

This Opinion is Not a
Precedent of the TTAB

Mailed: August 8, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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DC Comics

v.

Joseph F. Oliveri

—
Opposition No. 91219587
—

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

Dale A. Malone of the Law Office of Dale A. Malone,
for Joseph F. Oliveri.

—
Before Bergsman, Lykos and Masiello,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Joseph F. Oliveri (“Applicant”) seeks registration on the Principal Register of the mark FLASH TEC and design, shown below, for a wide variety of clothing items and shoes, in International Class 25.¹

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¹ Application Serial No. 86234274 was filed on March 27, 2014, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce.



Applicant's description of the mark reads as follows:

The mark consists of the word "FLASH" in red, and the word "TEC" in blue, separated by a gold lightning bolt, pointing downward.

The color(s) red, blue, and gold is/are claimed as a feature of the mark.

DC Comics ("Opposer") opposed the registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark so resembles Opposer's mark THE FLASH and the mark consisting of a lightning bolt design, shown below,



used in connection "with a vast array of goods and services," "including but not limited to comic books, television series, video games, apparel and toys" as to be likely to cause confusion.² Opposer pleaded ownership of the federal registrations listed below:

- Registration No. 1078898 for the mark THE FLASH for "comic books," in Class 12;³

² Notice of Opposition ¶4 (1 TTABVUE 6). Opposer also alleged dilution but withdrew that claim. Opposer's Brief, p. 25 n. 4 (46 TTABVUE 27 n.4).

³ Registered December 6, 1977; second renewal.

- Registration No. 3712418 for the mark THE FLASH for “computer and video games which are designed for hardware platforms, namely, game consoles and personal computers,” in Class 9;⁴ and
- Registration No. 1385324 for the mark shown below for “toys, namely, toy dolls,” in Class 28.⁵



Applicant, in its Answer, denied the salient allegations in the Notice of Opposition. Also, Applicant alleged that, in the alternative, it should be entitled to a registration with a restriction not to seek registration in Classes 9, 16, or 28.⁶

Only Opposer filed a brief.

I. Preliminary Issue

Trademark Rule 2.128(b), 37 C.F.R. § 2.128(b), provides that Opposer’s main brief “shall not exceed fifty-five pages in length in its entirety, including ... description of the record. ... Any brief beyond the page limits and any brief with attachments

⁴ Registered November 17, 2009; Sections 8 and 15 affidavits accepted and acknowledged.

⁵ Registered March 4, 1986; second renewal. The drawing of THE FLASH character is reproduced from the application drawing which more clearly displays the lightning bolt on the character’s chest than does the certificate of registration. (32 TTABVUE 113).

⁶ Answer ¶13 (7 TTABVUE 3).

outside the stated requirements may not be considered by the Board.” Opposer’s brief is 74 pages consisting in part of a 21 page appendix describing the record. Because the brief is supposed to assist the Board in understanding the record as a discussion of the facts in light of the law, we exercise our discretion to consider Opposer’s brief excluding the improper appendix.

II. The Record

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

The record also includes the testimony and evidence listed below.

A. Opposer’s testimony and evidence.

1. Notice of reliance on Applicant’s responses to Opposer’s interrogatory Nos. 2, 5, 6, 8-10, 12, 13, and 15;⁷
2. Notice of reliance on the prosecution history files for Opposer’s pleaded registrations⁸ and on records from the USPTO showing Opposer’s enforcement of its rights in THE FLASH mark;⁹

⁷ 31 TTABVUE.

⁸ 32 TTABVUE 7-231.

⁹ 32 TTABVUE 233-253.

3. Notice of reliance on a selection of THE FLASH comic book covers from 1959-2015¹⁰ and on copies of news articles referring to THE FLASH character;¹¹ and
4. Testimony deposition of Michael Gibbs, Senior Vice President of Licensing and Business Development for Warner Brothers Entertainment, the licensing agent for Opposer, with attached exhibits.¹²

B. Applicant's testimony and evidence.

1. Opposer's responses to Applicant's first set of interrogatories;¹³
2. Copies of third-party registrations printed from the USPTO electronic database that purportedly were referred to in the prosecution of the application at issue, that feature a lightning bolt design registered for clothing, and consist of the word "Flash" and a lightning bolt design;¹⁴ and

¹⁰ 33 TTABVUE 25-149.

¹¹ 33 TTABVUE 151-855.

¹² 34 TTABVUE. The portions of the Gibbs deposition designated as confidential are posted at 35-37 TTABVUE. Pursuant to Trademark Rule 2.116(g), 37 C.F.R. § 2.166(g), "[t]he Board may treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party."

¹³ 38 TTABVUE.

