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RESEARCH

Generic Super Heroes: Can They Exist?

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The term 'superhero' would seem, at first glance, to be generic. That is to say, 'superhero' may be a word or term used to refer to any caped, masked or costumed crusader who fights crime, whether super powered, inhuman, demigod, or genius playboy billionaire philanthropist. However, the legalities of super heroes are far more nuanced than that. This article discusses the use of 'super heroes' in light of the fact that the term is covered by a trade mark right jointly held by Marvel and DC. It discusses the protection that Marvel and DC maintain over their mark, the impact of this protection, the challenge to the validity of the registration which was heard in 2016, and the possibility of a declaration of genericide, which would allow the term superhero to be freely used.

Keywords: DC Comics; genericide; Marvel Characters; monopoly; superhero(es); trade mark(s)

Superhero (n): A person with extraordinary heroic attributes; (now *spec.*) a benevolent fictional character with superhuman powers, typically one who features in a comic strip or film (*Oxford English Dictionary*, 2011).

Introduction

A registered trade mark allows the holder of the mark to use that mark as a designation of origin for their goods. The purpose of a trade mark is to give that holder rights to protect the use of a mark which is capable of being represented graphically and distinguishing their goods or services from another (*Trade Marks Act (TMA) 1994: s 1*). It grants them the right to take infringement proceedings if another party uses an identical or confusingly similar mark on identical or similar goods in the course of trade (*TMA 1994: s 10*). The two largest comic book and graphic novel producers in the world, Marvel and DC, jointly hold a range of trade marks which cover the term 'super heroes'. In effect, what their successful registration of the term 'super heroes'

achieves is to restrict the use of a genre title to the two biggest companies in the industry, and enable them to prevent others from using that term to describe their goods which are similar or identical – their trade mark creates a statutory monopoly on the term. This in turn means that a generic super hero cannot actually exist. This article discusses, primarily from a UK perspective, the purpose and registration of trade marks. It outlines the trade marks Marvel and DC hold on the term, particularly in the UK, and why these are a detriment to the superhero genre. It then moves on to discuss how Marvel and DC have protected their trade marks through legal action and trade mark opposition in both the US and the UK. The article covers the failed challenge to the validity of the registration of the UK trade mark. Finally, the article considers alternative actions for cancellation of the trade mark, applying genericide, before concluding that this could well allow the generic super hero to exist.

A note on terminology: Although the Marvel and DC trade mark cites the term as 'super heroes', for the purposes of this article, the singular 'super hero' and compound 'superhero' and 'superheroes' versions are all used interchangeably. The reasoning behind this is that one of the grounds on which trade mark registrations can be challenged, or trade mark infringement claimed, is the use of a similar mark on identical goods (ie, use of the term 'superhero' on a comic book) where the use of the mark is likely to cause confusion to the consumer (*TMA* 1994: s 10). Trade mark similarity is certainly a topic for discussion (Setchi, 2016), but it is less relevant to this article specifically. There is doubtless a strong argument to be made that the term 'superhero' is confusingly similar to 'super heroes' and thus Marvel and DC's trade mark opposition encompasses the variety of spellings and plurals of the term 'super heroes'. This article follows the same body of reasoning in assuming that similar marks such as superhero, superheroes, and super hero will fall within the bounds of trade mark similarity.

Trade Mark Purposes

The purpose of trade marks is often debated, with conceptions ranging from the economic purposes of trade mark registration as monopolies (Lunney, 1999) to semiotic analysis of concepts of distinctiveness and dilution (Beebe, 2004). There is a rich

and deeply interesting history of the development of trade marks, reaching back as far as Ancient China, Egypt, India, Greece, and Rome. Marks on pottery, jewellery, ironwork, bricks, and other craftworkers have all been uncovered in archaeological finds, stretching even to bread found in Pompeii which was stamped with the mark of the baker (Karapapa and McDonagh, 2019, 213). These have been catalogued by Schechter in his seminal work as production and proprietary signs (Schechter, 1925). Historical development has brought us to the modern-day situation where trade marks are used to indicate goodwill in a particular trader or group of traders, and marks indicate origin, rather than acting as a guarantee of quality (Karapapa and McDonagh, 2019, 215). Thus, the use of a trade mark indicates that goods come from a particular manufacturer or supplier, and that perception will exist in the mind of the consumer also – buying a chocolate bar with 'Cadbury' on the wrapper will bring certain expectations as to provenance of the goods. There is, however, debate whether a trade mark can or should act as a monopoly, as well as whether trade marks protect the consumer or the owner of the mark (McKenna, 2007). In a situation where a trade mark protects the owner of a brand, how does this chime with the encouragement of free competition and avoidance of monopoly situations? Specifically with relation to the mark being discussed, super heroes, how does the restriction of the term to only two comic book producers encourage free competition in a market which is undoubtedly lucrative?

Case law history on registration of trade marks has demonstrated that there is a general judicial unwillingness to grant broad marks, on the grounds that it would create an unfair monopoly. See, for example, *Re Coca-Cola Trade Marks (1986)*, which sought to register a trade mark in the shape of the Coca Cola bottle, its design registration having expired, and *British Sugar plc v James Robertson & Sons Ltd (1996)*, which concerned a trade mark registration in the word 'Treat' for dessert toppings and syrups. Although commentary can be found to argue that the granting of trade marks does not create monopolies (see, for example, Karapapa and McDonough, 2019, 217) and debate stretching back decades on the detrimental effects of monopolophobia (Pattishal 1952), the situation as discussed here is quite different to a standard trade mark registration, given that the term at issue is a genre title, and

frequently generically used. It is likely that a trade mark registration submitted at this point on the term super heroes (assuming none already existed) would be denied, as it is insufficiently clear in indicating an origin of goods. Nonetheless, the situation in reality differs for several reasons – primarily because the trade marks at issue are already registered.

