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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Mailed: September 24, 2008

Opposition No. 91175853

DC Comics

v.

Gotham City Networking, Inc.

**Before Quinn, Drost, and Mermelstein,
Administrative Trademark Judges.**

By the Board:

Gotham City Networking, Inc. ("applicant") filed two applications for registration. The first application is for the mark GOTHAM BATMEN in standard characters.¹ The second application is for the mark in the following form:²



¹ Application Serial No. 78899511, filed on June 2, 2006, based on an allegation of use in commerce under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), asserting dates of first use anywhere and first use in commerce since February 1, 2006.

² Application Serial No. 78917938, filed on June 27, 2006, based on an allegation of use in commerce under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), asserting dates of first use anywhere and first use in commerce since February 1, 2006.

As originally filed, both applications recited the following identification of services: "recreational services in the nature of sports teams."

USPTO records demonstrate that, during the prosecution of each of these two applications, applicant, via examiner's amendment, disclaimed the exclusive right to use the term GOTHAM apart from the mark as shown and amended its identification of services to read as follows: "entertainment services in the nature of softball, baseball, basketball and hockey games" in International Class 41.

On January 23, 2007, applicant's application Serial No. 78899511 for the mark GOTHAM BATMEN in standard characters was published for opposition as amended. Thereafter, on January 30, 2007, applicant's application Serial No. 78917938 for the mark GOTHAM BATMEN and design was published for opposition as amended.

DC Comics ("opposer") filed a notice of opposition to registration of applicant's marks on February 12, 2007 on the following grounds: (1) likelihood of confusion, (2) dilution, (3) fraud and (4) no bona fide use of the mark in commerce.

On April 16, 2007, applicant filed a motion to dismiss opposer's claims of likelihood of confusion and dilution on the ground that opposer had failed to state a claim upon which relief may be granted. On April 26, 2007, opposer

filed its response to applicant's motion to dismiss which included a request to strike evidence outside of the pleadings. By order dated August 18, 2007, the Board converted applicant's motion to one for summary judgment inasmuch as applicant presented matters outside the pleadings in support of its motion to dismiss. Additionally, the Board allowed opposer additional time in which to supplement its already filed response to applicant's motion. On September 10, 2007, opposer filed a motion for Rule 56(f) continued discovery which the Board granted, in part, by order dated September 30, 2007. On January 25, 2008, opposer filed its response to applicant's motion for summary judgment concurrently with its own cross-motion for summary judgment on its pleaded claims of fraud, lack of a bona fide use of the mark in commerce, likelihood of confusion and dilution.

This case now comes up for consideration of (1) applicant's motion for summary judgment on opposer's claims of likelihood of confusion and dilution and (2) opposer's cross-motion for summary judgment on opposer's claims of fraud, likelihood of confusion, dilution, and lack of a bona fide use of the mark in commerce. The motions are fully briefed.

We first turn to opposer's cross-motion for summary judgment on its claim of fraud. In support of

its motion, opposer argues that applicant has committed fraud in attempting to procure registrations for its involved marks, thus making the involved applications *void ab initio*. Opposer asserts that applicant, at the time it filed its involved applications, at the time it amended its identification of services during the examination process, and to date was not and is not using its involved marks in commerce in connection with all the recited services as amended. Specifically, opposer contends that applicant has admitted in its responses to opposer's Rule 56(f) discovery requests that it was not and is not using the involved marks in commerce in connection with entertainment in the nature of baseball, basketball and hockey games, and has only used the marks in connection with softball games.

Opposer argues that this case is analogous to the case of *Medinol Ltd. v. Neuro Vasx, Inc.*, 67 USPQ2d 1205 (TTAB 2003), in which fraud was found because there was no use of the involved mark on one of the two listed goods in the statement of use, and applicant admitted as much.

Thus, opposer argues that the involved applications are invalid because applicant falsely represented that it used its marks on the all the recited services, as amended, when applicant knew, or

should have known, that it was not using its involved marks in commerce on all the services identified in the amended identification of services.

Opposer further argues that the involved applications were signed by applicant's counsel, David O. Klein, who opposer asserts is also a member of opposer's business networking organization, as well as a player on the softball team which is the subject of applicant's applications and, therefore, was clearly in a position to have personal knowledge of the facts concerning applicant's own use of its marks on the amended services identified in the involved applications.

