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Keywords

Copyright, Trademark, Trademark interests, Lanham act, Kirby litigation

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By Jay Goldberg

"There is a war coming. Are you sure you're on the right side?"¹

-Wolverine

I. Introduction

Studies in dualism permeate the history of comic book storytelling: the righteous Superman does battle with the evil mastermind Lex Luthor; the benevolent Batman combats the destructive and nihilistic Joker; the compassionate Professor Charles Xavier and apocalyptic Magneto engage in a struggle by which the very future of humanity hangs in the balance! While these epic confrontations play out on the pages of comic books a similar, yet less simplistic, battle occurs in real life: the artist versus the publisher in the battle for copyrights. While the real-life conflict may not place the fate of humanity at risk, it does implicate an important and pervasive aspect of our society: money. Simply put, the storylines and characters developed by the comic book industry are big business. From simple, paperback origins comic books have spawned television shows, merchandise, videogames, and most lucratively, movies.² As the

power to exploit a copyright enables its possessor to reap untold profits, the battle between the parties rages fierce. While artists may not have the ability to summon super-strength or x-ray vision to their aide in this conflict, they may in certain circumstances exercise their right of copyright termination under the Copyright Act of 1976 ("the Act") to regain control of their creations.³

This, however, oftentimes proves more difficult than it might initially seem, as publishers are not without their own arsenal of statutory powers.

This article elucidates this aspect of the conflict between artist and publisher, specifically focusing on the ongoing legal struggle between the heirs of comic book artist Jack Kirby and Marvel Entertainment.⁴ First, this article gives a brief introduction to the Kirby litigation, focusing on the origins of the conflict and the relevant legal issues. Next, this essay discusses the pertinent provisions of copyright and trademark law, focusing specifically on copyright termination, the derivative works exception, and the Lanham Act, as well as utilizing case law to examine the application of the legal concepts. Finally, this essay applies the relevant doctrines to the Kirby litigation, concluding that while copyright law may vest the Kirby heirs with a right to partially reclaim their father's creations, the derivative works exception and the Lanham Act significantly weaken the value of that



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1. X-MEN (Twentieth Century Fox 2000).

2. See generally Benjamin A. Goldberger, *How the "Summer of the Spinoff" Came to Be: The Branding of Characters in American Mass Media*, 23 LOY. L.A. ENT. L. REV. 301 (2003) (discussing the conglomeration of the entertainment business, whereby proven entertainment commodities and properties are reused as often as possible in order to maximize profits, recognizing the extremely valuable nature of brand name characters). See also The Internet Movie Database, All-Time Box Office: World-wide, <http://www.imdb.com/boxoffice/alltimegross?region=world-wide> (last visited Apr. 4, 2010) (noting that some of the top worldwide grossing movies of

all time were based on comic books, for example, *The Dark Knight* (\$1,001,921,825), *Spider-Man 3* (\$885,430,303), and *Spider-Man* (\$806,700,000).

3. The United States Copyright Act, 17 U.S.C. § 304(c) (2005) (granting an artist, or their specifically-designated heir, the right to terminate a copyright "at any time during a period of five years beginning at the end of fifty-six years from the date copyright was originally secured, or beginning on January 1, 1978, whichever is later" if the copyright was executed before January 1, 1978).

4. Complaint at 1, *Kirby v. Marvel Entm't, Inc.*, Case No. 10-00289-CJC-AN (C.D. Cal. filed Mar. 9, 2010).

right. This article concludes by calling on Congress to revisit the relevant copyright and trademark provisions and comport them with one another in order to prevent the further devaluation of a reclaimed copyright by competing trademark interests.

II. The Comic Book Industry and *Kirby v. Marvel Entertainment, Inc.*

Like any fledgling upstart, the American comic book industry comes from humble and rocky beginnings. The early industry was plagued by disorganization and many times publishers operated under a “gentleman’s agreement” with their artists, whereby the artists and the publisher would achieve a general understanding that the artist would be compensated for his work, foregoing any formal contract.⁵ Many artists responsible for the “Golden Era” of the comic book industry sold their creations to publishers on this basis and consequently regretted the manner in which they conducted their business.⁶ Jack Kirby’s heirs allege that he was one of these artists.