Trade Mark Registration

Marvel and DC jointly hold trade mark registrations for the term Super Heroes and variations thereof in several territories. Although the first iteration was registered with the US Patents and Trade Marks Office (PTO), it is also validly registered across the EU. A jointly registered UK word mark is held by Marvel LLC and DC Comics LLC applying to the word 'super heroes' in classes 16 (books and paper products), 25 (clothing, footwear, and headgear), 28 (toys and games), and 30 (tea, coffee, breads, cakes, and pastries). It was registered in the UK on 12 December 1979 and has been periodically renewed since its first registration (DC Comics and Marvel Characters 1979). An EU-wide trade mark in the same term (super heroes) also exists, which was filed in 2003 and registered in 2007 (DC Partnerships and Marvel Characters 2007). This trade mark registration is not for an image or depiction of the term super heroes, such as a logo, but over the words themselves. While trade marks can (and indeed often do) consist of specific images, designs, typefaces, or colours, such as the Cadbury logo, with its distinctive swirled C (**Figure 1**) (Cadbury UK Limited 2000), they can also be over specific words. Cadbury UK also holds a trade mark in the word 'Cadbury' when not displayed in its distinctive images (Cadbury



Figure 1: Cadbury UK Limited 2000, *Cadbury* [image mark], Trade Mark no EU 001367515 © Cadbury UK Limited (2000).

UK Limited 2005). Thus, a word mark in the term 'super heroes' effectively grants Marvel and DC, two of the largest comic book companies in the world, jointly held control over the term super heroes, to the exclusion of others who wish to use the term in the UK in the categories of books and printed materials, clothes, toys, and foodstuffs. Anyone who uses the term 'super heroes' on goods which are not exclusively Marvel and/or DC could be subject to a suit for trade mark infringement, on the basis that they are using an identical mark on identical or confusingly similar goods (*TMA 1994*: s 10). The same situation is replicated in other territories, including the US, where the companies are based, and where their first jointly held trade mark is registered (DC Comics Partnership and Marvel Characters, Inc 1974).

Trade Mark Enforcement

In practice, although Marvel and DC could potentially challenge uses of the term super hero within printed material, this does not appear to be their approach. Rather, their trade mark enforcement efforts seem to have focused on those goods and services which infringe their registered trade mark in titles, and competing trade mark registrations. This is certainly the position that commentator Brian Cronin takes (2006). While it is difficult to assess how often Marvel and DC as trade mark holders send cease and desist letter to potential infringers, there is evidence of their using this as a prelude to proceedings for trade mark infringement. On receipt of a cease and desist notice, creators (especially independent or short run comic book creators) may cede to the requests of the trade mark holders rather than engage in costly litigation. This was the case for (Super) Hero Happy Hour. Between its launch at the Mid-Ohio Comic Book Convention in 2001 and the publication of Hero Happy Hour: On The Rocks in 2003, the comic's title was truncated. The creators explained this as their response to a 'letter from the trade mark counsel to "the two big comic book companies"' (Brady 2004).

The co-creators, Dan Taylor and Chris Fason, continue to refer to their title change in promotional material, mentioning on their Patreon page that they 'had to change the title of the comic (dropping the 'Super') to Hero Happy Hour when the 'Big Two' comic book publishers felt threatened by the underdog..' (Patreon 2019).

Similarly, the creator of limited-run comic 'A World Without Superheroes' Ray Felix received a cease and desist letter requesting that he change his comic book title, and Marvel and DC opposed his trade mark registration application for the same title. After a four-year trade mark dispute, the parties settled, and Felix did not register the trade mark, although the comic continued to publish under the title (Felix 2019). These examples are not isolated. A search of TTABVue (the US Trade mark Trial and Appeal Board's online case registration system) shows 59 trade mark disputes which concern the term superhero, or variants thereof. Marvel and/or DC are plaintiffs (i.e. opposing the mark) in 55 of those actions. They are the defendant in another. Their consistent opposition to registration of marks containing the term super hero, super heroes, or superhero indicates their commitment to ensuring that their brand is not diluted by alternative providers. However, as we shall see later in the article, this may not be sufficient to protect their trade mark if challenged.

Although the examples discussed above are US-based, evidence of similar trade mark enforcement practices can be found in other territories. In the UK in 2015, Start Up Pop Up Ltd attempted to register a trade mark in the logo for its self-help start-up manual 'Business Zero To Superhero' (**Figure 2**). Marvel and DC opposed the trade mark registration. Proprietor of the business Graham Jules chose to respond to the opposition by challenging the validity of the original registration of Marvel and DC's mark. Although he was unsuccessful in this challenge (which is fully discussed in the next section), Marvel and DC did then elect to withdraw their opposition to



Figure 2: Start Up Pop Up Ltd 2013 *Zero to Superhero*, Trade mark no UK0000 3017203, © Start Up Pop Up Ltd 2013.

