

This Opinion is Not a
Precedent of the TTAB

Mailed: March 17, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board
—

San Diego Comic Convention

v.

Erik Yacko

—
Opposition No. 91263787
—

Peter K. Hahn of Pillsbury Winthrop Shaw Pittman LLP
for San Diego Comic Convention.

Richard S. Finkelstein of RC Trademark Company LLC
for Erik Yacko.

—
Before Wellington, Dunn and Lebow, Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Erik Yacko (“Applicant”) seeks registration of the following mark:



for “conducting entertainment exhibitions in the nature of comic book and pop culture conventions,” in International Class 41.¹

San Diego Comic Convention (“Opposer”) opposes the registration of Applicant’s mark under Section 2(d) of the Trademark Act (“the Act”), 15 U.S.C. § 1052(d), on the ground that Applicant’s mark so resembles Opposer’s registered and previously-used marks containing the term COMIC-CON, it is likely to cause confusion.² In total, Opposer pleads ownership of nine registered marks,³ including the standard-character mark **COMIC-CON** for “education and entertainment services, namely, organizing and conducting conventions in the fields of animation, comic books and popular art,” in Class 41.⁴

Opposer submitted testimony and other evidence during its testimony period, and filed a brief in this case. Applicant did not take testimony or introduce any evidence during his testimony period or file a brief, but he is not required to do so. *Shenzhen*

¹ Application Serial No. 88385810, filed April 15, 2019, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on alleged first use anywhere and in commerce on December 31, 2016

² 1 TTABVUE (Notice of Opposition).

Citations to the record refer to TTABVUE, the Board’s online docketing system. Specifically, the number preceding “TTABVUE” corresponds to the docket entry number(s), and any number(s) following “TTABVUE” refer to the page number(s) of the docket entry where the cited materials appear.

³ The other registered marks are: COMIC CON INTERNATIONAL (Reg. No. 2218236); SAN DIEGO COMIC CON INTERNATIONAL (stylized with design, Reg. Nos. 3221808, 4835134, 4835135, and 4835136); ANAHEIM COMIC-CON (Reg. No. 4425806); COMIC-CON INTERNATIONAL PRESENTS WONDERCON ANAHEIM (stylized with design, Reg. No. 4854233); and LOS ANGELES COMIC-CON (Reg. No. 4856095). All registrations are based on claims of acquired distinctiveness as to the term COMIC-CON by itself or with other literal elements or with the geographic terms in marks disclaimed.

⁴ Reg. No. 3219568 issued March 20, 2007, renewed.

IVPS Tech. Co. Ltd. v. Fancy Pants Prods., LLC, 2022 USPQ2d 1035, at *4 (TTAB 2022). As plaintiff, Opposer bears the burden of proving, by a preponderance of the evidence, its entitlement to a statutory cause of action and its Section 2(d) claim. See *B&B Hardware, Inc. v. Hargis Ind., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015) (“The party opposing registration bears the burden of proof, see § 2.116(b) [37 C.F.R. § 2.116(b)], and if that burden cannot be met, the opposed mark must be registered, see 15 U.S.C. § 1063(b)”).

I. Record

The record consists of the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of Applicant’s involved application.

In addition, Opposer introduced:

- Notice of Reliance on its nine pleaded registrations;⁵
- Testimony Declaration of David Glanzer, Opposer’s Chief Communications and Strategy Officer, (“Glanzer Decl.”) and accompanying Exhibits 1-18;⁶ and
- Supplemental Declaration of David Glanzer.⁷

II. Opposer’s Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action is a requirement in every inter partes case. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837 at *3 (Fed. Cir. 2020), *cert. denied*, 142 S. Ct. 82 (2021) (citing

⁵ 9 TTABVUE.

⁶ 10 TTABVUE.

⁷ 11 TTABVUE.

Lexmark Int'l, Inc. v. Static Control Components, Inc., 572 U.S. 118, 125-26 (2014)). A party in the position of plaintiff may oppose registration of a mark when doing so is within the zone of interests protected by the statute and it has a reasonable belief in damage that would be proximately caused by registration of the mark. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at * 6-7 (Fed. Cir. 2020), *cert. denied*, 141 S.Ct. 2671 (2021) (holding that the test in *Lexmark* is met by demonstrating a real interest in opposing or cancelling a registration of a mark, which satisfies the zone-of-interests requirement, and a reasonable belief in damage by the registration of a mark, which demonstrates damage proximately caused by registration of the mark).