Mr. Kirby, widely known as “King Kirby” amongst his colleagues, is directly responsible for some of the most famous and lucrative comic book characters of all time. From 1958 to 1963, Mr. Kirby either authored or co-authored works containing the characters The Fantastic Four, X-Men, Iron Man, Spider-Man, The Incredible Hulk, Thor, The Avengers, Nick Fury, and Ant-Man (“Kirby Works”).⁷ At the time of their creation, Mr. Kirby’s heirs claim that Mr. Kirby was working on a freelance basis and never committed to any

written agreement to create works directly for Marvel’s predecessors.⁸

In 1972, Mr. Kirby entered into an agreement with Marvel’s predecessor whereby he assigned his interests in the Kirby Works and the original copyrights to the company and received further compensation.⁹ On September 19, 2009, the Kirby heirs, pursuant to 17 U.S.C. § 304(c), served Marvel with notices of termination of the copyrights of all the Kirby Works to take effect at the expiration of the statutory period.¹⁰ These terminations serve as the basis of the lawsuit at hand and, if effective, will dictate the extent to which Mr. Kirby’s heirs may recover under his legacy.

In the section of the complaint pertinent to this essay, the Kirby heirs put forth two claims for relief. First, the heirs seek a declaratory judgment that the notices of termination are effective pursuant to 17 U.S.C. § 304(c).¹¹ Second, noting that a declaratory judgment on the first claim would result in a joint-ownership of the Kirby Works copyrights, the heirs ask the court to define “profits” for the purpose of the parties accounting to one another on future monetary gains.¹² As is shown in the sections that follow, the success or failure of these claims turns primarily on the court’s application of a number of legal doctrines, including aspects of both copyright and trademark law.

III. The Underlying Legal Concepts

A. Copyright Termination, Works for Hire, and the Derivative Works Exception under the Copyright Act of 1976

Copyrights are meant to protect “original works of authorship in any tangible medium of expression” and include, non-exhaustively, works of literary, graphic, musical, or dramatic merit.¹³ The Copyright Act of 1976 empowers an author, and his or her heirs, with

5. See Ashok Chandra, *Crisis of Indefinite Consequence: How the Derivative Works Exception and the Lanham Act Undercut the Remunerative Value of Termination of Transfers*, 16 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 241, 267 (2005) (stating that during the Golden Age of comic books, work made for hire agreements were not the norm); Brooks Barnes and Michael Cieply, *A Supersized Custody Battle Over Marvel Superheroes*, N.Y. TIMES, Mar. 19, 2010, <http://www.nytimes.com/2010/03/21/business/21marvel.html?8dpc> (quoting Kirby attorney Marc Toberoff as contending that “an industrywide decency code put so much pressure on Marvel that few at the company were worrying about contractual niceties with artists.”).

6. See *Siegel v. Warner Bros. Entm’t, Inc.*, 542 F. Supp. 2d 1098 (C.D. Cal. 2008) (holding that the heirs of Jerome Siegel, one of the co-creators of Superman, were entitled to a share of the U.S. copyright of that character, despite previous agreements between the parties); *Marvel Characters, Inc. v. Simon*, 310 F.3d 280 (2d Cir. 2002) (recognizing Joseph Simon’s right of termination in Captain America, despite a prior settlement of an authorship dispute).

7. *Kirby*, Case No. 10-00289-CJC-AN at ¶ 19. See generally The Internet Movie Database, <http://www.imdb.com> (last visited April 4, 2010) (noting generally that a significant number of Mr. Kirby’s creation have become lucrative movie properties).

8. *Kirby*, Case No. 10-00289-CJC-AN at ¶ 22 (asserting further that Mr. Kirby “worked solely on a freelance basis out of his own home, with his own instruments and materials and thereby bore the financial risk of creating his copyrighted materials.”).

9. *Id.* at ¶ 24.

10. *Id.* at ¶ 25. See also 17 U.S.C. § 304(c) (applying the statutory time period, note that the Kirby Works would be subject to termination from 2014-2019, 56 years from the original copyrights).

11. *Kirby*, Case No. 10-00289-CJC-AN at ¶¶ 30-33.

12. *Id.* at ¶¶ 34-37.

