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An Overview of Legal Protection for Fictional Characters: Balancing Public and Private Interests

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AN OVERVIEW OF LEGAL PROTECTION FOR FICTIONAL
CHARACTERS: BALANCING PUBLIC AND PRIVATE
INTERESTS

AMANDA SCHREYER[†]

I. Fictional Characters and the Law	52
II. Legal Basis for Protecting Characters.....	53
III. Copyright Protection of Characters	57
<i>A. Literary Characters Versus Visual Characters.....</i>	60
<i>B. Component Parts of Characters Can Be Separately Copyrightable</i>	63
<i>C. Stock Characters Are Not Copyrightable</i>	64
IV. Protection of Characters Through Trademark Rights.....	65
<i>A. Trademark Rights Are Separate from Copyrights.....</i>	65
<i>B. Character Elements Must Act as Source Identifiers</i>	66
<i>C. Distinctive Visual Representations Are Protectable by Trademark Law.</i>	69
<i>D. General Traits Are Not Protected by Trademark</i>	70
V. Protection of Characters Through Rights of Publicity.....	70

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[6:49 2015]	AN OVERVIEW OF LEGAL PROTECTION FOR FICTIONAL CHARACTERS	51
VI.	Limitations on Exclusive Use.....	72
	<i>A. Non-infringing Uses—Copyright</i>	72
	<i>B. Non-infringing Uses—Trademark</i>	76
	<i>C. Copyright Fair Use</i>	79
	<i>D. Literary Works in the Public Domain</i>	83
	<i>E. Visual Images in the Public Domain</i>	86
	<i>F. The First Amendment</i>	89
VII.	Conclusion.....	92

I. FICTIONAL CHARACTERS AND THE LAW

After 127 years of providing detective consulting services, in 2014, Sherlock Holmes faced his toughest case yet: “The Mystery of the Public Domain.” In that case, the Seventh Circuit was asked to balance the competing interests of the estate of the Sherlock Holmes creator with the interests of authors to use the character in new fictional works.¹ Utilizing the existing body of case law on the subject, the court deduced that Arthur Conan Doyle and his estate had exploited the Holmes character as far as copyright law allows, setting Holmes up for new adventures in the public domain.²

American intellectual property law is designed to incentivize authors to create new literary, artistic, and other works of authorship; and thus add to America’s rich and ever-growing popular culture. To achieve this objective, copyright law, and in fact, the Constitution, affords authors certain exclusive rights in their copyrighted works, including to the original characters contained therein, so that the authors can secure a fair return on their efforts.³ At the same time, the law limits a character owner’s monopoly by (i) limiting the protection afforded to characters to only those that are fully developed; (ii) allowing others to create and exploit similar, but non-infringing, characters that share common traits and stock or genre characteristics; (iii) permitting third parties to make fair uses of characters; and (iv) ensuring that the copyright in protected characters will eventually expire, injecting such characters into the public domain. While character owners have an assortment of legal tools available to protect their work, these legal tools are not absolute; the public can utilize characters owned by others without the need to secure rights from the owners by way of devices like the fair use doctrine and free speech rights.

¹ *Klinger v. Conan Doyle Estate, Ltd.*, 755 F.3d 496 (7th Cir. 2014).

² *Id.* at 503.

³ U.S. CONST. art. I, § 8, cl. 8.; U.S. CONST. amend. I.

Character owners and new creators should familiarize themselves with the legal protections afforded to fictional characters. To best exploit and protect a character over time, character creators should consider legal protections while conceiving and designing characters. New creators should understand how existing characters might impact their ability to create and exploit new ones that are similar to, or reminiscent of, those existing characters. On the other hand, creators and owners of existing characters should be aware of the limits on their exclusive rights, so that they can avoid wasting energy and resources taking meritless actions against perceived infringers.

This article explains the legal protections available to characters, and the limitations on character owners' exclusive rights. Part II provides an overview of the laws available to protect fictional characters. Sections III through V examine specific examples of how various laws have been applied to fictional characters. Section VI addresses the limitations on character owners' rights, and explores the ways in which characters or their constituent elements may be freely used without permission. Finally, section VII offers tips on protecting characters within existing legal parameters.

II. LEGAL BASIS FOR PROTECTING CHARACTERS

Copyright law provides exclusive rights for creative works, including fictional characters that are (1) original, and (2) fixed in a tangible medium.⁴ Cases construing the meaning of "originality" generally have required it to mean "independent creation plus a modicum of creativity."⁵ The creativity bar is not high.⁶ Moreover,

⁴ 17 U.S.C. § 102(a) (2012); *see* *Balt. Orioles v. Major League Baseball Players Ass'n*, 805 F.2d 663, 668 (7th Cir. 1986) (discussing the statutory definition of "fixed" in 17 U.S.C. § 101).

⁵ *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 362 (1991).

⁶ *See* *Mazer v. Stein*, 347 U.S. 201 (1954); *Balt. Orioles*, 805 F. 2d at 669 n.7; *L. Batlin & Son, Inc. v. Snyder*, 536 F. 2d 486, 490 (2d Cir. 1976) ("[T]he quantum of originality that is required may be modest indeed . . .").

while “some original expression” is required, the original expression contributed to a work need not be separable from the work as a whole.⁷

The goal of copyright is to promote the progress of the arts⁸ and consequently enrich the public.⁹ This goal is accomplished by giving creators an incentive to create by allowing them certain exclusive rights for limited periods of time.¹⁰ By limiting the duration of copyright,¹¹ the public’s interest in an ever-growing, rich public domain is balanced with the interests of creators. By affording copyright owners protection in their works, copyright law also benefits the public by encouraging authors to produce original works. It is not designed to let creators avoid “the drudgery of working up something fresh” by simply copying existing works.¹²

Trademark law protects any word, name, symbol, or device that is used to identify the source or origin of a product.¹³ Thus, to the extent that any character indicia function to identify the source or origin of a product or service, such character indicia may be entitled to trademark protection.¹⁴ While exclusive trademark

⁷ *Gaiman v. MacFarlane*, 360 F.3d 644, 658 (7th Cir. 2004).

⁸ U.S. CONST, art. I, § 8, cl. 8.

⁹ *See, e.g.*, *Golan v. Holder*, 132 S. Ct. 873, 889 (2012); *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984); *Mazur v. Stein*, 347 U.S. 201, 219 (1954).

¹⁰ *See Golan*, 132 S. Ct. at 902 (citing *Sony Corp.* and *Mazur* in support of the proposition that the limited copyright conferred by copyright is meant to motivate authors to create).

¹¹ 17 U.S.C. § 302 (2012).

¹² *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 580 (1994).

¹³ 15 U.S.C. § 1127 (2012).

¹⁴ *See Sony v. Fireworks*, 137 F. Supp. 2d 1177, 1198 (C.D. Cal. 2001) (holding that where plaintiffs could not define to what they were claiming trademark rights, nor that the character had acquired secondary meaning as a source identifier, the court could not assess whether there was a likelihood of confusion between plaintiff’s and defendant’s marks to find trademark infringement by the defendants), *vacated*, 2002 WL 32387901 (C.D. Cal. 2002).

rights protect owners by encouraging them to invest in the goodwill attendant with their marks, trademark law is rooted in consumer protection.¹⁵ Just as consumers buy any trademarked goods based on the goodwill of the applicable trademark, the public consumes entertainment products based on the brands associated with such products.

The goal of trademark law is to protect “the purchasing public from confusing desired product with similarly named, labeled, or branded product from a different source.”¹⁶ Trademark law also gives trademark owners the incentive to invest in the establishment of brand names and marks, and to maintain high levels of quality control over their products and services.¹⁷ Trademark law can thus “contribute to a favorable climate for expression by complementing the economic incentive that copyright provides to create and disseminate artistic works.”¹⁸ Unlike copyright, trademark rights may persist indefinitely as long as the trademark owner continues to use its mark. However, merely registering an image of a character as a trademark does not give the registrant perpetual

Where a character, or its name, is not inherently distinctive, and it is not otherwise protected as a registered trademark, it may still be entitled to trademark protection if it has acquired “secondary meaning” such that the consuming public would associate any third party’s use of those elements with the source or origin of the entertainment property from which those elements were derived. *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 203 (2d Cir. 1979).

¹⁵ *James Burrough Ltd. v. Sign of Beefeater, Inc.*, 540 F.2d 266, 276 (7th Cir. 1976) (“The trademark laws exist not to ‘protect’ trademarks, but. . . to protect the consuming public from confusion, concomitantly protecting the trademark owner’s right to a non-confused public.”).

¹⁶ *Mechanical Plastics Corp. v. Titan Techs., Inc.*, 823 F. Supp. 1137, 1143 (S.D.N.Y. 1993).

¹⁷ *Scandia Down Corp. v. Euroquilt, Inc.*, 772 F.2d 1423, 1429 (7th Cir. 1985); *Truck Equip. Serv. Co. v. Freuhauf*, 536 F.2d. 1210, 1215 (8th Cir. 1976).

¹⁸ *Silverman v. CBS, Inc.*, 870 F.2d 40, 48 (2d Cir. 1989).

rights in the image.¹⁹ It is not the recognition of a character image that provides perpetual rights in that image. Rather, it is the character owner's continued use of that image as a source identifier that allows the image to receive trademark protection indefinitely.²⁰ Copyright protection in a character, in contrast, continues for the duration of the copyright term regardless of whether the copyright owner continues to exploit the work. Copyright owners can let their works go out of print or elect not to publish or license any third parties to publish any new works using a character, and still preserve copyright protection for that character. Trademark law, on the other hand, requires that a trademark owner continually convey its character to the public to maintain trademark rights in that character.

Another proprietary right that may protect characters from unauthorized use is the right of publicity. Every person, whether famous or not, has a property right in her name and likeness. Some people become famous because of characters they portray or personas they adopt, and the name and likeness of that character or persona can have substantial value. Unlike copyright and trademark law, rights of publicity are state-based (both statutory and common law), and therefore not uniform throughout the country. Generally, the laws prohibit the unauthorized use of a person's name or likeness for commercial purposes.²¹ As opposed

¹⁹ See *In re DC Comics, Inc.*, 689 F.2d 1042, 1052 (C.C.P.A. 1982) (Nies, J., concurring).

²⁰ See *id.* at 1052.

²¹ RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (1995) ("One who appropriates the commercial value of a person's identity by using without consent the person's name, likeness, or other indicia of identity for purposes of trade is subject to liability . . ."); *Id.* § 47 (1995) ("The name, likeness, and other indicia of a person's identity are used "for purposes of trade" . . . if they are used in advertising the user's goods or services, or are placed on merchandise marketed by the user, or are used in connection with services rendered by the user. However, use "for purposes of trade" does not ordinarily include the use of a person's identity in news reporting, commentary,

to the right of privacy, which protects a person's feelings, a person's right of publicity gives the exclusive right to control the commercial exploitation of her name and likeness.²² Often invoked as a complement to trademark rights, right of publicity laws have been used by individuals to prohibit others from commercially exploiting characters or personas that they portray. Moreover, right of publicity claims will not be preempted by copyright or trademark laws if such claims address rights different from those protected by copyright and trademark, such as persona or likeness.²³

III. COPYRIGHT PROTECTION OF CHARACTERS

Copyright provides exclusive protection for original works of authorship fixed in a tangible medium.²⁴ The law does not grant a monopoly over mere ideas, themes, or concepts; which are in the public domain and available to everyone.²⁵ In order to gain exclusive copyright in a character, character creators must not only create original works, but must also flesh out their characters with enough original expression to make them distinctive.²⁶ Courts have therefore developed tests to determine whether a character has

entertainment, works of fiction or nonfiction, or in advertising that is incidental to such uses.”).

