

ESTTA Tracking number: **ESTTA376875**

Filing date: **11/04/2010**

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

Notice of Opposition

Notice is hereby given that the following parties oppose registration of the indicated application.

Opposers Information

Name	DC Comics
Granted to Date of previous extension	11/07/2010
Address	1700 Broadway New York, NY 10019 UNITED STATES

Name	Marvel Characters, Inc.
Granted to Date of previous extension	11/07/2010
Address	1600 Rosecrans Avenue Manhattan Beach, CA 90266 UNITED STATES

Attorney information	Jonathan D. Reichman, Esq. Kenyon and Kenyon LLP One Broadway New York, NY 10004 UNITED STATES tmdocketny@kenyon.com Phone:212-425-7200
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Applicant Information

Application No	77895152	Publication date	05/11/2010
Opposition Filing Date	11/04/2010	Opposition Period Ends	11/07/2010
Applicant	Sunne & LaBouff, LLP 651 Dallas Street, Suite B Atlanta, GA 30308 UNITED STATES		

Goods/Services Affected by Opposition

Class 045. First Use: 2009/10/01 First Use In Commerce: 2009/10/01 All goods and services in the class are opposed, namely: Legal services

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	825835	Application Date	04/12/1966
Registration Date	03/14/1967	Foreign Priority Date	NONE
Word Mark	SUPER HERO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U039 (International Class 025). First use: First Use: 1965/10/29 First Use In Commerce: 1966/03/04 MASQUERADE COSTUMES		

U.S. Registration No.	1140452	Application Date	01/24/1974
Registration Date	10/14/1980	Foreign Priority Date	NONE
Word Mark	SUPER HEROES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 028. First use: First Use: 1973/07/02 First Use In Commerce: 1973/07/02 Toy Figures		

U.S. Registration No.	1179067	Application Date	07/03/1979
Registration Date	11/24/1981	Foreign Priority Date	NONE
Word Mark	SUPER HEROES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1966/10/00 First Use In Commerce: 1966/10/00 PUBLICATIONS, PARTICULARLY COMIC BOOKS AND MAGAZINES AND STORIES IN ILLUSTRATED FORM [((; CARDBOARD STAND-UP FIGURES; PLAYING CARDS; PAPER IRON-ON TRANSFER; ERASERS; PENCIL SHARPENERS; PENCILS; GLUE FOR OFFICE AND HOME USE, SUCH AS IS SOLD AS STATIONERY SUPPLY;] NOTEBOOKS AND STAMP ALBUMS))		

U.S. Registration No.	3674448	Application Date	01/23/2004
Registration Date	08/25/2009	Foreign Priority Date	NONE
Word Mark	SUPER HEROES		
Design Mark			
Description of Mark	NONE		

Goods/Services	Class 025. First use: First Use: 2005/01/01 First Use In Commerce: 2005/01/01 t-shirts
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Attachments	78356610#TMSN.gif (1 page)(bytes) SUPERHERO LAWYERS Notice of Opp.pdf (22 pages)(18654160 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Jonathan D. Reichman/
Name	Jonathan D. Reichman, Esq.
Date	11/04/2010

2. The application was originally filed by Applicant's alleged predecessor-in-interest Sunne & LaBouff, LLP. On June 17, 2010, title to the application was purportedly assigned to Celia T. Sunne, PC. On July 2, 2010, Celia T. Sunne, PC purportedly assigned its interest in the application to Sunne Law, PC. On information and belief, Ms. Celia T. Sunne, the principal of Applicant, was the principal of Celia T. Sunne, PC and a principal of Sunne & LaBouff, LLP. Sunne Law, PC and its alleged predecessors-in-interest are collectively referred to herein as "Applicant".

3. Applicant has claimed use of the mark in commerce under Trademark Act Section 1(a) (15 U.S.C. §1051(a)), and has claimed that its first use of the mark in commerce commenced on October 1, 2009.

4. Opposer is engaged in the businesses of, *inter alia*, publishing, merchandise licensing, media and entertainment. Opposer DC Comics is the owner and publisher of "DC Comics" and related intellectual property, which feature such world-famous characters and properties as "SUPERMAN[®]", "SUPERGIRL[®]" and "BATMAN.[®]" Opposer 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[®]", "IRON MAN[®]" and "HULK[®]".

