

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

1/9/01

Hearing:
August 16, 2000

Paper No. 64
HRW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Church of God

v.

The Church of God

Opposition No. 98,057
to application Serial No. 74/428,670
filed on August 24, 1993

Mark S. Graham and Robert O. Fox of Luedeka, Neely & Graham,
P.C. for Church of God.

James Francis Browne for The Church of God.

Before Simms, Wendel and Bottorff, Administrative Trademark
Judges.

Opinion by Wendel, Administrative Trademark Judge:

The Church of God (applicant) has filed an application to register the mark THE CHURCH OF GOD for "conducting religious and ministerial services."¹

¹ Serial No. 74/428,670, filed August 24, 1993. The application as originally filed set forth first use dates of July 24, 1993 but was subsequently amended to set forth dates of June 13, 1993. A disclaimer was entered of the word CHURCH. The application was also amended to one seeking registration under Section 2(f) and the claim of distinctiveness made thereunder was ultimately accepted by the Office.

Church of God (opposer) has filed an opposition to registration of the mark on the ground of priority and likelihood of confusion, and also on the ground of fraud on the Trademark Office by applicant's execution of a declaration in connection with its application which failed to disclose opposer's rights to the mark CHURCH OF GOD.² Opposer alleges that since a date long before any date of actual or constructive first use by applicant, opposer has continuously used the mark CHURCH OF GOD in connection with its religious, evangelistic and ministerial services; that applicant's mark THE CHURCH OF GOD is confusingly similar to opposer's mark and is being used for the same or related services; that applicant has not used the terminology "The Church of God" as a mark in commerce in connection with any goods or services prior to August 24, 1993; and that use by applicant of its mark is likely to cause confusion or mistake on the part of the public who might reasonably believe that applicant's services are associated with, or sponsored by, opposer.

² Although opposer pleaded fraud on the Office as a separate ground in its notice of opposition, in its brief opposer failed to make any arguments with respect to fraud based on statements made in applicant's original declaration. When questioned at oral hearing, opposer stated that this claim had not been withdrawn. In view of opposer's failure, however, to pursue this claim in its brief, we consider the claim withdrawn. Opposer's arguments with respect to fraudulent statements made in connection with applicant's claim of distinctiveness under Section 2(f) have not been considered in that fraud based on these circumstances was not pleaded.

Applicant, in its answer, denies the salient allegations of the notice of opposition.

The Record

The record consists of the file of the involved application; opposer's trial testimony depositions, with accompanying exhibits, of Dr. Lamar Vest, General Overseer of opposer from 1990-1994, and Dr. Charles W. Conn, General Overseer from 1966-1970 and designated historian of opposer since 1952; and applicant's trial testimony deposition of Robert J. Pruitt, General Overseer of applicant.³ Opposer also submitted the testimonial depositions upon written questions, with accompanying exhibits, of eleven pastors and one administrator associated with opposer and a notice of reliance upon, inter alia, assembly minutes, or portions thereof, from 1906 to 1996; official publications of opposer; books concerning the history of opposer and its churches in various states; newspaper clippings about opposer; and the discovery depositions taken of Robert J. Pruitt in both Opposition No. 94,180⁴ and the present opposition. (Exhibits 58-247).

³ Opposer made many objections during the taking of the Pruitt testimony and has requested in its brief that all testimony elicited as a result of improper or leading questions be excluded. While not totally excluding this rather large proportion of the testimony, we have taken opposer's objections into consideration in determining the weight to be given to the testimony.

⁴ In Opposition No. 94,180 applicant opposed the registration by Church of God of Prophecy of a flag design mark for its evangelistic and ministerial services. Opposer was not a party

Both parties filed briefs and both participated in an oral hearing.

Although the lineage of applicant as a church is deeply intertwined with the priority dispute in this case, we find the record establishes the following facts with respect to the history of the churches involved. In June 13, 1903 A. J. Tomlinson joined with the small band called the Holiness Church to form the group which became known as the Church of God.⁵ In 1907 at its second General Assembly this organization officially adopted Church of God as its name.⁶ In 1923, as a result of a schism in the church, A. J. Tomlinson and his followers separated from the original group, but both churches continued to use the same name. While applicant contends that it was the Tomlinson group

in that case. The Board dismissed the opposition in a decision issued May 18, 2000.

⁵ In the church history written by Dr. Charles Conn, *Like a Mighty Army* (1996 ed.)(Opposer's Exhibit 1), we find the following account of the beginnings of the church:

On June 13, 1903, he [Tomlinson] cast his lot with the small band, and later wrote concerning his tardy decision to join them:

... I learned more about the organization at this time, and when I understood fully they meant to stand for the whole Bible rightfully divided and to take the New Testament as their only rule of faith and practice, it appealed to me, and I became very much interested at once.

