

Batman v Superman v Copyright v Trademark: The Future of the Public Domain & Source Identification

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Introduction

The public domain has been the subject of recent headlines as famous characters such as Winnie the Pooh (2022), Mickey Mouse (2024), and Peter Pan (2024) have been made available to the public for their own use. Fans and creators have wasted little time crafting their own stories. “Winnie the Pooh: Blood and Honey,” a horror movie based upon the world of the titular character, was released in January of 2023, grossing \$5 million dollars on a \$100,000 budget.¹ From the same studio, “Peter Pan: Neverland Nightmare” is set to release in October of 2024.² Similarly, the trailer of a horror movie using Mickey Mouse was released in early 2024 and the famous episode “Steamboat Willie” has been edited to “make it sound as if Mickey is using profanity.”³

Listed among the characters whose copyrights will also lapse in the next 10-15 years are many well-known superheroes that have captured the world’s attention for the past century.⁴ It is these characters that will be the focus of this article. They include: Superman (2033), Batman (2034), Namor (2034), The Human Torch⁵ (2034), Captain Marvel⁶ (2034), The Flash⁷ (2035),

¹ Aya Tsintziras, *Winnie The Pooh: Blood And Honey Has Started A Hilarious Horror Movie Trend*, GAME RANT (July 17, 2023). <https://gamerant.com/winnie-the-pooh-blood-and-honey-hilarious-public-domain-horror-movie-trend/>.

² Jeremy Dick, *Peter Pan Horror Movie First Look and Plot Details Revealed, Director Teases Dark Tinkerbell Twist*, CBR (Jan. 31, 2024) <https://www.cbr.com/peter-pan-neverland-nightmare-first-look/>.

³ Anna Gordon, *Mickey Mouse Is Now in the Public Domain After 95 Years of Disney Copyright*, TIME (Jan. 2, 2024, 12:22 PM) <https://time.com/6551496/mickey-mouse-public-domain-steamboat-willie/>.

⁴ Michael Grothaus, *After Winnie the Pooh, These Other Characters Will Soon Enter the Public Domain*, FAST COMPANY (Feb. 21, 2023). <https://www.fastcompany.com/90853397/winnie-the-pooh-public-domain-mickey-mouse-superman>.

⁵ The android Jim Hammond version, not the more well-known Johnny Storm version.

⁶ Now known as “Shazam” due to other, unrelated legal disputes.

⁷ The Jay Garrick version of the character, not the more well-known Barry Allen or Wally West versions.

Green Lantern⁸ (2035), Captain America (2036), Aquaman (2036), and Wonder Woman (2036).⁹

Quite an array of characters to be sure. A quick observation will show that DC is far more affected by this round of copyright expirations,¹⁰ but Marvel will find themselves in a similar situation in the not-so-far future of the late 2050s when characters entering the public domain will include the Fantastic Four, The Hulk, Spider-man, Thor, Iron Man, Dr. Strange, The X-men, and Daredevil.¹¹

The earnings of these characters is an instructive tool to understand how “some properties have values that can’t easily be duplicated.”¹² Starting with those that are already publicly available, Winnie the Pooh has netted approximately \$48 billion and Mickey Mouse and Friends has made a staggering \$52 billion.¹³ Turning to superheroes, Batman has earned approximately \$29 billion and Superman an impressive \$7 billion.¹⁴ Further, while the other listed superheroes soon to enter the public domain have not approached these numbers (although they have certainly still made money), they all contribute to both DC and Marvel’s immensely successful movies,¹⁵ television shows, comic books, and merchandise.¹⁶ Although these are rough

⁸ The Alan Scott version of the character, not the more well-known Hal Jordan, John Stewart, Guy Gardner, Kyle Rayner, or other versions.

⁹ Grothaus, *supra* note 4..

¹⁰ Although, Captain America is currently a substantial property.

¹¹ Shawn Lealos, *Marvel’s First 10 Superhero Comic Book Series, In Chronological Order*, SCREEN RANT (Sept. 29, 2021) <https://screenrant.com/marvel-first-superhero-comic-book-series-chronological-order/>.

¹² Rebecca Schoff Curtin, *Zombie Cinderella and the Undead Public Domain*, 85 TENN. L. REV. 961, 992 (2018) (citation omitted).

¹³ These characters are of course members of a larger cast, but with each being the respective leading star, these numbers give a good idea. UPRINTING, *The Highest-Grossing Characters of All Time* (Aug. 8, 2023) <https://www.uprinting.com/highest-grossing-characters-of-all-time.html>.

¹⁴ *The Highest-Grossing Characters of All Time*, UPRINTING (Aug. 8, 2023) <https://www.uprinting.com/highest-grossing-characters-of-all-time.html>.

¹⁵ As proof, Marvel’s highest grossing movie was *Avengers: Endgame* (2019) at nearly \$2.8 billion worldwide, IMDB, *Highest Grossing MCU Movies Worldwide*, <https://www.imdb.com/list/ls040671689/> (last visited Apr. 7, 2024), and DC’s was *Aquaman* (2018) at more than \$1.1 billion globally, IMDB, *Highest Grossing DC Films*, <https://www.imdb.com/list/ls085165411/> (last visited Apr. 7, 2024).

¹⁶ Examples of merchandise superheroes find themselves on include “T-shirts, watches, mugs, lunchboxes, costumes, calendars [] posters[,] . . . dolls, action figures, stuffed animals, paintings, wallpaper, bedspreads and

estimates, it is clear that superheroes have evolved well beyond the “silly pictures” that some in the legal world once thought of them as.¹⁷

This article will explore how intellectual property laws will affect these superheroes once they inevitably enter the public domain. Part I will touch upon how copyright law works, whether an extension of the copyright term is possible, and what derivative copyrights mean for public domain properties. Part II will delve into how trademark law functions, how trademark law interacts with the public domain, the current landscape of trademark infringement and dilution claims, and how the “aesthetic functionality” doctrine could be used as a tool to strike a new balance between trademark and copyright.

Part I. Copyright

(a) How Copyright Works

Since this article deals with what happens after a copyright has already expired, an in depth discussion on copyright law is not necessary, but the basics will be provided to give helpful context. The Constitution gives Congress the power “to promote the progress of science and the useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.”¹⁸ A copyright is just that, an “exclusive right,” or a monopoly, to do whatever the creator wishes with their work (or in this case, character) for a certain period of time. The basic foundation of copyright law is to use economic incentives to encourage new works to be created.¹⁹ Works that can be copyrighted include literary works,

furniture.” Christine Nickles, *The Conflicts Between Intellectual Property Protections when a Character Enters the Public Domain*, 7 UCLA ENT. L. REV. 133, 133 (1999).

¹⁷ Nat’l Comics Pubs., Inc. v. Fawcett Pubs., Inc., 191 F.2d 594, 603 (2d Cir. 1951).

¹⁸ U.S. CONST. art. I, § 8, cl. 8.

¹⁹ See *Rockford Map Publishers v. Directory Serv. Co.*, 768 F.2d 145, 148 (7th Cir. 1985) (“The copyright laws are designed to give people incentives to produce new works. They allow people to collect the reward for their contributions.”) (internal citations omitted).

musical works, dramatic works, graphic works, and motion pictures.²⁰ One important dichotomy is that only an expression of an idea can be copyrighted, not the idea itself.²¹ Other obvious, but crucial pieces, are that the work must be original and that it must be “embodied in a fixed medium” such as a book or script.²² Once a creator has a copyrighted work, they can “reproduce copies of the work, distribute those copies to the public, produce derivative works, or display and perform the work publicly.”²³

A copyright exists as soon as the work is created, but to bring any civil action to enforce it, the copyright must be registered with the U.S. Copyright Office.²⁴ In order to enforce an infringement on a copyrighted character, there is essentially a two-step analysis: (1) is the character copyrightable and (2) does the subsequent character infringe on the original character’s copyright.²⁵ An additional requirement is that, if outright copying can not be proven (as is often the case), then the plaintiff must prove that the defendant had “access” to the copyrighted work.²⁶

²⁰ 17 U.S.C. §102(a).

²¹ 17 U.S.C. §102(b).

²² Aaron Weiss, Note, *It’s Elementary, or is it? How the Ongoing Sherlock Holmes Litigation Could Shake Up the Public Domain*, 97 CHI.-KENT L. REV. 257, 258 (2022) (citing Mitchell Zimmerman, *Copyright Basics For Non-experts*, CAL. B.J. (Feb. 2006)).

²³ *Id.* at 258. See 17 U.S.C. § 106.

²⁴ 17 U.S.C. § 411(a).

²⁵ See *Olson v. Nat’l Broad. Co.*, 855 F.2d 1446, 1448 (9th Cir. 1988) (citation omitted) (“In order to establish copyright infringement a plaintiff must prove ownership of the copyright and copying by the defendant.”); *Metro-Goldwyn-Mayer, Inc. v. Am. Honda Motor Co., Inc.*, 900 F. Supp. 1287, 1292 (C.D. Cal. 1995) (“A claim for copyright infringement requires that the plaintiff prove (1) its ownership of the copyright in a particular work, and (2) the defendant’s copying of a substantial, legally protectable portion of such work.” (citation omitted)).

²⁶ *Narell v. Freeman*, 872 F.2d 907, 910 (9th Cir. 1989) (“Because in most copyright cases direct evidence of copying is not available, a plaintiff may establish copying by showing that the infringer had access to the work and that the two works are substantially similar.” (citation omitted)). See, e.g., *Rogers v. Koons*, 960 F.2d 301, 307 (2d Cir. 1992) (the “rare scenario where there is direct evidence of copying” was presented when an artist gave a copy of a photograph to artisans “with the explicit instruction that the work be copied” (emphasis added)).

A character can receive copyright separate and apart from the work itself.²⁷ To get through the threshold matter of copyrightability there are several different tests.²⁸ The first is that the character “constitutes the story being told,” or in other words, that the story is about the character and they are not merely a “chessman in the game of telling the story.”²⁹ The second test is that the character is sufficiently distinct: the more developed the character, the easier it can be infringed upon.³⁰ In either case, courts have found that “[n]o more is required for a character copyright” in a case where a graphic character (rather than a purely literary one) has a specific name and appearance.³¹ Moreover, the copyrightability of specifically cartoon and comic book characters have long been recognized.³²

For the second part of the analysis, there is both an objective “extrinsic” test (usually a matter of law for the judge) and a subjective “intrinsic” test (usually a matter of fact for the factfinder).³³ Generally, “[t]he true test for infringement is the degree of similarity between the allegedly infringing character and the original work.”³⁴ Where the “graphic image” of a character

²⁷ See *Rice v. Fox Broad. Co.*, 330 F.3d 1170, 1175 (9th Cir. 2003) (“[C]haracters that are ‘especially distinctive’ or the ‘story being told’ receive protection apart from the copyrighted work” (citations omitted)).

²⁸ Kathryn M. Foley, Note, *Protecting Fictional Characters: Defining the Elusive Trademark-Copyright Divide*, 41 CONN. L. REV. 921, 937 (2009) (“Whether the analysis occurs under the standards outlined in *Nichols*, *Warner Brothers*, *Air Pirates* or some combination thereof, it remains an essential aspect of the copyright infringement analysis for fictional characters.” (citation omitted)).

²⁹ *Warner Bros. Pictures v. Columbia Broadcasting Sys. (Sam Spade)*, 216 F.2d 945, 950 (9th Cir. 1954), cert. denied, 348 U.S. 971 (1955). See, e.g., *Metro-Goldwyn-Mayer*, 900 F.Supp. at 1296 (“A James Bond film without James Bond is *not* a James Bond film.”).

³⁰ *Nichols v. Universal Pictures Corp.*, 45 F.2d 119 (2d Cir. 1930), cert. denied, 282 U.S. 902 (1931) (recognizing that a character can be protected even if they are “quite independent[] of the ‘plot’ proper”). This has come to be known as the “distinct delineation” standard.

