



**ALP** | **NG & CO.**  
AFRICA LAW PRACTICE NG & COMPANY  
[WWW.ALP.COMPANY](http://WWW.ALP.COMPANY)

# NOW WE CAN ALL BE SUPER HEROES:

DC & MARVEL LOSE THEIR JOINT TRADEMARK  
ON THE TERM "SUPER HERO"

## AUTHORS

**Michael Chukwu, Olajumoke Coker, Philip Oke**  
SENIOR ASSOCIATE      ASSOCIATE      ASSOCIATE

[alp.company](http://alp.company)

## INTRODUCTION

In a landmark decision, the United States Patent and Trademark Office (USPTO) have cancelled a set of 'Super Hero' trademarks which were jointly owned by DC Comics and Marvel Comics, two of the biggest players in the comics industry. This decision was as a result of a petition brought by Superbabies Ltd arguing that the phrase 'Super Hero' is a generic term and as such, is not entitled to trademark protection. The petition by Superbabies Ltd was in response to DC opposing Superbabies' attempt to trademark "Super Babies" as DC claimed that this term infringed its 'Super' trademarks.<sup>1</sup> In the unending quest to strike a balance between fostering creativity and protecting intellectual property rights, it is understandable that many have welcomed this decision as a victory not only for Superbabies Ltd but for creativity and innovation.<sup>2</sup>

In this article, we will examine the concept of trademark protection, delve into the notion of generic marks, explore the origins of the 'Super Hero' trademark, review the background of the Superbabies Limited v DC and Marvel case and discuss the implications of the decision.

## WHAT IS A TRADEMARK?

The USPTO describes a trademark as *"a word, phrase, design or a combination that identifies your goods or services, distinguishes them from the goods or services of others, and indicates the source of your goods or services."*<sup>3</sup> In comparison, Nigerian law defines a trademark as *"a mark used or proposed to be used in relation to goods or services for the purpose of indicating a connection between the goods or services and a person having the right...to use the mark"*<sup>4</sup>



While, these definitions may vary, they highlight two key and interconnected factors of trademarks. Firstly, a trademark must be distinctive. Secondly, a trademark's primary purpose is to differentiate specific products or services from those of competitors within the same industry, thereby enabling consumers to identify the origin or source of a particular good or service.

Typically, marks such as symbols, words, logos or signs can be registered as trademarks. Upon registration, trademark protection prevents the unauthorised use of the registered mark or similar marks by others in the same industry to avoid confusion in the minds of consumers.

## GENERIC MARKS

Not all marks are eligible to be registered as trademarks for various reasons including where the marks have a generic nature (that is, the mark is widely recognized as a general name for a product or service). Therefore, the common generic name of a good or service cannot be registered as a trademark as they do not indicate source<sup>5</sup> nor are they identifiable with a specific brand.

For example, in the food and beverages industry the word 'apple' cannot be registered as a trademark as it is a generic term for a widely known fruit and as such no one enterprise can have the exclusive right to refer to their products as an apple. However, in the technology sector, 'Apple' can no longer be deemed to be a generic term and has been registered as a trademark to show that particular products are identified with Apple Inc., a consumer electronics company.

Marks that may have been deemed to be distinctive and afforded trademark protection at a point in time may become generic over time if such marks are misused by the public, leading to the loss of their trademark protection and entry the public domain.

<sup>1</sup> Petition to Cancel Super Heroes Trademark Registrations', available at Brittain, B. (2024) 'Marvel, DC Face US Trademark Challenge Over 'Super Hero' Stranglehold',

Available at: <https://www.reuters.com/legal/litigation/marvel-dc-face-us-trademark-challenge-over-super-hero-stranglehold-2024-05-14/>, accessed on 25 October 2024

<sup>2</sup> Brittain, B. (2024) 'US Trademark Office Cancels Marvel, DC's 'Super Hero' Marks', Reuters. Available at: <https://www.reuters.com/legal/litigation/us-trademark-office-cancels-marvel-dcs-super-hero-marks-2024-09-26/>, accessed on 25 October 2024

<sup>3</sup> USPTO, 'Trademark, Patent, Copyright' Available at: <https://www.uspto.gov/trademarks/basics/trademark-patent-copyright>, accessed on 25 October 2024

<sup>4</sup> Section 67, Trade Marks Act 1967

<sup>5</sup> USPTO 'Strong Trademarks'. Available at: <https://www.uspto.gov/trademarks/basics/strong-trademarks>, accessed on 25 October 2024

This phenomenon is often referred to as ‘genericide’, where a brand/mark (such as Escalator, Zipper, and Granola) gained such popularity that it ultimately turned into the generic name.

