

ESTTA Tracking number: **ESTTA13592**

Filing date: **08/18/2004**

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 party opposes registration of the indicated application.

Opposer Information

Name	DC COMICS
Granted to Date of previous extension	08/18/2004
Address	DC COMICS 1700 Broadway New York, NY 10019 UNITED STATES

Attorney information	PATRICK T. PERKINS FROSS ZELNICK LEHRMAN & ZISSU, P.C. 866 UNITED NATIONS PLAZA NEW YORK, NY 10017 UNITED STATES pperkins@fzlj.com Phone:212-813-5900
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Applicant Information

Application No	76533167	Publication date	04/20/2004
Opposition Filing Date	08/18/2004	Opposition Period Ends	08/18/2004
Applicant	PacNet, Inc.		

Goods/Services Affected by Opposition

Class 017. First Use: First Use In Commerce:

All goods and services in the class are opposed, namely: Adhesive tape for sealing cartons for industrial or commercial use

Attachments	KRYPTO TAPE Notice of Opposition.pdf (9 pages)
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Signature	/Patrick T. Perkins/
Name	PATRICK T. PERKINS
Date	08/18/2004

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

Our Ref.: DCC USA TC-0421009

In the matter of Application Serial No. 76/533,167
Published in the Official Gazette on April 20, 2004

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DC COMICS,	:	
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Opposer,	:	Opposition No.
	:	
- against -	:	
	:	
PACNET, Inc.,	:	
	:	
Applicant.	:	
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NOTICE OF OPPOSITION

DC Comics (“DC” or “Opposer”), a New York partnership located at 1700 Broadway, New York, New York 10019, believes that it is or will be damaged by the issuance of a registration of the trademark KRYPTO TAPE as applied for in Application S.N. 76/533,167 filed on July 28, 2003 by PACNET, Inc. (“Applicant”) for “adhesive tape for sealing cartons for industrial or commercial use” in International Class 17 and therefore opposes the same. As grounds for the opposition, Opposer, by its attorneys Fross Zelnick Lehrman & Zissu, P.C., alleges as follows:

FACTS

1. DC is a New York partnership with its principal place of business at 1700 Broadway, New York, New York 10019.
2. DC Comics and its predecessors-in-interest (collectively “DC Comics”) is the publisher of comic books and magazines featuring comic characters and stories, including the

world-famous character Superman. DC Comics is among the most well known and successful publishers of comic magazines in the world. It has created and published the highly successful and well known characters Superman, Batman, Wonder Woman, and The Flash, among others.

3. Over the many years since the Superman character was first introduced in 1938, DC Comics has focused an enormous amount of attention and effort to develop the Superman mythos, including the character, his associates, his world, and other indicia associated with him. Throughout the period of Superman's existence, DC Comics has invested a vast amount of creative energy and resources to continually update and improve the Superman property to keep the character and his adventures timely and fresh in the public's mind. Opposer's efforts in this regard have led to a vast array of literary works, television series and feature films which fully explore in great depth Superman himself and the fictional world inhabited by him. Due to Opposer's extraordinary nurturing of the Superman mythos, the character and his universe have captured the popular imagination and it is beyond dispute that today the Superman lore is one of a rarified group of legends known and loved throughout the world.

4. As has been oft repeated in DC Comics' many well-known works, while still an infant, Superman was sent by his parents to Earth aboard a space ship from his distant homeworld, Krypton, as Krypton was destroyed by cosmic forces. On Earth, Superman is secretly possessed of extraordinary physical abilities, including superhuman strength and speed, x-ray vision, super-sensitive hearing, the ability to fly, and the ability to withstand bullets, among others. In his ordinary life, Superman is a mild-mannered newspaper reporter for The Daily Planet known as Clark Kent, while in his dramatic role, Superman is a costumed heroic figure who uses his extraordinary abilities to perform great feats for the public good.

5. Shortly after his creation, DC Comics authorized the appearance of Superman in

media other than comic books. Beginning in 1940, DC Comics embarked on the aforementioned project to nurture and develop the then fledgling Superman story beyond the comic book genre. In connection therewith, Superman was featured in a regular radio program from 1940 through 1951, during the height of radio as a storytelling medium. In 1941, Superman also began to appear in a series of animated motion pictures. The first of these was nominated for an Academy Award. Then, beginning in 1948, Superman appeared in a series of live action movie serials. In the 1970's, Superman again appeared on the big screen in four major, big budget motion pictures, featuring Hollywood stars such as Marlon Brando, Christopher Reeve, and Gene Hackman.