5. Opposer is the joint owner of the trademarks and service marks "SUPER HERO[®]", "SUPER HEROES[®]" and variations thereof. Beginning at least as early as January 1958, *i.e.*, well prior to Applicant's filing date as well as its alleged first use date, Opposer (including its predecessors-in-interest) has used "SUPER HERO[®]", "SUPER HEROES[®]" and variations thereof as trademarks and service marks for a wide variety of products and services,

including, without limitation, comic books, clothing, toys, foods, motion picture films, television programming and internet programming.

6. Opposer is the owner of numerous registrations on the Principal Register of the United States Patent and Trademark Office for its marks “SUPER HERO[®]” and “SUPER HEROES,[®]” including without limitation the following:

Mark	Reg. No.	Date of Reg.	Goods/Services
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
SUPER HEROES	3,674,448	8/25/09	t-shirts

Each of these registrations issued prior to Applicant’s filing date and alleged first use date, and consequently there is no question of priority of rights, such priority clearly belonging to Opposer. Moreover, most of these registrations are incontestable under 15 U.S.C. § 1065. True and correct copies of these registrations are attached hereto as Exhibit “A”.

7. Through Opposer’s 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.

8. 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 for its products and services. Registration of the applied-for mark would be inconsistent with such right of Opposer.

9. Substantial efforts have been made 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, such marks have acquired secondary meaning in the minds of both the trade and public in connection with Opposer and with its products and services.

10. Moreover, Opposer’s “SUPER HERO[®]” and “SUPER HEROES[®]” marks constitute famous marks under 15 U.S.C. § 1125(c)(1). Opposer’s “SUPER HERO[®]” and “SUPER HEROES[®]” marks acquired such fame well prior to Applicant’s application filing date and Applicant’s alleged first use date.

11. If Applicant is granted registration for the mark opposed herein, 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, on at least the following grounds:

Lanham Act Section 2(d)

12. Registration should be denied under Lanham Act Section 2(d) (15 U.S.C. § 1052(d)), because Applicant’s applied-for mark “SUPERHERO LAWYERS” wholly incorporates and is confusingly similar to Opposer’s “SUPER HERO[®]” and “SUPER HEROES[®]” trademarks and service marks.

13. Applicant's use and registration of its mark is likely to cause injury to Opposer's "SUPER HERO[®]" and "SUPER HEROES[®]" marks, as such use and registration will inevitably cause confusion and mistake and deceive the public into believing that Applicant's services are affiliated with, sponsored by, or approved by Opposer or Opposer's licensees, and that such services emanate from the same source, and/or that Applicant is in some other fashion connected with Opposer, all to Opposer's injury.

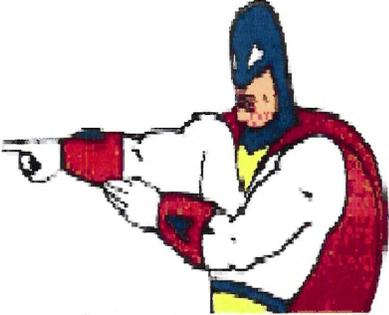
14. In fact, Applicant has sought to exacerbate such confusion by using characters owned by Opposer and/or its affiliates in connection with the use of "SUPERHERO LAWYERS". (Opposer reserves all of its rights and remedies against Applicant with respect to such infringing usage.)

15. For example, the use specimen submitted in Applicant's trademark application depicts a cartoon character which is confusingly and/or substantially similar to DC Comics' "SUPERGIRL[®]" character, and a cartoon character which is confusingly and/or substantially similar to the "SPACE GHOST[®]" character owned by DC Comics' affiliate Hanna Barbera. A true and correct copy of this use specimen is attached hereto as Exhibit "B".

16. Applicant subsequently made use of a character which is confusingly and/or substantially similar to Marvel's "HYPERION[™]" character from Marvel's "AVENGERS" and "DEFENDER" series. A true and correct copy of the relevant website page is attached hereto as Exhibit "C".

17. Applicant is currently making use of characters which are confusingly and/or substantially similar to DC Comics' "SUPERMAN[®]" and "KRYPTO THE SUPERDOG[®]" characters. A true and correct copy of Applicant's current website page, as of November 3, 2010, is attached hereto as Exhibit "D".

