

NOTE

MARKED BY FAITH:  
A JUSTIFICATION FOR RELIGIOUS FAIR USE IN  
TRADEMARK INFRINGEMENT DISPUTES

*Summer Basham Todd\**

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## I. INTRODUCTION

At the heartbeat of American jurisprudence is the freedom of religion.<sup>1</sup> Under the First Amendment, religious works and symbols, taking shape as religious expression, are fiercely guarded and held sacred.<sup>2</sup> Yet, trademark law may compete with First Amendment protections when religious expression is brought within its ambit.<sup>3</sup> Accordingly, trademark law must be applied in a manner that respects and accommodates religious expression. However, as this Note explores, trademark law often operates to preference certain religious groups at the expense of others and to burden the free exercise of religion when one group sues another to protect the exclusive use of a religious mark in a trademark infringement dispute.<sup>4</sup> To understand how trademark infringement disputes impact the religious freedoms of others, consider the story of Jane Smith.<sup>5</sup>

Jane Smith attended the Peaceful Pines Community in practice of her faith. The pillars of the Community are peace, strength, endurance, and renewal—as seen in pine trees themselves. The Community is grounded in both spirituality and environmental justice, and it lives out the pillars of the faith by focusing on these virtues in weekly teachings, daily meditation practices, and engaging with service projects geared towards sustainability. The Peaceful Pines Community has registered for trademark protection both its name and symbol—a grove of four pines, each representing one pillar. These marks have proven beneficial to the Community as they have allowed opportunities for members to share the pillars of the faith when asked about the meaning behind the name and symbol. Moreover, the Community has used its marks on teaching materials, meditation books, marketing materials, and more.

When Jane was nominated to a leadership position within the Community, she was denied the position as a woman. True to its teachings and traditions, the Peaceful Pines Community has not allowed women to serve in leadership positions. In disagreement with this decision, Jane, along with the

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<sup>1</sup> See U.S. CONST. amend. I.

<sup>2</sup> See *id.*; see also Jed Michael Silversmith & Jack Achiezer Guggenheim, *Between Heaven and Earth: The Interrelationship Between Intellectual Property Rights and the Religion Clauses of the First Amendment*, 52 ALA. L. REV. 467, 469 (2001).

<sup>3</sup> See *infra* Section II.A.

<sup>4</sup> See *infra* Part III.

<sup>5</sup> The story of Jane Smith and the Peaceful Pines Community was imagined for purposes of this Note. The story was inspired by the case law discussed herein as well as modern examples of schisms in religious organizations.

members who nominated her, left the Community to form their own. This new group began to meet and practice its faith under the name—the True Peaceful Pines Community. Moreover, the new group advanced an additional pillar of the faith—equality—such that it began using a grove of five pines as its symbol. While the new group could have chosen any other name or symbol for its new identity, it believed this name and symbol were so sacred to its beliefs that it couldn't imagine a different choice. Additionally, the group felt this choice was divinely mandated.

Concerned that members of the congregation would mistake the True Peaceful Pines Community for its own Community, and perhaps hurt by the loss of members, the founding Community looked to trademark law. The founding Community successfully won a trademark infringement dispute for the exclusive use of both its name and symbol, and the new group was denied use of its name and symbol. In effect, the new group was denied the right to freely use a particular religious name and symbol in spiritual practice and to identify its belief system according to its sincerely held convictions. As evident through the scenario of Jane Smith, which reflects the central tension in religious trademark disputes, such disputes threaten the religious freedoms of others by excluding religious entities from using names and symbols that hold deep spiritual significance. Accordingly, this Note proposes a novel fair use defense—religious fair use—to trademark infringement claims in an effort to achieve a better balance in the public interest in protecting trademark rights against the public interest in protecting religious freedoms.

In support of this conclusion, this Note begins in Part II by discussing the importance of trademarks in the religious context and how infringement disputes arise in the ecclesiastical context. This Part further provides background on the relevant provisions of the Lanham Act that apply to trademark infringement. Part III explores how infringement disputes over religious marks run afoul of Establishment and Free Exercise principles, and this Part explains why existing fair use defenses are inapplicable in the religious context. Part IV thus offers a new framework for courts analyzing infringement of religious marks. This Note proposes a two-prong test that can be raised as a fair use defense to infringement claims. Under the first prong, courts evaluate whether there is any religious relevance to the use of a mark. If so, then under the second prong, courts evaluate whether there has been explicit confusion as to the source of a mark. Part IV also explains how this new framework better balances the public interest in avoiding consumer confusion against the public interest in protecting religious freedoms. Part V concludes.

## II. TRADEMARK LAW & THE RELIGIOUS MARK

To understand the problem identified by this Note, this Part first provides important information on the role of religious trademarks and context for how disputes over religious trademarks arise in a variety of ecclesiastical contexts. As such, Section A of this Part overviews trademarks generally and the role that trademarks play in the religious context specifically. Section B then walks through the history of religious trademarks under federal law. Section C introduces the Lanham Act, the federal law that governs trademark rights, and discusses the relevant provisions under the Act that apply to this Note. Finally, Section D explores trademark limitations both under the Lanham Act and as imposed by judges.

### A. TRADEMARKS & THEIR ROLE IN RELIGIOUS CONTEXTS

A trademark is a “word, name, symbol, or device, or any combination thereof” used to identify and distinguish a particular artisan’s goods or services from those of others.<sup>6</sup> By identifying the origin of a good or service, a trademark reduces consumer confusion about that product’s source.<sup>7</sup> And by protecting against consumer confusion, a trademark further operates to protect the goodwill that a business has earned.<sup>8</sup> Stated another way, one entity has no right to “piggyback” off the goodwill another entity has built in its name.<sup>9</sup> Indeed, the twin

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<sup>6</sup> 15 U.S.C. § 1127; *see also In re Trade-Mark Cases*, 100 U.S. 82, 92 (1879) (defining a trademark as “a symbol or device to distinguish the goods or property made or sold by the person whose mark it is, to the exclusion of use by all other persons”).

<sup>7</sup> J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 2:2 (5th ed. 2024).

<sup>8</sup> *Id.*; *see also* Jack Daniel’s Props., Inc. v. VIP Prods. LLC, 599 U.S. 140, 146 (2023) (noting that the law protects trademarks because they allow producers to “reap the financial rewards associate with the[ir] product’s good reputation”).

<sup>9</sup> *See* Vidal v. Elster, 602 U.S. 286, 307 (2024).

aims of trademark law are protecting against consumer confusion and preserving producer goodwill.<sup>10</sup>

Trademarks are central to a business's brand and identity.<sup>11</sup> In this way, trademarks are vital assets to businesses.<sup>12</sup> For example, trademarks help businesses establish quality standards, as trademarks signal to the public that a business has built a reputation for quality products or services.<sup>13</sup> This in turn builds customer loyalty and repeat business.<sup>14</sup> Similarly, trademarks build brand equity—the value in a brand related to the amount of money consumers are willing to pay for a product or service based solely on reputation.<sup>15</sup> And through trademark protection, businesses are able to safeguard their reputation against competitors in the marketplace and entities that threaten to tarnish the business's reputation.<sup>16</sup> The bottom line is that trademarks help businesses to flourish.<sup>17</sup>

From these considerations, the value of trademarks to religious organizations is clear. Safeguarding an entity's identity is very important in the

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<sup>10</sup> MCCARTHY, *supra* note 7, § 2:2. In a concurring opinion, Justice Stevens observed that in a Report accompanying the Lanham Act in 1946, the Senate said the Act had two goals:

The purpose underlying any trade-mark statute is twofold. One is to protect the public so it may be confident that, in purchasing a product bearing a particular trade-mark which it favorably knows, it will get the product which it asks for and wants to get. Secondly, where the owner of a trade-mark has spent energy, time, and money in presenting to the public the product, he is protected in his investment from its misappropriation by pirates and cheats. This is the well-established rule of law protecting both the public and the trade-mark owner.

Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 782 (1992) (Stevens, J., concurring) (quoting S. REP. NO. 1333, 79th Cong., 2d Sess., 3 (1946)).

<sup>11</sup> Viktor Johansson, *6 Ways a Trademark Increases Your Company's Value*, DIGIP (Dec. 27, 2022), <https://www.digip.com/blog/post/6-ways-a-trademark-increases-your-companys-value#> [<https://perma.cc/L423-6CYS>].

<sup>12</sup> *Id.*

<sup>13</sup> *Id.*

<sup>14</sup> *Id.*

<sup>15</sup> *Id.*

<sup>16</sup> *Id.*

<sup>17</sup> Johansson, *supra* note 11.

religious context, as religion touches one's most sacred beliefs and values.<sup>18</sup> As the court in *Purcell v. Summers* recognized, "[t]he name of [a] church . . . [is] of great value, not only because business [is] carried on and property [is] held in [its] name, but also because members associate the name [with] the most sacred of their personal relationships and the holiest of their family traditions."<sup>19</sup> Similar to the phenomena of cultural appropriation,<sup>20</sup> religious identity and religious history are at risk of deterioration or mischaracterization by misuse of the symbols and terminology that exemplify the religion.<sup>21</sup>

Moreover, as mission-driven entities, a religious organization's goodwill and reputation are crucial to fulfilling its ministry and purpose.<sup>22</sup> Indeed, churches rely on their goodwill and reputation for success in advancing messages, attracting congregants, and fulfilling their missionary purposes.<sup>23</sup>

Additionally, "branding" is just as important to religious organizations as it is to other businesses.<sup>24</sup> Religious organizations rely on their names, symbols, and other trademarks to express their identities and convey important messages central to their missions.<sup>25</sup> And like other businesses, religious organizations have

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<sup>18</sup> Agnes Beatrice Gambill, *Trademark Holy Wars: The 2nd Circuit's Attempt to Genericide God*, 48 AM. INTELL. PROP. L. ASSOC. Q.J. 225, 226 (2020).

<sup>19</sup> *Purcell v. Summers*, 145 F.2d 979, 985 (4th Cir. 1944).

<sup>20</sup> See Sari Sharoni, *The Mark of a Culture: The Efficacy and Propriety of Using Trademark Law to Deter Cultural Appropriation*, 26 FED. CIR. BAR J. 407, 408, 419–20 (2017) (defining cultural appropriation as "the act of taking some product from a 'source community' culture and repurposing it in a different culture").

<sup>21</sup> See Stephanie B. Turner, *The Case of the Zia: Looking Beyond Trademark Law to Protect Sacred Symbols*, 11 CHI.-KENT. J. INTELL. PROP. 116, 116 (2012) (discussing the Zia Sun symbol, a sacred religious symbol for the Zia Pueblo people, that appears on the New Mexico state flag such that, for the Zia people, this use dilutes the sacred meaning of the sun symbol).

