

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed:  
July 17, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*DC Comics*  
*v.*  
*Gotham City Networking, Inc.*

—  
Opposition No. 91194716

James D. Weinberger and Leo Kittay of Fross Zelnick Lehrman & Zissu, P.C. for DC Comics.

Daniel West and David O. Klein of Klein Moynihan Turco LLP for Gotham City Networking, Inc.

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Before Taylor, Bergsman and Wolfson, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Gotham City Networking, Inc. (“Applicant”) filed two use-based applications for the marks GOTHAM BATMEN, in standard character form, and GOTHAM BATMEN and design, shown below,<sup>1</sup>

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<sup>1</sup> Serial Nos. 77669398 and 77668420, respectively, filed on consecutive days in February 2009. Applicant claimed February 1, 2006 as the date of first use of its mark anywhere and the date of first use of its mark in commerce for both classes of services in each of the applications.



both for the services set forth below:

General business networking referral services, namely, promoting the goods and services of others by passing business leads and referrals among group members, in Class 35; and

Entertainment in the nature of amateur softball games, in Class 41.

Applicant disclaimed the exclusive right to use the word “Gotham.”<sup>2</sup>

DC Comics (“Opposer”) opposed the registration of Applicant’s marks on the grounds of likelihood of confusion under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), and dilution by blurring and tarnishment under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c).<sup>3</sup> In its Second Amended Notice of Opposition, Opposer claimed ownership of the following registrations:

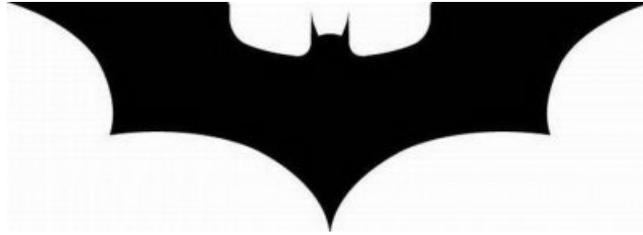
1. Registration No. 3313612 for the BATMAN logo shown below, for, *inter alia*, toys and sporting goods, in Class 28;<sup>4</sup>

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<sup>2</sup> “Gotham” is defined as “a journalistic nickname for New York City.” Dictionary.com based on the **RANDOM HOUSE DICTIONARY** (2013). Applicant’s notice of reliance Exhibit 9 (51 TTABVUE 36). Citations to the record will be to TTABVUE, the docket history system for the Trademark Trial and Appeal Board.

<sup>3</sup> Opposer also pleaded that Applicant abandoned the use of its marks for the activities in both classes 35 and 41. However, because Opposer did not pursue those claims in its brief, we consider them withdrawn. *Research in Motion Limited v. Defining Presence Marketing Group Inc.*, 102 USPQ2d 1187, 1189-90 (TTAB 2012); *Swiss Watch International Inc. v. Federation of the Swiss Watch Industry*, 101 USPQ2d 1731, 1734 n.4 (TTAB 2012).

<sup>4</sup> Registered October 16, 2007; Sections 8 and 15 affidavits accepted and acknowledged.



2. Registration No. 1221720 for the mark BATMAN, in typed drawing form, for “comic magazines,” in Class 16;<sup>5</sup>

3. Registration No. 1652640 for the mark BATMAN, in typed drawing form, for “entertainment services, namely, television and animated cartoon programs,” in Class 41;<sup>6</sup>

4. Registration No. 0856045 for the mark BATMAN, in typed drawing form, for clothing, including inter alia, t-shirts, hats, and warmup jackets, in Class 25;<sup>7</sup>

5. Registration No. 0858860 for the mark BATMAN, in typed drawing form, for toys and games, in Class 22;<sup>8</sup>

6. Registration No. 2457655 for the mark BATMAN, in typed drawing form, for “entertainment in the nature of amusement park rides,” in Class 41;<sup>9</sup>

7. Registration No. 0828412 for the mark BATMAN, in typed drawing form, for “lunch kits, vacuum bottles, combined plastic cups and straws, various types of bags for cosmetics, garments, toiletries, and the like,” in Class 2;<sup>10</sup>

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<sup>5</sup> Registered December 12, 1982; second renewal.

<sup>6</sup> Registered July 30, 1991; second renewal.

<sup>7</sup> Registered September 3, 1968; second renewal.

<sup>8</sup> Registered October 22, 1968; second renewal.

<sup>9</sup> Registered June 5, 2001; renewed.

8. Registration No. 1861233 for the mark BATMAN THE RIDE, in typed drawing form, for “entertainment in the nature of an amusement ride,” in Class 41;<sup>11</sup>

9. Registration No. 1581659 for the BATMAN logo shown below, for “tank tops, shorts, t-shirts, hats, jackets, sweat shirts, pants, pajamas, sneakers, sunvisors,” in Class 25;<sup>12</sup>



10. Registration No. 1581725 for the BATMAN logo shown below, for “flying discs, video game programs, toy doll figures, toy airplanes,” in Class 28;<sup>13</sup>



11. Registration No. 2119266 for the BATMAN logo shown below, for a variety of books and paper products, in Class 16;<sup>14</sup>

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<sup>10</sup> Registered May 9, 1967; second renewal.

<sup>11</sup> Registered November 1, 1994; renewed.

<sup>12</sup> Registered February 6, 1990; second renewal.

<sup>13</sup> Registered February 6, 1990; second renewal.

<sup>14</sup> Registered December 9, 1997; renewed.



12. Registration No. 3110604 for the BATMAN logo shown below, for a variety of books and paper products, in Class 16;<sup>15</sup>



13. Registration No. 3326043 for the BATMAN logo shown below, for a wide variety of clothing, including shirts, t-shirts and hats, in Class 25;<sup>16</sup> and



14. Registration No. 3353156 for the mark GOTHAM CITY, in typed drawing form, for “toys and sporting goods, namely, games and playthings, namely, action figures and accessories therefor; toy vehicles; dolls; equipment sold as a unit

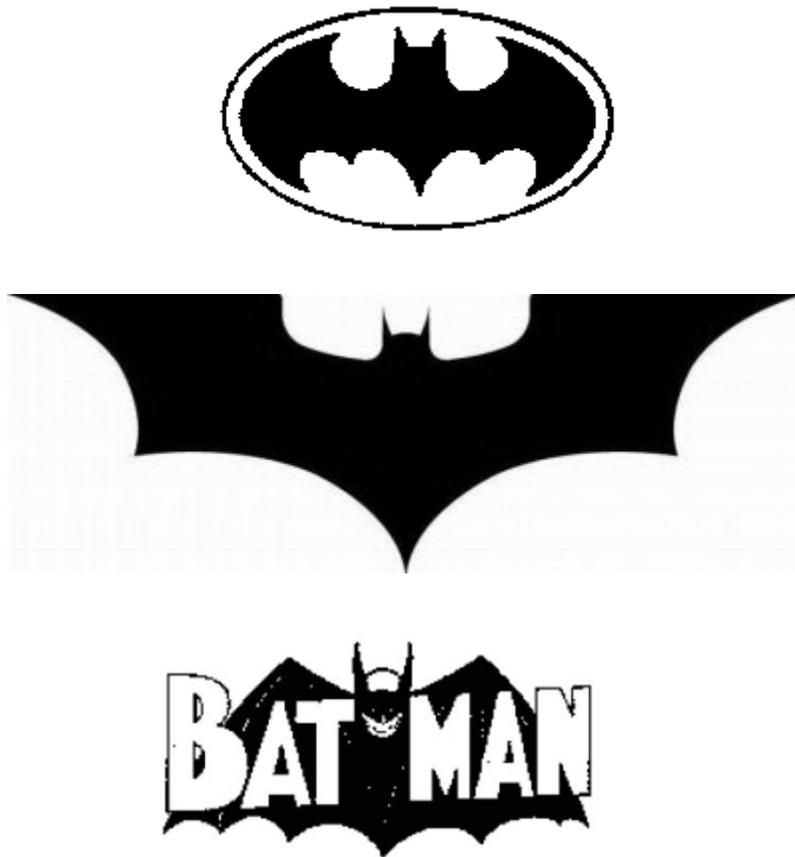
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<sup>15</sup> Registered June 27, 2006; Sections 8 and 15 affidavits accepted and acknowledged.

