

IN THE UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF TEXAS  
FORT WORTH DIVISION

GENERAL CONFERENCE CORPORATION OF  
SEVENTH-DAY ADVENTISTS, a District of  
Columbia Corporation,

Plaintiff,

v.

JOE GRESHAM, STERLING TRICE, LINDA  
TRICE, BILL MATHIS, GAY MATHIS, FORT  
WORTH NW FREE SEVENTH-DAY ADVENTIST  
CHURCH, BEREAN CHURCH OF FREE  
SEVENTH-DAY ADVENTISTS, INC. d/b/a  
INTERNATIONAL ASSOCIATION OF FREE  
SEVENTH-DAY ADVENTISTS, and JOHN DOES  
1-20,

Defendants.

Case No. 4:22-cv-00395-P

**PLAINTIFF'S ANSWER TO IAFSDA'S COUNTERCLAIMS**

Plaintiff, General Conference Corporation of Seventh-day Adventists (GCC), hereby answers the Counterclaims of Defendant Berean Church of Free Seventh-Day Adventists, Inc. d/b/a International Association of Free Seventh-day Adventists (IAFSDA) in its First Amended Answer (ECF No. 59), as follows:

**I. PARTIES**

1. Paragraph 1 is admitted.
2. Paragraph 2 is admitted.

**II. JURISDICTION AND VENUE**

3. Paragraph 3 is admitted.
4. Paragraph 4 is admitted.
5. Paragraph 5 is admitted.

### **III, FACTUAL BACKGROUND**

#### **A. History of IAFSDA and the Free Seventh-day Adventist Denomination**

6. GCC is without knowledge sufficient to admit or deny paragraph 6.
7. GCC is without knowledge sufficient to admit or deny paragraph 7.
8. GCC is without knowledge sufficient to admit or deny paragraph 8.

#### **B. Long Time Use of “Free Seventh-day Adventist” by Groups Unaffiliated with General Conference/GCC**

9. GCC is without knowledge sufficient to admit or deny the first sentence of paragraph 9. The second sentence is denied.

10. GCC is without knowledge sufficient to admit or deny paragraph 10.

11. GCC is without knowledge sufficient to admit or deny paragraph 11.

12. GCC is without knowledge sufficient to admit or deny paragraph 12.

13. In response to paragraph 13, GCC denies that IAFSDA has common law rights to use the Marks. GCC denies that it as an entity has legally admitted same. GCC does not deny the existence of the letter, and states that its contents speak for themselves. Otherwise, denied.

14. In response to paragraph 14, GCC does not know what “At all relevant times” means and it is ambiguous; therefore, the first sentence of paragraph 14 is denied. GCC denies that it as an entity has legally admitted the allegations of paragraph 14. GCC does not deny the existence of the letters, and states that its contents speak for themselves. Otherwise, denied.

15. In response to paragraph 15, GCC states that the contents of the article speaks for itself and GCC does not consider the encyclopedia article a legal admission of GCC.

#### **C. GCC’s Application to Register “ADVENTIST” (App. 73/261,132; Reg. No. 1,176,153)**

16. Paragraph 16 is admitted.

17. Paragraph 17 is admitted.

18. Paragraph 18 is admitted.

19. Paragraph 19 is admitted.

20. In response to paragraph 20, GCC is without knowledge sufficient to admit or deny what the PTO relied upon. Otherwise, admitted.

**D. GCC's Application to Register "SEVENTH-DAY ADVENTIST" (App. 73/261,134; Reg. No. 1,177,185)**

21. Paragraph 21 is admitted.

22. Paragraph 22 is admitted.

23. Paragraph 23 is admitted.

24. In response to paragraph 24, GCC is without knowledge sufficient to admit or deny what the PTO relied upon. Otherwise, admitted.

**E. GCC's Application to Register "ADVENTIST" (App. 73/312,118; Reg. No. 1,218,657)**

25. Paragraph 25 is admitted.

26. Paragraph 26 is admitted.

27. Paragraph 27 is admitted.

28. Paragraph 28 is admitted.

29. In response to paragraph 29, GCC is without knowledge sufficient to admit or deny what the PTO relied upon. Otherwise, admitted.

**F. GCC Made False and Material Representations of Fact in the Applications**

30. Paragraph 30 is denied. In particular, GCC denies knowing the Marks were generic.

31. GCC is without knowledge sufficient to admit or deny paragraph 31.

32. GCC is without knowledge sufficient to admit or deny paragraph 32.

33. Paragraph 33 is denied. In particular, GCC denies knowing the Marks were generic.

34. As to the quotation from the *Kinship* case in Paragraph 34, GCC admits that the *Kinship* case is identified and that a substantial portion ( but not all ) of the quoted language is accurately detailed. As to the remaining allegations, GCC is without knowledge sufficient to admit or deny paragraph 34.