<sup>22</sup> Kenneth E. Liu, *The Importance of Trademarks for Churches*, CHURCH L. & TAX (June 26, 2014), <https://www.churchlawandtax.com/stay-legal/property-law/the-importance-of-trademarks-for-churches/> [https://perma.cc/7XNE-JJ29].

<sup>23</sup> *Id.*

<sup>24</sup> *Id.*

<sup>25</sup> See Andrew Ventimiglia, *Cross and Crown™: Trademarks and the Legal Naming of American Religions*, 33 RELIGION & AM. CULTURE 183, 195 (2023) (discussing how the term CHRISTIAN SCIENCE was meant to indicate recovering "primitive Christianity and its lost element of healing" and express that its teachings that "provided a method or rule for demonstrating universal divine

a strong interest in excluding others who threaten to tarnish their brand or reputation.<sup>26</sup> Practically, the ability to protect religious marks allows religious groups to protect themselves from unwanted associations, such as cults, domestic terrorist organizations, and scams.<sup>27</sup>

Furthermore, like other trademark holders, owners of religious marks leverage their trademark protections to prevent consumer confusion with other marks.<sup>28</sup> But in the religious context, the “consumers” may be congregations distinguishing between the old and the new when ideological shifts, schisms, reformations, and other divisions occur.<sup>29</sup> It is a universal proposition that as a religion grows, differences of opinion over doctrine and practice will develop and new religions will form from those differences:

Nearly all our varieties of churches of the same denomination are the result of secession or withdrawals from the parent church of that name, and it has been the usual course for the new church society to adopt as a permanent part of its name the name of the parent organization. Take one instance: A part of the Methodist

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law,” a use decidedly distinctive compared with conventional usage of the word “science”).

<sup>26</sup> See Gambill, *supra* note 18, at 226.

<sup>27</sup> See TE-TA-MA Truth Found.—Fam. of URI, Inc. v. World Church of the Creator, 297 F.3d 662, 662 (7th Cir. 2002) (describing a lawsuit filed by a religious organization against a white-supremacy group that adopted a name similar to the organization’s name).

<sup>28</sup> See, e.g., Sovereign Ord. of Saint John of Jerusalem, Inc. v. Grady, 119 F.3d 1236, 1238 (6th Cir. 1997); Jews for Jesus v. Brodsky, 993 F. Supp. 282, 282 (D.N.J. 1998), *aff’d*, 159 F.3d 1351 (3d Cir. 1998) (describing how the mark holder of “Jews for Jesus” brought infringement, dilution, and unfair competition action against website); *In re Riverbank Canning Co.*, 95 F.2d 327, 329 (C.C.P.A. 1938) (holding that the “Madonna” trademark on wine was scandalous under the Trademark Act of 1905).

<sup>29</sup> See *Purcell*, 145 F.2d at 988 (evaluating confusion created when breakaway group from Methodist Episcopal Church used name “Methodist Episcopal Church, South”); *In re St. Stanislaus Polish Nat’l Reformed Church of Scranton*, 12 Pa. D. 532, 525 (Pa. Com. Pl. 1903).



Episcopal Church withdrew and established the Protestant Methodist Church. . .<sup>30</sup>

Accordingly, a trademark's ability to help members of congregations distinguish between religious sects can be quite valuable to religious organizations.

Finally, trademarks allow religious organizations to flourish. Religious marks are often used on advertising materials and religious publications, such as religious books, magazines, pamphlets, newsletters, brochures, and more.<sup>31</sup> Religious marks are also used for establishing and administering important programs like employee health care and benefit programs, as well as critical services like educational instruction services, film production and distribution services, and religious observances and missionary services.<sup>32</sup> Candidly, religion is big business.<sup>33</sup> In fact, sources report that religion generates more revenue annually than the top tech companies, including Apple, Amazon, and Google, combined.<sup>34</sup> A leading study on the annual socio-economic value of religion reports that religion contributes nearly \$1.2 trillion each year.<sup>35</sup> As such, the key business benefits of trademarks apply in the religious context.

#### B. HISTORY OF RELIGIOUS MARKS

Yet despite the contemporary use of trademark law for religious purposes, jurists and legal theorists have historically struggled to justify registering religious marks.<sup>36</sup> When Congress first enacted federal trademark law in 1870, religious marks freely qualified for federal registration.<sup>37</sup> However, William Henry Browne,

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<sup>30</sup> Supreme Lodge Knights of Pythias v. Improved Ord. Knights of Pythias, 71 N.W. 470, 471 (Mich. 1897).

<sup>31</sup> Gen. Conf. Corp. of Seventh-Day Adventists v. McGill, 617 F.3d 402, 405 (6th Cir. 2010).

<sup>32</sup> *Id.*

<sup>33</sup> See Gambill, *supra* note 18, at 226.

<sup>34</sup> Brian J. Grim & Melissa E. Grim, *The Socio-economic Contribution of Religion to American Society: An Empirical Analysis*, 12 INTERDISC. J. RES. RELIGION 2, 2 (2016).

<sup>35</sup> *Id.* at 35.

<sup>36</sup> See, e.g., WILLIAM HENRY BROWNE, A TREATISE ON THE LAW OF TRADE-MARKS AND ANALOGOUS SUBJECTS 360 (2d ed. 1885).

<sup>37</sup> See Patent, Copyright, and Trademark Act of 1870, ch. 230, § 79, 16 Stat. 198, 211 (1870).

a prominent legal scholar in the late nineteenth century, argued that names and symbols that are “distinctive emblems of all creeds—religious or political” should be preemptively rejected.<sup>38</sup> In his view, words like “Christian” or symbols like the Christian cross or Muslim crescent were not eligible for trademark protection.<sup>39</sup> First, he presumed that a trademark for CHRISTIAN would be rejected because of its strong connection to a religious faith, precluding it from adequately serving as a merchant’s source identifier.<sup>40</sup> In this way, he argued that religious trademarks could not serve the essential purpose of trademark law—to identify a source—and, thus, were improper.<sup>41</sup>

Second, Browne believed a lawful mark must not transgress the rules of morality or public policy; he emphasized “the moral, religious, or political sensibilities of any people must not be shocked by the perversion of an emblem sacred in their eyes.”<sup>42</sup> Analyzing the consequences of recognizing religious marks, Browne identified a preexisting proprietary right that connected religious communities to their symbols, and he warned that the law would disrupt this connection if it subordinated religious terms to commercial use.<sup>43</sup> Browne wrote:

The law will not aid any person to bring obloquy upon objects and symbols consecrated to religion. But what is religion, in its relation to commerce? It is the recognition of God as an object of worship, love, and obedience. All peoples worship God under one form or another, or at least think that they do. Their religious prejudices should not be trampled upon . . . If a scoffer should endeavor to curry favor with infidels by the profane use of an Agnus Dei, or any symbol of the Alpha and Omega, or the Ineffable Name, or even of angels, apostles, saints, and martyrs, or of a thousand objects depicted by ancient art, and hallowed by associations, would any court of justice sustain a claim to a trademark so composed? No.<sup>44</sup>

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<sup>38</sup> Ventimiglia, *supra* note 25, at 185 (quoting BROWNE, *supra* note 36, at 238).

<sup>39</sup> BROWNE, *supra* note 36, at 360.

<sup>40</sup> *See id.*

<sup>41</sup> *See id.*

<sup>42</sup> *Id.* at 608 (stating “[a] violation of this rule is not only in bad taste, but is also an outrage”).

<sup>43</sup> *See id.*

<sup>44</sup> BROWNE, *supra* note 36, at 608–09.

Browne's writings echoed in the Trade-Mark Act of 1905, which expanded the list of reasons for barring trademark registration to include any mark that "[c]onsists of or comprises immoral or scandalous matter."<sup>45</sup> As recognized by Congress and Arthur Greeley, the 1905 Trade-Mark Act's architect, the newly added registration bars permitted registration of all trademarks that qualified for protection under the preexisting United States common law and prohibited registration for all marks considered improper under the common law.<sup>46</sup> Indeed, the common law landscape at that time was heavily influenced by Browne and like-minded scholars who pondered whether trademark protection should extend to marks consisting of religious or other moral matters.<sup>47</sup> Accordingly, the immoral or scandalous bar was likely intended to prevent registration for marks containing terms or icons associated with a religion or otherwise referring to moral matters.<sup>48</sup>

The contentious history of religious marks continued with the application of the immoral or scandalous bar to preclude registration of religious emblems to be used on products deemed antithetical to religious values.<sup>49</sup> For instance, the mark "MADONNA" was considered "scandalous" when used in connection with wine, because that term is associated with the Virgin Mary, who "stands as the highest example of the purity of womanhood and [given that] the entire Christian world pays homage to her as such."<sup>50</sup> On the other hand, less controversial religious marks were often successfully registered.<sup>51</sup> But even with such "success" came pushback from the religious communities themselves, as was the case with the Religious Society of Friends' challenge to the commercial use of the name "Quaker."<sup>52</sup>

Around 1915, members of the Society began voicing concern that businesses were misappropriating the term "Quaker" as a name for their products,

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<sup>45</sup> Act of Feb. 20, 1905, ch. 592, § 5, 33 Stat. 724, *repealed by* Lanham Act of 1946, ch. 540, § 46(a), 60 Stat. 427.

<sup>46</sup> Jasmin Abdel-Khalik, *To Live in In-'Fame'-Y: Reconceiving Scandalous Marks as Analogous to Famous Marks*, 25 CARDOZO ARTS & ENT. L. J. 173, 195 (2007).

<sup>47</sup> *Id.*

<sup>48</sup> *Id.*

<sup>49</sup> Ventimiglia, *supra* note 25, at 186.

<sup>50</sup> *Id.*

<sup>51</sup> *Id.*

<sup>52</sup> *Id.*

such as “Quaker Oats.”<sup>53</sup> However, their objections were not rooted in concerns that the name was being used in a scandalous manner, but rather in concerns that businesses were commercializing “a name that [has] deep religious significance.”<sup>54</sup> So, the Society of Friends came to Congress to pass a bill addressing their concerns.<sup>55</sup> The Federal Council of Churches, an ecumenical group representing most major Protestant denominations, threw its support behind the measure.<sup>56</sup>

In debate, the Chair of the Friends’ Legislative Board advanced a number of policy arguments related to the twin aims of trademark law.<sup>57</sup> For instance, the Chair argued that corporate registration of the Quaker’s name was akin to pirating preexisting goodwill that the Quakers had built in their name while also producing significant consumer confusion.<sup>58</sup> The Friends did not seek a common-law right to the Quaker trademark.<sup>59</sup> Rather, as indicated in a subsequent statement by Henry Haviland of the New York Society of Friends, the Society of Friends believed the Quaker name was simply “not a thing to be sold.”<sup>60</sup> Haviland advanced that trademark registration fundamentally infringed the Society’s

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<sup>53</sup> *Id.* (showing that the issue was use at all rather than scandalous use); TIMOTHY E. W. GLOEGE, *GUARANTEED PURE: THE MOODY BIBLE INSTITUTE, BUSINESS, AND THE MAKING OF MODERN EVANGELICALISM* 1 (2015) (“The face of modern marketing in the early twentieth century belonged to an old-fashioned Quaker. Consumers across the United States could purchase Quaker pharmaceuticals, lace curtains, and men’s negligee shirts. They were wooed with ads wryly depicting ‘Quaker Maids’ sailing the high seas atop bottles of rye whiskey. But all other efforts paled in comparison to the Quaker Oats Company. A sophisticated pioneer of promotion, it had spent millions of dollars since the mid-1800s to make its smiling Quaker trademarks synonymous with breakfast food, guaranteed pure.”).

