

It's a Bird . . . It's a Plane . . . No, It's a Generic Trademark

October 18, 2024

What do the words aspirin, escalator, and laundromat have in common? They are all formerly registered trademarks that have become generic, losing the protections conferred by registration and becoming a commonly used term for a good or service.^[1] That is, over time, the public can cause a term to lose its trademark protection by continually using the term generically.^[2] Marvel Characters, Inc. (“Marvel”) and DC Comics (“DC”) recently became the latest trademark owners to lose their registration rights for this reason. On September 26, 2024, the U.S. Patent and Trademark Office’s Trademark Trial and Appeal Board canceled Marvel and DC’s joint registrations of the terms SUPER HERO and SUPER HEROES by issuing a default judgment after receiving a challenge that these terms are generic.^[3]

On May 14, 2024, Super Babies Limited, the creator of the *Super Babies* book series authored by Scott Richold, challenged Marvel and DC’s jointly-owned trademark of the term Super Hero.^[4] The Petition to cancel these trademark registrations asserted that DC and Marvel did not register these trademarks to differentiate their goods in the marketplace. Instead, like Super Villains depicted in their comics, the rivals only worked together to stifle competition.^[5]

First, Super Babies illustrated the generic use of the term in (i) dictionaries, (ii) comic-book covers, (iii) descriptions of products in the marketplace, (iv) genres on Netflix and Amazon, and (v) its widespread use by other comic-book and cartoon creators.^[6] Similarly, Super Babies cited comments made by various Marvel and DC executives, as well as statements in the comics themselves, to demonstrate the term SUPER HERO is a category, genre, and archetype rather than an exclusive mark representative of the Marvel and DC brands.^[7] Accordingly, Super Babies argued that under 15 U.S.C. § 1064(3), the term has “become[] the generic name for the goods or services, or a portion thereof, for which it is registered” and should be canceled.^[8]

Next, Super Babies asserted that fierce competitors, such as Marvel and DC, cannot jointly own a trademark under the applicable laws.^[9] Specifically, Super Babies argued that “[i]t is fundamental that a trademark identifies a *single* source of goods.”^[10] That is, trademarks are registered to allow their creators to distinguish their mark “from goods of others.”^[11] Super Babies emphasized the longstanding rivalry that has been encouraged between Marvel and DC for decades, and that they are certainly not viewed as a “single source” for the purposes of trademark ownership but as “distinct companies with ‘different publishing philosophies’ and ‘completely different worldviews.’”^[12] Moreover, Super Babies argued that the use of the term “SUPER HERO” by such vehement rivals is further evidence that it is a “generic description for a category of goods offered by both

companies.”^[13]

Last, Super Babies advocated for the cancellation of the marks for abandonment.^[14] For decades, Marvel and DC have opposed other companies’ attempts to trademark any term including “superhero.”^[15] However, neither has challenged the other’s use of this “exclusive” mark.^[16] Marvel and DC constantly use SUPER HERO in titles and as a generic label causing it to “lose its significance as a mark.”^[17] Super Babies asserted that Marvel and DC’s failure to enforce the mark and ensure it is only used as a trademark demonstrates that it has been abandoned.^[18]

Upon Marvel and DC’s failure to answer Super Babies’ Petition, the Trademark Trial and Appeal Board ruled on Super Babies’ default motion, and canceled the following jointly held trademark registrations:

- SUPER HEROES (U.S. Reg. No. 1179067) – Marvel and DC’s trademark for comic books, magazines, cardboard stand-up figures, playing cards, paper iron-on transfers, erasers, pencil sharpeners, pencils, glue, notebooks, stamp albums;
- SUPER HEROES (U.S. Reg. No. 1140452) – Marvel and DC’s trademark for toy figures;
- SUPER HEROES (U.S. Reg. No. 3674448) – Marvel and DC’s trademark for T-shirts;
- SUPER HERO (U.S. Reg. No. 0825835) – Marvel and DC’s trademark for masquerade costumes. ^[19]

This case serves as a cautionary tale to trademark owners that the use of their mark as a generic term could lead to their loss of registration rights and that owners must take steps to prevent such use to defeat genericization.

Cullen and Dykman’s Intellectual Property team continues to monitor important developments in trademark and copyright law. Should you have any questions about this legal alert, please feel free to contact Karen Levin (klevin@cullenllp.com) at (516) 296-9110 or Ariel E. Ronneburger (aronneburger@cullenllp.com) at (516) 296-9182. Thank you to Jordan Milite, an associate on the Intellectual Property team, who assisted in the preparation of this alert.

This advisory provides a brief overview of the most significant changes in the law and does not constitute legal advice. Nothing herein creates an attorney-client relationship between the sender and recipient.

Footnotes

^[1] That Have Become Victims of Genericization, *Consumerist* (July 19, 2014), <https://www.consumerreports.org/consumerist/15-product-trademarks-that-have-become-victims-of-genericization/>.

^[2] 15 U.S.C. § 1064(3); <https://www.law.cornell.edu/wex/genericide>.

^[3], *Super Babies Limited v. Marvel Characters, Inc. and DC Comic*, Cancellation No. 92085201, at ¶ 4 (TTAB Sep. 26, 2024).

^[4] Petition for Cancellation, *Super Babies Limited v. Marvel Characters, Inc. and DC Comics* at ¶ 85 (explaining DC and Marvel’s joint trademark included SUPER HERO in the singular, plural, single-word, and two-word forms).

[5] *Id.* at ¶¶ 8-9.

[6] *Id.* at ¶¶ 31, 33 – 47.

[7] *Id.* at ¶¶ 49 – 65.

[8] *Id.* at ¶ 87 (citing 15 U.S.C. § 1064(3)).

[9] *Id.* at ¶¶ 67 – 68, 83.

[10] *Id.* at ¶ 66.

[11] *Id.* at ¶ 90 (citing 15 U.S.C. § 1052).

[12] *Id.* at ¶ 80.

[13] *Id.* at ¶ 82.

[14] *Id.* at ¶¶ 95 – 96, 101 – 102, 104, 106, 108.

[15] *Id.* at ¶¶ 45, 46 (citing Ross D. Petty, The “Amazing Adventures” of SUPER HERO, 100 TMR 729,743-47 (2010)).

[16] *Id.* at ¶¶ 83, 95.

[17] *Id.* at ¶ 101 (citing 15 U.S.C. § 1127).

[18] *Id.*

[19] *Id.* at notice page; *Super Babies Limited v. Marvel Characters, Inc. and DC Comic*, Cancellation No. 92085201, at ¶ 4 (TTAB Sep. 26, 2024).

Practices

- Intellectual Property

Attorneys

- Karen I. Levin
- Ariel E. Ronneburger
- Jordan Milite