As evidence in support of its motion for summary judgment on its claim of fraud, opposer submitted the declaration of its attorney, Andrea L. Calvaruso, through which opposer makes of record, *inter alia*: (a) true and correct copies of applicant's involved applications, together with the examiner's amendments and USPTO Snapshot of the involved applications at the time of publication from the USPTO online records, (b) true and correct copies of applicant's responses to opposer's First Set of Requests for Admissions, applicant's responses to opposer's First Set of Requests for Interrogatories, and letters from

applicant's counsel regarding such responses and (c) a true and correct copy of applicant's entire document production in response to opposer's discovery requests stamped by applicant at GOT0001-GOT0202.

In response to opposer's motion on the claim of fraud, applicant contends that it did not commit fraud. Applicant asserts that its involved marks have been used in conjunction with recreational sports entertainment since as early as February 2006, to identify and distinguish its GOTHAM BATMEN softball team, as well as its business networking and referral organization. Applicant further argues that, to the extent that applicant's use of its involved marks to promote interest in its business networking and referral services was not adequately conveyed during the registration process, not having done so was the product of a good faith, inadvertent mistake regarding direct and indirect use of applicant's involved marks. Moreover, applicant contends that, in completing its involved applications, applicant intended to convey that since as early as February 2006, its use of its involved marks was limited to the promotion of recreational sports activities in furtherance of its sale of memberships in its business networking organization and that the undisputed fact that its

involved marks have only been used in conjunction with softball is immaterial and the additional recreational sports identified in the involved applications were similarly the product of an inadvertent mistake concerning applicant's use of the involved marks.

Additionally, applicant argues that opposer's use of applicant's responses to opposer's Rule 56(f) discovery requests to support its motion for summary judgment on its claim of fraud is improper inasmuch as the Board only permitted limited discovery regarding opposer's claim of likelihood of confusion.

As evidence in support of its opposition to opposer's motion for summary judgment on the claim of fraud, applicant has submitted the affidavit of its counsel, David O. Klein, who attests to, among other things, applicant's intent regarding its filing of the involved applications.

In its reply, opposer argues that applicant's subjective intent does not absolve the fraud committed by applicant. Rather, opposer argues that the appropriate inquiry is the objective manifestation of applicant's intent. Moreover, opposer contends that applicant's alleged inadvertent mistake of including services in its involved applications for which applicant does not use or has ever used its marks in

association therewith also does not cure a finding of fraud. Finally, opposer asserts that applicant's claim that the Board's September 30, 2007 order regarding the scope of Rule 56(f) discovery precludes opposer's use of facts obtained as a result of such discovery to support its own motion for summary judgment on its claim of fraud is baseless. Indeed, opposer contends that, to the extent applicant's responses bear on other issues in this opposition proceeding, such as opposer's fraud claim, they may be considered for summary judgment on any of the pleaded claims at issue.

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986), and *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). When the moving party's motion is supported by evidence sufficient to indicate that there is no genuine issue of material fact, and that the moving party is entitled to judgment, the burden shifts to the nonmoving party to demonstrate the existence of specific genuinely-disputed facts that must be resolved at trial.

The nonmoving party may not rest on the mere allegations of its pleadings and assertions of counsel, but must designate specific portions of the record or produce additional evidence showing the existence of a genuine issue of material fact for trial. In general, to establish the existence of disputed facts requiring trial, the nonmoving party "must point to an evidentiary conflict created on the record at least by a counterstatement of facts set forth in detail in an affidavit by a knowledgeable affiant." *Octocom Systems Inc.*, supra at 1786, citing *Barmag Barmer Maschinenfabrik AG v. Murata Machinery, Ltd.*, 731 F.2d 831, 836, 221 USPQ 561, 564 (Fed. Cir. 1984). A dispute as to a material fact is genuine only if a reasonable fact finder viewing the entire record could resolve the dispute in favor of the nonmoving party. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). Finally, in deciding a motion for summary judgment, the Board must view the evidence in the light most favorable to the nonmovant, and must draw all reasonable inferences from underlying facts in favor of the nonmovant. *Id.*