<sup>54</sup> Ventimiglia, *supra* note 25, at 186.

<sup>55</sup> *Id.* (proposing the bill known as *H.R. 435: To Prohibit the Use of the Name of Any Church Religious Denomination, Society, or Association for the Purposes of Trade and Commerce*). See *H.R. 435*, 64th Cong. (1916).

<sup>56</sup> GLOEGE, *supra* note 53, at 1.

<sup>57</sup> Ventimiglia, *supra* note 25, at 186–87.

<sup>58</sup> *Id.* at 186 (“Friends have a reputation for honesty [that] only serves to emphasize the robbery and usurpation of this valued and historic appellation. It is a matter of record that certain people who are acquainted with Friends have the impression that the companies using the ‘Quaker’ name are companies of Quakers using the name for the purposes of private profit.”).

<sup>59</sup> *Id.* at 187.

<sup>60</sup> *Id.*

religious rights.<sup>61</sup> But as a speaker representing the interests of the Quaker Lace Company rebutted, “the sacred things in religion are not the sects or their names, but the things in which we believe and the things in which we have crystallized our beliefs.”<sup>62</sup>

The various concerns around the Quaker trademarks signaled an important moment in American religious history—religious and business interests had become increasingly intertwined.<sup>63</sup> Products like Quaker Oats, Post’s Elijah’s Manna cereal, and Shaker seed packets and furniture all pointed to an increasing “ideological overlap between modern consumer capitalism and religion.”<sup>64</sup> Just as businesses found it valuable to borrow from religious imagery to sell products, so too did religious organizations find it valuable to borrow from business practices to successfully compete in the American spiritual marketplace.<sup>65</sup> Thus, many religious organizations explicitly began mobilizing trademark law to support their spiritual authority.<sup>66</sup>

So, despite the Friends’ efforts, religious marks became more and more prominent.<sup>67</sup> And with the rise of religious marks came the rise of infringement disputes relating to religious marks.<sup>68</sup> Notably, these infringement disputes have

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<sup>61</sup> *Id.*

<sup>62</sup> *Id.*

<sup>63</sup> Ventimiglia, *supra* note 25, at 187.

<sup>64</sup> *Id.*

<sup>65</sup> *Id.* at 188–89.

<sup>66</sup> *See id.* at 192 (“[T]rademark law provided a useful, albeit imperfect, resource for affirming the interests of religious organizations in the late nineteenth and twentieth centuries. The emergent doctrinal language of *consumers*, *deception*, *goodwill*, and *competition* in trademark law could be harnessed by religious organizations to explain their interests and operations in an era of American religious history witnessing the rapid development of an increasingly complex spiritual marketplace.”).

<sup>67</sup> *See id.* at 189.

<sup>68</sup> *See, e.g.,* Maktab Tarighe Oveyssi Shah Maghsoudi, Inc. v. Kianfar, 179 F.3d 1244, 1247 (9th Cir. 1999); Self-Realization Fellowship Church v. Ananda Church of Self-Realization, 59 F.3d 902, 904 (9th Cir. 1995); Gen. Conf. Corp. of Seventh-Day Adventists v. Seventh-Day Adventist Congregational Church, 887 F.2d 228, 229 (9th Cir. 1989); Church of Scientology Int’l v. Elmira Mission of the Church of Scientology, 794 F.2d 38, 40–41 (2d Cir. 1986); Jews for Jesus v. Brodsky, 993 F. Supp. 282, 290 (D.N.J. 1998), *aff’d*, 159 F.3d 1351 (3d Cir. 1998).

predominantly been the result of schisms within a church, like that illustrated in the story of Jane Smith above, whereby one group breaks away from the parent church over a theological dispute.<sup>69</sup> Indeed, the “prototypical” religious trade name dispute is aptly described as follows:

The prototypical dispute occurs when a small group of parishioners breaks away from its mother church. In doing so, they hope to use part of their mother church’s name in the name of their new church. Out of a legitimate concern of confusion, or perhaps out of spite, the members of the mother church attempt to enjoin the breakaway church from using its name.<sup>70</sup>

#### C. TRADEMARK INFRINGEMENT UNDER THE LANHAM ACT

But before taking a deeper dive into infringement disputes over religious marks, this Section discusses the relevant framework by which courts analyze trademark infringement. Congress has long played a role in protecting trademarks.<sup>71</sup> In 1946, Congress enacted the Lanham Act, the current federal trademark statutory scheme.<sup>72</sup> The Lanham Act addresses a wide range of issues related to trademarks, service marks, and unfair competition.<sup>73</sup> It also creates a federal trademark registration system that allows businesses and individuals to register trademarks for their goods and services under federal law.<sup>74</sup> Federal registration, though not required, “confers important legal rights and benefits.”<sup>75</sup> As relevant to the scope of this Note, federal registration allows a mark owner to bring a suit for infringement in federal court.<sup>76</sup>

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<sup>69</sup> See *supra* Part I; see, e.g., *Self-Realization Fellowship Church*, 59 F.3d 901.

<sup>70</sup> *Silversmith & Guggenheim*, *supra* note 2, at 504.

<sup>71</sup> See *supra* Section II.B. Yet, for most of the 18th and 19th centuries, trademark law largely fell within the “province of the states” and went largely unrecorded. See *Matal v. Tam*, 582 U.S. 218, 224 (2017). And while states continue to have their unique trademark laws, such laws are outside the scope of this Note that is exclusively focused on federal law.

<sup>72</sup> 15 U.S.C. §§ 1051–1141.

<sup>73</sup> See *id.*

<sup>74</sup> See *id.* §§ 1051–66.

<sup>75</sup> *B&B Hardware, Inc. v. Hargis Indus.*, 575 U.S. 138, 172 (2014) (Thomas, J., dissenting).

<sup>76</sup> See *id.* at 173; see also 15 U.S.C. § 1121.

When an entity, religious or otherwise, alleges trademark infringement, courts look to the Lanham Act to determine if the legal rights to a mark have been violated, and if so, to determine the appropriate remedy for the violation.<sup>77</sup> In an infringement action, courts are tasked with analyzing whether the defendant's use of a mark in commerce "is likely to cause confusion, or to cause mistake, or to deceive" with regard to the plaintiff's mark.<sup>78</sup> Notably, courts do not make a substantive distinction between confusion, deception, and mistake.<sup>79</sup> Plaintiffs can assert their rights for a registered mark under § 32(1) of the Lanham Act, or they may have an unregistered mark rely on § 43(a) of the Act.<sup>80</sup> While the statutory language of the two sections may be different, the standards for recovery under both sections are identical.<sup>81</sup>

In a typical trademark infringement case, the "likelihood of confusion" inquiry centers on whether members of the purchasing public are likely to believe that the defendants' products or services come from the same source as plaintiffs' protected products or services.<sup>82</sup> Because simply viewing the marks at issue side by side does not replicate how they appear to consumers in actual market conditions, courts analyze a multitude of factors to compensate for their inability to stand as members of the purchasing public.<sup>83</sup> These factors include: similarity of the marks, actual confusion, competitive proximity of the parties' goods or services, relationship between the parties' channels of trade and relationship

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<sup>77</sup> See 15 U.S.C. § 1114 (noting remedies and infringement procedures).

<sup>78</sup> *Id.* § 1114(1)(a) (registered marks); *id.* § 1125(a)(1)(A) (unregistered marks).

<sup>79</sup> JEROME GILSON & ANNE GILSON LALONDE, *GILSON ON TRADEMARKS* § 5.01 (2024).

<sup>80</sup> *Id.*

<sup>81</sup> *Id.*

<sup>82</sup> See, e.g., *1-800-Contacts, Inc. v. Lens.com, Inc.*, 722 F.3d 1229, 1238 (10th Cir. 2013) ("Confusion can be of several sorts. For example, consumers may experience direct confusion of source when they develop the mistaken belief that the plaintiff is the origin of the defendant's goods or services—so that the defendant capitalizes on the plaintiff's good name."); *Therma-Scan, Inc. v. Thermoscan, Inc.*, 295 F.3d 623, 630 (6th Cir. 2002) ("In the first and most common type of infringement, similar marks on directly competing goods or services cause confusion over their origin. This situation is known as 'palming off,' because the defendant junior user misleads the public about the source of its goods or services, leading consumers to purchase the defendant's products in the belief that they are buying the plaintiff's.").

<sup>83</sup> See GILSON & GILSON, *supra* note 79, § 5.02.

between their advertising methods, likelihood of bridging the gap or expanding product lines, degree of care of prospective purchasers, good or bad faith of the junior trademark owner in selecting its mark, strength of the prior mark, trademark fame, quality of the parties' goods or services, and any market interface between the parties.<sup>84</sup> While these factors may vary from jurisdiction to jurisdiction, there is little substantive distinction in the versions applied by the courts.<sup>85</sup>

If the infringing party's mark fails the likelihood of confusion inquiry, then a court will uphold the plaintiff's right to exclude another from using the mark. When it comes to remedies for trademark infringement, the Lanham Act includes many: injunctive relief, damages, or the defendant's ill-gotten profits.<sup>86</sup>

An infringement judgment can be devastating to businesses for several reasons. First, a judgment may lead to significant financial consequences beyond paying substantial damages, such as costly rebranding efforts like changing the face of the business and all marketing and advertising materials.<sup>87</sup> Second, a judgment may also disrupt business operations and lead to a loss of brand recognition and customer loyalty.<sup>88</sup> Third, the reputational damage associated with the judgment may erode consumer trust and negatively impact future business prospects.<sup>89</sup>

#### D. TRADEMARK LIMITATIONS

Trademark rights, however, are not absolute. For instance, a defendant can make "fair use" of a plaintiff's mark and not be held liable for infringement. Fair use in trademark law serves as a critical mechanism for balancing the rights of trademark owners with the public's interest in free expression and competition.<sup>90</sup> There are several different fair use doctrines recognized by the Lanham Act and courts.

