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Mailed:  
29 September 2004

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Open Bible Standard Churches

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Serial Nos. 76382384 and 76382385

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John P. Fredrickson of Boyle, Fredrickson, Newholm, Stein & Gratz, S.C. for Open Bible Standard Churches.

Christopher S. Adkins, Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Managing Attorney).

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Before Hairston, Bucher, and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

Applicant, Open Bible Standard Churches, applied to register two marks, OPEN BIBLE<sup>1</sup> and OPEN BIBLE STANDARD<sup>2</sup> (in typed form), on the Principal Register for a collective membership mark used "to indicate membership in an organization of churches" in International Class 200. Both applications contain an allegation of a date of first use and a date of first use in commerce of July 26, 1935.

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<sup>1</sup> Serial No. 76382384 filed March 13, 2002.

<sup>2</sup> Serial No. 76382385 filed March 13, 2002.

The examining attorney has refused to register applicant's marks on two grounds.<sup>3</sup> First, the examining attorney held that applicant's marks are not registrable under the provisions of Section 2(d) of the Trademark Act because it is likely to cause confusion, to cause mistake, or to deceive as a result of two registrations in International Class 16, owned by the same party, for the marks THE OPEN BIBLE for a "Bible series"<sup>4</sup> and THE NEW OPEN BIBLE<sup>5</sup> for "Bibles" in typed form. 15 U.S.C. § 1052(d). Second, the examining attorney refused to register applicant's marks without a disclaimer of the term "Bible" under the provision of Section 6(a) of the Trademark Act. 15 U.S.C. § 1056(a). The examining attorney ('385 Brief<sup>6</sup> at page 15) has required a disclaimer of the term on the ground that the term "is merely descriptive of the 'membership in an organization of churches.'" See 15 U.S.C. § 1052(e)(1). After the examining attorney made the

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<sup>3</sup> On February 17, 2004, the board granted applicant's request to consolidate the appeals involving the two referenced applications.

<sup>4</sup> Registration No. 1,243,614 issued June 28, 1983, renewed. The registration contains a disclaimer of the terms "The" and "Bible."

<sup>5</sup> Registration No. 1,633,188 issued January 29, 1991, renewed. The registration contains a disclaimer of the terms "New" and "Bible."

<sup>6</sup> The examining attorney did not submit a consolidated brief.

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refusals under Section 2(d) and the requirements for a disclaimer final, applicant appealed.

The Requirements for a Disclaimer

We first address the issue of the examining attorney's requirements for a disclaimer. The examining attorney argues ('384 Brief, page 16) that "the term 'BIBLE' has consistently been found to be descriptive for religious goods and services (including church services, ministerial services, religious membership and association services), the examiner asserts that it should also be held as descriptive in reference to the similar collective membership of churches in this instance" (footnote and parenthetical omitted). On the other hand, applicant argues that "[o]ne hearing the mark would not know, without substantial imagination, that it identifies a collective organization of churches." Reply Brief at 6.

The examining attorney argues that the term "Bible" is merely descriptive of applicant's indication of membership in an organization of churches. A term is merely descriptive if it immediately describes the ingredients, qualities, or characteristics of the goods or services or if it conveys information regarding a function, purpose, or use of the goods or services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978). See

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also In re MBNA America Bank N.A., 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003) (A "mark is merely descriptive if the ultimate consumers immediately associate it with a quality or characteristic of the product or service"); In re Nett Designs, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). "[T]he analysis regarding descriptiveness or genericness of a collective membership is the same as that with respect to a trademark or service mark." In re Association of Energy Engineers, Inc., 227 USPQ 76, 77 (TTAB 1985).

We look at the mark in relation to the goods or services (or in this case collective membership), and not in the abstract, when we consider whether the mark is descriptive. Abcor, 200 USPQ at 218. See also MBNA, 67 USPQ2d at 1783 ("Board correctly found MBNA's emphasis on the regional theme through marketing promotions and picture designs provides circumstantial evidence of how the relevant public perceives the marks in a commercial environment"). Courts have long held that to be "merely descriptive," a term need only describe a single significant quality or property of the goods or services. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987); Meehanite Metal Corp. v. International Nickel Co., 262 F.2d 806, 120 USPQ 293, 294 (CCPA 1959).

