

This Opinion is not a  
Precedent of the TTAB

Mailed: September 25, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*Dille Family Trust*

*v.*

*Nowlan Family Trust*

—  
Opposition No. 91200643  
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Vincent G. LoTempio and Daniel I. Herman of Kloss, Stenger & LoTempio for Dille Family Trust.

John J. O'Malley of Volpe and Koenig P.C. for Nowlan Family Trust.

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Before Cataldo, Adlin and Masiello,  
Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

Nowlan Family Trust (“Applicant”) filed an application<sup>1</sup> to register the mark  
BUCK ROGERS in standard characters for the following goods and services:

Motion picture films about science fiction, fantasy heroism and action adventure; science fiction, and motion picture films about fantasy heroism and action adventure for broadcast on broadcast mediums; audio tapes, audio-video tapes, audio video cassettes, audio video discs, and

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<sup>1</sup> Application Serial No. 77650082, filed on January 15, 2009 under Trademark Act Section 1(b), 15 U.S.C. § 1051(b), on the basis of Applicant’s alleged *bona fide* intention to use the mark in commerce.

digital versatile discs featuring music, comedy, drama, action, adventure, and animation; stereo headphones; batteries; cordless telephones; audio cassette and CD players; CD ROM computer game discs; telephone and radio pagers; short motion picture films about science fiction, fantasy heroism and action adventure and adventure; video cassette recorders and players, compact disc players, digital audio recorders and players; radios; mouse pads; eyeglasses, sunglasses and cases therefore; game equipment, namely, video game machines for use with televisions, hand-held electronic games adapted for use with television receivers only and player operated electronic controllers for electronic video game machines; video and computer game programs; video game cartridges and cassettes; cellular telephone accessories, namely, cell phone covers, batteries, fitted plastic films known as skins for covering and providing a scratch proof barrier, decorative charms, decorative ornaments, headsets, boosters, connectivity kits and memory cards; encoded magnetic cards, in International Class 9;

Printed matter and paper goods, namely, books featuring science fiction, fantasy heroism and action adventure, comic books, magazines featuring science fiction, fantasy heroism and action adventure; stationery, writing paper, envelopes, notebooks, diaries, note cards, greeting cards, trading cards; lithographs; pens, pencils, cases therefor, erasers, crayons, markers, colored pencils, painting sets for children, chalk and chalkboards; decals, heat transfers; posters; mounted and unmounted photographs; book covers, book marks, calendars, gift wrapping paper; Paper party decorations; Printed patterns for costumes, pajamas, sweatshirts and t-shirts; paper party favors, in International Class 16;

Clothing, namely, pajamas, t-shirts, shirts, jumpers, sweatshirts, vests, coats, jackets, overcoats, trousers, shorts, socks, gloves, ties, scarves, skirts, underwear, footwear; headgear, namely, hats, caps, head scarves, baseball caps and headbands, clothing accessories, namely, belts, gloves, suspenders, sweat bands, straps for bras, in International Class 25;

Toys, namely, musical toys, inflatable toys, electric action toys, punch toys, plush toys, talking toys, toy cars, role-

playing toys in the nature of play sets for children to imitate real life occupations, toy boats, toy airplanes, toy weapons, toy rocket ships, construction toys, toy putty, toy scooters, toy action figures and accessories for use with toy action figures, toy model vehicles, water squirting toys and toy model space craft, toy building blocks, toy model hobby craft kits comprising paints, beads, ceramics, plastics, crayons, stencils, toy model vehicles and related accessories sold as a units, toy modeling dough kits comprising toy modeling dough, molds and accessories for use therewith sold as units, toy vehicles, toy weapons, toy model vehicles and accessories therefor sold as a unit, wind-up toys and miniature toy helmets; sporting goods, namely, beach balls, playground balls, soccer balls, sport balls, baseball balls, basketball balls, baseball bats, and baseball gloves; games, namely, action type target games, board games, card games, hand held units for playing electronic games other than those adapted for use with an external display screen or monitor, virtual arcade shooting game machines, trading card games, parlor games, action skill games, coin operated and non-coin operated pinball machine games, stand alone video game machines, collectible card games, and collectible miniature board games, in International Class 28;

Entertainment services, namely, an on-going series provided through broadcast mediums, namely, television, webcasts, and radio broadcasts, in International Class 41.

