



THE “SUPERHERO” TRADEMARK

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INTRODUCTION

The word “Superhero” was first used in 1917. A superhero is a kind of heroic stock character or public figure, generally possessing supernatural or superhuman strength and powers, who is committed to battling crime, protecting people, and mainly battling supervillains.¹ A female superhero is technically called a superheroine, despite the fact that the word superhuman is generally used for females too. Superhuman fiction is the genre of fiction that is fixated on such characters, particularly in American comic books since the 1930s. In early 1970s the two famous comic book franchises started focusing on licensing and trade marking their superheroes which ultimately led to both the corporations holding the trademark for the word “Superhero” in 1979.

Based on most definitions, characters do not require real superhuman strength or powers or phenomena to be regarded as superheroes. According to the dictionary the meaning of the word “hero” is “a figure, particularly in a comic strip or cartoon, equipped with superhuman strength and powers and generally depicted as battling evil or crime”, the Merriam-Webster dictionary gives the definition as “a fictional character having remarkable or superhuman

powers; also: an exceptionally skillful or successful individual”. Terms, for example, masked crime fighters, costumed swashbucklers or masked vigilantes are used to allude to characters.

Some superheroes utilize their powers to counter every day crime and evil while also fighting dangers against humankind from supervillains, who are their criminal counterparts. Generally at least one of these supervillains will be the superhero's archenemy.

Some of the famous and long-running superheroes are Spider-Man, Batman, Iron Man, Superman, Captain America, Wolverine, Wonder Woman, Deadpool, The Flash, The Hulk etc.

Studies have shown that whenever a person hears the word “Superhero” he or she thinks of either Marvel or DC hence establishing that, these corporations have a monopoly over superhero/ comic book industry. In my opinion is a reasonable claim from both the corporations over the trademark of the word “Superhero” and it was absolutely clever on their parts to own the trademark jointly.

The occasions of jointly registering trademarks are uncommon however not obscure and the words “Superhero” or “Superheroes” and every single alternate version including these words are altogether registered as trademarks of Marvel and DC both. As the years progressed, Marvel or DC has pursued litigation against individuals for infringement of their trademark.

¹ Wikipedia Encyclopedia, Superhero, Mar 2012, https://en.wikipedia.org/wiki/Superhero#cite_note-46

HISTORY OF THE TRADEMARK



The word "Superhero" was first used in 1917, to allude to "a public figure of great accomplishments". Meaning, in those days a "Superhero" was practically just a successful human. It was at some point after the 1930s, that the word began taking current implications i.e. Superheroes being individuals with superhuman powers.

The exact time of the Golden Age of Comic Books is not clear, however most concur that it began with the launch of Superman in 1938. Superman is the most conspicuous and famous superhero to this day. The accomplishment of Superman produced a whole new genre of characters with secret identities and superpowers.

Neither Marvel nor DC (the Duo) pinned the word superhero, but does not act as a factor in determining the ownership of trademark. Neither of the corporations were the first to register the word "Superhero" as a trademark.

Ben Cooper Inc., was the first to register the word "Superhero" as a trademark for the product costumes, in 1967. In 1972, Mego Corporation attempted to register "World's Greatest Superheroes" for toys; however Ben Cooper Inc. sued them.²

Mego soon became burnt out on the legal proceedings and gave over the burden to Marvel and DC. Despite overwhelming opposition, Ben Cooper Inc. dropped their opposition and by the late 1970s, it had gone bankrupt and gave over all its exclusive

rights concerning the trademark to Marvel and DC.

In the middle of the dispute between Ben Cooper and Mego, there was a drop in comic book sales, Marvel and DC began focusing on licensing. By the 1970s, The Duo began profiting out of licensing registered trademarks, (for example, "Superman"), than out of comic book sales. Therefore, it did not take them much time to understand the degree of lucre accessible in the mark "Superhero". The Duo obtained trademark over the word "Superhero" in 1979. Basically, by 1983, The Duo had rights over "Superhuman" over different

The US Trademark and Patent Office explains over what categories they have trademark:

"Publications, Particularly comic books and magazines and stories in illustrated form, cardboard stand-up figures, playing cards, paper iron-on transfer, erasers, pencil sharpeners, pencils, glue for office and home use, such as is sold as stationery supply, notebooks and stamp albums."

Through the years, Marvel or DC has pursued litigation against people for infringement of their trademark, the most recent being where a British Businessman was sued for the title of his book, "Business Zero to Superhero" and he won the suit. More about this can be read from here . But this suit has led to looking closely into the very existence of this trademark and on whether this is actually beneficial or not,

² Sakshi Sharma, The Origin Story of "Superhero", Nov 21st 2016, <http://www.mondaq.com/india/x/546340/Trademark/The+Origin+Story+Of+Superhero>



both to the consumers and the owners of the mark.³

Critics in the legal community dispute whether the "Super Hero" marks meet the legal standard for trademark protection in the United States: distinctive designation of a single source of a product or service. Controversy exists over each element of that standard: whether "Super Hero" is distinctive rather than generic, whether "Super Hero" designates a source of products or services, and whether DC and Marvel jointly represent a single source.⁴ Some critics further characterize the marks as a misuse of trademark law that will competition.⁵ To date, aside from a failed trademark removal action brought in 2016 against DC Comics' and Marvel Comics' United Kingdom registration, no dispute involving the trademark "Super Hero" has ever been to trial or hearing.⁶

VALIDITY OF THE TRADEMARK

The instances of jointly registering trademarks are rare but not unknown and the words "Superhero" or "Superheroes" (and the diametric opposite i.e. Super villain) and all alternate versions involving these words are all registered as trademarks of Marvel and DC both. In fact, if usage of the trademark in this very article could amount

to trademark infringement, provided that it is used for commercial purposes and unjust enrichment by means of free riding on the good will of the owner of the marks.

