

I. Introduction

Usually a fictional character is protected by copyright law within the context of the work in which the character appears. In these cases infringement is found if there is access to the copyrighted work and there is substantial similarity between the copyrighted work and the allegedly infringing work.¹ Access is usually easy to prove if the original work is widely available. Substantial similarity, however, is much more difficult to determine. One limiting principle is that copyright protection extends only to the expression of an idea and not to the idea itself.²

In determining whether there is substantial similarity between the expression of ideas courts have sometimes used the “extrinsic” test where the plot, characters, setting, dialogue and other details of the two works are compared.³ Other times courts have turned to a more “intrinsic” test where “[t]he two works involved...[are] considered and tested, not hypercritically or with meticulous scrutiny, but by the observations and impressions of the average reasonable reader and spectator.”⁴ Another test, articulated by Judge Hand, is the abstraction test where each work can be made more and more general as details are left out so that there will be “a point in this series of abstractions where they are no longer protected, since otherwise the playwright could prevent the use of his ‘ideas’, to which, apart from their expression, his property is never extended.”⁵

As is evident by the number of different tests used it is often difficult to determine if an allegedly infringing work has taken so much of the expression of the original to satisfy the

¹ Sid & Marty Krofft Television Production, Inc. v. McDonald’s Corp., 562 F.2d 1157 (9th Cir. 1977).

² Mazer v. Stein, 347 U.S. 201, 217-218 (1954); Baker v. Selden, 101 U.S. 99, 102-103 (1879).

³ Twentieth Century Fox Film Corp. v. Stonesifer, 140 F.2d 579, 582 (9th Cir. 1944).

⁴ *Id.*

⁵ Nichols v. Universal Pictures Corporation, 45 F.2d 119, 121 (2nd Cir. 1930).

“substantially similar” standard of copyright infringement. The problem is further complicated when we consider whether literary characters deserve separate and independent protection.

The problem of separate protection for literary characters arises when the character is removed from the original work so that the character is now leading a new and independent life completely separate from the original work. Characters that are capable of leading independent lives are especially memorable characters that stay in a reader’s imagination long after the original storyline is forgotten. What happens if somebody wants to write a new adventure for Superman, Tarzan, or Sherlock Holmes? Now that the character is separated from his original copyrighted work it becomes difficult to decide what sort of legal protection he deserves.

A few years ago the topic of character protection arose when the estate of Vladimir Nabakov sued Pia Pera, the author of *Lo’s Diary*.⁶ *Lo’s Diary* makes extensive use of Lolita and Humbert, the main characters of Nabakov’s 1955 copyrighted novel, *Lolita*.⁷ *Lo’s Diary* tells the story from Lolita’s point of view.⁸ The parties ultimately settled, presumably in part because of the uncertainty regarding protection of literary characters. *Lo’s Diary* is not the only work where authors have borrowed characters from other novels. A novel by Valerie Martin retells the story of Dr. Jeckyl and Mr. Hyde from the point of view of Mary Reilly, the doctor’s maid.⁹ Tom Stoppard used two minor characters from Shakespeare’s *Hamlet* when he wrote *Rosencrantz and Guildenstern are Dead*.¹⁰ A novel, *Wild Sargasso Sea*, was written about Mrs. Rochester, the mysterious crazed first wife from the novel *Jane Eyre*.¹¹

On one hand, characters could be copyrighted separately so that the same character or a substantially similar character cannot appear in a new work without the author’s permission.

⁶ Ralph Blumenthal, *Nabokov Son Files Suit To Block a Retold ‘Lolita’*, N.Y. TIMES, October 10, 1998.

⁷ *Id.*

⁸ *Id.*

⁹ VALERIE MARTIN, *MARY REILLY* (1990).

¹⁰ TOM STOPPARD, *ROSENCRANTZ AND GUILDENSTERN ARE DEAD* (1967).

¹¹ JEAN RHYS, *WILD SARGASSO SEA* (1966).

This approach will clearly limit the building blocks or raw material that other authors have to work with in a way that would likely hinder creativity. On the other hand, characters could be denied copyright protection altogether, apart from that granted to the original work. In this case an author can slave for months developing a really memorable character that will bring joy to generations of readers only to have that character copied and placed in any story the copier pleases. Such a treatment may prove to offer too little incentive for the original author to exert the amount of effort needed in order to create extraordinary characters.

It becomes clear that there is a need for balancing between giving the author enough incentive to keep creating remarkable characters and leaving enough raw materials in the public domain for new authors to build on. Courts have tried to come up with tests for when a character deserves independent copyright protection keeping in mind the need for balancing, but there is still much uncertainty when it comes to protection of literary characters.

Part II of this paper will offer a discussion of the characteristics of literary characters which make them especially difficult to protect. Part III will describe historical treatment of literary characters and the two main tests used to determine if they deserve independent protection. Part IV will demonstrate that the two tests currently used are not an adequate tool for determining when protection applies. The possibility of using trademark and unfair competition laws to offer partial protection to fictional characters will be explored in part V. Part VI will present an argument that literary characters do not need independent protection because they are already sufficiently protected by copyright in the original work when supplemented by protection offered from trademark and unfair competition laws. Also Part VI will argue that the tests created for protection of fictional characters do not add anything different or valuable to the determination of when characters should be protected that cannot already be found in the substantial similarity test. Part VII will offer a conclusion.

II. Why Are Literary Characters So Difficult To Protect?

Literary characters are especially hard to protect because they have a “tangible existence only in specific words, pictures, and sounds created by [their] author.”¹² Each reader uses these descriptions to come up with a different mental image of the character. Different readers will interpret the author’s description of a character differently; they will fill in the gaps left by the author in various ways and will choose to judge and presume things about the character based on their own individual set of values. “An independent character, therefore, is difficult to define or grasp clearly, since no two minds will conceive of it in precisely the same way.”¹³

Defining a character is also difficult because authors, or good authors at least, do not simply list all of the characteristics of their fictional characters at the beginning of a work. A character develops throughout the book, through interactions with others, as well as through accomplishments, failures and reactions to difficult situations. Because descriptions of characters are often scattered throughout a work and continuously changing and building, it is very difficult to grasp and clearly define who a character is.

Protecting a literary character independently poses a more difficult problem than protecting a literary work as a whole. While neither is easy, at least a work has a beginning, middle and end that can be compared to another work. Furthermore, a work has a plot that follows a specific sequence, a set of characters, a setting, and a mood: all elements that can be compared. The description of a character, on the other hand, is scattered throughout the book and the mental image of the character is continuously changing and being developed in the reader’s mind as the story unfolds. So when it comes time to compare two characters to see if one substantially infringes another, it is difficult to put into words exactly what you are trying to

¹² Leslie A. Kurtz, *The Independent Legal Lives Of Fictional Characters*, 1986 WIS. L. REV. 429, 431 (1986).

¹³ *Id.*

protect (the mental image of this character). When one cannot clearly define or limit a character a comparison with a potentially infringing character is especially difficult.

Graphic characters, on the other hand, do not suffer from the same elusiveness of other non-graphically depicted literary characters and have therefore received different treatment. A long line of cases has found that cartoon characters are protected by copyright even when elements of plot are not copied.¹⁴ Graphic characters are not treated differently because they are more deserving of protection, but rather because “it is far simpler to make visual comparisons than to compare abstractions.”¹⁵

III. Historical Treatment of Literary Characters

Despite the difficulty inherent in providing independent legal protection for literary characters courts have articulated two main tests for when a character deserves independent copyright protection. The first test was termed the “distinctively delineated” test and the second test has been referred to as the “story being told” test.

The possibility of protecting literary characters seems to have had its origin in *Nichols v. Universal Pictures Corporation*.¹⁶ The plaintiff was the author of the play *Abie's Irish Rose* about a Jewish boy marrying an Irish-Catholic girl.¹⁷ The play follows the conflict the couples' union causes within their religious families but ultimately has a happy ending. The plaintiff alleges that the defendant's motion picture *The Cohen's and The Kelleys* infringed upon her play.¹⁸ The defendant's movie is about a Jewish girl and an Irish-Catholic man who marry and

¹⁴ Warner Bros., Inc. v. American Broadcasting Cos., 720 F.2d 231, 240 (2d Cir. 1983); Walt Disney Prods. v. Air Pirates, 581 F.2d 751, 754 (9th Cir. 1978), cert. denied, 439 U.S. 1132 (1979); Atari v. North Am. Philips Consumer Elecs. Corp., 672 F.2d 607 (7th Cir.), cert. denied, 459 U.S. 880 (1982).

