

**IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF SOUTH CAROLINA  
CHARLESTON DIVISION**

The Right Reverend Charles G. vonRosenberg, individually and in his capacity as the former Provisional Bishop of The Episcopal Church in South Carolina and The Right Reverend Gladstone B. Adams, III, individually and in his capacity as the Provisional Bishop of The Episcopal Church in South Carolina,  
Plaintiffs,

The Episcopal Church,  
Plaintiff in Intervention

vs.

The Right Reverend Mark J. Lawrence, et al.  
Defendants.

**CIVIL ACTION NUMBER:  
2:13-cv-00587-RMG**

**DEFENDANTS, THE PROTESTANT  
EPISCOPAL CHURCH OF THE  
PARISH OF SAINT MICHAEL, IN  
CHARLESTON, IN THE STATE OF  
SOUTH CAROLINA, VESTRY AND  
CHURCH WARDENS OF THE  
EPISCOPAL CHURCH OF THE  
PARISH OF ST. HELENA, VESTRY  
AND CHURCH WARDENS OF THE  
EPISCOPAL CHURCH OF THE  
PARISH OF ST. JOHN’S  
CHARLESTON COUNTY, THE  
VESTRIES AND CHURCHWARDENS  
OF THE PARISH OF ST. ANDREW,  
AND TRINITY EPISCOPAL CHURCH  
MEMORANDUM IN SUPPORT OF  
MOTION FOR SUMMARY  
JUDGMENT**

Pursuant to Rule 56 of the Federal Rules of Civil Procedure, Defendants The Protestant Episcopal Church of the Parish of Saint Michael, in Charleston, in the State of South Carolina, Vestry and Church Wardens of The Episcopal Church of the Parish of St. Helena, Vestry and Church Wardens of The Episcopal Church of the Parish of St. John’s Charleston County, The Vestries and Churchwardens of the Parish of St. Andrew, and Trinity Episcopal Church (collectively “Defendants”) hereby submits this Memorandum in Support of its Motion for Summary Judgment against Plaintiff Adams and vonRosenberg (“Plaintiff Bishops”), Plaintiff-in-

Intervention The Episcopal Church in South Carolina (“TECSC”), and Plaintiff-in-Intervention The Episcopal Church (“TEC”) (collectively “Plaintiffs”).

## INTRODUCTION

Filed in 2013, this trademark action is one iteration of a number of ongoing lawsuits between the parties since the Defendant Diocese and the Defendant Parishes parted ways with TEC and those later formed TECSC in 2012. In the South Carolina State Court proceeding, the court found that the Diocese disassociated from the unincorporated association TEC and the parishes remained associated with the Diocese. The Defendants retained their corporate identities and names after this disassociation of the Diocese. A fractured South Carolina Supreme Court issued five separate opinions on the issues appealed by TEC and TECSC and on remitter, the state trial court is determining the application of those five separate opinions. Plaintiffs amended this action to raise Lanham Act claims against Bishop Lawrence, the Diocese, and the associated Parishes.

Earlier this year, 2018, Plaintiffs amended their pleadings to name the Defendant Parishes, including Defendants, based on Parishes’ alleged use of the word “episcopal” and public association with a “diocese.” Plaintiffs’ claims fail as a matter of law for a number of reasons. First, as shown by briefing submitted by the Defendant Diocese, which Defendants specifically incorporates by reference herein, the marks which form the basis of Plaintiffs’ claims are generic and, thus, invalid. Second, Defendants’ use of its marks predates both the existence of TEC and TECSC and their use of any alleged marks. Without priority, Plaintiffs claims against Defendants fail. Next, even if Plaintiffs are senior owners of valid marks, they have not—and cannot—introduce evidence supporting the elements of their causes of action. Finally, Plaintiffs’ delay in

naming Defendants in this case is fatal under the doctrine of laches. For these reasons, Defendants are entitled to summary judgment on all of Plaintiffs' claims.

### **FACTUAL BACKGROUND**

#### **A. Vestries and Church-wardens of the Episcopal Churches of the Parishes of Saint Philip and Saint Michael, Charleston**

The Parish of Saint Michael, in Charleston, in the State of South Carolina was established by an Act of the Colonial Assembly, Act No. 795 entitled "An Act for Dividing the Parish of St. Philip's, Charlestown, and for Establishing Another Parish in the said Town, by the Name of the Parish of St. Michael..." adopted June 14, 1751. Exhibit 1 (SMI-1). The Protestant Episcopal Church of the Parish of Saint Michael, in Charleston, in the State of South Carolina is a legislatively chartered South Carolina non-profit corporation, originally incorporated as the "VESTRIES AND CHURCH-WARDENS OF THE EPISCOPAL CHURCHES OF THE PARISHES OF SAINT PHILIP AND SAINT MICHAEL, CHARLESTON," by Act of the General Assembly of the State of South Carolina on March 24, 1785, Act No. 1278 entitled "An Act to Incorporate the Vestries and Church-wardens of the Episcopal Churches in the Parishes of Saint Philip and Saint Michael, in Charleston; and for other Purposes." Exhibit 2 (SMI-2). This Act was adopted as a result of a joint petition for incorporation submitted by the Vestries and Wardens of the Parish of St. Philip and the Vestries and Wardens of the Parish of St. Michael and to the General Assembly of South Carolina pursuant to Article 38 of the South Carolina Constitution of 1778. Exhibit 3 (SMI-40). In November, 1791, the Vestry and Church Wardens of the Parish of Saint Philip's and the Vestry and Wardens of Parish of Saint Michael's separately petitioned the General Assembly of South Carolina to separate the two churches into two separate corporations. Exhibit 4 (SMI-5). As a result, the legislatively chartered corporation known as the

“Vestries and Church-wardens of the Episcopal Churches of the Parishes of St. Philip and St. Michael, Charleston,” was split into two separate Legislatively chartered corporations known respectively as “The Protestant Episcopal Church, of the Parish of Saint Philip, in Charleston, in the State of South Carolina” and “THE PROTESTANT EPISCOPAL CHURCH, OF THE PARISH OF SAINT MICHAEL, IN CHARLESTON, IN THE STATE OF SOUTH CAROLINA” (“St. Michaels”) by Act of the General Assembly of the State of South Carolina on December 20, 1791, Act No. 1533 entitled “AN ACT to make and establish the Vestries and Churchwardens of the Episcopal Churches of the Parishes of St. Philip and St. Michael, in Charleston, two separate and distinct bodies politic and corporate, and to enlarge their powers.” Exhibit 5 (SMI-4). St. Michaels owns the following South Carolina state trademark registrations for the following names: The Protestant Episcopal Church, of the Parish of Saint Michael, in Charleston, in the State of South Carolina – December 20, 1791; St. Michael’s Episcopal Church – June 1, 1751; and St. Michael’s Church – February 6, 1796. Exhibit 6 (SMI-17).

The Plaintiff-in-Intervention The Episcopal Church (“TEC”) has not provided any facts to support its causes of action against St. Michaels. TEC’s Rule 30(b)(6) designee, Chief Operating Officer Geoffrey T. Smith, testified TEC was not aware of any instance where a member of the public became confused that St. Michaels was affiliated with TEC. Exhibit 7 - Smith Depo. p. 177:23-178:2, 180:14-19, 181:17-20 (Oct. 23, 2018). TEC’s only evidence that St. Michaels held itself out to the public as being affiliated with TEC was that St. Michaels referenced the Diocese of South Carolina on its website. *Id.* at p. 178:3-12. TEC testified that St. Michaels does not use any of the registered marks of TEC. *Id.* at p. 179:1-11, 181:25-182:4. Neither could identify any activity of St. Michael that has led to dilution of their marks, either through blurring or tarnishment. *Id.* at p. 181:21-24. Nor could TEC identify anyone being misled by St. Michaels that they were

affiliated with TEC, *Id.* at p. 182:16-19, and TEC was unable to identify any repeat actions by St. Michael that they allege created public confusion or false perceptions. *Id.* at p. 182:5-11. TEC admitted they have suffered no harm from St. Michaels. *Id.* at p. 182:13-15.

