

COMIC CON: A CONVENTION BY ANY OTHER NAME?

by MICHAEL I. KATZ AND L. REX SEARS

Comic Con™

Comicon™

In December 2017, a federal jury in San Diego was asked to declare the death of Comic-Con . . . in the trademark sense. They were asked to decide whether “Comic-Con” had become generic, or suffered “genericide,” due to widespread use of the term to refer to a comic convention—much as “aspirin,” once a Bayer trademark, eventually became the common name for acetylsalicylic acid,¹ a fate that befell other brands, including cellophane, escalator, and linoleum. Yet other brands that have become common terms, such as Kleenex, have not yet suffered this fate—not yet anyway. Now would be a good time to get some Kleenex, as you may want to have a good cry before this is over.

Like all good stories, this one begins with a lawsuit. San Diego Comic Convention (SDCC) is a not-for-profit entity that puts on Comic Con International: San Diego every July. SDCC claims “Comic-Con” is another name for its particular event. So SDCC sued the promoters of Salt Lake Comic Con for trademark infringement. Salt Lake Comic Con is one of over 100 comic conventions

held throughout the United States that use some form of “comic con” in their name. So the defendants—Dan Farr and Bryan Brandenburg and their company, Dan Farr Productions—argued that the term “comic con” is generic. The game was afoot, as they say.

At trial, the promoters of Salt Lake Comic Con testified that by the time they held their first event in September 2013, there was already a well-developed comic con circuit that included Chicago Comic Con, New York Comic Con, Emerald City Comic Con in Seattle, Denver Comic Con, Baltimore Comic-Con, Alamo Comic Con (in San Antonio), and dozens more. They selected their name using an industry-wide formula: Salt Lake, to say *where* they were, and Comic Con, to say *what* they were: a comic convention.

The trial aroused the interest of two groups having little to do with each other: the trademark bar and comic fandom. The question of genericide—whether a mark has become generic—might hold the interest of the former, but not the average comics fan who pays a few

hundred bucks to attend a convention dressed as the Green Lantern. To fandom in the know, comic cons are everywhere. How can one con claim to own the rights to a word that is used by all? Therein, as they say, lies the rub.

I like to imagine you, fearless reader, to be a lawyer whose inhibitions do not prevent you from wearing a spandex costume. So it is fitting that I ask you this question: How are we to judge when a mark becomes generic? At what point does it lose its valence as a *source*-signaling mark and become pedestrian verbiage that refers to a *thing*? When, if ever, did Comic-Con stop referring to SDCC’s event, and instead come to refer to any and every comic convention? The jury’s answer, as you will see, is never. The rub, it seems, also lies there as well. Perhaps this is starting to rub you the wrong way, as it does me.

Let’s take a step back. The Ninth Circuit likes to characterize the legal test for genericness as “the ‘who-are-you/what-are-you’ test”;² a generic term says *what* a thing is, but a trademark says *who* (or *whose*) it is. So here the question became: Does “comic con” refer to



the world-renowned San Diego event? Or does it refer to a type of event, a comic convention?

To find an answer, the law encourages us to consider different types of evidence. We are to look at usage of the term in the press, in trade journals, and among competitors. We can resort to a poll of relevant members of the public, which one can purchase for a fee. And, indeed, people attending San Diego Comic Convention's event refer to it as "comic con," as do the press and the movie and television studios promoting their products at the event. The problem is, people attending Emerald City Comicon in Seattle, for example, also refer to *that* event as "comic con," as do the press and the industry trade journals. Usage, it turns out, is context dependent. And as a linguist could explain, that means it's generic.

We will discuss what happened at trial. But first, a detour through what did *not*. The jury

did not hear from an expert on linguistics. Some might posit that this is a subject best suited for such expertise. The court hearing our case, however, struck the expert testimony of the linguist retained by the defendants because much of the material on which he based his opinion was obtained from the defendants, so best not to discuss his conclusions.

There were other things that might also be best not discussed, because the jury also did not hear them. For example, the jury never learned the origin of the term "comic con." They were not told that it was coined and in use by 1963 among comic aficionados who, one year later, organized the New York Comic Con, attended by scores of artists, writers, and comic book devotees. The *Oxford English Dictionary* reports the term "con" originated in the 1930s, when it was first used as a shorthand for "convention" by sci-fi fans who held,

well, sci-fi cons; but that dictionary entry was not admitted at trial either. These sci-fi con-goers used the same terminology when organizing events to celebrate the comic arts. In an early (and ancient) document, a fanzine contributor detailed a cross-country networking trip he called the Traveling Comicon. SDCC founder Shel Dorf wrote that he set out from Detroit to San Diego, to bring the west coast its "very own comic con" (the Johnny Appleseed of comics).

Intrepid (and caped) reader, at this point we must share our dismay—as counsel for Salt Lake Comic Con and as comic fans—that none of this origin story was revealed at trial. Everyone knows the importance of origin stories in the comic medium. Origin stories matter for trademarks, too, because "[a] 'generic' term . . . cannot become a trademark under any circumstances."³ So if (as it seems)

“comic con” started out as the generic term for a comic convention, then it cannot thereafter have suffered genericide by becoming generic because it was never anything else. A term that cannot become a protectable mark because it starts out generic is said by other courts to be generic “ab initio.”²⁴ But the entire matter of origins was written out of this particular story because according to *this* court: “There ain’t no generic ab initio.”²⁵

The jury was allowed to hear evidence of usage dating back only to 1970—when SDCC held its first event, called “San Diego’s Golden State Comic-Con.” SDCC experimented with a few variations over the next several years, finally settling on “San Diego Comic-Con” in 1973. The story doesn’t get interesting again until 1995, when SDCC rebranded its event “Comic Con International” and filed an application to register the standalone “Comic Con.” Chicago Comicon (spelled differently, back then) filed an objection, pointing out that “comic con” is in the public domain and there were dozens of other events named “comic con” advertised in a single monthly issue of the *Comic Buyer’s Guide*. SDCC abandoned its application in favor of a more modest application to register “Comic Con International.”