²² *Haelan Lab. Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir. 1953) (recognizing property right in a baseball player's photograph used on trading cards).

²³ *See* *Wendt v. Host Int'l, Inc.*, Nos. 93-56318, 93-56510, 1995 WL 115571, at *1 (9th Cir. Mar. 16, 1995).

²⁴ 17 U.S.C. §102 (2012) (corresponding to the language of the Copyright Act of 1909 Act, § 3) (“That the copyright provided by this title shall protect all the copyrightable component parts of the work copyrighted . . .”).

²⁵ *Sega Enterprises Ltd. v. Accolade, Inc.*, 977 F.2d 1510, 1526 (9th Cir. 1992) (explaining that copyright does not confer a monopoly over the underlying idea or functional principle, as that is the domain under the more stringent standards imposed by patent laws).

²⁶ *See* *Nichols v. Universal Pictures Corp.*, 45 F.2d 119 (2d Cir. 1930).

reached a level of distinction to grant exclusive rights to the unique compilation of the character's traits.

In the 1930 case of *Nichols v. Universal Pictures*, the Ninth Circuit employed the now oft-cited “sufficiently delineated” test.²⁷ Pursuant to this test, if an author has imbued the character with sufficient original details, the character will be entitled to some level of protection.²⁸ The more highly developed the character, the greater the protection available. In *Nichols*, the court found that the plaintiff's characters were not sufficiently developed and thus not copyrightable because they were merely archetypal characters that often appeared in literature.²⁹ In his opinion, Judge Learned Hand warned would-be plaintiffs that “[t]he less developed a character in a play is, the less it can be copyrighted; that is the penalty an author must bear for marking them too indistinctly.”³⁰

Another well-known judicial test for the copyrightability of characters is the “story being told” test that originated in the Second Circuit in 1954. In *Warner Bros. v. Columbia Broadcast Systems*, the court found that a character could only be the subject of copyright protection where the character constituted “the story being told.”³¹ Pursuant to this test, the character must be more than a “mere vehicle” for the telling of the story, and must actually be the “story being told.”³² Taking a more restrictive view of the copyrightability of a character apart from the work in which he appears, the court here reasoned that because “[t]he characters of an author's imagination and the art of his descriptive talent . . . are always limited and always fall into limited patterns,” allowing one author to claim a monopoly over that character would violate copyright law's goal of promoting the useful arts unless the

²⁷ *See id.* at 121.

²⁸ *Id.*

²⁹ *Id.* at 122–23.

³⁰ *Id.* at 121.

³¹ *See* 216 F.2d 945, 950 (9th Cir. 1954).

³² *Id.*

character constitutes the story.³³ In that case the court found that Sam Spade was merely the vehicle for telling the *The Maltese Falcon* story, and thus not copyrightable.³⁴

Most courts have declined to follow *Warner Brothers*, suggesting that the proposed “story being told” test was dictum.³⁵ Others have reasoned that while the “story being told” test may apply to literary characters, it is inapplicable to visual characters.³⁶ Still others have held that, if the test was ever good law, it is no longer.³⁷ Other courts have applied elements from each of the foregoing tests, looking both at how developed a character is, and the character’s role in the work in which it appears.³⁸ In *Anderson v. Stallone*, the court held that the characters from the first three films from the *Rocky* motion picture series were among “the most highly delineated characters in modern American cinema, and were *so highly developed* and central to the films that they constituted *the story being told*.”³⁹ A few years later, in *Metro-Goldwyn-Mayer v. American Honda*, the same court found that the James Bond character was both sufficiently delineated and the story being told throughout the sixteen films in which he had

³³ *Id.* at 950.

³⁴ *Id.* In that case, the holding that the character was not protectable under copyright law actually favored the character’s creator who wished to use the character in new works after granting exclusive rights to the work in which the character first appeared to a movie studio. *Id.*

³⁵ See *Walt Disney Prods. v. Air Pirates*, 581 F.2d 751, 755 (9th Cir. 1978); *Anderson v. Stallone*, 11 U.S.P.Q.2d 1161, 1165 (C.D. Cal. Apr. 25, 1989).

³⁶ See *Gaiman v. McFarlane*, 360 F.3d 644 (7th Cir. 2004); *Walt Disney Prods.*, 581 F.2d at 755; *Anderson*, 11 U.S.P.Q.2d, at 1165.

³⁷ *Anderson*, 11 U.S.P.Q.2d, at 1165 (“Subsequent decisions in the Ninth Circuit cast doubt on the reasoning and implicitly limit the holding of the Sam Spade case.”); *Gaiman* at 660 (“The Ninth Circuit has killed the decision, though without the usual obsequies.”).

³⁸ See *Metro-Goldwyn-Mayer v. American Honda*, 900 F. Supp. 1287 (C.D. Cal. 1995); *Anderson*, 11 U.S.P.Q.2d, at 1166.

³⁹ *Anderson*, 11 U.S.P.Q.2d, at 1166 (emphasis added).

appeared, such that the character was deserving of copyright protection.⁴⁰

A. Literary Characters Versus Visual Characters

Not all characters qualify for copyright protection, and not all characters are treated equally under the law. Pursuant to any judicial test, characters lacking distinctive, original traits or an original combination of distinctive traits have been found to be uncopyrightable.⁴¹ Also, while purely literary characters might be protectable, visual characters (such as comic or cartoon characters) are easier to protect, as their visual embodiments are entitled to protection independent of their literary attributes. This is not to say that characters developed solely by “word portraits”⁴² are not entitled to protection. They certainly are, but identifying the protectable elements of purely literary characters presents challenges not applicable to visual characters.⁴³ In a recent Seventh Circuit case, the court was asked to consider all the protectable traits of the Sherlock Holmes and John Watson characters from an entire series of books and stories.⁴⁴ It found that those characters were distinctive enough to be proper subjects of copyright independent of the stories in which they appeared.⁴⁵ While

⁴⁰ *Metro-Goldwyn-Mayer*, 900 F. Supp. at 1296.

⁴¹ See *Olson v. National Broad. Co.*, 855 F. 2d 1446 (9th Cir. 1988).

⁴² 1 MELVIN NIMMER, NIMMER ON COPYRIGHT § 2.12 (Matthew Bender rev. ed. 2014).

⁴³ See *Anderson*, 11 U.S.P.Q.2d, at 1165 (“As a practical matter, a graphically depicted character is much more likely than a literary character to be fleshed out in sufficient detail so as to warrant copyright protection.”); *Walt Disney Prods. v. Air Pirates*, 581 F.2d 751, 755 (9th Cir. 1978) (“While many literary characters may embody little more than an unprotected idea... a comic book character, which has physical as well as conceptual qualities, is more likely to contain some unique elements of expression.”).

⁴⁴ *Klinger v. Conan Doyle Estate Ltd.*, 755 F.3d 496, 503 (7th Cir. 2014) (“From the outset of the series of Arthur Conan Doyle stories and novels that began in 1887 Holmes and Watson were distinctive characters and therefore copyrightable.”).

⁴⁵ *Id.*

multiple appearances may aid in the development of the character, they are not required for a court to find that a literary character is developed enough to be copyrightable. A district court in Washington had no difficulty in concluding that an anthropomorphized seagull appearing in one book was both sufficiently delineated and the story being told, and therefore copyrightable.⁴⁶ But characters lacking visual depiction that are only described in a few lines will likely not be developed enough to be copyrightable.⁴⁷

In the case where a character is solely described in writing, the reader must necessarily use imagination to create a vision of the character in the mind. Each reader therefore could have a different interpretation of the elements combined to create the character, making it difficult to define what makes the character developed. Where a character has a visual representation, however, all viewers receive a uniform interpretation of the character.⁴⁸ The Ninth Circuit in *Walt Disney Productions v. Air Pirates* asserted that visual characters should not be subject to the Second Circuit's stringent test applicable to literary characters.⁴⁹ It reasoned that the physical and conceptual qualities of a comic book character, apparent through its visual representation, are more likely to be a unique expression.⁵⁰ The court then held that Disney's famous graphic characters were protected by copyright and infringed by the defendants when they placed the innocent characters in "adult" situations.⁵¹

⁴⁶ *Bach v. Forever Living Prods. U.S., Inc.*, 473 F. Supp. 2d 1127 (W.D. Wash. 2007). *C.f.* *Rice v. Fox*, 330 F.3d 1170, 1175 (9th Cir. 2002) ("[T]he magician is dressed in standard magician garb—black tuxedo with tails, a white tuxedo shirt, a black bow tie, and a black cape with red lining—and his role is limited to performing and revealing the magic tricks.").

⁴⁷ *See Olson v. Nat'l Broad. Co.*, 855 F. 2d 1446, 1452–53 (9th Cir. 1988).

⁴⁸ *See Gaiman v. McFarlane*, 360 F.3d 644 at 660–61 (7th Cir. 2004).

⁴⁹ 581 F.2d 751 (9th Cir. 1978).

⁵⁰ *Id.* at 755.

⁵¹ *Id.* at 755–56

The court in *Anderson v. Stallone* found that the defendant's script treatment for a fourth *Rocky* film was a "bodily appropriation" of the characters portrayed in the first three *Rocky* films—and an infringement.⁵² In its opinion, the court evaluated the judicial tests for copyrightability of characters and noted that "[a]s a practical matter, a graphically depicted character is much more likely than a literary character to be fleshed out in sufficient detail so as to warrant copyright protection."⁵³ Reasoning that the detail with which the characters were developed in the first three films delineated the characters more than sufficiently, and that the characters—as opposed to the plots—are what drove the three *Rocky* films, the court found the *Rocky* characters copyrightable under both tests.⁵⁴ Similarly, the court in *Metro-Goldwyn-Mayer v. American Honda* had to determine whether James Bond was a copyrightable character separate from the works in which he appeared.⁵⁵ Noting that the law in the Ninth Circuit was unclear as to which test should be applied to a visual character such as James Bond, the court elected to analyze the copyrightability of Bond under both tests.⁵⁶ Because the character as portrayed in each of plaintiffs' sixteen Bond movies displayed such specific traits—"his cold-bloodedness; his overt sexuality; his love of martinis 'shaken, not stirred;' his marksmanship; his 'license to kill'"—James Bond was more than sufficiently delineated.⁵⁷ Moreover, because these character traits remained consistent throughout the sixteen

⁵² *Anderson v. Stallone*, 11 U.S.P.Q.2d, at 1166 (C.D. Cal. 1989).