13. § 102(a). See also *Detective Comics v. Bruns Publ’n* 111 F.2d 432 (2d Cir. 1940) (holding that the character of Superman was protected under copyright law); Emerson, *supra* note 13, at 214 (mentioning that “graphic representations of characters are inherently expressive and thus considered copyrightable works.”).

the exclusive right to (a) reproduce their work, (b) produce derivative works based off the original work, and (c) display or otherwise perform their work.¹⁴ Once an author obtains a copyright, he may assign those rights to a third party.¹⁵ Nevertheless, the 1976 Act permits an author, or his statutory heirs, to terminate the transferred copyright after 56 years (if the copyright was created before January 1, 1978).¹⁶ A termination allows an author to recapture the copyright and either exploit the profits garnered from that copyright, renegotiate the terms of the copyright assignment, or assign the copyright to another party.¹⁷ Importantly, as the Supreme Court recognized in *Mills Music, Inc. v. Snyder*,¹⁸ unlike other rights an author cannot contract away or assign the right of termination.¹⁹ Despite this, it can still be difficult for an author or his heirs to exercise the termination right, as many statutory details must be complied with.²⁰

There are two major exceptions to the right of termination found in § 304(c) of the 1976 Act, both of which can seriously reduce the value of a terminated copyright. First, the Act expressly prohibits an author of a “work made for hire” from exercising a termination right on their creation.²¹ Instead, a work for hire vests the rights of copyright in the employer. A work made for hire is defined as “a work prepared by an employee within the scope of his or her employment” or “a work specially ordered or commissioned for use as a contribution to a collective work.”²² If an author creates a work and then later assigns the copyright to a publisher, however, the publisher may not retroactively

deem the work a work made for hire.²³

In *Marvel Characters, Inc. v. Simon*,²⁴ the court permitted the exercise of an author’s termination right despite a prior agreement between the parties that the works in question were works done for hire. Joseph Simon, the creator of the popular comic book character Captain America, sought to terminate a copyright transfer he granted to Timely Publications, a successor to Marvel Comics.²⁵ In a settlement agreement from a previous litigation, Simon acknowledged that he contributed to the Captain America character as an employee for hire and not on a freelance basis.²⁶ Despite this previous agreement, the court permitted Simon to present evidence that he did not, in fact, create Captain America as a work for hire and that the settlement agreement was an arrangement between the parties after the character’s creation.²⁷ Noting that under § 304(c)(5) of the 1976 Act an author cannot contract away his right to termination, the court permitted Mr. Simon to effect terminations, holding that the settlement agreement, which deemed the work a work for hire after its creation, was ineffective.²⁸

The second important exception to the right of termination, pertinent especially in the context of comic books, eliminates the right for derivative works created by the copyright holder prior to the exercise of the termination.²⁹ A derivative work is defined as “a work based upon one or more preexisting works.”³⁰ Generally speaking, a derivative work must be “an original work of authorship,”³¹ although a derivative author is not under a requirement to greatly change the original work in order to receive independent copyright protection.³² While

14. § 106. See also Lauren Beth Emerson, *Termination of Transfer of Copyright: Able to Leap Trademarks in a Single Bound?*, 75 *FORDHAM L. REV.* 207, 213 (2006).

15. 17 U.S.C. § 201(d) (2005).

16. § 304(c).

17. 17 U.S.C. § 203(b) (2005). See also Emerson, *supra* note 13, at 207.

18. 469 U.S. 153, 172-73 (1985) (noting that the termination right exists primarily to protect an author from “the consequences of ill-advised and unprofitable grants that had been made before the author had a fair opportunity to appreciate the true value of his work product.”).

19. § 304(c)(3), (5).

20. See Emerson, *supra* note 13, at 221 (recognizing that for a termination right to be properly executed, it must be done within a five-year window in which termination is permitted and the terminating party must give between two and ten years notice before the termination becomes effective, pointing out that when there are multiple or renegotiated agreements between the relevant parties this time period can be difficult to identify).

21. § 304(c).

22. 17 U.S.C. § 101 (2005).

23. See *Siegel v. Nat’l Periodical Publ’ns, Inc.*, 508 F.2d 909 (2d Cir. 1974) (holding that even though the creators of a comic strip revised and expanded the original material at the request of the publisher, this was not tantamount to a finding that the strip was a work for hire).

24. 310 F.3d 280 (2d Cir. 2002).

25. *Id.*

26. *Id.* at 283.

27. *Id.* at 292.

