

Copyright, Trademark & Right of Publicity Law for Comic Book Creators

PREPARED FOR THE COMIC BOOK LEGAL
DEFENSE FUND BY KIRKLAND & ELLIS.



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Intro & Contents

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The Comic Book Legal Defense Fund is a non-profit organization dedicated to protecting the First Amendment rights of the comic book community and providing information on legal issues impacting creators, publishers, retailers, and more. Here, we worked with our pro bono legal counsel, Kirkland & Ellis LLP, to provide FAQs with basic information regarding intellectual property matters in the United States as well as helpful links to additional resources.

This FAQ is in three sections: (1) Copyright, (2) Trademark, and (3) Right of Publicity. At the end of this FAQ is a lengthy resource guide of organizations that supply pro bono services to people and companies that meet various income criteria. Feel free to contact CBLDF for additional information.

Please note that no summary of law can be comprehensive or cover the unique facts of a particular situation. This FAQ is presented as an educational text to provide general public information. It does not constitute legal advice. We urge you to consult an attorney about your specific needs.

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The information contained in this communication is accurate as of July 24, 2024, but neither the law nor the resources contained herein are being regularly updated and may change over time.



I. Copyright Law

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1. WHAT IS A COPYRIGHT?

- ▶ **Answer:** A copyright is a legal grant of rights that gives the owner the right to prevent other people from copying, selling, displaying, performing or creating adaptations derived from original works of expression created by an author of a copyrighted work without permission. See 17 U.S.C. § 106. Copyrights can cover a variety of different types of expressive works, from art to literature to software code. For more information, visit <https://www.copyright.gov/what-is-copyright>.
- ▶ **Examples:** Comic books, graphic novels, cartoons, characters, illustrations, paintings, scripts, prose, poetry, photographs, choreography, movies, paintings, architecture, musical compositions, song lyrics, and computer programs all can qualify as original works of creative

expression protectable by copyright law. See 17 U.S.C § 102.

2. IS MY WORK COPYRIGHTABLE?

- ▶ **Answer:** To be copyrightable, the work needs to be original and fixed in a “tangible medium of expression.” 17 U.S.C. § 102(a). To be considered original, a work must be independently created, meaning not entirely copied from another work, and show a “modicum” of creativity. Fixation means any form in which the work can be seen, copied, or communicated. For example, as long as you write your work down, record it by video, or draw it on paper, the work is “fixed” under copyright law.
- ▶ As noted above, copyright can cover a broad range of creative works. It can cover finished comic books and graphic novels as well as works-in-progress. It can also

include elements used in creating the works, including scripts, pitches, and artwork. Fictional characters and even creative inanimate objects can be also copyrightable. However, “stock characters,” such as wizards or mobsters, are not copyrightable unless they have unique elements of expression. Nevertheless, some rise to the level of being copyrightable.

- ▶ For example, in *DC Comics v. Towle*, 802 F.3d 1012 (9th Cir. 2015), the court found that characters and other elements, such as a character’s vehicle and accessories, that appear over multiple works can be protected if they have physical qualities, are recognizable as the same character or element whenever they appear with consistent traits (though their appearance may change), and contain unique elements of expression. Under this test, the court in *Towle* found that the Batmobile is entitled to copyright protection because it has maintained its distinct and unique physical and conceptual qualities throughout its appearances such that it can be recognized as the same vehicle wherever it appears, even if its appearance changes.
- ▶ In contrast, stories or ideas that are never put down on paper or preserved digitally would not meet the requirement to be fixed in a tangible medium of expression and are not protectable by copyright. In addition, an artist’s “style” is generally not protectible under copyright, but it may be eligible for protection under right of publicity laws (see Section III). As for lettering, typefaces themselves are not protected by copyright in the United States, though computer software that generates or provides fonts can be protected. This often means, for example, that hand-drawn letters that mimic

the look of a typeface may not infringe, but using a copyrighted computer program to use a typeface, without an appropriate license, may infringe.

3. WHEN IS MY WORK PROTECTED?

- ▶ **Answer:** Your work is under copyright protection the moment it is created and fixed in a tangible medium. The United States has no requirement that a work be registered to gain copyright protection. (But as noted in Question 5 below, there are advantages to obtaining a copyright registration.)

4. HOW LONG IS MY WORK PROTECTED?

- ▶ **Answer:** Under the current Copyright Act, copyright lasts for the life of the author plus 70 years. 17 U.S.C. § 302(a). Where the work is a joint work (meaning a work with more than one author), copyright protection lasts for the duration of the life of the last surviving author, plus another 70 years. 17 U.S.C. § 302(b). Where the work is a work for hire (meaning a work created in the scope of employment or a commission such that the employee is not deemed an author, but rather the company is the author and owner), copyright lasts for 95 years from the first publication or 120 years from the year of creation, whichever expires first. 17 U.S.C. § 302(c). For the purposes of copyright law, “publication” is defined as distributing copies of the work to the public. 17 U.S.C. § 101.

5. WHY SHOULD I REGISTER MY COPYRIGHT?

- ▶ **Answer:** While as noted above you have a copyright in a work even if it is not registered, there are some important benefits to registering your works with the United States

Copyright Office. Perhaps the most important benefit is that registration or being denied a registration is required to sue someone for infringement in federal court. 17 U.S.C. § 411. Additionally, if you file for registration within five years of the first publication of the work, the registration will serve as “prima facie evidence” to courts of valid copyright ownership. 17 U.S.C. § 410. This means that the burden is on the infringer to show that the copyright is not valid. Timely registration can also affect what you can recover in a lawsuit. If you register your copyright prior to the start of the infringement or within three months of first publication, you will be entitled to seek statutory damages (*i.e.*, set damages for each work infringed) and your attorney’s fees in pursuing a lawsuit. 17 U.S.C. § 412. With a later registration, you will only be able to recover your actual damages, an amount which sometimes can be difficult to support with evidence, such as claims for hypothetical lost profits, and you will not be able to seek your attorney’s fees.

6. HOW DO I REGISTER MY COPYRIGHT?

- ▶ **Answer:** Either you or your lawyer can apply for a copyright registration through www.copyright.gov or on a paper application. You will need to submit a completed application form, a nonrefundable filing fee, and a nonreturnable deposit. For more information, visit <https://www.copyright.gov/circs/circ02.pdf>.
- ▶ As of this writing, an electronic filing costs \$65 for an application, plus \$45 for the first work sought to be registered for a single author. Additional works may be registered at the same time for a flat fee; for instance, up to fifty additional works may be registered electronically for a single

\$60 charge. Paper filings for a single work cost \$125, with up to 10 additional works for \$60. Authors may also register a claim in a group of two or more serials for \$35 per issue, or a claim in a group of contributions to periodicals for \$85.

- ▶ Claims submitted electronically, and where the Copyright Office does not respond with a refusal or request for more information, are normally completed in one to two months, but creators do not need to wait for processing to be completed before publishing. Expedited processing (five business days or less) is available for a \$800 fee in cases of pending litigation, customs matters, or contract or publishing deadlines.
- ▶ For updated fee structures, visit: <https://www.copyright.gov/about/fees.html>.

7. WHAT IS A COPYRIGHT NOTICE?

- ▶ **Answer:** A copyright notice is a statement placed on copies of a work to inform the public that a copyright owner is claiming ownership of the work. Such notice usually specifies the copyright status, the year of publication, and the author. 17 U.S.C. § 401. A sample copyright notice could be the following: © 2000 Your Name (or the name of your company). Note that you can put a copyright notice on your work even if it is not registered.
- ▶ There is no cost incurred to you for using a copyright notice. Putting a copyright notice on your work would help make clear that you are claiming ownership and could help deter others from copying your work. Also, using a proper copyright notice can have certain benefits should you decide to sue. First, using a copyright notice will ensure that the copyright holder’s damages are not reduced due to innocent infringement. Second, if the notice is removed by an infringer, it will

potentially entitle you to damages under the Digital Millennium Copyright Act (“DMCA”) for intentional removal of the notice.

- ▶ **Example Notice:** “This website is © 2000-2024 by [Your Name or Company]. All rights reserved. This website may not be copied or duplicated in whole or part by any means without express prior agreement in writing or unless specifically noted on the website.”

8. IS THERE ANY PROBLEM IF I DECIDED NOT TO INCLUDE A COPYRIGHT NOTICE?

- ▶ **Answer:** Currently, no. It is up to you. For works created on or after March 1, 1989, no notice is required for copyright protection. However, if your work was published before 1978 and you did not use a copyright notice, your work may have fallen into the public domain, meaning it would not be protected by copyright. If the work was published without a notice between 1978 and March 1, 1989, and you did not register the copyright with the Copyright Office within the next five years, your work may also have fallen into the public domain. This can be a nuanced issue of law and you should discuss your particular facts with a lawyer if you have questions concerning pre-March 1989 works.