¹⁴ 39 TTABVUE. In its brief, Opposer objects to Applicant's notice of reliance on the third-party registrations on the ground that Applicant did not indicate the relevance of the registrations and on the ground that Applicant misidentified some of the third-party registrations (*i.e.*, Applicant asserted that they were cited during the prosecution of his application, but no registrations were cited in the prosecution of his application). Opposer's Brief, p. 10 (46 TTABVUE 13). Opposer's objections are overruled. First, Applicant's failure to indicate the relevance and the misidentification of the third-party registrations are procedural errors that could have been cured had Opposer promptly lodged its objections. *See* TBMP §§ 707.02(a) and (b) and 707.04 (June 2017) and the cases cited therein. Second, Opposer is not prejudiced because it is clear that Applicant introduced the third-party registrations to show the weakness of the word "Flash" and the lightning bolt design. It is common practice for parties to introduce evidence of third-party registrations to demonstrate

3. Testimony deposition of Applicant with attached exhibits.¹⁵

III. Introduction to THE FLASH.

Opposer's portfolio of comic book characters includes, *inter alia*, BATMAN, SUPERMAN, WONDER WOMAN and THE FLASH.¹⁶ Together these characters form the JUSTICE LEAGUE.¹⁷ THE FLASH is known for "his attributes of speed and his heroic nature, and very recognizable iconic symbol of the lightning bolt, which really epitomizes him in terms of his superhero qualities and speed."¹⁸ THE FLASH wears a red costume that features a yellow lightning bolt.¹⁹ A depiction of THE FLASH from a comic book cover is shown below:²⁰

that a mark or a portion of a mark is weak. Such evidence introduced by Applicant is publicly available via the USPTO website. Moreover, Opposer had thirty days between the close of Applicant's testimony period and the opening of its rebuttal testimony period to prepare evidence to rebut the third-party registrations. *See Sheetz of Delaware, Inc. v. Doctor's Assoc. Inc.*, 108 USPQ2d 1341, 1348 (TTAB 2013).

However, Applicant included some cancelled and expired registrations. A cancelled or expired registration has no probative value other than to show that it once issued and it is not entitled to any of the statutory presumptions of Section 7(b) of the Trademark Act. *In Re Ginc UK Limited*, 90 USPQ2d 1472, 1480 (TTAB 2007); *see also Action Temporary Services Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) ("a cancelled registration does not provide constructive notice of anything."). Accordingly, we do not give the cancelled or expired registrations any consideration.

¹⁵ 40 TTABVUE.

¹⁶ Gibbs Dep., p. 14 and 16 (34 TTABVUE 17 and 19).

¹⁷ Gibbs Dep., p. 14 (34 TTABVUE 17).

¹⁸ Gibbs Dep., p. 17 (34 TTABVUE 20).

¹⁹ Gibbs Dep., pp. 17, 19 and 64 (34 TTABVUE 20, 22 and 67).

²⁰ 32 TTABVUE 28.



THE FLASH comic books have been published since the 1940's.²¹ Opposer has capitalized on the popularity of the character to license THE FLASH mark, character, and lightning bolt symbol on a variety of products.

In terms of overall DC Comics, you know, we exploit it across various mediums from, like I said, TV shows, animated series, video games, all the consumer products that we are responsible for. Comic books, obviously is the cornerstone across all those key mediums.²²

* * *

Because what is driving that sale is the character affinity and application to the product that they're - - that consumers to looking to associate with.²³

Those products include computer and video games, toys, audio accessories, mobile phone and tablet accessories, collectible figures, wallets, DVDs, mugs, watches, books, bags, and clothing.²⁴

²¹ Gibbs Dep., p. 22 (34 TTABVUE 25).

²² Gibbs Dep. p. 15 (34 TTABVUE 18).

²³ Gibbs Dep., p. 54 (34 TTABVUE 57).

²⁴ Opposer's responses to Applicant's interrogatory Nos. 2 and 4-5 (38 TTABVUE 9-11).

IV. Standing

Standing is a threshold issue that must be proven by the plaintiff in every *inter partes* case. Any person who believes it is or will be damaged by registration of a mark has standing to file an opposition. Trademark Act Section 13, 15 U.S.C. § 1063. Our primary reviewing court has enunciated a liberal threshold for determining standing, namely that a plaintiff must demonstrate that it possesses a “real interest” in a proceeding beyond that of a mere intermeddler, and “a reasonable basis for his belief of damage.” *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014) (quotation omitted), *cert. denied*, 135 S. Ct. 1401 (2015). A “real interest” is a “direct and personal stake” in the outcome of the proceeding. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1026 (Fed. Cir. 1999). A claim of likelihood of confusion that “is not wholly without merit,” including prior use of a confusingly similar mark, may be sufficient “to establish a reasonable basis for a belief that one is damaged.” *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

Opposer or its licensees have sold or offered for sale hats, costumes, t-shirts, underwear, sleepwear, gloves, socks, sneakers, slip-on shoes, clogs, cleats, flip-flops, water shoes and slippers identified by THE FLASH mark, character, and lightning bolt design.²⁵ These products are “offered for sale in all manners of trade to all types of consumers nationwide.”²⁶

²⁵ Opposer’s responses to Applicant’s interrogatory Nos. 2 and 4-5 (38 TTABVUE 9-11).