⁵³ *Id.*

⁵⁴ *Id.* at 1174.

⁵⁵ 900 F. Supp. 1287 (C.D. Cal. 1995).

⁵⁶ *Id.* at 1296–97.

⁵⁷ *Id.* at 1296; *see also* *Toho Co. v. William Morrow & Co.* 33 F. Supp. 2d 1206, 1216 (C.D. Cal. 1998) ("Toho's Godzilla is a well-defined character with highly delineated consistent traits. Therefore, Toho has demonstrated prima facie ownership of copyrights in the Godzilla character apart from any film.").

films even though the character was played by multiple actors, the stories really were about the James Bond character.⁵⁸

B. Component Parts of Characters Can Be Separately Copyrightable

While the collection of specific traits of a character can be copyrightable, original, individual components of a character's identity may also be protected by copyright. In *New Line Cinema v. Russ Berrie*, the court found that the glove worn by Freddy Krueger in the *Nightmare on Elm Street* films was protectable by copyright on its own.⁵⁹ The court in that case opined that where the component part of a character protected by copyright so helps to identify the character, that part, even when separated from the rest of the character, remains protected by copyright.⁶⁰ Recently, a court held that the Batmobile was a copyrighted character.⁶¹ In *DC Comics v. Towle*, the court rejected the defendant's argument that the Batmobile is not protectable by copyright because it is a useful item—a car—holding on alternative bases that: (1) the Batmobile is a copyrighted character because it displays “a series of readily identifiable and distinguishing traits . . . [it is] recognizable because it contains bat-like motifs, such as a bat-faced grill or bat-shaped tailfins in the rear of the car, and it is almost always jet black;”⁶² and (2) the separately identifiable creative elements incorporated into the Batmobile that are capable of existing independently from the utilitarian aspects of the car are protectable as pictorial, graphic and sculptural works.⁶³ The original,

⁵⁸ See, e.g., *Metro-Goldwyn-Meyer*, 900 F. Supp. at 1296; see also *William Morrow & Co.*, 33 F. Supp. 2d at 1216 (“While Godzilla may have shifted from evil to good, there remains an underlying set of attributes that remain in every film.”).

⁵⁹ 161 F. Supp. 2d 293, 302 (S.D.N.Y. 2001).

⁶⁰ *Id.*

⁶¹ *DC Comics v. Towle*, 989 F. Supp. 2d 948 (C.D. Cal. 2013).

⁶² *Id.* at 967.

⁶³ *Id.* at 968.

consistent features of the design of the car are what make it recognizable as a character.

C. Stock Characters Are Not Copyrightable

Characters lacking originality, however, will not be protected by copyright. Stock characters, archetypes, and characters lacking unique expression, cannot be monopolized under copyright law.⁶⁴ *Suntrust Bank v. Houghton Mifflin Co.* described the “spectrum” of copyright protection for characters.⁶⁵ On one end are *scènes à faire*:⁶⁶ “stock scenes and hackneyed character types,” which are not protectable because they contain no unique aspects.⁶⁷ However, as characters become more idiosyncratic, they eventually cross the line into “expression” and are protected by copyright.⁶⁸ A character that in its early stages was merely a stock character can be fleshed

⁶⁴ See e.g., *DiTocco v. Riordan*, 815 F. Supp. 2d 655, 668 (S.D.N.Y. 2011) (“Young male heroes who must cope with missing parents and display their strength in battles with otherworldly forces are commonplace.”). For further examples of characters which are not protected, see *Walker v. Time Life Films, Inc.*, 784 F.2d 44, 50 (2d Cir. 1986) (holding that *scènes à faire*, which have been described as “scenes that necessarily result from the choice of a setting or situation” are not copyrightable.); *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 979 (2d Cir. 1980) (providing more examples of *scènes à faire* such as “incidents, characters or settings which are as a practical matter indispensable, or at least standard, in the treatment of a given topic”) (internal quotation omitted); *Reyher v. Children’s Television Workshop*, 533 F.2d 87, 91 (2d Cir. 1976) (holding that “thematic concepts . . . which necessarily must follow from certain similar plot situations” are not copyrightable).

⁶⁵ 268 F.3d 1257 (11th Cir. 2001).

⁶⁶ French translation for “scenes of action.” See also BLACK’S LAW DICTIONARY (9th ed. 2009) (“Standard or general themes that are common to a wide variety of works and therefore not copyrightable.”).

⁶⁷ *Suntrust Bank*, 268 F.3d at 1266.

⁶⁸ *Id.* (internal quotation omitted); see also *Sid & Marty Krofft Prod., Inc. v. McDonald’s Corp.*, 562 F.2d 1157, 1165 (9th Cir. 1977) (Explaining that there is no infringement if only the ideas from a work are copied because ideas receive no copyright protection. “To constitute infringement the copying must reach the point of ‘unlawful appropriation,’ or the copying of the protected expression itself.”).

out enough to bring it into “copyright land.”⁶⁹ Once the character embodies an “original arrangement of incidents and literary expressions,” and does not merely describe a type of character, the character may be protected by copyright.⁷⁰ In *Detective Comics v. Bruns*, the court acknowledged that copyright does not extend to “archetypal” elements such as the idea or premise of a “Superman” who is a blessing to mankind. But while the underlying premise for the “benevolent Hercules” type character is not protectable, other elements, such as incredible feats, characterizations (such as employment and secret identities), and unique antics are.⁷¹

IV. PROTECTION OF CHARACTERS THROUGH TRADEMARK RIGHTS

A. Trademark Rights Are Separate from Copyrights

Because trademark and copyright principles apply to and protect different aspects of a creative work and are not mutually dependent, trademark rights in a character may be owned and enforced even if the trademark owner does not own the copyright in the character.⁷² For example, in *Tri-star Pictures, Inc. v. Del Taco, Inc.*, even though the plaintiff did not own any copyrights in the “Zorro” character, it was not barred from bringing a trademark infringement claim when the defendant sought to use Zorro-related indicia to promote its restaurant chain.⁷³ Trademark law offers character owners protections independent of copyright law, which

⁶⁹ *Gaiman v. McFarlane*, 360 F.3d 644, 659 (7th Cir. 2004).

⁷⁰ *Detective Comics v. Bruns Publ'ns*, 111 F.2d 432, 433–34 (2d Cir. 1940); see *Gaiman*, 360 F.3d at 659 (discussing the court’s analysis in the *Detective Comics* case). The author’s verbal description of a comic book character is an uncopyrightable stock character. *Id.* at 661. However, once the character is “drawn and named and given speech, he be[comes] sufficiently delineated to be copyrightable.” *Id.*

⁷¹ See *id.* at 433–34.

⁷² See, e.g., *Silverman v. CBS, Inc.*, 870 F.2d 40 (2d Cir. 1989); *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, 772 F. Supp. 2d 1135, 1153–54 (C.D. Cal. 2008), *aff’d*, 654 F.3d 958 (9th Cir. 2011); *Tri-star Pictures, Inc. v. Del Taco, Inc.*, 1999 WL 33260839 (C.D. Cal. 1999).

⁷³ See *Tri-star*, 1999 WL 33260839, at *2–4.

can be exercised by the owner of a character notwithstanding that any copyright in the character may have expired.⁷⁴

B. Character Elements Must Act as Source Identifiers

Just as copyright law does not protect all elements of a character, not all character elements are protectable by trademark law. Only those elements of a character that assist the public in associating the character with a specific source may receive trademark protection.⁷⁵ A character's name may be a protectable component of a character under trademark law.⁷⁶ In *Wyatt Earp Enterprises, Inc. v. Sackman, Inc.*, the court held that the plaintiff had established secondary meaning and hence trademark rights in the "Wyatt Earp" name even though Wyatt Earp was a real person of historic significance.⁷⁷ The court recognized that the commercial value of the character's name was attributable almost entirely to a television program produced by the plaintiff along with the plaintiff's extensive licensing program, which "battered [the name] into the public consciousness."⁷⁸ The secondary meaning in the Wyatt Earp name generated by the plaintiff's use of the name allowed the plaintiff to stop the licensee from selling and promoting Wyatt Earp costumes after its license had expired.⁷⁹ The

⁷⁴ *Id.* at *3–4. See generally *Sony Pictures Entm't, Inc. v. Fireworks Entm't Grp., Inc.*, 137 F. Supp. 2d 1177 (C.D. Cal. 2001).

⁷⁵ *DC Comics, Inc. v. Filmation Assocs.*, 486 F. Supp. 1273, 1277 (S.D.N.Y. 1980) ("[W]here the product sold by plaintiff is 'entertainment' in one form or another, then not only the advertising of the product but also an ingredient of the product itself can amount to a trademark protectable under § 43(a) because the ingredient can come to symbolize the plaintiff or its product in the public mind.").

⁷⁶ *E.g.* *Conan Properties, Inc. v. Conans Pizza, Inc.*, 752 Fed.2d 145 (5th Cir. 1985); *Am. Broad. Co. Merch., Inc. v. Button World Mfg., Inc.*, 1966 WL 7657 (N.Y. Sup. Ct. 1966); *Wyatt Earp Enters., Inc. v. Sackman, Inc.*, 157 F. Supp. 621 (S.D.N.Y. 1958).

⁷⁷ *Wyatt Earp*, 157 F. Supp. at 623–625.

⁷⁸ *Id.* at 624.

⁷⁹ *Id.* at 627.

court found that defendant's use of the Wyatt Earp name on children's play costumes would very likely cause the consuming public to believe that the costumes came from the plaintiff because of the goodwill contributed to the Wyatt Earp name through the plaintiff's radio and television shows.⁸⁰

In a case construing the related doctrine of unfair competition, the court in *Lone Ranger, Inc. v. Cox* enjoined the defendants from using any language that could be construed by the public as suggesting a connection between defendant's circus and the "Lone Ranger" name.⁸¹ The court held that the Lone Ranger name was the trade name under which plaintiff producers' radio program was distributed.⁸² Plaintiff had engendered good will in the Lone Ranger name, and by using the title "the Original Lone Ranger" for a performer in its circus—an obvious attempt to trade off plaintiff's good will in the Lone Ranger name—the defendants had fraudulently appropriated that good will.⁸³

Costumes worn by characters can also qualify for trademark protection,⁸⁴ and the unauthorized use of a character's costume can falsely suggest a connection between the unauthorized user and the character owner.⁸⁵ The issue in *Dallas Cowboys Cheerleaders v. Pussycat Cinemas* was whether the plaintiff owned a trademark in the unique costumes worn by its cheerleaders.⁸⁶ The court found

⁸⁰ *Id.* at 625.

⁸¹ *Lone Ranger, Inc. v. Cox*, 124 F.2d 650, 653 (4th Cir. 1942).

⁸² *Id.*

⁸³ *See id.*; *see also Button World Mfg.* 1966 WL 7657 at *1 (enjoining defendant from "using the very name which plaintiffs have popularized and which is associated in the public mind with their broadcasting programs.").