6. Superman has also widely appeared on television. In 1953, the live action television series The Adventures of Superman began running and, due to its extreme popularity, 104 episodes were created and broadcast. The Adventures of Superman is today considered a television classic and has rarely been "off the air" since its premiere in 1953, appearing since that time in syndication on the schedule of numerous U.S. television stations. Beginning in 1991, the major cable television network NICKELODEON, began broadcasting episodes of The Adventures of Superman nightly as part of its NICK-AT-NITE service.

7. In 1966, Superman appeared in his first animated television cartoon series, entitled The New Adventures of Superman. This series ran for many years and individual episodes were re-broadcast in subsequent animated series, such as The Superman-Aquaman Hour and The Batman-Superman Hour, until 1984. Superman also appeared in numerous other animated television series including Super Friends, which ran from 1973 to 1986, Superman, which ran in 1988, and Superman: The Animated Series which premiered in September 1996. Superman: The Animated Series continues to be broadcast on the WB Kids! television network.

8. In the early 1990's, the American Broadcasting Company ("ABC") produced a new Superman television series, Lois & Clark: The New Adventures of Superman, which first aired in 1993.

9. In the fall of 2001, the WB television channel began airing a new Superman television series entitled Smallville. The program has garnered excellent reviews and is highly rated.

10. Superman's appearance in each of the above media represented a broadening and reinvigoration of the character, his universe and the lore surrounding him, always under the watchful eye of DC Comics.

11. In addition to Opposer's entertainment productions featuring Superman described above, DC Comics has also achieved international publishing success with various Superman literary works. Comic books, in almost every comic book format, including periodicals, magazine serializations, albums, trade paperbacks and pocket books, have been published in approximately twenty languages in approximately forty-five countries throughout the world, all under Opposer's supervision and/or control.

12. All of the aforementioned Superman entertainment services and goods have originated with, or were sponsored or approved by, a single source, namely DC Comics.

13. Because of DC Comics' shepherding and careful development of not just the Superman character, but also of his universe and of the things and people that populate that universe, 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 for various goods and services for which Plaintiff has licensed others to use these marks. Among these indicia are Krypton, Krypto

the Superdog, and Kryptonite. Krypto was the infant Superman's pet on the planet Krypton, and was his pet also on Earth. Kryptonite, as is well-known throughout the world, is an element from Superman's home planet, Krypton. While Superman is virtually invulnerable and can withstand such things as a hail of bullets, he is helpless in the face of Kryptonite radiation.

14. Since their introduction into the Superman mythos, Krypto, Krypton, and Kryptonite and have come to be recognized as powerful symbols standing alone, and are immediately recognized as associated with and identifying the character Superman, as well as goods and services manufactured, distributed and/or licensed by or on behalf of Opposer.

15. By virtue of DC Comics' ceaseless efforts to develop the Superman character and his universe, including the introduction and continuing use of Krypto, Krypton, and Kryptonite, and in intimate association with Superman, the popularity of the Superman mythos in the Superman television series, motion pictures, and comic books and in connection with other various goods and services, and the enormous affect and goodwill associated by the public therewith, Krypton, Kryptonite, and Krypto have become famous and instantly call to mind Superman and such goods and products to consumers.

16. Opposer owns the following valid and subsisting federal trademark registrations for KRYPTO and KRYPTO THE SUPERDOG, respectively: No. 1,168,308 for features of comic magazines in International Class 16 and No. 1,216,674 for periodical section in a comic magazine.

17. Opposer owns valid and subsisting federal trademark registration No. 1,246,353 for KRYPTON CHRONICLES for comic magazines in Class 16. This registration has become incontestable pursuant to Section 15 of the Lanham Act, 15 U.S.C. § 1065. Opposer owns valid intent-to-use application Serial No. 75/490,864 for the mark PLANET KRYPTON for a variety

toys and sporting goods in Class 28 and valid intent-to-use application Serial No. 78/123,762 for the mark PLANET KRYPTON for a variety of apparel items in Class 25.

18. Opposer owns the following valid and subsisting federal trademark registrations for the KRYPTONITE mark: Nos. 1,231,983 and 1,107,333, for clothing in International Class 25. These registrations have become incontestable pursuant to Section 15 of the Lanham Act, 15 U.S.C. § 1065. Opposer has also filed intent-to-use application Serial No. 75/489,954 for the KRYPTONITE mark in International Class 28, for use in connection with various goods including toys, action figures, electronic and board games, puzzles, and sporting goods.

19. Opposer's foregoing registrations are valid, subsisting and in full force and effect; as such, they constitute *prima facie* evidence of the validity of the registered marks and of the registrations thereof, of Opposer's ownership of the marks shown therein and of Opposer's exclusive right to use the marks in commerce in connection with the goods and services named therein, without condition or limitation; they also constitute notice to Applicant of Opposer's claim of ownership of the marks shown therein; all as provided in Sections 7(b), 22 and 33(a) of the Lanham Trademark Act of 1946 as amended (the "Lanham Act").