Dille Family Trust (“Opposer”) opposed registration of the mark on the ground that the mark, as intended to be used in connection with the identified goods and services, so resembles Opposer’s mark BUCK ROGERS as to be likely to cause confusion, mistake or deception under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d); and dilution under Trademark Act Section 43(c), 15 U.S.C. § 1125(c).<sup>2</sup> Opposer asserts that it has used the mark BUCK ROGERS in connection with a variety of goods and services, commencing at least as early as 1928. Opposer also

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<sup>2</sup> Opposer’s reference to Trademark Act Section 43(a) as an additional basis for its dilution claim is inapposite.

pleaded ownership of two pending applications, Serial Nos. 77831393 and 77831213, and two expired registrations, Nos. 0714184 and 1555871.

Applicant, in its answer, denied the salient allegations in the notice of opposition. The case is fully briefed.

I. The record.

The record includes the pleadings and, by operation of Trademark Rule 2.122, 37 C.F.R. § 2.122, the application file for the opposed mark.<sup>3</sup>

Applicant has submitted no evidence or testimony.

Opposer has filed the following:

- Testimony deposition of Louise A. Geer, Esq., Opposer's Trustee, with exhibits (40-41 TTABVUE).
- Notice of reliance on information from the USPTO's online database relating to Opposer's pending applications Nos. 77831213 and 77831393; and pages from a publication called Previews (49 TTABVUE).

II. Standing.

Ms. Geer testified that Opposer has produced a series of books with titles including "Buck Rogers in the 25<sup>th</sup> Century: The Western Publishing Years," "Buck Rogers in the 25<sup>th</sup> Century: the complete newspaper dailies," and "Buck Rogers in the 25<sup>th</sup> Century: the complete Sundays."<sup>4</sup> It is therefore clear that Opposer has a real interest in the outcome of this proceeding. *See Ritchie v. Simpson*, 170 F.3d 1092, 1095, 50 USPQ2d 1023, 1026 (Fed. Cir. 1999); *Jewelers Vigilance Committee*,

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<sup>3</sup> Applicant filed a notice of reliance on information relating to its involved application, taken from the USPTO's online database (44 TTABVUE); and subsequently filed a notice of reliance seeking to *delete* that matter from the record (50 TTABVUE). Nonetheless, as noted, the entire application file is automatically of record.

<sup>4</sup> Geer Exhibit 19, 41 TTABVUE 3-69.

*Inc. v. Ullenberg Corp.*, 823 F.2d 490, 492-493, 2 USPQ2d 2021, 2023-24 (Fed. Cir. 1987). Opposer has therefore established its standing to oppose registration of Applicant's mark. See *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); *Swiss Grill Ltd. V. Wolf Steel Ltd.*, \_\_ USPQ2d \_\_ (TTAB 2015); *Conolty v. Conolty O'Connor NYC LLC*, 111 USPQ2d 1302, 1308 (TTAB 2014); *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009) (standing established by showing of common law rights).

III. Opposer's claim under Section 2(d).

Opposer brings its opposition under Trademark Act Section 2(d) on the ground of likelihood of confusion. Under Section 2(d), the Patent and Trademark Office may refuse registration of a mark that "so resembles ... a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods [or services] of the applicant, to cause confusion, or to cause mistake, or to deceive." 15 U.S.C. § 1052(d). We address first the issue of priority.

The earliest date of use that Applicant claims, for its part, is January 15, 2009, the date on which it filed the opposed application. ("Applicant does not dispute that it has not alleged a date of first use earlier than this date.")<sup>5</sup> Applicant is entitled to rely on that date as its date of constructive use. *Cent. Garden & Pet Co. v. Doskocil*

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<sup>5</sup> Applicant's brief at 14-15, 54 TTABVUE 23-24.

