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Paper No.
PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Plymouth Rock Foundation
v.
Christian Heritage Tours, Inc.

Opposition No. 106,991
to application Serial No. 75/023,501
filed on November 24, 1995
and
Cancellation No. 27,541

Neil F. Markva, Esq. for **Plymouth Rock Foundation.**

Benjamin J. Lambiotte, Esq. and **Adam R. Brownstein, Esq.**
of **Garvey, Schubert & Barer** for **Christian Heritage
Tours, Inc.**

Before **Seeherman, Hairston and Bottorff**, Administrative
Trademark Judges.

Opinion by **Hairston**, Administrative Trademark Judge:

In these consolidated proceedings, Plymouth Rock
Foundation (plaintiff) has opposed an application and
sought to cancel a registration owned by Christian
Heritage Tours, Inc. (defendant). Defendant's

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application, under Section 2(f), covers the mark

CHRISTIAN HERITAGE MINISTRIES for:

educational services, namely seminars, conferences, workshops and classroom instruction, reviving and teaching America's original Christian heritage and history, some or all of which incorporate slide and/or video presentations, all in the field of America's Christian heritage and history, offered both nationally and internationally, and distributing course materials in connection therewith.¹

Defendant's registration is for the mark CHRISTIAN HERITAGE TOURS, INC. for "arranging educational, historical and religious travel tours nationally and internationally."²

In the notice of opposition, plaintiff alleges that it is a leading national ministry that promotes and explains America's Christian heritage; that CHRISTIAN HERITAGE describes the field or subject matter of the educational services that many existing ministries provide, and CHRISTIAN HERITAGE generically describes the main feature and field of any educational service that promotes Christian heritage and history; that CHRISTIAN

¹ Serial No. 75/023,501 filed November 24, 1995, alleging dates of first use as early as 1991.

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HERITAGE MINISTRIES is a generic designation associated with services that promote Christian heritage and history of the United States; that CHRISTIAN HERITAGE MINISTRIES describes educational services, and the like, that pertain to the Christian heritage and history of the United States; that since numerous third parties use the designation CHRISTIAN HERITAGE as part of their business names for businesses that

² Registration No. 1,862,018 issued April 16, 1993. The word "TOURS" is disclaimed apart from the mark as shown.

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are associated with educational services that promote the Christian heritage and history of the United States, applicant's use of that designation for its educational services is not substantially exclusive; that no evidence exists to show that either CHRISTIAN HERITAGE or CHRISTIAN HERITAGE MINISTRIES has acquired secondary meaning within the United States, such that neither term is a source indicator for applicant's educational services; that "neither 'Christian heritage' nor 'Christian heritage ministries' has become distinctive of applicant's educational services in commerce"; that "'Christian heritage ministries' is so highly descriptive of educational services associated with the promotion or teaching of America's Christian heritage and history as to be incapable of registration based upon a claim of acquired distinctiveness"; and that "registration by applicant of the merely descriptive phrase 'Christian heritage ministries' would be inconsistent with Opposer's and others' right to use that term descriptively."

Defendant, in its answer to the notice of opposition,³ has denied the essential allegations thereof.

In the petition to cancel, plaintiff alleges that it is the owner of the marks AMERICA'S CHRISTIAN HERITAGE WEEK and

AMERICA'S CHRISTIAN HERITAGE WEEK MINISTRY for educational services; namely, conducting events involving groups of people to learn about America's Christian form of government, development of educational materials regarding the historical Christian foundation of America, and distributing those educational materials in connection therewith and promoting these services and related educational information on the Internet; that plaintiff is the owner of application Serial No.

75/207,824 to register the mark AMERICA'S CHRISTIAN HERITAGE WEEK MINISTRY on the Principal Register for educational services, namely, conducting seminars, and

³ Defendant also asserted the affirmative defenses of laches, acquiescence and unclean hands; and a "Morehouse defense", maintaining that in view of its ownership of the registered mark CHRISTIAN HERITAGE TOURS, INC., plaintiff cannot be damaged by the issuance of a registration to defendant for CHRISTIAN HERITAGE MINISTRIES. Defendant did not pursue any of these defenses. In any event, we should note that the defenses of laches, acquiescence and unclean hands are unavailable in a proceeding involving a claim of genericness/mere descriptiveness. Moreover, the "Morehouse defense" would not have been well taken inasmuch as the plaintiff seeks to cancel that registration.

