The Trademark Reporter®

The Law Journal of the International Trademark Association

Vol. 100 **May-June, 2010** **No. 3**

THE "AMAZING ADVENTURES" OF SUPER HERO®*

*By Ross D. Petty***

I. INTRODUCTION

When two high school students, writer Jerome Siegel and illustrator Joseph Shuster, created the Super Hero character Superman in the summer of 1935, they never dreamed that nearly 75 years later a company with ownership rights to about 5,000 Super Hero characters would be acquired for the unimaginable sum of $4 billion by the cartoon company Walt Disney.[1]

After reviewing the development of Super Hero characters, this article examines how DC Comics, the company that acquired the rights to *Superman* from Siegel and Shuster, and Marvel Comics, the company eventually purchased by Disney, jointly managed to acquire the rights in the trademark SUPER HERO across a broad range of product categories and to enforce those rights despite the arguably generic nature of the term "Super Hero." Further, it addresses the public policy implications of allowing competitors jointly to control a term that could be considered generic to their industry.

II. KRYPTON CHRONICLES— THE DEVELOPMENT OF SUPER HERO CHARACTERS

In 1932, Jerry Siegel and Joe Shuster began to produce a mail-order "fanzine." Their 1933 issue, shown below, presented "The Reign of the Superman," the story of a poor man transformed by a mad scientist into a mental giant who could read and control

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 The author wishes to thank the Babson Faculty Research Fund and the Zwerling Family Term Chair for support of this product and his brother Jack Petty for introducing him to Super Hero comics many years ago. AMAZING ADVENTURES is a former trademark of Marvel Comics. SECRET ORIGINS is a registered trademark of DC Comics. KRYPTONITE is a registered trademark of DC Comics (toys and clothing) and Schlage Lock Co. (bicycle locks). KRYPTON CHRONICLES, DYNAMIC DUO and MORE POWERFUL THAN A LOCOMOTIVE are former trademarks of DC Comics.

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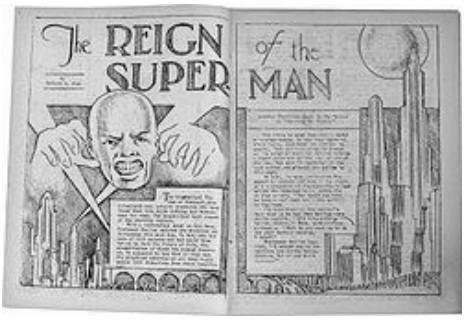
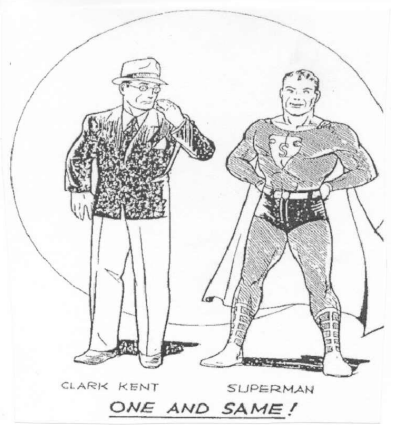
1. Ethan Smith & Lauren A.E. Schuker, *Disney Nabs Marvel Heroes*, Wall St. J., Sept. 1, 2009, at A1.

minds and thus dominate the earth.[2] Two years later, the young collaborators transformed the evil bald-headed madman into a handsome, tights-clad hero possessed of superhuman powers, a mission to fight evil and a secret identity: mild-mannered, bespectacled newspaper reporter Clark Kent (see below). Siegel and Shuster's "super villain" had evolved into a new fictional archetype, the Super Hero.[3]





Joe Shuster Drawing from 1935[4]

Siegel and Shuster produced four weeks' worth of *Superman* comic strips intended for newspaper publication, but they had no luck finding a publisher until December 1937, when National Allied Publications (later Detective Comics and also known for a time as National Comics Publications; hereinafter DC) contracted with them to produce a 13-page comic book featuring the character Superman. Much of Siegel and Shuster's original material was

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2. Siegel v. Warner Bros. Entm't, Inc., 542 F. Supp. 2d 1068, 1102 (C.D. Cal. 2008).

3. "Superheroes" have been defined as embodying three essential elements: a mission (typically to combat evil and injustice), super powers (sometimes native, but sometimes derived from technology or training, as with Ironman and Batman), and an "identity" comprising a Super Hero name, a secret identity and a distinctive costume. Peter Coogan, Superhero: The Secret Origins of a Genre 30-39 (Monkey Brain Books, 2006). Coogan identifies these basic elements as underlying themes referenced in the opinion by Judge Augustus Noble Hand (whom he misidentifies as Judge Learned Hand) in *Detective Comics, Inc. v. Bruns Publ'ns, Inc.*, 111 F.2d 432, 433 (2d Cir. 1940). Super powers often are coupled with a unique vulnerability, such as that of Superman to Kryptonite. Randy Duncan & Matthew J. Smith, The Power of Comics: History, Form and Culture 227 (Continuum, 2009).

4. Siegel v. Warner Bros. Entm't, Inc., Case No. CV-04-8400-SGL (RZx), slip op. at 7 (C.D. Cal. filed Mar. 26, 2008).

published in the debut issue of *Action Comics*, June 1938.[5] The Super Hero genre was born.

Superman's debut ushered in the so-called golden age of American comic books. The Superman character spawned a number of imitators, which sported Super Hero names, secret identities, super powers, uniforms and a do-good mission.[6] However, these early characters typically were introduced not as Super Heroes but, rather, simply by their name followed by a short description, such as "The Shield, G-man Extraordinary" or "The Flash – Fastest Man Alive."[7] Publishers apparently assumed that readers would recognize the characters as Super Heroes by their uniforms and the depiction of superhuman feats on the comic book covers.

Within a few years, more than 150 different comic book series, accounting for one-third of all magazine sales, were produced by 29 publishers.[8] However, DC had realized the potential of Superman as early as August 1938, when it filed for the registration of the name as a trademark. The mark was registered in October 1939.[9] In June 1941, DC sought to register a second mark for prints and publications that included a picture of Superman breaking chains. This mark was registered in November 1941.[10] January 3, 1937, was claimed as the date of first use in commerce for both of these marks. (See below.)

Interest in Super Hero comics faded after World War II. DC's *Superman*, *Batman* and *Wonder Woman* were the only major titles

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5. Siegel v. Warner Bros. Entm't, Inc., 658 F. Supp. 2d 1036, 1042-47 (C.D. Cal. 2009).

6. *See, e.g.*, Detective Comics, Inc. v. Bruns Publ'ns, Inc., 111 F.2d 432 (2d Cir. 1940).

7. Paul Sassienie, The Comic Book: The One Essential Guide for Comic Book Fans Everywhere 27 (Ebury, 1994).

8. Duncan & Smith, *supra* note 3, at 33.

9. U.S. Reg. No. 0371803 (Oct. 10, 1939). DC had registered ACTION COMICS as a trademark in 1938; U.S. Reg. No. 0360765 (Sept. 27, 1938).