Jules' mark, and it was successfully registered in May 2016 (Start Up Pop Up Ltd 2013). This is somewhat unusual by comparison with the US examples, where the majority of trade marks have been refused registration. This is not to say that Jules' is the only valid trade mark which includes the term super hero or super heroes, but it is certainly unusual that the Big Two withdrew their opposition to a class 16 mark. Nonetheless, there now exists another trade mark in the UK which contains the term super hero, and is validly registered in the class covering books and printed matter. This may, however, be explained by the fact that this is an image, rather than a word, mark, and so it can only be used in the specific format depicted in the trade mark registration.

The Effect of These Trade Marks

The impact of Marvel and DC jointly holding a trade mark on the term super heroes is wide-ranging. Given the function of a trade mark as a brand origin, a potential supposition is that a valid trade mark in the term super heroes indicates that the only companies which can or should propagate stories, merchandise, and media referencing 'super heroes' should be the Big Two. Even where the actions of Marvel and DC are limited, as described above, to titles only, the 'chilling effect' of holding and enforcing this trade mark cannot be underestimated. The possibility of a cease and desist letter from the legal teams of two of the largest media companies in the world is likely a deterrent to many would-be creators, and its impact is difficult to quantify. Chilling effects can exist in many spheres, from constitutional law (Columbia Law Review, 1969) to domestic violence (Cloven and Roloff, 1993). The existence of 'trade mark bullying' (Manta, 2012) is documented across the trade mark spectrum, and the uneven power balance between Marvel and DC's joint legal team as compared to any other comic producer in the world is manifest.

The very existence of a trade mark on an industry standard term likely has severe (although as yet not fully documented) impact. It is possible to theorise that comic book or graphic novel creators may elect not to enter the genre of super heroes, or new entrants to the genre may elect to retreat when faced with the threat of legal action. Thus, while creativity itself may not be chilled, in that stories of heroes with super powers will continue to be created, the commercial exploitation thereof is

limited – although there are occasional entries of super hero characters onto the big screen (such as Dark Horse's Hellboy, who has had three cinematic outings in the 2000s), there is evidence which could be construed as wariness of infringing the mark. Disney Pixar's 'The Incredibles' (2004), for example, refers to its superhuman characters as 'supers' rather than 'super heroes'. This is not in keeping with the public perception of the term – it is highly unlikely that many would associate the term 'super heroes' with only Marvel and DC characters, and exclude The Incredibles, Hellboy, Hancock, or other characters with different origin stories. Of course, there are other influences which will impact on the development of films, many of which have nuanced elements which will interplay with aspects of the film industry, including studio 'deals' and confidence in particular producers or screenwriters, resulting in funding disparities also, but this article argues that the trade marks discussed here present an additional barrier which should be dismantled.

Further, the existence of a trade mark on the term 'super heroes' fails to 'protect the quality of market information, reduce consumer search costs, [or] safeguard the reputation of sellers.' (Bone, 2016) Rather, it creates an oligopolistic situation where the market in a booming cultural era is saturated with the content of two overarching bodies, and the protectionist, or bullying (depending on one's perspective) behaviours discussed in the section above reduce the entrance of new creators into the market.

There is doubtless debate about whether the superhero is a genre, and if it is a genre, whether it is one which straddles both comic books and films (Romagnoli and Pagnucci, 2013). It is possible that the superhero is, instead, a character archetype (Gilmore and Stork, 2014) and the films and media in which superheroes are depicted fall into other genres. There is a rich underpinning of literary and artistic theory around the superhero, its development, and its future, with many questions still to be answered. It is also unclear what the extent of the chilling effect of the trade marks is, and how it has impacted on the development of superhero stories in visual media. It is possible that there are many creators who have chosen not to develop or commercialise a superhero character for fear of potential legal action from Marvel and DC. Faced with the possibility of a trade mark infringement action,

whether it is a genre, or the superhero is a character archetype, the cautious creator may seek to develop their work in a different area, one less fraught with potential consequences. There is no way to know this for certain. The choices of individual creators cannot be known on a wider scale. What is clear, however, is that Marvel and DC jointly have a near-monopoly on the concept of the superhero, in direct contradiction of the general perception of the genre.

This is particularly evident in the superhero film genre. The past decade and a half has been declared the 'golden age' of the superhero film (Huls, 2016), and indeed of the superhero (Yeo, 2017), but an examination of the films released shows a distinct trend of featuring almost exclusively characters from, or linked to, the Marvel and DC universes. Although there are some superhero characters that have gained popularity in comic book media, and even transitioned to the big screen, such as Dark Horse's Hellboy (three Hellboy films were released in 2004, 2008 and 2019), they are rare in a market saturated with Marvel and DC characters. Of course, this does not suggest that the trade marks held by Marvel and DC are the sole reason for their market dominance in the genre. Indeed, there are multiple reasons why Marvel and DC dominate the superhero field, including differing cultural influences (Chapman, 2012), and the often-hidden history of the British Superhero (Murray, 2017).

Nonetheless, it is submitted that the existence of these trade marks is antithetical to the purpose of trade mark registration, and they fail to distinguish their goods or services as coming from a specific proprietor (not least because the marks are jointly held by two rival companies). This trade mark contrasts sharply with the perception of superhero as a generic, undefined person with superpowers, which straddles media types and proprietors, creating a tension between literary theory, which discusses superheroes as a genre construct (Cates, 2011), and the legal restrictions on using the term 'super heroes' on any media which is identical to, or confusingly similar to, the goods or services of the Marvel and DC only.

In this way, use of the term 'super heroes' could be subject to a challenge from Marvel and/or DC where it is used on any work which might conceivably fit into the superhero genre. This article now moves on to discuss the ways in which these marks could be challenged, in order to remove their influence from the superhero

genre, and eliminate the possibility of anti-competitive practice through bad faith challenges to the use of the term 'super heroes'.

