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

Baxley

Mailed: August 21, 2009

Opposition No. **91176744**

DC Comics and Marvel
Characters, Inc.

v.

Michael Craig Silver

Before Grendel, Holtzman, and Mermelstein,
Administrative Trademark Judges.

By the Board:

Michael Craig Silver ("applicant") seeks to register the mark SUPER HERO in standard character form 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 3.¹

DC Comics ("DC") and Marvel Characters, Inc. ("Marvel") (together "opposers") oppose registration of applicant's mark. In a second amended notice of opposition, opposers set forth the following grounds of opposition: 1) likelihood of confusion with their previously registered

¹ Application Serial No. 78823155, filed February 24, 2006, based on an assertion of a bona fide intent to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. Section 1051(b).

SUPER HERO and SUPER HEROES marks under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d); 2) dilution of their allegedly famous SUPER HERO and SUPER HEROES marks under Trademark Act Section 43(c), 15 U.S.C. Section 1125(c); and 3) lack of a bona fide intent to use the involved mark in commerce under Trademark Act Section 1(b), 15 U.S.C. Section 1051(b), when applicant filed the involved intent to use application. Applicant, in his answer, denied the salient allegations of the second amended petition to cancel.

This case now comes up for consideration of opposers' motion (filed May 29, 2009) for summary judgment on their pleaded claim that applicant lacked a bona fide intent to use his involved mark in commerce when he filed the involved intent-to-use application. The motion has been fully briefed.²

In support of their motion for summary judgment, opposers have submitted copies of applicant's written discovery responses and a copy of opposers' discovery deposition of applicant. Opposers maintain that applicant has failed to produce any documents or corroborating

² Opposers' motion is the second motion for summary judgment that they have filed in this proceeding. On October 25, 2007, opposers filed a motion for summary judgment on their pleaded claim under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). The Board denied opposers' first motion for summary judgment in an April 21, 2008 order.

evidence in support of his claimed intent to use the mark and that applicant has done "*absolutely nothing*" toward bringing the identified goods to market. Opposers' brief at 13 (emphasis in original). Accordingly, opposers contend that there is no genuine issue of material fact that applicant had no bona fide intent to use the SUPER HERO mark on the identified goods when he filed his application and that entry of summary judgment is warranted under the circumstances.

Applicant has responded with notes from his personal records. Applicant maintains that he is a professional entrepreneur who owns "several business entities with complementing licenses for each one;" that his educational background, including completion of all college pre-medical course requirements and various graduate business courses, "establishes [his] ability and willingness ... to execute and follow through with an intent to use application for a business endeavor." Applicant's brief at 3-4. Applicant further contends that, because he is licensed by the American Petroleum Institute to sell "automobile, heavy duty, and industrial lubricant products" under his TEXASTEAM mark, he has established that he "can achieve licenses from a governing body of an industry, such as the FDA, without having had direct prior business experience in an industry, such as the sunscreen industry." Applicant's brief at 6-7.

Applicant further contends that his bona fide intent to use the SUPER HERO mark in commerce is evidenced by the "Maiden Waves formula" description previously submitted [as an exhibit to his brief in opposition to opposers' motion for leave to file their first amended notice of opposition] and the newly submitted checklist and notes concerning the [SUPER HERO] mark and that his involved mark "can be recognized as a viable brand name product that could be sold" through his Waveworks/Maiden Waves apparel company. Applicant's brief at 8. Applicant further contends that his bona fide intent to use the SUPER HERO mark in connection with the identified goods is further established by his "creation of a Maiden Waves sunscreen formula that can be used to help create a formula for the [SUPER HERO] product." Applicant's brief at 9. Accordingly, applicant asks that the Board deny opposers' motion for summary judgment and instead enter summary judgment in his favor.

In reply, opposers contend that arguments in applicant's brief are not supported by documentary evidence and contradict his earlier discovery responses; that the documents that applicant includes as exhibits with his brief in opposition to opposers' motion were not previously produced in discovery; and that these documents and the Maiden Waves formula description that applicant previously submitted as an exhibit to his brief in opposition to

opposers' motion for leave to file their first amended notice of opposition fail to establish a bona fide intent to use the involved mark on the identified goods.