10. U.S. Reg. No. 0391821 (Nov. 25, 1941).

that continued to be published.[11] DC effectively litigated Fawcett Publications' title *Captain Marvel* out of existence by filing a complaint in 1941.[12] While most of the subsequent litigation concerned copyright issues, DC also sued for unfair competition.[13] It argued that the image of Superman identified a specific source of comics and that Captain Marvel's visual similarities (skin-tight costume, cape, and chest emblem) would lead readers to purchase *Captain Marvel* comic books in the mistaken belief that they were published by the same source as the *Superman* comics. In 1951, the U.S. Court of Appeals for the Second Circuit dismissed the idea that "silly pictures" would be associated with a particular producer: "[N]obody cares who is the producer—least of all, children[,] who are the chief readers…."[14] It added, "To allow the first producer of such pictures to prevent others from copying them, save as he can invoke the Copyright Law, would sanction a completely indefensible monopoly."[15] Thus, although the U.S. Patent Office had allowed the trademark registration of a graphic image of Superman in 1941, ten years later the Second Circuit appeared dismissive of the very idea that such images warranted trademark protection. This matter ended with a settlement in 1953 in which Fawcett agreed to stop publishing the Captain Marvel character and pay DC $400,000 in damages.[16]

It should be noted parenthetically that criticism of comic books' purportedly pernicious influence on society in general and young people in particular began in the 1940s and led to several attempts at restrictive legislation, which the courts typically overturned based on principles of free speech under the First

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11. Shirrel Rhoades, A Complete History of American Comic Books 47 (Peter Lang Publishing, 2008).

12. Nat'l Comics Publ'ns, Inc. v. Fawcett Publ'ns, Inc., 93 F. Supp. 349, 351 (S.D.N.Y. 1950).

13. Nat'l Comics Publ'ns, Inc. v. Fawcett Publ'ns, Inc., 191 F.2d 594, 603 (2d Cir. 1951), *aff'd per curiam*, 198 F.2d 927 (2d Cir. 1952). Most of this decision addresses the issue of copyright notice and whether National Comics had forfeited its rights under copyright law. The court decided for the most part that it had not. The decision is particularly interesting because it clearly approaches the question of copyright infringement on a comic-strip-by-comic-strip basis, rather than by examining the similarities between the two *characters*, as the Second Circuit appears to have done in an earlier case; *see* Detective Comics, Inc. v. Bruns Publ'ns, Inc., 111 F.2d 432 (2d Cir. 1940).

14. Nat'l Comics Publ'ns, Inc. v. Fawcett Publ'ns, Inc., *supra* note 13, 191 F.2d at 603.

15. *Id.*

16. Joe Simon & Jim Simon, The Comic Book Makers 54-55 (Vanguard, 2003); Joseph Kary, *Superman vs. the Big Red Cheese*, Comic Book Marketplace, Jan. 1998, at 18. It appears Fawcett's capitulation was based in part on lackluster Super Hero popularity at the time.

Amendment.[17] Consequently, by the time of the Second Circuit's 1951 decision, courts were familiar with comic books and their then-negative image. In response to the publication in 1954 of psychiatrist Fredric Wertham's *Seduction of the Innocent,* a book critical of comic books, and subsequent investigative hearings by the U.S. Senate Subcommittee on Juvenile Delinquency, the industry toughened the voluntary "Comic Code" it had originally adopted in 1948.[18] Between 1954 and 1956, 18 publishers left the field and the number of comic book titles published annually dropped from 650 to just over 300.[19] However, with the new Comic Code, comic books again became relatively acceptable in American society. Indeed, in 1957 the Commissioner of Patents supported DC's trademark rights by allowing the company to oppose the registration of SUPERMAN by a bakery as a trademark for bread.[20]

In the mid-1950s, DC revitalized its original pre-war Flash character, heralding what is now known as the silver age of American comic books.[21] Revamped versions of the characters Green Lantern, The Atom, and Hawkman followed. In 1958, DC introduced the new Legion of Super Heroes as a vehicle for its existing character Superboy, the teenaged incarnation of Superman. Two years later DC united its adult Super Heroes to form The Justice League. Rival publisher Marvel Comics responded with its own Super Hero team, The Fantastic Four, in 1961.[22] Marvel's most famous Super Hero, Spider-Man, debuted the following year. By 1964, Marvel had introduced 10 new titles with 17 new or resurrected Super Heroes, including The Hulk, Captain America and Daredevil.[23] Three years later Marvel began airing *Spider-Man* and *Fantastic Four* television cartoons,[24] and in 1968 it sold 55 million comic books, just behind DC's sales volume.[25] In the face of heavy competition from Marvel, in 1962

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17. Amy Kiste Nyberg, Seal of Approval: The History of the Comics Code 3-49 (University Press of Mississippi, 1998).

18. *Id.* at 53-84, 104-28.

19. Bradford W. Wright, Comic Book Nation: The Transformation of Youth Culture in America 179 (Johns Hopkins University Press, 2001).

20. National Comics Publ'ns, Inc. v. Sive, 115 U.S.P.Q. 393 (Comm'r Pats. 1957).

21. Shirrel Rhoades, A Complete History of American Comic Books 70-71 (Peter Lang Publishing, 2008).

22. *Id.* at 70-78.

23. Les Daniels, Marvel: Five Fabulous Decades of the World's Greatest Comics 84-119 (Harry N. Abrams, 1991).

24. *Id.* at 141.

25. Wright, *supra* note 19, at 230.

DC registered its comic book logo, first used in 1949, as a trademark (see below).[26]

Marvel also designed a logo, which incorporated Spider-Man's head, but did not register it as a trademark. It did, however, register the name MARVEL in 1969, with first commercial use indicated as 1939.[27]

When the television series *Batman* premiered on ABC in January 1966, it set off a new Super Hero craze that ultimately stretched far beyond DC and Marvel. Dell Comics began its own *Super Heroes* line of comics. The Mighty Comics Group, an imprint of Archie Comics, produced a special issue entitled *Super-Heroes vs. Super-Villains* that included updates of several golden age Super Heroes who subsequently formed a team, The Mighty Crusaders.[28] By 1967, CBS and NBC had their own Super Hero parodies, titled, respectively, *Mr. Terrific* and *Captain Nice*; however, ABC had already taken the live action Super Hero TV show to another level with the introduction in the fall of 1966 of *The Green Hornet* as a "serious" show starring Van Williams in the title role and the now legendary Bruce Lee as Kato.

The Green Hornet had originated as a radio series rather than in comic books, and the TV series led to the first lawsuit regarding, albeit indirectly, the term "Super Hero." ABC successfully sued Button World Manufacturing for making an unlicensed button picturing a green hornet and the legend "Official Member Super Hero Hornet Society." (Below, left, the unlicensed button; right, a licensed button that includes the legend "Official Green Hornet Agent.")[29] Although the court did not perform a detailed comparison between the unlicensed and licensed buttons, it found

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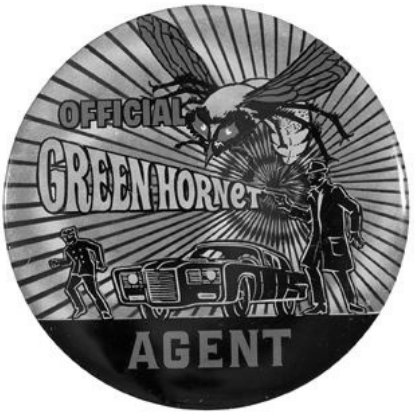
26. U.S. Reg. No. 0736443 (Aug. 21, 1962).

27. U.S. Reg. No. 0870506 (June 3, 1969).

28. Sassienie, *supra* note 7, at 90, 275, 311.

29. *See* Hake's Americana & Collectibles, http://www.hakes.com/item.asp?ItemNo=81787&ListID=103 (last visited Apr. 21, 2010).

they were confusingly similar.[30] Thus, it apparently did not believe that "Official Member Super Hero Hornet Society" was sufficiently distinctive to avoid confusing similarity.