*Mfg. Co.*, 108 USPQ2d 1134, 1140 (TTAB 2013); *Larami Corp. v. Talk To Me Programs Inc.*, 36 USPQ2d 1840 (TTAB 1995).

Opposer contends that its rights in the mark BUCK ROGERS date back to the earliest publication of a newspaper comic strip regarding the fictional hero named Buck Rogers. The evidence indicates that an Illinois corporation called National Newspaper Service entered into a series of agreements (dated August 27, 1926, November 15, 1929 and May 1, 1933) with an author named Philip F. Nowlan under which Mr. Nowlan would supply “material suitable for newspaper publication,” also described as “A story in strip form of conditions in America some five hundred years hence.”<sup>6</sup> The agreements anticipate that the work might be variously entitled “Buck Rogers”; “Buck Rogers 2429 A.D.”; and “Buck Rogers 2433 A.D. (or in the Twenty-Fifth Century).” On September 2, 1932, the same parties entered an agreement to allow National Newspaper Service to sell related radio broadcast rights of “Buck Rogers 2432 A.D. (or 25<sup>th</sup> Century).”<sup>7</sup> In these agreements, the signature for National Newspaper Service appears to read “John F. Dille.”

In 1936, an entity called John F. Dille Co. had dealings with Universal Pictures Company, Inc.<sup>8</sup> A recital in their agreement states:

WHEREAS, Dille represents that it is the sole owner of the copyright and of all rights hereinafter stated to be granted to Universal in and to a certain newspaper feature consisting of a series of comic pages entitled

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<sup>6</sup> Geer Exhibits 1, 2 and 4, 40 TTABVUE 93-98, 101-103.

<sup>7</sup> Geer Exhibit 3, 40 TTABVUE 99-100.

<sup>8</sup> Agreement of January 11, 1936, Geer Exhibit 6, 40 TTABVUE 109-110. The record contains only the cover page and the first page.

“BUCK ROGERS” and controls the trademarks and titles;  
...<sup>9</sup>

An agreement of June 17, 1937 among National Newspaper Service, Philip Nowlan, and Richard Calkins states that “John Dille Co. is a party to this contract in all respects and in the same manner as it applies to National and agrees to be bound hereby.”<sup>10</sup> It also contains the following release:

Nowlan and Calkins hereby waive and release any objection or right of any kind they might have now or hereafter in respect to the production of motion pictures of BUCK ROGERS material by any party or parties with whom National may contract, or have the opportunity of contracting, respecting said motion picture rights in favor of said party or parties. Nolan and Calkins also waive and release any right they might have to obtain compensation therefor from said party or parties. This provision is to safeguard said party or parties in the production of said motion pictures against any objection by Nowlan and/or Calkins. ...

On the basis of these documents, it is plausible (but not certain) that Phillip Nowlan may have developed trademark rights in marks that include the designation BUCK ROGERS, inasmuch as he appears to have produced and delivered to National Newspaper Service a series of newspaper strips under those titles. The title of a series of works can function as a trademark. *In re Polar Music Int'l AB*, 714 F.2d 1567, 221 USPQ 315, 318 (Fed. Cir. 1983). If such rights existed, we would not consider the June 17, 1937 release to have divested Mr. Nowlan of

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<sup>9</sup> *Id.*, 40 TTABVUE 110.

<sup>10</sup> Geer Exhibit 5, 40 TTABVUE 105-108. There is no signature on behalf of John F. Dille Co., although the signatory for National Newspaper Service appears to be John F. Dille.

them, as he released only those rights relating to the production of motion pictures by certain particular parties.