²⁶ Opposer’s response to Applicant’s interrogatory No. 16 (38 TTABVUE 17); *see also* Gibbs Dep., p. 52 (34 TTABVUE 55) (“We sell The Flash products in all channels of retail.”).

[W]e sell products to all genders and all age groups. Depending on the execution of the product, we'll kind of define who the general consumer is. So as you see here, the Super Friends styling, that's more of an infant preschool.²⁷

The above-noted testimony and evidence is sufficient to establish Opposer's interest in the subject matter of this proceeding and, thus, its standing.

V. Priority

Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), permits opposition on the basis of ownership of "a mark or trade name previously used in the United States ... and not abandoned." Thus, we must consider whether Opposer has established its priority of use, a necessary element of any claim under Section 2(d).

Opposer must establish proprietary rights in its pleaded common-law marks that precede Applicant's actual or constructive use of its involved mark. *See Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981); *Larami Corp. v. Talk to Me Programs Inc.*, 36 USPQ2d 1840, 1845 (TTAB 1995). In other words, because unregistered marks are not entitled to the presumptions established under Section 7(b)-(c) of the Trademark Act, 15 U.S.C. § 1057(b)-(c), it is Opposer's burden to demonstrate that it owns trademarks that were used prior to Applicant's first use or constructive use of its mark and not abandoned. *Life Zone Inc. v. Middleman Grp. Inc.*, 87 USPQ2d 1953, 1959 (TTAB 2008).

Because Applicant did not present any testimony or evidence regarding the use of his mark, Applicant may rely on the filing date of his application as his constructive

²⁷ Gibbs Dep., p. 52 (34 TTABVUE 55).

date of first use (*i.e.*, March 27, 2014).²⁸ However, through the totality of the evidence, Opposer has shown that it has used THE FLASH mark, character, and lightning bolt design in connection with clothing prior to March 27, 2014. The evidence establishing Opposer's priority is discussed below:

- Gibbs Exhibit 157 [confidential] is a summary of different contracts Warner Brothers Entertainment has entered into with third parties for products, including clothing, identified by THE FLASH mark, character, or lightning bolt design. It covers contracts entered into as early as 1990 through 2015;²⁹

- Gibbs Exhibit 158 [confidential] is a summary of revenues generated in connection with the licensing of THE FLASH mark, character, or lightning bolt design from 2010 through 2015;³⁰

- Gibbs Exhibit 159 [confidential] is a copy of a license between Warner Brothers Entertainment on behalf of Opposer with a major apparel manufacturer dated June 13, 2013 that includes THE FLASH name, character, and other indicia associated with the character (*e.g.*, the lightning bolt design);³¹

- Gibbs Exhibit 160 [confidential] is a copy of a license between Warner Brothers Entertainment on behalf of Opposer with a major shoe manufacturer dated April 5,

²⁸ In response to Opposer's Interrogatory No. 2, Applicant stated that it has used its mark on "ion infused insoles." 31 TTABVUE 9. However, Applicant did not state when it used its mark on those products.

²⁹ Gibbs Dep., pp. 23-24 and Exhibit 157 (35 TTABVUE 26-27 and 115-368).

³⁰ Gibbs Dep., p. 27 and Exhibit 158 (35 TTABVUE 30 and 369-371).

³¹ Gibbs Dep., p. 31 and Exhibit 159 (35 TTABVUE 31, 372-512).

2010 that includes the FLASH name, character, and other indicia associated with the character;³²

• Gibbs Exhibit 162 [confidential] are examples of products utilizing THE FLASH character from the Warner Brothers Entertainment brand assurance division.³³ Although not every product reviewed by Warner Brothers brand assurance division gets to market, “[t]he majority of the products ultimately get to market if they put this level of energy into developing a final product.”³⁴ The exhibits displayed below are representative:

35



36



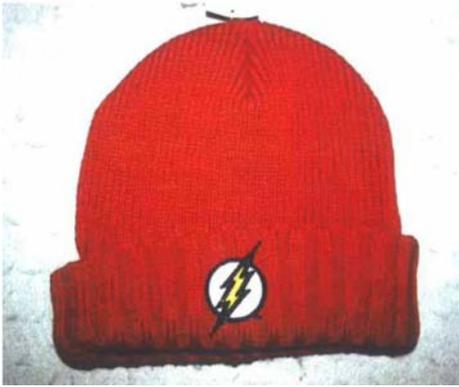
³² Gibbs Dep., p. and Exhibit 160 (35 TTABVUE 513-583)

³³ Gibbs Dep., p. 39 (35 TTABVUE 42).