<sup>16</sup> Registered October 30, 2007; Sections 8 and 15 affidavits accepted and acknowledged.

for playing a board game, a manipulative game, a parlor game and an action type target game,” Class 28.<sup>17</sup>

Opposer also alleged ownership and common law use of BATMAN and composite BATMAN and GOTHAM-formative marks, and the logos set forth below for a “vast array of goods ... including but not limited to comic books, motion pictures, television shows ... baseball jerseys, baseball caps, baseballs, baseball bats, and baseball gloves.”<sup>18</sup>



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<sup>17</sup> Registered December 11, 2007; Sections 8 and 15 affidavits accepted and acknowledged.

<sup>18</sup> Second Amended Notice of Opposition ¶¶4-5 (27 TTABVUE 3-5).

Applicant, in its Amended Answer, denied the salient allegations in the Second Amended Notice of Opposition.

I. 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 files. In addition, the parties introduced the following testimony and evidence:

A. Opposer's testimony and evidence.

1. Notice of reliance on Internet documents pursuant to *Safer Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031, 1038 (TTAB 2010) purportedly to show the history, development, notoriety and fame of the BATMAN character and the BATMAN and GOTHAM marks;<sup>19</sup>

2. Two notices of reliance on printed publications pursuant to 37 CFR § 2.122(e) purportedly to show the history, development, notoriety, strength and fame of the BATMAN character and the BATMAN and GOTHAM marks;<sup>20</sup>

3. Testimony deposition of Michael Gibbs, Senior Vice President of Licensing and Business Development for Warner Brothers Consumer Products, Inc.,

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<sup>19</sup> Opposer's Exhibit Nos. 1-40 (44 TTABVUE). Opposer has relied extensively on documents printed from the Internet. Such documents are admissible only to show what has been printed, not the truth of the matter printed therein. *Safer Inc. v OMS Investments, Inc.*, 94 USPQ2d at 1040. For example, *The New York Times* news articles reporting box office receipts is evidence that *The New York Times* published specific box office receipts on certain dates, not that those were the actual box office receipts.

<sup>20</sup> Opposer's Exhibit Nos. 41-44 (45 TTABVUE) and Nos. 45-46 (46 TTABVUE).

Opposer's representation agent for the licensing of Opposer's intellectual property, including the BATMAN marks and batwing logos, with attached exhibits;<sup>21</sup> and

4. Opposer properly made its pleaded registrations of record by submitting copies of those registrations printed from the electronic database records of the USPTO showing the current status and title of the registrations pursuant to 37 CFR § 2.122(d)(1).

B. Applicant's testimony and evidence.

1. Notice of reliance on Internet documents submitted under *Safer* purportedly to show "1) the unlikelihood of consumer confusion; 2) the dissimilarity of the marks at issue; 3) the dissimilarity of the services at issue; and 4) the dissimilarity of the channels of trade and advertising at issue";<sup>22</sup> and

2. Testimony deposition of Fred C. Klein, Applicant's co-founder and President, with attached exhibits.<sup>23</sup>

## II. Standing

Because Opposer has properly made of record its pleaded registrations, Opposer has established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d

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<sup>21</sup> 50 TTABVUE 11 – 12. The confidential version of the Gibbs deposition is docketed at 48 TTABVUE. The publicly available version of the Gibbs deposition is docketed at 50 TTABVUE.

Warner Bros. Consumer Products is the licensing arm of Warner Bros. Studios. It acts as Opposer's licensing agent for Opposer's intellectual property, including, *inter alia*, BATMAN. 50 TTABVUE 11-12.

<sup>22</sup> Applicant's Exhibit Nos. 1-10 (51 TTABVUE).

<sup>23</sup> 52 TTABVUE.

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).

### III. Priority

Because Opposer has properly made of record its pleaded registrations, Section 2(d) priority of use is not an issue in the opposition as to the marks and the goods and services covered by the pleaded registrations. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

Opposer used BATMAN as a mark identifying a series of movies since 1989.<sup>24</sup> Fred Klein testified that Applicant first used its two BATMEN marks on February

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<sup>24</sup> 44 TTABVUE 14 and 17. The evidence comprises news articles from 1989 about the BATMAN movies produced by Warner Brothers Studios. As indicated above, Warner Bros. Consumer Products is the licensing arm of Warner Bros. Studios. 50 TTABVUE 11. Warner Bros. Consumer Products also “acts as [Opposer’s] representation agent ... for the licensing of [Opposer’s] intellectual properties,” (50 TTABVUE 11-12), including, *inter alia*, BATMAN. While there was no evidence expressly explaining the relationship between Opposer and Warner Bros. Studios, because Warner Bros. Consumer Products acts as licensing agent for both Warner Bros. Studios and Opposer, we find that logic dictates that there must be some sort of licensing relationship between Opposer and Warner Bros. Studios regarding the use of the BATMAN marks and character. In further support of our finding that there is a licensing relationship between Opposer and Warner Bros. Studios, we take note of the “Batman Begins Style Guide” (Gibb’s Deposition Exhibit 6; 50 TTABVUE 118-265), a document written by Warner Bros. Consumer Products for Opposer in anticipation of the “Batman Begins” movie (50 TTABVUE 36). The “Introduction” explains that the “Batman Begins” movie is “the inspiration for the most dynamic merchandising program of 2005. ... The drama and intensity of Batman’s original story, fully explored onscreen for the first time, has been translated into action-packed character artwork supported with a full array of graphic elements.” Potential licensees are instructed to contact Opposer’s Licensee Services “to discuss commissioning custom art because “[a]ll custom art must be provided by [Opposer].” 50 TTABVUE 123. It stretches credulity to assert that Opposer and Warner Bros. Consumer Products would work so closely together marketing products derived from the Warner Bros. Studios “Batman Begins” movie unless there was a relationship between Opposer and Warner Bros. Studios. Moreover, although Applicant cross-examined Michael Gibbs, Senior Vice President of Licensing and Business Development for Warner Brothers Consumer Products, Inc., regarding the relationship between Opposer and Warner Bros. Consumer Products, Applicant did not challenge the fame of the BATMAN marks or argue that the renown of the BATMAN marks derived through the movies did not inure to the benefit of Opposer.

1, 2006 for the services identified in Applicant's applications.<sup>25</sup> Thus, Opposer has priority of use for its BATMAN mark in connection with a series of movies prior to any use by Applicant of its marks.<sup>26</sup>

#### IV. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003).

##### A. Fame of Opposer's Marks.

This *du Pont* factor requires us to consider the fame of Opposer's marks. Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

Fame may be measured indirectly by the volume of sales and advertising expenditures of the goods and services identified by the marks at issue, "the length

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<sup>25</sup> 52 TTABVUE 29-30.

<sup>26</sup> Opposer did not introduce any evidence or testimony regarding its first use of the batwing logos or any GOTHAM-formative marks in connection with a series of movies.

of time those indicia of commercial awareness have been evident,” widespread critical assessments and through notice by independent sources of the products identified by the marks, as well as the general reputation of the products and services. *Bose Corp.*, 63 USPQ2d at 1305-1306 and 1309. However, raw numbers alone may be misleading. Thus, some context in which to place raw statistics may be necessary (e.g., the substantiality of the sales or advertising figures for comparable types of products or services). *Bose Corp.*, 63 USPQ2d at 1309.

