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

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Mailed: May 9, 2011

Opposition No. 91197289

DC Comics,
Marvel Characters, Inc.

v.

Sunne Law, PC

Before Quinn, Kuhlke and Mermelstein,
Administrative Trademark Judges.

By the Board:

Applicant seeks to register the mark SUPERHERO LAWYERS (standard characters, LAWYERS disclaimed) for "legal services" in International Class 45.[1]

Opposers filed a notice of opposition on the grounds of 1) priority and likelihood of confusion under Trademark Act Section 2(d); and 2) dilution under Trademark Act Section 43(c). Opposers assert ownership of the following four registrations:

1) Registration No. 825835 for SUPER HERO (standard characters) for "masquerade costumes" in International Class 25;[2]

[1] Application Serial No. 77895152, filed December 16, 2009, alleging use in commerce pursuant to Trademark Act Section 1(a), and a date of first use anywhere and first use in commerce of October 1, 2009.
[2] Registered March 14, 1967; first renewal March 14, 1987, and second renewal March 2, 2007.

2) Registration No. 1140452 for SUPER HEROES (standard characters) for "toy figures" in International Class 28;[3]

3) Registration No. 1179067 for SUPER HEROES (standard characters) for "publications, particularly comic books and magazines and stories in illustrated form" in International Class 16;[4]

4) Registration No. 3674448 for SUPER HEROES (standard characters) for "t-shirts" in International Class 25.[5]

In Paragraphs 4 and 5, opposers also allege ownership of various marks as follows:

4. Opposer is engaged in the business 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.

Applicant filed an answer denying the salient allegations in the notice of opposition, and concurrently moved to dismiss

[3] Registered October 14, 1980; first renewal March 4, 2001, and second renewal January 19, 2010.
[4] Registered November 24, 1981; first renewal August 19, 2002, and second renewal December 4, 2010.

the opposition pursuant to Fed. R. Civ. P. 12(b)(6) for failure to state a claim upon which relief may be granted, or in the alternative, to strike Paragraphs 14 through 20, and Exhibit C, under Fed. R. Civ. P. 12(f) as immaterial, impertinent and/or scandalous.

The motion has been fully briefed.[6]

Motion to dismiss

A motion to dismiss for failure to state a claim upon which relief can be granted is a test solely of the legal sufficiency of a complaint. To survive a motion to dismiss, a plaintiff need only allege sufficient factual matter as would, if proved, establish that (1) the plaintiff has standing to maintain the proceeding,[7] and (2) a valid ground exists for opposing or cancelling the mark. *See Ashcroft v. Iqbal*, 556 U.S. ___, 129 S. Ct. 1937 (2009); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982). *See also* TBMP § 503.02 (2d ed. rev. 2004).

In the context of inter partes proceedings before the Board, the factual allegations "must be enough to raise a right to relief above the speculative level." *See Totes-*

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[5] Registered August 25, 2009.

[6] Applicant's brief and reply brief are unnumbered, in violation of Trademark Rule 2.126(a)(5). With respect to applicant's future filings, the pages of briefs should be numbered.

[7] We find that opposers' allegations, if proved, sufficiently plead their standing.

Inasmuch as the copies of each of opposers' four pleaded registrations attached to the notice of opposition do not show current status of and title to the registrations, the

Isotoner Corp. v. United States, 594 F.3d 1346, 1354 (Fed. Cir. 2010) (citing *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 555 (2007)). The pleading must be examined in its entirety, construing the allegations therein so as to do justice. Fed. R. Civ. P. 8(e); *see also Otto Int'l Inc. v. Otto Kern GmbH,* 83 USPQ2d 1861, 1862 (TTAB 2007).

Priority and Likelihood of Confusion

To state a claim under Section 2(d), opposers must sufficiently allege that 1) they have registered or previously used a mark; and 2) contemporaneous use of the parties' respective marks on or in connection with their respective goods or services would be likely to cause confusion, mistake or to deceive consumers. *See Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.,* 60 USPQ2d 1733, 1735 (TTAB 2001).

Turning to the most pertinent portions of the pleading, in Paragraphs 6, 12 and 13, opposers allege as follows:

> 6. Each of (opposer's pleaded) 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".
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> 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

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registrations are not in evidence and are not part of the record. *See* Trademark Rule 2.122(d)(1).

> "SUPER HERO®" and "SUPER HEROES®" trademarks and service marks.
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> 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.

The Board finds that these allegations sufficiently set forth the elements of a claim of likelihood of confusion. In particular, opposers allege that the parties' marks are confusingly similar, and that the use of applicant's mark will cause confusion and mistake, and will deceive the public into believing that applicant's services emanate from the same source as opposers' goods, or are affiliated with or sponsored by opposers.

Dilution

To state a claim of dilution, opposers must allege that 1) opposers' mark is famous; 2) opposers' mark became famous before applicant commenced use of the challenged mark in its use-based application; and 3) applicant's use is likely to cause dilution of the distinctive quality of opposers' mark or to lessen the capacity of the mark to identify and distinguish opposers' goods or services. *See Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1172-73 (TTAB 2001); *Polaris Indus. Inc. v. DC Comics*, 59 USPQ2d 1798, 1800 (TTAB 2000).

