

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: August 17, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

DC Comics
v.
Deanna Rivetti

Opposition No. 91219851

James D. Weinberger of Fross Zelnick Lehrman & Zissu PC,
for DC Comics.

David Barlavi of the Law Office of David Barlavi,
for Deanna Rivetti.

Before Bergsman, Masiello and Pologeorgis,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Deanna Rivetti (“Applicant”) seeks registration on the Principal Register of the mark SUPER WOMAN OF REAL ESTATE (in standard characters) for “real estate procurement for others,” in Class 36.¹ Applicant disclaimed the exclusive right to use the term “Real Estate.”

¹ Application Serial No. 86240703 was filed on April 2, 2014, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1052(a), based upon Applicant’s claim of first use anywhere and use in commerce since at least as early as August 2, 2011.

DC Comics (“Opposer”) filed a Notice of Opposition against the registration of Applicant’s mark on the ground of likelihood of confusion and dilution by blurring pursuant to Sections 2(d) and 43(c) of the Trademark Act, 15 U.S.C. §§ 1052(d) and 1125(c). Opposer pleaded ownership of, *inter alia*, the registered trademarks listed below:

- Registration No. 1181536 for the mark SUPERMAN (typed drawing form) for “entertainment services – namely, series of motion pictures, television programs, animated cartoon films,” in Class 41;²

- Registration No. 1216976 for the mark SUPERMAN (typed drawing form) for “advertising and promotional services – namely, creating advertising for others incorporating comic strip materials,” in Class 35;³

- Registration No. 1218552 for the mark SUPERMAN (stylized), shown below, for “advertising and promotional services – namely, creative advertising for others incorporating comic strip materials, licensing use of comic strip characters for promotional purposes, and providing promotional services in connection with these licenses,” in Class 35;⁴ and



² Registered December 8, 1991; second renewal.

³ Registered November 16, 1982; second renewal.

⁴ Registered November 30, 1982; second renewal.

- Registration No. 3784483 for the mark SUPERWOMAN (standard characters) for “action figures and accessories therefor,” in Class 28.⁵

In addition, Opposer alleged common law use of the SUPERMAN, SUPERGIRL, and SUPERWOMAN trademarks, and “the appearance of Superman in his blue bodysuit (and the appearance of SUPERGIRL in her blue top) with the letter ‘S’ inside a five-sided shield on the chest and red cape” in connection with “literary and entertainment works” and “various goods and services.”⁶

Applicant, in her Answer, made the following admissions:

- Opposer “has created and published highly successful and well-known characters, including Superman, Superwoman”;⁷

- “Due to Opposer’s extraordinary nurturing of the Superman mythos, the character and his universe have captured popular imagination, and it is beyond dispute that today the Superman lore is one of a rarefied group of legends known and loved throughout the world.”;⁸

- “Superman has become associated with certain symbols and indicia which, in the public mind, are inextricably linked with the Superman character and which function as trademarks, both for literary and entertainment works featuring Superman and related characters and for various goods and services for which

⁵ Registered May 4, 2010; Sections 8 and 15 affidavits accepted and acknowledged.

⁶ Notice of Opposition ¶3 (1 TTABVUE 8).

⁷ Notice of Opposition ¶1 (1 TTABVUE 7) and Answer ¶1 (9 TTABVUE 2).

⁸ Notice of Opposition ¶2 (1 TTABVUE 8) and Answer ¶2 (9 TTABVUE 2).

Opposer has licensed others to use these marks,” including SUPERMAN, SUPERWOMAN, “and the appearance of Superman in his blue bodysuit ... with the letter ‘S’ inside a five-sided shield on the chest and a red cape.”;⁹

- Opposer has use prior to any date upon which Applicant may rely in connection with Opposer’s marks SUPERMAN, SUPERWOMAN, and the appearance of Superman in his blue bodysuit with the letter “S” inside a five-sided shield on the chest and a red cape;¹⁰

- Opposer’s marks SUPERMAN, SUPERWOMAN and the appearance of Superman in his blue bodysuit with the letter “S” inside a five-sided shield on the chest and a red cape have become famous marks and became famous prior to any date upon which Applicant may rely;¹¹ and

- Opposer’s ownership of and current status to its pleaded registrations.¹²

Applicant denied the remaining allegations in the Notice of Opposition.