9. WHEN DOES MY EMPLOYER OR PUBLISHER RETAIN COPYRIGHT OF A WORK I WAS HIRED TO CREATE?

- ▶ For newer works, if you are employed by a company and create your comic book within the scope of employment, your work will likely be considered a “work for hire.” 17 U.S.C. § 101. Moreover, if the creator is an “independent contractor” rather than an employee, a work may still count as a “work for hire” if it was specially ordered for use,

so long as it is one of the types of works allowed by the Copyright Act (discussed further in Question 10 below) and the parties have expressly agreed in a written document signed by them that the work shall be considered a “work for hire.”

10. WHAT IS A “WORK FOR HIRE”?

- ▶ The copyright in a work for hire belongs to the hiring party, not the creator. 17 U.S.C. § 201(b). Determining whether a work is a “work for hire” first requires determining whether the creator is an “employee” or merely an “independent contractor.” A work prepared by an employee within the scope of their employment are works for hire. For specially ordered or commissioned works created since 1978, if a freelance creator is not an employee and does not sign a written contract specifically mentioning “work-for-hire,” then the work cannot be a work-for-hire, and the creator will retain copyright in the work.
- ▶ In addition, works that are specially ordered may qualify as work for hire only if they fall into specific categories, namely, a contribution to a collective work (such as an anthology), a part of a motion picture or other audiovisual work, a translation, a supplementary work, a compilation, an instructional text, a test, answer material for a test, or an atlas. 17 U.S.C. § 101. This means that if the work was created by a non-employee, and it does not fall into one of these limited categories, then it cannot be a “work for hire” even if there is an agreement saying that. (Though the parties could agree to transfer the ownership from the original author to the company.)
- ▶ **Example:** In a recent case, colorist William Crabtree sought to invalidate an agreement

that writer Robert Kirkman had him sign in 2005 stating that his work on the *Invincible* comic book beginning in 2003 was work for hire. *Crabtree v. Kirkman*, No. 2:22-cv-00180-MEMF-AFM, 2023 WL 8113797 (C.D. Cal. Nov. 22, 2023). The case later settled before trial. See Question 14.

11. HOW DO I KNOW IF I QUALIFY AS AN EMPLOYEE OR AN INDEPENDENT CONTRACTOR?

- ▶ The line between employee and independent contractor is not always clear. There are two tests to determine whether a creator was an employee or an independent contractor. Which test applies depends on when the work was created.
- ▶ For works created before 1978, courts examine whether the work was created at the “instance and expense” of the employer. This test was used in the case of *Marvel Characters, Inc. v. Kirby*, 726 F.3d 119 (2nd Cir. 2013), in which the court found that Marvel owned the copyright in the characters that Jack Kirby created, even though he was a freelance creator, because the work was done at Marvel’s “instance and expense.” To determine this, the court considered Marvel’s right to supervise the work and make creative contributions, and that Marvel paid him a flat page rate without providing royalties or covering his expenses or materials. As such, the court found that the characters were works for hire.
- ▶ For works created since 1978, courts balance 12 factors adopted from agency law (an area of law that addresses employee-employer relationships) to measure the company’s “right to control the manner and means by which the product is accomplished”: (1) the

skill required; (2) the source of tools used; (3) the location of the work; (4) the duration of the relationship; (5) the right to assign additional projects; (6) the hired party’s discretion over when and how long to work; (7) the payment method; (8) the hired party’s roles in hiring and paying assistants; (9) whether the work is part of the regular business of the hiring party; (10) whether the hiring party is in business; (11) the provision of employee benefits; and (12) the tax treatment of the hired party. *Community for Creative Non-Violence v. Reid*, 490 U.S. 730 (1989). The closer a situation resembles a traditional salaried employment relationship, the more likely it is that a work created within the scope of employment is a “work for hire.”

- ▶ Courts generally follow the test in *Reid*, although there is some debate as to whether the *Reid* factors identified above should still apply. After the Supreme Court decided *Reid*, the Restatement of Agency treatise, upon which the Court based the multi-factor test, replaced the factors with a simple test, namely: “An employee acts within the scope of employment when performing work assigned by the employer or engaging in a course of conduct subject to the employer’s control. An employer’s act is not within the scope of employment when it occurs within an independent course of conduct not intended by the employee to serve any purpose of the employer.” Restatement (Third) of Agency § 7.07. Courts, however, have yet to adopt this interpretation.
- ▶ **Example:** There have been many famous cases in the comic book industry in which creators contested whether characters were works for hire, including those

involving Superman creator Jerry Siegel and Captain America creators Joe Simon and Jack Kirby. *See Siegel v. Time Warner Inc.*, 496 F. Supp. 2d 1111, 1115–18 (C.D. Cal. 2007) (describing a 1940s dispute over the rights to Superboy); *Marvel Characters v. Simon*, 310 F.3d 280, 282–84 (2d Cir. 2002) (describing a 1960s dispute over Captain America); *Marvel Characters, Inc. v. Kirby*, 726 F.3d 119 (2d Cir. 2013). In the cases listed here, the creators and publishers settled, and the publisher retained control of the copyrights. Note, however, that the *Kirby* case listed above did result in a decision for Marvel, before the parties settled ahead of an appeal to the Supreme Court. See Question 13.

12. CAN I TRANSFER OR LICENSE THE COPYRIGHT IN MY COMIC BOOK TO ANOTHER PARTY? IS THERE A DIFFERENCE?

- ▶ **Answer:** Copyright owners can assign or license the rights to their copyrighted works in any way they choose. With an assignment, the ownership of the copyright is transferred to the assignee, and the original creator no longer owns it. With a license, the original owner retains ownership of the copyright, but gives the licensee the right to use the work as specified under the terms of the license, often for a fee.
- ▶ **Example:** Jerry Siegel and Joe Shuster assigned Superman to the publisher now known as DC Comics in 1938 for \$130. Today, authors and studios often license rights to stories and characters from other mediums to comic-book publishers. For instance, Paramount Pictures has licensed the right to create and produce comic books based on “Star Trek” to IDW.

13. CAN I TERMINATE A LICENSE OR A TRANSFER OF THE COPYRIGHT IN MY COMIC BOOK OR CHARACTERS?

- ▶ **Answer:** First, check if there is a time limit to the license or transfer in the agreement. Second, if there is not a time limit, or if the transfer or license was given “in perpetuity” (or in some similar language), you may be able to recapture your copyrighted work 35 years after the grant of the rights if your work was created since 1978. This is called your “termination right,” which an author can invoke regardless of the terms of the original agreement, unless the work was a work for hire (for copyright purposes, the “author” of a work for hire is the employer, not the creator). The termination right cannot be waived or contracted away, even in a will, and may only be enforced by an author, their immediate family, or their estate. *See* 17 U.S.C. § 203. This is a very complex area of the law. Beyond this general information, if you are at all thinking of exercising a termination right, speak to a lawyer to see if it applies to your works and investigate the limited time windows in which to exercise them.
- ▶ **Example:** Cases involving comic books played a key role in both the creation of termination rights in the 1970s and their enforcement today. Congress created the termination right to ensure creators could realize the true value of the work, which could rarely be known before the work was published. *See* H.R. Rep. No. 94-1476, at 124 (1976).
- ▶ In recent years, the families of freelance Golden Age and Silver Age creators, including creators of Superman, Captain America, and Spider-Man, have tried to

enforce their termination rights. Publishers have argued that these works are works for hire, and thus ineligible for termination. While a court found that Jack Kirby's creations published by Marvel were works for hire, other creators have entered into settlements with the publishers, the terms of which are confidential, that ensure the publishers can continue publishing the characters. *Larson v. Warner Bros. Ent.*, 504 F. App'x 586, 587–88 (9th Cir. 2013); *see also* Bloomberg News, *Dispute Over Captain America Is Settled*, N.Y. TIMES (Sept. 30, 2003), <https://www.nytimes.com/2003/09/30/business/media/dispute-over-captain-america-is-settled.html>; Blake Brittain, *Marvel and Spider-Man Artist's Estate Settle Superhero Copyright Clash*, REUTERS (Dec. 7, 2023), <https://www.reuters.com/legal/litigation/marvel-spider-man-artists-estate-settle-superhero-copyright-clash-2023-12-07>.

14. IF I CO-AUTHORED A COMIC BOOK WITH ANOTHER CREATOR, DOES THAT AFFECT MY COPYRIGHT IN THE COMIC BOOK?

- ▶ **Answer:** If more than one person work together to create the work, the work may be considered a “joint work.” 17 U.S.C. § 101. This is true whether the “work” in question is the comic book as a whole or just the character(s) within a comic. Ownership of a joint work is shared among co-authors. 17 U.S.C. § 201(a). Not everyone, however, who contributes to a work is a co-author. Co-authors must contribute more than just ideas. Rather, to be a joint author each person's contribution must be independently copyrightable and the co-authors of the work must have intended to combine their contributions as part of a whole. Note that the ownership of the copyright in a character

may be different than the ownership for the work in which the character appears, or other characters in the same work, as each can be considered separate and independent copyrighted works.

