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

Proceeding	91197289
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application of : Sunne Law, P.C.
Serial No. : 77/895,152
Filed : December 16, 2009
Mark : SUPERHERO LAWYERS
Published Official Gazette : May 11, 2010

DC COMICS and
MARVEL CHARACTERS, INC.,

Opposers,

v.

SUNNE LAW, P.C.

Applicant.

Opposition No. 91197289

SUNNE LAW, P.C.’S REPLY TO RESPONSES RELATING TO MOTIONS:

- (1) TO DISMISS FOR FAILURE TO STATE A CAUSE OF ACTION PURSUANT TO FED. R. CIV. PROC. 12(B)(6); and**
- (2) TO STRIKE PARAGRAPHS 14, 15, 16, 17, 18, 19, 20, AND EXHIBIT C OF THE NOTICE OF OPPOSITION AS BEING IMMATERIAL, IMPERTINENT, AND/OR SCANDALOUS PURSUANT TO FED. R. CIV. PROC. 12(F).**

Sunne Law, P.C. (“Applicant”) moved to dismiss Opposers’ Notice of Opposition for failure to state a claim upon which relief may be granted (Fed. R. Civ. Proc. 12(b)(6)), or, in the alternative, to strike Paragraphs 14, 15, 16, 17, 18, 19, 20, and Exhibit C of the Notice of Opposition pursuant to Fed. R. Civ. Proc. 12(f).

Opposers filed a Response in which they, again, showed their deep rooted appreciation for the fictional aspects of legal practice, asserting in their opening paragraph that Applicant had not filed a “serious motion”, and that it should be “summarily denied”.¹ Having found

¹ Thereby evoking the learned teachings contained in the classic legal treatise, *My Cousin Vinny*, wherein, Vinny (Joe Pesci) and Judge Chamberlain Haller (the late Fred Gwynne) had the following “courtroom” discussion:

themselves in the “unique” position of opposing a mark for services totally unrelated to any use or sales of goods by them, Opposers nevertheless felt the need to respond. The issues raised in Opposers’ Response can be set out as relating to two main issues, namely, (1) Applicant’s Motion to Dismiss; and (2) Applicant’s alternative Motion to Strike. Opposers argued that Applicant’s Motion to Dismiss should be denied as Opposers claim to have set out *prima facie* showings of both (a) a likelihood of confusion; and (b) dilution. In fact, Opposers merely expressed unsupported, and unsupportable, legal conclusions, without any factual allegation supporting such legal conclusions.

I. OPPOSERS’ CLAIM THAT APPLICANT’S USE OF THE WORD MARK “SUPERHERO LAWYERS” FOR “LEGAL SERVICES” CREATES A LIKELIHOOD OF CONFUSION WITH OPPOSERS’ REGISTERED TRADEMARKS HAS NO FACTUAL OR LEGAL BASIS, WHEREFORE OPPOSER’S NOTICE OF OPPOSITION FAILS TO STATE A CLAIM UPON WHICH RELIEF MAY BE GRANTED.

Rather than denying Applicant’s assertion that Opposers’ use of “SUPER HEROES” was limited to registrations relating solely to Opposers’ sale of *goods*², they embraced it, pointing out their Opposition asserted (1) “priority of use”, and (2) “likelihood of confusion”, doing so

Judge Chamberlain Haller: How do your clients plead?

Vinny Gambini: My clients were caught completely by surprise. They thought they were getting arrested for shoplifting a can of tuna.

Judge Chamberlain Haller: Huh? What are you telling me? That they plead not guilty?

Vinny Gambini: No. I’m just trying to explain...

Judge Chamberlain Haller: [*cutting him off*] I don’t want to hear explanations. I don’t know how you practice law in New York, but the state of Alabama has a procedure. And that procedure is to have an arraignment. Are we clear on this?

Vinny Gambini: Yes, but there seems to be a great deal of confusion here. You see, my clients...

Judge Chamberlain Haller: Uh, Mr. Gambini? [*Motions for him to approach the bench*]

Judge Chamberlain Haller: All I ask from you is a very simple answer to a very simple question. There are only two ways to answer it: guilty or not guilty.

Vinny Gambini: But your honor, my clients didn’t do anything.

Judge Chamberlain Haller: Once again, the communication process has broken down between us. It appears to me that you want to skip the arraignment process, go directly to trial, skip that, and get a dismissal. Well, I’m not about to revamp the entire judicial process just because you find yourself in the unique position of defending clients who say they didn’t do it.