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). The party moving for summary judgment has the initial burden of demonstrating that there is no genuine issue of material fact remaining for trial and that it is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56(c); *Celotex Corp. v. Catrett*, 477 U.S. 317 (1987).

In a motion for summary judgment, the moving party, in this case opposer, has the burden of establishing the absence of any genuine issues of material fact for trial and that it is entitled to judgment as a matter of law. In considering the propriety of summary judgment, all evidence must be viewed in a light favorable to the nonmovant, in this case applicant, and all justifiable inferences are to be drawn in the nonmovant's favor. The Board may not resolve issues of material fact; it may only ascertain whether such issues are present. 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); *Olde Tyme*

Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

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. v. Houston Computer Services Inc.*, 918 F.2d 937, 941, 16 USPQ2d 1783, 1786 (Fed. Cir. 1990).

At the outset, we note that applicant has not contended that opposers do not have standing to maintain this proceeding. In any event, we find that there is no genuine issue of material fact that each of the opposers has standing to maintain this proceeding. See *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2

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USPQ2d 2021 (Fed. Cir. 1987); *Stuart Spencer Designs Ltd. v. Fender Musical Instruments Corp.*, ___ USPQ2d ___ (TTAB, Opposition No. 91161403, March 25, 2009); TBMP Section 303.06 (2d ed. rev. 2004).

Regarding DC's standing, opposers submitted a declaration of DC's executive director for brand management, Marilyn Drucker, who avers that, "beginning in 1966, [opposers and their predecessors-in-interest] have exploited their SUPER HERO and SUPER HEROES trademarks in connection with comic books, toys, and masquerade costumes;" that "a substantial part of [DC's] business originates from licensing its marks ... for use in connection with a variety of goods and services, including ... cosmetics, personal care and health products such as bubble baths, toothbrushes, foam soaps, facial tissues and bandages;" "that [DC's] merchandise licensing agreements bundle groups of comic book characters and generally include licenses to use the SUPER HERO and SUPER HEROES marks."³ Drucker declaration at paragraphs 5 and 7-8.

³ In the second amended notice of opposition, opposers allege that DC filed application Serial No. 78946654 for the mark MY FIRST SUPER HERO for goods in International Class 3 including "sunscreen preparation" and that the examining attorney cited applicant's involved application against DC's application. However, opposers did not submit any evidence on this point. A copy of the Office Action in which the examining attorney cited applicant's involved application would have, by itself, been sufficient to establish DC's standing to maintain this proceeding. See *Hartwell Co. v. Shane*, 17 USPQ2d 1569 (TTAB 1990).

Regarding Marvel's standing, opposers have submitted a declaration of Carol G. Pinkus, the director of intellectual property for Marvel Entertainment, Inc., Marvel's parent company and status and title copies of Marvel's Registration Nos. 825835⁴ and 3022405⁵ for the mark SUPER HERO and Registration Nos. 1140452⁶ and 1179067⁷ for the mark SUPER HEROES. The Pinkus declaration is highly similar to the Drucker declaration, except that Ms. Pinkus avers that "a substantial part of [Marvel's] business originates from licensing its marks ... for use in connection with a variety of goods and services, including ... cosmetics and toiletries." Pinkus declaration at paragraph 5. In view of evidence opposers' activities in connection with the SUPER HERO and SUPER HEROES marks, we find that DC and Marvel have each established that they have a real interest in the outcome of this proceeding; that is, each opposer has a direct and personal stake in the outcome of this opposition. See *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed.

⁴ Issued March 14, 1967 for "masquerade costumes" in International Class 25; renewed twice.

⁵ Issued December 6, 2005 for "ice cream" in International Class 30.

⁶ Issued October 14, 1980 for "toy figures" in International Class 28; renewed.

⁷ Issued November 24, 1981 for publications, particularly comic books and magazines and stories in illustrated form; notebooks and stamp albums" in International Class 16; renewed.

Cir. 1999); *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, *supra*.

