

A SUPER HERO-ic Trademark Takedown

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“Enjoy your reign while you may, Superman. For surely as night follows day, there comes a time when even gods must die.”

– Lex Luthor, *Superman: Doomsday*

Last month, the creators of beloved characters like “Superman” and “Spider-Man” declined to come to their *own* rescue when their SUPER HERO and SUPER HEROES registrations were cancelled by a default judgment from the U.S. Patent and Trademark Office’s Trademark Trial and Appeal Board (the “Board”).

Marvel and DC have reigned as the titans of the comic book industry for decades. Although, it is possible that some of this success can be attributed to the rivals’ joint ownership of the SUPER HERO and SUPER HEROES registrations, the earliest of which registered in the United States in 1967.

This saga began when Marvel and DC opposed an effort by a London-based artist and his company, Superbabies Limited (“The Super Babies”), to register the mark SUPER BABIES—the name for a comic book series featuring superpowered infants. But The Super Babies fought back by filing a cancellation petition that alleged Marvel and DC were using a strategy “ripped straight from their own supervillains’ playbook” by using their trademark rights to “stifle competition and exclude others from the marketplace,” rather than to “prevent confusion.” Ironically, the petition cites an old Spider-Man comic where the recurring villain Kingpin “registered Spider-Man as a trademark, and used threats of litigation and financial ruin to pressure Spider-Man into letting Kingpin operate without SUPER HERO interference.”



In particular, the petition attacked Marvel and DC's ownership of the SUPER HERO marks on genericness and abandonment grounds. A mark becomes "generic" when it no longer distinguishes one product or service from another, but rather, is commonly used to refer to an entire category of products or services. Because the term "SUPER HERO" is widely used to refer to an entire genre or character archetype, The Super Babies argued that the mark was no longer distinctive and should be cancelled under 15 U.S.C. § 1064(3).

In addition to the mark becoming genericized, The Super Babies also alleged that the SUPER HERO mark had been abandoned by Marvel and DC in three ways: (1) by allowing each other—as fierce competitors—to use the SUPER HERO mark; (2) by allowing the general public to use the SUPER HERO mark as the name of an entire genre; and (3) by themselves using the SUPER HERO mark as a generic label instead of as a source identifier. The petition highlighted how unusual it is for industry competitors to jointly own a trademark and argued that this arrangement was "antithetical to the foundational purpose of trademarks." The Super Babies argued that, as competitors, the

Lanham Act prohibits Marvel and DC from jointly owning a single mark, since the mark cannot not identify a single source of goods and services in these circumstances. After Marvel and DC failed to file a response, the Board issued an order cancelling the registrations. While DC and Marvel have the option to file a motion seeking to set aside the default judgment for good cause, they would face an uphill battle. At the time of this post, no further motions have been filed, though the TMCA will continue to monitor the case.

The epic fight between The Super Babies, Marvel, and DC demonstrates the delicate balance between protecting one's intellectual property assets without overly restricting creation or innovation. With great power—i.e., the exclusive ownership of a trademark—comes great responsibility—including to stop generic use of your mark. However, in an attempt to shoulder this responsibility by opposing The Super Babies' applications, Marvel and DC landed themselves in a greater web of trouble. The Super Babies' victory also serves as a warning to owners of trademark registrations that may be vulnerable to cancellation. In general, registrants' spidey senses should be tingling when they attempt to enforce rights in arguably abandoned and/or genericized marks. Indeed, even incontestable registrations are vulnerable to generic attacks, nor is there a time bar for attempting to cancel generic registrations. But now that the SUPER HERO mark has been unmasked and returned to the public domain, the saying that "anyone can be a [super] hero" may finally ring true. Well, at least anyone can be a super hero . . . without fear of a lawsuit.