There is no evidence demonstrating the marketplace strength of Opposer’s batwing logos or GOTHAM-formative marks. In regard to the batwing logos and the GOTHAM-formative marks, we note that because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it. *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007). Accordingly, we focus instead on the fame of the BATMAN word marks.

The evidence shows that BATMAN is an iconic American comic book, television and movie hero. In fact, Applicant’s President, Fred Klein, testified that “everybody probably knows about Batman.”<sup>27</sup>

Q. I think you testified previously that everyone heard about Batman?

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<sup>27</sup> 52 TTABVUE 33.

A. It's a prominent name. I'm not going to dispute that.

Q. And you adopted the Gotham Batmen name because of Batman, correct?

A. Partially.

Q. As a reference to Batman, correct?

A. As I said before, I had an aha moment that softball uses a bat, Gotham is the name of our networking group. It just came to me if you are going to play softball and use a bat, you should be the Batmen.

Q. But also in part that Batman the character operates from Gotham?

A. Yes, correct.

Q. And the logo that you applied to register the Gotham Batmen logo, the subject of this proceeding, that also makes a reference to Batman, correct?

A. Correct. It doesn't have the hood or the cowl. It has if you look at it upside down, it has a tongue-in-cheek reference to a five-fingered fielder's mitt, but obviously, it could be a spider web; and obviously, it evokes Batman, yes.<sup>28</sup>

The first BATMAN comic was published in 1939, one year after the debut of SUPERMAN comic books.<sup>29</sup>

Batman wasn't as strong as Superman, but he was much more agile, a better dresser and had better contraptions and a cooler place to live.

He lived in the Batcave, drove the Batmobile, which had a crime lab and a closed circuit television in the back, and

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<sup>28</sup> 52 TTABVUE 50-51.

<sup>29</sup> 44 TTABVUE 26-27.

owned a Batplane. He also kept a lot of tools in his utility belt, including knockout gas, a smoke screen and a radio.

“Since he had no superpowers, he had to rely only on his physical and mental skills,” said Allen Asherman, the librarian at DC Comics.

Batman’s fictional history, which was created years after the character himself, was dark. According to Batlegend, under his cape Batman was really a man named Bruce Wayne who, as a child, watched as his parents were murdered in the dark streets of New York City while they were walking home from a movie. Traumatized, young Bruce vowed to avenge their deaths by punishing criminals everywhere. He studied criminology, trained his body and assembled an assortment of tools to fight crime in Gotham. One night, startled by a bat outside his window, he made up his mind to dress up as a bat to put fear into the “cowardly and superstitious” hearts of criminals.<sup>30</sup>

See also the **ENCYCLOPAEDIA BRITANNICA** entry for Batman.<sup>31</sup>

“Batman was an immediate sensation.”<sup>32</sup> The character flourished in the 1940’s appearing in multiple comic book series (*e.g.*, *Detective Comics*, *Batman*, and *World’s Finest Comics*).<sup>33</sup> After a down period in the 1950’s, during which time the comics, while less popular, were continuously available, the ABC television network premiered a live-action Batman television series in 1966 starring Adam West and Burt Ward.<sup>34</sup>

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<sup>30</sup> *Id.*

<sup>31</sup> 44 TTABVUE 157-158.

<sup>32</sup> 44 TTABVUE 157. That BATMAN has an encyclopedia entry is some indicia of the character’s renown.

<sup>33</sup> *Id.*

<sup>34</sup> *Id.*

Batman bubbled with flashy costumes and sets (at a time when colour television was relatively new), pop-art sound-effect graphics and guest appearances by popular celebrities as villains. The show was an immediate hit, spawning an unprecedented wave of Bat-merchandise. The Batman newspaper strip resumed, and a theatrical movie was churned out for the summer of 1966.<sup>35</sup>

In 1989, Tim Burton directed a Batman movie that was a huge success.

*The New York Times* (April 9, 1989)

TIM BURTON, BATMAN AND THE JOKER

\* \* \*

Although “Batman” doesn’t open until late June, a widely distributed trailer has already given millions of American moviegoers a taste the film’s darkly elegant style. The most talked about “coming attraction” in recent memory, it elicits applause and often cheers with its succession of electrifying images: Gotham City in post-modern decay; the sleek black contours of the Batmobile and Batwing (the Caped Crusader’s airplane); the hero himself flitting, batlike, from the deep shadows into a pool of sulphurous light.<sup>36</sup>

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*The New York Times* (July 4, 1989)

‘Batman’ Sets Sales Record: \$100 Million in 10 Days

Inexorably swooping down on movie audiences for the second weekend in a row, “Batman” continues to dominate the box office. The movie broke another record on Sunday. In just 10 days, the movie, from Warner Brothers, has sold \$100.2 million worth of tickets, breaking the record of “Indiana Jones and the Last Crusade,” which reached \$100 million on its 19th day.<sup>37</sup>

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<sup>35</sup> *Id.* at 158.

<sup>36</sup> 44 TTABVUE 9.

<sup>37</sup> 44 TTABVUE 14.

The success of the 1989 BATMAN movie revitalized BATMAN merchandise.<sup>38</sup> Success bred success and more BATMAN movies were made each setting box office records.

*The New York Times* (June 22, 1992)

#### Batman Is Back, and the Money Is Pouring In

Batman has indeed returned. The newly opened sequel, "Batman Returns," broke box office records over the weekend and is poised to turn into one of the largest grossing films ever.

Executives at Warner Brothers, which produced and distributed the dark, perverse and hugely expensive comedy, said today that the movie would gross a staggering \$46.5 million for the weekend, a record. The previous weekend record was held by "Batman," the 1989 film that hauled in \$42.7 million and then went on to be the sixth-biggest-grossing film in history.

Tom Semel, the president of Warner Brothers Inc., said in an interview: "It's clear that the chemistry in and around this movie -- the subject matter, the characters, the look of the film -- appeals to children, to people in high school, to adults, male and female. The film has become an event. People want to get out of the house and see this movie."<sup>39</sup>

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*The New York Times* (June 26, 1995)

#### A Big Weekend For 'Batman'

The film "Batman Forever," after blazing a box-office record for its opening weekend, cooled this past weekend but still became the first film this year to take in \$100 million.

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<sup>38</sup> 44 TTABVUE 158.

<sup>39</sup> 44 TTABVUE 21.

During its opening weekend, June 16 to 18, the Warner Bros. film grossed \$52.8 million, surpassing the previous record holder, “Jurassic Park,” by \$5.8 million. Total earnings so far, using actual figures through Saturday and projections for yesterday, were \$105.9 million.

\* \* \*

“Batman Forever,” is the third film about the Caped Crusader, who earlier found fame in comic books, on television and even as a ride at Six Flags Great Adventure theme parks.<sup>40</sup>

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Bloomberg website (Bloomberg.com) (September 4, 2008)

Batman’s Box Office Rises with ‘Titanic’

“The Dark Knight,” the latest chapter in the Batman film saga, took 30 days to become No. 2 in U.S. box office history. It joined the other top four-earners, “Titanic,” “Star Wars” and “Shrek 2” ...

Time Warner’s film earned \$471.5 million in the month starting July 18 ...<sup>41</sup>

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CNN.com/entertainment (cnn.com) (January 8, 2009)

‘The Dark Knight’ wins big at People’s Choice Awards

“The Dark Knight” took home top honors at the People’s Choice Awards Wednesday night, walking away with five awards.

The movie, which won high praise and acclaim from critics and fans, won the award for favorite movie, favorite action movie, favorite cast, favorite on screen

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<sup>40</sup> 44 TTABVUE 160.