³⁴ Gibbs Dep., p. 41 (35 TTABVUE 44).

³⁵ Gibbs Dep. Exhibit 162 (36 TTABVUE 7 dated January 2007).

³⁶ Gibbs Dep. Exhibit 162 (36 TTABVUE 14 dated January 2007).



Finally, several news articles or press releases made of record report on Opposer's licensing of THE FLASH mark or character in connection with clothing. For example,

- A July 22, 2013 article posted on the Global License! website (licensemag.com) reports that Under Armour and Warner Brothers Consumer Products and Opposer are continuing their collaboration with new additions to the Alter Ego line of performance apparel.

The Under Armour Alter Ego line taps into the transformative strength and inspiration of DC Comics Super Heroes including Superman, Batman, The Flash, Wonder Woman and others to create a collection of athletic performance wear that inspires athletes to soar to new heights.³⁹

- A May 14, 2013 article posted on Global License! website (licensemag.com) reports that Warner Brothers Consumer Products, Opposer and Target have teamed

³⁷ Gibbs Dep. Exhibit 162 (36 TTABVUE 166 dated February 2012).

³⁸ Gibbs Dep. Exhibit 162 (36 TTABVUE 266 dated March 2013).

³⁹ 33 TTABVUE 182.

up to create a collection of Justice League merchandise including apparel featuring the full line up of Opposer's Justice League heroes including THE FLASH;⁴⁰ and

- A November 8, 2011 article posted on Global License! website (licensemag.com) reporting that Warner Brothers has partnered with Diesel to produce, *inter alia*, THE FLASH boxer trunks for release in November 2011.⁴¹

When viewed in isolation, each piece of evidence introduced by Opposer might not be sufficient to establish that Opposer used THE FLASH mark and lightning bolt design prior to March 27, 2014.

However, whether a particular piece of evidence by itself establishes prior use is not necessarily dispositive as to whether a party has established prior use by a preponderance. Rather, one should look at the evidence as a whole, as if each piece of evidence were part of a puzzle which, when fitted together, establishes prior use.

West Florida Seafood Inc. v. Jet Rest. Inc., 31 F.3d 1122, 31 USPQ2d 1660, 1663 (Fed. Cir. 1994). When all of the testimony and evidence is considered together, rather than individually, the testimony and evidence as a whole establishes that Opposer used THE FLASH and lightning bolt design in connection with clothing prior to the March 27, 2014 filing date of Applicant's application.

VI. 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

⁴⁰ 33 TTABVUE 201; *see also* Business Wire (33 TTABVUE 204) and Benzinga.com (33 TTABVUE 207).

⁴¹ 33 TTABVUE 280.

likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*du Pont*”) (cited in *B&B Hardware, Inc. v. Hargis Ind., Inc.*, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015)); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We have considered each *du Pont* factor that is relevant and for which there is evidence of record. *See M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See In re Chatam Int’l Inc.*, 380 F.2d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *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.”); *see also In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1409 (TTAB 2015).

A. The similarity or dissimilarity and nature of the goods.

Applicant is seeking to register its mark on a wide range of clothing items including, *inter alia*, ankle socks, anti-perspirant socks, athletic shoes, baseball caps and hats, basketball sneakers, beach shoes, hats, men’s dress socks, men’s socks, rain hats, sleep pants, sleep shirts, sneakers; sports caps and hats, stocking hats, t-shirts, and tennis shoes.

Opposer has used the word mark THE FLASH and the lightning bolt design in connection with hats, costumes, t-shirts, underwear, sleepwear, gloves, socks, sneakers, slip-on shoes, clogs, cleats, flip-flops, water shoes and slippers.⁴² Thus, the goods are in part identical.

Under this *du Pont* factor, the Opposer need not prove, and we need not find, similarity as to each and every product listed in the description of goods. It is sufficient for an opposition based on likelihood of confusion that relatedness is established for any item encompassed by the identification of goods in a particular class in the application. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014); *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1588 n.1 (TTAB 2011), *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014); *Apple Computer v. TVNET.Net, Inc.*, 90 USPQ2d 1393, 1397 (TTAB 2007). Thus, this factor weighs in favor of finding a likelihood of confusion.

