⁰ 28 U.S.C. § 1295 provides the Federal Circuit with exclusive appellate jurisdiction over copyright and patent matters.

⁵⁰¹ Neutrality here also implies independence. The decision-maker should be able to make decisions without fearing repercussions and without conflicts of interest.

⁵⁰² See generally KAREN ARMSTRONG, *THE BATTLE FOR GOD* (Random House, Inc. 2000) (illustrating the prominent role of *mythos*, as opposed to *logos*, in religion).

⁵⁰³ Helfer & Dinwoodie, *supra* note 457, at 212–13.

⁵⁰⁴ *Id.* at 212.

⁵⁰⁵ Geist, *supra* note 444, at 922.

⁵⁰⁶ Stempel, *supra* note 487, at 105.

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ganizations, not only those with special bargaining positions. Thus, the selection process should not favor one religion over another.

Moreover, the identity of the arbitrator will influence the selection process itself. In other words, because the selection process necessarily entails a value judgment about who should serve as arbitrators, this judgment will affect the function of the selection process. For example, the goal might be to select neutral arbitrators with a rich understanding of the tenets and principles of the disputed religion. To that end, the selection pool should include individuals with such knowledge and exclude individuals who could not act as neutral arbitrators. Moreover, the selection should evaluate whether the applying arbitrator understands the religion at issue.

Finally, the selection process may favor certain types of individuals, such as individuals who specialize in the particular religions or religious issues in dispute.⁵⁰⁷ This type of bias is not necessarily a detriment. If the system selects individuals who serve the best interests of the system, then no problems exist. When, however, the selection process favors the individuals the system seeks to exclude—for example, individuals with personal stakes in particular disputes or religious leaders with agendas—it becomes ineffective and hinders the goals of the RAP. Thus, it is important to maintain strict criteria for potential judges or arbitrators. A process that selects individuals that best serve the system's goals will ensure that disputes are resolved fairly and efficiently.

8. Single-Round Proceedings

Dispute resolution under the UDRP occurs within a single round of proceedings.⁵⁰⁸ Generally, the complainant files the complaint, the respondent answers and the panel makes a decision based on those two documents.⁵⁰⁹ However, the panel has discretion when conducting the proceedings.⁵¹⁰ For example, ICANN may receive other documents, including additional evidence and contentions from the parties.⁵¹¹ In these cases, ICANN will notify the panel about whether to accept or reject the documents.⁵¹² If the panel accepts the documents, it can allow for rebuttal of the document by the other party.⁵¹³ Except in ex-

⁵⁰⁷ Cheng, *supra* note 489, at 38.

⁵⁰⁸ Smith & Wilbers, *supra* note 440, at 224.

⁵⁰⁹ *Id.*

⁵¹⁰ *Id.*

⁵¹¹ *Id.*

⁵¹² *Id.*

⁵¹³ *Id.*

traordinary circumstances, the panel does not accept unsolicited documents or evidence unless they are of little significance, or the documents are not disputed.⁵¹⁴

The RAP will need to have more than a single proceeding. Further internal and external checks would be needed to accurately and legitimately resolve the dispute. Such checks on the dispute resolution process would likely necessitate an internal appellate review process.

9. Dispute Resolution Provider

The UDRP maintains an independent third-party provider, ICANN, which resolves the disputes arising between the complainants and respondents.⁵¹⁵ Lack of independent, third-party arbitration results in slanted dispute resolutions.⁵¹⁶

The RAP, however, should not be treated like other independent ADR resolution co-operatives, such as the CPR Institute for Dispute Resolution.⁵¹⁷ In-house counsel from several Fortune 500 companies formed the CPR Institute to resolve disputes.⁵¹⁸ The focus on ADR stems from fear of litigation.⁵¹⁹ Conversely, the RAP creates a separate form of dispute resolution. The RAP would provide an adequate dispute resolution forum, unlike present law, which does not recognize legal theories based on religious identity or authenticity.

IV. CONCLUSION

Religious organizations frequently use trademark law to protect their identity. For example, trademarks are source identifiers that allow consumers to associate the trademarks with images, lifestyles and even beliefs. Because consumers make associations between beliefs and trademarks, religious organizations use the legal protection trademark law affords to their marks.

While religious organizations seek protection by using trademark law, the law cannot always adequately protect the religious organization's identity.

⁵¹⁴ *Id.*

⁵¹⁵ See UDRP, *supra* note 1, at para. 1; see also Lisa B. Bingham, *Mandatory Arbitration: Control Over Dispute-System and Mandatory Commercial Arbitration*, 67 LAW & CONTEMP. PROBS. 221, 246 (2004) (discussing third-party dispute-resolution providers).

⁵¹⁶ Bingham, *supra* note 515, at 239–40.

⁵¹⁷ Otherwise known as the International Institute for Conflict Prevention and Resolution, <http://www.cpradr.org/> (last visited Feb. 9, 2009).

⁵¹⁸ Bingham, *supra* note 515, at 227.

⁵¹⁹ *Id.* at 232–33 (noting that the control over arbitration can control the risks of litigation).

Indeed, religious organizations use trademark law not only because of the associations consumers make with their mark, but also because there is no other mechanism to adequately protect their identities. Current law is insufficient to protect a religious organization's identity. Trademark law does not protect identity and is not concerned with identity as perceived by the trademark holder. Instead, trademark law focuses on consumer perception.

Other problems confronting religious organizations that use trademark law to protect their identities have been highlighted as well. Specifically, a mark may become generic; a mark's meaning may change because of consumer perception; a religious organization cannot assert a claim that its mark represents the authentic beliefs of that religion; the law permits parody of religious symbols; a cause of action for scandalous or disparaging marks limits only trademark uses; and dilution arises only when a mark has achieved fame. These issues are impossible for religious organizations to overcome because they are inherent in the framework of trademark law. Religious organizations cannot use trademark law to preserve their identity because trademark law was never intended to protect religious identity.

Trademark law's limited ability to protect religious identity becomes apparent in view of the battles over religious identity in court. On occasion, religious organizations make misplaced arguments asserting themselves as the "true" religion, but, on the whole, the majority of arguments are disguised in language of trademark law. The disputes are superficially analyzed under a likelihood-of-confusion standard, but in actuality the organizations—and sometimes even the courts—are trying to settle an underlying identity dispute. The current judicial method of dispute resolution is inefficient, ineffective, and sometimes inappropriate. Judicial resources settle disputes that often deal with an inapposite subject. The resolution of the trademark dispute does not solve the underlying dispute over identity and authenticity.

In light of the shortcomings of trademark law in settling identity disputes and the UDRP's success in resolving domain-name disputes outside of court, this article proposed that the UDRP could be used as a model to resolve disputes in the religious-identity context. Specifically, the article adapted portions of the UDRP to the religious context. In the process, two main problems became apparent. First, developing methods to ensure that all possible parties consent to the RAP is difficult. It requires an incentive-laden system that may not capture all possible parties. Second, several arbitrator selection processes lead to inherent biases. As previously illustrated, however, these two problems can be adequately addressed. Once the RAP or a similar dispute resolution forum is created, religions will have a better alternative in which to settle disputes over authenticity and identity.