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Superheroes Tussle with IPR

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Marvel! DC! I am pretty sure even reading these words brings characters such as Captain America, Iron Man, Batman, Superman, etc. to your mind. Marvel and DC have established themselves as global players in the comic industry as well as in the cinema. People are divided between these two companies and have been following them for decades. This brand loyalty that is making Marvel or DC earn huge chunks of money has its driving force in the intellectual property that they have acquired over these years. Intellectual property is such intangible property that results in the creation of tangible property later on. By acquiring Copyrights and Trademarks in their artistic and literary works, Marvel and DC have been able to provide deeper protection to their characters and obtain exclusive rights to use the same. By trademarking taglines and combinations of colors, they have also excluded other competing businesses from using their products. This article intends to cover all the IP laws that exist in the fictional world of superheroes.

Keywords: *intellectual property, marvel, dc, copyright, trademark, exclusive right.*

INTRODUCTION

Comic books are treasured by everyone, be it Gen Z or the Millennials. From Chacha Chaudhary, Tinkle, Archie to Marvel and DC Comics, there are numerous comic books available in the world. In fact, comic books date as far back to 1933 published in newspapers as comic strips. By 1935 reprints of newspaper strips and books with original stories were being

sold in large quantities.¹ In 1939, Martin Goodman created Timely Comics (the precursor to Marvel comics). Timely Comics introduced many superhero characters such as the Human Torch, Sub-Mariner, and Captain America. These characters were often portrayed fighting the Nazis and the Japanese even before World War II.² In 1951, Timely Comics became Atlas Magazines and in the early 1960s Atlas became Marvel Comics. In 1956, DC Comics created their own universe and established a strong foot in the comic industry. Characters such as Superman, Batman, Wonder woman are all products of the DC Universe.

With over more than 10,000 characters in the DC Universe³ and 37,000 Marvel comics,⁴ DC and Marvel are the two big comic giants of the industry. Besides comic books, they have expanded their operations in the cinematic universe as well as the creation of merchandise. As these companies are based entirely on their creative assets, having intellectual property protection is very vital for them. Intellectual Property helps protect creations generated by the human intellect. According to World Intellectual Property Organization (WIPO) *"Intellectual property refers to creations of the mind – everything from works of art to inventions, computer programs to trademarks and other commercial signs."*⁵

Intellectual Property broadly exists in:

- original literary, musical, dramatic, or artistic work (Copyright),
- distinctive mark identifying a good or service (Trademark)
- a new product or process involving an inventive step (Patent)
- features such as shape, pattern, the composition of lines, colors (Design)

Since DC and Marvel have established themselves as rival brands in the market, there have been a number of Intellectual Property issues surrounding the comic books and the

¹ 'Comic Book' (*Encyclopedia Britannica*) <<https://www.britannica.com/art/comic-book>> accessed 18 August 2021

² 'Marvel Comics | History, Characters, Facts, & Movies' (*Encyclopedia Britannica*) <<https://www.britannica.com/topic/Marvel-Comics>> accessed 18 August 2021

³ 'Comics' (DC) <<https://www.dccomics.com/comics>> accessed 18 August 2021

⁴ 'A-Z List of Marvel Comic Characters | Marvel Comic Characters List' (*Marvel Entertainment*) <<https://www.marvel.com/comics/characters>> accessed 18 August 2021

⁵ WIPO, 'What is Intellectual Property?' (*WIPO*, 2020)

<<https://www.wipo.int/publications/en/details.jsp?id=4528>> accessed 18 August 2021

superheroes created by them. Two of the most important being copyright and trademark issues. Comic books contain original literary and artistic work such as the storyline, characters, their dialogues, and their overall appearance, which are protected under the Copyright domain. However, the name and outlook of a comic book can also be protected by Trademark. These issues are hereby discussed in detail.

COPYRIGHT PROTECTION

Copyright is one of the inherent forms of IP. It comes into existence as soon as the work is created. However, registering a copyright provides a wider remedy. According to U.S. Copyright Office, “Copyright is a type of intellectual property that protects original works of authorship as soon as an author fixes the work in a tangible form of expression.” Copyright, thus, grants the owner an exclusive right to use his work. Copyright can subsist in an original literary, dramatic, musical, or artistic work. Comic books contain a storyline and different characters, which are works of literary and artistic nature, and are thus protected under copyright.