## ORIGIN OF THE ‘SUPER HERO’ TRADEMARK

Before examining the circumstances that resulted in the cancellation of Marvel and DC’s joint trademarks, it is worthwhile to consider exactly how these two competitors<sup>6</sup> came to jointly own the trademarks. The use of the term ‘super hero’ in American media can be traced to circa 1917 when the term was typically used in newspapers to describe individuals who performed heroic, commendable or brave acts.<sup>7</sup> The first use of the term in the context of today was in an advert for a radio serial, and it was not until 1941, that the term was included in a comic book relating to a superhero character.<sup>8</sup> The term ‘Super Hero’ was first trademarked in 1967 by Ben Cooper Inc for a series of Halloween costumes featuring characters from both DC and Marvel.<sup>9</sup> In 1972, Mego Corporation sought to register the term ‘World’s Greatest Heroes’ as a trademark for action figures. When Ben Cooper opposed Mego’s registration, Mego then assigned its interest in the trademark to both DC and Marvel. In consideration of that and to avoid contesting against the powerful duo, Ben Cooper opted to withdraw its opposition and subsequently assign its interest in the ‘super hero’ mark to both DC and Marvel.<sup>10</sup> Subsequently, Marvel and DC have registered the term in various classes to ensure protection in relation to a wide range of goods including but not limited to comic books, video games, belts, television shows and cake pans.<sup>11</sup>

The two companies’ subsequent determination to protect their marks have resulted in a plethora of oppositions to trademark registrations that contain ‘super hero’, in a bid to further entrench their dominance over the term. The two titans have maintained their stronghold on the term by diligently and aggressively notifying any possible unauthorized users of their trademark infringement.



Perhaps when faced with the size of Marvel and DC, coupled with their legal resources, the companies’ opposition alone leads to some registrants withdrawing their trademark applications.<sup>12</sup> This may be a contributing factor in why it has taken so long for the validity of the joint registration of the mark to be challenged. Some of the notable cases of DC and Marvel opposing registrations over the years include the Australian company, Hero Marketing Pty Ltd.’s application to register the mark term for its laundry liquid, dishwashing liquid amongst other items trademark in 1996 which was opposed by Marvel and DC resulting in the cancellation of the mark.<sup>13</sup> DC and Marvel persistently opposed this trademark which was then dismissed on 3 December 1998. In 2014, the companies, opposed the registration of the term in relation to the publication of a self-help business manual titled ‘Business Zero to Superhero’, however they eventually withdrew this particular opposition.<sup>14</sup> DC and Marvel’s relentless crusade to protect the use of the ‘Super Hero’ trademark have left many guarded against the use of the term and have resorted to adopting alternatives of the term for their products. Example of this can be seen in the use of ‘Supers’ in the Pixar animation ‘The Incredibles’ the use of ‘Supes’ in the television series ‘The Boys’.

## CASE BACKGROUND – SUPERBABIES V DC AND MARVEL

Superbabies Limited (Superbabies) is a UK based company which produces series of comics and story books featuring a team of super hero babies called ‘The Super Babies’.

<sup>6</sup> As outlined in Superbabies’ petition, Marvel & DC have referred to themselves as competitors and are recognised as such by consumers. ‘Petition to Cancel Super Heroes Trademark Registrations’, available at Brittain, B. (2024) ‘Marvel, DC Face US Trademark Challenge Over ‘Super Hero’ Stranglehold’. Available at: <https://www.reuters.com/legal/litigation/marvel-dc-face-us-trademark-challenge-over-super-hero-stranglehold-2024-05-14/>, accessed on 25 October 2024

<sup>7</sup> Cronin, B. (2021). ‘When Was the Term ‘Superhero’ First Used in Comics?’ CBR. Available at: <https://www.cbr.com/first-superhero-usage-comic-books/>, accessed on 25 October 2024

<sup>8</sup> Ibid.

<sup>9</sup> Adler, A. (2018). ‘When Marvel and DC Teamed Up to Own Super Heroes’ The Escapist. Available at: <https://www.escapistmagazine.com/the-super-hero-trademark-needs-a-powerful-challenger/>, accessed on 25 October 2024

<sup>10</sup> Ibid.

