

MARVEL COMICS, LIMITED, Plaintiff, v. DEFIANT, a division of ENLIGHTENED ENTERTAINMENT, L.P., Defendant.

93 Civ. 5343 (MBM)

UNITED STATES DISTRICT COURT FOR THE SOUTHERN DISTRICT OF NEW YORK

1993 U.S. Dist. LEXIS 20845

September 30, 1993, Decided

DISPOSITION: [*1] The application for a preliminary injunction denied.

COUNSEL: SKADDEN, ARPS, SLATE, MEAGHER & FLOM, Attorneys for plaintiff; BY: KENNETH A. PLEVAN, of counsel.

PROSKAUER, ROSE, GOETZ & MENDELSON, Attorneys for defendant; BY: MARYA LENN YEE and WALTER ELIOT BARD, of counsel.

JUDGES: Before: HON. MICHAEL B. MUKASEY, District Judge

OPINIONBY: MICHAEL B. MUKASEY

OPINION: THE COURT: The purpose of today's session, as you know, is to announce my decision on the preliminary injunction hearing. It is as follows:

Plaintiff and defendant are comic book publishers. Both are at the initial stages of publishing new comic book series. Plaintiff's series, which has been announced to the trade and to consumers at trade shows and in plaintiff's other comic books, is called "Plasmer." Plasmer is the name of the lead character in the book, a female scientist named Oonagh Mullarkey who succeeded in transforming herself during a laboratory experiment into infinitely divisible good and bad beings with complete control over how those beings manifest themselves and each molecule of each such manifestation. The name was formed as a compound of plasma, a word that means, among other things, ionized gas, and polymer.

Defendant's [*2] series, the first of which has been published, is called Warriors of Plasm. Plasm is a place rather than a character, a planet where the ecosystem has been exploited to the limit and the inhabitants must survive by recycling protoplasm either from within the planet or from characters lured or kidnapped from without. The comic book explores the demands that such conditions place on the inhabitants of the planet, including the demand to suppress individuality for the sake of the common good and the opposing struggle for individual freedom.

This case is before the court on plaintiff's motion for a preliminary injunction barring defendant from distributing or advertising its comic book under its current name as an alleged infringement of plaintiff's mark.

For the reasons set forth below the injunction is denied.

The requirements for obtaining a preliminary injunction are familiar. They include a showing of likely irreparable injury in the absence of a preliminary injunction, coupled with a showing of either likelihood of success on the merits or at least a fair ground for litigation coupled with balance of hardships tipping decidedly in favor of plaintiff. Here, plaintiff fails because [*3] it has failed to prove likely irreparable injury and therefore has failed to prove also likely success on the merits. In addition, the balance of hardships is at most even and probably tips in defendant's favor.

In cases such as this, before a plaintiff may proceed to show irreparable injury, which involves a showing of likely confusion among potential consumers, it must show that the mark in question is strong enough to warrant protection. Strength of the mark is measured in two ways -- conceptually and economically.

The four categories of conceptual strength set forth in *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4 (2d Cir. 1976), are generic, descriptive, suggestive and arbitrary or fanciful. Although the divisions between these categories themselves are somewhat arbitrary in another sense, the mark "Plasmer" is best characterized as suggestive, meaning that the mark "requires imagination, thought and perception to reach a conclusion as to the nature of the goods." *Hunting World* at 11. Plasmer is not arbitrary because it relates to the content of the comic book and the physical properties of the lead character who can transform herself in various ways like a gas [*4] or polymer substance. The name is not like Camel Cigarettes or Shell Gasoline, which involves a completely arbitrary juxtaposition of a mark and a product with no a priori relationship between the two.

A suggestive mark like this is strong enough to warrant protection.

There has been no showing of commercial strength of the Plasmer mark as measured by consumer perception. The mention of the name in Stan's Soapbox, a feature column of comic book news appearing in plaintiff's other comic books, and the distribution of a brochure entitled, "A Gathering of Heroes," including a brief description of the upcoming comic book series at a trade show in San Diego in August of 1992, have not been shown to have created any appreciable public awareness of the title.

As mentioned above, the showing of irreparable injury in cases such as this is made by a showing of likely consumer confusion. Here, there has been no showing by survey evidence of such confusion, nor is there any evidence of actual confusion. Therefore, I must rely on assessing the similarity of marks, keeping in mind that that assessment must be made so far as possible by recreating or at least considering the conditions of the [*5] marketplace. *McCarthy on Trademarks and Unfair Competition* (3d Ed. 1992) Sections 23.20 [2] and 23.17 [1].

Similarity is essentially a sound, sight and meaning test -- McCarthy at section 23-04 -- but it is important to keep in mind how goods are sold in order to weigh these components. The parties have stipulated that both comic books are sold or to be sold, as the case may be, in what is called the direct rather than the mass market -- which is to say in stores devoted particularly to comic books rather than on newsstands or in drug stores or other outlets not devoted exclusively to comic books. The evidence at the hearing showed that comic books in the direct market are purchased by people who enter the store as opposed to telephone order or other methods -- and that the books are displayed principally in alphabetical order by title. Although defendant's book is entitled "Warriors of Plasm," it appears likely that because the planet Plasm is the focus of the story, the books will be displayed in the P section rather than in the W section. Indeed, plaintiff's exhibits 61 and 62, photographs of comic book store displays, show that the book is displayed in the P section. In [*6] addition, whatever similarities are found must be considered in relation to the sophistication of the consumer.