... I then said, this means that it is the Church of God. To this, they assented. Then, I ventured to ask if they would be willing to receive me into the church with the understanding that it is the Church of God of the Bible. They were willing [citing Tomlinson, *Answering the Call of God*].

⁶ See *Minutes of Second General Assembly*, January 11, 1907: Name of Church. Decision was made harmoniously. "Church of God" 1 Cor. 1:2 2 Cor. 1:1. (Opposer's Exhibit 59).

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that went forward as the representative of the original standards of the church and that it was the other group (opposer herein) that had deviated therefrom, opposer views the separation in the opposite manner.

In any event, in 1953, as the result of continued litigation between the two groups over the common use of the name Church of God, the Tomlinson group was required by court decree to adopt the name Church of God of Prophecy for use in connection with all secular matters. This name continues to be used by this group to the present time. Specific holdings made by the Tennessee Supreme Court in *Church of God v. Tomlinson Church of God*, 247 S.W. 2d 63 (Tenn Sup. Ct. 1952) and the subsequent decree issued by the Chancery Court of Bradley County at Cleveland, Tennessee in 1953 will be discussed more fully, *infra*.

Then in 1990 a faction within the Church of God of Prophecy became discontented with practices considered to be deviations from the established principles of theocratic government of the church and from the proper strict interpretation of certain of the teachings of the church. In July 1993 this faction separated from the Church of God of Prophecy and set up its own organization, which it called THE CHURCH OF GOD (applicant herein). Applicant considers itself to be the continuation of the Church of God of Prophecy before it deviated from "the doctrine and governs"

in 1990, and, in fact, to be the true continuation of the organization founded by A. J. Tomlinson in 1903.

The Opposition

The issue of likelihood of confusion is readily resolved. The marks are nearly identical; the only difference is the use of the article THE by applicant as an explicit part of its mark. The religious and ministerial services offered by opposer under CHURCH OF GOD and applicant under THE CHURCH OF GOD are, for our purposes, legally identical. Applicant has failed to proffer any evidence or make any argument refuting the likelihood of confusion.

Applicant's arguments are in terms of priority and rightful ownership of the mark THE CHURCH OF GOD. Applicant contends that it has established its date of first use of the mark THE CHURCH OF GOD as June 13, 1903. Applicant states that opposer and applicant "shared the same church under A. J. Tomlinson from 1903 until the 1920's." (Brief p. 5). Since the split in the 1920's, however, applicant maintains that opposer has called itself various names, including the "General Assembly of the Church of God" and "Church of God" in connection with a geographical term, as well as the "Church of God." Applicant asserts that, on the other hand, it is part of the branch which has continuously to used the name "The Church of God." Even after the

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Tennessee court decree under which the Tomlinson church was required to designate itself as "Church of God of Prophecy" for secular matters, applicant maintains that the church continued to refer to itself internally as "The Church of God." Applicant further contends that after the dispute with the Church of God of Prophecy in 1990, it was applicant that continued as the true church founded by A. J. Tomlinson. According to the testimony of Rev. Pruitt, applicant simply re-organized under the original name and continued the original spiritual entity. (Pruitt discovery deposition in Opp. 98,057, p. 119).

Applicant argues that not only has opposer failed to successfully challenge applicant's first use date of June 13, 1903 but opposer has also failed to establish rights in the mark CHURCH OF GOD. Applicant insists that opposer has no claim of exclusive rights to CHURCH OF GOD in itself, in view of its usages throughout the years of various forms which merely incorporate these three words. Applicant points particularly to the many present-day variations used by opposer which include geographic indicators, e.g., Oak Park Church of God, Riverhills Church of God. Applicant goes so far as to argue that opposer lacks standing in this opposition because it has no rights in the mark CHURCH OF GOD.

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Looking to the record before us, we find that opposer has clearly shown that the name Church of God was officially adopted during the Second Assembly of opposer in 1907. Opposer claims no earlier date of use of the name as a mark, although both opposer and applicant claim roots in the church which was founded in June 1903. Opposer has also fully documented its continuous use of the mark CHURCH OF GOD since 1907 by evidence including copies of the official minutes of the general assemblies held since that time (Exhibits 58-123), representative examples of its official publication "Church of God Evangel" covering the years 1910 to 1997 (Exhibits 133-152) and of its youth journal "The Lighted Pathway" covering the years 1937 to 1990 (Exhibits 160-171), and testimony of use of the mark in connection with radio and television broadcasts. By the testimonial depositions upon written questions of eleven pastors and one administrator opposer has also introduced evidence of the public use of signs bearing the CHURCH OF GOD as part of individual church names across the country for periods up to fifty years. Moreover, although these usages of the CHURCH OF GOD are frequently in connection with a particular geographic location, we do not consider the addition of a geographic identifier to in any way diminish or detract from opposer's use of the mark CHURCH OF GOD in itself. Opposer has demonstrated that it has consistently used CHURCH OF GOD

as a service mark throughout the country, as well as the world, both with and without geographic indicators, since 1907. There is no question as to this use or as to opposer's standing to bring this opposition.⁷