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The examining attorney submitted a dictionary definition of the word "Bible"<sup>7</sup> and numerous registrations with a disclaimer of the term "Bible" as support for the requirement for a disclaimer. The registrations include those in which a church or ministry has disclaimed the term "Bible" in the registered mark. See, e.g. Registration No. 2,604,360 (CHAIN OF LAKES COMMUNITY BIBLE CHURCH for 'operating a place of assembly for prayer and worship," "Bible Church" disclaimed); 2,422,939 ("bibleinfo.com 1-800-97-BIBLE" and design for "ministerial services," "1-800-97-BIBLE" disclaimed); 2,281,738 (BIBLE BELIEVERS for "religious ministerial services," "Bible" disclaimed); 2,255,380 (CHRIST'S DISCIPLES HOLY BIBLE and design for "evangelistic and ministerial services," "Bible" disclaimed); and 2,242,533 (BIBLE WAY CHURCH OF OUR LORD JESUS CHRIST WORLD WIDE and design for "ministerial services," "Bible Way Church of our Lord Jesus Christ World Wide" disclaimed).

In addition, the examining attorney included other registrations for a variety of goods and services that show the disclaimer of the term "Bible." See, e.g.,

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<sup>7</sup> See Office Action dated March 11, 2003 ("The sacred book of Christianity, a collection of writings including the books of both the Old Testament and the New Testament").

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Registration No. 2,680,308 (BIBLE GEEK for providing prerecorded devotional and motivational ministerial messages, "Bible" disclaimed); 2,343,297 (WYCLIFFE BIBLE TRANSLATORS for Bible translation services, "Bible translators" disclaimed); 2,562,993 (INTERNATIONAL WORD OF LIFE WORD OF LIFE BIBLE INSTITUTE - HOLDING FORTH THE WORD OF LIFE - PHIL 2:16 for educational services, "Bible Institute" disclaimed); 2,542,501 (CROSSROADS BIBLE COLLEGE for educational services, "Bible College" disclaimed); 2,663,619 (SING THROUGH THE BIBLE for educational services, "Bible" disclaimed); 2,652,261 for educational and entertainment services, "Bible" disclaimed); 2,448,733 (COVENANT BIBLE COLLEGE for educational service, "Bible College" disclaimed); 2,335,457 and (RIVER BIBLE INSTITUTE for educational services, "Bible Institute" disclaimed).

Third-party registrations can be used as a form of a dictionary definition to illustrate how the term is perceived in the trade or industry. In re J.M. Originals Inc., 6 USPQ2d 1393, 1394 (TTAB 1987) ("[T]hird party registrations are of use only if they tend to demonstrate that a mark or a portion thereof is suggestive or descriptive of certain goods and hence is entitled to a narrow scope of protection. Used in this proper, limited manner, 'third party registrations are similar to

dictionaries showing how language is generally used.’ 1  
McCarthy, *Trademarks and Unfair Competition*, § 11:26 at p.  
516 (2d ed. 1984)”).

The registrations indicate that the term “Bible” describes churches, colleges, institutes, and others that emphasize or highlight the Bible as a feature of their services. Similarly, for applicant’s indication of membership in an organization of churches, the term “Bible” would similarly describe a feature of its services, i.e., that the organization and its members emphasize the use of the Bible.

Therefore, we conclude that applicant’s term “Bible” is merely descriptive for applicant’s mark indicating membership in an organization of churches and the examining attorney’s requirement for a disclaimer is affirmed.

#### Likelihood of Confusion

The next question we address is whether there is a likelihood of confusion between applicant’s marks when used with its indication of membership in an organization of churches and registrant’s marks when used with Bibles and a Bible series. We consider the issue of likelihood of confusion under the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont

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de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must keep in mind that “[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.” Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Inasmuch as applicant’s marks are collective membership marks, our likelihood of confusion analysis must take this difference into consideration.

[T]he finding of likelihood of confusion between a collective membership mark and a trademark or service mark is not based on confusion as to the source of any goods or services which happen to be provided by the members of the collective organization. Rather, the question is whether relevant persons are likely to believe that the trademark owner's goods or services emanate from or are endorsed by or in some other way associated with the collective organization.

In re Code Consultants Inc., 60 USPQ2d 1699, 1701 (TTAB 2001).