Plaintiff Adams and vonRosenberg, and Plaintiff-in-Intervention The Episcopal Church in South Carolina (collectively “TECSC”) similarly provided no evidence of public confusion, trademark infringement, or false advertising by St. Michaels. TECSC’s 30(b)(6) designee, The Right Reverend Gladstone B. Adams, III, stated that St. Michaels use of the word “Episcopal” has caused confusion. Exhibit 8 – Adams Depo. p. 256:23-257: 21 (Oct. 22, 2018). TECSC’s designee testified a single instance where he claimed St. Michaels used “The Episcopal Church,” *Id.* at p. 259:6-11, but he was unable to identify where they used that term or the names of the people who heard its use and told him. *Id.* at p. 259:12-19. He also identified the use of the word “Episcopal” and the use of the Book of Common Prayer as St. Michaels activities that infringed TEC marks. *Id.* at p. 259:12-260:25. However, TEC’s designee, Geoffrey Smith, specifically testified that the use of the TEC Book of Common Prayer and the TEC Hymnal do not infringe on TEC’s marks. Exhibit 7 at p. 70:19-71:7. Finally, he was aware of one check in the past that went to St. Michaels which forwarded the check to TECSC immediately but did not relay the name of the person or why the check was sent to St. Michael. *Id.* at p. 261:2-18.

**B. The Vestry and Church-wardens of the Episcopal Church of the parish of St. Helena (“St. Helena”)**

St. Helena Parish was created by an Act of the Colonial Assembly, Act No. 307 entitled “An Additional Act to the Several Acts Relating to the Establishment of Religious Worship in this Province, and Not in Force in the Same, and also to the Act for Securing the Provincial Library at Charlestown in Carolina,” adopted June 7, 1712. Exhibit 9 (PCSH-2). St. Helena’s Parish is a legislatively chartered South Carolina nonprofit and eleemosynary corporation, originally

incorporated by an Act of the General Assembly, Act No. 1339 entitled “An Act to Incorporate the Vestries and Churchwardens of the Episcopal Churches in the Parishes of Saint Bartholomew, Saint Helena, and Saint John’s Colleton County” adopted on March 22, 1786. Exhibit 10 (PCSH-5). This Act was adopted as a result of a petition for incorporation submitted by the “members of the Episcopal Church of St. Helena’s parish” to the General Assembly of South Carolina on February 21, 1786 pursuant to Article 38 of the South Carolina Constitution of 1778. Exhibit 11 (PSCH-4). St. Helena owns the following South Carolina state trademark registrations for the following names: The Parish Church of St. Helena – July 1, 1712; St. Helena’s Church – July 1, 1842; St. Helena’s Episcopal Church – July 1, 1946; and The Parish Church of St. Helena (Episcopal) – July 1, 2005. Exhibit 12 (PCSH-23).

TEC has not provided any facts to support its causes of action against St. Helena. Its designee testified TEC was “not aware of any” instance where a member of the public became confused that St. Helena was affiliated with TEC. Exhibit 13 - Smith Depo. p. 183:6-10. TEC was unable to provide any evidence that St. Helena held itself out to the public that it was affiliated with TEC. *Id.* at p. 183:11-185:5. TEC also testified that St. Helena does not use any of the registered marks of TEC. *Id.* at p. 184:15-21, 190:3-9. TEC could not identify any activity of St. Helena that has led to dilution of their marks, either through blurring or tarnishment. *Id.* at p. 189:25-190:2. TEC could not identify anyone misled by St. Helena into believing that they were affiliated with TEC. *Id.* at p. 183:6-10, 190:21-24. TEC could not identify any repeat actions by St. Helena that TEC alleges created public confusion or false perceptions. *Id.* at p. 190:10-16. TEC admitted they have suffered no harm from St. Helena, *Id.* at p. 190:18-20. TEC’s designee admitted that he was unable to identify any instance of confusion that was brought to him by TECSC. *Id.* at p. 187:23-188:3. TEC’s designee also admitted they only investigate potential

infringement when one of their bishops complains, *Id.* at 33:8-21, since there is no proactive approach to protecting TEC's marks. *Id.* at p. 40:6-17.

TECSC similarly provided no evidence of confusion, trademark infringement, or false advertising by St. Helena. Its designee testified that they have no evidence of anyone in the public being confused as to whether St. Helena was affiliated with TEC or TECSC. Exhibit 14 – Adams Depo. p. 263:16:20. He testified the only instances of trademark infringement by St. Helena was through their use of the Book of Common Prayer and the Hymnal and having “The Episcopal Church” in its title. *Id.* at p. 261:23-262:5, 262:13-19, 263:9-12. However, TEC's designee, specifically testified that the use of the TEC Book of Common Prayer and the TEC Hymnal do not infringe on TEC's marks. Exhibit 7 at p. 70:19-71:7. TECSC's designee admitted that St. Helena's formation predated the formation of TEC. Exhibit 13 – Adams Depo. at p. 262:20-263:1. Finally, he was not aware of any person who had misdirected funds to St. Helena them to go to TEC or TECSC. *Id.* at p. 264:14-19. TECSC's designee stated that St. Helena's “association on the [Diocese of South Carolina] website” was an instance of trademark infringement by St. Helena. *Id.* at p. 264:3-8.

**C. The Vestry and Church-wardens of the Episcopal Church of the parish of St. John's Colleton county (“St. John's”)**

St. John's Parish was created by an Act of the Colonial Assembly of South Carolina, Act No. 567 entitled “An Act for Dividing the Parishes of St. Paul's in Colleton County, and Prince George Winyaw, in Craven County,” adopted April 9, 1734. Exhibit 15 (SJC-1). St. John's is a legislatively chartered South Carolina nonprofit and eleemosynary corporation, incorporated by an Act of the General Assembly, Act No. 1339 entitled “An Act to Incorporate the Vestries and Church-wardens of the Episcopal Churches in the Parishes of Saint Bartholomew, Saint Helena, and Saint John's Colleton county” adopted on March 22, 1786. Exhibit 16 (SJC-2). This Act was

adopted as a result of a petition for incorporation submitted by “the Members of the Episcopal Church in Saint John’s Parish Colleton County” to the General Assembly of South Carolina on February 18, 1786 pursuant to Article 38 of the South Carolina Constitution of 1778. Exhibit 17 (SJC-3).