If we assume that Mr. Nowlan's trademark rights existed, the record indicates that, after multi-party litigation involving Mr. Nowlan's estate, they were transferred to John F. Dille. A "Full and Compete Release and Assignment" dated May 14, 1942, executed by Teresa Maria Nowlan, as executrix of Mr. Nowlan's will, states:

The party of the first part [Ms. Nowlan] hereby assigns, releases, waives and conveys all ... rights and interests of any kind whatsoever ... in and to all trade-marks, good will, titles including specifically "Buck Rogers" and "Buck Rogers In The 25<sup>th</sup> Century" and all characters, patents and inventions and all other subject matter relating in any way to the Buck Rogers features to John F. Dille.<sup>11</sup>

Here the chain of title beginning in 1926, to the extent that we can trace it on this record, ends. Thereafter, the entire roster of interested parties appearing in the record changes. Opposer is not John F. Dille, but the Dille Family Trust. Nothing in the record explains the connection between the two, if any, and nothing shows how any trademark rights of Mr. Dille were transferred to Opposer, if they were transferred at all. There are three later assignments (two of which are represented in the record only by their first and last pages) that indicate transfers of unspecified marks and registrations that are identified only by registration number, as follows:

February 1, 1968: Robert C. Dille assigned nine marks and registrations to National Newspaper Syndicate, Inc.<sup>12</sup>

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<sup>11</sup> Geer Exhibit 8, 40 TTABVUE 114.

<sup>12</sup> Geer Exhibit 62, 40 TTABVUE 168-169.

May 31, 1974: National Newspaper Syndicate, Inc. assigned seven marks and registrations to Robert C. Dille.<sup>13</sup>

September 24, 1982: Robert C. Dille assigned 16 marks and registrations to himself and Virginia N. Dille in their capacities as Trustees of The Dille Family Trust.<sup>14</sup>

There is another assignment, also dated September 24, 1982, that actually refers to the mark BUCK ROGERS. That document states that Robert C. Dille assigns 2 marks (TIGER MAN and BUCK ROGERS) and registrations to himself and Virginia N. Dille in their capacities as Trustees of The Dille Family Trust.<sup>15</sup> It is in the two 1982 documents described above that Opposer makes its first appearance in this record, but the record shows no connection between the properties described therein and any rights that may have been in the hands of John F. Dille or Philip F. Nowlan. The testimony shows that Robert C. Dille was the son of John F. Dille, and it appears that Virginia Dille was Robert's wife.<sup>16</sup> However, the record shows no transfer of any property, much less the specific properties at issue in this case, between John and Robert Dille. If there is any relationship between National Newspaper Service and National Newspaper Syndicate, Inc., it remains unexplained. Accordingly, we can find, on this record, no connection between Opposer and any trademark rights arising at the time of the original issuance of the Buck Rogers newspaper strips.

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<sup>13</sup> Geer Exhibit 61, 40 TTABVUE 166-167.

<sup>14</sup> Geer Exhibit 59, 40 TTABVUE 162-163.

<sup>15</sup> Geer Exhibit 60, 40 TTABVUE 164-165.

<sup>16</sup> Geer 69:8-12, 40 TTABVUE 71.

Of course, Opposer need not trace its rights back to the earliest days of the Buck Rogers newspaper strip in order to prevail in this proceeding. Opposer need only show that its rights arose prior to January 15, 2009. We therefore consider whether Opposer has demonstrated such rights.

The record shows that Opposer has issued a series of publications with titles such as “Buck Rogers”; “Buck Rogers in the 25<sup>th</sup> Century: The Western Publishing Years”; “Buck Rogers 25<sup>th</sup> Century A.D.”; “Buck Rogers in the 25<sup>th</sup> Century: the complete newspaper dailies” (in numerous volumes); “Buck Rogers in the 25<sup>th</sup> Century: the complete Sundays”; and “Buck Rogers in the 25<sup>th</sup> Century: The Dailies and Sundays 1979-1980.”<sup>17</sup> However, with the exception of the first three volumes of the “complete newspaper dailies” compilation, all of these bear copyright notices dated 2010 or later; and there is no evidence to indicate that Opposer published these works at an earlier date.