First, we address whether the goods and the collective membership as they are identified in the applications and registrations are related. Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) (“Trademark cases involving the issue of likelihood of

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confusion must be decided on the basis of the respective descriptions of goods"). Applicant's collective membership marks indicate "membership in an organization of churches." Registrant's goods are "Bibles" and a "Bible series." Obviously here, Bibles and an indication of church membership are not identical. However, the examining attorney has submitted registrations that show that a common mark has been registered for various association services and publications. See, e.g. Registration No. 2,659,511 "... YOUR ISRAEL CONNECTION" for "newsletters and newspapers featuring articles on religion and current events; and religious books" and "eleemosynary services, namely providing food, blankets, medical assistance, clothing and individuals..."); 2,666,391 (Design mark for religious books and association services, namely, promoting the education of the public to the worldwide need for food and nourishment); 2,661,641 (PLAYERS CHAPEL PROGRAM registered for religious books and association services, namely, promoting the interests of Christians); 1,776,315 (ADL ANTI-DEFAMATION LEAGUE for books on religious diversity and association services promoting the interests of people opposed to discrimination); 2,354,189 (CHRISTIAN LEGAL SOCIETY for newsletters concerning the legal profession and association services promoting the concept

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of the Christian lawyer in the legal profession); and 2,668,909 (BREAD FOR THE WORLD for religious books and association services, namely promoting the education of the public to the worldwide need for food and nourishment). The examining attorney also submitted copies of various registrations where the sponsor of religious educational and entertainment services are the source of books or publications. See, e.g. Registration Nos. 2,665,297; 2,621,105; and 1,577,466.

This board has long found that relevant registrations may suggest that goods or services are related. See In re Mucky Duck Mustard Co., 6 USPQ2d 1467, 1470 n.6 (TTAB 1988) (Although third-party registrations "are not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, [they] may have some probative value to the extent that they may serve to suggest that such goods or services are the type which may emanate from a single source"). See also In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1786 (TTAB 1993).

However, it is important to emphasize that we must consider the goods or services as they are described in the identification in the applications and registrations. Octocom Systems, Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The

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authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed").

In this case, the goods and services are not periodicals and the services are not educational or even general association services. The evidence that suggests that an association opposing discrimination or an organization of lawyers is the source of religious books or newsletters is very limited support to show that an indication of membership in an organization of churches is related to the source of Bibles.

The examining attorney has also submitted additional registrations for services such as ministerial services that are more directly related to applicant's collective membership services of indicating membership in an organization of churches. Here, the problem is that these registrations do not show that these organizations are the source of religious books, much less Bibles in particular. See, e.g. Registration No. 2,413,816 (EVANGELICAL LUTHERAN CHURCH IN AMERICA for ministerial services and missionary

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services and newsletters and newspapers related to religion); 2,378,509 (YOUTH FOR CHRIST for ministerial services and magazines, brochures and instructional guides featuring religious instruction); 2,035,413 (WISDOM FROM ABOVE for religious ministry services and newsletter, magazines, and printed programs on the subject of religion); and 1,584,602 (CRYSTAL CATHEDRAL for religious ministerial services and church newsletters). The suggestion that the source of ministerial services may also be the source of a periodical again does not directly address the question of whether registrant's Bibles are related or are endorsed by or in some other way associated with the an organization of churches.

Finally, the examining attorney refers to several other registrations for "both collective membership services in IC 200 and 'books, periodicals, magazines, newsletters or pamphlets' (literature)." Denial of Motion for Reconsideration dated January 14, 2004 (Serial No. 76382384, page 3). See, e.g. (Registration No. 2,542,284 (ASTARA for collective membership mark to indicate membership in a spiritual and religious organization and religious books and educational pamphlets regarding personal enhancement and regarding various world religions of the world); 1,790,204 (APOSTOLATE FOR FAMILY

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CONSECRATION for indicating membership in an evangelistic organization and books and newsletters dealing with religion and family);<sup>8</sup> 2,029,490 (FELLOWSHIP OF CHRISTIAN COWBOYS for Bibles and membership organization of individuals interested in the Christian faith); 1,873,785 (DIVINE RIGHT ORDER for religious and self-help books and indicating membership in a religious organization); and 1,544,356 (A design mark for religious books and indicating membership in a church organization).<sup>9</sup> While these registrations do provide some support for the examining attorney's argument, we hold that these few registrations provide only de minimis evidence that the goods and collective membership are related.

