

ESTTA Tracking number: **ESTTA260714**

Filing date: **01/15/2009**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91176744
Party	Plaintiff DC Comics and Marvel Characters, Inc.
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Date	01/15/2009
Attachments	SUPER HERO_SECOND Amended NOO.pdf (19 pages)(284820 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

DC COMICS and
MARVEL CHARACTERS, INC.,

Opposers,

v.

MICHAEL CRAIG SILVER,

Applicant.

Opposition No. 91/176,744
Application No. 78/823,155
Mark: SUPER HERO

OPPOSER'S SECOND AMENDED NOTICE OF OPPOSITION

DC Comics, a New York general partnership, having a place of business at 1700 Broadway, New York, New York 10019, and Marvel Characters, Inc. ("Marvel"), a Delaware corporation, having a place of business at 9242 Beverly Boulevard, Suite 350, Beverly Hills, California 90210 (sometimes collectively, "Opposer"), believe that they will be damaged by registration of the above-identified mark, and hereby oppose the registration of said mark. The grounds of opposition are as follows:

1. By the application herein opposed, Applicant Michael Craig Silver is seeking to obtain, under the provisions of the Trademark Act of 1946 (15 U.S.C. § 1051 *et seq.*), registration for 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; sun block lotions" in International Class 3. Applicant filed its application on February 24, 2006.

2. Applicant filed its application under 15 U.S.C. § 1051(b), and, on information and belief, has not yet commenced commercial use of the subject mark.

3. Opposer is engaged in the businesses of, *inter alia*, publishing, merchandise licensing, media, and entertainment. DC Comics is the owner and publisher of “DC Comics” and related intellectual property, which feature such world-famous characters and properties as “SUPERMAN[®]” and “BATMAN[®].” Marvel (including its related companies) is the owner and publisher of “Marvel Comics” and related intellectual property, which feature such world-famous characters and properties as “SPIDER-MAN[®]” and “THE HULK[®].”

4. Opposers are the joint owners of the trademarks and service marks “SUPER HERO,[®]” “SUPER HEROES,[®]” and variations thereof. Beginning at least as early as 1958, *i.e.*, well prior to Applicant’s filing date, Opposer (including its predecessors-in-interest) has used “SUPER HERO,[®]” “SUPER HEROES,[®]” and variations thereof as trademarks and services marks for a wide variety of products and services, including, without limitation, comic books, clothing, foods, toys, motion picture films, and television programming.

5. Opposer is the owner of numerous registrations on the Principal Register of the United States Patent and Trademark Office for its “SUPER HERO[®]” and “SUPER HEROES[®]” marks, including the following:

Mark	Reg. No.	Date of Reg.	Goods
SUPER HERO	825,835	3/14/67	Masquerade costumes
SUPER HEROES	1,140,452	10/14/80	Toy figures

SUPER HEROES	1,179,067	11/24/81	Publications, particularly comic books and magazines and stories in illustrated form, notebooks and stamp albums
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True and correct copies of these registrations are attached hereto Exhibit "A." All of these registrations issued prior to Applicant's application date and consequently there is no question of priority of rights, such priority clearly belonging to Opposer. Moreover, all of these registrations are incontestable under 15 U.S.C. § 1065.

6. Through Opposer's exploitation activities, and through the extensive promotional and advertising activities of Opposer and its licensees connected therewith, the public and trade have come to associate the trademarks and service marks "SUPER HERO," "SUPER HEROES," and variations thereof with Opposer and with its products and services.

7. By virtue of its prior use in commerce of "SUPER HERO," "SUPER HEROES," and variations thereof, Opposer is entitled to hold itself out to the public and trade as having the exclusive right to use "SUPER HERO," "SUPER HEROES," and variations thereof as trademarks and service marks. Registration of Applicant's mark would be inconsistent with that right of Opposer.