⁸⁴ *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 204 (2d Cir. 1979).

⁸⁵ *See Brown v. It's Entm't, Inc.*, 34 F. Supp. 2d 854, 859 (E.D.N.Y. 1999) (granting preliminary injunction against defendant renting infringing "Arthur the Aardvark" costume); *Warner Bros. Inc. v. Rooding*, 1989 WL 76149 at *3-*4 (N.D. Ill. 1989).

⁸⁶ *Dallas Cowboys*, 604 F.2d at 203-04.

that plaintiff's "combination of the white boots, white shorts, blue blouse, and white star-studded vest and belt is an arbitrary design which makes the otherwise functional uniform trademarkable."⁸⁷ In *Warner Bros. Inc. v. Rooding*, the court enjoined the owner of a movie theater from jumping out of a helicopter wearing a Batman costume on the day of the release of the Batman movie.⁸⁸ The timing and advertising for the stunt demonstrated to the court defendant's obvious intention to exploit plaintiff's trademarks "in the form of a Batman costume."⁸⁹ In *Brown v. It's Entertainment, Inc.*, the plaintiff owners of the "Arthur the Aardvark" character sought to enjoin the defendant's unauthorized commercial use of an unlicensed "Arthur" costume.⁹⁰ The court found "Arthur," a stylized Aardvark with the persona of a schoolboy, to be an inherently distinctive, and as the evidence showed, a famous trademark.⁹¹

Other indicia, such as a prop, well-known saying, or slogan, of a character can be protected by trademark if it is so connected to the character so as to identify the character's source.⁹² Bugs Bunny's "What's up, doc?"⁹³ and "E.T. phone home"⁹⁴ are trademarks. In *Lone Ranger v. Cox*, the court found defendant's use of the familiar call of plaintiff's character—"Hi Ho Silver!"—in its circus served to accentuate defendant's deceptive use of the Lone Ranger

⁸⁷ *Id.* at 204.

⁸⁸ *Rooding*, 1989 WL 76149 at *3; *see also id.* at *4 (explaining how the injunction applied only to the defendant's commercial use of the costume, explicitly permitting him to wear it for "a walk down the beach . . . [h]anding out free candy at orphanages . . .").

⁸⁹ *Id.* at *3.

⁹⁰ *Brown v. It's Entertainment, Inc.*, 34 F. Supp. 2d 854 (E.D.N.Y. 1999).

⁹¹ *Id.* at 858–59.

⁹² *See supra* note 75 (discussing protectability of an "ingredient" of an entertainment product).

⁹³ WHAT'S UP, DOC?, Registration No. 75,844,359.

⁹⁴ *Universal City Studios, Inc. v. Kamar Indus., Inc.*, 217 U.S.P.Q. 1162 (S.D. Tex. 1982).

character.⁹⁵ Holding that the familiar coloring and symbols on the “General Lee” had attained secondary meaning, the court in *Warner Bros. v. Gay Toys* concluded that defendant’s unauthorized toy cars were likely to confuse consumers into believing that the infringing cars originated with the creators of the *Dukes of Hazzard*.⁹⁶

C. Distinctive Visual Representations Are Protectable by Trademark Law.

Visual representations of characters are also protectable under trademark law. For example, defendant’s chain of pizza restaurants named “Conans Pizza,” and whose “menus, signs, promotional materials, and general décor featured a barbarian-like man who closely resembled” plaintiff’s “Conan the Barbarian” character was found to have infringed the image of the trademarked character.⁹⁷ At trial, the jury found it likely that “the pervasive, inescapable aura of Conan the Barbarian” present at the restaurants could lead consumers to conclude that the restaurants were associated with the plaintiff owners of the “Conan the Barbarian” character.”⁹⁸ In *DC Comics v. Filmation*, the court compared defendant’s “Manta,” “Moray,” and “Superstretch” characters to plaintiff’s “Aquaman” and “Plastic Man” characters and found that the similarity of the physical appearances and costumes of the defendant’s characters were likely to cause confusion among consumers as to whether such characters were associated with plaintiff, thereby demonstrating trademark infringement and unfair competition.⁹⁹

⁹⁵ *Lone Ranger, Inc. v. Cox*, 124 F.2d 650, 652 (4th Cir. 1942).

⁹⁶ *Warner Bros., Inc. v. Gay Toys, Inc.*, 724 F.2d 327, 333 (2d Cir. 1983).

⁹⁷ *Conan Properties, Inc. v. Conans Pizza, Inc.*, 752 F.2d 145, 148 (5th Cir. 1985); *id.* at 155 (holding that plaintiff owns protectable rights in the Conan the Barbarian name and character).

⁹⁸ *Id.* at 150.

⁹⁹ *See DC Comics, Inc. v. Filmation Assocs.*, 486 F. Supp. 1273 (S.D.N.Y. 1980).

D. General Traits Are Not Protected by Trademark

While a competitor's use of an existing character's distinctive elements may cause confusion as to the source of the competing character, the use of similar, common character traits will not. The owner of a character will not be able to use trademark law to claim exclusive rights in the general traits and abilities of its character, just as it cannot use copyright law to claim exclusive rights in the stock elements contained in the character.¹⁰⁰ Because there are infinite potential manifestations of personality traits and physical abilities in a character, each can never be consistent enough to serve as a single source identifier, and therefore cannot be protected by trademark law.¹⁰¹ For example, in *American Greetings Corp. v. Easter Unlimited, Inc.*, the court found that in selling its stuffed bears with messages displayed on their chests, the defendant may have capitalized on the enhanced demand for stuffed bears arising from the 75th anniversary of the teddy bear, but it had not infringed on any trademark rights plaintiffs held in their "Care Bears" stuffed bears which also bore symbols on their chests.¹⁰²

V. PROTECTION OF CHARACTERS THROUGH RIGHTS OF PUBLICITY

Separate from, and in addition to, copyrights and trademark rights, the character persona adopted by an actor or other celebrity may be protectable by rights of publicity.¹⁰³ The right of publicity gives a celebrity portraying a character or other famous persona the right to control the exploitation of her "identity."¹⁰⁴ The "identity"

¹⁰⁰ *Id.* at 1277.

¹⁰¹ *Id.*

¹⁰² *Am. Greetings Corp. v. Easter Unlimited, Inc.*, 579 F. Supp. 607, 617 (S.D.N.Y. 1983).

¹⁰³ Although the case law typically involves the rights of publicity of famous people, non-celebrities hold this property right as well.

¹⁰⁴ *See Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 835 (6th Cir. 1983). Note that most state laws provide rights of publicity for living persons only. Some states do provide post-mortem rights of publicity. New York

of a character or other persona may be a name, image, signature, general appearance, or even voice. In *Wendt v. Host Int'l, Inc.*, the Ninth Circuit rejected the district court's ruling that plaintiffs' rights of publicity were not violated because no reasonable jury could find that three dimensional robots resembling television characters played by plaintiffs looked enough like plaintiffs to violate their rights of publicity.¹⁰⁵ The appeals court held that it was the physical likenesses of the actors that had value to the defendant, and regardless of plaintiff's lack of copyright ownership in the "Norm" and "Cliff" characters they played on television, a reasonable trier of fact could conclude that defendant's robots appropriated the actors' likenesses.¹⁰⁶ Accordingly, the use of likenesses of actors who portray copyrighted characters on television may violate their rights of publicity and constitute false endorsements if the resemblance is to the actors themselves, and not just characteristics unique to the copyrighted characters that they played.¹⁰⁷

A celebrity's identity can also include a signature saying,¹⁰⁸ his name or nickname,¹⁰⁹ or his car.¹¹⁰ These identity elements can be misappropriated by a commercial user even without the use of the celebrity's likeness.¹¹¹ An actor's claim that his right of publicity

does not recognize a post-mortem right of publicity, but California provides seventy years post-mortem right of publicity that is descendible and transferable. Compare N.Y. CIV. RIGHTS LAW §§ 50–51 (Consol. 2000) with CAL. CIV. CODE § 3344.1 (f)–(h) (2012).

¹⁰⁵ *Wendt v. Host Int'l, Inc.*, 125 F.3d 806, 810 (9th Cir. 1997).

¹⁰⁶ *Id.* at 811 (stating actors do not lose the right to control the commercial exploitation of their identities simply by portraying fictional characters).

¹⁰⁷ *Id.* at 812.

¹⁰⁸ See *Carson v. Here's Johnny*, 698 F.2d at 832, 836 ("Here's Johnny").

¹⁰⁹ See *Ali v. Playgirl, Inc.*, 447 F. Supp. 723, 726–27 (S.D.N.Y. 1978) ("the Greatest").

¹¹⁰ See *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821, 822, 827 (9th Cir. 1974) (image of famous race car driver's car with a solid red body and a distinctive narrow white pinstripe on the leading edge).

¹¹¹ See *infra* notes 142–44.

has been violated by the commercialization, without his consent, of the character he portrays will only lie if the accused character evokes the persona of the actor.¹¹² Where it is not an actual person's identity being exploited, but only the character he portrays, it is likely there will be no violation of a right of publicity.¹¹³

VI. LIMITATIONS ON EXCLUSIVE USE

Even if a person or entity owns copyrights and trademarks in a character, there are limitations on that person or entity's exclusive use of the character. Not all uses of existing characters, copyrightable elements, or character indicia infringe on any party's exclusive rights. Not only will the copyrightable elements of characters all eventually enter the public domain after a limited time, but all characters, even while still eligible for copyright protection or entitled to trademark protection or protectable under one's right of publicity, may be used in new works in certain circumstances without violating the rights of the character rights holder. These exceptions to an owner's monopoly over a character, discussed below, ensure a proper balance between the exclusive rights of character owners and the rights of the public and new creators to use existing characters.

A. Non-infringing Uses—Copyright

It is typically the challenge of an infringement action that determines whether a character is protected by copyright, and, if

¹¹² See *Landham v. Lewis Galoob Toys, Inc.*, 227 F.3d 619, 624–25 (6th Cir. 2000).

¹¹³ See *id.* at 625; accord *Burck v. Mars, Inc.*, 571 F. Supp. 2d 446, 454 (S.D.N.Y. 2008) (holding that while an M&M dressed as a naked cowboy in Times Square evokes the character of the Naked Cowboy portrayed by Burck it does not evoke Burck himself, and therefore does not violate New York's right of publicity law). *Contra White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1399 (9th Cir. 1992) (holding a robot that looks like Vanna White violated her rights of publicity).

so, whether copyright in that character has been infringed.¹¹⁴ The court may examine the similarities between the specific aspects of the characters in dispute,¹¹⁵ or between the totality of the characters' look and feel,¹¹⁶ or it may engage in combination of the foregoing.¹¹⁷ Because stock character traits are not copyrightable,¹¹⁸ some courts will distill the generic, unprotectable elements from a character before making a comparison to an allegedly infringing character.¹¹⁹

Under the “abstraction/filtration” test, even if a character is original, its unique features must outweigh its stock characteristics to withstand the scrutiny of a comparison of protectable elements in an infringement action.¹²⁰ Before the court compares the

¹¹⁴ See 1–2 NIMMER, *supra* note 42, at § 2.12 (explaining that the copyrightability of characters is “more properly framed as relating to the degree of substantial similarity required to constitute infringement rather than in terms of copyrightability *per se*”). *But see* Klinger v. Conan Doyle Estate Ltd., 988 F. Supp. 2d 879, 889 (N.D. Ill. 2013) *aff'd*, 755 F.3d 496 (7th Cir. 2013) (seeking declaratory judgment); Silverman v. CBS, Inc., 632 F. Supp. 1344 (S.D.N.Y. 1986), *vacated by* 870 F.2d 40 (2d Cir. 1989) (seeking declaratory judgment).