³¹ *Gaiman v. McFarlane*, 360 F.3d 644, 660 (7th Cir. 2004) (citations omitted). See *Anderson v. Stallone*, No. 87-0592, 1989 U.S. Dist. LEXIS 11109 at *19-18 (C.D. Cal. Apr. 25, 1989) (“As a practical matter, a graphically depicted character is much more likely than a literary character to be fleshed out in sufficient detail so as to warrant copyright protection.”).

³² *Hill v. Whalen & Martell*, 220 F. 359, 360 (S.D.N.Y. 1914).

³³ *Sid & Marty Krofft Television Productions, Inc. v. McDonald’s Corp.*, 562 F.2d 1157, 1164-65 (9th Cir. 1977), overruled in part on other grounds by *Skidmore v. Led Zeppelin*, 952 F.3d 1051, 1066 (9th Cir. 2020).

³⁴ Michael Todd Helfand, Note, *When Mickey Mouse Is as Strong as Superman: The Convergence of Intellectual Property Laws to Protect Fictional Literary and Pictorial Characters*, 44 STAN. L. REV. 623, 631 (1992) (citations omitted).

is copied, there has usually been found to be infringement.³⁵ However, a court can also look at the “totality of the character’s attributes and traits.”³⁶ In a decision shortly after the creation of Superman, a character called “Wonderman” was found to infringe on the hero’s copyright when it copied enough elements of the hero.³⁷ At the same time, abstract or general traits such as “race, intelligence, aggressiveness, paranoia and athleticism” can not be copyrighted and therefore can not be infringed.³⁸ An important exception to infringement is the “fair use” provision, in which a person who does not hold a copyright can use a work if they use it in a “transformative” manner, which commonly includes parody, criticism, comment, or educational purposes.³⁹ This is allowed because the work does not act as a “substitute” for the copyrighted work in the relevant market, and thus does not act as competition to which consumers could turn to.

If a subsequent work is found to infringe the copyright of the original work, the remedies available are an injunction or monetary damages.⁴⁰ Again, these remedies are rationalized because the economic value of the copyrighted work is damaged or stolen from the owner. As a note, Circuits differ as to whether the Copyright Act allows for a world-wide injunction if necessary.⁴¹

(b) Copyright Extension

³⁵ Walt Disney Prods. v. Air Pirates, 581 F.2d 751, 756 (9th Cir. 1978).

³⁶ Warner Bros. Inc. v. Am. Broad. Co., 720 F.2d 231, 241 (2d Cir. 1983).

³⁷ Detective Comics, Inc. v. Bruns Publications, Inc., 111 F.2d 432, 433 (2d Cir. 1940) (Wonderman “used more than general types and ideas and have appropriated the pictorial and literary details embodied in the complainant’s copyrights.”)

³⁸ Whitehead v. Paramount Pictures Corp., 53 F. Supp. 2d 38, 48 (D.D.C. 1999).

³⁹ 17 U.S.C. § 107. See *Metro-Goldwyn-Mayer*, 900 F.Supp. at 1300-01 (The following factors must be considered: “(1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use on the potential for, or value of, the copyrighted work.” (citations omitted)).

⁴⁰ 17 U.S.C. §§ 502-505.

⁴¹ *Compare* *Subafilms, Ltd. v. MGM-Pathe Communications*, 24 F.3d 1088, 1095-98 (9th Cir.) (en banc), *cert. denied*, 513 U.S. 1001 (1994), *and* *Update Art, Inc. v. Modiin Publishing, Ltd.*, 843 F.2d 67, 73 (2d Cir. 1988), *with* *Liberty Toy Co. v. Fred Silber Co.*, No. 97-3177, 1998 U.S. App. LEXIS 14866 at *11 (6th Cir. 1998), *and* *NFL v. Primetime 24 Joint Venture*, No. 98 Civ. 3778, 1999 U.S. Dist. LEXIS 3592 at *6-7 (S.D.N.Y. 1999).

Before delving into the minutiae of when a copyright expires, an effective first question to address is whether the law can and will be changed before that enddate is reached? The length of corporate authorship copyrights, the category that these superheroes fall under,⁴² has certainly grown over the years: from 28 years (Copyright Act of 1790)⁴³ to 42 years (Copyright Act of 1831)⁴⁴ to 56 years (Copyright Act of 1909)⁴⁵ to 75 years (Copyright Act of 1976)⁴⁶ to 95 years (Copyright Term Extension Act of 1998).⁴⁷ Works created by a non-corporate author are decided differently.⁴⁸ The most recent extensions occurred in no small part due to lobbying efforts of Disney to protect its central money-maker. The following figure depicts the not-so-coincidental timeline of copyright extension and Mickey Mouse's own copyright.⁴⁹

⁴² Many courts have determined that the authors in question created superheroes as “work-for-hire” for their relevant corporate entity. *See, e.g.,* Siegel v. Warner Bros. Entertainment Inc., 658 F. Supp. 2d 1036 (C.D. Cal. 2009) (concerning Superman); Marvel Characters Inc. v. Simon, 00 Civ. 1393 (RCC) (S.D.N.Y. Feb. 27, 2002) (settling a case concerning Captain America); Marvel Characters, Inc. v. Kirby, 726 F.3d 119, 143 (2nd Cir. 2013) (concerning several Marvel heroes including Spider-Man, The Avengers, and The X-men).

⁴³ Copyright Act of 1790, § 1, 1 Stat. 124 (1790).

⁴⁴ Copyright Act of 1831, §§1-2, 4 Stat. 436 (1831).

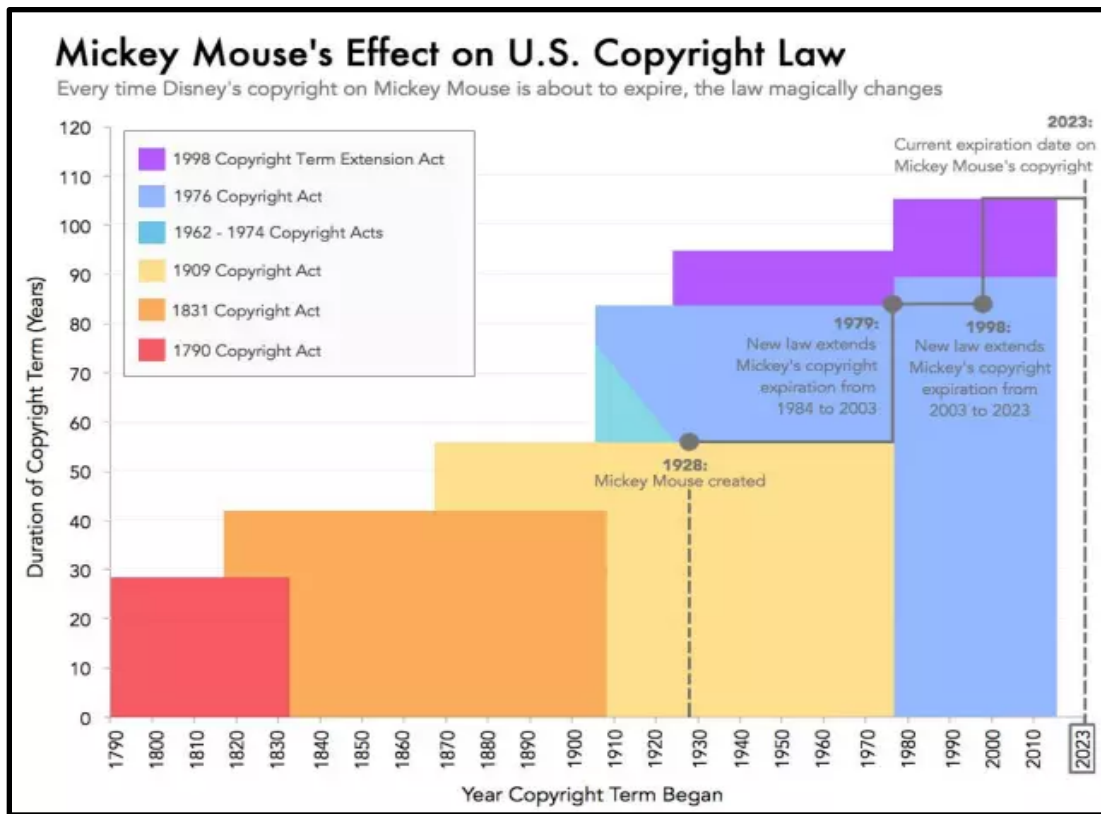
⁴⁵ Copyright Act of 1909, § 23, 35 Stat. 1075, (1909) (repealed 1978).

⁴⁶ Copyright Act of 1976, § 304, 90 Stat. 2541 (1976). *See* Joseph P. Liu, *The New Public Domain*, 2013 U. ILL. L. REV. 1395, 1414 (2013) (noting that this law made it so that unmarked works received a copyright and thus avoided the public domain, flipping the past policy).

⁴⁷ Sonny Bono Copyright Term Extension Act, 17 U.S.C. § 101 (1998) (providing for an initial 28 year term and an option to renew the copyright for an additional 67 years, coming to a total of 95 years).

⁴⁸ If the work was created on or *after* January 1, 1978, the copyright lasts 70 years after the death of the creator. 17 U.S.C. § 302. The same goes for works created *before* the same date, but which were not published by that date. 17 U.S.C. § 303. Works both created and published *before* January 1, 1978, last the normal 95 years (with a renewal required after 28 years). 17 U.S.C. § 302.

⁴⁹ Zachary Crockett, *How Mickey Mouse Evades the Public Domain*, PRICEONOMICS (Jan. 7, 2016) <https://priceonomics.com/how-mickey-mouse-evades-the-public-domain/>.



Political activist Phyllis Schlafly noted that Disney paid nearly \$150,000 (close to \$290,000 today) in lobbying efforts during the leadup to the 1998 law.⁵⁰ Around the same time, when asked about Disney’s lobbying efforts, spokesperson Thomas Deegan responded, “[w]e regard our lobbying as proprietary to us. We don't wish to talk about it.”⁵¹ While the law was ultimately nicknamed the “Mickey Mouse Protection Act,” others think that Disney was a “convenient boogeyman” and their lobbying efforts were a “little overstated.”⁵² Either way, now and then, “[o]wners of expiring copyrighted works . . . have huge financial incentives to spend tremendous amounts of money lobbying for yet another term extension.”⁵³

⁵⁰ Phyllis Schlafly, *Why Disney Has Clout with the Republican Congress*, EAGLE FORUM (Nov. 25, 1998) <https://eagleforum.org/column/1998/nov98/98-11-25.html>.

⁵¹ Alan K. Ota, *Disney In Washington: The Mouse That Roars*, ALLPOLITICS (Aug. 10, 1998) <https://www.cnn.com/ALLPOLITICS/1998/08/10/cq/disney.html>.

⁵² Gene Maddaus, *Mickey Mouse, Long a Symbol in Copyright Wars, to Enter Public Domain: 'It's Finally Happening'*, VARIETY (Dec. 22, 2023, 8:30 AM). <https://variety.com/2023/biz/news/mickey-mouse-public-domain-disney-copyright-lawsuits-1235844322/> (Southern Illinois University law professor, Zvi Rosen, espoused this view).

⁵³ Liu, *supra* note 46, at 1425.

Such extensions of copyright lengths are not out of the realm of possibility even in the modern day, as evidenced by Canada increasing their own copyright protection from 50 to 70 years after the creator’s death in 2023.⁵⁴ While this action was more about playing catch-up to other countries,⁵⁵ the move still exemplifies the feasibility of such an action in today’s world. In terms of U.S. copyright law, an extension of the already-long term of 95 years might sound like a stretch of Congressional powers. However, in *Eldred v. Ashcroft*, the Supreme Court ruled that Congress has the power to determine the length of copyrights as long as the term has a definite end, thus satisfying the “limited times” provision of the Copyright Clause in the Constitution.⁵⁶ If such an attempt at future extension was made, there would undoubtedly be arguments that the move is not a “rational enactment” as the 1998 extension was, but *Eldridge*’s deference to Congressional motives would be a difficult obstacle to overcome.⁵⁷ Nonetheless, a recent scholar expressed concern for even the current copyright term, noting that it “is many decades longer than the average human lifespan.”⁵⁸ And moving from the legal to the political, a campaign to once again extend the length of copyrights would likely be met with “a storm of protest” due to the increased publicity of the issue, possibly making the notion a non-starter.⁵⁹

Therefore, the answer is not quite clear as to whether U.S. copyright laws will remain in their current form, and if companies holding the rights to these characters have anything to say about it, they will not.