8. Substantial efforts have been devoted by Opposer and its licensees to advertise and promote its goods and services under Opposer's "SUPER HERO" and "SUPER HEROES" trademarks and service marks. Opposer, by its aforesaid use of "SUPER HERO", "SUPER HEROES" and variations thereof, and by its promotional efforts in connection therewith, has built up valuable goodwill associated with these marks. As a result of the long

use, advertising and promotion by Opposer, said marks have acquired secondary meaning in the minds of both the trade and public in connection with Opposer and with its products and services.

9. Moreover, Opposer's "SUPER HERO[®]" and "SUPER HEROES[®]" trademarks constitute famous marks under 15 U.S.C. § 1125(c)(1). Opposer's "SUPER HERO[®]" and "SUPER HEROES[®]" trademarks acquired such fame well prior to Applicant's application filing date.

10. Additionally, Opposer has exploited various of its trademarks in connection with cosmetic and toiletry products in International Class 3. Hence, such product category represents a "natural zone of expansion" for Opposer's "SUPER HERO[®]" and "SUPER HEROES[®]" trademarks. Opposer's marks in Class 3 include the following:

Mark	Reg./(Appl.) No.	Reg./(Filing) Date	Goods
MY FIRST SUPER HERO	(78/946,654)	(8/7/06)	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; 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
KRYPTONITE	2,936,470	3/29/05	Cosmetics, namely lipstick, lip gloss and non-medicated lip balm; mascara; nail enamel; face powder, face cream, skin lotion and skin gel; bath powder and perfumed body powder; bath oil, bath gel and non-medicated bath salts; baby oil, baby powder, baby gel and baby lotion; hand cream and lotion; body cream and lotion; sunscreen preparation, namely cream and lotion;

Mark	Reg./ (Appl.) No.	Reg./ (Filing) Date	Goods
			shaving cream and after-shave lotion, skin cleanser and non-medicated body soaks; body deodorant, cologne and perfume; soaps namely liquid bath soap, gel soap and bar soap; detergent soap, namely, liquid and powder; fabric softener; deodorant soap, skin soap; shampoo and shampoo conditioner; and hairstyling gel
X-MEN	(77/046,945)	(11/17/06)	Cologne, eau-de-toilette; fragrances for personal use; perfume
STORM	(78/061,369)	(5/1/01)	Cosmetics, namely lipstick, eye shadow, lip gloss, rouge, eye makeup, nail polish, artificial fingernails; body lotion, hand lotion, after-shave lotion, face cream, cold cream, body cream, shaving cream, skin soap, hand soap, deodorant soap, liquid soap for hands, face and body, bubble bath, perfume, cologne; hair care products, namely, shampoo, hair gel, hair spray, hair conditioner, hair dye

A true and correct copy of Registration No. 2,936,470 is attached hereto as Exhibit "B."

11. In addition to the foregoing, DC Comics exploits its "BATMAN" trademark in connection with toothpaste, toothbrushes, bubble bath, body wash, shower gel, soap, "bath fizzies," bath holders, soap molders, play razors, play shaving brushes, play after-shave cologne, and soap crayons. DC Comics further exploits its "SUPERMAN" trademark in connection with bubble bath, soap, toothbrushes, bath paint, bath crayons and bath sponges.

12. Representative samples of products marketed by Opposer in International Class 3 are attached hereto as Exhibit "C."

13. Moreover, the Examining Attorney has cited Applicant's Application No. 78/823,155 against DC Comics' application for "MY FIRST SUPER HERO," and has suspended the "MY FIRST SUPER HERO" application on this basis. Hence, Applicant's mark is posing a

direct obstacle to Opposer's protection and exploitation of its legitimate prior rights in its "SUPER HERO®" and "SUPER HEROES®" trademarks.

14. If Applicant is granted a registration for the mark herein opposed, it would obtain thereby at least the *prima facie* exclusive right to use such mark. Such registration would be a source of damage and injury to Opposer.

15. Applicant's mark for which it seeks registration is identical and/or confusingly similar to Opposer's "SUPER HERO®" and "SUPER HEROES®" trademarks and service marks. Applicant's proposed use and registration of its mark is likely to cause injury to Opposer's rights in its "SUPER HERO®" and "SUPER HEROES®" marks, and such use and registration will inevitably cause confusion and mistake and will deceive the public into believing that the goods of Applicant are affiliated with, sponsored by, or jointly developed with Opposer or Opposer's licensees, and that such goods emanate from the same source, and/or that Applicant is in some other fashion connected with Opposer, all to Opposer's injury.