<sup>11</sup> Alder, A. (2018). ‘The Super Hero Trademark Needs a Powerful Challenger’. Available at: <https://www.escapistmagazine.com/the-super-hero-trademark-needs-a-powerful-challenger/>, accessed on 25 October 2024

<sup>12</sup> Ibid.

<sup>13</sup> Johnston, R. (2024) US Courts State Marvel and DC Have Lost Their Super Hero Trademark. Available at: <https://bleedingcool.com/comics/us-court-states-marvel-dc-lost-super-hero-trademark/>, accessed on 25 October 2024

<sup>14</sup> The Telegraph (2016) ‘Businessman wins Battle Against Marvel and DC Comics to Use ‘Superhero’ in Book Title’. Available at: <https://www.telegraph.co.uk/news/2016/05/25/businessman-wins-battle-against-marvel-and-dc-comics-to-use-supe/>, accessed on 25 October 2024



Superbabies sought to register the word ‘Super Babies’ as a trademark in the US but its application was opposed by DC Comics on the grounds that the word ‘Superbabies’ was an infringement of its ‘Super’ related trademarks. DC further asserted they had the exclusive right to use “the prefix SUPER followed by a general term for a person.”<sup>15</sup> In response to this, Superbabies filed a petition to cancel the registration of the term ‘Super hero’ in a number of classes including the use of the term in relation to publications, toy figures, t-shirts and masquerade costumes.<sup>16</sup>

In its petition, there are two main arguments put forward by Superbabies to justify the cancellation of the trademarks. First, they argued that super hero is a generic term as it is a description of common character type and a genre that featured these types of characters. They further argued that the public no longer associate the word ‘Super Hero’ with a particular brand or character, but rather associate the term with the genre as a whole. Consequently, they stated that Marvel and DC’s registration does not serve to prevent consumer confusion, but rather has been used to stifle competition.<sup>17</sup>

Superbabies also argued that the use of ‘super hero’ by these two companies and the manner in which the term is used by the companies only further cements its argument as they stated that *“the fact that Marvel and DC both use and claim ownership over SUPER HEROES confirms that neither company uses the term as a trademark, but rather as a generic description of a category of goods offered by both companies.”*<sup>18</sup>

This particular argument has merit especially when we consider that the purpose of a trademark as an identifier of source for the respective good or service, to thereby prevent any confusion among consumers. Considering this, it is unjust to attempt to claim the exclusive use of a mark that prevents others from competing effectively in the market, especially where that mark is, or has become through genericide, the name or descriptor of the good or service

To do this, would effectively create a monopoly, or a duopoly in this case, as is emphasized by Superbabies who stated in its petition that DC and Marvel’s registration of the term ‘super hero’ limited its ability to describe, promote and market its work and as such it has been harmed by said registration.<sup>19</sup>

Second, in its petition, Superbabies also argued that the joint ownership of the trademark ‘super hero’ did not comply with trademark law, which is intended to identify a single source of goods and services. As such, they claimed that DC and Marvel’s joint registration is antithetical to the purpose of trademarks.<sup>20</sup> The notion of two rivals sharing a trademark would perhaps be more reasonable to comprehend if the joint trademark was used in relation to a collaborative effort between the two companies.<sup>21</sup> In which case, it could then perhaps be argued that consumers view both DC and Marvel and the joint single source of this hypothetical collaborative product.



On the contrary, whilst using the term ‘super hero’, Marvel and DC have gone to lengths to ensure that that their characters are not affiliated with the other and have gone to great lengths to create and maintain distinct commercial identities for their comics and their characters in the view of the consumers and to this end actively support and encourage the rivalry between their respective companies.

<sup>15</sup> Petition to Cancel Super Heroes Trademark Registrations', available at Brittain, B. (2024) 'Marvel, DC Face US Trademark Challenge Over 'Super Hero' Stranglehold'. Available at: <https://www.reuters.com/legal/litigation/marvel-dc-face-us-trademark-challenge-over-super-hero-stranglehold-2024-05-14/>, accessed on 25 October

<sup>16</sup> Ibid.

<sup>17</sup> Ibid.

<sup>18</sup> Ibid.

<sup>19</sup> Ibid.

<sup>20</sup> Ibid.