Here, Opposer's pleaded registrations for marks containing the term COMIC-CON, which have been properly introduced, establish that it is entitled to oppose registration of Applicant's mark on the ground of likelihood of confusion. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (registration establishes "standing").

III. Priority

Because Applicant has not counterclaimed to cancel any of Opposer's pleaded registrations, priority is not at issue with respect to these registered marks vis-à-vis Applicant's mark and goods. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

IV. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on the likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

We focus our analysis on Opposer’s registered mark mentioned above, **COMIC-CON**, in standard characters, for “education and entertainment services, namely, organizing and conducting conventions in the fields of animation, comic books and popular art” versus Applicant’s mark. If we find confusion likely between these marks, we need not consider the likelihood of confusion with Opposer’s other pleaded marks. On the other hand, if we find no likelihood of confusion between Opposer’s COMIC-CON mark and Applicant’s mark, we would not find confusion likely between Applicant’s mark and Opposer’s other pleaded marks. *In re Max Capital Grp.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

A. Relatedness of the Parties' Services; Their Trade Channels and Classes of Consumers

We now first to the *DuPont* factor involving the “similarity or dissimilarity and nature of the goods or services as described in an application or registration.” *DuPont*, 177 USPQ at 567; *see also Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). “[L]ikelihood of confusion can be found ‘if the respective goods are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.’” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (internal citations omitted). Concurrent with our relatedness of the parties’ services determination, we also assess the third *DuPont* factor involving “the similarity or dissimilarity of established, likely-to-continue trade channels,” *DuPont*, 177 USPQ at 567, and the classes of consumers to which the services are marketed. *Coach Servs.*, 101 USPQ2d at 1723 (considering together “the similarity or dissimilarity of the trade channels in which the parties’ goods are sold and the purchasers to whom the parties’ goods are marketed”).

Opposer argues that its services, as described in its registration, are “the same as” Applicant’s services, as described in the application.⁸ We agree with this assessment because a plain reading of both parties’ recitations of services reveals that each

⁸ 12 TTABVUE 30.

Opposer and Applicant render “entertainment” services in the nature of providing “conventions” in the field of “comic books.”

As to the trade channels, because Applicant’s and Opposer’s services are the same, at least in part as discussed, we must presume that the channels of trade and classes of purchasers for those services are also the same. *See In re Inn at St. John’s*, 126 USPQ2d 1742 1745 (TTAB 2018); *United Glob. Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049 (TTAB 2014); *Am. Lebanese Syrian Associated Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011). In other words, we assume that the parties’ entertainment services in the nature of comic book conventions will be advertised in all the normal trade channels for such events, and these conventions will be offered to and attended by the same class of consumers, namely, anyone from the general public with an interest in comic books.

Accordingly, the second and third *DuPont* factors strongly favor a finding of likelihood of confusion.


B. Similarity of the Marks

We turn now to the *DuPont* factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567. “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s*, 126 USPQ2d at 1746 (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. 2019); *accord Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity

in either form, spelling or sound alone is likely to cause confusion.”) (citation omitted). We also bear in mind that, when the involved marks are used in connection with the same services, “the degree of similarity necessary to support a conclusion of likely confusion declines.” *Century 21 Real Estate v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992); *see also Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018).

Here, we find the involved marks are overall very similar because the dominant



element of Applicant’s mark, , is the literal term COMICONN and this is nearly identical to Opposer’s standard-character mark, COMIC-CON. The stylized term COMICONN appears prominently in Applicant’s mark and the additional wording A SHOW FOR THE FANS BY THE FANS! appears below in significantly smaller lettering. The latter wording is a tag line, informing a consumer as to who the comic book convention services are directed to and from, but does not obviate the overall similarity between the marks resulting from Applicant’s addition of the virtually identical term as Opposer’s mark.