16. If Applicant is permitted to register its mark so as to claim exclusive rights therein, confusion among the public and trade will result, causing damage and injury to Opposer. Members of the trade and public familiar with Opposer's "SUPER HERO®" and "SUPER HEROES®" trademarks and service marks would be likely to believe (and would be justified in so believing) that Applicant's goods originated from Opposer, or an entity in some way associated with Opposer, or are licensed or authorized by Opposer or with Opposer's approval. Furthermore, any objection or fault found with Applicant's goods would necessarily reflect upon and seriously injure the reputation which Opposer has established in connection with the goods and services sold by Opposer and its licensees under its "SUPER HERO®" and "SUPER HEROES®" marks.

17. Moreover, Applicant's "SUPER HERO" mark, if used under the application herein opposed, would dilute the distinctive quality of Opposer's famous "SUPER HERO[®]" and "SUPER HEROES[®]" trademarks, thereby causing further damage to Opposer.

18. Additionally, as noted supra, Applicant's "SUPER HERO" application is blocking the registration of DC Comics' "MY FIRST SUPER HERO" application in International Class 3, notwithstanding Opposer's priority of rights in "SUPER HERO[®]" and "SUPER HEROES[®]". Such obstacle represents a further source of damage and injury to Opposer.

19. Consequently, Applicant's alleged mark does not and cannot exclusively identify the goods in connection with which it is proposed to be used as the goods of Applicant, nor can it distinguish those goods from the goods or services of Opposer, nor can it serve as an indication of source or origin of such goods.

20. By reason of the foregoing, Applicant's registration of the mark herein opposed will cause damage and injury to Opposer, and to Opposer's rights in its "SUPER HERO[®]" and "SUPER HEROES[®]" marks, and to the use thereof as described herein.

21. For the above reasons, Applicant's mark should be denied registration under 15 U.S.C. § 1052(d).

22. In addition, Applicant's registration should be denied because, based on information and belief, Applicant lacked a bona fide intent to use the SUPER HERO mark in commerce at the time that he filed the application, as established by the fact that he has no documents or information evidencing his alleged intent at the time of the filing, or to date.

WHEREFORE, Opposer prays that Application Serial No. 78/823,155 be rejected, and that the registration of the mark therein sought for the goods therein specified be denied and refused, and that this Opposition be sustained.

KENYON & KENYON LLP

Dated: January 15, 2009

By: 
Jonathan D. Reichman
Michelle Mancino Marsh
Michelle C. Morris
One Broadway
New York, New York 10004
(212) 425-7200
Attorneys for Opposer

PROOF OF SERVICE

I hereby certify that a true and complete copy of OPPOSER'S SECOND AMENDED NOTICE OF OPPOSITION, has been served by mailing said copy on January 15, 2009, via first class mail, to:

Michael Craig Silver
64 Lincoln Drive
Sausalito, CA 94965

A handwritten signature in black ink, reading "Michelle C. Morris". The signature is written in a cursive style with a horizontal line underneath the name.

Michelle C. Morris

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Int. Cl.: 25

Prior U.S. Cl.: 39

United States Patent and Trademark Office

Renewal

Reg. No. 825,538

Registered Mar. 14, 1967

OG Date Oct. 4, 1988

**TRADEMARK
PRINCIPAL REGISTER**

SUPER HERO

MARVEL ENTERTAINMENT GROUP,
INC. (DELAWARE CORPORATION)
387 PARK AVENUE SOUTH
NEW YORK, NY 10016 AND

DC COMICS, INC. (NEW YORK CORPORA-
TION)
666 FIFTH AVENUE
NEW YORK, NY 10103, ASSIGNEE BY
MESNE ASSIGNMENT BEN COOPER,
INC. (NEW YORK CORPORATION)
BROOKLYN, NY

FOR: MASQUERADE COSTUMES, IN
CLASS 39 (INT. CL. 25).