I. Preliminary Issues.

A. Applicant’s statement of “Substantive Arguments in Favor of Application,” with attached exhibits.

Applicant, in her Answer, included a statement of “Substantive Arguments in Favor of Application,” with attached exhibits.¹³ Applicant should not, in her answer,

⁹ Notice of Opposition ¶3 (1 TTABVUE 8) and Answer ¶3 (9 TTABVUE 2).

¹⁰ Notice of Opposition ¶4 (1 TTABVUE 8-9) and Answer ¶4 (9 TTABVUE 2); *see also* Notice of Opposition ¶¶ 11 and 12 (1 TTABVUE 12) and Answer ¶¶11 and 12 (9 TTABVUE 4).

¹¹ Notice of Opposition ¶6 (1 TTABVUE 9) and Answer ¶6 (9 TTABVUE 3).

¹² Notice of Opposition ¶7 (1 TTABVUE 9-11) and Answer ¶7 (9 TTABVUE 3).

¹³ Answer p. 6 (9 TTABVUE 7).

argue the merits of the allegations in the complaint but rather should state, as to each of the allegations contained in the complaint, that the allegation is either admitted or denied. Trademark Rule 2.106(b)(2), 37 C.F.R. § 2.106(b)(2); Fed. R. Civ. P. 8(b). However, an answer may include a short and plain statement of any defenses, including affirmative defenses that Applicant may have to the claim or claims asserted by Opposer.¹⁴ Also, evidentiary matters upon which Applicant intends to rely should not be included in an answer. They are matters for proof, not for pleading.¹⁵

Applicant's statement of "Substantive Arguments in Favor of Application" is an amplification of why Applicant believes that there is no likelihood of confusion. She does not present any defenses or affirmative defenses.

The exhibits attached to Applicant's Answer may not be considered. *See* Trademark Rule 2.122(c), 37 C.F.R. § 2.122(c) ("an exhibit attached to a pleading is not evidence on behalf of the party to whose pleading the exhibit is attached, and must be identified and introduced in evidence as an exhibit during the period for the taking of testimony.").

Finally, in the "Substantive Arguments in Favor of Application," Applicant reviews her settlement discussions with Opposer to show that the parties had reached a preliminary agreement to resolve their trademark issues. Pursuant to Fed. R. Evid.

¹⁴ Trademark Rule 2.106(b)(2); 37 C.F.R. § 2.106(b)(2); Fed. R. Civ. P. 8(b).

¹⁵ *See McCormick & Co. v. Hygrade Food Prods. Corp.*, 124 USPQ 16, 17 (TTAB 1959) ("while applicant may in due course introduce any evidence which it considers to be relevant to its case, statements as to proposed evidence are not proper matters for pleading.").

408, statements made in settlement negotiations are not admissible to prove or disprove a claim. Accordingly, we do not consider Applicant's statements regarding settlement negotiations.

B. Opposer's Brief exceeds the page limits.

Trademark Rule 2.128(b), 37 C.F.R. § 2.128(b), provides that Opposer's main brief "shall not exceed fifty-five pages in length in its entirety, including ... description of the record. ... Any brief beyond the page limits and any brief with attachments outside the stated requirements may not be considered by the Board." The only subject that will be considered in an appendix to the brief is a statement of objections. *Id.* Because Opposer's brief is 92 pages consisting in part of a 37 page appendix describing the record, Opposer's brief exceeds the page limit without prior leave of the Board, we have not considered Opposer's brief.

C. Final decision remand to Examining Attorney.

Trademark Rule 2.131, 37 C.F.R. § 2.131, provides for a remand to the Trademark Examining Attorney.