(c) *The Public Domain*

⁵⁴ Joseph Pugh, *Change to Copyright Laws Means You’ll Have to Wait to use this Literary Giant’s Work for Free*, CBC (Jan. 7, 2023, 4:00 AM) <https://www.cbc.ca/news/entertainment/canada-public-domain-pause-1.6706498>.

⁵⁵ *Id.*

⁵⁶ *Eldred v. Ashcroft*, 537 U.S. 186, 210 (2002).

⁵⁷ *Id.* at 208.

⁵⁸ Stacey M. Lantagne, *Building a Better Mousetrap: Blocking Disney’s Imperial Copyright Strategies*, 12 HARV. J. OF SPORTS & ENT. LAW 141, 152 (2021) (“This is troubling in and of itself.”).

⁵⁹ Maddaus, *supra* note 52. *See also*, Liu, *supra* note 46, at 1421 (“future attempts to limit the public domain will run into more resistance”).

Once the copyright on a work eventually expires, it will enter the public domain. This means that—with important caveats that will be discussed in the next section—any person is free to use the work as they please. Indeed, an instructive example of how important and powerful the public domain can be is the multitude of ideas that Disney has taken from its deep wells.⁶⁰ The following is a visual depiction of many of these examples, paired with the financial rewards Disney has reaped from these endeavors.⁶¹

A Selection of Disney Films Based on Public Domain Works		
Film	Work Based On	Revenue
Aladdin (1992)	"One Thousand and One Nights" (1702)	\$504 million
Alice in Wonderland (1951, 2010)	"Alice in Wonderland" (Lewis Carroll, 1865)	\$1.02 billion
Beauty and the Beast (1991)	"Beauty and the Beast" (Villeneuve, 1775)	\$425 million
Bug's Life (1998)	Aesop's Fables	\$363.4 million
Cinderella (1950)	"Cinderella" (Perrault, 1697)	\$85 million
Christmas Carol (2009)	"A Christmas Carol" (Dickens, 1843)	\$325.3 million
Frozen (2013)	"Ice Queen" (Hans Christian Anderson, 1845)	\$810.3 million
Hercules (1997)	The Greek myth (400 BCE)	\$252.7 million
Little Mermaid (1989)	"Little Mermaid" (Anderson, 1837)	\$211.3 million
Mulan (1998)	Chinese legend of Hua Mulan	\$304 million
Pinnocchio (1940)	"Pinnocchio" (Collodi, 1883)	\$84.3 million
Robin Hood (1973)	From English folk tales	\$87 million
Sorcerer's Apprentice	"L'apprenti Sorcier" (Goethe, 1797)	\$236.9 million
Snow White	From Brothers Grimm folk tale (1857)	\$416 million
Sleeping Beauty	"The Sleeping Beauty..." (Perrault, 1697)	\$51.6 million
Tangled (2010)	"Rapunzel" (Brothers Grimm, 1812)	\$591.8 million
Tarzan (1999)	"Tarzan of the Apes" (Burroughs, 1914)	\$448.2 million
The Hunchback of Notre Dame (1996)	"The Hunchback..." (Hugo, 1831)	\$325.4 million
The Lion King (1994)	"Hamlet" (Shakespeare, 1603)	\$987.5 million
The Jungle Book (1994)	"The Jungle Book" (Kipling, 1894)	\$205.8 million
Three Musketeers (1993)	"Three Musketeers" (Dumas, 1844)	\$53.9 million
Treasure Planet	"Treasure Island" (Stevenson, 1883)	\$109.6 million

If an enormous company like Disney finds the public domain so useful, surely it is worthy of reverence and protection.

Special consideration is also due to the characters that have already and will continue to enter the public domain following the latest "freeze" of copyright expirations that resulted from

⁶⁰ See Lantagne, *supra* note 58, at 143 (listing the many "myths, legends, folk stories, fairy tales, and other narratives" that Disney has taken inspiration from to create their wildly successful movies).

⁶¹ Crockett, *supra* note 49.

the 1998 legislation.⁶² One scholar dubs these “some of the most iconic and important American cultural works ever produced.”⁶³ And superheroes like Superman and Batman can certainly be considered among their ranks. While significant effort is necessary to make people aware of some works in the public domain, these character’s entrances will be met with much fanfare. Aside from the characters themselves, their entrance into the public domain also coincides with a world that makes it increasingly easier to adapt these works and widely distribute them due to markedly advanced technology.⁶⁴ Additionally, the characters that have so far entered the public domain (Mickey Mouse, Winnie the Pooh, etc.) are targeted mostly to small children and are generally used for ornamental rather than storytelling purposes. On the other hand, superheroes have cultivated audiences that include all ages who are waiting-in-the-wings to adapt these primarily storytelling characters using the ideas that have been swimming in their heads for years. And if that is not enough, many of these heroes have proved their enormous popularity at the box office in recent years, making the prospect of capturing even a fraction of their value very enticing. These facts make it that much more crucial to understand the ramifications of these works entering into the public domain.

(d) “Derivative Works”

At its most romanticized, works in the public domain are as “free as the air to common use.”⁶⁵ Predictably, the truth is much more complex. The biggest complication comes in the form of “derivative works.” When a work enters into the public domain, its plot, dialogue, characters, and other elements become “fair game” for all to use.⁶⁶ However, when the same story or

⁶² Sonny Bono Copyright Term Extension Act, 17 U.S.C. § 101 (1998).

⁶³ Liu, *supra* note 46, at 1397.

⁶⁴ *Id.* at 1409-11.

⁶⁵ *Int’l News Serv. v. Associated Press*, 248 U.S. 215, 250 (1918) (Brandeis, J., dissenting).

⁶⁶ *Klinger v. Conan Doyle Estate, Ltd.*, 755 F.3d 496, 500 (7th Cir. 2014).

character is continued in subsequent works (as is often the case), and some of the works are in the public domain and others are not, a newcomer is only permitted to use the elements that are represented in the public domain works.⁶⁷ In the oft-cited case, *Silverman v. CBS*, the plaintiff (seeking declaratory judgment) was allowed to use elements from the portions of the “Amos ‘n Andy” radio show that were in the public domain, but not those that came from portions of the radio show that were still copyrighted, nor from a subsequent television show.⁶⁸

However, the complications do not end there. An owner can only exercise a derivative copyright if they have made “original embellishments and additions” to the work that is now in the public domain.⁶⁹ The key here is how “original” subsequent additions must be. The widely-held view is that the standard is quite low and that any relatively significant change to a character’s appearance or other elements is enough.⁷⁰ With that being said, if a character has “not changed to any appreciable degree,” then any newcomer would have an unencumbered right to use them.⁷¹ It should be noted that there have been attempts to raise the standard to require a “substantial variation,”⁷² but this view has not been widely accepted and has even been explicitly disavowed.⁷³ This heightened standard might logically make sense to promote as much free use as possible and to prevent patent-like “evergreening” (where small changes are made to retain a monopoly over a patent),⁷⁴ but without support from courts, it is little more than a wish.

⁶⁷ See *Silverman v. CBS, Inc.*, 870 F.2d 40, 49-50 (2d Cir. 1989).

⁶⁸ See *id.* at 50.

⁶⁹ *Filmvideo Releasing Corp. v. Hastings*, 668 F.2d 91, 92 (2d Cir. 1981).

⁷⁰ See *Liu*, *supra* note 46, at 1442-43.

⁷¹ *Harvey Cartoons v. Columbia Pictures Indus.*, 645 F. Supp. 1564, 1570 (S.D.N.Y. 1986). See *Helfand*, *supra* note 34, at 655.

⁷² See *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 491 (2d Cir. 1976); *Gracen v. Bradford Exchange*, 698 F.2d 300, 305 (7th Cir. 1983).

⁷³ See *Schrock v. Learning Curve Int’l*, 586 F.3d 513, 516 (7th Cir. 2009).

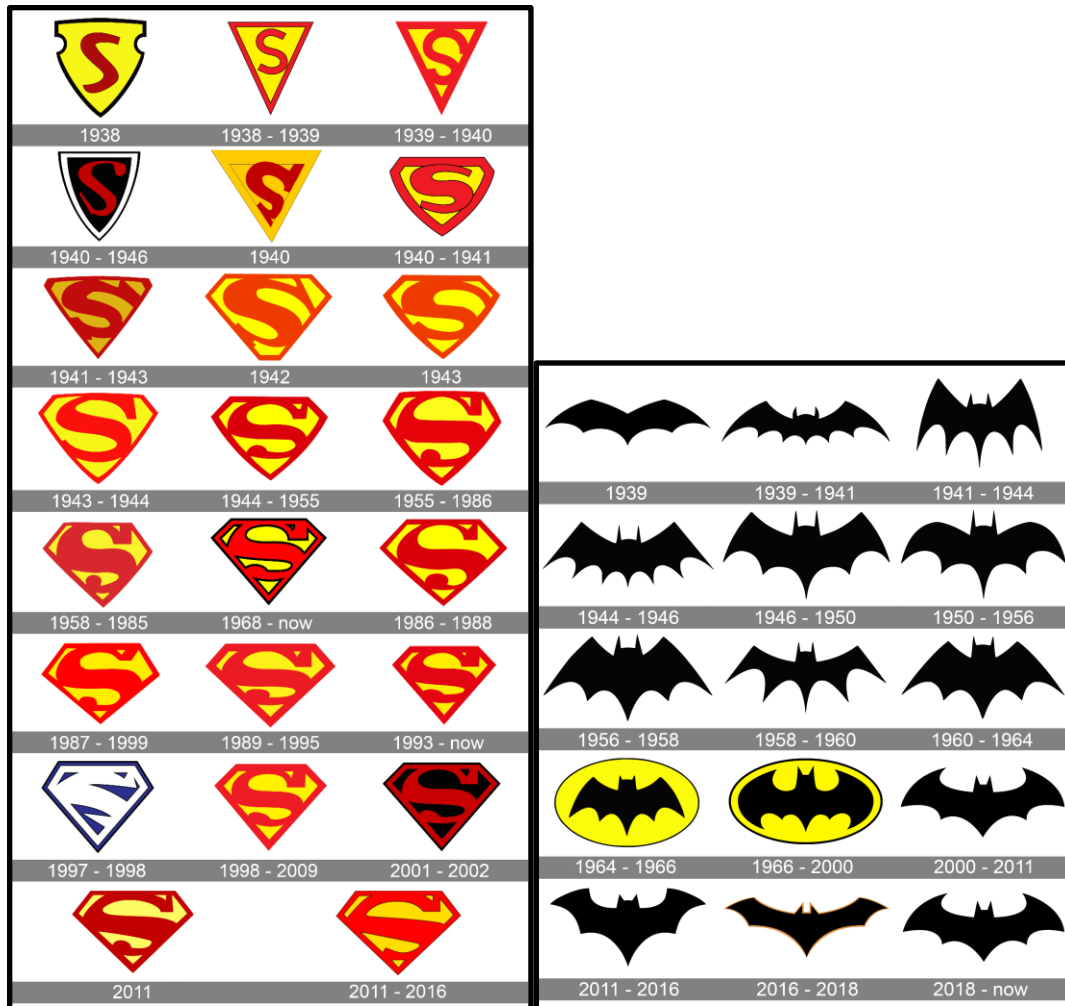
⁷⁴ See *Weiss*, *supra* note 22, at 260.

Despite the low standard of “originality,” the analysis for derivative copyrights can still be difficult to apply and particularly so to characters. To begin with the easier facets, the physical appearance of a character is relatively straightforward. Returning to the current common example of Mickey Mouse: “(i) modern Mickey is in color while Steamboat Willie is monochrome black and white; (ii) modern Mickey wears white gloves; and (iii) Steamboat Willie only has black dots for eyes.”⁷⁵ Simply put, any adapter must adhere to the original appearance of the character that is now in the public domain. For superheroes, the original depiction of characters differs from their modern interpretations in many ways. An easy example is that the chest-symbols on both Superman⁷⁶ and Batman⁷⁷ have changed drastically, as shown below.