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<sup>84</sup> *Id.*

<sup>85</sup> *Id.*

<sup>86</sup> *Romag Fasteners, Inc. v. Fossil Grp., Inc.*, 590 U.S. 212, 213 (2020).

<sup>87</sup> *See Johansson, supra* note 11.

<sup>88</sup> *See id.*

<sup>89</sup> *See id.*

<sup>90</sup> *See GILSON & GILSON, supra* note 79, § 13.07.



First, a defendant can avail herself of the fair use defense in § 33(b)(4) of the Lanham Act, which authorizes the defendant to use the plaintiff's mark in a non-trademark sense to describe one's own goods or services.<sup>91</sup>

Second, a defendant can assert "nominative fair use" of a plaintiff's mark by using that mark as a trademark to refer to the plaintiff's goods or services so long as such use is not misleading, untruthful, or likely to cause confusion as to source, sponsorship, or affiliation.<sup>92</sup> The "nominative fair use" doctrine is a judge-made doctrine that is distinct from classic tests for fair use and likelihood of confusion.<sup>93</sup> Rather, the defense focuses on whether a defendant's reference to a plaintiff's trademark to describe its own goods and services is necessary, not too prominent, and not confusing.<sup>94</sup>

Third, a defendant's use of plaintiff's trademark may also be protected by the First Amendment in very limited cases, such as parody or use in an artistic work.<sup>95</sup> While no statutory provision exempts artistic uses from the infringement provisions of the Lanham Act, courts nevertheless acknowledge this First Amendment defense in cases involving artistic expression.<sup>96</sup>

### III. PROBLEMS FLOWING FROM INFRINGEMENT DISPUTES OVER RELIGIOUS MARKS

Owners of religious trademarks rely on the Lanham Act as a sword to police infringement of their marks and as a shield to protect against fraud and disparagement.<sup>97</sup> But once a court upholds an owner's right to exclude others, the court grants a monopoly over the religious name or symbol at issue, while ordering the infringer to stop using that name or symbol.<sup>98</sup> Exclusion from a religious name or symbol can be devastating to religious entities.<sup>99</sup> Exclusion not

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<sup>91</sup> 15 U.S.C. § 1115(b)(4); *see also* GILSON & GILSON, *supra* note 79, § 13.07.

<sup>92</sup> GILSON & GILSON, *supra* note 79, § 13.22.

<sup>93</sup> *Id.*; *see also* New Kids on the Block v. News America Pub., Inc., 971 F.2d 302, 306 (9th Cir. 1992).

<sup>94</sup> GILSON & GILSON, *supra* note 79, § 13.22.

<sup>95</sup> *Id.* § 13.24.

<sup>96</sup> *See id.*

<sup>97</sup> *See supra* Section II.A.

<sup>98</sup> *See supra* Section II.C.

<sup>99</sup> *See* Gen. Conf. Corp. of Seventh-Day Adventists v. McGill, 617 F.3d 402, 405–06 (6th Cir. 2010) ("While the Defendant was aware that the Plaintiffs had

only impacts operations by requiring religious entities to rebuild their “brand,” but it also strikes at the core of an entity’s identity and mission.<sup>100</sup> Exclusion forces those entities to forfeit the names and symbols that hold deep spiritual and cultural significance.<sup>101</sup>

There are three major problems with excluding religious entities from using religious names and symbols. Section A of this Part identifies how such exclusion offends Establishment Clause considerations. Similarly, Section B explores how such exclusion violates Free Exercise principles. Finally, Section C explains why existing Free Speech Defenses cannot save religious entities from being denied use of a religious name or symbol. Ultimately, this Part outlines how the Lanham Act is too narrow to achieve these First Amendment interests and emphasizes why religious considerations must be given greater weight in trademark infringement disputes.<sup>102</sup>

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trademarked the name ‘Seventh Day Adventist,’ he used it anyway, because he believed that he was divinely mandated to do so.”).

<sup>100</sup> See *Purcell v. Summers*, 145 F.2d 979, 985 (4th Cir. 1944).

<sup>101</sup> See *supra* Section II.C (discussing the financial ramifications of an infringement judgment); see also *supra* Section II.A (reviewing the role of trademarks in the religious context).

<sup>102</sup> Importantly, this Note argues First Amendment considerations must be given greater weight when trademark law governs protections for religious marks; it does not argue the Lanham Act is unconstitutional under the First Amendment.

First, the Establishment Clause of the First Amendment is not violated by the Lanham Act. For one thing, this Clause is not violated when churches and other religious organizations are granted trademark registration under the Lanham Act. “The USPTO has made it clear that registration of a mark does not indicate the government’s approval of the mark.” *Matal v. Tam*, 582 U.S. 218, 237 (2017). Moreover, the Supreme Court has indicated that trademarks are not a form of government speech. *Id.* at 236 (“If federal registration of a trademark makes the mark government speech, the Federal Government is babbling prodigiously and incoherently. It is saying many unseemly things.”). Furthermore, the Supreme Court has clarified that trademark registration does not constitute approval of the mark’s content or message on the government’s behalf. *Id.* at 237. Therefore, registering a religious mark cannot constitute the government endorsing or supporting a religion. See *McGill*, 617 F.3d at 405–08 (confirming the validity of the church’s federal trademark); *Nat’l Bd. of the YMCA v. YMCA of Charleston*, 335 F. Supp. 615, 624–25 (D.S.C. 1971) (“Nothing in the Constitution prohibits a religious organization from owning property—and a trademark is a property right—or prohibits the

A. EXCLUDING RELIGIOUS ENTITIES FROM USING RELIGIOUS NAMES  
AND SYMBOLS OFFENDS ESTABLISHMENT CLAUSE CONSIDERATIONS

The Establishment Clause of the First Amendment prohibits Congress from making any law “respecting an establishment of religion.”<sup>103</sup> While Establishment Clause jurisprudence is far from clear, at least one approach to the Establishment Clause focuses on neutrality, whereby the government cannot favor religion over secularism and one religion over others.<sup>104</sup> In *Engel v. Vitale*, the Supreme Court explained that one purpose of the Establishment Clause rests on the awareness that, historically, religions established under government and religious persecutions go hand in hand.<sup>105</sup>

The Supreme Court explained that the Establishment Clause was drafted against the backdrop of the 1559 Act of Uniformity in England, which was passed just a few years after the Book of Common Prayer became the official form of worship in the Church of England.<sup>106</sup> This law required all English citizens to attend services using the Book of Common Prayer and made it a criminal offense to attend any other type of religious service.<sup>107</sup> Moreover, the Founders were

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government from protecting that property from unlawful appropriation of others.”). As the government is not acting by recognizing religious marks, the “history and tradition” approach articulated in *Kennedy v. Bremerton School District* for approaching the Establishment Clause is inapplicable. 597 U.S. 507, 535 (2022).

Second, the Free Exercise Clause of the First Amendment is not violated by the Lanham Act. In *Employment Division v. Smith*, the Supreme Court proffered that so long as a regulation burdening religious practice is neutral and generally applicable, it will likely pass constitutional muster. See 494 U.S. 872, 879 (1990). After *Smith*, only a law burdening religious practice that is not neutral or not of general applicability will undergo the “most rigorous scrutiny.” See *Church of the Lukumi Bablu Aye v. City of Haileah*, 508 U.S. 520, 546 (1993) (applying strict scrutiny to ordinance that prohibited the killing of animals for religious purposes while permitting such action for other purposes, including food, scientific experimentation, pest control, clothing, and sport). In the wake of *Smith*, courts have construed the Lanham Act as a neutral and generally applicable law. See, e.g., *McGill*, 617 F.3d at 409.

<sup>103</sup> U.S. CONST. amend. I.

<sup>104</sup> See *Engel v. Vitale*, 360 U.S. 421, 433 (1962).

<sup>105</sup> *Id.* at 432.

<sup>106</sup> *Id.*

<sup>107</sup> *Id.* at 432–33.

aware of similar persecutions that were permitted under colonial law.<sup>108</sup> This backdrop also provides important context to James Madison's point in his Memorial and Remonstrance that: "Whilst we assert for ourselves a freedom to embrace, to profess and to observe the Religion which we believe to be of divine origin, we cannot deny an equal freedom to those whose minds not yet yielded to the evidence which has convinced us."<sup>109</sup>

Accordingly, the Establishment Clause has been interpreted as prohibiting the establishment of one religious society in preference to others.<sup>110</sup> This is reflected in opinions such as *United States v. Ballard*, where the Court emphasized that "[t]he First Amendment does not select any one group or any one type of religion for preferred treatment. It puts them all in that position."<sup>111</sup> Similarly, then-Justice Rehnquist wrote in his dissent in *Wallace v. Jaffree*, "[t]he evil to be aimed at . . . appears to have been the establishment of a national church, and perhaps the preference of one religious sect over another[.]"<sup>112</sup>

Yet, trademark law effectively strips religious entities of the protections that the Establishment Clause was intended to provide. Consider the "prototypical" religious trade name dispute wherein a newer break-away church will leave the mother church over some form of theological dispute and will seek to brand itself under a name similar, if not identical, to the mother church's trade name.<sup>113</sup> In these disputes, just like any other trademark infringement dispute, a court will apply the likelihood of confusion inquiry under the Lanham Act.<sup>114</sup> While the versions of the factors assessed under the "likelihood of confusion" inquiry vary from jurisdiction to jurisdiction, a court's analysis will typically include: (1) the similarity of the marks, (2) the relatedness of goods and services, (3) intent in selecting the mark, and (4) the perspective of the prospective purchasers.<sup>115</sup>

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<sup>108</sup> *Id.* at 433.

<sup>109</sup> James Madison, *Memorial and Remonstrance Against Religious Assessments*, in THE WRITINGS OF JAMES MADISON 295 (Robert A. Rutland et al. eds., 1973).

<sup>110</sup> *See, e.g., Vitale*, 360 U.S. at 433.

<sup>111</sup> *United States v. Ballard*, 322 U.S. 78, 87 (1944).

<sup>112</sup> *See Wallace v. Jaffree*, 472 U.S. 38, 99 (1985) (Rehnquist, J., dissenting).

<sup>113</sup> *Silversmith & Guggenheim*, *supra* note 2, at 504.