Registration Challenge 2015

This article argues for genericide as the only potential ground for invalidation of the Marvel and DC trade mark because there is already relatively recent precedent which declared that the term was not generic and was validly registered at the date of first registration of the mark.

Graham Jules, proprietor of Start Up Pop Up Ltd, as discussed in the section above entitled trade mark enforcement, makes a reappearance as a trade mark challenger also. At roughly the same time as Marvel and DC opposed his trade mark registration, and presumably in response to it, Start Up Pop Up Ltd applied for a declaration that the Marvel and DC trade mark was invalidly granted (IPO 2016b). Succeeding in this argument would then mean that Marvel and DC did not have a competing interest and would not be able to oppose the registration of the aforementioned trade mark for the book title. The registration challenge was heard on 26th May 2016 (that is to say, thirteen days after the registration of the Business Zero to Superhero trade mark). Jules, on behalf of Start Up Pop Up Ltd, made four arguments, including that super heroes is a common generic term used by the media, that it lacks distinctiveness, and that super hero is used in a customary way in entertainment and fiction (IPO 2016b). Although these arguments might bear some merit, Start Up Pop Up Ltd.'s arguments failed due to the nature of the challenge it elected to pose.

Upon inspection by Mr Mark Bryant of the Intellectual Property Office, the arguments for invalidity were conclusively dismissed (IPO 2016). However, it is crucial to note that as the claim was that the trade mark was invalidly registered (and not that it was *now* a generic term used by the media), the evidence considered was from the 1970s, relating to use of the term super hero at the point of registration of the mark, not how it was used at the time of the challenge. Thus, a declaration was made by the IPO that the trade mark jointly held by Marvel and DC was validly registered in 1979 and continued to be validly registered up to the date of the challenge.

For this reason, although there is potentially an argument to be made that the term super heroes was generic at the point of registration, this article elects not to

re-tread arguments which have already been heard and dismissed by the IPO in opposition to the registration of the marks. Rather, it moves on to discuss how the marks could be challenged now, assuming the registration in the past was valid, in keeping with the decision of the IPO in 2016.

Despite the declaration of the mark's validity, Marvel and DC did eventually withdraw their opposition to the pending application for a trade mark; the trade mark Business Zero to Superhero was successfully registered, and remains valid, meaning that the trade marks coexist. Although Jules was successful in registering his trade mark, the continued existence of the jointly held Marvel and DC trade mark means that the companies still maintain **control** over the term 'super heroes', and can continue to issue cease and desist letters, or oppose trade mark registrations, for works which more closely compete with their proprietary interests – that is to say, the super hero genre as a whole.

Trade Mark Cancellation for non-use (Grounds 1 and 2)

Within the Trade Mark Act 1994, there are several other avenues to remove trade marks from the register, and thus allow the term super hero to return to common usage (*TMA* 1994: s 46(1)). The first of these is lack of use in the five years since registration (*TMA* 1994: s 46(1)(a)). Given that DC and Marvel have used the trade mark consistently since its first registration, this is unlikely to succeed.

The second ground for revocation of registration is 'use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;' (*TMA* 1994: s 46(1)(b)). Thus, both the first and second grounds for revocation could be properly described as non-use, with the distinction being whether the trade mark was never used or was allowed to lapse.

Where an application for revocation for non-use is made, a trade mark owner is required to adduce evidence of genuine use over a period of five years. The burden of proof rests on the trade mark proprietor to adduce sufficient evidence of use. It does occasionally happen that a trade mark in consistent use is cancelled – as was the case in 2019 with the cancellation of McDonald's 'Big Mac' mark (EUIPO 2019) – but this case turned on a lack of evidence, rather than actual non-use. Given this recent example, combined with the fact that Marvel and DC consistently use the mark, it

is unlikely a non-use action on 'super heroes' would succeed. It would be careless in the extreme for the legal teams of Marvel and DC to fall at the same hurdle which recently felled a similarly global company.

It is likely that the companies would prepare a submission which adduces evidence of their use of the term super heroes, such as in Lego Marvel Super Heroes, DC Super Hero Girls, etc. Interestingly, while it is a condition of the shared trade mark in class 30, which covers confectionary and gum (Marvel and DC 1967), that neither party use the mark independently, this restriction does not apply to the class 16 mark (Marvel and DC 1979), nor the EU mark which covers multiple classes (Marvel and DC 2007). Thus, use by one of the companies without the other in, for example, comic books could still be considered use under the terms of the mark. This then renders cancellation for non-use a less than appropriate avenue for attempting to challenge the trade mark and permit a generic super hero to exist.

Further, the existence of an appeals process for cancellation through non-use means that even if Marvel and DC were to suffer a cancellation in the same way as McDonald's, an appeal with sufficient evidence offers a second chance for the mark to avoid its permanent erasure. Finally, an action for trademark revocation for non-use ignores the greater issue – not that Marvel and DC do not use the term 'super heroes', as they certainly do, but that the term is not solely associated with goods and services coming from those providers.