<sup>41</sup> 44 TTABVUE 58.

match-up (Christian Bale and Heath Ledger) and favorite superhero (Christian Bale as Bruce Wayne/Batman).<sup>42</sup>

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*Business Insider* (July 20, 2012)

‘Dark Knight Rises’ Scores Second Highest-Grossing Midnight Opening

Midnight box-office records were no match for Batman.

According to *The Wrap*, “The Dark Knight Rises” easily swooped past “The Avengers” midnight earnings with \$30.6 million at the box office, making it the second highest-grossing midnight opening in history.<sup>43</sup>

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*Forbes* (September 9, 2012)

‘The Dark Knight Rises’ Tops \$1 Billion, Surpasses ‘The Dark Knight’

Despite early concerns that it was “underperforming” after an opening weekend that didn’t meet realistic expectations, Christopher Nolan’s trilogy-ending Batman epic *The Dark Knight Rises* rose above those early doubts and has now entered the elite club of films with more than \$1 billion in worldwide box office to their name.

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Domestically, however, *The Dark Knight* still has the upper hand, with \$533 million compared to the most recent film’s \$33 million tally.<sup>44</sup>

According to the IMDb website (imdb.com), the IMDb list of all-time best USA box office receipts (as of September 17, 2013) has two BATMAN movies in the

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<sup>42</sup> 44 TTABVUE 65.

<sup>43</sup> 44 TTABVUE 104.

<sup>44</sup> 44 TTABVUE 124.

top ten: “The Dark Knight” (2008) is listed as number 4 with \$533,316,061 in box office receipts and “The Dark Knight Rises” (2012) is listed as number 7 with \$448,130,642 in box office receipts. “Batman” (1989) is listed as number 75 with \$251,188,924 in box office receipts.<sup>45</sup>

Michael Gibbs, Senior Vice President of Licensing and Business Development for Warner Brothers Consumer Products, Inc., Opposer’s representation agent for the licensing of Opposer’s intellectual property, corroborated the success of the BATMAN movies.

Q. And just looking at the most recent three Batman movies [BATMAN BEGINS, DARK KNIGHT, and DARK KNIGHT RISES], can you tell us what your understanding is of the box office performance of each movie?

A. All three movies were highly successful, and the most recent Dark Knight Rises eclipsed a billion dollars in worldwide box office.<sup>46</sup>

One Forbes magazine writer for arts and entertainment selected the BATMAN films “The Dark Knight Rises” as the number one comic book superhero movie and “The Dark Knight” as the number three comic book superhero movie.<sup>47</sup> *Forbes* (August 22, 2012).

In 1992, director Tim Burton launched the animated television series *Batman: The Animated Series*. That show was broadcast through 1995. According to the **ENCYCLOPAEDIA BRITANNICA**,

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<sup>45</sup> 44 TTABVUE 134 – 135.

<sup>46</sup> 50 TTABVUE 57.

<sup>47</sup> 44 TTABVUE 119-120.

*Batman: The Animated Series* set a new standard for storytelling in the Batman universe. The series – which was marked by the mature tone of its plotlines, its distinctive colour palette and Art Deco visuals, and the outstanding caliber of its voice actors – reimagined villains such as Mr. Freeze and the Riddler, and introduced fan-favourite character Harley Quinn as the Joker’s sidekick. The show earned four Emmy Awards and exerted a profound influence on later depictions of Gotham City and its inhabitants.<sup>48</sup>

Further demonstrating Opposer’s claim that the BATMAN character is known as an iconic American hero is the auction price for original BATMAN comics.

*The New York Times* (December 19, 1991)

Holy Record Breaker! \$55,000 for First Batman Comic

The superhero at Sotheby’s first auction of comic books yesterday was Harold M. Anderson. ... Mr. Anderson bought many of the most important properties and paid a record price at auction for a comic book with his \$55,000 purchase of a copy of Detective 27, the 1939 issue in which Batman appeared for the first time.<sup>49</sup>

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*The New York Times* (February 26, 2010)

Arts Beat

Batman’s First Appearance at a Bruce Wayne Price

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On Monday, the \$1 million sale of a copy of Action Comics No. 1, which features the first appearance of Superman set a record for the sale of a comic book. But it was short-lived.

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<sup>48</sup> 44 TTABVUE 158.

<sup>49</sup> 44 TTABVUE 19.

On Thursday, a copy of Detective Comics No. 27, the first appearance of Batman from 1939, sold for \$1,075,500.<sup>50</sup>

BATMAN also stakes its claim to the bestseller list.

*The New York Times* (July 6, 2012)

Arts Beat

Graphic Books Best Sellers: Five Batman Books Crowd the Hardcover List

For a character who has been around for more than 70 years, Batman is looking awfully spry. The caped crusader stars in five of the Top 10 books on the hardcover best-seller list this week, including “Batman: The Black Glove,” a deluxe collected edition that enters the list at No. 2.<sup>51</sup>

Michael Gibbs testified as follows:

Q. Can you describe generally the types of products licensed by D.C. Comics that bear the Batman trademark?

A. Batman is our largest and most extensive licensing program. Our program has probably – we have license[s] for the most product categories ranging from apparel, t-shirts, sleepwear, underwear, shoes, to toys with action figures, and sports equipment, to hard lines category like bedding and notebooks and note pads.

And we’ve also, in terms of not hard physical product, we have also have themed entertainment area that does a Batman live arena show.

So we have - - it’s our most extensive licensing program.<sup>52</sup>

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<sup>50</sup> 44 TTABVUE 79. We make no finding as to whether the auction price of their first comics has any bearing as to who would win in a fight between SUPERMAN and BATMAN.

<sup>51</sup> 44 TTABVUE 95.

<sup>52</sup> 50 TTABVUE 18-19.

On behalf of D.C. Comics, Warner Brothers Consumer Products licenses the BATMAN trademark on “150 different product categories of which there are subsets within those categories.”<sup>53</sup> This translates into royalties based on the sale of BATMAN and BATMAN logo-branded goods that are substantial by any means.<sup>54</sup> The *Licensing Letter* estimate of licensing revenues reports that BATMAN is the 18th rated licensed property generating \$250 million in retail sales in the U.S. and Canada in 2010.<sup>55</sup>

The marketing strength of the BATMAN brand is discussed in the following news article in Forbes magazine (July 2012) which discusses how the BATMAN merchandise helped Mattel:

Mattel Sees Brightened Profits from Batman, Barbie

Mattel shares rallied today after the company’s quarterly profits flew past analyst’s expectations. A bright second

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<sup>53</sup> 50 TTABVUE 20. Mr. Gibbs also testified that in the year when a BATMAN movie is released, there are in excess of a million SKUs at retail in the U.S. 50 TTABVUE 21. However, Opposer did not explain what that means and, therefore, it has no bearing on our decision.

<sup>54</sup> 50 TTABVUE 682 – 684. The royalty revenues generated by the sale of BATMAN and BATMAN logo-branded goods was designated as confidential and, therefore, may only be referenced in general terms.