35. Paragraph 35 is denied, except that the scripture passages are accurately quoted.

36. GCC is without knowledge sufficient to admit or deny paragraph 36.

37. GCC is without knowledge sufficient to admit or deny paragraph 37.

38. GCC is without knowledge sufficient to admit or deny paragraph 38.

**G. GCC's Declaration of Incontestability Submitted with the '118 Application Was Fraudulent.**

39. Paragraph 39 is admitted.

40. Paragraph 40 is denied.

**IV. FIRST COUNTERCLAIM**  
**Cancellation of Trademark Registration Due to Genericness**

41. GCC's responses in the foregoing paragraphs are incorporated herein by reference.

42. In response to paragraph 42, GCC denies that ADVENTIST is generic; otherwise, GCC is without knowledge sufficient to admit or deny paragraph 42.

43. GCC is without knowledge sufficient to admit or deny paragraph 43.

44. GCC is without knowledge sufficient to admit or deny paragraph 44.

45. GCC is without knowledge sufficient to admit or deny paragraph 45.

46. In response to paragraph 46, GCC admits that ADVENTIST and SEVENTH-DAY ADVENTIST refer to the Seventh-day Adventist Church and its adherents.

47. Paragraph 47 is denied.

48. Paragraph 48 is denied.

- 49. GCC is without knowledge sufficient to admit or deny paragraph 49.
- 50. Paragraph 50 is denied.
- 51. Paragraph 51 is denied.
- 52. Paragraph 52 is denied.

**V. SECOND COUNTERCLAIM**  
**Cancellation of Trademark Registration Due to Abandonment**

- 53. GCC's responses in the foregoing paragraphs are incorporated herein by reference.
- 54. GCC is without knowledge sufficient to admit or deny paragraph 54.
- 55. Paragraph 55 is denied.
- 56. Paragraph 56 is denied.
- 57. Paragraph 57 is denied.

**VI. THIRD COUNTERCLAIM**  
**Cancellation of Trademark Registration Due to Fraud**

- 58. GCC's responses in the foregoing paragraphs are incorporated herein by reference.
- 59. Paragraph 59 is denied.
- 60. Paragraph 60 is denied.
- 61. Paragraph 61 is denied.
- 62. Paragraph 62 is denied.
- 63. Paragraph 63 is denied.
- 64. In response to paragraph 64, GCC admits that IAFSDA is seeking such relief, but denies that it is entitled to it.

**VII. FOURTH COUNTERCLAIM**  
**Civil Liability for False or Fraudulent Registration**

- 65. GCC's responses in the foregoing paragraphs are incorporated herein by reference.
- 66. Paragraph 66 is admitted.

67. Paragraph 67 is denied.

68. Paragraph 68 is denied.

69. In response to paragraph 69, GCC admits that IAFSDA is seeking such relief, but denies that it is entitled to it.

**VIII. FIFTH COUNTERCLAIM**  
**Declaratory Judgment of Non-infringement**

70. GCC's responses in the foregoing paragraphs are incorporated herein by reference.

71. Paragraph 71 is denied.

72. Paragraph 72 is denied.

73. In response to paragraph 73, GCC admits that IAFSDA is seeking such relief, but denies that it is entitled to it.

**IX. PRAYER FOR RELIEF**

74. GCC denies that IAFSDA is entitled to any of the relief sought.

**AFFIRMATIVE DEFENSES**

75. The Marks ADVENTIST and SEVENTH-DAY ADVENTIST are distinctive, or at least descriptive with secondary meaning, referring to the Seventh-day Adventist Church, not generic, and are incontestable. The mere fact that ADVENTIST and SEVENTH-DAY ADVENTIST may have some historical significance does not prevent their being subject to registration. *Cf. Bauer Bros. LLC v. Nike, Inc.*, No. 09cv500, 2011 WL 843971, 2011 U.S. Dist. LEXIS 23025, \*11-14 (S.D. Cal. Mar. 8, 2011). More specifically as to GCC's Marks:

The Court finds that "SEVENTH-DAY ADVENTIST" has not become generic. The Plaintiff's surveys, as well as its use of the name, convince the Court that most of the public identifies "SEVENTH-DAY ADVENTIST" as the name of the Plaintiff Church and not a religion.

*General Conf. Corp. of Seventh-Day Adventists v. Perez*, 97 F. Supp. 2d 1154, 1162-63 (S.D. Fla. 2000). *See generally General Conf. Corp. of Seventh-Day Adventists v. McGill*, 617 F.3d 402, 412-16 (6th Cir. 2010).

76. The fraudulent registration claims fail to plead all the required elements and thus do not state causes of action; alternatively, those claims fail for lack of proof. *See*:

The four elements of a fraudulent oath claim are that: (1) there was another use of the same or a confusingly similar mark at the time the oath was signed; (2) the other users had legal rights superior to the applicant's rights; (3) the applicant knew that the other user had superior rights, and either believed that a likelihood of confusion would result or had no reasonable basis for believing otherwise; and (4) the applicant, in failing to disclose these facts to the PTO, intended to procure a registration to which it was not entitled. The claim is not established through mere knowledge that another party was using a similar mark.... In addition, because the oath made in the verified statement in a trademark application is "phrased in terms of a subjective belief," it is "extremely difficult to prove fraud so long as the signer has an honestly held, good faith belief" that it is the senior right holder.