To be sure, the words "super hero" had a life before comics. Its earliest-known occurrence of this expression was in 1917, when it was used to describe a "public figure of great accomplishments."[31] The word "super" in this context thus described an extraordinary real-life hero. "Super," used as an adjective or a prefix, became a popular slang term in the mid-1930s.[32] In early 1934, "super hero" was used to promote the radio serial exploits of the adventure character Doc Savage.[33] Although Savage possessed highly developed physical and mental skills (as well as a trove of futuristic gadgets), these fell somewhere close to the upper boundaries of actual rather than "super" human ability, and Savage lacked both the uniform and the secret identity of characters now considered Super Heroes. In any case, "super hero" never caught on as the primary description of a Doc Savage–type character. Descriptions such as "mystery man"[34] or "The Man of Bronze" were more common.

In summary, it is clear that notwithstanding some earlier uses of the term in popular fiction, the term "Super Hero," perhaps by the late 1930s and certainly no later than the 1960s, had come to

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30. American Broad. Co. Merch. Inc. v. Button World Mfg., Inc., 151 U.S.P.Q. 361 (N.Y. Sup. Ct. 1966).

31. Coogan, *supra* note 3, at 189.

32. Will Murray, The Roots of the Superman 20 (Comic Book Marketplace, 1998).

33. Coogan, *supra* note 33, at 189-92; Murray, *supra* note 32, at 19.

34. Coogan, *supra* note 33, at 192.

mean a fictional character with superhuman abilities (demonstrated either as skills or through the use of gadgets) who wore a costume or uniform when pursuing his or her mission (usually to fight evil) and kept a secret identity as a normal person.[35] DC started explicitly using the term with its Legion of Super Heroes, and Marvel commonly labeled its new offerings using Super Hero or Super Heroes. While these two companies pioneered the use of Super Hero, other comic book publishers and television show producers also used the term in both titles and promotions of their offerings.

III. SECRET ORIGINS® OF SUPER HERO®

Despite the investment in Super Heroes by comic book publishers and other entertainment companies, it was Halloween costume maker Ben Cooper, Inc. that first sought to register SUPER HEROES as a trademark. By the mid-1960s, Cooper had a portfolio of licensed properties that included both Marvel and DC Super Hero characters.[36] Seeking a name for its line of costumes that included characters from both publishers, Cooper quietly paid $35 in April 1966 to apply for the registration of SUPER-HEROES as a trademark for use on masquerade costumes. It claimed first use of SUPER-HEROES on goods in October 1965 and first use in interstate commerce in March 1966. The examiner noted that the proposed mark was not similar to any other registered trademark but that the drawing of the proposed mark actually showed SUPER HERO (rather than SUPER-HEROES). Cooper readily agreed that the singular unhyphenated form was the proper specification. The proposed mark SUPER HERO was then published for opposition in December 1966. As neither DC, Marvel, nor anyone else opposed the registration, it was granted to Cooper as one of three "hero" trademarks in March 1967.[37] These were Cooper's first registered trademarks.[38] The company apparently did not entirely anticipate the future value of the SUPER HERO mark, as it also registered the trademarks FAMOUS HEROES

35. See *supra* note 3 and sources cited therein.

36. Cooper had been offering Superman costumes at least since 1959; *see* Display Ad 130, NY Times, Oct. 18, 1949, at 131.

37. U.S. Reg. No 0825835 (Mar. 14, 1967).

38. The company did not register BEN COOPER as a trademark until 1976; U.S. Reg. No. 1029426 (Jan. 6, 1976).

and GREAT HEROES, evidently as potential alternatives for its costume lines.[39]

The illustrations below trace the history of Cooper's use of SUPER HERO. First, as the packaging from 1963 suggests, initially Cooper produced Spiderman costumes with no SUPER HERO designation. Next, the SUPER HERO trademark appears on a 1965 Spiderman costume package, but the words "TV HERO" are arguably more prominent. Last, in 1967 the Ben Cooper Spiderman costume is prominently proclaimed as part of the "Super Heros" [*sic*] line.

Cooper was not the only company interested in marketing Super Hero items derived from multiple publishers. In 1966, Ideal Toys produced Captain Action, a universal action figure that could be dressed as one of several Super Heroes or other fictional heroes, such as Buck Rogers and Flash Gordon. Accessory Super Hero kits

39. *See* U.S. Reg. No. 0825842 (Mar. 14, 1967); U.S. Reg. No. 0825843 (Mar. 14, 1967).

included DC's Superman, Batman and Aquaman and Marvel's Captain America and Sergeant Fury (a fictional war hero).[40]

While Cooper secured the use of the trademark SUPER HERO for costumes, Mego Corporation sought to follow in Ideal's footsteps by producing individual action figures. In November 1972, Mego filed to register WORLD'S GREATEST SUPER HEROES (WGSH) as a trademark for toy figures. It appears to have selected this longer name to avoid exactly copying Cooper's mark for costumes. Cooper was not appeased. In December 1973, it filed an opposition to the WGSH registration.[41] The next month, Cooper applied to register the plural SUPER HEROES as a trademark for both costumes and toy figures. The mark was registered for costumes in February 1975 based on its previous registration in the singular for those products.[42] However, the proposed mark for toy figures became entangled with Cooper's opposition to WGSH. In July 1974, the examiner suspended further action on the SUPER HEROES registration for toy figures until that opposition was decided.

Mego filed its answer to the WGSH opposition in May 1974, but it soon tired of the proceedings, and in December 1975 it assigned its interest to DC and Marvel jointly. DC and Marvel had previously realized that trademark protection both for individual character names and likenesses and for the category name "Super Heroes" was essential to developing merchandising revenue, although there were gaps in their trademark portfolios.[43] This notwithstanding, by the mid-1970s DC and Marvel enjoyed licensing revenue not only from Super Hero toys but also from cartoon and live action television shows, as well as from a planned *Superman* movie. However, comic book sales at newsstands were declining. By the time of Mego's assignment, both DC and Marvel enjoyed more revenue from licensing than from comic book publications.[44] Direct distribution of comic books to specialty stores

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40. *See* ToyNfo.com, http://www.bigredtoybox.com/cgi-bin/toynfo.pl?caindex. Ideal Toys eventually registered the trademark COMIC HERO in 1975 for play cases; U.S. Reg. No. 1003286 (Jan. 28, 1975).

41. Opposition No. 55,127 (Dec. 6, 1973). Documents filed in opposition proceedings are available from the U.S. Patent and Trademark Office, with newer proceedings available online at www.uspto.gov.

42. U.S. Reg. No. 1004306 (Feb. 11, 1975).

43. For example, in 1963 Marvel had adopted a logo that included Spider-Man's head and the name Marvel Comics for use in the upper left-hand corner of its magazines, but it did not register the logo as a trademark until June 1969; *see* U.S. Reg. No. 0870506 (June 3, 1969).

44. Wright, *supra* note 19, at 259.

was a new concept that was building momentum,[45] but the two dominant industry firms must have realized such stores also provided increased access to smaller and independent publishers. All of these factors provided a strong incentive for DC and Marvel to obtain the widest possible control of the term "Super Hero" when used as a trademark or part of a trademark.

