



analogous use saves the day for comic book character trademark

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In *Cosmic Crusaders LLC v. Andrusiek*, No. 23-1150 (Fed. Cir. Oct. 19, 2023), a case involving comic book characters and trademark rights, the U.S. Court of Appeals for the Federal Circuit explored the application of the "prior use" element of a trademark likelihood of confusion claim under Section 2(d) of the Lanham Act. The court placed particular emphasis on the ways to prove prior use – not just "actual use," but also "analogous use." In doing so, the court provided useful insights for those looking to protect character names as trademarks.

The Appellants sell comic books under the mark "CAPTAIN CANNABIS" (the "CC Mark"). Laverne John Andrusiek also sells comic books under the same, although unregistered, CC Mark. The comic books sold by both parties also contain a fictitious character under the same "CAPTAIN CANNABIS" name. When Andrusiek learned of Appellants' registration for their CC Mark, he filed a petition for cancellation based on a likelihood of confusion with his own mark. Andrusiek contended that, based on common law rights, his use of the CC Mark predated the 2014 date of Appellants' application. Given that both parties used the same CC Mark on the same products, the parties conceded that the only disputed issue was priority of use.

Under Section 2(d) of the Lanham Act, a mark may be excluded from registration (or cancelled) when a mark is likely to cause confusion with a mark or trade name previously used or registered by another. A party alleging a likelihood of confusion must prove it had "priority" – meaning the party must show it had certain proprietary rights, which can be demonstrated by "actual use" or "analogous use."

"Actual use" may be shown by a prior registration, prior trademark or service mark use, or prior use as a trade name. However, a trademark owner's "use" of the mark need not be this direct to satisfy the prior use element. The trademark owner can also claim priority of use based on "analogous use" by others or on uses that are only indirectly used with the goods or services but have an impact

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on the consumer's impression of the mark. Under prevailing law, "analogous uses" are uses of the mark that create an association that must reasonably be expected to have a substantial impact on the purchasing public before a later user acquires proprietary rights in a mark.

The court cited multiple examples of analogous use, including use of the mark in advertising brochures, catalogs and newspaper ads, on samples displayed at trade shows, and in press releases and trade publications. Unlike the examples of "actual use," the "analogous use" examples affix the mark onto something other than the good itself. However, even with analogous use, the court noted that there is still a "timeliness requirement," where after a party engages in analogous use, the party must then actually use the mark in connection with goods within a commercially reasonable timeframe.

The Trademark Trial and Appeal Board (the "TTAB") granted Andrusiek's petition for cancellation, and Appellants appealed this decision contending that (i) the TTAB abused its discretion by considering Andrusiek's analogous-use argument; and (ii) Andrusiek had not provided sufficient evidence to prove prior use. After finding that the TTAB did not abuse its discretion by considering the analogous-use argument, the court upheld the TTAB's decision to cancel Appellants' CC Mark, holding that Andrusiek provided ample evidence to show analogous use and actual use, thus giving his mark priority over Appellants' CC Mark.

The court rejected Appellants argument that analogous use required direct evidence of public association." Rather, an impact on the purchasing public could be inferred based on Andrusiek's use of the mark to promote the comic book. The court then found that there was sufficient evidence to support an impact on the purchasing public. This evidence included Andrusiek's (i) registration and maintenance of a website under the URL "captaincannabis.com;" (ii) attendance at trade shows and conventions where he distributed materials on the comic books; (iii) distribution of photocopies of "premiere issue" versions of the comic book that specifically referenced the "Captain Cannabis" character as the "star attraction" of the book as well as reference Andrusiek's website; (iv) presentation of statements from his publisher of comic book sales; (v) active maintenance of social media accounts using the image of the screenplay entitled "Captain Cannabis: The Ultimate Hit;" and (vi) participation in interviews praising Andrusiek's work with the comics. The court also cited multiple news and magazine outlets that associated CAPTAIN CANNABIS with Andrusiek's comic books, with viewership totaling to about 750,000 people per month as additional evidence of a public association. Given the relatively "small" and "niche" market for marijuana-related goods and services due to federal and state restrictions, the court supported the TTAB's findings that there was ample evidence to support that "more than a negligible portion of the relevant market" had associated Andrusiek's comics with his CC Mark from 2006 to the present, thereby pre-dating Appellants' registration.

Likewise, the court found that the Appellants' argument regarding the lack of actual use within a commercially reasonable time lacked merit. Appellants argued that the TTAB relied on a single comic-book title and asserted, "the title of a single book cannot serve as a source identifier" as a matter of law as cited in the decision in *Herbko Int'l, Inc. v. Kappa Books Inc.* While this legal statement is generally true, the court found that this argument misstated the record, citing that Andrusiek had also used the mark in connection with a related *series* of goods including a movie, screenplay, and comic book. These uses, combined with other testimony and documentary evidence, supported the TTAB's conclusion that actual use occurred in 2017, which was within a commercially



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reasonable time period following Andrusiek's analogous use, even though it came after the 2014 filing date.

As a result, the court affirmed the TTAB's decision to grant the petition to cancel Appellants' CC Mark. This ruling serves as a useful reminder of the power of analogous use and the ways in which use can be established in the field of expressive works and beyond.