<sup>55</sup> 45 TTABVUE 244-251. The *Licensing Letter* provides to its subscribers “estimates of retail sales of licensed merchandise by property type and product category.” 45 TTABVUE 246. The *Licensing Letter* looks “exclusively at consumer products that are licensed to third parties for manufacture and distribution, and where the manufacturer is paying a royalty on the goods sold.” *Id.* at 245. “These estimates are developed through a combination of surveys; interviews with licensors, licensees, agents, and retailers; analysis of annual reports, royalty income and data from publicly held companies; corporate sales information from websites; press releases; and articles. Executives at the licensors of properties listed were given an opportunity to review and comment on the list so far as their own and their competitor’s properties, as were selected industry experts.” *Id.* at 246.

quarter came on strong demand for its Batman: Dark Knight and Barbie toys.<sup>56</sup>

According to Michael Gibbs, “we are continually consistently doing focus groups and other research on the awareness of the brand utilizing Q scores that are a known quantity within the industry. And Batman is consistently over 90 percent awareness on Q scores.”<sup>57</sup> Corroborating the Q score testimony is the press release published on Opposer’s website (DCComics.com) (August 23, 2013) that BATMAN’s FACEBOOK page hit the 10 million fan mark.<sup>58</sup>

We find that the BATMAN mark is a famous mark in connection with BATMAN for comic books and movies.<sup>59</sup> That fame is transferred to a vast array of collateral or merchandising products that are purchased because they bear the BATMAN trademark; that is, consumers have come to associate the fame of BATMAN with the products bearing that mark. *See Harley-Davidson Motor Co. v. Pierce Foods Corp.*, 231 USPQ 857, 863 (TTAB 1986).<sup>60</sup>

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<sup>56</sup> 44 TTABVUE 98.

<sup>57</sup> 50 TTABVUE 57. A Q score shows “familiarity, awareness of the Batman brand, the logos, the character art.” *Id.* The better practice would have been for Opposer to have introduced the Q score studies into evidence.

<sup>58</sup> 44 TTABVUE 130.

<sup>59</sup> In making this finding of fact, we acknowledge that there is a hearsay element to much of the evidence. However, there is no bias in the news articles which were not published for purposes of this proceeding, but rather were published as part of the regular reporting of news. Moreover, the multiple sources of information all corroborate the testimony made of record affirming the renown of the BATMAN character and recognition of the BATMAN brand.

<sup>60</sup> “That the mark HARLEY-HOG used on pork products is likely to be associated as to source with opposer is also corroborated by the fact that opposer’s uses of HARLEY and HOG in relation to its collateral goods frequently have been whimsical in character (e.g., HOG piggy banks, T-shirts bearing the phrase, ‘I LOVE MY HOG HARLEY,’ ‘the HOG Tales’ publication, etc.). Because of these uses, a person having knowledge of them would

- B. The similarity or dissimilarity of the marks in their entireties in terms of appearance, sound, connotation and commercial impression.

Having found opposer's BATMAN mark, in its myriad uses, to be famous, and therefore entitled to a broad scope of protection, we now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. In a particular case, a "finding of similarity as to any one factor (sight, sound or meaning) alone 'may be sufficient to support a holding that the marks are confusingly similar.'" *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988) (citations omitted). *See also In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1987). In comparing the marks, we are mindful that "[t]he proper test is not a side-by-side comparison of the marks, but instead 'whether the marks are sufficiently similar in terms of their commercial impression' such that persons who encounter the marks would be likely to assume a connection between the parties." *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted). *See also San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd mem.*, 972 F.2d 1353 (Fed. Cir. 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc. v. Oliver &*

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not be surprised to see HARLEY-HOG used in connection with hot dogs or similar products, and the association with opposer of the mark so used would also be not at all surprising."

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*Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

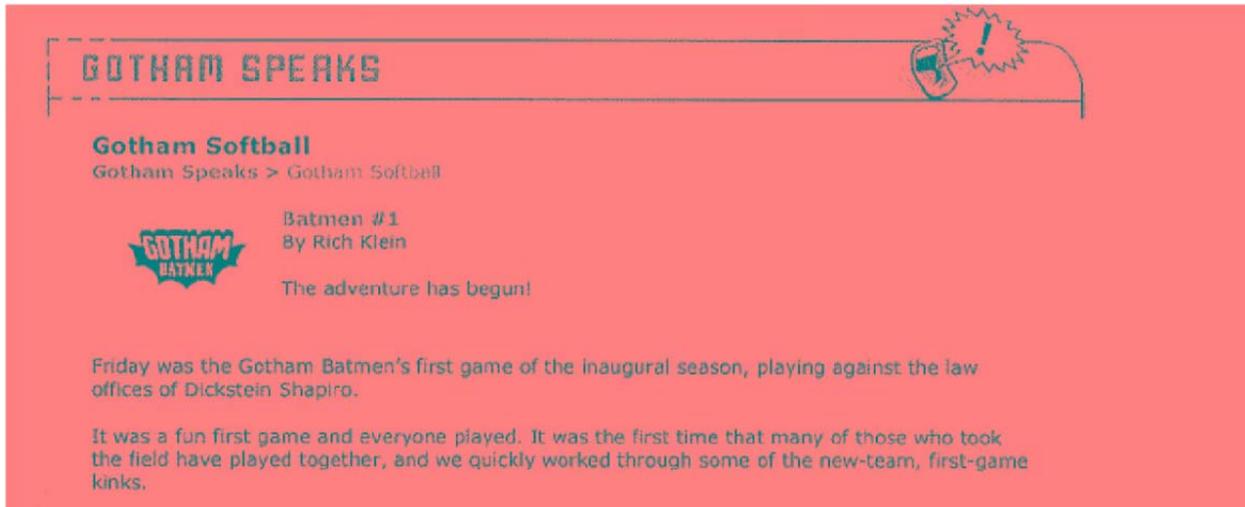
Applicant is seeking to register the mark GOTHAM BATMEN, in typed drawing form, and GOTHAM BATMEN and design shown below:



Applicant uses its marks in connection with its Class 35 networking services as displayed below in an excerpt from its website submitted as a specimen of use in its applications:



Applicant uses its marks in connection with its Class 41 softball services as displayed below in an excerpt from its website submitted as a specimen of use in its applications:



Ordinarily, for a word mark, we do not look to the trade dress which may be changed at any time. But we may look to Applicant's trade dress to determine the commercial impression engendered by Applicant's marks.

[T]he trade dress may nevertheless provide evidence of whether the word mark projects a confusingly similar commercial impression.

*Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281, 1284 (Fed. Cir. 1984). *See also 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.").

Applicant's specimens support rather than negate Opposer's complaints: that Applicant's GOTHAM BATMEN marks create a commercial impression which is confusingly similar to that of Opposer's BATMAN marks and batwing logos. For example, Applicant's use of the term BATMEN, GOTHAM and a batwing logo<sup>61</sup> is certain to elicit a connection with Opposer's famous BATMAN mark especially because "Batmen" is merely the plural form of "Batman." Case law holds that use of the plural form of a term "is almost totally insignificant in terms of the likelihood of confusion of purchasers." *In re Pix of Am., Inc.*, 225 USPQ 691, 692 (TTAB 1985). *See also Weidner Publ'ns, LLC v. D&B Beauty Care Co.*, 109 USPQ2d 1347, 1355 (TTAB 2014) ("It is well established that trademarks and/or service marks consisting of the singular and plural forms of the same term are essentially the same mark.").

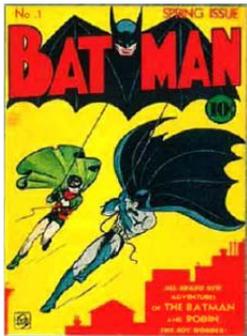
The fact that Applicant's mark encompasses both Opposer's BATMAN mark and the batwing logos increases the similarity of the marks. *See, e.g., Schering-Plough HealthCare Products Inc. v. Ing-Jing*, 84 USPQ2d 1323, 1326 (TTAB 2007) (if Opposer's two marks are used together on a single product or in marketing, they may be considered together in the likelihood of confusion analysis). In the present case, there is ample evidence to establish the conjoint use of the BATMAN mark with the batwing logos.<sup>62</sup> The examples below are representative.

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<sup>61</sup> We acknowledge but do not accept applicant's contention that the design element of its composite mark would be perceived as a fielder's mitt. It is much more likely to be perceived as a batwing design.

<sup>62</sup> See 50 TTABVUE 266 – 528.