Genericide (Ground 3)

The third ground for revocation from the *Trade Mark Act* is that 'in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered;' (*TMA* 1994: s 46(1)(c)). Known as 'genericide' (OED 2011), this transformation of a brand name from a designation of origin to a description of a class of products sounds a death knell for that trade mark. The Act specifies that any person may challenge a trade mark registration on the grounds listed (*TMA* 1994: s 46(4)). However, beyond the statutory wording, there is little guidance as to what would satisfy the test of becoming the 'common name in the trade' in the UK, and notably no published decisions of the UKIPO relying on this

provision. It has been put forward as an argument in several cases, notably *Hormel Foods Corp v Antilles Landscape Investments NV* (2005), *Hasbro Incorporate Inc v 123 Nahrmitte GmbH* (2011), and *32Red Plc v WHG (International)* (2011). However, none of these cases turned on issues of genericide. Rather, in all circumstances genericide was used as one of many defences to an infringement action, and only briefly considered in the decision. We can look to older jurisprudence to demonstrate the theory behind genericide. Jacob J provided the following illuminating commentary in *British Sugar plc v James Robertson & Sons Ltd* (1996):

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 trade mark for soap the word would not be distinctive of his goods.

Although referring to the likelihood of confusion in this specific case, the principles remain applicable to genericide also. It is important to note that when defending against a declaration under this provision, demonstrating use alone of the mark is not sufficient. We can see that while there is evidence that Marvel and DC certainly *use* the term 'super heroes', and variants thereof, the question for genericide becomes instead whether that use is distinctive enough to protect the trade mark from revocation.

The closest UK discussion of genericide can be found in *The London Taxi Corporation v Frazer Nash* (2017), which concerned shape trade marks – specifically in London taxicabs. It briefly discussed, with approval, the Kornspitz case, before dismissing it as not of assistance in making the decision regarding taxis.

Consequently, we must look to that EU jurisprudence, which applied the test for genericide from the 2008 Trade Mark Directive (Article 12) (now the 2015 Directive Article 20), in 2014 in Kornspitz (Case C-409/12) (Kornspitz 2014). The wording in the 1994 TMA, 2008 Directive and 2015 Directive, and indeed the 2017 EU Trade Mark Regulation (Article 58), is identical, namely, 'in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service in respect of which it is registered'.

The Kornspitz case considered the question of whether the requirements of Article 12 (2)(a) of the 2008 Directive would be fulfilled where the perception by the end-user is that the trade mark has become the common name for that trade mark. This case concerns the word mark KORNSPITZ, a registered trade mark held by Backaldrin Österreich The Kornspitz Company. Pfahnl sought revocation of the trade mark on the basis that end users perceived the word to refer to any oblong bread roll with pointed ends, and not solely those manufactured with Kornspitz flour and dough preparations. The Austrian Patent Office referred the case to the EU with several questions on whether the perceptions of end users were important (as opposed to trade users) in determining whether a trade mark was a common name for a product (Kornspitz 2014).

The judgment of the ECJ highlighted the essential function of a trade mark as an indication of origin (per Joined Cases C-236/08 to C-238/08 Google France and Google 2010), and considered whether the use or perception of the end user would be affected by the fact that neither the trade mark proprietor nor bakeries would generally advertise the fact that some bread rolls were made with Kornspitz mix, nor that the term Kornspitz was a registered trade mark (Kornspitz 2014). In answering the question put before the court, whether a trade mark was liable for revocation where, as a consequence of the actions or inaction of the proprietor, the trade mark had become the common name for a product solely in the perception of the end user, an affirmative response was given. In those circumstances, despite trade users' knowledge of the term KORNSPITZ as a registered trade mark, the ECJ affirmed that the trade mark could be revoked (Kornspitz 2014).

Trade mark genericide is a danger which looms large at the heels of many brand names. Particularly in the US, companies stave off the possibility of trade mark revocation with ever-more innovative tactics, from advertisements in trade magazines, as discussed in the World IP Review (2016), to catchy YouTube videos (Velcro® Brand 2017). This video has gained over half a million views. The reasoning behind this is clear. Trade mark revocation is not uncommon, again particularly in the US, and is a fate which has befallen many, including ASPIRIN, CELLOPHANE, and THERMOS (per Elliott v Google 2017). Yet Marvel and DC have not defended use of their trade

mark as vigorously as their history of litigation has indicated – indeed perhaps not even to the extent that their trade mark could resist a genericide challenge.

Application

Applying the test from Kornspitz to the term super heroes, we can disregard the earlier discussions regarding whether comic book creators or trade users regard the term as indicating a super-powered character originating from Marvel and/or DC, and instead look only to the perception of the end user in the EU. Thus, the question becomes: does the term super hero, to the end user (that is the consumer of comic books or their adaptations through film, television, and toys), refer only to the cast of characters owned by DC and Marvel? And have Marvel and DC acted in a way to prevent the term from being used to describe a genre, rather than their own specific characters?

Prima facie, no. Numerous sources indicate that the term is generic. The Oxford English Dictionary definition, as cited at the beginning of this article, makes no mention of the trade mark and does not indicate that it is a proprietary term (Oxford English Dictionary 2012). Contrast this against, for example, Velcro, Hoover, Xerox, Rollerblades, and Tippex, definitions for all of which indicate that they are a proprietary name for goods (Oxford English Dictionary, 2012). Wikipedia's entry on 'super hero' contains a sub-section which refers to the trade mark registration, but does not indicate its proprietary status in the introduction to the article ('Superhero' 2019), again contrasting against other trade marks such as Velcro and Tippex ('Velcro' 2019, 'Tippex' 2019). *Encyclopaedia Britannica* does not mention the trade mark at all (Misiroglu et al. 2018). The USPTO itself refers to inventor superheroes in a 2017 tweet (USPTO 2017). The IMDb, the largest online database of films and TV shows, lists superhero as a genre. The *World Comic Book Review* lists Superheroes as a genre of comic book, and published a 2017 article arguing that the trade mark should be revoked for lack of distinctiveness (Stewart 2017). Similarly, academic opinion indicates that the trade mark should fail an action for revocation through lack of distinctiveness (Petty 2010), or fails to even mention the fact that the trade mark exists (Vashko 1998, Price 1996). Even the USPTO refused registration for trade mark