28. *Id.*

29. § 304(c)(6)(A). See also Chandra, *supra* note 5, at 278 (utilizing the example of the Superman movie, a derivative work based off of the comic book, which held its own copyright distinct from the comic book copyright).

30. § 101.

31. § 101. But see Chandra, *supra* note 5, at 279 (noting that divining what elements are to be considered part of the original and which are unique to the derivative has proven to be a difficult task).

32. See *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 54-55 (2d Cir. 1936) (recognizing that there is no “novelty, creative or aesthetic requirement for copyright in a derivative work.”). See also,

the courts have, as of yet, not identified the full extent of what constitutes a derivative work, it could potentially be construed broadly to encompass written story elements and character traits, as well as the illustrative representation of any graphical characters.³³

In *Siegel v. Warner Bros. Entm't, Inc.*, the court limited the extent of an asserted termination right under the derivative works doctrine.³⁴ The heirs of Jerome Siegel, one of the creators of Superman, sought a declaration that they had successfully terminated Mr. Siegel's half of the original copyright.³⁵ In partially granting the plaintiffs' claim, the court was forced to deal with various aspects of the copyright, including international revenues and derivative works.³⁶ While addressing the issue of international revenues and copyrights, the court cited the 1976 Act and limited the plaintiffs' termination recovery to only those profits realized by the domestic exploitation of the Superman *Action Comics, Vol. 1* copyright.³⁷ The court did not address what to do, accounting-wise, with any alteration in pre-termination derivative work. However, it did hold that profits garnered by the publisher from unaltered pre-termination derivative works were not subject to accounting with the plaintiffs.³⁸

It is clear that the doctrines of work for hire and derivative works limit the value of a copyright recaptured by an author through exercise of a termination right. Given that the *Simon* court held that a work was not a work for hire even though the publisher deemed it so after the fact, the modern comic book industry now makes it standard practice for publishers to require their artists to enter work for hire agreements up front, therefore limiting an author's ability to profit from his own work.³⁹ The derivative works exception presents

additional difficulty when applied to the comic book industry, as by their very nature, comic book characters continually evolve and change with every new issue. Therefore, it is not a stretch to imagine a court accepting the argument that a character as it exists today is far different from the character as originally copyrighted by the author, thus seriously diminishing the value of the recaptured copyright.⁴⁰

B. Trademark Protection and Copyright Overlap

In addition to copyright law, trademark law provides another method by which publishers may diminish the value of a recaptured copyright. Trademarks, by definition, are any identifiable articles that symbolize, and are readily associated with, a specific brand or producer of goods.⁴¹ Under the Lanham Act, individuals and companies are prevented from using the distinctive marks of other entities in commercial activity without permission.⁴² Unlike copyright law, which protects an image itself, trademark law is meant to protect the consumer and the goodwill of the company who owns the mark.⁴³ Therefore, rather than provide total coverage against the usage of the mark, only certain usages are prohibited.⁴⁴ Also different from a copyright, a trademark is infinite in its duration and never expires so long as the entity that owns the mark continues to exploit that mark in the marketplace.⁴⁵ An owner may additionally lose a trademark through genericide, or the inclusion of the mark into the cultural lexicon.⁴⁶

It is widely accepted that comic book characters are protected by trademark in some situations. In *DC Comics, Inc. v. Unlimited Monkey Business, Inc.*, the court held that Superman and Wonder Woman

Chandra, *supra* note 5, at 280.

33. See Chandra, *supra* note 5, at 277-78.

34. 542 F.Supp.2d 1098 (C.D. Cal. 2008).

35. *Id.* (granting the plaintiffs a copyright termination *only with respect to character and story elements as introduced in Action Comics Vol. 1*). See also Michael Cieply, *Ruling Gives Heirs a Share of Superman Copyright*, N.Y. TIMES, Mar. 29, 2008, http://www.nytimes.com/2008/03/29/business/media/29comics.html?_r=3&ref=business&oref=slogin (noting that the court in *Siegel* upheld the heirs' copyright in the material published in *Action Comics Vol. 1* only and did not determine the extent to which later versions of the character were derived from the original iteration).

36. *Id.* at 1139-43.

37. *Id.* at 1140 (citing 17 U.S.C. § 304(c)(6)(E)).

38. *Id.* at 1142-43.