We turn next to whether opposers have established that there is no genuine issue of material fact for trial on their claim that applicant lacked a bona fide intent to use the mark in commerce when he filed his involved application. Trademark Act Section 1(b), 15 U.S.C. Section 1051(b), states that "a person who has a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce" may apply for registration of the mark. An applicant's bona fide intent to use a mark must reflect an intention that is firm, though it may be contingent on the outcome of an event (that is, market research or product testing) and must reflect an intention to use the mark "'in the ordinary course of trade, ... and not ... merely to reserve a right in a mark.'" *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993) (quoting Trademark Act Section 45, 15 U.S.C. Section 1127, and citing Senate Judiciary Comm. Rep. on S. 1883, S. Rep. No. 515, 100th Cong., 2d Sess. 24-25 (1988)).

As a general rule, the factual question of intent is particularly unsuited to disposition on summary judgment. See *Copelands' Enterprises, Inc. v. CNV, Inc.*, 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991). Nonetheless, the absence of any documentary evidence on the part of an

applicant regarding its bona fide intent to use a mark in commerce constitutes objective proof sufficient to prove that applicant lacks a bona fide intention to use its mark in commerce. See *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d at 1507. Indeed, the Board has held, that where there is no evidence of an applicant's bona fide intent to use the mark at issue on the claimed goods or services, entry of summary judgment on a claim that the applicant had no bona fide intent to use the mark in commerce when he filed his involved application may be warranted. See *Honda Motor Co. v. Winkelmann*, 90 USPQ2d 1660 (TTAB 2009).

In determining the sufficiency of documentary evidence demonstrating bona fide intent, the Board has held that the Trademark Act does not expressly impose "any specific requirement as to the contemporaneousness of an applicant's documentary evidence corroborating its claim of bona fide intention. Rather, the focus is on the entirety of the circumstances, as revealed by the evidence of record." See *Lane Ltd. v. Jackson International Trading Co.*, 33 USPQ2d 1351, 1355 (TTAB 1994).

In this case, opposers have proffered applicant's statements made during discovery, which opposers assert demonstrate that applicant has no current business plans, ongoing discussions, promotional activities, or anything

else to corroborate his claim of a bona fide intent to use the mark in commerce in the United States. Specifically, opposers point to applicant's supplemental responses to opposers' interrogatories, in which applicant conceded that he has not taken any steps toward manufacturing, distributing, selling, or promoting any products or services under the SUPER HERO trademark and that he does not know the retail or wholesale prices that he plans to charge for the identified goods. Applicant's supplemental responses to interrogatory nos. 12 and 27. In addition, opposers have proffered applicant's statements that he has conducted no market studies or surveys concerning his involved mark. See applicant's supplemental response to interrogatory no. 19; Silver deposition at 105.

Further, opposers have proffered applicant's statements from his February 23, 2009, discovery deposition. In that deposition, applicant states, among other things that, when he filed the application, he had not formed a business that was geared toward manufacturing, marketing and selling the identified goods; that applicant has no experience in manufacturing or marketing any of the identified goods; that applicant was not aware of any Food and Drug Administration regulations regarding skin care and sunscreen products; that applicant has no specific educational training to equip him with the ability to develop the identified goods; and that

that has engaged neither a chemical engineer nor a marketing firm since filing his application on February 24, 2006. See Silver deposition at 40, 43, 54-57, 63-64, 85, 105, 112-13, 118, and 136-40.

As for document requests, opposers note requests nos. 16 (representative samples of advertisements and promotional materials in which the mark has appeared), 17 (copies of advertising scripts), 18 (documents sufficient to show actual or planned promotional expenditures under the mark), 19 (documents concerning trade channels), 20 (documents concerning trade shows, conventions, seminars and other events open to the public at which goods sold or offered for sale under the SUPER HERO mark were or are planned to be displayed), 21 (documents concerning investigations, market studies and surveys concerning any matter related to this proceeding), 22 (documents concerning "any investigation of the marketplace with respect to applicant's involved mark or opposers' pleaded marks) and 23 (documents concerning surveys, studies and opinion polls with respect to applicant's involved mark or opposers' pleaded marks), to which applicant produced no responsive documents. In addition, opposers proffer applicant's response to document request no. 12, in which applicant states that he "has no documents concerning any effort to exploit or commercialize any product under SUPER HERO."

Taken together, the evidence that opposers submitted in support of their motion for summary judgment is sufficient to indicate that applicant had taken no actual steps toward preparing to use the SUPER HERO mark on the identified goods and that applicant merely had a subjective intent to use the SUPER HERO mark on the identified goods when he filed his involved application. Based on the foregoing, we find that opposers have met their initial burden of establishing that there is no genuine issue of material fact remaining for trial on their claim that applicant did not have a bona fide intent to use the SUPER HERO mark in commerce when he filed his involved application.