¹⁵ Kurtz, *supra* note 12, at 452.

¹⁶ Nichols v. Universal Pictures Corp., 45 F.2d 119 (2d Cir. 1930).

¹⁷ *Id.* at 120.

¹⁸ *Id.*

the trouble their marriage causes within their families.¹⁹ The movie also ends happily with the families reconciling.

In the course of his decision Judge Hand mentioned the possibility that characters could be protected “independently of the ‘plot’” even though such a case had not previously arisen.²⁰ He explained that “[i]f *Twelfth Night* were copyrighted, it is quite possible that a second comer might so closely imitate Sir Toby Belch or Malvolio as to infringe, but it would not be enough that for one of his characters he cast a riotous knight who kept wassail to the discomfort of the household, or a vain and foppish steward who became amorous of his mistress. These would be no more than Shakespeare’s ‘ideas’ in the play, as little capable of monopoly as Einstein’s Doctrine of Relativity, or Darwin’s theory of the Origin of Species. It follows that the less developed the characters, the less they can be copyrighted; that is the penalty an author must bear for marking them too indistinctly.”²¹ This analysis by Judge Hand gave rise to the “distinct delineation” test.

The distinct delineation test rests on the principle that the more developed a character is the more he embodies protectable expression and less a general idea. A two part test has developed from Judge Hand’s discussion and has become the standard to use in character infringement cases.²² The first question is “whether the character was created with enough delineation to afford copyright protection.”²³ Only if the character is sufficiently developed to constitute more than just an idea and therefore be worthy of copyright protection should one move on to the second question. The second question is whether “the alleged infringer copied

¹⁹ *Id.*

²⁰ *Id.* at 121.

²¹ *Id.*

²² Gregory S. Schienke, *The Spawn of Learned Hand – A Reexamination of Copyright Protection And Fictional Characters: How Distinctly Delineated Must the Story Be Told?*, 9 MARQ. INTELL. PROP. L. REV. 63, 68 (2005).

²³ Mathew A. Kaplan, *Rosencrantz and Guildenstern Are Dead, But Are They Copyrightable?: Protection of Literary Characters With Respect To Secondary Works*, 30 RUTGERS L.J. 817, 823 (1999).

that character's physical, emotional, or mental traits, or created a character based on a broader, more abstract outline."²⁴ To establish an infringement there must be actual copying of expression rather than copying of ideas or a general type of character.

The Ninth Circuit came up with the second major standard for determining whether characters deserve independent copyright protection in *Warner Bros. Pictures Inc. v. Columbia Broadcasting System*.²⁵ In that case an author, Hammett, composed a mystery detective story called the *Maltese Falcon* which had as its main character a detective named Sam Spade.²⁶ Hammett then granted Warner Brothers exclusive rights in the *Maltese Falcon* writings to be used in movies, radio and television.²⁷ Hammett later used Sam Spade as the main character in new stories he wrote and Warner Brothers complained that it had acquired the exclusive right to the use of the writing, the *Maltese Falcon*.²⁸ Warner argued that the license included the individual characters, their names and the title.²⁹ The author argued that the exclusive use of the characters and their names were not granted in the license and that he could therefore use them in subsequent stories.³⁰

The Court held that rights to the characters were not granted in the license to Warner and that Hammett could use the character in a subsequent story. The Court explained that the argument set forth by Warner was "unreasonable, and would effect the very opposite of the statute's purpose which is to encourage the production of the arts."³¹ The Court went on to reason, however, that "[i]t is conceivable that the character really constitutes the story being told, but if the character is only a chessman in the game of telling the story he is not within the area of

²⁴ *Id.*

²⁵ 216 F.2d 945 (1954).

²⁶ *Id.* at 948.

²⁷ *Id.*

²⁸ *Id.*

²⁹ *Id.*

³⁰ *Id.*

³¹ *Id.* at 950.

the protection afforded by the copyright.”³² The Court concluded that even if Hammett had assigned the complete rights to Warner he could still use his characters in subsequent stories because “[t]he characters were vehicles for the story told, and the vehicles did not go with the sale of the story.”³³

The story being told test greatly narrowed the protection available for literary characters.³⁴ In fact, the standard excluded “virtually any character from copyright protection, because it ‘seems to envisage a ‘story’ devoid of plot wherein character study constitutes all, or substantially all, of the work.’”³⁵ The standard has been criticized and many courts have declined to use it, have distorted what it said to avoid its consequences, or have ignored it and applied the *Nichols* test instead.³⁶ Despite the stringent standard, certain characters such as Rocky and James Bond have been found to constitute the story being told.³⁷ In both these cases, however, the court also included an analysis under the “distinctly delineated” standard.

If the two main standards used to determine when literary characters are entitled to copyright protection seem vague and confusing it is because they are. The following section outlines some of the problems with both the “distinctly delineated” and the “story being told” standard.

IV. The “Distinctly Delineated” and “Story Being Told” Standard Are Not Helpful When It Comes To Deciding Which Characters To Protect.

The “distinctively delineated” standard is difficult to apply for three main reasons. The test is vague and asks judges to assume the roles of literary critics, it is often applied wrongly

³² *Id.*

³³ *Id.*

³⁴ MELVILLE B. NIMMER & DAVID NIMMER ON COPYRIGHT, §2.12 at 2-173 (1996).

³⁵ Kurtz, *supra* note 12, at 455 (quoting Nimmer on Copyrights § 2.12).

³⁶ *Id.* at 455.

³⁷ See *Anderson v. Stallone*, 11 U.S.P.Q.2d 1161 (C.D. Calif. 1989); see also *Metro-Goldwyn-Mayer Inc. v. Am. Honda Motor Co. Inc.*, 900 F. Supp. 1287, 1296 (1995).

leading to overprotection, and it does not necessarily protect the most developed characters.³⁸ The distinctively delineated test makes it clear that the more developed a character is the more protection he deserves. However, beyond that the test does not give much guidance. What exactly makes a character distinctively delineated enough to warrant protection has not been explained. Judges are left to act as literary critics and decide on their own which fictional characters deserve protection and which lack sufficient development. “What makes a fictional character worthy of protection seems to require Justice Stewart’s ‘I know it when I see it’ test.”³⁹

The problem with trying to clearly articulate why a certain character is distinctively delineated is demonstrated well by the court’s efforts in *Burroughs v. Metro-Goldwyn-Mayer*.⁴⁰ The court held that Tarzan was distinctively delineated and sufficiently developed so as to be copyrightable. The court’s description of Tarzan, however, does not convey in the least why the character is developed or distinctively delineated. The court’s description was as follows: “Tarzan is the ape-man. He is an individual closely in tune with his jungle environment, able to communicate with animals yet able to experience human emotion. He is athletic, innocent, youthful, gentle and strong. He is Tarzan.”⁴¹ The description seems more of a general character type and can apply equally well to Kipling’s Mowgli.⁴²

The case could be used to demonstrate that a comparison of the two works would offer a more convincing and less arbitrary argument for why Tarzan should be protected, except that the judge in that case had nothing to compare. Unfortunately, the issue in that case was not infringement, but whether a grant of the right to use the character arose under copyright.⁴³ The court had to determine if Tarzan was sufficiently delineated to be copyrightable in order to

³⁸ Kurtz, *supra* note 12, at 457-459.

³⁹ Schienke, *supra* note 22, at 80.

⁴⁰ *Burroughs v. Metro-Goldwyn-Mayer*, 519 F. Supp. 388 (S.D.N.Y. 1981), *aff’d*, 683 F.2d 610 (2d Cir. 1982).

⁴¹ *Id.* at 391.

⁴² Kurtz, *supra* note 12, at 458.