If, during an inter partes proceeding involving an application under section 1 or 44 of the Act, facts are disclosed which appear to render the mark unregistrable, but such matter has been tried under the pleadings as filed by the parties or as they might be deemed to be amended under Rule 15(b) of the Federal Rules of Civil Procedure to conform to the evidence, the Trademark Trial and Appeal Board, in lieu of determining the matter in the decision on the proceeding, may remand the application to the trademark examining attorney for reexamination in the event the applicant ultimately prevails in the inter partes proceeding. Upon remand, the trademark examining attorney shall reexamine the application in light of the matter referenced by the Board. If, upon reexamination,

the trademark examining attorney finally refuses registration to the applicant, an appeal may be taken as provided by §§ 2.141 and 2.142.

Trademark Rule 2.131, 37 C.F.R. § 2.131.

As noted above, the mark sought to be registered is SUPER WOMAN OF REAL ESTATE. Neither the original specimen of record, nor the substitute specimen, displays the mark sought to be registered. To be clear, neither specimen includes SUPER WOMAN OF REAL ESTATE. Accordingly, if Applicant ultimately prevails in this case, we recommend, pursuant to Trademark Rule 2.131, the Examining Attorney reexamine the application with respect to this issue.

II. The Record.

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), Applicant's application file. Because Opposer attached to its Notice of Opposition copies of its pleaded registrations printed from the USPTO electronic database showing the current status and title to its registrations, those registrations are also of record. *See* Trademark Rule 2.122(d)(1), 37 C.F.R. § 2.122(d)(1).

Only Opposer introduced testimony and evidence. Opposer's testimony and evidence are set forth below:

A. Notice of reliance on Applicant's responses to Opposer's interrogatories;¹⁶

B. Notice of reliance on the prosecution files for Opposer's pleaded registrations;¹⁷

¹⁶ 22 TTABVUE.

¹⁷ 23 and 29 TTABVUE.

- C. Notice of reliance on printed publications purportedly to show the history, development, notoriety, strength and fame of Opposer's SUPERMAN and SUPER-formative marks;¹⁸
- D. Notice of reliance on excerpts from websites purportedly to show the history, development, notoriety, strength and fame of Opposer's SUPERMAN and SUPER-formative marks;¹⁹
- E. Notice of reliance on printed publications purportedly to show the history, development, notoriety, strength and fame of Opposer's SUPERMAN and SUPER-formative marks;²⁰
- F. Testimony deposition of Michael Gibbs, Senior Vice President of Fast Moving Consumer Goods for Warner Brothers Entertainment, a division of Warner Brothers Consumer Products, Inc., the licensing agent for Opposer, with attached exhibits.²¹

III. Standing

Standing is a threshold issue that must be proven by the plaintiff in every *inter partes* case. Any person who believes it is or will be damaged by registration of a mark has standing to file an opposition. Trademark Act Section 13, 15 U.S.C. § 1063. Our

¹⁸ 24 and 25 TTABVUE.

¹⁹ 26 and 27 TTABVUE.

²⁰ 28 TTABVUE.

²¹ 31-34 TTABVUE. The Gibbs deposition was designated as confidential. The entire deposition is not of a confidential character. Pursuant to Trademark Rule 2.116(g), 37 C.F.R. § 2.166(g), "[t]he Board may treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party."

primary reviewing court has enunciated a liberal threshold for determining standing, namely that a plaintiff must demonstrate that it possesses a “real interest” in a proceeding beyond that of a mere intermeddler, and “a reasonable basis for his belief of damage.” *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014) (quotation omitted), *cert. denied*, 135 S. Ct. 1401 (2015). A “real interest” is a “direct and personal stake” in the outcome of the proceeding. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1026 (Fed. Cir. 1999).

In light of its pleaded ground of likelihood of confusion, Opposer's introduction of its pleaded registrations adequately establishes its interest in this proceeding and a reasonable basis for its belief that damage would result from registration of Applicant's mark. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). Having established its standing with respect to its likelihood of confusion claim, Opposer need not separately show its standing to assert its claim of dilution. *See, e.g., Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1727-28 (Fed. Cir. 2012) (“Coach”) (“once an opposer meets the requirements for standing, it can rely on any of the statutory grounds for opposition set forth in 15 U.S.C. § 1052.”); *Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1820 (TTAB 2015).