While every comic book contains the basic idea of good and evil, this idea per se is not protectable. Copyright protects every author’s original expression of the idea. Therefore, even though the characters of Marvel and DC both fight injustice and crime, their expression of depicting that idea through their original characters is unique and copyrighted. As the ultimate beneficiaries of the work created are the public, copyright is granted to the owner for his creativity and hard work. Although copyright is granted for a limited period of time, it provides the author the exclusive right to reproduce and perform the work, as well as the right to make adaption and derivative works for the duration of the copyright term. Thus, copyright is a negative concept, where the public at large is barred to have a right to copy the author’s creation.

AUTHORSHIP AND WORK FOR HIRE

Section 2(d) read with Section 17 of the Indian Copyright Act, provides who is the author/ first owner of the copyrighted works. The writer in case of literary and dramatic work,

composer for musical work and the artist for artistic work, is considered the author for such works. In creating a comic book, a storyteller or a writer, a sketch artist, and an inker (person who actually brings life to the characters by adding colors) all play an equally important role. Therefore, in such a situation a question as to ownership arises. The US Copyright Act, 1976 defines joint work as: “a work prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole.” This Act clearly states that it is the intention of the parties that play a vital role in determining the question of joint authorship. If all the parties have the intention to become authors, that prevails; otherwise, whichever party intends to take the authorship he will become the author.

Now, a lot of writers and artists are employed by the company to create certain works. In such a case, the authorship vests with the employer company as these works are said to be works created for hire. The creators are paid an amount for their work but the intellectual property they create is treated as created by their employers. Their rights are automatically transferred to the employer unless there is an agreement to the contrary. These artists thus lose any royalties they could have possibly earned working independently.

Such was the situation when Marvel first started producing comic books. Marvel hired Jack Kirby, a comic book artist, who created characters such as Captain America, the Incredible Hulk, and the Fantastic Four. Kirby used to work with Stan Lee while creating these characters. While Kirby’s character brought fame and recognition to Marvel, the rights in these characters were not owned by him. Marvel had full control and rights over these characters. In 2009, Kirby’s heir sued Marvel (now owned by Disney) for copyright termination notices. The US Courts ruling in favor of Marvel held that Kirby’s work was a work for hire and he was working as a freelancer. While determining whether Kirby was working for hire or not, the court applied the “Instance and Expense Test.” Kirby used to work at the instance of Marvel (usually as asked by Stan Lee) Stan Lee also asserted that Kirby did most of his work keeping Marvel in mind and according to the “Marvel Method” established by him. Kirby was given the liberty to set his own time and work from home. He was paid only for the work accepted by Marvel. Marvel’s this right to supervise was more than enough to establish that the works

were created at Marvel's instance. The courts thereby held that as there was no agreement to the contrary between Marvel and Kirby, Kirby's work was a work for hire and was not entitled to receive the royalties. Thus, the protection of copyright (or Intellectual Property at large) is not granted to work-for-hire employees because their creation is transferrable to their employers at the instance of completion of the particular task they are hired for.

TRADEMARK PROTECTION

According to Investopedia, *"the term trademark refers to a recognizable insignia, phrase, word, or symbol that denotes a specific product and legally differentiates it from all other products of its kind. A trademark exclusively identifies a product as belonging to a specific company and recognizes the company's ownership of the brand"*. Therefore, the brand name and even the taglines or phrases associated with the brand name have been provided trademark protection.

Marvel and DC being distinctive names have been granted this protection. There are a variety of elements in comic books which are also protected under trademark law. They include, character names such as Spiderman, nicknames such as Spidey, key phrases associated with the character like *"Your friendly neighborhood Spider-Man"*, *"My Spider-sense is tingling!"* and even its costume (the red and blue tights with the black web pattern and the black spider on his chest). Thus, a trademark protects the names and likenesses of comic book superheroes. It is due to this protection that Marvel and DC are character merchandising and earning a lot of revenue.

Trademark ownership can also exist jointly. The Indian Trade Marks Act, 1999 under Section 24 lays down a provision for jointly owned trademarks. Joint ownership exists between two or more parties when there is a mutual agreement between them to jointly use and hold a single mark. In such a case, neither party is an absolute owner of the mark and the rights to use the trademark are vested jointly between the parties.

Joint ownership in a trademark is although an unlikely scenario but is not rare. The interesting thing to note here is that the word *"Superheroes"* is a Registered Trademark. Superheroes being related to Marvel as well as DC is jointly owned by the two big giants. That means by

using this word here can be liable for an infringement if this article is used for commercial purposes or for driving unjust benefit from the goodwill of the owner of the mark.