18. A chart comparing the striking similarities between Opposer's character properties and Applicant's infringing characters is set forth below:

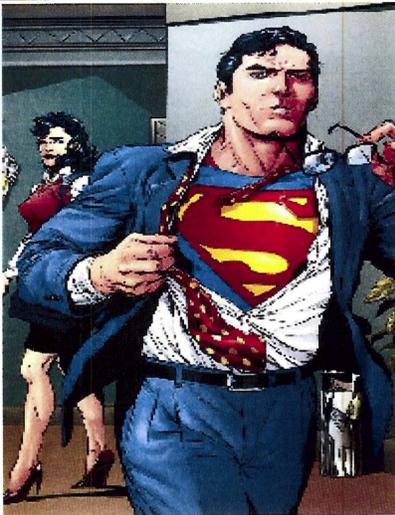
 <p>SPACE GHOST® Character</p>	 <p>Infringing Character</p>
 <p>SUPERGIRL® Character</p>	 <p>Infringing Character</p>



HYPERION™ Character



Infringing Character



SUPERMAN® Character



Infringing Character



KRYPTO® Character



Infringing Character

19. The use of these infringing characters constitutes further evidence of Applicant's bad faith intent to trade off of the good will developed by Opposer in its "SUPER HERO[®]" and "SUPER HEROES[®]" marks, and of Applicant's efforts to sow confusion among consumers.

20. If Applicant is permitted to register the applied-for 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 services are in some way associated with Opposer, or are licensed or authorized by Opposer, or are offered with Opposer's approval. Furthermore, any objection or fault found with Applicant's services would necessarily reflect upon and seriously injure the reputation which Opposer has established in connection with the goods and services marketed by Opposer and its licensees under its "SUPER HERO[®]" and "SUPER HEROES[®]" marks.

Lanham Act Section 43(c)

21. Registration should also be denied under Lanham Act Section 43(c) (15 U.S.C. § 1125(c)), because the subject mark is likely to dilute the distinctive quality of Opposer's famous "SUPER HERO[®]" and "SUPER HEROES[®]" marks, thereby causing further damage to Opposer.

22. Consequently, the applied-for mark does not and cannot exclusively identify the services in connection with which it is used as the services of Applicant, nor can it distinguish those services from the goods and services of Opposer, nor can it serve as an indication of source or origin of such services.

23. 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.

24. For the above reasons, the application opposed herein should be denied registration under 15 U.S.C. §§ 1052(d) and 1125(c).

25. The statutory fee of three hundred (\$300.00), and any additional required fees, should be charged to the undersigned's Deposit Account No. 11-0600.

WHEREFORE, Opposer prays that Application Serial No. 77/895,152 be rejected, and that the registration of the mark be denied and refused, and that this Opposition be sustained.

KENYON & KENYON LLP

Dated: November 4, 2010

By: 

Jonathan D. Reichman
Michelle C. Morris
One Broadway
New York, New York 10004
Phone: (212) 425-7200
Fax: (212) 425-5288

Attorneys for Opposers

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this correspondence is being filed through the electronic system for The Trademark Trial and Appeal Board in the United States Patent and Trademark Office on November 4, 2010.

By: Michelle C. Morris

CERTIFICATE OF SERVICE

It is hereby certified that a true and correct copy of the foregoing document, entitled Notice of Opposition, with the accompanying exhibits, was served on this 4th day of November, 2010, by first class mail, postage prepaid, upon Applicant's attorney of record with the United States Patent and Trademark Office, at the following addresses:

Mr. Sanford J. Asman, Esq.
Law Office of Sanford J. Asman
570 Vinington Court
Atlanta, GA 30350-5710

By: *Michelle C. Morris*
Michelle C. Morris

EXHIBIT A

Int. Cl.: 25

Prior U.S. Cl.: 39

United States Patent and Trademark Office
Renewal

Reg. No. 825,835
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 CORPO-
RATION)
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

United States Patent and Trademark Office

Reg. No. 1,140,452

Registered Oct. 14, 1980

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

Int. Cl.: 25

Prior U.S. Cls.: 22 and 39

Reg. No. 3,674,448

United States Patent and Trademark Office

Registered Aug. 25, 2009

TRADEMARK
PRINCIPAL REGISTER

SUPER HEROES

MARVEL CHARACTERS, INC. (DELAWARE CORPORATION)
9442 BEVERLY BOULEVARD
SUITE 350
BEVERLY HILLS, CA 90210 AND
DC COMICS (NEW YORK PARTNERSHIP)
1700 BROADWAY
NEW YORK, NY 10019

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

OWNER OF U.S. REG. NOS. 1,140,452 AND 1,179,067.

FOR: T-SHIRTS, IN CLASS 25 (U.S. CLS. 22 AND 39).

SN 78-356,610, FILED 1-23-2004.

FIRST USE 1-1-2005; IN COMMERCE 1-1-2005.