Federal Rule of Civil Procedure 56 requires a nonmoving party to go beyond the pleadings and to "set out specific facts showing a genuine issue for trial." Fed. R. Civ. P. 56(e)(2); *Celotex Corp. v. Catrett*, *supra* at 324. To raise a genuine issue of material fact, applicant must rely on specific facts that establish that he possessed an ability and willingness to use the SUPER HERO mark as a mark for his identified goods when he filed the application.

Applicant's arguments in his brief do not provide specific facts in support of his position. See, e.g., *Hornblower & Weeks Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733, 1736 (TTAB 2001). Further, applicant's evidence consists of four documents: 1) applicant's undated

typed checklist of activities that he claims to undertake when he starts a business in which the wording "SuperH." is handwritten in the upper left-hand corner;⁸ 2) an undated handwritten note which consists solely of the wording "Maiden Waves Sunscreen formula" and an arrow pointing to the wording "SuperHero Name"; 3) an undated description of a formula for "Maiden Waves Sunscreen"; and 4) a photograph of a drum of synthetic motor oil that includes the TEXASTEAM mark. Applicant did not submit any declaration or affidavit as an exhibit to his brief. Although applicant did not produce a copy of the checklist, the handwritten note, or the photograph of the drum showing the TEXASTEAM mark prior to filing his brief in opposition to opposer's motion for summary judgment, we have, in an abundance of caution, considered those documents in our decision.

Regarding the undated checklist, applicant admits in his brief that he only recently recognized the checklist as being "substantial enough to serve as a credible business plan and checklist for the Super Hero product." Applicant's brief at 6. As such, the checklist does not corroborate his

⁸ The checklist otherwise states as follows:

[Illegible wording] DBA
Publish DBA
Business License
Separate Tel. #
Industry Licenses
Business Cards
Logos
Co. Office inspection

assertion of an intent to use at the time the application was filed. Here, the checklist, which is undated and unsupported by a declaration or affidavit, is, at best, a recitation of general tasks to be performed in setting up a business, none of which relate specifically to the SUPER HERO mark or the goods at issue. Further, applicant does not indicate that he actually performed any of the tasks listed thereon to prepare for using the SUPER HERO mark on the identified goods. Regarding the handwritten note, nothing in the record indicates that the handwritten note was prepared contemporaneously with the filing of the application. In addition, regarding applicant's alleged possible use of the SUPER HERO mark to market sunscreen prepared under the Maiden Waves formula, applicant states in his discovery deposition that such formula was never actually prepared.⁹ See Silver deposition at 73-74.

Thus, applicant's evidence indicates, at most, that applicant has considered use of the involved mark for the identified goods and has confidence in his ability to bring such goods to market at some point in the future; however, these documents do not rebut opposers' showing that there is

⁹ Any alleged use of the TEXASTEAM mark on petroleum products has no bearing upon applicant's intent to use SUPER HERO, a completely different mark, on "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."

no genuine issue of material fact that applicant did not possess the requisite intent to use the mark on the identified goods when he filed his application.¹⁰ See *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, *supra*; see also *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1887 (TTAB 2008), and *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1587 (TTAB 2008) (no bona fide intent found because there was no relevant business established). Moreover, applicant's arguments in his brief regarding his ability to bring the goods to market are directly contradicted by statements that applicant made in his discovery deposition that he had no experience or training in the relevant field. Therefore, after having considered the evidence and arguments submitted by the parties in connection with the motion, and viewing that evidence in the light most favorable to applicant, we find there is no evidence of applicant's bona fide intent to use the mark on the identified goods when he filed his application.

Because applicant has not established that there is any genuine issue of material fact as to his a bona fide intent to use the mark on the identified goods, opposers' motion

¹⁰ Although applicant indicated in his discovery deposition that he does not intend to move forward with preparing to use his mark until after the resolution of this proceeding, opposers' claim relates to applicant's intent when he filed the involved the application on February 24, 2006, and not his intent during the pendency of this proceeding.

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for summary judgment is granted. The opposition is sustained, and registration is refused to applicant.