B. Established, likely-to-continue channels of trade.

Opposer's products are "offered for sale in all manners of trade to all types of consumers nationwide."⁴³ "[W]e sell products to all genders and all age groups. Depending on the execution of the product, we'll kind of define who the general

⁴² Opposer's responses to Applicant's interrogatory Nos. 2 and 4-5 (38 TTABVUE 9-11).

⁴³ Opposer's response to Applicant's interrogatory No. 16 (38 TTABVUE 17); *see also* Gibbs Dep., p. 52 (34 TTABVUE 55) ("We sell The Flash products in all channels of retail.").

consumer is.”⁴⁴ For example, one of the news articles noted above reported that Opposer had contracted with Target to sell Opposer’s licensed clothing.⁴⁵

Because there is no limitation in Applicant's identification of goods, we must presume that Applicant's clothing moves in all channels of trade that would be normal for clothing, including Opposer’s channels of trade, and that they would be purchased by all potential customers. This is so despite the fact that Applicant testified his goods are infused with negative ions⁴⁶ and that Applicant intends to market the products to clothing manufacturers.⁴⁷ *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); *Morton-Norwich Prods., Inc. v. N. Siperstein, Inc.*, 222 USPQ 735, 736 (TTAB 1984); *In re Heat Mirror Assoc.*, 219 USPQ 1015 (TTAB 1983); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). For purposes of the likelihood of confusion analysis, Applicant’s clothing moves in the same channels of trade as Opposer’s clothing.

C. The strength of Opposer’s marks, including the number and nature of similar marks in use on similar goods.

In determining the strength of a mark, we consider both its inherent strength based on the nature of the mark itself and its commercial strength, based on the marketplace recognition value of the mark. *See In re Chippendales USA, Inc.*, 622

⁴⁴ Gibbs Dep., p. 52 (34 TTABVUE 55).

⁴⁵ 33 TTABVUE 201; *see also* Business Wire (33 TTABVUE 204) and Benzinga.com (33 TTABVUE 207).

⁴⁶ Applicant’s Dep., pp. 10-11 (40 TTABVUE 11-12) (Applicant infuses negative ions into the apparel).

⁴⁷ Applicant’s Response to Opposer’s Interrogatory No. 5 (31 TTABVUE 10).

F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).”); *Top Tobacco, L.P. v. North Atlantic Operating Co., Inc.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011) (the strength of a mark is determined by assessing its inherent strength and its commercial strength); *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006); **McCarthy on Trademarks and Unfair Competition** § 11:83 (4th ed. 2017) (“The first enquiry focuses on the inherent potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another's use.”). Market strength is the extent to which the relevant public recognizes a mark as denoting a single source. *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d at 1899. In other words, it is similar to acquired distinctiveness.

THE FLASH and a lightning bolt design are arbitrary, fanciful terms when used in connection with clothing and, therefore, Opposer’s marks are inherently distinctive.

As noted above, Opposer, through Warner Brothers Entertainment, capitalizes on the success of THE FLASH comic books to license THE FLASH mark, character and lightning bolt design for use across various media and on a variety of products, including clothing.⁴⁸

⁴⁸ Gibbs Dep., pp. 15 and 54 (34 TTABVUE 18 and 57); Opposer’s responses to Applicant’s interrogatory Nos. 2 and 4-5 (38 TTABVUE 9-11).

The Flash is, as a property, spans all of our key product categories. The key categories being apparel, accessories, footwear, toys, hard lines, hard goods, bedding, stationary, all the key categories you expect in a broad merchandising program.⁴⁹

Because Opposer designated as confidential the revenues generated from licensing THE FLASH mark, character, and lightning bolt design, the Board may refer to Opposer's revenues only in general terms. However, Opposer did not segregate THE FLASH licensing revenues from various other properties of which THE FLASH is a member (*e.g.*, JUSTICE LEAGUE, TEEN TITANS, DC COMICS and other groups). Therefore, we cannot discern the revenues attributable solely to THE FLASH mark, character, or lightning bolt design.⁵⁰ Nevertheless, based on Opposer's active licensing program, the appearance of THE FLASH in the LEGO video game, in THE FLASH television show, in at least two animated series, and in the BATMAN v. SUPERMAN movie,⁵¹ we find that THE FLASH is a valuable intellectual property asset with marketplace strength.

This marketplace strength based primarily on Opposer's comic book serves a source indicating function: that is, the primary significance of THE FLASH and the lightning bolt design on licensed products, including clothing, indicates to "the purchasing public the source of the T-Shirt, not the source of manufacture but the secondary source." *In re Paramount Pictures Corp.*, 213 USPQ 1111, 1112 (TTAB

⁴⁹ Gibbs Dep., p. 26 (35 TTABVUE 29). This testimony was improperly designated confidential.