⁴³ *Burroughs*, 519 F.Supp. at 391.

determine whether a grant of a nonexclusive license to use the character of Tarzan was a right under copyright, and therefore subject to the termination provisions of the Copyright Act.⁴⁴

The case is still illustrative of the difficulty in trying to fit characters into a category such as developed on one hand or not sufficiently developed on the other hand. “Attempting to determine the extent of a character’s development, without making comparisons, leads to abstract and fruitless speculation.”⁴⁵ Inevitably a description of a character meant to demonstrate why he is distinctly delineated ends up reading like a description of a general type and “covers the pattern of many characters.”⁴⁶ These inherent problems with attempting to designate a character “distinctly delineated” or “well developed” lead to the conclusion that this is not a helpful or proper test for determining when to offer independent protection to literary characters.

Perhaps, because of the lack of guidance courts have begun overprotecting characters by considering whether they are copyrightable rather than whether there has been infringement. These courts seem to be concentrating on the first part of the *Nichols* test by determining whether a character is sufficiently delineated and then automatically finding infringement without performing a comparison of the two works in order to determine whether enough has been taken to constitute infringement. For instance, in a case involving Tarzan the court found that defendant’s adult movie entitled *Tarz & Jane & Boy & Cheeta* infringed upon plaintiff’s literary work.⁴⁷ The court explained that the characters were distinctly delineated and then automatically, without further analysis, found defendant’s characters to be substantially similar and therefore infringing.⁴⁸

⁴⁴ Kurtz, *supra* note 12, at footnote 167.

⁴⁵ Kurtz, *supra* note 12, at 464.

⁴⁶ *Id.*

⁴⁷ *Edgar Rice Burroughs, Inc. v. Mann*, 195 U.S.P.Q. (BNA) 159 (C.D. Cal. 1976).

⁴⁸ *Id.* at 162.

Another example of a court concentrating on the copyrightability of a character is seen in a case dealing with Hopalong Cassidy.⁴⁹ The character of Cassidy as portrayed in the book was tough, confrontational, prone to violence, cursing, and tobacco-chewing.⁵⁰ The character of Cassidy in the movie was cleaned up quite a bit and appeared kind and sentimental, and did not curse.⁵¹

Despite this lack of similarity between the two characters the court held that Hopalong Cassidy in the book was distinctly delineated and that using his character would be copyright infringement “irrespective and independent of the similarity of the story line.”⁵² The court held that Cassidy from the motion picture was “substantially similar to the character ‘Hopalong Cassidy’ in the books, and [that] both characters exhibit the same basic traits.”⁵³ “As to the demonstrable fact that not the least similarity beyond name and cowboy background existed between the character Mulford [the author] created and the character portrayed by William Boyd in the movies, [Judge] Werker simply described the movie Cassidy as Mulford’s Cassidy “turned inside out.”⁵⁴

It is evident from these cases that courts have sometimes turned to determining whether a character is copyrightable or distinctly developed without comparing the original and allegedly infringing characters. “Explicitly or implicitly, some courts have used the ‘magically expedient’ phrase of ‘well developed’ to arrive [at and] solidify their reasoning.”⁵⁵ The magic words “well developed” or “distinctly delineated”, however, do not tell us anything about whether the two

⁴⁹ Filmvideo Releasing Corp. v. Hasting, 509 F. Supp. 60 (S.D.N.Y.), *aff’d*, 668 F.2d 91 (2d Cir. 1981).

⁵⁰ Kurtz, *supra* note 12, at 459. (describing expert witness testimony as to a description of the book version of Cassidy).

⁵¹ *Id.*

⁵² *Id.* at 66,

⁵³ *Id.* at 65.

⁵⁴ Francis Nevins, *Copyright + Character = Catastrophe*, 39 J. COPYRIGHT SOC’Y U.S.A. 303, 313 (1992).

⁵⁵ Schienke, *supra* note 22, at 81.

works or characters are substantially similar or if enough was taken to constitute copyright infringement.

Apart from being employed in a way that is susceptible to overprotection of characters based on a pronouncement of the magic words “well developed”, the “distinctly delineated” test is also flawed because it does not necessarily offer protection for the most developed of characters. In fact, “[t]he most well-rounded characters, those that are the most fully human, may be the most inextricably bound to their context.”⁵⁶ It is questionable whether a reader would be able to recognize the character of Raskolnikov in a new story despite the fact that *Crime and Punishment* centers on the characters interior conflict, thoughts, feelings of alienation and self loathing to a degree that makes Raskolnikov seem very real.⁵⁷ Instead, the “flatter character”, the one that does not change through experiences but is always consistent, is the character that is the most recognizable when removed from the original work.⁵⁸

Sherlock Holmes has been described as a very limited and predictable character, almost formulaic.⁵⁹ Doyle had grown tired of Holmes “because his character admits of no light or shade.”⁶⁰ However, Sherlock Holmes is one of those characters that would be considered well developed and offered protection. “A more rounded character, however, is remembered in connection with the scene ‘through which she passed and as modified by these scenes – that is to say, we do not remember her so easily because she waxes and wanes and has facets like a human being.’”⁶¹

⁵⁶ Kurtz, *supra* note 12, at 464; citing Doyle, *Sidelights on Sherlock Holmes*, THE BAKER STREET READER 12, 14 (P. Shreffler ed. 1984).

⁵⁷ See <http://www.sparknotes.com/lit/crime/characters.html>

⁵⁸ *Id.*

⁵⁹ *Id.* at 465.

⁶⁰ *Id.* (quoting, Doyle, *Sidelights on Sherlock Holmes*, in THE BAKER STREET READER 12, 14 (P. Shreffler ed. 1984)).

⁶¹ Kurtz, *supra* note 12, at 465; quoting Doyle, *supra* note 46, at 106 (“A round character is capable of surprising in a convincing way. If it never surprises, it is flat. If it does not convince, it is a flat pretending to be round.” *Id.* at 118.).

Because it is so difficult to determine which characters are developed enough to deserve protection it seems that a test allowing judges to reach decisions based on the magic words “well developed” is not a desirable solution. “There is no reason to credit judges with the ability to function as literary or artistic critics of last resort.”⁶² While the distinctively delineated test was initially developed to include a determination of whether there is substantial similarity between the two characters, courts have been selectively ignoring this second part of the *Nichols* test.

All of the criticisms of the distinctively delineated test apply equally well to the “story being told” test. The “story being told test” offers us a distinction between a character who “constitutes the story being told” and one that is “only the chessman in the game of telling the story.”⁶³ However, “[w]hat this distinction is suppose to mean, how any court could conceivably use it to divide protected from unprotected characters, and what gives a federal judge the aesthetic credentials to draw this line, are matters on which Judge Stephens maintains a sphinxlike silence.”⁶⁴ The result is that the test is applied inconsistently, not at all or in combination with the distinctively delineated test.⁶⁵ Either way the results are unpredictable and confusing.

V. Trademark and Unfair Competition

As explained above the tests for determining protection under copyright law are confusing, difficult to apply and often yield unpredictable results. The difficult application of the “distinctly delineated” and “story being told” test has led legal scholars to examine alternate

⁶² Kurtz, *supra* note 12, at 438.

⁶³ Warner Bros. Pictures Inc. v. Columbia Broadcasting System, 216 F.2d 945 (1954).

⁶⁴ Nevins, *supra* note 54, at 315.

⁶⁵ Shaw v. Lindheim, 919 F.2d 1353 (9th Cir. 1990) (the Ninth Circuit did not even mention the story being told test in this character infringement case); Anderson v. Stallone, 11 U.S.P.Q.2d 1161 (C.D. Calif. 1989) (court notes that the distinctly delineated test is “simple in theory but elusive in application” and that the Ninth circuit has cast doubt on the reasoning of the “story being told” test, deciding in the end to apply both tests because of the unsettled state of the law); See also Feldman, *Finding a Home for Fictional Characters: A Proposal for Change in Copyright Protection*, 78 CALIF. L. REV. 687, 691 (1990); (explaining that the test was never widely accepted or used).

grounds for offering protection to literary characters. Trademark and unfair competition seem to be the primary alternatives to copyright.⁶⁶ “Where the concept of copyright is intended to protect the creative expression existing within a character, trademark and unfair competition laws are concerned with a character’s capacity to symbolize a particular source of goods or services.”⁶⁷ The critical issue is whether the alleged infringer’s use of character is likely to cause public confusion regardless of whether protection is sought under state laws of unfair competition or the federal trademark statute.⁶⁸ Unfair competition encompasses the narrower law of trademark,⁶⁹ which protects against “any false designation of origin, false or misleading description of fact, or false or misleading representations of fact” that are likely to “cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to origin...”⁷⁰

Two questions must be answered to determine if infringement has taken place.⁷¹ The first is whether the character has achieved “secondary meaning” or rather “does the public associate the character’s name with the particular product being sold?”⁷² The second question is whether there is a likelihood of confusion or “is the use of the character’s name by another likely to deceive and confuse the public as to the source of the goods?”⁷³

⁶⁶ Kenneth E. Spahn, *The Legal Protection of Fictional Characters*, 9 U. MIAMI ENT. & SPORTS L. REV. 331, 342 (1992).