20. Upon information and belief Applicant is a Florida corporation. On July 28, 2003, Applicant filed Application S.N. 76/533,167 in the United States Patent and Trademark Office to register the mark KRYPTO TAPE for "adhesive tape for sealing cartons for industrial or commercial use" in Class 17.

21. Upon information and belief, Applicant applied to register KRYPTO TAPE with full knowledge of Opposer's rights in and to the KRYPTO, KRYPTON, and KRYPTONITE marks and with an intent to trade off of the good will of Opposer's marks.

22. The application, which is based upon an alleged bona fide intent to use, was filed July 28, 2003. This date, the only date upon which Applicant may rely, is long after Opposer's first use of the KRYPTO, KRYPTON, and KRYPTONITE marks and well after they became famous marks.

23. Upon information and belief, Applicant willfully copied the Opposer's marks in choosing its KRYPTO TAPE mark in a deliberate attempt to associate its goods and services with Opposer and its Superman character and the overwhelming goodwill therein.

24. Applicant's KRYPTO TAPE mark incorporates the entirety of Opposer's KRYPTO and is very similar to its KRYPTON and KRYPTONITE marks.

25. The goods listed in Applicant's application are related to goods with which Opposer has licensed some of its Superman related trademarks. In addition, Applicant's application does not limit the channels of trade through which Applicant's goods will travel nor does it limit the consumers to whom the goods are directed. Thus, Applicant's goods are presumed to travel through all channels of trade and to be directed to all relevant consumers.

26. Applicant's use of KRYPTO TAPE falsely suggests an association with or approval by Opposer of Applicant's goods, and will inevitably create confusion in the marketplace, as consumers will assume that Applicant's goods are authorized or endorsed by Opposer. Such false suggestion will cause irreparable harm to Opposer.

27. Applicant's use of KRYPTO TAPE is certain to dilute Opposer's famous marks.

FIRST GROUND FOR RELIEF
UNDER 15 U.S.C. § 1052(d)

28. Opposer incorporates by reference paragraphs 1 through 27 as if fully set forth herein.

29. The KRYPTO, KRYPTON, and KRYPTONITE marks have been used continually by Opposer since a date prior to any date on which Applicant may rely.

30. Applicant's KRYPTO TAPE mark is highly similar in appearance and in commercial impression to Opposer's KRYPTO, KRYPTON and KRYPTONITE marks.

31. The objected to goods of Applicant to be offered under its KRYPTO TAPE mark are intended and are likely to be perceived as related to Opposer's goods under the KRYPTO, KRYPTON, and/or KRYPTONITE mark and to the Superman character itself.

32. The use by Applicant of its mark for the objected to goods listed in the application is likely to create the erroneous impression that Applicant's goods originate with, are sponsored or promoted by, come from, or are otherwise associated with Opposer or Opposer's goods or services provided under the KRYPTO, KRYPTON, KRYPTONITE or other Superman-related marks or that Applicant's goods are endorsed, sponsored, or in some way connected with Opposer. Any use of KRYPTO TAPE by Applicant is, therefore, likely to cause confusion, cause mistake or to deceive the public into the belief that the goods offered under Applicant's KRYPTO mark come from or are otherwise authorized or sponsored by Opposer in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

SECOND GROUND FOR RELIEF
DILUTION UNDER 15 U.S.C. § 1125(c)

33. Opposer incorporates by reference paragraphs 1 through 32 as if fully set forth herein.

34. Opposer's KRYPTO, KRYPTON, and KRYPTONITE mark are strong and famous and have been so from a date prior to Applicant's application date.

35. Applicant's use of KRYPTO TAPE has caused and will continue to cause dilution

of the distinctive quality of Opposer's marks.

36. Applicant's use and registration of Applicant's KRYPTO TAPE mark are in violation of Section 43(c) of the Federal Trademark Act, 15 U.S.C. § 1125(c).

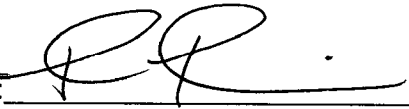
WHEREFORE, it is respectfully requested that this opposition be sustained and that the registration sought by Application S.N. 76/533,167 be denied.

Please charge the opposition fee in the amount of \$300.00 to our deposit Account No. 230825.

Dated: New York, New York
August 18, 2004

Respectfully submitted,

FROSS ZELNICK LEHRMAN
& ZISSU, P.C.

By: 
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*Attorneys for Opposer
DC Comics*