As indicated above, we are constrained to consider the issue of the relatedness of the goods and collective membership as they are identified in the registrations and applications so the issue is not whether prospective users would believe that there is a relationship between an

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<sup>8</sup> There are apparently another two registrations (Nos. 1,950,315 and 1,814,751) from the same organization that are also in the record.

<sup>9</sup> There is also a registration for AWANA (No. 1,377,869) for Bibles and non-denominational Christian youth association. However, the registration also includes belt buckles, key rings, toys, beach and bath towels, wristwatches, and carry-all bags. The breadth of the registration makes it of little value to demonstrate that two individual items in the disparate list of goods and services are related.

association and a periodical but whether prospective users would likely believe that there is a relationship between an organization of churches and the source of Bibles and a Bible series. The simple fact that members of a church may use Bibles is not sufficient to establish that Bibles emanate from, or are endorsed by, or in some other way associated with the organization of churches. As applicant argues: "Stained glass, pews, bibles, candles, brass candlesticks, organs, pianos, and robes, among other things, can all be characterized as 'complementary to' and found in many, if not most churches. Yet their complementary nature does not support a conclusion that a collective organization of churches is likely to be viewed as the source of stained glass, candles, organs, pianos or robes, or, in this case bibles." Applicant's Brief at 8-9 (emphasis omitted). We conclude that the evidence suggests a tenuous connection between a collective membership mark indicating membership in an organization of churches and Bibles and a Bible series.

Now we turn to the similarity of the marks, applicant's OPEN BIBLE and OPEN BIBLE STANDARD and registrant's THE OPEN BIBLE and THE NEW OPEN BIBLE. We will concentrate on applicant's OPEN BIBLE and registrant's THE OPEN BIBLE marks, which are virtually identical. The

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presence of the article "The" obviously does not distinguish the two marks. See In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (Federal Circuit held that the addition of the words "The" and "Cafe" and a diamond-shaped design to registrant's DELTA mark still resulted in a likelihood of confusion).

However, the examining attorney argues ('384 brief at 6-7) that "the arbitrary use of OPEN in its direct conjugation of BIBLE in the registered marks 'THE OPEN BIBLE and 'THE NEW OPEN BIBLE' (in relation to 'bibles' and 'series of bibles') are of a unique and memorable nature so that it is quite distinctive to relevant person[s] and consumers." We cannot agree. The examining attorney does acknowledge the disclaimer of the word "Bible" in the registered marks and we have found that the term "Bible" is at least descriptive of applicant's collective membership so that term would not have much trademark significance. In addition, the word "open" in both marks hardly seems unique or arbitrary when used in relationship to the goods or collective membership. For registrant's goods, the term suggests the Bible in use, or "open." Furthermore, many of the registrations that the examining attorney submitted to show that the word "Bible" was descriptive contain what appears to be a representation of an "open" bible as part

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of the mark. See, e.g., Registration No. 1,374,283 (THE WAYS CORPS and additional wording and design specifically contains a disclaimer of the "representations of the open Bible"); 2,625,035 (BIBLE SEED and design of an open book); 2,562,993 (WORD OF LIFE BIBLE INSTITUTE and representation of an open bible); 2,255,380 (CHRIST'S DISCIPLES HOLY BIBLE and representation of an open Bible); and 1,577,001 (Design with a representation of an open "Holy Bible"). These registrations also provide evidence that the use of an "open Bible" is not arbitrary when used with various religious services.

In this case, "the question is whether relevant persons are likely to believe that the trademark owner's goods or services emanate from or are endorsed by or in some other way associated with the collective organization." Code Consultants, 60 USPQ2d at 1701. When we consider that the evidence of the relatedness of the goods and collective membership organization is tenuous and the marks are suggestive, we conclude that "the potential for confusion appears a mere possibility not a probability." Electronic Data & Sales Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 21 USPQ2d 1388, 1393 (Fed. Cir. 1992).

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Decision: The refusals to register applicant's marks on the grounds of likelihood of confusion are reversed. The examining attorney's requirements for a disclaimer of the term "Bible" are affirmed. If applicant submits appropriate disclaimers of the word "Bible" within thirty days of the mailing date of this decision, these refusals to register will be reversed.