⁶⁷ Gerald Jagorda, *The Mouse That Roars: Character Protection Strategies of Disney and Others*, 21 T. JEFFERSON L. REV. 235, 243 (1999).

⁶⁸ Leslie A. Kurtz, *The Methuselah Factor: When Characters Outlive Their Copyrights*, 11 U. MIAMI ENT. & SPORTS L. REV. 437, 442 (1994).

⁶⁹ 1 J. Thomas McCarthy, *Trademarks and Unfair Competition*, § 3.03[3] (3d ed. 1994).

⁷⁰ Lanham Act, § 45, 15 U.S.C. § 1225(a).

⁷¹ Spahn, *supra* note 66, at 342.

⁷² *Id.* citing Nimmer, § 2.16; J.T. McCarthy, TRADEMARKS AND UNFAIR COMPETITION § 23:1 (2d ed. 1984); *see also* Universal City Studios v. Nintendo Co., 746 F.2d 112, 115 (2d Cir. 1984); Boston Pro. Hockey Ass’n v. Dallas Cap & Emblem Mfg., 510 F.2d 1004 (5th Cir. 1975); Sunbeam Furniture Corp. v. Sunbeam Corp., 191 F.2d 141 (9th Cir. 1951); Tomlin v. Walt Disney Prods., 18 Cal. App. 3d 226 (1971).

⁷³ *Id.*

There are several advantages to trademark and unfair competition protection over copyright protection for literary characters. For one thing, trademark and unfair competition offer protection of the name, appearance, costumes, and key phrases of a character, all things left unprotected by copyright.⁷⁴ Another significant advantage is that “the fact that a copyrightable character or design has fallen into the public domain should not preclude protection under the trademark laws so long as it is shown to have acquired independent trademark significance...”⁷⁵ Therefore, trademark and unfair competition protection may extend well beyond the copyright term as long as the character keeps his secondary meaning and there is a likelihood of public confusion.

Unfair competition and trademark laws have been used to protect various aspects of fictional characters. In an early case the name and appearance of Charlie Chaplin were protected.⁷⁶ The defendant was featured in films dressed and acting like “Charlie Chaplin” but under the name “Charlie Aplin”.⁷⁷ The court found that the defendants wanted to deceive the public into believing they were paying to see Charlie Chaplin so as to secure a larger audience and therefore enjoined the defendants from further imitating the plaintiff.⁷⁸ In another case a defendant was enjoined from using the name “Frank Merriwell” under the law of unfair competition, even though none of the plaintiff’s stories were copied.⁷⁹ The court found that the name “has become descriptive, and is closely identified in the public mind with the work of a particular author” so as to mislead the public.⁸⁰

⁷⁴ Kurtz, *supra* note 68, at 442; (Phrases that have been protected include “E.T. Phone Home” and “I Love You E.T.” in *Universal City Studios v. Kamar Indus.*, 1982 Copyright L. Dec. (CCH) P 25, 452 (S.D. Tex. 1982), as well as “Hi, yo, Silver, away” in *Lone Ranger, Inc. v. Cox*, 124 F.2d 650, 652 (4th Cir. 1942).)

⁷⁵ *Frederick Warn & Co., Inc. v. Book Sales, Inc.*, 481 F. Supp. 1191, 1198 (S.D.N.Y. 1979).

⁷⁶ *Chaplin v. Amador*, 269 P. 544 (Cal. Ct. App. 1928).

⁷⁷ *Id.*

⁷⁸ *Id.*

⁷⁹ *Patten v. Superior Talking Pictures*, 8 F. Supp. 196 (S.D.N.Y. 1934).

⁸⁰ *Id.* at 197.

A character's name was also protected in a case where a radio host known as the Old Maestro advertised plaintiff's beer and malt beverages.⁸¹ The defendant started using the name Old Maestro Brew for its own beer.⁸² The court found that the radio audience knew that the Old Maestro's radio show was sponsored by the plaintiff and associated the name with the plaintiff's products as well as the radio host.⁸³ The court therefore enjoined the defendant from using the name because it was likely to cause confusion.⁸⁴

Similarly, Tarzan's name was protected in a case where the defendant advertised an X-rated film by the name *Tarz & Jane & Boy & Cheeta*.⁸⁵ The court held that the public could be misled about the source or origin of the film and mistakenly think it was authorized or provided by the plaintiff.⁸⁶

The appearance and costumes of characters have also been protected under trademark and unfair competition laws. In a case where the plaintiff owned the copyrights and trademarks relating to the characters Superman and Wonder Woman the defendant was enjoined from using similar characters in his business.⁸⁷ The defendant operated a singing telegram company that featured characters named Superstud and Wonderwench who were dressed in costumes similar to the originals and carried balloons depicting Superman and Wonder Woman.⁸⁸ The court found the public was likely to be confused as to the source and sponsorship of the singing telegram service.⁸⁹ The court also found the defendant was benefiting from the good will created by the plaintiff's mark.⁹⁰

⁸¹ Premier Pabst Corp. v. Elm City Brewing Co., 9 F. Supp. 754 (D. Conn. 1935).

⁸² *Id.*

⁸³ *Id.* at 756.

⁸⁴ *Id.* at 761.

⁸⁵ Edgar Rice Burroughs, Inc. v. Mann, 195 U.S.P.Q. (BNA) 159 (C.D. Cal. 1976).

⁸⁶ *Id.*

⁸⁷ DC Comics v. Unlimited Monkey Business, 598 F. Supp. 110 (N.D. Ga. 1984).

⁸⁸ *Id.* at 114.

⁸⁹ *Id.* at 115.

⁹⁰ *Id.*

Despite the numerous ways in which trademark and unfair competition have been used to protect elements of fictional characters there are disadvantages to this protection as well. In order to receive protection a character must acquire “secondary meaning”, the public must identify the character with a single source, and there must be a likelihood of public confusion.⁹¹

The requirement that a character acquire “secondary meaning” leaves new, unsuccessful or simply less well known literary characters unprotected.⁹² The only characters that receive protection under trademark and unfair competition law are ones that are known to the public and have “undergone some reasonable degree of circulation.”⁹³

For instance, the names Ziggy⁹⁴ and Melvin the Monster⁹⁵ were not protected under trademark and unfair competition even though the defendants used identical names in their work. The characters were not known to the public, they had almost no circulation, so that nobody associated them with a particular source and there was little likelihood of confusion.⁹⁶

Similarly, the character of Paladin was not extended protection because he was not widely known and therefore could not have acquired secondary meaning.⁹⁷ The plaintiff, De Costa, made public appearances at rodeos where he entertained children dressed up in a cowboy costume and pretended to be a character named Paladin.⁹⁸ He carried with him a business card that had the phrases “Have Gun Will Travel, Wire Paladin, N. Court St., Cranston, R.I.” on it and was inscribed with a chess knight.⁹⁹ He wore all black and had St. Mary’s medal affixed to his

⁹¹ Spahn, *supra* note 66, at 344.

⁹² *Id.*

⁹³ Kurtz, *supra* note 68, at 443.

⁹⁴ Pellegrino v. American Greetings Corp., 592 F. Supp. 495 (D.S.D. 1984), *aff’d mem.*, 760 F.2d 272 (8th Cir. 1985).

⁹⁵ Gantz v. Hercules Publishing Corp., 15 Misc. 2d 1061, 182 N.Y.S.2d 450 (Sup. Ct. 1959).