applications depicting SUPERHEROES OF THE CIRCUS and SUPERHERO NETWORK on the basis of being merely descriptive (Petty 2010). Further, academic commentary within the area of graphic and comic scholarship does little to distinguish the trade mark. Coogan's article in the *Journal of Graphic Novels and Comics* refers to superhero as a genre, rather than a specific trade mark or designation of origin (Coogan 2018), while Fradkin's article in *The Comics Grid* makes no reference to limitations on the directory of superheroes he compiled (Fradkin 2016). Numerous edited works, readers, and academic works reference superheroes and do not limit themselves to the Marvel and DC character stable, several of which are referred to in this article (Gilmore and Stork, 2014, Murray, 2017, Romagnoli and Panucci, 2013). Finally, commentary on popular culture does not distinguish between a Marvel and DC Superhero, as opposed to a comic book hero – journalist and author Helen O'Hara's 2019 book 'The Ultimate Superhero Movie Guide' (O'Hara, 2019) features Hellboy on the cover, along with DC's Superman, Wonder Woman and Batman, and Marvel's Spider-man, Wolverine, and Black Panther.

Although Marvel and DC have defended their trade mark through opposing conflicting registrations, they have done little to satisfy the Kornspitz test for protecting a trade mark. There is no readily available evidence of their challenging the use of the term super heroes in books, genre classifications, consumer marketing, or indeed general commentary – newspapers, websites, magazines, and general commentary use super heroes as a term to cover the genre or characters as a whole, not restricting it to Marvel and DC characters. Instead, Marvel and DC's only activity has been in opposing trade mark registrations and sending cease and desist letters to comic book creators who infringe on their statutory monopoly. This activity, as best can be ascertained from the information available, has been focused towards industry insiders, rather than end-users. There is no evidence of attempts to emphasise the restriction of the term to their products only, unlike other brands which have seeped into the public consciousness. (*World IP Review*, 2016) This would, arguably, be sufficient to satisfy the test of 'inactivity', thereby allowing their mark to become the common name in the trade for their good or service – namely, the term 'super heroes' in comic books, films, and merchandising, refers to any person with extraordinary

heroic attributes (OED, 2012), rather than to the stable of characters housed exclusively under the umbrella of the Marvel and DC labels.

Marvel and DC have satisfied the test for 'inactivity' within the meaning of that provision by not encouraging sellers to make more use of that mark in marketing a product in respect of which the mark is registered. (Kornspitz 2014). Equally, Marvel and DC have failed to use the term 'super heroes' as an adjective to describe a brand of comic book or cartoon hero, but instead use it to describe a 'category of person', giving numerous examples such as 'Earth's Mightiest Super-Heroes', and materials filed in support of Marvel and DC's 1981 renewal of their shared trade mark (Petty 2010).

Finally, it is worth noting that there is no alternative term to describe superpowered heroes. This lack of an alternative presents a compelling argument that the term designates the item itself – rather than the source of the item. The same argument resulted in the cancellation of the trademark Escalator in the US in 1950 (*Haughton Elevator Co v. Seeberger*, 1950).

Taken together, it is clear that the use of a genre title to indicate a specific origin is, if not at the time of registration, certainly inappropriate at this point in time. 'Super heroes' does not indicate only those characters which come from Marvel or DC, and to claim that the term applies only to those two houses is to take cynical advantage of their dominant market position. Marvel and DC have failed to protect their trade mark in the eyes of the consumer or end user and have not taken steps to promote the use of an alternative term. Through the acts and inactivity of the trade mark holder, the term 'super heroes' has become (if it was not always) the common name in the trade.

Conclusion

Marvel and DC jointly own several currently valid trade marks in the term super heroes. The UK IPO has determined that their UK trade mark was validly registered at first registration, pursuant to the application of Pop Up Start Up Ltd. However, this article has argued strongly that the mark does not retain any distinctiveness with regard to the term super heroes, and indicates a category, rather than a specific

brand. Not only that, the generic term 'super heroes' applies to a genre as a whole, and the stranglehold that the 'big two' have over a descriptive term likely impacts negatively on the development of super heroes as a genre. Thus, an action for revocation of the trade mark pursuant to s 46(4) of the Trade Mark Act 1994 would, if properly evidenced, likely succeed and prevent Marvel and DC from enforcing their spurious trade mark, thereby removing their proprietary rights over a term which is monopolised by two industry giants. In conclusion, at time of writing, the generic super hero cannot exist, due to a statutory monopoly owned jointly by the 'Big Two'. However, it could require only one motivated third party to submit the revocation argument and write the origin story for the generic super hero.

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Competing Interests

The author has no competing interests to declare.

Editorial Note

This article is a piece of research that underwent double blind peer review by two external reviewers, and it is part of the Graphic Justice Special Collection edited by Thomas Giddens and Ernesto Priego with support from the journal's editorial team. Our gratitude to our pool of peer reviewers. Every effort has been made to trace copyright holders and to obtain their permission for the use of copyright material under educational fair use/dealing for the purpose and criticism and review and full attribution and copyright information has been provided in the captions.

