



December 10, 2015

VIA EMAIL

Douglas Bush
Arent Fox LLP on behalf of Intellectual Reserve, Inc.
1717 K Street, NW
Washington, DC
2006-5344
doug.bush@arentfox.com

Dear Mr. Bush:

I am writing to you on behalf of my client, the Mormon Mental Health Association (“MMHA”), regarding Intellectual Reserve, Inc.’s (“IRI”) assertions that my client has violated IRI’s purported trademark rights in the word “Mormon” and/or “Mormon.org” (collectively, “Mormon”). IRI’s improper assertions have caused significant harm to my client as well as others wishing to use a common, well-understood word to describe a community. Those assertions should be immediately withdrawn.

MMHA is a professional association for mental health providers, clinicians, educators and advocates who are interested in or are working with members of the Church of Jesus Christ of Latter-day Saints, as well as members of any church tracing back to the restoration movement of Joseph Smith. MMHA seeks to improve training, research, strategy, collaboration and education in the mental health treatment of Mormons, helping ensure that this population’s needs are being met by trained professionals who adhere to professional ethics codes.

MMHA uses the term “Mormon” to accurately describe the population it seeks to serve, and IRI has no legal basis to challenge that use.

First, the term “Mormon” has an established original, descriptive, primary meaning and my client is free to use it in that sense. *See* 15 U.S.C. § 1115(b)(4), *see also, e.g., KP Permanent MakeUp, Inc. v. Lasting Impression Inc.*, 125 S. Ct. 542, 550 (2004) (trademark law should not be used to “deprive commercial speakers of the ordinary utility of descriptive words.”). “Mormon” is a term used to describe those who follow Mormonism or are members of the Mormon community.¹ That is precisely what MMHA has done in the name of its organization, as well as related commentary. MMHA does not use the term “Mormon” as a mark, but instead to refer to and describe the community it serves. There is no other term that MMHA can employ that would convey the same meaning.

¹ IRI itself has claimed that the term “Mormon” is often used to describe church members. *See Eller v. Intellectual Reserve, Inc.*, No. 4:14-cv-00914, Dkt. No. 45, at 5 (S.D. Tex. filed May 27, 2014).



Second, the term is generic. It is popularly understood to refer to a way of life that is common to many and owned by none. See *Self-Realization Fellowship Church v. Ananda Church of Self-Realization*, 59 F.3d 902, 909 (9th Cir. 1995).

Even if the term “Mormon” in “Mormon Mental Health Association” could be seen as use as a mark, IRI cannot show any infringement of any valid IRI mark, for numerous reasons, some of which are discussed here.

When considered as a whole, the term “Mormon Mental Health Association” and its related URL “MormonMentalHealthAssoc.org” are distinctly different from the marks “Mormon” and “Mormon.org.” See *Entrepreneur Media Inc. v. Smith*, 279 F.3d 1135, 1144, 1146-47 (9th Cir. 2007) (noting that “the common and necessary uses of the word ‘entrepreneur’ provide[s] strong evidence that [the incontestable mark holder] cannot have the exclusive right to use the *word* ‘entrepreneur’ in any mark identifying a printed publication addressing subjects related to entrepreneurship” and “[i]n the Internet context, consumers are aware that domain names for different Web sites are quite often similar, because of the need for language economy, and that very small differences matter”) (emphasis in original); see also *In re National Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985) (“[L]ikelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark.”).

Furthermore, any rights IRI may have to the term “Mormon” are necessarily weak. See *Universal Money Centers, Inc. v. American Telephone & Telegraph Co.*, 22 F.3d 1527 (10th Cir. 1994) (noting that a weak trademark is “one that is often used by other parties” (quotation and citation omitted)). A host of organizations apparently not affiliated with IRI or the Church of Jesus Christ of Latter-day Saints use the term “Mormon.” See, e.g., MormonChurch.org; MormonMatters.org; MormonThink.com; MormonDiscussionPodcast.org.²

Notably, MMHA prominently disclaims any association with the Church of Jesus Christ of Latter-day Saints. Indeed, MMHA makes clear that its positions may differ from those of the Church of Jesus Christ of Latter-day Saints. In addition, there is no intent to trade on any goodwill held by IRI, which further shows there can be no infringement of any purported mark. See *First Savings Bank, FSB v. First Bank System*, 101 F.3d 645, 655 (10th Cir. 1996).

In light of the foregoing, please confirm that you withdraw your claims against MMHA by January 4, 2016. In addition, I strongly urge you to take similar steps with regard to the myriad other organizations and persons who have also been the targets of this misguided campaign.

² The status of “Mormon” as an incontestable mark would not imply that it is strong. See *Oreck Corp. v. U.S. Floor Sys., Inc.*, 803 F.2d 166, 171 (5th Cir. 1986).



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MMHA wishes to work with the Church of Jesus Christ of Latter-day Saints, its members, and those within the broader Mormon community, not against them. However, if you do not cease your unfounded threats, we are prepared to pursue all legal remedies as necessary.

If you have any questions, please contact me: 415-436-9333 x 160 or vera@eff.org.

Sincerely,

A handwritten signature in blue ink, appearing to read 'Vera Ranieri'.

Vera Ranieri
Staff Attorney