⁹⁶ Kurtz, *supra* note 12, at 481.

⁹⁷ De Costa v. Columbia Broadcasting Sys., 520 F.2d 499 (1st Cir. 1975), *cert. denied*, 423 U.S. 73 (1976).

⁹⁸ *Id.* at 502.

⁹⁹ *Id.*

hat.¹⁰⁰ The plaintiff dressed up in the character of Paladin purely to entertain people.¹⁰¹ Years after the plaintiff began appearing as Paladin defendants came out with a television show that copied the appearance of Paladin, his name, and had the phrase “Have Gun, Will Travel, Wire Paladin, San Francisco” on his card.¹⁰² The court acknowledged that the defendants had copied, but found there was no likelihood of confusion as to the source of the tv show.¹⁰³ The original Paladin was therefore denied relief despite the high degree of copying. The only thing that was relevant to the analysis was that there was no likelihood of public confusion.

Even characters that are well known may not be protected if they are associated with more than one source. In order, to obtain protection a literary character must be associated with a single source.¹⁰⁴ Association with a single source, in many cases, is a “convenient fiction” for literary characters, since they have been associated with their authors¹⁰⁵, producers¹⁰⁶, sponsors¹⁰⁷, and even with themselves^{108, 109}.

For instance, the character of King Kong was denied protection under trademark or unfair competition because he was not associated with a single source in the public mind.¹¹⁰ Universal sued Nintendo alleging that its game “Donkey Kong” infringed Universal’s trademark in King Kong.¹¹¹ The rights in King Kong were divided between RKO, which owned rights in the first

¹⁰⁰ *Id.*

¹⁰¹ *Id.* at 511.

¹⁰² *Id.* at 509.

¹⁰³ *Id.* at 515.

¹⁰⁴ Kurtz, *supra* note 68, at 442.

¹⁰⁵ *Gruelle v. Molly – ‘Es Doll Outfitters*, 94 F.2d 172, 176 (3d Cir. 1937), *cert. denied*, 304 U.S. 561 (1938); *Patten v. Superior Talking Pictures, Inc.*, 8 F. Supp., 196, 197 (S.D.N.Y. 1934); *Fisher v. Star Co.*, 231 N.Y. 414, 433, 132 N.E. 133, 139, *cert. denied*, 257 U.S. 654 (1921).

¹⁰⁶ *Processed Plastic Co. v. Warner Communications, Inc.*, 675 F.2d 852, 856 (7th Cir. 1982); *Wyatt Earp Enters. V. Sackman, Inc.*, 157 F. Supp. 621, 625 (S.D.N.Y. 1958).

¹⁰⁷ *Premier Pabst Corp. v. Elm City Brewing Co.*, 9 F. Supp. 754, 761 (D. Conn. 1935).

¹⁰⁸ *DC Comics v. Unlimited Monkey Business*, 598 F. Supp. 110, 115 (N.D. Ga. 1984).

¹⁰⁹ Kurtz, *supra* note 12, at 485.

¹¹⁰ *Universal City Studios v. Nintendo Co.*, 578 F. Supp. 911 (S.D.N.Y. 1983), *aff’d* 746 F.2d 112 (2d Cir. 1984).

¹¹¹ *Id.* at 913.

King Kong movie, DDL which owned the rights in a 1976 remake, Cooper, the son of the author, who owned rights in the book and Universal which obtained its rights from Cooper.¹¹²

The court explained that “[e]xactly what shred of the King Kong character and name Universal owns is far from clear” and that the “vagueness of the image in which Universal claims a trademark right violates the fundamental purpose of trademark: to identify the source of a product and thereby prevent consumer confusion as to that source.”¹¹³ Therefore, the court found that because of the extensive merchandising and “the competing property interests in King Kong”, the character “no longer signifies a single source of origin to consumers and thus is not a valid trademark.”¹¹⁴

Similarly, in *Frederick Warner & Co. v. Book Sales, Inc.*, the plaintiff was the publisher of the Peter Rabbit books written and illustrated by Beatrix Potter.¹¹⁵ The plaintiff sued the defendant for trademark infringement of the illustrations of Peter Rabbit.¹¹⁶ The defendant had used a few of the illustrations in his own book about Peter Rabbit. Plaintiff claimed that while a number of volumes were no longer protected by copyright, the illustrations had acquired a secondary meaning and identified the publishing company.¹¹⁷ The court found that “it would not be enough that the illustrations in question have come to signify Beatrix Potter as author of the books; plaintiff must show that they have come to represent its goodwill and reputation as Publisher of those books.”¹¹⁸ Therefore, before a party can seek protection through trademark or unfair protection laws it must be sure that the character is associated with one source and that source is the plaintiff himself.

¹¹² *Id.* at 914-916.

¹¹³ *Id.* at 924.

¹¹⁴ *Id.* at 923.

¹¹⁵ 481 F. Supp. 1191, 1193 (S.D.N.Y. 1979).

¹¹⁶ *Id.*

¹¹⁷ *Id.* at 1193-1194.

¹¹⁸ *Id.* at 1195.

Trademark and unfair competition are also unavailable as a means of protection if there is little likelihood of public confusion. To be confused the public does not need to be tricked into buying something because they believe it is something different.¹¹⁹ It is enough if the public believes a single source approved the new work, is in some way associated or connected with the new work or sponsored it.¹²⁰ The public may not even “be aware of the name of the source” as long as “they assume that products bearing the mark come from a single, though anonymous source.”¹²¹ This is important in the movie industry because most people cannot identify a specific movie with a producing company, but they recognize that there is a single source.¹²²

The King Kong case discussed above is a good example of a case where the court held the characters were not similar enough for the public to be confused as to source or association.¹²³ The court found that even if King Kong possessed a secondary meaning associated with Universal there would still remain the question of whether consumers were likely to confuse Donkey Kong and King Kong.¹²⁴ The court explained that Universal must show that “there exists a likelihood that an appreciable number of ordinary prudent purchasers will be misled, or simply confused, as to the source of the goods in question.”¹²⁵

After a comparison of the two characters the court found that Donkey Kong and his environment “create a totally different concept and feel” and that “at best, Donkey Kong is a parody of King Kong.”¹²⁶ While King Kong “fights with dinosaurs, giant snakes, airplanes and helicopters” and dies a “tragic and bloody death”, Donkey Kong’s obstacles include “pies,

¹¹⁹ Kurtz, *supra* note 12, at 477.

¹²⁰ *Id.* (citing 2 J. McCarthy, TRADEMARKS AND UNFAIR COMPETITION, § 24:3(B) (2d ed. 1984) (likelihood of confusion denotes any type of confusion, including: confusion of source; confusion of affiliation; confusions of connection; or confusion of sponsorship).

¹²¹ Kurtz, *supra* note 12, at 477 (citing 3A R. Callman, THE LAW OF UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES §19.25 (4th ed. 1983)).

¹²² Kurtz, *supra* note 12, at footnote 263.

¹²³ Universal City Studios v. Nintendo, 578 F. Supp. 911 (S.D.N.Y. 1983), *aff’d* 746 F.2d 112 (2d Cir. 1984).

¹²⁴ *Id.* at 926.

¹²⁵ *Id.* (citing Lever Brothers Co. v. American Bakeries Co., 693 F.2d 251, 253 (2d Cir. 1982)).

¹²⁶ *Id.* at 928.

cement tubs, birthday cakes, and umbrellas.”¹²⁷ The video game character, Donkey Kong, was described as “farcical”, “childlike”, “nonsexual”, “comical” and therefore much different than the “ferocious” King Kong who goes on “rampages, chases people, crushes them underfoot, and throws them to the ground.”¹²⁸ The court held that even if King Kong possessed a secondary meaning associated with Universal there was no likelihood of confusion and granted defendant summary judgment.¹²⁹

Trademark and unfair competition laws can offer protection of the author’s good will and give the author a say in how his character will be used even if the character is not copied enough for a finding of copyright infringement.¹³⁰ However, in many ways the scope of protection offered by trademark is far more limited than copyright protection. Whereas copyright protection requires a showing of access and substantial similarity, trademark and unfair competition require a showing of secondary meaning, association with a single source, and likelihood of public confusion. As evidenced by the cases discussed above any of these three requirements can make it difficult to retain control through trademark or unfair competition laws.