² Namely, “masquerade costumes” in International Class 025 (“SUPER HERO”, U.S. Reg. No. 825,835); “toy figures” in International Class 028 (“SUPER HEROES”, U.S. Reg. No. 1,140,452); “publications” in International Class 016 (“SUPER HEROES”, U.S. Reg. No. 1,179,067); and “t-shirts” in International Class 025 (“SUPER HEROES”, U.S. Reg. No. 3,674,448)

without any semblance of addressing any of the issues relevant to a determination of whether a likelihood of confusion actually exists. In particular, with consideration to the eight *DuPont*³ factors relevant to determining whether a likelihood of confusion are among trademarks exists, namely: (1) the strength of the mark (*See*, below), (2) the relatedness of the goods or services offered by the parties (Clearly, the goods of Opposer are unrelated to the services offered by Applicant.), (3) the similarity of the marks (*See*, below), (4) any evidence of actual confusion (Obviously, there has been, and can be, none.), (5) the marketing channels used by the parties (Obviously, the marketing channels for comic books and the other goods offered by Opposers differs from those relating to the legal services offered by Applicant.), (6) the probable degree of purchaser care and sophistication (Clearly, one seeking comic books, or the other goods offered by Opposers, would not expect them to be sold by a law office; nor would one seeking legal services do so at a place where comic books, or the other goods offered by Opposers, are sold, so the consumer of either would clearly be sufficiently sophisticated so as to be able to distinguish between legal services and goods depicting fictional characters/), (7) the applicant's intent in selecting its mark (*See*, below), and (8) the likelihood of either party expanding its product line using the marks (It is legally impossible for Opposers to expand their product lines to include legal services.).

Thus, of the eight *DuPont* factors, it is clear that five of them, namely (2), (4), (5), (6), and (8) weigh heavily in favor of Applicant, with only three even subject to any possible discussion. With respect to those three factors, we must consider (a) the strength of Opposers' marks; (b) the similarity of the marks; and (c) Applicant's intent in adopting its mark.

As to the strength of Opposers' "SUPER HERO" and "SUPER HEROES" marks, while those marks are registered on the Principal Register, and while they have "incontestable" status,

³ *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). *See*, also T.M.E.P. § 1207.

the very first comic book “superhero”, namely “Superman”, first came into existence in 1938, while the word “superhero” has been in English dictionaries since at least 1917. Thus, while Opposers’ marks, comprised of the two words – “super” and “hero”, may be considered strong⁴, by virtue of their long use in connection with specific goods, “superhero” (the single word) is a word which was not coined by Opposers, and which is descriptive of the qualities of their comic book characters. At best, this factor is a “wash”.

As to the similarity of the marks, each of the marks relied on by the Opposers includes the two words “SUPER HERO” or “SUPER HEROES”, while Applicant’s mark is “SUPERHERO LAWYERS”. While Opposers’ marks include the “SUPERHERO” portion of Applicant’s mark (albeit as two words, rather than one), they do not, nor could they ever, include the word “LAWYERS”, as does Applicant’s mark; nor could either of Opposers use their (jointly owned) marks to refer to “legal services”. Accordingly, one must accept that Applicant has the superior position with respect to that *Dupont* factor.

Finally, Applicant’s intent in adopting the word mark “SUPERHERO LAWYERS” was to adopt a mark suggestive of the nature and quality of the legal work performed by Applicant’s law firm, while acting to parody the comic book concept of a “super hero”. To the extent that Applicant’s mark includes the word “superhero” it was not to trade on Opposer’s rights, but to invoke the suggestion provided by the common, English language use of the word.

Based upon the foregoing, it is clear that five of the eight *Dupont* factors are unquestionably in favor of Applicant, with the remaining three leaning in Applicant’s favor.

Thus, when one considers “likelihood of confusion”, Opposers have merely expressed a legal conclusion without any justification or relevant factual allegations supporting such

⁴ That is, assuming, *arguendo*, that they are not merely descriptive or generic. Of course, Applicant does not concede that the marks upon which Opposers rely are not merely descriptive and that they have not become generic.

conclusion, and as such Opposers have clearly failed to state a viable cause of action as to “likelihood of confusion”. *Bell Atlantic Corp. v. Twombly*, 127 S.Ct. 1955, 550 U.S. 544 (2007).