39. See, e.g., DC Comics, Submissions/Talent Search, <http://dc-comics.com/about/submissions.html> (last visited Apr. 7, 2010) (noting that DC will not accept unsolicited artwork or writing).

40. See Chandra, *supra* note 5, at 283 (mentioning that in 1986 DC Comics "killed off" all of its characters only to recreate them again in the next issue, noting that because of this DC could claim that it authored all of the characters it now publishes).

41. See Emerson, *supra* note 13, at 223 (offering that trademarks can be "words, symbols, logos, sounds, scents, or even colors.").

42. See 15 U.S.C. § 1125(a).

43. See Chandra, *supra* note 5, at 271 (pointing out that a trademark does not protect the character of Mickey Mouse, but instead the good will of Disney).

44. See *Prestonettes, Inc. v. Coty*, 264 U.S. 359, 368 (1924) (holding that the use of a brand name in the description of a product is not trademark infringement).

45. 15 U.S.C. § 1127.

46. See, e.g., *King-Seeley v. Thermos Co. v. Aladdin Indus.*, 321 F.2d 577 (2d Cir. 1963) (refusing to find a trademark infringement in the defendant's usages of the word "thermos" as the word had become the generic term for describing the good itself rather than the source of the item).

were protected trademarks of DC Comics.⁴⁷ The defendant ran a singing telegram service, which featured characters that bore strong resemblance to Superman and Wonder Woman and were unlicensed by DC. In their discussion, the court noted that the characters had long been associated with and utilized by DC in the marketing of their products. Additionally, the court recognized that DC carefully chooses when, and to whom, to license usage of the marks.⁴⁸ The court noted that the trademark was not limited simply to the physical appearance of the characters, but also included the name, phrases, logos, and design marks associated with them.⁴⁹

While trademark law is limited in its application, it can significantly weaken the value of recaptured copyright. Although no court has directly addressed the issue of when copyright and trademark law overlap in this realm, it appears likely that trademark protection would interfere somewhat with an author's recaptured copyright.⁵⁰ As the court in *Unlimited Monkey Business* recognized, comic book characters and their distinguishing features have long since become associated with their publishers and when used in commerce indicate an implicit approval of the product by the company that owns the mark.⁵¹ In the event that an author, upon successful termination, decides not to license a copyrighted character back to the original publisher he would not be able to start releasing comic books or other materials of his own, as the publisher would retain the trademarks associated with the character.⁵² In cases such as *Kirby*, as shown below, this may present significant difficulty for an artist.

IV. Application to Kirby

47. 598 F. Supp. 110 (N.D. Ga. 1984).

48. *Id.* at 113.

49. *Id.*

50. See, e.g., *Frederick Warne & Co. v. Book Sales, Inc.* 481 F. Supp. 1191 (S.D.N.Y. 1979) (holding that the trademark protection of an image of a character may persist even though the copyrightable character had previously entered the public domain, so long as the mark possesses an independent value). But see *In re DC Comics, Inc.* 689 F.2d 1042, 1052 (C.C.P.A. 1982) (Neis, J., concurring) (“[I]f trademark rights are recognized in a picture of a product, the design itself may be perpetually protected, contrary to the limited term afforded to some designs under the copyright or design patent statutes.”).

51. See 542 F.Supp.2d at 1098.

52. See Chandra, *supra* note 5, at 275 (pointing out that even though copyright law dictates that upon termination the image should return to the original author, any subsequent publication or licensing of that image would be in violation of trademark law, as most comic book characters have become synonymous with their long time publishers).

Before reaching the issues present in the relevant aspects of the plaintiffs' complaint, the court must first decide whether the Kirby heirs possess a right of termination in the first place. This turns, in essence, on two issues: did Jack Kirby originally produce the characters as a freelance artist or as works for hire, and if he did produce them as a freelance artist does his estate still possess his right to termination? As the 1976 Act states, the right of termination does not apply to works for hire.⁵³ In such a case, the copyrights belong to the publisher, who is deemed the author of the works.⁵⁴ If, on the other hand, Mr. Kirby produced the works with his own materials and on his own initiative, then his heirs undoubtedly possess the right to reclaim the original copyright.⁵⁵ As discovery has yet to be conducted in the case, there is no way to know for sure whether the Kirbys obeyed all the statutory demands of § 304(c). Therefore, in order to focus on deeper legal implications, this article continues on the assumption that all facts alleged in the complaint are accurate.

