Bloomberg BNA

BNA's
Patent, Trademark & Copyright Journal®

VOL. 90, NO. 2223 AUGUST 7, 2015

Trademarks/Likelihood of Confusion

'Gotham Batmen' Softball Team Likely to Cause Confusion With DC Comics' 'Batman'

The use of the name ''Gotham Batmen'' by a networking company's softball team was likely to cause confusion with DC Comics' famous ''Batman'' character, the Trademark Trial and Appeal Board ruled July 17 in a nonprecedential decision (*DC Comics v. Gotham City Networking, Inc.*, T.T.A.B., No. 91194716, 7/17/15).

The board also ruled that the team name was not parodic because it was likely to cause confusion, and because the joke was on the group's members, not Batman himself.

In a dissenting opinion, Administrative Trademark Judge Jyll Taylor said that DC Comics had failed to establish that ''Batman'' was a famous mark entitled to extensive protection because DC had not proven the trademark connection between DC and Warner Bros. Studios, makers of the ''Batman'' movies.

The majority had found ''Batman'' to be famous largely because of the films.

Not the Trademark Gotham Deserves. Gotham City Networking Inc. filed to register ''Gotham Batmen'' with a stylized bat-like logo for use with networking referral services and ''entertainment in the nature of amateur softball games.''

DC Comics, which owns the rights to Batman and numerous trademarks related to the superhero, opposed the registration on dilution and likelihood of confusion grounds.

After finding that DC's Batman trademark was famous in connection with comic books and movies—and therefore entitled to trademark protection in many different classes of goods, including the classes at issue—the board turned to whether there was a likelihood of confusion between the marks.

The board found that most of the factors from the *In re E. I. du Pont de Nemours & Co.* (C.C.P.A. 1973) likelihood of confusion test favored DC:

- The marks had ''confusingly similar'' commercial impressions—and ''Gotham'' did not distinguish Gotham City's mark because of its prominent place in the Batman mythology.
- The types of goods were similar because DC licenses sporting equipment including baseball gloves, bats, caps and jerseys.
- The channels of trade and classes of consumers were the same; ''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.''
- There were no reported instances of actual confusion, but there may not have been a significant opportunity for actual confusion to have occurred, making this factor neutral.

The Jokers. Gotham City also argued that its trademark constituted a parody of Batman.

The board, however, found that ''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,'' and it found that ''Gotham Batmen'' did create such confusion.

The board also said that Gotham City's parody defense didn't apply in any case because the mark parodied the group's members, not Batman.

As the group's president said, the joke was that the group members ''refer to themselves as superheroes of the softball field and super networkers.'' Therefore, the parody targeted the group itself instead of DC Comics.

Emily Campbell of Dunlap Codding PC, Oklahoma City, told Bloomberg BNA that for a parody defense to succeed in trademark law, the parodist has to walk a ''fine line'' between resembling the parodied mark and making a point.

''Honestly, it seems like the more outrageous the joke, the more successful the parody mark is,'' Campbell said.

Campbell offered as an example *Girl Scouts of U.S. v. Personality Posters Mfg. Co.*, 304 F. Supp. 1228 (S.D.N.Y. 1969).

In that case, Campbell said that a poster of a pregnant woman wearing a Girl Scout uniform with the Scouts' slogan ''Be Prepared'' written underneath qualified as an example of an outrageous joke that worked as a trademark parody.

 ISSN 0148-7965

The poster clearly referenced the Girl Scouts' trademark, but also didn't create a likelihood that anyone would believe the Girl Scouts had created or endorsed it.

Campbell said the fact that the ''Batman''-''bat men'' softball joke wasn't as immediately obvious didn't bode well for Gotham City's chances that its mark wouldn't cause confusion.

Interesting Dissent. The dissenting opinion said that DC had failed to establish that ''Batman'' was a famous mark for the purposes of a trademark dilution claim.

The majority found the relevant trademarks famous based largely on the public's exposure to them through Warner Bros. Studio's ''Batman'' movies.

Taylor, however, said that DC failed to produce a licensing agreement between DC and Warner Bros., and therefore DC could not use the films to prove the fame of its marks.

Taylor also said that ''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.''

Campbell said that Taylor's concerns were valid, and the majority's famous mark analysis could be an issue on appeal.

''The dissent is interesting because there does seem to be a hole in the evidence. The majority filled in the blanks to come to the conclusion that we all recognize the Batman name, but I think that to adhere to the law'' the board needed to make a fuller analysis, Campbell said.

Campbell said that the lack of proof of a connection between DC and Warner Bros. was a ''glaring hole that needs to be addressed,'' and she could see this issue being appealed, especially since Gotham City still appears to be using the mark.

''I'm curious to see where this goes next,'' Campbell said.

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Text is available at: http://pub.bna.com/ptcj/91194716.pdf.

  PTCJ ISSN 0148-7965