The fact that the first word in Applicant’s mark is nearly the same as Opposer’s registered mark results in that portion of both marks being verbalized and heard by consumers in a very similar manner. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) (finding “the identity of the marks’ two initial words is particularly significant because consumers typically notice those words first”); *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En*

1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (“Veuve” is the most prominent part of the mark VEUVE CLICQUOT because “veuve” is the first word in the mark and the first word to appear on the label); *Century 21 Real Estate Corp. v. Century Life of Am.*, 23 USPQ2d 1700 (upon encountering the marks, consumers will first notice the identical lead word).

Also, in terms of appearance, Applicant’s stylized lettering does not distinguish the marks because Opposer’s mark is registered in standard characters, and is not limited to any particular “font, style, size, or color...” Trademark Rule 2.52(a), 37 C.F.R. § 2.52(a). Opposer’s protection of its registered mark thus extends to any stylized font or color, including the same or similar style like that used by Applicant for the term COMICONN. *In re Viterra, Inc.*, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012); *In re Morinaga Nyugyo K.K.*, 120 USPQ2d 1738, 1742-43 (TTAB 2016). “[T]he argument concerning a difference in type style is not viable where one party asserts rights in no particular display.” *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983) *quoted in In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1748 (Fed. Cir. 2017).

With regard to the marks’ overall meaning, we note that the shared term COMIC-CON[N] may be understood by consumers as an abbreviation for “comic convention.” We note that Opposer’s COMIC-CON registration issued under Section 2(f) of the Trademark Act, which constitutes an admission by Opposer that COMIC-CON is not an inherently distinctive term. *See, e.g., In re RiseSmart, Inc.*, 104 USPQ2d 1931, 1932 (TTAB 2012) (citing *Yamaha Int’l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6

USPQ2d 1001, 1005 (Fed. Cir. 1988)). We further note that, during the prosecution of Applicant's application, the Examining Attorney required a disclaimer of the term COMIC-CON apart from Applicant's mark as whole, and such a disclaimer has been entered into the application file.⁹ Thus, while consumers may understand either COMIC-CON or COMICONN to reference a "comic convention" and such meaning has some inherent weakness in connection with the involved services, that same meaning is conveyed by each mark.¹⁰ Moreover, even if we find that Opposer's mark is not an inherently strong mark, it would not be fatal, as even a conceptually weak mark is entitled to protection against confusion. *See e.g., King Candy*, 182 USPQ at 109.

In sum, because the marks are overall similar in appearance, sound, meaning and commercial impression, this factor weighs in favor of finding confusion likely.

C. Commercial Strength of Opposer's Mark

The fifth *DuPont* factor examines the commercial strength and the extent to which the relevant public perceives the mark as indicating a single source of

⁹ See Office Action issued July 7, 2019 (requiring a disclaimer because the term "refers to a comic book and pop culture convention"); and Examining Attorney's Amendment issued February 13, 2020 (entering the disclaimer as agreed to by Applicant's counsel).

¹⁰ As acknowledged by the Examining Attorney during the prosecution of the application, Applicant's use of the extra N in COMICONN may be understood to "reference the fact that [Applicant's] convention is in Connecticut," (Office Action issued July 7, 2019, TSDR p. 1), but there is no evidence showing that consumers will perceive Applicant's mark in that manner. Inasmuch as Applicant did not file a brief and Opposer did not raise this issue, the possible connotation of Applicant's mark as a reference to the state of Connecticut was not argued. Moreover, because Applicant seeks registration of its mark without any geographical limitation as to its use, we must consider the possibility that the mark will be used outside of the state of Connecticut, thus reducing any likely association of the mark with the state in the minds of consumers.

origin. *DuPont*, 177 USPQ at 567; *Tea Bd. of India v. Republic of Tea, Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006). In the context of a likelihood of confusion analysis, the commercial strength of a mark is not a binary factor. Rather, it “varies along a spectrum from very strong to very weak.” *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (quoting *Palm Bay Imps.*, 73 USPQ2d at 1694).