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development of educational materials regarding the
historical Christian foundation of

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America, and distributing those educational materials in connection therewith; that registration of plaintiff's application has been refused under Section 2(d) of the Trademark Act in view of defendant's Registration No. 1,862,018 for the mark CHRISTIAN HERITAGE TOURS, INC.; that the only common portion between plaintiff's mark and defendant's mark is the term "Christian heritage"; that the term "Christian heritage" is a generic name for educational goods and services in the field of Christian heritage and history and therefore plaintiff has disclaimed "CHRISTIAN HERITAGE" apart from the mark as shown in its application; that defendant's registration does not include a disclaimer of "CHRISTIAN HERITAGE", nor does the registration include a claim of distinctiveness under Section 2(f) of the Act; that defendant's continued use of its mark without a disclaimer of the generic term "CHRISTIAN HERITAGE" is likely to cause confusion in the minds of the public in that defendant appears to have the right to exclusive use of the term "Christian heritage" in the field of Christian heritage and history; that plaintiff will be irreparably damaged in its business and in the goodwill thereof if defendant's registration is not cancelled because the public (a) will be deceived as to the nature

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of the generic term CHRISTIAN HERITAGE; (b) will be led to believe that the defendant is the owner of the generic term CHRISTIAN HERITAGE and therefore may control the use of the generic term CHRISTIAN HERITAGE by plaintiff in the providing of its goods and services in the field of Christian heritage and history, which is not true; and (c) will be led to believe that defendant has the exclusive right to use the generic term CHRISTIAN HERITAGE. Further, plaintiff alleges that "unless defendant's registration is cancel[l]ed, the goodwill associated with plaintiff's marks is likely to be placed in jeopardy and to suffer dilution thereof and thus reflect upon and seriously injure the reputation which plaintiff presently enjoys for its services rendered under its marks; [and] that the existence of defendant's registration would have the tendency to encourage others to adopt marks resembling plaintiff's marks for the same or related goods and services in the field of Christian heritage and history thus further weakening and diluting the distinctiveness of plaintiff's marks and making it more difficult for plaintiff to maintain the scope of protection to which its marks are entitled; [and] that defendant's registration is invalid under Section 6(a) of

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the Act without a disclaimer of the generic term
CHRISTIAN HERITAGE."

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Defendant has denied the allegations of the petition to cancel.⁴

Before turning to the merits of this case, we must first consider an evidentiary matter. As background, we note that the parties stipulated that testimony could be submitted by way of affidavit or declaration. Plaintiff, during its testimony period, submitted a paper styled "Opposer's Notice of Reliance and Declaration of Neil F. Markva" which is accompanied by ninety-one exhibits. The first paragraph of the paper reads as follows:

Neil F. Markva declares:

1. Pursuant to 37 CFR 2.122(e), Opposer Plymouth Rock Foundation ("PRF"), hereby submits its reliance on the attached publications and/or official records bearing the designations Exhibits O-1 through O-91 as described in the attached Table of Contents of Opposer's Exhibits.

Defendant, in its brief on the case, has objected to many of the exhibits accompanying this paper on the ground that the information therein is hearsay and otherwise not appropriate for introduction by way of notice of

⁴ Defendant also asserted the affirmative defenses of laches, acquiescence and unclean hands in its answer to the petition to cancel. Defendant did not pursue these defenses in this proceeding, and for the reasons stated in footnote 3, the defenses are unavailable, in any event.

reliance.⁵ Plaintiff, in its reply brief, has offered no response to defendant's objections.

Upon review of plaintiff's paper, we deem it a notice of reliance and not stipulated testimony. Plaintiff has characterized it as such, and while we recognize that the parties stipulated that testimony could be presented by affidavit or declaration, the paper filed under the declaration of plaintiff's attorney Neil F. Markva is not in the nature of testimony. Moreover, an attorney generally may not appear as a witness on behalf of a party he is representing.