After Mego assigned its interest in the WGSH mark to DC and Marvel, Cooper was faced with a united front from the two dominant comic book publishers and trademark holders for the vast preponderance of popular Super Hero characters. Cooper withdrew its opposition to the WGSH mark, and the proceeding was terminated in June 1977. The mark was registered six months later.[46] At the same time, Cooper assigned its interest in the trademark application for SUPER HEROES for toy figures to DC and Marvel. In the summer of 1979, DC and Marvel requested that the prosecution be continued. It was, and the mark SUPER HEROES was registered for use with toy figures in October 1980.[47] The registration is still active.

IV. DC AND MARVEL— THE DYNAMIC DUO OF SUPER HERO®

The evolution of a joint trademark strategy between DC and Marvel had not occurred overnight. The companies remained competitors, and each filed for separate Super Hero–related trademarks; in some cases they appeared to test each other before finally arriving at a unified position. In September 1975, shortly before the companies jointly acquired Mego's interest in the WGSH registration, DC started selling belts with a SUPER HEROES common-law trademark. DC alone filed to register that mark in the belts product category in May 1976. It had introduced the Legion of Super-Heroes in 1958, but it cautiously filed first for registration of SUPERBOY AND THE LEGION OF SUPER-HEROES as a stylized mark (i.e., a particular logo rather than the

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45. Shirrel Rhoades, A Complete History of American Comic Books 264 (Peter Lang Publishing, 2008).

46. The WGSH trademark for toy figures was registered in December 1977 by both Marvel and DC as joint owners and assignees of Mego. U.S. Reg. No. 1080655 (Dec. 27, 1977). Somewhat surprisingly, they allowed this mark to lapse in October 1998, and ten years later Abrams Gentile Entertainment Inc. applied to register the mark MEGO – WORLD'S GREATEST SUPER HEROES for toy figures. This application was abandoned in December 2009 after Lego, DC, and Marvel announced their potential opposition to the application.

47. U.S. Reg. No. 1140452 (Oct. 14, 1980).

words themselves) in February 1977, based on first use in December 1972. The mark, which is shown below, was registered in June 1978 for use with comic magazines.[48]

Not to be outdone, Marvel filed to register the mark MARVEL SUPER HEROES in March 1978 for motion picture films and entertainment services, based on its television cartoon series and a single special-issue comic book of the same title, both of which debuted in 1966. After submitting a statement that the SUPER HEROES portion of the new mark was used with the permission of the by-then joint owner of the SUPER HEROES trademark, Marvel received its registration in September 1981.[49] By early 1978, DC had assigned its interest in the belt mark to Marvel and itself jointly. The mark was not actually registered until August 1983, perhaps because the same mark was under consideration for use in a number of different industry categories at the time.[50]

Meanwhile, DC, emboldened by its success with its stylized LEGION OF SUPER-HEROES mark, filed in November 1979 to register the words LEGION OF SUPER-HEROES as a trademark for use with comic magazines. The examiner initially felt that the proposed word mark was likely to cause confusion with MARVEL SUPER HEROES, registered in the same product category. He also questioned whether the joint use of the words SUPER HEROES by both DC and Marvel would be potentially confusing. Ultimately, however, he accepted DC's contention that use of a mark by one co-registrant creates goodwill that also inures to the other co-registrant. He accepted the proffered analogy of use of the mark CELANESE by competing dress manufacturers: there would be no confusion because each dress manufacturer also used its own trademark, just as DC and Marvel used their own trademarks in conjunction with their use of the SUPER HERO mark. The word mark LEGION OF SUPER HEROES was registered in June 1983,

48. U.S. Reg. No. 1093241 (June 13, 1978).

49. U.S. Reg. No. 1168988 (Sept. 15, 1981).

50. U.S. Reg. No. 1248407 (Aug. 16, 1983).

two months before the joint registration for the SUPER HEROES belt trademark was granted.[51]

Although registration of individual Super Hero–related marks at first appeared more competitive than cooperative, the fact that in practice neither DC nor Marvel could easily register such marks without the other's permission eventually steered them to a cooperative strategy. They applied for joint registration of the SUPER HEROES mark for comic books in July 1979, around the time they began joint pursuit of the mark for toy figures. The mark was registered for use with comic books in November 1981, and it is still active today.[52] In the 1980s the same mark was then registered jointly in a number of product categories, including tote bags, cake pans, soap, cookies and entertainment services, in addition to costumes, toys, comics and belts. In July 1983, DC and Marvel finally obtained the assignment of the original SUPER HERO and the plural SUPER HEROES trademarks for costumes from Cooper.[53] The singular mark (but not the plural) remains active today. This effectively completed the joint strategy of DC and Marvel to gain control of the term "Super Hero" through trademark registration.

V. MORE POWERFUL THAN A LOCOMOTIVE— ENFORCING SUPER HERO®

Registration of various SUPER HERO marks was only the first step in DC and Marvel's joint attempt to control the use of those words to designate the origin or sponsorship of products. They also needed to assert and enforce those rights against others who tried to use any variant on "Super Hero" as a trademark or part of a trademark. By the 1990s, when several independent publishers introduced or reintroduced Super Hero characters, none described them on their covers as "super heroes."[54] Apparently, they anticipated that DC and Marvel would object to such a use.[55]

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51. U.S. Reg. No. 1242016 (June 14, 1983).

52. U.S. Reg. No. 1179067 (Nov. 24, 1981).

53. Cooper filed a voluntary petition for reorganization under Chapter 11 in April 1988; *see In re* Ben Cooper, Inc., 896 F.2d 1394 (2d Cir. 1990).

54. *See, e.g.*, Sassienie, *supra* note 7, at 119-20.

55. DC did successfully sue a periodical named *The Daily Planet* for copying the name of the fictional newspaper that employed Superman's alter ego Clark Kent. The name was also used by DC for a promotional news column in *Superman* comic books. The court found DC had common-law trademark rights in the name. DC Comics, Inc. v. Powers, 465 F. Supp. 843 (S.D.N.Y. 1978).

In fact, DC and Marvel did not wait for actual commercial use of the words "Super Hero" before objecting. They carefully monitored trademark registration applications. Once the applications were published for opposition, they usually did not immediately incur the expense of a formal opposition. Rather, their strategy was to simply request an extension of time to file an opposition. This made their displeasure known to the applicant and typically started settlement discussions. As a result, applicants often abandoned their applications.

DC and Marvel began their joint opposition proceedings strategy in April 1983, just three months before finally gaining the costume trademark rights from Cooper. At this time they jointly opposed the application of Leo A. Gutman, Inc. to register the mark SUPER-ACTION HEROES before the U.S. Patent and Trademark Office's (USPTO's) Trademark Trial and Appeal Board (TTAB). The Gutman application had been filed in June 1981 for entertainment services (specifically, distributing movies to television) and published for opposition in November 1982. DC and Marvel may have become aware of the application before its formal publication because they filed for the trademark registration of SUPER HEROES in the same industry category in September 1982. This application was delayed by examiner review, perhaps because of its similarity to Gutman's mark SUPER-ACTION HEROES, but eventually (March 1984) it was published for opposition, and the mark was registered three months later.[56] That same month, Gutman lost its motion to dismiss the opposition to its own registration. Rather than face a trial, Gutman started negotiations, and in December 1984 it assigned its rights to DC and Marvel. The trademark SUPER-ACTION HEROES was registered by DC and Marvel in April 1985.[57]

DC and Marvel's registration activity and their united opposition to the Gutman application led to a temporary lull in attempts by other parties to register Super Hero–related trademarks. The first half of the 1990s saw six attempts at registration of Super Hero–related marks, all quickly abandoned. While information on the extent to which DC and/or Marvel played a role in these abandonments is not publicly available, USPTO records confirm some three dozen oppositions by the SUPER HEROES co-registrants, as shown in Table 1. As noted above,

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56. U.S. Reg. No. 1282804 (June 19, 1984).