ESTHER BELENKER, EXAMINING ATTORNEY

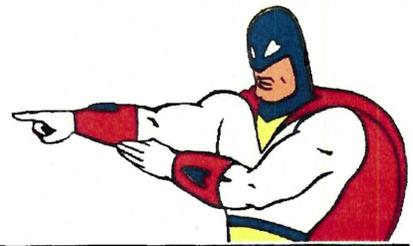
EXHIBIT B



Superhero Lawyers

Sunne & LaBouff

Attorneys at Law



Celia Todd Sunne

TOUGH ADVOCACY COMPASSIONATE COUNSELING™

John Paul LaBouff

www.mysuperherolawyer.com

651 Dallas Street, Suite B, Atlanta, Georgia 30308 404.240.0975 office 404.240.0198 fax

EXHIBIT C

Sunne & LaBouff

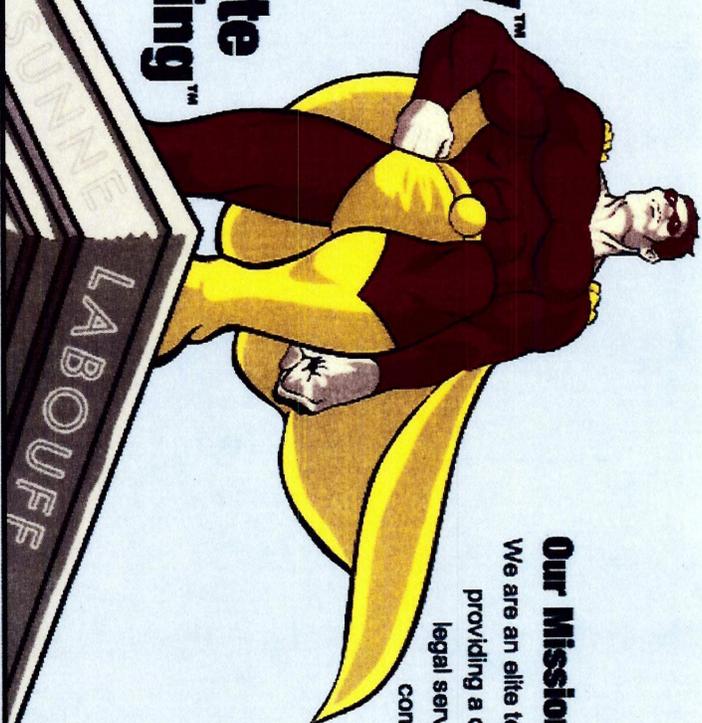
Attorneys at Law

Sunne & LaBouff - Attorneys at Law

- What We Do
- What You Can Do
- What We've Done
- Who We Are

Tough

Advocacy™



Our Mission

We are an elite team of superhero lawyers committed to providing a comprehensive and highly personalized legal service that combines tough advocacy and compassionate counseling. We protect our clients' rights and ultimately help guide them back to wholeness.

Compassionate Counseling™

**Who We Are
What We Do
Why We're Different**

**Who We Are
What We Do
Why We're Different**

Two lawyers protecting the rights of injured workers in the State of Georgia for the past twenty years.

What We Do

We are Workers' Compensation specialists. We do everything in our power to advocate for the injured worker's rights.

Why We're Different

Our philosophy and practice are based on tough advocacy and compassionate counseling™.

EXHIBIT D

[Who We Are](#) [What We Do](#) [Why We're Different](#) [What You Can Do](#) [What We've Done](#)

Our quest is to single-handedly restore faith in our profession so that the first thing that comes to mind when a person hears the word "lawyer" is not a bad joke but rather the memory of a positive experience. In our practice we intend to lead the way in demonstrating how lawyers should practice, how they should behave in the world... changing the perception, one client at a time.

Our firm logo reflects the manner in which we approach our work. We are superhero lawyers dedicated to fighting injustice. As superhero lawyers we will continue to be tough in fighting against the insurance companies and we will also continue to provide the compassionate counseling that every injured worker needs to help them through the difficult time that follows a work injury.



We also work closely with lawyers who exhibit our same qualities of tough advocacy and compassionate counseling but who specialize in other areas of law.

We are building an elite team of superhero lawyers who will protect your rights and fight injustice.

If you or a friend ever needs a referral to an attorney for any reason please take the time to call and speak with us.

We will assure that you are referred to the right lawyer, a lawyer who exhibits all of the qualities of a superhero.

[Contact Us](#) [Home](#)

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[Read Celia's Bio](#)