- ▶ **Example:** In *Gaiman v. McFarlane*, the court determined that Neil Gaiman and Todd McFarlane were co-authors of three characters created jointly for an issue of *Spawn*. Gaiman contributed original, fixed expression to the characters by describing and naming them and writing their dialogue. McFarlane likewise created the characters' visual appearance. McFarlane conceded that one character, Angela, was a joint work, but he claimed that the other two, Medieval Spawn and Cogliostro, were not copyrightable, as Medieval Spawn was derivative of Spawn (the title character), and Cogliostro was a stock character (see Question 2, above). The court found that both characters were sufficiently distinct expressive content to be copyrightable, and thus that both creators were entitled to ownership of the copyright in all three characters. *Gaiman v. McFarlane*, 360 F.3d 644, 660 (7th Cir. 2004)
- ▶ **Example:** Because co-creators are often friends, they often see little need to enter into a contract defining ownership when they are in the process of creating. But disputes can arise, particularly when a work later finds success. These disputes can often be avoided by signing a written contract, such as a collaboration agreement, and by having that contract reviewed by an attorney, regardless of the relationship among creators. For example, in 2012, childhood friends Robert Kirkman and Tony Moore settled an ownership dispute over *The Walking Dead* after Moore alleged Kirkman had defrauded him into assigning

his rights. Moore claimed that he did not receive the royalties he was promised, and Kirkman filed a counterclaim arguing that Moore was overcompensated. When the case moved to federal court, Moore asserted an additional claim that he was a co-owner of the work. The parties later settled the case in an agreement that was not disclosed to the public. Later, William Crabtree, the colorist on Kirkman's *Invincible*, alleged that Kirkman had him unfairly certify that his work on *Invincible* was a work-for-hire two years after the comic was first published. Crabtree also claimed he and Kirkman had an oral contract that he would receive royalties, but he never received the compensation he was promised. In 2023, a court found that the statute of limitations for Crabtree's copyright claims had expired but allowed a breach of contract claim to proceed to trial. *Crabtree v. Kirkman*, No. 2:22-cv-00180-MEMF-AFM, 2023 WL 8113797 (C.D. Cal. Nov. 22, 2023). The parties settled on undisclosed terms in 2024. See Winston Cho, *Robert Kirkman 'Invincible' Ownership Lawsuit Settles Just Ahead of Trial*, HOLLYWOOD REP. (Jan. 25, 2024), <https://www.hollywoodreporter.com/business/business-news/invincible-profits-showdown-series-ownership-ends-settlement-1235807371>.

15. WHAT ARE THE CONSEQUENCES OF CO-AUTHORSHIP?

- ▶ **Answer:** Each co-author can exploit the work however they wish, including the right to create adaptations or other derivative works, without receiving permission from the other authors. That means each joint author can grant licenses, although joint authors cannot grant exclusive licenses without the consent of other co-authors. Each author, however, has a duty to account for any profits earned from the licensing or use of the copyright in proportion to each co-author's ownership rights. See *Ashton-Tate Corp. v. Ross*, 916 F.2d 516 (9th Cir. 1990). For instance, if a writer and an artist were co-authors of a graphic novel, and the writer wanted to license the publication rights in the book to a publisher, they may do so, but the artist would be entitled to half the profits.
- ▶ Not having exclusive rights can sometimes make it hard to license a joint work, as the party seeking a license often wants exclusivity. Since no single author can prevent their co-authors from licensing a joint work, co-authors of a joint work cannot grant truly exclusive licenses without the permission of all co-authors. Thus, before publishers enter into an agreement for what they believe to be an "exclusive license," they should first determine that the other party owns the entirety of the work.

16. IF I USE ARTIFICIAL INTELLIGENCE TO AUTHOR A COMIC BOOK, DOES THAT AFFECT MY COPYRIGHT IN THE COMIC BOOK?

- ▶ **Answer:** The Supreme Court long ago determined that a work must embody the ideas of an author to be entitled to copyright protection. *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884). Subsequent courts have found that an author must be human (or a company in the case of a work made for hire). The Copyright Office has established that parts of a work generated by artificial intelligence—or the entire work if everything was generated by artificial intelligence—is not copyrightable under current law. 88 Fed. Reg. 16190. Law in this area is not fully settled, however. In one case, the Copyright Office repeatedly refused to register an AI-

generated artwork called “A Recent Entrance to Paradise” on the ground that the image lacked human authorship. A court upheld the refusal but noted that the use of AI in creating a work “will prompt challenging questions” about how much human input is necessary to qualify the user of an AI system as an author of a generated work. *Thaler v. Perlmutter*, No. 22 Civ. 1564, 2023 WL 5333236 (D.D.C. Aug. 18, 2023). The case is currently on appeal.

- ▶ **Example:** *Zarya of the Dawn* is a graphic novel by Kristina Kashtanova, who used text-prompt artificial intelligence to generate the images for her book. The Copyright Office limited the registration to the graphic novel’s text and the selection and arrangement of text and artwork generated by AI as Kashtanova wrote the text and selected the arrangement of the text and images. The Copyright Office, however, refused to register the AI-generated images themselves because they lacked human creation. The Office found that the AI-generated images were not copyrightable because they were not a work of human authorship.
- ▶ **Example:** Other works have been registered, however, when the applicant disclosed that the work used some pre-existing material that was generated using AI. For instance, Abhinav and Raghav Aggarwal registered a book titled “Bridging the AI Gap,” the text of which was entirely generated by AI. See Copyright Reg. TXu002349597. Novelist Vin Strong used AI to generate text for a draft of his book “Maze of Spies” before building on the generated text himself for the final version. See Copyright Reg. TX0009391072.

17. COULD I BE HELD LIABLE FOR INFRINGEMENT IF I USE AI TO CREATE MY WORK?

- ▶ **Answer:** AI-generated content may expose you to legal liability. For example, because generative AI is often trained on unlicensed content, its outputs might implicate copyright, trademarks, and rights of publicity (the right a person has to control their name and likeness). See Section II below. Thus, using AI to create works that are substantially similar to other people’s copyrighted works could subject you to liability.

18. IF I SELL SOMEONE A DRAWING OR A COMIC BOOK, DO THEY HAVE THE RIGHT TO MAKE COPIES OF IT?

- ▶ **Answer:** No. Physical ownership of a work does not grant the owner of the physical copy a copyright in the work. For example, when comic book artists create artwork for sale at conventions, the purchaser of the work will own the physical copy, but the artist will still own the copyright. This means the buyer may resell, loan, rent, or destroy the physical copy, but may not infringe the artist’s exclusive rights in the work to reproduce, adapt, publish, perform, or display the work.
- ▶ However, commissioned artworks (*i.e.*, works that a buyer requests and an artist creates and delivers) may be subject to implied licenses for the buyer to use the artwork unless expressly limited at the time the artwork is delivered. Implied licenses involve fact-specific inquiries and often turn on objective indicia of the artist’s intent, which can include the artist’s understanding of the buyer’s intended uses of the artwork, the artist’s contemporaneous objection to certain

uses, industry customs regarding uses of the sort the buyer ultimately makes, and whether and how much the artist was paid for their work. Because implied licenses require fact-specific analyses, you should consult a lawyer for questions about your particular situation.

19. CAN A BUYER RESELL MY ARTWORK WITHOUT VIOLATING COPYRIGHT LAWS?

- ▶ **Answer:** Yes, but only for physical artwork. The “first sale doctrine” permits the legal owner of a physical copy of a work to sell or otherwise dispose of that copy without violating the rights of the copyright owner. See 17 U.S.C. § 109. If you sell digital copies of your work, however, such as a digital comic or eBook, purchasers of those copies cannot resell them. The first sale doctrine does not apply to digital copies of works, as transferring a digital file requires the creation of a copy of the file, and copyright protects authors’ rights to reproduce their works. See 17 U.S.C. § 106(1); *Capitol Recs., LLC v. ReDigi Inc.*, 910 F.3d 649 (2d Cir. 2018).

20. CAN I INCLUDE ANY OTHER AUTHORS’ CREATIVE WORKS, SUCH AS CHARACTERS, IN MY OWN WORK?

- ▶ **Answer:** Using a copyrighted work in your work, such as by drawing a scene that incorporates it, might make you liable for copyright infringement. Sometimes the original artist will be flattered by your homage, but it is possible that the artist will be upset by the use, particularly if you use a lot of the original work or make many copies for sale. It is generally a good idea to get permission to use other people’s creations in your work or be sure that your use would be considered fair use. See Question 23.