<sup>21</sup> Alder, A. (2018). 'The Super Hero Trademark Needs a Powerful Challenger'. Available at: <https://www.escapistmagazine.com/the-super-hero-trademark-needs-a-powerful-challenger/>, accessed on 25 October

<sup>22</sup> Petition to Cancel Super Heroes Trademark Registrations', available at Brittain, B. (2024) 'Marvel, DC Face US Trademark Challenge Over 'Super Hero' Stranglehold'. Available at: <https://www.reuters.com/legal/litigation/marvel-dc-face-us-trademark-challenge-over-super-hero-stranglehold-2024-05-14/>, accessed on 25 October

As a result of these efforts by both companies, and as highlighted by Superbabies in its petition the use of the term super hero by both companies does not indicate a single source of the term ‘super hero’, instead, consumers associate the term “Super Hero” not to collaboration between DC and Marvel, but rather to the general concept of a superhero, independent of either company.

It is interesting to note that neither DC or Marvel filed a response to Superbabies’ petition, which led to a default judgement delivered in Superbabies’ favour and ultimately the subsequent cancellation of the joint trademarks.<sup>24</sup> While fact that by way of this default judgement, Superbabies avoided what may have been a significant challenge from both Marvel and DC, this should not diminish the strength of Superbabies’ case.

## IMPLICATIONS

The cancellation of these marks means that the term ‘super hero’ is now in the public domain where it is available to be used by all storytellers.<sup>25</sup>

While this is a significant loss for the comic giants, it does not impact either company’s existing rights over the trademarks associated with their respective characters, names or logo. Marvel and DC will still retain their rights over these characters and will therefore be able to continue capitalizing on them. While Marvel and DC can refer to their characters as super heroes, they cannot continue to prevent others from doing the same.

Notably, DC and Marvel also have a joint trademark over the term “Super Villian”.<sup>26</sup> It will be interesting to see if Super Villian suffers the same fate as ‘Super Hero’ bearing in mind that many of the arguments made by Superbabies against DC and Marvel in relation to Super Hero could potentially be applied to ‘Super Villain’.<sup>27</sup>

## CONCLUSION

It could be reasonably argued that the prominence of DC and Marvel characters may have to some extent justified the initial registration of the word ‘Super Hero.’ Undoubtedly, consumers would have associated this term with these brands and their iconic characters such as Superman, Wonder Woman, the Captain Marvel and Spider-man. However, this view no longer reflects today’s society, where the term superhero conjures up the image of any hero with extraordinary powers.

DC and Marvel’s monopolisation of the term has indeed fostered creativity within the industry, leading to the adoption of alternative terms like ‘Supes’ or ‘Supers’ in a bid to circumvent potential legal issues. However, the decision to cancel the ‘Super hero’ trademark now grants other individuals the freedom to refer to their stories and characters as superheroes. This development enriches the superhero genre as a whole by allowing a wider range of voices contribute to the genre without the need to create alternative terms to describe a generic concept.

This decision is also significant as it highlights how a mark which was once registrable can become generic and lose its trademark protection. While it remains uncertain whether the generalisation of a mark can be pre-empted and avoided, the ruling of the USTPO highlights that while there is a need for brands to innovate and differentiate themselves in a crowded market place, that alone does not give a brand – or in this case, two brands – the right to claim ownership of a whole genre or sector of a market. This is especially true when a mark that may have once been considered unique has evolved into a symbol of the industry as a whole and no longer merely serves as an identifier of a specific brand.

<sup>23</sup> Alder, A. (2018). ‘The Super Hero Trademark Needs a Powerful Challenger’. Available at: <https://www.escapistmagazine.com/the-super-hero-trademark-needs-a-powerful-challenger/>, accessed on 25 October

<sup>24</sup> Brittain, B. (2024). ‘US Trademark Office Cancels Marvel, DC’s ‘Super Hero’ Marks’. Reuters.

<sup>25</sup> Available at: <https://www.reuters.com/legal/litigation/us-trademark-office-cancels-marvel-dcs-super-hero-marks-2024-09-26/>, accessed on 25 October

<sup>26</sup> Ibid.

<sup>27</sup> Siegel, D.H. (2024). ‘Super Heroes Fall but Super Villains Still Stand’. Available at: <https://natlawreview.com/article/super-heroes-fall-super-villains-still-stand>, accessed on 25 October

<sup>28</sup> Ibid.

# AUTHORS



## Michael Chukwu

SENIOR ASSOCIATE

Corporate, Commercial, and Business Advisory  
mchukwu@alp.company



## Olajumoke Coker

ASSOCIATE

Corporate, Commercial and Business Advisory  
ocoker@alp.company



## Philip Oke

ASSOCIATE

Corporate Commercial, Commercial Litigation & Dispute Resolution  
poke@alp.company