¹¹⁵ See Nichols v. Universal Pictures Corp., 45 F.2d 119 (2d Cir. 1930) (abstraction/filtration test).

¹¹⁶ See Sid & Marty Krofft, 562 F.2d 1157 at 1164 (extrinsic/intrinsic test).

¹¹⁷ See Hogan v. DC Comics, 48 F. Supp. 2d 298 at 309–10.

¹¹⁸ Walker v. Viacom Intern. Inc., 2008 WL 2050964, at *9 (N.D. Cal. 2008) (“the similarities between the two characters are limited to the stock elements used to humanize a sponge”).

¹¹⁹ This method employs the “abstraction/filtration” test famously set forth by Judge Hand in *Nichols*:

“Upon any work, and especially upon a play, a great number of patterns of increasing generality will fit equally well, as more and more of the incident is left out. The last may perhaps be no more than the most general statement of what the play is about, and at times might consist only of its title; but there is a point in this series of abstractions where they are no longer protected, since otherwise the playwright could prevent the use of his ideas”

Nichols, 45 F.2d at 121 (internal quotation omitted).

¹²⁰ See *id.* (discussing abstraction/filtration test).

substantial similarity between two characters, it must first remove from each character all unprotectable ideas and themes, so that it can compare only the protectable components of each character.¹²¹ Even if one party's character contains original stylistic choices, those characteristics must be enhanced significantly to warrant copyright protection after the unprotectable elements have been filtered.¹²² In *Mattel v. MGA*, the court analyzed the substantial similarity between defendants' Bratz dolls, and the doll sketches and sculptures owned by plaintiff.¹²³ The appeals court held that the district court's filtration of unprotectable elements was insufficient, and that it had erred by actually comparing similarities between non-protectable ideas.¹²⁴ Upon further filtering of themes and ideas, the appeals court held that no reasonable trier of fact could find the characters substantially similar if they were only looking at the protectable expression.¹²⁵

In determining whether one character infringes the copyright of another, some courts not only look at the specific traits of each character, but also consider the overall look and feel and the total expression of character elements such as background story,

¹²¹ See *Blehm v. Jacobs*, 702 F.3d 1193, 1200 (10th Cir. 2012); *Mattel Inc. v. MGA Entm't, Inc.*, 616 F.3d 904, 916 (9th Cir. 2010); *Original Appalachian Artworks, Inc. v. Toy Loft, Inc.*, 684 F.2d 821, 829 (11th Cir. 1982).

¹²² *Blehm*, 702 F.3d at 1200–01 (stick figures engaging in commonplace activities); *Scholastic, Inc. v. Spiers*, 28 F. Supp. 2d 862, 868 (S.D.N.Y. 1998) (skeleton wearing sneakers and a cap).

¹²³ *Mattel*, 616 F.3d 904.

¹²⁴ *Id.* at 916 (“[A plaintiff] can’t claim a monopoly over fashion dolls with a bratty look or attitude, or dolls sporting trendy clothing—these are unprotectable ideas.”); see also *Ideal Toy Corp. v. Kenner Prods. Div. of Gen. Mills Fun Grp. Inc.*, 443 F. Supp. 291, 304 (S.D.N.Y. 1977) (“The defendants have no more right to a monopoly in the theme of a black-robed, helmeted, evil figure in outer-space conflict with a humanoid and a smaller non-humanoid robot than Shakespeare would have had in the theme of a ‘riotous knight who kept wassail to the discomfort of the household’ . . .”) (quoting *Nichols*, 45 F.2d at 121).

¹²⁵ See *Mattel*, 616 F.3d at 917.

personality attributes, and interaction with other characters.¹²⁶ In *Sid & Marty Krofft Television Productions v. McDonalds Corp.*, the defendant attempted to dissect each trait—clothing, colors, mannerism, speech—comprising its character, and compare it to a corresponding trait in the plaintiff’s character, to conclude that because each individual trait was not exactly copied by its character, there was no infringement.¹²⁷ The court rejected this argument, taking the position that the characters must be compared with respect to the overall look and feel in the context of the works in which they appear.¹²⁸ In a case comparing the “Superman” character to a character appearing in the episodic television show, *The Greatest American Hero*, the *Warner Bros., Inc. v. American Broadcasting Cos.* court articulated its rationale for comparing the overall look and feel of the characters by distinguishing the analysis of literary characters from visual characters.¹²⁹ Unlike a literary work, it reasoned, a graphic or three-dimensional work “is created to be perceived as an entirety.”¹³⁰ What the character thinks, feels, says, and does, and the descriptions conveyed by the author through the comments of other characters in the work

¹²⁶ This method employs the “extrinsic/intrinsic test” set forth in *Sid & Marty Krofft Television Productions v. McDonald’s Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977) (“The test for similarity of *ideas* is still a factual one, to be decided by the trier of fact. . . . We shall call this the ‘extrinsic test.’ . . . The test to be applied in determining whether there is substantial similarity in *expressions* shall be labeled an intrinsic one depending on the response of the ordinary reasonable person.”) (emphasis added).

¹²⁷ *Id.* at 1166–67 (rebuking defendant’s analysis with “[w]e do not believe that the ordinary reasonable person, let alone a child, viewing these works will even notice that Pufnstuf is wearing a cummerbund while Mayor McCheese is wearing a diplomat’s sash.”).

¹²⁸ *See id.* at 1167. *But see* *Am. Greetings Corp. v. Easter Unlimited, Inc.*, 579 F. Supp. 607, 614 (S.D.N.Y. 1983) (holding that defendant’s bears do not appropriate the look and feel of plaintiff’s bears).

¹²⁹ *See Warner Bros., Inc. v. Am. Broad. Cos.*, 720 F.2d 231, 239–45 (2d Cir. 1983).

¹³⁰ *Id.* at 241.

episodically, fill out a viewer's understanding of the character.¹³¹ Noting that “[s]tirring one’s memory of a copyrighted character is not the same as appearing to be substantially similar to that character,” defendant’s “Hinkley” character, in the context of the television show in which he appeared, was so different from Superman that no infringement could be found.¹³² In *Hogan v. DC Comics*, the court agreed with the defendant’s position that “the works must share a similarity of expression, such as similarities of treatment, details, scenes, events and characterization, or a similarity in their ‘total concept and feel.’”¹³³ The court found that even though the main characters in both works had the same name, the similarities between these characters were mostly unprotectable ideas, such as their half-human/half-vampire genealogy, their struggles with good and evil, and their “Generation X” appearance.¹³⁴ Furthermore, the total concept and feel of the characters was not substantially similar, as they had very different interactions and personalities.¹³⁵ A character owner cannot stop all uses of traits that merely remind the public of the proprietary character; only those instances where the traits used are substantially similar to the protectable features of the proprietary character.

B. Non-infringing Uses—Trademark

Trademark infringement involves the use of mark in a way that is likely to confuse consumers as to the source or origin of a product.¹³⁶ Accordingly, where there is no substantial similarity

¹³¹ *Id.* at 241–42.

¹³² *Id.* at 243 (“The total perception of the Hinkley character is not substantially similar to that of Superman. On the contrary, it is profoundly different.”).

¹³³ *Hogan v. DC Comics*, 48 F. Supp. 2d 298, 309 (S.D.N.Y. 1999) (citations omitted).

¹³⁴ *Id.* at 310–12.

¹³⁵ *Id.* at 312–13.

¹³⁶ *See, e.g., Conan Props., Inc. v. Conans Pizza*, 752 F.2d 145, 148 (5th Cir. 1985); *Warner Bros., Inc. v. Am. Broad. Cos.*, 654 F.2d 204, 211 (2d. Cir.

between an allegedly infringing character and a plaintiff's character from a copyright perspective, it is likely that potential confusion under trademark law also will not be found.¹³⁷ In addition, trademarks can be used by others if the marks are not being used as a source identifier. In the long-running case of *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, the court ultimately held that the use of the "Betty Boop" name in connection with the sale of merchandise incorporating public domain images of that character did not constitute trademark infringement because the defendants' use was a non-trademark use.¹³⁸ Both the Ninth Circuit and the district court on remand held that the use of the name by the defendants was an aesthetically functional use, meaning that consumers bought the Betty Boop merchandise because of the decorative function of the "Betty Boop" name.¹³⁹ The district court reasoned that because the name was adapted from public domain posters in a way that made it a "decorative component and part of the aesthetic design of the defendant's goods," the purpose of the use of the name was to look aesthetically pleasing to potential customers, not to identify a source.¹⁴⁰ On remand, the district court

1981); *Wyatt Earp Enters., Inc. v. Sackman, Inc.*, 157 F. Supp. 621, 626 (S.D.N.Y. 1958).

¹³⁷ *Warner Bros. v. American Broadcasting Companies*, 720 F.2d 231, 246 (2d Cir. 1983) (noting "[o]ur discussion of the differences in 'total concept and feel' of the central characters of Superman and Hinkley applies to the issue of likelihood of confusion as well as to copyright infringement."); *American Greetings Corp. v. Easter Unlimited, Inc.*, 579 F. Supp. 607 (S.D.N.Y. 1983); *see also* *Harvey Cartoons v. Columbia Pictures Inc.*, 645 F. Supp. 1564 (S.D.N.Y. 1986) (finding look and feel of plaintiff's "Ghostly Trio" not infringed by defendant's "Ghostbusters" logo).

¹³⁸ *Fleischer Studios v. A.V.E.L.A.*, 925 F. Supp. 2d 1067, 1074 (C.D. Cal. 2012) ("Fleischer II").

¹³⁹ *Fleischer Studios v. A.V.E.L.A.*, 636 F.3d 1115 (9th Cir. 2011) ("Fleischer I"); *Fleischer II* at 1067.