FIRST USE 10-29-1965; IN COMMERCE
3-4-1966.

SER. NO. 243,225, FILED 4-12-1966.

*In testimony whereof I have hereunto set my hand
and caused the seal of The Patent and Trademark
Office to be affixed on Oct. 4, 1988.*

COMMISSIONER OF PATENTS AND TRADEMARKS

Int. Cl.: 28

Prior U.S. Cl.: 22

Reg. No. 1,140,452

Registered Oct. 14, 1980

United States Patent and Trademark Office

TRADEMARK
Principal Register

SUPER HEROES

Cadence Industries Corporation (Delaware corporation)
575 Madison Ave.
New York, N.Y. 10022
and
DC Comics Inc. (New York corporation)
75 Rockefeller Plz.
New York, N.Y. 10019, assignees of
Ben Cooper, Inc. (New York corporation)
Brooklyn, N.Y.

For: TOY FIGURES, in CLASS 28 (U.S. Cl. 22).
First use Jul. 2, 1973; in commerce Jul. 2, 1973.
Owner of U.S. Reg. No. 1,080,655.

Ser. No. 11,796, filed Jan. 24, 1974.

M. MERCHANT, Primary Examiner

Int. Cl.: 16

Prior U.S. Cls.: 5, 22, 37 and 38

United States Patent and Trademark Office

Reg. No. 1,179,067
Registered Nov. 24, 1981

TRADEMARK
Principal Register

SUPER HEROES

Cadence Industries Corporation (Del. corporation),
a.k.a. Marvel Comics Group and DC Comics Inc.
575 Madison Ave.
New York, N.Y. 10022

For: PUBLICATIONS, PARTICULARLY
COMIC BOOKS AND MAGAZINES AND
STORIES IN ILLUSTRATED FORM; CARD-
BOARD STAND-UP FIGURES; PLAYING
CARDS; PAPER IRON-ON TRANSFERS; ERAS-
ERS; PENCIL SHARPENERS; PENCILS; GLUE
FOR OFFICE AND HOME USE, SUCH AS IS
SOLD AS STATIONERY SUPPLY; NOTEBOOKS
AND STAMP ALBUMS, in CLASS 16 (U.S. Cls. 5,
22, 37 and 38).

First use Oct. 1966; in commerce Oct. 1966.

Ser. No. 222,079, filed Jul. 3, 1979.

HENRY S. ZAK, Primary Examiner

Exhibit B

Int. Cl.: 3

Prior U.S. Cls.: 1, 4, 6, 50, 51 and 52

Reg. No. 2,936,470

United States Patent and Trademark Office

Registered Mar. 29, 2005

**TRADEMARK
PRINCIPAL REGISTER**

KRYPTONITE

DC COMICS (PARTNERSHIP)
1700 BROADWAY
NEW YORK, NY 10019

FOR: COSMETICS, NAMELY LIPSTICK, LIP GLOSS AND NON-MEDICATED LIP BALM; MASCARA; NAIL ENAMEL; FACE POWDER, FACE CREAM, SKIN LOTION AND SKIN GEL; BATH POWDER AND PERFUMED BODY POWDER; BATH OIL, BATH GEL AND NON-MEDICATED BATH SALTS; BABY OIL, BABY POWDER, BABY GEL AND BABY LOTION; 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; SOAPS, NAMELY,

LIQUID BATH SOAP, GEL SOAP AND BAR SOAP; DETERGENT SOAP, NAMELY, LIQUID AND POWDER; FABRIC SOFTENER; DEODORANT SOAP, SKIN SOAP; SHAMPOO AND SHAMPOO CONDITIONER; AND HAIRSTYLING GEL, IN CLASS 3 (U.S. CLS. 1, 4, 6, 50, 51 AND 52).

FIRST USE 11-23-2001; IN COMMERCE 11-23-2001.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SER. NO. 78-465,204, FILED 8-10-2004.

CHERYL STEPLIGHT, EXAMINING ATTORNEY

Exhibit C



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