⁵⁰ Gibbs Dep., p. 28 (35 TTABVUE 31).

⁵¹ Gibbs Dep. pp. 18-19 and 22-23 (34 TTABVUE 21-22 and 25-26).

1982); *see also In re Olin Corp.*, 181 USPQ 182 (TTAB 1973) (stylized “O” design registrable for t-shirts where applicant had previously registered the “O” design for skis).

The ‘ornamentation’ of a T-shirt can be of a special nature which is inherently tells the purchasing public the source of the T-Shirt, not the source of manufacture but the secondary source. Thus, the name ‘New York University’ and an illustration of the Hall of Fame, albeit it will serve as ornamentation on a T-shirt will also advise the purchaser that the university is the secondary source of that shirt. It is not imaginable that Columbia University will be the source of an N.Y.U. T-shirt. Where the shirt is distributed by other than the university the university's name on the shirt will indicate the sponsorship or authorization by the university.

In re Paramount Pictures Corp., 213 USPQ at 1112. In other words, consumers are accustomed to seeing THE FLASH mark, character, and the lightning bolt design used as trademarks to indicate the sponsorship or authorization of the clothing by Opposer.

On the other hand, Applicant introduced copies of third-party registrations to show that the word “Flash” and a lightning bolt design have been registered numerous times and, therefore, they are entitled to only a narrow scope of protection or exclusivity of use. Third-party registrations can be used in the manner of a dictionary definition to illustrate how a term is perceived in the trade or industry.⁵²

⁵² Third-party registrations have little other probative value because they are not evidence that the marks are in use on a commercial scale or that the public has become familiar with them. *See Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973) (the purchasing public is not aware of registrations reposing in the U.S. Patent and Trademark Office); *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973); *In re Hub Distrib., Inc.*, 218 USPQ 284, 285 (TTAB 1983).

Juice Generation, Inc. v. GS Enters. LLC, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015); *Institut Nat'l Des Appellations D'Origine v. Vintners Int'l Co.*, 958 F.2d 1574, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992) (“Such third party registrations show the sense in which the word is used in ordinary parlance and may show that a particular term has descriptive significance as applied to certain goods or services.”); *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151, 153 (CCPA 1978) (“we find no error in the citation of nine third-party registrations ‘primarily to show the meaning of * * * [zing] in the same way that dictionaries are used.”); *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987) (“Said third party registrations are of use only if they tend to demonstrate that a mark or a portion thereof is suggestive or descriptive of certain goods and hence is entitled to a narrow scope of protection. Used in this limited manner, ‘third party registrations are similar to dictionaries showing how language is generally used.’”) (Internal citation omitted.)

“Flash” is defined, *inter alia*, as “a brief, sudden burst of bright light: *a flash of lightning*,” “a very brief moment; instant: *I’ll be back in a flash*.”⁵³

Applicant introduced six third-party registrations consisting of both the word “Flash” and a lightning bolt design.⁵⁴ However, they are of limited, if any, probative value because they do not cover clothing. *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1639

⁵³ *Dictionary.com* based on the **Random House Dictionary** (2017). The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *Threshold.TV Inc. v. Metronome Enters. Inc.*, 96 USPQ2d 1031, 1038 n.14 (TTAB 2010).

⁵⁴ 39 TTABVUE 87-98.

(TTAB 2009) (the third-party registrations are of limited probative value because the goods identified in the registrations appear to be in fields which are far removed from the goods at issue); *see also Key Chemicals, Inc. v. Kelite Chemicals Corp.*, 464 F.2d 1040, 175 USPQ 99, 101 (CCPA 1972) (“Nor is our conclusion altered by the presence in the record of about 40 third-party registrations which embody the word “KEY”. The great majority of those registered marks are for goods unrelated to those in issue, and there is no evidence that they are in continued use. We, therefore, can give them but little weight in the circumstances present here”); *SBS Products Inc. v. Sterling Plastic & Rubber Products Inc.*, 8 USPQ2d 1147, 1149 n.6 (TTAB 1988) (“[E]ven if evidence of such third-party use were submitted, it would be of no aid to respondent herein where the third-party usage was for goods unrelated to either petitioner's skin care products or respondent's stuffing box sealant”).

The Court of Appeals for the Federal Circuit, our primary reviewing court, has rejected similar third-party evidence where the marks were used on unrelated goods.

None of the third party marks and uses of ACE made of record are nearly as closely related to the activities of the parties as the virtually identical uses of the parties are to each other. Thus, we agree with the Board that nothing in the record shows a narrowing of Editors’ identification with A.C.E./ACE by third party marks with respect to the relevant public, namely, the film industry or even the broader entertainment industry. In sum, Cable's argument that it can use ACE because ACE is a “weak” mark, as an abstract proposition, is not only unpersuasive but essentially meaningless.