IV. Dilution

Dilution by blurring is “association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.” Section 43(c)(2)(B) of the Trademark Act, 15 U.S.C. § 1125(c)(2)(B). Dilution may be likely “regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.” Section 43(c)(1) of the Trademark Act, 15 U.S.C. § 1125(c)(1).

Our primary reviewing court, the Court of Appeals for the Federal Circuit, has set forth the following four elements a plaintiff must prove in a Board proceeding in order to prevail on a claim of dilution by blurring:

- (1) [the plaintiff] owns a famous mark that is distinctive;
- (2) the defendant is using a mark in commerce that allegedly dilutes the plaintiff's famous mark;
- (3) the defendant's use of its mark began after the plaintiff's mark became famous; and
- (4) the defendant's use of its mark is likely to cause dilution by blurring or by tarnishment.

Coach, 101 USPQ2d at 1723-24.

- A. The fame of Opposer's marks and whether such fame was acquired prior to Applicant's first use of her involved mark.

Based upon Applicant's admission that (i) “the Superman lore is one of a rarefied group of legends known and loved throughout the world” and (ii) “Opposer's marks have become famous marks and became famous prior to any date upon which Applicant can rely,” we find that Opposer's marks SUPERMAN, SUPERWOMAN and the appearance of Superman in his blue bodysuit with the letter “S” inside a five-

sided shield on the chest and a red cape are famous marks for purposes of dilution and that those marks became famous prior to any date upon which Applicant may rely.²² Opposer has therefore satisfied the first and third dilution elements.

B. Applicant's use of her mark in commerce.

The second dilution element Opposer must establish is that Applicant is using her allegedly diluting mark in commerce. An opposer asserting a dilution claim in a Board proceeding against an application based on an allegation of actual use in commerce pursuant to Section 1(a) of the Trademark Act, 15 U.S.C. § 1052(a), may prove applicant's use in commerce by direct evidence or rely on the application filing date as the date of constructive use. *See Chanel, Inc. v. Makarczyk*, 110 USPQ2d 2013, 2023 (TTAB 2014); *see also Omega SA (Omega AG) (Omega Ltd.) v. Alpha Phi Omega*, 118 USPQ2d 1289, 1295 (TTAB 2016). In this case, we have the application filing date and Applicant's statement introduced by Opposer that Applicant "started using the mark in July 2011 on Facebook, and has continuously used it since."²³

We therefore find that Opposer has satisfied the second dilution element.

C. Whether Applicant's mark is likely to cause dilution?

The final element of our dilution analysis assesses whether Applicant's mark is likely to dilute Opposer's marks. As noted *supra*, dilution by blurring occurs when a substantial percentage of consumers, on seeing the junior party's use of a mark in connection with her services, are immediately reminded of the famous mark and

²² Applicant, in her brief, did not contest that Opposer's marks are famous for purposes of dilution.

²³ Applicant's response to Opposer's Interrogatory No. 4 (22 TTABVUE 4).

associate the junior party's use with the owner of the famous mark, even if they do not believe that the services emanate from the famous mark's owner. *N.Y. Yankees P'ship v. IET Prods. & Servs., Inc.*, 114 USPQ2d 1497, 1506 (TTAB 2015) (citing *UMG Recordings Inc. v. Mattel Inc.*, 100 USPQ2d 1868, 1888 (TTAB 2011) and *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1183 (TTAB 2001)).

The Trademark Act enumerates six non-exhaustive factors a tribunal may consider in determining whether a mark is likely to cause dilution by blurring:

- (i) The degree of similarity between the mark or trade name and the famous mark;
- (ii) The degree of inherent or acquired distinctiveness of the famous mark;
- (ii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark;
- (iv) The degree of recognition of the famous mark;
- (v) Whether the user of the mark or trade name intended to create an association with the famous mark; and
- (vi) Any actual association between the mark or trade name and the famous mark.