⁷⁵ *Id.* at 281 (citing Jesse Kirkland, *In 2024, Mickey Mouse Will Finally Enter the Public Domain - Sort of*, THE BLOG: NYU J. INTELL. PROP. & ENT. L. (Dec. 4, 2019), <https://perma.cc/9SC6-3MGK>).

⁷⁶ 1000LOGOS, *Superman Logo* (Apr. 20, 2024) <https://1000logos.net/superman-logo/>.

⁷⁷ 1000LOGOS, *Batman Logo* (Mar. 20, 2024) <https://1000logos.net/batman-logo/>.



Additionally, the now well-known versions of the Flash and Green Lantern are entirely devoid from their original depictions, as shown below.⁷⁸

⁷⁸ See, e.g., GARDNER FOX, THE FLASH 123 (Detective Comics, Inc., Sept. 1961); JOHN BROOME, GREEN LANTERN 40 (Detective Comics, Inc., Oct. 1965).



In fact, every character's costume has changed to some degree over the years, whether it be minor tweaks or major redesigns. Once the original copyrights on the characters expire, newcomers will be restricted to only the original depictions of these characters. Another piece that is covered here would be tools or powers that the character uses or possesses. In relation to superheroes, examples would include Superman being able to fly⁷⁹ (2 years after the first appearance of Superman), Superman using heat-vision⁸⁰ (11 years after the first appearance of Superman), the invention of kryptonite⁸¹ (5 years after the first appearance of Superman), the naming of the Batmobile⁸² (2 years after the first appearance of Batman), and the introduction of the Batcave⁸³ (5 years after the first appearance of Batman).

⁷⁹ See THE ADVENTURES OF SUPERMAN (New York WOR, Feb. 1940) (in the radio show episode titled "Clark Kent, Reporter").

⁸⁰ See WILLIAM WOOLFOLK, SUPERMAN 50 (Detective Comics, Inc., July 1949).

⁸¹ See THE ADVENTURES OF SUPERMAN (New York WOR, June 1943) (in the radio show episode titled "The Meteor from Krypton").

⁸² See BILL FINGER, DETECTIVE COMICS 48 (Detective Comics, Inc., Feb. 1941). A recent case found a copyright in the Batmobile as a character. DC Comics v. Towle, 802 F.3d 1012, 1027 (9th Cir. 2015), *cert denied*, 577 U.S. 1194 (2016). Recent scholars have cautioned against such a trend. Missy G. Brenner, Comment, *Shadow of the Bat: Character Copyright After DC Comics v. Towle*, 57 SANTA CLARA L. REV. 481, 505 (2017).

⁸³ See DON CAMERON, DETECTIVE COMICS 83 (Detective Comics, Inc., Jan. 1944).

Another relatively easy consideration is that while the appearance of a character may be in the public domain, certain pieces of dialogue or catch phrases might not. In *Warner Bros. v. X One X Productions*, the defendant was allowed to use images from *The Wizard of Oz* movie that were in the public domain, but was prohibited from using still-copyrighted phrases such as “There’s no place like home.”⁸⁴ In regards to superheroes, some iconic phrases may join the public domain in short order, like Superman’s motto of “truth, justice, and the American way”⁸⁵ (4 years after Superman’s first appearance), but to use others such as “Avengers Assemble”⁸⁶ (23 years after Captain America’s first appearance) or “I’m Batman”⁸⁷ (50 years after Batman’s first appearance), creators might have to wait significantly longer. Of course, the work must be copyrightable for there to be a valid derivative copyright, so some of these shorter phrases might not be a concern. However, at least some famous dialogue or monologue will almost certainly be copyrightable and thus shielded from public use by a derivative copyright.

A slightly more nuanced component is that of “created facts,” which take the form of fictitious events in a character’s life. In *Castle Rock v. Carol Publ’g Group*, the court found that certain events from the show *Seinfeld* that were used in the *SAT* were copyrighted because they are creative expressions from the authors.⁸⁸ There is a “distinction between discovered facts, which do not ‘owe their origin to an act of authorship’ and therefore are not protected by copyright, and created facts, which constitute original, protected expression.”⁸⁹ Using the

⁸⁴ *Warner Bros. Entm’t, Inc. v. X One X Prods.*, 644 F.3d 584, 603 (8th Cir. 2011).

⁸⁵ See *THE ADVENTURES OF SUPERMAN* (New York WOR, Sep. 1942) (in the radio show episode titled “The Wolfe”). See also, *THE SUPERMAN HOME PAGE*, The History of Superman’s “Truth and Justice” Motto (Oct. 21, 2021) <https://www.supermanhomepage.com/the-history-of-supermans-truth-and-justice-motto/#:~:text=While%20%20%9CTruth%20%20%9D%20and%20%20%20%9CJustice,of%20%20%20%9CThe%20Wolfe%20%20%9D%20saga.>

⁸⁶ See *STAN LEE, AVENGERS 10* (Marvel Comics, Inc., Nov. 1964) (the phrase was first uttered by Thor, but Captain America officially adopted it in issue 16).

⁸⁷ *BATMAN* (Warner Bros. Pictures 1989).

⁸⁸ See *Castle Rock Ent. v. Carol Publ’g Group*, 150 F.3d 132, 138-39 (2d Cir. 1998).

⁸⁹ *Id.* at 139 (citing *Feist Publications, Inc. v. Rural Tel. Serv., Co.*, 499 U.S. 340, 347 (1991)).

character of Batman as an example, much like the previous discussion on dialogue, some “created facts” will become free to use quickly, such as meeting the first Robin, Dick Grayson⁹⁰ (1 year after Batman’s first appearance), while others will be restricted for longer, such as the birth of his son, Damian Wayne⁹¹ (48 years after Batman’s first appearance), and the death of the second Robin, Jason Todd⁹² (49 years after Batman’s first appearance). For any person wishing to adapt the character, they must be careful to only incorporate “created facts” (and their ramifications) that are already in the public domain.

The analysis becomes far more difficult when one turns to the question of character traits. In a case concerning the character Sherlock Holmes, it was recognized that “[s]torylines, dialogue, characters and *character traits* newly introduced” can be protected under a derivative copyright.⁹³ A later case, again involving the famous detective, recognized that the new character trait of liking dogs was “original” and was thus copyrighted.⁹⁴ When the “Enola Holmes” movie was created, the Arthur Conan Doyle Estate returned to the courts to challenge (among other things) that Sherlock Holmes was portrayed as more empathetic, a trait that was present in only the later, still-copyrighted books.⁹⁵ This case was settled,⁹⁶ leaving open the question of whether and how such a character trait could be infringed upon. Either way, the seeming acquiescence that at least some specific character traits can be copyrighted will force courts and litigants to “put[] on their sleuth hat”⁹⁷ and delve into a collection of works to find evidence of a trait’s

⁹⁰ See BILL FINGER, DETECTIVE COMICS 28 (Detective Comics, Inc., Apr. 1940).

⁹¹ See MIKE BARR, BATMAN: SON OF THE DEMON (Detective Comics, Inc., Dec. 1987) (the story of Damian Wayne is quite complicated, but for simplicity’s sake this year will suffice).

⁹² See JIM STARLIN, BATMAN 428 (Detective Comics, Inc., Oct. 1988).

⁹³ Pannonia Farms, Inc. v. USA Cable, No. 03 Civ. 7841, 2004 U.S. Dist. LEXIS 23015 at *29 (S.D.N.Y. June 8, 2004).

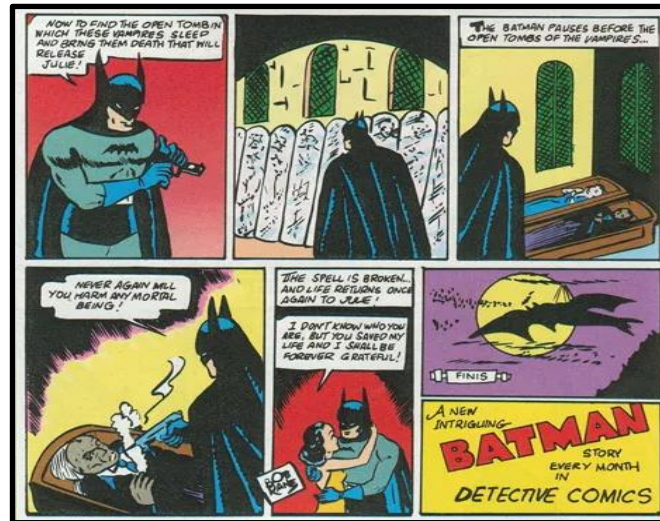
⁹⁴ *Klinger*, 755 F.3d at 502.

⁹⁵ Complaint for Injunction & Damages at 28, 37, Conan Doyle Est., Ltd. v. Springer, No. 1:20-cv-00610 (D.N.M. June 23, 2020).

⁹⁶ Stipulation to Dismiss with Prejudice at 1, *Springer*, No. 1:20-cv-00610 (D.N.M. Dec. 18, 2020).

⁹⁷ Weiss, *supra* note 22, at 285.

existence and date of conception. In regards to superheroes, an easy example is that Batman's now-iconic aversion to firearms was not always the case, evident from the fact that in early stories he actually carried and used guns.⁹⁸ The following image is a panel from that comic book.



However, generally, this task would prove exceedingly difficult, as these comic book heroes were subjected to the new idea of whatever creator had the hands on the switch that week, making them some of the most-often interpreted characters out there. Apart from their original comic books, superheroes have also been utilized in countless movies, television shows, and video games. In these different mediums, single characters have taken on just-as-countless character traits, from child-like silliness to violent mental illness, and everything in between. Therefore, it might be likely that a certain character has at one time espoused a certain trait, but being able to prove such a proposition might be significantly more difficult. Let alone that the trait first appeared at a certain time.

Some of these distinctions cut the bread pretty thin and one could imagine a scenario where the harm created by a slight violation of a derivative copyright would be almost

⁹⁸ See GARDNER FOX, DETECTIVE COMICS 31 (Detective Comics, Inc., Sept. 1939) (this story was entitled “Batman Versus the Vampire”).

nonexistent. This brings to mind a *de minimis* defense. A recent 9th Circuit case made clear that its precedent (and those of many other circuits) is that for copyright law, a *de minimis* defense can be used to determine “whether a work is infringing” (“substantially similar”), but can not be used in terms of a “minimal use of concededly infringing material.”⁹⁹ In other words, a permissible argument is that the “quality or quantity” of similarities between an original and subsequent work are *de minimis*, meaning that the subsequent work is not “a recognizable copy” and there is therefore no copyright infringement.¹⁰⁰ An impermissible argument is that “how extensively” the subsequent work infringes the original is *de minimis* and as a result there is no remedy available.¹⁰¹ Either there is copyright infringement or there is not, and if there is, an appropriate remedy will be awarded. A path is there to attempt a *de minimis* defense, but as long as the subsequent work is “substantially” similar, infringement will be found.

The main takeaway from derivative copyrights, and the wider discussion on copyright laws, is that once these superheroes enter into the public domain, newcomers are immediately free to use them, but only subject to certain rules, some more complex than others.¹⁰²

(e) The Cost of Litigation, Copyright Strikes & Section 230

Starting with the obvious, the threat of “high damage awards can force parties to settle even dubious claims.”¹⁰³ One possible path is that once these superheroes enter the public domain, DC and Marvel will initially throw their weight around in an attempt to utilize litigation as a weapon to clamp down on even permissible uses of their coveted heroes. However, while

⁹⁹ Bell v. Wilmott Storage Servs., LLC, 12 F.4th 1065, 1076 (9th Cir. 2021).