In view thereof, and inasmuch as plaintiff offered no response to defendant's objections, we have considered only those exhibits accompanying plaintiff's notice of reliance which constitute printed publications and official records. See Trademark Rule 2.122(e). Thus, we have not considered the listings of "Christian Heritage" or "Heritage Christian" businesses or ministries taken from the American Yellow Pages published by American

⁵ We note that with respect to exhibits nos. 1-83, in particular, defendant is renewing objections it made when these exhibits were submitted in support of plaintiff's summary judgment motion. While such objections were overruled and the exhibits considered for purposes of summary judgment, we should point out that the Board is liberal with respect to the types of

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Business Information Inc.; correspondence; newsletters not available to the general public; internet search results; and the results of searches of on-line libraries for the titles of books, and magazine and newspaper articles incorporating the words "Christian Heritage."

The record, therefore, consists of the files of the involved application and registration; the file of plaintiff's application, portions of books and journals, newspaper articles, copies of certificates of incorporation/amendment of third-parties, and copies of official proclamations of "Christian Heritage Week", submitted under plaintiff's notice of reliance. Defendant submitted a notice of reliance on the dictionary definitions of the words "Christian", "heritage", "tour", and "ministries;" and the declaration of its president, Catherine Millard, with exhibits.

We turn then to the merits of this case. The issues to be decided herein are (a) whether the terms CHRISTIAN HERITAGE MINISTRIES and CHRISTIAN HERITAGE TOURS, INC. are generic or merely descriptive of defendant's services;

(b) whether, assuming the terms are not generic but merely descriptive, they have become distinctive of

evidence which may be submitted in connection with a summary

defendant's services; and (c) whether absent a disclaimer of CHRISTIAN HERITAGE, CHRISTIAN HERITAGE MINISTRIES and CHRISTIAN HERITAGE TOURS, INC. are registrable.⁶

In support of its contention that CHRISTIAN HERITAGE MINISTRIES and CHRISTIAN HERITAGE TOURS, INC. are generic or at the very least merely descriptive of defendant's educational services and travel tour services, plaintiff relies on the dictionary definitions of the words "Christian"; "heritage"; and "ministries"; and various uses of "Christian Heritage" alone or as part of other phrases by defendant and third parties. Examples of these uses, with *Christian Heritage* highlighted, include: the book God's Signature Over The Nation's Capital written by defendant's president, Catherine Millard, which contains the tag line "Evidence of Your *Christian Heritage*" on the front cover; the book Up With America written by Robert Flood and published by plaintiff, which

judgment motion.

⁶ Contrary to plaintiff's contention, the "ultimate issue" herein is not whether defendant has the exclusive right to use the term CHRISTIAN HERITAGE apart from its marks CHRISTIAN HERITAGE MINISTRIES and CHRISTIAN HERITAGE TOURS, INC. so as to preclude registration of plaintiff's mark. The registrability of plaintiff's mark is not before us. Moreover, although plaintiff alleged in the petition to cancel that defendant's use of its marks would weaken and dilute the distinctiveness of plaintiff's marks, plaintiff has not argued this as a dilution claim and we have not considered it as such.

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contains the tag line "Rediscovering Our *Christian Heritage* on the front cover;" articles of amendment changing the name of the Christian Conservative Center, Inc. in Louisville, Kentucky to the *Christian Heritage Center, Inc.*; and proclamations of *Christian Heritage Week* by governors in several states.

Determining whether a mark is generic involves a two-step analysis. The first step is to identify the category of goods or services at issue. The second step is to determine whether the mark sought to be registered is understood by the relevant public primarily to refer to that category or class of goods or services. See *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999) citing *H. Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). Moreover, in the case of a mark which consists of multiple terms which are not joined in any other sense than appearing as a phrase, dictionary definitions of the separate words are not sufficient to establish the genericness of the mark in its entirety. Rather, there must be evidence that the mark has been used by the defendant or others in a generic manner. Id.