VI. Do We Even Need A Separate Test For Characters?

In examining the protection available for fictional characters two points become clear. One is that the “distinctly delineated” and “story being told” tests are generally unhelpful because they are vague and offer little guidance as to when a character is infringed upon. Second, when the tests are applied in a helpful manner they essentially reiterate the substantial similarity test and do not offer anything new to the analysis. Since the unhelpful parts are best ignored and the helpful parts are already included in the substantial similarity test there is no need for separate tests for literary characters and they should not be used.

¹²⁷ *Id.*

¹²⁸ *Id.*

¹²⁹ *Id.* at 929.

¹³⁰ Kurtz, *supra* note 12, at 495.

As mentioned in the introduction there is a need for a balance between giving authors the chance to profit from and control the use of their characters and the need to leave enough building blocks in the public domain for new authors. After reviewing the current state of copyright, trademark and unfair competition laws as applied to literary characters it appears the proper balance would be reached if a character was protected within the original work in which it appeared and also by trademark and unfair competition laws. Separate protection for literary characters would not offer authors any additional incentive to create and would remove too much from the public domain.

A. Protection Within The Original Work Using The Substantial Similarity Test

Literary characters should receive copyright protection, but only because a substantial copying of a character may infringe the original copyrighted work in which the character appears, not because fictional characters deserve independent protection. There have been a variety of tests designed to determine when one work is substantially similar to another.

The first step in the analysis should be to separate ideas from expression. As applied to characters this first step would involve deciding whether the character is just a general type, an idea, or whether there is enough expression to be protectable. This analysis is precisely what some courts have been doing as part of the “distinctly delineated” or “well developed” test. The first step, however, does not deserve a separate name since it has always been part of the substantial similarity test. It is a basic principle of copyright law that in order to find copyright infringement one must “determine whether there has been copying of the expression of an idea rather than just the idea itself.”¹³¹ The determination by itself is only useful in eliminating those characters who are so clearly a general type and not worthy of protection that a full analysis

¹³¹ Sid & Marty Krofft Television Productions, Inc. v. McDonald’s Corporation, 562 F.2d 1157, 1163 (9th Cir. 1977).

would be a waste of time. This step does not help us with characters that are more than a general type, and for these more expressive characters a comparison is needed.

The two-part, extrinsic/intrinsic test articulated in *Krofft* will work well in determining whether a character is protected by copyright within the context of the original work.¹³² The “extrinsic test” compares “specific, objective criteria of two works on the basis of an analytic dissection of the following elements of each work –plot, theme, dialogue, mood, setting, pace, characters, and sequence of events.”¹³³ The outcome of the extrinsic test “may often be decided as a matter of law.”¹³⁴

The second part of the *Krofft* analysis “requires that the trier of fact then decide whether there is substantial similarity in the expressions of the ideas so as to constitute infringement.”¹³⁵ This “intrinsic” part asks whether the “total concept and feel” of the two works is substantially similar.¹³⁶ The intrinsic test relies on the observations of the “ordinary reasonable person.”¹³⁷ The *Krofft* test permits a finding of infringement only if both the extrinsic and intrinsic test are satisfied.¹³⁸

The amount of protection offered to a character within the original work in which it appears is sufficient because it is extremely hard to completely separate a character from “trailing elements of plot”.¹³⁹ All characters are bound by their time, place, history, experiences, and relationships with other characters.¹⁴⁰ Professor Kurtz gives the example of placing Tarzan

¹³² Krofft, *supra* note 131, at 1157.

¹³³ *Metro-Goldwyn-Mayer, Inc., v. American Honda Motor Co., Inc.*, 900 F.Supp. 1287, 1297 (1995); citing *Shaw v. Lindheim*, 919 F.2d 1353, 1359 (9th Cir. 1990).

¹³⁴ Krofft, *supra* note 126, at 1164.

¹³⁵ 3 M. NIMMER & NIMMER ON COPYRIGHT § 13.03 [E][3], at 62.14 (1989).

¹³⁶ *Litchfield v. Spielberg*, 736 F.2d 1352, 1357 (9th Cir. 1984), *cert. denied*, 470 U.S. 1052, 105 S.Ct. 1753, 84 L.Ed.2d 817 (1985).

¹³⁷ Krofft, *supra* note 131, at 1164.

¹³⁸ *Metro-Goldwyn*, *supra* note 133, at 1297.

¹³⁹ Kurtz, *supra* note 12, at 431.

¹⁴⁰ *Id.*

in New York city for a new story.¹⁴¹ Even though Tarzan is in a completely new setting and involved in a different story he would not be Tarzan if “he was not previously raised by apes”, if he did not grow up in the jungle, and if he was not good with animals.¹⁴² Therefore, if one is to copy a character and capture who that character is in a substantially similar way, it is almost impossible not to copy elements of the original work.

If the new author included a description of Tarzan’s history, the jungle where Tarzan grew up, his relationships with the animals, and the development of his various skills these descriptions would most likely be enough to constitute substantial similarity with the original work thereby offering protection for Tarzan’s character. On the other hand if the second author copies only the idea of a man growing up with animals, but produces a very different character, the intrinsic part of the test would act as a check to overprotection. Therefore, if the New York Tarzan had a vastly different “concept and feel” about him there would be no infringement since the intrinsic part of the test would not be satisfied. So far the *Krofft* test is accomplishing precisely what it is supposed to: it is protecting the expression of ideas but not the ideas themselves.

One possible problem occurs when the new author uses only the name Tarzan, relying on the character’s popularity to conjure up in the consumer’s minds a mental image of who the character is. Copyright law cannot protect a character’s name and would offer no relief. The new author would not have to include a description of Tarzan’s history, relationships, jungle origins, or special skills in order to convey to the reader who Tarzan is. Everyone already knows who Tarzan is. Therefore, there may not be enough substantial similarity of expression between the original and new work to constitute infringement. However, the name of the character, his

¹⁴¹ *Id.*

¹⁴² *Id.*

dress, a famous phrase the character utters, or anything that conjures up the mental image of the character can most likely be protected by trademark and unfair competition laws.

B. Trademark and Unfair Competition To Supplement Copyright In Original Work

As described in the cases mentioned earlier, trademark and unfair competition laws can protect a character's name, appearance, and catch phrase.¹⁴³ Therefore, trademark and unfair competition laws would offer the original author protection if a new author started writing stories about Tarzan. What about the additional requirements of trademark law, the need for a finding of secondary meaning and likelihood of confusion?

If the character is one that has not acquired secondary meaning then there is no trademark protection, but the same concerns or compelling reasons to offer protection are also not present. Since the character does not have secondary meaning, the character is most likely not well known and will not automatically create a mental image in a reader's mind. Therefore, the new author will either have to copy the original author's expression that created the character, in which case copyright will offer relief, or else come up with his own description of the character in which case there will be no substantial copying.

If the character is well known or has secondary meaning, the courts are very likely to find likelihood of confusion. When Tarzan's name was used in the title of an X-rated movie the court found the use likely to cause confusion as to source or origin.¹⁴⁴ Furthermore, the court found that a disclaimer, which explained the movie was in no way associated with the plaintiff, was not enough to prevent the confusion and ordered the defendant to stop using the name.¹⁴⁵ It is clear from this example that authors can gain substantial protection for their literary characters through trademark and that potential infringers will not be able to get away with copying by simply

¹⁴³ See *supra* note 74.

¹⁴⁴ *Edgar Rice Burroughs, Inc. v. Mann*, 195 U.S.P.Q. (BNA) 159 (C.D. Cal. 1976).

¹⁴⁵ *Id.*; see also Kurtz, *supra* note 12, at footnote 282.

including a disclaimer. In fact trademark seems to overprotect characters since it is unlikely the public would think Edgar Rice Burroughs, after writing some twenty six novels about Tarzan, decided to venture in to the adult movie industry.

C. Protection Within The Original Work Through The Krofft Test Together With Trademark and Unfair Competition Laws As Applied To The Cases.