*Taza Sys., LLC v. Taza 21 Co., LLC*, No. 11-0073, 2012 U.S. Dist. LEXIS 194711, \*7-8 (W.D. Pa. Nov. 39, 2012). *See also Quiksilver, Inc. v. Kymsta Corp.*, 466 F.3d 749, 755-56 (9th Cir. 2006); *AirWair Int'l Ltd. v. Schultz*, 84 F. Supp. 3d 943, 953 (N.D. Cal. 2015); *Acme Valve & Fittings Co. v. Wayne*, 386 F. Supp. 1162, 1169 (S.D. Tex. 1974); *WRB, Inc. v. DAMM, LLC*, No. 21-cv-1899, 2022 WL 17844323, 2022 U.S. Dist. LEXIS 230054, \*50-56 (D. Minn. Dec. 22, 2022); *LiveRamp, Inc. v. Kochava, Inc.*, No. 19-cv-02158, 2020 WL 2065696, 2020 U.S. Dist. LEXIS 75482, \*5-10 (N.D. Cal. Apr. 29, 2020); *Smith Int'l, Inc. v. Olin Corp.*, 209 U.S.P.Q. 1033, 1043-44, 1981 TTAB LEXIS 47, \*27 (T.T.A.B. 1981). Specifically, "a senior user ordinarily need not identify junior users in the oath." *Rosso & Mastracco, Inc. v. Giant Food, Inc.*, 720 F.2d 1263, 1266 (Fed. Cir. 1983). *See also eCash Techs., Inc. v. Guagliardo*, 210 F. Supp. 2d 1138, 1148-51 (C.D. Cal. 2000).

77. GCC had prior rights in the ADVENTIST and SEVENTH-DAY ADVENTIST Marks over IAFSDA. Also, on information and belief, any common law rights that IAFSDA may have had prior to GCC's registration of the Marks, if any, had been lost at the time of the registration due to discontinuity of commercial use. *See Financial Sys. Software, Ltd. v. Financial Software Sys., Inc.*, 85 F. Supp. 2d 482, 487 (E.D. Pa. 1999), *aff'd w/o opin.*, 242 F.3d 370 (3d Cir. 2000); *Am. Tech. Ventures v. Orlov*, No. 20-23728-CIV, 2021 WL 4973536, 2021 U.S. Dist. LEXIS 212139, \*7-10 (S.D. Fla. June 9, 2021).

78. IAFSDA cannot excuse its own infringing use based on supposed defenses of third parties. *Fletcher's Original State Fair Corny Dogs, LLC v. Fletcher-Warner Holdings LLC*, 434 F. Supp. 3d 473, 489 (E.D. Tex. 2020); *Neal Techs., Inc. v. Unique Motorsports, Inc.*, No. 4:15CV385, 2016 WL 3912988, 2016 U.S. Dist. LEXIS 93149, \*5-12 (E.D. Tex. June 28, 2016), *adopted*, 2016 WL 3902306, 2016 U.S. Dist. LEXIS 92652 (July 16, 2016).

**WHEREFORE**, Plaintiff GCC prays Defendant IAFSDA's Counterclaims be dismissed for failure to state a claim, and that all relief sought by IAFSDA be denied, and judgment entered for GCC, and for such other relief to which GCC is entitled.

Dated: April 24, 2023

Respectfully submitted,

/s/ Richard L. Schwartz  
Richard L. Schwartz  
Texas Bar No. 17869500  
Whitaker Chalk Swindle &  
Schwartz PLLC  
301 Commerce St., Ste 3500  
Fort Worth, TX 76102  
Telephone: (817) 878-0500  
Fax: (817) 878-0700  
[rschwartz@whitakerchalk.com](mailto:rschwartz@whitakerchalk.com)



Todd R. McFarland (*Pro Hac Vice*)  
Illinois Bar No. 6272690  
General Conference of  
Seventh-day Adventists  
12501 Old Columbia Pike  
Silver Spring, MD 20904-6600  
Telephone: (301) 680-6321  
Fax: (301) 680-6329  
[mcfarlandt@gc.adventist.org](mailto:mcfarlandt@gc.adventist.org)

*Counsel for Plaintiff General Conference  
Corporation of the Seventh-day Adventists*

**CERTIFICATE OF SERVICE**

**I HEREBY CERTIFY** that on April 24, 2023, I caused this document to be filed pursuant to the e-filing protocol of this Court, which thereby served via electronic mail all counsel of record.

/s/ Richard L. Schwartz  
Richard L. Schwartz