<sup>114</sup> *Id.*

<sup>115</sup> *See GILSON & GILSON*, *supra* note 79, § 5.02. Courts will also discuss other factors such as actual confusion, competitive proximity, and advertising

An analysis of these elements in the most common disputes over religious marks demonstrates why most courts resolve the threat of confusion in favor of the plaintiff, the mother church.<sup>116</sup> Because the break-away churches are often smaller, less powerful entities, the result of these disputes is to prefer older, more established religions over newer, dissenting factions.<sup>117</sup>

First, the similarity of the marks typically lends a court to find in favor of the plaintiff.<sup>118</sup> First, the similarity of the marks typically lends a court to find in favor of the plaintiff.<sup>119</sup> This factor is universally considered an indicator of likelihood of confusion because the more similar that the marks are, the more likely reasonable consumers will mistake or confuse the source of the product (or service) that each mark represents.<sup>120</sup> Indeed, the touchstone of this analysis is the probability of potential confusion.<sup>121</sup> In the prototypical dispute whereby one religious group has separated from the parent group, a defendant may even use the plaintiff's *entire* mark as religious organizations tend to name themselves according to the source of its theological teachings.<sup>122</sup> For instance, in *General Conference Corporation of Seventh-Day Adventists v. Perez*, the Plaintiff's entire mark SEVENTH DAY ADVENTIST was included in the infringing Defendant's name

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methods that are outside the scope of this Note, as those factors cannot be discussed in a vacuum without the specific facts of a case.

<sup>116</sup> See, e.g., *Gen. Conf. Corp. of Seventh-Day Adventists v. McGill*, 624 F. Supp. 2d 883, 897–900 (6th Cir. 2010).

<sup>117</sup> Silversmith & Guggenheim, *supra* note 2, at 506 (“Not surprisingly, most courts have found that the threat of confusion between two nonprofit organizations is sufficient grounds for denying the newer group the right to use a similar mark, despite the fact the parties have no economic or trade interests.”).

<sup>118</sup> See, e.g., *Gen. Conf. Corp. of Seventh-Day Adventists v. Perez*, 97 F. Supp. 2d 1154, 1157 (S.D. Fl. 2000).

<sup>119</sup> See *id.*

<sup>120</sup> See *id.*

<sup>121</sup> *Id.* (citing *Frehling Enters. Inc. v. Int’l Select Grp., Inc.*, 192 F.3d 1330 (11th Cir. 1999)).

<sup>122</sup> See, e.g., *Perez*, 97 F. Supp. 2d at 1157 (“[T]he marks are patently similar due to the Defendant’s utilization of Plaintiff’s entire SEVENTH-DAY ADVENTIST mark”); *Universal Church, Inc. v. Universal Life Church/ULC Monastery*, 2017 U.S. Dist. LEXIS 127362, at \*28 (S.D.N.Y. Aug. 8, 2017) (“Defendants are using the same words that comprise plaintiff’s mark.”).

“Eternal Gospel Church of the Seventh Day Adventists.”<sup>123</sup> The fact that the Defendant had attempted to distinguish its group by including “Eternal Gospel Church” in its name did not preclude the court from finding that the two marks at issue were critically confusing.<sup>124</sup> Accordingly, courts tend to find this factor favors the plaintiff.<sup>125</sup>

Second, the relatedness of the goods and services also favors the plaintiff in these infringement actions. Indeed, the prototypical dispute involves churches on both sides of the dispute, and these churches tend to share similar beliefs and provide religious services in line with those beliefs.<sup>126</sup> Thus, courts typically find this factor favors the plaintiff as well.

Third, a defendant’s intent in selecting the mark typically cuts against the defendant’s success in these infringement actions. Even where the defendant’s choice to use a mark is made in good faith, such a choice is inherently tied to that defendant’s prior knowledge of a name.<sup>127</sup> Infringement disputes over religious marks often result from a small group breaking away from its mother church, so, of course, a defendant knows and is aware of the mother church’s trademark.<sup>128</sup> Accordingly, courts typically find this factor favors the plaintiff.

Fourth, the perspective of the prospective purchasers also weighs in favor of the plaintiffs. The purchasers, or the “customers,” involved are the religious adherents associated with both parties.<sup>129</sup> Typically, they are followers of the religious beliefs practiced by the churches involved in the dispute.<sup>130</sup> In light of the

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<sup>123</sup> *Perez*, 97 F. Supp. 2d at 1157.

<sup>124</sup> *Id.* at 1157–58; *see also McGill*, 624 F. Supp. 2d at 898–99 (finding the fact that the Defendant added the word “Creation” to the name of the church as unpersuasive in overcoming the likelihood of confusion).

<sup>125</sup> *See Perez*, 97 F. Supp. 2d at 1157–58 (stating that the more similar the two marks are at issue, the more likely that there is a likelihood of confusion by the consumer which results in this factor favoring the plaintiff).

<sup>126</sup> *See, e.g., McGill*, 624 F. Supp. 2d at 898; *but see Universal Church*, 2017 U.S. Dist. LEXIS 127362, at \*31 (“While plaintiff is a traditional church offering spiritual services to its members, defendant primarily offers online ordinations so that its members can perform weddings and other religious ceremonies for nonmembers, something plaintiff does not do.”).

<sup>127</sup> *See, e.g., Perez*, 97 F. Supp. 2d at 1163.

<sup>128</sup> *Silversmith & Guggenheim*, *supra* note 2, at 504.

<sup>129</sup> *See Perez*, 97 F. Supp. 2d at 1157.

<sup>130</sup> *See id.* (implying that the people who attend a church adhere to the churches religious beliefs and traditions).

relatedness of the parties' services and similarities of the marks at issues, believers are likely to consume religious materials published by one group that they would mistakenly believe to be produced by the other group, or the believers are likely ascribe the teachings of one group to the teachings of another group.<sup>131</sup> Therefore, courts typically find this factor also favors the plaintiff.

So, while courts will consider other factors alongside these four factors discussed herein,<sup>132</sup> on balance, the factors tip the scales towards the mother church. Thus, the practical effect of a dispute under the Lanham Act is to allow the mother church to appropriate the name or symbol of a religion and enjoin a dissenter from using it. But as Justice Black has argued, the First Amendment ensures that "no one powerful sect or combination of sects [can] use political or governmental power to punish dissenters whom they [cannot] convert to their faith."<sup>133</sup>

In this way, the Lanham Act predominantly favors the mother group over any new group that secedes or withdraws, thereby giving "preference of one religious sect over another[.]"<sup>134</sup> Therefore, trademark law offends key Establishment Clause considerations.

#### B. EXCLUDING RELIGIOUS ENTITIES FROM USING RELIGIOUS NAMES & SYMBOLS IMPLICATES FREE EXERCISE PRINCIPLES

The First Amendment further guarantees that "Congress shall make no law . . . prohibiting the free exercise [of religion]."<sup>135</sup> Under the Free Exercise Clause, a person has "the right to believe and profess whatever religious doctrine one desires."<sup>136</sup> Accordingly, the government is prohibited from regulating beliefs, meaning it "may not compel affirmation of religious belief, punish the expression of religious doctrines it believes to be false, impose special disabilities on the basis of religious views or religious status, or lend its power to one or the other side in controversies over religious authority or dogma."<sup>137</sup>

<sup>131</sup> See *Gen. Conf. Corp. of Seventh-Day Adventists v. McGill*, 617 F.3d 402, 416 (6th Cir. 2010).

<sup>132</sup> See *GILSON & GILSON*, *supra* note 79, § 5.02.

<sup>133</sup> *Zorach v. Clauson*, 343 U.S. 306, 319 (1952) (Black, J., dissenting).

<sup>134</sup> See *Wallace v. Jaffree*, 472 U.S. 38, 99 (1985) (Rehnquist, J., dissenting).

<sup>135</sup> U.S. CONST. amend. I.

<sup>136</sup> *Emp. Div. Dep't of Hum. Res. of Or. v. Smith*, 494 U.S. 872, 877 (1990).

<sup>137</sup> *Id.*

Yet, because a trade name may be a “religious touchstone for another individual,” excluding another religious entity from using a name or phrase may impede the ability of individuals to freely exercise religion without government interference.<sup>138</sup> One’s ability to freely use a particular religious name in spiritual practice, and to identify one’s belief system with the words that often describe it, are weakened when trademark law designates just one owner.<sup>139</sup>

Furthermore, trademark law burdens the free exercise of religion by depriving organizations of the benefits that a religious name and symbol provide in helping to build their mission and promote growth. From a business perspective, an infringement judgment tells the religious group to start over. Pick a new name; rebuild your brand; find a new way to publish and advertise; put your reputation at risk.<sup>140</sup> From a religious perspective, an infringement judgment tells the group that it cannot use that which is sacred to its identity. And so, a two-hundred-year-old congregation loses its identifying mark;<sup>141</sup> a pastor cannot use the name he was divinely mandated to choose;<sup>142</sup> a minority congregation forfeits the name it has held for over sixty years.<sup>143</sup>

#### C. EXISTING FREE SPEECH DEFENSES ARE INAPPLICABLE TO RELIGIOUS MARKS

As previously discussed in this Note, alleged infringers may seek shelter under the First Amendment in certain cases by raising an expressive fair use defense.<sup>144</sup> Moreover, free-speech protections are sprinkled throughout the

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<sup>138</sup> Silversmith & Guggenheim, *supra* note 2, at 468.

<sup>139</sup> N. Cameron Russell, *Allocation of New Top-Level Domain Names and the Effect upon Religious Freedom*, 12 J. MARSHALL REV. INTELL. PROP. L. 697, 711 (2013).

<sup>140</sup> See generally *supra* Section II.A.

<sup>141</sup> See *Protestant Episcopal Church v. Episcopal Church*, 806 S.E.2d 82, 92–93 (S.C. 2017).

<sup>142</sup> See *Gen. Conf. Corp. of Seventh-Day Adventists v. McGill*, 617 F.3d 402, 416–17 (6th Cir. 2010) (upholding the infringement claim against a pastor’s use of the term “Seventh-day Adventists”).

<sup>143</sup> See *Lutheran Free Church v. Lutheran Free Church*, 141 N.W.2d, 827, 835–36 (Minn. 1966) (ruling against a minority faction who opposed the church’s merger and sought to retain possession of the old name).

<sup>144</sup> See *supra* Section II.D.



Lanham Act.<sup>145</sup> For example, generic<sup>146</sup> and descriptive<sup>147</sup> marks, symbols, and phrases are barred from registration in order to preserve their use for others.<sup>148</sup> Additionally, the Act allows fair use of marks in journalism and comparative advertising as well as other non-trademark uses.<sup>149</sup> Indeed, many Lanham Act defenses and the Act's required showing of likelihood of confusion reflect an effort to balance intellectual property rights with the rights of others to use the words and symbols they choose.<sup>150</sup>

Since religious organizations use trademarks to express their views, can alleged infringers defend a mark as religious speech? Not quite. Free speech arguments against infringement liability have generally been limited to uses of a mark that are *not* commercial speech, including uses in parody, satire, artistic expression, or social commentary.<sup>151</sup> However, the use of trademarks for religious purposes is generally treated as commercial use and is subject to the Lanham

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<sup>145</sup> GILSON & GILSON, *supra* note 79, § 13.24

<sup>146</sup> The United States Patent and Trademark Offices defines a term as generic “if its primary significance to the relevant public is the class or category of goods or services on or in connection with which it is used.” Trademark Manual of Examining Procedure § 1209.01(c)(i) (Nov. 2024). “Thus, ‘piano’ is the generic name for one member of a class of keyboard instruments, ‘cat food’ is the generic name for nourishment for felines, and ‘pen’ is the generic name for an implement used for writing with ink.” GILSON & GILSON, *supra* note 79, § 2.02.