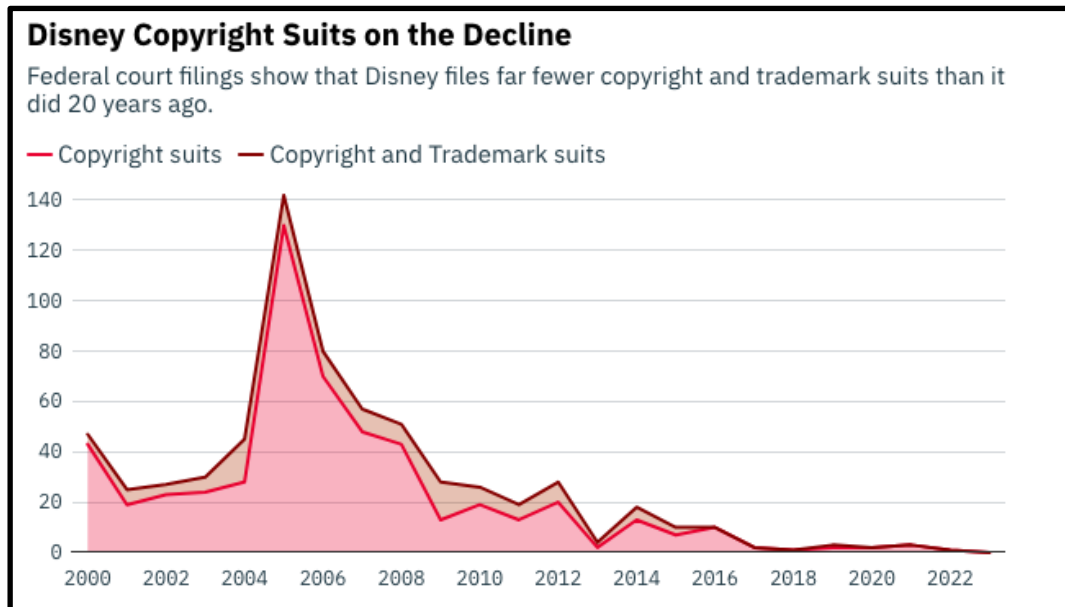
¹⁰⁰ *Id.*

¹⁰¹ *Id.*

¹⁰² See Liu, *supra* note 46, at 1449-50 (contemplating the complexities of Superman’s entrance into the public domain).

¹⁰³ Amanda G. Ciccattelli, *Inspiration vs. Copying: Where’s the Line in Hollywood?*, IP WATCHDOG (July 7, 2017) <https://perma.cc/UAA6-KZGH>.

not necessarily predictive of what will happen, it is worth noting that the numbers of copyright (and trademark) lawsuits by Disney (Marvel's parent company) have drastically reduced in recent years, as depicted in the following graph.¹⁰⁴



This might be due to increased usage of the Digital Millennium Copyright Act (DMCA), which allows studios to submit “takedown notices” to online platforms.¹⁰⁵ For the case of public domain superheroes, although the original copyright would have expired, DC and Marvel could still report violations of derivative copyrights that they still own. While some of these might be difficult cases to make, the “good faith” requirement of the DMCA is rarely enforced, most submissions are never challenged, and permissible uses of works are frequently taken down by algorithms.¹⁰⁶ Therefore, this system is ripe for abuse from these companies, which can either replace or supplement litigation.

¹⁰⁴ Maddaus, *supra* note 52.

¹⁰⁵ 17 U.S.C. § 512.

¹⁰⁶ See Lantagne, *supra* note 58, at 165.

Additionally, Disney has lobbied for watering down Section 230, which gives protection to internet platforms for anything that their users might do.¹⁰⁷ The more this protection is limited, the more that platforms themselves can police possible copyright concerns, thereby doing Disney's job for them.

(f) Contemporary Industry Evidence

To bring this abstracted discussion a little more down to reality, in 2023 James Gunn (Co-chairman & Co-CEO of *DC Studios*) was asked about characters like Superman and Batman entering the public domain and his answer was interesting: “[T]hat’s why we’re bringing the Authority into mainstream. . . . And so being able to try to create these other properties, use our diamonds, our Batman, Superman, Wonder Woman, to prop up our Booster Golds or Green Lanterns or Plastic Mans or whatever is important.”¹⁰⁸ While Gunn has since tried to distance himself from this sentiment,¹⁰⁹ it’s clear that the expiration of the copyrights of these superheroes is very present in the minds of those that work the levers. And this should be seen as a good thing. After all, “copyright holders are on notice of the eventual expiration of their copyright protection and are able to plan the overall strategy of their brand accordingly.”¹¹⁰ This is the process of copyright at work, functioning exactly as it should. The owners of these characters know that they have enjoyed their profitable monopoly for a very long time and that it soon will end.

Part II. Trademark

¹⁰⁷ See *id.* at 158-59.

¹⁰⁸ Kofi Outlaw, *James Gunn Elaborates On What Might Happen When Superman Goes To Public Domain*, COMICBOOK.COM (Jan. 31, 2023, 12:21 PM) <https://comicbook.com/dc/news/will-superman-enter-public-domain-2034-explained-dc-studios-james-gunn/>.

¹⁰⁹ See Felipe Rangel, *James Gunn Responds To How Superman Becoming Public Domain Affects The DCU*, SCREENRANT (Jan. 22, 2024) <https://screenrant.com/superman-dcu-public-domain-james-gunn/> (“No, no story decisions were based on characters becoming public domain.”).

¹¹⁰ Weiss, *supra* note 22, at 287.

(a) How Trademark Works

The second piece of the puzzle is trademarks. The Lanham Act created the modern system of federal trademark law.¹¹¹ The purpose of a trademark is to act as a source identifier for a particular good or service, thereby communicating to consumers that the product comes from a certain source (or is at least authorized by it) and is of the quality that they have come to expect from that source.¹¹² A trademark, much like a copyright, is essentially a monopoly to use the mark. However, unlike a copyright, a trademark is for commercial purposes¹¹³ (rather than artistic), is often limited to a specific market,¹¹⁴ and (while it needs to be periodically proved that the mark still identifies a source) its duration is potentially infinite.¹¹⁵

Also similar to copyright, a trademark attaches upon its use, but to sue under the Lanham Act, a mark must be registered with the U.S. Patent and Trademark Office.¹¹⁶ As a note, the Lanham Act does allow for a world-wide injunction if it is found to be necessary.¹¹⁷ A trademark can be “any word, name, symbol, or device, or any combination thereof.”¹¹⁸ However, although a mark can be almost anything, in order to be registered, it must (1) be used in commerce or have a bona fide intention to be used thus,¹¹⁹ (2) indicate a single source¹²⁰ and (3) be “distinctive.”¹²¹

¹¹¹ 15 U.S.C. §§ 1051 *et seq.* (1946).

¹¹² See Helfand, *supra* note 34, at 635-36 (“Trademarks and service marks perform four main functions: (1) ‘to identify one seller’s goods and distinguish them from goods sold by others’; (2) ‘to signify that all goods bearing the trademark come from a single, albeit anonymous, source’; (3) ‘to signify that all goods bearing the trademark are of an equal level of quality’; and (4) ‘[to serve] as a prime instrument in advertising and selling goods.’”)

¹¹³ 15 U.S.C. § 1125.

¹¹⁴ Nickles, *supra* note 16, at 156.

¹¹⁵ 15 U.S.C. §§ 1058-59.

¹¹⁶ 15 U.S.C. 1125. See U.S. PAT. & TRADEMARK OFF., WHY REGISTER YOUR TRADEMARK? (2023).

¹¹⁷ See, e.g., Reebok Int’l, Ltd. v. Marnatech Enter., Inc., 970 F.2d 552, 554-55 (9th Cir. 1992).

¹¹⁸ 15 U.S.C. 1127.

¹¹⁹ *Id.*

¹²⁰ Universal City Studios v. Nintendo Co., 578 F. Supp. 911, 925 (S.D.N.Y. 1983), *aff’d* 746 F.2d 112 (2d Cir. 1984) (denying a trademark infringement of King Kong by the video game character of Donkey Kong, because many different sources used the King Kong character).

¹²¹ 15 U.S.C. 1052(f).

“Distinctiveness” can be either inherent¹²² or acquired through “secondary meaning.”¹²³ It has been recognized that “drawings” of characters can be trademarks.¹²⁴ In fact, the characters of Superman and Wonder Woman have been explicitly found to function as trademarks because of their “universal recognition,” “widespread popularity,” and “extensive goodwill.”¹²⁵ The same goes for the character of Batman, who was ruled as a trademark because he is “fanciful,”¹²⁶ the highest category of distinctiveness.¹²⁷ In essence, these rulings are because the superheroes “can come to symbolize the plaintiff or its product in the public mind,” hence satisfying the elements of a trademark.¹²⁸ Aside from the characters themselves, courts have found trademarks in character’s names, nicknames, appearances, costumes, and phrases, but have explicitly rejected the same in “physical abilities or personality traits.”¹²⁹ As a note, even elements of superheroes’ stories have been found to act as trademarks, such as Superman’s Daily Planet¹³⁰ and Kryptonite.¹³¹

(b) Trademark vs Copyright: A History

¹²² Wal-Mart Stores, Inc. v. Samara Bros., 529 U.S. 205, 212-13 (2000) (inherent distinctiveness is “automatically” assigned when “[c]onsumers are [] predisposed to regard those symbols as indication of the producer”).

¹²³ Zatarains, Inc. v. Oak Grove Smokehouse, Inc., 698 F.2d 786, 791 (5th Cir. 1983), *overruled in part on other grounds by*, KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc., 543 U.S. 111 (2004) (Secondary meaning when “long use with a particular product, come to be known by the public as specifically designating that product”).

¹²⁴ In re DC Comics, Inc., 689 F.2d 1042, 1043-44 (C.C.P.A. 1982) (concerning “drawings” of specifically “Superman, Batman, or Joker” acting as a trademark for dolls)

¹²⁵ DC Comics, Inc. v. Unlimited Monkey Bus., 598 F. Supp. 110, 115 (N.D. Ga. 1984). *See* Foley, *supra* note 28, at 947.

¹²⁶ D.C. Comics, Inc. v. Reel Fantasy, Inc., 539 F. Supp. 141, 143 (S.D.N.Y.), *rev’d on other grounds*, 696 F.2d 24 (1982).

¹²⁷ *See* Brown v. It’s Entm’t, Inc., 34 F. Supp. 2d 854, 860 (E.D.N.Y. 1999) (“Marks are often classified in categories of generally increasing distinctiveness; following the classic formulation set out by Judge Friendly, they may be (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful. The latter three categories of marks, because their intrinsic nature serves to identify a particular source of a product, are deemed inherently distinctive and are entitled to protection.” (quoting Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 768 (1992))).

¹²⁸ DC Comics, Inc. v. Filmation Associates, 486 F. Supp. 1273, 1277 (S.D.N.Y. 1980).

¹²⁹ *Id.*

¹³⁰ DC Comics, Inc. v. Powers, 465 F. Supp. 843, 847 (S.D.N.Y. 1978).

¹³¹ DC Comics v. Kryptonite Corp., 336 F. Supp.2d 324, 332 (S.D.N.Y. 2004).

Of course, for the purposes of this article, an important question is what happens to a trademark when the copyright expires on a work (particularly a character)? Originally, courts found that trademark law and copyright law occupy separate spheres and have different goals, and can thus coexist, meaning that mark-based rights survive when a work enters the public domain.¹³² These courts even explicitly noted that “[d]ual protection under copyright and trademark laws is particularly appropriate for graphic representations of characters.”¹³³ The argument was that trademark law’s purpose is to take certain works out of the public’s hands, and that the requirements of the mark being a source-identifier and a likelihood of confusion (discussed in the next section) act as safeguards to prevent any unnecessary restrictions on public use.¹³⁴ Subsequently, scholars recognized that these cases were essentially blending copyright and trademark law, with public use mostly bearing the harm.¹³⁵ One scholar praised a case where the court made sure to analyze the copyright and trademark claims separately in turn.¹³⁶ Other scholars argued that “[w]hen copyright law relegates a character that functions as a trademark into the public domain, the public should be able to employ the character.”¹³⁷ At the same time, courts began to question whether trademark was subsuming copyright.¹³⁸

¹³² See, e.g., *Frederick Warne & Co. v. Book Sales, Inc.*, 481 F. Supp. 1191, 1196 (S.D.N.Y. 1979) (“Because the nature of the property right conferred by copyright is significantly different from that of trademark, trademark protection should be able to co-exist and possibly to overlap with copyright protection without posing preemption difficulties.”) *Boston Professional Hockey Ass’n v. Dallas Cap & Emblem Mfg., Inc.*, 510 F.2d 1004, 1011 (5th Cir. 1975) (“trademark laws are based on the needed protection of the public and business interests and there is no reason why trademarks should ever pass into the public domain by the mere passage of time.”)