References

- 32Red Plc v WHG (International) Ltd [2011] EWHC 62 (Ch), Ch D.
Backaldrin Österreich The Kornspitz Company v Pfahnl Backmittel. 2014. Case no. C-409/12. *Official Journal*, C 129/3.

- Beebe, B.** 2004. The Semiotic Analysis of Trade mark Law. *UCLA Law Review*, 51(3): 621–704.
- Bone, RG.** 2016. Notice failure and defenses in trade mark law. *Boston University Law Review*, 96(3): 1245–1292.
- Brady, M.** 2004. *Super Hero Happy Hour changes name* [Archived from the original on September 12, 2010]. Available at: <https://web.archive.org/web/20100912200525/http://forum.newsarama.com/showthread.php?s=&threadid=8650> (Accessed: 7 September 2020).
- British Sugar Plc v. James Robertson & Sons Ltd. 1996. *Reports of Patent, Design and Trade Mark Cases*, 113(9): 281–306. DOI: <https://doi.org/10.1093/rpc/1996rpc281>
- Cadbury UK Limited.** 2000. *Cadbury [image mark]*. Trade Mark no EU 001367515, 10 November, viewed 7 September 2020, <https://trademarks.ipo.gov.uk/ipo-tmcase/page/Results/4/EU001367515>.
- Cadbury UK Limited.** 2005. *Cadbury*. Trade Mark no EU 003507829, 17 January, viewed 7 September 2020 <https://trademarks.ipo.gov.uk/ipo-tmcase/page/Results/4/EU003507829>.
- Cates, I.** 2011. On the Literary Use of Superheroes; or, Batman and Superman Fistfight in Heaven. *American Literature*, 83(4): 831–857. DOI: <https://doi.org/10.1215/00029831-1437234>
- Chapman, J.** 2012. *British Comics: A Cultural History*. Reaktion Books: London.
- Cloven, DH and Roloff, ME.** 1993. The chilling effect of aggressive potential on the expression of complaints in intimate relationships. *Communications Monographs*, 60(3): 199–219. DOI: <https://doi.org/10.1080/03637759309376309>
- Columbia Law Review.** 1969. The Chilling Effect in Constitutional Law. *Columbia Law Review*, 69(5): 808–842. DOI: <https://doi.org/10.2307/1121147>
- Coogan, P.** 2018. Wonder Woman: superheroine, not superhero. *Journal of Graphic Novels and Comics*, 9(6): 566–580. DOI: <https://doi.org/10.1080/21504857.2018.1540137>
- Cronin, B.** 2006. *The Superhero Trade mark FAQ*. Available at <https://www.cbr.com/the-superhero-trademark-faq/> (Accessed 7 September 2020).

DC Comics Inc, and Marvel Characters, Inc. 1967. *Super heroes*. Trade mark no UK00000918433, 11 December, viewed 7 September 2020, <https://trademarks.ipo.gov.uk/ipo-tmcase/page/Results/1/UK00000918433>.

DC Comics Inc, and Marvel Characters, Inc. 1979. *Super heroes*. Trade mark no UK00001125479, 12 December, viewed 7 September 2020, <https://trademarks.ipo.gov.uk/ipo-tmcase/page/Results/1/UK00001125479>.

DC Comics (partnership), and Marvel Characters, Inc. 2007. *Super heroes*. Trade mark no EU 003357621, 27 July, viewed 7 September 2020, <https://trademarks.ipo.gov.uk/ipo-tmcase/page/Results/4/EU003357621>.

DC Comics Partnership and Marvel Characters, Inc. 1974. *Super heroes*. Trade mark no 73011796, 24 January [US].

Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (Codified version) (Text with EEA relevance) OJ L 299, p. 25.

Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks (Text with EEA relevance) OJ L 336, p. 1.

Elliott v. Google, Inc. 2017. 9th Circ. No. 15-15809.

European Union Intellectual Property Office. 2019. *Notification of Decision to the applicant (CANCELLATION No 14788C (REVOCAATION))*.

Felix, R. 2019. *A World Without Superheroes Vol. 1*, <https://www.bxhcc.com/a-world-without-superheroes-vol1.html#> (Accessed: 7 September 2020).

Fradkin, C. 2016. Pre-Cloak Comic Superheroes: Tools for the Empowerment of Children. *The Comics Grid: Journal of Comics Scholarship*, 6: 13. DOI: <https://doi.org/10.16995/cg.85>

Gilmore, J and Stork, M. 2014. *Superhero Synergies: Comic Book Characters Go Digital*. Lanham, Maryland: Rowman & Littlefield Publishers.

Hasbro Incorporate Inc v 123 Nahrmitte GmbH [2011] EWHC 199 (Ch), Ch D.

Haughton Elevator Co. v. Seeberger (Otis Elevator Co. substituted). 1950. 85 USPQ 80.

Hormel Foods Corpn v Antilles Landscape Investments NV [2005] EWHC 13 (Ch),
Ch D.

Huls, A. 2016. *The golden age of superhero movies has yet to face its greatest threats*,
<https://film.avclub.com/the-golden-age-of-superhero-movies-has-yet-to-face-its-1798250388> (Accessed: 7 September 2020).

In Re Coca Cola Co [1986] 2 All ER 274, [1986] 1 WLR 695 [HL].

