

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

Lykos

Mailed: April 21, 2008

Opposition No. 91176744

DC Comics and Marvel  
Characters, Inc.

v.

Silver, Michael Craig

Before Holtzman, Cataldo and Ritchie de Larena,  
Administrative Trademark Judges.

By the Board:

On February 24, 2006, applicant applied to register the mark SUPER HERO for "after sun creams; beauty creams for body care; cosmetic products in the form of aerosols for skincare; non-medicated sun care preparations; skin moisturizer; skin toners; sun block; sun care lotions; sun screen; sun tan oil; and sun-block lotions" in International Class 3.<sup>1</sup> Opposers have opposed registration on the grounds that applicant's applied-for mark (1) so resembles opposers' previously used and registered marks that it is likely to cause confusion, mistake, or deceive prospective consumers under Section 2(d) of the Lanham Act; and (2) will dilute the distinctive quality of opposers' marks under Section

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<sup>1</sup> Application Serial No. 78823155, alleging a bona fide intent to use the mark in commerce.

43(c) of the Lanham Act as amended. In their notice of opposition, opposers pleaded ownership of several registered marks, including the following:

SUPER HERO for "masquerade costumes" in International Class 35;<sup>2</sup>

SUPER HEROES for "toy figures" in International Class 28;<sup>3</sup>

SUPER HEROES for "publications, particularly comic books and magazines and stories in illustrated form; notebooks and stamp albums" in International Class 16;<sup>4</sup>

In addition, opposers also pleaded ownership of several pending applications, including an intent-to use application for the mark MY FIRST SUPER HERO for "cosmetics, namely lipstick, lip gloss and non-medicated lip balm; mascara; nail enamel; face powder, face cream, skin lotion and skin gel; body powder; bath oil, bath gel and non-medicated bath salts; hand cream and lotion; body cream and lotion; sunscreen preparation, namely cream and lotion; shaving cream and after-shave lotion, skin cleanser and non-medicated body soaks; body deodorant, cologne and perfume;

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<sup>2</sup> Registration No. 825835, issued March 14, 1967, alleging October 29, 1965 as the date of first use anywhere and in commerce, Sections 8 and 9 affidavits accepted and granted.

<sup>3</sup> Registration No. 1140452, issued October 14, 1980, alleging July 2, 1973 as the date of first use anywhere and in commerce, Sections 8 and 9 affidavits accepted and granted.

<sup>4</sup> Registration No. 1179067, issued November 24, 1981, alleging October 1966 as the date of first use anywhere and in commerce, Sections 8 and 9 affidavits accepted and granted.

soaps, namely, liquid bath soap, gel soap and bar soap; detergent soap, namely, liquid and powder; fabric softener; deodorant soap, skin soap; and shampoo and shampoo conditioner" in International Class 3.<sup>5</sup> Opposers further noted that the Examining Attorney has cited applicant's application against opposers' MY FIRST SUPER HERO application as a potential bar to registration under Section 2(d).

In his answer, applicant denied the salient allegations contained in the notice opposition.

This case now comes up for consideration of opposers' motion for partial summary judgment on their Section 2(d) claim. The parties have fully briefed the motion.<sup>6</sup>

The Board has carefully reviewed the parties' respective arguments and accompanying exhibits, although the Board has not repeated the parties' arguments in this order.

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

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<sup>5</sup> Application Serial No. 78946654, filed August 7, 2006.

<sup>6</sup> Applicant's responsive brief does not indicate proof of service of a copy of same on counsel for opposers as required by Trademark Rule 2.119. Opposers have not objected to consideration of applicant's brief. Nonetheless, applicant is reminded of his obligation to properly serve all communications on counsel for opposer in this proceeding. See the information appended to the end of this order.

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, 106 S.Ct. 2548 (1986). The evidence must be viewed in a light favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992).

After reviewing the submissions and arguments of the parties, we find that opposers have failed to sustain their burden on summary judgment. At a minimum, opposers have not established the absence of a genuine issue of material fact regarding the issue of priority. Opposers, in support of their motion for summary judgment, rely on their pleaded registrations to establish priority. However, opposers failed to submit certified copies of the registrations showing that the registrations are subsisting and owned by opposers.<sup>7</sup> See, e.g., *King Candy v. Eunice King's Kitchen*,

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<sup>7</sup> On December 19, 2007, the Board denied opposers' request to make status and title copies of their pleaded registrations of record after briefing of the summary judgment motion was completed.

*Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

Instead, opposers submitted photocopies of their registrations with print-outs from the Trademark Electronic Search System (TESS). Such evidence is insufficient to establish both the current status of and title to the registrations. See TBMP § 704.03(b)(1)(A) (2d ed. rev. 2004).<sup>8</sup>

In addition, opposers have failed to establish the absence of a genuine issue of material fact regarding their common law usage of their SUPER HERO and SUPER HEROES marks in connection with the goods identified in their pleaded registrations prior to applicant's constructive use date (that is, the filing date of applicant's application). Opposers have merely stated that they have "exploited" their SUPER HERO and SUPER HEROES marks in connection with comic books, toys and masquerade costumes at least as early as 1966. Declaration of Carol G. Pinkus, Director, Intellectual Property, Marvel Entertainment, Inc., para. 7; Declaration of Marilyn Drucker, Executive Director, Brand Management for DC Comics, para. 7. This statement of first use without any detail about the nature of the use or extent of the use is insufficient to establish that opposers are

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<sup>8</sup> The recent amendment to Trademark Rule 2.122(d)(1) which provides parties with the option of proving proof of status and title of pleaded registrations with copies of records retrieved from the USPTO electronic databases applies only to cases commenced on or after August 31, 2007.