II. OPPOSERS’ CLAIM OF DILUTION BASED ON APPLICANT’S USE OF THE “SUPERHERO LAWYERS” MARK

Again, Opposers allegation of “dilution” was merely yet another expression of a legal conclusion lacking a single scintilla of factual allegation in support of such conclusion. The Trademark Dilution Revision Act of 2006 (“TDRA”), corresponding to 15 U.S.C. § 1125(c) sets out civil causes of action for “dilution by blurring” and for “dilution by tarnishing”.

Notwithstanding Opposers’ allegations, the TDRA provides relief to *the* owner of a “famous” mark. However, as the TDRA is statutory, the term “famous” is not that which one might assume it to be, but that which the statute defines. Specifically, a mark can only be “famous” under the TDRA, if “it is widely recognized by the general consuming public of the United States as a designation of the goods or services of *the* mark’s owner.” 15 U.S.C. § 1125(xxx).

Here the marks “SUPER HERO” and “SUPER HEROES” *have no single* “owner”, as the marks are jointly “owned” by each of the Opposers, who are, in fact, direct competitors in connection with the very products which they each sell in direct, and independent, competition with one another. It is hard to understand how Opposers even have standing to allege “dilution” in view of the fact that two direct competitors in the comic book industry (namely, DC Comics and Marvel Characters, Inc.) are already using the mark to compete with one another on a daily basis with respect to directly competitive goods. As such it is hard to believe that Opposers could possibly claim that their jointly owned “SUPER HERO” and “SUPER HEROES” marks could be “diluted” by Applicant’s use of a different (“SUPERHERO LAWYERS”) mark for

services which neither of them could possibly provide, when they are already competing on a daily basis with respect to identical marks.

Again, Opposers have not made, nor could they make, any showing as to how Applicant's use of its "SUPERHERO LAWYERS" mark could, within the scope of the TDRA, be diluted by Applicant's use of a wholly different mark for wholly different services which neither of the Opposers could provide.

III. PARAGRAPHS 14, 15, 16, 17, 18, 19, 20, AND EXHIBIT C OF THE NOTICE OF OPPOSITION SHOULD BE STRUCK AS BEING IMMATERIAL AND/OR IMPERTINENT PURSUANT TO FED. R. CIV. PROC. 12(F).

Applicant's mark is a word mark, namely, "Superhero Lawyers" ("the Mark"), used by Applicant (a professional corporation engaged in the practice of providing legal services) as a mark relating to the "legal services" offered by Applicant to its very *real* clients. In that the Mark is a word mark, any reference to allegedly "infringing" characters is immaterial and/or impertinent and should be struck from the pleadings.

In particular, Opposers' Notice of Opposition includes several paragraphs, including, *inter alia*, Paragraphs 14-19, as well as Exhibit C, which relate solely to issues associated with fictional "characters" to which Opposers claim copyright, *not* trademark rights. In that Applicant's Mark is a word mark, and in that Applicant has claimed no trademark right to any character, the allegations in the Notice of Opposition as to claims of ownership of, or confusion as to, various fictional characters, are wholly irrelevant, immaterial, and/or impertinent, wherefore they should be struck from the Notice of Opposition.

Further, Paragraph 20 contains baseless, frivolous, unfounded, defamatory, and scandalous remarks relating to hypothetical "objections or faults" associated with Applicant's legal services. Such remarks are reprehensible and should be struck from the Notice of

Opposition, and this honorable Trademark Trial and Appeal Board should severely admonish Opposers' counsel as to the impropriety associated with any such remarks.

CONCLUSION

In view of the foregoing, Applicant respectfully requests that the present Opposition be dismissed.

Alternatively, Applicant respectfully requests that the TTAB issue an Order requiring Opposers to refile their Notice of Opposition without the immaterial and impertinent mention of the various characters which are wholly irrelevant to Applicant's application to register the word mark "Superhero Lawyers" for "legal services" in International Class 045.

Respectfully submitted,

Dated: February 8, 2011

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CERTIFICATE OF SERVICE

Undersigned hereby certifies that, on the date set forth below, a copy of the foregoing:

- SUNNE LAW, P.C.'S REPLY TO RESPONSES RELATING TO MOTIONS:**
- (3) TO DISMISS FOR FAILURE TO STATE A CAUSE OF ACTION PURSUANT TO FED. R. CIV. PROC. 12(B)(6); and**
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was served through the electronic filing system of the U.S. Patent and Trademark Office, Trademark Trial and Appeal Board, and by first class mail, postage prepaid, upon Opposer's counsel, addressed as follows:

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Dated: February 8, 2011

By: /s/ Sanford J. Asman
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