

cyberlaw: the brave new e-world



By Anne F. Downey

Holy Batmobile!

Imitation may be the sincerest form of flattery, but it can also constitute trademark and copyright infringement. In February, a federal court in California ruled that a custom automobile maker's sale of replica Batmobiles infringed the copyright and trademark rights of DC Comics.

DC Comics, a comic book publisher (now part of the Warner Bros. empire), owns copyright registrations in the "Batman" comic books, as well as federal trademark registrations for Batman, Batmobile, the Bat emblem, and other Bat-related marks for a long list of goods/services. The publisher has engaged in extensive licensing, with third parties being authorized by DC Comics to sell a wide variety of collectibles including toy replicas of the Batmobile and various car accessories such as floor mats. DC Comics also licensed the "Batman" television show in the 1960s, as well as the movie series that launched with "Batman" in 1989. DC Comics has granted Fiberglass Freaks (BuyBatParts.com) a license to make full-size automobiles based on the Batmobile design, and has granted George Barris, designer of the original 1966 Batmobile featured in the TV show, a license to make replica Batmobiles and exhibit them around the world.

The defendant in the California litigation, *DC Comics v. Towle*, CV 11-3934, (C.D. Calif.), is Mark Towle, a sole proprietor operating Gotham Garage, a custom automobile business that makes cars modeled after vehicles featured in movies and television shows. Through websites at GothamGarage.com, MarkTowle.com, and BatmobileReplicas.com, he has sold custom cars based on the 1966 TV version and 1989 movie version of the Batmobile, car kits that allow others to customize their vehicles into the Batmobile, and car accessories such as floor mats with the Bat emblem. At the time this article was written, the home pages of the websites were still active but

indicated that the sites were being overhauled, presumably as a result of the court ruling.

In May 2011, DC Comics filed a complaint in the U.S. District Court for the Central District of California alleging that defendant had infringed the copyrighted Batmobile design and related trademarks. In his answer, defendant asserted various affirmative defenses including laches, unclean hands and fair use. In December 2012, both parties moved for summary judgment.

On February 7, 2013, the court ruled in favor of DC Comics on the motion for summary judgment as to the trademark infringement claim, finding a likelihood of confusion as a matter of law. For the same reasons, the court also granted summary judgment to DC Comics on the unfair competition claim.

Summary judgment was also granted on DC Comics' copyright infringement claim. The court ruled that DC Comics had granted certain rights to Barris and others but retained rights in the 1966 Batmobile design featured in the TV show and the 1989 Batmobile design featured in the movie, despite not owning the copyright in the TV show or movie and despite having never used the 1966 or 1989 designs in any comic book. The court further opined that, even if DC Comics did not retain rights in the 1966 and 1989 designs, it clearly had rights in the Batmobile featured in the comic books, and thus DC Comics could sue Towle for infringement of the 1966 and 1989 designs because they constituted derivative works. In addition, the court ruled that the Batmobile is entitled to copyright protection as a distinctive superhero character and should not be denied copyright protection on grounds that, as Towle had argued, it was merely a "useful article."

Regarding defendant's laches defense, the evidence indicated that Warner Bros. knew about defendant's activities as early as 2003, eight years before the law-

suit was commenced. The court nevertheless granted summary judgment to DC Comics on the laches issue as it related to the trademark infringement claim, ruling that defendant's intentional copying of plaintiff's trademarks deprived him of the laches defense. However, as to defendant's assertion of the laches defense to the copyright infringement claim, the court denied summary judgment to either party, finding that there was a genuine dispute concerning whether defendant was aware that his conduct constituted copyright infringement and thus should be barred from raising the laches defense.

In a discussion forum at Towle's website, a fellow custom car builder posted an entry expressing support for Mark and taking the viewpoint that Barris, not DC Comics, owns the copyright in the 1966 car design and thus Mark should be permitted to make replicas of that design.

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Lawyers for Life Schedule Annual Banquet

The public is invited to attend Western New York Lawyers for Life's 17th Annual Pregnancy Care Center Benefit Banquet on Thursday, May 16, at Salvatore's Italian Gardens in Depew. The evening will begin with a social hour at 6:00 p.m., followed by dinner at 7:00.

The guest speaker, Melissa Ohden, is a prominent pro-life activist. The annual banquet is sponsored also by The Catholic Medical Society, 101.7 FM Radio "The Station of the Cross," and Buffalo 40 Days for Life.

All proceeds benefit eight volunteer crisis pregnancy centers in Erie, Genesee and Niagara Counties. Music will be provided by Imprints of Love, and additional funds will be raised by an auction of donated items.

The requested minimum donation is \$35 per person; tables of eight are \$250. For reservations, call Timothy Byrnes at 836-9264 or go to www.lifebanquet.org. To make a tax-deductible donation, call Lawyers for Life president Laurence D. Behr at 856-1300.

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Meanwhile, in January 2013, the original Barris car (the 1966 TV show Batmobile created by Barris) was sold at auction for \$4.2 million.

On the larger issue of whether selling a replica automobile constitutes a violation of intellectual property rights, the courts have not always agreed. Ferrari has won two battles against replica car makers. *Ferrari S.p.A. Esercizio Fabrice Automobili e Corse v. McBurnie Coachcraft Inc.*, 11 U.S.P.Q. 2d 1843 (S.D. Cal. 1989); and *Ferrari S.p.A. Esercizio Fabrice Automobili E Corse v. Roberts*, 739 F. Supp. 1183 (E.D. Tenn. 1990), *aff'd*, 944 F. 2d 1235 (6th Cir, 1991), *cert. denied*, 505 U.S. 1219 (1992). Bentley won a similar case in 2012. *Bentley Motors Ltd. Corp. v. McEntegart*, 2012 WL 4792820 (M.D. Fla. 2012). General Motors won a similar case in 2005. *General Motors Corp. v. Hot Carts, Inc.*, 2005 WL 3046289 (E.D.Mich. 2005).

But the U.S. District Court in Massachusetts ruled against the designer of the Cobra sports car in litigation against a replica car maker. *Carroll Shelby Licensing, Inc. v. Superformance Int'l, Inc.*, 251 F. Supp. 2d 983 (D. Mass. 2002), *appeal dismissed as moot after settlement*, 435 F. 3d 42 (1st Cir. 2006). [B]

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