57. U.S. Reg. No. 1333672 (Apr. 30, 1985). In 2008, Com2US registered the trademark SUPER ACTION HERO for electronic games without opposition from DC or Marvel; U.S. Reg. No. 3381071 (Feb. 12, 2008).

typically the two companies would file a simple motion to extend the time to file an opposition ("Ext. to file opp."). Such motions were routinely granted. In some cases, the applicant would abandon its application at this point; in other cases, DC and Marvel had to file an opposition and initiate a TTAB proceeding. In every case but one, DC and Marvel managed to obtain an abandonment or a settlement. Not a single TTAB opposition proceeding was decided on the merits of either infringement or dilution of the opposing mark.

Table 1.
DC and Marvel Joint Trademark Oppositions

Proposed Mark	Use	Filed	Published	Outcome
MISS B. FIT SUPERHERO OF FITNESS	Education services	6/20/94	5/23/95	Ext. to file opp. 6/5/95; abandoned 10/30/95.
SUPERHERO ATHLETICS	T-shirts	4/5/96	11/12/96	Ext. to file opp. 12/13/96; abandoned 2/18/97.
SUPERHERO SKATEBOARDS	Skateboards	8/1/96	7/22/97	TTAB 10/6/97; no response 1/8/98.
SUPER HEROES	Ice cream	3/12/97	10/28/97	Ext. to file opp. 10/27/97; TTAB 5/19/00; abandoned after default 11/30/00.
SOUPER HEROES	Dips and chowders	6/16/98	1/19/99	Ext. to file opp. 2/16/99; TTAB 5/21/99; abandoned by agreement 7/14/99.
SUPERHERO SCHOOL	Education services	5/17/99	12/25/01	Ext. to file opp. 1/30/02; TTAB 4/26/02; suspended for settlement until 1/20/10.
WISH-WONDERFUL, INCREDIBLE, SUPER HEROES	Charitable services	6/29/00	4/3/01	Ext. to file opp. 5/4/01; abandoned 8/22/01.

Proposed Mark	Use	Filed	Published	Outcome
SUPER FLOSSMAN & FROM ZERO TO SUPERHERO	Dentist services	5/24/02	9/30/03 & 6/10/03	Ext. to file opp. 10/21/03; TTAB (of first mark by DC) 12/24/03 (for infringement of SUPERMAN); both abandoned 10/28/05.
BURGH MAN PITTSBURGH'S SUPER HERO	Education services	9/16/02	7/29/03	Ext. to file opp. 9/8/03; TTAB denied further exts. 3/17/05; mark registered 5/22/07.
REAL SUPER HEROES ICE CREAM	Ice cream	5/26/03	3/16/04	Ext. to file opp. 4/23/04; TTAB 4/15/04; no answer to opp., so app. terminated 3/12/05.
	Ice cream	6/27/03	9/13/05	Assigned (to DC/Marvel) 9/27/05.
CAPTAIN KIDZO AND THE READING SUPER HEROES	Education	6/29/03	3/8/05	Ext. to file opp. 4/13/05; TTAB 9/9/05; opp. terminated 7/15/06 after deletion of SUPER; mark registered 1/8/08.
COMPUTER SUPERHEROES	Computer service	11/25/03	8/31/04	Ext. to file opp. 10/20/04; TTAB 3/16/05; stipulated dismissal with assignment 3/19/07; mark registered by DC/Marvel 4/29/08.
TEACHERS ARE THE REAL SUPERHEROES	T-shirts, pens, bags	12/2/03	3/8/05	Ext. to file opp. 4/18/05; TTAB 4/11/05; suspended for settlement negotiations 4/8/07.
SUPER HEROES	T-shirts	1/23/04	11/16/04	Ext. to file opp. 12/28/04; TTAB 5/20/05; stipulated dismissal with assignment 10/3/05; mark registered by DC/Marvel 8/25/09.
GUNSTAR SUPER HEROES	Video games	3/10/05	5/23/06	Ext. to file opp. 7/3/06; TTAB 6/27/06; withdrawn 9/7/06.

Proposed Mark	Use	Filed	Published	Outcome
SUPERHERO 7'S	Gaming machines	5/27/05	2/14/06	Ext. to file opp. 3/27/06; TTAB (DC only) 3/20/06; abandoned 5/10/06.
S.H.A.K.T.I. SUPER HERO ACADEMY…	Education software	2/2/06	6/12/07	Ext. to file opp. 7/19/07; TTAB 10/15/07; withdrawn 2/7/08.
SUPER HERO	Sun care lotion	2/24/06	10/10/06	Ext. to file opp. 11/16/06; TTAB 4/9/07; reg. denied finding no intent to use 11/6/09.
YOUR HOME SUPER HERO	Home repair	3/1/06	10/31/06	Ext. to file opp. 12/4/06; TTAB 12/22/06; reg. in error 1/16/07; reg. cancelled with notice of potential opp. 5/27/07; abandoned by consent 6/6/08.
SUPERHERO	Beer	11/2/06	5/1/07	Ext. to file opp. 6/6/07; TTAB 8/28/07; withdrawn 12/7/07; terminated 1/23/08.
DANGERMAN THE URBAN SUPERHERO	Education	6/14/06	7/18/06	Ext. to file opp. 8/24/06; TTAB 11/17/06; abandoned after settlement negotiations 12/22/07.
SUPERHERO ARTIST MANAGEMENT	Manage-ment services	5/15/07	11/6/07	Ext. to file opp. 12/13/07; TTAB (DC only) 12/11/07; abandoned 3/3/08.
SUPERHERO MOMS	Entertain-ment	7/2/07	2/19/08	Ext. to file opp. 3/26/08; TTAB 4/18/08; no answer to opp., so app. abandoned 10/1/08.
BECAUSE YOU DON'T HAVE TO BE A SUPERHERO…	Bags	7/13/07	3/18/08	Ext. to file opp. 4/22/08; TTAB 5/19/08; settled with assignment 9/25/08; mark registered by DC/Marvel 11/4/08.

Proposed Mark	Use	Filed	Published	Outcome
SUPERHEROES OF SERVICE	Tele-communi-cations	11/14/07	4/15/08	Registered 7/1/08; TTAB 2/2/09; suspended for settlement negotiations 8/20/09.
ARISTOTLE'S SUPERHEROES	Video games	1/11/08	8/5/08	Ext. to file opp. 9/4/08; TTAB 12/3/08; no answer to opp., so app. terminated 3/16/09.
SOUP A HERO	Advertising and cafe services	4/16/08	9/9/08	Ext. to file opp. 10/8/08; TTAB 10/8/08; suspended for settlement negotiations 5/21/09.
BE A SUPERHERO, HELP FIGHT CHILD ABUSE	Clothing, public service	6/11/08	12/2/08	Ext. to file opp. 12/16/08; abandoned 5/27/09.
SUPERHERO	Charity fundraising	7/11/08	12/2/08	Ext. to file opp. 12/16/08; abandoned 5/27/09.
POLLEN –FIRST ECO-SUPERHERO…	Motion pictures	8/25/08	12/2/08	Ext. to file opp. 2/19/09; TTAB 2/19/09; no answer to opp., so app. abandoned 10/15/09.
GASTRONOMO THE CULINARY SUPERHERO	Cartoon prints	8/28/08	7/16/09	Ext. to file opp. 7/16/09; TTAB 9/4/09; opp. filed 12/11/09.
SUPERHERO PLUS+; SUPERHERO	Explosives	10/1/08	2/24/09	Ext. to file opp. 3/25/09; TTAB 3/25/09; suspended for settlement negotiations 12/22/09.
MEGO – WORLD'S GREATEST SUPER HEROES	Toys	10/24/08	9/8/09	Ext. to file opp. 10/2/09; abandoned 12/21/09.
SUPERHERO	Medical devices	1/8/09	4/28/09	Ext. to file opp. 5/27/09; abandoned 10/16/09.