<sup>147</sup> A descriptive term is typically an adjective or adverb that is used to describe the functions, characteristics, size, weight, dimensions, uses, or components of a product or the nature of a service. GILSON & GILSON, *supra* note 79, § 2.03. “For example, SPEEDY for a delivery services does not distinguish, inasmuch as competing businesses may and probably do say that their delivery services are speedy as well. Similarly, SOAKER for a squirt gun or BREAK & BAKE for scored cookie dough do not signify the source of either product to the consumer or distinguish the product of one manufacturer from those of another.” *Id.*

<sup>148</sup> See 15 U.S.C. § 1502(e). For an article discussing how tests for genericness impact religious marks, see Gambill, *supra* note 18, at 244.

<sup>149</sup> GILSON & GILSON, *supra* note 79, § 13.22.

<sup>150</sup> *Id.* § 13.24.

<sup>151</sup> *Id.*

Act.<sup>152</sup> Accordingly, confusingly similar uses of religious marks may be enjoined.<sup>153</sup> Thus, in most disputes over religious marks, a finding of likelihood of confusion ends the matter, and the court refrains from resolving any constitutional questions.<sup>154</sup>

#### IV. PROPOSING A RELIGIOUS FAIR USE DEFENSE TO TRADEMARK INFRINGEMENT

To better balance the public interest in protecting trademark rights against protecting religious freedoms, this Part introduces a novel religious fair use defense to trademark infringement disputes. While still respecting the valuable protections that trademark law provides religious organizations, a religious fair use defense better affords religious communities the right to use certain names and symbols that hold deep spiritual significance. Section A of this Part borrows from the expressive fair use defense to lay the groundwork for a religious fair use defense. Section B then analyzes how the history and tradition of religious marks justify courts implementing a religious fair use defense. Section C grounds this

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<sup>152</sup> See, e.g., *United We Stand Am., Inc. v. United We Stand, Am. N.Y., Inc.*, 128 F.3d 86, 90 (2d Cir. 1997) (“The Lanham Act has . . . been applied to defendants furnishing a wide variety of non-commercial public and civil benefits.”); *Gen. Conf. Corp. of Seventh-Day Adventists v. McGill*, 617 F.3d 402, 408 (6th Cir. 2010) (finding it permissible to resolve disputes over church trademarks when using neutral principles of trademark law); *Maktab Tarighe Oveyssi Shah Maghsoudi, Inc. v. Kianfar*, 179 F.3d 1244, 1249–50 (9th Cir. 1999) (same).

<sup>153</sup> See, e.g., *Christian Sci. Bd. of Dirs. of the First Church of Christ, Scientist v. Robinson*, 115 F. Supp. 2d 607, 610–11 (W.D.N.C. 2000) (holding that use of CHRISTIAN SCIENCE mark by dissident group would be misrepresentation); *Gen. Conf. Corp. of Seventh-Day Adventists v. Perez*, 97 F. Supp. 2d 1154, 1164 (S.D. Fla. 2000) (judgment for corporate entity holding church assets; likelihood of confusion found with group that left to form own church); *Gideons Int’l, Inc. v. Gideon 300 Ministries, Inc.*, 94 F. Supp. 2d 566, 577 (E.D. Pa. 1999) (finding likelihood of confusion between marks used by two Christian ministries; “The nonprofit or non-business character of the parties does not affect the proper trademark analysis.”); *Jews for Jesus v. Brodsky*, 993 F. Supp. 282, 313 (D.N.J. 1998), *aff’d*, 159 F.3d 1351 (3d Cir. 1998) (preliminary injunction against “bogus” and “jewsforjesus.org”); *Nat’l Spiritual Assembly of the Baha’Is v. Nat’l Spiritual Assembly of the Baha’Is*, 150 U.S.P.Q. 346, 356 (N.D. Ill. 1966) (enjoining the use of the BAHA’I name and related symbols that were used by a schismatic group).

<sup>154</sup> See *United We Stand*, 128 F.3d at 90; *McGill*, 617 F.3d at 408; *Kianfar*, 179 F.3d at 1249–50.

defense in Establishment Clause and Free Exercise Clause principles, demonstrating why a fair use doctrine should be specifically tailored to respect religious freedoms. Ultimately, this proposed defense seeks to foster an environment where religious freedoms are respected and protected, while also upholding the integrity and rights of trademark owners.

A. ENVISIONING A RELIGIOUS FAIR USE DEFENSE

The doctrine of fair use in trademark law serves as a critical mechanism for balancing the rights of trademark owners with the public's interest in free expression and competition.<sup>155</sup> As such, judges have established fair use defenses to allow for certain uses of trademarks without permission, provided that these uses do not cause consumer confusion or diminish the value of a trademark.<sup>156</sup> Until now, the idea of religious fair use not been explicitly explored. However, a religious fair use defense could recognize the unique role that religious names and symbols play in society, whereby the use of certain names and symbols may transcend commercial interests and serve deeper spiritual or cultural functions.<sup>157</sup> By establishing a religious fair use defense, courts could ensure that individuals or organizations are not unduly restricted from using religious marks in a way that is integral to their faith or religious practice. This defense would not only protect religious freedoms but also encourage a more nuanced understanding of how trademarks intersect with cultural and religious identities in a legal framework that still respects intellectual property rights.

In formulating a religious fair use defense, this Note borrows from the expressive fair use defense—the *Rogers* test.<sup>158</sup> The *Rogers* test emerged from a dispute in the Second Circuit where the Defendants produced and distributed a film titled “Ginger and Fred” about two fictional Italian cabaret dancers who imitated Ginger Rogers and Fred Astaire.<sup>159</sup> Ginger Rogers objected under the Lanham Act to the use of her name; however, the Second Circuit rejected the claim

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<sup>155</sup> See GILSON & GILSON, *supra* note 79, § 13.07.

<sup>156</sup> See, e.g., *New Kids on the Block v. News Am. Pub., Inc.*, 971 F.2d 302, 306 (9th Cir. 1992) (creating a nominative fair use defense); *Rogers v. Grimaldi*, 857 F.2d 994, 999 (2d Cir. 1989) (creating an expressive fair use defense).

<sup>157</sup> See generally Section II.A.

<sup>158</sup> See *Rogers*, 857 F.2d at 999.

<sup>159</sup> *Id.* at 996–97.

reasoning that the titles of “artist works,” like the works themselves, have an “expressive element.”<sup>160</sup>

Therefore, the titles implicate First Amendment values.<sup>161</sup> Notably, the court found that the names only posed a slight risk of confusion as to the source or content of the work.<sup>162</sup> Accordingly, the Second Circuit attempted to limit application of the Lanham Act to when “the public interest in avoiding consumer confusion outweighs the public interest in free expression”<sup>163</sup> such that, when a title “with at least some artistic relevance” does not “explicitly mislead[] as to the content,” the claim cannot go forward.<sup>164</sup> The *Rogers* Court reasoned that “because overextension of Lanham Act restrictions in the area of [expressive works] might intrude on First Amendment values, we must construe the Act narrowly to avoid such a conflict.”<sup>165</sup>

From this case came a two-prong test for assessing marks with expressive elements that implicate First Amendment values. Under the first prong, courts examine whether the use of the mark has any “artistic relevance to the underlying work whatsoever.”<sup>166</sup> If there is some cognizable artistic relevance, courts must presume that the use is to be protected.<sup>167</sup> As one district court explained, “as long as the plaintiff’s trademark is used to further plausibly expressive purposes, and not to mislead consumers about the origin of a product or suggest that the plaintiff endorsed or is affiliated with it, the First Amendment protects that use.”<sup>168</sup> Then under the second prong, courts assess whether “the title explicitly misleads as to the source or the content of the work.”<sup>169</sup> Under this test, plaintiffs find it difficult to prevail and enjoin the sale of the expressive work at issue.<sup>170</sup>

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<sup>160</sup> *Id.* at 998.

<sup>161</sup> *Id.*

<sup>162</sup> *Id.* at 999–1000.

<sup>163</sup> *Id.* at 1006.

<sup>164</sup> *Rogers*, 857 F.2d at 1000.

<sup>165</sup> *Id.* at 998.

<sup>166</sup> *Id.* at 999.

<sup>167</sup> *Id.* at 1006.

<sup>168</sup> See *Hermès Int’l v. Rothschild*, 654 F. Supp. 3d 268, 276 (S.D.N.Y. 2023); see also *E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1100 (9th Cir. 2008) (emphasizing that the *Rogers*’ artistic-relevance test presents a very low threshold: “the level of relevance must merely be above zero”).

<sup>169</sup> *Rogers*, 857 F.2d at 999.

<sup>170</sup> See GILSON & GILSON, *supra* note 79, § 13.07(2)(a).

For decades, lower courts have used the *Rogers* test in cases involving trademarks that perform expressive functions.<sup>171</sup> Indeed, the test has broken out into many different interpretations across the circuits.<sup>172</sup> So, in 2022 when the Supreme Court granted certiorari in *Jack Daniel's Properties v. VIP Products*, where

<sup>171</sup> See, e.g., *Mattel, Inc. v. MCA Rec., Inc.*, 296 F.3d 894, 902 (9th Cir. 2001) [hereinafter *Mattel I*]; *Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 683 F.3d 1266, 1278 (2012); *Louis Vuitton Malletier S.A. v. Warner Bros. Ent., Inc.*, 866 F. Supp. 2d 172, 182 (S.D.N.Y. 2012).

<sup>172</sup> For one thing, courts have construed the artistic relevance prong differently. Compare *Hermès Int'l*, 654 F. Supp. 3d at 280–81 (centering the “artistic relevance” determination around the defendant’s *intention* in creating the work) (emphasis added), with *Twentieth Century Fox Television v. Empire Distrib. Inc.*, 875 F.3d 1192, 1198 (9th Cir. 2017) (noting that “cultural significance” of a trademark may be relevant to the artistic relevance prong). And while courts applying the *Rogers* test all agree that the second prong involves examining whether use of the mark would be misleading as to the source or content and that this requirement is stricter than the standard multi-factor test for likelihood of confusion, the application of the second prong falls into two different categories: “(1) those examining whether the title or other use of the mark is ‘explicitly misleading’ and (2) those applying the standard multi-factored confusion test but ‘raising the bar.’” GILSON & GILSON, *supra* note 79, § 13.24[ii][C].