Section 43(c)(B)(i)-(vi) of the Trademark Act, 15 U.S.C. § 1125(c)(B)(i)-(vi).

1. The degree of similarity between Applicant's mark and Opposer's famous marks.

The Board noted in *National Pork Board v. Supreme Lobster & Seafood Co.*, 96 USPQ2d 1479, 1497 (TTAB 2010), that,

after finding in the affirmative on the question of pre-existing fame, an important question in a dilution case is whether the two involved marks are sufficiently similar to

trigger consumers to conjure up a famous mark when confronted with the second mark.

While we are not conducting a Section 2(d) likelihood of confusion analysis under this factor for dilution by blurring, we still consider the degree of similarity or dissimilarity of the marks in their entireties as to appearance, connotation, and commercial impression. *N.Y. Yankees P'ship v. IET Prods. & Servs., Inc.*, 114 USPQ2d at 1506; *Research in Motion Ltd. v. Defining Presence Marketing Group Inc.*, 102 USPQ2d 1187, 1198 (TTAB 2012). We consider the marks in terms of whether they are sufficiently similar in their overall commercial impressions that the required association exists. *N.Y. Yankees P'ship v. IET Prods. & Servs., Inc.*, 114 USPQ2d at 1506; *Nike Inc. v. Maher*, 100 USPQ2d 1018, 1030 (TTAB 2011).

Applicant is seeking to register SUPER WOMAN OF REAL ESTATE in standard characters. Examples of how Applicant uses her mark are set forth below:

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²⁴ 26 TTABVUE 343 (October 30, 2014).



Opposer has used SUPERMAN and the appearance of Superman in his blue bodysuit with the letter “S” inside a five-sided shield on the chest and a red cape. Opposer’s marks are displayed below:²⁶

²⁵ 26 TTABVUE 355.

²⁶ Opposer’s marks are displayed in a specimen showing the marks in a combined Renewal Application and Declaration of Use for Registration No. 1218552 for the mark SUPERMAN (stylized), for “advertising and promotional services – namely, creative advertising for others incorporating comic strip materials, licensing use of comic strip characters for promotional purposes, and providing promotional services in connection with these licenses,” in Class 35. (23 TTABVUE 140).



Based on the manner in which Applicant has used her mark, the overall similarity of the marks is immediately apparent. Applicant's trade dress shows that Applicant's mark projects a similar, if not identical, commercial impression as that engendered by Opposer's marks. In fact, Applicant stated that "[s]everal times a month since July 2011 ... clients, other agents, brokers, and prospective clients"²⁷ have "referred directly or indirectly to Opposer, Opposer's Superman, Supergirl or Super Woman characters, or Opposer's Marks in connection with Applicant's Mark."²⁸

As our primary reviewing court has stated:

Ordinarily, for a word mark we do not look to the trade dress, which can be changed at any time. *Vornado, Inc. v. Breuer Electric Mfg. Co.*, 390 F.2d 724, 156 USPQ 340, 342 (CCPA 1968). But the trade dress may nevertheless provide evidence of whether the word mark projects a confusingly similar commercial impression.

Kenner Parker Toys Inc. v. Rose Art Indus. Inc., 963 F.2d 350, 22 USPQ2d 1453, 1458 (Fed. Cir. 1992); *see also Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 223 USPQ 1281, 1284 (Fed. Cir. 1984) ("Applicant's labels support rather than negate that of which opposer complains: that SPICE VALLEY inherently creates a

²⁷ Applicant's response to Opposer's Interrogatory No. 19 (22 TTABVUE 6).

²⁸ Opposer's Interrogatory No. 19 (22 TTABVUE 16).

commercial impression which is confusingly similar to that of SPICE ISLANDS.”); *American Rice, Inc. v. H.I.T. Corp.*, 231 USPQ 793, 796 (TTAB 1986) (“we may take into account whether the trade dress of packages or labels in the application file as specimens, or otherwise in evidence, may demonstrate that the trademark projects a confusingly similar commercial impression.”); *Northwestern Golf Co. v. Acushnet Co.*, 226 USPQ 240, 244 (TTAB 1985) (“Evidence of the context in which a particular mark is used on labels, packaging, etc., or in advertising is probative of the significance which the mark is likely to project to purchasers.”).