Proposed Mark	Use	Filed	Published	Outcome
SUPERHERO	Carrying cases	6/22/09	9/29/09	Ext. to file opp. 10/29/09; ext. to file opp. granted until 1/27/10; expressly abandoned 9/23/09; abandonment notice mailed 4/8/10.

As shown, of the 36 DC and Marvel oppositions and extension requests identified, only one was not successful: BURGH MAN PITTSBURGH'S SUPER HERO. This one failure was caused by requesting extensions of time to file opposition papers beyond the total amount of time allowed by TTAB rules. However, USPTO records reveal that even in this case the applicant initially filed a letter requesting that its proposed mark be changed to BURGH MAN PITTSBURH ULTRA HERO because DC and Marvel attorneys had promised to then withdraw their opposition. The applicant reconsidered and withdrew its request one month later, and it was ultimately awarded the registration. In most of the 35 cases with favorable outcomes, the registration was abandoned in lieu of filing an answer to the opposition, while in others the applicant sought a formal suspension to allow time for settlement negotiations.[58] In three cases, the mark was assigned to DC and Marvel, and in at least one of those cases it was licensed back to the original applicant.[59]

58. In the case involving the proposed mark SUPER HERO for sun care lotions, DC and Marvel not only survived a motion to dismiss but also filed their own application to register the mark MY FIRST SUPER HERO for cosmetics, increasing the likelihood of confusion with the proposed mark because of the similarity of the products. DC Comics & Marvel Characters, Inc. v. Silver, Opposition No. 91176744 (T.T.A.B. Apr. 21, 2008) (plaintiffs' motion for summary judgment denied). Ultimately, however, DC and Marvel prevailed by arguing that the registrant could not demonstrate a bona fide intent to use.

59. In the case involving the proposed mark COMPUTER SUPERHEROES, DC and Marvel defeated the applicant's motion to dismiss based on the argument that confusion was not likely because the marks would be used in different industries. It was only then that the applicant settled and assigned the mark to DC and Marvel. DC Comics & Marvel Characters, Inc. v. Onetech Computer Consulting Inc., 76 U.S.P.Q.2d 1472 (T.T.A.B. 2005). The computer service firm appears to have an active website that uses the name Computer Superheroes. *See* http://www.computersuperheroes.com/# (last visited Apr. 29, 2010).

VI. WITH GREAT POWER COMES GREAT RESPONSIBILITY

In retrospect, it appears doubtful that either Cooper or DC and Marvel initially masterminded a scheme to broadly control trademark rights to Super Hero. Cooper simply wanted a single "umbrella" term it could use exclusively to describe the costumes made under license from both DC and Marvel. The latter appear to have been unaware of Cooper's efforts until after the trademarks were obtained. It was only when Mego imitated Cooper by applying for the WORLD'S GREATEST SUPER HEROES trademark that DC and Marvel appeared to realize the value of trademark control. Once they agreed to a cooperative effort, they worked hard for that strategy to succeed.

In this case being the second mover appears to have had distinct advantages for the "Super Hero duopoly." Because a single company (Cooper) registered the mark for a peripheral product category (Halloween costumes), DC and Marvel were largely able to avoid questions about whether the mark was generic or merely descriptive for the product category (comic books) and whether it was appropriate for two market-dominating competitors to jointly register the mark. Each of these questions is briefly discussed below.

A. Is Genericism KRYPTONITE® to SUPER HERO®?

In considering whether a registered or proposed mark is generic, the Court of Appeals for the Federal Circuit poses a two-part inquiry: "First, what is the genus of goods or services at issue? Second, is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services?"[60] Often firms distinguish their brand name (species name) from the product category (genus name) by using both together—for example, KLEENEX facial tissues, BAND-AID brand adhesive bandages, XEROX photocopiers. Courts have declared some product names such as shredded wheat and cellophane to be generic because the producer did not develop a distinct product category name.[61] Courts have also rejected not just generic product names but also generically descriptive terms, such as "brick oven" for frozen pizza, "crab

60. *In re* 1800Mattress.com IP, LLC, 586 F.3d 1359, 1362-63 (Fed. Cir. 2009).

61. Kellogg Co. v. Nat'l Biscuit Co., 305 U.S. 111 (1938); DuPont Cellophane Co. v. Waxed Prods. Co., 85 F.2d 75 (2d Cir. 1936).

house" for restaurants, "honey brown" for ale and "Dutch chocolate" for ice cream.[62]

Even if we consider the most obvious generic term for DC and Marvel's primary products in 1966 (the year of Cooper's initial registration) to be "comic books," these court decisions suggest that "Super Hero" might still be descriptive. However, licensing of established Super Hero characters soon thereafter overshadowed comic books in terms of revenue, and DC and Marvel claimed ownership of the vast majority of such characters. If DC and Marvel are considered Super Hero entertainment and licensing companies, rather than merely comic book publishers, the question of whether "Super Hero" is a generic or descriptive term is even a closer question.

This question is critical because the various DC and Marvel Super Hero marks have achieved "incontestable status," meaning they can no longer be challenged for being merely descriptive but *could* be challenged for being generic.[63] Tellingly, USPTO records indicate trademark examiners refused registration of the marks SUPERHEROES OF THE CIRCUS and SUPERHERO NETWORK by parties other than DC and Marvel because both were deemed merely descriptive of the type of entertainment that would be offered.[64]

In deciding whether a mark refers to a *category of goods or services* or a *specific product source*, courts consider several factors, including generic use by the registrant or competitors, dictionary definitions,[65] media usage, testimony of people in the trade, and consumer surveys.[66] The fact that characters from other sources have been described as Super Heroes since 1934 and comic books published by multiple competitors have used "Super Hero" in their titles suggests the term is generic.[67]

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62. *See* Schwan's IP LLC v. Kraft Pizza Co., 460 F.3d 971 (8th Cir. 2006); Hunt Masters, Inc. v. Landry's Seafood Rest., 240 F.3d 251 (4th Cir. 2001); Genesee Brewing Co. v. Stroh Brewing Co., 124 F.3d 137 (2d Cir. 1997); Carpenter v. Borden Co., 147 F. Supp. 445 (S.D. Iowa 1956).

63. 15 U.S.C. § 1064 (2006).

64. *See* Trademark Application No. 78581102 (Mar. 5, 2005); Trademark Application No. 76474251 (Dec. 9, 2002).

65. The Merriam-Webster Online Dictionary defines "superhero" as "a fictional hero having extraordinary or superhuman powers; *also* an exceptionally skillful or successful person"; http://www.merriam-webster.com/dictionary/SUPERHERO (last visited Jan. 14, 2010).

66. 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 12:13 (4th ed. 1997).

67. *See* Sassienie, *supra* note 28 and accompanying text.