The Sixth, Ninth, and Eleventh Circuits fall within the first category, asking whether the mark is “explicitly misleading.” These courts consider “whether there was an ‘explicit indication,’ ‘overt claim,’ or ‘explicit misstatement’ that cause . . . consumer confusion.” *Brown v. Electronic Arts, Inc.*, 724 F.3d 1235, 1245 (9th Cir. 2013) (quoting *Rogers* 875 F.2d at 1001). In these circuits, an artistically relevant use will likely outweigh a relatively small risk of confusion. See, e.g., *AM Gen. LLC v. Activision Blizzard, Inc.*, 450 F. Supp. 3d 467, 479 (S.D.N.Y. 2020) (interpreting precedent to hold that “an artistically relevant use will outweigh a moderate risk of confusion where the contested user offers a ‘persuasive explanation’ that the use was an ‘integral element’ of an artistic expression”).

On the other hand, the Second, Fifth, and Tenth fall within the second category, applying an iteration of the multi-factored confusion test. These circuits tend to require a “particularly compelling” showing of likelihood of confusion. See, e.g., *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Grp.*, 886 F.2d 490, 495 (2d Cir. 1989); *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 665–66 (5th Cir. 2000) (citing *Sugar Busters LLC v. Brennan*, 177 F.3d 258, 269 n.7 (5th Cir. 1999)).

the infringement claim at issue was subject to the threshold *Rogers* test,<sup>173</sup> many suspected the Court to finally articulate the appropriate balance between First Amendment freedoms and trademark law.<sup>174</sup> But in reality, the Court merely offered a “narrow” opinion, explaining only when *Rogers* does not apply— “[w]hen a mark is used as a mark[.]”<sup>175</sup>

The Court explained that when a mark is being used to identify a source, “the First Amendment does not demand a threshold inquiry like the *Rogers* test, ...as the likelihood-of-confusion test does enough work to account for the public interest in free expression.”<sup>176</sup> For “when a challenged trademark use functions as ‘source-identifying,’ trademark rights ‘play well with the First Amendment.’”<sup>177</sup> Declining to rule on whether the *Rogers* test is ever appropriate, the Court effectively left the *Rogers* test intact.<sup>178</sup>

This Note breathes new life into the *Rogers* test, tailoring its framework to apply to disputes over religious marks. Accordingly, a religious fair use defense should similarly be a two-prong test. Under the first prong, courts should examine the religious relevance of the use of a mark. The alleged infringer should only have to point to any “[religious] relevance to the underlying work whatsoever,” and if there is some cognizable religious relevance, courts should presume that use is to be protected.<sup>179</sup> This should be a low threshold for alleged infringers. This low threshold is critical not just to safeguard religious liberties that have historically been compromised in these disputes but also to avoid courts undertaking “judicial review of ecclesiastical matters.”<sup>180</sup> A determination of what constitutes religious

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<sup>173</sup> See *Jack Daniel’s Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140, 140 (2023).

<sup>174</sup> See, e.g., Lesley Grossberg, *Jack Daniel’s Props., Inc. v. VIP Products LLC: The Supreme Court Corrects Course on Rogers Test*, ICEMILLER (June 26, 2023), <https://www.icemiller.com/thought-leadership/jack-daniels-properties-inc-v-vip-products-llc-the-supreme-court-corrects-course-on-rogers-test> [<https://perma.cc/SH6A-CY95>].

<sup>175</sup> *Jack Daniel’s Props.*, 599 U.S. at 158.

<sup>176</sup> *Id.*

<sup>177</sup> *Id.* at 156.

<sup>178</sup> *Id.* at 160.

<sup>179</sup> *Rogers v. Grimaldi*, 857 F.2d 994, 999 (2d Cir. 1989).

<sup>180</sup> For an interesting discussion on the topic of government action in intra-church trademark disputes as a violation of the neutral principles’ framework, see generally Mary Kate Nicholson, *Left with No Name: How Government Action in Intra-Church Trademark Disputes Violates the Free Exercise Clause of the First Amendment*, 76 WASH. & LEE L. REV. 1345, 1348 (2019).

relevance may present a most delicate question.<sup>181</sup> However, such an inquiry is not unlike what courts do all the time in Free Exercise challenges whereby courts must assess whether a sincerely held religious belief is being burdened.<sup>182</sup>

Then, under the second prong, courts should examine whether the mark “explicitly misleads as to the source or the content of the work.”<sup>183</sup> Accordingly, courts need only perform a minimal examination of whether a religious use of a trademark would mislead consumers. Courts can ask “whether there was an ‘explicit indication,’ ‘overt claim,’ or ‘explicit misstatement’ that causes . . . consumer confusion.”<sup>184</sup> This can be satisfied by survey results, witness testimony, or other evidence that could establish the public being explicitly misled by the trademark at issue.<sup>185</sup>

But, again, *Jack Daniel’s* instructs that the *Rogers* test should not apply where the alleged infringer has used a mark as a mark, i.e., to identify a source.<sup>186</sup> The rub is that the religious fair use exemption should exist to allow a religious entity to use a trademark religious name, symbol, or other emblem precisely as one’s own mark. In this way, the religious fair use exemption looks more like the nominative fair use exemption that does allow a mark to be used as a trademark.<sup>187</sup>

Accordingly, the *Jack Daniel’s* limitation should be cabined to the context of expressive fair use, not religious fair use. A First Amendment religious exception to trademark infringement should be broader than the First Amendment speech exception. First, religious freedom interests were not at play in the Jack Daniel’s dispute over whiskey and dog toys.<sup>188</sup> Second, the *Rogers* test has not been applied to religious marks because the use of such marks has traditionally been classified as commercial, thereby barring any application of *Rogers*.<sup>189</sup> Third, the

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<sup>181</sup> See *Welsh v. United States*, 398 U.S. 333, 351–61 (1970) (Harlan, J., concurring in result); *Ballard*, 322 U.S. at 79.

<sup>182</sup> See, e.g., *Wisconsin v. Yoder*, 406 U.S. 205, 215–17 (1972).

<sup>183</sup> *Rogers*, 857 F.2d at 999.

<sup>184</sup> *Brown v. Electronic Arts, Inc.*, 724 F.3d 1235, 1245 (9th Cir. 2013) (quoting *Rogers*, 875 F.2d at 1001).

<sup>185</sup> For an example of how surveys are used to analyze this prong under the *Rogers* test, see *Mattel, Inc. v. MCA Rec., Inc.*, 28 F. Supp. 2d 1120, 1143 (C.D. Cal. 1998) [hereinafter *Mattel II*].

<sup>186</sup> See *Jack Daniel’s Props.*, 599 U.S. at 146.

<sup>187</sup> GILSON & GILSON, *supra* note 79, § 13.22.

<sup>188</sup> See *Jack Daniel’s Props.*, 599 U.S. at 140.

<sup>189</sup> GILSON & GILSON, *supra* note 79, § 13.24(3)(a).

*Jack Daniel's* Court's reasoning does not apply in the context of religious fair use.<sup>190</sup> As the Court explained, "the likelihood-of-confusion test does enough work to account for the public interest in free expression."<sup>191</sup> While free-speech protections may be sprinkled throughout the Lanham Act, these protections are distinct from protections for religious freedoms under the First Amendment.<sup>192</sup> Moreover, for reasons explained below in Section IV.B., religious trademark rights have not historically "play[ed] well with the First Amendment."<sup>193</sup> Fourth, the *Jack Daniel's* Court left the door cracked to situations when a mark may fairly be used as a mark.<sup>194</sup> For the reasons that follow, religious expression is one of those situations.

B. WHY HISTORY & TRADITION JUSTIFY A RELIGIOUS FAIR USE  
DEFENSE

Justification for a religious fair use defense begins with the history and tradition of religious marks. Indeed, as the Court recently exemplified in its latest decision covering the intersection of the First Amendment and trademark law, the nature of trademark law informs the constitutional analysis.<sup>195</sup>

In *Vidal v. Elster*, the Supreme Court resolved a challenge to the names clause under the Lanham Act, which prohibits registration of a trademark that "[c]onsists of or comprises a name . . . identifying a particular living individual except by his written consent."<sup>196</sup> In deciding what the First Amendment demanded of the court's analysis, the Court looked to history and tradition.<sup>197</sup>

Writing for the majority, Justice Thomas explained, "trademark rights have always coexisted with the First Amendment[.]"<sup>198</sup> Then focusing specifically on the names clause, Justice Thomas found that "[r]estrictions on trademarking

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<sup>190</sup> See *Jack Daniel's Props.*, 599 U.S. at 160.

<sup>191</sup> *Id.* at 159.

<sup>192</sup> See *supra* Section III.C. Indeed, the right to free speech is closely related but distinct from the right to religious freedom under the First Amendment.

<sup>193</sup> *Jack Daniel's Props.*, 599 U.S. at 157 (citing *Mattel I*, 296 F.3d at 900).

<sup>194</sup> *Jack Daniel's Props.*, 599 U.S. at 159 (explaining "[w]hen a mark is used as a mark (except, potentially, in rare situations), the likelihood-of-confusion inquiry does enough work to account for the interest in free expression").

<sup>195</sup> See *Elster*, 602 U.S. at 294.

<sup>196</sup> *Id.* at 304 (citing 15 U.S.C. § 1052(c)).

<sup>197</sup> *Id.* at 295–309.

<sup>198</sup> *Id.* at 295.



names have a long history”<sup>199</sup> and “a tradition of restricting the trademarking of names has coexisted with the First Amendment, and the names clause fits within that tradition.”<sup>200</sup> In light of the “longstanding, harmonious relationship” between both trademark law generally and the names clause specifically, the majority found that heightened scrutiny need not apply to its analysis.<sup>201</sup>

The majority then took the history and tradition test a step further to conclude that “history and tradition establish that the particular restriction before us . . . does not violate the First Amendment.”<sup>202</sup> Thus, history and tradition not only informed the level of judicial review but also conclusively settled the constitutionality of the names clause.<sup>203</sup> Justice Barrett, with whom Justice Kagan joined and Justice Sotomayor and Justice Jackson joined in part, wrote a concurrence disagreeing with the majority’s use of history as wholly dispositive.<sup>204</sup> In Justice Barrett’s view, history played a key role in understanding why the court need not engage in heightened scrutiny in its analysis.<sup>205</sup> Furthermore in a concurrence joined by Justice Kagan and Justice Jackson, Justice Sotomayor agreed with Justice Barrett’s use of history in this manner, while ultimately proposing a separate test for resolving the constitutionality of the provision at issue.<sup>206</sup>

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<sup>199</sup> *Id.* at 301.

<sup>200</sup> *Engel*, 370 U.S. at 307.

<sup>201</sup> *Id.* at 299.

<sup>202</sup> *Id.* at 310.

<sup>203</sup> *See id.*

<sup>204</sup> *Id.* at 311 (Barrett, J., concurring).