SDCC bided its time until 2005, then applied for a mark for the *hyphenated* form “Comic-Con.” The trademark examiner rejected the application as purely descriptive. SDCC overcame this objection by filing a sworn declaration that it was substantially the only user of the mark—which was not exactly accurate, but was effectual: the examiner credited the declaration, as required, and allowed the registration. Other cons did not object. Perhaps they were willing to let San Diego claim “Comic-Con”—with a hyphen—and continue to use “Comic Con” without one. As you, the caped trademark lawyer, may know, the law does not generally recognize the hyphen as a difference-making distinction for purposes of infringement. But to this day, Wikipedia has a disambiguation page that identifies the hyphenated form “comic-con” with SDCC’s event and the unhyphenated form with comic conventions more generally, consistent with what appears to be the general view in the industry.⁶ (The Wikipedia page did not see daylight in a court of law, either.)

But I digress. The jury did not hear about the history of the mark, or the abandoned registration for the unhyphenated form, or the Wikipedia page. What the jury did hear is that SDCC obtained a registration for “Comic-Con” that had achieved “incontestable” status by virtue of

having survived unopposed for five years after issuance. The jury was instructed that “incontestable” does not mean incontestable; or, rather, that even an “incontestable” mark can be challenged for genericness.

And so the jury had to balance an SDCC-commissioned “teflon” poll, which showed that 83 percent of those polled believed the term “Comic-Con” to be a brand name, with the evidence of widespread usage of the generic term comic con in the press and among competitors. Ultimately, the jury did not find the mark “Comic-Con” had become generic.

Perhaps you are wondering about the more-than-one-hundred events named “comic con” over the decades prior to trial. Counsel for San Diego Comic Convention in her closing argument referred to these entities as “infringers” and reminded the jury that SDCC was not required to sue them all at once. Of course you don’t have to sue them all at once, but doesn’t a right holder have to do *something*? The court elected to address the issue of estoppel in

To fandom in the know, comic cons are everywhere. How can one con claim to own the rights to a word that is used by all?

post-verdict bench proceedings.

And so an impartial jury of San Diego residents, limited to the evidence they were permitted to hear, decided that, on balance, San Diego Comic Convention could keep its mark Comic-Con—despite decades of widespread use of “comic con” and its variants throughout the industry and by so-called “comic fandom” more generally.

The fate of the Salt Lake Comic Con and all the other events named Comic Con—the so-called “infringers”—remains to be decided. The San Diego jury reached a verdict that Salt Lake Comic Con infringed the mark, but awarded only \$20,000, a bit shy of the \$12.2 million SDCC sought, by way of damages. The jury also found no willful infringement, leaving SDCC to seek a post-trial reversal of that finding to support a motion to recover in excess of \$4.6 million in legal fees incurred on this one enforcement effort. The jury, as they say, is still out on that one.

Dan Farr and Bryan Brandenburg, true to

their roots as a modern-day Barnum and Bailey, immediately declared that the show must go on. They renamed their event, Salt Lake Comic Convention. In January, fans began purchasing tickets for the September 2018 event. No doubt, the fans will continue to refer to that event as “comic con,” just as fans attending all the other events throughout the country will do with respect to *their* local comic conventions. Like it or not, “comic con” is part of the American vernacular—even though our clients, absent a reversal on appeal, can no longer use it.

ENDNOTES

(1) See *Bayer Co. v. United Drug Co.*, 272 F. 505 (S.D.N.Y. 1921).

(2) *Filipino Yellow Pages, Inc. v. Asian J. Publ’ns, Inc.*, 198 F.3d 1143, 1147 (9th Cir. 1999).

(3) See *Surgicenters of Am., Inc. v. Med. Dental Surgeries Co.*, 601 F.2d 1011, 1014 (9th Cir. 1979).

(4) See, e.g., *BellSouth Corp. v. DataNational Corp.*, 60 F.3d 1565, 1569–70 (Fed. Cir. 1995) (“A descriptive term may be generic for a designation ab initio . . . or it may become generic over time through common usage . . .”).

(5) Motion In Limine Hearing tr., No. 14CV1865 (S.D. Cal. Nov. 14, 2017) 5:25.

(6) See Wikipedia, *Comic Con*: disambiguation (Nov. 22, 2016), [https://en.wikipedia.org/wiki/Comic_Con_\(disambiguation\)](https://en.wikipedia.org/wiki/Comic_Con_(disambiguation)) (last updated Nov. 22, 2016).



Michael I. Katz and L. Rex Sears are litigation shareholders in Maschoff Brennan, an Intellectual Property and Commercial Litigation boutique firm based in Salt Lake City, Park City, and Irvine. Michael was first chair, and Rex second chair, in the trial described above. They can be reached at MKatz@mabr.com and RSears@mabr.com, respectively.

This article first appeared in Orange County Lawyer, April 2018 (Vol. 60 No. 4), p. 34. The views expressed herein are those of the author. They do not necessarily represent the views of Orange County Lawyer magazine, the Orange County Bar Association, the Orange County Bar Association Charitable Fund, or their staffs, contributors, or advertisers. All legal and other issues must be independently researched.