

Disney's Public Domain Mickey Mouse Trap

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Earlier this year, media and news outlets widely reported that Mickey Mouse had entered the “public domain” because Disney’s copyright in the cartoon “Steamboat Willie” expired on Jan. 1, 2024. What implications does the expiration of this copyright registration actually have and may we all start using Mickey to promote our products and services?

Perhaps you’ve heard of Mickey Mouse—one of the most lovable and recognizable characters in animation history. Similarly, Mickey’s “owner,” The Walt Disney Co., is undoubtedly among the most famous and powerful brand owners in the world, known for its rigorous protection and enforcement of its intellectual property rights. Earlier this year, media and news outlets widely reported that Mickey Mouse had entered the “public domain” because Disney’s copyright in the cartoon “Steamboat Willie” expired on Jan. 1, 2024. What implications does the expiration of this copyright registration actually have and may we all start using Mickey to promote our products and services?

Developed with a budget of \$4,986 and released on Nov. 18, 1928, Disney’s seven-minute long “Steamboat Willie” was the first cartoon with synchronized sound and introduced Mickey and Minnie Mouse to the world for the very first time. Steamboat Willie shows a beady-eyed, black and white, gloveless Mickey Mouse steering a steamboat downriver while entertaining Minnie without speaking a word. Since Steamboat Willie’s release, Mickey Mouse has appeared in countless shows and movies, becoming Disney’s most recognizable character and boasting one of the most identifiable silhouettes in entertainment history (sorry “Jumpman” Michael Jordan).

Disney’s copyright registration for the seven-minute Steamboat Willie cartoon expired on Jan. 1, 2024. Without copyright protection in Mickey Mouse’s debut film, Mickey Mouse is in the public domain, right? Over the past few months, media outlets reported exactly that, with even Time.com publishing an article titled “Mickey Mouse Is Now in the Public Domain After 95 Years of Disney Copyright.” Despite widespread attention, much of the reporting, headlines, and public discourse surrounding Mickey’s potential free rein in the public domain has been distorted and misunderstood.

Copyright Law in the United States (Title 17) provides the creator, or another right holder of a creative work, the exclusive and legally secured right to copy, distribute, adapt, display, and perform the work for a limited time, albeit a very long time. Indeed, the expiration of the 1928 Steamboat Willie copyright opened the curtain for Mickey Mouse's first step in the public domain, but not entirely. In reality, the 1928 copyright covered the entire Steamboat Willie cartoon film, so what has entered the public domain is the relatively narrow right to reproduce only the 1928 Steamboat Willie film in its entirety, perform the film publicly, distribute copies, and prepare derivative works of the film. While Mickey Mouse's 1928 black and white, beady-eyed, and gloveless body may be reproduced to a certain extent, more recognizable and modern versions of Mickey Mouse remain protected.

And Disney is no dummy. While copyright protections eventually expire, trademark rights have the potential to be protected in perpetuity as long as the owner continues using the trademark in commerce. And while a copyright is an original, artistic work, a trademark is generally a word, phrase, symbol or design that distinguishes one party's goods or services from those of others. The U.S. Trademark Act, also known as the Lanham Act, confers specific additional protections and benefits to the owner of a registered trademark, including the presumptive exclusive right to use the mark in connection with the specified goods or services nationwide. Applications to register a trademark within the U.S. Patent and Trademark Office (USPTO) are subject to approval by the USPTO and must meet certain requirements. One requirement for registration and subsequent renewal is that the mark must be used in commerce in connection with the specified goods and services. A trademark registration may be renewed as long as the mark is used in commerce, the registrant can show proof of this use, and the registrant files acceptable renewal declarations. Unlike a copyright registration, there is no expiration of a trademark registration as long as the renewal requirements are continuously met during the renewal periods.

Not surprisingly, Disney owns dozens of trademark registrations for the word mark "MICKEY MOUSE" and additional registrations for various design depictions of Mickey Mouse, including designs that appear similar to the original 1928 Steamboat Willie Mickey Mouse. These registrations grant Disney the exclusive right to use the registered marks in connection with the registered goods and services. Importantly, the Lanham Act provides a federal cause of action against infringers, which are defined as "any person who shall, without the consent of the registrant—use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive ..."

In other words, Disney may sue any person who uses in commerce a mark that is confusingly similar to any of Disney's registered marks. Despite 1928 Mickey being in the public domain in terms of copyright, an interloper that uses the 1928 Mickey as a trademark to promote goods or services risks liability for trademark infringement due to what might be obvious similarities between the original 1928 Mickey or the more modern Mickey, which is a registered trademark of Disney. For example, selling a T-shirt with 1928 Mickey emblazoned on the front may constitute trademark infringement based on Disney's longstanding use and federal registrations in more modern Mickey Mouse designs, if such use is "likely to cause confusion, or to cause mistake, or to deceive" consumers into believing the t-shirt originates from or is sponsored by Disney.

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The first Mickey film may be in the public domain, but Disney's robust intellectual property portfolio still includes trademark rights in Mickey Mouse designs. For those contemplating capitalizing on the fact that Mickey Mouse's debut film Steamboat Willie is no longer copyright protected and in the public domain, be wary of Disney's likely enforcement efforts surrounding the iconic Mickey. Putting it another way, while Steamboat Willie may be sailing in public domain waters, Disney's trademark protections anchor Mickey Mouse firmly in the realm of enforceable intellectual property.

Laura Lipschutz is a member of Flaster Greenberg's intellectual property department. She focuses her practice on domestic and international trademark, copyright, and unfair competitions matters, including developing brand strategies, trademark prosecution and maintenance, licensing, and Trademark Trial and Appeal Board (TTAB) proceedings.

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