There is obvious phonetic similarity between Plasmer and Plasma. However, although word of mouth may play a strong role in the popularity of a comic book, the actual selection is made visually.

Although the two comic books have similar sounding names, the sight and meaning tests yield a finding that the marks are dissimilar. The name Plasmer appears principally in block style letters with the letters alternating large and small -- thereby suggesting the protean qualities of the heroine, with the exception of the middle letter S, which is larger than any other letter and assumes a more elongated and sinuous form than the other letters -- again suggesting the properties of the heroine. In addition, the first issue of Plasmer, apparently rushed to print for purposes of this litigation, shows that main character on the cover in her good and bad manifestations, the good introducing herself with "Hi, I'm Plasmer!" and the evil with "Me too, heh heh!" Plaintiff has conceded that future issues also will show the main character on the cover, although perhaps with not such an explicit [*7] designation.

By contrast, defendant's book shows "Warriors of" in rudimentary capital letters rising and falling above and below the horizontal, with the word "Plasm" rendered in what I would describe as gelatinous capital letters that appear to be flowing and dripping at their edges, thereby suggesting the biomass that is at the heart of the struggle on the planet Plasm. Although the first issue of defendant's book shows a monster that plaintiff claims resembles Plasmer's evil self, I see no resemblance beyond the natural tendency of many comic book monsters to have sharp teeth and frightening facial expressions.

The appearance of the two comic books is not similar beyond the name. Here it is important to keep in mind that a feature of comic book titles is that they are consistently rendered from one issue to the next, as illustrated in plaintiff's exhibits 61 and 62. Thus, for example, Predator is always in block capitals of the same size, The Punisher is always in block capitals with the first and last letters larger than the rest, and so on. What that means is that a customer with any experience in buying comic books would be alerted by the difference in appearance between the [*8] two books to the substantial possibility that they do not have the same origin or portray the same characters.

In addition, the names and logos of publishers are displayed prominently in the left-hand corner of each cover, further differentiating the two comic books.

Finally, the meaning of the two marks as exemplified by the content of the two books is sharply different. Beyond a generally biotechnological context there is no resemblance whatever between the two books.

It is useful before evaluating the similarity of the products in a market setting to consider the sophistication of the consumer. Defendant's evidence showed that 75% of the customers of comic book stores -- the relevant market in this case -- are regular customers who account for 74% of sales. Defendant exhibit LL. That leaves about 25% who may be assumed to be infrequent customers. Even that would be a sizeable enough group to justify an injunction if I were to conclude that there was a likelihood that these infrequent customers or any substantial proportion of them were likely to be confused.

In order to consider similarity of the market setting, I must consider two possibilities. The first is that the two [*9] products will be displayed side by side or in close proximity. The second is that defendant's Warriors of Plasm but not plaintiff's Plasmer may be displayed in a particular store with the result that a consumer seeking plaintiff's product will be confronted instead only with defendant's product. The question is whether there is a likelihood of confusion in either scenario.

There is little likelihood of confusion in the first scenario. As mentioned above, comic book titles remain consistent in appearance from issue to issue. The dissimilarity in appearance would be immediately apparent and invite at least a cursory examination of the books. Although it was noted at the hearing that comic book dealers are generally alert to make sure that customers do not simply read the books in the store rather than buy them, a customer certainly could examine the books and a cursory examination would disclose the differences. This dissimilarity would be apparent even to an inexperienced customer so long as that customer had even a slight acquaintance with the genre of comic books. In view of the prevalence of comic books, it seems unlikely that even a neophyte will be having his or her first encounter [*10] with the comic books on a visit to a comic book store at which a purchase will be made.

That leaves the second scenario in which the purchaser is seeking plaintiff's Plasmer but the store stocks only defendant's Warriors of Plasm. However, no evidence has been introduced as to whether any stores habitually stock the magazines of certain publishers and not others, which seems doubtful, and there is no way based on the evidence presented to estimate the frequency with which this would occur. Even if it did occur, the court must still assess the likelihood that the purchaser will buy defendant's book by mistake. That would depend on what the purchaser knew what he was looking for -- "he or she," I should say, although the evidence indicated that it is mostly he. In order to find a likelihood of confusion sufficient to warrant an injunction, I would have to find that the prospective purchaser was acting on word of mouth, and knew only the title of the book -- Plasmer -- and nothing else. In such an event, the purchaser might well buy Warriors of Plasm shelved in the P section instead. But that doubly hypothetical possibility -- a store that had copies of defendant's book but not of plaintiff's, [*11] and a purchaser who knew nothing but the name of plaintiff's book -- is simply too tenuous, absent any

evidence whatever, to justify an injunction. Even a purchaser acting on word of mouth that included so much as a rudimentary description of the contents of the book would know that Warriors of Plasm is not about the character depicted in Plasmer.

For the above reasons, plaintiff has not shown a likelihood of confusion and therefore has not shown a likelihood of success on the merits either. In addition, it appears that plaintiff is the Goliath in this struggle and defendant the David, which is to say the balance of hardships is far more threatening to the defendant's existence than it is to plaintiff's.

Accordingly, the application for a preliminary injunction is denied.

The foregoing will constitute my findings of fact and conclusions of law pursuant to Rule 52, Fed. R. Civ. P.

(Time noted: 5:15 p.m.)