Turning to the most pertinent portions of the pleading, in Paragraphs 10 and 21, opposers allege as follows:

> 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.
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> 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.

The Board finds that these allegations sufficiently set forth the elements of a claim of dilution.

In summary, in view of these findings, applicant's motion to dismiss the opposition under Fed. R. Civ. P. 12(b)(6) is denied. We emphasize that opposers' likelihood of prevailing on their claims is not the issue here. That is a matter to be decided on the merits. We conclude only that opposers' notice of opposition is sufficient to state a claim for relief.

Motion to strike

Upon motion, the Board may order stricken any insufficient defense or any redundant, immaterial, impertinent or scandalous matter. *See* TBMP § 506.01 (2d ed. rev. 2004); *Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289, 1292 (TTAB 1999). Motions to strike matter from a pleading are not favored, and matter claimed to be objectionable will

not be stricken unless it clearly has no bearing upon the issues in the case. *Id.* The Board may decline to strike even objectionable pleadings where their inclusion will not prejudice the adverse party, but rather will provide fuller notice of the basis for a claim or defense. *See Order of Sons of Italy in America v. Profumi Fratelli Nostra AG,* 36 USPQ2d 1221, 1223 (TTAB 1995).

At issue are Paragraphs 14-19, and Exhibit C, which applicant argues should be stricken because "any reference to allegedly 'infringing' characters is immaterial and/or impertinent," and because the allegations "relate solely to issues associated with fictional 'characters' to which Opposers claim rights" (applicant's brief, unnumbered p. 3).

In Paragraphs 14 – 19, opposers essentially allege that applicant uses various characters in connection with its applied-for mark SUPERHERO LAWYERS, that some characters are "confusingly and/or substantially similar to" (notice of opposition, para. 15, 16 and 17) character marks for which one or both opposers own a registration, that through this use applicant "has sought to exacerbate such confusion" (notice of opposition, para. 14), and that "[T]he 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" (notice of opposition, para. 19). In

Paragraph 16, opposers identify Exhibit C as a page from applicant's website, alleging that it constitutes "use of a character which is confusingly and/or substantially similar to Marvel's "HYPERION™" character from Marvel's "AVENGERS" and "DEFENDER" series."

By way of these allegations and exhibit, opposers essentially set forth the position that the manner in which applicant uses the wording SUPERHERO LAWYERS may be relevant to the determination of whether the wording is registrable. As such, the allegations serve to amplify opposers' grounds. Additionally, applicant has failed to support its assertion that the allegations are "wholly irrelevant."[8]

Lastly, applicant seeks to strike Paragraph 20, asserting that it contains "baseless, frivolous, unfounded, defamatory, and scandalous remarks relating to hypothetical 'objections or faults' associated with Applicant's legal services" (applicant's brief, unnumbered p. 4).

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[8] Of course, the persuasiveness of opposers' allegations depends on whether they are proven at trial. Notwithstanding our disposition of applicant's motion to strike, the parties are reminded that the Board is empowered with the limited jurisdiction of determining the right to register the service mark set out in the subject application, and does not have jurisdiction over the right to use, infringement or unfair competition claims. *See* TBMP § 102.01 (2d ed. rev. 2004). While opposers are allowed some flexibility, we caution that the only evidence that is relevant to this proceeding is that which is probative of applicant's right to register the mark SUPERHERO LAWYERS for use on the identified services. Whether applicant's *use* of that or any other alleged mark is otherwise appropriate is beyond our jurisdiction.

In Paragraph 20, opposers essentially allege that allowing applicant to register its mark will result in confusion, and that applicant's use of its mark would reflect upon and injure opposers' reputation. These allegations constitute an amplification of opposers' pleaded grounds for opposition. Moreover, applicant fails to support its conclusion that these allegations, or as applicant characterizes them, "remarks," are objectionable such as would warrant striking them. Opposer does not allege that applicant's services are, in fact, questionable, but rather sets forth, as applicant itself notes, a "hypothetical" that merely augments its claim of possible damage ("Furthermore, any objection or fault found with Applicant's services would necessarily reflect upon and seriously injure the reputation …").

In view of these findings, applicant's motion to strike pursuant to Fed. R. Civ. P. 12(f) is denied.

Schedule

Proceedings are resumed. Conferencing, disclosure, discovery and trial dates are reset as follows:

Deadline for REQUIRED Discovery Conference	**6/17/2011**
Discovery Opens	**6/17/2011**
Initial Disclosures Due	**7/17/2011**
Expert Disclosures Due	**11/14/2011**
Discovery Closes	**12/14/2011**
Plaintiff's Pretrial Disclosures due	**1/28/2012**
Plaintiff's 30-day Trial Period	**3/13/2012**

Ends	
Defendant's Pretrial Disclosures due	**3/28/2012**
Defendant's 30-day Trial Period Ends	**5/12/2012**
Plaintiff's Rebuttal Disclosures due	**5/27/2012**
Plaintiff's 15-day Rebuttal Period Ends	**6/26/2012**

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.l25.

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.l29.