In many character infringement cases when two works are compared they are often described in a limited fashion so that a full analysis of plot, mood, setting, dialogue and the various other elements is difficult to accomplish. For instance, in *Burroughs v. Manns Theatres*, the defendant's X-rated film *Tarz & Jane & Boy & Cheeta* was found to utilize characters which were substantially similar to those contained in the plaintiff's copyrighted works.¹⁴⁶ The court did not include a comparison of the two works, but simply found that "characters which are distinctly delineated in copyrighted works are protected by the copyright in those works" and that the advertising and distribution of defendants movie would infringe on the plaintiff's copyright in the literary works.¹⁴⁷

There are certain things that can be easily presumed about an X-rated movie without the benefit of a court description or personal familiarity so that a comparison can be carried out despite the lack of information. The first step of the test is whether the character of Tarzan in the original work is merely a stock character or whether he contains enough expression to be copyrightable. This standard is set relatively low since it is meant to eliminate those characters that are clearly a general type. Tarzan has been the main character of twenty-six novels in the course of which his childhood, history, relationships, characteristics and skills have been outlined in detail. It is therefore safe to assume that Tarzan is more than an idea and is composed of expression.

¹⁴⁶ *Edgar Rice Burroughs, Inc. v. Manns Theatres, et al.*, 195 U.S.P.Q. (BNA) 159 (C.D. Cal. 1976).

¹⁴⁷ *Id.*

The analysis of why Tarzan is more than just an idea is not any more articulate than the description of why Tarzan is “well-developed” offered in *Burroughs v. Metro-Goldwyn-Mayer*, and criticized earlier in the paper. However, the reason the description in *Burroughs* was criticized is because that was the entirety of the test used to determine whether a character was copyrightable. The case was used to illustrate the problem of fitting a character in to a category, well-developed vs. not well-developed and then using this determination to find infringement.¹⁴⁸ In contrast, the test proposed here treats the question of whether a character is more than an idea as only the first step in a longer analysis and is meant only to eliminate those characters that are clearly a general type. The proposed test recognizes that the idea/expression dichotomy is difficult to articulate and that it cannot be the sole basis of a test, but that it is useful in eliminating characters who are purely ideas and therefore not protectable by copyright.

Next, the two-part, extrinsic/intrinsic test articulated in *Krofft* is applied.¹⁴⁹ The extrinsic test calls for a comparison of plot, theme, dialogue, mood, setting, pace, characters and sequence of events.¹⁵⁰ It is doubtful that the movie stays true to the plot of any of the Tarzan literary works or attempts to follow the same sequence of events. What is more likely is that the movie borrows the general idea of a man rescuing a woman in the jungle and then adds numerous events and acts not present in the original works. The theme and mood, considering the different purposes and audiences, are likely different. It is fair to assume that the movie did not borrow the literary works dialogue in its entirety or at all and instead substituted its own dialogue. Similarly, while the literary works describe in detail the beauty and wilderness of the jungle, the

¹⁴⁸ As noted earlier in the paper the judge in this specific case had nothing to compare because the issue was not infringement but rather termination of a license. The case is nonetheless illustrative of the speculation that goes into deciding and describing when a character is well-developed so as to underscore the point that courts should not automatically find infringement when they find a character copyrightable.

¹⁴⁹ Krofft, *supra* note 131.

¹⁵⁰ Metro, *supra* note 133, at 1297.

movie may use this setting in a minimal way. Finally, an X-rated movie is not likely to focus on developing the characters so that no more than the idea of Tarzan was likely taken.

Since, the extrinsic test would undoubtedly fail there is no need to move on to the intrinsic part of the test. However, in the event that “Tarz & Jane & Boy & Cheeta” is a movie that closely follows the literary works as far as sequence of events, dialogue, theme, and takes time to develop the characters, the intrinsic test will be applied. The intrinsic test calls for the trier of fact to determine whether the two works have a substantially similar “total concept and feel.” Again, taking into consideration the vastly different purposes of the two works and the non-sexual nature of the literary work as opposed to the highly sexualized nature of the movie, the two works would likely have a drastically different concept and feel.

Under the proposed test, therefore, the defendant’s X-rated movie would not infringe upon the plaintiff’s copyright. However, the name Tarzan would be protected under trademark and unfair competition, and in fact was protected in the actual case as described earlier. The court went too far, however, when it found that the movie infringed the plaintiff’s copyright since the defendant cannot even remedy the problem by changing the title and character names. If the test proposed in this paper was used then the defendant would still have to change the names in the movie, but would be able to distribute it once there was no likelihood of confusion because the two works are not substantially similar and should not be protected by copyright.

The desirability of allowing the defendant to distribute his film, once he no longer infringed plaintiff’s trademark, may escape some readers, but the principal of balancing between authors rights and what is left in the public domain must apply equally to all sorts of works. Next time a set of characters is found to be distinctly delineated and a work automatically deemed infringing, the second work could be one of great artistic value. Even in this case, the

creativity of the defendant's work may offer raw material and building blocks to others within the movie industry, as well as enrich the lives of a certain segment of the public.

The proposed test would also yield better results in the Hopalong Cassidy case.¹⁵¹ The court in that case found that the character of Cassidy and a few others from the book “were sufficiently delineated, developed and well known to the public to be copyrightable. The use of these characters for the purposes intended by Filmvideo therefore would constitute infringement with respect to the above numbered films irrespective and independent of the similarity of the story line.”¹⁵² Despite reading the books and viewing the movies the court could only explain the similarity in character as the movie Cassidy being “Cassidy turned inside out.”¹⁵³ Other similarities the court noted included names of characters, names of towns, and the same general setting.¹⁵⁴ As previously described the two characters did not seem especially similar apart from sharing a name and a western setting so the *Krofft* test will be applied to determine whether Filmvideo should have been enjoined from using the 23 movies they developed.

Hopalong Cassidy has been described in detail in twenty six novels and is therefore likely to be more than a simple stock character. Since Cassidy likely encompasses protectable expression the next step is to apply the extrinsic test. Rather than view the twenty three movies and read the twenty six novels I will rely on the courts descriptions as well as the description provided by an expert witness for Filmvideo.¹⁵⁵

The Court found that eleven of the movies infringed the books copyrights because there was substantial similarity of storyline.¹⁵⁶ For the rest of the movies, however, the Court did not

¹⁵¹ Filmvideo, *supra* note 49.

¹⁵² *Id.* at 66.

¹⁵³ *Id.* at 65.

¹⁵⁴ *Id.* at 63.

¹⁵⁵ See Kurtz, *supra* note 12, at 459. (Outlines the testimony of an expert witness for Filmvideo regarding a description of Cassidy's character in the book as contrasted with the Cassidy in the movie).

¹⁵⁶ Filmvideo, *supra* note 49, at 65.

find substantial similarity of storyline, but found that the use of the Hopalong Cassidy characters alone would constitute copyright infringement irrespective of the plot. Therefore, for those remaining twelve movies there is no substantial similarity in plot, dialogue, or sequence of events since these can all be said to constitute the storyline.

The setting, theme, mood and pace of the movies and the books are most likely similar. The setting of both is the Old West and the theme is one of action and adventure. The mood is light hearted and both the books and movies are quick paced. However, the Old West and the types of locales that existed in that time as well as the “genre of action-adventure” are precluded from copyright protection by the “scenes a faire” exception.¹⁵⁷ Included under the “scenes a faire” exception are “incidents, characters, or settings which are indispensable, or at least standard, in the treatment of a given topic.”¹⁵⁸

The Ninth Circuit has held that when two works both emphasize action and adventure and therefore share the same general theme, mood and pace than “those similarities that do exist arise from unprotectable scenes a faire, [and] there exists no substantial similarity of protectable expression.”¹⁵⁹ Likewise, in the Cassidy case the similarity that does exist is not similarity of protectable expression, but rather of general elements without which an action-adventure movie set in the Old West would not be possible.