We find that Applicant’s mark is sufficiently similar to Opposer’s marks to “trigger consumers to conjure up” Opposer’s famous marks. That is, consumers encountering Applicant’s mark will immediately be reminded of Opposer’s famous SUPERMAN mark and the appearance of Superman in his blue bodysuit with the letter “S” inside a five-sided shield on the chest and a red cape and associate them.

2. The degree of inherent or acquired distinctiveness of Opposer’s marks.

Opposer’s marks are inherently distinctive. Moreover, Applicant has admitted that Opposer’s marks are famous, which necessarily subsumes a finding that the marks have acquired distinctiveness.

3. The extent to which Opposer is engaging in substantially exclusive use of its marks.

There is no evidence in the record of any third-party use of a word mark similar to SUPERMAN or of the appearance of Superman in his blue bodysuit with the letter “S” inside a five-sided shield on the chest and a red cape.

4. The degree of recognition of the Opposer's marks.

Applicant, in her Answer, has admitted that “it is beyond dispute that today the Superman lore is one of a rarefied group of legends known and loved throughout the world.”²⁹ In addition, the recognition of SUPERMAN has been reported in various news media. For example,

- A Cable News Network (“CNN”) wire story (December 30, 2011), *The Union Leader* (December 4, 2011), *The Chronicle of Higher Education* (November 20, 2011), and *The New York Post* (October 9, 2011) referred to Superman as an “iconic” character;³⁰

- The *Telegraph Herald* (Dubuque, Iowa) (December 17, 2006) referred to Superman as a “household name.”³¹

- *The Washington Times* (December 15, 2011) referred to Superman as “DC Comics’ famed superhero”;³²

- *Advertising Age* (November 2011) printed the following passage:

You don’t tug on Superman’s cape, Jim Croce told us in a popular song. That’s probably good advice—a character like the Man of Steel is worth millions of dollars in licensing, merchandise and movies.³³

²⁹ Notice of Opposition ¶2 (1 TTABVUE 8); Applicant’s Answer (9 TTABVUE 2).

³⁰ 28 TTABVUE 25 at 28; 28 TTABVUE 69 at 70; 28 TTABVUE 86 at 87; 28 TTABVUE 142 at 143.

³¹ 28 TTABVUE 481.

³² 28 TTABVUE 49 at 50.

³³ 28 TTABVUE 79.

- The *Chattanooga Times Free Press* (December 28, 2006) reports that “Superman, Wonder Woman and the Incredible Hulk top the list of most requested stamps at area U.S. Postal Service offices”;³⁴

- The *Star-Gazette* (Elmira, New York) (December 21, 2006) reports

In today’s world, people need a Superman and a Spider-Man just as much as they need Santa Claus. As actor Marlon Brando, when asked about his work on “Superman: The Motion Picture,” said, “We must preserve the myth.”³⁵

The SUPERMAN media references corroborate Opposer’s internal market research for familiarity and general awareness in which SUPERMAN scores very high.³⁶

This renown has translated into substantial licensing revenues. Michael Gibbs, Senior Vice President of Fast Moving Consumer Goods, and formerly the Senior Vice President of Licensing and Business Development, for Warner Brothers Entertainment, a division of Warner Brothers Consumer Products, Inc., the licensing agent for Opposer, testified that BATMAN and SUPERMAN are Opposer’s “strongest properties in terms of revenue[,] familiarity, reach, size and scope of our overall licensing programs in terms of amount of licensees and the amount of products that

³⁴ 28 TTABVUE 477.

³⁵ 28 TTABVUE 480 at 481.