TEC was unable to provide any facts to support their causes of action against St. John’s. Its designee testified TEC was not aware of any instance where a member of the public became confused that St. John’s was affiliated with TEC. Exhibit 18 - Smith Depo. p. 202:21-203:2. TEC was unable to provide any evidence that St. John’s held itself out to the public as being affiliated with TEC. *Id.* at p. 201:23-202:3, 202:14-17. TEC also testified that St. John’s does not use any of the registered marks of TEC. *Id.* at p. 201:12-16, 202:4-6. The only activity of St. John’s that TEC claimed that has led to dilution of their marks, either through blurring or tarnishment was the use of the Diocese of South Carolina marks on St. John’s website. *Id.* at p. 201:17-22. Yet TEC could not identify anyone being misled by St. John’s that they were affiliated with TEC. *Id.* at p. 203:17-10. TEC could not identify any evidence regarding use of TEC’s marks by St. John’s. *Id.* at p. 202:4-6. TEC was unable to identify any repeat actions by St. John’s that they allege created public confusion or false perceptions. *Id.* at p. 202:21-203:2. TEC admitted they have suffered no harm from St. John’s, *Id.* at p. 203:4-6

TECSC similarly provided no evidence of public confusion, trademark infringement, or false advertising by St. John’s. Its designee stated that TECSC has no evidence of anyone in the public confused as to whether St. John’s was affiliated with TEC or TECSC. Ex. 19 – Adams Depo. p. 271:17-21. He testified there were instances of trademark infringement by St. John’s through their use of the Book of Common Prayer and the Hymnal and having “The Episcopal Church” in its title. *Id.* at p. 271:3-12. However, TEC’s designee, Geoffrey Smith, specifically



testified that the use of the TEC Book of Common Prayer and the TEC Hymnal do not infringe on TEC's marks. Exhibit 18 at p. 70:19-71:7. TECSC's designee was unaware of any other infringing activities by St. John's as to TEC or TESC. Exhibit 8 – Adams Depo. at p. 271:13-16. Finally, he was not aware of any person who had misdirected funds to St. John's who intended those funds to go to TEC or TECSC. *Id.* at p. 272:16-21. TECSC's designee stated that St. John's "association on the [Diocese of South Carolina] website" was claimed to be trademark infringement by St. John's. *Id.* at p. 272:5-10.

**D. The Vestries and Churchwardens of the Parish of St. Andrew ("Old St. Andrew")**

The Parish of St. Andrew was formed by Act of the General Assembly of South Carolina on November 30, 1706, Act No. 256 entitled "An Act for the Establishment of Religious Worship in this Province, according to the Church of England, and for the erecting of Churches for the Public Worship of God, and also for the Maintenance of Ministers and the Building Convenient Houses for them," which divided the Province into various parishes naming "one upon the Ashley River, which shall be called by the name of St. Andrews." Exhibit 20 (OSA-1). Old St. Andrew is a legislatively chartered South Carolina non-profit corporation, originally incorporated, as "The Vestries and Churchwardens of the Parish of St. Andrew," by Act of the General Assembly of the State of South Carolina on March 24, 1785, Act No. 1289 entitled "An Ordinance for Vesting Powers in the Respective Vestries and Churchwardens of the Episcopal Churches in the Parishes of St. Paul and St. Andrew, and their successors for the time being, for the benefit of the said respective churches and congregations." Exhibit 21 (OSA-3). The Act also proscribed the "vestries and churchwardens" could "appoint and choose a proper Episcopal clergyman and minister" for the church. *Id.*

TEC has not provided any facts to support its causes of action against Old St. Andrew. Its designee testified TEC has no knowledge of actual misrepresentation where a member of the public became confused that Old St. Andrew was affiliated with TEC. Exhibit 22 - Smith Depo. p. 208:20-209:10. TEC testified that Old St. Andrew does not use any of the registered marks of TEC. *Id.* at p. 209:6-10. TEC's designee testified that Old St. Andrew referring to themselves as Old St. Andrew's Episcopal Church was an activity that has led to the dilution of TEC's marks, either through blurring or tarnishment. *Id.* at p. 209:15-210:2. TEC could not identify anyone being misled by Old St. Andrew that they were affiliated with TEC. *Id.* at p. 210:10-18. TEC was unable to provide any factual evidence that Old St. Andrew held itself out the public as being affiliated with TEC. *Id.* at p. 209:11-14. TEC was unable to identify any repeat actions by Old St. Andrew that they allege created public confusion or false perceptions. *Id.* at p. 210:3-10. TEC admitted they have suffered no harm from Old St. Andrew, *Id.* at p. 210:12-14.

TECSC similarly provided no evidence of public confusion, trademark infringement, or false advertising by Old St. Andrew. Its designee could not provide any specific instance of anyone in the public confused as to whether Old St. Andrew was affiliated with TEC or TECSC besides a story he had heard, but he could not identify the person who had first-hand knowledge. Exhibit 8 – Adams Depo. p. 277:8-278:25, 279:6-11. He testified there were instances of trademark infringement by Old St. Andrew through their use of the Book of Common Prayer and the Hymnal and having “Episcopal” on an exterior sign. *Id.* at p. 274:21-275:9. However, TEC's designee specifically testified that the use of the TEC Book of Common Prayer and the TEC Hymnal do not infringe on TEC's marks. Exhibit 22 – Smith Depo. at p. 70:19-71:7. While TECSC's designee claimed Old St. Andrew used TEC's trademark on their exterior sign, Exhibit 8 – Adams Depo. at 275:22-276:2, he has not seen the contents of the sign personally. *Id.* at p. 275:10-14. TECSC's

designee was unaware of any other infringing activities by Old St. Andrew as to TEC or TESC. *Id.* at p. 279:1-5. Finally, he was not aware of any person who had misdirected funds to Trinity Edisto who intended those funds to go to TEC or TECSC. *Id.* at p. 281:13-17. TECSC's designee stated that Old St. Andrew's "association on the [Diocese of South Carolina] website" was an instance of trademark infringement by Old St. Andrew. *Id.* at p. 280:10-15.

#### **E. Trinity Episcopal Church ("Trinity Edisto")**

Trinity Edisto was originally created as a Chapel of Ease on Edisto Island, pursuant to Petition of the citizens of Edisto Island, by the General Assembly of South Carolina on April 7, 1770, Act No. 996 entitled "An Act for Establishing a Chapel of Ease on Edisto Island, in the Parish of St. John, Colleton County, and also a Chapel of East in the Upper Part of the Parish of St. John, Berkeley County, and for Obliging the Rectors or Ministers of the Respective Parishes to Perform Divine Worship in the said Chapels." Exhibit 24 (TED-1). Trinity Edisto was incorporated as a church under the name "THE PROTESTANT EPISCOPAL CHURCH ON EDISTO ISLAND" on December 21, 1793, Act No. 1574 entitled "An Act to incorporate the Episcopal Church on Edisto Island, the Primitive Methodist of Trinity Church, Charleston, and the Primitive Methodist of Ebenezer Church, Georgetown" by the General Assembly of South Carolina as "The Episcopal Church on Edisto Island." Exhibit 25 (TED-2). The Act was adopted as a result of a petition for incorporation submitted by the "Members of the Episcopal Church on Edisto Island" to the General Assembly of South Carolina on November 8, 1793. Exhibit 26 (TED-3). Trinity Edisto changed its name from "The Episcopal Church on Edisto Island" to "Trinity Episcopal Church" in the 1800's.<sup>1</sup> Trinity Edisto has also been known as Trinity, Trinity Episcopal

---

<sup>1</sup> Documentation of Trinity Edisto's name change that occurred in the 1800's has been misplaced and cannot be located.

Church, Trinity Episcopal Church of Edisto, and The Episcopal Church of Edisto Island. Exhibit 27 (TED-5).

TEC has not provided any facts to support its causes of action against Trinity Edisto. Its designee testified TEC has “no knowledge of actual misrepresentation” where a member of the public became confused that Trinity Edisto was affiliated with TEC. Exhibit 28 - Smith Depo. p. 191:9-14. TEC claims that Trinity Edisto’s use of “Trinity Episcopal Church” on its website and exterior sign and the term “Episcopal Church” on its Facebook page indicates it is holding itself on as being affiliated with TEC. *Id.* at p. 192:9-193:3, but TEC testified that Trinity Edisto does not use any of the registered marks of TEC. *Id.* at p. 193:4-8, 18-23. TEC could not identify any activity of Trinity Edisto that has led to dilution of their marks, either through blurring or tarnishment. *Id.* at p. 193:9-17. TEC could not identify anyone being misled by Trinity Edisto that they were affiliated with TEC. *Id.* at p. 194:12-14. TEC was unable to provide any factual evidence that Trinity Edisto held itself out the public as being affiliated with TEC, *Id.* at p. 195:10-14, and TEC was unable to identify any repeat actions by Trinity Edisto that they allege created public confusion or false perceptions. *Id.* at p. 193:24-194:5. TEC stated the harm they suffered was “confusion to people who might otherwise think this is an Episcopal Church”, but could not identify anyone who was misled by Trinity Edisto that they were affiliated with TEC. *Id.* at p. 194:7-14.