Opposer argues that the commercial strength of its COMIC-CON mark is “high.”¹¹ In support, Opposer relies on the testimony declaration of Mr. Glanzer, its Chief Communications and Strategy Officer, who testifies, inter alia, that:

- Opposer has been using its COMIC-CON mark since 1970;¹²
- By the year 2000, the COMIC-CON convention has “grown to 48,000 people, and by 2008, the event sold out in advance and had over 125,000 attendees”¹³
- “Television networks found COMIC-CON and its enthusiastic fanbase a great place to introduce and promote new shows, new story lines, and new characters, and also a way to get feedback from the audience. TV series like *Lost*, *Battlestar Galactica*, *Heroes* and *Family Guy* have all been part of the COMIC-CON convention.”¹⁴
- “Since 2008 the convention sold out each year. By 2010, tickets to COMIC-CON sold out in an hour. Television stories or television series like *The Big Bang Theory* built story lines around obtaining those coveted COMIC-CON tickets.”¹⁵

¹¹ 12 TTABVUE 38.

¹² 10 TTABVUE (Glanzer Decl. ¶ 12).

¹³ *Id.*; ¶ 18.

¹⁴ *Id.*.

¹⁵ *Id.*; ¶ 19.

- “Television networks also began attending and we marketed to them. Examples of studios and networks and shows include Warner Brothers, Fox, Sci-fi Channel, Nickelodeon, Adult Swim, Cartoon Network, The Simpsons, Battlestar Galactica and Heroes. The studios promoting their films and shows also in effect promoted COMIC-CON. We started to get a lot more publicity and a lot more news crews taking an interest in COMIC-CON. That ended up in more people being interested in COMIC-CON, and resulted in more people wanting to buy tickets to COMIC-CON.”¹⁶
- “The reach of our Internet and social media presence is enormous. Our website has had millions of views. Our Facebook page has over 2 million followers. Our Twitter feed has over 1.6 million followers. Our Instagram has over 1.1 million followers. On TikTok #sdcc tag had in excess of 49 million views.”¹⁷
- “[T]he COMIC-CON convention was not held in 2020 and 2021. In 2020 we held a virtual convention called COMIC-CON@HOME. This virtual event was held via YouTube. The event resulted in 30.7 million impressions on the YouTube channel, 85.5 million video views, 4.9 million page views from the @Home webpage, 155,000 downloads of the Souvenir Guide and 210 million impressions on social media including affiliates.”¹⁸
- “San Diego Comic Convention receives numerous requests from major corporations and industry leaders to sponsor its COMIC-CON conventions. 2018 sponsors included Amazon Prime Video, AMC, Baby Tattoo, ComiXology (Amazon), DC, DragonBall, FOX, FX, hulu, Marvel Studios, NBC, Netflix, Nintendo, San Diego Public Library, SYFY, YouTube Originals, and Comic-Con Village. 2019 Sponsors included AMC; Baby Tattoo; ComiXology (Amazon), DC; FOX, FX Networks, Hyper X, Marvel Studios, NBC, Netflix, Nintendo, Pepsi, Amazon Prime Video, San Diego Public Library and Warner Brothers.”¹⁹

Based on the entirety of Mr. Glanzer’s testimony, along with the related exhibits attached to his declaration, it is clear that Opposer’s mark, COMIC-CON has

¹⁶ *Id.*; ¶ 43.

¹⁷ *Id.*; ¶ 46.


¹⁸ *Id.*; ¶ 47.

¹⁹ *Id.*; ¶ 62.

acquired a significant amount of popularity amongst the relevant consuming public. Particularly probative is the unsolicited media attention from television shows, like Big Bang Theory and Jeopardy, as well as the attendance by many well-known national networks that promote their own content at Opposer's COMIC-CON conventions. The attendance numbers and online social media attention that Opposer has received in connection with its COMIC-CON entertainment services further demonstrate a high degree of renown.

Accordingly, we find Opposer's COMIC-CON mark is commercially strong and entitled to a scope of protection commensurate with such strength in connection with comic book convention services. *See Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734-35 (Fed. Cir. 2017). The mark's commercial strength weighs in favor of finding a likelihood of confusion, though we must also consider the previously-discussed inherent weakness of the mark.

V. Conclusion

In view of the overall similarity of the marks,  and COMIC-CON, and weighing the inherent weakness as well as the commercial strength of Opposer's mark, we ultimately find that when these marks are used in connection with the same entertainment services and are offered in some of the same trade channels to the same class of consumers, there is a likelihood of confusion as to the source of the services.

Decision: The opposition based on likelihood of confusion is sustained.