¹³³ *Frederick Warne*, 481 F. Supp. at 1196 (finding that it did not matter that cover illustrations were in the public domain, only that they identified a particular publisher).

¹³⁴ See Helfand, *supra* note 34, at 665-66.

¹³⁵ See, e.g., *id.* at 623; Foley, *supra* note 28, at 945.

¹³⁶ See *Ideal Toy Corp. v. Kenner Products Div. of Gen. Mills Fun Grp, Inc.*, 443 F. Supp. 291 (S.D.N.Y. 1977).

¹³⁷ Nickles, *supra* note 16, at 166. See also, Foley, *supra* note 28, at 953 (the convergence of trademark and copyright “stifl[e] the very creative forces copyright is supposed to nurture”).

¹³⁸ See, e.g., *In re DC Comics*, 689 F.2d at 1052 n.6 (Nies, J., concurring) (where a “copyrighted doll design is also a trademark for itself, there is a question of whether the quid pro quo for the protection granted under copyright has been given, if, upon expiration of the copyright, the design cannot be used at all by others.”) *Comedy III Prods., Inc. v. New Line Cinema*, 200 F.3d 593, 595 (9th Cir. 2000) (“[T]he footage at issue here was clearly covered by the Copyright Act, . . . and the Lanham Act cannot be used to circumvent copyright law. If material covered by

This all came to a head in the landmark Supreme Court case, *Dastar Corp. v. Twentieth Century Fox Film Corp.*, which dealt with an unfair competition claim brought against a party that used video tapes from the public domain without attributing their source.¹³⁹ For this article’s purposes, the facts of the case are of less consequence than the underlying policy that the case created. In *Dastar*, the Court “caution[ed] against misuse or over-extension of trademark and related protections into areas traditionally occupied by patent or copyright.”¹⁴⁰ It found that too strong of an adherence to trademark laws on public domain works “would create a species of mutant copyright law that limits the public’s federal right to copy and to use expired copyrights,”¹⁴¹ which in turn amounts to the dreaded “perpetual” copyright that the Constitution prevents Congress from implementing.¹⁴² As one scholar puts it, “the Court limited the potential reach of trademark law through a direct appeal to copyright law policy and the importance of free use of public domain materials.”¹⁴³ At its simplest, *Dastar* stands for the proposition that when trademark and copyright law conflict, it is copyright law that prevails. A powerful precedent to be sure. However, only “communicative” goods (books, movies, etc.) are subject to *Dastar*,¹⁴⁴ while commercial goods that are more “traditionally occupied” by trademark law alone (merchandise, toys, etc.) would still be covered by trademark doctrines. *Dastar* of course has its critiques, with the biggest points of contention including how much purchasers of

copyright law has passed into the public domain, it cannot then be protected by the Lanham Act without rendering the Copyright Act a nullity.” (citations omitted)).

¹³⁹ See 539 U.S. 23, 28 (2003).

¹⁴⁰ *Id.* at 34 (comparing the long-held principle that trademark must give way to patent law (even if some consumer confusion is likely) when a patent expires, to copyright law (citing *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 230, (1964) and *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 121-122 (1938)).

¹⁴¹ *Id.*

¹⁴² *Id.* at 37.

¹⁴³ Liu, *supra* note 46, at 1432.

¹⁴⁴ *Dastar*, 539 U.S. at 33.

“communicative” goods care about the source of the product¹⁴⁵ and whether this policing of the trademark-copyright divide is necessary.¹⁴⁶

Therefore, under *Dastar*, once superheroes enter into the public domain, creators should be quite safe to use the characters in “communicative” works (the kind that most newcomers will be interested in creating) from a trademark perspective. The use of “non-communicative” products would still be governed solely under trademark law. And, in all likelihood, there are several claims that can and will be brought should newcomers attempt to use the public domain superheroes on commercial goods. Common remedies allowed for and sought are injunction and damages (including treble damages in some instances).¹⁴⁷ The following two sections will deal with the different claims that can be brought if a party has a valid trademark: trademark infringement, unfair competition, and trademark dilution. Section (c) will cover the first two claims and the third will be addressed in Section (d).

(c) Trademark Infringement & Unfair Competition

Trademark infringement is codified in Title 15 (the Lanham Act).¹⁴⁸ The same is true for unfair competition, a common law claim.¹⁴⁹ While the language of unfair competition is broader

¹⁴⁵ Compare *Dastar*, 539 U.S. at 32-33 (“The consumer who buys a branded product does not automatically assume that the brand-name company is the same entity that came up with the idea for the product, or designed the product - and typically does not care whether it is. The words of the Lanham Act should not be stretched to cover matters that are typically of no consequence to purchasers.”), with Laura A. Heyman, *The Trademark/Copyright Divide*, 60 SMU L. REV. 55, 80 (2007) (this “contention[], it seems to me, [is] misaligned with how consumers experience communicative goods”), and Helfand, *supra* note 34, at 663 (“[C]onsumers are likely to buy a character mark because of the continuity in storyline guaranteed by purchasing from the same source. Moreover, the consumer may be interested in the interplay among characters of different works created or sponsored by the same source.”)

¹⁴⁶ See Heyman, *supra* note 145, at 98 (“The trademark/copyright interface should be treated no differently from other intellectual property interfaces, such that claims asserting harm relating to the interest in exploiting the work itself should be addressed by copyright law, while claims asserting harm relating to the way the source of the work is presented to consumers should be addressed by trademark law-based schemes.”).

¹⁴⁷ See 15 U.S.C. §§ 1111, 1114, 1116-18.

¹⁴⁸ 15 U.S.C. § 1114(1); 15 U.S.C. § 1125(a)(1)(A).

¹⁴⁹ 15 U.S.C. § 1125(a)(1)(B).

than a trademark infringement claim and they do not overlap perfectly,¹⁵⁰ both claims serve the same purpose and have been construed to utilize the same standard of a “likelihood of consumer confusion.”¹⁵¹ Additionally, state law claims of both trademark infringement and unfair competition have been construed as “substantially congruent” to their federal counterparts.¹⁵² For purposes of this report, each of these claims can be treated synonymously.

In order to be successful on a trademark infringement claim, a plaintiff must prove that the defendant’s use of their mark will cause a “likelihood of consumer confusion.”¹⁵³ Factors to be considered include: “1. strength of the mark; 2. proximity of the goods; 3. similarity of the marks; 4. evidence of actual confusion; 5. marketing channels used; 6. type of goods and the degree of care likely to be exercised by the purchaser; 7. defendant’s intent in selecting the mark; and 8. likelihood of expansion of the product lines.”¹⁵⁴ The consumer confusion standard has been broadened to cover both purchasers and third parties, as well as confusion of source, endorsement, sponsorship, and initial but later dispelled.¹⁵⁵ While not the only option, one method of proving that purchasers have indeed been confused by a party’s use of a mark is to

¹⁵⁰ Unfair competition goes beyond trademark infringement to cover “passing off” goods, which includes a false or misleading attribution of source. *See Waldman Publ. Corp. v. Landoll, Inc.*, 43 F.3d 775, 780-81 (2d Cir. 1994) (mostly overruled by *Dastar*); Helfand, *supra* note 34, at 638; Heyman, *supra* note 145, at 65-66.

¹⁵¹ *See, e.g., Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, 925 F. Supp. 2d 1067, 1074-75 (C.D. Cal. 2012) (“When, as here, trademark and unfair competition claims under 15 U.S.C. § 1114 and 15 U.S.C. § 1125(a) are based on the same infringing conduct, courts apply the same analysis to both claims.” (citing *E. & J. Gallo Winery v. Gallo Cattle Co.*, 967 F.2d 1280, 1288 n.2 (9th Cir.1992))); *Banff, Ltd. v. Federated Dept. Stores, Inc.*, 841 F.2d 486 (2d Cir. 1988); *A. J. Canfield Co. v. Honickman*, 808 F.2d 291, 296 (3d Cir. 1986).

¹⁵² *See, e.g., Cleary v. News Corp.*, 30 F.3d 1255, 1262-63 (9th Cir. 1994) (“This Circuit has consistently held that state common law claims of unfair competition and actions pursuant to [] § 17200 are ‘substantially congruent’ to claims made under the Lanham Act.”).

¹⁵³ 15 U.S.C. § 1114(a); 15 U.S.C. § 1125(a)(1)(A).

¹⁵⁴ *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979). *See also In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) (espousing additional factors).

¹⁵⁵ *See Liu, supra* note 46, at 1429.

conduct consumer surveys, but the efficacy and weight of such surveys are for factfinders to determine.¹⁵⁶ At bottom, the determinative factor is the perception of consumers.

While not codified in a statute, a defense to trademark infringement, similar to copyright, is “fair use,” allowing for parodies, satires, and the like. This is due to the fact that such a use of a mark would not confuse a purchaser as to whether the source of the trademark created or authorized the use.¹⁵⁷ As simple as it may sound, if a use of a trademark is “merely amusing, not confusing,” it will likely not be subject to a successful infringement claim.¹⁵⁸ A 2023 Supreme Court case, *Jack Daniel’s v. VIP Prods.*, clarified the First Amendment’s role in a fair use inquiry. If a fair use of a mark is not used to identify the newcomer as the source of their own product, then the *Rogers* test applies. Said test results in the dismissal of an infringement claim brought against an expressive use of a mark unless the mark owner can prove either that the so-called expressive use “has no artistic relevance to the underlying work” or that it “explicitly misleads as to the source or the content of the work.”¹⁵⁹ However, if the expressive use of the mark is also acting as a source-identifier, then this preliminary question is not asked and the inquiry turns to the normal “likelihood of consumer confusion” test.¹⁶⁰ However, the expressive

¹⁵⁶ See *id.* at 1436; *Reddy Communications, Inc. v. Envtl. Action Found.*, 477 F. Supp. 936, 947 (D.D.C. 1979) (“While the results of surveys are generally deemed to be of probative value in infringement cases, and thus admissible, the Court, as trier of fact, must decide the weight to be accorded a particular survey in light of the evidence adduced.”).

¹⁵⁷ See, e.g., *Dr. Seuss Enters. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1405 (9th Cir. 1997) (“In a traditional trademark infringement suit founded on the likelihood of confusion rationale, the claim of parody is ... merely a way of phrasing the traditional response that customers are not likely to be confused as to the source, sponsorship or approval.”); *Anheuser-Busch, Inc. v. L & L Wings, Inc.*, 962 F.2d 316, 321 (4th Cir. 1992) (“Although parody necessarily evokes the original trademark, effective parody also diminishes any risk of consumer confusion.”).

¹⁵⁸ *McCarthy on Trademarks*, § 31.38[1], at 31-216 (rev. ed. 1995) (“Some parodies will constitute an infringement, some will not. But the cry of parody!’ does not magically fend off otherwise legitimate claims of trademark infringement or dilution. There are confusing parodies and non-confusing parodies. All they have in common is an attempt at humor through the use of someone else’s trademark. A non-infringing parody is merely amusing, not confusing.”).

¹⁵⁹ *Jack Daniel’s Props. v. VIP Prods. LLC*, 143 S. Ct. 1578, 1580 (2023) (quoting *Rogers v. Grimaldi*, 875 F. 2d 994, 999 (2d Cir. 1989)).

¹⁶⁰ See *Jack Daniel’s*, 143 S. Ct. at 1592.

use plays an important role in the consumer confusion analysis, as “consumers are not so likely to think that the maker of a mocked product is itself doing the mocking.”¹⁶¹ It should be noted here that some parodies have been found to infringe on trademarks due to failing to dispel consumer confusion,¹⁶² so creators must remain on guard.