¹⁴⁰ *Fleischer II*, 925 F. Supp. 2d at 1074. While *Fleischer I* was withdrawn and superseded by *Fleischer Studios v. A.V.E.L.A.*, 654 F.3d 958 (9th Cir. 2011) on remand, the district court in *Fleischer II* held defendants' use of the word mark was aesthetically functional.

also held in the alternative that the defendants' use of the "Betty Boop" name on their products was fair use, because it was not being used to identify the source of the goods, but merely to name the character.¹⁴¹ The court reasoned that the manner in which the defendants used the words was descriptive and therefore "otherwise than as a mark" pursuant to the Lanham Act.¹⁴²

To retain trademark rights in a character or its indicia, the owner of the trademark must continue to use that trademark in commerce. A character owner may therefore lose its exclusive trademark rights in a character or any of that character's indicia if it abandons the mark.¹⁴³ Pursuant to the Lanham Act, three years of non-use of a trademark with "intent not to resume" use is prima facie evidence of trademark abandonment.¹⁴⁴ The burden is on the alleged mark owner to produce evidence that it used the mark during that time period, or that it intends to resume use.¹⁴⁵ In *Crash Dummy Movie v. Mattel Inc.*, the court found that Mattel had met its burden of demonstrating its intent to use its "Crash Dummies" mark, despite three years of non-use, by providing evidence of discussions with a prospective distributor, ongoing research and development into future toys using the mark, and evidence of shipments of sample toys for research and development purposes.¹⁴⁶ In contrast, the former owners of the "Amos 'n' Andy" mark were unable to overcome the presumption of abandonment when they had not used the mark for over twenty years, and could not show any intent to revive its use.¹⁴⁷

¹⁴¹ *Fleischer II*, 925 F. Supp. 2d at 1076.

¹⁴² *Id.* (quoting 15 U.S.C. § 1115(b)(4)).

¹⁴³ See *Crash Dummy Movie, LLC v. Mattel, Inc.*, 601 F.3d 1387 (Fed. Cir. 2010); *Silverman v. CBS*, 870 F.2d 40 (2d Cir. 1989).

¹⁴⁴ 15 U.S.C. § 1127 (2012) ("Nonuse [of a trademark] for 3 consecutive years shall be prima facie evidence of abandonment.").

¹⁴⁵ *Id.*

¹⁴⁶ *Crash Dummy Movie*, 601 F.3d at 1391.

¹⁴⁷ *Silverman*, 870 F.2d at 48.

It is important to keep in mind, however, that regardless of whether confusion is likely, the owner of trademark elements of a character can separately maintain an action for trademark dilution. Trademark dilution can occur where a latter party's use of a character or character indicia is the same or so similar to a famous mark already in use by another party that its use would dilute or weaken the distinctive value of the senior user's mark.¹⁴⁸ For example, in the "Arthur the Aardvark" costume case, the plaintiff was entitled to the injunction because if the defendants used their confusingly similar "Arthur" costume in connection with "unwholesome causes, . . . the image sought by the plaintiffs for Arthur will be difficult to control and might easily become blurred or tarnished, resulting in a loss of credibility, public affection, and consumer interest."¹⁴⁹ In *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinemas, Ltd.*, the appeals court upheld the district court's injunction against defendant's use of the plaintiff's trademarked cheerleader outfit on actors in its "sexually depraved" film on the basis that such use tarnishes the Dallas Cowboys Cheerleaders brand.¹⁵⁰

C. Copyright Fair Use

The fair use doctrine, codified in the Copyright Act of 1976, significantly limits character owners' exclusive rights.¹⁵¹ A new creator's use of another's character in a new work will not constitute infringement if the use falls within the parameters of fair use. Fair use protects free speech by permitting use of another's copyrighted work for "purposes such as criticism, comment, news

¹⁴⁸ 15 U.S.C. § 1125(C) (2012); *see* *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894 (9th Cir. 2002).

¹⁴⁹ *See* *Brown v. It's Entm't, Inc.*, 34 F. Supp. 2d 854, 860 (E.D.N.Y. 1999).

¹⁵⁰ *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinemas, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979)

¹⁵¹ *See* 17 U.S.C. § 107 (1992); *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1262–63 (11th Cir. 2001).

reporting, teaching . . . , scholarship, or research.”¹⁵² Courts engage in a four-part inquiry to determine whether an unauthorized use of another’s copyrighted work is a “fair use” and therefore not an infringement.¹⁵³ In recent years, some courts have put less emphasis on the four-factor fair use analysis and focused instead on whether the unauthorized use amounts to a “transformative” use—that is, a use that gives new message or meaning to the work used.¹⁵⁴

A common scenario in which the court analyzes whether the defendant’s use of the plaintiff’s character is fair use occurs when the defendant claims it used plaintiff’s character for the purpose of parodying the character or the work in which it appeared.¹⁵⁵ If a defendant successfully parodies a character, the “purpose and character of the use” is transformative and weighs heavily in favor of fair use.¹⁵⁶ In the parody context, one issue is whether the defendant copied more than needed to “conjure up the original.”¹⁵⁷ The more famous the character is, the less that is needed.¹⁵⁸ Moreover, with visually represented characters, such as those in

¹⁵² 17 U.S.C. § 107 (1992).

¹⁵³ See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 577 (1994); *Salinger v. Colting*, 641 F. Supp. 2d 250, 255 (S.D.N.Y. 2009), *vacated*, 607 F.3d 68, 73-74 (2d Cir. 2010); *Suntrust Bank*, 268 F.3d at 1268.

¹⁵⁴ See, e.g., *Seltzer v. Green Day, Inc.*, 725 F.3d 1170, 1175–76 (9th Cir. 2013); *Cariou v. Prince*, 714 F.3d 694, 705–06 (2d Cir. 2013); *Monge v. Maya Magazines, Inc.*, 688 F.3d 1164, 1171–74 (9th Cir. 2012).

¹⁵⁵ 17 U.S.C. § 107; see, e.g., *Salinger*, 641 F. Supp. 2d at 256; *Suntrust Bank*, 268 F.3d at 1268; *Walt Disney Prods. v. Air Pirates*, 581 F.2d 751, 756 (9th Cir. 1978); see also *Lyons P’ship v. Giannoulas*, 179 F.3d 384, 388 (5th Cir. 1999) (holding defendant’s use of plaintiff’s “Barney the Dinosaur” character as a victim to its sports mascot was parody).

¹⁵⁶ See, e.g., *Salinger*, 641 F. Supp. 2d at 256; *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 800–01 (9th Cir. 2003); *Suntrust Bank*, 268 F.3d at 1269.

¹⁵⁷ *Walt Disney Prods.*, 581 F.2d at 757.

¹⁵⁸ See *id.* (recognizing that very little of the Mickey Mouse or Donald Duck characters need be used in the parodic work in order to put those characters in the viewer’s mind).

comic books, very little is needed for an effective parody.¹⁵⁹ Accordingly, in *Walt Disney Prods. v. Air Pirates*, defendant's near exact replications of "Mickey Mouse" and "Donald Duck" constituted too much of a taking to warrant a fair use finding.¹⁶⁰

In *Salinger v. Colting*, the defendant argued that his appropriation of plaintiff's Holden Caulfield character was fair use because his book was a parody of *The Catcher in the Rye*.¹⁶¹ The court reasoned that merely rehashing the themes of plaintiff's book with an aged version of the book's protagonist was insufficient to demonstrate that the defendant had any intention to comment on or criticize that book or that character.¹⁶² Recognizing that a parodist must appropriate some amount of the existing work in order to comment upon it, the court warned: "If . . . the commentary has no critical bearing on the substance or style of the original composition, which the alleged infringer merely uses to get attention or to avoid the drudgery in working up something fresh, the claim to fairness in borrowing from another's work diminishes accordingly (if it does not vanish). . . ."¹⁶³ In *United Feature v.*

¹⁵⁹ See *id.*; see also *Lucasfilm Ltd. v. Media Mkt. Grp., Ltd.*, 182 F. Supp. 2d 897, 900–01 (N.D. Cal. 2002) (denying preliminary injunction against defendant's pornographic film parodying *Star Wars*).

¹⁶⁰ *Walt Disney Prods.*, 581 F.2d at 757; see also *Walt Disney Prods. v. Air Pirates*, 345 F. Supp. 108, 115 (N.D. Cal. 1972) ("It can scarcely be maintained that there is no other means available to defendants to convey the message they have, nor is it even clear that other means are not available within the chosen genre of comics and cartoons.").

¹⁶¹ See *Salinger*, 641 F. Supp. 2d at 258 (S.D.N.Y. 2009), *vacated*, 607 F.3d at 73 (2d Cir. 2010). The court did note that while a work need not be labeled a parody to be treated as one, a defendant cannot "post hoc" seek to characterize his potentially infringing work as a parody to avoid liability. *Id.* at 260 (citing *Campbell v. Acuff-Rose*, 510 U.S. 569, 600 (1994)). There was evidence in this case that prior to the commencement of the infringement action against him, the defendant author had characterized his book as a sequel or tribute to *The Catcher in the Rye*. *Salinger*, 641 F. Supp. 2d at 260 n.3.

¹⁶² *Id.* at 260.

¹⁶³ *Id.* at 257 (quoting *Campbell*, 510 U.S. at 581).

Koons, the court held that Jeff Koons' appropriation of plaintiff's "Odie" character was infringing.¹⁶⁴ There the court reasoned that defendant's sculpture of "Odie" (from "Garfield") was not an effective parody because Koons admittedly selected the "Odie" character arbitrarily, and not with the purpose of commenting on the character itself—demonstrating that at best, the work was a "parody of society at large . . ."¹⁶⁵ Moreover, because the defendant copied plaintiff's "Odie" character in its entirety and nearly identically, and he was found to have no motivation in creating the Odie sculpture other than to sell it, the court rejected Koons' fair use defense.¹⁶⁶

In contrast to *Salinger v. Colting*, the court in *Suntrust Bank v. Houghton Mifflin Co.* held that the author of a book entitled *The Wind Done Gone* made fair use of the classic novel, *Gone with the Wind*.¹⁶⁷ The defendant, publisher of *The Wind Done Gone*, argued that it should not be enjoined from publishing the book because the book was a fair use parody criticizing slavery, the Civil War-era south, and the characters in *Gone with the Wind*.¹⁶⁸ The court analyzed the manner in which the author of *The Wind Done Gone* used the characters from *Gone with the Wind* and concluded that she made fair use of those characters.¹⁶⁹ Applying the four factors to the facts at bar, the court found: (1) the use was commercial in the sense that it was written for-profit, but because it was highly transformative, factor one weighed in favor of fair use;¹⁷⁰ (2) *Gone*

¹⁶⁴ *United Feature Syndicate v. Koons*, 817 F. Supp. 370, 384–85 (S.D.N.Y. 1993).

¹⁶⁵ *Id.* at 383–84.

¹⁶⁶ *See id.* at 384.

¹⁶⁷ *Suntrust Bank v. Houghton Mifflin Co.*, 628 F.3d 1257 (11th Cir. 2001).

¹⁶⁸ *Id.*

¹⁶⁹ *Id.* at 1267–76 (11th Cir. 2001). *But see* *Toho Co., Ltd. v. William Morrow & Co., Inc.*, 33 F. Supp. 2d 1206, 1216–18 (C.D. Cal. 1998) (applying the four factor test and concluding defendant's use of stills of plaintiff's copyrighted Godzilla films in his compendium not fair use).