Furthermore, when DC and Marvel used the words "Super Hero," typically it was not as an adjective to describe a brand of character or comic book. To do so would have emphasized that Super Hero characters were not real. While even children realize this fact, emphasizing it could have dulled some of the enjoyment or interest in the fantasy. Instead, they tended to use "Super Hero" as a category of person (or fictional character). For example, in promoting its new offerings in the 1960s, Marvel used laudatory taglines that often included generic use of "Super Hero." In Iron Man's debut it asked, "Who? Or What, is the Newest Most Breath-taking, Most Sensational Super-hero of all…?".[68] Thor was described as "The Most Exciting Super-Hero of All Time!"[69] When these two joined with others to form The Avengers, the group was described as "Earth's Mightiest Super-Heroes."[70] When Marvel introduced the X-Men in 1963, the caption above the title proclaimed them "The Strangest Super-Heroes of All!"[71] In 1966, *The Marvel Super Heroes* animated cartoon series debuted in television syndication. In addition to use in the series title, the series theme song used "Super Hero" or "Super Heroes" nine times.[72] In 1965, Marvel formed a fan club called the Merry Marvel Marching Society, whose theme song promised fans that they, too, could be a Super Hero if they marched to Marvel's music.[73] Last, in 1977, when Marvel reintroduced many of its golden age Super Heroes, it described the group on the cover of a comic as "The Greatest Superheroes of World War Two."[74]

DC also has used "Super Hero" generically. On the cover of its Legion of Super Heroes debut in the April 1958 issue of *Adventure Comics*, Cosmic Boy announces that Superboy could not join their "Super-Hero Club." In 1959, DC reprised its Legion of Super

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68. Les Daniels, Marvel: Five Fabulous Decades of the World's Greatest Comics 99 (Harry N. Abrams, 1991), referencing *Tales of Suspense*, March 1962.

69. *Id.* at 93, referencing *Journey into Mystery*, August 1962.

70. *Id.* at 109, referencing *The Avengers*, September 1963.

71. *Id.* at 111, referencing *The X-Men*, September 1963.

72. *Id.* at 141. The lyrics were: "Meet the bulky, kinda sulky, kinda Hulky Super Hero. /Altruistic and electrically transistored Super Hero. / An exotically neurotic and aquatic Super Hero. / The Marvel Super Heroes have arrived. / Super powered from their foreheads to their toes. / Watch them change their very shape before your nose. / See our cane-striking Super Heroes change to Viking Super Heroes, our zingin', real swingin' shield flingin' Super Heroes. / They're the latest, they're the greatest, ultimatest Super Heroes. / The Marvel Super Heroes have arrived."

73. *Id.* at 106.

74. Sassienie, *supra* note 7, at 99.

Heroes in a title story, "Prisoner of the Super Heroes."[75] Use of the words in the LEGION OF SUPER HEROES and MARVEL SUPER HEROES trademarks resembles generic use, which ordinarily would require disclaimer of trademark protection for the words SUPER HEROES. Indeed, DC's own POCKET SUPER HEROES trademark does disclaim SUPER HEROES.[76]

Last, several specimens filed with the USPTO for renewal of the SUPER HEROES trademark illustrate generic use.[77] For example, neither the Super Heroes Stamp Album nor the Super Hero Glue Stick indicates that SUPER HERO is a registered trademark. A comic book specimen filed in 2002 contained an advertisement for medallion coins "that show likenesses of your super heroes." These likenesses were undoubtedly licensed by Marvel, which thus effectively allowed the generic use of "Super Heroes" in the advertisement. Taken in total, this evidence suggests a strong argument could be made that DC and Marvel use the term generically when promoting their own products and allow such use for licensed products.

B. Allowing Industry-Dominating Co-registrants for SUPER HERO® Is Contrary to "Truth, Justice and the American Way"[78]

The primary purpose of trademarks is to identify a *single* source of products and distinguish those offerings from the offerings of competitors.[79] Given the existence of numerous Super Hero characters from sources other than DC and Marvel, including some well-known characters such as the Green Hornet, the SUPER HERO trademarks do not appear to satisfy this purpose. Rather, DC and Marvel's individual trademarks inform consumers about the single source of those companies' respective Super Hero offerings. For this reason, Marvel registered MARVEL SUPER HEROES as noted above and DC registered stylized marks that included pictures of its own proprietary popular Super Heroes and

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75. *Id.* at 72-73; Les Daniels, DC Comics: A Celebration of the World's Favorite Comic Book Heroes 122-23 (Watson-Guptill, 2003).

76. U.S. Reg. No. 2730169 (June 24, 2003).

77. U.S. Reg. No. 1179067 (Nov. 24, 1981).

78. DC Comics applied to register "Truth, Justice and the American Way" (the well-known conclusion to the introduction of the *Superman* television show of the 1950s) as a mark in 2003, but later it abandoned those applications. *See* Trademark Application No. 78250522 (abandoned Jan. 19, 2007); Trademark Application No. 78250529 (abandoned Dec. 13, 2007); Trademark Application No. 78250536 (abandoned July 17, 2006).

79. *See, e.g.*, J. Thomas McCarthy, *Joint Ownership of a Trademark*, 73 TMR 1 (1983).

the words DC SUPER HEROES—the latter only from 1998 through 2005.[80]

There have been cases where registration of a single trademark by two or more independent businesses has been found to be appropriate.[81] The earliest case involved owners of a business who wanted to register the trademark jointly in their own names rather than in the name of the business.[82] A later case involved two interstate truck haulers that were limited to separate territories but often hauled freight for each other when needed and jointly promoted a single trademark.[83] The trucking situation is similar to concurrent use, where two parties independently use a mark in the same industry but in different geographic territories. The USPTO director or the courts can allow concurrent registration of the jointly used mark if conditions can be delineated to avoid consumer confusion, such as limiting each mark user to specific, non-overlapping territories.[84]

In other cases, two companies have been allowed to jointly register a composite mark of their individual trademarks. For example, Hercules Inc. and American Petrofina registered the composite mark HERCOFINA in the name of a jointly owned venture.[85] Similarly, Diamond Walnut Growers and Sunsweet Growers licensed their individual trademarks to a joint venture in order to market gift baskets of walnuts and dried fruits under the composite mark DIAMOND/SUNSWEET. Because the individual

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80. U.S. Reg. No. 1073580 (Sept. 20, 1977); U.S. Reg. No. 2165794 (June 16, 1998).

81. The Patent Office apparently changed its previous policy against joint ownership in 1961; *see* Patricia Kimball Fletcher, *Comment: Joint Registration of Trademarks and the Economic Value of a Trademark System*, 36 U. Miami L. Rev. 297, 315 (1982). The Lanham Act allows registration by two or more firms that have formed a joint venture because a joint venture satisfies the Act's definitions of a "juristic person" (15 U.S.C. § 1127). However, there is no evidence that DC and Marvel entered into any joint venture. When asked by the trademark examiner of the application for registration of SUPER HEROES as a trademark for use with comic books to explain their relationship (because normally a mark is owned by a single business entity), DC and Marvel replied only that they were "joint applicants and co-owners of the mark"; filing of July 3, 1979, with examiner Henry S. Zak, *available at* tmportal.uspto.gov/external/PA_1_0_LT/OpenServletWindow?serialNumber=73222079&scanDate=2008031745186&DocDesc=Unclassified&docType=UNC&currentPage=1&rowNum=3&rowCount=7&formattedDate=12_Mar_2008. McCarthy (*supra* note 80 at 5-10) also examines business dissolution cases, arguing that trademark law is better served by assigning the disputed trademark to whoever will control the quality of goods that the mark is known to represent rather than allowing it to be used by more than one entity, as some tribunals have done. However, the dissolution scenario also clearly does not apply here.