21. CAN I USE SOMEONE ELSE’S CREATIVE WORKS, SUCH AS PHOTOGRAPHS, AS REFERENCE MATERIAL?

- ▶ **Answer:** A copyright owner has the right not only to prevent other people from copying, selling, or displaying the copyrighted work without permission but also to prevent others from creating derivative works. 17 U.S.C. § 106. A “derivative work” is one based upon preexisting works, such as an adaptation, translation, reproduction, abridgment, or any other form in which a work may be recast or transformed (such as a sequel or prequel that uses the same copyrighted characters). 17 U.S.C. § 101. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a derivative work.
- ▶ A work of art that copies a copyrighted photograph may be considered a derivative work if the reference material is recognizable in the final artwork. For example, the Andy Warhol Foundation was found to have infringed photographer Lynn Goldsmith’s photograph of the musician Prince when it licensed silkscreened prints derived from the photograph. *Andy Warhol Found. for Visual Arts, Inc. v. Goldsmith*, 11 F.4th 26 (2d Cir. 2021). Merely using a portion of another’s photo as reference material from which to draw on elements of a photo, however, such as a guide for musculature or draping, is unlikely to create liability for infringing the copyright in the photo. This is because these elements are uncopyrightable facts that there are only a limited number of ways to depict, and thus the original author could not assert a

copyright over these unprotectable elements. Moreover, the material in some art books that are specifically created to serve as reference guides may be used under an implied license.

22. HOW DO I KNOW IF I HAVE CREATED A “DERIVATIVE WORK”?

- ▶ **Answer:** Whether a work is a derivative work is determined case by case, but some examples include translation, fictionalization, motion picture adaptations, sound recording, art reproduction, abridgement, and condensation. Using a copyrighted character in a new story also could be considered a derivative work, or otherwise an infringement. If you are concerned about this issue, it is generally a good idea to get permission to use other people’s photos in your work or be confident that your use would be considered fair use. See Question 23.

23. WHAT IS FAIR USE?

- ▶ **Answer:** Under the fair use doctrine, it is permissible to use limited portions of a work for purposes such as commentary, criticism, news reporting, and scholarly reports. There are no legal rules permitting the use of a specific percentage of a work. Rather, courts consider multiple factors in a fair use analysis. The factors include “(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 upon the potential market for or value of the copyrighted work.” See 17 U.S.C. § 107.
- ▶ Under the **first** factor, the purpose and character of a work, a use may be

considered transformative if it adds some new expression to convey a new meaning or message different from the original work. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994). But the inquiry also considers the user’s justification for copying the original work. If the secondary use and the original work “share substantially the same purpose” then the newer use will not be considered transformative. Factor One also looks at whether a work is commercial. Non-profit works are more likely to be fair use. For example, in the *Warhol* case described in Question 21, the court found that licensing the silkscreened prints to be used as magazine covers was not fair use in part because both Goldsmith’s photograph and the Foundation’s prints “share substantially the same purpose, and the use is of a commercial nature.”

- ▶ The **second** factor, the nature of the use, weighs in favor of a finding of fair use if the original work is less creative than it is functional. For instance, some courts often find source code to be functional because source code is chiefly designed to efficiently perform specific tasks. In cases where portions of such source code are used, this factor may favor fair use. The creation of most comic books, however, requires creative input. When creative works are used, this factor is more likely to weigh against a finding of fair use.
- ▶ The **third** factor, the amount of the work used, is more likely to weigh in favor of a finding of fair use if only a small or insubstantial portion of the original work is used, and only for a short duration. The third factor is not merely about *quantity*, however; it also requires a *qualitative* calculation. In other words, even if the

portion used is a tiny fraction of the original, this factor can still weigh against fair use if that fraction is determined to be the “heart” of the original work. *Harper & Row v. Nation Enterprises*, 471 U.S. 539 (1985).

- ▶ The **fourth** factor, the effect on the market, will weigh against a finding of fair use if the new use usurps the market for the original. Thus, under this factor, a use that has no effect on demand for the original is more likely to be found to be fair use than a use that competes with the original in the same market. Similarly, if the copyright owner has not established a market for licensing its work in the way in which it is being used by the alleged infringer, this factor may be less likely to favor a finding of fair use.
- ▶ **Example:** When a *Star Trek* fan wanted to make his own fan film, he turned to online crowdfunding platforms and raised over a million dollars to pay for a “professional production with a fully professional crew.” He released a short film for free on YouTube to raise funds for a full-length feature, and Paramount sued for copyright infringement. The fan raised a fair use defense, and the court considered the four factors. Under the first factor, the court found that the film was of a commercial nature, even though the short film was released for free, because the creators gained an indirect commercial benefit from the work’s popularity. The court found that the second factor weighed in favor of Paramount because the *Star Trek* works were creative and thus “are given broad copyright protections.” The third factor also weighed in favor of Paramount because the film’s extensive use of elements from *Star Trek* works were critical to the film. The fourth factor also weighed against a finding of fair use because the

short film was the “the kind of potential derivatives” that Paramount would develop themselves or grant licenses to develop. With all four factors weighing against fair use, the court found in a written decision that the defendants were not entitled to a fair use defense. *See Paramount Pictures Corp. v. Axanar Prods., Inc.*, No. 2:15-CV-09938-RGK-E, 2017 WL 83506 (C.D. Cal. Jan. 3, 2017).

- ▶ **Example:** Vanguard Productions, LLC published a book, *Frazetta Book Cover Art*, that contained two pieces of artwork by Frank Frazetta that appeared on the covers of books one and four of James Silke’s *Death Dealer* series. Frazetta’s estate sued for copyright infringement, and Vanguard raised a fair use defense. The court found that none of the four factors favored fair use. For the first factor, the court held that Vanguard’s use was not transformative. In so doing, the court distinguished the case from a 2006 precedent finding fair use for small-size thumbnail images of Grateful Dead posters used in a coffee table book where they were “were included ‘only to enrich the presentation’ in combination with ‘a prominent timeline, textual material, and original graphical artwork.’” The court found that unlike in *Graham*, here the works shared the same purpose—to display the cover art. For factor two, the court found that because Frazetta’s works were creative, this factor weighed against fair use. The court found that factor three was neutral. Although the entirety of Frazetta’s works was included, Frazetta’s works comprised a small part of Vanguard’s book. As for factor four, the court held that this factor cut against fair use. Because the works shared the same purpose, Vanguard’s work supplanted the

original, and if its conduct were to become widespread, this would undermine the incentive to create. *Frazetta v. Vanguard Prods.*, 8:22-cv-00581-WFJ-AEP, 2024 WL 519767 (M.D. Fla. Feb. 9, 2024).

24. IS IT AUTOMATICALLY FAIR USE OF A WORK IF I AM NOT MAKING MONEY FROM IT?

- ▶ No, offering an infringing work to the public for free might negatively impact the market for the original work, such as by decreasing the price people are willing to pay to view the original work or license the original work. In addition, as noted above in the *Paramount* case, even if an infringing work is not sold there may be indirect commercial benefits. Moreover, non-commercial use is only one of many factors in the fair use analysis, so comic book creators should be cautious about including third-party works in their comic books without permission, even if they will not make money from the comic books.

25. CAN I USE SOMEONE ELSE'S WORK FOR THE PURPOSE OF PARODY OR SATIRE?

- ▶ **Answer:** Courts also apply the fair use doctrine to determine whether a use of a copyrighted work is permissible as a parody. Using copyrighted material for purposes of criticism and comment are examples of fair use, and this often includes parody, which is a criticism of the original work that requires some mimicry of the original to make its point. The key question in deciding whether a parody is fair use is whether it uses only enough of the original work to parody the original, and not more. Note, however, that parody may not permit extensive use of another's trademark.