Nat’l Cable Television Ass’n, Inc. v. Am. Cinema Editors, Inc., 937 F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991).

The most relevant registration is Registration No. 4306540 for the mark **2112 FLASH FIRE & ARC FLASH PROTECTION** and design, shown below, for “flame retardant safety apparel, namely, coveralls, shirts, pants and jackets.”⁵⁵



As used in the above-noted third-party registration, the words “flash fire” and “arc flash” have descriptive meaning and engender a different commercial impression (*i.e.*, actual hazards against which the flame retardant apparel protects). Moreover, specialized safety apparel is only marginally related to general purpose clothing *per se* and these types of products move in different channels of trade.

Applicant introduced 17 third-party registrations for lightning bolts registered in connection with clothing.⁵⁶ The registrations displayed below are representative:

Mark	Reg. No.	Goods/services
	2956462	Men’s, women’s and children’s clothing; organizing and presenting professional football games and exhibitions
	4151023	Football jerseys, t-shirts and hats; organizing and presenting football games

⁵⁵ 39 TTABVUE 95.

⁵⁶ 39 TTABVUE 11, 15, 23, 27-86. Registration Nos. 3032097 and 3128746 are cancelled (39 TTABVUE 25 and 37). Registration No. 3071625 is registered for clothing patches. (39 TTABVUE 31).

Mark	Reg. No.	Goods
	3054143	Clothing, namely, athletic uniforms, caps, hat, t-shirts
	3089437	Clothing, namely, shirts, belts, and hats
	3311709	Clothing, namely, t-shirts, sweatshirts, and tank tops all relating to the martial arts

While these lightning bolt registrations show that third-parties have registered lightning bolt designs to engender the commercial impression of power or speed, none of the lightning bolt designs are remotely close the lightning bolt designs at issue before us: that is, Applicant’s mark is closer to Opposer’s lightning bolt design than any of the other marks.

As we turn to a comparison of the marks, we keep in mind that a lightning bolt design suggests power or speed and that the combination of the word “Flash” and a lightning bolt design engenders the commercial impression of a flash of lightning.

D. The similarity or dissimilarity of the marks.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *du Pont*, 177 USPQ at 567. In comparing the marks, we are mindful that where, as here, the goods are in part identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *Century 21 Real Estate*

Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Prod. Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007).

“The 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*, 101 USPQ2d at 1721 (quoting *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1905 (TTAB 2007); see also *San Fernando Elec. Mfg. Co. v. JFD Elec. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Rests. 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. *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971); *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Winnebago Indus., Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). Because the goods at issue are clothing without any restrictions or limitations, the average customer is an ordinary consumer.

Applicant is seeking to register the mark FLASH TEC and design, shown below:



Opposer uses the mark THE FLASH and a lightning bolt design shown below:



Moreover, Opposer uses the mark THE FLASH and the lightning bolt design together as shown below:

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⁵⁷ Gibbs Dep. Exhibit 163 (34 TTABVUE 196).

⁵⁸ Gibbs Dep., Exhibit 163 (34 TTABVUE 289).



Opposer's THE FLASH mark and the lightning bolt design may be considered together in assessing the similarity of the marks if Opposer establishes (1) that its marks have been and are being used on a single product or in marketing and (2) that they are used in such a fashion that it would be proper to combine them for purposes of comparison; that is, they have been used or advertised conjointly in such a manner and to such an extent in connection with a single product that they have come to be associated together, in the mind of the purchasing public, as indications of origin for Opposer's products. *Schering-Plough HealthCare Prods. Inc. v. Ing-Jing Huang*, 84 USPQ2d at 1326.

As to the first element, Michael Gibbs testified that THE FLASH comic books, featuring THE FLASH mark, character, and lightning bolt design on the character's

⁵⁹ Gibbs Dep., Exhibit 163 (34 TTABVUE 302).

⁶⁰ Gibbs Dep., Exhibit 163 (34 TTABVUE 379).

costume, is the cornerstone of the marketing program⁶¹ and that it is the character affinity and the application of the marks to the products that are driving the sales; that is, consumers are looking to associate themselves with THE FLASH mark and character and the lightning bolt design.⁶²

[P]robably one of the strongest attributes is the lightning bolt and how consumers have instant - - can instantly recognize the lightning bolt on a red garment that symbolizes The Flash. And then within that comes all the qualities and attributes The Flash [sic] that they want to associate with.⁶³

As discussed above, THE FLASH and the lightning bolt design function as secondary source indicators; that is, the primary significance of THE FLASH and the lightning bolt design on licensed products, including clothing, indicates to prospective consumers the sponsorship or authorization by Opposer.