³⁶ Gibbs Dep., pp 52-56 and Exhibit 11 (31 TTABVUE 55-59 and 32 TTABVUE 353-626), Opposer’s market research has been designated confidential and, therefore, we may refer to it only in general terms.

we develop.”³⁷ SUPERMAN is licensed across all major product categories.³⁸ Opposer has licensed Superman for movies in the 1970s, 2006 and 2013, television shows, including *Smallville* and *Lois and Clark*, the Lego Superheroes video game, and a SUPERGIRL television show.³⁹ The revenues generated through Opposer’s licensing program is substantial.⁴⁰

We find that SUPERMAN and the appearance of Superman in his blue bodysuit with the letter “S” inside a five-sided shield on the chest and a red cape has attracted widespread recognition and success as a source of Opposer’s goods and services.

5. Whether Applicant intended to create an association with Opposer’s marks.

Considering Applicant’s use of a blue bodysuit with the letters “SW” inside a five-sided shield on the chest and a red cape, which are extremely similar to the SUPERMAN indicia, the only possible conclusion that we can reach is that Applicant intended to create an association with Opposer’s SUPERMAN character and marks.

6. Any actual association between the mark or trade name and famous mark.

As noted above, “[s]everal times a month since July 2011 ... clients, other agents, brokers, and prospective clients”⁴¹ have “referred directly or indirectly to Opposer,

³⁷ Gibbs Dep., p. 15 (31 TTABVUE 18). BATMAN is Opposer’s biggest property followed by SUPERMAN. Gibbs Dep., p. 22 (31 TTABVUE 22).

³⁸ Gibbs Dep., p. 28-29 (31 TTABVUE 31-32).

³⁹ Gibbs Dep., pp. 16, 18, 20 (31 TTABVUE 19, 21, 23).

⁴⁰ Gibbs Dep., pp. 22-23 (31 TTABVUE 25-26). Opposer’s licensing revenues have been designated confidential and, therefore, we may refer to them only in general terms.

⁴¹ Applicant’s response to Opposer’s Interrogatory No. 19 (22 TTABVUE 6).

Opposer's Superman, Supergirl or Super Woman characters, or Opposer's Marks in connection with Applicant's Mark."⁴² Accordingly, there has been actual association between Applicant's mark and Opposer's marks.

D. Analyzing the factors.

Having considered all of the evidence properly of record, we find that the dilution by blurring factors weigh in Opposer's favor. Opposer's marks are famous and became famous before Applicant adopted her mark. The marks are sufficiently similar that an association between them is established as shown by the evidence of actual association between the marks. Opposer's marks are inherently distinctive and the degree of public recognition is high. Applicant intended to create an association with Opposer's marks, and third parties have actually associated Applicant's mark with Opposer's marks. Accordingly, we find that Applicant's mark is likely to dilute Opposer's marks.

Having determined that Opposer is entitled to prevail in this proceeding based upon its dilution claim, we need not reach Opposer's likelihood of confusion claim. *See American Paging Inc. v. American Mobilphone Inc.*, 13 USPQ2d 2036, 2039 (TTAB 1989), *aff'd unpublished*, 932 F.2d 869, 17 USPQ2d 1726 (Fed. Cir. 1990) ("Having determined that petitioner is entitled to the relief it seeks based upon its claim pursuant to Section 2(d) of the Lanham Act, we need not address petitioner's claim that registrant has abandoned its rights in the mark AMERICAN MOBILPHONE PAGING and design."). *Accord Venture Out Props. LLC. v. Wynn Resorts Holdings*

⁴² Opposer's Interrogatory No. 19 (22 TTABVUE 16).

LLC, 81 USPQ2d 1887, 1894 (TTAB 2007) (“In view of our decision finding a likelihood of confusion, we need not reach the issue of dilution.”); *Interglo AG v. Abrams/Gentile Entertainment Inc.* 63 USPQ2d 1862, 1864 (TTAB 2002) (“Having found that there exists a likelihood of confusion, we elect to sustain the opposition on this basis alone.”).

Decision: The opposition is sustained on Opposer’s claim of dilution, and registration to Applicant is refused.