The first three volumes of “Buck Rogers in the 25<sup>th</sup> Century: the complete newspaper dailies” bear copyright notices reading “Copyright © 2009 The Dille Family Trust, reprinted with permission.” These notices have limited evidentiary weight. At best, they are hearsay statements to the effect that the works were first published in 2009. *See* 17 U.S.C. § 401(b)(2). In any event, even if we consider these notices as evidence that the works were published in 2009, we have no way of knowing whether they were published before or after January 15 of that year. There

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<sup>17</sup> Geer Exhibit 19, 41 TTABVUE 3-69.

is no testimony or other evidence on this point. We have given due consideration to the copyright notice at 41 TTABVUE 15, which reads as follows:

*Buck Rogers and Buck Rogers in the 25<sup>th</sup> Century*® © 1964, 1979-80 and 2013 Dille Family Trust. ...

**Dates of original publication:** Buck Rogers #2, August, 1979; #3, September, 1979; #4, October, 1979; #5, December, 1979; #6, February 1980; #7, April, 1980; and #1, 1964.

The assertion of dates of publication in a copyright notice is hearsay and cannot be accepted for the truth of the matter asserted. There is no evidence of record to show that Opposer issued the publications of 1964 and 1979-80 mentioned in the notice; nor is there any evidence to suggest that any person or entity related to Opposer had rights in the BUCK ROGERS mark as of those dates. Indeed, nothing connects Opposer to the mark prior to 1982 (the date that Robert C. Dille purported to transfer the mark BUCK ROGERS to Opposer).<sup>18</sup> Although the record does show substantial activity by Opposer under various BUCK ROGERS marks beginning in 2009, the record does not prove any such trademark use prior to Applicant's filing date of January 15, 2009.

We have given due consideration to the testimony of Louise Geer, Opposer's current trustee, who was appointed in 2011. She testified, for example:

The Dille Family Trust has used this mark continuously since – well, at least 1929 and when they started with the memorandum of agreement, and then they started the newspaper strip. They've done movies, they did all kinds of paraphernalia, sales, et cetera, over the years.<sup>19</sup>

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<sup>18</sup> 40 TTABVUE 164-165.

<sup>19</sup> Geer 27:8-14, 40 TTABVUE 29.

On this point, we find Ms. Geer's testimony to be unclear. The record does not support the suggestion that The Dille Family Trust even existed in 1929; rather, documents of record indicate that the trust was created in 1979.<sup>20</sup> Where a party seeks to establish its priority by means of the testimony of a single witness, the testimony must be "clear, convincing, consistent and sufficiently circumstantial to convince the trier of facts of its probative value," and "not characterized by inconsistencies, contradictions and indefiniteness." *H. Betti Industries, Inc. v. Brunswick Corporation*, 211 USPQ 1188, 1197 (TTAB 1981); *see also Powermatics, Inc. v. Globe Roofing Products Co.*, 341 F.2d 127, 144 USPQ 430, 432 (CCPA 1965); *Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana Inc.*, 98 USPQ2d 1921, 1931 (TTAB 2011). However, Ms. Geer's testimony is inconsistent with other evidence of record. For example, her testimony refers to certain agreements purportedly involving Opposer, while the documents of record indicate that Opposer was not a party.<sup>21</sup>

Opposer's evidence indicates that the process of producing the BUCK ROGERS publications of 2009 through 2013 began prior to the filing of Applicant's application; however, that contention is supported by only a single page of evidence: the first page of an agreement between Opposer and Herman and Geer

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<sup>20</sup> *See, e.g.*, Geer Exhibit 33, 40 TTABVUE 122 (referring to "the trust instrument dated August 16, 1979").

<sup>21</sup> *See, e.g.*, Geer 21:13-21; 28:1-12, 40 TTABVUE 23, 30; *compare* Geer Exhibit 6, agreement of January 11, 1936 between Universal Pictures Company, Inc. and John F. Dille Co., 40 TTABVUE 109-110; and Exhibit 13, agreement of May 12, 1977 between Universal Television and Leisure Concepts, Inc., 40 TTABVUE 117-118.