The court in the Cassidy case also noted that the names of some of the characters and towns were taken from the books and included in the movies. The name of a town or character

¹⁵⁷ *Olson v. National Broadcasting Company*, 855 F.2d 1446, 1451 (9th Cir. 1988) (finding that the theme, mood and pace are all common to the genre of action-adventure television series and movies and therefore do not demonstrate substantial similarity); citing *Berkic v. Crichton*, 761 F.2d 1289, 1293-94 (9th Cir.) (denying protection to “familiar scenes and themes [which] are among the very staples of modern American literature and film”), *cert. denied*, 474 U.S. 826, 106 S.Ct. 85, 88 L.Ed.2d 69 (1985); *Walker v. Time Life Films, Inc.*, 784 F.2d 44, 50 (2d Cir.) (denying protection to “‘stock’ themes commonly linked to a particular genre”), *cert. denied*, 476 U.S. 1159, 106 S.Ct. 2278, 90 L.Ed.2d 721 (1986).

¹⁵⁸ *Atari Inc. v. North m. Philips Consumer Elecs. Corp.*, 672 F.2d 607, 616 (7th Cir.), *cert. denied*, 459 U.S. 880 (1982).

¹⁵⁹ *Olson*, *supra* note 157, at 1451 and 1453.

cannot be protected under copyright laws¹⁶⁰, but use of a characters name can be used as one factor in determining whether the development of a character was copied.¹⁶¹ “If the character’s development [was] not copied, however, using the name is not a basis for finding copyright infringement.”¹⁶²

Therefore, the analysis leads us to a comparison of Cassidy as described in the books and Cassidy as portrayed in the movies. The book Cassidy is described as “a falmouthed, tobacco-spitting, violence-prone young tough, who... is involved in countless battles, chases, and confrontations...[He] grows into a hard-bitten, middle-aged gunman and sometimes peace officer...”¹⁶³ The movie Cassidy avoids alcohol, does not swear, rides on a white horse, is kind and sentimental and is so “sanitized from Mulford’s [the authors] conception of the character that Mulford made constant complaints to the film-makers who generally responded . . . by ignoring his diatribes and sending him a box of cigars.”¹⁶⁴ Therefore, the cleaned up movie version of Cassidy is not substantially similar to the rough version of Cassidy described in the books.

At least twelve of the movies followed their own storylines, dialogue, sequence of events and had vastly different main characters. The movies have a similar theme, pace and mood as the book, but these are “scenes a faire” without which the specific genre of Old West adventure movies or books could not be produced. Therefore, according to the extrinsic part of the Krofft test the two works are not substantially similar.

¹⁶⁰ 37 C.F.R. § 202.1(a) (provides that “[w]ords and short phrases such as names, titles and slogans’ are not subject to copyright . . .”).

¹⁶¹ Kurtz, *supra* note 12, at 460.

¹⁶² *Id.*

¹⁶³ Kurtz, *supra* note 12, at 459. (describing expert witness testimony which gave a more complete description of Cassidy as described in the book).

¹⁶⁴ Kurtz, *supra* note 12, at 459-460; citing Nevins, *The Doctrine of Copyright Ambush: Limitations on the Free Use of Public Domain Derivative Works*, 25 ST. LOUIS U.L.J. 58, 68 (1981) (citing J. LUSKA, *THE FILMING OF THE WEST* 323 (1976)).

Next the intrinsic test would be left to the jury to decide whether the book and movie version have the same “total concept and feel”. The story line was already determined by the court to be different, the theme, mood, and pace are common to many western adventure stories so the only element that could give the movies the same feel as the book are the characters. It is doubtful that a jury would have recognized Cassidy in his “inside out” form. It is also doubtful that the jury would have attributed the many differences between the two characters to the movie’s exposure to the public of the “kind, sentimental, thinking person” hidden from public view in the book Cassidy. What is more likely is that the different storylines and different characters would have created a different “total concept and feel.”

Therefore, under the proposed test at least twelve of the movies would not be found to infringe, but the plaintiff would still be able to protect Hopalong Cassidy’s name under trademark and unfair competition laws. The defendant would be forced to use different names for the main character and public would get the benefit of twenty three movies. This result is more desirable because it is closer to the purpose of copyright law which is to make as many works available to the public as possible while leaving artists with enough incentive to create. A movie that does not copy the names, storyline or characters from another work, but uses the same “scenes a fair” is unlikely to offend artists to such an extent that they will lose incentive to create.

The test proposed in this paper is not easy to administer. It requires reading, viewing or listening to both the original work and the allegedly infringing work, which in some cases is no simple task.¹⁶⁵ Furthermore, the test requires a jury to consider the two works in order to determine if they have the same concept and feel. On the other hand, the “distinctly delineated”

¹⁶⁵ Despite reaching a decision that has since been criticized in many law review articles the judge in the Hopalong Cassidy case read all 26 novels (8363 pages) and viewed 23 motion pictures (almost 27 hours of viewing); Filmvideo, *supra* note 49, at 62.

and “story being told” test are fairly easy to administer. A judge can decide whether a character is well-developed based on the number of works the character has appeared in or the popularity of the character or a variety of other factors that do not involve dissecting and comparing various elements of each work or letting a jury consider the matter.

The difference is that there is a much lower likelihood of error with the proposed test than with either the “distinctly delineated” or the “story being told” test. The test proposed in this paper is composed of several steps because it recognizes the difficulty in determining whether two works are substantially similar and whether the alleged infringer has copied more than just an idea. The test works well because it allows the court to compare various aspects of the two works, step by step, but also examine the works as a whole and evaluate how the total work appears to the ordinary observer. The test is complicated for a reason, it is designed to fairly and accurately further the purpose of copyright law.

D. Appropriate Balance Achieved with Copyright In the Original Work

In recent years the balance between giving new authors enough incentive to create and leaving enough building blocks in the public domain seems to have tilted against the public domain.¹⁶⁶ This trend of offering increasing amounts of protection for fictional characters may have been influenced by the exceptional earning power of fictional characters. Fictional characters are at the center of a multibillion-dollar industry offering strong motivation for owners to fight to preserve their monopoly any way they can.

For instance, Forbes reported in a list of top ten earning fictional characters that Mickey Mouse made \$5.8 billion in 2003.¹⁶⁷ Winnie the Pooh, born in 1926, made \$5.6 billion in

¹⁶⁶ Kurtz, *supra* note 12, at 429.

¹⁶⁷ Vanesa Gisquet and Lacey Rose, *Top Earning Fictional Characters: Top Characters Gross \$ 25B*; available at http://www.forbes.com/free_forbes/2004/1101/058a.html.

2003.¹⁶⁸ Harry Potter, a new addition, made \$2.8 billion, the same year.¹⁶⁹ In fact, J.K. Rowling, who was on welfare before she wrote the Harry Potter books, is now the first author to qualify for a spot on Forbes's billionaire list.¹⁷⁰

The earnings of these characters are impressive, but they do not offer an argument for why fictional characters deserve their own independent protection. After all, would J.K. Rowling forgo writing the Harry Potter books if she knew she would “only” earn \$10 million as opposed to the \$147 million she earned in 2003?¹⁷¹ Authors already have enough incentive to create by virtue of their monopoly in the original work. In order for literary works to be successful they must contain interesting and real characters and this will not change whether or not the characters are offered independent protection. The bargain authors have struck with the public is already more than fair so that offering characters independent protection will not make more of the arts available to the public, but will only stifle further creativity.

VII. Conclusion

Literary characters are protected within the copyright of the original work in which they appear, but the law is less clear when a character is separated from the original work and leads an independent life. The two main tests articulated by courts to deal with the phenomenon of an independent character have not been particularly helpful. The tests are mainly used after a decision has already been reached to give the decision additional validity by uttering the magic words “distinctly delineated” or “story being told”.

A better alternative is to rely on the copyright protection in the original work since it will be difficult to copy a character without copying a substantial amount of the original author's expression. The substantial similarity test is well suited for determining when so much has been

¹⁶⁸ *Id.*

¹⁶⁹ *Id.*

¹⁷⁰ *Id.*

¹⁷¹ *Id.*

taken from the original so as to constitute infringement. Furthermore, trademark and unfair competition laws protect the character who is so well known that an infringer need only mention the name without copying the expression.

Granting fictional characters independent protection would go against the purpose of copyright law since it would limit creativity and the dissemination of new works to the public. For years, authors have borrowed from each other and used these building blocks to create new inspiring and enriching works. Offering independent protection to fictional characters would limit the pool of raw material and would do a great disservice to the public. The main concern of copyright law should be to promote the progress of the arts, not to secure an everlasting stream of revenue for character owners.