<sup>205</sup> *See Elster*, 602 U.S. at 313 (“This history, in my view, is key to understanding why we need not evaluate content-based trademark registration restrictions under heightened scrutiny.”).

<sup>206</sup> *See id.* at 330 (Sotomayor, J., concurring) (“Whereas the denial of trademark registration under viewpoint-and content-based criteria is presumptively unconstitutional under heightened scrutiny, a denial under viewpoint-neutral content-based criteria is not constitutionally suspect and does not trigger the same exacting scrutiny. In explaining why the difference is decisive in this context, the Court and Justice Barrett emphasize that trademarks are inherently content based, yet have long go existed with the First Amendment. I agree with the use of historical evidence to support this point. History informs the understanding that content-based distinctions are an intrinsic feature of trademarks, and that the marks’ purpose is to identify and distinguish goods for the public. That use of history is legitimate and in fact valuable, just as evidence of a longstanding practice of government can

Therefore, all nine Justices at least agreed that history informs the manner by which the Court examines the constitutionality of trademark law.<sup>207</sup>

Even though the constitutionality of the Lanham Act, or its likelihood of confusion inquiry more specifically, is not challenged by this Note, the *Elster* decision nonetheless emphasizes the importance of analyzing the relationship between the First Amendment and trademark law through the lens of history and tradition.<sup>208</sup> Additionally, after Justice Gorsuch's concurrence in the *Jack Daniel's* case wherein he questioned whether the expressive fair use defense is commanded by the First Amendment, or if it is "merely gloss" on the Lanham Act, evaluating the history and tradition of religious marks is critical.<sup>209</sup>

First, because jurists and legal theorists originally struggled to justify religious marks, Congress enacted a registration bar intended to prevent registration of religious marks. As such, religious marks have not historically "always coexisted with the First Amendment[.]"<sup>210</sup> Although Congress permitted religious marks to be registered when it first enacted federal trademark law in 1870, it quickly limited registration of religious marks by enacting the "immoral or scandalous" registration bar.<sup>211</sup> As previously described in Part II.B., Congress was inspired by works such as those written by William Henry Browne, who advocated that religious names and symbols were ineligible for trademark protection as religious marks in the commercial setting would offend those who viewed the names and symbols as sacred.<sup>212</sup> Thus, the theory behind the "immoral or scandalous" bar is that the bar was likely intended to prevent registration of those marks containing terms or icons associated with religion and other moral matters.<sup>213</sup> Therefore, religious marks have not always existed alongside the First Amendment.

Second, because religious marks that were successfully registered generated pushback from religious communities themselves, religious marks do

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inform the meaning of constitutional provisions in appropriate cases.") (citations omitted).

<sup>207</sup> See *id.* at 295, 330, 313.

<sup>208</sup> See *id.*

<sup>209</sup> *Jack Daniel's Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140, 165 (2023) (Gorsuch, J., concurring).

<sup>210</sup> *Elster*, 602 U.S. at 295.

<sup>211</sup> Act of Feb. 20, 1905 § 4(a).

<sup>212</sup> See BROWNE, *supra* note 36, at 608–09.

<sup>213</sup> Abdel-Khalik, *supra* note 46, at 195.

not boast a “longstanding, harmonious relationship” with the First Amendment.<sup>214</sup> This pushback is exemplified by the Quakers’ effort to pass the bill known as *H.R. 435: To Prohibit the Use of the Name of Any Church Religious Denomination, Society, or Association for the Purposes of Trade and Commerce*.<sup>215</sup> As previously explained in Section II.B., the Quakers advanced arguments relating to the purposes of trademark protection, such as consumers being confused about who was producing goods like Quaker Oats.<sup>216</sup> Furthermore, the group advanced that the Quaker name was simply “not a thing to be sold.”<sup>217</sup> Before Congress, one member of the Society of Friends argued that registering marks with the Quaker name infringed the Society’s religious rights.<sup>218</sup> Accordingly, history reflects that religious marks do not boast the same “longstanding, harmonious relationship” with the First Amendment as seen in areas of trademark law.<sup>219</sup>

Third, because the “immoral or scandalous” bar denied some religious marks while upholding others until it was recently ruled unconstitutional, religious marks are not deeply rooted in our legal tradition.<sup>220</sup> In *Iancu v. Brunetti*, the Court asked whether the “immoral or scandalous” provision of the Lanham Act was viewpoint-based.<sup>221</sup> The Court analyzed how the USPTO had refused to register certain marks that communicated “immoral” or “scandalous” views about religion and other controversial topics.<sup>222</sup> The Court provided examples including:

The PTO disapproved registration for the mark BONG HITS 4 JESUS because it “suggests that people should engage in an illegal activity [in connection with] worship” and because “Christians would be morally outraged by a statement that connects Jesus Christ with illegal drug use.” And the PTO refused to register

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<sup>214</sup> *Elster*, 602 U.S. at 299.

<sup>215</sup> *To Prohibit the Use of the Name of Any Church Religious Denomination, Society, or Association for the Purposes of Trade and Commerce: Hearing on H.R. 435 Before the H. Comm. on the Judiciary*, 64th Cong. 4–55 (1916) [hereinafter *To Prohibit the Use of the Name Hearing*].

<sup>216</sup> Ventimiglia, *supra* note 25, at 186–87.

<sup>217</sup> *Id.* at 187.

<sup>218</sup> *Id.*

<sup>219</sup> *See id.*

<sup>220</sup> *See generally* *Iancu v. Brunetti*, 588 U.S. 388 (2019).

<sup>221</sup> *Id.* at 394.

<sup>222</sup> *Id.* at 395.

trademarks associating religious references with products (AGNUS DEI for safes and MADONNA for wine) because they would be “offensive to most individuals of the Christian faith” and “shocking to the sense of propriety.” But once again, the PTO approved marks—PRAISE THE LORD for a game and JESUS DIED FOR YOU on clothing—whose message suggested religious faith rather than blasphemy or irreverence.<sup>223</sup>

Accordingly, the Court found this clause viewpoint-based and thus unconstitutional.<sup>224</sup> In light of the “immoral or scandalous” bar’s impact on religious marks throughout the 20<sup>th</sup> and early 21<sup>st</sup> century, religious marks are not deeply rooted in our legal tradition.

For at least these three reasons, religious marks have a contentious history and tenuous tradition. Therefore, religious freedoms under the constitution command courts to adopt a religious fair use defense.

C. A RELIGIOUS FAIR USE DEFENSE PROTECTS BOTH TRADEMARK RIGHTS & RELIGIOUS FREEDOMS

This new defense gives teeth to First Amendment considerations in infringement disputes over religious marks. First, by allowing religious entities to argue for religious fair use, smaller, dissenting religious groups will be afforded a greater opportunity to use those names and symbols that are sacred to their religion and culture after breaking away from their parent churches. Therefore, trademark law will evolve to no longer consistently prefer certain religious groups at the expense of others.<sup>225</sup> In this way, a religious fair use defense considers Establishment Clause principles that have traditionally been compromised under a strict application of the Lanham Act in trademark infringement disputes.<sup>226</sup>

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<sup>223</sup> *Id.* at 395–96.

<sup>224</sup> *Id.* at 398. Viewpoint-based trademark law “distinguishes between two opposed sets of ideas.” *Id.* at 394. In this way, the government singles out a trademark “based on the specific motivating ideology or the opinion or perspective of the speaker. *See Reed v. Town of Gilbert*, 576 U.S. 155, 168 (2015). Viewpoint discrimination is an “egregious form of content discrimination” and is presumed unconstitutional unless the government proves the discriminatory regulation is narrowly tailored to serve a compelling state interest. *See Rosenberger v. Rector and Visitors of Univ. of Va.*, 515 U.S. 819, 829 (1995).

<sup>225</sup> *See supra* Section III.A.

<sup>226</sup> *See supra* Section III.A.

Second, while the likelihood of confusion inquiry often stunts the growth and mission of break-away groups, thereby burdening those groups' free exercise of religion, a religious fair use defense will create more breathing room for break-away groups to identify with those names and symbols that they hold most sacred and to fulfill their mission.<sup>227</sup> Religious entities often use symbols as part of their sacred practices and teachings, and these uses are not merely intended for commercial gain but for the preservation and promotion of faith.<sup>228</sup> Thus, the devastating financial and religious implications associated with an infringement judgment enjoining a religious entity's use of a mark can be better avoided by allowing room for more religious groups to use marked religious emblems. Accordingly, a religious fair use defense better accomplishes the religious freedoms guaranteed by our Constitution.

Importantly, a religious fair use defense will not act as an absolute bar to trademark infringement. In this way, courts do not impose limitations that contravene Congressional intent by recognizing religious fair use, but rather, courts avoid the serious constitutional problems discussed herein when construing the application of the Lanham Act. Religious entities may continue to rely on the important protections and benefits that trademark law provides. Indeed, as acknowledged in Section II.A., religious marks need the armor of legal protection offered under federal trademark law where such marks touch an entity's most sacred beliefs and values.<sup>229</sup> And under trademark law, religious entities may shield themselves from unwanted associations that threaten to tarnish their beliefs and values. Therefore, this new defense respects the twin goals of facilitating consumers' choice and protecting producers' goodwill in a market where religious entities, just like other businesses, rely on trademark law to grow and expand and to protect their reputation.<sup>230</sup>

Therefore, a religious fair use defense addresses the problems identified in this Note by better balancing the public interest in avoiding consumer confusion against the public interest in protecting religious freedoms.

## V. CONCLUSION

As discussed herein, religious marks can prove a critical asset to a religious organization, allowing the organization to be an active participant in the marketplace as well as to fulfill its ministerial purpose. As such, when owners of

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<sup>227</sup> See *supra* Section III.B.

<sup>228</sup> See *supra* Section II.A.

<sup>229</sup> See *id.*

<sup>230</sup> See *id.*

religious marks successfully bring an infringement suit against users of religious marks, thereby enjoining the use of the disputed marks, the impact on the infringing group can be devastating. A congregation may lose its identifying mark, a pastor may forfeit use of a name that he was divinely mandated to choose, and a minority group may lose its long-held name. Because trademark rights are not constitutionally mandated, courts should hesitate to uphold trademark rights where constitutionally protected freedoms are at stake.

This Note demonstrates how infringement disputes implicate both Establishment Clause and Free Exercise Clause considerations, and yet existing defenses to trademark infringement offer no sanctuary to alleged infringers. In light of recent Supreme Court precedent reviewing the intersection of trademark law and the First Amendment, lower courts can comfortably advance the framework proposed herein in order to better balance the public interest in avoiding consumer confusion against the public interest in protecting religious freedoms. In effect, religious adherents, like Jane Smith,<sup>231</sup> may hold onto the names and symbols so deeply intertwined with their own religious expression so long as they do not explicitly mislead or confuse others as to the source of the name or symbol at issue.

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<sup>231</sup> See *supra* Part I.