TECSC similarly provided no evidence of public confusion, trademark infringement, or false advertising by Trinity Edisto. Its designee could not provide any specific instance of confusion by a member of the public as to whether Trinity Edisto was affiliated with TEC or TECSC besides a story he heard, but he could not identify the person who had first-hand knowledge. Exhibit 29 – Adams Depo. p. 265:13-266:3. He testified there were instances of

trademark infringement by Trinity Edisto through their use of the Book of Common Prayer and the Hymnal and having “The Episcopal Church” in its Trinity Edisto’s name. *Id.* at p. 267:11-268:14. However, TEC’s designee specifically testified that the use of the TEC Book of Common Prayer and the TEC Hymnal do not infringe on TEC’s marks. Exhibit 7 – Smith Depo. at p. 70:19-71:7. TECSC’s designee was unaware of any other infringing activities by Trinity Edisto as to TEC or TESC. Exhibit 28 – Adams Depo. at p. 265:9-12. Finally, he was not aware of any person who had misdirected funds to Trinity Edisto who intended those funds to go to TEC or TECSC. *Id.* at p. 266:14-19. TECSC’s designee stated that Trinity Edisto “association on the [Diocese of South Carolina] website” was an instance of trademark infringement by Trinity Edisto. *Id.* at p. 264:20-265:1, 268:15-20.

### **LEGAL STANDARD**

Defendants incorporates herein by reference all of the legal arguments and authorities submitted to the court by The Protestant Episcopal Church, of the Parish of Saint Philip, in Charleston, in the State of South Carolina, and those of the Defendants The Rt. Rev. Mark J. Lawrence (“Bishop Lawrence”) and The Protestant Episcopal Church In The Diocese of South Carolina (“Diocese of South Carolina”) regarding trademark and Lanham Act claims.

### **ARGUMENT**

#### **I. Plaintiffs Cannot Establish Prior Use of a Protectable “The Episcopal Church” Mark**

It is a fundamental proposition of trademark law that “as between conflicting claimants to the right to use the same mark, priority of appropriation determines the question.” *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 100 (1918); accord *George & Co. v. Imagination Entm’t Ltd.*, 575 F.3d 383, 400 (4th Cir. 2009). The prior use of a mark by a defendant therefore is not actionable, and the evidentiary presumptions attached to any registration acquired by a latter-

day plaintiff are void as to that prior user. *See* 15 U.S.C. §§ 1065, 1115(b). Here, Plaintiffs have failed to make showings of prior use in multiple respects, and that failure mandates the summary disposition of their claims against the Defendants.

Defendants are entitled to summary judgment as to all Plaintiffs' trademark-based causes of action because Defendants, and not TEC, are the prior users of a mark consisting in part of "The Episcopal Church." Although TEC claims to have been founded as a denomination in 1789, its Second Amended Complaint-in-Intervention fails to identify the service mark under which TEC operated at that time. TEC's filings in the USPTO claim a date of first use of "The Episcopal Church" as a service mark only as early as January 1, 1967, and a date of first use of "The Protestant Episcopal Church in the United States of America" only as early as January 1, 1836. To the extent TEC claims dates earlier than these, it must prove them by clear and convincing evidence:

[TEC] is not bound by the date of first use alleged in his application[s] for registration... [It] is entitled to carry the date of first use back to a prior date by proper evidence. However, where one has alleged in his application for a trade-mark a date of earliest use and subsequently by proof attempts to show an earlier date, he is then under a heavy burden, and his proof must be clear and convincing.

*Elder Mfg. Co. v. Int'l Shoe Co.*, 194 F.2d 114, 118 (C.C.P.A. 1952); *accord Martahus v. Video Duplication Serv., Inc.*, 3 F.3d 417, 423 n.7 (Fed. Cir. 1993); *Harod v. Sage Prods. Inc.*, 188 F. Supp. 2d 1369, 1377 (S.D. Ga. 2002).

Plaintiffs have failed to make such a showing, and, of critical significance, *TEC would be the junior user of an "episcopal" mark even if the Court credits the 1789 date of first use claimed in TEC's complaint.* The undisputed record evidence and testimony establish Defendants separately petitioned the South Carolina General Assembly to incorporate their church under the

1778 Constitution of the State of South Carolina.<sup>2</sup> Defendants were incorporated in South Carolina under the marks:

- VESTRIES AND CHURCH-WARDENS OF THE EPISCOPAL CHURCHES OF THE PARISHES OF SAINT PHILIP AND SAINT MICHAEL, CHARLESTON (March 24, 1785);<sup>3</sup>
- THE VESTRY AND CHURCH-WARDENS OF THE EPISCOPAL CHURCH OF THE PARISH OF ST. HELENA (March 22, 1786);
- THE VESTRY AND CHURCH-WARDENS OF THE EPISCOPAL CHURCH OF THE PARISH OF ST. JOHN'S COLLETON COUNTY (March 22, 1786);<sup>4</sup>
- THE VESTRIES AND CHURCHWARDENS OF THE PARISH OF ST. ANDREW (March 24, 1785); and
- THE PROTESTANT EPISCOPAL CHURCH ON EDISTO ISLAND (December 21, 1793).<sup>5</sup>

Defendants have operated continuously under that mark (or a derivation of said mark) since then.

**a. Evolution of Defendants Marks**

Minor evolutions in the Defendants<sup>6</sup> continuous use of its mark does not affect Defendant's priority of rights. Trademark law recognizes and accommodates the need to update marks from time to time:

Minor changes in a mark which do not change the basic overall commercial impression created on buyers will not constitute any abandonment and will not interrupt the user's chain of ownership back to adoption and use in the original form. That is, the owner will

---

<sup>2</sup> Parishes filed incorporation Petitions for: St. Michael - March 1785, St. Helena - February 21, 1786, St. John's - February 18, 1786, Trinity Edisto - November 8, 1793

<sup>3</sup> That evidence and testimony also establishes that St. Michael petitioned the South Carolina General Assembly in November 1791 to split the incorporation of their churches. Ex. 4. St. Michael was incorporated in South Carolina under the mark THE PROTESTANT EPISCOPAL CHURCH, OF THE PARISH OF SAINT MICHAEL, IN CHARLESTON, IN THE STATE OF SOUTH CAROLINA. Ex. 5.

<sup>4</sup> In 1786, John's Island was located in Colleton County. The parish changed its name to THE VESTRY AND CHURCH WARDENS OF THE EPSICOAPL CHURCH IN THE PARISH OF ST. JOHN'S CHARLESTON COUNTY once their location became part of Charleston County.

<sup>5</sup> Trinity Edisto has also been known as Trinity, Trinity Episcopal Church of Edisto, and The Episcopal Church of Edisto Island during that time frame.

<sup>6</sup> Specifically, St. Michael (Legislature splitting the corporation and removing ST. PHILIP from the name), St. John's (substituting CHARLESTON COUNTY for COLLETON COUNTY), and Trinity Edisto (changing its name in the 1800's from THE PROTESTANT EPISCOPAL CHURCH ON EDISTO ISLAND to TRINITY EPISCOPAL CHURCH).

be permitted to “tack-on” the prior format for priority purposes....