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Applicant’s combination of the name “Gotham,” “Batmen” and the batwing design engender a commercial impression similar to Opposer’s BATMAN marks and batwing logos.<sup>66</sup> See the marks of Opposer and Applicant on t-shirts and hats displayed below.

Opposer’s shirt<sup>67</sup>



Applicant’s shirt<sup>68</sup>



<sup>63</sup> 44 TTABVUE 154.

<sup>64</sup> 50 TTABVUE 303.

<sup>65</sup> 50 TTABVUE 337

<sup>66</sup> “Gotham City” is where BATMAN fights crime. 44 TTABVUE 157 (“By 1942 Gotham City Police Commissioner James Gordon – in a reversal from the early days of the comic, when he had ordered his officers to fire upon Batman – was summoning the hero into action by illuminating the nighttime skies of Gotham City with the Bat-Signal.”). See also n.3 defining “Gotham” as a journalistic nickname for New York City.

<sup>67</sup> 50 TTABVUE 411.

<sup>68</sup> 52 TTABVUE 85.

Opposer's hats<sup>69</sup>



Applicant's hat<sup>70</sup>



In view of the foregoing, we find that Applicant's marks GOTHAM BATMEN and GOTHAM BATMEN and design are similar to Opposer's BATMAN marks and batwing logos.

Applicant argues that the mark GOTHAM BATMEN "falls under the Gotham family of marks," and, therefore, identifies Applicant as the source of the services.<sup>71</sup> Setting aside the question of whether Applicant has proven that it has a family of "Gotham" marks, the family of marks doctrine is unavailable to a defendant as a defense in an *inter partes* proceeding. *Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPQ2d 1048, 1052 (TTAB 1992) ("a defendant, whose sole mark in issue is its mark sought to be registered or its mark sought to be cancelled, can rely upon only its rights in that mark, except in very limited situations."). *See also Mag Instrument Inc. v. Brinkman Corp.*, 96 USPQ2d 1701, 1715 (TTAB 2010). The issue in this case is whether Applicant's GOTHAM BATMEN marks so resemble Opposer's BATMAN and batwing logos as to be likely to cause confusion, not whether Applicant has used other GOTHAM-formative marks.

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<sup>69</sup> 50 TTABVUE 419 and 434.

<sup>70</sup> 52 TTABVUE 84.

<sup>71</sup> 57 TTABVUE 31.

Applicant further argues that its addition of the word GOTHAM to BATMEN “drastically changes the aural [and visual] similarities between the parties’ respective marks.”<sup>72</sup> We disagree. The presence of “Gotham” to Applicant’s mark GOTHAM BATMEN does not distinguish Applicant’s mark from Opposer’s BATMAN marks. First, while the term “Gotham” is not an explicit part of opposer’s pleaded marks, the relationship of the superhero BATMAN to a place known as Gotham is indisputable. Thus, any aural dissimilarity would be outweighed by the recognition of this fact by those familiar with opposer’s marks, who would still be more likely to think of the superhero BATMAN even if their exposure to applicant’s mark was aural.

Second, even if “Gotham” is viewed as a geographically descriptive term rather than a term evocative of the milieu for the superhero who protects the city and residents of Gotham, those who see, rather than hear, the applicant’s marks will still be more likely to think of the superhero and the city he protects, particularly because of the batwing element in applicant’s composite mark. In short, technical differences in the sight and sound of the parties’ marks will be outweighed by their connotative similarity.

C. The similarity or dissimilarity and nature of the goods and services of the parties and the variety of goods and services on which Opposer’s marks are used.<sup>73</sup>

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<sup>72</sup> 57 TTABVUE 27.

<sup>73</sup> The ninth *du Pont* likelihood of confusion factor is “[t]he variety of goods on which a mark is or is not used (house mark, “family” mark, product mark).”

The next *du Pont* factor we consider is that of the relatedness of the goods and services. Applicant points out that it uses its GOTHAM BATMEN marks in connection with networking services and softball games, and “not a single one of Opposer’s marks is offered in connection with either general business networking services or entertainment in the form of amateur softball games.” Further, Applicant asserts that despite Opposer’s extensive licensing program, Opposer “cannot even begin to make a colorable argument that it has ever offered or licensed goods and/or services that are complementary or even related to business networking services.”<sup>74</sup>

It is well established that Applicant’s services and Opposer’s goods and services need not be similar or competitive, or even move in the same channels of trade, to support a holding of likelihood of confusion. It is sufficient that the respective goods and services are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods and services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. *See Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1492 (TTAB 2007); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

In this case, we note that Opposer’s BATMAN character is an iconic, fictional American hero, that the BATMAN trademark is famous, and that Opposer

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<sup>74</sup> 57 TTABVUE 22 – 25.

leverages the fame of the BATMAN character and trademark through an extensive licensing program. The Board, in another case, stated the following, which is equally appropriate in this case:

The licensing of commercial trademarks for use on “collateral” products (such as clothing, glassware, linens, etc.), which are unrelated in nature to those goods or services on which the marks are normally used, has become a common practice in recent years. *See: General Mills Fun Group, Inc. v. Tuxedo Monopoly, Inc.*, 204 USPQ 396, 400 [where we stated that such use is a matter of common knowledge and “has become a part of everyday life which we cannot ignore”], *affirmed* 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) [where the Court of Customs and Patent Appeals noted that “collateral product’ use is a matter of textbook discussion (see J. Gilson, Trademark Protection and Practice §5.05[10] (1980) and frequent commentary (see Grimes and Battersby, The Protection of Merchandising Properties, 69 T.M. Rep. 431 (1979) and references cited therein)].

*In re Phillips-Van Heusen Corporation*, 228 USPQ 949, 951 (TTAB 1986). *See also L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1889 (TTAB 2008) (“It is common knowledge, and a fact of which we can take judicial notice, that the licensing of commercial trademarks on ‘collateral products’ has become a part of everyday life.”); *Turner Entertainment Co. v. Nelson*, 38 USPQ2d 1942, 1945 (TTAB 1996) (“It is common knowledge, and in the present case, undisputed that video games, t-shirts, beach towels, caps and other logo-imprinted products are used as promotional items for a diverse range of goods and services.”). As shown by the record evidence, virtually everyone in America is familiar with the BATMAN character and trademark and is aware that the trademark is licensed for use in connection with a vast array of goods and services.

Normally, consumers would not expect that business networking services or softball games would emanate from the same source as entertainment services in the nature of movies, television series and comic books. However, such generalizations, while analytically convenient and superficially persuasive, must not overreach. Michael Gibbs testified that Opposer licenses the BATMAN mark in connection with “most product categories ranging from apparel, t-shirts, sleepwear, underwear, shoes, to toys with action figures, and sports equipment, to hard lines category like bedding and notebooks and note pads ... we also have a themed entertainment area that does a Batman live arena show.”<sup>75</sup> With respect to sporting goods, Mr. Gibbs testified that Opposer licenses “all types of sporting equipment from all types of balls, from baseballs to footballs to basketballs to gloves, bats, fishing poles, life vests, jerseys, apparel jerseys, both hockey, football, and baseball.”<sup>76</sup> Displayed below is a copy of a bat and ball set licensed by Opposer.

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<sup>75</sup> 50 TTABVUE 18-19.

<sup>76</sup> 50 TTABVUE 19.

<sup>77</sup> 50 TTABVUE 308.

Opposer has registered BATMAN<sup>78</sup> and the batwing design<sup>79</sup> for clothing, including hats and t-shirts. The BATMAN t-shirt displayed above (footnote 67) is advertised for sale on the Sport Chalet website<sup>80</sup> and the Dick's Sporting Goods website.<sup>81</sup> BATMAN baseball caps displayed above (footnote 69) are advertised for sale on the Champs Sports website.<sup>82</sup> These products can be used as softball uniforms and are presumably sold by the companies that are advertising them for sale. T-shirts and hats that can be used as softball uniforms are complementary products related to softball games as demonstrated by the fact that Applicant uses similar products for its hats and jerseys.<sup>83</sup>

Applicant's GOTHAM BATMEN networking services are related to the GOTHAM BATMEN softball games.