Communications.<sup>22</sup> The agreement appears to relate to Opposer's intention to grant "a non-exclusive license to publish the entire newspaper strip run of Buck Rogers in the 25<sup>th</sup> Century ..." At the top of the page is the date "3/16/2008," and Opposer's witness stated that the agreement was dated March 16, 2008.<sup>23</sup> The act of entering into such an agreement is not use of a trademark; but we have considered whether it indicates the kind of use analogous to trademark use that would be sufficient to give rise to proprietary rights. We find that it does not. "Before a prior use becomes an analogous use sufficient to create proprietary rights, the [plaintiff] must show prior use sufficient to create an association in the minds of the purchasing public between the mark and the [plaintiff's] goods. ... [T]he activities claimed to create such an association must reasonably be expected to have a substantial impact on the purchasing public ..." *Herbko International Inc. v. Kappa Books Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002). This single page, relating to a single contemplated transaction within the publishing trade, can tell us nothing about any impact on the minds of the purchasing public.

The one other piece of evidence that involves Opposer and is dated prior to Applicant's filing date is the front page of a Memorandum of Agreement dated as of October 31, 1996 between Walt Disney Pictures and Opposer.<sup>24</sup> To the extent that we can surmise, the contemplated agreement appears to grant to Disney "the exclusive and irrevocable option ('Option') to acquire all right, title and interest ...

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<sup>22</sup> Geer Exhibit 19, 41 TTABVUE 2.

<sup>23</sup> Geer 31:3-6, 40 TTABVUE 33.

<sup>24</sup> Geer Exhibit 14, 40 TTABVUE 119.

including, without limitation, the exclusive motion picture, television, digital television, video and computer games, videocassette, video and laser disc, computer assisted media (including but not limited to CD-ROM,” [the page ends here]. The Preamble refers to rights in and to

the comic book character “BUCK ROGERS” owned by Owner and any and all publications and radio programs based thereon (collectively referred to as the “Property”) in connection with a proposed motion picture based thereon tentatively entitled “BUCK ROGERS” (the “Picture”).

This document makes no mention of any trademark. In any event, it does not demonstrate that either Opposer or Disney ever used a BUCK ROGERS trademark on any product. Accordingly, it does not demonstrate trademark rights, much less that Opposer has prior rights in the mark BUCK ROGERS.

Finally, the record contains a number of “deal memos” relating to product licenses. However, they bear dates from May 5, 2010 through September 23, 2013.<sup>25</sup> Accordingly, they cannot prove use of the BUCK ROGERS mark by Opposer prior to January of 2009.

After careful review of all of the evidence of record, we find that Opposer has failed to demonstrate proprietary rights in the BUCK ROGERS designation prior to Applicant’s filing date. *See Otto Roth & Co., v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981); *see also* 15 U.S.C § 1052(d). On this record, Opposer’s claim under Section 2(d) must therefore fail, and we need not consider the other elements of Opposer’s claim of likelihood of confusion.

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<sup>25</sup> Geer Exhibits 51, 34, 36, 37, 39, 40, 42, 43, 53, 40 TTABVUE 139-155.

IV. Opposer's claim under Section 43(c).

We turn now to Opposer's claim of dilution under Section 43(c). Applicant filed its application under Trademark Act Section 1(b), on the basis of its intent to use its mark. Where such an application is opposed, an essential element of a dilution claim is a demonstration that the opposer's mark became famous prior to the filing date of the application. *Midwestern Pet Foods Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1439, *citing Toro Co. v. ToroHead Inc.*, 61 U.S.P.Q.2d 1164, 1174 (TTAB 2001); *see also* 15 U.S.C. 1125(c). Inasmuch as Opposer cannot demonstrate its proprietary interest in the asserted mark prior to Applicant's filing date, as demonstrated above, Opposer cannot make the necessary showing of fame as of an appropriate time, and its claim of dilution must fail.

**Decision:** The opposition is dismissed as to both asserted grounds, Trademark Act Sections 2(d) and 43(c).