The history of this word (not the trademark) began in 1917 when it was used to describe a “public figure of great accomplishments.” In the 1940s when comic books came into the picture, people started associating this term with someone possessing supernatural powers. Superman was the first person to be associated as a Superhero. However, in 1967 Ben Cooper Inc. was the first to register “Superhero” for its product costumes. Meanwhile, in Manhattan, Mego Corporation tried to register “World’s Greatest Superheroes” for its toys. However, it got sued by Ben Cooper Inc. The comic giants were gradually realizing the importance of licensing and owning trademark protection. Therefore, when Mego Corp. got tired of the legal proceeding it decided to hand over its application to Marvel and DC (hereinafter referred to as the Duo). They succeed in the same. By the late 1970s, Ben Cooper Inc. got bankrupt and assigned all the original rights in favor of the Duo.

The Duo realized that there is no point fighting over getting individual trademark right as it will eventually lead to neither of them being granted the trademark. Thus, they decided to work together and filed for joint ownership. The US Trade Mark and Patent Office (USTPO) states that they own the trademark over:

“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.”⁶

Over the years the Duo has attained rights over several other products. Some of them are listed below:

⁶ United States Patent and Trademark Office, 'Trademark Status & Document Retrieval' (TSDR, 2021) <https://tsdr.uspto.gov/#caseNumber=1179067&caseSearchType=US_APPLICATION&caseType=SERIAL_NO&searchType=statusSearch> accessed 20 August 2021

Mark	Ownership	Owners	Reg. No.	Goods and Services
SUPER HEROES	Assignment	Marvel Characters, Inc. DC COMICS Warner Communications Inc.	3674448	t-shirts
SUPER HEROES	Original Applicants	Marvel Characters, Inc. DC Comics E.C. Publications, Inc.	5613972	Production and distribution of a series of animated motion pictures, and entertainment services in the nature of cartoon exhibitions.
SUPER HEROES	Assignment	Marvel Characters, Inc. DC COMICS PARTNERSHIP	1179067	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 sold as stationary supply; notebooks and stamp albums]]]
SUPER HEROES	Assignment	Marvel Characters, Inc. DC COMICS Partnership	1140452	Toy Figures.
SUPER HERO	Assignment	Marvel Characters, Inc. DC COMICS Partnership	0825835	Masquerade Costumes
COMPUTER SUPERHEROES	Assignment	Marvel Characters, Inc. DC COMICS comprised of Warner Communications Inc.	3419713	Computer service, namely, acting as - an application service provider in the field of knowledge management to host computer application software for creating searchable databases of information and data...

After establishing joint ownership, the biggest question is How can a Generic term like “Superheroes” be trademarked? According to World Intellectual Property Organization (WIPO), “a trademark is a sign capable of distinguishing the goods or services of one enterprise from those of other enterprises.”⁷ This means that having distinctiveness is an essential feature for a trademark. Distinctiveness can be of two kinds: Inherent and Acquired. Inherent

⁷ WIPO, 'Trademarks' (WIPO) <<https://www.wipo.int/trademarks/en/>> accessed 22 August 2021

distinctiveness means that the trademark has sufficient features to act as a distinguishable identifier from other sources of goods or services in the marketplace.

On the other hand, acquired distinctiveness, also known as “secondary distinctiveness”, implies that the mark was not distinctive, to begin with; but has gained significance or significant popularity among its consumer base. And now the consumer base associates it with that particular product. Although the word “Superheroes” is in existence since 1917, it was relatively new when the comic books were launched and were popularized by the Duo through their characters. Thus, in this case, “Superheroes” attained Acquired distinctiveness and the companies were able to establish that whenever a common man thinks of this word, he is reminded of the characters of either Marvel or DC. They were able to prove this fact through various surveys and reports. US Trademark and Patent Office considered this a reasonable ground for granting the protection.

Therefore, the term "Superhero" has become distinctly known as coming from DC or Marvel, just like Band-Aid or Xerox which even though descriptive in nature have acquired secondary meaning as a brand in itself. Now, registering a trademark is not enough. The owner has to establish concurrent use of the mark and has to take steps to protect the mark from infringement. Marvel and DC have retained this trademark for over a decade by stopping other parties whenever they infringed their trademark. Superhero Cleaners, Superhero Donuts are some of the businesses where Duo was successful in stopping the infringement. However, there are two cases that are most renowned.

1. “A world without Superheroes” is a book published by Mr. Ray Felix in the year 2010. Mr. Ray wanted to get this title of his book trademark but was stopped by the Duo. Mr. Ray fighting the order of the USPTO stated that Marvel and DC have created a monopoly over a word found in the English Dictionary and are suing independent comic creators.