entitled to judgment as a matter of law on the issue of priority. See *West Florida Seafood Inc. v. Jet Restaurants, Inc.*, 31 F.3d 1122, 31 USPQ2d 1660 (Fed. Cir. 1994),

As to the issue of the relatedness of the parties' goods, opposers rely on the doctrine of collateral product trademark licensing. Under that doctrine, the licensing of trademarks on collateral products may result in consumer confusion. See, e.g., *DC Comics v. Pan American Grain Mfg. Co.*, 77 USPQ2d 1220 (TTAB 2005) (applicant's and opposer's goods held related where opposer used KRYPTONITE as a merchandising mark with respect to a variety of goods and the evidence of record demonstrated consumer recognition of the mark used in the marketplace in this manner). After reviewing the evidence of record, the Board finds however a genuine issue of material fact as to whether the parties' respective goods are sufficiently related such that consumers, in this particular licensing environment, will believe that applicant's goods emanate from or are associated with opposers'.

In view thereof, opposers' motion for partial summary

judgment is denied.<sup>9</sup>

Proceedings herein are resumed and trial dates are reset as follows:

THE PERIOD FOR DISCOVERY TO CLOSE:	5/5/08
30-day testimony period for party in position of plaintiff to close:	8/3/08
30-day testimony period for party in position of defendant to close:	10/2/08
15-day rebuttal testimony period for party in position of plaintiff to close:	11/16/08

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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<sup>9</sup> The parties should not construe the Board's ruling as a finding that the facts in dispute identified herein are the only issues for trial.

The parties should also note that all evidence submitted in support of and in opposition to the motion for summary judgment is of record only for consideration of said motion. Any such evidence to be considered in final hearing must be properly introduced in evidence during the appropriate trial periods. See *Levi Strauss & Co. v. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); and *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983).

### Pro Se Information

It is noted that applicant is not represented by legal counsel in this proceeding. While Patent and Trademark Rule 10.14 permits any person to represent itself,<sup>10</sup> it is generally advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in an opposition or opposition proceeding to secure the services of an attorney who is familiar with such matters. The Patent and Trademark Office cannot aid in the selection of an attorney.

The Trademark Rules of Practice, other federal regulations governing practice before the Patent and Trademark Office, and many of the Federal Rules of Civil Procedure govern the conduct of this opposition proceeding. The Trademark Rules are codified in part two of Title 37 of the Code of Federal Regulations (also referred to as the CFR). There are other rules in part one of Title 37, relevant to filing of papers, meeting due dates, etc., that are also applicable to this case. The CFR and the Federal Rules of Civil Procedure, are likely to be found at most law

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<sup>10</sup> Any individual may appear in a trademark case for (1) a firm of which he or she is a member or (2) a corporation or association of which he or she is an officer and which he or she is authorized to represent, if such firm, corporation, or association is a party to a trademark proceeding pending before the Office. Further, individuals who are not attorneys are not recognized to practice before the Office in trademark matters. Trademark Rules 10.14(b) & (e), 37 C.F.R. §§ 10.14(b) and (e).

libraries, and may be available at some public libraries. If opposer or applicant wishes to obtain a copy of Title 37 of the CFR, it may be ordered for a fee from the Government Printing Office, Washington, D.C. 20401, or from the U.S. Government Bookstore, using the following web address:

**<http://bookstore.gpo.gov/actions/GeneralSearch.do>**.

Applicant may also refer to the Trademark Trial and Appeal Board Manual of Procedure (TBMP) and the Trademark Rules of Practice, both available on the USPTO website, *www.uspto.gov*.

Applicant is reminded that Trademark Rules 2.119(a) and (b) require that every paper filed in the Patent and Trademark Office in a proceeding before the Board must be served upon the attorney for the other party (or adversary), or on the party (or adversary) if there is no attorney, and proof of such service must be made *before the paper will be considered by the Board*. Consequently, copies of all papers that the parties may subsequently file in this proceeding must be accompanied by "proof of service" of a copy on the other party or the other party's counsel.

"Proof of service" usually consists of a signed, dated statement attesting to the following matters: (1) the nature of the paper being served, (2) the method of service (e.g., first class mail), (3) the person being served and

the address used to effect service, and (4) the date of service.

While it is true that the law favors judgments on the merits wherever possible, it is also true that the Patent and Trademark Office is justified in enforcing its procedural deadlines. *Hewlett-Packard v. Olympus*, 18 USPQ2d 1710 (Fed. Cir. 1991). In that regard, the parties should note that any paper they are required to file herein must be received by the Patent and Trademark Office by the due date, unless one of the filing procedures set forth in Patent and Trademark Rules 1.8 and 1.10 is utilized.<sup>11</sup> These rules are in part one of Title 37 of the previously-discussed Code of

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<sup>11</sup> Use of electronic filing with ESTTA (Electronic System for Trademark Trials and Appeals (ESTTA)), available through the USPTO website, is strongly encouraged.

Correspondence required to be filed in the Office within a set period of time will be considered as being timely filed on the date of deposit in the mail if accompanied by a certificate of mailing. The actual date of receipt by the Office will be used for all other purposes, including electronically filed documents.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first-class mail in an envelope addressed to:

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

on \_\_\_\_\_ (Date)

\_\_\_\_\_ (Signature)

\_\_\_\_\_ (Typed or printed name)

Federal Regulations.

**NEWS FROM THE TTAB:**

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>

[http://www.uspto.gov/web/offices/com/sol/notices/72fr42242\\_FinalRuleChart.pdf](http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf)

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>