In the complaint, the Kirby estate claims that Mr. Kirby created the works at his own expense and not as works for hire.⁵⁶ While the reply of the defendant is not currently available, it is likely that Marvel will contend that Mr. Kirby produced the works in the stead of his employment with Marvel. Barring some clear-cut evidence to the contrary, it is unlikely that the court will side with the defendant on this issue. Given the widely recognized state of the industry at the time of the creation of the Kirby Works, it is likely that Marvel's predecessors purchased the works from Kirby on a consignment basis.⁵⁷

After finding that the works were produced as freelance works subject to termination, the court will then have to move on to the effect of the 1972 assignment of the copyrights from Mr. Kirby to the publisher.⁵⁸ In this agreement, Mr. Kirby assigned his interest in the copyrights to the publisher for compensation in addition to his original payments

53. 17 U.S.C. § 304(c).

54. U.S. Copyright Office, Works Made For Hire Under the 1976 Copyright Act, <http://www.copyright.gov/circs/circ09.pdf> (last visited Apr. 11, 2010).

55. § 304(c)(6)(C).

56. Complaint at ¶ 23, *Kirby v. Marvel Entm't, Inc.*, Case No. 10-00289-CJC-AN (C.D. Cal. filed Mar. 9, 2010).

57. See *supra* note 5. Which cite in note 5 is this referring to? Provide author name plus pincite. *Supra* should not be used for cases, per R.4.2. This refers to note 5 as a whole, not any particular cite therein. Maybe it can refer to the page of text, not the cite?

58. *Kirby*, Case No. 10-00289-CJC-AN at ¶ 24.

from Marvel. The court should not have a problem in holding that this assignment has no effect on the plaintiff's ability to exercise the termination right of the original copyright, as under § 304(c)(5) of the 1976 Act, regardless of any prior agreement to the contrary an author may effect termination of an original copyright.⁵⁹ Assuming that the Kirbys have complied with all statutory demands contained within § 304, as they allege, the court must then deal with the effect of the terminations.

The effect of the Kirby terminations will be significantly tempered by the derivative works provision of the 1976 Act and by the relevant aspects of trademark law. In their prayer for relief, plaintiffs essentially ask the court to include any profits made by the defendant from exploitation of any *new* derivative work, either domestically or overseas, if the overseas profits result from the "predicate exercise *in the United States* of any right under the copyright[s]."⁶⁰ The plaintiffs, as they must, concede that they do not possess a right to monies gained from the exploitation of derivative works created before the exercise of the termination.⁶¹ Therefore, the value of the termination will turn in part on how liberally the court decides to apply the derivative works exception.⁶²

As recognized earlier, comic book characters inherently evolve from issue to issue. As an example, it stands to reason that the Wolverine of *The Incredible Hulk #181* is a far different animal than the Wolverine of *X-Men Origins: Wolverine*.⁶³ With each incarnation, Marvel could potentially argue that the Wolverine of Mr. Kirby's creation no longer exists. The current manifestation of the character, the argument goes, is a derivative work that the publisher itself created and may continue to exploit on its own.⁶⁴ Although not controlling, when considered in connection with the *Siegel* case, it seems likely that the court would limit the recovered copyright to those elements apparent in the

initial personification of the characters.⁶⁵ While it is unlikely that the court would count the entire catalogue of characters as new and unique derivative creations, the extent of the reclaimed copyright will likely be significantly narrowed as a result of the court's findings.

Additionally, using *Siegel* as a barometer, it is likely that the court will limit the plaintiffs' right to those profits realized solely from the domestic exploitation of the joint copyright.⁶⁶ This significantly weakens the value of the reclaimed copyright, as a considerable portion of the value derives from the international film market.⁶⁷ Although plaintiffs limit their request to overseas profits predicated on the exercise of the copyright in the United States, given the clear language of the 1976 Act this may be murky territory that the court decides to avoid.⁶⁸

In addition to devaluation due to copyright provisions, the applicable aspects of trademark law might further devalue any recognition of termination by the court.⁶⁹ In the decades since characters such as the X-Men or The Incredible Hulk burst onto the scene, their appearances and related identifying characteristics have become synonymous with the Marvel brand. Further, these characters are extremely unique and for the most part are in constant use, so the concepts of genericide and loss through inactivity are not an issue. Therefore, despite the termination by the Kirby estate, the plaintiffs would be unable to produce works featuring the distinct elements of the characters without running afoul of Marvel's trademark rights.⁷⁰ This reduces the alienability of the newly-reclaimed rights, as well as places the Kirbys at a disadvantage should they decide to renegotiate terms with Marvel.