- ▶ **Example:** In 1978, the Ninth Circuit Court of Appeals considered whether the underground comic *Air Pirates Funnies*, which featured graphic depictions of Disney characters in adult situations, was fair use. The court held that the extensive use of the characters, including on the cover of the comic and references to the characters by name, went beyond what was necessary to “conjure up” the works being parodied. Wholesale copying, the court held, is not fair use. *Walt Disney Prods. v. Air Pirates*, 581 F.2d 751 (9th Cir. 1978).
- ▶ Satire, however, is not an example of fair use. As opposed to parody, satire is criticism that stands on its own without requiring the use of the original work. Three cases involving Dr. Seuss illustrate this distinction. In the first case, a court found that a book satirizing the O.J. Simpson murder trial, *The Cat NOT in the Hat!*, broadly mimicked Dr. Seuss' characteristic style, but did not comment on or criticize Dr. Seuss' work. Rather, it used Dr. Seuss' work to comment on O.J. Simpson. Thus, the court found that the book was a work of satire and not entitled to a parody fair use defense. *Dr. Seuss Enters. v. Penguin Books, USA, Inc.*, 109 F.3d 1394 (9th Cir. 1997). In contrast, a playwright's one-woman show, “Who's Holiday!” based on “How the Grinch Stole Christmas,” was found to be protected by the fair use doctrine as a transformative parody because it made the characters, setting, and “Dr. Seuss' rhyming innocence all appear ridiculous.” *Lombardo v. Dr. Seuss Enterprises L.P.*, 279 F. Supp. 3d 497 (S.D.N.Y. 2017). In a third case, a Star Trek-themed parody book, “Oh the Places You'll Boldly Go,” was not considered fair use because it was not transformative. The court found that the book did not instill a new meaning or message, but “merely

repackaged” Seuss’ “Oh, the Places You’ll Go!” by copying the composition of the original. *Dr. Seuss Enters., LP v. ComicMix LLC*, 983 F.3d 443 (9th Cir 2020).

26. CAN I USE SOMEONE ELSE’S WORK IF THE WORK IS OLD?

- ▶ **Answer:** Once the copyright in a work expires, it enters the public domain and can never again be protected by copyright law. As a general matter, works from 1928 or earlier are likely to be in the public domain because they were created at least 95 years ago. See Question 4. Note that this can be complicated as the first appearance of a character might have fallen into the public domain, but subsequent works that add notable elements could continue to be protected by copyright. Determining if more recent works are in the public domain can be difficult because different terms apply to different works depending on when they were published or created, or if the copyright has been renewed. Be careful relying on online sources to determine if a work has fallen into the public domain, as the rules can be complicated and the law has changed over time. Consult an attorney if you plan to use a work that you believe may have fallen into the public domain, as all or some elements of a work may still be protected by copyright. Moreover, the copyright holder might have trademark rights that could impact how the public domain work is used, as discussed below.
- ▶ **Example:** Under an older version of the Copyright Act, works published before 1964 had to be renewed during their 28th year after publication to receive another 28 years of copyright protection. Since many Golden Age publishers went out of business before their 28th year, they did not renew their copyrights in the works-for-hire they had published, and these works may have entered the public domain. Other publishers may have overlooked the renewal requirement.
- ▶ When a work enters the public domain, later incarnations of characters used in that work may still be protected by copyright. For instance, *Action Comics* #1 (published in 1938) will eventually enter the public domain and likely be available for anyone to reprint or adapt. But this likely does not mean that the Superman character would be completely unprotected. To the extent elements of the Superman character and his world were created after 1938—such as his modern costume and traits, the Daily Planet, Jimmy Olsen, and Lex Luthor—copyright protection will still remain when the first *Action Comics* stories enter the public domain. Trademark protection also may apply.
- ▶ Other areas of the law may also limit unrestrained use of public domain material. For instance, unlike copyright, trademarks may last forever and be continually renewed. Trademark law may continue to prevent other people from using the name of a character in connection with certain products, even if the copyright in the character or original stories have entered the public domain. Since this guide cannot cover every area of law, consult a lawyer about your planned uses of public-domain material.

27. CAN I ABANDON MY RIGHTS AS A COPYRIGHT OWNER?

- ▶ **Answer:** Yes, copyright owners can intentionally relinquish rights or grant an unconditional, irrevocable license for anyone to use their work.

- ▶ This becomes more complicated, however, when a work has been assigned or licensed to another party. The original author cannot waive any rights that they have already transferred to another, such as in a work-for-hire. Relinquishing rights after licensing rights to use a work can leave the author liable for a breach of the license agreement.
- ▶ **Example:** In 2023, *Fables* creator Bill Willingham said he intended to put the series and its characters in the public domain amid a dispute with the series' publisher, DC Comics. Willingham claimed he owned the copyright and could relinquish his rights. See Bill Willingham, *Willingham Sends Fables into the Public Domain*, THESE FOOLISH GAMES (Sept. 14, 2023), <https://billwillingham.substack.com/p/willingham-sends-fables-into-the>. DC, however, released a statement that it owned the *Fables* stories and characters and would continue to enforce its copyright interests. See David H. Siegel, *Creator Dedicates Award-Winning Comics Series to the Public Domain – Or Does He?*, NAT'L L. REV. (Sept. 22, 2023), <https://natlawreview.com/article/creator-dedicates-award-winning-comics-series-to-public-domain-or-does-he>. DC continued to publish *Fables* comics in 2024.

28. DO I NEED TO ENFORCE MY RIGHTS AS A COPYRIGHT OWNER?

- ▶ **Answer:** No, copyright owners may choose not to enforce their rights. If the work has been assigned or licensed to another party, however, that party may choose to enforce their rights.
- ▶ In addition to not pursuing copyright infringement claims, you can publish your work under a Creative Commons CC0 license. This particular kind of Creative Commons license signifies to others that a work may be freely copied or adopted.

For more information, visit <https://creativecommons.org/public-domain/cc0>.

29. WHAT ARE MY OPTIONS IF I FIND OUT THAT SOMEONE IS USING MY WORK WITHOUT MY PERMISSION?

- ▶ **Answer:** There are a number of options which you could pursue. First, you could make a phone call or send an email directly to the infringer and attempt to negotiate. Second, you could send a cease-and-desist letter informing the infringer of your rights and demanding that they stop the infringing conduct. One of the biggest risks of a cease-and-desist letter is the potential for an unwanted lawsuit; if the infringer who receives a cease-and-desist letter has a real and reasonable fear that they might be sued, they are allowed to file a lawsuit to get guidance about whether there was in fact a violation of the copyright in the forum of their choosing. Third, you could file a lawsuit, though this would be an aggressive measure. Which choice makes the most sense depends on the facts of your particular situation. Given the risks, it is best to do this in consultation with an attorney.
- ▶ If the infringement is an online infringement, then another option is to send a DMCA notice and take-down request to the webhost asking it to remove the infringing content. Most content-hosting websites have a form or an email address you can use to report copyright infringement. For example, to report infringing content on Facebook, you can access Meta's DMCA notice on Facebook's Help Center. This can be a quick and relatively inexpensive way to resolve infringement.
- ▶ However, the online infringer could argue that their content is not infringing, and the content could be put back online. In this case, you may need to resolve this matter via a lawsuit.



II. Right of Publicity Law

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1. WHAT IS THE RIGHT OF PUBLICITY?

- ▶ **Answer:** The right of publicity protects against unauthorized uses of a person's name, likeness, or other ways by which they can be identified. Unlike copyright law, which is governed by federal law (meaning the same statute applies in all states), right of publicity law varies from state to state. Which state law applies often depends on where the person in question lives or where they had been living at the time of death.

2. HOW IS THE RIGHT OF PUBLICITY DIFFERENT FROM COPYRIGHT LAW?

- ▶ **Answer:** The right of publicity is a separate body of law from copyright law. Copyright

law protects the unauthorized use of certain kinds of creative works, whereas the right of publicity protects unauthorized use of a person's name or likeness. The test for liability usually retains many of the same considerations as copyright, however, particularly whether the work is transformative.

3. CAN I USE A FAMOUS PERSON'S LIKENESS IN MY COMIC BOOK?

- ▶ **Answer:** Maybe. Using a person's likeness in a comic book may implicate the individual's right of publicity. Some uses of a celebrity's likeness, however, may be protected under the First Amendment as parody or political commentary.

- ▶ **Examples:** Comic book publishers and creators have been sued after using well-known individuals' names or likenesses in their works. For example, a *Jonah Hex* comic published by DC Comics featured a pair of villains—violent half worms who were eventually killed—that resembled the likenesses of musicians Johnny and Edgar Winter. The Winter brothers objected to this depiction and sued under California's right of publicity law. The California Supreme Court unanimously found that the “fanciful, creative characters” were transformative expressive works entitled to First Amendment protection and did not violate the Winter brothers' right of publicity. *Winter v. DC Comics*, 30 Cal. 4th 881 (2003).
 - ▶ A case under Missouri's right of publicity law had a different outcome. Tony Twist, a former professional hockey player, sued Todd McFarlane over the use of his name for a mafia boss character in the *Spawn* comic book. The Missouri Supreme Court rejected California's test for right of publicity violations, holding instead that First Amendment protection depended on whether the use was predominantly commercial or expressive in nature. *Doe v. TCI Cablevision*, 110 S.W.3d 363 (Mo. 2003). Following a trial, a jury found that McFarlane's use of Twist's name was predominantly to sell comic books and related products rather than to make an artistic or literary expression about the hockey player. Thus, because McFarlane was primarily using Twist's identity to gain a commercial advantage, McFarlane's use was not protected by the First Amendment and violated Twist's right of publicity. The jury awarded Twist \$15 million, a verdict that was upheld on appeal. *Doe v. McFarlane*, 207 S.W.3d 52 (Mo. Ct. App. 2006).
 - ▶ But not every use of a celebrity's likeness ends up in litigation. According to published reports, in 2002—years before the creation of the “Marvel Cinematic Universe”—Marvel Comics reimagined its Nick Fury character with Samuel L. Jackson's likeness in the pages of *The Ultimates*, allegedly without requesting the actor's permission. Jackson questioned Marvel about the depiction, and the publisher “avoided a lawsuit by saying that if Nick Fury was ever in a movie, Jackson could play the role.” Jackson accepted and went on to play Fury in 11 movies and multiple TV shows, while Jackson's wife bought a page of Bryan Hitch's original art from the *Ultimates* comic. DAVE GONZALES ET AL., MCU: THE REIGN OF MARVEL STUDIOS 93–94 (2023).
- #### 4. DOES THE RIGHT OF PUBLICITY STILL APPLY IF THE PERSON IS DEAD?
- ▶ Many states have laws that permit rights of publicity to descend to a person's heirs if the person had exploited their right of publicity during their lifetime. Sometimes, such a decedent's right of publicity lasts for only a certain number of years after their death. If you have an issue about this subject, it would be good to contact a lawyer to see which laws apply to your situation.