As a preliminary matter, we find that there is no genuine issue of material fact as to opposer's standing. Opposer has submitted the declaration of opposer's special counsel, Lillian Laserson, who attests, among other things, to the following: (1) opposer is the owner of all rights and interests in the world-famous BATMAN comic books and

related BATMAN character, including all trademarks, copyrights and indicia associated with BATMANM and (2) since as early as 1939, opposer and its predecessor in interest have used the mark BATMAN, and related marks, including the black silhouette image of batwings with pointed edges, family of marks with the prefix "BAT" and related indicia, including GOTHAM CITY, in connection with its world-famous comics and related goods and services such as television programs, motion pictures, and licensed consumer merchandise. Ms. Laserson's declaration is sufficient to show that there is no genuine issue of material fact that opposer has a real interest in the proceedings, i.e., a personal interest in the outcome of the proceeding, and a reasonable basis for a belief of damage.³ See, e.g., Trademark Act Section 14(a), 15 U.S.C. Section 1064(a); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Universal Oil Prod. Co. v. Rexall Drug & Chem. Co.*, 463 F.2d 1122, 174 USPQ 458, 459 (CCPA 1972).

Next, the Board finds applicant's argument that opposer is precluded from using facts obtained during the limited Rule 56(f) discovery permitted by the Board regarding opposer's likelihood of confusion claim to support its claim of fraud in its cross-motion for summary judgment unpersuasive. The Board notes that opposer served Rule

³ The Board notes that applicant does not contest opposer's standing in its motion for summary judgment or in its response to opposer's cross-motion for summary judgment.

56(f) discovery requests within the scope permitted by Board order dated September 30, 2007. The Board agrees with opposer that the fact that applicant's responses to such discovery may have a bearing on other issues in this proceeding does not preclude the party seeking such discovery from relying on facts obtained from such discovery to support a motion for summary judgment on any other pleaded claims at issue in the case. Indeed, applicant has not provided any authority to the contrary. Accordingly, opposer's use of applicant's responses to opposer's Rule 56(f) discovery requests to support its own motion for summary judgment on its claim of fraud is permissible.

We now turn to the merits of opposer's motion for summary judgment on its claim of fraud. Based on the record now before us and for the reasons discussed below, we conclude that summary judgment is appropriate because opposer has established that there are no genuine issues of material fact remaining for trial with regard to its claim of fraud, and that it is entitled to a judgment on this ground.

Fraud in procuring a trademark registration occurs when an applicant for registration knowingly makes false, material representations of fact in connection with an application to register. See *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir., 1986). A party making a fraud claim is under a heavy burden because fraud must be proved by clear and convincing evidence, leaving nothing to

speculation, conjecture, or surmise. Any doubt must be resolved against the party making the claim. See *Smith International, Inc. v. Olin Corporation*, 209 USPQ 1033 (TTAB 1981).

There is no dispute and no genuine issue of material fact that applicant filed its applications based on use in commerce and provided authorization to amend its identification of services during the prosecution of the involved applications to specifically delineate its services when it knew or should have known that it did not use the involved marks in connection with all the recited services, as amended, as of the filing dates of the applications.

Statements regarding the use of the mark on goods and services are certainly material to issuance of a registration. See *Standard Knitting, Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ2d 1917 (TTAB 2006) (fraud found based on misrepresentation regarding use of the mark on most of the goods identified in the filed applications); *First International Services Corp. v. Chuckles Inc.*, 5 USPQ2d 1628 (TTAB 1988) (fraud found in applicant's filing of application with verified statement that the mark was in use on a range of personal care products when applicant knew it was in use only on shampoo and hair setting lotion). See also, *General Car and Truck Leasing Systems Inc. v. General Rent-A-Car Inc.*, 17 USPQ2d 1398 (D.C. S.Fla. 1990), aff'g

Opposition No. 91175853

General Rent-A-Car Inc. v. General Leaseways, Inc., Canc.
No. 14,870 (TTAB May 2, 1988).

The Board agrees with opposer that this case is similar to the *Medinol* case. In *Medinol*, a trademark application was filed, the mark was published, a statement of use was submitted, and a registration issued for "medical devices, namely, neurological stents and catheters." In response to a petition for cancellation, registrant admitted in its answer that the mark was not used on stents. The Board stated the following (at 1208):

The fraud alleged by petitioner is that respondent knowingly made a material representation to the USPTO in order to obtain registration of its trademark for the identified goods. There is no question that the statement of use would not have been accepted nor would registration have issued but for respondent's misrepresentation, since the USPTO will not issue a registration covering goods upon which the mark has not been used. (cites omitted).