¹⁷⁰ *Suntrust Bank*, 268 F.3d at 1269–71.

with the Wind was entitled to “the greatest degree of copyright protection” as an original work of fiction;¹⁷¹ (3) the defendant took a substantial portion of plaintiff’s characters but that alone was not dispositive;¹⁷² and (4) the parodic nature of the defendant’s work indicated that it would not act as a substitute for the plaintiff’s work.¹⁷³ For these reasons the court held that *The Wind Done Gone* did not infringe *Gone with the Wind*.

Another fair use of a proprietary character was found in the case of *Mattel v. Walking Mountain*.¹⁷⁴ There, the defendant photographer created and photographed scenes comprised of “carefully positioned, nude, and sometimes frazzled looking Barbies in often ridiculous and apparently dangerous situations.”¹⁷⁵ Mattel sued him for, *inter alia*, copyright infringement. The photographer argued that the purpose of his photographs was to criticize society’s objectification of women, which was exemplified by the popularity of the Barbie doll.¹⁷⁶ After addressing each of the fair use factors, the court concluded that the defendant’s use of the Barbie character was fair use because: “(1) his use was parody meant to criticize Barbie, (2) he only copied what was necessary for his purpose, and (3) his photographs could not affect the market for Mattel’s products. . . .”¹⁷⁷ Even the use of famous proprietary characters in their entirety will be permissible where the use is fair pursuant to the Copyright Act.

D. Literary Works in the Public Domain

But characters will not remain proprietary forever. Characters, like all copyrighted works, will be entitled to copyright protection

¹⁷¹ *Id.* at 1271.

¹⁷² *Id.* at 1272–74.

¹⁷³ *Id.* at 1275–76.

¹⁷⁴ *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 806 (9th Cir. 2003).

¹⁷⁵ *Id.* at 802.

¹⁷⁶ *See id.* at 796.

¹⁷⁷ *Id.* at 800.

only for the applicable term of copyright. Once the copyright in the work in which a character appears expires—whether it be a book, a play, a radio program, a movie or otherwise—that character, as depicted in that work, enters the public domain. The extent to which later published works featuring the same character include further protectable development of the character will determine whether and to what extent the owner retains exclusive right to use the character. Where a character appears in a series of works over time, inevitably, at some point, the earliest of the works will enter the public domain while others remain protected by copyright. In this situation, a character can exist in two or more incarnations, some of which may enter the public domain, while others remain protected. Courts have held that where an author has used a character in a series of works, and any of those have entered the public domain, anyone can use the story and character elements from the works that have entered the public domain.¹⁷⁸

In a case involving characters appearing in a radio series, *Silverman v. CBS*, the plaintiff sought a declaratory judgment that the “Amos ‘n’ Andy” characters were in the public domain so he could use them in his original musical.¹⁷⁹ The court had to consider the many appearances of “Amos ‘n’ Andy” over time, first via

¹⁷⁸ *Klinger v. Conan Doyle Estate, Ltd.*, 988 F. Supp. 2d 879, 889 (N.D. Ill. 2013), *aff’d*, 755 F.3d 496 (7th Cir. 2013); *see Silverman v. CBS Inc.*, 870 F.2d 40 (2d Cir. 1989); *Pannonia Farms, Inc. v. USA Cable*, No. 03 Civ. 7841 (NRB), 2004 WL 1276842 (S.D.N.Y. June 8, 2004), *aff’d in part*, 426 F.3d 650 (2d Cir. 2005); *see also Siegel v. Warner Bros Entm’t, Inc.*, 690 F. Supp. 2d 1048, 1059 (“Subsequent works in a series (or sequels) are in a sense derivative works, while the characters which appear throughout the series are a part of the underlying [initial] work upon which the later works are based So copyright in a particular work in a series will not protect the character as contained in such series if the work in the series in which the character first appeared has entered the public domain[; instead,] protection for the character extends only to those . . . elements added in [the sequel].”) (quoting 1 NIMMER, *supra* note 42, at § 2.12 at 2–178.31 to –178.32).

¹⁷⁹ *Silverman*, 870 F.2d at 42 (2d Cir. 1989).

radio programs, and later on television.¹⁸⁰ Because the facts showed that the pre-1948 radio scripts—in which the characters first appeared and were sufficiently delineated—had entered the public domain, the court found that the “Amos ‘n’ Andy” characters as they appeared in those pre-1948 scripts were in the public domain.¹⁸¹ However, CBS still owned the increments of original expression that appeared in the later, derivative works, even if some of that original expression further developed the characters.¹⁸² It was this later-created expression that Silverman was precluded from using.¹⁸³ Silverman was therefore allowed to use the “Amos ‘n’ Andy” characters, so long as they didn’t display any traits first appearing after 1948.¹⁸⁴

Klinger v. Conan Doyle Estate was another declaratory judgment action by a plaintiff who desired to use characters purportedly owned by the defendants in his original work.¹⁸⁵ Sherlock Holmes and John Watson appeared in four novels and fifty-six stories, only the last ten of which remained protected by copyright at the time of the litigation.¹⁸⁶ The author’s estate argued that because the characters were developed throughout the entire canon, including the last ten stories still protected by copyright, the characters remained protected by the estate’s copyrights in those last ten stories.¹⁸⁷ Both the district court and the appeals court rejected that argument, holding that the characters were delineated upon their first appearance in the first novel, and that all subsequent novels and stories containing the characters were

¹⁸⁰ *See id.* at 43.

¹⁸¹ *Id.* at 50.

¹⁸² *See id.*

¹⁸³ *Id.*

¹⁸⁴ *Id.*

¹⁸⁵ *See Klinger v. Conan Doyle Estate, Ltd.*, 988 F. Supp. 2d 879, 882 (N.D. Ill. 2013).

¹⁸⁶ *See id.* at 892.

¹⁸⁷ *Id.* at 888.

derivative works.¹⁸⁸ Applying the “increments of expression” doctrine to the derivative works, the Seventh Circuit did find, however, that even though the characters themselves were in the public domain, the estate still owned the original expression added to the characters in those last ten stories, precluding Klinger’s use of those elements.¹⁸⁹

Thus, new creators can take characters from the public domain, add new creative elements to those characters, and in effect bring their versions of those characters to copyright life—as Universal Pictures did with Mary Shelley’s “Frankenstein” and Bram Stoker’s “Dracula,” and Disney did with the Brothers’ Grimm “Snow White,” “Cinderella,” and “Rapunzel.”¹⁹⁰ The new creative elements will be protected by copyright as long as they do not infringe upon any creative elements that remain protected by copyright by a prior user.¹⁹¹

E. Visual Images in the Public Domain

Another situation in which a character owner’s exclusive rights may be tempered arises where a work that contains visual images of that character has entered the public domain. In *Warner Brothers v. X one X Productions*, the plaintiffs challenged the defendant’s right to create and sell merchandise derived from publicity shots and posters from the *The Wizard of Oz* and *Gone*

¹⁸⁸ See *Klinger v. Conan Doyle Estate, Ltd.*, 755 F.3d 496, 503 (7th Cir. 2014) (“From the outset of the series of Arthur Conan Doyle stories and novels that began in 1887 Holmes and Watson were distinctive characters and therefore copyrightable.”).

¹⁸⁹ *Id.* at 501.

¹⁹⁰ See *M.H. Segan Ltd. Partnership v. Hasbro, Inc.*, 924 F. Supp. 512 (S.D.N.Y. 1996) (accepting as true that MCA/Universal Merchandising, Inc. owns the copyright in the visual image of the Frankenstein character); see also *Sleeping Beauty*, *The Little Mermaid*, *Aladdin*, and *Pinocchio*.

¹⁹¹ *Warner Bros. Entm’t, Inc. v. X One X Prods.*, 644 F.3d 584, 586 (8th Cir. 2011). (“[T]his freedom to make new works based on public domain materials ends where the resulting derivative work comes into conflict with a valid copyright.”).

with the Wind films.¹⁹² The defendant argued that because its merchandise used only public domain images, as opposed to stills from the actual films, it was not infringing on the plaintiff's copyrights in the films.¹⁹³ The posters and still images were in the public domain because they were published without complying with then-required copyright formalities such as including copyright notice or filing copyright renewals.¹⁹⁴ Analyzing the attributes of the characters in the public domain publicity materials, and those embodied by the films, the court reasoned that because the publicity materials "reveal[ed] nothing of each film character's signature traits or mannerisms,"¹⁹⁵ and because "the characters' visual appearances in the publicity materials for *The Wizard of Oz* do not present the requisite consistency to establish any 'copyrightable elements' of the film characters' visual appearances," even if those images were in the public domain, the characters in the films were not.¹⁹⁶ Therefore, the defendant was only permitted to faithfully reproduce the public domain images on merchandise because those particular images, in contrast to the characters depicted in those images, were in the public domain. The defendant was precluded from extracting the images of the characters from the public domain works in which they appeared and creating new composite works featuring the characters and

¹⁹² *Id.* at 584.

¹⁹³ *See id.* at 596.

¹⁹⁴ *See id.* at 597–98.

¹⁹⁵ *Id.* at 599.

¹⁹⁶ *Id.* at 602 ("[A]lthough the derivative work may enter the public domain, the matter contained therein which derives from a work still covered by statutory copyright is not dedicated to the public. The established doctrine prevents unauthorized copying or other infringing use of the underlying work or any part of that work contained in the derivative product so long as the underlying work itself remains copyrighted.") (quoting *Russell v. Price*, 612 F.2d 1123, 1128 (9th Cir. 1979)); *see also* *Fleischer Studios, Inc. v. A.V.E.L.A.*, 772 F. Supp. 2d 1135, 1148 (C.D. Cal. 2008) ("[E]ven if the poster did fall into the public domain as a result of the lack of a copyright notice, the original Betty Boop character that is a component part of the pre-July-1931 cartoon films did not.").

their famous maxims (such as “There’s no place like home”), because such new composite works would “evoke the film character in a way the individual items of public domain material did not,” even if each composite work was “composed entirely of faithful extracts from public domain materials.”¹⁹⁷ The combination of the images and aphorisms, the court held, added the increments of expression required to infringe upon the more developed film characters.¹⁹⁸

In contrast to the above-cited cases in which the seminal works embodying the character remained protected by copyright, the purported owners of the “Fatso” the ghost character (a friend of “Casper the Friendly Ghost”) were unable to sustain a copyright infringement claim against the producers of the *Ghostbusters* film for use of a ghost image in their marketing, because the early “Casper” cartoons in which “Fatso” appeared had entered the public domain.¹⁹⁹ Because “Fatso” appeared in later “Casper” episodes identical to the way he appeared in public domain episodes, he had entered the public domain when those early episodes did.²⁰⁰

The fact that the copyright in a visual image of character has fallen into the public domain does not mean that the character, or elements of the character, may not still function as a trademark.²⁰¹ For instance, the plaintiff in *Frederick Warne & Co. v. Book Sales, Inc.* conceded that the pictures on the covers of the books that were the subject of the litigation were in the public domain, but argued that those same illustrations had acquired secondary meaning and

¹⁹⁷ *Warner Bros.*, 644 F.3d at 602–03.