All of this leads to the conclusion that even though the court will likely find that the Kirby heirs have properly asserted their termination right on the original copyrights, the value of those rights are significantly reduced. Simply looking at the derivative rights exception, the reclamation will likely be limited to only those characteristics of the superheroes present

59. See also *Siegel v. Warner Bros. Entm't, Inc.*, 542 F. Supp. 2d 1098 (C.D. Cal. 2008); *Marvel Characters, Inc. v. Simon*, 310 F.3d 280 (2d Cir. 2002).

60. *Kirby*, Case No. 10-00289-CJC-AN at ¶ 66.

61. § 304(c)(6)(A).

62. See Chandra, *supra* note 5, at 278.

63. *The Incredible Hulk #181* marks the first appearance of the character of Wolverine as a mutant agent of the Canadian government. The most recent incarnation of the character in the film *X-Men Origins: Wolverine* presents Wolverine as a Canadian-born mutant, who leaves Canada and comes to the United States, joining the American military.

64. See Chandra, *supra* note 5, at 282-83.

65. See *supra* note 5.

66. See *supra* notes 35-38.

67. See, e.g., Box Office Mojo, X-Men Origins: Wolverine, <http://www.boxofficemojo.com/movies/?id=wolverine.htm> (last visited Apr. 10, 2010) (noting that the movie *X-Men Origins: Wolverine* made \$179,883,157 domestically and \$193,179,412 internationally for a total worldwide box office of \$373,062,569).

68. § 304(c)(6)(E).

69. See *supra* notes 40-51.

70. See Chandra, *supra* note 5, at 274-75.

in the original works. Given the nature of comic book storytelling, these original creations are far different from the heroes that grace present-day movie screens, comic book pages, and videogames. It remains a possibility that Marvel will argue, successfully, that the relinquished copyrights are no longer as lucrative as they once were, thus reducing the amount that Marvel will be responsible for in accounting to the Kirby estate. The copyright is further devalued when rights to international profits are denied, as will likely be the case.

When factoring in the additional constraints trademark law places upon the usefulness of the recaptured copyright, it appears as though the Kirby estate is left with only two viable options: either relicense the copyrights back to Marvel from a disadvantaged bargaining position, or pump more money into litigating the precise terms of the accounting between the parties. Given that Disney now owns Marvel, in the likely event that the court recognizes an effective termination of copyright it would behoove the Kirbys to pursue the former option with their corporate opposition. Given the decreased bargaining strength that accompanies only being able to negotiate with one corporate party, it is unlikely that the Kirbys will reap the rewards they might have without the interference of trademark law.

In 1958, Jack Kirby had no idea that his creations would spawn a multibillion-dollar worldwide industry. Congress enacted § 304(c) of the 1976 Act in order to give authors, such as Mr. Kirby, the opportunity to reap the benefits of the continued success of their work.⁷¹ In the context of the comic book industry, however, the competing interests of trademark law significantly frustrate this goal. Rather than place the author in an advanced bargaining position, trademark law essentially eliminates the alienability of the reclaimed copyright. This forces the author, or his heirs, to simply renegotiate terms with the publisher from a position of disadvantaged bargaining power. This frustrates the intent of Congress in passing the 1976 Act.

V. Conclusion

The battle of author versus publisher lacks the stark dualism apparent in the pages of comic books, in that its parties may not be easily classified as right and wrong, benevolent and parsimonious, or good and evil. While an author, or in many cases their estate, has an undeniable interest in the success of their creations, a publisher likewise possesses an interest in profiting

from its investments. Either way, it is clear that when trademark law interferes with an author's reclaimed copyright, it undermines the intent of Congress and undercuts the author's ability to rightfully claim the fruits of his hard work. Given the increasingly lucrative nature of comic book-based branded entertainment, Congress must revisit both trademark and copyright law in order to ensure that the forefathers of the comic book industry are properly recognized for their work.

71. *See supra* note 18.