Because small and insignificant changes in trademark format are a minor element on which to base a drastic holding of abandonment, the courts hardly ever find abandonment where the key element of the mark continues through new formats.

2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 17:27; *see also Sands, Taylor & Wood Co. v. Quaker Oats Co.*, 978 F.2d 947, 955 (7th Cir. 1992) (no abandonment or loss of priority where mark evolved from THIRST-AID—FIRST AID FOR YOUR THIRST to THIRST-AID); *Miami Credit Bureau, Inc. v. Credit Bureau, Inc.*, 276 F.2d 565, 568 (5th Cir. 1960) (“The [names] ‘Miami Credit Bureau’ and ‘Credit Bureau of Greater Miami,’ if not the grammatical equivalent of each other, are so obviously synonymous as to be self-refutation of the contention that the [plaintiff] abandoned the former trade name when it began to use the latter ....”); *Drexel Enters. v. Richardson*, 312 F.2d 525, 527 (10th Cir. 1962) (no abandonment or loss of priority where mark evolved from HERITAGE to HERITAGE-HENDRON back to HERITAGE).

**b. Defendants’ First Use pre-dates Plaintiffs’ First Use**

Here, Defendants’ priority tacks back to its adoption of their marks.<sup>7</sup> Plaintiffs’ use of their claimed marks therefore postdates Defendants’ use of its full name by almost half a century. Plaintiffs consequently have failed to state trademark-related causes of action against Defendants, and the Court therefore should find in favor of Defendants. *See, e.g., Am. Express Co. v. Goetz*, 515 F.3d 156, 160-61 (2d Cir. 2008) (affirming summary dismissal of trademark claims based on counterclaim plaintiff’s inability to prove prior use of disputed mark); *Cent. Mfg. Co. v. Brett*, 78 U.S.P.Q.2d 1662, 1669 (N.D. Ill. 2005) (granting defense motion for summary judgment in light

---

<sup>7</sup> South Carolina General Assembly incorporation dates: St. Michael – March 24, 1785, St. Helena – March 22, 1786, St. John’s – March 22, 1786, Old St. Andrew – March 24, 1785, Trinity Edisto – December 21, 1793



of plaintiffs' inability to prove prior use of disputed mark).<sup>8</sup>

## **II. TECSC Trademark Infringement Claims**

For reasons more fully argued in Defendant Diocese's motions for summary judgment, Defendants are entitled to summary judgment on Plaintiff Bishops' and TECSC's trademark-based claims because the Defendant Diocese—not the Plaintiffs—is the registrant, owner, and senior user of the “diocese” marks. Rather than repeat the Defendant Diocese's arguments concerning its ownership and priority of use of the “diocese” marks, Defendants specifically incorporates by reference those portions of the Defendant Diocese's motions for summary judgment.<sup>9</sup> As set forth below, the Plaintiff Bishops and TECSC cannot make out the elements of their remaining claim for trademark-based claims and, thus, Defendants are entitled to summary judgment.

## **III. TEC Trademark Claims - Confusion is Unlikely as a Matter of Law**

TEC and TECSC (“Plaintiffs”) cannot establish likelihood of confusion. Each of the factors in the likelihood of confusion inquiry favors a finding of noninfringement in this case. *Variety Stores, Inc.*, 888 F.3d at 660. While a likelihood of confusion analysis can often involve disputed issues of fact, “summary judgment is appropriate if, based on the undisputed facts in the summary judgment record, no reasonable jury could find a likelihood of confusion.” *Fuel Clothing Co. v. Nike, Inc.*, 7 F. Supp. 3d 594, 609 (D.S.C. 2014) (internal citations and quotations omitted).

TEC's marks are generic and also conceptually and commercially weak and entitled to a narrow scope of protection. *See* Memo. in Support of Mot. for Summary Judgment, Diocese of

---

<sup>8</sup> Defendants adopt and incorporate the argument of the Diocese and Bishop Lawrence that it is entitled to summary judgment because Plaintiffs cannot establish the marks acquired distinctiveness, or secondary meaning, prior to Defendants' first use of its marks.

<sup>9</sup> TECSC's designee admitted that TECSC was blocked from using the Diocese of South Carolina marks and are not terms of TECSC. Exhibit 8 – Adams Depo. at 58:11-59:4 & 210:1-212:4.

South Carolina and Bishop Mark Lawrence (Dec. 7, 2018). The widespread undisputed third-party use of “episcopal,” and “episcopal church” upon which, to reiterate, TEC itself has successfully relied for its own purposes, is compelling evidence that confusion is unlikely between the parties’ marks. *See, e.g., Renaissance Greeting Cards, Inc. v. Dollar Tree Stores, Inc.*, 227 F. App’x 239, 243 (4th Cir. 2007) (affirming grant of defense motion for summary judgment based in part on weakness of plaintiff’s mark as documented by third-party use); *Fuel Clothing Co.*, 7 F. Supp. 3d at 612 (summary judgment of noninfringement based in part on third-party use); *see also Petro Stopping Ctrs.*, 130 F.3d at 93 (holding third-party use of similar marks and lack of actual confusion to be probative of mark weakness).

Defendants do not use TEC’s marks and the only similar words in their names are the generic words, “episcopal” and “church.” “It is settled ... a manufacturer has no right to the exclusive use of a descriptive word in connection with his goods, and if nevertheless he adopts such a trade-mark, he himself is largely to blame for the confusion which ensues when other manufacturers, with equal right, adopt similar terms to describe their products.” *Bliss, Fabyan & Co. v. Aileen Mills*, 25 F.2d 370, 372 (4th Cir. 1928). In evaluating the similarity of the marks, “the marks need only be sufficiently similar in appearance, with greater weight given to the dominant or salient portions of the marks.” *Variety Stores, Inc.* 888 F.3d at 664 (internal quotations omitted). TEC’s name and Defendants names are readily distinguishable and generic and descriptive terminology is given less weight in the likelihood-of-confusion inquiry, *see, e.g., Keebler Co. v. Murray Bakery Prods.*, 866 F.2d 1386, 1388 (Fed. Cir. 1989), an overlap of this sort has never precluded a finding as a matter of law that confusion is unlikely. *See, e.g., Glenmore Distilleries Co. v. Nat’l Distillers Prods. Corp.*, 101 F.2d 479, 479 (4th Cir. 1939) (affirming

dismissal of challenge to use of KENTUCKY TAVERN, despite shared term with plaintiff's TOWN TAVERN mark). Here, the Defendants' marks:

- THE PROTESTANT EPISCOPAL CHURCH, OF THE PARISH OF SAINT MICHAEL, IN CHARLESTON, IN THE STATE OF SOUTH CAROLINA
- THE VESTRY AND CHURCH-WARDENS OF THE EPSICOAPL CHURCH IN THE PARISH OF ST. HELENA;
- THE VESTRY AND CHURCH-WARDENS OF THE EPSICOAPL CHURCH IN THE PARISH OF ST. JOHN'S COLLETON COUNTY;
- THE VESTRIES AND CHURCHWARDENS OF THE PARISH OF ST. ANDREW
- TRINITY EPISCOPAL CHURCH

are dissimilar when compared to Plaintiff THE EPISCOPAL CHURCH and this factor weighs against the Plaintiff.

Defendants and Plaintiffs do not have a directly competitive relationship. There is no relationship; the parties' dispute arises from a very conspicuous and public split between the parties. Additionally, the Diocese which the Defendants are affiliated with has publicly maintained that there is no affiliation between the parties. This factor also weights against the Plaintiffs. *See George & Co.*, 575 F.3d at 397 (affirming summary judgment of noninfringement despite "nearly identical" goods sold by parties in overlapping markets); *Arrow Distilleries*, 117 F.2d at 351 (finding of noninfringement as a matter of law on appeal despite parties' use of identical marks for "closely related" goods).