Finally, as shown in Gibbs Deposition Exhibit 163, THE FLASH mark, character and lightning bolt design have been used on products and in advertising for licensed products, including clothing.⁶⁴ In point of fact, as seen from the above uses, the marks appear together on some clothing products.

As to the second element, we find that the mark THE FLASH and the lightning bolt design have come to be known together as indications of origin for Opposer's clothing as shown by the evidence of secondary source discussed above. Moreover,

⁶¹ Gibbs Dep. p. 15 (34 TTABVUE 18).

⁶² Gibbs Dep., p. 54 (34 TTABVUE 57).

⁶³ Gibbs Dep., p. 20 (34 TTABVUE 23).

⁶⁴ 34 TTABVUE 91

THE FLASH and the lightning bolt design have been used and advertised conjointly in such a manner and to such an extent in connection with Opposer's clothing that they have come to be associated together, in the mind of the purchasing public, as indications of origin for Opposer's products. See Gibbs Deposition Exhibit 163.⁶⁵ For example,

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We find that Opposer's marks THE FLASH and the lightning bolt design may be considered together and compared in combination to Applicant's mark in our likelihood of confusion analysis. Thus, the similarity or dissimilarity of the marks in this case may be based on a comparison of the conjointly used marks THE FLASH and a lightning bolt design with Applicant's mark **FLASH**  **TEC** rather than a comparison of each of Opposer's marks individually with Applicant's mark.

⁶⁵ 34 TTABVUE 91.

⁶⁶ 34 TTABVUE 92.

⁶⁷ 34 TTABVUE 96.

⁶⁸ 34 TTABVUE 118.

The word portion of Applicant's mark FLASH TEC encompasses the dominant portion of Opposer's mark THE FLASH. Generally, the indefinite article "the" has little trademark significance. *See In re Narwood Productions, Inc.*, 223 USPQ 1034 (TTAB 1984); *Jay-Zee, Inc. v. Hartfield-Zodys, Inc.*, 207 USPQ 269 (TTAB 1980); *United States National Bank of Oregon v. Midwest Savings and Loan Association*, 194 USPQ 232, 236 (TTAB 1977). If consumers place any significance in the indefinite article in THE FLASH, it serves only to highlight the significance of the word "Flash."

With respect to the design elements of the marks, both Applicant and Opposer have adopted a yellow lightning bolt descending diagonally from right to left, used (or intended to be used) in connection with the word "Flash" further highlighting the visual similarity of the marks.

Finally, Applicant's mark features a color scheme that is similar in part to the colors associated with THE FLASH character. The FLASH character wears a red costume displaying a yellow lightning bolt. The color scheme chosen by Applicant projects a similar commercial impression to the trade dress associated with THE FLASH character. Trade dress may be probative of whether a word mark projects a similar commercial impression. *See Kenner Parker Toys Inc. v. Rose Art Indus. Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1458 (Fed. Cir. 1992); *Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 223 USPQ 1281, 1284 (Fed. Cir. 1984).

We note that Applicant's mark differs from Opposer's marks in that it includes the term "Tec" which is an abbreviation for "Technology."⁶⁹ Because of the ubiquity

⁶⁹ Applicant's Dep., p. 16 (40 TTABVUE 17).

of the term “Tec,” and variations thereof, and the use of the same color scheme in the respective marks, we find that Applicant’s addition of “Tec” does not serve to distinguish its mark from Opposer’s THE FLASH mark and lightning bolt design.

In view of the foregoing, we find that Applicant’s mark **FLASH**  **TEC** is similar to the conjoint use of Opposer’s marks THE FLASH and the lightning bolt design  in terms of appearance, sound, connotation and commercial impression.

C. Balancing the factors.

Because the marks are similar, the goods are in part identical, and the goods move in the same channels of trade to the same classes of customers, we find that Applicant’s mark **FLASH**  **TEC** for clothing items is likely to cause confusion with the conjoint use of Opposer’s mark THE FLASH and the lightning bolt design  for clothing.

Applicant’s pleading, in the alternative, that it should be entitled to a registration with a restriction not to seek registration in Classes 9, 16 and 28 is an acceptable affirmative defense. *See* Trademark Rule 2.133(b), 37 C.F.R. § 2.133(b); *see also* *Embarcadero Tech. Inc. v. RStudio Inc.*, 105 USPQ2d 1825, 1828 (TTAB 2013); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1220-21 n.5 (TTAB 1990) (applicant may make a request to restrict goods set forth in its own application by way of affirmative pleading in answer). Based on the record in this case, however, Applicant’s proposed restriction does not obviate the finding of likelihood of confusion so as to permit its mark to register.

Decision: The opposition is sustained.