III. Trademark Law



1. WHAT IS A TRADEMARK?

- ▶ **Answer:** A trademark is any word, phrase, design, or combination thereof used to identify and distinguish the source of goods or services of one seller from those of another seller. See 15 U.S.C. § 1127. The first person to use a mark in business (the “senior user”) can prevent others (“junior users”) from using similar trademarks for similar goods and services if the use is likely to cause consumer confusion. 15 U.S.C. § 1114. To determine whether a use is likely to cause consumer confusion, courts apply multi-factored tests (which specific factors depends on the jurisdiction), including considering the similarity of the trademarks, the similarity of the goods or services offered, how the goods or services are sold, and the strength of the senior user’s trademark rights, among other considerations.

- ▶ **Example:** Below are some examples of trademarks. For more examples and more detailed explanations, visit the Trademark Office’s website at <https://www.uspto.gov/trademarks/basics/trademark-examples>.

2. WHY SHOULD I GET A TRADEMARK?

- ▶ **Answer:** Consumers often make their purchasing choices on the basis of recognizable trademarks that they know and trust. Having and enforcing your trademark rights can prevent others from free riding on the investment you have made in building a recognizable brand. It also ensures that consumers know what they’re getting when they purchase a product and are not confused as to the source or sponsorship of the product.
- ▶ **Example:** The Coca-Cola Company has worked for decades to build rights in its trademark, “COCA-COLA”. The Coca-Cola

Word	SPIDER-MAN	SUPERMAN
Phrase	With great power comes great responsibility	Man of Steel
Design		

Company can thus prevent others from using similar names for soda, ensuring that when consumers purchase soda with the name “COCA-COLA”, they are getting a product that originates from the Coca-Cola Company.

3. ARE SOME TRADEMARKS STRONGER THAN OTHERS?

- ▶ **Answer:** Yes. The more a trademark is used the stronger it generally becomes. For example, as a trademark, Spider-Man was not as strong in 1963 as it is today. The more distinctive a trademark is, the stronger the protection it receives. Distinctiveness is measured on a spectrum. The following five categories generally define the strength of a trademark on a spectrum, ranked from strongest to weakest. Marks that are fanciful, arbitrary, or suggestive can get trademark protection without “secondary meaning.” A mark has secondary meaning when the public has come to associate the mark with a particular source or company (as opposed to merely viewing the word as *describing* a good or service).
- ▶ **Fanciful:** Marks created solely for the purpose of being used as a trademark that have no other meaning (e.g., “Kodak” for cameras or “Pepsi” for soda).
- ▶ **Arbitrary:** Marks using common words but in a way that is unrelated to the goods or services that they are used to identify for sale (e.g., “Apple” for computers or “Marvel” for comics).
- ▶ **Suggestive:** Marks that suggest a quality or characteristic of the goods and services but does not directly describe them (e.g., “Microsoft” for software or “Chicken of the Sea” for canned seafood).
- ▶ **Descriptive (including surnames):** Marks that immediately convey an idea of the qualities or characteristics of the goods or services and describe the goods or services on which they are used (e.g., “Holiday Inn” for hotels, “Raisin Bran” for cereal with raisins and bran flakes). Descriptive marks are not entitled to protection until they have secondary meaning (meaning that consumers have come to associate the brand with the owner of the mark rather than a characteristic of the product).

- ▶ **Generic:** The generic name of a product or service cannot be used as a trademark (e.g., smartphone or e-mail). Sometimes, a well-known brand name can come to be known as a generic name for a product or service (e.g., aspirin or laundromat). While these terms started as trademarks, after time they became so ubiquitous that they became known as the generic name of the product because they were no longer associated with a single source. This concept, known as “genericide,” actually terminates a company’s trademark protection in the generic term.

4. HOW DO I GET TRADEMARK RIGHTS?

- ▶ **Answer:** The United States, unlike many other countries, recognizes common law trademark rights. This means that, without even filing for a trademark registration, which can make the rights clear to others, you can still develop rights in a trademark simply by using it in commerce. The scope of your rights depends on how distinctive the mark is, how long you have been using it, and where you are using it. For example, if you only use the trademark in New York (e.g., you only sell a product or service in New York and nowhere else), you will only have common law trademark rights in New York. By contrast, as discussed below, a federal trademark registration will give you rights nationwide.

5. WHY SHOULD I REGISTER MY TRADEMARK?

- ▶ **Answer:** Federally registered marks give the registrant rights throughout the entire United States and provide several benefits:
 - Gives notice to others that you have rights in the mark. The trademark will be listed in the United States Patent and Trademark

(“USPTO”) database. This makes your trademark searchable to anyone who may be trying to file for a similar or identical mark and may thereby prevent infringement.

- Creates the legal presumption that you own the trademark and have the right to use it. Registration is prima facie evidence of validity.
- Confers nationwide priority of rights. The first entity that uses a mark in commerce generally has “priority” for the mark (meaning others cannot use the mark for similar goods). An exception to that rule is that the USPTO allows for filing a trademark application based on an “intent to use” the mark before the mark is actually used. In such instances, the owner (once a registration issues) is able to claim the filing date of the application as its priority date.
- Allows trademark owners to work with U.S. Customs to block importation of goods using an infringing mark into the United States.

6. HOW MUCH WILL IT COST ME TO GET A TRADEMARK REGISTRATION?

- ▶ **Answer:** The costs for applying and maintaining a trademark registration depends on several factors. The application itself can cost anywhere from \$250 to \$350 for the registration of one mark for one class of goods (like, for example, printed comic books in Class 16). After registering your marks, you will have to pay fees to maintain your registration five years after registration, and then every ten years after that. For example, for a mark registered on January 1, 2024, the initial renewal will be due between January 1,

2029, and January 1, 2030. The maintenance fee is \$525. For more information on the PTO's fee schedule, visit <https://www.uspto.gov/learning-and-resources/fees-and-payment/uspto-fee-schedule>.

- ▶ Note that in the event that you do not properly renew your trademark registration, that does not mean that you have abandoned your common law rights if you continue to use the mark. See Question 17.

7. WHAT DO I NEED TO DO BEFORE I TRY TO REGISTER MY TRADEMARK?

- ▶ **Answer:** You should research and determine if anyone else is using a similar trademark for similar goods and services, and thus may have prior trademark rights. You can search for your proposed mark on the federal government's Trademark Search (<https://tmsearch.uspto.gov>) to see if anyone is using the mark you want to register. You should also survey the Internet and determine if there are common law users that may oppose your registration. If possible, consult with an attorney about conducting a full trademark clearance, a report that checks for common law use and similar registrations for the mark you wish to use and provides legal advice on your ability to successfully register the mark. It is also wise to have an attorney conduct a trademark clearance before you start using a trademark in connection with your goods or services, even if you do not wish to register a trademark.
- ▶ For more information about the benefits or searching for your proposed mark, visit <https://www.uspto.gov/trademarks/basics/why-search-similar-trademarks>.
- ▶ Many law schools offer pro bono services to the public that include trademark clearances. For more information and a list of schools that

offer trademark services, visit <https://www.uspto.gov/learning-and-resources/ip-policy/public-information-about-practitioners/law-school-clinic-1>. Note also that at the end of this FAQ is a general listing of organizations that provide free legal services.

