

UNITED STATES COURT OF APPEALS  
FOR THE SECOND CIRCUIT

SUMMARY ORDER

RULINGS BY SUMMARY ORDER DO NOT HAVE PRECEDENTIAL EFFECT. CITATION TO A SUMMARY ORDER FILED ON OR AFTER JANUARY 1, 2007 IS PERMITTED AND IS GOVERNED BY FEDERAL RULE OF APPELLATE PROCEDURE 32.1 AND THIS COURT'S LOCAL RULE 32.1.1. WHEN CITING A SUMMARY ORDER IN A DOCUMENT FILED WITH THIS COURT, A PARTY MUST CITE EITHER THE FEDERAL APPENDIX OR AN ELECTRONIC DATABASE (WITH THE NOTATION "SUMMARY ORDER"). A PARTY CITING TO A SUMMARY ORDER MUST SERVE A COPY OF IT ON ANY PARTY NOT REPRESENTED BY COUNSEL.

1           At a stated term of the United States Court of Appeals for the Second Circuit,  
2 held at the Thurgood Marshall United States Courthouse, 40 Foley Square, in the  
3 City of New York, on the 2<sup>nd</sup> day of November, two thousand eighteen.

4  
5           PRESENT: JOHN M. WALKER, JR.,  
6                       RAYMOND J. LOHIER, JR.,  
7                       *Circuit Judges,*  
8                       WILLIAM H. PAULEY III,\*  
9                       *District Judge.*

10 -----  
11           THE UNIVERSAL CHURCH, INC.,

12  
13                       *Plaintiff-Counter-*  
14                       *Defendant-Appellant,*

15  
16                       v.

No. 17-2960-cv

17  
18           CALVIN TOELLNER, GEORGE FREEMAN,  
19           BRUCE TAYLOR, UNIVERSAL LIFE  
20           CHURCH/ULC MONASTERY, UNIVERSAL  
21           LIFE CHURCH MONASTERY STOREHOUSE,

---

\* Judge William H. Pauley III, of the United States District Court for the Southern District of New York, sitting by designation.

1  
2 *Defendants-Counter-*  
3 *Claimants-Appellees,*  
4

5 DANIEL CHAPIN,  
6

7 *Defendant.*  
8

9 -----  
10 FOR APPELLANT: DAVID DONAHUE (Laura Popp-Rosenberg,  
11 Jennifer Insley-Pruitt, *on the brief*), Fross Zelnick  
12 Lehrman & Zissu, P.C., New York, NY; Katherine  
13 J. Daniels, Tendy Law Office, LLC, New York,  
14 NY.

15 FOR APPELLEES: JURA C. ZIBAS (Stephen J. Barrett, *on the brief*),  
16 Wilson Elser Moskowitz Edelman & Dicker LLP,  
17 New York, NY.  
18

19 Appeal from a judgment of the United States District Court for the  
20 Southern District of New York (Naomi Reice Buchwald, *Judge*).

21 UPON DUE CONSIDERATION, IT IS HEREBY ORDERED, ADJUDGED,  
22 AND DECREED that the judgment of the District Court is AFFIRMED.

23 The Universal Church, Inc. (“Universal Church”) appeals from a  
24 September 20, 2017 order of the District Court (Buchwald, J.) granting summary  
25 judgment in favor of appellees (collectively, “Universal Life Church”). We  
26 assume the parties’ familiarity with the underlying facts and the record of prior

1 proceedings, to which we refer only as necessary to explain our decision to  
2 affirm.

3 The standards for our de novo review of the District Court’s grant of  
4 summary judgment are well established. See Nick’s Garage, Inc. v. Progressive  
5 Cas. Ins. Co., 875 F.3d 107, 113 (2d Cir. 2017); Nora Beverages, Inc. v. Perrier Grp.  
6 of Am., Inc., 164 F.3d 736, 745 (2d Cir. 1998). In granting summary judgment on  
7 Universal Church’s trademark infringement claim and cancelling its trademark  
8 registrations, the District Court concluded that the trademarks “Universal  
9 Church” and “The Universal Church” are generic. A term is generic if it “refers  
10 to the genus of which the particular product is a species.” Park ‘N Fly, Inc. v.  
11 Dollar Park & Fly, Inc., 469 U.S. 189, 194 (1985) (citing Abercrombie & Fitch Co.  
12 v. Hunting World, Inc., 537 F.2d 4, 9 (2d Cir. 1976)). In determining whether a  
13 term is generic, moreover, “the relevant purchasing public is not the population  
14 at large, but prospective purchasers of the product.” Lane Capital Mgmt., Inc.  
15 v. Lane Capital Mgmt., Inc., 192 F.3d 337, 345 (2d Cir. 1999). Here, the District  
16 Court concluded that the relevant public is all those who seek and provide  
17 religious worship services, and Universal Church does not challenge this  
18 conclusion on appeal.