Defendants do not provide their services side-by-side in the same manner as directly competitive goods in retail stores resulting in an absence of an overlap in individual retail outlets weighing against likely confusion. The resulting absence of an overlap in individual retail outlets weighs against likely confusion. *See, e.g., Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 263 (4th Cir. 2007) (affirming summary judgment of noninfringement in part because "there is little overlap in the individual retail stores selling the [parties'] brands"); *see also*

*Swatch AG*, 739 F.3d at 160-61 (affirming finding of noninfringement based in part on lack of overlapping retail outlets).

In affirming a finding of no likelihood of confusion as a matter of law, the Fourth Circuit has held that “[t]he intent of a junior user is relevant only if the junior user intended to capitalize on the good will associated with the senior user’s mark.” *CareFirst of Md.*, 434 F.3d at 273. In particular, mere knowledge of another party’s use is not evidence of bad-faith intent under this factor. *Swatch AG*, 739 F.3d at 161; *see also Fuel Clothing Co.*, 7 F. Supp. 3d at 620 (summary judgment of nonliability despite defendant’s awareness of plaintiff’s prior use). Defendants have acted in good faith by promoting its affiliation with the Diocese of South Carolina who conscientiously advised the public of the lack of relationship between itself, and TEC and TECSC. *See Grayson O Co.*, 856 F.3d at 319 (affirming grant of defense motion for summary judgment in part because diminished use of challenged term by defendant after learning of plaintiff’s objections constituted evidence of good faith).

The Plaintiffs fail to identify any deficiencies in the Defendants’ goods or services. This consideration therefore favors the grant of the Defendants’ motion. *See, e.g., Sly Magazine, LLC v. Weider Publ’ns LLC*, 529 F. Supp. 2d 425, 441-42 (S.D.N.Y. 2007) (summary judgment of noninfringement based in part on plaintiff’s failure to prove deficiencies in defendants’ goods); *Omega S.A. v. Omega Eng’g, Inc.*, 396 F. Supp. 2d 166, 182 (D. Conn. 2005) (same).

The high degree of sophistication of consumers of religious services precludes confusion. *See Universal Church, Inc. v. Universal Life Church/ULC Monastery*, No. 14 CIV. 5213 (NRB), 2017 WL 3669625, at \*15 (S.D.N.Y. Aug. 8, 2017) (granting defense motion for summary judgment based in part on sophistication of potential consumers for religious services), *aff’d sub nom. Universal Church, Inc. v. Toellner*, No. 17-2960-CV, 2018 WL 5783687 (2d Cir. Nov. 2,

2018). In pursuing registration of its claimed mark, “The Episcopal Church”, TEC responded to the likelihood-of-confusion-based rejection of its application by averring the following concerning the sophistication of “customers” for religious services:

This factor strongly favors a finding that the marks are not likely to be confused. Religious services are perhaps the quintessential example of an area where consumers make careful, sophisticated decisions. Individuals do not make decisions about the Church [TEC] or other religious institution[s] in which they wish to participate without considerable thought. This not a situation where marks that include common elements may be confused because decisions are made quickly, such as with the purchase of certain inexpensive consumer goods. See *Palm Bay Imports, Inc. v. Vueve Clicquot Ponsardin*, 396 F.3d 1369, 1375 (Fed. Cir. 2005) (“Purchaser sophistication may tend to minimize likelihood of confusion. Conversely, impulse purchases of inexpensive items may have the opposite effect.”).

Exhibit 30 - 2006 Letter to USPTO.

Because the Fourth Circuit has repeatedly held that consumer sophistication such as that documented in this case weighs against a finding of infringement, summary judgment is appropriate for this reason as well. *See generally Shakespeare Co. v. Silstar Corp. of Am.*, 110 F.3d 234, 242 (4th Cir. 1997) (affirming finding of noninfringement in light of sophistication of parties’ customers); *Perini Corp. v. Perini Constr., Inc.*, 915 F.2d 121, 127 (4th Cir. 1990) (vacating summary judgment of liability based on district court’s failure to consider consumer sophistication); *Durox Co. v. Duron Paint Mfg. Co.*, 320 F.2d 882, 884 (4th Cir. 1963) (affirming finding of noninfringement in light of knowledgeable nature of parties’ customers); *see also interState Net Bank v. NetB@nk, Inc.*, 348 F. Supp. 2d 340, 355 (D.N.J. 2004) (granting defense motion for summary judgment in part because “[w]hen consumers exercise heightened care in evaluating the relevant products before making purchasing decisions, courts have found there is not a strong likelihood of confusion”).

Finally, and perhaps most significantly, the Plaintiffs have failed to provide any evidence of actual confusion. The Plaintiffs did not provide an expert survey report concerning any of the parishes and the likelihood of confusion to the public. The Fourth Circuit has observed that “we are aware of no case where a court has allowed a trademark infringement action to proceed beyond summary judgment where two weak marks were dissimilar, there was no showing of a predatory intent, and the evidence of actual confusion was *de minimis*.” *George & Co.*, 575 F.3d at 400; *accord Grayson O Co.*, 856 F.3d at 320. Plaintiffs’ failure to identify cognizable evidence of actual confusion also merits a finding that confusion is unlikely as a matter of law. *See, e.g., George & Co.*, 575 F.3d at 399 (summary judgment of noninfringement based on *de minimis* evidence of actual confusion; *Arrow Distilleries*, 117 F.2d at 351 (finding no infringement as a matter of law on appeal based on absence of actual confusion); *see also Anheuser-Busch, Inc. v. L & L Wings, Inc.*, 962 F.3d 316, 320 (4th Cir. 1992) (reinstating jury verdict of noninfringement based in part on absence of actual confusion). Indeed, the absence of past actual confusion during the years the parties have coexisted creates a presumption it will not occur in the future. *Petro Stopping Ctrs.*, 130 F.3d at 95; *see also Butcher Co. v. Bouthot*, 124 F. Supp. 2d 750, 758-59 (D. Me. 2001) (summary judgment of noninfringement based in part on absence of actual confusion during only one and a half years of coexistence); *E & J Gallo v. Proximo Spirits, Inc.*, 103 U.S.P.Q.2d 1640, 1654 (E.D. Cal. 2012) (summary judgment of noninfringement based on coexistence of parties’ marks for “many months” without actual confusion).

Each of the factors in the likelihood of confusion inquiry favors a finding of noninfringement in this case, therefore summary disposition of Plaintiffs’ claims is appropriate.

**IV. Defendants are Entitled to Summary Judgment on Plaintiff Bishops and TECSC's False Advertising Claims**

Defendants are entitled to prevail as a matter of law on the false advertising cause of action asserted by the Plaintiff Bishops and TECSC because those Plaintiffs cannot make any showing under this Circuit's test for liability. *Verisign, Inc. v. XYZ.COM LLC*, 848 F.3d 292, 299 (4th Cir. 2017). Plaintiff Bishops and TECSC have failed to prove the existence of a false statement by the Defendants and failed to produce any evidence of injury suffered as a result of the alleged false statement. TECSC's 30(b)(6) designee testified they have no evidence of anyone in the public confused as to whether the Defendants are affiliated with TEC or TECSC, and further, they are not aware of any person who had misdirected funds to the Defendants who intended those funds to go to TEC or TECSC. The only statement that The Plaintiff Bishops and TECSC identified as alleged infringing activity was the Defendants have the word "episcopal" in their names and the Defendants being listed on the Diocese's website. This statement is not false or misleading as the Defendants is a member of the Diocese of South Carolina. Plaintiff Bishops and TECSC has not identified on statement made by the Defendants that are false or misleading. Nor are the Plaintiff Bishops and TECSC able to point to one challenged statement by Defendants that satisfies all five Lanham Act requirements. *Verisign*, 848 F.3d at 299. Since the Plaintiff Bishops and TECSC has failed to identify any false statement by Defendants, "failure to establish any one element is fatal to the claim," *Design Res.*, 789 F.3d at 501, and their claims fail as a matter of law.