Applicant, by the testimony of Rev. Pruitt and the exhibits identified therein, has only shown use of the mark THE CHURCH OF GOD in its own accord since its "reorganization" as a separate church on July 24, 1993. Applicant claims, however, and Rev. Pruitt has testified to the effect that this entity is the true continuation of the church founded by A.J. Tomlinson in 1903. Rev. Pruitt has testified that applicant felt the divine mandate that its new church be called THE CHURCH OF GOD. Thus, applicant argues, as this spiritual continuation it should be entitled to rely upon use of THE CHURCH OF GOD since 1903.

While we have the testimony of Rev. Pruitt that A.J. Tomlinson gave the name "The Church of God" to the church at the time of joining with the Holiness Church in 1903, as well as the previously noted account given by Dr. Conn in his history of the church, we find this evidence insufficient to establish that THE CHURCH OF GOD was actually used and held out to the public as a service mark

⁷ As pointed out at the oral hearing, applicant has failed to plead the affirmative defenses of either non-use or abandonment by opposer of its mark in view of the attachment of a geographic identifier thereto and accordingly such defenses have been given

as early as this date. From the evidence produced by opposer, it was not until 1907 that the name was officially adopted by the organization as an identifier of its religious activities.

Applicant points to the forty declarations which were submitted in connection with its claim of distinctiveness in its application as evidence of use of the mark since 1903.⁸ While the application and the declarations submitted in connection therewith are automatically part of the record, these declarations are not evidence in this proceeding of the truth of the statements made therein. Proof in the inter partes case must be established by competent evidence introduced at trial. See *British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197 (TTAB 1993), *aff'd*, *Brunswick Corp. v. British Seagull Ltd.* 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994). Accordingly, no consideration has been given to these declarations.

Even if we were to accept the date of June 13, 1903 as the date of first use of THE CHURCH OF GOD as a service mark for the religious group formed by A.J. Tomlinson, applicant must still establish continuous use of the mark since that

no consideration. The only issue at this point is one of standing, which opposer has fully satisfied.

⁸ In each of these declarations, the statement is made that "THE CHURCH OF GOD ... has, since June 13, 1903, and continues up to this day to conduct religious and ministerial services using the name CHURCH OF GOD to identify and distinguish its religious and ministerial services ...".

date up until its adoption by the group headed by Rev. Pruitt in 1993, or that applicant stands in privity with the original Tomlinson church.

Since it is acknowledged by applicant that both applicant and opposer shared the same church until the schism in the 1920's, opposer's evidence of use of the mark CHURCH OF GOD is applicable to both groups during this period. Moreover, we find the evidence convincing that after the split in the 1920's both groups continued to use the CHURCH OF GOD.⁹ In fact, it was this common use which lead to the litigation that we find to be decisive of applicant's claim of priority herein.

From the decision issued by the Supreme Court of Tennessee in Church of God v. Tomlinson Church of God, *supra*, it is apparent that use by the Tomlinson group of the name "Church of God" had been the subject of prior litigation and of an injunction issued in 1929, and repronounced in 1939, barring use by the Tomlinson group of the name without "such suitable prefix or suffix to avoid confusion." Thus it was that the name Tomlinson Church of God was adopted. In the decision issued in 1952, in which the Church of God (complainant) was seeking reparation for

⁹ As this point, we note that while the article "the" was frequently used in connection with the name, there was no evidence that "THE" was considered to be part of the official name or service mark of either church group.

repeated violations of the injunction including the appropriation by the Tomlinson Church of God of money and other property of complainant and the solicitation and acceptance of funds intended for complainant on the false representation that they were the true Church of God, the court found the prior decree to be the law of the case. The Court went on to state as follows:

Responding to the complainants' contention that defendants are liable in damages for the unlawful use of the trade name, "Church of God," we hold as follows. The right of the complainant to the exclusive use of the name "Church of God" is a closed question. It cannot be relitigated. The right, however, to sue the defendant for the unlawful use of the name as an infringement upon a "trademark" or "tradenname" cannot be maintained. "Trademarks" or "Tradenames" are thought of only in connection with commercial activities, the buying or selling of articles of merchandise wherein such articles have a special value due to the use of a trademark. ...