1           In this case, Universal Life Church met its burden of showing that the term  
2   “Universal Church” is generic in the context of “evangelistic and ministerial  
3   services, namely, conducting religious worship services,” and that the term “The  
4   Universal Church” is generic in the context of “religious counseling and  
5   ministerial services,” the classes for which the trademarks are registered. App’x  
6   55, 63. Specifically, Universal Life Church introduced admissible evidence in  
7   the form of an expert report and testimony that “the longstanding common use  
8   of the phrase ‘Universal Church’ in various contexts demonstrates without  
9   question that the phrase has been in generic usage over two millennia to describe  
10   the Church as a whole throughout the world.” App’x 610, 659–61 (deposition  
11   testimony). It also introduced the following definition of “universal” from the  
12   Oxford English Dictionary: “Designating the whole Christian Church or all  
13   Christians collectively . . . Freq. in *universal church*.” App’x 572 (emphasis in  
14   original); see Harley Davidson, Inc. v. Grottanelli, 164 F.3d 806, 810 (2d Cir. 1999)  
15   (“Though not conclusive, dictionary definitions of a word to denote a category of  
16   products are significant evidence of genericness because they reflect the public’s  
17   perception of a word’s meaning and its contemporary usage.”).

1           The remaining question before us, therefore, is whether Universal Church  
2     created a genuine factual dispute about the issue by presenting any contrary  
3     admissible evidence that the term “Universal Church” does not generically refer  
4     to religious counseling and evangelistic and ministerial services. We agree with  
5     the District Court that Universal Church did not. First, the testimony of  
6     Universal Church’s religious expert alone failed to create a genuine dispute that  
7     the term “Universal Church” refers to Christian services in general among the  
8     relevant public. Second, the testimony of Universal Church’s vice president  
9     that “Universal Church” is a “distinctive name” because the organization  
10    “promote[s] this brand” to its 30,000 members and in its weekly television  
11    program (which may reach up to 800,000 people), App’x 373; see id. 357, 360,  
12    also failed to establish the significance of the term “Universal Church” among  
13    the relevant public. In any event, “no matter . . . what success [the user of a  
14    generic term] has achieved in securing public identification, it cannot deprive  
15    competing manufacturers of the product of the right to call an article by its  
16    name.” Abercrombie, 537 F.2d at 9. In urging a contrary conclusion,  
17    Universal Church points to its efforts to police its mark by preventing other  
18    organizations from using the words “universal” and “church” in their name.

1 But “when . . . the mark has entered the public domain beyond recall, policing is  
2 of no consequence to a resolution of whether a mark is generic.” Murphy Door  
3 Bed Co. v. Interior Sleep Sys., Inc., 874 F.2d 95, 101 (2d Cir. 1989) (quotation  
4 marks omitted). Because a generic term can never be trademarked, moreover,  
5 see Park ‘N Fly, 469 U.S. at 194; Genesee Brewing Co. v. Stroh Brewing Co., 124  
6 F.3d 137, 143 (2d Cir. 1997), the District Court did not abuse its discretion in  
7 thereafter cancelling the trademarks. We therefore affirm the District Court’s  
8 grant of summary judgment in favor of Universal Life Church and cancellation  
9 of the trademark registrations.

10 Because Universal Church’s marks are generic, we also affirm the District  
11 Court’s grant of summary judgment to Universal Life Church on Universal  
12 Church’s cybersquatting claims under the Anticybersquatting Consumer  
13 Protection Act, 15 U.S.C. § 1125, which required Universal Church to show that  
14 its marks were distinctive. See Sporty’s Farm L.L.C. v. Sportsman’s Market,  
15 Inc., 202 F.3d 489, 497 (2d Cir. 2000).

16 Finally, the District Court was also correct to dismiss Universal Church’s  
17 unfair competition claims. Universal Church argues that even a generic term  
18 may give rise to an unfair competition claim if the junior user adopts the term in

1 order to conflate itself with the senior user. But our review of the record does  
2 not suggest that Universal Life Church, an organization which provides free  
3 online ordination and does not conduct church services other than occasional  
4 mass weddings, attempted to portray itself as a Pentecostal church in order to  
5 “confus[e] the public into mistakenly purchasing [its] product in the belief that  
6 the product is the product of the competitor.” Murphy Door Bed, 874 F.2d at  
7 102 (quotation marks omitted).

8 We have considered Universal Church’s remaining arguments and  
9 conclude that they are without merit. For the foregoing reasons, the judgment  
10 of the District Court is AFFIRMED.

11 FOR THE COURT:  
12 Catherine O’Hagan Wolfe, Clerk of Court