Similarly, in this case there is no question that the applications for registration under Section 1(a) of the Trademark Act would have been refused but for applicant's misrepresentation regarding its use of the mark on all the recited services, as amended, in the involved applications. It is irrelevant that registrations have yet to issue for applicant's marks. The timing of the misrepresentation is immaterial. Whether the false statements alleging use of the mark in commerce occur at the time of filing the application, during the examination process, or at a later

point during the USPTO's review of the statement of use, the result is the same--an application results in a registration improperly accorded legal presumptions in connection with goods and/or services on which the mark is not used.⁴ See *Hurley Int'l LLC v. Volta*, 82 USPQ2d 1339, 1344 (TTAB 2007).

In this case, applicant has admitted that as of the filing dates of its involved applications, as well as during the examination process of the same, it was not using the mark in commerce for the following services identified in the applications, as amended: "entertainment services in the nature of baseball, basketball and hockey games." From the original filing of its involved applications and throughout the prosecution thereof, applicant continued to assert its claim of use under Section 1(a) of the Trademark Act. In this instance, the law is clear that an applicant may not claim a Section 1(a) filing basis unless the mark was in use in commerce on or in connection with *all* the

⁴ We note, however, that a misstatement in an application as to the goods or services on which a mark has been used does not rise to the level of fraud where an applicant amends the application prior to publication. See *Universal Overall Co. v. Stonecutter Mills Corp.*, 379 F.2d 983, 154 USPQ 104 (CCPA 1967). However, the Board further notes that applicant did not amend its applications during the examination process to exclude entertainment services in the nature of basketball, baseball and hockey games. Rather, applicant amended its applications to specifically include such services.

goods or services covered by the Section 1(a) basis as of the application filing date. 37 C.F.R. Section 2.34(a)(1)(i). *Cf. E.I. du Pont de Nemours & Co. v. Sunlyra International, Inc.*, 35 USPQ2d 1787, 1791 (TTAB 1995). Moreover, applicant's counsel authorized the issuance of an examiner's amendment in each of applicant's involved applications during the prosecution of these applications whereby applicant agreed to amend its identification of services to specifically delineate its services when it knew or should have known that it did not use the involved marks in connection with all the recited services, as amended, as of the filing dates of the applications. Thus, as in *Medinol*, a material representation of fact with regard to use of the mark on particular services was made by applicant and that statement was relied upon by the USPTO in determining applicant's rights to registration.

The fact that applicant's inclusion of basketball, baseball and hockey games in its amended identification of services was allegedly inadvertent and that applicant's intent, during the examination process of its involved applications, was to convey that its use of its involved marks was limited to the promotion of recreational sports activities in furtherance of its sale of memberships in its business networking organization does not change our finding of fraud herein. It is well established that in *inter*

partes proceedings "proof of specific intent is not required, rather, fraud occurs when an applicant or registrant makes a false material representation that the applicant or registrant knew or should have known was false." *General Car and Truck*, 17 USPQ2d at 1400-1401.

As the Board determined in *Medinol, supra* at 1209, "the appropriate inquiry is...not into the registrant's subjective intent, but rather into the objective manifestations of that intent." In *Medinol, supra* at 1209-1210, the Board concluded that the facts justified a finding of fraud:

The undisputed facts in this case clearly establish that respondent knew or should have known at the time it submitted its statement of use that the mark was not in use on all of the goods. Neither the identification of goods nor the statement of use itself was lengthy, highly technical, or otherwise confusing, and the President/CEO who signed the document was clearly in a position to know (or to inquire) as to the truth of the statements therein.

As previously indicated, applicant in the case before us has admitted that it was not using, and indeed never used, its involved marks for most of the recited services, as amended, in commerce as of the filing dates of its involved applications. Applicant was certainly in a position to have personal knowledge of the facts concerning its own use of its marks in connection with the services identified in its applications, as amended, especially since applicant's counsel, who filed the applications on behalf of

applicant and who authorized the examiner's amendments amending the identification of services, is a co-founder of applicant's business network organization, as well as a member of applicant's GOTHAM BATMEN softball team.

Similarly, applicant was clearly capable of availing itself of the relevant information available on the USPTO website regarding the various filing bases and their specific requirements.

In view of the above, we find applicant's material misrepresentations made in connection with its applications were fraudulent and, therefore, the applications are *void ab initio*. Accordingly, summary judgment is entered in opposer's favor on the issue of fraud. The opposition is sustained and judgment is entered against applicant solely on the issue of fraud.

In view of our finding of fraud, we need not reach the remaining claims of likelihood of confusion, dilution, parody, and lack of a bona fide use of the mark in commerce raised in the parties' respective motions for summary judgment.