**V. Plaintiff TEC is not Entitled to Relief Under a Dilution Theory**

The Defendants are entitled to prevail as a matter of law on TEC's dilution-based claims under Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c), for number of reasons. As in the infringement context, a finding of genericness will preclude a successful claim for dilution. *See, e.g., Firefly Digital Inc. v. Google Inc.*, 817 F. Supp. 2d 846, 867 (W.D. La. 2011). The Court

does not need to resolve the question of the validity of TEC's claimed marks to find as a matter of law that the Defendants are entitled to summary judgment on TEC's claims of dilution.

Specifically: (1) TEC cannot prove that the Defendants have commenced using a mark in commerce that allegedly is diluting the famous mark; (2) TEC has failed to show a similarity between the Defendants' mark and the famous mark gives rise to an association between the marks; and (3) TEC has failed to show that the association is likely to impair the distinctiveness of the famous mark or likely to harm the reputation of the famous mark. *Rosetta Stone Ltd.*, 676 F.3d at 168 (quoting *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 264 (4th Cir. 2007)) (affirming summary judgment of nondilution).

**a. No Record Evidence or Testimony Supports TEC's Dilution by Tarnishment Claim**

TEC cannot prove the Defendants marks are likely to tarnish TEC's claimed marks under the definition of tarnishment set for in Section 43(c)(3)(C), which provides that "dilution by tarnishment" is associated arising from the similarities between a mark or trade name and a famous mark that harms the reputation of the famous mark." 15 U.S.C. § 1125(c)(3)(C). Here TEC does not claim anything about Defendants' use of its marks harm their reputations in any way as recognized by past case law. *See, e.g., Rolls-Royce Motors Ltd. v. Davis*, 118 U.S.P.Q.2d 1851, 1859 (D.N.J. 2016) ("A mark is tarnished. . . when it is improperly associated with an . . . offensive product or service . . . presenting a danger that customers will form unfavorable associations with the mark."); *see also V Secret Catalogue, Inc. v. Moseley*, 605 F.3d 382, 388-89 (6th Cir. 2010) (sex-related goods); *Dallas Cowboys Football Club, Ltd. v. America's Team Props., Inc.*, 616 F. Supp. 2d 622, 643 (N.D. Tex. 2009) (shoddy goods); *Pepsico, Inc. v. #1 Wholesale, LLC*, 84 U.S.P.Q.2d 1040, 1044 (N.D. Ga. 2007) (contraband). There is no material dispute that the Defendants' use of its name neither tarnishes TEC's claimed marks nor is likely to do so.



**b. No Record Evidence or Testimony Supports TEC's Dilution by Blurring Claim**

The Defendants are also entitled to summary judgment as to TEC's assertion that the Defendants' marks are likely to blur the alleged fame of TEC's claimed marks under Section 43(c)(2)(B), which provides that "dilution by blurring' is [an] association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark." 15 U.S.C. § 1125(c)(2)(B).

That Section establishes six statutory factors for consideration, and each favors the Diocese:

(i) *The degree of similarity between the defendant's mark or trade name and the claimed famous mark:* Here, the only similarity between the parties' respective uses are the generic and descriptive words "episcopal" and "church," which are not a basis for a finding of liability under a blurring theory. *See, e.g., Miss Universe, L.P. v. Villegas*, 672 F. Supp. 2d 575, 594 (S.D.N.Y. 2009) (finding MISS ASIA USA mark unlikely to dilute MISS USA mark in part because "the limited distinctiveness of 'Miss USA' lessens the degree of protection dilution law affords it"); *Fla. Int'l Univ. Bd. of Trustees v. Fla. Nat'l Univ., Inc.*, 91 F. Supp. 3d 1265, 1287 (S.D. Fla. 2015) (granting defense motion for summary judgment and observing that "[w]hile 'Florida International University' and 'Florida National University' may indeed sound the same, the words 'international' and 'national' have different meanings, and though only two syllables distinguishes the two marks, those two syllables are not insignificant"), *aff'd*, 830 F.3d 1242 (11th Cir. 2016); *see also Swatch AG*, 739 F.3d at 163 (affirming finding that dilution unlikely based in part on dissimilarity between SWATCH and SWAP marks); *Century 21 Real Estate LLC v. Century Sur. Co.*, No. CIV030053PHXSMM, 2007 WL 433579, at \*3 (D. Ariz. Feb. 6, 2007) (granting defense motion for summary judgment in part because "[g]iven the prevalence of the

term ‘Century’ in the real estate and insurance industries and [the unitary nature of the C21 mark], the mere commonality of “Century” in both parties’ marks is an insufficient basis on which to find substantial similarity”), *aff’d*, 300 F. App’x 527 (9th Cir. 2008).

(ii) *The degree of inherent or acquired distinctiveness of the allegedly famous mark:* Here, as set forth above, TEC conceded while registering its marks under Section 2(f) of the Lanham Act, 15 U.S.C. § 1052(f), that the marks were merely descriptive and therefore lacking inherent distinctiveness. This factor therefore weighs against a finding of blurring. *See Miss Universe*, 672 F. Supp. 2d at 594 (“It is fair to say that the limited distinctiveness of [the plaintiff’s mark] lessens the degree of protection dilution law affords it.”).

(iii) *The extent to which the owner of the allegedly famous mark engages in substantially exclusive use of the mark:* This factor strongly favors the Defendants in light of the undisputed record evidence and testimony of numerous third-party uses of the words making up TEC’s claimed marks, especially the generic word “episcopal.” *See Astra Pharm. Prods., Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 1210 (1st Cir. 1983) (“If the other registrations and uses of the ‘ASTRA’ mark have not already diminished the uniqueness of Astra’s mark, [defendant’s] use of it ... will not diminish it, either.”); *Va. Polytechnic Inst. & State Univ. v. Hokie Real Estate, Inc.*, 100 U.S.P.Q.2d 1199, 1212 (W.D. Va. 2011) (declining to find liability because “[f]irst and most importantly, the court is unable to conclude that [the plaintiff] is engaging in ‘substantially exclusive use’ of [its] mark”); *Pan Am. World Airways, Inc. v. Flight 001, Inc.*, No. 06CIV14442CSH, 2007 WL 2040588, at \*19 (S.D.N.Y. July 13, 2007) (denying relief because “the fact that numerous other ... companies [in the same industry] use meridian globe logos suggest that the defendants’ globe logo is not likely to diminish the capacity of the [plaintiff’s] logo to identify and distinguish goods and services”). “Where there are several identical or very

similar marks [in the marketplace], a [defendant's] mark that may have some similarities to the [plaintiff's] mark is unlikely to cause any significant further dilution,” and that is the case here. *Hershey Co. & Hershey Chocolate & Confectionery Corp. v. Promotion in Motion, Inc.*, No. 07-CV-1601 (SDW), 2013 WL 12157828, at \*25 (D.N.J. Jan. 18, 2013).