8. WHAT HAPPENS IF MY PROPOSED TRADEMARK IS ALREADY TAKEN?

- ▶ **Answer:** If someone has already registered an identical trademark in connection with identical goods or services then, absent extenuating circumstances, it is unlikely you will be able to register your trademark. This is because having two very similar marks in the marketplace for the same goods and/or services could confuse consumers. If the marks and/or goods or services are distinguishable, however, the USPTO may still grant your application. Even identical trademarks may not cause consumer confusion if the goods and services are different. If there is a trademark you are concerned about, it may be helpful to hire an attorney to help you analyze the risks.

9. WHAT IS A TRADEMARK NOTICE?

- ▶ **Answer:** A trademark notice is a symbol that can be placed next to a mark that indicates the owner is claiming trademark rights in the mark. There are three commonly used trademark symbols: TM, SM, and ®. TM and SM are used for unregistered trademarks. TM is for trademarks that represent goods (for example, comic books) and SM is for marks that represent services (for example, a mark that an artist uses in connection with their services related to drawing comics for others). Note that you can use a TM or SM symbol even if the trademark is not registered. The ® symbol is only for marks that have been registered. If you do not own a trademark registration, you should not use the ® symbol.

- ▶ There is no cost incurred to you for using a trademark notice. If you have a good faith belief that you have common law rights in a mark, you can add a TM or SM symbol without having to file a registration. Putting a trademark notice on your work would help make clear that you are claiming ownership and could deter others from using your mark.

- ▶ **Example:** Man of Steel®; Man of Tomorrow™; CBLDFSM

10. DO I NEED TO INCLUDE A TRADEMARK NOTICE?

- ▶ **Answer:** No. You don't have to use any of these symbols, but doing so helps put others on notice that you are claiming rights in the trademark, similar to the effect of using a copyright symbol. See Question 7 in the Copyright section. There is no cost incurred to you for using a trademark notice and it could help deter others from using similar marks. If you do not provide notice of a registered trademark, you will not be able to recover profits or damages in an infringement suit, unless the defendant had actual notice of the registration. 15 U.S.C. § 1111.

11. WHAT IS TRADEMARK INFRINGEMENT?

- ▶ **Answer:** Trademark infringement is the unauthorized use of a trademark on or in connection with goods and/or services in a manner that is *likely to cause consumer confusion, deception, or mistake* about the source of the goods and/or services. If you use someone else's trademark (or a confusingly similar trademark) in one of the ways listed above, they can file a lawsuit against you and seek a court order to force you to stop using the trademark and also to pay monetary damages, among other forms of relief.

- ▶ **Example:** If you start a new comic book with a title that a prior user thinks likely causes confusion with what they have done, that could be problematic. Similarly, if someone is using a trademark that you think is likely to cause consumer confusion with a trademark that you own, then you might want to take action to get them to stop.

12. WHAT SHOULD I DO IF SOMEONE ELSE IS USING MY TRADEMARK?

- ▶ **Answer:** There are a number of options you could pursue. First, you could make a phone call or send an email directly to the infringer and attempt to negotiate. Second, you could send a cease-and-desist letter informing the infringer of your rights and demanding that they stop the infringing conduct. One of the biggest risks of a cease-and-desist letter is the potential for an unwanted lawsuit; if the infringer who receives a cease-and-desist letter has a real and reasonable fear that they might be sued, they are allowed to file a lawsuit to get guidance about whether there was in fact a violation of the trademark. Third, you could file a lawsuit, though this would be an aggressive measure. Which choice makes the most sense depends on the facts of your particular situation. Given the risks, it is best to do this in consultation with an attorney.

13. DO I NEED TO ENFORCE MY TRADEMARK RIGHTS?

- ▶ **Answer:** A trademark owner who consistently fails to enforce their rights in a trademark may lose those rights. Unlike in copyright law where there is no duty to enforce infringement, in trademark law you must regularly police third-party use of your mark and attempt to enforce your rights; otherwise, you risk having your rights

weakened or your mark become generic if so many third parties use it that consumers no longer associate the mark with you. You should therefore take appropriate steps to enforce your trademark rights. For instance, you should use the appropriate trademark symbol next to your mark. See Question 9. In addition, if you become aware of other people using a mark that is similar to your own, you should consider contacting them to object. See Question 12. If you fail to actively “police” potential infringement by other companies, it can make it harder for you to stop that company (or other companies engaging in similar uses) from using that trademark in the future.

14. CAN THE TITLE OF MY COMIC BOOK BE A TRADEMARK?

- ▶ **Answer:** Maybe. The USPTO will not register one-off book titles, but titles that are part of a series of books may serve as trademarks.
- ▶ **Example:** The USPTO did not initially accept Marvel’s application for the mark I AM GROOT in connection with books and other printed matter because Marvel did not provide evidence that this mark was used for a series, as opposed to being simply the title of a single book. Marvel successfully registered the mark after submitting evidence that I AM GROOT was used for a series of comic books. Registration No. 7190100; see <https://tsdr.uspto.gov/documentviewer?caseId=sn90370505>.

15. HOW LONG WILL IT TAKE ME TO GET A TRADEMARK REGISTRATION?

- ▶ **Answer:** It typically takes anywhere from at least 12 to 18 months for your trademark application to proceed to registration, but the time frame can vary depending

on the particular mark. There, however, is no guarantee that your trademark can be registered, and various factors could delay your registration. For example, if there are issues with the application, the USPTO may issue “office actions” requiring you to fix those issues. In the example to the previous question, the USPTO issued an office action to notify Marvel that an issue with its trademark application needed to be corrected. The application proceeded to registration after Marvel fixed the issue and responded to the office action.

- ▶ Apart from office actions, if someone else claims that they used the mark first (and thus are the senior user of the mark) and thinks that your trademark is likely to cause consumer confusion, then the senior user might file a trademark opposition, which objects to the registration of your trademark application. Other people or entities also could object on other bases, such as that the mark is generic or descriptive. A trademark opposition is a litigation proceeding, though it is decided by the USPTO’s Trademark Trial and Appeal Board, as opposed to a federal court. The only issue it will decide is whether the trademark application should register.

16. DO I NEED AN ATTORNEY TO HELP ME GET A TRADEMARK REGISTRATION?

- ▶ **Answer:** You are not required to have an attorney in order to register a trademark unless you live outside of the United States. However, hiring an attorney may provide crucial guidance during the application process. If someone contests your trademark application, or if the Trademark Office issues an Office Action rejecting or suggesting material alterations to your application, it would be smart to seek advice

from an attorney. At the end of this FAQ are some options for organizations that offer free legal aid.

17. DO TRADEMARK REGISTRATIONS EXPIRE?

- ▶ **Answer:** Trademarks do not expire as long as they are used in commerce. A trademark is considered to be “used in commerce” when it is displayed on goods and the goods are sold or transported so that they can be sold or it is used in connection with the promotion or sale of services. Trademarks are typically displayed on goods through labels, tags, or logos on the products.
- ▶ As noted above, in order to keep a federal trademark registration alive, you must also file for renewal five to six years after the registration date, 10 years after the registration date, and every 10 years after that. If you do not renew your federal trademark registration, your registration can be cancelled. Even if you fail to renew your federal trademark registration, you can still have common law trademark rights if you continue to use the mark.

18. WHAT HAPPENS IF I STOP USING MY TRADEMARK?

- ▶ **Answer:** In order to keep your trademark rights, you must continue to use your mark in commerce. Your mark may be considered abandoned if you fail to use your mark and intend not to resume using the mark. This may open the door for other people to enter the marketplace and start using your mark. If you fail to use your mark in commerce for three consecutive years, it is presumed that you abandoned your mark; however, you can defeat this presumption if you can prove

that you planned to resume using your mark. See 15 U.S.C. § 1127.

19. CAN I USE OTHER PEOPLE’S TRADEMARKS IN MY WORK?

- ▶ **Answer:** In granting trademark rights, the law aims to protect against consumer confusion as to the source of goods and services. But trademark law also recognizes that there are times when people may use others’ trademarks, such as when identifying another’s goods or services. Some courts recognize the doctrine of nominative fair use—the use of someone else’s mark without intent to confuse consumers or capitalize on the owner’s goodwill. To qualify as nominative fair use, the use must meet three elements: (1) the product or service cannot be readily identified without using the trademark, (2) the user only uses so much of the mark as is necessary for the identification, and (3) the user does nothing to suggest sponsorship or endorsement by the trademark holder. *New Kids on the Block v. News America Pub., Inc.*, 971 F.2d 302 (9th Cir. 1992). For instance, a comic retailer may advertise his store by saying that it sells Batman comics, and a creator may make a passing reference to Batman comics in a graphic novel (for instance, a character may be a Batman fan), so long as the creator does not use more of the Batman trademarks than required to identify the comics or suggest that DC Comics is sponsoring or endorsing the store or graphic novel.
- ▶ The doctrine of descriptive fair use is another defense to trademark infringement. This doctrine permits the use of a term or phrase in its primary descriptive meaning rather than as an indicator of the source of a good or a service. See 15 U.S.C. § 1115(4). For example,

the Seventh Circuit found that Ocean Spray's use of the phrase "sweet-tart" to describe the flavor of its cranberry juice did not infringe upon the trademark "SweeTARTS", because Ocean Spray was using the phrase to describe a drink that has elements of both sweetness and tartness. *Sunmark, Inc. v. Ocean Spray Cranberries, Inc.*, 64 F.3d 1055 (7th Cir. 1995). Some courts, however, have held that even when a term is literally descriptive of the goods or services, if the context in which the defendant is using that term—e.g., the size, design, and placement of the term on the advertisement— is as a mark, the use may not be fair use. *See, Mobil Oil Corp. v. Mobile Mechanics, Inc.*, 192 U.S.P.Q. 744 (D. Conn. 1976).