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Applying these principles here, we find that the evidence fails to demonstrate that CHRISTIAN HERITAGE MINISTRIES and CHRISTIAN HERITAGE TOURS, INC. are the generic names for defendant's educational services and travel tour services, respectively. There is no showing that either designation, in its entirety, has actually been used in a generic manner by defendant or others in connection with such services. Also, we are not persuaded on this record that the term CHRISTIAN HERITAGE alone is a generic name for such services. Again, there is no evidence that this term has been used in a generic manner by defendant or others in connection with educational services and travel tours. On the contrary, the several articles of incorporation or amendment which are of record indicates that third parties have used "Christian Heritage" as part of their trade names (e.g., Christian Heritage Center, Christian Heritage Church, Christian Heritage Foundation). Also, while we note the dictionary definitions of the words "Christian" and "heritage," the term CHRISTIAN HERITAGE is not in the nature of a compound word and, thus, the dictionary definitions of the individual words are not sufficient to establish that the term, in its entirety, is generic for defendant's services.

Although we do not believe that either of defendant's marks rises to the level of genericness, we do believe that the components of both marks are merely descriptive, and that the resulting combinations are also merely descriptive. Defendant has conceded the descriptiveness of CHRISTIAN HERITAGE MINISTRIES inasmuch as it has sought registration under Section 2(f). Moreover, the term CHRISTIAN HERITAGE clearly describes the subject matter of defendant's educational services and travel tours. This is evidenced by the fact that defendant itself describes its educational services as being in the "field of America's christian heritage." Also, there is no question that defendant's travel tours are in the same field. Further, the words "ministries" and "tours" describe the nature of defendant's respective services.

The remaining question, then, is whether the marks have become distinctive of defendant's services. Briefly, defendant's evidence in this regard consists of the declaration of its president, Catherine Millard. Ms Millard attests to the following facts:

- that CHRISTIAN HERITAGE TOURS, INC. has been used since 1984 and that CHRISTIAN HERITAGE MINISTRIES has been used since 1991;
- that since 1984 defendant has conducted thousands of travel tours;

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- that since 1984 defendant has distributed thousands of brochures about its tours and has sold approximately 25,000 Christian Heritage Tours videotapes focusing on sites in Washington, D.C. and Philadelphia;
- that defendant, under the mark CHRISTIAN HERITAGE MINISTRIES, organizes and promotes "Christian Heritage Week" in 46 states with celebrations which include lectures, slide presentations, and television and radio interviews with defendant's president;
- that defendant's Christian Heritage News newsletter highlights the educational services offered under the mark CHRISTIAN HERITAGE MINISTRIES and is distributed to hundreds of persons and organizations in the United States and worldwide;
- that defendant's CHRISTIAN HERITAGE TOURS, INC. travel tours and CHRISTIAN HERITAGE MINISTRIES educational services have been the subject of numerous newspaper and magazine articles; and
- that at least since 1986 defendant has appeared at trade shows and conventions where it has displayed information about its services.

In addition, defendant has submitted four declarations of individuals who are familiar with defendant's travel tours and educational services, and who testified that they recognize the marks CHRISTIAN HERITAGE TOURS, INC. and CHRISTIAN HERITAGE MINISTRIES as identifying and distinguishing defendant's services from those of others.

After careful review of defendant's evidence of acquired distinctiveness, including the declaration relating to the promotion and use of the marks over the years and the affidavits of individuals who state that

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they recognize defendant's marks as identifying and distinguishing defendant's services from those of others, we agree with defendant that its evidence of extensive and successful use and promotion of the marks demonstrates that the marks have become distinctive of its services and that they are entitled to registration on the Principal Register.⁷ In view of our finding that the term CHRISTIAN HERITAGE is not generic for defendant's services, defendant is not required to disclaim this term in its application.

Decision: The notice of opposition is dismissed and the petition to cancel is denied.

⁷ We should point out that defendant's evidence establishes that CHRISTIAN HERITAGE TOURS, INC. had acquired secondary meaning as of the time of registration (November 8, 1994), and that the mark currently possesses secondary meaning. If defendant had failed to establish secondary meaning either at the time of registration or currently, the petition to cancel would be granted. See *Neapco Inc. v. Dana Corp.*, 12 USPQ2d 1746, 1747 (TTAB 1989). ["[I]f it is established either that as of the time of registration, the registered mark was merely descriptive and lacked secondary meaning, or that as of [the time of trial], the mark is merely descriptive and lacks secondary meaning, the cancellation petition would be granted."]