Intellectual Property Office. 2016. IN THE MATTER OF REGISTRATION NO 1125479
IN THE NAME OF DC COMICS INC. AND MARVEL CHARACTERS, INC. IN RESPECT
OF THE TRADE MARK SUPER HEROES IN CLASS 16 AND AN APPLICATION FOR A
DECLARATION OF INVALIDITY THERETO UNDER NO 500750 BY START UP POP
UP LTD, O-267-16.

Karapapa, S and **McDonagh, L.** 2019. *Intellectual Property Law*. Oxford University
Press. DOI: <https://doi.org/10.1093/he/9780198747697.001.0001>

Lunney, G. 1999. Trade mark monopolies. *Emory Law Journal*, 48(2): 367–488.

Manta, ID. 2012. Bearing down on Trade mark Bullies. *Fordham Intellectual
Property, Media & Entertainment Law Journal*, 22(4): 853–872.

McKenna, MP. 2007. The normative foundations of trade mark law. *Notre Dame
Law Review*, 82(5): 1839–1916.

Misiroglu, G, Eury, M, et al. 2018. *Superhero|fictional character*. Available at:
<https://www.britannica.com/art/superhero> (Accessed: 7 September 2020).

Murray, C. 2017. *The British Superhero*. Mississippi: University Press of Mississippi.
DOI: <https://doi.org/10.14325/mississippi/9781496807373.001.0001>

O'Hara, H. 2019. *The Ultimate Superhero Movie Guide: The definitive handbook for
comic book film fans*. Welbeck Publishing Group: London.

Patreon. 2019. *Dan & Chris are creating HERO HAPPY HOUR webcomic*. Archived
from the original <https://www.patreon.com/herohappyhour> on 30 January 2019.
[https://web.archive.org/web/20190130043742/https://www.patreon.com/
herohappyhour](https://web.archive.org/web/20190130043742/https://www.patreon.com/herohappyhour) (Accessed: 7 September 2020).

Pattishall, BW. 1952. Trade-Marks and the Monopoly Phobia. *Michigan Law Review*,
50(7): 967–990. DOI: <https://doi.org/10.2307/1284936>

- Petty, RD.** 2010. The “Amazing Adventures” of Super Hero ®. *Trade Mark Reporter*, 100: 729–755.
- Price, MT.** 1996. When Phone Booths are Inadequate Protection: Copyright and Trade mark Infringement of Superheroes. *Wayne L. Rev.* 43: 321–343.
- Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (Text with EEA relevance.) *OJ L*, 154: p. 1.
- Romagnoli, AS** and **Pagnucci, GS.** 2013. *Enter the Superheroes: American Values, Culture, and the Canon of Superhero Literature*. Lanham, Maryland: Scarecrow Press.
- Schechter, FI.** (1925, reprinted 2012). *The Historical Foundations of the Law Relating to Trade Marks*. Columbia University Press: Columbia.
- Setchi, R.** 2016. Multi-faceted Assessment of Trade mark Similarity. *Expert Systems with Applications*, 65: 16–27. DOI: <https://doi.org/10.1016/j.eswa.2016.08.028>
- Start Up Pop Up Ltd.** 2013. *Zero to Superhero*. Trade mark no UK00003017203, 08 August, <https://trademarks.ipo.gov.uk/ipo-tmcase/page/Results/1/UK00003017203> (Accessed: 7 September 2020).
- Stevenson, A** and **Waite, M.** 2011. *Concise Oxford English dictionary*. 12th ed./edited by Angus Stevenson, Maurice Waite. Oxford: Oxford University Press.
- Stewart, DG.** 2017. *The “Superhero” Trade mark: how the name of a genre came to be owned by DC and Marvel, and how they enforce it*. Available at: <https://www.worldcomicbookreview.com/index.php/2017/06/01/superhero-trademark-name-genre-came-owned-dc-marvel-enforce/> (Accessed: 7 September 2020).
- Superhero.** 2019. *Wikipedia*. Available at <https://en.wikipedia.org/wiki/Superhero> (Accessed: 7 September 2020).
- The London Taxi Corporation Limited trading as The London Taxi Company v Frazer-Nash Research Limited [2017] EWCA Civ 1729, CA.
- Tippex.** 2019. *Wikipedia*. Available at <https://en.wikipedia.org/wiki/Tipp-ex> (Accessed: 7 September 2020).
- Trade Marks Act 1994, c. 26* (UK) available at: <https://www.legislation.gov.uk/ukpga/1994/26/contents> (Accessed: 7 September 2020).

- USPTO.** 2017. [Twitter] 25 September. Available at: <https://twitter.com/uspto/status/912395131701092352> (Accessed: 7 September 2020).
- Vashko, RE.** 1998. Exploitation of the Comic Book Superhero. *Loy Intell Prop & High Tech LQ*, 3: 37–51.
- Velcro.** 2019. *Wikipedia*. Available at <https://en.wikipedia.org/wiki/Velcro> (Accessed: 7 September 2020).
- Velcro® Brand.** 2017. *Don't Say Velcro*. Available at <https://www.youtube.com/watch?v=rRi8LptvFZY> (Accessed: 7 September 2020).
- World IP Review.** 2016. Xerox: avoiding a 'genericide' headache. Available at <https://www.worldipreview.com/article/xerox-avoiding-a-genericide-headache> (Accessed: 7 September 2020).
- Yeo, C.** 2017. *The golden age of superhero films ignores the golden aged at its peril* <http://theconversation.com/the-golden-age-of-superhero-films-ignores-the-golden-aged-at-its-peril-75202> (Accessed: 7 September 2020).

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