Because the central tenet of trademark law is consumer perception, some trademark issues should be defeated by a disclaimer that warns a consumer that the product is not created or authorized by the trademark owner, such as Marvel or DC in the scenario of public domain superheroes.¹⁶³ While such a disclaimer might not notify all consumers,¹⁶⁴ it would correct the perception of many of them in certain situations, thereby not causing confusion, and not running afoul of trademark law. The trademark owner could still create and release works that boast to be the “true” or “original,” and consumers who care could locate them. Some scholars argue that when a character is “synonymous with its source” a disclaimer is not enough.¹⁶⁵ Mickey Mouse to Disney can undoubtedly be considered in that vein, and there are good arguments to also count Batman and Superman to DC as well as Captain America to Marvel. This line of argument is undoubtedly why Disney believes that they can assert their 19 trademarks on “Mickey Mouse”¹⁶⁶ and specific trademarks on “Steamboat Willie” clips¹⁶⁷ to keep their golden goose from falling into the public’s hands. For communicative goods, *Dastar* suggests that “a disclaimer may not

¹⁶¹ *Id.* at 1587.

¹⁶² *See, e.g.,* Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd., 604 F.2d 200, 208-07 (2d Cir. 1979) (finding an infringement in a porn video using Dallas Cowboys Cheerleader uniforms) ; Original Appalachian Artworks, Inc. v. Topps Chewing Gum, Inc., 642 F. Supp. 1031, 1040-41 (N.D. Ga. 1986) (holding that a parody “Garbage Pail Kids” trading cards infringed upon “Cabbage Patch Kids”).

¹⁶³ *See* Liu, *supra* note 46, at 1433; Nickles, *supra* note 16, at 166-67; Helfand, *supra* note 34, at 670-71.

¹⁶⁴ Such as “children or unattentive” purchasers. *See* Helfand, *supra* note 34, at 670-71.

¹⁶⁵ *Id.* at 671.

¹⁶⁶ *See* LUCENTEM, Disney vs. The Public Domain: How Mickey Mouse Continues to Protect His Copyright (Dec. 5, 2018) <https://lucentem.com/2018/12/05/disney-vs-the-public-domain-how-mickey-mouse-continues-to-protect-his-copyright/>.

¹⁶⁷ *See* Lantagne, *supra* note 58, at 161-62.

even be necessary,”¹⁶⁸ but a label is a good way to prevent litigation nonetheless. While disclaimers for non-communicative products might be a harder sell, as long as they adequately prevent confusion, the notion should work just the same. Whether a disclaimer or label is effective would be a fact-intensive inquiry. Thus, while Jennifer Jenkins, director of the Duke Center for the Study of the Public Domain, warns to “not go start selling Disney merchandise,”¹⁶⁹ some goods sporting a public domain version of Mickey Mouse that are labeled as not affiliated with Disney might be okay.¹⁷⁰ Even though the method is not perfect, it is certainly better than a harsher remedy like a blanket injunction against using public domain works.¹⁷¹

Another consideration, albeit a more amorphous one, is the public perception of the source of the character. Much of this discussion, and indeed many of the relevant cases, depends on the assumption that the public is associating the mark with the source even after its copyright expires.¹⁷² But if and when the public becomes sufficiently aware that the work is now in the public domain, this assumption could become moot. Mickey Mouse’s copyright ending was certainly a big news story,¹⁷³ meaning that some percentage of people now understand that when they see the “Steam Boat Willie” version of the character, it’s not necessarily coming from

¹⁶⁸ Liu, *supra* note 46, at 1433 (citing *Dastar*, 539 U.S. at 37-38).

¹⁶⁹ Maddaus, *supra* note 52.

¹⁷⁰ See, e.g., *Geisel v. Poynter Products, Inc.*, 295 F. Supp. 331, 348-49, 352-54 (S.D.N.Y. 1968) (rejecting a label that said “From the Wonderful World of Dr. Seuss,” but permitting one that read “Based on Liberty Magazine Illustrations by Dr. Seuss,” because “[t]he phrase ‘based on’ or the word ‘based,’ as used by defendants after April 9th, like the phrases ‘derived from,’ ‘suggested by,’ or ‘inspired by,’ accurately characterizes the genetic link between the cartoons and the dolls.”)

¹⁷¹ See Leslie A. Kurtz, *The Independent Legal Lives of Fictional Characters*, 1986 WIS. L. REV. 429, 522 (1986).

¹⁷² Helfand, *supra* note 34, at 663 (“When a character passes into the public domain, the reality of the marketplace and psychological associations between a character and its source remain intact.” (citation omitted)).

¹⁷³ See, e.g., Sopan Deb, *These Classic Characters Are Losing Copyright Protection. They May Never Be the Same*, NYT (Jan. 1, 2024) <https://www.nytimes.com/2024/01/01/arts/public-domain-mickey-mouse.html>; Michael Cavanaugh, *Mickey Mouse is Finally in the Public Domain. Here’s What That Means*, WASH. POST (Jan. 1, 2024, 7:00 AM) <https://www.washingtonpost.com/entertainment/2024/01/01/mickey-mouse-public-domain-steamboat-willie/>.

Disney. Similarly, when these high-profile superheroes enter the public domain, the media will ensure that much of the populace hears about it. While it will be up to courts to draw a line, at some point consumer perception will presumably no longer be on the trademark owner's side.¹⁷⁴ This is a farsighted option, but still has merit.

(d) Trademark Dilution

The whole conversation of trademark law turns on its head when it comes to "dilution." Trademark dilution was federally codified in 1995.¹⁷⁵ To successfully claim trademark dilution, a party must prove (1) the mark is "famous," (2) the mark is "distinctive," and (3) the defendant's actions are likely to dilute the mark.¹⁷⁶ Statutory language is very broad in terms of whether a mark is "famous" and courts must undertake a fact-intensive analysis to make such a determination.¹⁷⁷ Dilution can occur through either "blurring" ("impair[ing] the distinctiveness of the famous mark")¹⁷⁸ or "tarnishment" ("harm[ing] the reputation of the famous mark").¹⁷⁹ One thing that is notably absent is any need for consumer confusion, which in fact is not required

¹⁷⁴ See Heyman, *supra* note 145, at 101 ("In the end, this may mean simply that the point of equilibrium between confusion and lack thereof may shift in tandem with the law and/or consumer perceptions.").

¹⁷⁵ 15 U.S.C. § 1125(c).

¹⁷⁶ 15 U.S.C. § 1125(c). See *Brown v. It's Entm't, Inc.*, 34 F. Supp. 2d 854, 859 (E.D.N.Y. 1999); *Danjaq LLC v. Sony Corp.*, 1998 U.S. Dist. LEXIS 22231 at *15 (C.D. Cal. 1998).

¹⁷⁷ See 15 U.S.C. § 1125(c)(2)(A) ("[A] mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner. In determining whether a mark possesses the requisite degree of recognition, the court may consider all relevant factors, including the following: (i) The duration, extent and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties. (ii) The amount, volume and geographic extent of sales of goods or services offered under the mark. (iii) The extent of actual recognition of the mark. (iv) Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register."). See, e.g., *Danjaq LLC v. Sony Corp.*, 1998 U.S. Dist. LEXIS 22231 at *15 (C.D. Cal. 1998) (finding James Bond to be "famous").

¹⁷⁸ 15 U.S.C. § 1125(c)(2)(B) (listing factors that may be considered to determine whether a mark is likely to cause blurring).

¹⁷⁹ 15 U.S.C. § 1125(c)(2)(C).

for a dilution claim.¹⁸⁰ Some scholars argue that this fundamentally goes against the goal of trademark law,¹⁸¹ but others think dilution is crucial to protect “famous” marks.¹⁸²

Dilution, like copyright and trademark infringement, has a fair use provision containing the usual exceptions, including parody, criticism, and news reporting.¹⁸³ The same *Jack Daniel’s* clarification that applies to infringement also applies to dilution: if a fair use is also source-identifying, it does not receive First Amendment protection.¹⁸⁴ Another notable fair use exception is a “non-commercial” use.¹⁸⁵ One scholar points out that cases have interpreted “non-commercial” as including “communicative” works.¹⁸⁶ Combining that notion with the fact that dilution must still comply with *Dastar*, leads to the reasonable conclusion that communicative works (those traditionally covered by copyright law) are an exception to dilution claims. Otherwise, trademark law would “swallow copyright law whole.”¹⁸⁷

However, the non-communicative works that *Dastar* left to trademark law would not so easily escape a dilution claim. And tools such as disclaimers or public awareness would be useless without a confusion standard. In regards to superheroes, it would take little analysis to find that Superman, Batman, or Captain America are “famous” marks. It is thus useful to address both types of dilution.

¹⁸⁰ See 15 U.S.C. § 1125(c)(1) (dilution can occur “regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury”).

¹⁸¹ See Robert G. Bone, *A Skeptical View of the Trademark Dilution Revision Act*, 11 INTELL. PROP. L. BULL. 187, 187-188 (2007) (arguing dilution “threatens to sever trademark law from its policy moorings” and maybe even “lacks a coherent policy foundation”); Vincent N. Palladino, *Reigning in Trademark Dilution Claims*, 1 N.Y.L.J. 1, 8 (1999).

¹⁸² See Kristen Knudsen, *Tomorrow Never Dies: The Protection of James Bond and Other Fictional Characters Under the Federal Trademark Dilution Act*, 2 VAND. J. ENT. L. & PRAC. 13, 19 (2000).

¹⁸³ 15 U.S.C. § 1125(c)(3).

¹⁸⁴ See *Jack Daniel’s*, 143 S. Ct. at 1592-93.

¹⁸⁵ 15 U.S.C. § 1125(c)(3).

¹⁸⁶ See Liu, *supra* note 46, at 1439 (citing *Mattel, Inc. v. MCA Records Inc.*, 296 F.3d 894, 905-06 (9th Cir. 2002)).

¹⁸⁷ Lantagne, *supra* note 58, at 164.

Dilution by “blurring” is concerned with “weakening the association between a famous mark and its goods or services, regardless of whether the infringer actually competes with the mark owner or genuinely tricks customers.”¹⁸⁸ It most often arises in the context of another party using a famous brand name in a market that it does not participate in:¹⁸⁹ “Blockbuster”-branded fireworks¹⁹⁰ or “Chanel”-branded real estate services.¹⁹¹ For two reasons, this context will likely not pose much of a problem for superheroes. First, Marvel and DC have put their respective heroes on such a wide variety of commercial products, that it would be difficult for a newcomer to find a market that is not already occupied. Second, the markets that the companies currently participate in (clothing, bags, cups, etc.) are the ones that newcomers will find the most enticing and likely the ones they will enter. However, a “blurring” claim can also be found inside the same market when an unlicensed mark is employed. This is the exact scenario that will play out once newcomers use public domain superheroes.

On the other hand, dilution by “tarnishment” arises when the defendant’s mark is “linked to products of shoddy quality, or is portrayed in an unwholesome or unsavory context likely to evoke unflattering thoughts about the owner’s product.”¹⁹² The claim is concerned with the “negative association” the plaintiff’s mark might receive.¹⁹³ While some portrayals might be covered under “fair use,” newcomers will likely not hold to “family-friendly” uses of the mark.

¹⁸⁸ Matthew G. Sipe, *A Fragility Theory of Trademark Functionality*, 169 U. PA. L. REV. 1825, 1883 (2021).

¹⁸⁹ See *Louis Vuitton Malletier, S.A. v. My Other Bag, Inc.*, 156 F. Supp. 3d 425, 433 (2016) (“The classic case of dilution by blurring involves an unrelated product coopting a famous name or trademark as its own” such as “Dupont shoes, Buick aspirin tablets, Schlitz varnish, Kodak pianos, Bulova gowns, and so forth.”).

¹⁹⁰ See *Viacom Inc. v. Ingram Enters., Inc.*, 141 F.3d 886, 887-88 (8th Cir. 1998).