¹⁹⁸ *Id.* at 600.

¹⁹⁹ *Harvey Cartoons v. Columbia Pictures Indus., Inc.*, 645 F. Supp. 1564, 1570 (S.D.N.Y. 1986).

²⁰⁰ *See id.*

²⁰¹ *See, e.g., Tri-star Pictures, Inc. v. Del Taco, Inc.*, 1999 WL 33260839 (C.D. Cal. Aug. 31, 1999); *Frederick Warne & Co. v. Book Sales, Inc.*, 481 F. Supp. 1191, 1196 (S.D.N.Y. 1979).

functioned as trademarks.²⁰² Noting that copyright law and trademark law were not mutually exclusive means to protect a character, the court in *Warne* held that even if the illustrations had fallen into the public domain, an illustration could be protected by trademark law “so long as it is shown to have acquired independent trademark significance, identifying in some way the source or sponsorship of the goods.”²⁰³ It is on this same basis that the producer of the 1998 *The Mask of Zorro* movie was able to assert its trademark rights in the Zorro character to prevent a restaurant chain from adopting Zorro indicia in an advertising campaign.²⁰⁴

F. The First Amendment

Free speech rights will allow the use of another’s trademark in the title of a creative work where the mark is used for creative expression and not primarily for a commercial purpose.²⁰⁵ In a case whose rule has been adopted by the Ninth Circuit and applied to character cases, the Second Circuit in *Rogers v. Grimaldi* held there was no Lanham Act violation for false designation of origin where the defendant filmmaker used the famous plaintiff’s name in the title of his film, *Ginger and Fred*.²⁰⁶ With respect to this type of use of a mark or persona, the defendant’s freedom of expression outweighed the plaintiff’s concern that the title would mislead consumers.²⁰⁷ Adopting the Second Circuit’s “Rogers test” in

²⁰² See *Frederick*, 481 F. Supp. at 1193.

²⁰³ *Id.* at 1196. In this case, however, plaintiff had not provided sufficient evidence of this claim to be granted summary judgment of the issue. *Id.* at 1198.

²⁰⁴ See *Tri-star*, at *3.

²⁰⁵ *Rogers v. Grimaldi*, 875 F.2d 994, 997 (2d Cir. 1989). See also *Silverman*, 870 F.2d at 48; *Toho Co., Ltd. v. William Morrow & Co.* 33 F. Supp. 2d 1206, 1212 (C.D. Cal. 1998) (finding defendant’s use of “Godzilla” as the title of his books about the character likely to confuse consumers as to source of book).

²⁰⁶ See *Rogers*, 875 F.2d at 997–1002.

²⁰⁷ See *id.* at 1001. See also *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002) (“Limited to this core purpose—avoiding confusion in

Mattel v. MCA, Judge Kozinski of the Ninth Circuit upheld the district court's ruling that the band Aqua's song "Barbie Girl" did not infringe Mattel's trademark rights in the Barbie name.²⁰⁸ Cautioning that "the trademark owner does not have the right to control public discourse whenever the public imbues his mark with a meaning beyond its source-identifying function,"²⁰⁹ the court held that using the Barbie trademark in a song making fun of the values Barbie represents was artistically relevant and did not suggest that the song was sponsored by Mattel.²¹⁰ When Mattel returned to the same court shortly thereafter in *Mattel v. Walking Mountain* for the same First Amendment reasons, the court easily found that the defendant's use of the Barbie name in the titles of his photographs depicting Barbies was artistic expression accurately describing the subject of the photos and not suggesting that Mattel was in any way connected to the photographs.²¹¹

Similarly, claims for violations of rights of publicity may be rejected on First Amendment grounds. For example, the "transformative test" articulated in *Comedy III Productions v. Gary Saderup*, sets forth the rule that where a depiction of a celebrity is significantly transformed by the addition of increments of expression to his mere likeness, no violation of his right to publicity will occur, and the user's First Amendment rights will be maintained.²¹² In that case, the court averred that whether the use

the marketplace—a trademark owner's property rights play well with the First Amendment.").

²⁰⁸ 296 F.3d at 909 ("I'm a Barbie girl, in my Barbie world; Life in plastic, it's fantastic.").

²⁰⁹ *Id.* at 900.

²¹⁰ *Id.* at 902.

²¹¹ 353 F.3d. 792, 807 (9th Cir. 2003).

²¹² 21 P.3d 797, 810 (Cal. 2001); see *No Doubt v. Activision Publishing, Inc.*, 98 U.S.P.Q.2d 1728, 1740 (Cal. Ct. App. 2011) (holding Avatars representing the band No Doubt in Activision's game did not meet the transformative-use test because the avatars were simply "precise computer-generated reproductions of the band members" which did not "meld with the

of celebrities' likenesses (in this case, the "Three Stooges" on t-shirts) violates their rights of publicity or is protected First Amendment expression depends upon "whether the celebrities' likenesses are used as one of the 'raw materials' from which an original work is synthesized, or whether the depiction or imitation of the celebrity is the very sum and substance of the work in question."²¹³ The analysis thus turns on whether a product containing a celebrity's likeness is so transformed that it has become primarily the defendant's own expression rather than the celebrity's likeness.

Accordingly, the court in *Edgar Winter v. DC Comics* held that use of celebrities' likenesses as some of the raw materials comprising a comic book story does not violate the celebrities' rights of publicity where the depictions are transformative—that is, where the depictions contain significant expressive content other than the celebrities' mere likenesses.²¹⁴ The expressive content in that case included use of the likenesses in a larger story, which itself was quite expressive, as well as distortion, lampooning, parody, and caricature.²¹⁵

Rejecting the "transformative test," the court in *Doe v. MacFarlane* adopted a "predominant use test" when balancing a celebrity's right of publicity against freedom of speech rights.²¹⁶ Notwithstanding the expressiveness of the use of the identity, if a product is sold that predominantly exploits the commercial value of an individual's identity, that product should be held to violate the right of publicity and not be protected by the First Amendment, even if there is some "expressive" content in it that might qualify

other elements of the game to become . . . Activision's own artistic expression.").

²¹³ *Comedy III Prods.*, 21 P.3d at 809.

²¹⁴ 69 P.3d 473, 479 (Cal. 2003).

²¹⁵ *See id.*

²¹⁶ 207 S.W.3d 52, 56 (Mo. Ct. App. 2006).

as “speech.”²¹⁷ If, on the other hand, the predominant purpose of the product is to make an expressive comment on or about a celebrity, the expressive additions could be given greater weight.²¹⁸ In *Doe v. MacFarlane*, the court held that the use of the name “Tony Twist,” a former professional hockey player, as the name of a mobster in a comic book series violated the player’s right of publicity because the evidence demonstrated that the predominant use of Twist’s name was to sell comic books and appeal to hockey fans.²¹⁹

VII. CONCLUSION

Trademark, copyright, and rights of publicity laws encourage authors to conceive and develop original fictional characters and offer them to the public to enjoy in various forms of media and merchandise. The laws also protect the public and other authors by denying the creators and owners of original characters the ability to maintain monopolies over their characters by limiting the scope of exclusive protection available to characters.

Understanding what makes characters protectable will provide an author the opportunity to conceive and develop characters in a way that will enhance their protectability. Fully fleshing out one’s characters by including distinctive tangible and intangible traits—including physical appearance; clothing or (if applicable) costume; personality traits; powers; habits; manner of speech; origin and background story; interaction and relationships with other characters; and settings in which the character exists—will all increase the scope of protection afforded to such character under copyright whether in literary or visual imagery or both.

²¹⁷ *Id.* at 57 (quoting *Doe v. TCI Cablevision*, 110 S.W.3d 363, 374 (Mo. 2003)).

²¹⁸ *Id.*

²¹⁹ *See id.* at 61.

Giving a character a distinctive and memorable name and using that name in or as a series title and otherwise for the branding of publications, media productions, and merchandise will help the character creator establish trademark rights in the character name. This also applies to symbols, emblems, slogans, and visual imagery of or elements associated with the character. To establish and maintain trademark rights in elements associated with one's character, it is important to use those elements in a consistent manner. Character creators seeking to further their rights in their characters may secure trademark registrations and domain names based on their characters' names, and terms or slogans associated with their characters. But while trademark law rewards the entity that expended the time and money to develop a character so that the consuming public identifies it with that entity, those exclusive rights are subject to limitations. Character marks must be consistently used in commerce, and trademark rights cannot be used to prevent others from using characters that have fallen into the public domain, so long as the latter users of such characters use them in a manner that will not confuse the public as to the source of the latter users' works.

Notwithstanding the effort devoted to creating a protectable character, authors and their successors in interest should understand, however, that eventually the copyright in an original character will expire, thereby dedicating even a highly delineated and unique character to the public after some period of time. A character owner can keep a character fresh and alive by adding updates to keep the character current with the time, adding new traits, modifying the character's appearance, and introducing new supporting characters and elements. So, while the earliest versions of a character may enter the public domain, the original character owner or successor thereto can maintain itself in the public eye as the source of the official version of character.

Allowing creators and their assignees to exploit their characters through copyright, trademark, and right of publicity on an exclusive basis—subject to certain limited exceptions—encourages

authors, artists, and performers to add to the culture that benefits all of society. By giving character owners confidence that others cannot unfairly trade off their original work and the good will they have generated in connection with their characters, character owners will be encouraged to spend time and money developing the public's favorite characters. If so incentivized, the owners will invest in producing more entertainment products containing those characters for the public to enjoy. Exclusive rights in characters also benefit the public in that encouraging owners to produce more character entertainment products ensures that the owners will maintain the quality of the entertainment product, continuing to meet consumers' high expectations for the products.

The exceptions to exclusive use discussed above put reasonable limitations on a character owner's monopoly over a piece of our collective culture. Trademark law will only protect a character for so long as the owner is using the mark in commerce. Therefore, in order to maintain such exclusivity, owners must provide the public with entertainment products containing those characters. If an owner does abandon its trademark rights in a character, then any member of the public has a right to use whatever previously trademark-protected elements of the character they desire to keep the character alive. When the copyright in a character expires, any member of the public has the right to create original works using that character. If such a second comer desires to establish exclusive rights in a new version of the character, the second comer must add original creativity to the public domain character. This, in turn, will benefit the public by advancing the number and variety of works generated for public enjoyment. In addition, the First Amendment keeps character owners from extending their monopolies unconstitutionally by restricting owners from controlling public discourse, even when their proprietary characters are used. A robust public discourse is also encouraged by the allowance for use of protected characters for purposes such as parody and criticism. In these ways, the law endeavors to balance the exclusivity that owners deserve for adding desirable

[6:49 2015]

AN OVERVIEW OF LEGAL PROTECTION
FOR FICTIONAL CHARACTERS

95

characters to our shared culture, with the societal goals of encouraging the dissemination of creative works and public discourse by using culturally relevant characters in new works.