(iv) *The degree of recognition of the allegedly famous mark*: A finding that an allegedly famous mark is widely recognized will not itself create a factual dispute precluding the disposal of a dilution-by-blurring cause of action on summary judgment. *See, e.g., V Secret Catalogue, Inc. v. Moseley*, 558 F. Supp. 2d 734, 746–47 (W.D. Ky. 2008), *aff'd*, 605 F.3d 382 (6th Cir. 2010). Here, TEC has failed to make any showing that its claimed marks enjoy any greater degree of recognition than any of the myriad other uses of the word “episcopal”; indeed, there is no record evidence or testimony that TEC’s claimed marks are more widely recognized than the Defendants’ marks, and summary judgment therefore is appropriate for that reason as well.

(v) *Whether the defendant intended to create an association with the allegedly famous mark*: If anything is apparent from the record in this case, as well as the reported opinions in other litigation arising from the parties’ dispute, it is that none of the parties on either side of the divide intends to create an association with the parties on the other. This factor therefore strongly supports a finding of nonliability as a matter of law. *See, e.g., Century 21 Real Estate LLC v. Century Sur. Co.*, No. CIV030053PHXSMM, 2007 WL 433579, at \*4 (D. Ariz. Feb. 6, 2007) (granting defense motion for summary judgment based in part on absence of intent to associate), *aff'd*, 300 F.App’x 527 (9th Cir. 2008); *see also E.A. Sween Co. v. Big City Deli Express Corp.*, No. 14CV6031KAMJO, 2016 WL 11396817, at \*6 (E.D.N.Y. Sept. 12, 2016) (declining to grant unopposed motion for default judgment based on plaintiff’s failure to identify facts supporting an intent to create association), *report and recommendation adopted in part*, No. 14-CV-6031

(KAM)(JO), 2016 WL 5874998 (E.D.N.Y. Oct. 8, 2016); *Swatch, S.A. v. Beehive Wholesale, L.L.C.*, 888 F. Supp. 2d 738, 757 (E.D. Va. 2012) (finding that defendant's knowledge of plaintiff's mark did not constitute evidence of an intent to associate), *aff'd*, 739 F.3d 150 (4th Cir. 2014); *Va. Polytechnic Inst. & State Univ.*, 100 U.S.P.Q.2d at 1212 (W.D. Va. 2011) (denying relief based in part on evidence of good-faith intent by defendant).

(vi) *Any actual association between the mark or trade name and the allegedly famous mark impairing the distinctiveness of the allegedly famous mark*: TEC has produced no evidence of an actual association between the parties' marks other than the results of the Klein likelihood-of-confusion survey, but those results do not create a factual dispute for two reasons. First, Plaintiffs did not conduct a survey analyzing the Defendants' name only that of the Diocese. Second, as in the likelihood-of-confusion context, the survey results do not create a factual dispute as to the lack of association because "the survey did not measure how consumers would react to the [Defendant's] marks as they are actually packaged and presented in commerce." *Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 101 U.S.P.Q.2d 1212, 1216 (S.D.N.Y. 2011), *aff'd*, 736 F.3d 198 (2d Cir. 2013); *see also Playtex Prods., Inc. v. Ga.-Pac. Corp.*, 390 F.3d 158, 167–68 (2d Cir. 2004) (rejecting similarly flawed association survey not reflecting marketplace realities).

Second, and of equal significance, mere association is not probative evidence of actionable dilution; instead, Section 43(c)(2)(B) expressly requires proof of an "association arising from the similarity between a mark or trade name and a famous mark *that impairs the distinctiveness of the famous mark.*" 15 U.S.C. § 1125(c)(2)(B); *see also* 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24:116 (5th ed.) (observing that "[e]ven if there is proof of a likely association, that does not mean that there is also a likelihood of dilution by blurring or tarnishment" in the absence of evidence of an impairment). Here, TEC has

acknowledged the absence of monetary damage arising from the use of the Defendants' marks, and the record is equally devoid of proof that TEC's in its claimed marks or their effectiveness as brand signals has been diminished in any way. *See Nordstrom, Inc. v. NoMoreRack Retail Grp.*, No. C12-1853-RSM, 2013 WL 1196948, at \*13 (W.D. Wash. Mar. 25, 2013) ("The [plaintiff's] evidence is not persuasive because there is no discerning whether the number of complaints actually correlates with the business' overall reputation."). TEC's claim of blurring necessarily fails as a result.

**VI. Defendants are also entitled to summary judgment against all of Plaintiffs' claims under the doctrine of laches.**

Defendants are additionally entitled to summary judgment because, even if there were factual disputes concerning the lack of merit of the Plaintiffs' claims, laches bars the assertion of those claims: "Estoppel by laches generally applies to preclude relief for a plaintiff who has unreasonably 'slept' on his rights. In other words, laches bars false advertising claims where a defendant is prejudiced by a plaintiff's unreasonable delay in bringing suit after the plaintiff knew of the defendant's violation." *PBM Prods., LLC v. Mead Johnson & Co.*, 639 F.3d 111, 121 (4th Cir. 2011) (citation omitted).

Because the Lanham Act does not contain a statute of limitations, district courts should use the state statute of limitations for analogous torts as the appropriate benchmark for evaluating a plaintiff's delay. *Id.* at 121. In South Carolina, that statute of limitations for trademark infringement claims is three years. *See* S.C. CODE ANN. § 15-3-530(2) (designating a 3-year statute of limitations for actions for a liability created by statute other than a penalty or forfeiture); *id.* § 39-5-150 (designating a 3-year statute of limitations for actions for unfair trade practices); *Secret of the Islands, Inc. v. Hymans Seafood Co.*, No. 2-17-cv-00342, 2018 WL 1566706, at \*3 (D.S.C. Mar. 30, 2018) (identifying three years as relevant benchmark). Plaintiffs' delay for longer than

that period creates a strong presumption of unreasonable delay and prejudice. *See PBM Prods.*, 639 F.3d at 121.

Here, TEC has long known of Defendants use of marks incorporating the term “episcopal,” especially considering Defendants priority over TEC. Further, TEC has engaged in litigation with the Defendant Diocese regarding similar marks since 2013. However, TEC, Plaintiff Bishops, and the TECSC did not add Defendants to this lawsuit until 2018—well beyond the three-year period allowed under South Carolina law. Because TEC has brought this action so long after the expiration of the statute of limitations, its delay in bringing this action is presumptively unreasonable. Moreover, Defendants have built its reputation in its marks for over two centuries. Allowing Plaintiffs’ eleventh-hour claims against Defendants and forcing Defendants to cease use of its marks at this late juncture would inevitably cause undue and irreparable prejudice. Accordingly, laches bars TEC’s claims are barred, and Defendants are entitled to summary judgment for this reason as well.

### CONCLUSION

As this court previously noted, “[u]ltimately, Plaintiffs will need to support these allegations and present proof for each of the Lawrence Parishes.” Or., Doc. No. 411., p. 10 (Aug. 23, 2018). Plaintiffs have failed to support their allegations and failed to carry their burden of proof and all Plaintiffs causes of action against the Defendants should be dismissed by this Court.

December 7, 2018

Respectfully submitted,

/s/C. Alan Runyan  
C. Alan Runyan, Esq.  
Andrew S. Platte, Esq.  
RUNYAN & PLATTE, LLC

2015 Boundary Street, Suite 239  
Beaufort, SC 2902  
(843)-473-6800

*The Vestry and Church Wardens of the Episcopal Church of the Parish of St. Helena and the Parish Church of St. Helena Trust; The Parish of Saint Michael in Charleston, In The State of South Carolina and St. Michael's Church Declaration of Trust; Vestry and Church Wardens of the Episcopal Church of the Parish of St. John's Charleston County; Trinity Episcopal Church; The Vestries and Churchwardens of the Parish of St. Andrew*