- ▶ Other courts have recognized the "Rogers test," which permits use of another's mark in a way that has "artistic relevance" and is not "explicitly misleading." To have artistic relevance, your work must have an "artistic" (i.e., noncommercial) association with the other person's mark. Use of the mark is explicitly misleading if it leaves no room for confusion or doubt that the trademark owner has endorsed your work or that there is an association between your work and the mark. *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989). The Supreme Court has recently cautioned, however, that when using another's trademark to designate the source of your own goods or services, even an artistic use of another's trademark will not preclude an analysis of whether consumers are likely to be confused as to the source of the goods or services. In other words, if your use of another's mark is likely to mislead consumers as to the source of the goods or services, then a court may find the use to be infringing. For example, the Supreme Court recently held that calling a dog toy in the well-known shape

of a Jack Daniel's bottle, "Bad Spaniels," infringed the whiskey manufacturer's trademark rights. *Jack Daniel's Properties, Inc. v. VIP Products LLC*, 143 S. Ct. 1578 (2023).

- ▶ While these tests present broad guidelines on permissible use, some courts adhere to these rules more closely than others. When in doubt about whether you can fairly use another's trademark in your work, consider asking the owner for permission or a license to use the trademark.

20. HOW DO I LICENSE MY TRADEMARKS?

- ▶ **Answer:** You can grant people an exclusive or non-exclusive license to use your mark. This can be done orally, or through a contract, or by special agreement. An exclusive license means you are granting the other person the sole right to use your trademark (at least for certain specified purposes), and you will not grant that right to anyone else. A non-exclusive license does not prevent you from authorizing others to use the trademark for the same purpose. A trademark license can be structured to give another person rights to use a trademark for a specified purpose, for a specific period of time, in a certain context or region, or for specific products and/or services. When licensing your mark, you should require all licensees to meet certain quality standards, and you should monitor their compliance. Allowing licensees the unfettered right to use your mark without any quality control could lead to the loss of your mark. If licensees do not follow your quality specifications when using your licensed mark, they can be liable for breach of contract as well as trademark infringement. Many lawyers specialize in drafting licenses and might be helpful to consult.

IV. Legal Assistance

1. HOW DO I FIND A LAWYER?

- ▶ **Answer:** This depends on what you need. There are several different types of lawyers. Do you need to file a lawsuit, or do you need to file a trademark application? The answers to these questions will determine where you go to find a lawyer.
- ▶ Some cities have local bar associations or alliances and can help you find a lawyer. If you have a copyright or trademark issue,

in general you should try to find a lawyer with prior experience in that area. You could ask friends or attorneys you know for references. You should also find out what the fees would be in advance and find out if you can pay.

- ▶ Some cities or law schools have pro bono attorneys (*i.e.*, lawyers who are willing to work for free) for artists or companies who do not have a lot of money. Examples of these organizations include the following:

STATE	ORGANIZATION	WEBSITE
Arizona	Volunteer Legal Assistance for Artists	vlaarizona.tumblr.com
California	California Lawyers for the Arts (formerly Volunteer Lawyers for the Arts-Los Angeles and Bay Area Lawyers for the Arts)	www.calawyersforthearts.org
California (Irvine)	UC-Irvine School of Law Intellectual Property, Arts and Technology Clinic	www.law.uci.edu/academics/real-life-learning/clinics/ipat.html

STATE	ORGANIZATION	WEBSITE
California (Los Angeles)	USC Intellectual Property and Technology Law Clinic	iptlc.usc.edu
California (Orange)	Chapman University Fowler School of Law Entertainment Law Clinic	www.chapman.edu/law/legal-clinics/entertainment-contracts.aspx
California (San Diego)	The Patent & Trademark Clinic - Thomas Jefferson School of Law	www.tjssl.edu/academics/clinics-internships/small-business-law-center/the-patent-trademark-clinic
Colorado (Denver)	Colorado Attorneys for the Arts	cbca.org/colorado-attorneys-for-the-arts
Colorado (Denver)	University of Denver Sturm College of Law Community Economic Development Clinic	www.law.du.edu/academics/practical-experience/clinical-programs/community-economic-development
Connecticut	Volunteer Lawyers for the Arts	lawyers.justia.com/legalservice/connecticut-volunteer-lawyers-for-the-arts-9148
District of Columbia	Washington Area Lawyers for the Arts	waladc.org
District of Columbia	American University Washington College of Law Intellectual Property Law Clinic	ipclinic.org
District of Columbia	George Mason University Law School Arts & Entertainment Advocacy Clinic	www.law.gmu.edu/academics/clinics/arts_entertainment_advocacy_clinic
District of Columbia	George Washington University Law School Small Business & Community Economic Development Clinic	www.law.gwu.edu/small-business-community-economic-development-clinic
Florida	Florida Lawyers for the Arts	www.artslawfl.org
Florida (Miami)	Arts and Business Council of Miami	www.artsbizmiami.org
Georgia	Georgia Lawyers for the Arts	glarts.org
Illinois (Chicago)	Lawyers for the Creative Arts	law-arts.org
Iowa*	Volunteer Lawyers for the Arts	www.facebook.com/IowaVolunteerLawyersForTheArts
Louisiana (New Orleans)	The Ella Project - Tulane University Law School Entertainment Law Legal Assistance Program	ellanola.org
Maine	Volunteer Lawyers for the Arts	www.mainevla.org
Maryland	Volunteer Lawyers for the Arts	mdvla.org
Massachusetts	Volunteer Lawyers for the Arts	artsandbusinesscouncil.org/vla
Massachusetts (Boston)	Harvard Law School Transactional Law Clinics	clinics.law.harvard.edu/tlc/clinics-and-practice-areas
Minnesota	Minnesota Lawyers for the Arts	springboardforthearts.org/resources-access/legal-assistance

STATE	ORGANIZATION	WEBSITE
Missouri (Kansas City)	Kansas City Volunteer Lawyers and Accountants for the Arts	www.kcvlaa.org
Missouri (St. Louis)	Volunteer Lawyers and Accountants for the Arts	vlaa.org
New Hampshire	University of New Hampshire School of Law Intellectual Property and Transaction Clinic	law.unh.edu/academics/experiential-education/clinics
New Jersey	Volunteer Lawyers for the Arts	www.probono.net/oppsguideorganization.197364-New_Jersey_Volunteer_Lawyers_for_the_Arts
New Jersey	Rutgers Intellectual Property Law Clinics	law.rutgers.edu/legal-clinics
New Mexico	New Mexico Lawyers for the Arts	www.groundworksnm.org/nonprofit-directory/nonprofit/27484
New York	Volunteer Lawyers for the Arts	vlany.org
North & South Carolina	Carolina Lawyers for the Arts & Entertainment	www.carolinalawyers.org
Ohio (Cleveland)	Volunteer Lawyers for the Arts-Northeast Ohio	www.clemetrobar.org/?pg=VLAProgram
Oregon	Volunteer Lawyers for the Arts	www.oregonvla.org
Pennsylvania (Philadelphia)	Volunteer Lawyers for the Arts	artsbusinessphl.org/philadelphia-volunteer-lawyers-arts
Pennsylvania (Pittsburgh)	Volunteer Lawyers for the Arts	www.pittsburghartscouncil.org/vla
Pennsylvania	Penn State Law School Arts, Sports and Entertainment Law Clinic	pennstatelaw.psu.edu/practice-skills/clinics/arts-sports-entertainment-law-clinic
Rhode Island	Ocean State Lawyers for the Arts	www.artslaw.org
Tennessee (Nashville)	Volunteer Lawyers and Professionals for the Arts	abcnashville.org/vlpa
Texas	Texas Accountants and Lawyers for the Arts	talarts.org
Texas (Austin)	UT Law Students for the Arts	law.utexas.edu/news/2011/03/28/students-for-the-arts-cosponsors-free-legal-clinic-for-artists
Utah	Utah Lawyers for the Arts	www.utahlawyersforthearts.org
Washington	Washington Lawyers for the Arts	thewla.org

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