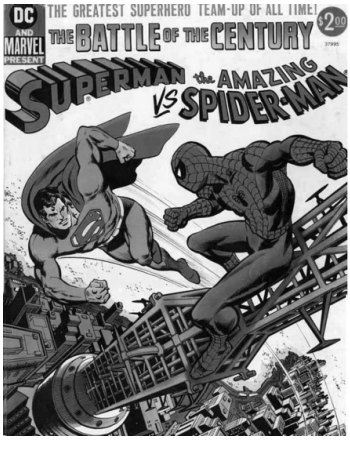
82. *Ex parte* Taylor (the Baby's Spray Tray case), 18 U.S.P.Q. 292 (Comm'r Pats. 1933).

83. *Ex parte* Pacific Intermountain Express Co., 111 U.S.P.Q. 187 (Comm'r Pats. 1956).

84. *See, e.g.*, *In re* Beatrice Foods, 429 F.2d 466, 473-74 (C.C.P.A. 1970).

85. *See In re* Hercofina, 207 U.S.P.Q. 777 (T.T.A.B. 1980).

marks were only licensed rather than sold outright to the joint venture, the TTAB held that the parent companies were appropriate parties to be joint registrants of the composite mark.[86] In contrast, when DC and Marvel introduced their first jointly produced Super Hero comic in 1976 (*Superman vs the Amazing Spider-Man*), they used both corporate trademarks in the caption "DC and Marvel Present" (see below).[87] They did not seek to register a hybrid mark. They also did not use the trademark registration symbol in the sentence at the top of the cover ("The greatest superhero team of all time!") that arguably uses "superhero" in a generic or descriptive sense.



Thus far we have discussed cases involving joint trademark registration by two firms that do not directly compete against each other. On one occasion at least, the TTAB allowed two competitors, knife producers Victorinox A.G. and Wenger S.A., to jointly register the trademark SWISS ARMY because Swiss law requires that the military have two sources for equipment and these two firms have exclusive rights to provide pocket knives to the Swiss military.[88] Victorinox and Wenger otherwise compete with each other to sell SWISS ARMY knives in other countries, including the

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86. *In re* Diamond Walnut Growers, Inc., & Sunsweet Growers, Inc., 204 U.S.P.Q. 507, 511 (T.T.A.B. 1979).

87. Sassienie, *supra* note 7, at 100.

88. *See* Wikipedia entry for "superhero," discussion of trademark status (last visited Jan. 19, 2010); *Do DC and Marvel Own Exclusive Rights in 'SUPER HERO'?*, The Trademark Blog, http://www.schwimmerlegal.com/2004/02/do_dc_and_marve.html (last visited Oct. 19, 2009).

United States, where they employ different U.S. distributors to do so. The TTAB found it appropriate to allow the companies to be joint registrants of the SWISS ARMY trademark because both produced knives to the same high level of quality required by the Swiss military.[89]

Like Victorinox and Wenger, DC and Marvel are independent competitors. Arguably, each company's adherence to the Comic Code provides some minimum level of quality control in the sense of avoiding scenes of graphic violence, sex, or drug use.[90] However, critics have considered the quality of both DC and Marvel's offerings to have varied over time and from title to title over the last half of the 20th century.[91] Thus, as distinct from the SWISS ARMY case, there is no mechanism here to ensure that both firms will produce virtually identical products to satisfy a single standard of high quality. Trademark registration is intended to benefit consumers by allowing firms to develop unique brands and promote each brand's unique attributes. In this case, joint registration merely allows the two dominant competitors to distinguish their offerings from those of smaller rivals.[92] The inability of smaller rivals to use the highly recognizable term "Super Hero" in a trademark makes it more difficult for them to succinctly describe their offerings. This arguably hinders rather than enhances competition. From a perspective of competition public policy, the SUPER HERO trademark should be cancelled or converted to a collective or certification mark available to anyone producing Super Hero entertainment or products.[93]

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89. Arrow Trading Co. v. Victorinox A.G. & Wenger, S.A., Opposition No. 103,315, 2003 WL 21509858 (T.T.A.B. June 27, 2003).

90. *See supra* note 17 and accompanying text. Furthermore, Marvel has published some comic books that have been found to violate the Code, so it does not appear that there is any consistent or binding quality control over the two joint registrants. Bradford W. Wright, Comic Book Nation: The Transformation of Youth Culture in America 239 (Johns Hopkins University Press, 2001).

91. *See, e.g.*, Duncan & Smith, *supra* note 3, at 46 (Continuum, 2009); Wright, *supra* note 19, at 185, 212-13, 259-60. For example, after Marvel introduced Super Heroes with "real life" problems, DC was criticized for continuing to offer one-dimensional characters.

92. In October 2006, Marvel enjoyed almost a 43 percent dollar market share of comics and magazines, and DC had 38 percent. Shirrel Rhoades, A Complete History of American Comic Books 2 (Peter Lang Publishing, 2008).

93. Collective and certification marks are defined at 15 U.S.C. § 1127.

VII. THE END[94]

In the early 1960s, before DC and Marvel gained control over the trademark SUPER HERO, they and many others explicitly used the words "Super Hero" in a generic or descriptive sense to promote their offerings. Only Archie Comics' short-lived *Super Heroes vs. Super Villains* series appeared to use "Super Hero" in a trademark sense. By the 1980s, however, other comic book publishers had been effectively discouraged from using the term "Super Hero" altogether. TV shows such as the 1980s' *The Greatest American Hero* and the current *Heroes*, as well as various relevant movies, also appear to deliberately avoid using the term. National Public Radio recently reported that an independent comic publisher changed one of its titles from *Super Hero Happy Hour* to *Hero Happy Hour* after receiving a letter from DC and Marvel.[95] Thus, consumers who are interested in new sources of Super Hero entertainment may be limited in their ability to find such entertainment because of the joint registration of the SUPER HERO trademark by the industry duopolists.

Furthermore, it appears that while the SUPER HERO mark was a relatively good source of licensing revenue for toys, clothing, and other merchandise in the 1970s and 1980s, more recently few of DC or Marvel's trademark oppositions have led to additional licensing opportunities under their various SUPER HERO trademarks. Regrettably, as Table 1 shows, their oppositions also may have limited the ability of firms providing education and charitable services to generate excitement among children for their offerings. The oppositions have, moreover, also restricted some for-profit companies, such as cafés and dental services providers, where confusion of sponsorship or affiliation by DC or Marvel seems very unlikely even assuming consumers recognize SUPER HERO as a joint trademark of the two companies. Therefore, I believe that joint registration of the trademark SUPER HERO is inappropriate today, and probably was never appropriate for two dominant industry competitors to undertake. This example serves as a unique case study in trademark law.

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94. Juan M. Ortiz applied to register THE END as a trademark for comic books, but the examiner objected because the phrase identified only a section of a comic book, not its source. This application was then abandoned. *See* U.S. Trademark Application No. 78603497 (Apr. 7, 2005).

95. Neta Ulaby, *Comic Creators Search for "Super Hero" Alternative*, National Public Radio, www.npr.org/templates/story/story.php?storyId=5304264 (last visited Sept. 23, 2009).