¹⁹¹ See *Chanel, Inc. v. Makarczyk*, 110 U.S.P.Q.2d 2013 (T.T.A.B. 2014).

¹⁹² *Deere & Co., v. MTD Prods., Inc.*, 41 F.3d 39, 43 (2d Cir. 1994).

¹⁹³ See *Id.* (“In such situations, the trademark’s reputation and commercial value might be diminished because the public will associate the lack of quality or lack of prestige in the defendant’s goods with the plaintiff’s unrelated goods, or because the defendant’s use reduces the trademark’s reputation and standing in the eyes of consumers as a wholesome identifier of the owner’s products or services.”); *Hormel Foods Corp. v. Jim Henson Prods., Inc.*, 73 F.3d 497, 507 (2d Cir. 1996).

And undoubtedly, newcomers could have or create a bad reputation regarding the quality of their products, which could then harm the superhero mark owner rather than the newcomer.¹⁹⁴

For either type of dilution, courts have recognized claims when a trademark would be “difficult to control” because of an unauthorized use, a rather low standard.¹⁹⁵ Lastly, “post sale confusion” is a claim related to dilution, but because it has only been recognized in the D.C. Circuit, there is little need to cover it.¹⁹⁶

(e) The “Aesthetic Functionality” Doctrine

As the law stands currently, many commercial uses of public domain superheroes would run into problems with either trademark infringement or dilution. Some might agree that this is the correct result. However, if sentiment fell the other way, the “aesthetic functionality” doctrine, used correctly, has the potential to rework this balance.

The doctrine has had a rather windy path, and examining its precedent is a useful exercise. The idea of “functionality” as a defense to trademark law violations is well established, even being codified in statutes concerning allowable uses of a registered trademark¹⁹⁷ and trade dress.¹⁹⁸ However, this “functionality” is more commonly discussed in the physical rather than aesthetic sense, predictably owing its roots to the patent-trademark divide.¹⁹⁹ However, “aesthetic functionality” was first applied to the context of characters in a 1980s case concerning

¹⁹⁴ See, e.g., *Disney Ent. v. Sarelli*, 322 F. Supp. 3d 413, 444 (S.D.N.Y. 2018).

¹⁹⁵ *Brown v. It’s Entm’t, Inc.*, 34 F. Supp. 2d 854, 860 (E.D.N.Y. 1999).

¹⁹⁶ See Sipe, *supra* note 188, at 1884.

¹⁹⁷ 15 U.S.C. § 1115(b) (“Such conclusive evidence of the right to use the registered mark shall be subject to proof of infringement as defined in section 32 [15 USCS § 1114], and shall be subject to the following defenses or defects: . . . (8) That the mark is *functional*”) (emphasis added).

¹⁹⁸ 15 U.S.C. § 1125(a)(3) (“In a civil action for trade dress infringement under this Act for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is *not functional*.”) (emphasis added).

¹⁹⁹ See *Traffix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23 (2001); *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159 (1995).

superhero action figures, which was subsequently reversed.²⁰⁰ It arose again in the 2010s with the character of Betty Boop in the 9th Circuit case, *Fleischer Studios v. A.V.E.L.A.*, but the opinion was subsequently withdrawn and replaced.²⁰¹ Notably, the reason the initial decision was withdrawn was that the court received significant backlash due to raising the issue of “aesthetic functionality” *sua sponte*.²⁰² Following the Circuit Court’s replacement decision, the District Court recognized that the original reasoning was “sound and applicable,” and mostly repeated the precedent and analysis.²⁰³ Additionally, as recently as 2021, the 9th Circuit has utilized the doctrine of “aesthetic functionality.”²⁰⁴ While the case was in the context of a phrase rather than a character, the logic remained the same.

In terms of characters, at its most basic, the doctrine stands for the premise that if a character depicted on a commercial good (bag, shirt, doll, etc.) is being purchased due to “lik[ing] the depicted character itself” rather than due to “allegiance with an entity,” then the character is not being used as a source-identifier, and is therefore not a trademark use.²⁰⁵ The central question is whether “exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage.”²⁰⁶ Factors for answering this fact-intensive question include (a) the value of the character itself, (b) whether the user designates its product as the “original” or not, (c) whether there is evidence of consumers actually being confused as to the

²⁰⁰ See *In re DC Comics, Inc.*, 211 U.S.P.Q. (BNA) 834, 837 (T.T.A.B. 1981), *rev’d*, 689 F.2d 1042, 1045 (C.C.P.A. 1982).

²⁰¹ See *Fleischer Studios, Inc., v. A.V.E.L.A., Inc. (Fleischer I)*, 636 F.3d 1115 (9th Cir. 2011), *opinion withdrawn by* 654 F.3d 958 (9th Cir. 2011).

²⁰² See Justin Hughes, *Cognitive and Aesthetic Functionality in Trademark Law*, 36 CARDOZO L.R. 1227, 1263-64 (2015).

²⁰³ *Fleischer Studios, Inc., v. A.V.E.L.A., Inc. (Fleischer II)*, 925 F. Supp. 2d 1067, 1074-75 (C.D. Cal. 2012).

²⁰⁴ See *LTTB LLC v. Redbubble, Inc.*, 840 Fed. Appx. 148 (9th Cir. 2021).

²⁰⁵ Curtin, *supra* note 12, at 1019-20. See also Liu, *supra* note 46, at 1437.

²⁰⁶ *Au-Tomotive Gold, Inc. v. Volkswagen of Am., Inc.*, 457 F.3d 1062, 1072 (9th Cir. 2006) (quoting *TrafFix*, 532 U.S. at 32 (quoting *Qualitex*, 514 U.S. at 165)).

product's source, and (d) whether other parties use the mark in the same manner.²⁰⁷ So, where a business offers a product that customers buy “only for its value as a symbol” and not because it is from a certain source, the use of the mark is “aesthetically functional” and therefore not infringing.²⁰⁸ A foundational assumption to the doctrine is that consumers buy goods adorned with characters because they like those characters, without any regard for where the good came from. For instance, children (the primary audience for many superheroes) do not care that a piece of Batman merchandise originated from Warner Bros or DC, they just care that it's Batman. I would posit that many adult fans feel the same way. While this notion is by no means widely accepted, logic and common sense arguably fall in its favor.²⁰⁹

Aside from its fraught history, the “aesthetic functionality” doctrine also certainly has its critics. One such critic was bothered by the doctrine's treatment of characters that, while they are (or were) copyrighted, were meant to and in practice do, primarily function as trademarks, such as Smokey Bear or Tony the Tiger.²¹⁰ However, while there are probably some consumers out there who value these types of characters intrinsically, they are clearly different from characters like superheroes. Characters who are primarily trademarks are not used for the story-driven, high-profile movies or shows that create the intrinsic value in them, nor are they slapped onto any type of good one can imagine. Taking Tony the Tiger as an example, it's hard to imagine the majority of consumers associating Tony the Tiger with anything other than “Frosted Flakes” and

²⁰⁷ *Fleischer I*, 636 F.3d at 1123-24 (considering “the articles themselves, the defendant's merchandising practices, and any evidence that consumers have actually inferred a connection between the defendant's product and the trademark owner” (citing *International Order of Job's Daughters v. Lindeburg & Co.*, 633 F.2d 912,919 (9th Cir. 1980))); *Fleischer I*, 925 F. Supp. 2d at 1074-75 (espousing the same factors).

²⁰⁸ *Fleischer I*, 925 F. Supp. 2d at 1074.

²⁰⁹ See Sipe, *supra* note 188, at 1825 (“A school backpack with the character Batman on it, for example, appeals to young students precisely because it has Batman on it. Whether it was specifically produced under the supervision of Warner Brothers Entertainment Company or not is wholly irrelevant. It strains the imagination to conjure up a hypothetical purchaser of a character-emblazoned t-shirt, mug, poster, watch, or other such item for whom the character's presence was not valued in and of itself.”).

²¹⁰ See Hughes, *supra* note 202, at 1265-67.

Kellogg. This line might become more blurred with the recent attempts to take primarily trademark characters and use them in movies, such as Barbie or Mario. However, I believe a difference can be drawn between simply using these characters in a story rather than transforming them into story-driven characters. Many of these such movies and shows are created for the purpose of increasing merchandise sales and therefore does not take away from the fact that these characters are primarily trademarks. There absolutely is a gray area, but a fact-intensive inquiry very common in the legal world could certainly answer the question of whether a character functions primarily as a trademark or a copyright. While this divide is important to consider, “aesthetic functionality” should be able to accommodate it. However, in the same breath, it’s impossible to avoid the fact that the doctrine at its core considerably shakes up trademark law.

The other half of the coin, copyright, plays an important role in the “aesthetic functionality” doctrine as well. Aside from a use of a mark other than source-identification negating trademark concerns, the original *Fleischer* decision also made clear that finding a trademark use in using the image of a character whose copyright has expired would “run directly contrary to *Dastar*” because the “character would essentially never enter the public domain.”²¹¹ It is only because of copyright that this doctrine would work, as copyright law acts as another limitation on it. Copyright law does not care about source-identification, it cares about copying. So while a copyright exists, the name or image of a character could never be used on commercial goods. But, once the copyright expires (after 95 years), this use is permitted, and trademark law becomes the central obstacle.

²¹¹ *Fleischer I*, 636 F.3d at 1124.

Thus, “aesthetic functionality” would only come into play when (a) the copyright on a character has expired (negating the copyright concern), (b) consumers value the character intrinsically (a fact-intensive inquiry that not every character will meet), and (c) consumers buy the character for said intrinsic value rather than its source (negating the trademark concern).

Because the character would not be acting as a trademark, the “aesthetic functionality” doctrine should be able to defeat any claim for trademark infringement or dilution. With that being said, the full picture might not be as straightforward. Dilution’s lack of a consumer confusion standard in particular could present some practical problems. However, again, the logic of the character not acting as a mark should get around this. Either way, in the face of any opposition to this premise, the policy behind the doctrine must be kept in mind. Said policy is that the intrinsic value of these characters was created not only by their owners, but also by society at large. Therefore, after their copyright has expired, the character should be returned to the society who helped to create their value.²¹² This concept can be thought of in much the same vein as any other legend, myth, or fairy tale. No one should own the right to exclusively use Hercules, King Arthur, or Robin Hood. Just the same, after 95 years, Batman, Superman, Captain America, and other superheroes have become akin to these figures and can not be kept from society forever.

Conclusion

²¹² See Jessica Litman, *Breakfast with Batman: The Public Interest in the Advertising Age*, 108 YALE L.J. 1717, 1718 (1999) (“Of course, I paid for that tube of toothpaste with Bugs Bunny’s picture on it. The value of the ‘Bugs Bunny’ mark reflects my participation (and that of millions of other consumers) as well as Warner Brothers’s. The building of a brand that becomes its own product is a collaborative undertaking; the investment of both dollars and imagination flows both ways. There is no particularly good reason to adopt a rule permitting the producers of the brands to arrogate all of that collaboratively created value to themselves.”); Hughes, *supra* note 202, at 1285 (“The alternative proposed here is a vigorous aesthetic functionality doctrine that prevents private parties from gaining market advantages that arise from exploiting widely-shared, preexisting cognitive, psychological, or aesthetic responses among consumers.”).

Once popular superheroes begin to enter the public domain in the next 10 to 15 years, corporate, creative, political, and legal interests will collide. As long as the copyright term is not extended (which would be legally possible, albeit politically difficult), newcomers will be able to use public domain superheroes in their own communicative works without running afoul of valid copyright infringement claims. These newcomers will however be constrained by derivative copyrights. How strictly the limits of a derivative copyright are enforced might fluctuate, but its basic concept will remain the same. Because of *Dastar*, newcomers should not have issues with trademark law for any communicative work. However, as the law currently stands, utilizing public domain superheroes in connection with commercial goods will run into problems with trademark infringement and dilution claims. Tools such as fair use, disclaimers, and consumer perception will find success in defeating these claims to varying degrees. If there is a desire to rework this balance, the “aesthetic functionality” doctrine is a good candidate to do so.