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There had been few popular instances which are noteworthy, apart from the above mentioned case of the British author's book are, Superhero Cleaners, a house cleaning service where the employees were supposed to be dressed in the traditional tights and capes of a Superhero but Marvel and DC had sent them a notice when they attempted at registering their service under the Trademark of Superhero Cleaners, and their registration was subsequently abandoned.

Superhero Donuts, where two students aimed at selling donuts inspired not from comic books (and to avoid Marvel/DC from holding them for trademark infringement and to skip the line of usage permission) but from the heroes of the Bible. However, the term Superhero is still used by them.

However, if the term superhero is considered to be generic then why hasn't the Court struck it down yet. Further, drawing from the examples of Xerox and Frisbee

³ Prateek Suriseti, The Superhero Trademark, Aug 18 2016, <https://spicyip.com/2016/08/the-marvellous-duo-and-their-superhero-trade-mark.html>

⁴ Coleman, Ron (March 27, 2006). "[SUPER HERO@ my foot](#)"

⁵ Doctorow, Cory (March 18, 2006). "[Marvel Comics: stealing our language](#)"

⁶ Stewart, DG (June 1, 2017). "[The "Superhero" Trademark: how the name of a genre came to be owned by DC and Marvel, and how they enforce it](#)".



itself, the companies still do own the trademarks, despite them becoming really common among the public. To decide on whether the mark is generic or not, what must be looked at, is the way it is used as in the registration of the mark itself, it is defined as descriptive and has been used that way by both the houses. In addition to this, there exist other superheroes that are famous and do not belong to either DC or Marvel, like Hell Boy or Spawn or Teenage Mutant Ninja Turtles and all of them are pretty famous amongst the masses as comic books or licensed movies. Therefore, though Marvel and DC comics are associated with "superheroes" the claim that the public associates the term "Superheroes" with these two houses only, in my opinion, is a feeble ground, thus rendering the claim of the mark as invalid.

Secondly, the concept of trademarks works in the way of protection of the product name and goodwill of companies by means of consumer recognition and since there are two competing houses registering for the same mark, it goes against the very nature and essence of trademarks being identification of a single source for the good. Apart from this, this registration can also be viewed as a market strategy by means of two houses monopolizing on the mark, thus eliminating competition. This registration thus, just seems unfair to small businesses, which is explained in detail in this article by Ross D. Petty where he states instances as to how Marvel and DC comics often bombard the smaller businesses with notices, thus leading to them abandoning their registration application.

The concept of joint ownership in trademark law is not new, but still is rare. There are three instances where the joint ownership of a mark is permitted. The first is in the context of a "composite mark" used by a joint venture where two unrelated entities may form a single joint venture, licensing their intellectual property, including trademarks, to that joint venture for use in the market. The second situation is "concurrent use," whereby two parties are granted separate registrations, permitting them to use the same mark in connection with a similar product albeit in different geographic markets. The third scenario is when joint ownership is permitted and appears to extend logically from the classic *Menendez* doctrine: a trademark registration may be jointly owned by, and the goodwill associated with the mark apportioned among, the heirs of a unitary owner.⁷

The joint ownership of the mark by DC/Marvel was not evolved overnight and in fact, both the competing houses had originally decided to battle for the owning the mark as well, by filing separately for the same. However, both these houses (and their smart lawyers) realized that the other would be using the mark as much as the one owning it, thus competing against one another in the courts for something as simple as the name of the book that they are publishing as well. To minimize this and the confusion at the source, joint registration of the mark was allowed and the rest they say is history.

⁷ Brian Cronin, The Superhero Trademark FAQ, Mar 28 2006, <https://www.cbr.com/the-superhero-trademark-faq/>



Marvel and DC monitored registrations for trademarks that contained the word “superhero” and instead of immediately filing an opposition, they simply asked the registration office for more time to file an opposition. The applicant, upon learning about the Duo’s chagrin, would be intimidated by the Duo’s might or might settle with them. Not one application (of 36 so far) has seen a trial.

Apart from monitoring registration applications, they also bully around enterprises through the mere threat of suing. The Duo’s strategy seems to be to take the opposition right to the precipice of a trial, hoping that the opposition would either back out or settle before that. Even if they don’t put across any threats, the mere knowledge of the Duo’s formal ownership over the mark makes competitors weary of using “superhero”.

CONCLUSION

When someone thinks of a superhero, they undoubtedly think of a product from either DC or Marvel. The term “superhero” has become distinctly known as coming from DC or Marvel.

Whether or not this mark is actually a means of eliminating competition by limiting their usage of the term "Superhero" or is exploitative to smaller businesses or is what two owners of a registered mark do as their genuine duty for the protection of the mark is something that needs to be decided by the courts as and when disputes arise on a case to case basis but the recent case is a glimmer of hope, an exception to the usual rulings and stands true to one of the principles that

"Superheroes" embody, nothing is impossible.

Therefore, it is imperative that trade mark officers take up the responsibility that competitors haven’t. There is a need for registration officers to scrutinize an applicant’s mark in a comprehensive manner, because otherwise, we have seen how a registered mark can be misused. Even after registration, when the companies have to revive their trademarks, reviewers need to have a much closer look for testing generosity. If the US trade mark office had done that in 2006, the Duo might not be having their trademark today.