Jonathan Reichman, Marvel and DC lawyer, in return, said,

“We are not trying to remove a word from the English language... We are just doing what we have done for decades – protect a trademarked term. And we always try to resolve matters amicably instead of going for a court hearing, which saves everyone a lot of time and money.”

The dispute went on for negotiations and amicable settlement but was eventually withdrawn by Mr. Ray in 2014.

2. “Business Zero to Superhero” is a book for startups written by a British author Mr. Graham Jules. In the United Kingdom, DC Comics and Marvel are the joint proprietors of the mark SUPERHEROES (“the registration”)

The registration covers the following goods in Class 16:

“Paper table napkins, invitation cards, stationery, pens, pencils included in Class 16, stamps (not being tools) stamp albums, photograph albums, notebooks, scrapbooks, coloring books.”

Marvel and DC's lawyer applied for trademark infringement when Mr. Graham tried to register his book's name. Mr. Graham's counterattack to declare trademark for “Superheroes” invalid. He stated that it is a common generic term used by the media and has no distinctive characteristic. The registration was also held to be violative of the “Free Use Doctrine” established by the EU. Mr. Graham not being a trademark lawyer failed to provide evidence of the state of mind of a consumer while reading his book.

The hearing officer repeatedly noted:

“The onus is upon [Mr. Jules] to demonstrate that, in 1979, the average consumer would perceive the term SUPERHEROES when used in respect of the goods for which it is registered, as indicating a characteristic of those goods rather than trade origin. As I have already commented, there is no evidence before me to illustrate this. There is nothing to suggest that, at that time, the average consumer, upon encountering the contested mark being used in respect of such goods, would perceive it as anything other than an indicator of trade origin.”

Even though Mr. Jule's book was nowhere related to the comic book "superheroes" and class 16 does not cover such instances, yet he was stopped from getting the title registered. This clearly states the amount of power a registration of a trademark can provide to the owner. However, Marvel and DC are slowly creating a duopoly market over the word "Superhero" - a generic, part of the English language word. This was not the purpose of trademark registration. On the other hand, Marvel and DC are establishing concurrent use of their product in the market so that they can get their registration renewed successfully. It will be easy for them to establish that they have stopped infringement within a reasonable time frame no matter what the outcome of the case is.

Getting a descriptive and non-distinctive word trademark faces the challenge of becoming generic. Some of such examples include, "Frisbee", "Aspirin", "Rollerblades", etc. The situation is somewhat analogous to the remarks of an English judge, Lord Davey, in an 1899 case called **Cellular Clothing Co Ltd vs Maxton & Murray**:

"... where a man produces or invents ... a new article and attaches a descriptive name to it - a name which, as the article has not been produced before, has, of course, not been used in connection with the article - and secures for himself either the legal monopoly or a monopoly in fact of the sale of that article for a certain time, the evidence of persons who come forward and say that the name in question suggests to their minds and is associated by them with the plaintiff's goods alone is of a very slender character..."

Another English judge, Justice Jacobs, explained in a case called **British Sugar plc vs James Robertson & Sons Ltd**:⁸

"There is an unspoken and illogical assumption that "use equals distinctiveness". The illogicality can be seen from an example; no matter how much use a manufacturer made of the word "Soap" as an unsupported trademark for soap the word would not be distinctive of his goods."

Marvel and DC, therefore, need to be very vigilant and ensure that their word does not fall in the public domain for being too generic.

⁸ *British Sugar PLC v James Robertson & Sons Ltd* 1996 RPC 281 Chancery Division UK

CONCLUSION

“Superheroes” – the mighty creatures that are undefeatable by mind, strength, and will, are superseded by the might of the legal regime of the Intellectual Property Laws. The same has been visually presented in their movies as well. (Sokovia Accords in the Marvel Cinematic Universe’s *Captain America: Civil War*, or the judicial hearing in the DC Extended Universe’s *Man of Steel*). However, instead of weakening them, IP Law has only protected and strengthened the identity they have attached with the readers, watchers, and fans.

Comics have the elements of artistic and literary works to avail the protection of Copyright. However, Marvel and DC have ventured much beyond comic books, and have found huge success. Their cinematic/animated creations, merchandise, and studio developments also require to be protected. Thus, the protection of the Trademark has also been extended to them. So much so, that they have been successful in protecting and preserving a generic term as a trademark. Interestingly, the protection of Patents has also been availed by Marvel Inc. for a fictional creation – Captain America’s Shield! This, we will reserve for another time. For now, the author rests their case. However, given the profound interest in IPR, it would not be wrong for the author to say – “I can do this all day”.