Q. Would you also say they [the GOTHAM BOMBERS, an associated softball team] are also a networking group in addition to being a softball group?

A. As I said, it's intended to be social. When you play on a team you get to know people very well, you know, a chain is as strong as its weakest link. It was a way to recruit members, network, going out drinking afterwards, having a party at the end of the year.

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<sup>78</sup> Registration No. 0856045.

<sup>79</sup> Registration No. 3326043.

<sup>80</sup> 50 TTABVUE 409.

<sup>81</sup> 50 TTABVUE 411.

<sup>82</sup> 50 TTABVUE 415-429.

<sup>83</sup> 52 TTABVUE 22-24 and 84-85.

Yes, some of our best new members have come from that meeting.<sup>84</sup>

For example, when Applicant sends out a communication seeking players to fill out the roster for a softball game, people often respond and make an inquiry such as “do you do any [real estate] legal work?”<sup>85</sup> The members make a referral as appropriate.<sup>86</sup>

Because Opposer’s BATMAN mark is famous and it has been licensed for use on a myriad of products, countless individuals have been exposed to Opposer’s BATMAN mark and to its use on or in connection with collateral products, including t-shirts and baseball balls and bats. Under these circumstances, individuals familiar with Opposer’s BATMAN marks and their associated goods and services, when confronted with Applicant’s mark in connection with softball games and networking services, will consider such activities to be sponsored by or affiliated with Opposer. *See NASDAQ Stock Market Inc. v. Antartica S.r.l.*, 69 USPQ2d 1718, 1732 (TTAB 2003).

In view of the foregoing, we find that Applicant’s services and Opposer’s goods and services are related.

D. Established, likely-to-continue channels of trade and classes of consumers.

Applicant is seeking to register its marks for the following services:

General business networking referral services, namely, promoting the goods and services of others by passing business leads and referrals among group members; and

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<sup>84</sup> 52 TTABVUE 18.

<sup>85</sup> 52 TTABVUE 38.

<sup>86</sup> 52 TTABVUE 38-39.

Entertainment in the nature of amateur softball games.

The channels of trade and classes of consumers for the softball games are unrestricted and, therefore, may include any men and women who participate in softball games, including fans of the BATMAN superhero. Likewise, because the channels of trade and classes of consumers for the business networking services are unrestricted, the business networking services are available to any person willing to join a business networking organization, including fans of the BATMAN superhero.

Opposer's entertainment services and licensed collateral merchandise are available to mass audiences comprising consumers from all walks of life; in other words, Opposer offers its entertainment services and licensed goods to ordinary consumers including men and women who play softball and who join business networking organizations.

Applicant argues that “[w]hen actual evidence of a party’s trade channels exist[s], the Board should rely on those specified trade channels.”<sup>87</sup> In Applicant’s case, its services are available only “through direct contact with [Applicant].”<sup>88</sup> Applicant’s interpretation of the law is incorrect. Because the scope of the registration Applicant seeks is defined by the description of services in its application (and not by its actual use), it is the description of services in the application (and not actual use) that we must look to in determining Applicant’s right to register:

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<sup>87</sup> 57 TTABVUE 18.

<sup>88</sup> 57 TTABVUE 18.

The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed.

*Octocom Syst. Inc. v. Houston Computers Svcs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

In view of the foregoing, we find that the *du Pont* likelihood of confusion factors relating to the channels of trade weighs in favor of finding that there is a likelihood of confusion.

E. The conditions under which and buyers to whom sales are made (*i.e.*, "impulse" vs. careful, sophisticated purchasing).

Applicant argues that the degree of care exercised by the relevant public is a factor that weighs against finding that there is a likelihood of confusion because Applicant "is a membership organization of business professionals" whose initiation is time consuming and requires careful consideration.<sup>89</sup> However, as indicated above, we may not resort to extrinsic evidence to restrict the classes of consumers for Applicant's services. *See In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986) (evidence that relevant goods are expensive wines sold to discriminating purchasers must be disregarded given the absence of any such restrictions in the application or registration). Thus, Applicant may not limit its "group membership" to "business professionals." For example, applicant's networking group membership may include or even be restricted to members of

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<sup>89</sup> 57 TTABVUE 21-22.

BATMAN fan clubs. Moreover, the classes of consumers for softball games include ordinary consumers from all walks of life, including BATMAN fans.

F. The absence of any reported instances of actual confusion.

Despite simultaneous use of their marks since 2006, there are no reported instances of actual confusion. “[T]he absence of actual confusion over a reasonable period of time might well suggest that the likelihood of confusion is only a remote possibility with little probability of occurring.” *Central Soya Co., Inc. v. North American Plant Breeders*, 212 USPQ 37, 48 (TTAB 1981). However, the probative value of the absence of actual confusion depends upon there being a significant opportunity for actual confusion to have occurred. *Barbara’s Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1287 (TTAB 2007). *See also Citigroup Inc. v. Capital City Bank Group, Inc.*, 94 USPQ2d 1645, 1660 (TTAB 2010), *aff’d*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011); *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992).

Applicant has argued that the goods and services of the parties move in different channels of trade because Applicant’s services are rendered exclusively through direct contact with Applicant which “is completely different from any of [Opposer’s] trade channels.”<sup>90</sup> Specifically,

[C]onsumers will only encounter the GOTHAM BATMEN Marks on the password-protected Gotham Website or through the referral-based GOTHAM BATMEN e-mail listserv. ... The GOTHAM BATMEN Marks are exclusively marketed through these two (2) trade channels, which consumers will only have access to if they

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<sup>90</sup> 57 TTABVUE 18.

have previously been referred to [Applicant] by [a member of Applicant]. This is unique and quite different from the broadly defined channels of trade used by [Opposer] to promote its goods to the general public. Therefore, because the only consumers that receive GOTHAM BATMEN advertising material are affiliated with [Applicant], it is almost guaranteed that they will not confuse [Applicant's] marketing material as originating from [Opposer].<sup>91</sup>

If, as Applicant argues, Applicant's trade channels are completely different than Opposer's trade channels, then there has not been a reasonable opportunity for actual confusion to have occurred. However, we have found the parties' presumptive trade channels to overlap.

In view of the foregoing, we find that the lack of any reported instances of actual confusion is neutral.

G. Balancing the factors.

Opposer's BATMAN marks and batwing logos are famous marks. Our primary reviewing court has cautioned that in such circumstances there is "no excuse for even approaching the well-known trademark of a competitor." *Kenner Parker Toys, Inc., Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

Thus, the Lanham Act's tolerance for similarity between competing marks varies inversely with the fame of the prior mark. As a mark's fame increases, the Act's tolerance for similarities in competing marks falls. For this reason, this court emphasizes:

When a Plaintiff's trademark is a strong, famous mark, it can never be "of little consequence". The

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<sup>91</sup> 57 TTABVUE 19 citing the Klein Deposition, p. 11 (52 TTABVUE 12-14).

fame of a trademark may affect the likelihood purchasers will be confused inasmuch as less care may be taken in purchasing a product under a famous name.

[*Specialty Brands*, 748 F.2d 669, 223 USPQ 1281, 1282 (Fed. Cir. 1984)]; *see also B.V.D. Licensing v. Body Action Design*, 846 F.2d 727, 730, 6 USPQ2d 1719, 1722 (Fed. Cir. 1988) (Nies, J. now C.J., dissenting) (“a purchaser is less likely *to perceive* differences from a famous mark.”) (emphasis in original). In accord with the same principles, this court states:

[T]here is “no excuse for even approaching the well-known trademark of a competitor . . . and that all doubt as to whether confusion, mistake, or deception is likely is to be resolved against the newcomer, especially where the established mark is one which is famous. . . .”