It is very obvious that the law which gives protection to a tradenname has no application to the instant case since neither the complainant nor the defendant is dealing with any article of merchandise that is the subject of barter and sale. However, the name, "Church of God," has a certain value as a tradenname as where a rival organization uses it to the financial disadvantage of one who is entitled to its exclusive use. In the instant case the measure of damages would be all such monies and property as the defendants received in the way of 'contributions and remittances' and which are shown to have resulted from the unlawful use of said name. So that whether the actions be for damages or for money had and received the result is practically the same.
247 S.W. 2d at 68-69.

In view of these statements with respect to trademark infringement, applicant argues that the Tennessee court

disavowed any applicability of its decision to trademark rights, making the decision of little weight in the present proceeding. We are in agreement with opposer, however, that the decision is highly relevant. Applicant is presently claiming to be a continuation of the chain running from the original church founded by A.J. Tomlinson in 1903 through the Church of God of Prophecy to the present-day church of applicant. In the Tennessee decision, as cited above, the court clearly set forth the exclusive right of opposer to use the name Church of God. Although the court stated that opposer was not entitled to sue the Tomlinson Church of God for trademark infringement, the court clearly was considering these rights in terms of opposer's using the mark in connection with merchandise, not in terms of use as a service mark for religious activities. The fact that the defendant was found accountable for monies obtained by the unlawful use of the name Church of God shows recognition by the court of the value of the name at the very least as a trade name to opposer, if not also as a service mark.

Moreover, the Tennessee Supreme Court decision was not the end of the matter. In the following year, by the decree of the Chancery Court of Bradley County at Cleveland, Tennessee, it was ordered that the Church of God of Prophecy was to be the official name for the former Tomlinson Church of God in "all matters, transactions and dealings relating

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to said organization in its secular affairs." The court specifically ordered the elimination of the words Tomlinson Church of God and substitution of the words Church of God of Prophecy in all real estate conveyances, church signs, telephone directory listings, publications or postcards, advertisements or news stories, radio broadcasts, and stationery or other printed matters. Thus, for all public purposes, the name of the Tomlinson church was the Church of God of Prophecy.

Applicant contends that while the Tomlinson Church of God used the court-ordered title for all secular and external affairs, the name The Church of God was continued to be used internally and thus the continuum was not broken. Applicant has failed, however, to produce documentary evidence in support of this contention. Although applicant points to the copy of the design patent which was made of record in the application as evidence of continued use of the name The Church of God, this is to no avail. In the first place, as pointed out *supra*, documents that are merely part of the application and have not been introduced during trial cannot be relied upon as evidence. Second, even if considered, the design patent appears to have been assigned to The Church of God in 1939, a time prior to the official change in name of the Tomlinson church and a time in which

the Tomlinson church was known to have been violating the earlier injunction.

Furthermore, while the Church of God of Prophecy may have been the spiritual continuation of the church founded by A. J. Tomlinson in 1903 and may have used the original name internally, the legal name for this church after the decree of 1953 was not Church of God (or The Church of God), but rather the Church of God of Prophecy. By order of the court, this was the name which was used externally¹⁰ after this date and thus this was the name which had the capacity of functioning as a mark for the religious services offered by the church. This holds true even up until the present date.

We find no basis for applicant's claim of continuous use of the name The Church of God, in the sense of a service mark to which the public was exposed, from 1953 until 1993. While applicant has shown that the group which split off from the Church of God of Prophecy in the 1990's adopted the name and mark THE CHURCH OF GOD in July 1993, there is no evidence of continuous legal use of this mark from 1903 until this time. Rev. Pruitt in his testimony has stated that applicant is not a continuation of the legal entity

¹⁰ By dictionary definition "secular" encompasses all things "worldly or temporal", as opposed to "spiritual or eternal." Thus the injunction covers all activities of the church, including any service mark registration, despite the arguments of

known as the Church of God of Prophecy, but rather a spiritual continuation of the Church of God of Prophecy before it went astray. (Pruitt discovery deposition, p. 120-21). Whether or not this status may be sufficient to avoid the injunction which binds the Church of God of Prophecy, it defeats applicant's claim of continuous use by applicant and its predecessors of the CHURCH OF GOD as a service mark. On the other hand, if applicant is the legal continuation of the true Church of God of Prophecy, then applicant is bound by the injunction and has no legal right to use the mark that it is attempting to register.

Accordingly, we find that applicant has failed to establish that it is in privity with the church founded by A.J. Tomlinson in 1903 with respect to the use of the mark THE CHURCH OF GOD. Opposer has established its priority with first use in 1907 of the mark CHURCH OF GOD and continuous use thereafter. Applicant is restricted to a first use date of July 24, 1993. Inasmuch as likelihood of confusion is inevitable, opposer prevails.

Decision: The opposition is sustained.

applicant's attorney to the contrary at oral hearing. See *Webster's Third International Dictionary* (1993).