[*Nina Ricci, S.A.R.L. v. E.T.F. Enters.*, 889 F.2d 1070, 12 USPQ2d 1901, 1904 (Fed. Cir. 1989)] (quoting *Planter’s Nut & Chocolate Co. v. Crown Nut Co., Inc.*, 305 F.2d 916, 134 USPQ 504, 511 (CCPA 1962)].

*Id.* at 1456.

In view of the facts that the marks of the parties are very similar, the goods and services are related and must be presumed to move in the same channels of trade and be sold to the same classes of consumers, we find that Applicant’s marks GOTHAM BATMEN and GOTHAM BATMEN and design for business networking services and softball games are likely to cause confusion with Opposer’s BATMAN marks and batwing logos.

V. Whether Applicant's Marks Constitute A Parody?

Applicant argues as a defense to the likelihood of confusion claim that its GOTHAM BATMEN marks represent "a parodic or satiric use" of Opposer's BATMAN marks and batwing logos.<sup>92</sup>

The GOTHAM BATMEN Marks are clear and undeniable twists on [Opposer's] Batman-related marks and its comic book hero Batman. The GOTHAM BATMEN play the game of softball, a game which necessarily involves the use of a softball bat, a batter, batting averages, batboys, etc. and members of the GOTHAM BATMEN group jokingly refer to themselves as superheroes of the softball field and super networkers. The members of the GOTHAM BATMEN are well past their athletic prime and have several members that are sixty (60) and seventy (70) years of age. Moreover, the GOTHAM BATMEN listserv makes joking references to [Opposer's] Batman character on a regular basis by referring to bat signals appearing in the sky, when it is obvious to all that nothing of the sort appeared.<sup>93</sup>

The right of the public to use words in the English language in a humorous and parodic manner does not extend to use of such words as trademarks if such use is likely to cause confusion. *Nike Inc. Maher*, 100 USPQ2d 1018, 1023 (TTAB 2011); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1592 (TTAB 2008); *Columbia Pictures, Inc. v. Miller*, 211 USPQ 816, 820 (TTAB 1981). In this case, the parody defense fails because Applicant's mark is likely to cause confusion with Opposer's marks.<sup>94</sup>

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<sup>92</sup> 57 TTABVUE 34.

<sup>93</sup> 57 TTABVUE 34.

<sup>94</sup> While the Board may consider as a defense to a likelihood of confusion claim whether the mark sought to be registered or cancelled is a parody of the plaintiff's mark, the Board will "not consider the parody defense as part of the assessment of a dilution claim, because a

Moreover, Applicant's GOTHAM BATMEN mark does not create a parody of Opposer's BATMAN marks and batwing logos because Opposer's marks are not the target of the parody; it is Applicant's members that are the target of the parody.<sup>95</sup> As noted above, Applicant, in its brief, asserts that "members of the GOTHAM BATMEN group jokingly refer to themselves as superheroes of the softball field and super networkers." Mr. Klein testified on behalf of Applicant that "there is no question that Batman was part of the joke on us."<sup>96</sup> In other words, the purported parody is an inside joke. Applicant's parody of the athletic and networking prowess of its members does not require the use of Opposer's marks because the parody does not target Opposer. Therefore, Applicant's use of GOTHAM BATMEN as a parody is not a good defense to the likelihood of confusion claim in this case. *See e.g., Elvis Presley Enterprises Inc. v. Capece*, 141 F.3d 188, 46 USPQ2d 1737, 1745-46 (5th Cir. 1998). *See also Nike Inc. Maher*, 100 USPQ2d at 1023.

In view of the foregoing, Applicant's parody defense fails to justify the registration of Applicant's marks.

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mark that identifies source, which it must for registration, will not concurrently qualify for a statutory exclusion to a dilution claim." *The New York Yankees Partnership v. IET Products and Services, Inc.*, \_\_\_ USPQ2d \_\_\_ (TTAB 2015).

<sup>95</sup> As stated in 6 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 31:153 (4<sup>th</sup> ed. 2014):

[I]f defendant appropriates a trademarked symbol such as a word or picture, not to parody the product or company symbolized by the trademark, but only as a prominent means to satirize and poke fun at something else in society, this is not "parody" of a trademark.

<sup>96</sup> 52 TTABVUE 52-53.

In view of our finding that there is a likelihood of confusion, we need not decide Opposer's dilution claim.

**Decision:** The opposition is sustained and registration to Applicant is refused as to both applications.

**Dissent By:**

Taylor, J., dissenting.

I respectfully dissent from the decision of the majority that Opposer has met its burden, on this record, to demonstrate the fame of its pleaded BATMAN marks. More particularly, the majority found the BATMAN marks to be famous primarily based on the public's exposure to them in connection with a series of movies released by Warner Bros. Studio. However, in my opinion the majority exceeded its discretion when it attributed use by Warner Bros. Studio of the pleaded Batman marks to inure to the benefit of Opposer, DC Comics. As the majority aptly points out in footnote 24, "there was no evidence explaining the relationship between Opposer, DC Comics and Warner Bros. Studios." Nonetheless, the majority goes on to note that the record demonstrates that Warner Bros. Consumer Products ("WBCP") is the licensing arm of Warner Bros. Studios and also "acts as [Opposer's] representation agent ... for the licensing of [Opposer's] intellectual properties, including Batman," and then presumes, because WBCP acts as a licensing agent for both Opposer and Warner Bros. Studios, that "logic dictates" that there must be some sort of licensing arrangement between them. I fail to see the logic. It simply

does not follow that because Opposer and Warner Bros. Studio use the same licensing agent, a license agreement exists between them. Nor, as the majority postulates, does the “Batman Begins Style Guide” demonstrate a licensing relationship between Opposer and Warner Bros. Studio. While the record shows that WBCP has entered into licensing agreements on behalf of Opposer, and apparently prepared the style guide for merchandising purposes in connection with the Batman Begins movie, there is nothing in the guide that expressly confirms a licensing arrangement between Opposer and Warner Bros. Studio. Notably, the style guide points to DC Comics Licensee Services and not WBCP for “custom artwork.” Even if one may surmise a relationship between Opposer and Warner Bros. Studio from the style guide, supposition does not replace the evidence required to establish factual findings. *See, for example, In re Hand*, 231 USPQ 487 (TTAB 1986) citing to *Ex parte The Pure Oil Company*, 99 USPQ 19 (Com’r 1953) (“[T]he Patent Office files should clearly reflect facts which justify a finding that such [trademark] use inures to the benefit of the applicant.”).

Last, while it is true that Applicant did not expressly challenge the fame of Opposer’s BATMAN marks or argue that the renown of the BATMAN marks derived through the movies did not inure to the benefit of Opposer, as the plaintiff in this opposition proceeding, Opposer has the burden to prove its case.

In short, while Opposer pleaded use of the BATMAN marks and character in connection with, *inter alia*, movies, it did not prove that claim, and the evidence of record of use of the BATMAN marks properly attributed to Opposer is insufficient

to establish fame. Since I would find that the BATMAN marks are not famous, and because the goods and services of the parties are so disparate, they would not be encountered by the same persons under circumstances that could, because of the admitted similarity of the marks at issue, give rise to the mistaken belief that they originate from the same source.

In view of the foregoing, I find that despite the similarity of the marks, Opposer failed to prove by a preponderance of the evidence that its pleaded BATMAN marks are famous and that the goods and services of the parties are related. Accordingly, the Opposition should be dismissed.